Chapter 1500 Design Patents

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. (35 U.S.C. 171)

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

1502 Definition of a Design

The design of an object consists of the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates a visual impact upon the mind of the observer.

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

Design is inseparable from the object 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.
(35 U.S.C. 112, first and second paragraphs).

¶ *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 object, to the surface ornamentation on the object or both.

1502.01 Distinction Between Design and Utility Patents [R–1]

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 is not easily separable. Invention is a blend of function and ornamental design. Articles of manufacture typically possess both functional and ornamental characteristics.

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

1. 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).

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

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

4. 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 § 1510.01).

5. 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.

6. 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.

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). However, unlike the latter, a preamble still remains a requirement in a design patent application, and 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 § 1503.01.

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

1503.01 Specification and Claim

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 specification.

The following order of arrangement should be observed in framing design specifications:

(a)Preamble, stating name of the applicant and title of the design.
(b)Description of the figure or figures of the drawing.
(c)Description, if any.
(d)Claim.
(e)Signed oath or declaration (See § 1.153(b)).

¶ *15.05 Design Patent Application Arrangement*

The following order of arrangement should be observed in framing design patent applications:

(a) Preamble, stating the name of the applicant and the title of the design.
(b) Description of the figure or figures of the drawings.
(c) Description, if any.
(d) Claim.
(e) Signed oath or declaration (See 37 CFR 1.153(b)).

PREAMBLE

The preamble must state the name of the applicant and the title of the design (37 CFR 1.153−1.154).

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 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 aids 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. Thus, applicants are encouraged to provide a specific and descriptive title.

Following are examples of preferred and non−preferred titles:

Preferred Title:	Rather than:
Stove	Heating Device
Vacuum Bottle	Bottle
Microwave Oven	Cooking Appliance
Alarm for an Automobile	Electronic Device

Since 37 CFR 1.153 requires that the title must designate the particular article, and since the particular article is defined by the claim, 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). 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 § 1505.03).

Any amendment to the language of the title must also be made in both the title and the claim. It is preferable (but not required) that the amended language also be incorporated into the figure description. However, it is not necessary to submit a new oath or declaration merely to obtain correspondence in terminology between the title, claim, and the oath or declaration.

¶ *15.05.1 Title of Design Invention*

The title of an article being claimed in a design patent must correspond to the name of the article shown in solid lines in the drawings.

¶ *15.59 Amend Title*

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

Examiner Note:

In bracket 2, insert "must be" or "has been."

DESCRIPTION

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. 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.

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

1. Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure.

2. Statement indicating that any broken line illustration in the drawing disclosure is not part of the design sought to be patented.

3. Description denoting the nature and environmental use of the claimed design.

It is the policy of the Office to attempt to resolve questions about the nature and intended use of the claimed design prior to examination by making a Requirement for Information (see Form Paragraph 15.56) 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. See MPEP §1506. It may alternately, at applicant's option, be submitted in a separate paper without amendment of the specification.

4. A "characteristic features" statement describing a particular feature of the design that is considered a feature of novelty or non-obviousness over the prior art (37 CFR 1.71(c)).

¶ *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 as ""The characteristic feature" of the design resides in [brief but accurate description] or, if combined with one of the figure descriptions, in terms such as the characteristic feature of which resides in [2 brief but accurate description]. 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. (*McGrady* v. *Aspenglas Corp.. et al.* 208 USPQ 242).

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. See *Ex parte Remington*, 114 O.G. 761, 1905 C.D. 28 (Comm'r Pat. 1904); *In re Blum*, 153 USPQ 177 (CCPA 1967).
b. Statements which describe or suggest modifications of the claimed design which are not illustrated in the drawing disclosure.
c. Statements describing matters which are constructions unrelated to the design.

¶ *15.60 Amend All Figure Descriptions*

For [1 insert reason] the figure descriptions [2] amended to read: [3].

Examiner Note:

In bracket 2, insert "must be" or "have been".

¶ *15.61 Amend Selected Figure Descriptions*

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

Examiner Note:

In bracket 3, insert "must be" or "have been."

1503.02 Drawing

37 CFR 1.152.Design drawing.

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 article. Appropriate surface shading must be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent 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. Photographs and ink drawings must not be combined 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. Color drawings and color photographs are not permitted in design patent applications.

