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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/453,426	04/29/2013	Vittorio BOLOGNA	76404-281687(077146-0580)	5788
23644	7590	12/27/2019	EXAMINER	
Barnes & Thornburg LLP (CH) P.O. Box 2786 Chicago, IL 60690-2786			MCINROY, RUTH T	
			ART UNIT	PAPER NUMBER
			2917	
			NOTIFICATION DATE	DELIVERY MODE
			12/27/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* VITTORIO BOLOGNA and THAD M. IDE

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Appeal 2018-003279  
Application 29/453,426  
Technology Center 2900

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Before JILL D. HILL, GEORGE R. HOSKINS, and  
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision rejecting the pending design claim under 35 U.S.C. § 112(a)<sup>2</sup> for lack of written description in the originally-filed application. *See* Non-Final Act. (dated Apr. 20, 2017) 2–5. The Board has jurisdiction over the appeal under 35 U.S.C. §§ 6(b) & 171(b).

We AFFIRM.

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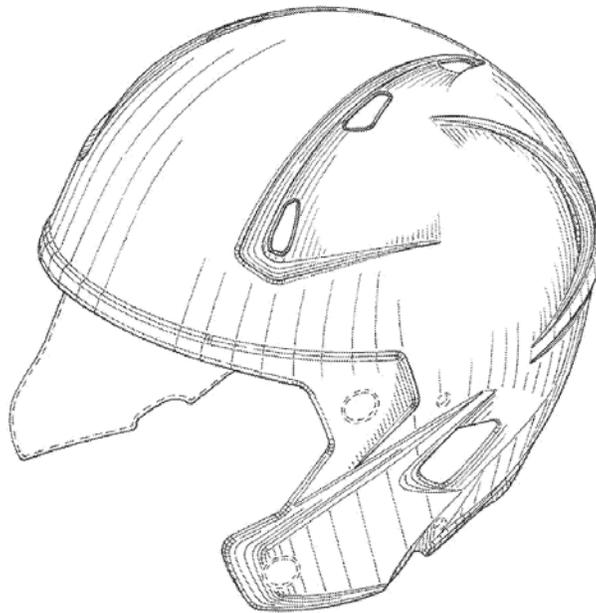
<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Riddell, Inc., as the real party in interest. Appeal Br. 1.

<sup>2</sup> This application was filed on April 29, 2013, after the AIA amendments to § 112 took effect on September 16, 2012. *See* Leahy-Smith America Invents Act (“the AIA”), Pub. L. No. 112-29, § 4(e), 125 Stat. 284, 297 (2011); MPEP § 2161(I).

### CLAIMED SUBJECT MATTER

As originally filed on April 29, 2013, the present application claimed “the ornamental design for a PROTECTIVE SPORTS HELMET, as shown and described.” Spec. 2. The originally-claimed design was shown in Figures 1–6 (hereafter “Original Figures”). *Id.* at 1. Original Figure 1 is reproduced here.

