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1501 Statutes and Rules Applicable

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.

37 CFR 1.151. *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.

37 CFR 1.152-1.155, which relate only to design patents, are reproduced in the sections of this chapter.

It is noted that design patent applications are not included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international applications are not to be followed for design patent applications.

The practices set forth in other chapters of this *Manual of Patent Examining Procedure* (MPEP) are to be fol-

lowed in examining applications for design patents, except as particularly pointed out in the chapter.

1502 Definition of a Design

In a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and not the article itself. *Ex parte Cady*, 1916 C.D. 62, 232 O.G. 621 (Comm'r Pat. 1916). “[35 U.S.C.] 171 refers, not to the design of an article, but to the design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

The design for an article consists of the visual characteristics embodied in or applied to an article.

Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.

Design is inseparable from the article to which it is applied 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.

¶ 15.42 *Visual Characteristics*

The design for an object consists of the visual characteristics or aspect 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.

¶ 15.43 *Subject Matter of Design Patent*

Since a design is manifested in appearance, the subject matter of a Design Patent may relate to the configuration or shape of an article, to the surface ornamentation on an article, or to both.

1502.01 Distinction Between Design and Utility Patents

In general terms, a “utility patent” protects the way an article is used and works (35 U.S.C. 101), while a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance.

While utility and design patents afford legally separate protection, the utility and ornamentality of an article are not easily separable. Invention is a blend of

function and ornamental design. Articles of manufacture may possess both functional and ornamental characteristics.

Some of the more common differences between design and utility patents are summarized below:

(A) The term of a utility patent on an application filed on or after June 8, 1995 is 20 years measured from the U.S. filing date; or if the application contains a specific reference to an earlier application under 35 U.S.C. 120, 121, or 365(c), 20 years from the earliest effective U.S. filing date, while the term of a design patent is 14 years measured from the date of grant (see 35 U.S.C. 173).

(B) Maintenance fees are required for utility patents (see 37 CFR 1.20), while no maintenance fees are required for design patents.

(C) Design patent applications may include only a single claim, while utility patent applications can have multiple claims.

(D) Restriction between plural, distinct inventions is discretionary on the part of the examiner in utility patent applications (see MPEP § 803), while it is mandatory in design patent applications (see MPEP § 1504.05).

(E) An international application naming various countries may be filed for utility patents under the Patent Cooperation Treaty (PCT), while no such provision exists for design patents.

(F) Foreign priority under 35 U.S.C. 119(a)–(d) can be obtained for the filing of utility patent applications up to 1 year after the first filing in any country subscribing to the Paris Convention, while this period is only 6 months for design patent applications (See 35 U.S.C. 172).

Other distinctions between design and utility patent practice are detailed in this chapter. Unless otherwise provided, the rules for applications for utility patents are equally applicable to applications for patents for designs (35 U.S.C. 171 and 37 CFR 1.151).

1503 Elements of a Design Patent Application

A design patent application has essentially the elements required of an application for a utility patent filed under 35 U.S.C. 101 (see Chapter 600). The

arrangement of the specification is as specified in 37 CFR 1.154.

A claim in a specific form is a necessary element of a design patent application. See MPEP § 1503.03.

A drawing is an essential element of a design patent application. See MPEP § 1503.02 for requirements for drawings.

1503.01 Specification

37 CFR 1.153. Title, description and claim, oath or declaration.

(a) 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.

(b) The oath or declaration required of the applicant must comply with § 1.63.

37 CFR 1.154. Arrangement of application elements.

(a) The elements of the design application, if applicable, should appear in the following order:

- (1) Design Application Transmittal Form.
 - (2) Fee Transmittal Form.
 - (3) Preamble, stating name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.
 - (4) Cross-reference to related applications.
 - (5) Statement regarding federally sponsored research or development.
 - (6) Description of the figure or figures of the drawing.
 - (7) Feature Description.
 - (8) A single claim.
 - (9) Drawings or photographs.
 - (10) Executed oath or declaration (See § 1.153(b)).
- (b) [Reserved]

¶ 15.05 Design Patent Specification Arrangement

The following order or arrangement should be observed in framing a design patent specification:

- (1) Preamble, stating name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.
- (2) Cross-reference to related applications.
- (3) Statement regarding federally sponsored research or development.
- (4) Description of the figure or figures of the drawing.
- (5) Feature Description, if any.
- (6) A single claim.
- (7) Drawings or photographs.

I. PREAMBLE AND TITLE

The preamble, if included, should state the name of the applicant, the title of the design, and a brief description of the nature and intended use of the article in which the design is embodied (37 CFR 1.154).

The title of the design identifies the article in which the design is embodied by the name generally known and

used by the public. A title descriptive of the actual article aids the examiner in developing a complete field of search of the prior art and further aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, and the proper classification of the patent upon allowance of the application. It also helps the public in understanding the nature and use of the article embodying the design after the patent has been published. For example, a broad title such as "Adapter Ring" provides little clue as to the nature and intended use of the article embodying the design. However, if the scope of a design is to be claimed broadly as defined by the title, to enable the examiner to do a proper and complete search, the description of the nature and intended use of the design may be incorporated into the preamble. Absent an amendment requesting deletion of the description, it would be printed on any patent that would issue.

Since 37 CFR 1.153 requires that the title must designate the particular article, and since the claim must be in formal terms to the "ornamental design for the article (specifying name) as shown, or as shown and described," it follows that the language of the title and claim must correspond. When the language of the title and claim do not correspond, the title should be objected to under 37 CFR 1.153 as not corresponding to the language of the claim.

However, it is emphasized that, under the second paragraph of 35 U.S.C. 112, the claim defines "the subject matter which the applicant regards as his invention" (emphasis added); that is, the ornamental design to be embodied in or applied to an article. Thus, the examiner should afford the applicant substantial latitude in the language of the title/claim. The examiner should only require amendment of the title/claim if the language is clearly misdescriptive, inaccurate, or unclear (i.e., the language would result in a rejection of the claim under 35 U.S.C. 112, second paragraph; see MPEP § 1504.04, paragraph II).

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. *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Inter. 1992). Amendments to the title which would introduce new matter into the disclosure are not permitted and should be objected to under 35 U.S.C. 132.

Any amendment to the language of the title should also be made at each occurrence thereof throughout the

application, except in the oath or declaration. If the title of the article is not present in the original figure descriptions, it is not necessary to incorporate the title into the descriptions as part of any amendment to the language of the title.

¶ 15.05.01 Title of Design Invention

The title of a design being claimed must correspond to the name of the article in which the design is embodied or applied as shown in solid lines in the drawing(s). See MPEP § 1503.01.

¶ 15.59 Amend Title

For [1], the title [2] amended throughout the application, original oath or declaration excepted, to read: [3]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert --should be-- or --has been--.

II. DESCRIPTION

Any description of the design in the specification, other than a brief description of the drawing, is generally not necessary since as a rule the illustration in the drawing views is its own best description. However, while not required, such a description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper.

¶ 15.46 Special Description Not Normally Needed

Any description of the design in the specification, other than a brief description of the drawing, is generally not necessary, since as a general rule, the illustration in the drawing views is its own best description.

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

(A) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure.

(B) Statement indicating that any broken line illustration of environmental structure in the drawing is not part of the design sought to be patented.

(C) Description denoting the nature and environmental use of the claimed design, if not included in the preamble pursuant to 37 CFR 1.154 and MPEP § 1503.01, paragraph I.

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 an 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.

¶ 15.56 Requirement for Information

A preliminary review of this application indicates that the designation of the article in which the claimed design is embodied or applied is so broad, that it will be difficult for the examiner to make a proper examination of the claim as required by 37 CFR 1.104.

Applicant is requested to provide a sufficient explanation of the designated article regarding its nature and intended use so that the most appropriate docket assignment and pertinent search can be made. This information should be submitted in the form of remarks only, and should not be inserted in the specification.

Additional information regarding analogous fields of search, pertinent prior art, advertising brochures, and the filing of copending utility applications would also prove helpful, and should be included in the reply. Attention is also directed to 37 CFR 1.56 and the procedure in MPEP § 609 as authorized by 37 CFR 1.97, 1.98 and 1.99.

Failure to respond prior to a first Office action on the merits may result in a rejection under 35 U.S.C. 112 in the first Office action if the examiner is unable to make a proper examination.

The new case status of this application for the purpose of issuance of a first Office action on the merits in filing date order, will continue under the provisions of MPEP § 708.

(D) A "characteristic features" statement describing a particular feature of the design that is considered by applicant to be a feature of novelty or nonobviousness over the prior art (37 CFR 1.71(c)).

This type of statement may not serve as a basis for determining patentability by an examiner. In determining the patentability of a design, it is the overall appearance of the claimed design which must be taken into consideration. *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Leslie*, 547 F.2d 116, 192 USPQ 427 (CCPA 1977). Furthermore, the inclusion of such a statement in the specification is at the option of applicant and will not be suggested by the examiner.

¶ 15.47 Characteristic Feature Statement

A "characteristic features" statement describing a particular feature of novelty or unobviousness in the claimed design may be permissible in the specification. Such a statement should be in terms such as "The characteristic feature of the design resides in [1]," or if combined with one of the Figure descriptions, in terms such as "the characteristic feature of which resides in [2]." While consideration of the claim goes to the total or overall appearance, the use of a "characteristic feature" statement may serve later to limit the claim (*McGradyv. Aspenglas Corp.*, 487 F. Supp. 859, 208 USPQ 242 (S.D.N.Y. 1980)).

Examiner Note:

In brackets 1 and 2, insert brief but accurate description of the design.

¶ 15.47.01 Feature Statement Caution

The inclusion of a feature statement in the specification is noted. However, the patentability of the claimed design is not based on the specified feature but rather on a comparison of the overall appearance of the design with the prior art. *In re Leslie*, 547 F.2d 116, 192 USPQ 427 (CCPA 1977).

The following types of statements are not permissible in the specification:

(A) A disclaimer statement directed to any portion of the claimed design that is shown in solid lines in the drawings is not permitted in the specification of an issued design patent. However, the disclaimer statement may be included in the design application as originally filed to provide antecedent basis for a future amendment. See *Ex parte Remington*, 114 O.G. 761, 1905 C.D. 28 (Comm'r Pat. 1904); *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967).

(B) Statements which describe or suggest modifications of the claimed design which are not illustrated in the drawing disclosure are not permitted in the specification of an issued design patent. However, such statements may be included in the design application as originally filed to provide antecedent basis for a future amendment.

(C) Statements describing matters which are directed to function unrelated to the design.

¶ 15.60 Amend All Figure Descriptions

For [1], the figure descriptions [2] amended to read: [3]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert ---should be--- or ---have been--.
3. In bracket 3, insert amended text.

¶ 15.61 Amend Selected Figure Descriptions

For [1], the description(s) of Fig(s). [2] [3] amended to read: [4]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert selected Figure descriptions.
3. In bracket 3, insert ---should be--- or ---have been--.
4. In bracket 4, insert amended text.

1503.02 Drawing

37 CFR 1.152. Design drawings.

(a) The design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.

(1) Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing.

(2) Color photographs and color drawings are not permitted in design applications in the absence of a grantable petition pursuant to § 1.84(a)(2). Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must comply with § 1.84(b) and must not disclose environmental structure but must be limited to the design for the article claimed.

(b) Any detail shown in the ink or color drawings or photographs (formal or informal) deposited with the original application papers constitutes an integral part of the disclosed and claimed design, except as otherwise provided in this paragraph. This detail may include, but is not limited to, color or contrast, graphic or written indicia, including identifying indicia of a proprietary nature, surface ornamentation on an article, or any combination thereof.

(1) When any detail shown in informal drawings or photographs does not constitute an integral part of the disclosed and claimed design, a specific disclaimer must appear in the original application papers either in the specification or directly on the drawings or photographs. This specific disclaimer in the original application papers will provide antecedent basis for the omission of the disclaimed detail(s) in later-filed drawings or photographs.

(2) When informal color drawings or photographs are deposited with the original application papers without a disclaimer pursuant to paragraph (b)(1) of this section, formal color drawings or photographs, or a black and white drawing lined to represent color, will be required.

Every design patent application must include either a drawing or a photograph of the claimed design. As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be clear and complete, and that nothing regarding the design sought to be patented is left to conjecture.

¶ 15.48 Necessity for Good Drawings

The necessity for good drawings in a design patent application cannot be overemphasized. As the drawing constitutes 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 design sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity (35 U.S.C. 112, first paragraph). Moreover, an insufficient drawing may have a negative effect with respect to the effective filing date of a continuing application.

In addition to the criteria for utility applications set forth in 37 CFR 1.81–1.88, design drawings must also comply with 37 CFR 1.152 as follows:

I. VIEWS

The drawings or photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed, including the front, rear, top, bottom and sides. Perspective views are suggested and may be submitted to clearly show the appearance of three dimensional designs. If a perspective view is submitted, the surfaces shown would normally not be required to be illustrated in other views if these surfaces

are clearly understood and fully disclosed in the perspective.

Views that are merely duplicative of other views of the design or that are merely flat and include no ornamentality may be omitted from the drawing if the specification makes this explicitly clear. See MPEP § 1503.01, paragraph II. For example, if the left and right sides of a design are identical or symmetrical, a view should be provided of one side and a statement made in the drawing description that the other side is identical/symmetrical. If the design has a flat bottom, a view of the bottom may be omitted if the specification includes a statement that the bottom is flat and unornamented. The term “unornamented” should not be used to describe visible surfaces which include structure that is clearly not flat. *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 131 USPO 413 (D. Del. 1961).

Sectional views presented solely for the purpose of showing the internal construction or functional and mechanical features are unnecessary and may lead to confusion as to the scope of the claimed design. *Ex parte Tucker*, 1901 C.D. 140, 97 O.G. 187 (Comm'r Pat. 1901); *Ex parte Kohler*, 1905 C.D. 192, 116 O.G. 1185 (Comm'r Pat. 1905). Such views should be objected to under 35 U.S.C. 112, second paragraph, and should be canceled. However, where the exact contour or configuration of the exterior surface of a claimed design is not apparent from the views of the drawing, and no attempt is made to illustrate features of internal construction, a sectional view may be included to clarify the shape of said design. *Ex parte Lohman*, 1912 C.D. 336, 184 O.G. 287 (Comm'r Pat. 1912). When a sectional view is added during prosecution, the examiner must determine whether there is antecedent basis in the original disclosure for the material shown in hatching (37 CFR 1.84(h)(3) and MPEP § 608.02) in the sectional view.

II. SURFACE SHADING

The drawing should be appropriately and adequately surface shaded to show clearly the character and contour of all surfaces of any 3-dimensional aspects of the design. 37 CFR 1.152(a)(1). Surface shading is also necessary to distinguish between any open and solid areas of the article.

Lack of appropriate surface shading in the drawing as filed may render the design nonenabling under 35 U.S.C. 112, first paragraph. Additionally, if the surface shape is not evident from the disclosure as filed, the addition of surface shading after filing may comprise new matter.

Solid black surface shading is not permitted except when used to represent the color black as well as color contrast.