Every design patent application must include a drawing. It is of utmost importance that the drawing clearly show the complete ornamental appearance of the entire article such that nothing is left to conjecture.

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:

A. Views

Normally, drawing figures should be provided showing the article, at a minimum, from each of its six normal views. Additional perspective views should also be provided if helpful in disclosing the design.

Views that are merely duplicative of other views of the article or that are merely plain and include no ornamentality may be omitted from the drawing if the specification makes this explicitly clear. See MPEP § 1503.01. For example, if the left and right sides of an article 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/sym- metrical; if the bottom of an article has a plain bottom, a view of the bottom may be omitted if the specification includes a statement that the bottom is plain and unornamented.

While a sectional view which more clearly brings out elements of the design is permissible (see *Ex parte Lohman*, 1912 CD 336, 184 OG 287 (Comm'r Pat. 1912)), a sectional view presented to show functional features or for exhibiting mechanical features or interior structure not part of the design should be rejected under 35 U.S.C. 112, paragraph 2.

B. Surface Shading

The drawing should be appropriately surface shaded to show clearly the character and contour of all surfaces of any 3–dimensional aspects of the design 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 indefinite under 35 U.S.C. 112. Additionally, if the surface shape is not evident from the disclosure as filed, the addition of surface shading after filing may comprise new matter and may prevent the applicant from obtaining priority under 35 U.S.C. 120 of any continuation–in–part filed to correct the defect in the original application.

C. Broken Lines

Structure that is not part of the claimed design but is considered necessary to show the environment in which the article is used may be represented in the drawing in broken lines. Additionally, a portion of an article that is not considered part of the design may be shown in broken lines, *In re Zahn*, 204 USPQ 988 (CCPA 1980). A broken line showing is for illustrative purposes only and forms no part of the claimed design.

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*, 852 O.G. 1045, 153 USPQ 177 (CCPA 1967). 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, 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.

D. Surface Indicia

The ornamental appearance of an article includes its shape and configuration as well as any indicia, lettering, or other ornamentation embodied in the article ("surface indicia"). Surface indicia must be embodied in an article of manufacture. Surface indicia, per se (i.e., not

embodied in a specific article of manufacture) is not proper subject matter for a design patent under 35 U.S.C. 171. See MPEP § 1507.

Surface indicia shown in a design drawing 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.

However, if the original disclosure of an application, taken as a whole, indicates that the inventor intended surface indicia to be merely exemplary or non-limitative, the examiner may afford applicant the opportunity to remove the surface indicia from the design or to show the indicia in broken lines. For example, lettering on an article that is described in the specification as merely exemplary of any lettering that could be applied to the article may be amended to be shown in broken lines without raising the issue of new matter.

If the original drawing shows surface indicia, and the disclosure, taken as a whole, does not indicate that the inventor considered the indicia to be merely optional or exemplary, an amendment canceling the indicia (or showing the indicia in broken lines) would comprise new matter.

If the examiner is uncertain from the application, as filed, whether the inventor considered any surface indicia to be part of the design or merely exemplary of other indicia, the examiner may require the actual inventor to provide an oath or declaration attesting to whether the indicia was considered a part of the claimed design. It is appropriate to request such information directly from the inventor since only the actual named inventor is directly aware of his or her actual inventive intent.

E. Photographs

Drawings are normally required to be submitted in black ink on white paper, 37 CFR 1.84(a). Photographs are normally not permitted in design patent applications.

However, the Office will accept black and white photographs in design patent applications only after granting a petition filed under 37 CFR 1.84(b)(1) requesting that photographs be accepted. Petitions to accept photographs as drawings will be considered by the Supervisory Patent Examiner and will be granted if the appropriate fee set forth in 37 CFR 1.17(h) has been included and the three sets of photographs required under 37 CFR 1.84(b)(1)(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 content of the drawing.

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 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.

Color drawings and color photographs will not be accepted under any conditions in design patent applications. See 37 CFR 1.152.

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.

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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 as specified in the Title of the Invention)* 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.

When there is a properly included special description of the design in the specification (see MPEP §1503.01), 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 should read "The ornamental design for (*the article as specified in the Title of the Invention*) 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 dotted lines. There are no portions of the claimed design which are immaterial or unimportant, and elements shown in dotted lines in the drawing are not part of the claim. See MPEP §1502.03(c) and *In re Blum*, 852 O.G. 1045, 153 USPQ 177 (CCPA 1967).

