



*Looks Matter...*

*Legally. ®*

# USPTO ROUNDTABLE

## Written Description Requirement As Applied to Design Patents

Perry J. Saidman

Saidman DesignLaw Group, LLC

Silver Spring, MD

March 5, 2014

# *Ariad Pharm. v. Eli Lilly*

*(598 F.3d 1336, Fed. Cir. 2010)*

... the test for [written description] sufficiency is whether the disclosure ... reasonably conveys to those skilled in the art that the inventor had *possession* of the claimed subject matter as of the filing date..

# *Ariad Pharm. v. Eli Lilly*

*(598 F.3d 1336, Fed. Cir. 2010)*

The test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, *the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.*

# 35 U.S.C. 171

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

*The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.*

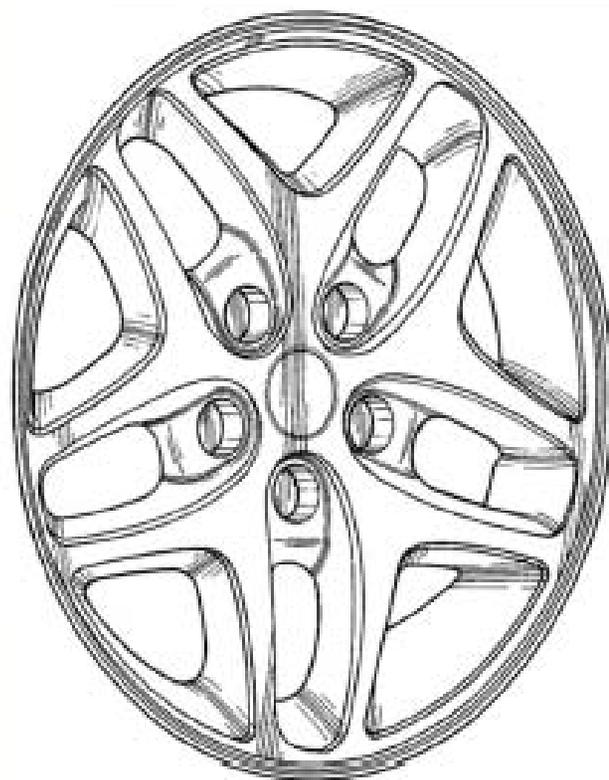


## Roundtable on the Written Description Requirement for Design Applications

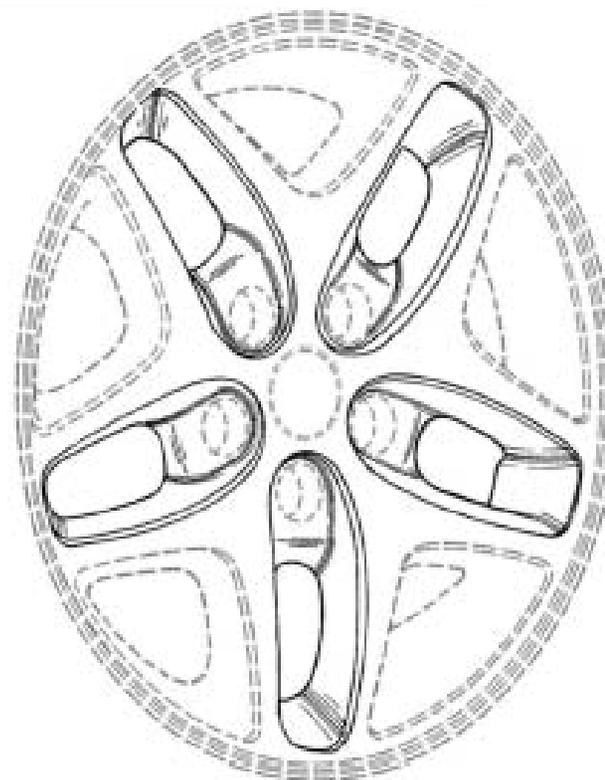
### Additional Examples to Aid Discussion