¶ 15.49 *Surface Shading Necessary*

The drawing figures should be appropriately and adequately shaded to show clearly the character and/or contour of all surfaces represented. See 37 CFR 1.152(a)(1). This is of particular importance in the showing of three (3) dimensional articles where it is necessary to delineate plane, concave, convex, raised, and/or depressed surfaces of the subject matter, and to distinguish between open and closed areas. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast.

III. BROKEN LINES

Structure that is not part of the claimed design but is considered necessary to show the environment in which the design is associated may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design. *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). A broken line showing is for illustrative purposes only and forms no part of the claimed design or a specified embodiment thereof. A boundary line may be shown in broken lines if it is not intended to form part of the claimed design. Applicant may choose to define the bounds of a claimed design with broken lines when the boundary does not exist in reality in the article embodying the design. It would be understood that the claimed design extends to the boundary but does not include the boundary. Where no boundary line is shown in a design application as originally filed, but it is clear from the design specification that the boundary of the claimed design is a straight broken line connecting the ends of existing full lines defining the claimed design, applicant may amend the drawing(s) to add a straight broken line connecting the ends of existing full lines defining the claimed subject matter. Any broken line boundary other than a straight broken line may constitute new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121(a)(6).

However, broken lines are not permitted for the purpose of indicating that a portion of an article is of lesser importance in the design. *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967). Broken lines may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. The use of broken lines indicates that the environmental structure or the portion of the article depicted in broken lines forms no part of the design, and is not to indicate the relative importance of parts of a design.

In general, when broken lines are used, they should not intrude upon or cross the showing of the claimed design and should not be of heavier weight than the lines used in depicting the claimed design. Where a broken line showing of environmental structure must necessarily cross or intrude upon the representation of the claimed design and obscures a clear understanding of the design, such an illustration should be included as a separate figure in addition to the other figures which fully disclose the subject matter of the design.

¶ 15.50 *Design Claimed Shown in Full Lines*

The ornamental design which is being claimed must be shown in solid lines in the drawing. Dotted lines for the purpose of indicating unimportant or immaterial features of the design are not permitted. There are no portions of a claimed design which are immaterial or unimportant. See *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967) and *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

¶ 15.50.01 *Use of Broken Lines in Drawing*

Environmental structure may be illustrated by broken lines in the drawing if clearly designated as environment in the specification. See 37 CFR 1.152(a)(1) and MPEP § 1503.02, paragraph (III).

¶ 15.50.02 *Description of Broken Lines*

The following statement must be used to describe the broken lines on the drawing:

-- The broken line showing of [1] is for illustrative purposes only and forms no part of the claimed design. --

The above statement [2] inserted in the specification preceding the claim.

Examiner Note:

1. In bracket 1, insert name of structure.
2. In bracket 2, insert --must be-- or --has been--.

¶ 15.50.03 *Objectionable Use of Broken Lines In Drawings*

Dotted lines or broken lines used for environmental structure should not cross or intrude upon the representation of the claimed design for which design protection is sought. Such dotted lines may obscure the claimed design and render the disclosure indefinite (35 U.S.C. 112).

¶ 15.50.04 *Proper Drawing Disclosure With Use of Broken Lines*

Where broken lines showing environmental structure obscure the full line disclosure of the claimed design, a separate figure showing the broken lines must be included in the drawing in addition to the figures showing only claimed subject matter.

¶ 15.50.05 *Description of Broken Lines as Boundary of Design*

The following statement must be used to describe the broken line boundary of a design:

-- The broken line(s) which define the bounds of the claimed design form no part thereof. --

IV. SURFACE INDICIA

The ornamental appearance of a design for an article includes its shape and configuration as well as any indicia, lettering, or other ornamentation applied to the article ("surface indicia"). Surface indicia must be applied to an article of manufacture. Surface indicia, *per se* (i.e.,

not applied to a specific article of manufacture), is not proper subject matter for a design patent under 35 U.S.C. 171. See MPEP § 1504.01.

Surface indicia shown in a design drawing or photograph will normally be considered as *prima facie* evidence that the inventor considered the surface indicia shown in the drawing to be an integral part of the claimed design. An amendment canceling the surface indicia or reducing it to broken lines would be permitted if it is clear from the application that applicant had possession of the basic design without the surface indicia at the time of filing of the application. See *In re Daniels*, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

V. PHOTOGRAPHS AND COLOR DRAWINGS

Drawings are normally required to be submitted in black ink on white paper, 37 CFR 1.84(a)(1). Color drawings are not permitted in design applications in the absence of a grantable petition pursuant to 37 CFR 1.84(a)(2), 37 CFR 1.152 (a)(2). Photographs are normally not permitted in design patent applications.

However, the Office will accept black and white or color photographs in design patent applications only after granting a petition filed under 37 CFR 1.84(a)(2) (for color photographs) or 37 CFR 1.84(b)(1) (for black and white photographs) requesting that photographs be accepted. Petitions to accept photographs or color drawings will be considered by the Supervisory Patent Examiner and will be granted if the requirements of 37 CFR 1.84 (a) or (b) are complied with. That is, the appropriate fee set forth in 37 CFR 1.17(i) has been included and the three sets of photographs or color drawings required under 37 CFR 1.84(b)(1)(ii) or 37 CFR 1.84(a)(2)(ii) have been included. If other provisions of 37 CFR 1.84(b) for photographs have not been complied with (e.g., the photographs are not on double weight photographic paper, are not properly mounted, or details are not adequately reproducible), such lack of compliance will not bar the grant of a petition to accept the photographs but rather will form the basis of subsequent objection to the quality of the photographic disclosure. If the details, appearance and shape of all the features and portions of the design are not clearly disclosed in the photographs, this also will not be a bar to the grant of a petition to accept the photographs, but would form the basis of a rejection of the claim under 35 U.S.C. 112, first paragraph, as nonenabling.

Photographs submitted on double weight photographic paper must have the drawing figure number entered on the face of the photograph. Photographs mounted on bristol board may have the figure number shown in black ink on the bristol board proximate the corresponding photograph.

Photographs and ink drawings must not be combined in a formal submission of the visual disclosure of the claimed design in one application. The introduction of both photographs and ink drawings in a design application would result in a high probability of inconsistencies between corresponding elements on the ink drawings as compared with the photographs.

When filing informal photographs or informal drawings with the original application, a disclaimer included in the specification or on the photographs themselves may be used to disclaim any surface ornamentation, logos, written matter, etc. which form no part of the claimed design.

Color photographs and color drawings may be submitted in design applications if filed with a petition under 37 CFR 1.84(a)(2) as required by 37 CFR 1.152(a)(2). Color may also be shown in pen and ink drawings by lining the surfaces of the design for color in accordance with the symbols in MPEP § 608.02. Lining a surface for color may interfere with a clear showing of the design as required by 35 U.S.C. 112, first paragraph, as surface shading cannot be used to define the contours of the design.

If color photographs or color drawings are filed with the original application, color will be considered an integral part of the disclosed and claimed design. The omission of color in later filed formal photographs or drawings would be permitted if it is clear from the application that applicant had possession of the basic design without the color at the time of filing of the application. See *In re Daniels*, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998). Note also 37 CFR 1.152(a)(2), which requires that the disclosure in formal photographs be limited to the design for the article claimed.

¶ 15.05.03 Drawing/Photograph Disclosure Objected To

The drawing/photograph disclosure is objected to [1].

Examiner Note:

In bracket 1, insert statutory or regulatory basis for objection and an explanation.

¶ 15.05.04 Photoprints for Proposed Drawing Corrections

Photoprint(s) showing the proposed corrections highlighted, preferably in red ink, must be submitted for the examiner's approval. Care should be exercised to avoid introduction of new matter (35 U.S.C. 132; 37 CFR 1.121). In lieu of proposed corrections, formal drawings including any corrections may be submitted.

¶ 15.05.05 Drawing Correction Required Prior to Appeal

Any appeal of the design claim must include the proposed correction of the drawings approved by the examiner in accordance with *Ex parte Bevan*, 142 USPQ 284 (Bd. App. 1964), and must follow the procedure set forth in the PTO-1474 attached to Paper No. [1].

Examiner Note:

This paragraph can be used in a FINAL rejection where an outstanding requirement for a drawing correction has not been satisfied.

¶ 15.07 Avoidance of New Matter

When preparing new drawings in compliance with the requirement therefor, care must be exercised to avoid introduction of anything which could be construed to be new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121.

¶ 15.45 Photographs As Informal Drawings

For filing date purposes, in those design patent applications containing photographs for drawings contrary to the requirement for ink drawings, the Office of Initial Patent Examination has been authorized to construe the photographs as informal drawings rather than to hold the applications incomplete as filed. By so doing, the Patent and Trademark Office can accept the applications without requiring applicants to file petitions to obtain the original deposit date as the filing date. However, 37 CFR 1.84(b)(1) requires that if black and white photographs are filed as formal drawings, a petition for acceptance of such, the fee under 37 CFR 1.17(i), and three sets of the photographs must be filed. Furthermore, under 37 CFR 1.152(a)(2), color photographs are not permitted in design applications in the absence of a grantable petition pursuant to 37 CFR 1.84(a)(2). Before the photographs in this application can be treated as formal drawings, applicant must submit [1].

Examiner Note:

In bracket 1, insert -- a petition --, -- the fee --, and/or -- three full sets of photographs --.

¶ 15.57 Non-Entered Drawings Returned

The non-entered drawing filed [1] will be returned to applicant(s) upon proper request. The request must be filed within a reasonable time. Otherwise, the drawing may be disposed of at the discretion of the Commissioner (MPEP § 608.02(y)).

1503.03 Design Claim

The requirements for utility claims specified in 37 CFR 1.75 do not apply to design claims. Instead, the form and content of a design claim is set forth in 37 CFR 1.153:

37 CFR 1.153 ... claim ...

(a) ... 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.

A design patent application may only include a single claim. The single claim should normally be in formal terms to "The ornamental design for (*the article which embodies the design or to which it is applied*) as shown." The description of the article in the claim should be consistent in terminology with the title of the invention. See MPEP § 1503.01, paragraph I.

When there is a properly included special description of the design in the specification (see MPEP § 1503.01, paragraph II), or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words "and described" should be added to the claim following the term "shown"; i.e., the claim must read "The ornamental design for (*the article which embodies the design or to which it is applied*) as shown and described."

The claimed design is shown by solid lines in the drawing. It is not permissible to show any portion of the claimed design in broken lines. There are no portions of the claimed design which are immaterial or unimportant, and elements shown in broken lines in the drawing are not part of the claim. See MPEP § 1503.02, paragraph III, and *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967).

¶ 15.62 Amend Claim "As Shown"

For proper form (37 CFR 1.153), the claim [1] amended to read: "[2] claim: The ornamental design for [3] as shown."

¶ 15.63 Amend Claim "As Shown and Described"

For proper form (37 CFR 1.153), the claim [1] amended to read: "[2] claim: The ornamental design for [3] as shown and described."

¶ 15.64 Addition of "And Described" to Claim

Because of [1] -- and described -- [2] added to the claim after "shown."

1504 Examination

In design patent applications, ornamentality, novelty and unobviousness are necessary prerequisites to the grant of a patent. The inventive novelty or unobviousness resides in the ornamental shape or configuration of the article in which the design is embodied or to which the surface ornamentation is applied.

Novelty and unobviousness of a design claim must generally be determined by a search in the pertinent design classes. It is also mandatory that the search be extended to the mechanical classes encompassing inventions of the same general type. Catalogs and trade journals are also to be consulted.

If the examiner determines that the claim of the design patent application does not satisfy the statutory

requirements, the examiner will set forth in detail, and may additionally summarize, the basis for all rejections in an Official action. If an examiner determines that the claim in a design application is patentable under all statutory requirements, but formal matters still need to be addressed and corrected prior to allowance, an *Ex parte Quayle* action will be sent to applicant indicating allowability of the claim and identifying the necessary corrections.

¶ 15.19.01 *Summary Statement of Rejections*

The claim stands rejected under [1].

Examiner Note:

1. Use as summary statement of rejection(s) in Office action.
2. In bracket 1, insert appropriate basis for rejection, i.e., statutory provisions, etc.

¶ 15.58 *Claimed Design Is Patentable (Ex Parte Quayle Actions)*

The claimed design is patentable over the references cited.

¶ 15.72 *Quayle Action*

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

With respect to *pro se* design applications, the examiner should notify applicant in the next Office action that it may be desirable for applicant to employ the services of a registered patent attorney or agent to prosecute the application. Applicant should also be notified that the Patent and Trademark Office cannot aid in the selection of an attorney or agent.

¶ 15.66 *Employ Services of Patent Attorney or Agent (Design Application Only)*

As the value of a design patent is largely dependent upon the skillful preparation of the drawings and specification, applicant might consider it desirable to employ the services of a registered patent attorney or agent. The Patent and Trademark Office cannot aid in the selection of an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

1504.01 Statutory Subject Matter for Designs

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.

The language "new, original and ornamental design for an article of manufacture" set forth in 35 U.S.C. 171 has been interpreted by the case law to include at least three kinds of designs:

- (A) a design for an ornament, impression, print, or picture applied to an article of manufacture (surface indicia);
- (B) a design for the shape or configuration of an article of manufacture; and
- (C) a combination of the first two categories.

See *In re Schnell*, 46 F.2d 203, 8 USPQ 19 (CCPA 1931); *Ex parte Donaldson*, 26 USPQ2d 1250 (Bd. Pat. App. & Int. 1992).

A picture standing alone is not patentable under 35 U.S.C. 171. The factor which distinguishes statutory design subject matter from mere picture or ornamentation, *per se* (i.e., abstract design) is the embodiment of the design in an article of manufacture. Consistent with 35 U.S.C. 171, case law and PTO practice, the design must be shown applied to an article of manufacture.

A claim to a picture, print, impression, etc. *per se*, that is not embodied in an article of manufacture should be rejected under 35 U.S.C. 171 as directed to nonstatutory subject matter.

¶ 15.07.01 *Statutory Basis, 35 U.S.C. 171*

The following is a quotation of 35 U.S.C. 171:

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.

¶ 15.09 *35 U.S.C. 171 Rejection*

The claim is rejected under 35 U.S.C. 171 as directed to nonstatutory subject matter because [1].

Examiner Note:

A rejection on the grounds of nonstatutory subject matter includes the more specific grounds of an abstract design not applied to an article of manufacture, lack of ornamentality, simulation, contrary to public policy, etc. Identify the specific ground(s) not complied with and give reasons why in bracket 1.

¶ 15.44 *Design Inseparable From Article to Which Applied*

Design is inseparable from the article to which it is applied, and cannot exist alone merely as a scheme of ornamentation. It must be a definite preconceived thing, capable of reproduction, and not merely the chance result of a method or of a combination of functional elements (35 U.S.C. 171; 35 U.S.C. 112, first and second paragraphs). See *Blisscraft of Hollywood v. United Plastics Co.*, 189 F. Supp. 333, 127 USPQ 452 (S.D.N.Y. 1960), 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961).

Form Paragraphs 15.38 and 15.40.01 may be used in a second or subsequent action, where appropriate (see MPEP § 1504.02).

1504.01(a) Computer-Generated Icons

To be directed to statutory subject matter, design applications for computer-generated icons must comply with the "article of manufacture" requirement of 35 U.S.C. 171.

