

Design Patent ProGuide – New Matter  
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Quick Reference Guide

DO:

Assume every amendment is high-risk. Treat all post-filing changes, whether to drawings, title, line conventions, shading, or context, as potentially introducing new matter unless clearly supported by the original disclosure.

Analyze amendments visually, not textually. Evaluate whether a designer of ordinary skill would have recognized possession of the amended design from the original drawings alone.

Compare amended drawings side-by-side with the original figures. Focus on changes to silhouette, contour, depth, configuration, and claimed context.

Confirm written description support before amending the title. Title amendments that affect the article of manufacture are among the most common triggers for § 132 objections and § 112(a) rejections.

Treat surface shading and the absence of shading as substantive disclosure. Shading communicates three-dimensional form, and its presence or absence may be relied upon by the Office when evaluating whether later amendments introduce new matter.

Require examiners to identify alleged new matter with specificity. Conclusory statements that amendments “introduce new matter” are procedurally insufficient and should be challenged.

Recognize when an application may be fatally defective. If no definite and enabled design can be pursued without adding unsupported subject matter, consider alternative strategies early.

DON'T:

Don't assume narrowing amendments are safe. An amendment that narrows claim scope can still introduce new matter if the resulting design was not originally disclosed.

Don't add environmental structure, even in broken lines, without original support. Environmental context can materially affect how a design is perceived and scrutinized under § 132.

Don't add interior detail, recesses, or depth features to "clarify" the design. Features such as bores, cavities, or chamfers are treated as claim-relevant geometry and require original disclosure.

Don't change corner geometry, radii, or silhouettes casually. Even small changes to outline or profile are commonly treated as impermissible reconstruction.

Don't add missing views after filing to "complete" the disclosure, except in the rare case where the view is necessarily implied by the original drawings (e.g., true mirror symmetry or other strict geometric relationships evident from the disclosed views, i.e., perfectly cylindrical objects). Outside this narrow exception, adding a previously undisclosed view is almost always treated as new matter.

Don't rely on broken-line treatment as a safe harbor. Broken lines must still be originally disclosed; line conventions do not override the written description requirement.

Don't accept examiner-suggested amendments without independent analysis. Examiner suggestions do not insulate an amendment from new matter objections.

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## 1. Introduction and Theory

The prohibition on new matter is one of the most rigid and unforgiving doctrines in U.S. design patent prosecution. Unlike many procedural defects that can be corrected through amendment, a violation of the new matter rule can permanently foreclose meaningful claim scope or render an application fatally defective. Because design patent claims are defined almost entirely by the drawings, even seemingly modest amendments, such as changes to surface shading, line conventions, environmental context, or article identification, can raise serious written description and new matter concerns.

New matter issues most commonly arise during routine prosecution activities. Applicants frequently encounter them when responding to prior art rejections, correcting perceived indefiniteness, conforming drawings to examiner preferences, or attempting to clarify claim scope. In many cases, applicants inadvertently introduce new matter while attempting to resolve an examiner-identified problem. In others, examiners improperly characterize permissible clarifications as new matter due to an unduly narrow reading of the original disclosure.

This ProGuide provides a structured, doctrine-driven framework for analyzing new matter issues in design patent applications. It explains how the USPTO evaluates amendments to titles, drawings, and specifications under 35 U.S.C. § 132 and the written description requirement of 35 U.S.C. § 112(a), with particular emphasis on how those standards apply in the design patent context. The objective is to equip practitioners with a consistent analytical approach for determining whether a proposed amendment is supported by the original disclosure and for responding effectively when new matter is alleged.

The central inquiry in any new matter analysis is whether the original disclosure reasonably conveyed to a designer of ordinary skill in the art that the inventor was in possession of the subject matter later introduced by amendment at the time of filing. This “possession” standard derives from *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010), and has been applied in the design patent context to require that the drawings, as filed, reasonably convey possession of the claimed design. In design patent applications, this inquiry is fundamentally drawing-centric. Because the drawings define both the scope and substance of the claim, the written description requirement and the prohibition on new matter are closely intertwined.

New matter is not limited to the introduction of entirely new features. It may arise whenever an amendment alters the visual appearance, configuration, or claimed context of the design in a manner not clearly and unequivocally supported by the original disclosure. This includes changes that affect the identified article of manufacture, environmental structure, surface shading that defines three-dimensional form, line conventions that alter claim scope, or the recasting of a design into a different claimed context (such as a GUI or icon) without original support.

Importantly, the fact that an amendment narrows claim scope does not immunize it from new matter scrutiny. Likewise, the fact that an amendment affects only subject matter shown in broken lines does not automatically avoid a § 132 objection. Any amendment that affects how the claimed design is understood—directly or indirectly—must be supported by the original disclosure.

At the same time, not every amendment constitutes new matter. Design patent applicants are permitted to clarify, narrow, or refine claim scope within the bounds of what was originally disclosed, provided that the resulting design would have been recognized as possessed at the time of filing. The difficulty lies in distinguishing permissible clarification from impermissible reconstruction. This ProGuide is structured to make that distinction explicit and defensible.

New matter doctrine in design patent practice serves a critical public-notice function. It ensures that the scope of exclusive rights is fixed as of the filing date and that competitors and the public may rely on the original disclosure to understand what was invented. For that reason, both applicants and examiners must articulate with specificity what support exists, or does not exist, in the original disclosure. Conclusory assertions of new matter are insufficient, just as unsupported amendments are impermissible.

At the same time, the new matter doctrine must be applied in a manner that permits reasonable clarification of valid disclosures without penalizing minor drafting imperfections. Design patent practice necessarily balances strict public-notice requirements against the practical need to perfect disclosures through supported amendments during prosecution.

Notes: This ProGuide is subject to certain limitations, which are set forth in Appendix 3 of this document.

## 2. Recommended Form

New matter issues should be evaluated *before* any amendment is drafted. In design patent practice, the question is not whether an amendment appears reasonable or improves clarity in isolation, but whether the amended disclosure would have been understood as part of the inventor's design at the time of filing. Because the drawings define the claimed design, the recommended analytical approach is visual and comparative rather than textual.

2.1 The first step is to identify precisely what is changing because of the proposed amendment. This includes changes to line conventions, surface shading, environmental context, article identification, silhouette geometry, or the presence or absence of interior or depth features. Practitioners should assume that even small visual changes may affect how the design is perceived and therefore require written description support.