#### Example 7

Vehicle Wheel  
Front Face

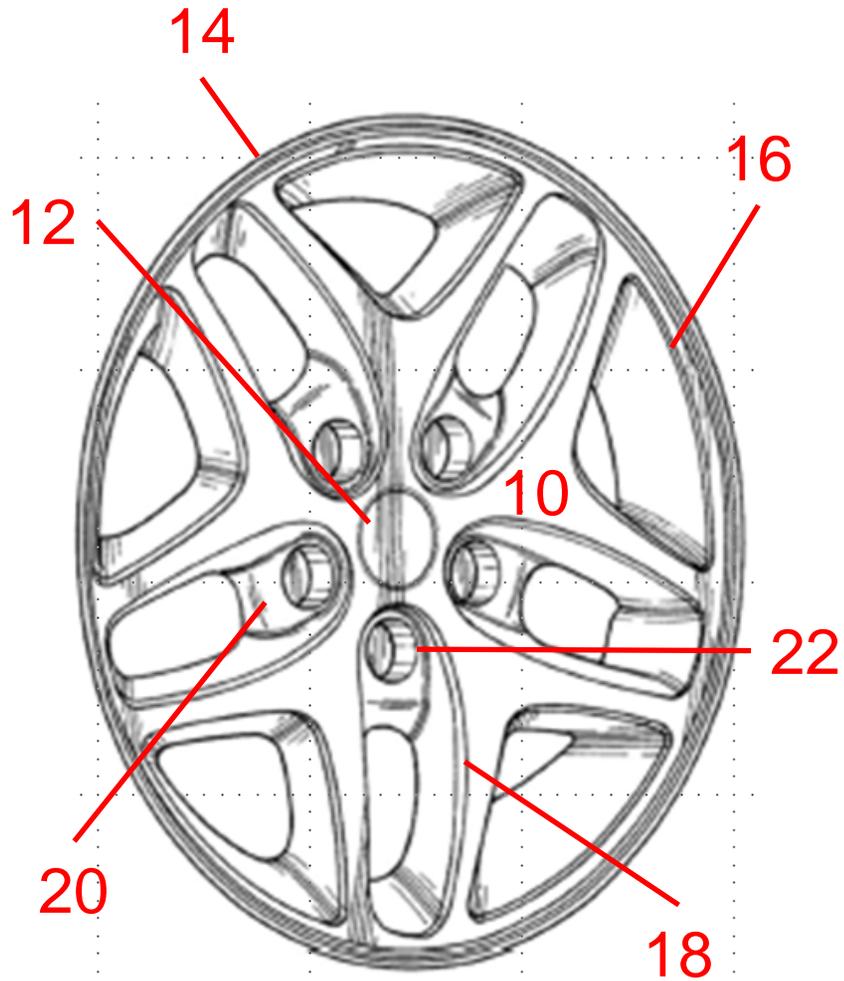


Original



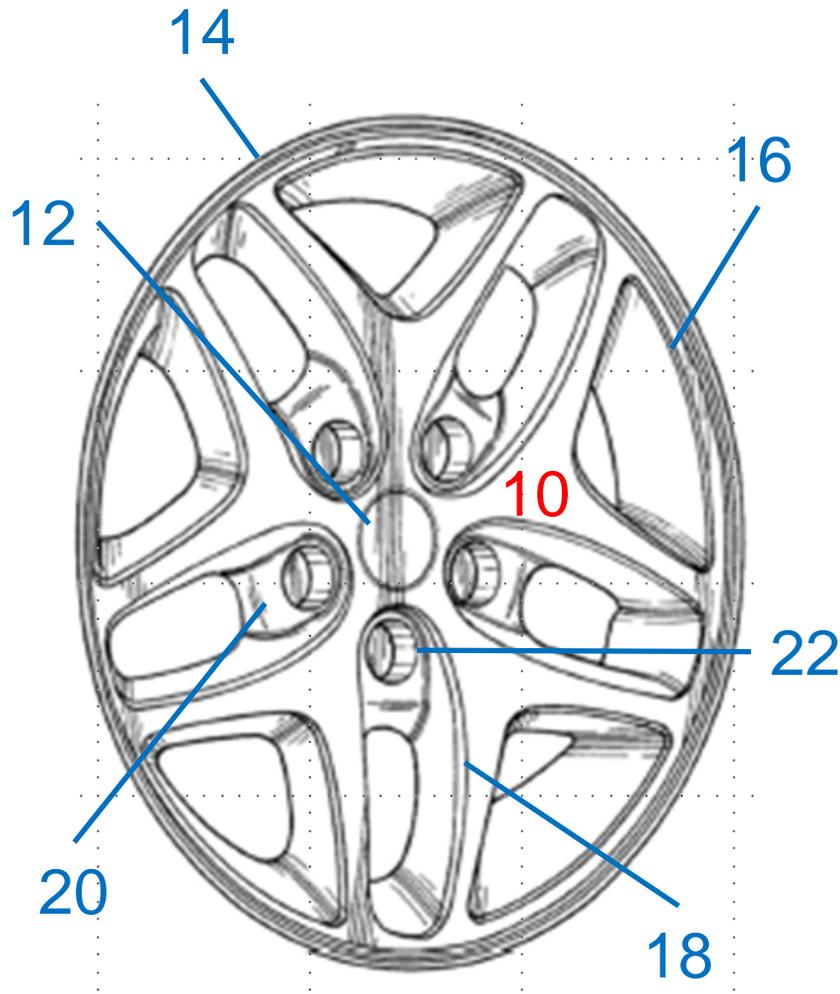
Amended

# WHEEL INVENTION SPECIFICATION



## WHEEL INVENTION

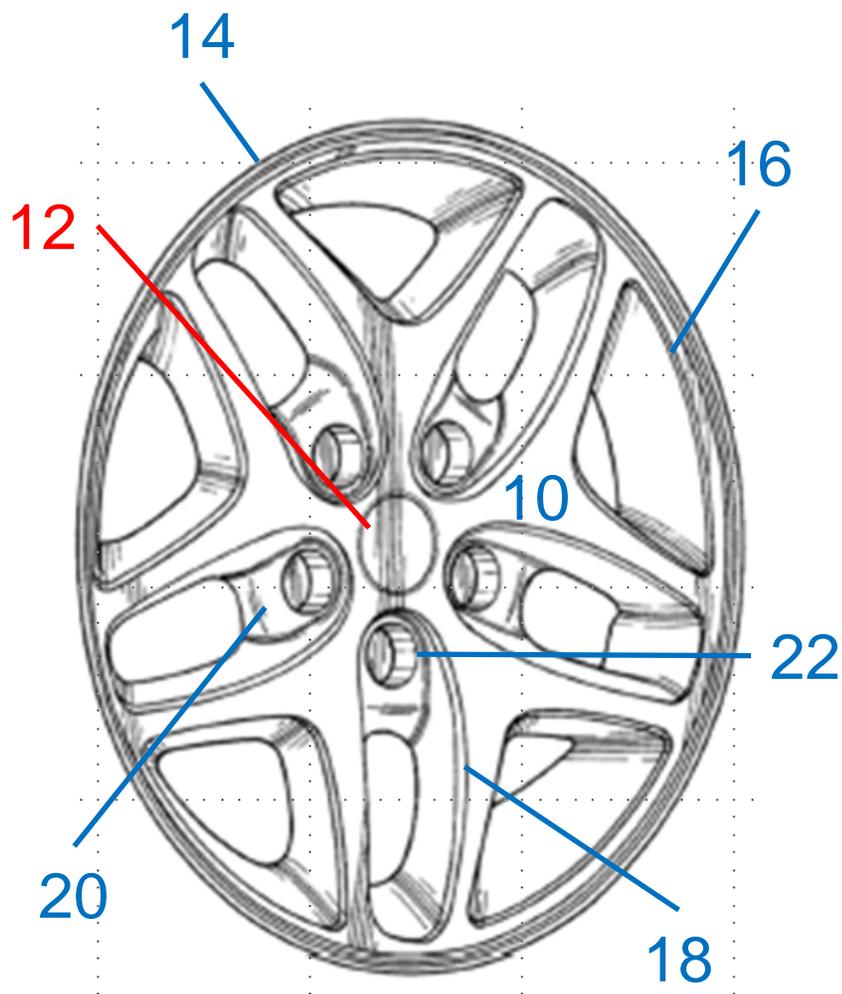
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

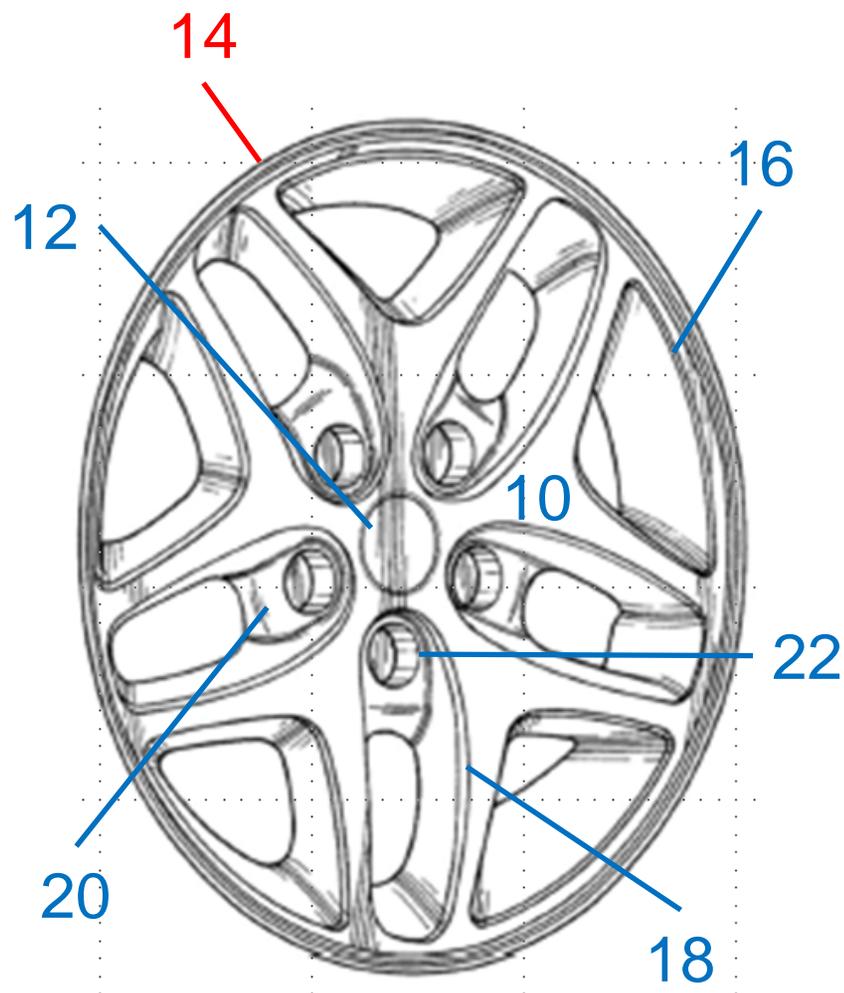
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

