Chapter 1500 Design Patents

1501 Statutes and Rules Applicable [R-07.2015]

Design patents are provided for in 35 U.S.C. chapter 16. In addition, international design applications filed under the Hague Agreement Concerning the International Registration of Industrial Designs ("Hague Agreement") are provided for in 35 U.S.C. chapter 38. Certain statutory provisions in 35 U.S.C. chapter 38 provide for the applicability of the provisions of 35 U.S.C. chapter 16 to international design applications. See 35 U.S.C. 382(c), 383, and 389(b). See MPEP Chapter 2900 for additional information concerning international design applications.

The right to a patent for a design stems from:

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—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.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

For design applications filed under 35 U.S.C. chapter 16:

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.

For international design applications designating the United States:

37 CFR 1.1061 Rules applicable.

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of § 1.74, § 1.84, except for § 1.84(c), and §§ 1.152 through 1.154 shall not apply to international design applications.

Other rules relating only to design applications, such as 37 CFR 1.152-1.155 and those contained in 37 CFR Part 1, Subpart I, are reproduced in the sections of this chapter and in MPEP Chapter 2900, as appropriate.

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 this chapter or in MPEP Chapter 2900. Also, with respect to international design applications that designate the United States, 35 U.S.C. 389(b) provides that "[a]ll questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16." Accordingly, many of the practices set forth in this chapter, such as those pertaining to examination in MPEP § 1504, are applicable to international design applications that designate the United States. Differences in practices are noted in this chapter where applicable.

1502 Definition of a Design [R-07.2015]

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

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

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

Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.

1502.01 Distinction Between Design and Utility Patents [R-07.2015]

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 for an article includes its shape/configuration or surface ornamentation applied to 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 may not be easily separable. Articles of manufacture may possess both functional and ornamental characteristics.

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

(A) The term of a utility patent on an application filed on or after June 8, 1995 is 20 years measured from the U.S. filing date; or if the application contains a specific reference to an earlier application under 35 U.S.C. 120, 121, 365(c), or 386(c), 20 years from the earliest effective U.S. filing date, while the term of a design patent is 15 years measured from the date of grant, if the design application was filed on or after May 13, 2015 (or 14 years if filed before May 13, 2015). (See 35 U.S.C. 173 as amended under section 102 of the Patent Law Treaties Implementation Act, 126 Stat. at 1531-32).

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

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

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

(E) An international application designating various countries may be filed for utility patents under the Patent Cooperation Treaty (PCT), whereas an international design application designating various countries may be filed for design protection under the Hague Agreement.

See MPEP Chapter 2900 for international design applications.

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

(G) Utility patent applications may claim the benefit of a provisional application under 35 U.S.C. 119(e) whereas design patent applications may not. See 35 U.S.C. 172 and 37 CFR 1.78(a)(4) .

(H) A Request for Continued Examination (RCE) under 37 CFR 1.114 may only be filed in utility and plant applications filed under 35 U.S.C. 111(a) on or after June 8, 1995, while RCE is not available for design applications (see 37 CFR 1.114(e)).

(I) Continued prosecution application (CPA) practice under 37 CFR 1.53(d) is only available for design applications filed under 35 U.S.C. chapter 16 (see 37 CFR 1.53(d)(1)).

(J) Utility patent applications filed on or after November 29, 2000 are subject to application publication under 35 U.S.C. 122(b)(1)(A), whereas design applications filed under 35 U.S.C. chapter 16 are not subject to application publication (see 35 U.S.C. 122(b)(2)).

Other distinctions between design and utility patent practice are detailed in this chapter and MPEP Chapter 2900 for international design applications. Unless otherwise provided, the rules for applications for utility patents are equally applicable to applications for design patents (35 U.S.C. 171 and 37 CFR 1.151 and 1.1061).

1503 Elements of a Design Patent Application Filed Under 35 U.S.C. chapter 16 [R-08.2017]

This section sets forth the elements of a design application filed under 35 U.S.C. chapter 16. Elements of an international design application are set forth in MPEP Chapter 2900, though reference to international design applications that designate the United States is included in this section where appropriate.

A design patent application has essentially the elements required of an application for a utility patent (see Chapter 600). The arrangement of the elements of a design patent application filed under 35 U.S.C. chapter 16 and the sections of the specification are 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, subsection III.

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

1503.01 Specification [R-08.2017]

37 CFR 1.153 Title, description and claim, oath or declaration (for applications filed on or after September 16, 2012).

(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 inventor's oath or declaration must comply with the requirements of § 1.63, or comply with the requirements of § 1.64 for a substitute statement.

*****

37 CFR 1.153 (pre-AIA) Title, description and claim, oath or declaration (for applications filed prior to September 16, 2012).

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

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

*****

37 CFR 1.154 Arrangement of application elements in a design application.

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

(1) Design application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings or photographs.

(6) The inventor's oath or declaration (see § 1.153(b)).

(b) The specification should include the following sections in order:

(1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

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

(5) Feature description.

(6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

¶ 15.05 Design Patent Specification Arrangement (Ch. 16 Design Application)

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

(1) Preamble, stating name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

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

(5) Feature description.

(6) A single claim.

Examiner Note:

Do not use this form paragraph in an international design application.

I. PREAMBLE AND TITLE

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

The title of the design identifies the article in which the design is embodied by the name generally known and used by the public and may contribute to defining the scope of the claim. See MPEP § 1504.04, subsection I.A. The title may be directed to the entire article embodying the design while the claimed design shown in full lines in the drawings may be directed to only a portion of the article. However, the title may not be directed to less than the claimed design shown in full lines in the drawings. A title descriptive of the actual article aids the examiner in developing a complete field of search of the prior art and further aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, and the proper classification of the patent upon allowance of the application. It also helps the public in understanding the nature and use of the article embodying the design after the patent has been issued. For example, a broad title such as “Adapter Ring” provides little or no information as to the nature and intended use of the article embodying the design. If a broad title is used, the description of the nature and intended use of the design may be incorporated into the preamble. Absent an amendment requesting deletion of the description, it would be printed on any patent that would issue.

When a design is embodied in an article having multiple functions or comprises multiple independent parts or articles that interact with each other, the title must clearly define them as a single entity, for example, combined or combination, set, pair, unit assembly.

Since 37 CFR 1.153 requires that the title must designate the particular article, and since the claim must be in formal terms to the “ornamental design for the article (specifying name) as shown, or as shown and described,” the title and claim must correspond. When the article named in the title does not correspond to the article named in the claim, the

examiner should object to the inconsistency under 37 CFR 1.153 and require correction.

However, it is emphasized that, under 35 U.S.C. 112(b) , the claim defines "the subject matter which the inventor or joint inventor regards as the invention" (emphasis added); (or for applications filed prior to September 16, 2012, under the second paragraph of 35 U.S.C. 112 the claim defines "the subject matter which the applicant regards as his invention"), that is, the ornamental design to be embodied in or applied to an article. Thus, the examiner should afford the applicant substantial latitude in the language of the title/claim. The examiner should 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(b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph); see MPEP § 1504.04, subsection II). The use of language such as "or the like" or "or similar article" in the title when directed to the environment of the article embodying the design will not be the basis for a rejection of the claim under 35 U.S.C. 112(b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph). However, such language is indefinite when it refers to the area of articles defining the subject matter of the design. An acceptable title would be "door for cabinets, houses, or the like," while the title "door or the like" would be unacceptable and the claim will be rejected under 35 U.S.C. 112(b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph). *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992). See also MPEP § 1504.04; subsection II.

Amendments to the title, whether directed to the article in which the design is embodied or its environment, must have antecedent basis in the original disclosure and may not introduce new matter. *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Inter. 1992). If an amendment to the title is directed to the environment in which the design is used and the amendment would introduce new matter, the examiner should object to the amendment under 35 U.S.C. 132. If an amendment to the title is directed to the article in which the design is embodied and the amendment would introduce new matter, in addition to the objection under 35 U.S.C. 132, the claim must be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, the first paragraph of 35 U.S.C. 112).

Any amendment to the language of the title should also be made at each occurrence thereof throughout the application, except in the oath or declaration. If the title of the article is not present in the original figure descriptions, it is not necessary to incorporate the title into the descriptions as part of any amendment to the language of the title.

The practice set forth above regarding the title of the design is generally applicable to international design applications designating the United States. The requirement for a title in an international design application designating the United States is set forth in 37 CFR 1.1067 and corresponds to the requirement set forth in 37 CFR 1.153. See MPEP § 2920.04(a).

¶ 15.05.01 Title of Design Invention

The title of a design being claimed must correspond to the name of the article in which the design is embodied or applied to. See MPEP § 1503.01 and 37 CFR 1.153 or 37 CFR 1.1067.

¶ 15.59 Amend Title

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

Examiner Note:

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

II. DESCRIPTION

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. *In re Freeman*, 23 App. D.C. 226 (App. D.C. 1904). 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. *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm'r Pat. 1919). Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should

object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.

(A) 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. Such a description, if provided, must be in the design application as originally filed, and may not be added by way of amendment after the filing of the application as it would be considered new matter.

(2) Description disclaiming portions of the article not shown in the drawing as forming no part of the claimed design.

(3) Statement indicating the purpose of broken lines in the drawing, for example, environmental structure or boundaries that form no part of the design to be patented.

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

It is the policy of the Office to attempt to resolve questions about the nature and intended use of the claimed design prior to examination by making a telephone inquiry at the time of initial docketing of the application. This will enable the application to be properly classified and docketed to the appropriate examiner and to be searched when the application comes up for examination in its normal course without the need for a rejection under 35 U.S.C. 112 prior to a search of the prior art. Explanation of the nature and intended use of the article may be added to the specification provided it does not constitute new matter. It may alternately, at applicant's option, be submitted in a separate paper without amendment of the specification

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

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

¶ 15.47 Characteristic Feature Statement

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

Examiner Note:

In brackets 1 and 2, insert brief but accurate description of the feature of novelty or nonobviousness of the claimed design.

¶ 15.47.01 Feature Statement Caution

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

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

(1) A disclaimer statement directed to any portion of the claimed design that is shown in solid lines in the drawings is not permitted in the specification of an issued design patent. However, the disclaimer statement may be included in the design application as originally filed to provide antecedent basis for a future amendment. See *Ex parte Remington*, 114 O.G. 761, 1905 C.D. 28 (Comm'r Pat. 1905); *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967). See MPEP § 2909.02 regarding disclaimer statements in international design applications.

(2) Statements which describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image of that shown or has a shape and appearance that would be evident from the one shown, are not permitted in the specification of an issued design patent. However, such statements may be included in the design application as originally filed to provide antecedent basis for a future amendment. In addition, statements which attempt

to broaden the scope of the claimed design beyond that which is shown in the drawings are not permitted.

(3) Statements describing matters that are directed to function or are unrelated to the design.

¶ 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.

¶ 15.46.01 Impermissible Descriptive Statement

The descriptive statement included in the specification is impermissible because **[1]**. See MPEP § 1503.01, subsection II. Therefore, the description should be canceled as 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.

Examiner Note:

In bracket 1, insert the reason why the descriptive statement is improper.

¶ 15.60 Amend All Figure Descriptions

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

Examiner Note:

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

¶ 15.61 Amend Selected Figure Descriptions

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

Examiner Note:

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

¶ 15.61.01 Amend Specification to Add Reference to Color Drawing(s)/ Photograph(s) (Ch. 16 Design Application)

The application contains at least one color drawing or color photograph. To comply with the provisions of 37 CFR 1.84 for color drawings/photographs in design applications, the specification **[1]** amended to include the following language as the first paragraph of the brief description of the drawings section:

> The file of this patent contains at least one drawing/photograph executed in color. Copies of this patent with color drawing(s)/photograph(s) will be provided by the Office upon request and payment of the necessary fee.

Examiner Note:

1. Do not use this form paragraph in an international design application.
2. In bracket 1, insert --must be-- or --has been--.

III. 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 claim in a design patent application filed under 35 U.S.C. chapter 16 is set forth in 37 CFR 1.153:

> ***37 CFR 1.153 ... claim...***
>
> (a) ... The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.
>
> *****

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

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

Full lines in the drawing show the claimed design. Broken lines are used for numerous purposes. Under some circumstances, broken lines are used to illustrate the claimed design (i.e., stitching and fold lines). Broken lines are not permitted for the purpose of identifying portions of the claimed design which

are immaterial or unimportant. See *In re Blum*, 374 F.2d 904, 907, 153 USPQ 177, 180 (CCPA 1967) (there are " *no* portions of *a design* which are 'immaterial' or 'not important.' A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design."). See also MPEP § 1503.02, subsection III.

The form and content of a claim in an international design application designating the United States is set forth in 37 CFR 1.1025, which mirrors the claim requirements set forth in 37 CFR 1.153. See also MPEP Chapter 2900 for international design applications.

¶ 15.62 Amend Claim "As Shown"

For proper form (37 CFR 1.153 or 37 CFR 1.1025), 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 title of the article in which the design is embodied or applied.

¶ 15.63 Amend Claim "As Shown and Described"

For proper form (37 CFR 1.153 or 37 CFR 1.1025), 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 title of the article in which the design is embodied or applied.

¶ 15.64 Addition of "And Described" to Claim

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

Examiner Note:

1. In bracket 1, insert reason.

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

1503.02 Drawing [R-08.2017]

37 CFR 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that 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 are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

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

When inconsistencies are found among the views, the examiner should object to the drawings and request that the views be made consistent. *Ex parte Asano*, 201 USPQ 315, 317 (Bd. Pat. App. & Inter. 1978); *Hadco Products, Inc. v. Lighting Corp. of America Inc.*, 312 F. Supp. 1173, 1182, 165 USPQ 496, 503 (E.D. Pa. 1970), *vacated on other grounds*, 462 F.2d 1265, 174 USPQ 358 (3d Cir. 1972). When the inconsistencies are of such magnitude that the overall appearance of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs), as nonenabling and indefinite. See MPEP § 1504.04, subsection I.A.

¶ 15.05.03 Drawing/Photograph Disclosure Objected To

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

Examiner Note:

In bracket 1, insert the reason for the objection.

¶ 15.05.04 Replacement Drawing Sheets Required

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as amended. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. If all the figures on a drawing sheet are canceled, a replacement sheet is not required. A marked-up copy of the drawing sheet (labeled as "Annotated Sheet") including an annotation showing that all the figures on that drawing sheet have been canceled must be presented in the amendment or remarks section that explains the change to the drawings. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d) . If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

¶ 15.05.05 Drawing Correction Required Prior to Appeal

Any appeal of the design claim must include the correction of the drawings approved by the examiner in accordance with *Ex parte Bevan*, 142 USPQ 284 (Bd. App. 1964).

Examiner Note:

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

¶ 15.07 Avoidance of New Matter

When preparing new or replacement drawings, be careful to avoid introducing new matter. New matter is prohibited by 35 U.S.C. 132 and 37 CFR 1.121(f).

Form paragraph 15.48 may be used to notify applicant of the necessity for good drawings.

¶ 15.48 Necessity for Good Drawings

The necessity for good drawings in a design patent application cannot be overemphasized. As the drawing constitutes the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness, that nothing regarding the design sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity (35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph). Moreover, an insufficient drawing may have a negative effect with respect to the effective filing date of a continuing application.

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

I. VIEWS

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

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

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

II. SURFACE SHADING

While surface shading is not required under 37 CFR 1.152, it may be necessary in particular cases to shade the figures 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. However, surface shading should not be used on unclaimed subject matter, shown in broken lines, to avoid confusion as to the scope of the claim.

Lack of appropriate surface shading in the drawing as filed may render the design nonenabling and indefinite under 35 U.S.C. 112(a) and (b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs). Additionally, if the surface shape is not evident from the disclosure as filed, the addition of surface shading after filing may comprise new matter. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror. Contrast in materials may be shown by using line shading in one area and stippling in another. By using this technique, the claim will broadly cover contrasting surfaces unlimited by colors. The claim would not be limited to specific material either, as long as the appearance of the material does not patentably depart from the visual appearance illustrated in the drawing.

III. BROKEN LINES

The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied, or applied to, that is not considered part of the claimed design. See *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof. A boundary line may be shown in broken lines if it is not intended to form part of the claimed design. Applicant may choose to define the bounds of a claimed design with broken lines when the boundary does not exist in reality in the article embodying the design. It would be understood that the claimed design extends to the boundary but does not include the boundary. When a boundary line is introduced via amendment or in a continuation application, the introduction of the boundary line must comply with the written description requirement of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph). *See In re Owens*, 710 F.3d 1362, 1366-67, 106 USPQ2d 1248, 1251 (Fed. Cir. 2013). For example, unclaimed boundary lines should satisfy the written description requirement where they make explicit a boundary that already exists, but was unclaimed in the original disclosure. *See Owens*, 710 F.3d at 1368-69, 106 USPQ2d at 1252. Where no boundary line is shown in a design application as originally filed, but it is clear from the design specification that the boundary of the claimed design is a straight broken line connecting the ends of existing full lines defining the claimed design, applicant may amend the drawing(s) to add a straight broken line connecting the ends of existing full lines defining the claimed subject matter where such amendment complies with the written description requirement of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph). Additionally, any broken line boundary other than a straight broken line may constitute new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121(f).

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

In general, when broken lines are used, they should not intrude upon or cross the showing of the claimed design and should not be of heavier weight than the lines used in depicting the claimed design. When broken lines cross over the full line showing of the claimed design and are defined as showing environment, it is understood that the surface which

lies beneath the broken lines is part of the claimed design. When the broken lines crossing over the design are defined as boundaries, it is understood that the area within the broken lines is not part of the claimed design. Therefore, when broken lines are used which cross over the full line showing of the design, it is critical that the description of the broken lines in the specification explicitly identifies their purpose so that the scope of the claim is clear. As it is possible that broken lines with different purposes may be included in a single application, the description must make a visual distinction between the two purposes; such as --The broken lines immediately adjacent the shaded areas represent the bounds of the claimed design while all other broken lines are directed to environment and are for illustrative purposes only; the broken lines form no part of the claimed design.-- Where a broken line showing of environmental structure must necessarily cross or intrude upon the representation of the claimed design and obscures a clear understanding of the design, such an illustration should be included as a separate figure in addition to the other figures which fully disclose the subject matter of the design. Further, surface shading should not be used on unclaimed subject matter shown in broken lines to avoid confusion as to the scope of the claim.

The following form paragraphs may be used, where appropriate, to notify applicant regarding the use of broken lines in the drawings.