2.2 Next, the amended disclosure should be compared side-by-side with the original drawings as filed. The inquiry is whether a designer of ordinary skill in the art would have recognized, from the original views alone, possession of the amended design. If the amendment reveals visual information that was not clearly and unequivocally conveyed, such as new curvature, depth, internal structure, or a different article context, it should be presumed to introduce new matter.

2.3 Where an amendment is intended as a clarification, practitioners should articulate *what ambiguity existed in the original disclosure and how the amendment resolves that ambiguity without altering the design*. Clarifications are most defensible where the original disclosure already suggested the amended feature through silhouette, perspective, or consistent treatment across multiple views. Amendments that supply missing geometry or complete an otherwise indeterminate design are rarely permissible.

2.4 Title amendments and changes affecting the article of manufacture require particular care. Because the article in which the design is embodied frames both examination and later infringement analysis, any amendment that recharacterizes the article must be supported by the original drawings. If the original disclosure does not clearly identify the amended article, the amendment should be treated as high-risk and evaluated under the written description requirement.

2.5 Surface shading should be approached conservatively. Shading may be used to clarify three-dimensional form that was already apparent from the original drawings, but it may not be used to create curvature, chamfers, or depth that were not visually disclosed. If the original drawings left the surface shape ambiguous, adding shading to resolve that ambiguity often introduces new matter rather than curing it.

2.6 Similarly, the removal of surface treatment must be evaluated based on whether the underlying configuration was clearly disclosed at filing. Removing two-dimensional, superimposed ornamentation may be permissible where the base form was evident. Removing three-dimensional surface treatment that defines configuration generally alters the design and introduces new matter.

2.7 For GUI and icon designs, practitioners should confirm that embodiment in a display panel was originally disclosed. If the original drawings do not suggest a display panel, attempts to add one during prosecution may render the application fatally defective, as the missing article of manufacture cannot be supplied post-filing without introducing unsupported subject matter.

2.8 Finally, practitioners should document their new matter analysis in the prosecution record where appropriate. When responding to a new matter objection, the response should map the amended feature to specific support in the original drawings and explain why the amendment reflects possession rather than reconstruction. Conclusory assertions, by either the examiner or the applicant, are insufficient. A clear, drawing-based explanation is essential.

### 3. Rules and Guidance for New Matter

#### 3.1 Original-Disclosure Support Is Required for All Amendments

Any amendment to the title, drawings, or specification must be supported by the application as originally filed. Subject matter that was not reasonably conveyed in the original disclosure constitutes new matter and is prohibited under 35 U.S.C. § 132 and 37 C.F.R. § 1.121(f). In design patent practice, this inquiry is predominantly drawing-centric: because the drawings define the claimed design, even modest changes to visual appearance, context, or claim scope can trigger new matter concerns if the resulting design was not clearly and unequivocally supported at filing.

#### 3.2 The Possession Test Governs New Matter in Design Applications

The central question is whether the original disclosure reasonably conveyed to a designer of ordinary skill in the art that the inventor was in possession of the later-introduced subject matter at the time of filing. *See In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998) (applying the possession test to design patents). New matter is not limited to adding entirely new components. It also arises when an amendment alters the visual appearance, configuration, or claimed context of the design in a way not supported by the original views. Practitioners should assume that the examiner will compare the amended design against the original figures to determine whether the amendment reflects permissible clarification or impermissible reconstruction.

#### 3.3 Amendments Affecting the Claimed Article of Manufacture Require Written Description Support

Where an amendment changes the identified article of manufacture in which the design is embodied, the amendment must be supported by the original disclosure. If the original drawings do not clearly convey possession of the amended article at filing, the claim is subject to rejection under 35 U.S.C. § 112(a) for lack of written description, in addition to an objection under 35 U.S.C. § 132. Title amendments are therefore high-risk in design prosecution because they can implicitly redefine what article is being claimed, even when the drawings are unchanged.

### 3.4 Environmental Structure Must Be Originally Disclosed, Even When Shown in Broken Lines

Environmental structure, whether referenced in the title or depicted in the drawings, must be supported by the original disclosure. Adding environmental context in replacement drawings, even in broken lines, can constitute new matter if that environment was not originally shown or described. In design applications, environmental features can affect how the claimed design is perceived and understood. For that reason, examiners routinely treat unsupported environmental additions as impermissible subject matter under § 132. Where environmental structure is shown in broken lines, the level of required detail is lower than for claimed structure, but the environment must still be sufficiently disclosed to understand its relationship to the claimed design.

### 3.5 Surface Shading Cannot Be Added to Create Three-Dimensional Form Not Evident at Filing

Surface shading is part of the original disclosure where it communicates contour, depth, and three-dimensional form. However, the new matter analysis differs between adding shading where none existed and modifying shading that was already present. If the surface shape was not evident from the drawings as filed, adding shading later may introduce new matter because it can effectively create curvature, chamfers, or depth that the original disclosure did not convey. While shading may sometimes be used to clarify a form already apparent in the original views, it cannot be used to supply missing three-dimensional geometry.

### 3.6 Removal of Surface Treatment Is Permissible Only Within Narrow Limits

Two-dimensional, superimposed surface ornamentation may sometimes be removed if it is clear from the original disclosure that the applicant possessed the underlying configuration without that treatment at filing. By contrast, removing three-dimensional surface treatment that is integral to configuration, such as ribs, grooves, beading, or relief features, generally changes the design's visual appearance and introduces new matter because it reveals a configuration not apparent from the original filing. For example, wood-grain texture typically constitutes two-dimensional surface ornamentation, whereas grooves, ribs, or relief features define three-dimensional configuration. Practitioners should treat any deletion that changes the perceived three-dimensional shape as presumptively new matter.

### 3.7 GUI and Icon Designs Must Be Originally Disclosed as Embodied in a Display Panel

A computer icon or GUI must be shown embodied in a display panel, or a portion thereof, to satisfy the article of manufacture requirement under 35 U.S.C. § 171. If the original disclosure does not suggest embodiment in a display panel, later attempts to add a panel in replacement drawings may be treated as new matter. Where the deficiency is fundamental, the application may be considered fatally defective, because the missing article of manufacture cannot be supplied after filing without introducing unsupported subject matter. While such defects may render the application fatally defective, practitioners should be aware that a continuation-in-part

application with proper disclosure may be available to remedy the defect, though the corrected design will receive only the later CIP filing date as its effective filing date for prior art purposes.