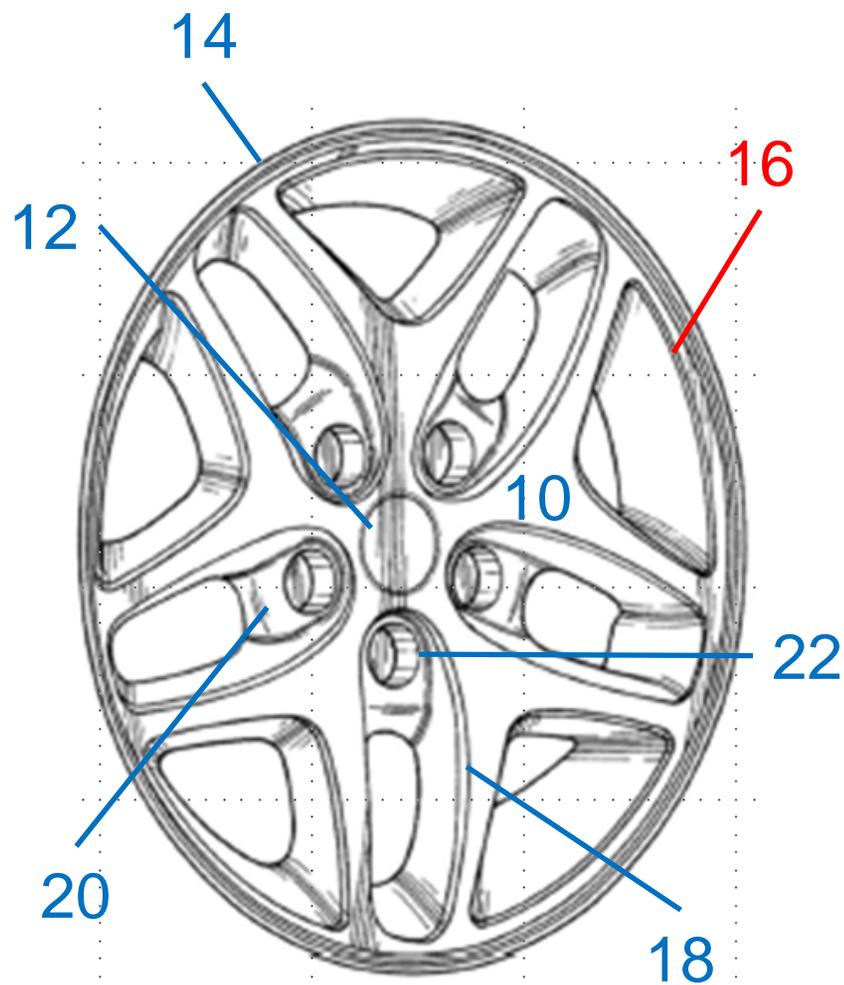
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and **an outer rim 14**. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

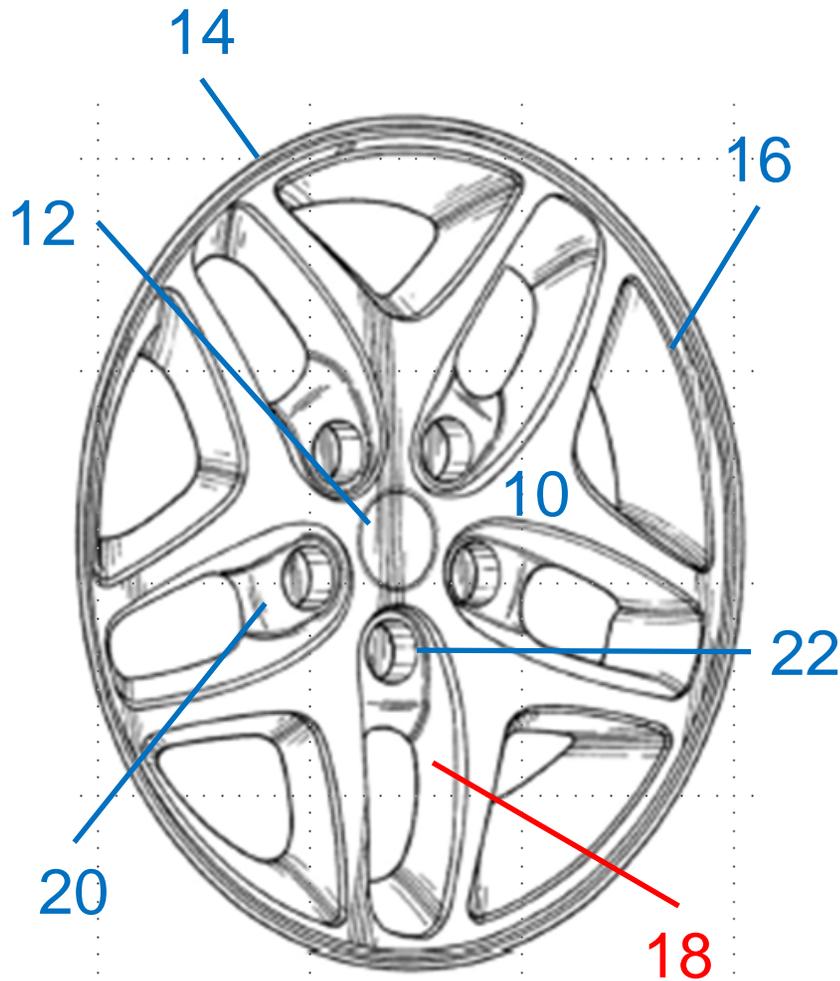
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five **triangular apertures 16** are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

