

Patentee Cannot Cure Lack of Written Description by Reference To Matter Present Only Foreign Priority Application

JANUARY 21, 2021

Dong Guan Leafy Windoware Co. Ltd., v. Anli Spring Co., Ltd. And Hsien-Te Huang, PGR2020-00001, Paper 21 (P.T.A.B. October 30, 2020).

Before: Hoskins, Woods, Moore

Petitioner previously challenged original claims 2 and 4 as indefinite. Claims 2 and 4 both require “the unequal-torque coil spring generates usable feedback torque values *with a ratio between 4:1*.” The Board determined it is more likely than not these claims are indefinite.

After institution, Patent Owner filed a contingent motion to amend replacing challenged claims 2 and 4 with substitute claims 5 and 6. Patent Owner requested Preliminary Guidance on its Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures.

Patent Owner’s proposed substitute claims addressed the indefiniteness issue by reciting “the unequal-torque coil spring generates a maximum feedback torque value and a minimum feedback torque value” and “a ratio of the maximum and the minimum feedback torque values is 4:1.” The Patent Owner relied on the specification of TW105204038U, from which the challenged patent claimed priority, as support for these proposed claims. The Board flatly rejected this theory, holding: “We are not aware of any legal authority that would permit Patent Owner here to rely on disclosures found in the Taiwan application, but not in the four corners of the U.S. application, to satisfy the written description requirement for proposed substitute claims 5 and 6.”

The Board went on to find that the Patent Owner had specifically disavowed such material. The Taiwanese application included the additional underlined language: “In addition, a maximum force and a minimum torque force values are determined according to the size of the curtain set 1, and a ratio between the above-described torque forces can be set to 1.” The Board held “the U.S. application omits any specific discussion of minimum and maximum feedback torque force values in the context of a ratio between torque force values,” and held this discrepancy “appears to show an intent to disavow the disclosure in the Taiwan application that was omitted from the U.S. application.” Consequently, the Board determined that the Patent Owner did not set forth adequate written description for the limitation “a ratio of the maximum and minimum feedback torque values is 4:1.”

The Board held that the Patent Owner does not appear to have shown a reasonable likelihood that it satisfied the statutory and regulatory requirements for a motion to amend for proposed substitute claims 5 and 6, and that the

Petitioner has shown a reasonable likelihood that proposed claims 5 and 6 are unpatentable for lack of written discretion.

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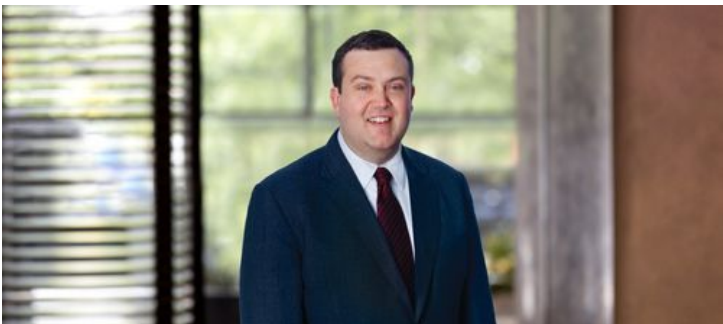
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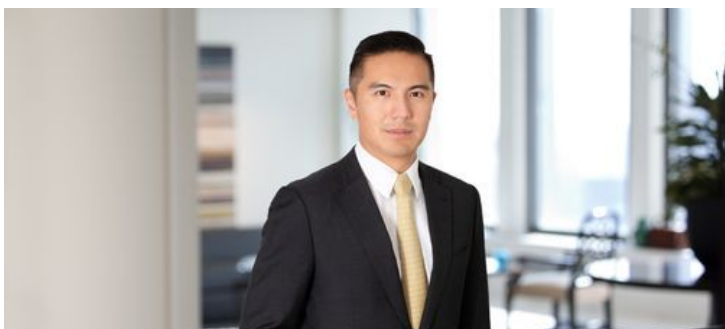
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