I. GUIDELINES FOR EXAMINATION OF DESIGN PATENT APPLICATIONS FOR COMPUTER-GENERATED ICONS

The following guidelines have been developed to assist PTO personnel in determining whether design patent applications for computer-generated icons comply with the "article of manufacture" requirement of 35 U.S.C. 171.

A. *General Principle Governing Compliance With the "Article of Manufacture" Requirement*

Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation. See, e.g., *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) (computer-generated icon alone is merely surface ornamentation). The PTO considers designs for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection under 35 U.S.C. 171. Thus, if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the "article of manufacture" requirement of 35 U.S.C. 171. Since a patentable design is inseparable from the object to which it is applied and cannot exist alone merely as a scheme of surface ornamentation, a computer-generated icon must be embodied in a computer screen, monitor, other display panel, or portion thereof, to satisfy 35 U.S.C. 171. See MPEP § 1502.

"We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design 'for an article of manufacture.'" *In re Hruby*, 373 F.2d 997, 1001, 153 USPQ 61, 66 (CCPA 1967) (design of water fountain patentable design for an article of manufacture). The dependence of a computer-generated icon on a central processing unit and computer program for its existence itself is not a reason for holding that the design is not for an article of manufacture.

B. *Procedures for Evaluating Whether Design Patent Applications Drawn to Computer-Generated Icons Comply With the "Article of Manufacture" Requirement*

PTO personnel shall adhere to the following procedures when reviewing design patent applications drawn to computer-generated icons for compliance with the "article of manufacture" requirement of 35 U.S.C. 171.

(A) Read the entire disclosure to determine what the applicant claims as the design and to determine whether the design is embodied in an article of manufacture. 37 CFR 1.71 and 1.152-1.154.

Since the claim must be in formal terms to the design "as shown, or as shown and described," the drawing provides the best description of the claim. 37 CFR 1.153.

(1) Review the drawing to determine whether a computer screen, monitor, other display panel, or portion thereof, is shown. 37 CFR 1.152.

Although a computer-generated icon may be embodied in only a portion of a computer screen, monitor, or other display panel, the drawing "must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article." 37 CFR 1.152. In addition, the drawing must comply with 37 CFR 1.84.

(2) Review the title to determine whether it clearly describes the claimed subject matter. 37 CFR 1.153.

The following titles do not adequately describe a design for an article of manufacture under 35 U.S.C. 171: "computer icon"; or "icon." On the other hand, the following titles do adequately describe a design for an article of manufacture under 35 U.S.C. 171: "computer screen with an icon"; "display panel with a computer icon"; "portion of a computer screen with an icon

image”; “portion of a display panel with a computer icon image”; or “portion of a monitor displayed with a computer icon image.”

(3) Review the specification to determine whether a characteristic feature statement is present. 37 CFR 1.71. If a characteristic feature statement is present, determine whether it describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof. See *McGrady v. Aspenglas Corp.*, 487 F.2d 859, 208 USPQ 242 (S.D.N.Y. 1980) (descriptive statement in design patent application narrows claim scope).

(B) If the drawing does not depict a computer-generated icon embodied in a computer screen, monitor, other 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.

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

(a) The claim is fatally defective under 35 U.S.C. 171; and

(b) 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, the claim should be rejected under 35 U.S.C. 112, first paragraph.

(2) If the disclosure as a whole suggests or describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof, indicate that the drawing may be amended to overcome the rejection under 35 U.S.C. 171. Suggest amendments which would bring the claim into compliance with 35 U.S.C. 171.

(C) Indicate all objections to the disclosure for failure to comply with the formal requirements of the Rules of Practice in Patent Cases. 37 CFR 1.71, 1.81–1.85, and 1.152–1.154. Suggest amendments which would bring the disclosure into compliance with the formal requirements of the Rules of Practice in Patent Cases.

(D) Upon reply by applicant:

(1) Enter any amendments; and

(2) Review all arguments and the entire record, including any amendments, to determine whether the drawing, title, and specification clearly disclose a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof.

(E) If, by a preponderance of the evidence (see *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”)), the applicant has established that the computer-generated icon is embodied in a computer screen, monitor, other display panel, or portion thereof, withdraw the rejection under 35 U.S.C. 171.

II. EFFECT OF THE GUIDELINES ON PENDING DESIGN APPLICATIONS DRAWN TO COMPUTER-GENERATED ICONS

PTO personnel shall follow the procedures set forth above when examining design patent applications for computer-generated icons pending in the PTO as of April 19, 1996.

III. TREATMENT OF TYPE FONTS

Traditionally, type fonts have been generated by solid blocks from which each letter or symbol was produced. Consequently, the PTO has historically granted design patents drawn to type fonts. PTO personnel should not reject claims for type fonts under 35 U.S.C. 171 for failure to comply with the “article of manufacture” requirement on the basis that more modern methods of typesetting, including computer-generation, do not require solid printing blocks.

1504.01(b) Design Comprising Multiple Parts Embodied in a Single Article

While the claimed design must be embodied in a single article of manufacture as required by 35 U.S.C. 171, it may encompass multiple parts within the single article. The multiple independent parts forming the claimed design may be disclosed in the drawing with or without the article being shown in broken lines. In either case, the title must clearly define the parts as a single entity, for example, set, pair, combination, etc. If the article is not

disclosed in broken lines in the drawing, then the title must disclose the article in which the design is embodied and the association of the claimed parts must be shown by a bracket.

1504.01(c) Lack of Ornamentality

I. FUNCTIONALITY VS. ORNAMENTALITY

An ornamental feature or design has been defined as one which was “created for the purpose of ornamenting” and cannot be the result or “merely a by-product” of functional or mechanical considerations. *In re Carletti*, 328 F.2d 1020, 140 USPQ 653, 654 (CCPA 1964); *Blisscraft of Hollywood v. United Plastic Co.*, 189 F. Supp. 333, 337, 127 USPQ 452, 454 (S.D.N.Y. 1960), *aff'd*, 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961). It is clear that the ornamentality of the article must be the result of a conscious act by the inventor, as 35 U.S.C. 171 requires that a patent for a design be given only to “whoever *invents* any new, original, and ornamental design for an article of manufacture.” Therefore, for a design to be ornamental within the requirements of 35 U.S.C. 171, it must be “created for the purpose of ornamenting.” *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

To be patentable, a design must be “primarily ornamental.” “In determining whether a design is *primarily functional or primarily ornamental* the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.” *L. A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993). The court in *Norco Products, Inc. v. Mecca Development, Inc.*, 617 F.Supp. 1079, 1080, 227 USPQ 724, 725 (D. Conn. 1985), held that a “primarily functional invention is not patentable” as a design.

A determination of ornamentality is not a quantitative analysis based on the size of the ornamental feature or features but rather a determination based on their ornamental contribution to the design as a whole.

While ornamentality must be based on the entire design, “[i]n determining whether a design is primarily functional, the purposes of the particular elements of the design necessarily must be considered.” *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240, 231 USPQ 774, 778 (Fed. Cir. 1986). The court in *Smith v. M & B Sales & Manufacturing*, 13 USPQ2d 2002, 2004 (N. D. Cal. 1990), states that if “significant decisions about how

to put it [the item] together and present it in the marketplace were informed by primarily ornamental considerations”, this information may establish the ornamentality of a design.

“However, a distinction exists between the *functionality of an article* or features thereof and the *functionality of the particular design of such article* or features thereof that perform a function.” *Avia Group International Inc. v. L. A. Gear California Inc.*, 853 F.2d 1557, 1563, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988). The distinction must be maintained between the ornamental design and the article in which the design is embodied. The design for the article cannot be assumed to lack ornamentality merely because the article of manufacture would seem to be primarily functional.

II. HIDDEN IN USE

Knowledge that the article would be hidden during its end use based on the examiner’s experience in a given art or information that may have been submitted in the application itself would be considered *prima facie* evidence of the lack of ornamentality of the claim. “Visibility during an article’s ‘normal use’ is not a statutory requirement of § 171, but rather a guideline for courts to employ in determining whether the patented features are ‘ornamental’.” *Larson v. Classic Corp.*, 683 F. Supp. 1202, 1202, 7 USPQ2d 1747, 1747 (N.D. Ill. 1988). However, if the examiner based on his/her knowledge of an art is aware that a specific design “is clearly intended to be noticed during the process of sale and equally clearly intended to be completely hidden from view in the final use,” it is not necessary that a rejection be made under 35 U.S.C. 171. *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990). However, a rejection as lacking ornamentality should be made if there is additional persuasive evidence of functionality, for example, a utility patent. Determination of whether a claimed design lacks ornamentality under 35 U.S.C. 171 must be made on a case-by-case basis as no design for an article can be considered in its entirety to be either all ornamental or all lacking in ornamentality.

In order to establish that a design is lacking in ornamentality based on the ultimate hidden end use of the article, the article must always be hidden in its end use to provide *prima facie* evidence of lack of ornamentality. In *Contico International, Inc. v. Rubbermaid Commercial Products, Inc.*, 506 F. Supp. 1072, 1076, 210 USPQ 649, 653 (8th Cir. 1981), the court held that the normal use of a dolly which supported refuse containers “entails frequent attachment to and detachment from the ‘Brute’

containers and, accordingly, that said dolly is not concealed in normal use." Some types of articles which would be hidden intermittently are lingerie, garment hangers, tent pegs, inner soles for shoes, etc.

III. ESTABLISHING A *PRIMA FACIE* BASIS FOR REJECTIONS UNDER 35 U.S.C. 171

To properly reject a claimed design under 35 U.S.C. 171 on the basis of a lack of ornamentality, an examiner must make a *prima facie* showing that the claimed design lacks ornamentality and provide a sufficient evidentiary basis for factual assumptions relied upon in such showing. The court in *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), stated that "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability."

Examples of proper evidentiary basis for a rejection under 35 U.S.C. 171 that a claim is lacking in ornamentality would be common knowledge in the art, the appearance of the design itself, the specification of a related utility patent, information provided in the specification, or the fact that an article would be hidden during its ultimate end use. Where the evidence supporting the rejection is based on common knowledge in the art or is "well-known" in the art, the examiner should take official notice by providing a statement that it is well known. See MPEP § 2144.03.

A rejection under 35 U.S.C. 171 for lack of ornamentality must be supported by evidence and rejections should not be made in the absence of such evidence.

IV. REJECTIONS MADE UNDER 35 U.S.C. 171

Rejections under 35 U.S.C. 171 as lacking in ornamentality based on a proper *prima facie* showing fall into two categories:

- (A) a design visible in its ultimate end use which is primarily functional based on the evidence of record; or
- (B) a design not visible in its ultimate hidden end use which is itself evidence that the design is primarily functional, *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949), unless the design "is clearly intended to be noticed during the process of sale." *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

When the examiner has established a proper *prima facie* case of lack of ornamentality, "the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992). A rejection under 35 U.S.C. 171 as lacking in ornamentality may be overcome by providing evidence from the inventor himself or a representative of the company that commissioned the design that there was an intent to create a design for the "purpose of ornamenting." *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

¶ 15.08 Lack of Ornamentality (Article Visible in End Use)

The claim is rejected under 35 U.S.C. 171 as being directed to non-statutory subject matter in that it lacks ornamentality. To be patentable, a design must be "created for the purpose of ornamenting" the article in which it is embodied. See *Avia Group International Inc. v. L. A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 231 USPQ 774 (Fed. Cir. 1986); *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964); *Hygienic Specialties Co. v. H.G. Salzman, Inc.*, 302 F.2d 614, 133 USPQ 96 (2d Cir. 1962); *A & H Manufacturing Co. v. Contempo Card Co.*, 576 F. Supp. 894, 221 USPQ 67 (D. R.I. 1983); *Blisscraft of Hollywood v. United Plastic Co.*, 189 F.Supp. 333, 127 USPQ 452 (S.D.N.Y. 1960), 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961); *Jones v. Progress Ind. Inc.*, 163 F.Supp. 824, 119 USPQ 92 (D. R.I. 1958); and *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Inter. 1993).

The following evidence establishes a *prima facie* case of a lack of ornamentality: [1]

An affidavit/declaration under 37 CFR 1.132 may be submitted over applicant's signature in an attempt to overcome this rejection explaining, specifically and in depth, which features or areas of the claimed design were created with "thought of ornament." This information will enable the examiner to determine if the design as a whole is ornamental as required by 35 U.S.C. 171. See *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964).

Examiner Note:

In bracket 1, insert source of evidence of lack of ornamentality, for example, a utility patent, a brochure, a response to a letter of inquiry, etc.

¶ 15.08.01 Lack of Ornamentality (Article Not Visible in End Use)

The claim is rejected under 35 U.S.C. 171 as being directed to non-statutory subject matter in that the design lacks ornamentality. To be patentable, a design must be "created for the purpose of ornamenting" the article in which it is embodied. The ornamental design for an article which is hidden during its end use cannot be considered to be a "matter of concern". See *In re Webb*, 916 F.2d 1553, 16 USPQ 2d 1433 (Fed. Cir. 1990); *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964); *In re Cornwall*, 230 F.2d 457, 109 USPQ 57 (CCPA 1956); *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949); *Larson v. Classic Corp.*, 683 F. Supp. 1202, 7 USPQ2d 1747 (N.D. Ill. 1988); *Norco Products, Inc. v. Mecca Development, Inc.*, 617 F. Supp. 1079, 227 USPQ 724 (D. Conn. 1985); *C & M Fiberglass Septic Tanks, Inc. v. T & N Fiberglass Mfg. Co.*, 214 USPQ 159 (D. S.C. 1981); *Blisscraft of Hollywood v. United Plastic Co.*, 189 F.Supp. 333, 127 USPQ 452 (S.D.N.Y. 1960), 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961); and *Ex parte Webb*, 30 USPQ 2d 1064 (Bd. Pat. App. & Inter. 1993).

The following evidence establishes a *prima facie* case of lack of ornamentality: [1]

In an attempt to establish that the appearance of the design is a "matter of concern" during the period between its manufacture and its ultimate end use, applicant may submit a showing that the appearance of the article was of commercial concern to prospective customers or an affidavit/declaration from actual customers attesting to their concern with the design of the article. Applicant must also establish that the design as a whole was created for the "purpose of ornamenting" or with

“thought of ornament” during the period of visibility, and that the design is “primarily ornamental.” This may be established by way of an affidavit/declaration under 37 CFR 1.132 over applicant’s signature explaining, specifically and in depth, which areas of the claimed design were created for primarily ornamental reasons. This information will enable the examiner to determine if the design as a whole is “primarily ornamental or primarily functional.” See *L. A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993); *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964); and *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Inter. 1993).

Examiner Note:

In bracket 1, insert source of evidence of article being hidden in use; for example, knowledge of the art, a utility patent, a brochure, a response to a letter of inquiry, etc.

