Chapter 1500 Design Patents

1501 ◊Statutes and◊ Rules Applicable [R-4]

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. Some sections of this Chapter make specific reference to other sections or chapters of the Manual.◊

1502 Definition of a Design [R-4]

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 paragaraphs).

Form Paragraph 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.◊

1503 Elements of a Design ◊Patent◊ Application [R-4]

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 where a preamble to the specification is no longer required, a preamble still remains a requirement in a design ◊patent◊ application (37 CFR 1.154).

◊A claim is a necessary element of a design patent application.

A drawing is an essential element of a design patent application. (See later § 1503.02 of this Chapter for requirements for drawings).

Form Paragraph 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 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)).

In addition to the drawings filed as required, it is premissible to include with the application papers a photograph of the article, or in the case of a thin, flat material such as cloth, a sample showing a complete unit of the design.

For filing date purposes, in those design patent applications containing 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 applications incomplete as filed. By so construing photographs when filed as informal drawings in design patent applications, the Office can accept the applications without requiring applicants to file petitions to obtain the original deposit date as the filing date. If such informal photographic drawings are filed, it is the responsibility of the examiner to determine whether or not the formal drawings, when filed, contain new matter. See discussion of new matter in MPEP 1504.

In view of the new matter problems and subsequent questions of disclosure under 35 U.S.C. 112, first paragraph, which may result, the use of the photographs as informal drawings should be mininal rather than routine.◊***

1503.01 Specification and Claim [R-4]

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)).

* * *

TITLE

The title is of great importance in a design ◊patent◊ application. It serves to identify the article in which the design is embodied * * * by the name generally ◊known and◊ used by the public. The title should be ***definite ◊and stated in singular form. For example,◊*** a stove ◊should◊ * be called a "Stove" and not ◊a◊ "Heating Device." The title may particularize the type of article named by specifying a use "Bottle for Perfume" or by indicating a structural type—"Vacuum Bottle." ◊Uniformity in the◊*** title ◊should appear◊*** in the preamble to the specification, in the description of the drawing, * in the claim ◊and in the oath or declaration. Subsequent changes in the title are to be effected throughout the application, except in the original oath or declaration◊. The title ◊recited in the claim◊*** must correspond to the name of the ◊subject matter◊ shown in the drawing.

◊Form Paragraph 15.05.1

TITLE OF DESIGN INVENTION

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

To allow latitude of construction it is permissible to add ◊a phrase such as— "or similar article"—◊ to the title. * * *

◊Form Paragraph 15.05.2

USE OF "OR SIMILAR ARTICLE" IN THE TITLE

The title must be in the singular but to allow latitude of construction, it is permissible to add to the title the phrase "or similar article".

For paragraph 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. ◊In addition to the figure descriptions, where necessary for clarity, 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 which indicates that any broken line illustration in the drawing disclosure is not a part of the design sought to be patented.

c. Description denoting the nature and environmental use of the claimed design in situations where an appropriate title cannot satisfy this requirement.

d. A "characteristic" features statement describing a particular feature of novelty or unobviousness in the claimed design (37 CFR 1.71(c))

Form Paragraph 15.47

CHARACTERISTIC FEATURE STATEMENT

A "characteristic" feature 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. Statements describing the construction or function of the claimed design.

b. A disclaimer statement directed to any portion of the claimed design invention. (See *Ex parte Remington,* 114 O.G. 761, 1905 C.D. 761, (Comr. Pats 1904); *In re Blum,* 153 USPQ 177 (CCPA 1967).

c. Statements which describe or suggest modifications of the claimed design which are not illustrated in the drawing disclosure.

Form Paragraph 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".

Form Paragraph 15.61

AMEND SELECTED FIGURE DESCRIPTIONS

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

Examiner Notes:

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

CLAIM

A ◊single◊ claim ◊only◊ is required and should be in formal terms to ◊"The◊* ornamental design for the article (as specified in the title) as shown." *** (◊See◊ In re Rubinfield, 1959 C.D. 412, 123 USPQ 210 ◊(CCPA 1959)◊.)

◊Form Paragraph 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.

Examiner Note:

1. In bracket 1, insert "must be" or "has been".
2. In bracket 2, insert "I" or "We".
3. In bracket 3, insert the title.

Form Paragraph 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.