¶ *15.45 Photographs as Informal Drawings*

For filing date purposes, in those design patent applications filed with photographs for drawings contrary to the requirement for ink drawings, the Application Division has been authorized to construe the photographs as informal drawings, rather than to hold the application incomplete as filed. By so doing, the Patent and Trademark Office can accept 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 as such, the fee under 37 CFR 1.17(h), and three sets of the photographs must be filed. Before the photographs in this application can be treated as formal drawings, applicant must submit [1].

Examiner Note:

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

¶ *15.57 Not–Entered Drawings Returned*

The non–entered drawings 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)).

1504 Examination

In design patent applications, as in utility patent applications, novelty and unobviousness are necessary prerequisites to the grant of a patent. In the case of a design, the inventive novelty or unobviousness resides in the shape or configuration and/or surface ornamentation of the subject matter which is claimed. This is in contradistinction to the evaluation of novelty and nonobviousness in utility patent applications, which involves evaluation of such factors as the operation, function, advantages, and properties of the article.

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.

1504.01 Statutory Subject Matter for Designs

A. Icons and Surface Indicia

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: (1) a design for an ornament, impression, print, or picture applied to an article of manufacture (surface indicia); (2) a design for the shape or configuration of an article of manufacture; and (3) 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 (37 CFR 1.152), the design must be shown applied to an article of manufacture.

A claim to a picture, icon, 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.

B. Functionality vs. Ornamentality

A design for an article of manufacture that is dictated purely by the function of the article lacks ornamentality and should be rejected under 35 U.S.C. 171. See *In re Carletti*, 328 F.2d 10, 140 USPQ 653 (CCPA 1964); *Power Control Corp.* v. *Hybrinetics, Inc.*, 806 F.2d 234, 231 USPQ 774 (Fed. Cir. 1986).

The examiner shall, upon making a *prima facie* showing that the design of an article is dictated by its function, make a rejection under 35 U.S.C. 171 that the design lacks ornamentality. Such a rejection is rebuttable through presentation of evidence of ornamentality, such as an affidavit by the actual inventor attesting to the ornamental concerns in making the invention and a showing of how the function of the article can be accomplished by substantively different designs. Mere arguments by the attorney of record are of little value in establishing ornamental intent on the part of the inventor. Upon submission of any evidence of ornamentality, the examiner must reevaluate all the evidence anew and

make a new determination whether the evidence of ornamentality is sufficient to overcome the *prima facie* showing of lack of ornamentality.

C. Hidden in Use

A design for an article of manufacture that is hidden in its ultimate end use, where there is no evidence that its ornamental appearance was of commercial concern prior to reaching its ultimate end use, lacks ornamentality and should be rejected under 35 U.S.C. 171. See *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949).

However, a design directed to an article of manufacture that is hidden in its ultimate end use may be proper subject matter for a design patent if there is some period in the commercial life of the design when its ornamentality has been shown to be a matter of concern. See *In re Webb*, 916 F.2d 1553, 16 USPQ2d 1433 (Fed. Cir. 1990).

The examiner shall, upon making a *prima facie* showing that an article is hidden in its ultimate end use and absent any evidence that the ornamentality was of actual concern to prospective purchaser of the article, make a rejection under 35 U.S.C. 171 that the design lacks ornamentality. Such a rejection is rebuttable through presentation of objective evidence of ornamentality, such as a showing that ornamentality of the article was of commercial concern during the period of commercial life between its manufacture and ultimate hidden end use. A showing that the actual appearance of the article (or a similar article) is advertised or displayed to prospective customers may comprise evidence that its ornamentality might be of actual concern. Affidavits or declarations from actual customers attesting that ornamentality of the article was of actual concern to them during the commercial life of the article would comprise stronger evidence. Upon submission of any objective evidence of ornamentality, the examiner must reevaluate all the evidence anew and make a new determination whether the objective evidence of ornamentality is sufficient to overcome the *prima facie* showing of lack of ornamentality.

¶ *15.08 35 U.S.C. 171 Rejection as Purely Functional*

The claim is rejected under 35 U..S.C. 171 as not meeting the requirements of ornamentality, the subject matter being obviously the result of purely functional considerations.

