

**Keywords:** design patent; continuation; broken lines; boundary lines, unclaimed subject matter; written description requirement

**General:** "Unclaimed boundary" lines in continuation application for design patent, which indicate that applicant has disclaimed portion beyond boundary while claiming area within it, typically should satisfy written description requirement only if lines make explicit boundary that already exists, but was unclaimed, in original disclosure.

*In re Owens.*

106 U.S.P.Q.2d 1248 (Fed. Cir. 2013)

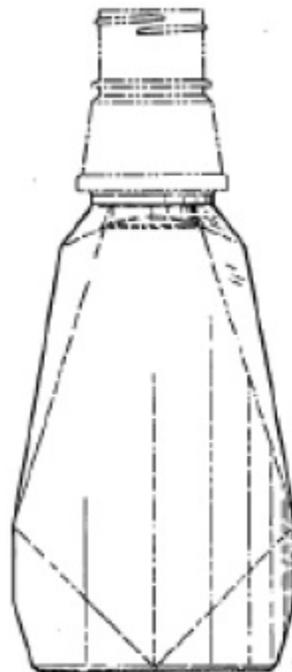
Decided March 26, 2013

**I. Facts**

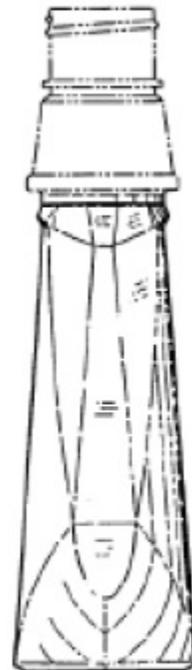
Timothy S. Owens et al. ("Owens") created an ornamental design of a bottle, and filed several design patent applications. The parent design application issued as D531,515 ('515 patent), which includes the following drawings, among others.



*Fig. 1*

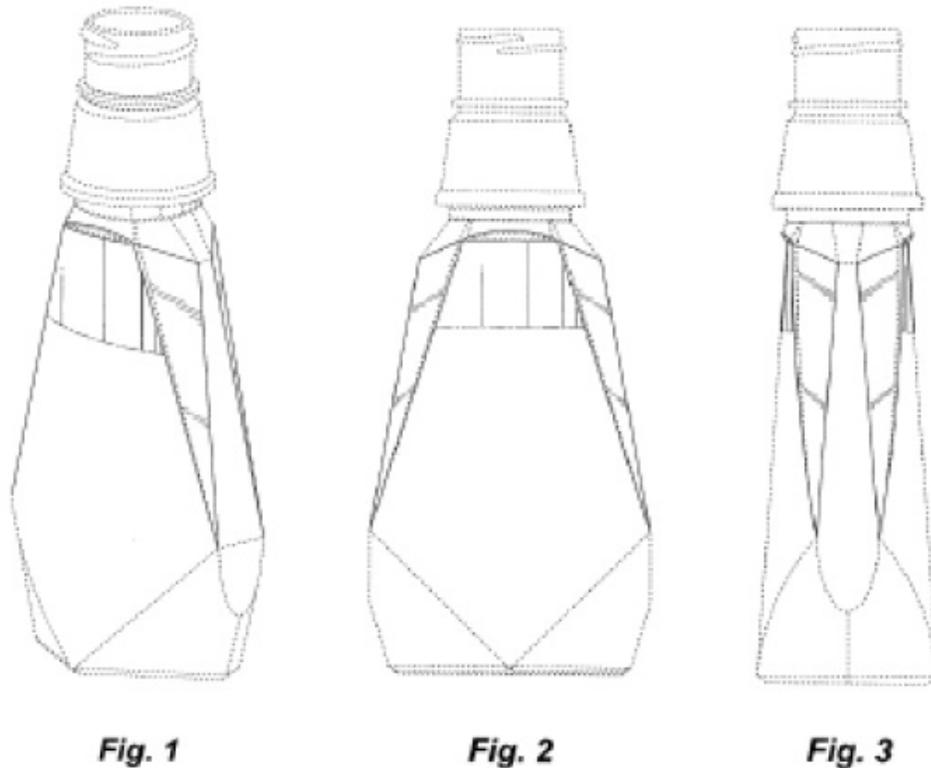


*Fig. 2*



*Fig. 3*

Owens subsequently filed a continuation application no. 29/253,172 ('172 application), which includes the following drawings, among others.



The '172 application claimed three design elements: (1) the small crescent-shaped area on the front and back of the bottle near the cap, (2) the narrow triangular areas along the bottle's shoulders, and (3) an upper portion of the bottle's pentagonal center panel. In order to define the boundary of element (3), Owens added a lower boundary line (i.e., a broken or dashed line) to bisect the pentagonal panel, thereby defining the upper portion in a manner represented as a trapezoidal shaped region.

During prosecution of the '172 application, the Examiner rejected the application for failing to meet the written description requirement, because Owens added a boundary line not in the original application (i.e., the '515 patent). In other words, the Examiner indicated that the lower boundary line represented new matter, because it defined a new trapezoidal shaped region that Owens did not originally possess in the '515 patent.

Owens appealed to the United States Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences ("Board"), but the Board affirmed the Examiner's rejection. Owens then appealed to the Federal Circuit.

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**II. Issues**

- A. Does the addition of a new boundary line (i.e., a broken or dashed line) need to meet the written description requirement in a design application?

**III. Discussion**

- A. Yes. In general, if an applicant desires to add a new boundary line in a design application (e.g., a continuation application), then the new boundary line must meet the written description requirement.

In design applications, broken or dashed lines are generally used to indicate unclaimed features, while solid lines define the scope of the claimed design. For example, the broken or dashed lines may be used to define environmental features or boundaries, but do not form any part of the claimed design.

On appeal, Owens asserted that his continuation was not even claiming a trapezoidal shaped region, but rather the lower boundary line was merely defining an unclaimed boundary of the upper portion of the bottle's pentagonal center panel. Owens suggested a relaxed written description test based on *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998), wherein the Federal Circuit held that the written description requirement was met in a later filed continuation application in which design features (i.e., a floral design) were removed from the drawings.

The Federal Circuit distinguished *In re Daniels* over the present case, emphasizing that the underlying design features of *Daniels* were clearly visible in the earlier design application, whereas the lower boundary line of Owens was not visible in the earlier design application (i.e., the '515 patent). In other words, the Federal Circuit stressed that *Daniels* removed design features rather than adding design features, whereas Owens added design features. The Federal Circuit further stated that "It does not follow from *Daniels* that an applicant, having been granted a claim to a particular design element, may proceed to subdivide that element in subsequent continuations however he pleases." *In re Owens*, 106 U.S.P.Q.2d at 1251.

Accordingly, the Federal Circuit affirmed the Board's decision.

**IV. Conclusion**

If any unclaimed boundary lines (e.g., broken or dashed lines) are desired after filing a design application (including subsequent continuations), then the Federal Circuit advised that the best practice, as presented in the PTO's brief, is to ensure that such unclaimed boundary lines are based on lines existing in the original disclosure. In other words, it would be permissible to change a solid line to a dashed line, but not to add a new dashed line without any basis in the original drawings.