### 3.8 Solid-Line and Broken-Line Conversions Require Support for the Resulting Claimed Design

Converting solid lines to broken lines, or broken lines to solid lines, does not automatically constitute new matter because the features being converted were originally disclosed. However, where a line-type conversion affects the claimed design, the resulting design as a whole must still satisfy the written description requirement. The relevant question is whether the original disclosure clearly allowed a designer of ordinary skill to recognize possession of the resulting claimed design at filing. Even where the converted features were originally disclosed, the resulting claimed design must independently satisfy the written description requirement.

### 3.9 Internal Detail, Recesses, and Depth Indicators Must Be Originally Disclosed

Amendments introducing interior features, such as bores, recesses, cavities, or depth indicators, constitute new matter if they were not clearly shown in the original filing. Even where an applicant views such features as “minor” or “functional,” adding them can materially alter the visual appearance and the understood configuration of the design. In design prosecution, features that affect the perceived three-dimensional structure must be treated as claim-relevant and therefore subject to strict § 132 scrutiny.

### 3.10 Silhouette Changes and Corner Geometry Are High-Risk and Often Prohibited

Changes to the silhouette, including altering the radius or geometry of corners, edges, and profiles, are commonly treated as new matter because they change the design’s overall visual impression. Even small changes in corner shape can create a different design. Where a line or mark is truly an artifact or drafting error, limited correction may be permissible, but the burden is on the applicant to show that the corrected figure remains consistent with the original disclosure as a whole. Intentional changes to silhouette geometry constitute new matter. However, correction of a clear drafting error may be permissible where the corrected version is consistent with the remaining original views.

### 3.11 Adding a Previously Undisclosed View After Filing Is Generally New Matter

Adding a previously undisclosed view after filing is almost always treated as new matter, except where the view is necessarily implied by the original disclosure, such as true mirror symmetry. Missing views are generally understood to represent unclaimed subject matter rather than an invitation to supplement the disclosure after the filing date. Accordingly, applicants should assume that “completing the set” of views during prosecution will be objected to unless the newly added view is fully and unambiguously supported by what was already shown.

### 3.12 Examiners Must Identify the Alleged New Matter with Specificity

An examiner’s new matter objection must identify what specific subject matter lacks support in the original disclosure. Conclusory statements that replacement drawings or amendments “introduce new matter,” without explaining the unsupported differences, are procedurally deficient. Practitioners should require the examiner to articulate the basis for the objection and should respond by mapping the amended feature to specific support in the original figures or specification.

### 3.13 Fatal Defect Determinations When No Definite and Enabled Design Can Be Supported Without New Matter

Where the original disclosure is so ambiguous or incomplete that no definite and enabled design can be pursued without adding unsupported subject matter, the application may be deemed fatally defective. In such circumstances, prosecution options are limited, and continuing prosecution may not salvage meaningful claim scope. Practitioners should identify these situations early to evaluate whether refiling or alternative strategies are necessary.

### 3.14 Amendments to Improve Line Quality May Introduce New Matter

Poor line quality, such as pixelation, jagged edges, merged lines, or unintended shading, may render drawings indefinite under 35 U.S.C. § 112(b). However, amendments submitted to “clarify” such defects may introduce new matter if they reveal contours, depth, or features not reasonably conveyed by the original disclosure. Amendments must enhance existing lines without adding unsupported geometry or elements.

### 3.15 Broken Lines Must Maintain Consistent Rhythm and Weight

Broken lines used to depict unclaimed subject matter or environmental context must maintain a uniform dash length, spacing, and line weight sufficient to distinguish them from solid (claimed) lines. Amendments to correct broken-line rhythm may introduce new matter if they clarify contours or features not previously disclosed, particularly where the original broken lines were ambiguous or merged during publication reduction.

### 3.16 Minor Inconsistencies May Be Tolerable Without Amendment

Not all inconsistencies between views render a design indefinite or unsupported. Minor discrepancies may be tolerated where they do not obscure the overall appearance or require conjecture to understand the claimed design. However, attempts to “fix” such inconsistencies through amendment may introduce new matter if the correction adds depth, contour, or configuration not originally possessed.

### 3.17 Changes in Shading Type Can Introduce New Matter

Shading techniques communicate specific visual information. Converting between shading types, such as gray-toned shading, stippling, cross-hatching, or surface texture indicators, may introduce new matter if the new technique implies texture, material, or surface

form not conveyed in the original disclosure. Shading modifications must preserve the original method and visual meaning.

### 3.18 Removal of Lines Is Treated as Substantive Amendment

Removal of solid or broken lines is scrutinized under the same standard as additions. Eliminating lines may introduce new matter if it alters the disclosed configuration, removes originally disclosed features, or results in a design not reasonably conveyed by the original drawings. Line removals are permissible only where the resulting design was clearly possessed at filing.

### 3.19 Boundary Subdivision Is Prohibited Absent Original Visual Support

Adding new boundary lines, solid or broken, to subdivide a continuous surface into smaller claimed regions constitutes new matter unless the boundary follows a physical edge, plane change, seam, or other feature already present in the original disclosure. An applicant may not retrospectively carve a claimed sub-portion from a visually unified surface.

### 3.20 Incorporation by Reference Cannot Cure Omitted Design Disclosure

In design patent practice, incorporation by reference may not be used to supply visual disclosure that was not clearly and unequivocally incorporated at the time of filing. An attempt to add or clarify design features through post-filing incorporation by reference constitutes impermissible new matter under 35 U.S.C. §§ 132 and 112(a).

The USPTO consistently rejects post-filing incorporation attempts where the original application did not clearly convey an intent to incorporate specific external material, or where the incorporated material is relied upon to supply missing design disclosure rather than merely contextual information. Incorporation by reference is not a mechanism to retrofit omitted drawings, photographs, or ornamental detail into a design application.

Source: U.S. Design Application Nos. 29/800,498 and 29/869,325 (final and non-final rejections citing 37 C.F.R. § 1.57 and MPEP § 608.01(p)).