¶ *15.09 35 U.S.C. 171 Rejection*

The claim is rejected under 35 U..S.C. 171 for the reason that [1].

Examiner Note:

A rejection on the ground of lack of ornamentality includes the more specific grounds of functionality, frivolity, fraud, contrary to public policy. The statutory basis for this rejection is 35 U.S.C. 171. (See MPEP Chapter 1500). Also, identify the specific ground(s) not complied with and give reasons why.

¶ *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.

¶ *15.44 Design Inseparable From Object to Which Applied*

Design is inseparable from the object 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. (35 U.S.C. 171; 35 U.S.C. 112, first and second paragraphs.)

D. 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 not meeting the requirements of ornamentality under 35 U.S.C. 171. Form Paragraph 15.10 should be used.

¶ *15.10 Frivolous, Offensive Subject Matter*

The disclosure and therefore the claim in this application is rejected as being frivolous and against public policy and therefore improper subject matter for design patent protection under 35 U.S.C. 171. Such subject matter is not seen to meet the requirements of ornamentality under 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 or caricatures in the disclosure, drawing and/or 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 Section 608 of the Manual of Patent Examining Procedure).

1504.02 Novelty

If the prior art discloses any article of substantially the same appearance as that of the claimed design, it is immaterial in the evaluation of novelty what the use of such an article is. Stated differently, it is not necessary that the claimed design and prior art article be from "analogous arts" when evaluating novelty.

In determining novelty with respect to design patents, the standard recognized by the courts is whether the prior art shows an article of "substantially the same appearance" to an ordinary observer. Absolute identity of design is not required to support a rejection for lack of novelty under 35 U.S.C. 102. See *In re Glavas*, 109 USPQ 50, 52 (CCPA 1956).

In evaluating a statutory bar based on 35 U.S.C. 102(b), the case law indicates that the experimental use exception to a statutory bar for public use or sale (see MPEP § 2 128.01) does not apply for designs patents. See *In re Mann*, 861 F.2d 1581, 8 USPQ2d 2030 (Fed. Cir. 1988).

Registration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119 and 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster et al.* 833 O.G. 8, 1966 C.D. 20 (Bd. App. 1965); *Ex parte Marinissen*, 842 O.G. 528, 155 USPQ 528 (Bd. App. 1966); *Appeal No. 239–48, Decided April 30, 1965*, 833 O.G. 10, 1966 C.D. 22 (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. For example, under the German Law (Federal Republic of Germany), Industrial Designs are called Geschmackmusters and the grant of protection is effective from the day the application for registration is filed, *In re Talbott*, 170 USPQ 281 (CCPA 1971) and *Ex parte Weiss*, 159 USPQ 122 (Bd. App. 1967). Like the British Law, the Swedish Law requires an application to be subject to examination to establish whether requirements for registration of the design are satisfied. See *In re Monks*, 200 USPQ 129 (CCPA 1978). A design patent does not gain legal force, under Swedish Law, for purposes of 35 U.S.C. 102(d), until registration is granted, following publication of the application, even though Swedish Law provides for recovery of damages for unauthorized exploitation during the application's pendency. See *Ex parte Lander*, 223 USPQ 687 (Bd. App. 1983).

¶ *15.11 35 U.S.C. 102(a) Rejection*

The claim is rejected under 35 U.S.C. 102(a) as 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.

¶ *15.12 35 U.S.C. 102(b) Rejection*

The claim is rejected under 35 U.S.C. 102(b) as 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 sale in this country more than one 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) Rejection*

The claim is rejected under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172, as 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 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 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.

1504.03 Nonobviousness

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

A. Gathering the Facts

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

1. Determining the scope and content of the prior art;

2. Ascertaining the differences between the claimed invention and the prior art;

3. Resolving the level of ordinary skill in the art; and

4. Evaluating any objective evidence of nonobviousness (i.e., so–called "secondary considerations").

1. Scope of the Prior Art

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

While the determination of whether arts are analogous is basically the same for both design and utility inventions, the case law (*In re Glavas*, 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 as distinguished from utility 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 articles 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.