Examiner Note:

1. In bracket 1, insert "must be" or "has been".
2. In bracket 2, insert "I" or "We".
3. In bracket 3, insert the title.

When there is a properly included special description of the design, or a proper showing of modified forms of the claimed design, or other properly included descriptive matter in the specification, the words "and described" must be part of the claim, and must follow the term "shown."

Form Paragraph 15.64

ADDITION OF "AND DESCRIBED" TO CLAIM

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

Examiner Note:

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

The ornamental design which is claimed must be shown in solid lines in the drawing. There are no portions of a claimed design which are immaterial or unimportant. (See *In re Blum*, 852 O.G. 1045, 153 USPQ 177, (CCPA 1967)).◀***

1503.02 Drawing [R-4]

37 CFR 1.152. Drawing. The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented.

▶STANDARD FOR 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 and second paragraphs◀.) Moreover, an insufficient drawing would prevent obtaining the benefit of the effective filing data of the parent application in a continuing application since 35 U.S.C. 120 requires that the invention in the parent application be disclosed in the manner provided by the first paragraph of 35 U.S.C. 112.

The drawing figures should be appropriately surface shaded to show clearly the character and/or contour of all surfaces represented. This is of particular importance in the showing of three-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 solid areas.

Note also the requirements of 37 CFR 1.84.

Form Paragraph 15.05.3

DRAWING DISCLOSURE OBJECTED TO

The drawing disclosure is objected to [1 insert reason].

Form Paragraph 15.05.4

PHOTOPRINTS FOR PROPOSED DRAWING CORRECTIONS

A photoprint or photoprints showing the proposed corrections 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 1.118).

Form Paragraph 15.05.5

DRAWING CORRECTION REQUIRED PRIOR TO APPEAL

Any appeal of the design claim must include a correction of the drawings in accordance with *Ex parte Bevan*, 142 USPQ 284 and must follow the procedure set forth in PTO–1474 attached to Paper No. [1 insert Paper Number].

Examiner Note:

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

Form Paragraph 15.06

PROCEDURE FOR CORRECTION OF DRAWING

All approved drawing corrections must be made by a Bonded Draftsman after Notice of Allowance has been received. (See attached PTO–1474).

Examiner Note:

See form paragraphs in Chapter 600 for additional paragraphs re: drawing changes.

Form Paragraph 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, the same being prohibited by 35 U.S.C. 132 and 37 CFR 1.118.

Form Paragraph 15.49

SURFACE SHADING NECESSARY

The drawing figures should be appropriately shaded to show clearly the character and/or contour of all surfaces represented. This is of particular importance in the showing of three- 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.

Drawing disclosure of design claim◀

The ornamental design which is being claimed must be shown in solid lines in the drawing. ▶Broken◀ 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. In re Blum, 852, O.G. 1045, 153 USPQ 177. ▶, (CCPA 1967 >: *In re Zahn*, 204 USPQ 988 (CCPA 1980).

For questions of new matter, see MPEP 1504.

Form Paragraph 15.50

DESIGN CLAIMED SHOWN IN FULL LINES (*IN RE ZAHN, 204 USPQ 988*)

The ornamental design which is 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*, 852 O.G. 1045, 153 USPQ 177; *In re Zahn*, 204 *USPQ 988*).

While a sectional view which more clearly brings out the design is permissible (see *Ex parte Lohman*, 1912 C.D. 336, 184 O.G. 287 (Comr. Pats. 1912)),

those which are presented for the purpose of including purely functional features, or for exhibiting mechanical functions or interior structure not related to the design, are not favored. It is the subject matter as seen by the observer, not its interior structure, which should be shown. With practically all articles except flat, thin goods such as fabrics, at least two well executed views are necessary, showing the article in three dimensions.

Form Paragraphs 15.48

NECESSITY FOR GOOD DRAWINGS (35 U.S.C. 112, PARAGRAPHS 1 AND 2)

The necessity for good drawings in a design patent application cannot be over-emphasized. 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 and second paragraphs). Moreover, an insufficient drawing may have a negative effect with respect to the effective filing date of a continuing application.