¶ 15.50 Use of Broken Lines for Indicating Unimportant Features Not Permitted

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. See *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967) and *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

¶ 15.50.01 Use of Broken Lines in Drawing (Ch. 16 Design Application)

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

Examiner Note:

Do not use this form paragraph in an international design application.

¶ 15.50.02 Description of Broken Lines (Ch. 16 Design Application)

A statement similar to the following should be used to describe the broken lines on the drawing (MPEP § 1503.02, subsection III):

-- The broken line showing of **[1]** is for the purpose of illustrating **[2]** and forms no part of the claimed design. --

A statement similar to the one above **[3]** inserted in the specification preceding the claim.

Examiner Note:

1. Do not use this form paragraph in an international design application.

2. In bracket 1, insert name of structure.

3. In bracket 2, insert --portions of the "article"-- or --environmental structure--.

4. In bracket 3, insert --must be-- or --has been--.

¶ 15.50.04 Proper Drawing Disclosure With Use of Broken Lines

Where superimposed broken lines showing environmental structure obscure the full line disclosure of the claimed design, a separate figure showing the broken lines must be included in the drawing in addition to the figures showing only claimed subject matter, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph.

¶ 15.50.05 Description of Broken Lines as Boundary of Design (Ch. 16 Design Application)

The following statement must be used to describe the broken line boundary of a design (MPEP § 1503.02, subsection III):

--The **[1]** broken line(s) define the bounds of the claimed design and form no part thereof.--

Examiner Note:

1. Do not use this form paragraph in an international design application.

2. In bracket 1 insert type of broken line, e.g. dashed or dot-dash or dot-dot-dash.

IV. SURFACE TREATMENT

The ornamental appearance of a design for an article includes its shape and configuration as well as any indicia, contrasting color or materials, graphic representations, or other ornamentation applied to the article ("surface treatment"). Surface treatment must be applied to or embodied in an article of manufacture. Surface treatment, *per se* (i.e., not applied to or embodied in a specific article of manufacture), is not proper subject matter for a design patent under 35 U.S.C. 171. Surface treatment

may either be disclosed with the article to which it is applied or in which it is embodied and must be shown in full lines or in broken lines (if unclaimed) to meet the statutory requirement. See MPEP § 1504.01. The guidelines that apply for disclosing computer-generated icons apply equally to all types of surface treatment. See MPEP § 1504.01(a).

A disclosure of surface treatment in a design drawing or photograph will normally be considered as *prima facie* evidence that the inventor considered the surface treatment shown as an integral part of the claimed design. An amendment canceling two-dimensional surface treatment or reducing it to broken lines will be permitted if it is clear from the application that applicant had possession of the underlying configuration of the basic design without the surface treatment at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998). Applicant may remove surface treatment shown in a drawing or photograph of a design without such removal being treated as new matter, provided that the surface treatment does not obscure or override the underlying design. The removal of three-dimensional surface treatment that is an integral part of the configuration of the claimed design, for example, removal of beading, grooves, and ribs, will introduce new matter as the underlying configuration revealed by this amendment would not be apparent in the application as originally filed. See MPEP § 1504.04, subsection I.B.

V. PHOTOGRAPHS AND COLOR DRAWINGS

Drawings in design applications may be submitted in black and white or in color. See 37 CFR 1.84(a). Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. However, the Office will accept photographs in utility and design patent applications if photographs are the only practicable medium for illustrating the claimed invention. See 37 CFR 1.84(b). See also 37 CFR 1.81(c) and 37 CFR 1.83(c), and MPEP § 608.02.

Where color drawings and color photographs are submitted, only one set of color drawings or color photographs are required if submitted via EFS-Web. Three sets of color drawings or color photographs are required if not submitted via EFS-Web. See 37 CFR 1.84(a)(2)(ii). In addition the specification must contain, or be amended to contain, the following language as the first paragraph of the brief description of the drawings: --The file of this patent contains at least one drawing/photograph executed in color. Copies of this patent with color drawing(s)/photograph(s) will be provided by the Office upon request and payment of the necessary fee.-- See 37 CFR 1.84(a)(2)(iii) and MPEP § 608.02.

If the photographs are not of sufficient quality so that all details in the photographs are reproducible, this will form the basis of subsequent objection to the quality of the photographic disclosure. No application will be issued until objections directed to the quality of the photographic disclosure have been resolved and acceptable photographs have been submitted and approved by the examiner. If the details, appearance and shape of all the features and portions of the design are not clearly disclosed in the photographs, this would form the basis of a rejection of the claim under 35 U.S.C. 112(a) and (b), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs), as nonenabling and indefinite.

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

When filing photographs or drawings with the original application, a disclaimer included in the specification or on the photographs themselves may be used to disclaim any surface ornamentation, logos, written matter, etc. which form no part of the claimed design. See also MPEP § 1503.01, subsection II.

Color drawings are permitted in design applications when filed in accordance with the requirements of 37 CFR 1.84(a)(2). Color may also be shown in pen and ink drawings by lining the surfaces of the design for color in accordance with the symbols in MPEP § 608.02. If the drawing in an application is lined for color, the following statement should be inserted

in the specification for clarity and to avoid possible confusion that the lining may be surface treatment --The drawing is lined for color.-- However, lining entire surfaces of a design to show color(s) may interfere with a clear showing of the design as required by 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph), as surface shading cannot be used simultaneously to define the contours of those surfaces.

If color photographs or color drawings are filed with the original application, color will be considered an integral part of the disclosed and claimed design. The omission of color in later filed photographs or drawings will be permitted if it is clear from the application that applicant had possession of the underlying configuration of the basic design without the color at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998) and MPEP § 1503.01, subsection II. Note also 37 CFR 1.152, which requires that photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

Form paragraph 15.05.041 may be used when color drawing(s) or photograph(s) have been submitted.

¶ 15.05.041 Color Drawing(s)/Photograph(s) Submitted

Color photographs or drawings have been submitted in this application. If replacement drawings are submitted, any showing of color in a black and white drawing is limited to the symbols used to line a surface to show color (MPEP § 608.02) and must comply with the written description requirements of 35 U.S.C. 112. Additionally, lining entire surfaces of a design to show color(s) may interfere with a clear showing of the design as required by 35 U.S.C. 112 because surface shading cannot be used simultaneously to define the contours of those surfaces. However, a surface may be partially lined for color with a description that the color extends across the entire surface; this technique would allow for the use of shading on the rest of the surface showing the contours of the design (37 CFR 1.152). In the alternative, a separate view, properly shaded to show the contours of the design but omitting the color(s), may be submitted if identified as shown only for clarity of illustration. Photographs and ink drawings are not permitted to be combined as drawings in one application.

In any drawing lined for color, the following descriptive statement must be inserted in the specification (the specific colors may be identified for clarity):

--The drawing is lined for color.--

However, some designs disclosed in color photographs/drawings cannot be depicted in black and white drawings lined for color. For example, a design may include multiple shades of a single color which cannot be accurately represented by the single symbol for a specific color. Or, the color may be a shade other than a true primary or secondary color as represented by the drafting symbols and lining the drawing with one of the drafting symbols would not be an exact representation of the design as originally disclosed.

Examiner Note:

Use this form paragraph when color drawing(s) or photograph(s) have been submitted in an application.

Form paragraph 15.61.01 may be used, where appropriate, to notify applicant regarding amending the specification to add a reference to color drawings or photographs.

¶ 15.61.01 Amend Specification to Add Reference to Color Drawing(s)/ Photograph(s) (Ch. 16 Design Application)

The application contains at least one color drawing or color photograph. To comply with the provisions of 37 CFR 1.84 for color drawings/photographs in design applications, the specification **[1]** amended to include the following language as the first paragraph of the brief description of the drawings section:

> The file of this patent contains at least one drawing/photograph executed in color. Copies of this patent with color drawing(s)/photograph(s) will be provided by the Office upon request and payment of the necessary fee.

Examiner Note:

1. Do not use this form paragraph in an international design application.

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

1504 Examination [R-08.2017]

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

Novelty and nonobviousness 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 as well as available foreign patent databases are also to be consulted.

If the examiner determines that the claim of the design patent application does not satisfy the statutory requirements, the examiner will set forth in detail, and may additionally summarize, the basis for all rejections in an Office action. If a reply to an Office action overcomes a rejection either by way of an amendment to the claim or by providing convincing arguments that the rejection should be withdrawn, that rejection must be indicated as withdrawn in the next Office action, unless such action is a notice of allowability. Likewise, any amendment to the specification or claim, or new drawing or drawing correction submitted in reply to an objection or objections in an Office action must be acknowledged in the next Office action, unless such action is a notice of allowability. When an examiner determines that the claim in a design application is patentable under all statutory requirements, but formal matters still need to be addressed and corrected prior to allowance, an *Ex parte Quayle* action will be sent to applicant indicating allowability of the claim and identifying the necessary corrections.

¶ 15.19.01 Summary Statement of Rejections

The claim stands rejected under **[1]**.

Examiner Note:

1. Use as summary statement of rejection(s) in Office action.

2. In bracket 1, insert appropriate basis for rejection, i.e., statutory provisions, etc.

¶ 15.58 Claimed Design Is Patentable (Ex parte Quayle Actions)

The claimed design is patentable over the references cited.

¶ 15.72 Quayle Action

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

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 OG 213 (Comm'r Pat. 1935).

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

If it is determined that a rejection of the claim should be given after a reply to a *Quayle* action, the indication of allowability set forth in the previous action must be withdrawn and prosecution reopened using the following form paragraph:

¶ 15.90 Indication of allowability withdrawn

The indication of allowability set forth in the previous action is withdrawn and prosecution is reopened in view of the following new ground of rejection.

With respect to *pro se* design applications, the examiner should notify applicant in the first Office action that it may be desirable for applicant to employ the services of a registered patent attorney or agent to prosecute the application. Applicant should also be notified that the U.S. Patent and Trademark Office cannot aid in the selection of an attorney or agent. See MPEP § 401. If it appears that patentable subject matter is present and the disclosure of the claimed design complies with the requirements of 35 U.S.C. 112, the examiner should include a copy of the "Guide To Filing A Design Patent Application" with the first Office action and notify applicant that it may be desirable to employ the services of a professional patent draftsperson familiar with design practice to prepare the drawings. Applicant should also be notified that the U.S. Patent and Trademark Office cannot aid in the selection of a draftsperson. The following form paragraph, where appropriate, may be used.

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

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

A listing of registered patent attorneys and agents is available at **https://oedci.uspto.gov/OEDCI/**. Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

1504.01 Statutory Subject Matter for Designs [R-07.2015]

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—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.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

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

(A) a design for an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia);

(B) a design for the shape or configuration of an article of manufacture; and

(C) a combination of the first two categories.

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

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

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

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

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

(a) IN GENERAL.—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.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

¶ 15.09 35 U.S.C. 171 Rejection

The claim is rejected under 35 U.S.C. 171 as directed to nonstatutory subject matter because the design is not shown embodied in or applied to an article.

Examiner Note:

This rejection should be used when the claim is directed to surface treatment which is not shown with an article in either full or broken lines.

¶ 15.42 Visual Characteristics

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

¶ 15.43 Subject Matter of Design Patent

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

¶ 15.44 Design Inseparable From Article to Which Applied

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

Form paragraphs 15.38 and 15.40 may be used in a second or subsequent action, where appropriate (see MPEP § 1504.02).

1504.01(a) Computer-Generated Icons [R-07.2015]

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

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

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

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

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

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

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

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

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

Since the claim must be in formal terms to the design "as shown, or as shown and described," the drawing provides the best description of the claim. 37 CFR 1.153 or 1.1025.

(1) Review the drawing to determine whether a computer screen, monitor, other display panel, or a portion of any of those articles, is shown.

Although a computer-generated icon may be embodied in only a portion of a computer screen, monitor, or other display panel, the drawing must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article.

(2) Review the title to determine whether it clearly refers to the claimed subject matter. 37 CFR 1.153 or 1.1067.

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

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

(descriptive statement in design patent application narrows claim scope).

(B) If the drawing does not depict a computer-generated icon embodied in a computer screen, monitor, other display panel, or a portion thereof, in either solid or broken lines, reject the claimed design under 35 U.S.C. 171 for failing to comply with the article of manufacture requirement.

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

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

(b) Amendments to the written description, drawings and/or claim attempting to overcome the rejection will ordinarily be entered, however, any new matter will be required to be canceled from the written description, drawings and/or claims. If new matter is added, the claim should be rejected under 35 U.S.C. 112(a).

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

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

(D) Upon reply by applicant:

(1) Enter any amendments; and

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

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

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

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

III. TREATMENT OF TYPE FONTS

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

IV. CHANGEABLE COMPUTER GENERATED ICONS

Computer generated icons including images that change in appearance during viewing may be the subject of a design claim. Such a claim may be shown in two or more views. The images are understood as viewed sequentially, no ornamental aspects are attributed to the process or period in which one image changes into another. A descriptive statement must be included in the specification describing the transitional nature of the design and making it clear that the scope of the claim does not include anything that is not shown. Examples of such a descriptive statement are as follows:

"The subject matter in this patent includes a process or period in which an image changes into another

image. This process or period forms no part of the claimed design;" or

"The appearance of the transitional image sequentially transitions between the images shown in Figs. 1-8. The process or period in which one image transitions to another image forms no part of the claimed design;" or

"The appearance of the transitional image sequentially transitions between the images shown in Figs. 1-8. No ornamental aspects are associated with the process or period in which one image transitions to another image."

1504.01(b) Design Comprising Multiple Articles or Multiple Parts Embodied in a Single Article [R-08.2012]

While the claimed design must be embodied in an article of manufacture as required by 35 U.S.C. 171, it may encompass multiple articles or multiple parts within that article. See *Ex parte Gibson*, 20 USPQ 249 (Bd. App. 1933). When the design involves multiple articles, the title must identify a single entity of manufacture made up by the parts (e.g., set, pair, combination, unit, assembly). A descriptive statement should be included in the specification making it clear that the claim is directed to the collective appearance of the articles shown. If the separate parts are shown in a single view, the parts must be shown embraced by a bracket "}". The claim may also involve multiple parts of a single article, where the article is shown in broken lines and various parts are shown in solid lines. In this case, no bracket is needed. See MPEP § 1503.01.

1504.01(c) Lack of Ornamentality [R-07.2015]

I. FUNCTIONALITY VS. ORNAMENTALITY

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

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

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

While ornamentality must be based on the entire design, "[i]n determining whether a design is primarily functional, the purposes of the particular elements of the design necessarily must be considered." See *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240, 231 USPQ 774, 778 (Fed. Cir. 1986). See, e.g., *Smith v. M & B Sales & Manufacturing*, 13 USPQ2d 2002, 2004 (N. D. Cal. 1990) (if "significant decisions about how to put it [the item] together and present it in the marketplace were informed by primarily ornamental considerations", this information may establish the ornamentality of a design.).

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

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

To properly reject a claimed design under 35 U.S.C. 171 on the basis of a lack of ornamentality, an examiner must make a *prima facie* showing that the claimed design lacks ornamentality and provide a sufficient evidentiary basis for factual assumptions relied upon in such showing. See *In re Jung*, 98 USPQ2d 1174, 1177 (Fed. Cir. 2011). See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), ("the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.").

The proper evidentiary basis for a rejection under 35 U.S.C. 171 that a claim is lacking in ornamentality is *an evaluation of the appearance of the design itself*. The examiner's knowledge of the art, a reply to a letter of inquiry, a brochure emphasizing the functional/mechanical features of the design, the specification of an analogous utility patent (the applicant's or another inventor), or information provided in the specification may be used to *supplement* the analysis of the design. If a design is embodied in a specific mechanical article, the analysis that the design lacks ornamentality because its appearance is dictated by functional requirements should be supported by reference to utility patents or some other source of information about the function of the design. If the design is embodied in an article that has a more general use, such as a clip, the analysis and explanation as to why the design lacks ornamentality should be detailed and specific. The examiner's contention that the specific appearance of the claimed design lacks ornamentality may be supported by *In re Carletti et al.*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964) (a design to be patentable must be "created for the purpose of ornamenting" the article in which it is embodied.). The presence or lack of ornamentality must be made on a case by case basis.

Knowledge that the article would be hidden during its end use based on the examiner's experience in a given art or information that may have been submitted in the application itself would **not** be considered *prima facie* evidence of the functional nature of the design. See *Seiko Epson Corp v. Nu-Kote Int'l Inc.*, 190 F.3d 1360, 52 USPQ2d 1011 (Fed. Cir. 1999). "Visibility during an article's 'normal use' is not a statutory requirement of § 171, but rather a guideline for courts to employ in determining whether the patented features are 'ornamental'." See *Larson v. Classic Corp.*, 683 F. Supp. 1202, 7 USPQ2d 1747 (N.D. Ill. 1988). If there is sufficient evidence to show that a specific design "is clearly intended to be noticed during the process of sale and equally clearly intended to be completely hidden from view in the final use," it is not necessary that a rejection be made under 35 U.S.C. 171. See *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990). The mere fact that an article would be hidden during its ultimate end use is **not** the basis for a rejection under 35 U.S.C. 171, but this information provides additional evidence to be used in support of the contention that the design lacks ornamentality. The only basis for rejecting a claim under 35 U.S.C. 171 as lacking in ornamentality is **an evaluation of the design itself** in light of additional information, such as that identified above.

Examples of proper evidentiary basis for a rejection under 35 U.S.C. 171 that a claim is lacking in ornamentality would be: (A) common knowledge in the art; (B) the appearance of the design itself; (C) the specification of a related utility patent; or (D) information provided in the specification.

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

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

Rejections under 35 U.S.C. 171 for lack of ornamentality based on a proper *prima facie* showing fall into two categories:

(A) a design visible in its ultimate end use which is primarily functional based on the evidence of record; or

(B) a design not visible in its normal and intended use as evidence that its appearance is not a matter of concern. See *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949); *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

When the examiner has established a proper *prima facie* case of lack of ornamentality, "the burden of coming forward with evidence or argument shifts to the applicant." See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A rejection under 35 U.S.C. 171 for lack of ornamentality may be overcome by providing evidence from the inventor himself or a representative of the company that commissioned the design that there was an intent to create a design for the "purpose of ornamenting." See *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964). Attorney's arguments are not a substitute for evidence. Once a proper *prima facie* case of lack of ornamentality is established by the examiner, it is incumbent upon applicant to come forth with countervailing evidence to rebut the rejection made by the examiner. See *Ex parte Webb*, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Int. 1993). Form paragraph 15.08 or 15.08.01, where appropriate, may be used to reject a claim under 35 U.S.C. 171 for lack of ornamentality.