2. Differences Between the Prior Art and the Claimed Design

Differences between the claimed design and the prior art may comprise those of surface indicia or of shape or form of the article of manufacture embodying the design. Note that whether any particular ornamentation is embossed on or impressed in the surface to which it is applied is considered a matter of choice well within the skill of the ordinary designer. See *In re Cornwall* 109 USPQ57 (CCPA 1956). 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. If any differences are considered *de minimis* or inconsequential from a design viewpoint, the rejection should so state.

3. Level of Ordinary Skill in the Art

In order to be unpatentable, 35 U.S.C. 103 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 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 1216, 211 USPQ 782, 784 (CCPA 1981); *In re Carter*, 213 USPQ 625 (CCPA 1982).

4. 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 just as in a utility 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.

B. *Prima Facie* Obviousness

Once the factual inquiries mandated under *Graham* v. *Deere* have been made, the examiner must determine whether they support a conclusion of *prima facie* obviousness.

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).

The procedure for evaluating *prima facie* obviousness of a design is set forth in *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982). *Rosen* states, essentially, that it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration. *Rosen* additionally states, on a procedural level, that the examiner must first provide "a reference, a something in existence, the design characteristics of which are basically the same as the claimed design." (213 USPQ at 350).

Such a basic reference (commonly called a "*Rosen* reference") is not required to be identical in all minutiae to the claimed design. The design of the article in the

"*Rosen* reference" need only possess design characteristics which are "basically the same as the claimed design." *Rosen*, supra. Once a reference meets the test as a "*Rosen* reference," ornamental features may reasonably be interchanged with or added from those of other references so long as the references "are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." *In re Rosen*, 213 USPQ at 350, quoting *In re Glavas*, 109 USPQ 50, 52 (CCPA 1956).

C. Rebuttal of the Prima Facie Case

In design cases as in utility cases, once a *prima facie* case of obviousness has been established, the examiner must consider any additional objective evidence of nonobviousness and/or rebuttal evidence offered by applicant.

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

The claim is rejected under 35 U.S.C. 103 as 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.

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

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

Although the invention is nor identically disclosed or described as set forth in section 102 of the statute, 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.

¶ *15.19.1 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*

The claimed design is patentable over the references cited.

1504.04 Considerations Under 35 U.S.C. 112

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). This description is incorporated into the claim by use of the language "as shown and described." See MPEP § 1503.03.

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 an inadequate disclosure and/or a rejection of the claim under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the design.

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:

1. Use of phrases in the claim such as "substantially as shown," "or similar article," "or the like,"or equivalent terminology.

2. The designation of the design as collectively shown in the drawing, referenced in the title and described in the specification is such that it can not be determined what article of manufacture is being claimed. For example, a design claimed as an "Adapter Ring" in which there are no distinguishing features in the drawing to identify the field of endeavor of the article.

¶ *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 paragraph or the second paragraph of 35 U.S.C. 112 are preferred. This paragraph should only be used when either the first or 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.

¶ *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 applicant regards as the invention.

Examiner Note:

1. Use this paragraph when claims are vague, indefinite, confusing, incorrect or cannot be understood.
2. Add a full explanation of the rejection.
3. See also form paragraph 17.07

¶ *15.21.1 35 U.S.C. 112 (Paragraph 2) Rejection*

The claim is rejected as failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112, second paragraph. The designation of the design is too broad for the examiner to make a proper examination of the claim per 37 CFR 1.104.

Applicant is therefore required to provide a sufficient explanation of the design regarding its nature and intended use so that a proper classification and reliable search can be made. Additional information, if available, regarding fields of search, pertinent prior art, advertising brochures and the filing of copending utility applications would also be helpful. If a utility application has been filed, please furnish its serial 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:

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

¶ *15.56 Request for Information*

A preliminary review of this application indicates that the designation of the article claimed is so broad that it will be difficult for the examiner to make a proper examination of the claim as required by 37 CFR 1.04.

Please provide sufficient explanation to the claimed design invention 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 response. Attention is also directed to 37 CFR 1.56 and the procedure in section 609 of the Manual of Patent Examining Procedure 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 on such 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 37 CFR 1.101, MPEP 708.

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

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.

New Matter

In design patent applications, as in applications filed under 35 U.S.C. 101, additional or amended illustrations involving new matter is in violation of 35 U.S.C. 132; 37 CFR 1.118.

In a design patent application, deletion of portions of the original design may constitute new matter if the original application as filed did not contain a disclosure that the deleted information was not part of the design. See MPEP § 1503.02(d).