V. EVALUATION OF EVIDENCE SUBMITTED TO OVERCOME A REJECTION UNDER 35 U.S.C. 171

In order to overcome a rejection of the claim under 35 U.S.C. 171 as lacking in ornamentality, applicant must provide evidence that he or she created the design claimed for the “purpose of ornamenting” as required by the court in *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964). This information must be submitted in the form of an affidavit or declaration under 37 CFR 1.132 over applicant’s signature clearly explaining, specifically and in depth, which areas of the claimed design were created for primarily ornamental reasons. This may be demonstrated by showing that the creation of specific features was done with “thought of ornament.” *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 655 (CCPA 1964). Evidence to show ornamentality may also be submitted by way of an affidavit or declaration under 37 CFR 1.132 from a representative of the company which commissioned the design, as these sources could establish the intent behind the creation of the design. Applicant may also show that the functional features of the design can be equally accomplished in other ways by giving specific examples which establish that design choice was the basis for the selection of features. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 40 USPQ2d 1048 (Fed. Cir. 1996); *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Inter. 1993). Attorney arguments are insufficient to establish such intent as only the applicant can know the motivation behind the creation of a design. *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 231 USPQ 774 (Fed. Cir. 1986); *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Inter. 1993).

The mere display of the article embodying the design at trade shows or its inclusion in catalogs is insufficient to establish ornamentality. *Ex parte Webb*, 30 USPQ2d 1064

(Bd. Pat. App. & Inter. 1993). There must be some clear and specific indication of the ornamentality of the design in this evidence for it to be given probative weight in overcoming the *prima facie* lack of ornamentality. *Berry Sterling Corp. v. Pescor Plastics Inc.*, 122 F.3d 1452, 43 USPQ2d 1953 (Fed. Cir. 1997).

The examiner must then evaluate this evidence in light of the design as a whole to decide if the claim is primarily ornamental. It is important to be aware that this determination is not based on the size or amount of the features identified as ornamental but rather on their influence on the overall appearance of the design.

In a rejection of a claim under 35 U.S.C. 171 in which the evidentiary basis for the rejection is that the design would be hidden during its end use, the applicant must establish that the “article’s design is a ‘matter of concern’ because of the nature of its visibility at some point between its manufacture or assembly and its ultimate use.” *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

Once applicant has proven that there is a period of visibility during which the ornamentality of the design is a “matter of concern,” it is then necessary to determine whether the claimed design was primarily ornamental during that period. *Larson v. Classic Corp.*, 683 F. Supp. 1202, 7 USPQ2d 1747 (N. D. Ill. 1988). The fact that a design would be visible during its commercial life is not sufficient evidence that the design was “created for the purpose of ornamenting” as required by the court in *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964). Examiners should follow the standard for determining ornamentality as outlined above.

“The possibility of encasing a heretofore concealed design element in a transparent cover for no reason other than to avoid this rule cannot avoid the visibility [guideline]... , lest it become meaningless.” *Norco Products Inc. v. Mecca Development Inc.*, 617 F. Supp. 1079, 1081, 227 USPQ 724, 726 (D. Conn. 1985). Applicant cannot rely on mere possibilities to provide factual evidence of ornamentality for the claimed design.

The requirements of visibility and ornamentality must be met for a rejection under 35 U.S.C. 171 based on the article being hidden during its end use to be overcome.

1504.01(d) Simulation

35 U.S.C. 171 requires that a design to be patentable be “original.” Clearly, a design which simulates an existing object or person is not original as required by the statute. The Supreme Court in *Gorham Manufacturing*

Co. v. White, 81 U.S. (14 Wall) 511 (1871), described a design as “the thing invented or produced, for which a patent is given.” “The arbitrary chance selection of a form of a now well known and celebrated building, to be applied to toys, inkstands, paper – weights, etc. does not, in my opinion, evince the slightest exercise of invention....” *Bennage v. Phillippi*, 1876 C.D. 135, 9 O.G. 1159 (Comm’r Pat. 1876). This logic was reinforced by the CCPA in *In re Smith*, 25 USPQ 359, 360, 1935 C.D. 565, 566 (CCPA 1935), which stated that “to take a natural form, in a natural pose, ... does not constitute invention” when affirming the rejection of a claim to a baby doll. This premise was also applied in *In re Smith*, 25 USPQ 360, 362, 1935 C.D. 573, 575 (CCPA 1935), which held that a “baby doll simulating the natural features...of a baby without embodying some grotesqueness or departure from the natural form” is not patentable.

Therefore, a claim directed to a design for an article which simulates a well known or naturally occurring object or person should be rejected under 35 U.S.C. 171 as nonstatutory subject matter in that the claimed design lacks originality. It would also be appropriate, if the examiner has prior art which anticipates or renders the claim obvious, to reject the claim under either 35 U.S.C. 102 or 103(a) concurrently. *In re Wise*, 340 F.2d 982, 144 USPQ 354 (CCPA 1965).

¶ 15.08.02 Simulation (Entire Article)

The claim is rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter in that the design lacks originality. The design is merely simulating [1] which applicant himself did not invent. See *In re Smith*, 25 USPQ 359, 1935 C.D. 565 (CCPA 1935); *In re Smith*, 25 USPQ 360, 1935 C.D. 573 (CCPA 1935); and *Bennage v. Phillippi*, 1876 C.D. 135, 9 O.G. 1159.

Examiner Note:

In bracket 1, insert the name of the article or person being simulated, e.g., the White House, Marilyn Monroe, an animal which is not stylized or caricatured in any way, a rock or shell to be used as paperweight, etc.

1504.01(e) Offensive Subject Matter

Design applications which disclose subject matter which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions, should be rejected as nonstatutory subject matter under 35 U.S.C. 171. See also MPEP § 608. Form Paragraph 15.10 should be used.

¶ 15.10 Offensive Subject Matter

The disclosure, and therefore the claim in this application, is rejected as being offensive and therefore improper subject matter for design patent protection under 35 U.S.C. 171. Such subject matter does not meet the statutory requirements of 35 U.S.C. 171. Moreover, since 37 CFR 1.3 proscribes the presentation of papers which are lacking in

decorum and courtesy, and this includes depictions of caricatures in the disclosure, drawings, and/or a claim which might reasonably be considered offensive, such subject matter as presented herein is deemed to be clearly contrary to 37 CFR 1.3. See MPEP § 608.

1504.02 Novelty

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 172. Right of priority.

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

The standard for determining novelty under 35 U.S.C. 102 was set forth by the court in *In re Bartlett*, 300 F.2d 942, 133 USPQ 204 (CCPA 1962). “The degree of difference [from the prior art] required to establish novelty occurs when the average observer takes the new design for a different, and not a modified, already-existing design.” 300 F.2d at 943, 133 USPQ at 205 (quoting *Shoemaker, Patents For Designs*, page 76). This “average observer” has been described in *In re Nalbandian*, 661 F.2d 1214, 1215–16 n.2, 211 USPQ 782, 784 n.2 (CCPA 1981), as having a “less discerning eye.” Therefore, absolute identity of the reference and the claimed design is not required to support a rejection for lack of novelty under

35 U.S.C. 102, however, the reference must be virtually identical to the claimed design.

The “average observer” test does not require that the claimed design and the prior art be from analogous arts when evaluating novelty. *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). Insofar as the “average observer” under 35 U.S.C. 102 is not charged with knowledge of any art, the issue of analogousness of prior art need not be raised. This distinguishes 35 U.S.C. 102 from 35 U.S.C. 103(a) which requires determination of whether the claimed design would have been obvious to “a person of ordinary skill in the art.”

When a claim is rejected under 35 U.S.C. 102 as being unpatentable over prior art, those features of the design which are functional and/or hidden during end use may not be relied upon to support patentability. *In re Cornwall*, 230 F.2d 447, 109 USPQ 57 (CCPA 1956); *Jones v. Progress Ind. Inc.*, 119 USPQ 92 (D. R.I. 1958). Further, in a rejection of a claim under 35 U.S.C. 102, mere differences in functional considerations do not negate a finding of anticipation when determining design patentability. *Black & Decker, Inc. v. Pittway Corp.*, 636 F.2d 1193, 231 USPQ 252 (N.D. Ill. 1986).

It is not necessary that prior art be cited or applied that shows functional and/or hidden features to be old in the art as long as the examiner has properly relied on evidence to support the *prima facie* lack of ornamentality of these individual features. If applicant wishes to rely on functional or hidden features as a basis for patentability, the same standard for establishing ornamentality under 35 U.S.C. 171 must be applied before these features can be given any patentable weight. See MPEP § 1504.01(c).

In evaluating a statutory bar based on 35 U.S.C. 102(b), the experimental use exception to a statutory bar for public use or sale (see MPEP § 2133.03(e)) does not usually apply for design patents. See *In re Mann*, 861 F.2d 1581, 8 USPQ2d 2030 (Fed. Cir. 1988). However, *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 1200, 31 USPQ2d 1321, 1326 (Fed. Cir. 1994) held that “experimentation directed to functional features of a product also containing an ornamental design may negate what otherwise would be considered a public use within the meaning of section 102(b).” See MPEP § 2133.03(e)(6).

Registration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119(a)–(d) and 35 U.S.C. 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster*, 151 USPQ 713 (Bd. App. 1965); *Ex parte Marinissen*, 155 USPQ 528 (Bd. App. 1966); *Appeal No. 239–48, Decided April 30, 1965*, 151 USPQ 711, (Bd. App. 1965); *Ex parte Appeal decided September 3, 1968*, 866 O.G. 16 (Bd. App. 1966). The basis of this practice is that if the foreign applicant has received the protection offered in the foreign country, no matter what the protection is called (“patent,” “Design Registration,” etc.), if the United States application is timely filed, a claim for priority will vest. If, on the other hand, the U.S. application is not timely filed, a statutory bar arises under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172. In order for the filing to be timely for priority purposes and to avoid possible statutory bars, the U.S. design patent application must be made within 6 months of the foreign filing. See also MPEP § 1504.10.

The laws of each foreign country vary in one or more respects.

The following table sets forth the dates on which design rights can be enforced in a foreign country (INID Code (24)) and thus, are also useable in a 35 U.S.C. 102(d) rejection as modified by 35 U.S.C. 172. It should be noted that in many countries the date of registration or grant is the filing date.

Country or Organization	Date(s) Which Can Also Be Used for 35 U.S.C. 102(d) Purposes ¹ (INID Code (24))	Comment
AT—Austria	Protection starts on the date of publication of the design in the official gazette	
AU—Australia	Date of registration or grant which is the filing date	
BG—Bulgaria	Date of registration or grant which is the filing date	
BX—Benelux (Belgium, Luxembourg, and the Netherlands)	Date on which corresponding application became complete and regular according to the criteria set by the law	
CA—Canada	Date of registration or grant	
CH—Switzerland	Date of registration or grant which is the filing date	Minimum requirements: deposit application, object, and deposit fee
CL—Chile	Date of registration or grant	
CU—Cuba	Date of registration or grant which is the filing date	
CZ—Czech Republic	Date of registration or grant which is the filing date	
DE—Germany	Date of registration or grant	The industrial design right can be enforced by a court from the date of registration although it is in force earlier (as from the date of filing—as defined by law).
DK—Denmark	Date of registration or grant which is the filing date	
EG—Egypt	Date of registration or grant which is the filing date	
ES—Spain	Date of registration or grant	
FI—Finland	Date of registration or grant which is the filing date	
FR—France	Date of registration or grant which is the filing date	

Continued on next page

Country or Organization	Date(s) Which Can Also Be Used for 35 U.S.C. 102(d) Purposes ¹ (INID Code (24))	Comment
GB—United Kingdom	Date of registration or grant which is the filing date	Protection arises automatically under the Design Right provision when the design is created. Proof of the date of the design creation needs to be kept in case the design right is challenged. The protection available to designs can be enforced in the courts following the date of grant of the Certificate of Registration as of the date of registration which stems from the date of first filing of the design in the UK or, if a priority is claimed under the Convention, as another country.
HU—Hungary	Date of registration or grant	With retroactive effect as from the filing date
JP—Japan	Date of registration or grant	
KR—Republic of Korea	Date of registration or grant	
MA—Morocco	Date of registration or grant which is the filing date	
MC—Monaco	Date of registration or grant which is the filing date	Date of prior disclosure declared on deposit
NO—Norway	Date of registration or grant which is the filing date	
OA—African Intellectual Property Organization (OAPI) (Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Cote d'Ivoire, Gabon, Guinea, Mali, Mauritania, Niger, Senegal, and Togo)	Date of registration or grant which is the filing date	
PT—Portugal	Date of registration or grant	
RO—Romania	Date of registration or grant which is the filing date	
RU—Russian Federation	Date of registration or grant which is the filing date	
SE—Sweden	Date of registration or grant	
TN—Tunisia	Date of registration or grant which is the filing date	

Continued on next page

Country or Organization	Date(s) Which Can Also Be Used for 35 U.S.C. 102(d) Purposes ¹ (INID Code (24))	Comment
TT—Trinidad and Tobago	Date of registration or grant which is the filing date	
WO—World Intellectual Property Organization (WIPO)		Subject to Rule 14.2 of the Regulations (on defects), the International Bureau enters the international deposit in the International Register on the date on which it has in its possession the application together with the items required. Reproductions, samples, or models pursuant to Rule 12, and the prescribed fees.

¹Based on information taken from the "Survey of Filing Procedures and Filing Requirements, as well as of Examination Methods and Publication Procedures, Relating to Industrial Designs" as adopted by the PCIPI Executive Coordination Committee of the World Intellectual Property Organization (WIPO) at its fifteenth session on November 25, 1994.

Rejections under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172 should only be made when the examiner knows that the application for foreign registration/patent has actually issued before the U. S. filing date based on an application filed more than six (6) months prior to filing the application in the United States. If the grant of a registration/patent based on the foreign application is not evident from the record of the U. S. application or from information found within the preceding charts, then the statement below should be included in the first action on the merits of the application:

¶ 15.03.01 *Foreign Filing More Than 6 Months Before U.S. Filing*

Acknowledgment is made of the [1] application identified in the declaration which was filed more than six months prior to the filing date of the present application. Applicant is reminded that if the [2] application matured into a form of patent protection before the filing date of the present application it would constitute a statutory bar to the issuance of a design patent in the United States under 35 U.S.C. 102(d) in view of 35 U.S.C. 172.

Examiner Note:

In brackets 1 and 2, insert the name of country where application was filed.

Form paragraphs for use in rejections under 35 U.S.C. 102 are set forth below.

¶ 15.11 *35 U.S.C. 102(a) Rejection*

The claim is rejected under 35 U.S.C. 102(a) as being clearly anticipated by [1] because the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country before the invention thereof by the applicant for patent.

¶ 15.12 *35 U.S.C. 102(b) Rejection*

The claim is rejected under 35 U.S.C. 102(b) as being clearly anticipated by [1] because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

¶ 15.13 *35 U.S.C. 102(c) Rejection*

The claim is rejected under 35 U.S.C. 102(c) because the invention has been abandoned.

¶ 15.14 *35 U.S.C. 102(d)/172 Rejection*

The claim is rejected under 35 U.S.C. 102(d), as modified by 35 U.S.C. 172, as being clearly anticipated by [1] because the invention was first patented or caused to be patented, or was the subject of an inventor's certificate by the applicant, or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country, or on an application for patent or inventor's certificate filed more than six (6) months before the filing of the application in the United States.

¶ 15.15 *35 U.S.C. 102(e) Rejection*

The claim is rejected under 35 U.S.C. 102(e) as being clearly anticipated by [1] because the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.