FIG. 1



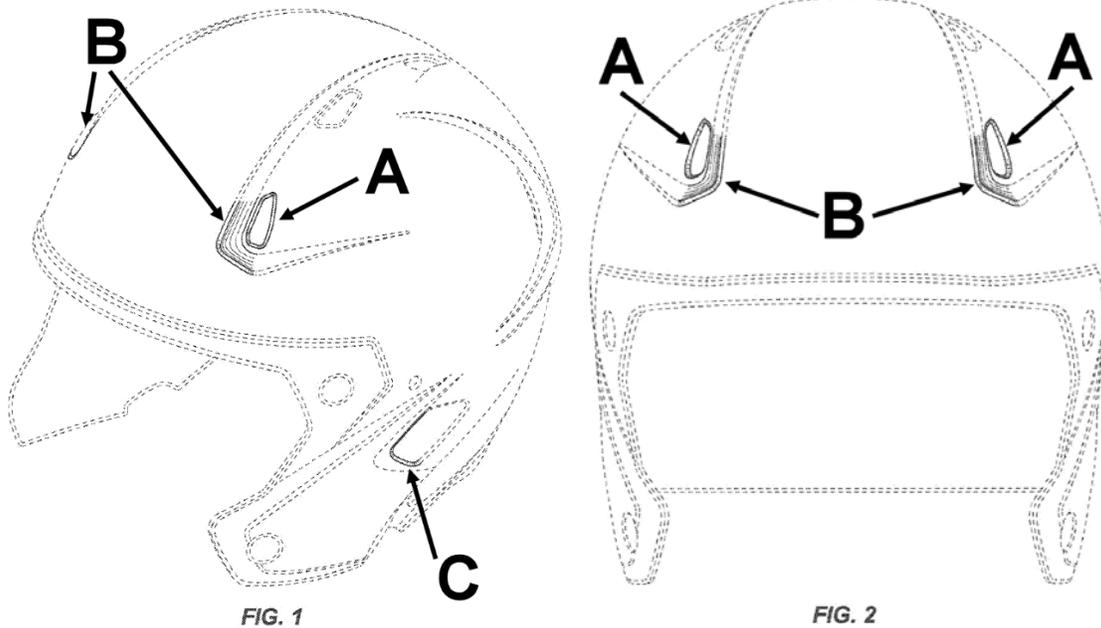
**Original Figure 1**

As representatively shown in Original Figure 1, the Original Figures depict the external design of a helmet, with most of the design shown in solid lines and therefore forming part of the claim, and only very limited portions of the design shown in broken lines and therefore forming no part of the claim.

*See* Original Figs. 1–6.

Later, on June 18, 2013, Appellant filed a Preliminary Amendment, in which Original Figures 1–6 were “canceled” and “replace[d]” with new Figures 1–12 (hereafter “First Replacement Figures”). Prelim. Amend.

(filed June 18, 2013) 3–4. The First Replacement Figures depict two embodiments of the external design of a helmet, a first embodiment in Figures 1–6 and a second embodiment in Figures 7–12. *Id.* at 2. First Replacement Figures 1 and 2 are reproduced here, with annotations A–C added for further reference below.



**First Replacement Figure 1.**

**First Replacement Figure 2.**

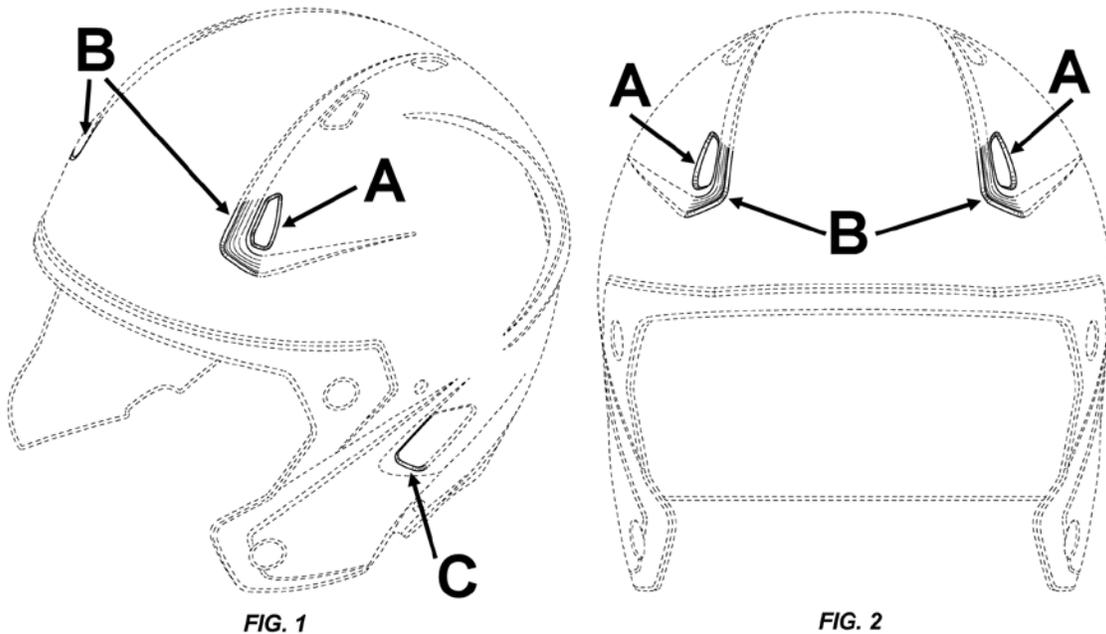
As representatively shown in the perspective view of First Replacement Figure 1, and the front view of First Replacement Figure 2, the solid lines of the claim are limited to the combination of three features of the helmet: (A) two front vent openings; (B) portions of two sidewall segments respectively wrapping around the front vent openings; and (C) the front portion of a left ear hole and at least a portion of a right ear hole.<sup>3</sup> See First