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

The claim is rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter in that it lacks ornamentality. To be patentable, a design must be "created for the purpose of ornamenting" the article in which it is embodied. See *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964).

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

Evidence that demonstrates the design is ornamental may be submitted from the applicant in the form of an affidavit or declaration under 37 CFR 1.132:

(a) stating the ornamental considerations which entered into the design of the article; and

(b) identifying what aspects of the design meet those considerations.

An affidavit or declaration under 37 CFR 1.132 may also be submitted from a representative of the company, which commissioned the design, to establish the ornamentality of the design by stating the motivating factors behind the creation of the design.

Attorney arguments are not a substitute for evidence to establish the ornamentality of the claim. *Ex parte Webb*, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Inter. 1993).

Examiner Note:

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

¶ 15.08.01 Lack of Ornamentality (Article Not Visible in its Normal and Intended Use)

The claim is rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter in that the design lacks ornamentality since it appears there is no period in the commercial life of applicant's **[1]** when its ornamentality may be a matter of concern. *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990); *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949).

The following evidence establishes a *prima facie* case of lack of ornamentality: **[2]**

In order to overcome this rejection, two types of evidence are needed:

(1) Evidence to demonstrate there is some period in the commercial life of the article embodying the claimed design when its ornamentality is a matter of concern. Such evidence may include a showing of a period in the life of the design when the ornamentality of the article may be a matter of concern to a purchaser during the process of sale. An example of this type of evidence is a sample of sales literature such as an advertisement or a catalog sheet which presents the appearance of the article as ornamental and not merely as a means of identification or instruction; and

(2) Evidence to demonstrate the design is ornamental. This type of evidence should demonstrate "thought of ornament" in the design and should be presented in the form of an affidavit or declaration under 37 CFR 1.132 from the applicant:

(a) stating the ornamental considerations which entered into the design of the article; and

(b) identifying what aspects of the design meet those considerations.

An affidavit or declaration under 37 CFR 1.132 may also be submitted from a representative of the company, which commissioned the design, to establish the ornamentality of the design by stating the motivating factors behind the creation of the design.

Attorney arguments are not a substitute for evidence to establish the ornamentality of the claim. See *Ex parte Webb*, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Inter. 1993).

Examiner Note:

1. In bracket 1, insert the name of the article in which the design is embodied.

2. In bracket 2, insert source of evidence of the article's design being of no concern, for example, an analysis of a corresponding utility patent, a brochure, a response to a letter of inquiry, etc.

IV. OVERCOMING A 35 U.S.C. 171 REJECTION BASED ON LACK OF ORNAMENTALITY

A rejection under 35 U.S.C. 171 based on lack of ornamentality may be overcome by the following:

(A) An affidavit or declaration under 37 CFR 1.132 submitted from the applicant or a representative of the company, which commissioned the design, explaining specifically and in depth, which features or area of the claimed design were created with:

(1) a concern for enhancing the saleable value or increasing demand for the article. See *Gorham Manufacturing Co. v. White*, 81 U.S. (14 Wall) 511 (1871), or

(2) a concern primarily for the esthetic appearance of the article;

(B) Advertisements which emphasize the ornamentality of the article embodying the claimed design may be submitted as evidence to rebut the rejection. See *Berry Sterling Corp. v. Pescor Plastics Inc.*, 122 F.3d 1452, 43 USPQ2d 1953 (Fed. Cir. 1997);

(C) Evidence that the appearance of the design is ornamental may be shown by distinctness from the prior art as well as an attempt to develop or to maintain consumer recognition of the article embodying the design. See *Seiko Epson Corp. v. Nu-Kote Int'l Inc.*, 190 F.3d 1360, 52 USPQ2d 1011 (Fed. Cir. 1999);

(D) Evidence may be provided by a representative of the company, which commissioned the design, to establish the ornamentality of the design by stating the motivating factors behind the creation of the design;

(E) When the rejection asserts that the design is purely dictated by functional considerations, evidence may be presented showing possible alternative designs which could have served the same function indicating that the appearance of the claimed design was not purely dictated by function. See *L.A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993);

(F) When the rejection asserts no period in the commercial life of the article when its ornamentality may be a matter of concern, the applicant must establish that the "article's design is a 'matter of concern' because of the nature of its visibility at some point between its manufacture or assembly and its ultimate use." See *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

Attorney arguments are not a substitute for evidence to establish the ornamentality of the claim. See *Ex parte Webb*, 30 USPQ2d 1064, 1068 (Bd. Pat. App. & Inter. 1993).

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

In order to overcome a rejection of the claim under 35 U.S.C. 171 as lacking in ornamentality, applicant must provide evidence that he or she created the design claimed for the "purpose of ornamenting". See *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

The mere display of the article embodying the design at trade shows or its inclusion in catalogs is insufficient to establish ornamentality. See *Ex parte Webb*, 30 USPQ2d 1064 (Bd. Pat. App. & Inter. 1993). There must be some clear and specific indication of the ornamentality of the design in this evidence for it to be given probative weight in overcoming the *prima facie* lack of ornamentality. See *Berry Sterling Corp. v. Pescor Plastics Inc.*, 122 F.3d 1452, 43 USPQ2d 1953 (Fed. Cir. 1997).

The examiner must evaluate evidence submitted by the applicant in light of the design as a whole to decide if the claim is primarily ornamental. It is

important to be aware that this determination is not based on the size or amount of the features identified as ornamental but rather on their influence on the overall appearance of the design.

In a rejection of a claim under 35 U.S.C. 171 in which some of the evidentiary basis for the rejection is that the design would be hidden during its end use, the applicant must establish that the "article's design is a 'matter of concern' because of the nature of its visibility at some point between its manufacture or assembly and its ultimate use." See *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990). This concern may be shown by the submission of evidence that the appearance of the article was of concern during its period of commercial life by declarations from prospective/actual customers/users attesting that the ornamentality of the article was of concern to them. Unless applicant is directly involved with the sale of the design or works with users of the design, he or she cannot provide factual evidence as to the reasons for the purchase/selection of the article embodying the design. See MPEP § 716.03(b), citing *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.).

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

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

The requirement that the design was created for the 'purpose of ornamenting' must be met with appropriate evidence concerning visibility for a rejection under 35 U.S.C. 171 to be overcome if the design would be hidden during its end use. See *In re Webb*, 916 F.2d 1553 (Fed. Cir. 1990).

1504.01(d) Simulation [R-08.2012]

35 U.S.C. 171 requires that a design to be patentable be "original." Clearly, a design which simulates an existing object or person is not original as required by the statute. The Supreme Court in *Gorham Manufacturing Co. v. White*, 81 U.S. (14 Wall) 511 (1871), described a design as "the thing invented or produced, for which a patent is given." "The arbitrary chance selection of a form of a now well known and celebrated building, to be applied to toys, inkstands, paper - weights, etc. does not, in my opinion, evince the slightest exercise of invention...." *Bennage v. Phillippi*, 1876 C.D. 135, 9 O.G. 1159 (Comm'r Pat. 1876). This logic was reinforced by the CCPA in *In re Smith*, 25 USPQ 359, 360, 1935 C.D. 565, 566 (CCPA 1935), which stated that "to take a natural form, in a natural pose, ... does not constitute invention" when affirming the rejection of a claim to a baby doll. This premise was also applied in *In re Smith*, 25 USPQ 360, 362, 1935 C.D. 573, 575 (CCPA 1935), which held that a "baby doll simulating the natural features...of a baby without embodying some grotesqueness or departure from the natural form" is not patentable.

Therefore, a claim directed to a design for an article which simulates a well known or naturally occurring object or person should be rejected under 35 U.S.C. 171 as nonstatutory subject matter in that the claimed design lacks originality. Form paragraph 15.08.02 should be used. However, when a claim is rejected on this basis, examiners should provide evidence, if

possible, of the appearance of the object, person or naturally occurring form in question so that a comparison may be made to the claimed design. Form paragraph 15.08.03 should be used. It would also be appropriate, if the examiner has prior art which anticipates or renders the claim obvious, to reject the claim under either 35 U.S.C. 102 or 103(a) concurrently. See *In re Wise*, 340 F.2d 982, 144 USPQ 354 (CCPA 1965).

¶ 15.08.02 Simulation (Entire Article)

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

Examiner Note:

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

2. This form paragraph should be followed by form paragraph 15.08.03 when evidence has been cited to show the article or person being simulated.

¶ 15.08.03 Explanation of evidence cited in support of simulation rejection

Applicant's design has in no way departed from the natural appearance of **[1]**. This reference is not relied on in this rejection but is supplied merely as representative of the usual or typical appearance of **[2]** in order that the claim may be compared to that which it is simulating.

Examiner Note:

1. In bracket 1, insert name of article or person being simulated and source (patent, publication, etc.).

2. In bracket 2, insert name of article or person being simulated.

1504.01(e) Offensive Subject Matter [R-07.2015]

Design applications which disclose subject matter which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions, should be rejected as nonstatutory subject matter under 35 U.S.C. 171. See also MPEP § 608. Form paragraph 15.09.01 should be used.

¶ 15.09.01 Offensive Subject Matter

The disclosure, and therefore the claim in this application, is rejected as being offensive and therefore improper subject matter for design patent protection under 35 U.S.C. 171. Such subject matter does not meet the statutory requirements of 35 U.S.C. 171. Moreover, since 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy, and this includes depictions of caricatures in the disclosure, drawings, and/or a claim which might reasonably be considered offensive, such subject matter as presented herein is deemed to be clearly contrary to 37 CFR 1.3. See MPEP § 608.

1504.02 Novelty [R-08.2017]

35 U.S.C. 102 Conditions for patentability; novelty.

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b) or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

35 U.S.C. 102 (pre-AIA) Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

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

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

(c) he has abandoned the invention, or

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

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

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

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

A claimed design may be rejected under 35 U.S.C. 102 when the invention is anticipated (or is "not novel") over a disclosure that is available as prior art. In design patent applications, the factual inquiry in determining anticipation over a prior art reference is the same as in utility patent applications. That is, the reference "'must be identical in all material respects.'" *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997). For anticipation to be found, the claimed design and the prior art design must be substantially the same. *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313, 59 USPQ2d 1472, 1475 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)).

In *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239-40, 93 USPQ2d 1001, 1005 (Fed. Cir. 2009), the Federal Circuit held that the ordinary observer test, the test used for infringement, is "the sole test for anticipation." Under the ordinary observer test, "'if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.'" *Gorham*, 81 U.S. at 528. In *Egyptian Goddess*, an *en banc* panel of the Federal Circuit "characteriz[ed] the ordinary observer as being 'deemed to view the differences between the patented design and the accused product in the context of the prior art.'" *Seaway*, 589 F.3d

at 1239-40, 93 USPQ2d at 1005, quoting *Egyptian Goddess Inc. v. Swissa Inc.*, 543 F.3d 665, 676, 88 USPQ2d 1658, 1666-67 (Fed. Cir. 2008) (*en banc)*. The court also explained that "'when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.'" *Id*.

The ordinary observer test requires consideration of the design as a whole. See *Seaway*, 589 F.3d at 1243, 93 USPQ2d at 1008; *Egyptian Goddess*, 543 F.3d at 677, 88 USPQ2d 1667. In applying the ordinary observer test, "determine whether 'the deception that arises is a result of the similarities in the overall design not of similarities in ornamental features in isolation.'" See *Richardson v. Stanley Works Inc.*, 597 F.3d 1288, 1295, 93 USPQ2d 1937, 1941 (Fed. Cir. 2010), citing *Amini Innovation Corp. v. Anthony California Inc.*, 439 F.3d 1365, 1371, 78 USPQ2d 1147, 1151 (Fed. Cir. 2006) (holding that the overall infringement test is not to be converted to an element-by-element comparison when factoring out the functional aspects of various design elements). See *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 998, 114 USPQ2d 1953, 1962 (Fed. Cir. 2015); *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1333, 115 USPQ2d 1880, 1896 (Fed. Cir. 2015); and *Sport Dimension, Inc. v. Coleman Co. Inc.*, 820 F.3d, 1316, 1320-21, 118 USPQ2d 1607, 1609-10 (Fed. Cir. 2016). "The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another." *Seaway*, 589 F.3d at 1243, 93 USPQ2d at 1008. "Just as minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement, so too minor differences cannot prevent a finding of anticipation." *Id.* (internal quotation marks omitted).

Anticipation does not require that the claimed design and the prior art be from analogous arts. *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). "It is true that the use to which an article is to be put has no bearing on its patentability as a design and that if the prior art discloses any article of substantially the same appearance as that of an applicant, it is immaterial what the use of such article is. Accordingly, so far as anticipation by a single prior art disclosure is concerned, there can be no question as to nonanalogous art in design cases." *Id*. (internal quotation marks omitted).

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

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

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

Registration of a design abroad is considered to be equivalent to patenting for priority purposes under 35 U.S.C. 119(a)-(d) and for prior art purposes pre-AIA 35 U.S.C. 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster*, 151

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

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

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

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

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

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

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

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

¶ 15.03.01.fti Foreign Filing More Than 6 Months Before U.S. Filing, Application Filed Before March 16, 2013

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

Examiner Note:

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

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

¶ 15.10.aia Application Examined Under AIA First Inventor to File Provisions

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Examiner Note:

This form paragraph should be used in any application subject to the first inventor to file provisions of the AIA.

¶ 15.10.fti Application Examined Under First Inventor to File Provisions

The present application, filed on or after March 16, 2013, is being examined under the pre-AIA first to invent provisions.

Examiner Note:

This form paragraph should be used in any application filed on or after March 16, 2013, that is subject to the pre-AIA prior art provisions.

¶ 15.10.15 Notice re prior art available under both pre-AIA and AIA

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

Examiner Note:

1. This form paragraph must be used in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013 that claims priority to, or the benefit of, an application filed before March 16, 2013.

2. This form paragraph should only be used ONCE in an Office action.

¶ 15.11.aia 35 U.S.C. 102(a)(1) Rejection

The claim is rejected under 35 U.S.C. 102(a)(1) as being anticipated by **[1]** because the claimed invention was patented, described in a printed publication, or in public use, on sale or otherwise available to the public before the effective filing date of the claimed invention.

Examiner Note:

1. In bracket 1, identify the reference applied against the claimed design.

2. For applications with an actual filing date on or after March 16, 2013 that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.11.fti Pre-AIA 35 U.S.C. 102(a) Rejection

The claim is rejected under pre-AIA 35 U.S.C. 102(a) as being 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.

Examiner Note:

1. In bracket 1, identify the reference applied against the claimed design.

2. For applications with an actual filing date on or after March 16, 2013 that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.12.fti Pre-AIA 35 U.S.C. 102(b) Rejection

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

Examiner Note:

1. In bracket 1, identify the reference applied against the claimed design.

2. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.13.fti Pre-AIA 35 U.S.C. 102(c) Rejection

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

¶ 15.14.fti Pre-AIA 35 U.S.C. 102(d)/35 U.S.C. 172 Rejection

The claim is rejected under pre-AIA 35 U.S.C. 102(d), as modified by pre-AIA 35 U.S.C. 172, as being 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 the applicant's legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than six (6) months before the filing of the application in the United States.

Examiner Note:

In bracket 1, identify the reference applied against the claimed design.

¶ 15.15.aia 35 U.S.C. 102(a)(2) Rejection

The claim is rejected under 35 U.S.C. 102(a)(2) as being anticipated by **[1]** because the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

Examiner Note:

1. In bracket 1, identify the reference applied against the claimed design.

2. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

3. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under 35 U.S.C. 102/103 as amended by the AIA.

¶ 15.15.fti Pre-AIA 135 U.S.C. 102(e) Rejection

The claim is rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by **[1]** because the invention was described in a patented or published application for patent by another filed in the United States before the invention thereof by the applicant for patent.

Examiner Note:

1. In bracket 1, identify the reference applied against the claimed design.

2. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.16.fti Pre-AIA 35 U.S.C. 102(f) Rejection

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

¶ 15.17.aia Pre-AIA 35 U.S.C. 102(g) Rejection

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

A rejection based on this statutory basis can be made in an application or patent that is examined under the first to file provisions of the AIA if it also contains or contained at any time (1) a claim to an invention having an effective filing date as

defined in 35 U.S.C. 100(i) that is before March 16, 2013, or (2) a specific reference under 35 U.S.C. 120, 35 U.S.C. 121, or 35 U.S.C. 365(c) to any patent or application that contains or contained at any time such a claim.

Examiner Note:

For applications with an actual filing date on or after March 16, 2013 that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.17.fti Pre-AIA 35 U.S.C. 102(g) Rejection

The claim is rejected under pre-AIA 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.

Examiner Note:

For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.fti and 15.10.15.

¶ 15.09.02.aia Statement of Statutory Bases, 35 U.S.C. 171 and 35 U.S.C. 115-Improper Inventorship

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

(a) IN GENERAL.—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.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

35 U.S.C. 115(a) reads as follows (in part):

An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.

The present application sets forth incorrect inventorship because **[1]**.

The claim is rejected under 35 U.S.C. 171 and 35 U.S.C. 115 for failing to set forth the correct inventorship for the reasons stated above.

Examiner Note:

In bracket 1, insert the basis for concluding that the inventorship is incorrect.

¶ 15.09.03.aia Statement of Statutory Basis, 35 U.S.C. 115-Improper Inventorship

35 U.S.C. 115(a) reads as follows (in part):

An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.

The present application sets forth incorrect inventorship because **[1]**.

The claim is rejected under 35 U.S.C. 171 and 35 U.S.C. 115 for failing to set forth the correct inventorship for the reasons stated above.

Examiner Note:

1. This form paragraph is to be used ONLY when a rejection under 35 U.S.C. 171 on another basis has been made and the statutory text thereof is already present.

2. This form paragraph must be preceded by form paragraph 15.07.01 for a rejection based on improper inventorship.

3. In bracket 1, insert an explanation of the supporting evidence establishing that an improper inventor is named.

¶ 15.24.05.fti Identical Claim: Common Assignee

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

The following form paragraph should be included after the form paragraph setting forth the rejection under 35 U.S.C. 102 (a), (b) , (d) or (e) to provide an explanation of the applied reference.

