





cluding in the application when filed a photograph or model of the article, or in the case of a flat article, such as cloth, a sample showing a complete unit of the design is permissible and may be followed. An insufficient drawing may be fatal to validity.

#### 1504 Examination

In design cases as in "mechanical" cases, novelty and invention are necessary prerequisites to the grant of a patent. In the case of designs, the inventive novelty resides in the shape or configuration or ornamentation as determining the appearance or visual aspect of the object or article of manufacture in contradistinction to the structure of a machine, article of manufacture or the constitution of a composition of matter.

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

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

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

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

Two or more articles are often shown in the drawing of an application, while the law permits only a single design in one case. If it is clear that applicant has disclosed and is attempting to claim two or more different designs or variations of the same design, he is required to elect one and cancel the other. (Ex parte Whittington, 1926 C. D. 51; 347 O. G. 281.)

If in response to a requirement to elect, the applicant traverses the requirement on its merits, i. e., argues that only one design in fact is disclosed, the requirement, before it may be repeated, must be approved by the Classification Examiner (Rule 143) just as in mechanical cases.

The question most often presented is whether the assembly of articles shown does in fact constitute a unitary design, or is merely an aggregation of designs. If it is the latter it is a ground for a rejection of the claim, and not for a requirement to elect.

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

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

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

A utility patent and a design patent may issue on the same subject matter; however, there must be a clearly patentable distinction between them. Where two applications, utility and design, involve the same inventive concept and in effect claim the same patentable invention two patents may not issue and a rejection on double patenting may result. (In re Barber, 1936 C. D. 184; 465 O. G. 724.)

#### 1504.01 Segregable Parts

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

### 1505 Allowance and Term of Design Patent

*Rule 155 Term of design patent.* (a) The petition for a design patent should specify the term, 3½, 7, or 14 years, for which a design patent is sought; but if no term is specified, or if the term specified is greater than that covered by the fee paid, the application will be accepted as filed for a term corresponding to the fee received, and the applicant so notified.

(b) Where the applicant initially requests that the patent issue for one of the shorter terms, he may, at any time before the application is allowed and passed to issue, upon the payment of the additional sum necessary, amend his application by requesting that the patent be issued for a longer term. In order to afford the applicant an opportunity for making such an amendment and paying the additional sum, the Office may notify him before the application is allowed and passed to issue unless otherwise directed, but failure of the Office to send or of the applicant to receive such notification will not warrant any change in the term requested after the application is allowed and passed to issue.

[Old Rule 80]

(Founded on Section 4931 R. S.; 35 U. S. C. 77)

It is unnecessary upon filing a design application to pay the fee for the maximum term of 14 years. Payment of a ten dollar fee entitles the applicant to an examination as to patentabil-

ity and to a patent for 3½ years if found patentable. Request may be made at the time of filing, or at any time before allowance, that applicant be notified before allowance, so that he may extend the term should he desire. Upon sending such notice the application is withheld from allowance for 30 days to permit the filing of the additional fee for such longer term as may be selected. If no response is received to such notice the application is thereupon allowed, and goes to patent for the term corresponding to the fee originally paid.

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

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

### 1506 Foreign Filing Dates

The provisions of Sec. 4887 R. S., 35 U. S. C. 32 (201.13) and Public Law 690 (201.16) apply also to design applications.