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<sup>3</sup> The figures only hint at the right ear hole, in First Replacement Figures 5 and 6. The Examiner refers to this portion of the claimed design as a “single line directed to the ear hole on right side of” the helmet. Non-Final Act. 3.

Replacement Figs. 1–6; Appeal 8–9 (describing scope of claim). The second embodiment is substantially the same as the first embodiment, except that the claimed sidewall segment portions B extend further upwardly and rearwardly than in the first embodiment. *See* First Replacement Figs. 7–12.

On December 10, 2014, Appellant filed another Amendment, in which the First Replacement Figures were “replaced” with new Figures 1–12 (hereafter “Second Replacement Figures”). Amend. (filed Dec. 10, 2014) 2–3. Appellant stated the Second Replacement Figures “more clearly define the scope of the claimed invention,” and also “include revised surface shading.” *Id.* at 3; *see also* Appeal Br. 11–13 (summarizing reasons for the changes). Second Replacement Figures 1 and 2 are reproduced below.



**Second Replacement Figure 1.**

**Second Replacement Figure 2.**

As representatively shown in the perspective view of Second Replacement Figure 1, and the front view of Second Replacement Figure 2, versus First

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Given the bases for our decision as set forth below, the exact scope of the claimed right ear hole does not affect the outcome of the present appeal.

Replacement Figures 1 and 2 reproduced above, the scope of the claimed design is materially the same in the First and Second Replacement Figures, at least insofar as the present decision is concerned. *Compare* First Replacement Figs. 1–12 *with* Second Replacement Figs. 1–12; Appeal Br. 11–13 (describing differences in more detail).

## OPINION

### A. *Claimed Design(s) At Issue*

We first decide, as a threshold issue, whether we must review the First Replacement Figures, or the Second Replacement Figures, or both sets of Replacement Figures, for compliance with the written description requirement of § 112 in relation to the Original Figures.

The Examiner analyzes only the First Replacement Figures, concluding the Second Replacement Figures are “not relevant” and “no longer germane,” because the Preliminary Amendment was filed “after the filing date” of the application. Ans. 1–2<sup>4</sup>; *see also* Non-Final Act. 2–5 (analyzing only the First Replacement Figures). Appellant requests that we review both sets of Replacement Figures. Appeal Br. 6–7, 22; Reply Br. 7–8 (contending the Second Replacement Figures “superseded” the First Replacement Figures, and the Office “acted upon” the Second Replacement Figures “on four separate instances” during prosecution prior to this appeal).