### 3.21 Conversion of Photographs or Reproductions to Line Drawings May Introduce New Matter

Replacing originally filed photographic reproductions with line drawings may introduce new matter if the conversion alters surface appearance, shading conventions, reflectivity, transparency, or perceived material properties. Even where the overall silhouette is preserved, the act of translating tonal or photographic information into line-based shading can introduce unsupported three-dimensional or material characteristics.

Examiners increasingly scrutinize such conversions under 35 U.S.C. § 112(a), particularly where shading conventions are used in a manner inconsistent with the original

disclosure (e.g., oblique shading implying reflectivity or transparency not evident in the photographs).

Source: U.S. Design Application No. 35/510,499 (final rejection based on shading and material implication introduced during photo-to-line conversion).

#### 4. Application of Rules and Guidance to Objections and Rejections

New matter objections and rejections in design patent prosecution tend to fall into a relatively small number of recurring patterns. Most arise not from aggressive claim expansion, but from attempts to clarify, narrow, or correct perceived defects in the original disclosure. Understanding how examiners typically frame these issues is critical to avoiding irreversible prosecution errors.

##### 4.1 New Matter Based on Unsupported Replacement Drawings

In Application 29/894,652, the Examiner objected that replacement drawings introduced new matter because the amended figures added internal hexagonal bores to the heads of threaded fasteners that were not shown or suggested in the originally filed drawings. The Examiner concluded that the amended figures disclosed new structural detail and depth information that was not reasonably conveyed at filing.

To resolve the objection, the Applicant cancelled the replacement drawings and reverted to the originally filed figures, acknowledging that the internal recess detail was not supported by the original disclosure and could not be introduced through post-filing amendment.  
Rule 3.1, Rule 3.2, Rule 3.9, Rule 3.14

##### 4.2 New Matter Based on Added Surface Shading to Introduce Curvature

In Application 29/894,652, the Examiner objected that newly added surface shading constituted new matter because the shading introduced three-dimensional curvature and contour that were not evident from the drawings as originally filed. The Examiner treated the shading as substantive disclosure because it defined surface geometry rather than merely clarifying line quality.

The Applicant cured the objection by withdrawing the shaded replacement drawings and proceeding with the original unshaded figures, recognizing that shading could not be added to supply three-dimensional form that was not clearly disclosed at filing.  
Rule 3.1, Rule 3.2, Rule 3.5, Rule 3.17

##### 4.3 New Matter Based on Added Geometry Intended to Clarify a Chamfer

In Application 29/894,652, the Examiner objected that an attempted clarification of a chamfer introduced new matter because the chamfered edge was not visible in the originally filed disclosure. The Examiner concluded that the amendment altered the configuration of the design by adding structural geometry not originally shown.

To overcome the objection, the Applicant removed the chamfer geometry and relied instead on the originally disclosed silhouette, declining to pursue clarification that would require unsupported contour disclosure. Rule 3.1, Rule 3.2, Rule 3.5, Rule 3.14

#### 4.4 New Matter Based on Silhouette Change from Corner Geometry Alteration

In Application 29/892,124, the Examiner objected that replacement drawings introduced new matter because they altered the silhouette of the design by changing the geometry of a rounded corner into a squared configuration. The Examiner treated the modification as a substantive change in overall appearance, not a permissible drafting correction.

The Applicant cured the defect by submitting corrected drawings that removed drafting artifacts while preserving rounded corner geometry consistent with the original disclosure, thereby maintaining the originally conveyed silhouette and configuration. Rule 3.1, Rule 3.2, Rule 3.10, Rule 3.14

#### 4.5 New Matter Based on Addition of a Previously Undisclosed Rear View

In Application 29/926,338, the Examiner objected that a newly added rear view constituted new matter because the rear of the article had not been shown or described in the original application. The Examiner concluded that the added view disclosed subject matter that was not necessarily implied by the originally filed figures.

To resolve the objection, the Applicant cancelled the added rear view and proceeded with the originally filed views, accepting that the unshown rear surface could not be added after filing without introducing new matter. Rule 3.1, Rule 3.2, Rule 3.11

#### 4.6 New Matter Based on Added Environmental Structure in Replacement Drawings

In Application 29/926,338, the Examiner objected that replacement drawings introduced new matter because they added environmental structure shown in broken lines that was not present in the original disclosure. The Examiner treated the added environment as unsupported context that altered how the design was perceived.

The Applicant cured the objection by removing the environmental structure and reverting to the original isolated depiction, recognizing that even broken-line environmental context must be supported by the disclosure as filed. Rule 3.1, Rule 3.2, Rule 3.4, Rule 3.18

#### 4.7 New Matter Based on Broken-Line to Solid-Line Conversion Without Possession

In Application 29/892,124, the Examiner objected that converting previously unclaimed structure from broken lines to solid lines constituted new matter because the resulting claimed design was not supported by the original disclosure. The Examiner concluded that although the

features existed in the drawings, the amendment changed the claimed design in a manner that lacked written description support.

To overcome the objection, the Applicant restored the broken-line treatment, conceding that the original disclosure did not convey possession of the expanded claimed configuration as amended. Rule 3.1, Rule 3.2, Rule 3.8, Rule 3.18

#### 4.8 New Matter Based on Title Amendment Identifying a Different Article of Manufacture

In Application 29/892,124, the Examiner objected that an amended title introduced new matter because it identified an article of manufacture not reasonably conveyed by the originally filed drawings. The Examiner concluded that the title amendment implicitly recharacterized the claimed article without original support, triggering both a new matter concern and written description risk.

The Applicant withdrew the title amendment and retained the original article identification supported by the drawings, recognizing that title amendments are treated as substantive and require clear original disclosure support. Rule 3.1, Rule 3.2, Rule 3.3

#### 4.9 New Matter Based on Line Quality Clarification That Revealed Unsupported Geometry

In Application 29/900,174, the Examiner objected that replacement drawings introduced new matter because line clean-up intended to correct jagged or pixelated contours revealed chamfers and recesses that were not visible in the drawings as filed. The Examiner concluded that the amendments did not merely improve clarity, but instead supplied new depth and contour information.