If new matter is added to the disclosure, the claim should be rejected under 35 U.S.C. § 112, paragraph one, as lacking support in the original disclosure. See Form Paragraph 15.51. If new matter is added to the description or drawing, the specification should be objected to under 35 U.S.C. 132. See Form Paragraph 7.28.

While amendments involving new matter are ordinarily entered, such matter is required by the examiner to be canceled from the specification, and the claim is rejected under 35 U.S.C. 112, first paragraph. While amended drawings containing new matter are not ordinarily entered in utility applications (see MPEP § 608.04), since the drawing in a design application is part of the claim, amended drawings in design cases involving new matter are entered; the drawing should be objected to under 35 U.S.C. 132, the new matter should be required to be canceled, and the claim should be rejected under 35 U.S.C. 112, first paragraph. (See *In re Rasmussen*, 211 USPQ 323 (CCPA 1981.)

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

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.

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 to avoid introduction of a lack of clarity as to what is being claimed. Therefore, the design patent examiner will require restriction in each 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.

1504.05

A. Independent Inventions

Design inventions are independent if there is no apparent relationship between two or more subjects disclosed in the drawings; that is, they are unconnected in overall appearance; 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 subjects.

B. Distinct Inventions

Design inventions are distinct if the overall appearance of two or more embodiments as disclosed in the drawings are related, for example, two embodiments of a vase, and are patentable (novel or 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. On the other hand, if nondistinct inventions are claimed in separate design patent applications, the issue of double patenting must be raised. Note MPEP § 806.05and 1504.06. In determining the question of distinctness under 35 U.S.C. 121 in a design patent application, a search of the prior art may be necessary.

1. Multiple Embodiments

It is permissible, in a proper case, 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 Rubinfied*, 123 USPQ 210, 1959 C.D. 412 (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 § 1503.01. The specification should make clear that multiple embodiments are disclosed and may particularize the differences between the embodiments.

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

This application contains the following separate embodiments of the disclosed design:

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 involve a single inventive concept. *In re Rubinfield*, 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. *In re Platner*, 155 USPQ 222.

The above disclosed embodiments define the following distinct groups of inventions:

Group I: Embodiment [3]
Group II: Embodiment [4]

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

A response to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. Any response that does not include election of a single group will be held non-responsive. Applicant is also requested to direct cancellation of all drawing figures directed to non-elected 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 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. No argument asserting patentability based on features of other embodiments will be considered once those embodiments have been determined to comprise a single inventive concept.

A shortened statutory period of THIRTY DAYS from the date of this letter is set for applicant to elect a single embodiment for prosecution on the merits.

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

This application contains the following separate embodiments of the disclosed design:

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 involve a single inventive concept. *In re Rubinfield*, 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. *In re Platner*, 155 USPQ 222.

The above disclosed embodiments define the following distinct groups of inventions:

Group I: Embodiment [3]
Group II: Embodiment [4]

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

During telephone discussion with [5] on [6], a provisional election was made [7] traverse to prosecute the invention of Group [8]. Affirmation of this election should be made by applicant in responding to this Office action.

Group [9] is withdrawn from further consideration by the examiner, 37 CFR 1.42(b), as being for a non-elected invention.

Examiner Note:

1. In bracket 7, insert "with" or "without".

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

Applicant is advised that the response 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.

2. Segregable Parts — Combination/Subcombination

A design patent covers the entire design as a whole. It is not limited to any part or portion of the design. Under the so-called doctrine of segregable parts, the design in its entirety (i.e., the combination) is distinct from parts thereof (i.e., any subcombination). See *Ex parte Sanford*, 1914 CD 69; 204 O.G. 1346 (Comm'r Pat. 1914), and *Blumcraft of Pittsburgh* v. *Ladd, Comr. Pats*, 144 USPQ 562 (D.D.C. 1965). Since separate inventions directed to a combination and subcombination thereof require separate claims, restriction to one or the other is necessary in a design patent application. See *Ex parte Heckman*, 135 USPQ 229 (PO Super. Exam. 1960); *In re Kelly*, 200 USPQ 560 (Comm'r Pat. 1978).

¶ *15.29 Restriction Under 35 U.S.C. 121, Segregable Parts*

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

Group I — Figures [1] drawn to a [2].
Group II — Figures [3] drawn to a [4].