We determine we must review only the Second Replacement Figures for compliance with the written description requirement of § 112. The

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<sup>4</sup> The Answer does not include page numbers. Our citations number the first substantive page (beginning with “**Grounds of Rejection . . .**”) as page 1, extending through the signature page as page 12.

record establishes Appellant amended the application to “**replace**” the First Replacement Figures with the Second Replacement Figures. Amend. (filed Dec. 10, 2014) 2–3 (emphasis by Appellant); *see also* Appeal Br. 10–22 (summarizing prosecution history, arguing the Examiner errs in focusing on the First rather than the Second Replacement Figures); Reply Br. 7. In the directly following Office Action, the Examiner did not refuse to enter, and also did not object to, the Second Replacement Figures. *See* Non-Final Act. (dated Feb. 11, 2015) 1–2 (“The replacement drawings filed 12-10-14 have been placed in the application file but are not relied upon for this rejection.”). Because the Second Replacement Figures have replaced the First Replacement Figures as presenting the claim that Appellant desires to patent in this application, we will review only the Second Replacement Figures for compliance with the written description requirement of § 112. The *claim on appeal* is represented by the Second Replacement Figures; whether or not the First Replacement Figures have written description support is not relevant to that claim.

In any event, as briefly noted above, our comparison of the First and Second Replacement Figures leads us to conclude that the scope of the claimed design is materially the same, at least insofar as the present decision is concerned. To be sure, the lines in the Second Replacement Figures are sharper than in the First Replacement Figures, and the surface shadings have been changed somewhat. Nonetheless, the claimed invention is materially the same. For this additional reason, we will hereafter cite to and discuss only the Second Replacement Figures. Our consideration and summary of the Examiner’s analyses, therefore, will be applied to the Second

Replacement Figures, despite the Examiner's focus and citation to the First Replacement Figures.

*B. Whether the Second Replacement Figures Comply with the Written Description Requirement*

*The Examiner's Rejection*

The Examiner determines the Second Replacement Figures “introduce new matter not supported by the original disclosure,” so “[t]he original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed.” Non-Final Act. 2 (citing *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998), and *In re Rasmussen*, 650 F.2d 1212 (CCPA 1981)). The Examiner points out that the claim presented by the Original Figures “is directed to an entire helmet,” whereas the two embodiments of the claim presented by the Second Replacement Figures are each directed to “the outline of two [front vent] holes and only a small portion of the [sidewall] surface area adjacent the [front vent] holes,” in combination with portions of the edges defining the left and right ear holes. *Id.* at 2–3 (annotating First Replacement Figures). The Examiner also determines that “[t]he partial [sidewall] shading around the two [front vent] openings . . . define a boundary edge where none previously existed,” and the right ear hole similarly “shows a new boundary line (only half of the hole is claimed).” *Id.* at 4 (emphases added) (citing *In re Owens*, 710 F.3d 1362, 1368–69 (Fed. Cir. 2013)). Thus, the Examiner's view is that “[t]he written description as originally filed does not precisely set forth the particular selection of features now claimed” and does not provide any “indication . . . that would direct one skilled in the art to the subject matter now claimed.”

*Id.* at 3–4 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) and 37 C.F.R. § 1.121(f)).

Appellant raises several appealable issues<sup>5</sup> in opposition to the Examiner’s rejection, which we consider in turn.

*Clarity of the Rejection*

Appellant contends the rejection is unclear in the identification of the new matter found not to be supported in the original application. *See* Appeal Br. 23–24; Reply Br. 18–20. According to Appellant, the rejection presents “tiny illegible images” which prevent Appellant from discerning the Examiner’s position in this regard, such that the “lack of clarity and articulation renders the Office Action defective on its face.” Appeal Br. 23–24 (citing MPEP § 707.07(d) & § 2103).