¶ 15.16 *35 U.S.C. 102(f) Rejection*

The claim is rejected under 35 U.S.C. 102(f) because applicant did not himself invent the subject matter sought to be patented.

¶ 15.17 *35 U.S.C. 102(g) Rejection*

The claim is rejected under 35 U.S.C. 102(g) because, before the applicant's invention thereof, the invention was made in this country by another who had not abandoned, suppressed or concealed it.

¶ 15.41 *Functional, Structural Features Not Considered*

Attention is directed to the fact that design patent applications are concerned solely with the ornamental appearance of an article of manufacture. The functional and/or structural features stressed by applicant in the papers are of no concern in design cases, and are neither permitted nor required. Function and structure fall under the realm of utility patent applications.

The following form paragraphs may be used in a second or subsequent action, where appropriate.

¶ 15.38 *Rejection Maintained*

The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under [1] should be withdrawn.

Examiner Note:

In bracket 1, insert basis of rejection.

¶ 15.40.01 *Final Rejection Under Other Statutory Provisions*

The claim is again and FINALLY REJECTED under [1] as [2].

Examiner Note:

1. In bracket 1, insert statutory basis.
2. In bracket 2, insert reasons for rejection.

1504.03 Nonobviousness

35 U.S.C. 103. *Conditions for patentability; non-obvious subject matter.*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

A claimed design that meets the test of novelty must additionally be evaluated for nonobviousness under 35 U.S.C. 103(a).

I. GATHERING THE FACTS

The basic factual inquiries guiding the evaluation of obviousness, as outlined by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), are applicable to the evaluation of design patentability:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art;
- (C) Resolving the level of ordinary skill in the art; and
- (D) Evaluating any objective evidence of nonobviousness (i.e., so-called "secondary considerations").

A. Scope of the Prior Art

The scope of the relevant prior art for purposes of evaluating obviousness under 35 U.S.C. 103(a) extends to all "analogous arts."

While the determination of whether arts are analogous is basically the same for both design and utility inventions (see MPEP § 904.01(c) and § 2141.01(a)), *In re Glavas*, 230 F.2d 447, 450 109 USPQ 50, 52 (CCPA 1956) provides specific guidance for evaluating analogous arts in the design context, which should be used to supplement the general requirements for analogous art as follows:

The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.

Thus, if the problem is merely one of giving an attractive appearance to a surface, it is immaterial whether the surface in question is that of wall paper, an oven door, or a piece of crockery. . . .

On the other hand, when the proposed combination of references involves material modifications of the basic form of one article in view of another, the nature of the article involved is a definite factor in determining whether the proposed change involves [patentable] invention.

Therefore, where the differences between the claimed design and the prior art are limited to the application of ornamentation to the surface of an article, any prior art reference which discloses substantially the same surface ornamentation would be considered analogous art. Where the differences are in the shape or form of the article, the nature of the articles involved must also be considered.

B. Differences Between the Prior Art and the Claimed Design

In determining patentability under 35 U.S.C. 103(a), it is the overall appearance of the design that must be considered. *In re Leslie*, 547 F.2d 116, 192 USPQ 427 (CCPA 1977). The mere fact that there are differences between a design and the prior art is not alone sufficient to justify patentability. *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

All differences between the claimed design and the closest prior art reference should be identified in any rejection of the design claim under 35 U.S.C. 103(a). If any differences are considered *de minimis* or inconsequential from a design viewpoint, the rejection should so state.

C. Level of Ordinary Skill in the Art

In order to be unpatentable, 35 U.S.C. 103(a) requires that an invention must have been obvious to a person having "ordinary skill in the art" to which the subject matter sought to be patented pertains. The "level of ordinary skill in the art" from which obviousness of a design claim must be evaluated under 35 U.S.C. 103(a) has been held by the courts to be the perspective of the "designer of . . . articles of the types presented." *In re Nalbandian*, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982).

D. Secondary Considerations

Secondary considerations, such as commercial success and copying of the design by others, are relevant to the evaluation of obviousness of a design claim. Evidence of nonobviousness may be present at the time a *prima facie* case of obviousness is evaluated or it may be presented in rebuttal of a prior obviousness rejection.

II. PRIMA FACIE OBVIOUSNESS

Once the factual inquiries mandated under *Graham v. John Deere Co.*, 383 U. S. 1, 148 USPQ 459 (1966), have been made, the examiner must determine whether they support a conclusion of *prima facie* obviousness. To establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art.

In determining *prima facie* obviousness, the proper standard is whether the design would have been obvious to a designer of ordinary skill with the claimed type of article. *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

As a whole, a design must be compared with something in existence, and not something brought into existence by selecting and combining features from prior art references. *In re Jennings*, 182 F.2d 207, 86 USPQ 68 (CCPA 1950). The “something in existence” referred to in *Jennings* has been defined as “...a reference... the design characteristics of which are basically the same as the claimed design...” *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982) (the primary reference did “...not give the same visual impression...” as the design claimed but had a “...different overall appearance and aesthetic appeal...”.) Hence, it is clear that “design characteristics” means overall visual appearance. This definition of “design characteristics” is reinforced in the decision of *In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993), and is supported by the earlier decisions of *In re Yardley*, 493 F.2d 1389, 181 USPQ 331, 334 (CCPA 1974) and *In re Leslie*, 547 F.2d 116, 192 USPQ 427, 431 (CCPA 1977). Specifically, in the *Yardley* decision, it was stated that “[t]he basic consideration in determining the patentability of designs over prior art is similarity of appearance.” 493 F.2d at 1392–93, 181 USPQ at 334. Therefore, in order to support a holding of obviousness, a basic reference must be more than a design concept; it must have an appearance substantially the same as the claimed design. *In re Harvey*, 12 F.3d 1061, 29 USPQ2d 1206 (Fed. Cir. 1993). Absent such a reference, no holding of obviousness under 35 U.S.C. 103(a) can be made, whether based on a single reference alone or in view of modifications suggested by secondary prior art.

A rejection under 35 U.S.C. 103(a) based on a single non-analogous reference would not be proper. The reason is that under 35 U.S.C. 103(a), a designer of ordinary skill would not be charged with knowledge of prior art that is not analogous to the claimed design.

Examiners are advised that differences between the claimed design and a basic reference may be held to be minor in nature and unrelated to the overall aesthetic appearance of the design with or without the support of secondary references. *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981). If such differences are shown by secondary references, they should be applied so as to leave no doubt that those differences would have been obvious to a designer of ordinary skill in the art. *In re Sapp*, 324 F.2d 1021, 139 USPQ 522 (CCPA 1963).

When a claim is rejected under 35 U.S.C. 103(a) as being unpatentable over prior art, features of the design

which are functional and/or hidden during end use may not be relied upon to support patentability. “[A] design claim to be patentable must also be ornamental; and functional features or forms cannot be relied upon to support its patentability.” *Jones v. Progress, Ind. Inc.*, 119 USPQ 92, 93 (D. R.I. 1958). “It is well settled that patentability of a design cannot be based on elements which are concealed in the normal use of the device to which the design is applied.” *In re Cornwall*, 230 F.2d 457, 459, 109 USPQ 57, 58 (CCPA 1956); *In re Garbo*, 287 F.2d 192, 129 USPQ 72 (CCPA 1961). It is not necessary that prior art be relied upon in a rejection under 35 U.S.C. 103(a) to show similar features to be functional and/or hidden in the art. However, examiners must provide evidence to support the *prima facie* functionality of such features. Furthermore, hidden portions or functional features cannot be relied upon as a basis for patentability. If applicant wishes to rely on functional or hidden features as a basis for patentability, then the same standard for establishing ornamentality under 35 U.S.C. 171 must be applied before these features can be given any patentable weight. See MPEP § 1504.01(c).

A. Combining Prior Art References

A rejection under 35 U.S.C. 103(a) would be appropriate if a designer of ordinary skill would have been motivated to modify a basic reference by deleting features thereof or by interchanging with or adding features from pertinent secondary references. In order for secondary references to be considered, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. *In re Borden*, 90 F.3d 1570, 1572, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996). The long standing test for properly combining references has been “...whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956).

The prohibition against destroying the function of the design is inherent in the logic behind combining references to render a claimed invention obvious under 35 U.S.C. 103(a). If the proposed combination of the references alters the primary reference in such a way that its broad function can no longer be carried out, clearly the combination of the prior art would not have been obvious to one of ordinary skill in the art. It is permissible to modify the primary reference to the extent that the specific function of the article may be affected while the

broad function is not affected. For example, a primary reference to a cabinet design claimed as airtight could be modified to no longer be airtight so long as its function as a cabinet would not be impaired.

1. Analogous Art

When a modification to a basic reference involves a change in configuration, both the basic and secondary references must be from analogous arts. *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). The reason for this is two fold. First, a designer of ordinary skill is only charged with knowledge of art related to that of the claimed design. Second, the ornamental features of the references must be closely related in order for a designer of ordinary skill to have been motivated to have modified one in view of the other. Hence, when modifying a basic reference, a designer of ordinary skill would have looked at design features of other related references for precisely the purpose of observing the ornamental characteristics they disclosed.

Analogous art can be more broadly interpreted when applied to a claim that is directed to a design with a portion simulating a well known or naturally occurring object. The simulative nature of that portion of the design is *prima facie* evidence that art which simulates that portion would be within the level of ordinary skill under 35 U.S.C. 103(a).

2. Non-analogous Art

When modifying the surface of a basic reference so as to provide it with an attractive appearance, it is immaterial whether the secondary reference is analogous art, since the modification does not involve a change in configuration or structure and would not have destroyed the characteristics (appearance and function) of the basic reference. *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956).

III. REBUTTAL OF THE PRIMA FACIE CASE

Once a *prima facie* case of obviousness has been established, the burden shifts to the applicant to rebut it, if possible, with objective evidence of nonobviousness. Examples of secondary considerations are commercial success, expert testimony and copying of the design by others. Any objective evidence of nonobviousness or rebuttal evidence submitted by applicant, including affidavits or declarations under 37 CFR 1.132, must be considered

by examiners in determining patentability under 35 U.S.C. 103(a).

When evidence of commercial success is submitted, examiners must evaluate it to determine whether there is objective evidence of success, and whether the success can be attributed to the ornamental design. *Litton System, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984); *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981). An affidavit or declaration under 37 CFR 1.132 has minimal evidentiary value on the issue of commercial success if there is no nexus or connection between the sales of the article in which the design is embodied and the ornamental features of the design. *Avia Group Int'l Inc. v. L.A. Gear*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988).

Submission of expert testimony must establish the professional credentials of the person signing the affidavit or declaration, and should not express an opinion on the ultimate legal issue of obviousness since this conclusion is one of law, rather than opinion. *Avia Group Int'l Inc. v. L.A. Gear*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

With regard to evidence submitted showing that competitors in the marketplace are copying the design, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as lack of concern for patent property or contempt for the patentee's ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985).

For additional information regarding the issue of objective evidence of nonobviousness, attention is directed to MPEP § 716 through § 716.06.

¶ 15.18 35 U.S.C. 103(a) Rejection (Single Reference)

The claim is rejected under 35 U.S.C. 103(a) as being unpatentable over [1]. Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

¶ 15.70 Preface, 35 U.S.C. 103(a) Rejection

It would have been obvious to one of ordinary skill in the art at the time the invention was made to [1].

Examiner Note:

Insert explanation of the use of the reference applied in bracket 1.

¶ 15.67 *Rationale for 35 U.S.C. 103(a) Rejection (Single Reference)*

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability. See *In re Frick*, 275 F.2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

¶ 15.19 *35 U.S.C. 103(a) Rejection (Multiple References)*

The claim is rejected under 35 U.S.C. 103(a) as being unpatentable over [1] in view of [2].

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

¶ 15.68 *Rationale for 35 U.S.C. 103(a) Rejection (Multiple References)*

This modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that one skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Anile*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

¶ 15.41 *Functional, Structural Features Not Considered*

Attention is directed to the fact that design patent applications are concerned solely with the ornamental appearance of an article of manufacture. The functional and/or structural features stressed by applicant in the papers are of no concern in design cases, and are neither permitted nor required. Function and structure fall under the realm of utility patent applications.

The following form paragraphs may be used in a second or subsequent action where appropriate.

¶ 15.38 *Rejection Maintained*

The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under [1] should be withdrawn.

Examiner Note:

In bracket 1, insert basis of rejection.

¶ 15.39 *Obviousness Under 35 U.S.C. 103(a) Repeated*

It remains the examiner's position that the [1] design claimed is obvious under 35 U.S.C. 103(a) over [2].

Examiner Note:

In bracket 1, insert name of design.

¶ 15.39.01 *35 U.S.C. 103(a) Rejection Repeated (Multiple References)*

It remains the examiner's position that the claim is obvious under 35 U.S.C. 103(a) over [1] in view of [2].

¶ 15.39.02 *Final Rejection Under 35 U.S.C. 103(a) (Single Reference)*

The claim is again and FINALLY REJECTED under 35 U.S.C. 103(a) over [1].

Examiner Note:

See paragraphs in MPEP Chapter 700, for "Action is Final" and "Advisory after Final" paragraphs.

¶ 15.40 *Final Rejection Under 35 U.S.C. 103(a) (Multiple References)*

The claim is again and FINALLY REJECTED under 35 U.S.C. 103(a) as being unpatentable over [1] in view of [2].

¶ 15.40.01 *Final Rejection Under Other Statutory Provisions*

The claim is again and FINALLY REJECTED under [1] as [2].

Examiner Note:

1. In bracket 1, insert statutory basis.
2. In bracket 2, insert reasons for rejection.

1504.04 Considerations Under 35 U.S.C. 112

35 U.S.C. 112. *Specification.*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The drawing in a design application is incorporated into the claim by use of the claim language "as shown."

Additionally, the drawing disclosure can be supplemented by narrative description in the specification (see MPEP § 1503.01, paragraph II). This description is incorporated into the claim by use of the language "as shown and described." See MPEP § 1503.03.

I. 35 U.S.C. 112, FIRST PARAGRAPH

A. *Enablement and Sufficiency of Disclosure*

A defect in the drawing or the narrative description in the specification that renders the design unclear, confusing, or incomplete supports a rejection of the claim under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure. An evaluation of the claim to determine if it meets the enablement requirement of 35 U.S.C. 112, first paragraph, cannot be based on the drawings alone but must include consideration of the scope of the claim as identified by the title and specification. "[T]he adequacy of the disclosure must be deter-

mined by reference to the scope asserted." *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 131 USPQ 413, 418 (D. Del. 1961).

¶ 15.20.01 *Rejection, 35 U.S.C. 112, First Paragraph (Nonenabling)*

The claim is rejected under 35 U.S.C. 112, first paragraph, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same.

The claim is nonenabling because [1].

¶ 15.73 *Drawing Corrections Required*

Failure to submit proposed drawing corrections or additional drawing views overcoming all of the deficiencies in the drawing disclosure set forth above, or an explanation why proposed drawing corrections or additional drawing views are not necessary will result in the rejection of the claim under 35 U.S.C. 112, first paragraph, being made FINAL in the next Office action.