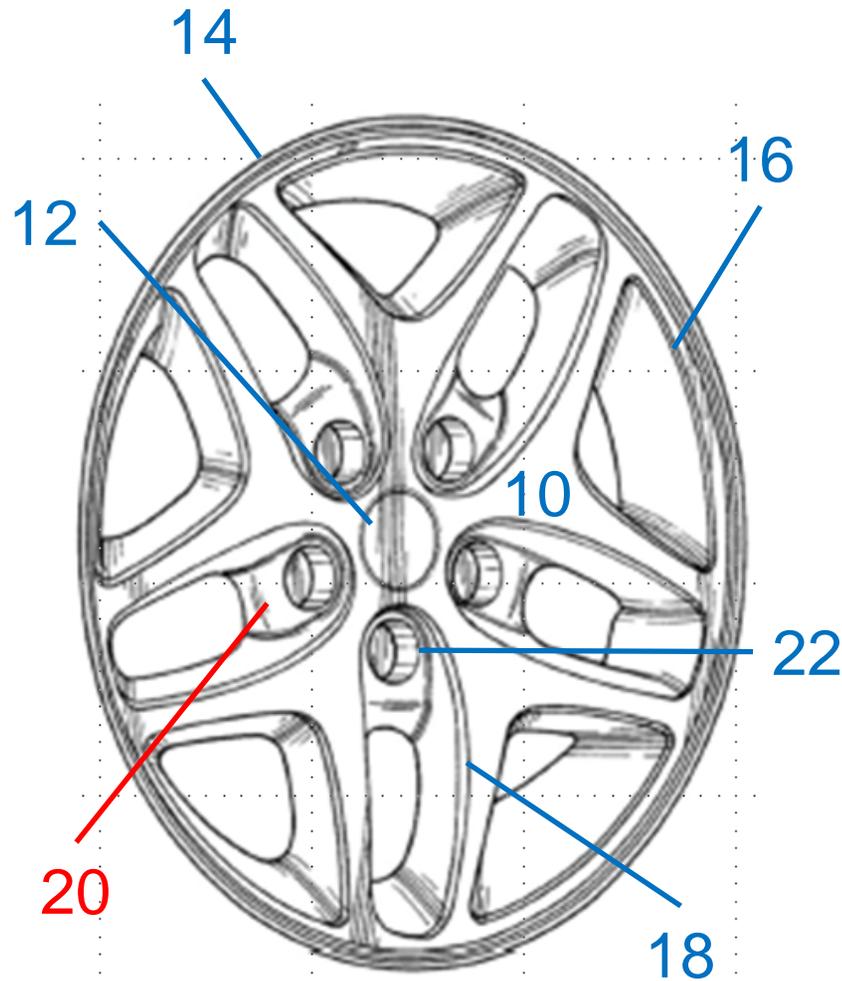
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five **elongated apertures 18**, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

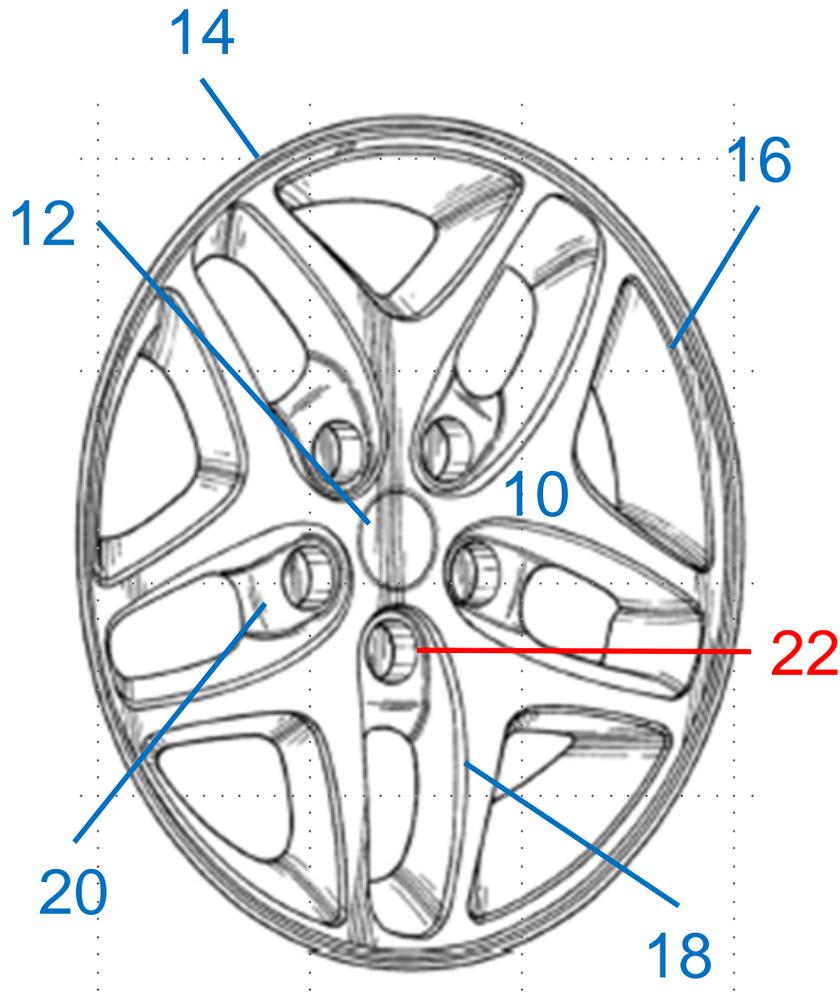
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five **curved portions 20** one located within each of the elongated apertures at one end thereof, and five bolt holes 22 that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

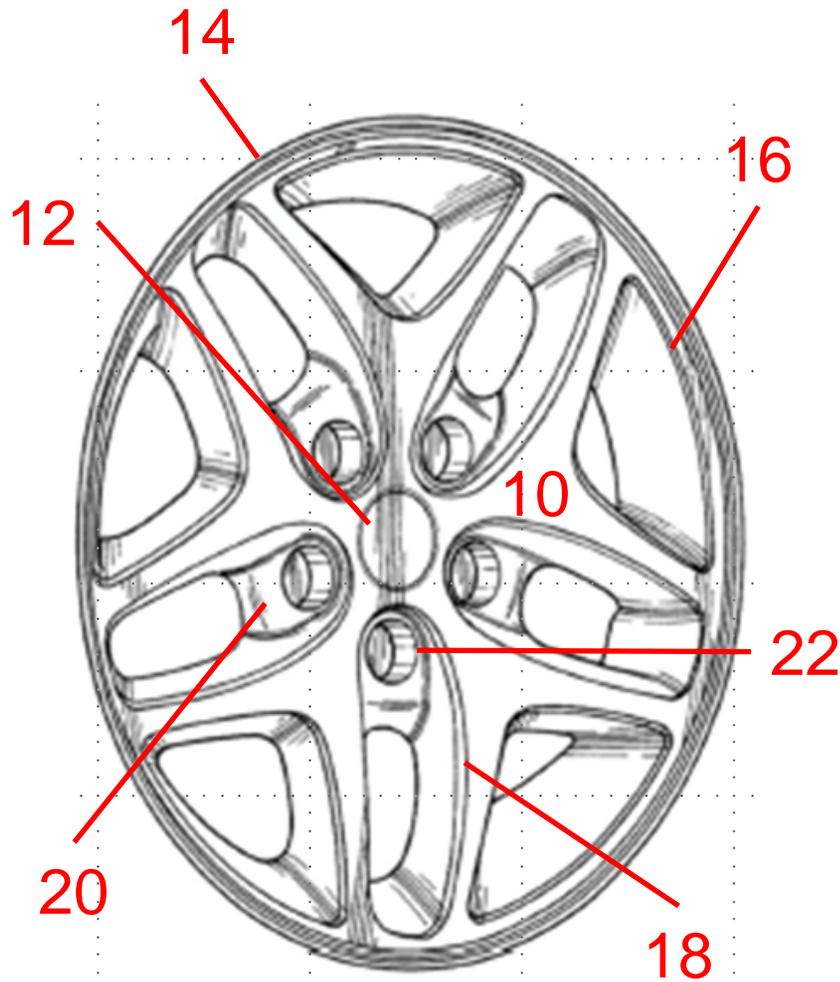
### SPECIFICATION



As illustrated in the sole drawing figure, my invention is a wheel that includes a front face 10, a center portion 12, and an outer rim 14. Five triangular apertures 16 are positioned evenly about the periphery thereof. There are also five elongated apertures 18, one of each of which is positioned between adjacent triangular apertures 16. In addition, there are five curved portions 20 one located within each of the elongated apertures at one end thereof, and five **bolt holes 22** that are each positioned on a respective one of the curved portions 20.