We do not agree with Appellant’s argument. We determine, instead, that the rejection, as summarized in the previous section of this decision, is sufficiently clear in explaining the reasons for the rejection that Appellant is

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<sup>5</sup> Appellant, additionally, asserts that the prosecution of this application has included various “unsound and contradictory rejections” that are not consistent with the Office’s goal of compact prosecution, as well as an improper withdrawal of the application from a previously-filed appeal to the Board. Appeal Br. 10–22, 35–36; Reply Br. 20–22. Review of such matters may be had, if at all, via Petition to the Director but not appeal to the Board. *See* 35 U.S.C. § 134(a) & § 6(b)(1) (Appellant “may appeal *from the decision* of the primary examiner,” and the Board “shall . . . *review adverse decisions* of examiners” (emphases added)); 37 C.F.R. § 1.113(a); *In re Berger*, 279 F.3d 975, 984–85 (Fed. Cir. 2002) (discussing, in general, review by petition and by appeal); MPEP § 1201 (“The line of demarcation between appealable matters for the Board and petitionable matters for the Director . . . should be carefully observed.”). We therefore do not comment further on these matters here.

able to respond. *See, e.g., In re Jung*, 637 F.3d 1356, 1361–62 (Fed. Cir. 2011) (discussing Examiner’s *prima facie* burden). Our conclusion is bolstered by Appellant’s demonstrated ability to respond. *See* Appeal Br. 22–35.

*Identification of Ordinary Artisan*

Appellant contends the rejection fails to identify the “artisan [(i.e. POSA)]” through whose eyes the written description requirement is evaluated, and “completely ignore[s]” the role of the POSA. *See* Appeal Br. 25–26 (citing *Daniels*, 144 F.3d at 1456, and *Owens*, 710 F.3d at 1368); Reply Br. 14–15. Appellant does not, however, explain how the identification of the POSA affects the written description analysis in this case. Appeal Br. 25–26; Reply Br. 14–15.

Thus, Appellant’s challenge “do[es] not argue with any specificity that the level of ordinary skill in the art would change the result” and “instead raise[s] a generalized challenge to the [Examiner’s] decision because it did not specifically articulate the level of ordinary skill in the art.” *In re Fought*, 941 F.3d 1175, 1179 (Fed. Cir. 2019). Such a challenge is “without merit.” *Id.* (requiring Appellant to “place[] the level of ordinary skill in the art in dispute and *explain[] with particularity how the dispute would alter the outcome*”) (emphasis added).

*Claiming Less Than the Entire Helmet*

A first basis for the Examiner’s rejection is that the original application fails to demonstrate possession of a claim directed to less than an entire helmet. Non-Final Act. 2–4. Specifically, according to the Examiner: “[t]he written description as originally filed does not precisely set forth *the*

*particular selection of features now claimed*” and does not provide any “*indication . . . that would direct one skilled in the art to the subject matter now claimed.*” *Id.* (emphasis added); Ans. 1–9.

Appellant argues we cannot sustain the rejection on this basis, because it does not properly apply the test for an adequate written description. *See* Appeal Br. 22–23 (citing *Daniels*, 144 F.3d at 1457); Reply Br. 11.

We agree with Appellant. The test for whether the written description requirement of § 112 is satisfied may be expressed in various ways, such as whether the application’s original disclosure “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Daniels*, 144 F.3d at 1456 (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). An applicant need not “describe exactly the subject matter claimed,” but “the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed.” *Id.* (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)).

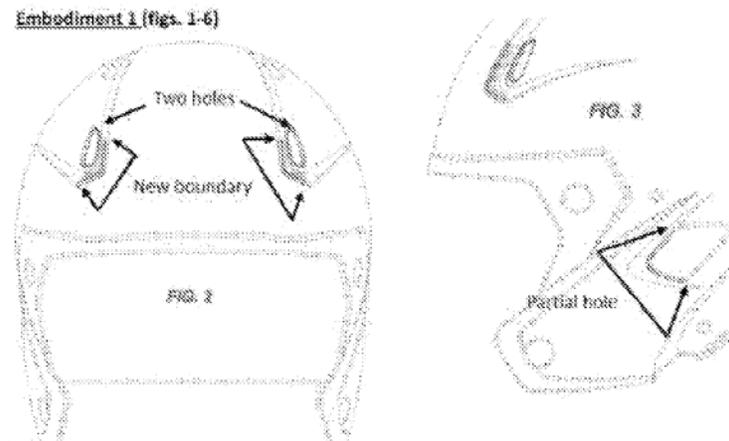
The Federal Circuit has rejected the notion that “a design is ‘a unitary thing,’ and thus that when the design is changed it becomes a different design, and not subject to severance of any common subject matter.” *Daniels*, 144 F.3d at 1457. We find no legal basis for the Examiner’s determination that the written description requirement limits Appellant here to claiming *only* an “entire helmet,” on the basis that the originally-filed disclosure must “precisely set forth the particular selection of features now claimed” by providing a “visual or written indication in the original disclosure that would direct one skilled in the art to the subject matter now claimed.” Non-Final Act. 2–4. The test for sufficiency of the written description is, instead, whether the originally filed 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 Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