Only those surfaces of the article that are visible at the point of sale or during use should be disclosed to meet the requirement of 35 U.S.C. 112, first paragraph, for an enabling disclosure. "The drawing should illustrate the design as it will appear to purchasers and users, since the appearance is the only thing that lends patentability to it under the design law." *Ex parte Kohler*, 1905 C.D. 192, 192, 116 O.G. 1185, 1185 (Comm'r Pat. 1905). The lack of disclosure of those surfaces of the article which are not claimed or which are hidden during sale or use does not violate the enablement requirements of the first paragraph of 35 U.S.C. 112 because the "patented ornamental design has no use other than its visual appearance...." *In re Harvey*, 12 F.3d 1061, 1064, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). Therefore, to make the "visual appearance" of the design merely involves the reproduction of what is shown in the drawings; it is not necessary that the functionality of the article be reproduced as this is not claimed. The function of a design is "that its appearance adds attractiveness, and hence commercial value, to the article embodying it." *Ex parte Cady*, 1916 C.D. 57, 61, 232 O.G. 619, 621 (Comm'r Pat. 1916).

The undisclosed surfaces not seen during sale or use are not required to be described in the specification even though the title of the design is directed to the complete article because the design is embodied only in those surfaces which are visible. *Ex parte Salisbury*, 38 USPQ 149, 1938 C.D. 6 (Comm'r Pat. 1938). While it is not necessary to show in the drawing those visible surfaces that are flat and unornamented, they should be described in the specification by way of a special description. *Ex parte Salisbury*, 38 USPQ 149, 1938 C.D. 6 (Comm'r Pat. 1938). Such special description may not be used to describe vis-

ible surfaces which include structure that is clearly not flat. *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 131 USPQ 413 (D. Del. 1961). See also MPEP § 1503.02.

If the title (in the claim) defines an entire article but the drawing fails to disclose surfaces which would be visible either during use or on sale, applicant may include the following statement in the specification in order to identify the scope of the claimed design: "The (identify those surfaces not shown) form(s) no part of the claimed design."

B. *New Matter*

New matter is subject matter which has no antecedent basis in the original specification, drawings or claim (MPEP § 608.04). An amendment to the claim must have antecedent basis in the original disclosure. 35 U.S.C. 132; 37 CFR 1.121(a)(b). Prior to final action, all amendments will be entered in the applications and will be considered by the examiner. *Ex parte Hanback*, 231 USPQ 739 (Bd. Pat. App. & Inter. 1986). If new matter is added to the disclosure, the disclosure should be objected to under 35 U.S.C. 112, first paragraph as lacking support in the application as originally filed. The claim should be rejected under 35 U.S.C. 112, first paragraph, if appropriate.

The scope of a design claim is defined by what is shown in full lines in the application drawings. *In re Mann*, 861 F.2d 1581, 8 USPQ2d 2030 (Fed. Cir. 1988). The claim may be amended by broadening or narrowing its scope within the bounds of the disclosure as originally filed.

An amendment which does alter the appearance of the amended claim by changing its configuration alters the claimed design. A change in the configuration of the claimed design is considered a departure from the original disclosure and introduces prohibited new matter (37 CFR 1.121(a)(6)). See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). An amendment which does alter the appearance of the amended claim by removing its surface treatment may be permitted if it is clear from the application that applicant had possession of the basic design without the surface treatment at the time of filing of the application. See *In re Daniels*, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

Amendments to the title must have antecedent basis in the original application to be permissible. Any amendment to the title which has no antecedent basis in the original application should be objected to under

35 U.S.C. 132 as introducing new matter into the disclosure. See MPEP § 1503.01, paragraph I.

Examples of permissible amendments filed with the original application include: (1) A preliminary amendment filed simultaneously with the application papers, that is specifically identified in the original oath/declaration as required by 37 CFR 1.63 and MPEP § 608.04(b); and (2) The inclusion of a disclaimer in the original specification or on the drawings/photographs as filed. See 37 CFR 1.152(b)(1) and MPEP § 1503.01 and § 1503.02.

An example of a permissible amendment submitted after the filing of the application would be an amendment that does not involve a departure from the configuration of the original disclosure (37 CFR 1.121(a)(6)).

Examples of amendments which introduce new matter include: (1) An amendment to the claim without antecedent basis in the original disclosure which would change the configuration or surface appearance of the original design by the deletion or reduction to broken lines of a portion thereof; and (2) An amendment to the claim without antecedent basis in the original disclosure which would change the configuration or surface appearance of the original design by the addition of previously undisclosed subject matter. *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981).

An amendment to the claim which has no antecedent basis in the specification and drawings as originally filed introduces new matter because that subject matter is not described in the application as originally filed. The claim should be rejected under 35 U.S.C. 112, first paragraph. An amendment to the disclosure which has no antecedent basis in the original application should be objected to under 35 U.S.C. 132 and a requirement should be made to cancel the new matter.

¶ 15.20 *Rejection, 35 U.S.C. 112, First Paragraph*

The claim is rejected under 35 U.S.C. 112, first paragraph, as [1].

Examiner Note:

Supply further explanation as appropriate. New matter rejections should be made under this section of the statute when the claims depend upon the new matter. See also form paragraph 15.51.

¶ 15.51 *35 U.S.C. 112, First Paragraph Rejection (New Matter)*

The proposed additional or amended illustration has been entered, however such illustration introduces new matter (35 U.S.C. 132, 37 CFR 1.121). Due to the differences between the original and the new drawings, applicant's disclosure fails to comply with the description requirement of 35 U.S.C. 112, first paragraph. Accordingly, the claim is rejected in that the disclosure does not satisfy the description requirement of 35 U.S.C. 112, first paragraph. See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

¶ 15.65 *Amendment May Not Be Possible*

The claim might be fatally defective; that is, it might not be possible to [1] without introducing new matter (35 U.S.C. 132, 37 CFR 1.121).

Examiner Note:

In bracket 1, identify portion of the claimed design which is insufficiently disclosed.

II. 35 U.S.C. 112, SECOND PARAGRAPH

Defects in claim language give rise to a rejection of the claim under the second paragraph of 35 U.S.C. 112. Typical examples include:

(A) Use of phrases in the claim such as "substantially as shown," "or similar article," "or the like," or equivalent terminology. *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988); *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

¶ 15.22.01 *Rejection, 35 U.S.C. 112, 2nd Paragraph ("Substantially" in Claim)*

The claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because of the use of the term "substantially" therein. Cancellation of said term will overcome the rejection. See *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988), *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992) and 37 CFR 1.153.

Examiner Note:

This rejection should be used where there is another rejection in the Office action. For issue with an examiner's amendment, see form paragraph 15.69.

¶ 15.69 *Remove Indefinite Language ("Substantially") by Examiner's Amendment*

The term "substantially" in the claim renders the claim indefinite under 35 U.S.C. 112, second paragraph, and 37 CFR 1.153. See *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988) and *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992). The term "substantially" has been cancelled from the claim by authorization of [1] in a telephone interview on [2].

¶ 15.22.02 *Rejection, 35 U.S.C. 112, 2nd Paragraph ("Or the Like" In Claim)*

The claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because of the use of the phrase "[1]" following the title. Cancellation of said phrase in the claim and each occurrence of the title throughout the papers, except the oath or declaration, will overcome the rejection. See *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988), *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992) and 37 CFR 1.153.

Examiner Note:

1. This rejection should be used where there is another rejection in the Office action. For issue with an examiner's amendment, see form paragraph 15.69.01.

2. In bracket 1, insert --or the like-- or --or similar article--.

¶ 15.69.01 *Remove Indefinite Language ("Or The Like") by Examiner's Amendment*

The phrase [1] in the claim following the title renders the claim indefinite. By authorization of [2] in a telephone interview on [3], the phrase has been cancelled from the claim and at each occurrence of the title throughout the papers, except the oath or declaration (35 U.S.C. 112, second paragraph, and 37 CFR 1.153). See *Ex parte Sussman*, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988) and *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

Examiner Note:

In bracket 1, insert objectionable phrase, e.g., --or the like--, --or similar article--, etc.

(B) The designation of the design as collectively shown in the drawing, referenced in the title and described in the specification is such that it cannot be determined what article of manufacture is being claimed. For example, a design claimed as a "widget" which does not identify a known or recognizable article of manufacture.

¶ 15.22 *Rejection, 35 U.S.C. 112, 2nd Paragraph*

The claim is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Examiner Note:

1. Use this paragraph when the claim language does not identify a known article of manufacture in which the design is embodied or applied.
2. Add a full explanation of the rejection.

¶ 15.21.01 *Rejection, 35 U.S.C. 112 (Second Paragraph) (Information Requested)*

The claim is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112, second paragraph. The title of the article in which the design is embodied or applied is too ambiguous and therefore indefinite for the examiner to make a proper examination of the claim under 37 CFR 1.104.

Applicant is therefore required to provide a sufficient explanation of the nature and intended use of the article in which the claimed design is embodied or applied, so that a proper classification and reliable search can be made. See 37 CFR 1.154(a)(3); MPEP 1503.01. Additional information, if available, regarding analogous fields of search, pertinent prior art, advertising brochures and the filing of copending utility applications would also prove helpful. If a utility application has been filed, please furnish its application number.

This information should be submitted in the form of a separate paper, and should not be inserted in the specification (37 CFR 1.56). See also 37 CFR 1.97, 1.98 and 1.99.

Examiner Note:

This rejection may be used when the applicant fails to respond to a request for information and as otherwise deemed appropriate.

III. RELATIONSHIP BETWEEN THE REQUIREMENTS OF THE FIRST AND SECOND PARAGRAPHS OF 35 U.S.C. 112

While the requirements of the first and second paragraphs of 35 U.S.C. 112 are separate and distinct, the relationship between these requirements is not always easily distinguishable in design patent practice due to the fact that the drawing disclosure (which is equivalent to the written description requirement) is incorporated into the claim by the use of the claim language "as shown." This reference to the drawing in the claim is the basis for a rejection under 35 U.S.C. 112, first paragraph, when an amendment to the drawing disclosure of the design introduces new matter (35 U.S.C. 132). When the drawing disclosure is not consistent with the scope of the subject matter defined in the claim, that fact alone does not render the claim indefinite or otherwise not in compliance with 35 U.S.C. 112, second paragraph. Rather, the claim is based on an insufficient disclosure and should be rejected under 35 U.S.C. 112, first paragraph. However, a rejection under 35 U.S.C. 112, first and second paragraphs, should be made when the drawing disclosure and the claim disagree, conflict or are inconsistent, other than in scope, and confusion exists as to whether the claimed design is sufficiently disclosed in the enabling teachings of the drawings. For instance, if the subject matter defined in the claim is directed to a design embodied in a chair and the drawing only discloses a design embodied in a table, the claim should be rejected under 35 U.S.C. 112, first and second paragraphs, as being based on a nonenabling disclosure and as being indefinite since it is not clear what article of manufacture is being claimed.

¶ 15.21 *Rejection, 35 U.S.C. 112, First And Second Paragraphs*

The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note:

1. This paragraph should not be used when it is appropriate to make one or more separate rejections under the first and/or the second paragraph of 35 U.S.C. 112. In other words, separate rejections under either the first or the second paragraph of 35 U.S.C. 112 are preferred. This paragraph should only be used when either the first or the second paragraph of 35 U.S.C. 112 could be applicable, but due to some question of interpretation, uncertainty exists as to whether the claimed invention is sufficiently described in the enabling teachings of the specification or the claim language is indefinite.
2. A full explanation should be provided with this rejection.

Where the design claim would otherwise be patentable but for the presence of any rejection under 35 U.S.C. 112, first and/or second paragraphs, Form Paragraph 15.58.01 should be used.

¶ 15.58.01 *Claimed Design Is Patentable (35 U.S.C. 112 Rejections)*

The claimed design is patentable over the references cited. However, a final determination of patentability will be made upon resolution of the above rejection.

Form Paragraphs 15.38 and 15.40.01 may be used in a second or subsequent action, where appropriate (see MPEP § 1504.02).

1504.05 Restriction

General principles of utility restriction are set forth in Chapter 800 of the MPEP. These principles are also applicable to design restriction practice with the exception of those differences set forth in this section.

Unlike a utility patent application, which can contain plural claims directed to plural inventions, a design patent application may only have a single claim and thus must be limited to a single invention. Therefore, the examiner will require restriction in each design application which contains more than one invention.

Restriction may be required under 35 U.S.C. 121 if subject matter in a design patent application as disclosed in the drawing is either independent or distinct and is able to support separate design patents. If the embodiments are held to be patentably indistinct and can be covered by a single claim, any rejection of one embodiment over prior art will apply equally to all other embodiments. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965).

I. INDEPENDENT INVENTIONS

Design inventions are independent if there is no apparent relationship between two or more disparate articles disclosed in the drawings; for example, a pair of eyeglasses and a door handle; a bicycle and a camera; an automobile and a bathtub. Also note examples in MPEP § 806.04. Restriction in such cases is clearly proper. This situation may be rarely presented since design patent applications are seldom filed containing disclosures of independent articles.

II. DISTINCT INVENTIONS

Design inventions are distinct if the overall appearance of two or more embodiments of an article as disclosed in the drawings are different in appearance or scope, for example, two embodiments of a brush, and their appearances are patentable (novel and unobvious) over each other. Restriction in such cases is also clearly proper. Distinct designs may constitute either multiple embodiments of the same article or they may be related as a combination and subcombination of the overall design. In determining the question of patentable distinctness under 35 U.S.C. 121 in a design patent application, a search of the prior art may be necessary.

A. Multiple Embodiments – Difference in Appearance

It is permissible to illustrate more than one embodiment of a design invention in a single application. However, such embodiments may be presented only if they involve a single inventive concept and are not patentably distinct from one another. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct over one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The disclosure of plural embodiments does not require or justify more than a single claim, which claim must be in the formal terms stated in MPEP § 1503.03. The specification should make clear that multiple embodiments are disclosed and should particularize the differences between the embodiments. If the disclosure of any embodiment relies on the disclosure of another embodiment for completeness to satisfy the requirements of 35 U.S.C. 112, first paragraph, the differences between the embodiments must be identified in the figure descriptions. For example, the second embodiment of a cabinet discloses a single view showing only the difference in the front door of the cabinet of the first embodiment; the figure description should state that this view "is a second embodiment of Figure 1, the only difference being the configuration of the door." This type of statement in the description is understood to incorporate the disclosure of the first embodiment to complete the disclosure of the second embodiment.

The obviousness standard under 35 U.S.C. 103(a) must be applied in determining whether multiple embodiments may be retained in a single application. That is, the differences between the embodiments must either be *de minimis* and unrelated to their overall aesthetic ap-

pearance or must be obvious to a designer of ordinary skill in view of the analogous prior art in order to be retained in a single application. If the embodiments are not considered obvious under 35 U.S.C. 103(a), restriction must be required.

¶ 15.27.02 *Restriction Not Required (First Action – Non Issue)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are not distinct from one another. Accordingly, they are deemed to comprise a single inventive concept and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315–40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the above identified embodiments.

¶ 15.27.03 *Restriction Not Required (First Action Issue)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are not distinct from one another. Accordingly, they are deemed to comprise a single inventive concept and are being retained and examined in the same application.

¶ 15.27 *Restriction Under 35 U.S.C. 121*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [3] create(s) patentably distinct designs.