Use of Broken Lines

***Unclaimed environmental structure in the drawing disclosure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be indicated adequately by a reasonably concise title or statement in the specification as set forth in MPEP 1503.01. Such showing by broken lines should not be executed in a manner as to obscure or confuse the appearance of the claimed design (note 35 U.S.C. 112). In general, when such 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 disclose fully*
the subject matter * * * for which the design protection is sought. * * *

Form Paragraph 15.50.1

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 MPEP 1503.02).

Form paragraph 15.50.2

DESCRIPTION OF BROKEN LINES

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

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

Form paragraph 15.50.3

OBJECTIONABLE USE OF BROKEN LINES IN DRAWING

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 or broken lines obscure the claimed design and render an indefinite disclosure (35 U.S.C. 112).

Form Paragraph 15.50.4

PROPER DRAWING DISCLOSURE WITH USE OF BROKEN LINES

Where broken lines showing environmental structure must cross 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.

Examiner Note:

This paragraph should be used where broken disclosure in the drawing aids in understanding the nature of the claimed design.

USE OF INDICIA

Indicia or legible matter should not be required to be removed from the showing of the claimed subject matter unless it appears to be merely instructional, such as game rules, move sequences or the like and trade names, or such similar matter which manifestly is not a part of the invention claimed.

USE OF PHOTOGRAPHIC DRAWINGS

Attention is directed to the paragraphs headed "Photographs" and "Special Categories" in MPEP 608.02. It is emphasized that the acceptance of photographs as drawings in special categories is a very restricted practice. It is further emphasized that the phrase "ornamental effects" as used in MPEP 608.02 was never intended, and is not intended to be a blanket inclusion of drawings in design patent applications directed to ornamental designs. Because of the technical problems in printing United States design patents, reproductions of photographic drawings tend to result in vague and indefinite disclosure. In those rare situations where photographic drawings are permissible in design patent applications, strict adherence to the guidelines set forth in MPEP 608.02 will be required.

Form Paragraph 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 Application Division has been authorized to construe the photographs as informal drawings, rather than to hold the applications incomplete as filed. By so construing photographs when filed as informal drawings in design patent applications, the U.S. Patent and Trademark Office can accept the applications without requiring applicants to file petitions to obtain the original deposit date as the filing date.

Form paragraph 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 [R-4]

a. Novelty and Unobviousness (35 U.S.C. 102; 103)

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 structure of a machine, article of manufacture or the constitution of a composition of matter considered in a "utility" invention.

SEARCH

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.***

Analogous Art

(a) Single Anticipatory Reference

The use to which an article is to be put has no bearing on its patentability as a design, thus if the prior art discloses any article of substantially the same appearance as that of applicant, it is immaterial what the use of such an article is. The Court of Customs and Patent Appeals in *In re Glavas,* 109 USPQ 50 (CCPA 1956) has established that insofar as anticipation by a single prior art disclosure is concerned, there can be no question as to non-analogous art in design cases.

(b) Combination of References

As stated in MPEP 904.01(c), "the determination of which arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims and not upon what it is called. For example, a tea mixer and a concrete mixer are for the same art, namely the mixing art, this being the necessary function of each. Similarly, a brick cutting machine and a biscuit cutting machine have the same necessary function." While the above guidelines are followed by both design and utility examiners, the above guidelines cited in the *In re Glavas* decision further provides guidelines which supplement MPEP 904.01(c) and also govern the combination of prior art in design claim rejections under 35 U.S.C. 103. The following quotation from the *Glavas* decision explains the Court's position which is established practice in examining design patent applications.

> "As regards the combination of reference in design cases, a different situation is presented. A design, from the standpoint of patentability, has no utility other than its ornamental appearance, and the problem of combining references is therefore one of combining appearances rather than uses. The principle of nonanalogous arts, therefore, cannot be applied to design cases in exactly the same manner as to mechanical cases. The question in design cases is not whether the reference 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. As was pointed out in *Northrup v. Adams,* 1877 C.D. 322, 12 O.G. 430 (U.S.C.C. E.D. Mich.), the painting "upon a familiar vase of a copy of Stuart's portrait of Washington" would not be patentable. The situation in the case of *In re Jabour,*—(86 USPQ 98 (CCPA 1950), was of the type just mentioned since it involved the application to a tank of surface ornamentation previously applied to a microphone.
>
> 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 invention."