## WHEEL INVENTION

### SPECIFICATION (cont'd) = WRITTEN DESCRIPTION



My invention, of which I have possession, may include all of the elements as illustrated in the sole drawing figure, e.g., triangular apertures 16, elongated apertures 18, curved portions 20, and bolt holes 22, as well as any individual element, or a plurality of the elements in any combination.

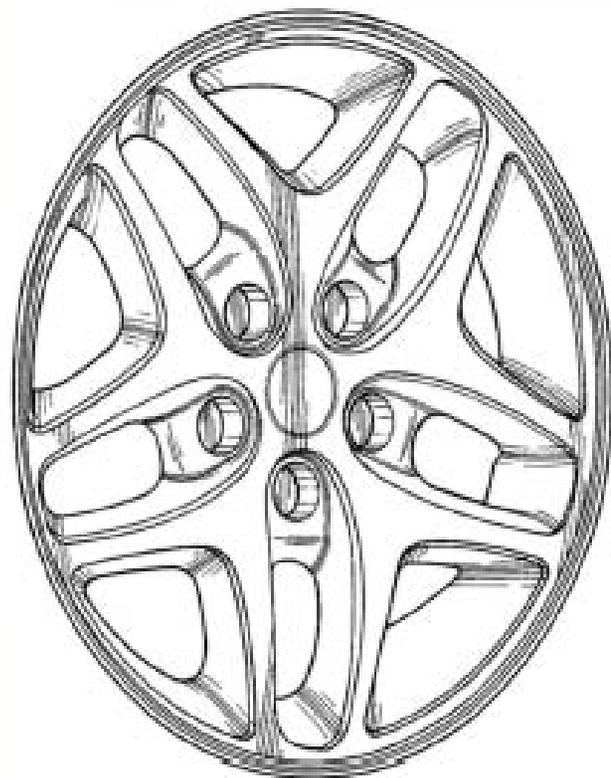


## Roundtable on the Written Description Requirement for Design Applications

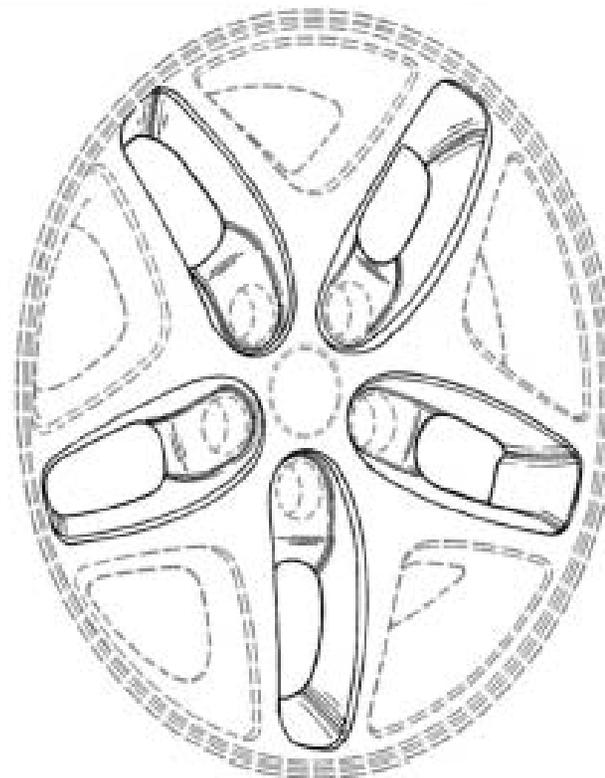
### Additional Examples to Aid Discussion

#### Example 7

Vehicle Wheel  
Front Face



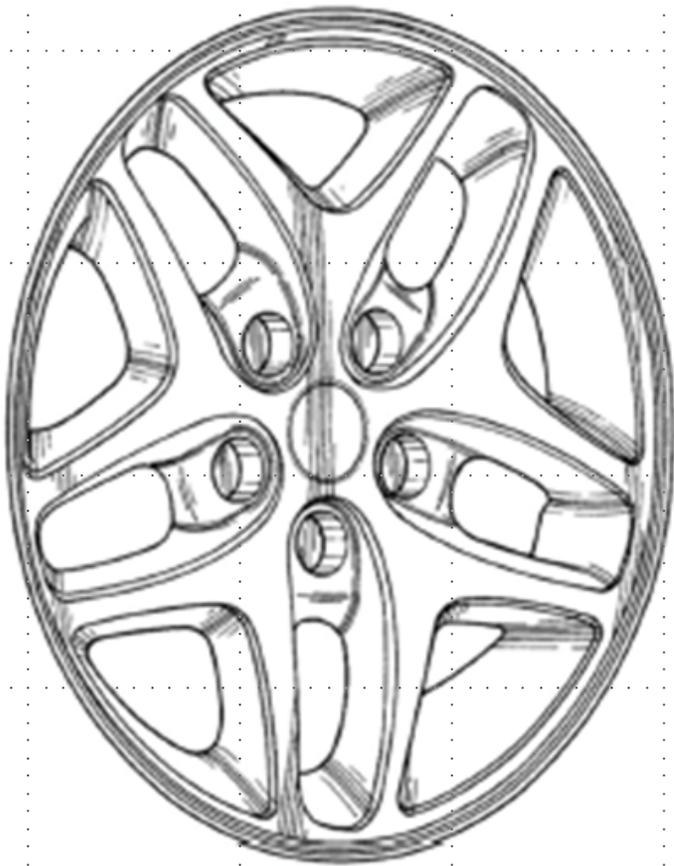
Original



Amended

## EXAMPLE 7 – ORIGINAL CLAIM

Vehicle Wheel Front Face



Original

A wheel, comprising:

- (a) a front face having a center portion and an outer rim;
- (b) a plurality of triangular apertures positioned adjacent said outer rim;
- (c) plurality of elongated apertures, each located between adjacent ones of said plurality of triangular apertures;
- (d) a plurality of curved portions one located within each of the elongated apertures at one end thereof; and
- (e) a plurality of bolt holes, each positioned on a respective one of said curved portions.

## EXAMPLE 7 – AMENDED CLAIM

A wheel, comprising:  
(7a) a plurality of elongated apertures;  
and  
(7b) a plurality of curved portions each positioned within one of said elongated apertures at one end thereof.