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

Restriction is required under 35 U.S.C. 121 to one of the above identified patentably distinct groups of designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. Any

reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the embodiments comprise a single inventive concept or are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the embodiments to be obvious variations of one another. If the embodiments are determined not to be patentably distinct and are accordingly retained in the same application, any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315–40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept.

A shortened statutory period of ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter is set for applicant to elect a single embodiment for prosecution on the merits.

Examiner Note:

In bracket 3, insert an explanation of the difference(s) between the designs.

¶ 15.27.01 *Restriction Under 35 U.S.C. 121 (Obvious Variations Within Group)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [3]

Group II: Embodiment [4]

The embodiments disclosed within each group do not present overall appearances that are distinct from one another; i.e., they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the [5] patentably distinguishes each group from the other(s).

Restriction is required under 35 U.S.C. 121 to one of the patentably distinct groups of the designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the embodiments comprise a single inventive concept or are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the embodiments to be obvious variations of one another. If the groups are determined not to be patentably distinct and are accordingly retained in the same application, any rejection of one group over prior art will apply equally to all other groups. See *Ex parte Appeal No. 315–40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

A shortened statutory period of ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter is set for applicant to elect a single embodiment for prosecution on the merits.

Examiner Note:

In bracket 5, insert an explanation of the differences between the groups.

¶ 15.28 *Telephone Restriction Under 35 U.S.C. 121*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. The [3] create(s) patentably distinct designs. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above disclosed embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

Restriction is required under 35 U.S.C. 121 to one of the patentably distinct groups of designs.

During a telephone discussion with [6] on [7], a provisional election was made [8] traverse to prosecute the invention of group [9]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [10] is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected invention.

Examiner Note:

1. In bracket 3, insert an explanation of the differences between the designs.
2. In bracket 8, insert --with-- or --without--.

¶ 15.31 *Provisional Election Required (37 CFR 1.143)*

Applicant is advised that the reply to be complete must include a provisional election of one of the enumerated designs, even though the requirement may be traversed (37 CFR 1.143).

B. Combination/Subcombination – Difference in Scope

A design claim covers the entire design as a whole. It is not limited to any part or portion of the design. However, a design claim may cover embodiments of different scope directed to the same inventive concept within a single application if the designs are not patentably distinct. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). The court held that the inventive concept of a design is not limited to its embodiment in a single specific article and as long as the various embodiments are not patentably distinct, they may be protected by a single claim. *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965). The determination that the design of the subcombination/element is patentably indistinct from the combination means that the designs are not patentable (novel and unobvious) over each other and may remain in the same application. If the embodiments

are patentably distinct, the designs are considered to be separate inventions which require separate claims, and restriction to one or the other is necessary. See *In re Kelly*, 200 USPQ 560 (Comm'r Pat. 1978); *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

¶ 15.29 *Restriction Under 35 U.S.C. 121 (Segregable Parts or Combination/Subcombination)*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I – Figs. [1] drawn to a [2].

Group II – Figs. [3] drawn to a [4].

[5]

Examiner Note:

In bracket 5, add groups as necessary.

The inventions as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm'r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[6]

Examiner Note:

In bracket 6, add comments, if necessary.

Because the inventions are distinct for the reason(s) given above, and have acquired separate status in the art, restriction for examination purposes as indicated is proper (35 U.S.C. 121).

Applicant is reminded that the reply to be complete must include a provisional election of one of the enumerated inventions, even though the requirement may be traversed (37 CFR 1.143).

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Applicant is given ONE MONTH or thirty days, whichever is longer, from the mailing date of this letter to make an election to avoid a question of abandonment.

¶ 15.30 *Telephone Restriction Under 35 U.S.C. 121 (Segregable Parts or Combination/Subcombination)*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I – Figs [1] drawn to a [2].

Group II – Figs. [3] drawn to a [4].

[5]

Examiner Note:

In bracket 5, add groups as necessary.

The inventions as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm'r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965). It is

further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[6]

Examiner Note:

In bracket 6, insert additional comments, if necessary, and continue.

During a telephone discussion with [7] on [8], a provisional election was made [9] traverse to prosecute the invention of Group [10]. Affirmation of this election should be made by applicant in responding to this Office action.

Group [11] withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being for a nonelected invention.

¶ 15.34 Groups Withdrawn From Consideration After Traverse

Group [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected invention, the requirement having been traversed in Paper No. [2].

¶ 15.35 Cancel Nonelected Design (Traverse)

The restriction requirement maintained in this application is or has been made final. Applicant must cancel Group [1] directed to the design(s) nonelected with traverse in Paper No. [2], or take other timely appropriate action (37 CFR 1.144).

¶ 15.36 Groups Withdrawn From Consideration Without Traverse

Group [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for the nonelected invention. Election was made without traverse in Paper No. [2].

¶ 15.37 Cancellation of Nonelected Groups, No Traverse

In view of the fact that this application is in condition for allowance except for the presence of Group [1] directed to an invention or inventions nonelected without traverse in Paper No. [2], and without the right to petition, such Group(s) have been canceled.

1504.06 Double Patenting

There are generally two types of double patenting rejections. One is the "same invention" type double patenting rejection based on 35 U.S.C. 171 which states in the singular that an inventor "may obtain a patent." The second is the "nonstatutory-type" double patenting rejection based on a judicially created doctrine grounded in public policy and which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes rejections based on one-way determination of obviousness, and two-way determination of obviousness. Nonstatutory double patenting could include a rejection which is not the usual "obviousness-type" double patenting rejection. This type of double patenting rejection is based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension

is sought. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

The charts in MPEP § 804 outline the procedure for handling all double patenting rejections.

Double patenting rejections are based on a comparison of the claims in a patent and an application or between two applications; the disclosure of the patent or application may be relied upon only to define the claim. 35 U.S.C. 171 specifically states that "a patent" may be obtained if certain conditions are met; this use of the singular makes it clear that only one patent may issue for a design.

Determining if a double patenting rejection is appropriate involves the answers to the following inquiries: Is the same design being claimed twice? If not, are the designs directed to the same inventive concept with a change in scope or directed to obvious variations of the same inventive concept?

Double patenting rejections are based on a comparison of claims. While there is a direct correlation between the drawings in a design application and the claim, examiners must be aware that no such correlation is necessary in a utility application or patent. Several utility patents may issue with the identical drawing disclosure but with claims directed to different inventions. So any consideration of possible double patenting rejections between a utility application or patent with a design application cannot be based on the utility drawing disclosure alone. *Anchor Hocking Corp. v. Eyelet Specialty Co.*, 377 F. Supp. 98, 183 USPQ 87 (D. Del. 1974). The examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the design drawings.

If a provisional double patenting rejection (of any type) is the only rejection remaining in two conflicting applications, the examiner should withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the provisional double patenting rejection in the other application which rejection will be converted into a double patenting rejection when the first application issues as a patent. If more than two applications conflict with each other and one is allowed, the remaining applications should be cross rejected against the others as well as the allowed application. For this type of rejection to be appropriate, there must be either at least one inventor in common, or a common assignee. If the claims in copending design

applications or a design patent and design applications have a common assignee but different inventive entities, rejections under 35 U.S.C. 102(e), (f) and (g)/103(a) must be considered in addition to the double patenting rejection. See MPEP § 804, § 2136, § 2137 and § 2138.

I. "SAME INVENTION" DOUBLE PATENTING REJECTIONS

A design – design statutory double patenting rejection based on 35 U.S.C. 171 prevents the issuance of a second patent for a design already patented. For this type of double patenting rejection to be proper, identical designs with identical scope must be twice claimed. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). A design – utility “same invention” double patenting rejection is based on judicial doctrine as there is no statutory basis for this rejection because neither 35 U.S.C. 101 nor 35 U.S.C. 171 can be applied against both claims. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). The “same invention” type of double patenting rejection, whether statutory or nonstatutory, cannot be overcome by a terminal disclaimer. *In re Swett*, 145 F.2d 631, 172 USPQ 72 (CCPA 1971).

¶ 15.23 35 U.S.C. 171 Double Patenting Rejection (Design – Design)

The claim is rejected under 35 U.S.C. 171 on the ground of double patenting of the claim in United States Design Patent No. [1].

¶ 15.23.01 35 U.S.C. 171 Provisional Double Patenting Rejection (Design – Design)

The claim is provisionally rejected under 35 U.S.C. 171 on the ground of double patenting of the claim in copending Application No. [1]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

¶ 15.24.07 Double Patenting Rejection (Design – Utility)

The claim is rejected under the judicially created doctrine of double patenting as being unpatentable over claim [1] of United States Patent No. [2]. See *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

¶ 15.24.08 Provisional Double Patenting Rejection (Design – Utility)

The claim is provisionally rejected under the judicially created doctrine of double patenting as being unpatentable over claim [1] of copending Application No. [2]. See *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

This is a provisional double patenting rejection because the claims have not in fact been patented.

¶ 15.24.01 35 U.S.C. 102(e) Rejection (Common Inventor or Assignee)

The claim is provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. [1] which has a common [2] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the conflicting copending application. This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the copending application was derived from the inventor of this application and thus not the invention “by another,” or by a showing of a date of invention of any unclaimed subject matter prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Examiner Note:

1. In bracket 2, insert ---inventor--- or ---assignee---

¶ 15.24.05 Identical Claim: Common Assignee

The claim is directed to the same invention as that of the claim of commonly assigned copending Application No. [1]. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved. Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly. Failure to comply with this requirement will result in a holding of abandonment of this application.

II. NONSTATUTORY DOUBLE PATENTING REJECTIONS

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

A nonstatutory double patenting rejection of the obviousness – type applies to claims directed to the *same inventive concept with different appearances which are obvious variations* of each other. The claimed designs are different in appearance but are not patentably distinct. Nonstatutory categories of double patenting rejections which are not the “same invention” type may be overcome by the submission of a terminal disclaimer.

The obviousness – type double patenting rejection must be based on the obviousness standard of 35 U.S.C. 103(a). That is, differences between the claimed designs must either be *de minimis* and unrelated to their overall aesthetic appearance or must be obvious to a designer of ordinary skill in the art related to the claimed design. If the claims are considered obvious under 35 U.S.C. 103(a), an obviousness – type double patenting rejection

must be made. While the earlier patent (if less than a year older than the application) or application is not technically "prior art", the principle involved is the same. *In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963)(see concurring opinion of Judge Rich).

A nonstatutory double patenting rejection may apply to claims directed to the *same inventive concept with differing scope*. The claimed designs are different in scope but are patentably indistinct. In determining whether to make this type of nonstatutory double patenting rejection, the examiner should compare the reference claim with the application claim. A rejection is appropriate if:

(A) The designs are of differing scope but patentably indistinct and are directed to the same inventive concept;

(B) Patent protection for the design, fully disclosed in and covered by the claim of the reference, would be extended by the allowance of the claim in the later filed application; and

(C) No terminal disclaimer has been filed.

This type of nonstatutory double patenting rejection in designs will occur between designs which may be characterized as a combination (narrow claim) and a subcombination/element thereof (broad claim). If the designs are patentably indistinct and are directed to the same inventive concept the examiner must determine whether the subject matter of the narrower claim is fully disclosed in and covered by the broader claim of the reference. If the reference does *not* fully disclose the narrower claim, then a double patenting rejection should not be made. The additional disclosure necessary to establish that the applicant was in possession of the narrower claim at the time the broader claim was filed may be in a title or special description as well as in a broken line showing in the drawings. If the broader claim of the reference does not disclose the additional subject matter claimed in the narrower claim, then applicant could not have claimed the narrower claim at the time the application with the broader claim was filed and a rejection under nonstatutory double patenting of the differing scope-type would be inappropriate.

A nonstatutory double patenting rejection may be made between a patent and an application or provisionally between applications. Such rejection over a patent should only be given if the patent issued less than a year after the filing date of the application. If the patent is

more than a year older than the application, the patent is considered to be "prior art" which may be applied in a rejection under 35 U.S.C. 102(b)/103(a). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing potential harm to the public by issuing a second patent, not to remove a patent as prior art. See MPEP § 804.

If the issue of double patenting is raised between a patent and a *continuing* application, examiners are reminded that this ground of rejection can only be made when the filing of the continuing application is voluntary and not the direct, unmodified result of restriction requirement under 35 U.S.C. 121. See MPEP § 804.01.

Examiners should particularly note that a design-design nonstatutory double patenting rejection does not *always* have to be made in both of the conflicting applications. For the most part, these rejections will be made in each of the conflicting applications; but, if the rejection is only appropriate in one direction, it is proper to reject only one application. The criteria for determining whether a one way obviousness determination is necessary or a two way obviousness determination is necessary is set forth in MPEP § 804. However, in design-utility situations, the majority opinion in *Carman Industries, Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983), appears to indicate that a two way obviousness determination is necessary for the rejection to be proper.

¶ 15.24.06 *Basis for Nonstatutory Double Patenting, "Heading Only"*

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Examiner Note:

This form paragraph must precede all nonstatutory double patenting rejections as a heading, except "same invention" type.

¶ 15.24 *Obviousness-type Double Patenting Rejection (Single Reference)*

The claim is rejected under the judicially created doctrine of the obviousness-type double patenting of the claim in United States Patent

No. [1]. Although the designs are not identical, they are not patentably distinct from each other because [2].

Examiner Note:

1. In bracket 1, insert prior U.S. Patent Number.
2. In bracket 2, an explanation is necessary.
3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ 15.24.03 *Provisional Obviousness—Type Double Patenting Rejection (Single Reference)*

The claim is provisionally rejected under the judicially created doctrine of the obviousness-type double patenting of the claim of copending Application No. [1]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [2]. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.
2. In bracket 2, an explanation is necessary.
3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ 15.67 *Rationale for 35 U.S.C. 103(a) Rejection (Single Reference)*

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability. See *In re Frick*, 275 F.2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

¶ 15.24.02 *35 U.S.C. 103(a) Rejection (Common Inventor or Assignee)*

The claim is provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. [1] which has a common [2] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting copending application. This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the copending application was derived from the inventor of this application and thus not the invention "by another," or by a showing of a date of invention of any unclaimed subject matter prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Examiner Note:

1. In bracket 2, insert -- inventor -- or -- assignee --.

¶ 15.25 *Obviousness—Type Double Patenting Rejection (Multiple References)*

The claim is rejected under the judicially created doctrine of the obviousness-type double patenting of the claim(s) in United States Patent No. [1] in view of [2]. At the time applicant made the invention, it would have been obvious to [3] as demonstrated by [4].

Examiner Note:

1. In brackets 3 and 4, insert explanation of basis for rejection.
2. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.68.

¶ 15.24.04 *Provisional Obviousness—Type Double Patenting Rejection (Multiple References)*

The claim is provisionally rejected under the judicially created doctrine of the obviousness-type double patenting of the claim of copending Application No. [1] in view of [2]. The claims are not patentably distinct from each other because [3]. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.
2. In bracket 2, insert secondary reference(s).
3. In bracket 3, insert an explanation.
4. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ 15.68 *Rationale for 35 U.S.C. 103(a) Rejection (Multiple References)*

This modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that one skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

¶ 15.24.09 *Double Patenting — Nonstatutory, Differing Scope (Based Solely on Improper Timewise Extension of Patent Rights) With A Patent*

The claim is rejected under the judicially created doctrine of double patenting over the claim of U.S. Patent No. [1] since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The [2] in the instant application is fully disclosed in the patent and the claims are not patentably distinct from each other. See *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965).