Examiner Note:

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 in an entirety, and does not extend to segregable parts: the only way to protect such segregable parts is to apply for separate patents (*Ex parte Sanford*, 1914 C.D. 69; 204 O.G. 1346 and *Blumcraft of Pittsburgh v. Ladd*, Comr., 144 USPQ 562.). It is further noted that combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. (*In re Rubenfield*, 123 USPQ 210).

Examiner Note:

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 response 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.

Applicant is given 30 days from the date of this letter to make an election to avoid a question of abandonment.

¶ *15.30 Restriction Under 35 U.S.C. 121 (Segregable Parts) (Telephonic)*

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

Group I – Figures [1] drawn to a [2].
Group II – Figures [3] drawn to a [4].

Examiner Note:

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 segregable parts: the only way to protect such segregable parts is to apply for separate patents *Ex parte Sandford*, 1914 C.D. 69; 104 O.G. 1346 and *Blumcraft of Pittsburgh v. Ladd*, Comr., 144 USPQ 562. It is further noted that combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. (*In re Rubenfield*, 123 USPQ 210).

Examiner Note:

Add comments if necessary.

During a telephone discussion with [5] on [6], a provisional election was made [7 (with traverse, without traverse) to prosecute the invention of Group [8]. Affirmation of this election should be made by applicant in responding to this Office action.

Group [9] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a non-elected 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 non-elected invention, the requirement having been traversed in Paper No. [2].

¶ *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 non-elected invention. Election was made without traverse in Paper No. [2].

¶ *15.37 Cancellation of Non-elected 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 non-elected without traverse and without right to petition in Paper No. [2], said groups have been cancelled.

1504.06 Double Patenting

There are two types of double patenting rejections which apply in the examination of design patent applications as in the examination of "Utility" applications — the "same invention"-type and the "obviousness"-type. See MPEP § 804. Double patenting may exist (1) between two or more design patent applications and/or patents and (2) between a design patent application and a "utility" application and/or patent.

A. Design — Design Double Patenting

The "same invention"-type double patenting rejection in design — design situation is based on 35 U.S.C. 171 which states in the singular that an inventor "may obtain a patent." This has been interpreted as meaning only one patent thus prohibiting twice claiming the same invention, see *In re Thorington*

et al. 163 USPQ 644 (CCPA 1969), *In re Geiger et al.* 165 USPQ 572 (CCPA 1970). This type of double patenting rejection cannot be overcome by terminal disclaimer (see MPEP § 804.02).

The "obviousness–type" double patenting rejection in design — design situations procedurally the same as where two utility cases are involved.

B. Design—Utility Double Patenting

A utility patent and a design patent may be based on the same matter; however, there must be clear patentable distinction between them.

Where the design invention as defined by the claim as shown in the drawing views and the utility invention as defined by the claim language cross read, double patenting exists. This involves the same invention–type double patenting: See *Adidas Fabrique* v. *Andsmore Sportswear Corp.*, 223 USPQ 1109 (D.C. S.D. N.Y. 1984); *Wahl et al.* v. *Rexnord, Inc.*, 206 USPQ 865 (3d Cir.1980); *Transmatic, Inc.* v. *Gulton Industries Inc.*, 202 USPQ 559 (6th Cir. 1979)).

The Court of Appeals for the Federal Circuit in *Carmen Industries Inc.* v. *Wahl et al.* 220 USPQ 481 (Fed. Cir. 1983) also supports the broader test of double patenting between design and utility claims based on obvious variations. This type of double patenting rejection may be overcome by a terminal disclaimer where same inventive entities or common ownership exist (See MPEP § 804.02.)

¶ *15.23 35 U.S.C. 171 Double Patenting Rejection*

The claim is rejected under 35 U.S.C. 171 on the ground of double patenting of the claim in applicant's prior U.S. patent no. [1].

¶ *15.24 Obviousness Double Patenting Rejection (Sole Reference)*

The claim is rejected under the judicially created doctrine of the obviousness–type double patenting of the claim in applicant's [1]. Although the designs are not identical, they are not patentably distinct from each other because [2]. The obviousness type double patenting rejection is judicially established doctrine based on public policy and is primarily intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP § 1490), *In re Vogel*, 164 USPQ 619.