¶ 15.15.01.aia Explanation of rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

The appearance of **[1]** is substantially the same as that of the claimed design. See e.g., *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237-38, 1240, 93 USPQ2d 1001 (Fed. Cir. 2009) and MPEP § 1504.02.

Examiner Note:

1. This paragraph should be included after paragraph 15.11.aia or 15.15.aia to explain the basis of the rejection.

2. In bracket 1, identify the reference applied against the claimed design.

¶ 15.15.01.fti Explanation of rejection under Pre-AIA 35 U.S.C. 102(a), (b), (d), or (e)

The appearance of **[1]** is substantially the same as that of the claimed design. See e.g., *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237-38, 1240, 93 USPQ2d 1001 (Fed. Cir. 2009) and MPEP § 1504.02.

Examiner Note:

1. This paragraph should be included after paragraph 15.11.fti, 15.12.fti, 15.14.fti or 15.15.fti to explain the basis of the rejection.

2. In bracket 1, identify the reference applied against the claimed design.

3. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

The following form paragraphs may be used to reject a claim under pre-AIA 35 U.S.C. 102(e) over an application or patent having an earlier effective U.S. filing date with a common inventor and/or assignee, or that discloses but does not claim the design.

¶ 15.15.02.aia 35 U.S.C. 102(a)(2) Provisional rejection - design disclosed in another application with common inventor and/or assignee

The claim is provisionally rejected under 35 U.S.C. 102(a)(2) as being anticipated by copending Application No. **[1]** which has a common **[2]** with the instant application.

Because the copending application names another inventor and has an earlier effective filing date, it would constitute prior art under 35 U.S.C. 102(a)(2), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(a)(2) is based upon a presumption of future publication or patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application (utility or design) with an earlier filing date that discloses the claimed invention which has not been patented or published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. In bracket 2, insert inventor or assignee.

3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

4. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under 35 U.S.C. 102/103 as amended by the AIA.

¶ 15.15.02.fti Provisional Pre-AIA 35 U.S.C. 102(e) rejection - design disclosed but not claimed in another application with common inventor and/or assignee

The claim is provisionally rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by copending Application No. **[1]** which has a common **[2]** with the instant application.

Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under pre-AIA 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under pre-AIA 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Since the design claimed in the present application is not the same invention claimed in the **[3]** application, the examiner suggests overcoming this provisional rejection in one of the following ways: (A) a showing under 37 CFR 1.132 that the design in the reference was derived from the designer of this application and is thus not the invention "by another;" (B) a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR 1.131(a); (C) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph; or (D) perfecting the benefit claim under 35 U.S.C. 120 by adding a specific reference to the prior filed application in compliance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph. If the application was filed before September 16, 2012, the specific reference must be included in the first sentence(s) of the specification following the title or in an application data sheet; if the application was filed on or after September 16, 2012, the specific reference must be included in an application data sheet.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application (utility or design) with an earlier filing date that discloses (but does not claim) the claimed invention which has not been patented or published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. Use pre-AIA 35 U.S.C. 102(e) as amended by the American Inventor's Protection Act (AIPA) (form paragraph 7.12.fti) to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) (form paragraph7.12.01.fti) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's pre-AIA or pre-AIPA 35 U.S.C. 102(e) date.

3. In bracket 2, insert inventor or assignee.

4. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.15.03.fti Pre-AIA 35 U.S.C. 102(e) provisional rejection - design claimed in an earlier-filed design patent application with common inventor and/or assignee

The claim is provisionally rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by the claim in copending Design Patent Application No. **[1]** which has a common **[2]** with the instant application.

Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under pre-AIA 35 U.S.C. 102(e), if patented. This provisional rejection under pre-AIA 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. The rejection may be overcome by abandoning the earlier-filed copending application.

Examiner Note:

1. In bracket 2, insert inventor or assignee.

2. This form paragraph must be preceded by form paragraph 15.24.05.fti to notify the applicant that the question of patentability under pre-AIA 35 U.S.C. 102(f)/(g) also exists.

3. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.15.04.aia 35 U.S.C. 102(a)(2) rejection - design disclosed in a patent

The claim is rejected under 35 U.S.C. 102(a)(2) as being anticipated by patent **[1]**.

Because the patent names another inventor and has an earlier effective filing date, it constitutes prior art under 35 U.S.C. 102(a)(2).

This rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the disclosure in the reference was obtained directly or indirectly from the inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is disclosed in the drawings of an earlier-filed design or utility patent. When the design claimed in the application being examined is disclosed in the drawings of an earlier-filed design patent, it would most often be in the form of subcombination subject matter, (part or portion of an article), that is patentably distinct from the claim for the design embodied by the combination or whole article. It may also be unclaimed subject matter depicted in broken lines in the earlier-filed application.

2. In bracket 1, insert number of patent.

3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.15.04.fti Pre-AIA 35 U.S.C. 102(e) rejection - design disclosed but not claimed in a patent

The claim is rejected under pre-AIA 35 U.S.C. 102 as being anticipated by patent **[1]**.

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under pre-AIA 35 U.S.C. 102.

Since the design claimed in the present application is not the same invention claimed in patent **[2]**, the examiner suggests overcoming this rejection in one of the following ways: (A) a showing under 37 CFR 1.132 that the design in the reference was derived from the designer of this application and is thus not the invention "by another;" (B) a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR 1.131(a); (C) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph; or (D) perfecting the benefit claim 35 U.S.C. 120 by adding a specific reference to the prior filed application in compliance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a) or 35 U.S.C. 112, first paragraph. If the application was filed before September 16, 2012, the specific reference must be included in the first sentence(s) of the specification following the title or in an application data sheet; if the application was filed on or after September 16, 2012, the specific reference must be included in an application data sheet.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is disclosed in the drawings of an earlier-filed design or utility patent but is not claimed therein. When the design claimed in the application being examined is disclosed in the drawings of an earlier-filed design patent, it would most often be in the form of subcombination subject matter, (part or portion of an article), that is patentably distinct from the claim for the design embodied by the combination or whole article. It may also be unclaimed subject matter depicted in broken lines in the earlier-filed application.

2. In brackets 1 and 2, insert number of patent.

3. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

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

¶ 15.38 Rejection Maintained

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

Examiner Note:

In bracket 1, insert basis of rejection.

¶ 15.40.01 Final Rejection Under Other Statutory Provisions

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

Examiner Note:

1. In bracket 1, insert statutory basis.

2. In bracket 2, insert reasons for rejection.

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

1504.03 Nonobviousness [R-08.2017]

It should be noted that for ease of discussion purposes, any reference to 35 U.S.C. 103 in this section refers to both AIA 35 U.S.C. 103 and pre-AIA 35 U.S.C. 103(a).

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

I. GATHERING THE FACTS

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

(A) Determining the scope and content of the prior art;

(B) Ascertaining the differences between the claimed invention and the prior art;

(C) Resolving the level of ordinary skill in the art; and

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

A. Scope of the Prior Art

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

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

> The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.
> Thus, if the problem is merely one of giving an attractive appearance to a surface, it is immaterial whether the surface in question is that of wall paper, an oven door, or a piece of crockery. . . .
> On the other hand, when the proposed combination of references involves material modifications of the basic form of one article in view of another, the nature of the article involved is a definite factor in determining whether the proposed change involves [patentable] invention.

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

B. Differences Between the Prior Art and the Claimed Design

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

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

C. Level of Ordinary Skill in the Art

In order to be unpatentable, 35 U.S.C. 103 requires that an invention must have been obvious to a designer 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." See *In re Nalbandian*, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982).

D. Objective Evidence of Nonobviousness (Secondary Considerations)

Secondary considerations, such as commercial success and copying of the design by others, are relevant to the evaluation of obviousness of a design claim. Evidence of nonobviousness may be present at the time a *prima facie* case of obviousness is evaluated or it may be presented in rebuttal of a prior obviousness rejection. See *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335-36, 110 USPQ2d 1235, 1242-43 (Fed. Cir. 2014); *Crocs Inc. v. International Trade Commission*, 598 F.3d 1294, 1310, 93 USPQ2d 1777, 1788-89 (Fed. Cir. 2010).

II. PRIMA FACIE OBVIOUSNESS

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

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

As a whole, a design must be compared with something in existence, and not something brought into existence by selecting and combining features

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

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

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

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

A. Combining Prior Art References

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

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

1. Analogous Art

When a modification to a primary reference involves a change in configuration, both the primary and secondary references must be from analogous arts. See *In re Glavas,* 230 F.2d 447, 109 USPQ 50 (CCPA 1956).

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

2. Nonanalogous Art

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

III. REBUTTAL OF THE PRIMA FACIE CASE

Once a *prima facie* case of obviousness has been established, the burden shifts to the applicant to rebut it, if possible, with objective evidence of nonobviousness. Examples of secondary considerations are commercial success, expert testimony and copying of the design by others. Any objective evidence of nonobviousness or rebuttal evidence submitted by applicant, including affidavits or declarations under 37 CFR 1.132, must be considered by examiners in determining patentability under 35 U.S.C. 103.

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

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

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

"A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was

taken by the applicant." See *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001).

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

The following form paragraph may be used in an obviousness rejection under 35 U.S.C. 103, where appropriate.

¶ 15.18.aia 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 claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

Examiner Note:

For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.18.fti Pre-AIA 35 U.S.C. 103(a) Rejection (Single Reference)

The claim is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over **[1]**. Although the invention is not identically disclosed or described as set forth in pre-AIA 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 designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Examiner Note:

1. In bracket 1, insert the reference citation.

2. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.70.aia Preface, 35 U.S.C. 103 Rejection

It would have been obvious to a designer of ordinary skill not later than the effective filing date of the present claimed invention to **[1]**.

Examiner Note:

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

¶ 15.70.fti Preface, Pre-AIA 35 U.S.C. 103(a) Rejection

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

Examiner Note:

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

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

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

¶ 15.19.aia 35 U.S.C. 103 Rejection (Multiple Reference)

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 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

Examiner Note:

For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.aia and 15.10.15.

¶ 15.19.fti Pre-AIA 35 U.S.C. 103(a) Rejection (Multiple References)

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

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

Examiner Note:

For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

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

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would

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

The following form paragraphs may be used when making a rejection under pre-AIA 35 U.S.C. 103(a), where the reference application or patent is prior art under pre-AIA 35 U.S.C. 102(e).

¶ 15.19.02.aia Preface 35 U.S.C. 102(a)(2)/103 rejection - Different inventors, common assignee, obvious designs, no evidence of common ownership not later than effective filing date of claimed design

The claim is directed to a design not patentably distinct from the design of commonly assigned **[1]**. Specifically, the claimed design is different from the one in **[2]** in that **[3]**. These differences are considered obvious and do not patentably distinguish the overall appearance of the claimed design over the design in **[4]**.

The commonly assigned **[5]**, discussed above, names another inventor and was effectively filed before the present application. Therefore, it qualifies as prior art under 35 U.S.C. 102(a)(2) and would form the basis for a rejection of the claimed design in the present application under 35 U.S.C. 103 if the claimed design and the designed disclosed were not commonly owned not later than the effective filing date of the claimed design under examination.

This rejection under 35 U.S.C. 102(a)(2)/103 might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that the design disclosed and the claimed design, not later than the effective filing date of the claimed design, were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

Examiner Note:

1. A nonstatutory double patenting rejection may also be included in the action.

2. In brackets 1, 2, 4 and 5, insert "patent" and number, or "copending application" and serial number.

3. In bracket 3, identify differences between design claimed in present application and that claimed in earlier-filed patent or copending application.

4. This form paragraph should only be used ONCE in an Office action.

5. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.19.02.fti Preface pre-AIA 35 U.S.C. 102(e)/103(a) rejection - Different inventors, common assignee, obvious designs, no evidence of common ownership at time later design was made

The claim is directed to a design not patentably distinct from the design of commonly assigned **[1]**. Specifically, the claimed design is different from the one in **[2]** in that **[3]**. These differences are considered obvious and do not patentably distinguish the overall appearance of the claimed design over the design in **[4]**.

The commonly assigned **[5]**, discussed above, has a different inventive entity from the present application. Therefore, it qualifies as prior art under pre-AIA 35 U.S.C. 102(e), (f) or (g) and forms the basis for a rejection of the claim in the present application under pre-AIA 35 U.S.C. 103(a) if the conflicting design claims were not commonly owned at the time the design in this application was made. In order to resolve this issue, the applicant, assignee or attorney of record can state that the conflicting designs were commonly owned at the time the design in this application was made, or the assignee can name the prior inventor of the conflicting subject matter.

A showing that the designs were commonly owned at the time the design in this application was made will overcome a rejection under pre-AIA 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under pre-AIA 35 U.S.C. 102(f) or 35 U.S.C. 102(g), or pre-AIA 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Examiner Note:

1. This form paragraph should be used when the application being examined is commonly assigned with a conflicting application or patent, but there is no indication that they were commonly assigned at the time the invention was actually made.

2. If the conflicting claim is in a patent with an earlier U.S. filing date, a rejection under pre-AIA 35 U.S.C. 102(e)/35 U.S.C. 103(a) should be made.

3. If the conflicting claim is in a commonly assigned, copending application with an earlier filing date, a provisional rejection under pre-AIA 35 U.S.C. 102(e)/35 U.S.C. 103(a) should be made.

4. A nonstatutory double patenting rejection may also be included in the action.

5. In brackets 1, 2, 4 and 5, insert patent and number, or copending application and serial number.

6. In bracket 3, identify differences between design claimed in present application and that claimed in earlier filed patent or copending application.

7. This form paragraph should only be used ONCE in an Office action.

8. If the rejection relies upon prior art under pre-AIA 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventor's Protection Act (AIPA) to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the pre-AIA and pre-AIPA 35 U.S.C. 102(e) dates, respectively.

9. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.03.aia 35 U.S.C. 102(a)(2)/103 Provisional Rejection - design disclosed in another application with common inventor and/or assignee

The claim is provisionally rejected under 35 U.S.C. 103 as being obvious over copending Application No. **[1]** which has a common **[2]** with the instant application. Because the copending application names another inventor and has an earlier effective filing date, it would constitute prior art under 35 U.S.C. 102(a)(2) if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 103 is based upon a presumption of future publication or patenting of the conflicting application.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

[3]

This provisional rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier-filed design or utility application. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier-filed design application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.

2. In brackets 1 and 4 insert serial number of copending application.

3. In bracket 2, insert inventor or assignee.

4. In bracket 3, provide explanation of obviousness including differences.

5. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.03.fti Provisional Pre-AIA 35 U.S.C. 102(e)/103(a) rejection - design disclosed but not claimed in another application with common inventor and/or assignee

The claim is provisionally rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over copending Application No. **[1]** which has a common **[2]** with the instant application. Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under pre-AIA 35 U.S.C. 102(e) if published under 35 U.S.C. 122(b) or patented. This provisional rejection under pre-AIA 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

Although the invention is not identically disclosed or described as set forth in pre-AIA 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 designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[3]

Since the design claimed in the present application is not the same invention claimed in the **[4]** application, this provisional rejection may be overcome by a showing under 37 CFR 1.132 that the design in the reference was derived from the designer

of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR 1.131(a). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier-filed design or utility application but is not claimed therein. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier-filed design application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.

2. In brackets 1 and 4 insert serial number of copending application.

3. In bracket 2, insert inventor or assignee.

4. In bracket 3, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70.fti and 15.67 or 15.68.

5. Use pre-AIA 35 U.S.C. 102(e) as amended by the American Inventor's Protection Act (AIPA) to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102 only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120 , 121, 365(c), or 386(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's pre-AIA and pre-AIPA 35 U.S.C. 102(e) dates, respectively.

6. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.04.fti Pre-AIA 35 U.S.C. 102(e)/103(a) Provisional Rejection - design claimed in an earlier-filed design patent application with common inventor and/or assignee

The claim is provisionally rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over the claim in copending Design Patent Application No. **[1]** which has a common **[2]** with the instant application. Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under pre-AIA 35 U.S.C. 102(e) if patented. This provisional rejection under pre-AIA 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application.

Although the invention is not identically disclosed or described as set forth in pre-AIA 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.

[3]

Since the design claimed in the present application is not patentably distinct from the design claimed in the **[4]** application, this provisional rejection may be overcome by merging the two applications into a single continuation-in-part and abandoning the separate parent applications. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in an earlier-filed copending application.

2. A provisional nonstatutory double patenting rejection must also be included in the action.

3. In brackets 1 and 4, insert serial number of copending application.

4. In bracket 2, insert inventor or assignee.

5. In bracket 3, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70.fti and 15.67 or 15.68.

6. This form paragraph must be preceded by form paragraph 15.19.02.fti.

7. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.05.aia 35 U.S.C. 102(a)(2)/103 rejection - design disclosed, no common inventors or common assignees

The claim is rejected under 35 U.S.C. 103 as being obvious over **[1]**.

Because the reference names another inventor and has an earlier effective filing date, it constitutes prior art under 35 U.S.C. 102(a)(2).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

[2]

This rejection under 35 U.S.C. 102(a)(2)/103 might be overcome by: (1) a showing under 37 CFR 1.130(a) that the subject matter disclosed in the copending application was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a) or (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B).

Examiner Note:

1. In bracket 1, insert document number that qualifies as prior art under 35 U.S.C. 102(a)(2).

2. In bracket 2, provide explanation of obviousness including differences.

3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.19.05.fti Pre-AIA 35 U.S.C. 102(e)/103(a) rejection - design disclosed but not claimed

The claim is rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over **[1]**.

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under pre-AIA 35 U.S.C. 102(e).

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

[2]

Since the design claimed in the present application is not the same invention claimed in the **[3]** patent, this rejection may be overcome by a showing under 37 CFR 1.132 that the design in the reference was derived from the designer of this application and is thus not the invention " by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR 1.131(a). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP §§ 706.02(l)(1) and 706.02(l)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier filed design or utility patent, or application publication, but is not claimed therein. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier filed design application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.

2. In brackets 1 and 3, insert number of the U.S. patent, U.S. patent application publication, or the WIPO publication of an international application that qualifies as prior art under pre-AIA 35 U.S.C. 102(e). See note 4 below.

3. In bracket 2, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70.fti and 15.67 or 15.68.

4. Use pre-AIA 35 U.S.C. 102(e) as amended by the American Inventor's Protection Act (AIPA) to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's 35 U.S.C. 102 (e) date.

5. For applications with an actual filing date on or after March 16, 2013 that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.06.fti Pre-AIA 35 U.S.C. 102(e)/103(a) rejection - design claimed in a design patent with an earlier effective filing date and common assignee

The claim is rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over the claim in design patent **[1]**.

