

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM K. STOUT, JR.

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Appeal No. 2004-1452  
Application No. 29/138,830

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ON BRIEF

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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. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to the ornamental design for a duct tap with an indented end as shown and described in Figures 1 through 8 submitted with a "Request for Authorization to Amend the Drawings" dated Sep. 9, 2002, and

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July 1, 2003 (Brief, page 3; a copy of these amended drawings are found in Exhibit F attached to the Brief).

*A. Background*

This design application was filed on March 20, 2001, with two original figures drawn to the ornamental design for a duct tap 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 tap with an indented end. *Id.* Appellant submitted new Figures 1-8 with the Request for Authorization to Amend the Drawings dated Sep. 9, 2002, and July 1, 2003 (Brief, page 3; see Exhibit F attached to the Brief). The examiner rejected the single design 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, page 4; final Office action dated Mar. 4, 2003, page 2). Appellant has appealed from this final rejection.<sup>1</sup>

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

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*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, page 2, referring to the final Office action dated Mar. 4, 2003, Paper No. 16). The examiner finds that there is no support in the original disclosure for seven features found in the amended drawings (final Office action, Paper No. 16, pages 2-3; see also the Brief, page 4). As correctly noted by the examiner (Answer, page 3), appellant's arguments are solely based on the 37 CFR § 1.132 Declaration of David H. Wagner, Jr., dated July 1, 2003 (hereafter the "Wagner Declaration"; see the Brief, pages 5-21). The examiner has replied to many of the "affiant's [sic, declarant's]" points from the Wagner Declaration (Answer, pages 4-8).

*C. The Decision*

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

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*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):

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). We determine that the Wagner Declaration contains statements of fact directly addressing the

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issue of whether the original drawings provide support for the amended drawings (e.g., see ¶¶ 7-11 in the Wagner Declaration).

As correctly argued by appellant (Reply Brief, pages 1-2), the examiner in the Answer apparently requires a "microanalysis" of every point of the drawings. However, our reviewing court has held that "[i]f 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. Accordingly, applying this standard to the facts of this appeal, we consider the design as a whole and determine whether the preponderance of evidence reasonably conveys to a designer of ordinary skill in the duct art that appellant was in possession of the now claimed subject matter as of the filing date.

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 reasonably understood appellant to be in possession of the claimed invention as now described by Figures 1-4 (the first embodiment) and Figures 5-8 (the second

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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, 2, 5 and 6, as well as the number of concentric outlines shown in Figures 3 and 7 (Wagner Declaration, ¶¶ 7 and 8; see Exhibit D). We agree with the declarant that it would have been reasonable to the designer of ordinary skill in the duct art that three flanges were represented in the original drawings, and these flanges would have reasonably 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 in amended Figures 1-8 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, would have been apparent due to the appearance of the profiles and surfaces shown in original Figures 1 and 2 (Wagner Declaration, ¶¶ 9-10). A designer of ordinary skill in the duct art, with knowledge of conventional technical drawing practice, would have recognized, upon rotation of original Figure 1 (as

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enlarged in Exhibit B, or as highlighted and marked as in Exhibit C), the curved profile of the protrusion numbered as "6" (see Exhibit D) and the edge profiles of each flange outward from the lines forming the basic cylinder of the duct tap, 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, ¶¶ 13-17). We agree that it would have been reasonable to the ordinary designer to consider that the two lines of the first step (numbered "11" as found in Exhibits C and D) do not go outward from the lines of the basic cylinder of the duct tap and thus could not be any protruding design such as a flange. Similarly, we agree with the declarant's explanation of the appearance of the corresponding lines of the second and third steps (see the Wagner Declaration, ¶¶ 15-17 and Exhibits C and D).

We also agree with the declarant that the saddle portions (numbered as "9, 10, 15, 17 and 18" in Exhibit D) would have been readily apparent to the designer of ordinary skill in this art from the perspective views originally presented in Figures 1-2 (Wagner Declaration, ¶¶ 25-26). The examiner's allegation that the original lack of surface shading "allows for the possibility that the exterior sides of the saddle ... could have a compound

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curvature" has no basis in fact on this record. *See In re Alton supra* (if one of ordinary skill would have understood the inventor to be in possession of the claimed invention, *even if every nuance* of the claims is not explicitly described, then the description requirement is met). From consideration of the design as a whole, we determine that the saddle portions of the amended Figures would have been readily apparent to a designer of ordinary skill in this art from the perspective view of original Figures 1-2.

For the foregoing reasons and those stated in the Brief, Reply Brief, and the Wagner Declaration, we determine that, based on the design as a whole and the totality of the record, the preponderance of the evidence establishes that the written description requirement of section 112 has been met by the amended Figures 1-8 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.

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The decision of the examiner is reversed.

**REVERSED**

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

TAW/tdl

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