That test may be met, in some circumstances, by broadening a claim during prosecution via changing solid lines in an original drawing to broken lines in an amended drawing. *See, e.g., Daniels*, 144 F.3d at 1455–57 (written description requirement satisfied when amended drawings did not contain leaf pattern present in original drawings). Therefore, we do not sustain the rejection on the basis that the original application fails to demonstrate possession of *any* claim directed to less than an entire helmet. Nonetheless, the written description requirement does fetter, to some extent, Appellant’s ability to broaden the claim via changing solid lines to broken lines. *See, e.g., Owens, supra*. We thus turn to the Examiner’s second basis for the rejection on appeal.

*Claiming Feature B (Portions of Sidewall Segments) and Feature C (Portions of Ear Holes)*

A second basis for the Examiner’s rejection is that feature B identified above introduces new matter because “[t]he partial [sidewall] shading around the two [front vent] openings . . . define *a boundary edge where none previously existed.*” Non-Final Act. 4 (emphasis added). The Examiner similarly concludes feature C identified above “shows *a new boundary line* (only half of the hole is claimed).” *Id.* (emphases added). To illustrate these conclusions, the Examiner provides the following annotations (*see* Non-Final Act. 3) to First Replacement Figures 2 and 3:



**First Replacement Figures 2 and 3  
(with Examiner’s Annotations).**

These annotations identify where the Examiner finds Figure 2 to define four new boundaries in the sidewalls surrounding the two front vent holes, and Figure 3 to define two new boundaries in the left ear hole. The Examiner concludes these “newly defined boundaries do not satisfy the written description requirement . . . because they do not make explicit a boundary that already exists but was unclaimed in the original disclosure.” *Id.* (citing *In re Owens*, 710 F.3d 1362, 1368–69 (Fed. Cir. 2013)); *see also* Ans. 9–11 (explaining how *Owens* applies here).

Appellant contends in opposition that the Original Figures show “surface shading proximate to” the front vent holes in solid lines, and show the left ear hole in solid lines, so the written description requirement is satisfied. Appeal Br. 17. According to Appellant, the Examiner has “failed to cite relevant case law or sections from the MPEP to support the assertion that a partially claimed [left ear hole feature C] or partially claimed [sidewall feature B] constitute ‘new boundaries,’ when every line is disclosed in the prior application.” Appeal Br. 18, 24. Appellant asserts the Examiner’s rejection in this regard fails to follow Office’s Guidelines and well as MPEP

§ 1504.04(B), which in Appellant’s view permit Appellant to change any solid line to a broken line and thereby “claim a subset of the originally disclosed elements in a later-claimed design.” Appeal Br. 26–27; Reply Br. 11–14. Appellant additionally argues the Examiner’s rejection is inconsistent with *Daniels*, 144 F.3d at 1456–57, and *Owens*, 710 F.3d at 1368. Appeal Br. 27–31. Appellant finally contends the changes at issue here are similar to changes that have been allowed in other applications to issue as a patent, claiming continuation priority to a parent application. Appeal Br. 31–35; Reply Br. 18.