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under pre-AIA 35 U.S.C. 102(e).

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

[2]

Since the design claimed in the present application is not patentably distinct from the design claimed in the **[3]** patent, this rejection may be overcome by submitting an oath or declaration under 37 CFR 1.131(c) stating that this application and the reference are currently owned by the same party and that the inventor named in this application is the prior inventor of the subject matter in the reference under 35 U.S.C. 104 as in effect on March 15, 2013. In addition, a terminal disclaimer in accordance with 37 CFR 1.321(c) is also required. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP §§ 706.02(l)(1) and 706.02(l)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in a design patent having an earlier effective date and a common assignee.

2. An nonstatutory double patenting rejection must also be included in the action.

3. In brackets 1 and 3, insert number of patent.

4. In bracket 2, provide explanation of obviousness including differences and follow the explanation by form paragraphs 15.70.fti and 15.67 or 15.68.

5. This form paragraph must be preceded by form paragraph 15.19.02.fti.

6. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.07.fti Pre-AIA 35 U.S.C. 102(e)/103(a) rejection - design claimed in a design patent having an earlier effective filing date and no common assignee

The claim is rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over the claim in design patent **[1]**.

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under pre-AIA 35 U.S.C. 102(e).

Although the invention is not identically disclosed or described as set forth in pre-AIA 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 designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[2]

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in a design patent having an earlier effective filing date.

2. In bracket 2, provide explanation of obviousness including differences and follow explanation with form paragraphs 15.70.fti and 15.67 or 15.68.

3. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

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

¶ 15.38 Rejection Maintained

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

Examiner Note:

In bracket 1, insert basis of rejection.

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

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

Examiner Note:

1. In bracket 1, insert reference citation.

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

¶ 15.39.02.fti Final Rejection Under pre-AIA 35 U.S.C. 103(a) (Single Reference)

The claim is FINALLY REJECTED under pre-AIA 35 U.S.C. 103(a) over **[1]**.

Examiner Note:

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

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

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

Examiner Note:

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

¶ 15.40.fti Final Rejection Under pre-AIA 35 U.S.C. 103(a) (Multiple References)

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

Examiner Note:

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

1504.04 Considerations Under 35 U.S.C. 112 [R-08.2017]

35 U.S.C. 112 Specification.

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

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

*****

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

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

I. 35 U.S.C. 112(a) and (b)

A. Enablement and Scope of Protection

Any analysis for compliance with 35 U.S.C. 112 should begin with a determination of the scope of protection sought by the claims. See *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Therefore, before any determination can be made as to whether the disclosure meets the requirements of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph), for enablement, a determination of whether the claims meet the requirements of 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112 , second paragraph) must be made. However, since the drawing disclosure and any narrative description in the specification are incorporated into the claim by the use of the language "as shown and described," any determination of the scope of protection sought by the claim is also a determination of the subject matter that must be enabled by the disclosure. Hence, if the appearance and shape or configuration of the design for which protection is sought cannot be determined or understood due to an inadequate visual disclosure, then the claim, which incorporates the visual disclosure, fails to particularly point out and distinctly claim the subject matter the inventor(s) regard as their invention, in violation of the second paragraph of 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph). Furthermore, such disclosure fails to enable a designer of ordinary skill in the art to make an article having the shape and appearance of the design for which protection is sought. In such case, a rejection of the claim under both 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, the first and second paragraphs of 35 U.S.C. 112) would be warranted. An evaluation of the scope of the claim under 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph), to determine whether the disclosure of the design meets the enablement requirement of 35 U.S.C. 112, first paragraph, cannot be based on the drawings alone. The scope of a claimed design is understood to be limited to those surfaces or portions of the article shown in the drawing in full lines in combination with any additional written description in the specification. The title of the design identifies the article in which the design is embodied by the name generally known and used by the public and may contribute to defining the scope of the claim. See MPEP § 1503.01, subsection I. It is assumed that the claim has been crafted to protect that which the applicant "regards as his invention." See *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Therefore, when visible portions of the article embodying the design are not shown, it is because they form no part of the claim to be protected. It is *prima facie* evidence that the scope of the claimed design is limited to those surfaces "as shown" in the application drawing(s) in the absence of any additional written disclosure. See MPEP § 1503.01, subsection II. "[T]he adequacy of the disclosure must be determined by reference to the scope asserted." See *Philco Corp. v. Admiral Corp.*, 199 F. Supp.

797, 131 USPQ 413, 418 (D. Del. 1961). However, it should be understood that when a surface or portion of an article is disclosed in full lines in the drawing it is considered part of the claimed design and its shape and appearance must be clearly and accurately depicted in order to satisfy the requirements of 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, the first and second paragraphs of 35 U.S.C. 112).

Only those surfaces of the article that are visible at the point of sale or during use must be disclosed to meet the requirement of 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs). "The drawing should illustrate the design as it will appear to purchasers and users, since the appearance is the only thing that lends patentability to it under the design law." See *Ex parte Kohler,* 1905 C.D. 192, 192, 116 O.G. 1185, 1185 (Comm'r Pat. 1905). The lack of disclosure of those surfaces of the article which are hidden during sale or use does not violate the requirements of 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, the first and second paragraphs of 35 U.S.C. 112) because the "patented ornamental design has no use other than its visual appearance...." See *In re Harvey,* 12 F.3d 1061, 1064, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). Therefore, to make the "visual appearance" of the design merely involves the reproduction of what is shown in the drawings; it is not necessary that the functionality of the article be reproduced as this is not claimed. In essence, the function of a design is "that its appearance adds attractiveness, and hence commercial value, to the article embodying it." See *Ex parte Cady,* 1916 C.D. 57, 61, 232 O.G. 619, 621 (Comm'r Pat. 1916).

The undisclosed surfaces not seen during sale or use are not required to be described in the specification even though the title of the design is directed to the complete article because the design is embodied only in those surfaces which are visible. See *Ex parte Salsbury,* 38 USPQ 149, 1938 C.D. 6 (Comm'r Pat. 1938). While it is not necessary to show in the drawing those visible surfaces that are flat and devoid of surface ornamentation, they should be described in the specification by way of a descriptive statement if they are considered part of the claimed design. See *Ex parte Salsbury,* 38 USPQ 149, 1938 C.D. 6 (Comm'r Pat. 1938). Such descriptive statement may not be used to describe visible surfaces which include structure that is clearly not flat. See *Philco Corp. v. Admiral Corp.,* 199 F. Supp. 797, 131 USPQ 413 (D. Del. 1961). See also MPEP § 1503.02.

Applications filed in which the title (in the claim) defines an entire article but the drawings and the specification fail to disclose portions or surfaces of the article that would be visible either during use or on sale, will not be considered to violate the requirements of 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, the first and second paragraphs of 35 U.S.C. 112). Therefore, amendment to the title will not be required in such applications. However, examiners should include a statement in the first Office action on the merits (including a notice of allowability) indicating that the surface(s) or portion(s) of the article that would be normally visible but are not shown in the drawing or described in the specification are understood to form no part of the claimed design and therefore, the determination of patentability of the claimed design is based on the views of the article shown in the drawing and the description in the specification. Form paragraph 15.85 may be used for this purpose.

When a claim is rejected under 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs), as nonenabling and indefinite due to an insufficient drawing disclosure, examiners must specifically identify in the Office action what the deficiencies are in the drawing. A mere statement that the claim is nonenabling and indefinite due to the poor quality of the drawing is not a sufficient explanation of the deficiencies in the drawing disclosure. Rather, examiners must specifically point out those portions of the drawing that are insufficient to permit an understanding of the shape and appearance of the design claimed, and, if possible, suggest how the rejection may be overcome. Form paragraphs 15.21 and 15.20.02 may be used.

When inconsistencies between the views of the drawings are so great that the overall appearance of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b) (or for applications

filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs), as nonenabling and indefinite, and the rejection should specifically identify all of the inconsistencies between the views of the drawing. Otherwise, inconsistencies between drawing views will be objected to by the examiner and correction required by the applicant. See MPEP § 1503.02.

If the visual disclosure of the claimed design as originally filed is of such poor quality that its overall shape and appearance cannot be understood, applicant should be advised that the claim might be fatally defective by using form paragraph 15.65.

As indicated above, a narrative description in the specification can supplement the drawing disclosure to define the scope of protection sought by the claim. Furthermore, such description is incorporated into the claim by the use of the language "and described" therein. However, if a description in the specification refers to embodiments or modified forms not shown in the drawing, or includes vague and nondescriptive words such as "variations" and "equivalents," or a statement indicating that the claimed design is not limited to the exact shape and appearance shown in the drawing, the claim should be rejected under 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs), as nonenabling and indefinite. The reason being the description fails to enable a designer of ordinary skill in the art to make an article having the shape and appearance of those other embodiments, modified forms or "variations" and "equivalents" referred to in the description in the absence of additional drawing views. Furthermore, in the absence of additional drawing views, the description, which is incorporated into the claim, fails to particularly point out and distinctly claim the shape and appearance of those other embodiments, modified forms or "variations" and "equivalents" that applicants regard as their invention. Form paragraph 15.21 may be used to reject a claim for the above reasons.

¶ 15.85 Undisclosed visible surface(s)/portion(s) of article not forming part of the claimed design

The **[1]** of the article **[2]** not shown in the drawing or described in the specification. It is understood that the appearance of any part of the article not shown in the drawing or described in the specification forms no part of the claimed design. *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Therefore, the determination of patentability is based on the design for the article shown and described.

Examiner Note:

1. In bracket 1, insert surface or surfaces which are not shown.

2. In bracket 2, insert "is" or "are".

¶ 15.21 Rejection, 35 U.S.C. 112(a) and (b) or pre-AIA 35 U.S.C. 112, First And Second Paragraphs

The claim is rejected under 35 U.S.C. 112(a) and (b) or pre-AIA 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 fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is indefinite and nonenabling **[1]**.

Examiner Note:

1. This form paragraph should not be used when it is appropriate to make one or more separate rejections under 35 U.S.C. 112(a) and/or (b) or pre-AIA 35 U.S.C. 112, first and/or second paragraph(s).

2. In bracket 1, a complete explanation of the basis for the rejection should be provided.

¶ 15.20.02 Suggestion To Overcome Rejection Under 35 U.S.C. 112(a) and (b) or pre-AIA 35 U.S.C. 112, First and Second Paragraphs (Ch. 16 Design Application)

Applicant may disclaim the areas or portions of the design which are considered indefinite and nonenabling in the rejection under 35 U.S.C. 112 above by converting them to broken lines and amend the specification to include a statement that the portions of the **[1]** shown in broken lines form no part of the claimed design.

Examiner Note:

1. For international design applications, use form paragraph 29.27 instead.

2. In bracket 1, insert title of the article.

¶ 15.65 Amendment May Not Be Possible

The application might be fatally defective because **[1]**. It might not be possible to identify any definite and enabled design claim without introducing new matter (35 U.S.C. 132, 37 CFR 1.121).

Examiner Note:

In bracket 1, identify the subject matter which is insufficiently disclosed.

¶ 15.73 Corrected Drawing Sheets Required

Failure to submit replacement correction sheets overcoming all of the deficiencies in the drawing disclosure set forth above, or

an explanation why the drawing corrections or additional drawing views are not necessary will result in the rejection of the claim under 35 U.S.C. 112(a) and (b) or pre-AIA 35 U.S.C. 112, first and second paragraphs, being made FINAL in the next Office action.

B. New Matter

New matter is subject matter which has no support in the original specification, drawings or claim (MPEP § 608.04(a)). An amendment to the claim must have support in the original disclosure. See 35 U.S.C. 132; 37 CFR 1.121(f). Prior to final action, all amendments will be entered in the application and will be considered by the examiner. *Ex parte Hanback*, 231 USPQ 739 (Bd. Pat. App. & Inter. 1986) (stating that "a design patent applicant may amend the drawing in his application before final rejection and is entitled to have his thus amended *claim* reconsidered and reexamined" and finding that the amended figures did not represent a mere clarification of detail but rather constituted new matter, not derivable from the original disclosure) (emphasis in original).

An amendment to the disclosure not affecting the claim (such as environment in the title or in broken lines in the drawings), which has no support in the application as originally filed, must be objected to under 35 U.S.C. 132 as lacking support in the application as originally filed and a requirement must be made to cancel the new matter. See MPEP § 1503.01, subsection I. Form paragraph 15.51.01 may be used.

¶ 15.51.01 Amendment to Disclosure Not Affecting Claim - 35 U.S.C. 132 Objection (New Matter)

The **[1]** is objected to under 35 U.S.C. 132 and 37 CFR 1.121 as introducing new matter. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the amended subject matter at the time the application was filed. See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure **[2]**.

To overcome this objection, applicant may attempt to demonstrate (by means of argument or evidence) that the original disclosure establishes that he or she was in possession of the amended subject matter or **[3]**.

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.

2. In bracket 2, specifically identify what is new matter so that the basis for the objection is clear.

3. In bracket 3, insert specific suggestion how the objection may be overcome depending on the basis; such as, "the broken line showing of environmental structure in Fig. 1 of the new drawing may be omitted to correspond to the original drawing" or "the title may be amended by deleting the reference to environmental structure."

A design claim may be amended by broadening or narrowing its scope within the bounds of the disclosure as originally filed provided it complies with the written description requirement of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph). See MPEP § 1504.04, subsection I.C (evaluating amendments affecting the claim for compliance with the written description requirement). An amendment to the claim, however, which has no support in the specification and/or drawings as originally filed introduces new matter because that subject matter is not described in the application as originally filed. The claim must be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph) as failing to comply with the written description requirement. Similarly, if an amendment to the title directed to the article in which the design is embodied has no support in the original application, the claim will be rejected under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph), as failing to comply with the written description requirement thereof. *Ex parte Strijland*, 26 USPQ2d 1259, 1262 (Bd. Pat. App. & Inter. 1992).

An example of an amendment which introduces new matter would be an amendment changing the configuration of the original design by the addition of previously undisclosed subject matter. A change in the configuration of the design is considered a departure from the original disclosure and introduces new matter (37 CFR 1.121(f)). See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). "In *In re Salmon*, the court held that an earlier filed design application showing a chair with a square seat did not describe a later claimed design for a chair with a circular seat; thus, the earlier was not a description of the later...." *In re Daniels*, 144 F.3d 1452, 1457, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

Another example of an amendment which introduces new matter would be an amendment changing the surface appearance of the original design by the addition of previously undisclosed subject matter. Removal of three-dimensional surface treatment that is an integral part of the configuration of the original design, for example, beading, grooves, and ribs, is an additional example of an amendment that would introduce new matter. See MPEP § 1503.02, subsection IV. The underlying configuration revealed by such an amendment would not be apparent in the application as filed and, therefore, it could not be established that the applicant was in possession of this amended configuration at the time the application was filed. An amendment, however, which alters the appearance of the original design by removing two-dimensional, superimposed surface treatment would not introduce new matter if it is clear from the application that applicant had possession of the underlying configuration of the design without the surface treatment at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998).

Also, an amendment that changes the scope of a design by either converting originally-disclosed solid line structure to broken lines or converting originally-disclosed broken line structure to solid lines would not introduce new matter because such amendment would not introduce subject matter that was not originally disclosed. Similarly, such an amendment to the design would not be a change in configuration of the original design as addressed by the court in *Salmon* (finding that the parent application disclosing a stool with a square seat did not provide written description support for a seat of another (i.e., circular) configuration). Where such an amendment affects the claimed design, however, the resulting amended design must be evaluated for compliance with the written description requirement. See MPEP § 1504.04, subsection I.C.

Additional examples of amendments that would not introduce new matter include: (A) a preliminary amendment filed simultaneously with the application papers (see MPEP § 608.04(b)); and (B) the inclusion of a disclaimer in the original specification or on the drawings/photographs as filed (see MPEP §§ 1503.01 and 1503.02).

C. *Written Description*

1. General Principles Governing Compliance with the Written Description Requirement for Design Applications

The scope of a design claim is defined by what is shown in full lines in the application drawings. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378, 62 USPQ2d 1065, 1069 (Fed. Cir. 2002) ("If features appearing in the figures are not desired to be claimed, the patentee is permitted to show the features in broken lines to exclude those features from the claimed design, and the failure to do so signals inclusion of the features in the claimed design." (citing *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313, 59 USPQ2d 1472, 1475 (Fed. Cir. 2001)). 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph) provides that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." The test for sufficiency of written description is the same for design and utility patents. *In re Daniels*, 144 F.3d 1452, 1455, 46 USPQ2d 1788, 1789 (Fed. Cir. 1998). See also *In re Owens*, 710 F.3d 1362, 1366, 106 USPQ 2d 1248, 1250 (Fed. Cir. 2013). For designs, "[i]t is the drawings of the design patent that provide the description of the invention." *Daniels*, 144 F.3d at 1455, 46 USPQ2d at 1789 (stating, "Although linguists distinguish between a drawing and a writing, the drawings of the design patent are viewed in terms of the 'written description' requirement of Section 112.").

In evaluating written description, "the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351, 94 USPQ2d 1161, 1172 (Fed. Cir. 2010) (citations omitted). See also *Daniels*, 144 F.3d at 1456, 46 USPQ2d at 1789. With respect to showing possession, the Federal Circuit has emphasized that "the hallmark of written description is disclosure" and "[t]hus, 'possession as shown in the disclosure'

is a more complete formulation." *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172. Accordingly, "the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art" and "[b]ased on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Id*.

In *Racing Strollers*, the Federal Circuit stated, "[a]s a practical matter, meeting the [written description] requirement of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein . . . ." *Racing Strollers Inc. v. TRI Industries Inc.*, 878 F.2d 1418, 1420, 11 USPQ2d 1300, 1301 (Fed. Cir. 1989) (*en banc*). Subsequent cases explain that the written description analysis must be conducted from the perspective of an ordinary designer. See, e.g., *Daniels*, 144 F.3d at 1456–57, 46 USPQ2d at 1790 (stating "The leecher as an article of manufacture is clearly visible in the earlier design application, *demonstrating to the artisan viewing that application* that [the inventor] had possession at that time of the later claimed design of that article . . . .") (citations omitted) (emphasis added); *In re Owens*, 710 F.3d at 1368, 106 USPQ2d at 1252 (stating "the question for written description purposes *is whether a skilled artisan would recognize* upon reading the parent's disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area." (citing *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172) (emphasis added)).