Here the Court has held in paragraphs 1 and 2 that where features or components of a prior art reference are ornamental in nature rather than functional, these features may be relied upon in 35 U.S.C. 103 design claim rejection even though the prior art reference itself is nonanalogous. In situations as defined in the last paragraph of the above quoted statement, the design examiner must rely on MPEP 904.01(c) for policy guidelines concerning analogous art.

Novelty

Inasmuch as a design patent deals with appearance only, the test to be applied in determining the question of novelty* is identity or similarity of appearance. If a reference is found which* is identical in appearance to that claimed, the question of novelty* is, of course, definitely settled in the negative (35 U.S.C. 102).

Form Paragraph 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 for patent.

Form paragraph 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.

Form Paragraph 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.

Form Paragraph 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.

Form Paragraph 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.

Form Paragraph 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.

Form Paragraph 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.

Unobviousness

However, it more often occurs that the references differ in some respects from the design claimed and the question of unobviousness is thus presented (35 U.S.C. 103). Are the differences in configuration and/or surface ornamentation in the claimed design unobvious and do the differences add to its ornamental value? Are the differences for structural or functional reasons, or for the purpose of ornamentation? ***

35 U.S.C. 103 and all of the case law interpreting that statute applies with equal force to a determination of the obviousness of either a design or a utility patent application. As in any analysis of the obviousness issue, consideration must be given to the following:

(*Graham et al v. John Deere Co. of Kansas City et al.*, 148 USPQ 459 (Sup. Ct. 1966) and *Litton Systems Inc. v. Whirlpool Corp.*, 221 USPQ 97 (Fed. Cir. 1984).

(1) *Scope and content of the prior art*

"The scope and content of the prior art has been defined as that 'reasonably pertinent to the particular problem with which the inventor was involved.' " quoting *Point Plastics Inc. v. Rainin Instrument Co. Inc.*, 225 USPQ 519 at 521 (D.C. N.D. Calif. 1984). In resolving the question of obviousness under 35 U.S.C. 103, the inventor is charged with full knowledge of all of the prior art in the field of endeavor.

(2) *Difference between the Prior Art and the Claim in Issue.*

An analysis of the prior art must be made to determine if the claimed invention as a whole is obvious in light of the differences between the prior art and the claim.

(3) *Level of Ordinary Skill in the Art*

In design applications, the fictitious section 35 U.S.C. 103 person of ordinary skill is the "designer of articles of the types presented". *In re Nalbandian.* 661 F.2d 1216; 211 USPQ 782 (CCPA 1981) and *In re Carter,* 213 USPQ 625 (CCPA 1982).

(4) *Secondary Considerations*

Secondary considerations such as commercial success are relevent and if such evidence is presented, it must be considered. *In re Rinehart,* 189 USPQ 143 (CCPA 1972), *In re Nalbandian,* 211 USPQ 782 (CCPA 1981), and *In re Felton,* 179 USPQ 295 (CCPA 1973). See MPEP 716.

When a 35 U.S.C. 103 rejection is based upon a combination of references, there must be a reference, a "something in existence", the design characteristics of which are basically the same as the claimed design. *In re Rosen,* 213 USPQ 347 (CCPA 1982). See also comments under analogous art above.

Form Paragraph 15.18

35 U.S.C. 103 REJECTION (SINGLE REFERENCE)

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

Form Paragraph 15.19

35 U.S.C. 103 REJECTION (MULTIPLE REFERENCES)

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

Although the invention is not 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 of ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Form Paragraph 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.

For Paragraph 15.58

CLAIMED DESIGN IS PATENTABLE

The claimed design is patentable over the references cited.

Other considerations

1. For guidelines and cases to be cited in rejections based on public use of sale, see MPEP Chapter 2100.

2. 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. Appls. 1965); *Ex parte Marinissen,* 842 O.G. 528, 155 USPQ 528 (Bd. Appls. 1966); *Appeal No. 239-48, Decided April 30, 1965,* 833 O.G. 10, 1966 C.D. 22 (Bd. Appls. 1965); *Ex parte Appeal decided September 3, 1968,* 866 O.G. 16, Bd. Appls. 1968). 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 six 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. Appls. 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. Appls. 1983).