The Applicant cured the objection by cancelling the replacement drawings and proceeding with the originally filed figures, addressing any clarity issues through argument rather than introducing geometric refinements that exceeded the original disclosure. Rule 3.1, Rule 3.2, Rule 3.14

#### 4.10 New Matter Based on Boundary Subdivision of a Unified Surface

In Application 29/253,172, the Examiner objected that a newly added boundary line subdivided a continuous surface into separate regions without any original visual support. The Examiner treated the amendment as an impermissible attempt to retrospectively carve out a narrower claimed portion from a unified surface that had been disclosed as continuous at filing.

To overcome the objection, the Applicant removed the boundary line and restored the originally disclosed unified surface, recognizing that boundary subdivision is prohibited unless the boundary corresponds to a physical edge, seam, or plane change originally shown. Rule 3.1, Rule 3.2, Rule 3.19

#### 4.11 New Matter Based on Shading Conversion That Implied Texture

In Application 35/521,689, the Examiner objected that conversion of gray-toned shading to stippling introduced new matter because the change implied a textured surface not conveyed in the original disclosure. The Examiner treated the shading-type conversion as substantive because shading methods communicate surface appearance and material characteristics.

The Applicant cured the objection by reverting to the original shading technique and adding only a clarifying statement without altering the underlying visual disclosure. Rule 3.1, Rule 3.2, Rule 3.17

#### 4.12 New Matter Based on Removal of Environmental Broken Lines

In Application 29/969,922, the Examiner objected that removal of broken-line environmental structure introduced new matter because the amendment altered the originally disclosed context and changed how the claimed design would be perceived. The Examiner treated the environmental context as part of the disclosure relied upon to understand the design at filing.

To resolve the objection, the Applicant reinstated the original environmental broken lines using consistent rhythm and spacing, restoring the disclosure as originally filed. Rule 3.1, Rule 3.2, Rule 3.4, Rule 3.18

#### 4.13 New Matter Based on Replacement Drawings That Added Depth and Contour

In Application 35/518,844, the Examiner objected that replacement drawings introduced new matter because the attempted corrections of minor inconsistencies added depth and contour not originally conveyed. The Examiner concluded that the amendments supplied new three-dimensional geometry rather than merely correcting drafting defects.

The Applicant withdrew the replacement drawings and demonstrated that the remaining inconsistencies were tolerable and did not require correction through amendments that would exceed the original disclosure. Rule 3.1, Rule 3.2, Rule 3.14, Rule 3.16

#### 4.14 New Matter Based on Improper Incorporation by Reference to Supply Missing Design Disclosure

In Application 29/800,498, the Examiner rejected an attempted incorporation by reference that was used to supply ornamental detail not clearly disclosed in the originally filed drawings. The Examiner concluded that incorporation by reference could not be used as a post-filing mechanism to retrofit missing design disclosure and treated the amendment as impermissible new matter.

To cure the defect, the Applicant was required to cancel the incorporation-by-reference language and proceed only on the basis of the original drawings, without reliance on the external referenced material. Rule 3.1, Rule 3.2, Rule 3.20

#### 4.15 New Matter Based on Photograph-to-Line Drawing Conversion That Introduced Unsupported Material Appearance

In Application 35/510,499, the Examiner objected that replacing originally filed photographic reproductions with line drawings introduced new matter because the added oblique shading implied reflectivity and transparency not supported by the original photographs. The Examiner treated the conversion as substantive because the line-based shading conveyed surface appearance not present in the original disclosure.

To overcome the objection, the Applicant was required to revert to reproductions consistent with the original photographic disclosure or eliminate shading conventions that implied unsupported material properties. Rule 3.1, Rule 3.2, Rule 3.17, Rule 3.21

#### 4.16 New Matter Based on Removal of Surface Texture That Altered the Disclosed Appearance

In Application 29/869,325, the Examiner objected that replacement drawings introduced new matter because they removed vertical line texture from a surface that originally conveyed material or surface treatment. The Examiner concluded that eliminating the texture altered the perceived appearance of the design and was not a permissible simplification.

To cure the objection, the Applicant reinstated the surface texture or converted the textured area to broken lines where original support existed to disclaim it from the claimed design. Rule 3.1, Rule 3.2, Rule 3.6, Rule 3.18

### 5. Practice and Enforcement Notes

#### 5.1 New Matter Analysis Should Precede Drafting, Not Follow It

The most common and costly mistake in design patent prosecution is treating new matter as a problem to be resolved after an examiner objects rather than a risk to be evaluated before any amendment is drafted. Because replacement drawings cannot be selectively withdrawn on a feature-by-feature basis once entered, a single unsupported element can taint an entire set of replacement figures. Practitioners should complete the comparative analysis described in Section 2 before drafting any amendment, and should document that analysis in their prosecution notes even when it does not appear in the official record.

#### 5.2 Examiner Interviews Are Underutilized in New Matter Disputes

When a proposed amendment raises new matter risk, an examiner interview before submission can be dispositive. Examiners are generally receptive to pre-amendment interviews on drawing issues, and an informal agreement on acceptable scope can prevent the entry of drawings that cannot later be corrected without introducing additional new matter. Practitioners should not treat the interview as a substitute for independent analysis, but as a mechanism to confirm whether the examiner's reading of the original disclosure is consistent with the applicant's. Where an examiner has already objected, a post-objection interview can clarify what

specific changes the examiner would accept, narrowing the response to what is actually in dispute.

### 5.3 Responding to New Matter Objections Requires Drawing-Specific Argument

A response to a new matter objection must map the challenged amendment to specific support in the original figures. General assertions that the amendment "merely clarifies" or "does not add new subject matter" are routinely insufficient and may be treated as non-responsive. The response should identify the specific view or views in the original disclosure that reasonably convey possession of the amended feature, explain what visual information was already present, and articulate why the amendment reflects clarification rather than reconstruction. Where the support is strong, practitioners should make the affirmative case explicitly. Where the support is marginal, it is generally preferable to withdraw the amendment than to create a prosecution history that concedes ambiguity in the original disclosure.

### 5.4 Withdrawal Is Often the Correct Response, Not a Last Resort

Practitioners sometimes resist withdrawing amendments because doing so feels like a concession. In new matter disputes, withdrawal is frequently the strategically correct choice. Proceeding with an unsupported amendment risks a final rejection, adverse prosecution history, and, in the worst case, a determination that the application is fatally defective. Where the original disclosure is sufficient to support a viable claim, withdrawing a specific amendment and relying on the original figures preserves both the application and the filing date. Withdrawal should be evaluated on its merits, not avoided out of reluctance to concede.

### 5.5 Distinguishing Permissible Correction from Impermissible Reconstruction

The line between correcting a drafting error and reconstructing an inadequately disclosed design is one of the most contested issues in design prosecution. The key distinction is whether the corrected feature was inferable from the original disclosure or whether the correction supplies missing information. A correction is most defensible where: (a) multiple original views consistently suggest the corrected feature; (b) the corrected version is geometrically necessary given other disclosed features; or (c) the original drawing contains a clear mechanical artifact, such as a scanning line, compression artifact, or rendering error, that is inconsistent with the otherwise coherent design. Corrections that require selecting among plausible interpretations of an ambiguous disclosure are not permissible and should be treated as reconstruction.

### 5.6 Fatal Defect Determinations Should Be Identified and Addressed Early

Where an original disclosure is so incomplete that no definite and enabled design can be claimed without introducing new matter, continuing prosecution serves little purpose and may generate adverse prosecution history. Practitioners who identify a likely fatal defect early should evaluate whether a continuation-in-part with corrected drawings, or a new application entirely, offers a more productive path. Because a CIP receives only the later filing date for any subject matter not supported by the parent, the decision to refile carries prior art consequences that must

be evaluated in light of the intervening period and any disclosures made during prosecution of the original application.

#### 5.7 Prosecution History Estoppel and New Matter

Amendments made to overcome new matter objections, including the withdrawal of drawing features, cancellation of added views, or reversion to original figures, become part of the prosecution history and may bear on claim scope in litigation. While design patent prosecution history estoppel is more limited in scope than its utility patent counterpart, statements made in response to new matter objections, particularly those conceding that certain features were not originally disclosed, can be used to narrow the interpretation of the issued claim. Practitioners should draft responses with this in mind and avoid concessions that exceed what the objection requires.

#### 5.8 Monitoring Post-Allowance New Matter Risk

New matter issues do not end at allowance. After a notice of allowance is issued, any amendment, including corrections to drawing formalities, must still satisfy the written description requirement. Amendments filed after allowance under 37 C.F.R. § 1.312 are subject to examiner discretion and are routinely rejected if they introduce any visual change not clearly supported by the original disclosure. Practitioners should treat post-allowance amendments with the same scrutiny applied during prosecution, and should generally limit such amendments to the minimum correction necessary to satisfy any outstanding formal requirement.

## Appendix 1 (Checklists)

Use this checklist before filing any amendment:

### Title Amendments

- Is the amended title fully supported by the original drawings/specification?
- Does the title reference only articles or environments originally disclosed?

### Drawing Amendments

- Do replacement drawings show only originally disclosed structure?
- Are added broken lines supported by the original figures?
- Are boundary lines or environment consistent with the original disclosure?
- Have I documented original disclosure support for each proposed amendment in the prosecution file?
- Have I considered whether an examiner interview would be beneficial before submitting replacement drawings?
- Are boundary lines consistent with the original disclosure, and do they define only claimed areas that were originally possessed?
- Do broken lines maintain consistent dash length, spacing, and weight across all views?
- Does any change to shading preserve the original shading *type* (e.g., tone vs. stippling) and visual meaning?
- Does removal of any line preserve the originally disclosed configuration without reconstruction?

### Surface Treatment

- Was surface shading originally present if curvature is claimed?
- Are you removing only two-dimensional surface treatment?
- Does the underlying configuration remain clearly disclosed?

### GUI / Icon Claims

- Is the GUI shown embodied in a display panel?
- Is the display panel shown in solid or broken lines?
- Does the disclosure clearly identify the article of manufacture?
- Is alternative embodiment support present if display-panel treatment changes?

### Claim Scope

- Does any broadening or narrowing remain within the originally disclosed design?
- Would a designer of ordinary skill recognize possession at filing?

#### Examiner Risk Flags

- Could the amendment trigger a § 132 objection?
- Could it trigger a § 112(a) written description rejection?
- Could the application become fatally defective?

Appendix 2  
(Questions and Answers)

Q1: Is all post-filing clarification considered new matter?

A: No. Clarification is permitted if it does not introduce subject matter not originally disclosed. The test is whether the original disclosure conveyed possession of the clarified design.

Q2: Does narrowing a claim avoid new matter issues?

A: No. Narrowing amendments are still subject to the written description requirement. A narrowing amendment can introduce new matter if the resulting design was not originally disclosed. For example, narrowing from “container” to “bottle with a specific narrow neck configuration” introduces new matter if that specific neck configuration was not shown in the original drawings, even though the claim scope has been narrowed.

Q3: Can broken lines be added after filing without introducing new matter?

A: Yes, but only if the structure shown in broken lines was originally disclosed. The resulting claimed design must still satisfy the written description requirement. Broken lines do not create a “safe harbor” for adding previously undisclosed structure.

Q4: Can surface shading be added to respond to an indefiniteness rejection?

A: Only if the shading clarifies a surface shape already apparent in the original disclosure. Shading cannot be used to add new geometry.

Q5: Is changing the title always risky?

A: Yes. Title amendments are frequently scrutinized for new matter. Changes affecting the article of manufacture require clear original support.

Q6: Are missing views automatically new matter if added later?

A: Almost always yes. Adding a previously undisclosed view after filing is treated as new matter except in rare cases where the view is necessarily implied by the original disclosure (e.g., true mirror symmetry or other strict geometric relationships evident from the disclosed views).

Q7: Can I add a display screen to fix a GUI rejection?

A: Only if the original disclosure reasonably suggested embodiment in a display panel. Otherwise, the application may be fatally defective.

Q8: Does showing something in broken lines mean it is safe to amend?

A: No. Broken-line subject matter must still be originally disclosed. Broken lines do not create a safe harbor for new matter.

Q9: What should I do if the examiner does not identify the alleged new matter?

A: Object to the conclusory nature of the rejection and request specific identification of the unsupported subject matter.

Q10: When should a continuation or refiling be considered?

A: If meaningful claim scope cannot be pursued without adding new matter, consider: (1) a continuation-in-part (CIP) with new disclosure (accepting a later effective filing date for the corrected design), or (2) filing a new application entirely. A regular continuation cannot cure these defects since it cannot add new matter.

Q11: Can removing lines from a drawing introduce new matter?

A: Yes. Removing solid or broken lines may introduce new matter if the resulting design differs from what was originally disclosed. Line removal is evaluated under the same written description standard as line addition and is not presumed to be safe.

Q12: Can I adjust broken-line spacing or rhythm to improve clarity?

A: Possibly. Adjustments to broken-line spacing or weight are permissible only if they do not clarify contours, edges, or features not reasonably conveyed by the original disclosure. Where rhythm changes cause ambiguous features to read as defined geometry, examiners may treat the amendment as new matter.

### Appendix 3 (Limitations)

This ProGuide addresses new matter issues as they arise in U.S. design patent prosecution, including objections and rejections related to amendments affecting the claimed design, the article of manufacture, environmental structure, surface treatment, and claim scope. It is based on USPTO practice, MPEP guidance, Federal Circuit precedent, and representative prosecution history examples.

This ProGuide does not perform a visual or technical audit of drawing figures. As a result, it does not:

1. Determine whether a particular drawing set adequately discloses surface contours, depth, or three-dimensional configuration.
2. Resolve close factual questions regarding whether a designer of ordinary skill would recognize possession of a later-claimed design from the original disclosure.
3. Substitute for examiner-specific preferences or art-unit-specific practices that may affect how new matter objections are framed.

Accordingly, this ProGuide should be used as a legal and procedural reference alongside a careful review of the original drawings, the prosecution record, and the specific amendments under consideration.

## Appendix 4 (Selected MPEP Sections)

Note: The following excerpts are reproduced from the Manual of Patent Examining Procedure (MPEP), a public-domain government publication. These sections are provided for reference only and reflect the MPEP edition current as of MPEP Revision 11.2024. Practitioners should consult the most current MPEP for up-to-date guidance.

### MPEP § 1503.01 - Title Amendments and New Matter

Amendments to the title, whether directed to the article in which the design is embodied or its environment, must have antecedent basis in the original disclosure and may not introduce new matter. *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Inter. 1992). If an amendment to the title is directed to the environment in which the design is used and the amendment would introduce new matter, the examiner should object to the amendment under 35 U.S.C. 132. If an amendment to the title is directed to the article in which the design is embodied and the amendment would introduce new matter, in addition to the objection under 35 U.S.C. 132, the claim must be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, the first paragraph of pre-AIA 35 U.S.C. 112).

In addition to the figure descriptions, the following types of statements are permissible in the specification:

(1) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure. Such a description, if provided, must be in the design application as originally filed, and may not be added by way of amendment after the filing of the application as it would be considered new matter.

It is the policy of the Office to attempt to resolve questions about the nature and intended use of the claimed design prior to examination by making a telephone inquiry at the time of initial docketing of the application. This will enable the application to be properly classified and docketed to the appropriate examiner and to be searched when the application comes up for examination in its normal course without the need for a rejection under 35 U.S.C. 112 prior to a search of the prior art.

Explanation of the nature and intended use of the article may be added to the specification provided it does not constitute new matter. It may alternately, at applicant's option, be submitted in a separate paper without amendment of the specification

### ¶ 15.07 Avoidance of New Matter

When preparing new or replacement drawings, be careful to avoid introducing new matter. New matter is prohibited by 35 U.S.C. 132 and 37 CFR 1.121(f).

Lack of appropriate surface shading in the drawing as filed may render the design nonenabling and indefinite under 35 U.S.C. 112(a) and (b), (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first and second paragraphs).

Additionally, if the surface shape is not evident from the disclosure as filed, the addition of surface shading after filing may comprise new matter.

A disclosure of surface treatment in a design drawing or photograph will normally be considered as prima facie evidence that the inventor considered the surface treatment shown as an integral part of the claimed design. An amendment canceling two-dimensional surface treatment or reducing it to broken lines will be permitted if it is clear from the application that applicant had possession of the underlying configuration of the basic design without the surface treatment at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

Applicant may remove surface treatment shown in a drawing or photograph of a design without such removal being treated as new matter, provided that the surface treatment does not obscure or override the underlying design. The removal of three-dimensional surface treatment that is an integral part of the configuration of the claimed design, for example, removal of beading, grooves, and ribs, will introduce new matter as the underlying configuration revealed by this amendment would not be apparent in the application as originally filed. See MPEP § 1504.04, subsection I.B.

(1) If the drawing does not depict a computer icon or a GUI embodied in a display panel, or a portion thereof, in either solid or broken lines, reject the claimed design under 35 U.S.C. 171 for failing to comply with the article of manufacture requirement.

(a) If the disclosure as a whole does not suggest or describe the claimed subject matter as a computer icon or a GUI embodied in a display panel, or a portion thereof, indicate that:

(i) The claim is fatally defective under 35 U.S.C. 171; and (ii) Amendments to the written description, drawings and/or claim attempting to overcome the rejection will ordinarily be entered, however, any new matter will be required to be canceled from the written description, drawings and/or claims. If new matter is added that affects the claim, the claim should be rejected under 35 U.S.C.

112(a).

Note that a replacement figure showing the portion of a mobile device screen in either solid or broken lines must not introduce new matter. The replacement figure shown represents a best practice for applicants as it is the most likely amendment to be supported by the original disclosure.

**B. New Matter** New matter is subject matter which has no support in the original specification, drawings or claim (MPEP § 608.04(a)). An amendment to the claim must have support in the original disclosure. See 35 U.S.C. 132; 37 CFR 1.121(f). Prior to final action, all amendments will be entered in the application and will be considered by the examiner. *Ex parte Hanback*, 231 USPQ 739 (Bd. Pat. App. & Inter. 1986) (stating that “a design patent applicant may amend the

drawing in his application before final rejection and is entitled to have his thus amended claim reconsidered and reexamined” and finding that the amended figures did not represent a mere clarification of detail but rather constituted new matter, not derivable from the original disclosure) (emphasis in original).

An amendment to the disclosure not affecting the claim (such as environment in the title or in broken lines in the drawings), which has no support in the application as originally filed, must be objected to under 35 U.S.C. 132 as lacking support in the application as originally filed and a requirement must be made to cancel the new matter. See MPEP § 1503.01, subsection I. Form paragraph 15.51.01 may be used.