2. Applying the General Principles to Specific Situations in Design Applications Where Issues of Compliance with the Written Description Requirement May Arise

A written description requirement issue generally involves the question of whether the subject matter of a claim is supported by the disclosure of an application as filed. A question as to whether the original or earlier disclosure of a design provides an adequate written description for a claimed design may arise when an amended claim is presented, or where a claim to entitlement of an earlier priority date or effective filing date (e.g., under 35 U.S.C. 120) has been made. See MPEP § 1504.20. For example, a continuation application must comply with the written description requirement to be entitled to a parent application's effective filing date. See *Owens*, 710 F.3d at 1366, 106 USPQ2d at 1250 (citing *Daniels*, 144 F.3d at 1456, 46 USPQ2d at 1790). In *Daniels*, the Federal Circuit concluded that applicant's parent application showed possession of the invention claimed in the continuing application such that the continuing application was entitled to claim benefit under 35 U.S.C. 120. *Daniels*, 144 F.3d at 1457, 46 USPQ2d at 1790. Compare *Munchkin, Inc. v. Luv N' Care, Ltd.*, 110 USPQ2d 1580, 1583 (P.T.A.B. 2014) (finding that the claim of a design patent for a drinking cup was not entitled to the parent's effective filing date; specifically, the Board found that "[a]lthough [the parent] application discloses that an oval or other shape may be used for the spout, it does not identify the specific shape of the spout in the claimed design or otherwise reasonably convey to those skilled in the art that the inventor had possession of the claimed design. See *Ariad* , 598 F.3d at 1351.").

Similarly, an amended claim must find written description support in the original disclosure. The resulting amended design as a whole must be evaluated for compliance with the 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, written description requirement. The fact that an amendment only affects features that were originally disclosed does not negate the need to determine whether the amendment complies with the written description requirement, i.e., whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the now claimed design as of the filing date. See *Ariad*, 598 F.3d 1336, 1348, 94 USPQ2d 1161, 1170 ("[O]ne can fail to meet the requirements of the statute in more than one manner, and the prohibition on new matter does not negate the need to provide a written description of one's invention."). In determining whether a claim complies with the written description requirement, an examiner should bear in mind that "the written description question does not turn upon what has been disclaimed, but instead upon whether the original disclosure 'clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is

claimed.'" *Owens*, 710 F.3d at 1368, 106 USPQ2d at 1252 (quoting *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172) (alternations in original) (emphasis added).

Issues of compliance with the written description requirement may arise where an amended claim or a claim in a continuing design application (i.e., a later-claimed design) is composed of only a subset of elements of the originally disclosed design. For example, the later-claimed design converts originally-disclosed solid line structure to broken lines or converts originally-disclosed broken line structure to solid lines, but does not introduce any new elements that were not originally disclosed. In the vast majority of such situations, the examiner will be able to determine based on a review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application. See *Racing Strollers*, 878 F.2d at 1420, 11 USPQ2d at 1301 (in discussing the requirements for satisfying 35 U.S.C. 120, the Federal Circuit stated, "As a practical matter, meeting the [written description] requirement of Sec. 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein . . . ."). See also *Daniels*, 144 F.3d at 1456-1457, 46 USPQ2d at 1790 (finding that "[t]he leecher as an article of manufacture is clearly visible in the earlier design application, demonstrating to the artisan viewing that application that [the inventor] had possession at that time of the later claimed design of that article [alone without the leaf ornamentation claimed in the earlier design application]"). In these situations, no further analysis by the examiner would be necessary with respect to the written description requirement.

In limited situations, however, the examiner will not be able to conclude based on a simple review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application. That is, even though elements of the later-claimed design may be individually visible in the original/earlier disclosure (whether shown in solid or broken lines), additional consideration is required by the examiner to determine whether the later-claimed design was reasonably conveyed to the ordinary skilled designer and therefore, supported by the original/earlier disclosure. As with all determinations for compliance with the written description requirement, the examiner should consider what design the original/earlier application -- in its totality-- would have reasonably conveyed to an ordinary designer at the time of the invention. See *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172 ("[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date."). See also *Owens*, 710 F.3d at 1368, 106 USPQ2d at 1252 (citing *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172). If the examiner determines that the later-claimed design was not reasonably conveyed to an ordinary designer by the original/earlier disclosure, the examiner should reject the claim for lack of written description (or when evaluating a priority or benefit claim, the application would not be entitled to the earlier date); see MPEP §§ 201.06(c), subsections III and XII, 602.05, and 1504.20).

3. Ensure That the Record is Clear

The Office has the initial burden of establishing a *prima facie* case for any rejection. If the examiner determines that a rejection for lack of written description is appropriate, the examiner must set forth express findings of fact which support that rejection. See MPEP § 2163 (examination guidelines pertaining to written description requirement).

After receiving a response from the applicant, before rejecting the claim again under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, for lack of written description, the examiner should review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant, such as affidavits or declarations. If the record as a whole demonstrates that the written description requirement is satisfied, the examiner should not repeat the rejection in the next Office action. If, on the other hand, the record does not demonstrate that the written description is adequate to support the claim, the examiner should repeat the rejection under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, fully

respond to applicant's rebuttal arguments, and properly treat any evidence submitted by applicant in the reply. Any affidavits or declarations filed by applicant that are relevant to the 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, written description requirement, must be thoroughly analyzed and discussed in the Office action when rejecting the claim again for lack of written description. See *In re Alton*, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996).

If the examiner determines that an amendment to a design claim is not supported by the original disclosure, the examiner should set forth a rejection under 35 U.S.C. 112(a), (or for applications filed prior to September 16, 2012, pre-AIA 35 U.S.C. 112, first paragraph) in the next Office action. The Office action should specifically identify the differences or changes made to the claimed design that are not supported in the original disclosure. A general statement by the examiner that the amended drawing, specification or title contains new matter is not sufficient. If possible, the examiner should suggest how the amended drawing, specification or title can be corrected to overcome the rejection. Form paragraph 15.51 may be used.

If an amendment that introduces new matter into the claim is the result of a rejection under 35 U.S.C. 112(a) and (b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first and second paragraphs) for lack of enablement and indefiniteness, and it is clear that the disclosure as originally filed cannot support any definite and enabled design claim without the introduction of new matter, the record of the application should reflect that the application is seen to be fatally defective. Form paragraph 15.65 may be used to set forth this position.

¶ 15.51 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph Rejection (Written Description)

The claim is rejected under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the **[1]** is not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure **[2]**.

To overcome this rejection, applicant may attempt to demonstrate (by means of argument or evidence) that the original disclosure establishes that he or she was in possession of the amended claim or **[3]**.

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.

2. In bracket 2, specifically identify what subject matter is not supported so that the basis for the rejection is clear.

3. In bracket 3, insert specific suggestion how rejection may be overcome depending on the basis; such as, “the bracket in figures 3 and 4 of the new drawing may be corrected to correspond to the original drawing” or “the specification may be amended by deleting the descriptive statement.”

¶ 15.65 Amendment May Not Be Possible

The application might be fatally defective because **[1]**. It might not be possible to identify any definite and enabled design claim without introducing new matter (35 U.S.C. 132, 37 CFR 1.121).

Examiner Note:

In bracket 1, identify the subject matter which is insufficiently disclosed.

¶ 15.51.01 Amendment to Disclosure Not Affecting Claim - 35 U.S.C. 132 Objection (New Matter)

The **[1]** is objected to under 35 U.S.C. 132 and 37 CFR 1.121 as introducing new matter. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the amended subject matter at the time the application was filed. See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure **[2]**.

To overcome this objection, applicant may attempt to demonstrate (by means of argument or evidence) that the original disclosure establishes that he or she was in possession of the amended subject matter or **[3]**.

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.

2. In bracket 2, specifically identify what is new matter so that the basis for the objection is clear.

3. In bracket 3, insert specific suggestion how the objection may be overcome depending on the basis; such as, “the broken line showing of environmental structure in Fig. 1 of the new drawing may be omitted to correspond to the original drawing” or “the title may be amended by deleting the reference to environmental structure.”

II. 35 U.S.C. 112(b) or pre-AIA 112, second paragraph

Defects in claim language give rise to a rejection of the claim under the second paragraph of 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, the second paragraph of 35 U.S.C. 112). The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph). "[T]he definiteness of the language employed must be analyzed – not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). A claim may appear indefinite when read in a vacuum, but may be definite upon reviewing the application disclosure or prior art teachings. Moreover, an otherwise definite claim in a vacuum may be uncertain when reviewing the application disclosure and prior art. *Moore*, 439 F.2d at 1235 n.2, 169 USPQ at 238 n.2. See also MPEP § 2173.05(b).

Use of phrases in the claim such as "or similar article," "or the like," or equivalent terminology has been held to be indefinite. See *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992). However, the use of broadening language such as "or the like," or "or similar article" in the title when directed to the environment of the article embodying the design should not be the basis for a rejection under 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph). See MPEP § 1503.01, subsection I.

Examiners are reminded that there is no *per se* rule, and that the definiteness of claim language must be evaluated on the facts and circumstances of each application. The following form paragraphs may be used.

¶ 15.22.02 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph ("Or the Like" In Claim)

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

Examiner Note:

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

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

3. This form paragraph should not be used when "or the like" or "or similar article" in the title is directed to the environment of the article embodying the design.

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

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

Examiner Note:

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

Rejections under 35 U.S.C. 112(b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, second paragraph), should be made when the scope of protection sought by the claim cannot be determined from the disclosure. For instance, a drawing disclosure in which the boundaries between claimed (solid lines) and unclaimed (broken lines) portions of an article are not defined or cannot be understood may be enabling under 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph), in that the shape and appearance of the article can be reproduced, but such disclosure fails to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Form paragraph 15.22 may be used.

¶ 15.22 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph

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

The claim is indefinite **[1]**.

Examiner Note:

1. Use this form paragraph when the scope of the claimed design cannot be determined.

2. In bracket 1, provide a full explanation of the basis for the rejection.

The claim should be rejected as indefinite when it cannot be determined from the designation of the design as shown in the drawing, referenced in the title and described in the specification what article of manufacture is being claimed, e.g., a design claimed as a "widget" which does not identify a known or recognizable article of manufacture. The following form paragraphs may be used.

¶ 15.22.03 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph (Title Fails to Specify a Known Article of Manufacture)

The claim is rejected under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph, as indefinite in that the title, as set forth in the claim, fails to identify an article of manufacture and the drawing disclosure does not inherently identify the article in which the design is embodied. *Ex parte Strijland* , 26 USPQ2d 1259, 1263 (Bd. Pat. App. & Int. 1992). Therefore, any attempt to clarify the title by specifying the article in which the design is embodied may introduce new matter. See 35 U.S.C. 132 and 37 CFR 1.121.

¶ 15.21.01 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, (Second Paragraph) (Additional Information Requested)

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

Applicant is therefore requested to provide a sufficient explanation of the nature and intended use of the article in which the claimed design is embodied or applied. See MPEP § 1503.01. Additional information, if available, regarding analogous fields of search, pertinent prior art, advertising brochures and the filing of copending utility applications would also prove helpful. If a utility application has been filed, please furnish its application number.

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

Where the design claim would otherwise be patentable but for the presence of any rejection under 35 U.S.C. 112(a) and/or (b) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112), first and/or second paragraphs, form paragraph 15.58.01 may be used.

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

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

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

1504.05 Restriction [R-08.2017]

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. See 37 CFR 1.153(a). More than one embodiment of a design may be protected by a single claim. However, such embodiments may be presented only if they involve a single inventive concept according to the nonstatutory double patenting practice for designs. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Therefore, the examiner will require restriction in each design application which contains more than one patentably distinct design.

Restriction will be required under 35 U.S.C. 121 if a design patent application claims multiple designs that are patentably distinct from each other. The issue of whether a search and examination of an entire application can be made without serious burden to an examiner (as noted in MPEP § 803) is not applicable to design applications when determining whether a restriction requirement should be made. Clear admission on the record by the applicant that the embodiments are not patentably distinct will not overcome a requirement for restriction if the embodiments do not meet the following two requirements: (A) the embodiments have overall appearances with basically the same design characteristics; and (B) the differences between the embodiments are insufficient to patentably distinguish one design from the other. Regarding the second requirement, without evidence, such an admission is merely a conclusory statement.

If multiple designs are held to be patentably indistinct and can be covered by a single claim, any rejection of one over prior art will apply equally to all. See *Ex parte Appeal No.* 315-40, 152 USPQ 71 (Bd. App. 1965).

I. INDEPENDENT INVENTIONS

Design inventions are independent if there is no apparent relationship between two or more disparate articles disclosed in the drawings; for example, a pair of eyeglasses and a door handle; a bicycle and a camera; an automobile and a bathtub. Also note examples in MPEP § 806.06. Restriction in such cases is clearly proper. This situation may be rarely presented since design patent applications are seldom filed containing disclosures of independent articles.

II. DISTINCT INVENTIONS

In determining patentable distinctness, the examiner must compare the overall appearances of the multiple designs. Each design must be considered as a whole, i.e., the elements of the design are not considered individually as they may be when establishing a *prima facie* case of obviousness under 35 U.S.C. 103. Designs are not distinct inventions if: (A) the multiple designs have overall appearances with basically the same design characteristics; and (B) the differences between the multiple designs are insufficient to patentably distinguish one design from the other. Differences may be considered insufficient to patentably distinguish when they are *de minimis* or obvious to a designer of ordinary skill in the art. Therefore, in determining the question of patentable distinctness under 35 U.S.C. 121 in a design application, a search of the prior art may be necessary. Both of the above considerations are important. Differences between the designs may prove to be obvious in view of the prior art, but if the overall appearances are not basically the same, the designs remain patentably distinct. Embodiments claiming different scopes of the same design can be patentably distinct using the two-step analysis above. When an application illustrates a component, which is a subcombination of another embodiment, the subcombination often has a distinct overall appearance and a restriction should be required. When an application illustrates only a portion of the design, which is the subject of another embodiment, that portion often has a distinct overall appearance and a restriction should be required.

A. Multiple Embodiments - Difference in Appearance

It is permissible to illustrate more than one embodiment of a design invention in a single application. However, such embodiments may be presented only if they involve a single inventive concept . Two designs involve a single inventive concept when the two designs are patentably indistinct according to the standard of nonstatutory double patenting. See *In re Rubinfield,* 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct over one another do not constitute a single inventive concept and thus may not be included in the same design application. See *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, subsection III. The specification should make clear that multiple embodiments are disclosed and should particularize the differences between the embodiments. If the disclosure of any embodiment relies on the disclosure of another embodiment for completeness to satisfy the requirements of 35 U.S.C. 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph), the differences between the embodiments must be identified either in the figure descriptions or by way of a descriptive statement in the specification of the application as filed. For example, the second embodiment of a cabinet discloses a single view showing only the difference in the front door of the cabinet of the first embodiment; the figure description should state that this view "is a second embodiment of Figure 1, the only difference being the configuration of the door, it being understood that all other surfaces are the same as those of the first embodiment." This type of statement in the description is understood to incorporate the disclosure of the first embodiment to complete the disclosure of the second embodiment. However, in the absence of such a statement in the specification of an application as filed, the disclosure of one embodiment will normally not be permitted to provide antecedent basis for any written or visual amendment to the disclosure of other embodiments.

The obviousness standard under 35 U.S.C. 103 must be applied in determining whether multiple embodiments may be retained in a single application. See MPEP § 1504.03. That is, it must first be determined whether the embodiments have overall appearances that are basically the same as each other. If the appearances of the embodiments are considered to be basically the same, then it must be determined whether the differences are either minor between the embodiments and not a patentable distinction, or obvious to a designer of ordinary skill in view of the analogous prior art. If embodiments meet both of the above criteria they may be retained in a single application. If embodiments do not meet either one of the above criteria, restriction is required. It should be noted, that if the embodiments do not have overall appearances that are basically the same, restriction must be required since their appearances are patentably distinct. In such case it does not matter for restriction purposes, if the differences between the appearances of the embodiments are shown to be obvious in view of analogous prior art.

Form paragraph 15.27.02 or 15.27.03, if appropriate, may be used to notify applicant that restriction is not required because the embodiments are not patentably distinct.

¶ 15.27.02 Restriction Not Required - Change In Appearance (First Action - Non Issue)

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]**

Embodiment 2 - Figs. **[2]**

[3]

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

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the above identified embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.03 Restriction Not Required - Change In Appearance (First Action Issue)

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]**

Embodiment 2 - Figs. **[2]**

[3]

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

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

The following form paragraphs may be used in a restriction requirement. Examiners must include a brief explanation of the differences between the appearances of the embodiments that render them patentably distinct.

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

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]**

Embodiment 2 - Figs. **[2]**

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The **[4]** create(s) patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

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

Group I: Embodiment **[5]**

Group II: Embodiment **[6]**

[7]

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

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

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

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

Examiner Note:

1. In bracket 3, add embodiments as necessary.

2. In bracket 4, insert an explanation of the difference(s) between the embodiments.

3. In bracket 7, add groups as necessary.

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

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]**

Embodiment 2 - Figs. **[2]**

[3]

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

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

Group I: Embodiment **[4]**

Group II: Embodiment **[5]**

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view analogous prior art cited. Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the **[7]** patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

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

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in

this application, any rejection of one group over prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

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

Examiner Note:

1. In bracket 3, add embodiments as necessary.

2. In bracket 6, add groups as necessary.

3. In bracket 7, insert an explanation of the difference(s) between the groups.

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

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]**

Embodiment 2 - Figs. **[2]**

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *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. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The **[4]** create(s) patentably distinct designs. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or, if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

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

Group I: Embodiment **[5]**

Group II: Embodiment **[6]**

[7]

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

During a telephone discussion with **[8]** on **[9]**, a provisional election was made **[10]** traverse to prosecute the design(s) of group **[11]**. Affirmation of this election should be made by applicant in replying to this Office action.

Group **[12]** is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.

2. In bracket 4, insert an explanation of the difference(s) between the embodiments.

3. In bracket 7, add groups as necessary.

4. In bracket 10, insert --with-- or --without--.

¶ 15.28.01 Telephone Restriction Under 35 U.S.C.121 (Obvious Variations Within Group)

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]**

Embodiment 2 – Figs. **[2]**

[3]

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

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

Group I: Embodiment **[4]**

Group II: Embodiment **[5]**

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the **[7]** patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

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

During a telephone discussion with **[8]** on **[9]**, a provisional election was made **[10]** traverse to prosecute the design(s) of group **[11]**. Affirmation of this election should be made by applicant in replying to this Office action.