Amended

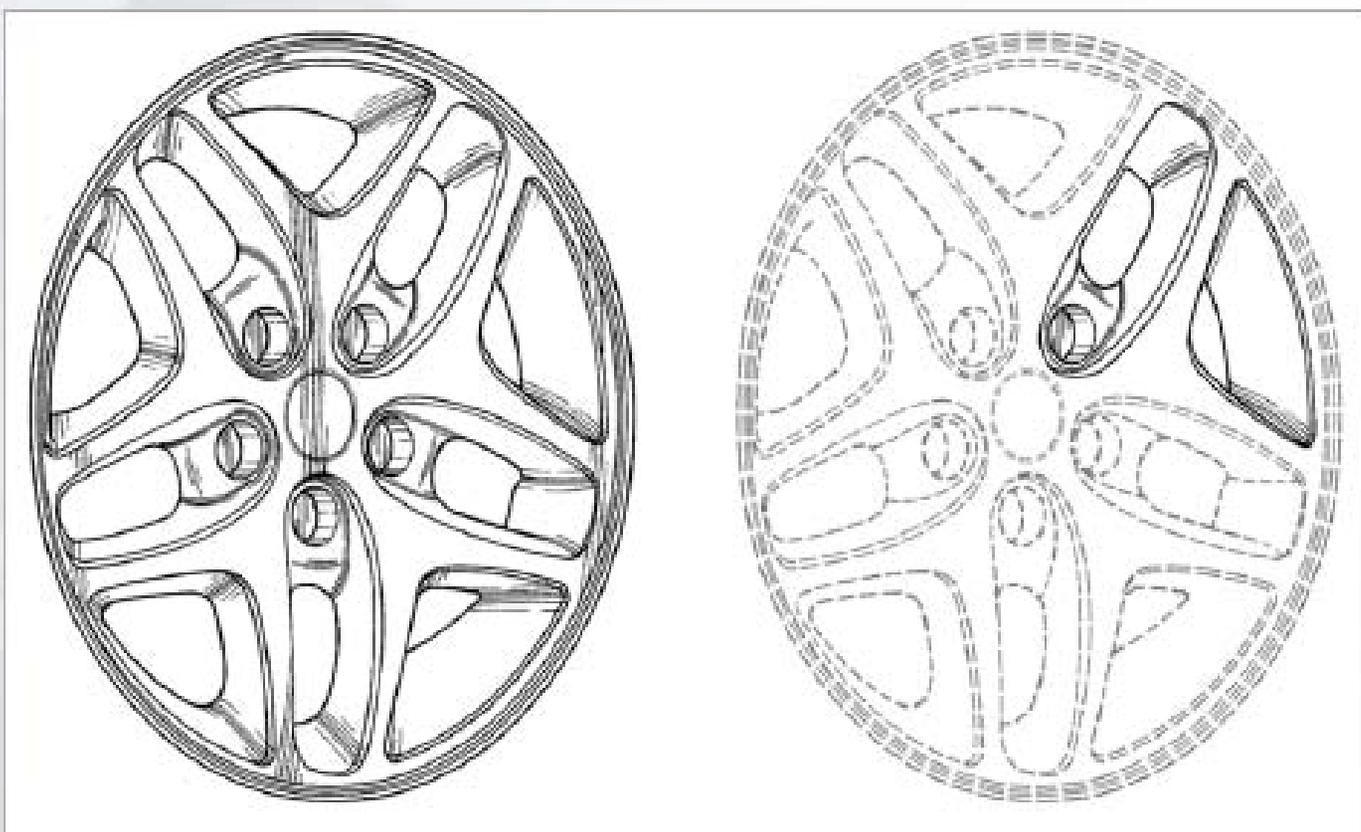


## Roundtable on the Written Description Requirement for Design Applications

### Additional Examples to Aid Discussion

#### Example 8

Vehicle Wheel  
Front Face



Original

Amended

## EXAMPLE 8 – AMENDED CLAIM

A wheel, comprising:

- (8a) a triangular aperture located on the periphery of said wheel;
- (8b) an elongated aperture located adjacent said triangular aperture;
- (8c) a curved portion positioned within said elongated aperture at one end thereof; and
- (8d) a bolt hole positioned on said curved portion.



Amended

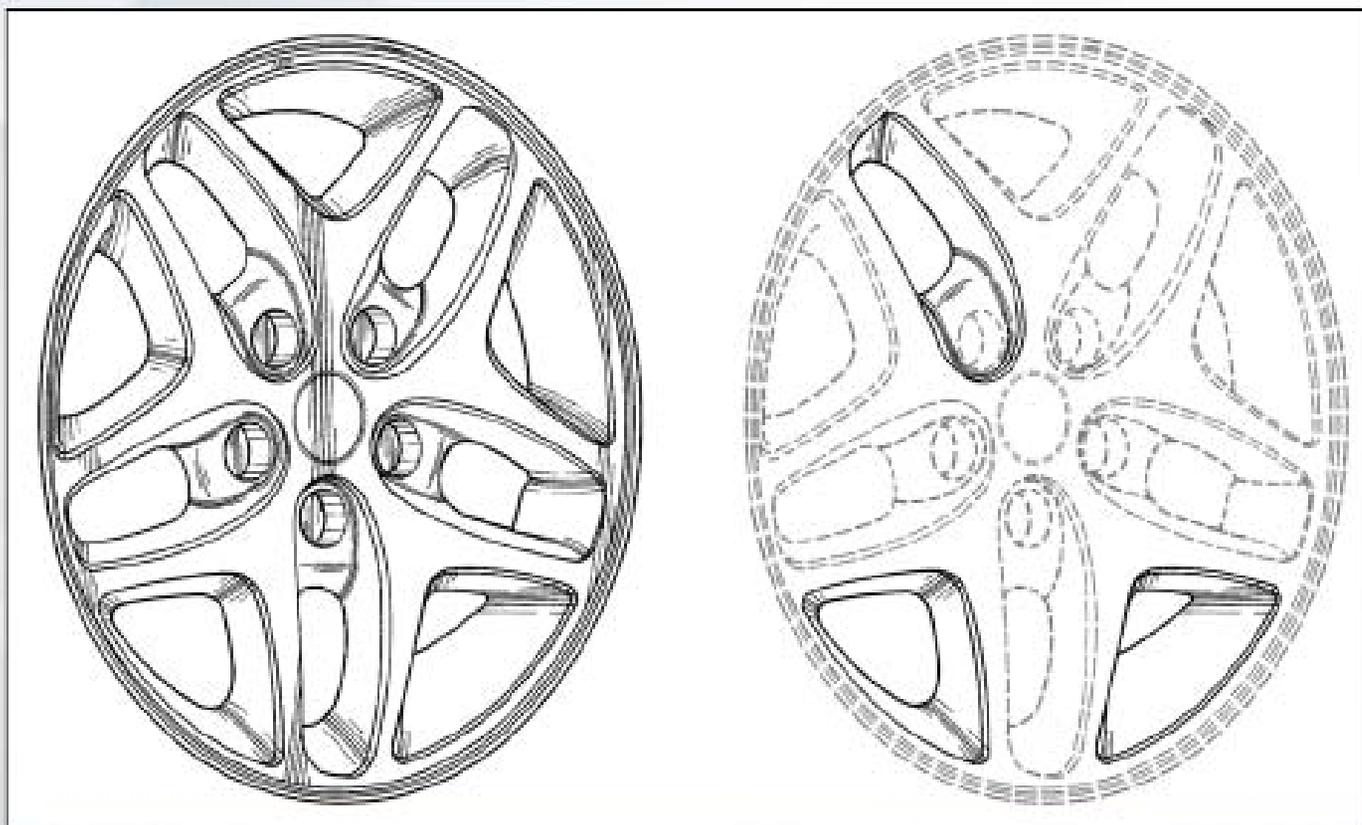


## Roundtable on the Written Description Requirement for Design Applications

### Additional Examples to Aid Discussion

#### Example 9

Vehicle Wheel  
Front Face



Original

Amended

## EXAMPLE 9 – AMENDED CLAIM

A wheel, comprising:

(9a) a pair of triangular apertures positioned adjacent to each other on the periphery of said wheel;

(9b) an elongated aperture located opposite to said pair of triangular apertures; and

(9c) a curved portion positioned within said elongated aperture at one end thereof.



Amended

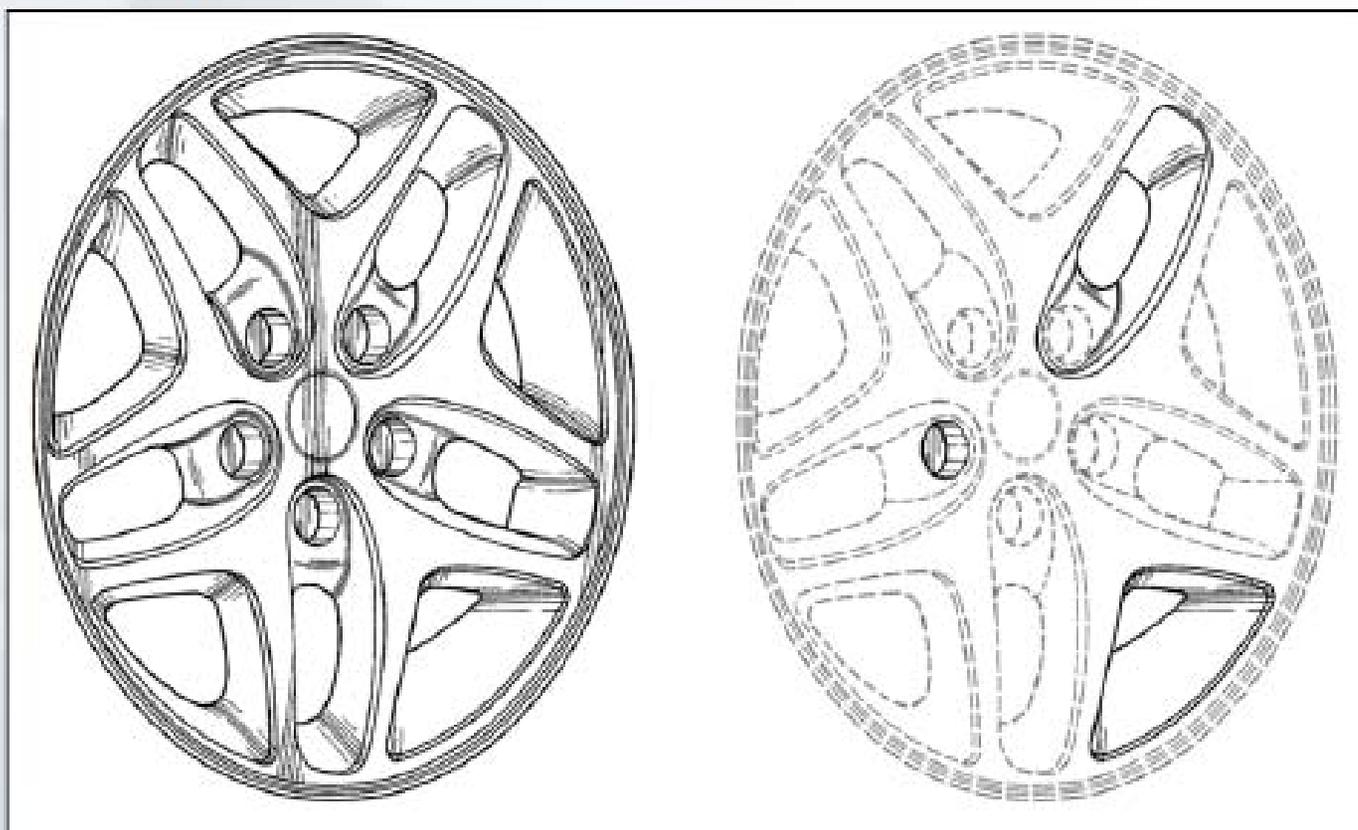


## Roundtable on the Written Description Requirement for Design Applications

### Additional Examples to Aid Discussion

#### Example 10

Vehicle Wheel  
Front Face

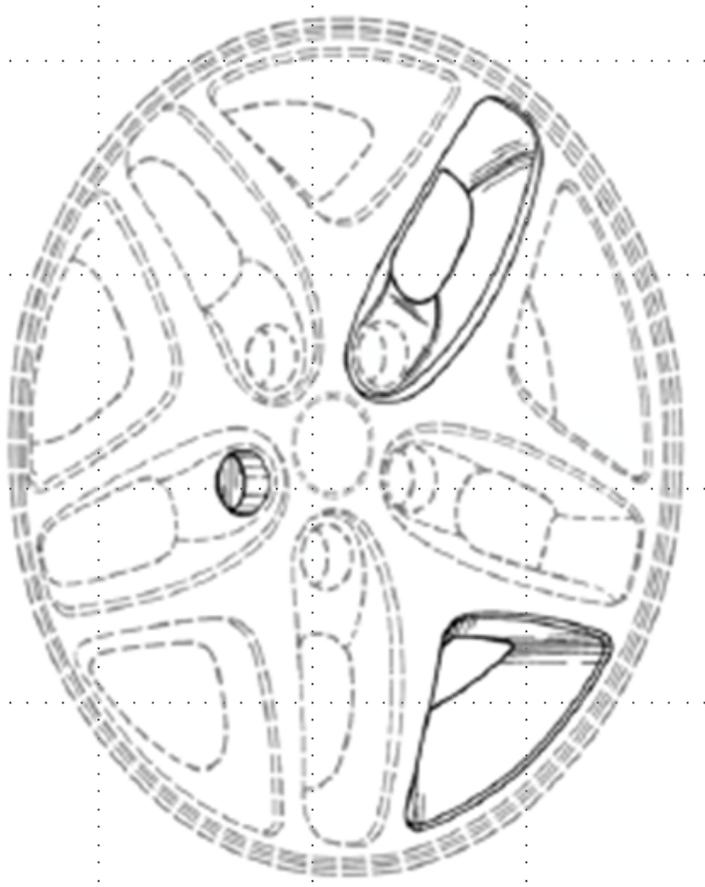


Original

Amended

## EXAMPLE 10 – AMENDED CLAIM

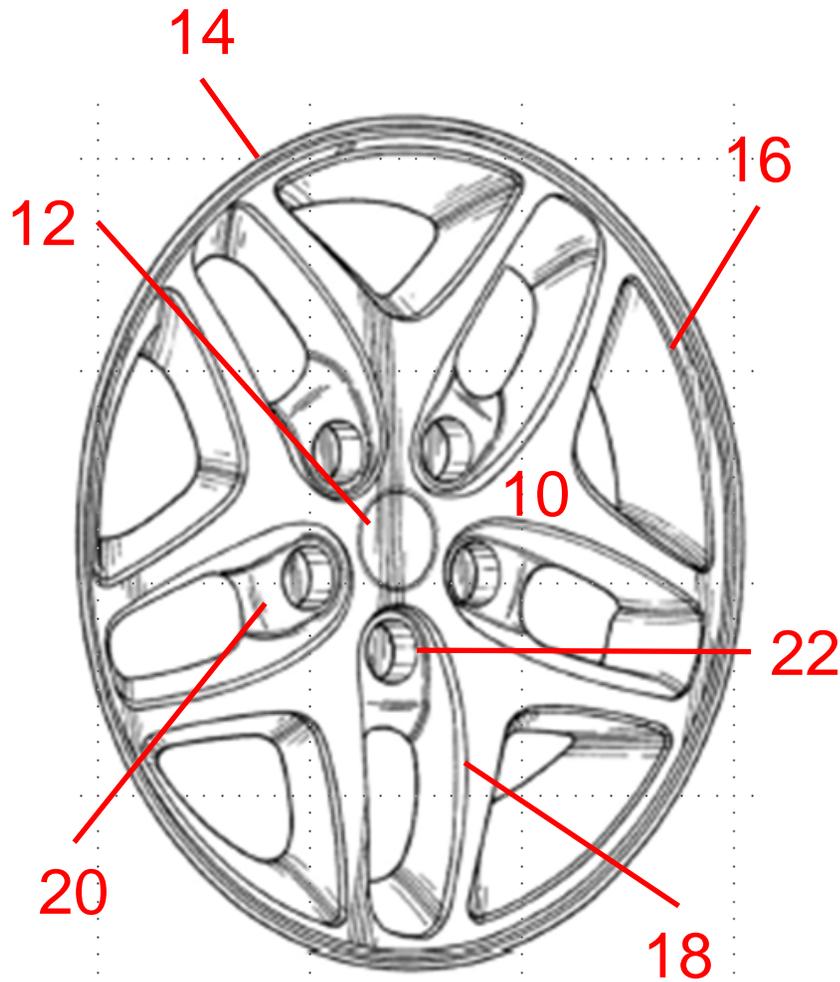
A wheel, comprising:  
    (10a) a triangular aperture on the periphery of said wheel;  
    (10b) an elongated aperture spaced from said triangular aperture;  
and  
    (10c) a bolt hole spaced from said triangular aperture and said elongated aperture.



Amended

## WHEEL INVENTION

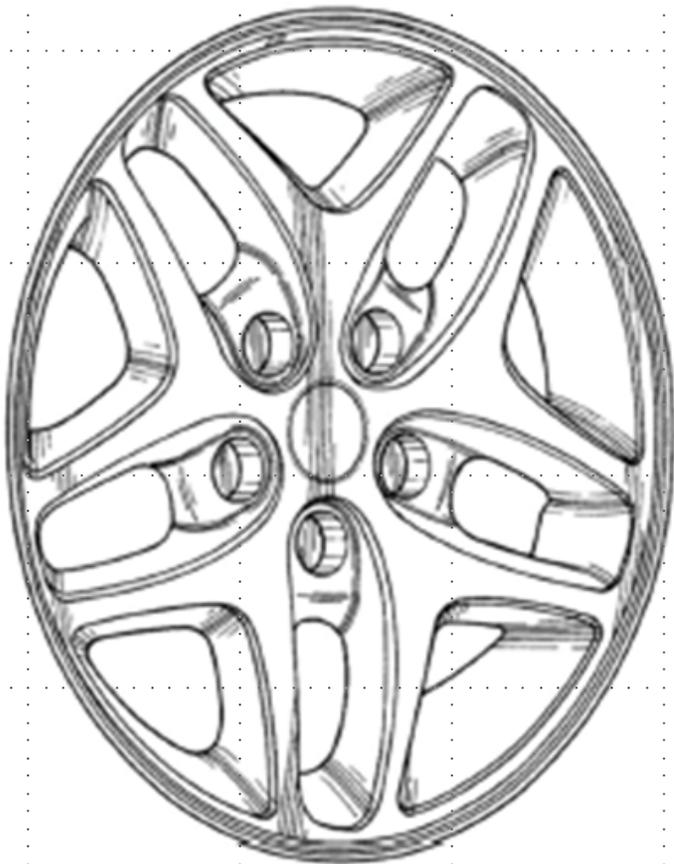
### SPECIFICATION (cont'd) = WRITTEN DESCRIPTION



My invention, of which I have possession, may include all of the elements as illustrated in the sole drawing figure, e.g., triangular apertures, elongated