

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM K. STOUT, JR.

Appeal No. 2004-1305
Application No. 29/138,829

ON BRIEF

Before PAK, WALTZ, and SAADAT, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of the single design claim 1. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to the ornamental design for a duct with an indented end as shown and described in Figures 1 through 6 submitted with the Requests for Authorization to Amend the Drawings dated September 17, 2002, and

Appeal No. 2004-1305
Application No. 29/138,829

December 30, 2002 (Brief, page 3; these amended drawings are shown in Exhibit F attached to the Brief).

A. Background

This design application was filed on March 20, 2001, with two original figures drawn to an ornamental design for a duct with an indented end (see Exhibit A attached to the Brief). These original figures are two-dimensional drawings representing two different embodiments of a duct with an indented end. Appellant submitted new Figures 1-6 with the Requests for Authorization to Amend the Drawings dated Sep. 17, 2002, and Dec. 30, 2002 (Brief, page 3; see Exhibit F attached to the Brief). The examiner objected to but entered these amended Figures (Brief, page 5; see the Office actions dated Dec. 16, 2002, and Mar. 4, 2003), while rejecting the claim under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement since the amended drawings introduced "new matter" not supported by the original disclosure (Brief, pages 3-4; final Office action dated Mar. 4, 2003, page 2). Appellant has appealed from this final rejection.¹

¹ We note that appellant has listed eleven (11) related appeals on page 2 of the Brief. However, we also note that appellant has omitted Application No. 29/138,764, filed Mar. 20, 2001, now Appeal No. 2004-1410.

Appeal No. 2004-1305
Application No. 29/138,829

B. The Rejection

The single design claim stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement since the amended drawings introduce new matter not supported by the original disclosure (Answer, unnumbered page 2, referring to the final Office action dated Mar. 4, 2003, Paper No. 15). The examiner finds that there is no support in the original disclosure for five features in the amended drawings (final Office action, Paper No. 15, page 2; see also the Brief, page 4). As noted by the examiner (Answer, unnumbered page 2), appellant's arguments are solely based on the 37 CFR § 1.132 Declaration of David H. Wagner, Jr., dated June 30, 2003 (hereafter the "Wagner Declaration"; see the Brief, pages 5-17). The examiner has replied to "affiant's [sic, declarant's]" points from the Declaration in the Answer (unnumbered pages 3-6).

C. The Decision

We reverse the examiner's rejection on appeal essentially for the reasons stated by appellant in the Brief, Reply Brief, the Wagner Declaration, and for those reasons set forth below.

D. The Opinion

As stated by our reviewing court in *In re Daniels*, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998):

Appeal No. 2004-1305
Application No. 29/138,829

The test for sufficiency of the written description is the same, whether for a design or a utility patent. This test has been expressed in various ways; for example, "whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" [Citations omitted].

...

In general, precedent establishes that although the applicant "does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed." [Citation omitted].

It is the drawings of the design patent that provide the description of the invention. [Citation omitted].

The issue of whether a patent specification adequately describes the subject matter claimed is a question of fact. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The Wagner Declaration, even couched in terms of the declarant's "opinion," clearly is offering factual evidence in an attempt to explain why one of ordinary skill in this art would have understood the original drawings to support the amended drawings. See *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). The Wagner Declaration contains statements of fact directly addressing the issue of whether the original drawings provide support for the amended drawings (e.g., see ¶9 in the Wagner Declaration).

Appeal No. 2004-1305
Application No. 29/138,829

As correctly argued by appellant (Reply Brief, pages 1-2), the examiner in the Answer requires a "microanalysis" of every point of the drawings. "If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the written description requirement is met." *In re Alton*, 76 F.3d at 1175, 37 USPQ2d at 1584.

We agree with appellant and the declarant that a designer of ordinary skill in the heating, ventilation and air conditioning (HVAC) duct art, with knowledge of conventional technical drawing practice, would have understood appellant to be in possession of the claimed invention as described by Figures 1-3 (the first embodiment) and Figures 4-6 (the second embodiment) at the time of filing this application, as supported by the original figures (Figure 1 as the first embodiment; Figure 2 as the second embodiment). For example, declarant states that the original application clearly describes the surfaces and profiles of the shapes of the indented ends and gaskets in Figures 1 and 4, as well as the number of concentric outlines shown in Figures 2 and 5 (Wagner Declaration, ¶¶ 7 and 8). We agree with declarant that it would have been clear to the design artisan that three flanges

Appeal No. 2004-1305
Application No. 29/138,829

were presented in the original drawings, and would have appeared as three concentric outlines in a top view. We also agree with the declarant that the surfaces and profiles of the indented ends and gaskets would have been readily apparent from original Figures 1-2. Furthermore, declarant states that the rounded edge profile of the shortest flange, as contrasted with the edge profiles of the intermediate and longest flanges, are apparent due to the appearances of the profiles and surfaces shown in original Figures 1 and 2 (Wagner Declaration, ¶¶ 9 and 10). A designer of ordinary skill in this art, with conventional knowledge of technical drawing, would have recognized, upon rotation of original Figure 1 (as enlarged in Exhibit B, or highlighted as per Exhibit C), the curved profile of the protrusion "6" (see Exhibit D) and the edge profiles of each flange outward from the lines of the basic cylinder of the duct, increasing in protuberance from top to bottom. We also agree with declarant's statement concerning the lines of various steps and step surfaces (Wagner Declaration, ¶¶ 13, 15 and 17). We agree that it would have been clear to the design artisan that the two lines of the first step (numbered "10" as in Exhibits C and D) do not go outside the lines of the basic cylinder which forms the duct and thus could not be a protruding flange.

Appeal No. 2004-1305
Application No. 29/138,829

Similarly, we agree with declarant's explanation of the appearance of the corresponding lines of the second step, the third step, the single lines listed as 10B and 12B, as well as the inner surface 16A (see Exhibits C and D; Wagner Declaration, ¶¶ 13, 15 and 17).

For the foregoing reasons and those stated in the Brief, Reply Brief, and the Wagner Declaration, we determine that, based on the totality of the record, the preponderance of evidence establishes that the written description requirement of section 112 has been met by the amended Figures 1-6 submitted by appellant. See *In re Alton*, 76 F.3d at 1175, 37 USPQ2d at 1584, citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Accordingly, we do not sustain the examiner's rejection on appeal.

Appeal No. 2004-1305
Application No. 29/138,829

The decision of the examiner is reversed.

REVERSED

Chung K. Pak)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
Thomas A. Waltz)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
Mahshid D. Saadat)	
Administrative Patent Judge)	

TAW/tdl

Appeal No. 2004-1305
Application No. 29/138,829

Dinsmore & Shohl, LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, OH 45202