Group **[12]** is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.

2. In bracket 6, add groups as necessary.

3. In bracket 7, insert an explanation of the differences between the groups.

4. In bracket 10, insert --with--or --without--.

¶ 15.31 Provisional Election Required (37 CFR 1.143)

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

B. Combination/Subcombination - Difference in Scope

A design claim covers the entire design as a whole. Furthermore, claim protection to the whole design does not extend to any individual part or portion thereof. See *KeyStone Retaining Wall Systems Inc. v. Westrock Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993). Embodiments directed to a design as a whole (combination) as well as individual parts or portions (subcombination) thereof may not be included in a single application if the appearances are patentably distinct. In such instance restriction would be required since patentably distinct combination/subcombination subject matter must be supported by separate claims. However, a design claim may cover embodiments of different scope directed to the same inventive concept within a single application if the designs are not patentably distinct. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). The court held that the inventive concept of a design is not limited to its embodiment in a single specific article, and as long as the various embodiments are not patentably distinct, they may be protected by a single claim. See *Blumcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965). The determination that the design of the subcombination/element is patentably indistinct from the combination means that the designs are not patentable over each other (novel and unobvious) and may remain in the same application. In contrast, if the embodiments are patentably distinct, the designs are considered to be separate inventions which require separate claims, and restriction to one or the other is necessary. See *In re Kelly*, 200 USPQ 560 (Comm'r Pat. 1978); *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960). In determining whether embodiments of different scope can be retained in a single application they must have overall appearances that are basically the same, and the difference in scope must be minor and not a patentable distinction. That is, they must, by themselves, be considered obvious over each other under 35 U.S.C. 103 without the aid of analogous prior art. The reason for this, as stated above, is because claim protection to the whole design does not extend to any individual part or portion thereof. Therefore, if the difference in scope between embodiments has an impact on the overall appearance that distinguishes one over the other, they must be restricted since the difference in scope creates patentably distinct designs that must be supported by separate claims. Form paragraph 15.27.04 or 15.27.05, if appropriate, may be used to notify applicant that restriction is not required because the embodiments required are not patentably distinct.

¶ 15.27.04 Restriction Not Required – Change In Scope (First Action – Non Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]**

Embodiment 2 – Figs. **[2]**

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any

rejection of one embodiment over prior art will apply equally to all other embodiments. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this Office action will be considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.05 Restriction Not Required – Change In Scope (First Action Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]**

Embodiment 2 – Figs. **[2]**

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

Form paragraph 15.29 or 15.30, if appropriate, may be used to make a restriction requirement.

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

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]** drawn to a **[2]**.

Embodiment 2 – Figs. **[3]** drawn to a **[4]**.

[5]

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

Group I – Embodiment **[6]**

Group II – Embodiment **[7]**

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm'r Pat. 1914); and *Blumcraft of Pittsburgh* v. *Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

Because the designs 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).

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. 37 CFR 1.143. Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

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

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

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. In bracket 9, add comments, if necessary.

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

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]** drawn to a **[2]**.

Embodiment 2 – Figs. **[3]** drawn to a **[4]**.

[5]

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

Group I – Embodiment **[6]**

Group II – Embodiment **[7]**

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm'r Pat. 1914); and *Blumcraft of Pittsburgh* v. *Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

During a telephone discussion with **[10]** on **[11]**, a provisional election was made **[12]** traverse to prosecute the invention of Group **[13]**. Affirmation of this election should be made by applicant in replying to this Office action.

Group **[14]** withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. In bracket 9, insert additional comments, if necessary.

Form paragraph 15.27.06 or 15.27.07, if appropriate, may be used to notify applicant that restriction is not required because the designs are not patentably distinct.

¶ 15.27.06 Restriction Not Required (Change in Appearance and Scope – First Action Non Issue)

This application discloses the following embodiments:

Embodiment 1 - Figs. **[1]** drawn to a **[2]**.

Embodiment 2 - Figs. **[3]** drawn to a **[4]**.

[5]

Embodiments **[6]** involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

Embodiment(s) **[7]** directed to the combination(s) in relation to Embodiment(s) **[8]** directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.
3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

¶ 15.27.07 Restriction Not Required (Change in Appearance and Scope – First Action Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. **[1]** drawn to a **[2]**.

Embodiment 2 – Figs. **[3]** drawn to a **[4]**.

[5]

Embodiment(s) **[6]** involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

Embodiment(s) **[7]** directed to the combination(s) in relation to Embodiment(s) **[8]** directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they were deemed to be obvious variations and are being retained and examined in the same application. Accordingly, they were deemed to comprise a single inventive concept and have been examined together.

Examiner Note:

1. In bracket 5, add embodiments as necessary.

2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.

3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

The following form paragraphs may be used in a restriction requirement.

Examiners must include a brief explanation of the differences between embodiments that render them patentably distinct.

¶ 15.27.08 Restriction with Differences in Appearance and Scope

This application discloses the following embodiments:

Embodiment 1: Figs. **[1]** drawn to a **[2]**.

Embodiment 2: Figs. **[3]** drawn to a **[4]**.

[5]

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

Group I: Embodiment **[6]**

Group II: Embodiment **[7]**

[8]

Group(s) **[9]** involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The **[10]** creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Group(s) **[11]** directed to the combination(s) in relation to Group(s) **[12]** directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965). It is further noted that combination/subcombination subject matter, if patentably distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

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

A reply to this requirement must include an election of a single group for prosecution on the merits even if this requirement is traversed. 37 CFR 1.143. Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

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

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

Examiner Note:

1. In bracket 5, add embodiments as necessary.

2. In bracket 8, add embodiments as necessary.

3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.

4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

5. In bracket 10, insert an explanation of the differences between the designs.

¶ 15.28.02 Telephone Restriction with Differences in Appearance and Scope

This application discloses the following embodiments:

Embodiment 1: Figs. **[1]** drawn to a **[2]**.

Embodiment 2: Figs. **[3]** drawn to a **[4]**.

[5]

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

Group I: Embodiment **[6]**

Group II: Embodiment **[7]**

[8]

Group(s) **[9]** involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The **[10]** creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Group(s) **[11]** directed to the combination(s) in relation to Group(s) **[12]** directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. *Ex parte Sanford*, 1914 C.D. 69, 204 OG 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburg v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965). It is further noted that combination/subcombination subject matter, if patentably distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

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

During a telephone discussion with **[13]** on **[14]**, a provisional election was made **[15]** traverse to prosecute the invention of Group **[16]**. Affirmation of this election should be made by applicant in replying to this Office action.

Group **[17]** is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.

2. In bracket 8, add groups as necessary.

3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.

4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

5. In bracket 10, insert an explanation of the differences between the designs.

6. In bracket 15, insert --with-- or --without--.

¶ 15.33 Qualifying Statement To Be Used In Restriction When A Common Embodiment Is Included In More Than One Group

The common embodiment is included in more than a single group as it is patentably indistinct from the other embodiment(s) in those groups and to give applicant the broadest possible choices in his or her election. If the common embodiment is elected in this application, then applicant is advised that the common embodiment should not be included in any continuing application to avoid a rejection on the ground of double patenting under 35 U.S.C. 171 in the new application.

The following form paragraphs may be used to notify applicant that the nonelected invention(s) are withdrawn from consideration.

¶ 15.34 Groups Withdrawn From Consideration After Traverse

Group **[1]** withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design, the requirement having been traversed in the reply filed on **[2]**.

¶ 15.35 Cancel Nonelected Design (Traverse)

The restriction requirement maintained in this application is or has been made final. Applicant must cancel Group **[1]** directed to the design(s) nonelected with traverse in the reply filed on **[2]**, or take other timely appropriate action (37 CFR 1.144).

¶ 15.36 Groups Withdrawn From Consideration Without Traverse

Group **[1]** withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for the nonelected design. Election was made without traverse in the reply filed on **[2]**.

¶ 15.37 Cancellation of Nonelected Groups, No Traverse

In view of the fact that this application is in condition for allowance except for the presence of Group **[1]** directed to a design or designs nonelected without traverse in the reply filed on **[2]**, and without the right to petition, such Group(s) have been canceled.

III. TRAVERSAL OF RESTRICTION REQUIREMENT

If a response to a restriction requirement includes an election with traverse on the grounds that the groups are not patentably distinct, applicant must present evidence or identify such evidence of record showing the groups to be obvious variations of one another. Traversal of a restriction requirement alone without an explanation in support thereof will be treated as an election without traverse. See MPEP § 818.01(c) and form paragraph 8.25.02.

A traversal of a restriction requirement based on there being no serious burden to an examiner to search and examine an entire application (as noted in MPEP § 803) is not applicable to design patent applications. The fact that the embodiments may be searched together cannot preclude a requirement for restriction if their appearances are considered patentably distinct, since patentably distinct embodiments cannot be supported by a single formal design claim. Also, clear admission on the record by the applicant, on its own, that the embodiments are not patentably distinct (as noted in MPEP § 809.02(a)) will not overcome a requirement for restriction if the embodiments do not have overall appearances that are basically the same as each other.

When a traversal specifically points out alleged errors in a restriction, examiners must reevaluate the requirement in view of these remarks. If the restriction requirement is to be maintained, it must be repeated and made final in the next Office action and the arguments answered. If the application is otherwise in condition for allowance, except for the presence of a non-elected invention, the examiner should contact applicant and advise the applicant of the options with regard to any pending claims withdrawn from consideration. Alternatively, applicant may be notified using form paragraph 8.03. See MPEP § 821.01.

1504.06 Double Patenting [R-08.2017]

There are generally two types of double patenting rejections. One is the same invention type or "statutory" double patenting rejection based on 35 U.S.C. 171 which states in the singular that an inventor may obtain "a patent." The second is the "nonstatutory" double patenting rejection based on a judicially created doctrine grounded in public policy and which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent.

The doctrine of nonstatutory double patenting also seeks to prevent the possibility of multiple suits against an accused infringer by different assignees of patents claiming patentably indistinct variations of the same invention. *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). The submission of a terminal disclaimer in compliance with 37 CFR 1.321(b) to overcome a double patenting rejection ensures that a patent owner with multiple patents claiming obvious variations of one invention retains all those patents or sells them as a group. *Van Ornum*, 686 F.2d at 944-45, 214 USPQ at 767. Nonstatutory double patenting includes rejections based on anticipation, a one-way determination of "obviousness," or a two-way determination of "obviousness." It is important to note that the "obviousness" analysis for nonstatutory double patenting is "similar to, but not necessarily the same as, that undertaken under 35 U.S.C. 103." *In re Braat*, 937 F.2d 589, 592-93, 19 USPQ2d 1289, 1292 (Fed. Cir. 1991) (citing *In re Longi*, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985)); *Geneva Pharmaceuticals*, 349 F.3d 1373, 1378 n.1, 68 USPQ2d 1865, 1869 n.1 (Fed Cir. 2003). In addition, nonstatutory double patenting also includes rejections based on the

equitable principle against permitting an unjustified timewise extension of patent rights. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); see also MPEP § 804, subsection II.B.3.

Charts in MPEP § 804 outline procedure for handling all double patenting rejections.

Double patenting rejections are based on a comparison of the claims in a patent and an application or between two applications which have at least one common inventor, common applicant, and/or are commonly assigned/owned or non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 102(c) or in pre-AIA 35 U.S.C. 103(c)(2) and (3). Notably, 35 U.S.C. 171 specifically states that "a patent" may be obtained if certain conditions are met; this use of the singular makes it clear that only one patent may issue for a design and is the basis for the statutory double patenting rejections.

Determining if a double patenting rejection is appropriate involves answering the following inquiries: Is the same design being claimed twice? If the answer is yes, then a rejection under 35 U.S.C. 171 should be made on the grounds of "same invention" type or statutory double patenting. If not, are the designs directed to patentably indistinct variations of the same inventive concept? If the answer is yes, then a rejection based on the nonstatutory double patenting should be made.

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

If a provisional double patenting rejection (nonstatutory or statutory) is the only rejection remaining in two conflicting applications, the examiner should consult MPEP § 1490, subsection VI.D to determine which, if any, of the provisional double patenting rejections should be withdrawn.

A provisional double patenting rejection will be converted into a double patenting rejection when the first application, which is the basis for the rejection, publishes as an application publication or issues as a patent. If more than two applications conflict with each other and one is allowed, the remaining applications should be cross rejected against the others as well as the allowed application. For this type of rejection to be appropriate, there must be either at least one inventor in common, common applicant, or a common owner/assignee. If the claims in copending design applications or a design patent and design applications have a common assignee but different inventive entities, anticipation and/or obviousness rejections based on the other application or patent as prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e), (f) and (g), as applicable, must be considered in addition to the double patenting rejection. See MPEP § 804, § 2136, § 2137, § 2138, and § 2154.

I. "SAME INVENTION" DOUBLE PATENTING REJECTIONS

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

disclaimer. See *In re Swett*, 145 F.2d 631, 172 USPQ 72 (CCPA 1971).

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

The claim is rejected under 35 U.S.C. 171 on the ground of double patenting since it is claiming the same design as that claimed in United States Design Patent No. **[1]**.

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

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

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

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

¶ 15.24.07 Double Patenting Rejection (Design-Utility)

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

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

¶ 15.24.08 Provisional Double Patenting Rejection (Design-Utility)

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

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

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

¶ 15.23.02 Summary for "Same Invention" – Type Double Patenting Rejections

Applicant is advised that a terminal disclaimer may not be used to overcome a "same invention" type double patenting rejection. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); MPEP § 804.02.

Examiner Note:

This form paragraph should follow all "same invention" type double patenting rejections.

II. NONSTATUTORY DOUBLE PATENTING REJECTIONS

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). A double patenting rejection also serves public policy when it prevents the possibility of multiple suits against an accused infringer by different assignees of patents claiming patentably indistinct variations of the same invention. *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).

A nonstatutory double patenting rejection applies to claims directed to the same inventive concept but with different appearances or differing scope that are patentably indistinct from each other. Nonstatutory categories of double patenting rejections which are not the "same invention" type may be overcome by the submission of a terminal disclaimer.

In determining whether a nonstatutory double patenting rejection is appropriate, the examiner must compare the overall appearance of the claimed design in the application with the overall appearance of the claimed design in the conflicting application or patent. The claim in the patent or conflicting application must be considered as a whole, i.e., the elements of the claimed design of the reference are not considered individually as they may be when establishing a *prima facie* case of anticipation under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See MPEP § 804, subsection II.B. (information on the analysis for nonstatutory double patenting rejections). For example, in an obviousness analysis, after the factual inquiries mandated under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), have been made (as with a rejection under 35 U.S.C. 103, the examiner must then determine whether the results of the inquiries support a conclusion nonstatutory double patenting. To establish nonstatutory double patenting under an

obviousness analysis: (A) the conflicting design claims must have overall appearances with basically the same design characteristics; and (B) the differences between the two designs must be insufficient to patentably distinguish one design from the other. Differences may be considered patentably insufficient when they are *de minimis* or obvious to a designer of ordinary skill in the art. While the conflicting application or patent (if less than a year older than the application) used to establish nonstatutory double patenting is not considered "prior art," the principle involved is basically the same. See *In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963)(see concurring opinion of Judge Rich).

In determining whether to make a nonstatutory double patenting rejection between designs having differing scope, the examiner should compare the reference claim with the application claim. A rejection is appropriate if:

(A) The difference in scope is minor and patentably indistinct between the claims being compared;

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

(C) No terminal disclaimer has been filed.

This kind of nonstatutory double patenting rejection in designs will occur between designs which may be characterized as a combination (narrow claim) and a subcombination/element thereof (broad claim). See MPEP § 1504.05, subsection II, B. If the designs are patentably indistinct and are directed to the same inventive concept the examiner must determine whether the subject matter of the narrower claim is fully disclosed in and covered by the broader claim of the reference. If the reference does *not* fully disclose the narrower claim, then a double patenting rejection should not be made. The additional disclosure necessary to establish that the applicant was in possession of the narrower claim at the time the broader claim was filed may be in a title or descriptive statement as well as in a broken line showing in the drawings. If the broader claim of the reference does not disclose the additional subject matter claimed in the narrower claim, then applicant could not have claimed the narrower claim at the time the application with the broader claim was filed and a rejection under nonstatutory double patenting would be inappropriate.

A nonstatutory double patenting rejection may be made between a patent and an application or provisionally between applications. Such rejection over a patent may only be necessary if the patent issued less than a year before the filing date of the application. If the patent is more than a year older than the application, the patent is considered to be "prior art" under 35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102(b) which may be applied in an anticipation or obviousness rejection as applicable. The purpose of a terminal disclaimer is to obviate a nonstatutory double patenting rejection by removing potential harm to the public by issuing a second patent. See MPEP § 804.

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

Examiners should particularly note that a design-design nonstatutory double patenting rejection does not *always* have to be made in both of the conflicting applications. For the most part, these rejections will be made in each of the conflicting applications; but, if the rejection is only appropriate in one direction, it is proper to reject only one application. The criteria for determining whether a one-way distinctness determination is necessary or a two-way distinctness determination is necessary is set forth in MPEP § 804, subsection II.B.2(b) and (c). However, in design-utility situations, a two-way distinctness determination is necessary for the rejection to be proper. See *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

The following form paragraphs may be used in making a nonstatutory double patenting rejection. Explanation should be provided in the appropriate brackets.

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

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

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.131(c). A registered attorney or agent of record may sign a terminal disclaimer.

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit **www.uspto.gov/forms/**. The filing date of the application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to **www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp**.

Examiner Note:

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

¶ 15.24 Nonstatutory Double Patenting Rejection (Single Reference)

The claim is rejected on the ground of nonstatutory double patenting of the claim in United States Patent No. **[1]**. Although the conflicting claims are not identical, they are not patentably distinct from each other because **[2]**.

Examiner Note:

1. In bracket 1, insert prior U.S. Patent Number.

2. In bracket 2, the differences between the conflicting claims must be identified and indicated as being minor and not distinguishing the overall appearance of one over the other.

3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ 15.24.03 Provisional Nonstatutory Double Patenting Rejection (Single Reference)

The claim is provisionally rejected on the grounds of nonstatutory double patenting of the claim of copending Application No. **[1]**. Although the conflicting claims are not identical, they are not patentably distinct from each other because **[2]**. This is a provisional nonstatutory double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.