We agree with the Examiner’s position that the *Owens* decision requires that we sustain the rejection. In *Owens*, the original claim in a parent application was directed to a design for a complete bottle, and the applicant filed a continuation application claiming only “certain elements found on the top and side portions of the original [complete] bottle.” *Owens*, 710 F.3d at 1363–64 (original claim), 1364–65 (continuation claim). The Board had concluded the continuation claim was directed to “previously undisclosed ‘trapezoidal sections *occupying part, but not all, of the surface area of the front and back panels*’ of the complete bottle, which was not supported by the written description of the complete bottle in the parent application. *Id.* at 1365–66 (emphasis added).

The Federal Circuit affirmed, concluding “the broken line that Owens introduced in his continuation application,” to limit the claimed design to a trapezoidal surface area of the complete bottle, lacked written description in the parent application disclosure. *Id.* at 1366–68. In particular, the Federal Circuit determined the parent application “discloses a design for a bottle with *an undivided pentagonal center-front panel*, whereas the continuation

claims *only the trapezoidal top portion of that center-front panel.*” *Id.* at 1368 (emphases added). The Federal Circuit held substantial evidence supported the Board’s finding that a skilled artisan would not have recognized, upon reading the parent application’s disclosure, “that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.” *Id.* (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). That is, “the parent [application] disclosure [did] not distinguish the now-claimed top trapezoidal portion of the panel from the rest of the pentagon in any way.” *Id.*

Similarly here, the borders to the claimed design that Appellant has introduced in the Second Replacement Figures lack written description in the originally-filed disclosure. In particular, the Original Figures do not demonstrate possession of a design wherein feature B stops at the edges of the front vent openings, and feature C is limited to only half of the ear hole. These amendments in claim scope are directly analogous to the amendment in *Owens*, in which the undivided pentagonal center-front panel of the original design was limited to only the trapezoidal top portion of that center-front panel.

Appellant correctly notes that the Second Replacement Figures do not add “a broken boundary line” to identify the new borders in the claimed design, whereas in *Owens* such a broken boundary line was added. *See* Appeal Br. 12 n.4, 31 (“*Owens* is entirely inapplicable to the present Application because . . . [Appellant] has not added broken (or dot-dash) boundary lines.”) This, however, is a distinction without a difference. The problem in *Owens* was that Appellant introduced a boundary into the claim

that was not identified in the original disclosure. *See Owens*, 710 F.3d at 1366–68 (“The subject of this appeal is the broken line that Owens introduced in his continuation application. The parties agree that *the parent application discloses no boundary that corresponds (either explicitly or implicitly) to this newly-added broken line.*”) (emphasis added); *see also id.* at 1368 (“the question for written description purposes is whether a skilled artisan would recognize upon reading the parent’s disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area”). Appellant has the same problem here, even though Appellant did not add a broken line to identify the new boundary.

Finally, the issued patents cited by Appellant do not persuade us to reverse the Examiner’s rejection. There is no evidence that the issue of continuation priority arose during prosecution of those patents, much less that the *Owens* decision was considered or persuasively distinguished during prosecution. *See* Appeal Br. 31–35; Reply Br. 18.

For the foregoing reasons, we sustain the rejection of the claimed design on appeal as lacking written description in Appellant’s original disclosure.

### C. *Continuation Priority*

The Examiner objects to Appellant’s designation of the present application as being a continuation of U.S. Patent Application Serial No. 29/391,016 (“the ’016 application). *See* Non-Final Act. 4–6. The basis for the objection is that the presently claimed design was not described in the ’016 application. *See id.* at 4.

Appellant urges us to determine whether continuation priority is proper, “if it is determined that the [Second] Replacement Figures satisfy the

Appeal 2018-003279  
Application 29/453,426

written description requirement of Section 112” with respect to Original Figures 1–6 of the present application. Reply Br. 6, 8, 21–22. Having resolved the written description rejection adversely to Appellant, we need not separately address the Examiner’s objection to continuation priority.

### CONCLUSION

In summary:

<b>Claim Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1	112(a)	Written Description	1	

### TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED