Chapter 1500 Design Patents

The right to a patent for a design stems from:

35 U.S.C. 171. Patents for designs. Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

1501 Rules Applicable

Rule 151. Rules applicable. The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

The other rules applying only to patents for designs are set forth in the sections that follow.

1502 Definition of a Design

The design of an object consists of the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates an impression, through the eye upon the mind of the observer.

As a design is manifested in appearance the subject matter of a design application may relate to the configuration or shape of an object, to the surface ornamentation thereof, or both.

A design is inseparable from the object and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.

1503 Elements of a Design Application

A design application has essentially the elements required of an application for a patent for a "mechanical" invention or discovery (see Chapter 600). However, unlike the latter where a preamble to the specification is no longer required, a preamble still remains a requirement in a design application (Rule 154).

If the single signature form be used it must be accompanied by a separate sheet of specification which includes a preamble.

In design applications the following should be observed in addition to the instruction set forth in 605.04 to 605.05(a) pertaining to signature and name.

If the name is typewritten without the middle initial or name, but the signature contains the middle initial or name, amendment should be required that the typewritten name conform with applicant's signature.

1503.01 Specification and Claim

Rule 153 (first paragraph). Title, description and claim. The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

Rule 154. Arrangement of specification. The following order of arrangement should be observed in framing design specifications:

(a) Preamble, stating name of the applicant and title of the design.

(b) Description of the figure or figures of the drawing.

(c) Description, if any.

(d) Claim.

(e) Signature of applicant. (See rule 57.)

If applicant is entitled under 35 U.S.C. 120 to the benefit of an earlier U.S. filing date, the statement that, "This is a division [continuation, continuation-in-part] of Design Application Serial No. ----------, filed ----------." should appear between the description of the figure and the claim.

The title is of great importance in a design application. It serves to identify the article in which the design is embodied and which is shown in the drawing, by the name generally

used by the public. The title should be to a specific definite article. Thus a stove would be called a "Stove" and not a "Heating Device." The same title is used in the petition, in the preamble to the specification, in the description of the drawing, and in the claim. The title should correspond to the name of the article shown.

To allow latitude of construction it is permissible to add to the title—"or similar article." The title in the preamble may be in the plural—Design for Chairs—or in the singular—Design for a Chair, but in the claim it must be in the singular.

The title implies that the type of article named is old, but that the form shown is new. The title may particularize the type named by specifying a use "Bottle for Perfumes" or by indicating a structural type—"Vacuum Bottle."

Any description of the design in the specification other than a brief description of the drawing figures is generally not necessary, for as a rule the illustration is its own best description. If there be any such special description it must be of the appearance of the article and not its manner of construction nor its function.

Where there is more than one feature of novelty in a case, the principal feature may be emphasized in the description by a "dominant feature" clause. Likewise it is permissible to emphasize some specific point of novelty as a "characteristic" or an "important" or an "essential" part of the design. Or, as stated under "Drawing," recourse may be had to dotted and full line illustration to differentiate between the immaterial and the material parts of the design.

Statements in the specification which describe or suggest modifications of the design shown on the drawing are not permitted. Similarly a statement amounting to a disclaimer is improper and not permitted.

Only one claim is required or permissible in a design application and this claim should be in formal terms to the ornamental design for the article (specifying name) as shown. (In re Rubinfield, 1959 C.D. 412; 749 O.G. 274.)

Where there is a special description, the claim must include the words, "and described" following "shown."

1503.02 Drawing

Rule 152. Drawing. The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented.

The necessity for good drawings in a design application cannot be overemphasized. As the drawing constitutes substantially the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness that nothing regarding the shape, configuration and surface ornamentation of the article sought to be patented is left to conjecture.

In general, the showing should be strictly confined to the article on which design patent protection is sought and no additional disclosure in the nature of structure to illustrate environmental use or association with other apparatus not an actual part of the design, is ordinarily permitted. Only in those cases where clarity of disclosure would be greatly sacrificed is such extraneous showing allowed, and in such cases it is permitted only by showing the same in dotted lines with a statement inserted in the specification to the effect that the dotted line showing is for illustrative purposes only.

Dotted or broken line showing is also employed to show such portions of the article claimed which are not important. Such a showing should be explained in the specification by a statement that the dominant features of the design reside in the portions shown in full lines. In every case dotted line showing is notice that the portion so shown is an immaterial part of the design.

With practically all articles, except flat goods, such as fabrics, at least two views are necessary, showing the article in three dimensions. Occasionally a good perspective view alone is sufficient.

The drawing figures should be appropriately surface shaded to show character or contour of the surface represented. This is of particular importance in the showing of three dimensional articles where it is necessary to clearly delineate plane, concave, convex, raised and depressed surfaces of the article and distinguish between open and closed areas thereof.

While a sectional view that more clearly brings out the design is permissible (ex parte Lohman, 1912 C.D. 336; 184 O.G. 287) those that are presented for the evident purpose of including purely structural features, or exhibiting mechanical functions, are not favored. It is the article as seen by the observer, and not internal structure, which should be shown.

In design applications, just as in "mechanical" cases, additional or amended illustration involving new matter is refused entry. The practice of including in the application when filed a photograph or model of the article, or in the case of a flat article, such as cloth, a sample showing a complete unit of the design is permissible and may be followed. An insufficient drawing may be fatal to validity.

1504 Examination

In design cases as in "mechanical" cases, novelty and invention are necessary prerequi-

sites to the grant of a patent. In the case of designs, the inventive novelty resides in the shape or configuration or ornamentation as determining the appearance or visual aspect of the object or article of manufacture in contradistinction to the structure of a machine, article of manufacture or the constitution of a composition of matter.

The fact that an object is new and ornamental is not conclusive of its patentability as a design, since the ornate effect may be due to color, workmanship, finish, and the like, factors of appearance that play no part in determining the question of patentable design.

Whether or not a design is new and original must generally be determined by a search in the class of design patents to which the article claimed belongs and in analogous classes. If no satisfactory anticipation be found here, the search must be extended to the mechanical division handling inventions of the same general type. Catalogs and trade journals are also consulted. In fact, there are no definite limits to the field of search.

Inasmuch as a design patent deals with appearance only, the test to be applied in determining the question of anticipation is identity or similarity of appearance. If a reference is found that is identical in appearance, the question of patentability is, of course, definitely settled in the negative.

However, it more often occurs that the reference differs in some respects from the design claimed and the question of invention is thus presented. Does the difference in configuration of applicant's design represent invention and does such difference add to its ornamental value? Is the difference for structural or functional reasons, or for the purpose of ornamentation?

It is permissible, in a proper case, to illustrate more than one embodiment of a design invention in a single application. However, such embodiments can be presented only if they involve a single inventive concept and are not patentably distinct from each other. An unreasonable number of embodiments of the same invention will not be permitted. The disclosure of plural embodiments does not require or justify more than a single claim which claim must be in formal terms to the ornamental design for an article as shown and described. In re Rubinfield 1959 C.D. 412; 749 O.G. 274.

If two or more patentably distinct articles are disclosed and attempted to be claimed in a single design application, the Examiner may require that the application be restricted to one invention. When a requirement for restriction is made, action on the merits of the claim will ordinarily be held in abeyance.

When an assembly of articles is shown, the question often presented is whether such assembly does in fact constitute a unitary design, or is merely an aggregation of designs. If it is the latter, it is a ground for a rejection of the claim.

Under the liberal design practice, many things are regarded as unitary designs when the same thing would not support a combination claim in a mechanical patent. Thus a "combined inkwell, stand and ash tray" might consist of separable parts, and yet form a unitary design, because of some common theme running through them, or because of some necessary interfitting relationship.

When an applicant presents two or more applications which are allowable over the prior art but which do not in the opinion of the Examiner differ patentably from one another, a requirement for election between the applications is made. If applicant refuses to elect, one of the applications is chosen by the Examiner and allowed and the other (or others) rejected thereon. (Harpignies, 167 Ms. D. 329, in Patent File of Des. Pat. D–136,559, Oct. 26, 1943.)

As novelty of configuration or surface ornamentation is a requisite for design patentability, a design which is merely simulative of a known object is not patentable and this is true even though it is used for a different purpose or function.

A utility patent and a design patent may be based on the same subject matter; however, there must be a clearly patentable distinction between them. Where the utility invention as defined by the claims cannot be made without infringing the design, double patenting exists and two patents cannot issue; but no double patenting is present where a device can be made in accordance with the claims of the utility patent that has an appearance so different from the design as not to infringe the same. (In re Barber, 1936, C.D. 184; 465 O.G. 724.)

1504.01 Segregable Parts

Since under the law a design patent covers only the design as an entirety and does not extend to segregable parts (contrasting in this respect to the copyright law which extends protection to "all the copyrightable component parts"), the only way to protect such parts is by taking out separate patents therefor. Ex parte Sanford, 1914, C.D. 69; 204 O.G. 1346.)

1505 Allowance and Term of Design Patent

Rule 155. Issue and term of design patents. If, on examination, it shall appear that the applicant is

entitled to a design patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of an issue fee in an appropriate amount dependent on the duration of the term desired by the applicant. If this issue fee is not paid within three months of the date of the notice of allowance, the application shall be regarded as abandoned. If this fee is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing of sufficient cause for the late payment, it may be accepted by the Commissioner as though no abandonment had ever occurred.

The filing fee is now the same for all design applications. There is also an issue fee which varies according to the term requested. These changes apply only to design applications filed on or after October 25, 1965. Design applications filed before this date are governed by the practice previously in effect which is stated in the following two paragraphs in brackets.

[It is unnecessary upon filing a design application to pay the fee for the maximum term of 14 years. Payment of a ten dollar fee entitles the applicant to an examination as to patentability and to a patent for 3½ years if found patentable. Request may be made at the time of filing, or at any time before allowance, that applicant be notified before allowance, so that he may extend the term should he desire. Upon sending such notice the application is withheld from allowance for 30 days to permit the filing of the additional fee for such longer term as may be selected. If no response is received to such notice the application is thereupon allowed, and goes to patent for the term corresponding to the fee originally paid.]

[It is to be noted that failure on the part of the Office to send or of the applicant to receive such notice will not warrant any change in the term after the application is passed to issue. Furthermore, issuance of a design patent may not be delayed under the provisions of Rule 314 as is the case with utility patent applications and any suspension beyond the thirty day notice period must be obtained in accordance with the provisions of Rule 103.]

The term of a design patent may not be extended by reissue.

1506 Foreign Filing Dates

The provisions of 35 U.S.C. 119 (Quoted in 201.13) apply also to design applications. It is emphasized however, in the case of a design application that before the application can obtain the benefit of a foreign filing date, it must be filed within six months from the earliest date on which any foreign application for the same design was filed.

35 U.S.C. 172. Right of priority. The right of priority provided for by section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs.

The time for filing the papers required by the statute is specified in the second paragraph of Rule 55. See 201.15(a). In design applications filed on or after October 25, 1965, the latest time at which the papers may be filed is the date for payment of the issue fee unless earlier required as specified in Rule 55. In design applications filed prior to October 25, 1965, the papers may be filed any time before the issuance of the design patent unless earlier required since there is no final fee in these applications.