Examiner Note:

In bracket 1, insert - copending application or - prior U.S. Patent No. In bracket 2, add explanation if necessary.

¶ *15.25 Obviousness 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 applicant's prior U.S. patent no. [1] in view of [2]. At the time the applicant made the invention, it would have been obvious to [3 examiner expand] as demonstrated by [4].

The obviousness type double patenting rejection is judicially established doctrine based on public policy and is primarily intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent. (*In re Vogel*, 164 USPQ 619).

A timely filed terminal disclaimer will obviate this rejection. (MPEP § 1490).

1504.10 Priority Under 35 U.S.C. 119 >(a)–(d)< [R–1]

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 also 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 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 country, if the application in this country is filed within six months from the earliest date on which such foreign application was filed.

¶ *15.03 Acknowledge Receipt and Notice of Return of Untimely Priority Papers*

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 months thereafter. (35 U.S.C. 172). The papers are accordingly 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 trea-

ties 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: (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 intergovernmental 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 U.S. 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 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 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 he deems 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 U.S. 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 the application.

¶ *15.52 Examination of Priority Papers*

While the U.S. Patent and Trademark Office does nor normally examine the priority papers to determine whether the applicant is in fact entitled to the right of priority, in cases 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 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 1.78 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 [R-1]

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 specification, either before or after the description of the drawing figures.

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,* 83 USPQ 277 at 281 (2d Cir. 1949) and cases cited therein). See also *In re Salmon et al.* 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 intervening reference, there is no need for the examiner to make a determination 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).

In both utility and design applications, 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.

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.

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

Note also *In re Berkman*, 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 Rule 60 (37 CFR 1.60) Requirement*

Applicant is reminded of the following requirement:

In 37 CFR 1.60 cases, applicant, in the amendment cancelling the non-elected inventions, should include directions to enter "This is a [1 (continuation) (division)] of ** >Application< No. [2], filed [3]" as the first sentence of the specification following the preamble.

1505 Allowance and Term of Design Patent [R-1]

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 and term of design patents.

(a) If, on examination, it shall appear that the applicant is entitled to a design patent under the law, a notice of allowance will be sent to 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 3 months of the date of the notice of allowance, the application shall be regarded as abandoned.

(b) The Commissioner may accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if upon petition the delay in payment is shown to have been unavoidable. The petition to accept the delayed payment must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for delayed payment (§ 1.17(l)), and (3) a showing that the delay was unavoidable. Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(c) The Commissioner may, upon petition, accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if the delay in payment was unintentional. The petition to accept the delayed payment must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition under paragraph (b) of this section which was filed within one year of the date of abandonment of the application. The petition to accept the delayed payment must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for unintentionally delayed payment (§ 1.17(m)), and (3) a statement that the delay was unintentional. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the abandonment was unintentional. The three-month period from the date of the first decision referred to in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

(d) Any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The filing and issue fees for design applications are set forth in 37 CFR 1.16(f) and 1.18(f).

1509 Reissue of a Design Patent

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

Design Reissue filing and issue fees.

The term of a design patent may not be extended by reissue, *Ex parte Lawrence*, 1946 C.D. 1, 70 USPQ 326 (Comm'r. Pats. 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

A. 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*, 181 USPQ 331). In *Mazer* v. *Stein*, 100 USPQ 325, 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.

B. 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.

(1) 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.

(2) 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.

(3) 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.

(4) 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 (3) 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.

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

C. 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.*, 140 USPQ 575 (CCPA 1964), later reaffirmed by the same court at 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.

D. Inclusion of Trademarks in Design Patent Applications

1. 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.

2. Drawings

Where trademarks are used in the drawing disclosure and there is no evidence of record that the trademark is owned by the applicant or assignee, applicant should be required to establish the legal right to use the registered trademark in the design application drawing disclosure. See *Dallas Cowboys Cheerleaders, Inc.* v. *Pussycat Cinema, Ltd.*, 203 USPQ 161 (2d Cir. 1979) and *Coca–Cola Co. v. Gemini Rising Inc.*, 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), new 35 U.S.C. 157, and 37 CFR 1.293 – 1.297 replaced the former Defensive Publication Program (37 CFR 1.139). The Statutory Invention Registration (SIR) Program applies to utility, plant, and design applications. See MPEP Chapter 1100.