¶ 15.51.01 Amendment to Disclosure Not Affecting Claim - 35 U.S.C. 132 Objection (New Matter)

The [1] is objected to under 35 U.S.C. 132 and 37 CFR 1.121 as introducing new matter. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that the inventor was in possession of the amended subject matter at the time the application was filed. See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure [2].

To overcome this objection, applicant may attempt to demonstrate (by means of argument or evidence) that the original disclosure establishes that the inventor had possession of the amended subject matter or [3].

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.
2. In bracket 2, specifically identify what is new matter so that the basis for the objection is clear.
3. In bracket 3, insert specific suggestion how the objection may be overcome depending on the basis; such as, “the broken line showing of environmental structure in Fig. 1 of the new drawing may be omitted to correspond to the original drawing” or “the title may be amended by deleting the reference to environmental structure.” A design claim may be amended by broadening or narrowing its scope within the bounds of the disclosure as originally filed provided it complies with the written description requirement of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first paragraph).

See MPEP § 1504.04, subsection I.C (evaluating amendments affecting the claim for compliance with the written description requirement). An amendment to the claim, however, which has no support in the specification and/or drawings as originally filed introduces new matter because that subject matter is not described in the application as originally filed.

The claim must be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first paragraph) as failing to comply with the written

description requirement. Similarly, if an amendment to the title directed to the article in which the design is embodied has no support in the original application, the claim will be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first paragraph), as failing to comply with the written description requirement thereof. *Ex parte Strijland*, 26 USPQ2d 1259, 1262 (Bd. Pat. App. & Inter. 1992).

An example of an amendment which introduces new matter would be an amendment changing the configuration of the original design by the addition of previously undisclosed subject matter. A change in the configuration of the design is considered a departure from the original disclosure and introduces new matter (37 CFR 1.121(f)). See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). “In *In re Salmon*, the court held that an earlier filed design application showing a chair with a square seat did not describe a later claimed design for a chair with a circular seat; thus, the earlier was not a description of the later...” *In re Daniels*, 144 F.3d 1452, 1457, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

Another example of an amendment which introduces new matter would be an amendment changing the surface appearance of the original design by the addition of previously undisclosed subject matter.

Removal of three-dimensional surface treatment that is an integral part of the configuration of the original design, for example, beading, grooves, and ribs, is an additional example of an amendment that would introduce new matter. See MPEP § 1503.02, subsection IV . The underlying configuration revealed by such an amendment would not be apparent in the application as filed and, therefore, it could not be established that the applicant was in possession of this amended configuration at the time the application was filed. An amendment, however, which alters the appearance of the original design by removing two-dimensional, superimposed surface treatment would not introduce new matter if it is clear from the application that applicant had possession of the underlying configuration of the design without the surface treatment at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir.1998).

Also, an amendment that changes the scope of a design by either converting originally-disclosed solid line structure to broken lines or converting originally-disclosed broken line structure to solid lines would not introduce new matter because such amendment would not introduce subject matter that was not originally disclosed. Similarly, such an amendment to the design would not be a change in configuration of the original design as addressed by the court in *Salmon* (finding that the parent application disclosing a stool with a square seat did not provide written description support for a seat of another (i.e., circular) configuration). Where such an amendment affects the claimed design, however, the resulting amended design must be evaluated for compliance with the written description requirement.

See MPEP § 1504.04, subsection I.C.

Additional examples of amendments that would not introduce new matter include: (A) a preliminary amendment filed simultaneously with the application papers (see MPEP §

608.04(b)); and (B) the inclusion of a disclaimer in the original specification or on the drawings/photographs as filed (see MPEP §§ 1503.01 and 1503.02).

Similarly, an amended claim must find written description support in the original disclosure. The resulting amended design as a whole must be evaluated for compliance with the 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, written description requirement. The fact that an amendment only affects features that were originally disclosed does not negate the need to determine whether the amendment complies with the written description requirement, i.e., whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the now claimed design as of the filing date. See *Ariad*, 598 F.3d 1336, 1348, 94 USPQ2d 1161, 1170 (“[O]ne can fail to meet the requirements of the statute in more than one manner, and the prohibition on new matter does not negate the need to provide a written description of one’s invention.”). In determining whether a claim complies with the written description requirement, an examiner should bear in mind that “the written description question does not turn upon what has been disclaimed, but instead upon whether the original disclosure ‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Owens*, 710 F.3d at 1368, 106 USPQ2d at 1252 (quoting *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172) (alternations in original) (emphasis added).

If the examiner determines that an amendment to a design claim is not supported by the original disclosure, the examiner should set forth a rejection under 35 U.S.C. 112(a), (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first paragraph) in the next Office action. The Office action should specifically identify the differences or changes made to the claimed design that are not supported in the original disclosure. A general statement by the examiner that the amended drawing, specification or title contains new matter is not sufficient. If possible, the examiner should suggest how the amended drawing, specification or title can be corrected to overcome the rejection. Form paragraph 15.51 may be used.

If an amendment that introduces new matter into the claim is the result of a rejection under 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first and second paragraphs) for lack of enablement and indefiniteness, and it is clear that the disclosure as originally filed cannot support any definite and enabled design claim without the introduction of new matter, the record of the application should reflect that the application is seen to be fatally defective. Form paragraph 15.65 may be used to set forth this position.

The claim should be rejected as indefinite when it cannot be determined from the designation of the design as shown in the drawing, referenced in the title and described in the specification what article of manufacture is being claimed, e.g., a design claimed as a “widget” which does not identify a known or recognizable article of manufacture. The following form paragraphs may be used.

¶ 15.22.03 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C.

112, Second Paragraph (Title Fails to Specify a Known Article of Manufacture) The claim is rejected under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph, as indefinite in that the title, as set forth in the claim, fails to identify an article of manufacture and the drawing

disclosure does not inherently identify the article in which the design is embodied. Ex parte Strijland , 26 USPQ2d 1259, 1263 (Bd. Pat. App. & Int. 1992). Therefore, any attempt to clarify the title by specifying the article in which the design is embodied may introduce new matter. See 35 U.S.C. 132 and 37 CFR 1.121.