apertures, curved portions, and bolt holes, as well as any individual element, or a plurality of the elements in any combination.

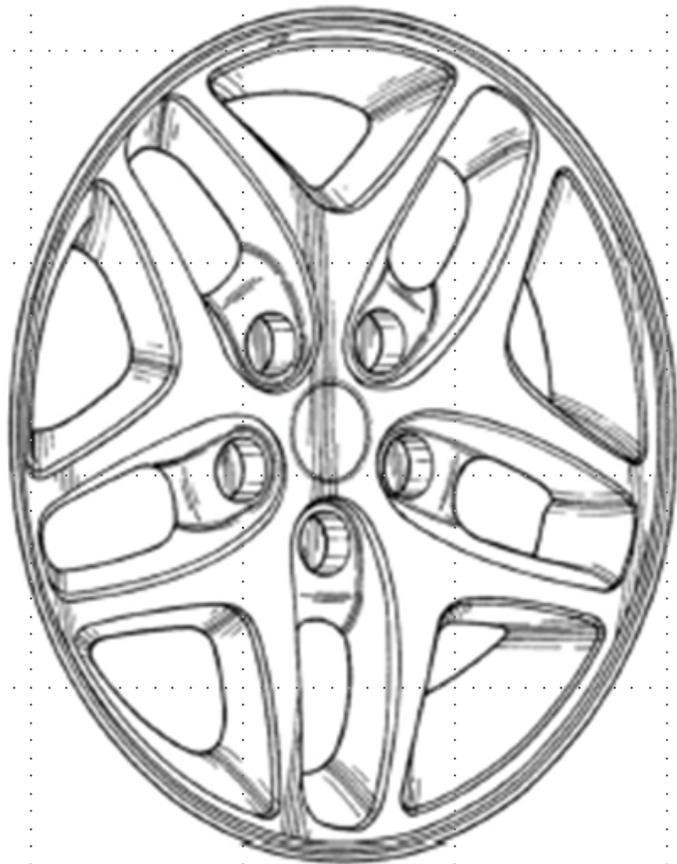
## WHEEL DESIGN

### SPECIFICATION/APPENDIX = WRITTEN DESCRIPTION OF DESIGN



My DESIGN, of which I have possession, may include all of the elements as illustrated in the sole drawing figure, e.g., triangular apertures, elongated apertures, curved portions, and bolt holes, as well as any individual element, or a plurality of the elements in any combination.

## CONCLUSION



SINCE ALL OF THE AMENDED UTILITY PATENT CLAIMS ARE SUPPORTED BY THE WRITTEN DESCRIPTION IN THE DISCLOSURE OF THE ORIGINAL UTILITY APPLICATION, THEN ALL OF THE AMENDED DESIGN PATENT CLAIMS **MUST BE** SUPPORTED BY THE SAME WRITTEN DESCRIPTION IN THE DISCLOSURE OF THE ORIGINAL DESIGN APPLICATION.



*Looks Matter...*

*Legally. ®*