Improper Subject Matter under 35 U.S.C. 171.

1. Design patent applications which disclose subject matter which is obviously the result of purely functional considerations will be rejected as not meeting the requirements of ornamentality under 35 U.S.C. 171. This includes designs where the differences over the prior art are purely functional in purpose and derivation, as well as those which disclose no surface ornamentation or configuration which can be attributed to ornamental considerations. (*In re Carletti et al,* 140 USPQ 653 (CCPA 1964); *In re Cornwall,* 109 USPQ 57 (CCPA 1956); *Ex parte Jaffe,* 147 USPQ 45 (Bd. Appls. 1964) and *In re Garbo,* 129 USPQ 72 (CCPA 1961)).

Form Paragraph 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.

Form Paragraph 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.

Form Paragraph 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.

Form Paragraph 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.)

***

2. 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.

Form Paragraph 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).

***

Indefiniteness

Form Paragraph 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 the 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.

Form Paragraph 15.21.5

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 prove 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.

Form Paragraph 15.56

REQUIREMENT 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 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.

Form Paragraph 15.66

EMPLOY SERVICES OF PATENT ATTORNEY OR AGENT (DESIGN)

As the value of 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 illustration involving new matter is in violation of 35 U.S.C. 132; 37 CFR 1.118. In a design patent application erasure of portions of the original disclosure may constitute new matter. In general terms, if the additional or amended illustration is reasonably supported by the original disclosure under 35 U.S.C. 112, first and second paragraphs, it will not be refused entry. Any entered amendment of the claim involving new matter will result in a new rejection based on 35 U.S.C. 112, first paragraph. (see *In re Rasmussen*, 211 USPQ 323 (CCPA 1981).

Form Paragraph 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.

Reconsideration

Form Paragraph 15.38

REJECTION ADHERED TO

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

Form Paragraph 15.39

OBVIOUSNESS UNDER 35 U.S.C. 103 REPEATED

It remains the examiner's position that the [1 name of design] design claimed as obvious under 35 U.S.C. 103 in view of [2].

Form Paragraph 15.39.1

35 U.S.C. 103 REJECTION REPEATED (MULTIPLE REFERENCES)

It remains the examiner's postition that the claim is obvious under 35 U.S.C. 103 over [1 insert references] in view of [2 insert other reference(s)].

Form Paragraph 15.39.2

FINAL REJECTION UNDER 35 U.S.C. 103 (SINGLE REFERENCE)

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

Examiner Note:

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

Form Paragraph 15.40

FINAL REJECTION UNDER 35 U.S.C. 103 (MULTIPLE REFERENCES)

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

Examiner Note:

See paragraphs in Chapter 700, for "Action is Final" and "Advisory After Final" Paragraphs.

Form Paragraph 15.40.1

FINAL REJECTION UNDER STATUTORY PROVISIONS OTHER THAN 35 U.S.C. 103

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

Form Paragraph 15.51

NEW MATTER (35 U.S.C. 132) REJECTION UNDER 35 U.S.C. 112, FIRST PARAGRAPH

The proposed additional or amended illustration has been entered, however said amendment introduces new matter (35 U.S.C. 132; 37 CFR 1.118). Since the original disclosure does not include reasonable support for the proposed changes, the claim is rendered indefinite under 35 U.S.C. 112, first paragraph. Accordingly, the claim is rejected under 35 U.S.C. 112, first paragraph, due to indefiniteness. (*In re Rasmussen*, 211 USPQ 323).

Form Paragraph 15.53

RECONSIDERATION OF ABANDONMENT—PAPERS LOST BY PTO

The Request for Reconsideration or Withdrawal of the holding of abandonment and accompanying papers, filed [1], have been associated with the file.

In view thereof, it appears that a timely response was received in the U.S. Patent and Trademark Office.

Accordingly, this application is restored to pending status and will receive further consideration by the examiner in the normal course of business.

Form Paragraph 15.54

RESTORE TO PENDING—LATE ASSOCIATION OF PAPERS

The response filed [1] was not associated with the file of the application until after Notice of Abandonment was mailed.