Furthermore, there is no apparent reason why applicant was prevented from presenting an embodiment corresponding to that of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 15.24.06.
2. Use this form paragraph only when the subject matter of the claim is fully disclosed in an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common) and the claims are not patentably distinct.
3. In bracket 1, insert the number of the patent.
4. In bracket 2, identify the common subject matter.

¶ 15.24.10 *Double Patenting — Nonstatutory, Differing Scope (Based Solely on Improper Timewise Extension of Patent Rights) With Another Application*

The claim is provisionally rejected under the judicially created doctrine of double patenting over the claim of copending Application No. [1] since the claim if allowed, would improperly extend the "right to exclude" granted in any patent that may issue on the copending application. This is a provisional double patenting rejection because the claims have not in fact been patented.

The [2] in the instant application is fully disclosed in the copending application and the claims are not patentably distinct from each other. See *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965).

Furthermore, there is no apparent reason why applicant would be prevented from presenting an embodiment corresponding to that of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 15.24.06.
2. Use this form paragraph only when the subject matter of the claim is fully disclosed in another copending application which is commonly owned or where there is common inventorship (one or more inventors in common) and the claims are not patentably distinct.
3. In bracket 1, insert the number of the conflicting application.
4. In bracket 2, identify the common subject matter.

Form Paragraphs 15.38 and 15.40.01 may be used in a second or subsequent action, where appropriate (see MPEP § 1504.02).

1504.10 Priority Under 35 U.S.C. 119 (a)–(d)

35 U.S.C. 172. *Right of priority.*

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

The provisions of 35 U.S.C. 119(a)–(d) apply to design patent applications. However, in order to obtain the benefit of an earlier foreign filing date, the United States application must be filed within 6 months of the earliest date on which any foreign application for the same design was filed. Design applications may not make a claim for priority of a provisional application under 37 CFR 1.78(a)(3).

¶ 15.01 *Conditions Under 35 U.S.C. 119(a)–(d)*

Applicant is advised of conditions as specified in 35 U.S.C. 119(a)–(d). An application for a design patent for an invention filed in this country by any person who has, or whose legal representatives have previously filed an application for a design patent, or equivalent protection for the same design in a foreign country which offers similar privileges in the case of applications filed in the United States, or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within six (6) months from the earliest date on which such foreign application was filed.

¶ 15.03 *Untimely Priority Papers Returned*

Receipt is acknowledged of the filing on [1] of a certified copy of the [2] application referred to in the oath or declaration. A claim for priority cannot be based on said application, since the United States application was filed more than six (6) months thereafter (35 U.S.C. 172). Accordingly, the papers are being returned.

The United States will recognize claims for the right of priority under 35 U.S.C. 119(a)–(d) based on applications filed under such bilateral or multilateral treaties as the “Hague Agreement Concerning the International Deposit of Industrial Designs” and the “Uniform Benelux Act on Designs and Models.” In filing a claim for priority of a foreign application previously filed under such a treaty, certain information must be supplied to the United States Patent and Trademark Office. In addition to the application number and the date of filing of the foreign application, the following information is required:

(A) the name of the treaty under which the application was filed,

(B) the name of at least one country other than the United States in which the application has the effect of, or is equivalent to, a regular national filing and

(C) the name and location of the national or inter-governmental authority which received the application.

¶ 15.02 *Right of Priority Under 35 U.S.C. 119(b)*

No application for design patent shall be entitled to the right of priority under 35 U.S.C. 119(b) unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the United States Patent and Trademark Office before the issue fee is paid, or at such time during the pendency of the application as required by the Commissioner not earlier than six (6) months after the filing of the application in this country. Such certification shall be made by the Patent Office, or other proper authority of the foreign country in which filed, and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language, and such other information as deemed necessary.

The notation requirement on design patent application file wrappers when foreign priority is claimed is set forth in MPEP § 202.03.

¶ 15.04 *Priority Under Bilateral or Multilateral Treaties*

The United States will recognize claims for the right of priority under 35 U.S.C. 119(a)–(d) based on applications filed under such bilateral or multilateral treaties as the Hague Agreement Concerning the International Deposit of Industrial Designs, and the Benelux Designs Convention. In filing a claim for priority of a foreign application previously filed under such a treaty, certain information must be supplied to the United States Patent and Trademark Office. In addition to the application number and the date of filing of the application, the following information is requested: (1) the name of the treaty under which the application was filed; (2) the name of at least one country other than the United States in which the application has the effect of, or is equivalent to, a regular national filing; and (3) the name and location of the national or international governmental authority which received such application.

¶ 15.52 *Examination of Priority Papers*

While the U.S. Patent and Trademark Office does not normally examine the priority papers to determine whether the applicant is in fact

entitled to the right of priority, in the case of a Design Patent application, the priority papers will normally be inspected to determine that the foreign application is in fact for the same invention as the application in the United States (35 U.S.C. 119). Inspection of the papers herein indicates that the prior foreign application was not for the same invention as claimed in this application. Accordingly, the priority claim is improper, and the papers are being returned.

Attention is also directed to the paragraphs dealing with the requirements where an actual model was originally filed in Germany (MPEP § 201.14(b)).

See MPEP Chapter 200 and 37 CFR 1.55 for further discussion of the practice and procedure under 35 U.S.C. 119(a)–(d).

1504.20 Benefit Under 35 U.S.C. 120

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] of design Application No. ———, filed ———.” should appear in the first line of the specification.

Attention is directed to the requirements for “continuing” applications set forth in MPEP § 201.07, § 201.08, and § 201.11. Note further that where the first application is found to be fatally defective under 35 U.S.C. 112 because of insufficient disclosure to support an allowable claim, a second design patent application filed as an alleged “continuation-in-part” of the first application to supply the deficiency is not entitled to the benefit of the earlier filing date. See *Hunt Co. v. Mallinckrodt Chemical Works*, 177 F.2d 583, 83 USPQ 277 (F.2d Cir. 1949) and cases cited therein. See also *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).

Unless the filing date of an earlier application is actually needed, for example, in the case of an interference or to avoid an intervening reference, there is no need for the examiner to make a determination in a continuation-in-part application as to whether the requirement of 35 U.S.C. 120 is met. Note the holdings in *In re Corba*, 212 USPQ 825 (Comm’r Pat. 1981).

Applicants are entitled to claim the benefit of the filing date of earlier applications for later claimed inventions under 35 U.S.C. 120 only when the earlier application discloses that invention in the manner required by 35 U.S.C. 112, first paragraph. Thus, a claim including limitations directed to the new matter added in a continuation-in-part application is not entitled to the benefit of the filing date of the parent application. See *In re Chu*,

66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).

¶ 15.74 Continuation—In—Part Caution

Reference to this application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Applicant is advised that design case law holds that any change in a previous design constitutes an entirely new design that cannot rely upon the earlier one for priority. See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). Therefore, an application that involves a change in the design from a prior application, as in the present case, cannot qualify as a CIP of the earlier application and is not entitled to benefit of its filing date. However, unless the filing date of the earlier application is actually needed, such as to avoid intervening prior art, the availability of the earlier filing date in this CIP application will not be considered. See *In re Corba*, 212 USPQ 825 (Comm’r Pat. 1981).

Examiner Note:

The following form paragraph should be used in the first action on the merits in any application which claims priority under 35 U.S.C. 120 as a continuation-in-part.

Where a continuation-in-part application claims benefit under 35 U.S.C. 120 of the filing date of an earlier application, a determination as to the propriety of this claim must be made if the earlier application claims the benefit of a foreign application under 35 U.S.C. 119(a)–(d). To determine the status of the foreign application, the charts in MPEP § 1504.02 should be used. If the conditions of 35 U.S.C. 120 are not met, then the claim for benefit of the earlier filing date under 35 U.S.C. 120 as a continuation-in-part should be denied and the claim for priority under 35 U.S.C. 119(a)–(d) should also be denied. If the foreign application for patent/registration has matured into a form of patent protection and would anticipate or render the claim in the alleged C-I-P application obvious, the design shown in the foreign application papers would qualify as prior art under 35 U.S.C. 102(d)/172 and the claim should be rejected under 35 U.S.C. 102/103.

¶ 15.75 Preface to Rejection in Alleged C-I-P Based on 35 U.S.C. 102(d)/172

Reference to this application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Applicant is advised that design case law holds that any change in a previous design constitutes an entirely new design that cannot rely upon the earlier one for priority. See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). Therefore, an application that involves a change in the design from a prior application, as in the present case, cannot qualify as a CIP of the earlier application and is not entitled to benefit of its filing date.

The parent application claimed foreign priority under 35 U.S.C. 119(a)–(d). Insofar as the foreign application has matured into a patent/registration more than six months before the filing date of the present application, it qualifies as prior art under 35 U.S.C. 102(d)/172.

Examiner Note:

This paragraph should be followed with a rejection under 35 U.S.C. 102 or 103(a) depending on the difference(s) between this claim and the design shown in the priority papers.

Where the conditions of 35 U.S.C. 120 are met, a design application may be considered a continuing application of an earlier utility application. Conversely, this also applies to a utility application relying on the benefit of the filing date of an earlier filed design application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).

In light of *KangaROOS USA, Inc. v. Caldor Inc.*, 778 F.2d 1571, 228 USPQ 32 (Fed. Cir. 1985) and *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981), the holdings in *In re Campbell*, 212 F.2d 606, 101 USPQ 406 (CCPA 1954) are no longer controlling.

Note also *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981) where the benefit of a design patent application filing date requested under 35 U.S.C. 120 was denied in the later filed utility application of the same inventor. The Court of Customs and Patent Appeals took the position that the design application did not satisfy 35 U.S.C. 112, first paragraph, as required under 35 U.S.C. 120.

¶ 15.26 Identification of Prior Application(s) in Nonprovisional Applications – Benefit of Priority Claimed

Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), the first line of the specification should include a reference to the prior application(s) from which benefit of priority is claimed. See 37 CFR 1.78. The following format is suggested: "This is a continuation (or division) of Application No. _____, filed _____, now (abandoned, pending or U.S. Patent No. _____)."

1505 Allowance and Term of Design Patent

35 U.S.C. 173. *Term of design patent.*

Patents for designs shall be granted for the term of fourteen years from the date of grant.

37 CFR 1.155. *Issue of design patents.*

If, on examination, it appears that the applicant is entitled to a design patent under the law, a notice of allowance will be sent to the applicant, or applicant's attorney or agent, calling for the payment of the issue fee (§ 1.18(b)). 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.

1509 Reissue of a Design Patent

See MPEP Chapter 1400 for practice and procedure in reissue applications.

For design reissue fee, see 37 CFR 1.16(h). For issue fee for issuing a reissue design patent, see 37 CFR 1.18(b).

The term of a design patent may not be extended by reissue. *Ex parte Lawrence*, 70 USPQ 326 (Comm'r Pat. 1946).

1510 Reexamination

See MPEP Chapter 2200 for practice and procedure for reexamination applications.

1511 Protest

See MPEP Chapter 1900 for practice and procedure in protest.

1512 Relationship Between Design Patent, Copyright, and Trademark

I. DESIGN PATENT/COPYRIGHT OVERLAP

There is an area of overlap between copyright and design patent statutes where the author/inventor can secure both a copyright and a design patent. Thus an ornamental design may be copyrighted as a work of art and may also be subject matter of a design patent. The author/inventor may not be required to elect between securing a copyright or a design patent. See *In re Yardley*, 493 F.2d 1389, 181 USPQ 331. In *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (1954), the Supreme Court noted the election of protection doctrine but did not express any view on it since a design patent had been secured in the case and the issue was not before the Court.

See Form paragraph 15.55 which repeats this information.

II. INCLUSION OF COPYRIGHT NOTICE

It is the policy of the Patent and Trademark Office to permit the inclusion of a copyright notice in a design patent application, and thereby any patent issuing therefrom, under the following conditions.

(A) A copyright notice must be placed adjacent to the copyright material and, therefore, may appear at any appropriate portion of the patent application disclosure including the drawing. However, if appearing on the drawing, the notice must be limited in print size from 1/8 inch to 1/4 inch and must be placed within the "sight" of the drawing immediately below the figure representing the copyright material. If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under 37 CFR 1.84.

(B) The content of the copyright notice must be limited to only those elements required by law. For

example, "© 1983 John Doe" would be legally sufficient under 17 U.S.C. 401 and properly limited.

(C) Inclusion of a copyright notice will be permitted only if the following waiver is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

A portion of the disclosure of this patent document contains material to which a claim for copyright is made. The copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but reserves all other copyright rights whatsoever.

(D) Inclusion of a copyright notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR 1.312 have been satisfied.

Any departure from these conditions may result in a refusal to permit the desired inclusion. If the waiver required under condition (C) above does not include the specific language "(t)he copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records . . ." the copyright notice will be objected to as improper.

See Form paragraph 15.55 which repeats this information.

The files of design patents D-243,821, D-243,824, and D-243,920 show examples of an earlier similar procedure.

III. DESIGN PATENT/TRADEMARK OVERLAP

A design patent and a trademark may be obtained on the same subject matter. The CCPA, in *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 USPQ 575 (CCPA 1964), later reaffirmed by the same court at 372 F.2d 593, 152 USPQ 593 (CCPA 1967), has held that the underlying purpose and essence of patent rights are separate and distinct from those pertaining to trademarks, and that no right accruing from one is dependent or conditioned by the right concomitant to the other.

See Form paragraph 15.55.01 which repeats this information.

IV. INCLUSION OF TRADEMARKS IN DESIGN PATENT APPLICATIONS

A. Specification

The use of trademarks in design patent application specifications is permitted under limited circumstances. See MPEP § 608.01(v). This section assumes that the proposed use of a trademark is a legal use under Federal trademarks law.

B. Title

It is improper to use a trademark alone or coupled with the word "type" (e.g., Band-Aid type Bandage) in the title of a design. Examiners must object to the use of a trademark in the title of a design application and require its deletion therefrom.

C. Drawings

When a trademark is used in the drawing disclosure of a design application, the following statement must be included in the specification after the figure descriptions: --The (identify trademark material) forming part of the claimed design is a registered trademark of (identify trademark owner).--

Any derogatory use of a trademark in a design application is prohibited and will result in a rejection of the claim under 35 U.S.C. 171 as being offensive and, therefore, improper subject matter for design patent protection. Cf. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 USPQ 161 (2d Cir. 1979) and *Coca-Cola Co. v. Gemini Rising Inc.*, 346 F. Supp. 1183, 175 USPQ 56 (E.D.N.Y. 1972).

1513 Miscellaneous

With respect to copies of references supplied to applicant in a design patent application, see MPEP § 707.05(a).

Effective May 8, 1985, the Statutory Invention Registration (SIR), 35 U.S.C. 157, and 37 CFR 1.293 - 1.297 replaced the former Defensive Publication Program. The Statutory Invention Registration (SIR) Program applies to utility, plant, and design applications. See MPEP Chapter 1100.
