

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL D. JACKSON

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Appeal No. 99-1439  
Application No. 29/033,921<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS,  
and FRAHM, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim under 35

U.S.C. § 112, first paragraph:

The ornamental design for [a] golf putter head as shown and described.

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<sup>1</sup> Application for patent filed January 24, 1995.

The appealed claim stands rejected under the first paragraph of 35 U.S.C. § 112 as being based on an original disclosure which, as filed in this application, does not satisfy the description requirement in that paragraph.<sup>2</sup>

The record before us shows that the instant application as filed contained a single embodiment of the putter head as illustrated in original Figures 1-5. In response to the first office action mailed September 1, 1995, appellant added by an amendment filed February 5, 1996, a second embodiment of the putter head. In this amendment, the specification was revised and the Figure numbers were changed so that the original embodiment is now illustrated in Figures 6-10 and the second, newly added embodiment is illustrated in Figures 1-5.

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<sup>2</sup> Appellant has devoted a substantial portion of his brief discussing issues under § 132. However, the standing rejection in this appeal is under the first paragraph of § 112, and not under § 132. The examiner's objection to the introduction of new matter is based on § 132 (see page 5 of the answer), but the examiner's objection is a petitionable matter, not one that is reviewable by us on appeal. See MPEP § 608.04(c).

In the final office action mailed April 30, 1996, the examiner properly entered the foregoing amendment, but stated that "[the] amendment introduces new matter (35 U.S.C.[§] 132, 37 C.F.R. § 1.118)." The examiner additionally required appellant to cancel the new matter.

As stated by appellant on page 2 of the brief and confirmed by the examiner on page 2 of the answer, the second, newly added embodiment was originally disclosed in appellant's Application No. 29/033,922 which was filed on even date with the instant application. Appellant states:

After receiving Office Actions in each application with provisional obviousness-type double patenting rejections, applicant determined that this could be rendered moot by consolidating the two embodiments into one application thereby assuring the simultaneous patenting of the two embodiments. No impediment was known or found in the MPEP, 35 U.S.C. or 37 C.F.R. that would indicate that such consolidation of the two applications into a single application was prohibited.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments, including those outlined supra. As

a result, we conclude that the rejection of the appealed claim is sustainable.

In design cases, as in utility cases, the test for compliance with the written description requirement in the first paragraph of § 112 is whether the disclosure as originally filed in the application in question reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. In re Daniels, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998). In a design case, the drawings of the illustrated design are viewed in terms of the written description requirement of § 112. Id. Accordingly, the design shown in the pending drawings and constituting the later claimed invention must have been illustrated or otherwise described in the application disclosure as filed. See generally Vas-Cath. Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

In the present case, we agree with the examiner that the second embodiment added by amendment to the instant application is not supported by the drawings or other disclosure as originally filed in this application.

Appellant seems to concede as much. He nevertheless contends in the paragraph bridging pages 2 and 3 of the brief that the test regarding the description requirement in the first paragraph of § 112 is satisfied in this case because he "had possession of both embodiments at the same time as supported by the two co-pending applications filed on the same date." We disagree.

As stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983), "[t]he test for determining compliance with the written description requirement in the first paragraph of § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, . . ." (emphasis added). See also In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) ("the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed"). The statute itself, in setting out the requirements for the contents of the specification in a patent application, explicitly states that "[t]he

specification [of that application] shall contain a written description of the invention, . . ." 35 U.S.C. § 112, first paragraph. Accordingly, the description requirement in the first paragraph of § 112 is not satisfied by reliance upon the disclosure of another application rather than the instant application.

For the foregoing reasons, we will affirm the examiner decision rejecting the appealed claim under the first paragraph of § 112.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37

C.F.R.

§ 1.136(a).

AFFIRMED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
ERIC FRAHM	)	
Administrative Patent Judge	)	

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Application No. 29/033,921

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