The response was timely filed.

Accordingly, the Notice of Abandonment is vacated, and the application is restored to pending status, to receive further consideration by the examiner in the normal course of business.

Form Paragraph 15.65

AMENDMENT MAY NOT BE POSSIBLE

The [1] might be fatally defective, that is, it might not be possible to [2] without introducing new matter.

Examiner Note:

In [1] specify either "disclosure" or "claim".

In [2] describe a possible corrective course of action which could result in new matter.

1504.05 Restriction and Double Patenting [R-4]

Restriction, Multiple Embodiments, and Double Patenting Procedures for handling restriction and double patenting situations are fully covered in MPEP Chapter 800, to which reference should be made.

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. 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 See *In re Rubinfield,* 123 USPQ 210, 1959 C.D. 412 (CCPA 1959)). The specification should make clear that multiple embodiments are disclosed and may particularize the differences between the embodiments.

2. *RESTRICTION—WHEN PROPER*

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.

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 design and operation. 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 dislcosures of independent subjects.

b. *DISTINCT INVENTIONS*

Design inventions are distinct if two or more subjects 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. On the other hand, if non-distinct inventions are claimed in separate design patent applications, the issue of double patenting must be raised. Note MPEP 806.05. 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.

Form Paragraph 15.27

RESTRICTION UNDER 35 U.S.C. 121

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 because each presents an over-all appearance which is either new or unobvious over the other.

Examiner Note:

Add comments or explanations as 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.

Form Paragraph 15.28

RESTRICTION UNDER 35 U.S.C. 121 (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 because each presents an over-all appearance which is either new or unobvious over the other.

Examiner Note:

Add comments or explanations as 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).

During a telephone discussion with [5] or [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.

Form Paragraph 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.

c. *SEGREGABLE PARTS—COMBINATION/SUBCOMBINATION*

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 parts is to apply for separate patents. Note *Ex parte Sandford,* 1914 C.D. 69; 104 O.G. 1346 (Comr. Pats. 1914) and *Blumcraft of Pittsburgh v. Ladd. Comr. Pats.,* 144 USPQ 562 (D.C. D.C. 1965). Thus, under the segregable parts doctrine, the disclosure in the drawings of segregable parts-combination/subcombination subject matter inherently represents distinct inventions. Restriction in such cases is clearly proper.

It is emphasized that independent subject matter and segregable part-combination/subcombination subject matter must be supported by separate claims whereas only a single claim is permissible in a design patent application.

A requirement for restriction under 35 U.S.C. 121 in a design patent application is supported by the holdings in *Ex parte Heckman,* 135 USPQ 222 (PO Super. Exam. 1960) and *In re Kelly,* 200 USPQ 560 (Comr. Pats. 1978).

Form Paragraph 15.29

RESTRICTION UNDER 35 U.S.C. (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 as an entirety, and does not extend to segregable parts: the only way to protect such segregable part 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 Rubinfield,* 123 USPQ 210).

Examiner Note:
Additional 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.

Form Paragraph 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 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 Rubinfield,* 123 USPQ 210).

Examiner Note:
Add comments or explanations as 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.

Form Paragraph 15.32.

ACTION ON MERITS DEFERRED (EX PARTE HECKMAN 135 USPQ 229)

In view of the foregoing restriction requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman,* 135 USPQ 229.

Form Paragraph 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].

Form Paragraph 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].

Form Paragraph 15.37

CANCELLATION OF NON-ELECTED GROUPS, NO TRAVERSE

In view of the fact that this appliction is in condition for allowance except for the presence of Group [1] directed to an invention or inventions non-elected without traverse and without the right to petition in Paper No. [2], said groups have been cancelled.

3. *Double Patenting*—Attention is directed to the Patent Law Amendment of 1984 (Public Law 98-622) regarding modification of the double patenting practice.

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. In addition, double patenting may exist (1) between two or more design patent applictions and/or patents and (2) between a design patent applications and a "utility" appliction and/or patent.

(a). *Design-Design Double Patenting*

(1) The "same invention" type double patenting rejection in design-design situations 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).

(2) The "obviousness" type double patenting rejection in design-design situations is a judicially created doctrine based on public policy rather than statute, and is primarily intended to prevent prolongation of monopoly by prohibiting the issuance of a claim in a second design patent not patentably distinguishing from the claim in a first design patent (*In re Thorington et al,* 163 USPQ 644 (CCPA 1969); *In re Russell,* 112 USPQ 58 (CCPA 1956)). This type of double patenting may be overcome by terminal disclaimer where (a) same inventive entities exists, or where, (b) different inventive entities exist but said inventions are commonly owned by the same person, see MPEP 804–804.03).

b. *Design—Utility Double Patenting*

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

(2) 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 (C.A. 3d 1980); *Transmatic, Inc. v. Gulton Industries Inc.,* 202 USPQ 559 (C.A. 6th 1979)).

(3) 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 double patenting rejection may be overcome by a terminal disclaimer where same inventive entities or common ownership exist.

Form Paragraph 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].

Form Paragraph 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 appliction—or—prior U.S. Patent No.—
In bracket 2, and explanation is necessary.

Form Paragraph 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 [R-4]

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

The provisions of 35 U.S.C. 119 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 six months of the earliest date on which any foreign application for the same design was filed.

Form Paragraph 15.01

CONDITIONS UNDER 35 U.S.C. 119

Applicant is advised of conditions as specified in 35 U.S.C. 119. 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.

Form Paragraph 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 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: (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 inter-governmental authority which received the application.

Form Paragraph 15.02

RIGHT OF PRIORITY UNDER 35 U.S.C. 119

No application for design patent shall be entitled to the right of priority under 35 U.S.C. 119 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 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 he deems necessary.

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

Form Paragraph 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 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 date of filing 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.

Form Paragraph 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 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 in 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.

1504.20 Benefit under 35 U.S.C. 120 [R-4]

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 Serial 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 (C.A. 2d 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 (Comr. Pats. 1981).

In both utility and design applications, applicants are entitled to claim the benefit of 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.

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 46 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 25 U.S.C. 120.

Form Paragraph 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 Serial No. [2], filed [3]" as the first sentence of the specification following the preamble.◀

1505 Allowance and Term of Design Patent [R-4]

35 U.S.C. 173. Term of design patent. Patents for designs shall be granted for the term of fourteen years. ▶(Amended August 27, 1982 Public Law 97-247, § 16, 96 Stat. 321).◀

▶*37 CFR 1.16 National application filing fee*

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(f) For filing each design application	
By a small entity (§ 1.9)	$70.00
By other than a small entity	$140.00

*****

37 CFR 1.18 Patent issue fees

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(b) Issue fee for issuing a design patent	
By a small entity (§ 1.9)	$100.00
By other than a small entity	$200.00

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The issue fees for original and reissue design applications are the same.◆

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. ◆40 FR 44813, Sept. 30, 1975 and 47 FR 33086, July 30, 1982, effective October 1, 1982).***

◆1509 Reissue of a Design Patent [R-4]

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

Design Reissue filing and issue fees.

37 CFR 1.16 National application filing fees

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(h) Basic filing fee for each reissue application,	
by a small entity (§ 1.9(f))	$170.00
by other than a small entity	$340.00

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For issuing each original or reissue design patent note 37 CFR 1.18(b) and MPEP 1505 above.◆

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

◆1510 Reexamination applications [R-4]

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

◆1511 Protest [R-4]

See MPEP Chapter 1900 for practice and procedure in protest.◆

◆1512 Relationship between Design Patent, Copyright and Trademark [R-4]

Form Paragraph 15.55

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 the 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.

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, 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 ⅛ inch to ¼ 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.

Thus, an ornamental design may be copyrighted as a work of art and may also be the subject matter of a design patent. (See *In re Yardley,* 181 USPQ 331 (CCPA 1974)). In *Mazer v. Stein,* 100 USPQ 325 (Sup. Ct. 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 same case and the issue was not before the Court.

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

Form Paragraph 15.55.1

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 re-affirmed by the same court at 152 USPQ 593 (CCPA 1967), has held that the underlying purpose and essence of patent rights are separated 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.

1513 Miscellaneous [R-4]

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 patent applications.