2. In bracket 2, the differences between the conflicting claims must be identified and indicated as being minor and not distinguishing the overall appearance of one over the other.

3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

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

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

¶ 15.25 Nonstatutory Double Patenting Rejection (Multiple References)

The claim is rejected on the grounds of nonstatutory double patenting of the claim(s) in United States Patent No. **[1]** in view of **[2]**. At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to **[3]** as demonstrated by **[4]**.

Examiner Note:

1. In bracket 1, insert conflicting patent number.

2. In bracket 2, insert secondary reference(s).

3. In bracket 3, insert an explanation of how the conflicting claim in the patent is modified.

4. In bracket 4, identify the secondary reference(s) teaching the modification(s).

5. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.68.

¶ 15.24.04 Provisional Nonstatutory Double Patenting Rejection (Multiple References)

The claim is provisionally rejected on the grounds of nonstatutory double patenting of the claim of copending Application No. **[1]** in view of **[2]**. At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to **[3]** as demonstrated by **[4]**. This is a provisional nonstatutory double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.

2. In bracket 2, insert secondary reference(s).

3. In bracket 3, insert an explanation of how the conflicting claim in the copending application is modified.

4. In bracket 4, identify the secondary reference(s) teaching the modification(s).

5. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.68.

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

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

1504.07 - 1504.09 [Reserved]

1504.10 Priority Under 35 U.S.C. 119(a)-(d), 386(a) and (b) [R-08.2017]

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

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

The provisions of 35 U.S.C. 119(a)-(d), 172, 386(a) and (b) apply to design patent applications. In order to obtain the benefit of an earlier foreign filing date, the U.S. application must be filed within 6 months of the earliest date on which any foreign application for the same design was filed. It should be noted that where a design patent application claims benefit under 35 U.S.C. 120 to an intermediate nonprovisional utility patent application that directly claims priority to a foreign application, the intermediate nonprovisional utility application must have been filed within 6 months of the filing date of the foreign priority application in order for the design patent application to obtain the benefit of the earlier foreign filing date. See 35 U.S.C. 172. Under certain conditions, a right of priority to a foreign application may be restored if the U.S. design application is filed within two months of the expiration of the six-month period specified in 35 U.S.C. 172. See 37 CFR 1.55(c). Design applications may not claim the benefit of a provisional application under 35 U.S.C. 119(e). See 37 CFR 1.55 and MPEP § 213 - 216 for further information concerning the right of priority to a foreign application and the formal requirements applicable thereto.

¶ 15.01 Conditions Under 35 U.S.C. 119(a)-(d), 172, 386(a) and (b)

Applicant is advised of conditions as specified in 35 U.S.C. 119(a)-(d), 172, 386(a) and (b). 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 in a WTO member country, or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within six (6) months from the earliest date on which such foreign application was filed. If the design application is filed within two months from the expiration of the six-month period and the delay was unintentional, the right of priority in the design application may be restored by filing a petition under 37 CFR 1.55(c).

¶ 15.01.01 Conditions Under 35 U.S.C. 172 Not Met

The claim for priority under 35 U.S.C. 119(a)-(d), 386(a) or (b) to the **[1]** application is acknowledged, however, the claim for priority cannot be based on such application since it was filed more than six (6) months before the filing date of the subsequent application in the United States and no petition to restore the right of priority under 37 CFR 1.55(c) has been granted. 35 U.S.C 172.

Applicant may wish to file a petition under 37 CFR 1.55(c) to restore the right of priority if the subsequent application was filed within two months from the expiration of the six-month period and the delay was unintentional. A petition to restore the right of priority must include: (1) the priority claim under 35 U.S.C. 119(a) - (d), 386(a) or (b) in an application data sheet, identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing (unless previously submitted); (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a statement that the delay in filing the subsequent application within the six-month period was unintentional. The petition to restore the right of priority must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450.

Examiner Note:

In bracket 1, insert the name of the foreign country.

¶ 15.03 Certified Copy Filed, But Proper Claim Not Made

Receipt is acknowledged of a certified copy of foreign application **[1]**. If this copy is being filed to obtain priority to the foreign filing date under 35 U.S.C. 119(a)-(d), 386(a) or (b), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application was filed before September 16, 2012, the priority claim must be made in either the oath or declaration or in an application data sheet; if the application was filed on or after September 16, 2012, the claim for foreign priority must be presented in an application data sheet.

In the case of a design application, the claim for priority must be presented during the pendency of the application, unless filed with a petition under 37 CFR 1.55(e). If the claim for priority is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323.

Examiner Note:

In bracket 1, insert the application number of the foreign application.

For design applications filed on or after May 13, 2015, a claim for priority may be made pursuant 35 U.S.C. 386(a) to an international design application filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, provided the international design application designates at least one Contracting Party other than the United States. The United States will also 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," "Uniform Benelux Act on Designs and Models" and "European Community Design." 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. The required information is:

(A) the application number,

(B) the date of filing of the foreign application,

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

¶ 15.02 Claimed Foreign Priority, No Certified Copy Filed

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in **[1]** on **[2]**. It is noted, however, that applicant has not filed a certified copy of the **[3]** application as required by 37 CFR 1.55. In the case of a design application, the certified copy must be filed during the pendency of the application, unless filed with a petition under 37 CFR 1.55(g) together with the fee set forth in 37 CFR 1.17(g), that includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application. If the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323.

Examiner Note:

1. In bracket 1, insert the name of the country or intellectual property authority.

2. In bracket 2, insert the filing date of the foreign application.

3. In bracket 3, insert the application number of the foreign application.

The notation requirement on design patent application file wrappers when foreign priority is claimed is set forth in MPEP § 202.

¶ 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, the Benelux Designs Convention and European Community Design. 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. The required information is (1) the application number: (2) the date of filing of the application, and (3) the name and location of the national or international governmental authority which received such application.

1504.11-1504.19 [Reserved]

1504.20 Benefit Under 35 U.S.C. 120 [R-08.2017]

35 U.S.C. 120 Benefit of earlier filing date in the United States.

[Editor Note: Applicable to a patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 120 (pre-AIA) for the law otherwise applicable.]

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings

on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. 120 (pre-AIA) Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

For a benefit claim under 35 U.S.C. 120, the later-filed application must contain a reference to the prior-filed copending application. For applications filed on or after September 16, 2012, the specific reference to the prior application must be in the application data sheet (37 CFR 1.76). For applications filed prior to September 16, 2012, the specific reference to the prior application must be in the first sentence(s) of the specification or in an application data sheet. The prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, the prior-filed application must either be: (i) a nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in §§ 1.53(b) or 1.53(d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application, (ii) an international design application entitled to a filing date in accordance with § 1.1023 and designating the United States; or (iii) an international application entitled to a filing date in accordance with PCT Article 11 and designating the United States. See 37 CFR 1.78(d).

Except as provided for in 37 CFR 1.78(e), the failure to timely submit the reference required under 35 U.S.C. 120 and 37 CFR 1.78 in a design application during its pendency is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c) or 386(c). See 37 CFR 1.78(d)(3)(iii).

See MPEP § 211 for additional information concerning benefit claims under 35 U.S.C. 120.

Form paragraph 15.26 may be used to remind applicant where a reference to the prior application must be included in the first sentence(s) of the specification or in an application data sheet.

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

Applicant is reminded of the following requirement:

> To claim the benefit of a prior-filed application, a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), must include a specific reference to the prior-filed application in compliance with 37 CFR 1.78. If the application was filed before September 16, 2012, the specific reference must be included in the first sentence(s) of the specification following the title or in an application data sheet; if the application was filed on or after September 16, 2012, the specific reference must be included in an application data sheet. For benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

Attention is directed to the requirements for "continuing" applications set forth in MPEP §§ 201.07, 201.08, and § 211. 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(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph). In all continuation and divisional applications, a

determination must be made by the examiner as to whether the conditions for priority under 35 U.S.C. 120 have been met. The claimed design in a continuation application and in a divisional application must be disclosed in the original application. If this condition is not met, the application is not entitled to the benefit of the earlier filing date and the examiner should notify applicant accordingly by specifying the reasons why applicant is not entitled to claim the benefit under 35 U.S.C. 120. Form paragraphs 2.09, 2.10 and 2.10.01 may be used followed by a specific explanation as to why the later filed application fails to comply with the requirements of 35 U.S.C. 120. The examiner should also require applicant to change the relationship (continuation or divisional application) to continuation-in-part or delete the benefit claim. For applications filed on or after September 16, 2012, applicant can delete or change the benefit claim by filing a corrected application data sheet in compliance with 37 CFR 1.76(c). For applications filed prior to September 16, 2012, applicant can delete or change the benefit claim by amending the specification (if the benefit claim is in the specification) or by submitting a supplemental application data sheet in compliance with pre-AIA 37 CFR 1.76(c). If applicant chooses to change the relationship (continuation or divisional application) to continuation-in-part, note that for applications filed on or after September 16, 2012, a continuing application, including a continuation-in-part application, may be filed with a copy of an oath or declaration or substitute statement from the prior nonprovisional application, provided that the oath or declaration is in compliance with 37 CFR 1.63 or the substitute statement is incompliance with 37 CFR 1.64. See 37 CFR 1.63(d)(1). See also MPEP § 602.05(a) (more information regarding the oath or declaration in continuing applications filed on or after September 16, 2012). For continuation-in-part applications filed before September 16, 2012, a newly executed oath or declaration must be filed. See pre-AIA 37 CFR 1.63(e).

In general, a mere statement that an application is a continuation or division of an earlier filed application is not an incorporation of anything into the application containing such reference for purposes of satisfying the disclosure requirements of 35 U.S.C. 112(a), (or for applications filed prior to September 16, 2012, 35 U.S.C. 112, first paragraph). See *In re de Seversky,* 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See also MPEP § 608.01(p). However, for applications filed on or after September 21, 2004, 37 CFR 1.57(b) provides that a claim under 37 CFR 1.78 for the benefit of a prior-filed application, that was present on the filing date of the application, is considered an incorporation by reference as to inadvertently omitted material. See MPEP § 217.

A continuation-in-part application is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the earlier nonprovisional application. Only when the claim of the continuation-in-part application is disclosed in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph in the earlier non-provisional application will the claim be entitled to the benefit of the filing date of the earlier nonprovisional application. However, unless the filing date of the earlier application is needed, such as with the existence of intervening prior art, the entitlement to benefit in the continuation in part application, as based on 35 U.S.C. 120, will not be considered by the examiner. See *In re Corba*, 212 USPQ 825 (Comm'r Pat. 1981).

When the first application is found to be fatally defective under 35 U.S.C. 112 because of insufficient disclosure to support an allowable claim and such position has been made of record by the examiner, a second design patent application filed as an alleged "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the earlier filing date. See *Hunt Co. v. Mallinckrodt Chemical Works*, 177 F.2d 583, 83 USPQ 277 (2d. Cir. 1949) and cases cited therein. Also, a design application filed as a "continuation-in-part" that changes the shape or configuration of a design disclosed in an earlier application is not entitled to the benefit of the filing date of the earlier application. See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983). However, a later filed application that changes the scope of a design claimed in an earlier filed application by reducing certain portions of the drawing to broken lines is not a change in

configuration as defined by the court in *Salmon*. See MPEP § 1504.04, subsection II.

Form paragraph 15.74 may be used in an Office action in any application identified as a continuation-in-part which claims benefit under 35 U.S.C. 120 to a prior application and the examiner has not considered whether the application is entitled to benefit of the earlier filing date. Form paragraph 15.74.01 should be used where there is intervening prior art and the examiner has determined that the application is not entitled to benefit of the earlier filing date.

¶ 15.74 Continuation-In-Part

Reference to this design application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Unless the filing date of the earlier application is actually needed, such as to avoid intervening prior art, the entitlement to priority in this CIP application will not be considered. See *In re Corba*, 212 USPQ 825 (Comm'r Pat. 1981).

Examiner Note:

This form paragraph should be used to notify applicant that the C-I-P application is not entitled to the benefit of the parent application under 35 U.S.C. 120.

¶ 15.74.01 Continuation-In-Part – Not Entitled To Benefit of Earlier Filing Date

Reference to this design application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Applicant is advised that the design claimed in the present application is not disclosed in the parent application. Therefore, the parent application does not satisfy the written description requirement of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, under 35 U.S.C. 120 for the design claimed in the present application and the present application is not entitled to the benefit of the earlier filing date.

Examiner Note:

This form paragraph should be used to notify applicant that the C-I-P application is not entitled to the benefit of the parent application under 35 U.S.C. 120.

Where a continuation-in-part application claims benefit under 35 U.S.C. 120 of the filing date of an earlier application, and also claims priority under 35 U.S.C. 119(a)-(d) of a foreign application through the earlier application, and the conditions of 35 U.S.C. 120 are not met, e.g., insufficient disclosure under 35 U.S.C. 112, the continuation-in-part application is not entitled to the benefit of the filing date of the parent application. In this situation, a determination must be made as to whether the foreign application would qualify as prior art under pre-AIA 35 U.S.C. 102(d)/172. To qualify as prior art under pre-AIA 35 U.S.C. 102(d)/172, the foreign application (for patent or registration) must have been filed more than six months before the filing date of the U.S. (CIP) application and the foreign application for patent/registration must have matured into a form of patent protection prior to the filing date of the U.S. (CIP) application. To determine the status of the foreign application, the charts in MPEP § 1504.02 should be used. If the foreign application for patent/registration has matured into a form of patent protection, the foreign application would qualify as prior art under pre-AIA 35 U.S.C. 102(d)/172 and the examiner should consider whether the design shown in the foreign application papers would anticipate or render the claim in the CIP application obvious. If the design shown in the foreign application papers would anticipate or render the claim in the CIP application obvious, the claim should be rejected under 35 U.S.C. 102/103 using form paragraphs 15.74.01 and 15.75.fti followed with a rejection under pre-AIA 35 U.S.C. 102(d)/pre-AIA 35 U.S.C. 103(a).

¶ 15.75.fti Preface to Rejection in CIP Based on pre-AIA 35 U.S.C. 102(d)/35 U.S.C.172

Reference to this design application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Applicant is advised that the design disclosed in the parent application is not the same design as the design disclosed in this application. Therefore, this application does not satisfy the written description requirement of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, under 35 U.S.C. 120 and is not entitled to benefit of the earlier filing date.

The parent application claimed foreign priority under 35 U.S.C. 119(a) -(d), however, the present application is not entitled to the benefit of the earlier filing date of the parent application. The foreign application that the parent application has claimed priority to has matured into a patent/registration before the filing date of the present application and was filed more than six months before the filing date of the present application. Therefore, the foreign patent/registration qualifies as prior art under pre-AIA 35 U.S.C. 102(d)/35 U.S.C. 172.

Examiner Note:

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

If the status of the foreign application cannot be determined the following form paragraph should be used instead.

¶ 15.75.01.fti C-I-P Caution, Claim to Foreign Priority in Earlier Filed Application - Status of Foreign Application Unknown

Reference to this application as a continuation-in-part under 35 U.S.C. 120 is acknowledged. Applicant is advised that the design disclosed in the parent application is not the same design as the design disclosed in this application. Therefore, this application does not satisfy the written description requirement of 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, under 35 U.S.C. 120 and is not entitled to benefit of the earlier filing date.

The parent application claimed foreign priority under 35 U.S.C. 119(a)-(d). Applicant is reminded that if the foreign application to which priority was claimed matured into a patent/registration before the filing of the present application and was filed more than six months before the filing date of the present application, the foreign patent/registration qualifies as prior art under pre-AIA 35 U.S.C. 102(d)/35 U.S.C. 172.

Therefore, Applicant is requested to inform the Office of the status of the foreign application to which priority is claimed.

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. *Racing Strollers Inc. v. TRI Industries Inc.*, 878 F.2d 1418, 11 USPQ2d 1300 (Fed. Cir. 1989). Conversely, this also applies to a utility application relying on the benefit of the filing date of an earlier filed design application. *Vas-Cath Inc. v. Mahurkar,* 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). In addition, a design application may claim benefit from an earlier filed PCT application under 35 U.S.C. 120 if the U.S. was designated in the PCT application. It should be noted that where a design patent application claims benefit under 35 U.S.C. 120 to an intermediate nonprovisional utility patent application that directly claims the benefit of a provisional application, the design patent application cannot claim the benefit of the filing date of the provisional application. This is because a design application may not claim the benefit of a provisional application. See 35 U.S.C. 172.

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

1504.21-1504.29 [Reserved]

1504.30 Expedited Examination [R-08.2017]

37 CFR 1.155 Expedited examination of design applications.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination.

(1) The application must include drawings in compliance with § 1.84, or for an international design application that designates the United States, must have been published pursuant to Hague Agreement Article 10(3);

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

(i) The fee set forth in § 1.17(k); and

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

37 CFR 1.155 establishes an expedited procedure for design applications. This expedited procedure is available to design applicants who first conduct a preliminary examination search and file a request for expedited treatment accompanied by the fee specified in 37 CFR 1.17(k). This expedited treatment is intended to fulfill a particular need by affording rapid design patent protection that may be especially important where marketplace conditions are such that new designs on articles are typically in vogue for limited periods of time. The expedited procedure is available for international design applications designating the United States that have been published pursuant to Hague Agreement Article 10(3).

A design application may qualify for expedited examination provided the following requirements are met:

(A) Expedited examination request is filed (Form PTO/SB/27 should be used);

(B) The design application is complete and includes drawings in compliance with 37 CFR 1.84 (see 37 CFR 1.154 and MPEP § 1503 concerning the requirements for a complete design application), or is an international design application designating the United States that was published pursuant to Hague Agreement Article 10(3);

(C) A statement is filed indicating that a preexamination search was conducted (a search made by a foreign patent office satisfies this requirement). The statement must also indicate the field of search such as by U.S. Class and Subclass (including domestic patent documents, foreign patent documents and nonpatent literature);

(D) An information disclosure statement in compliance with 37 CFR 1.98 is filed;

(E) The basic design application filing fee set forth in 37 CFR 1.16(b), if applicable, is paid; and

(F) The fee for expedited examination set forth in 37 CFR 1.17(k) is paid.

EXPEDITED EXAMINATION PROCEDURE

Design applications requesting expedited examination and complying with the requirements of 37 CFR 1.155 are examined with priority and undergo expedited processing throughout the entire course of prosecution in the Office, including appeal, if any, to the Patent Trial and Appeal Board. All processing is expedited from the date the request is granted.

Design applicants seeking expedited examination may file a design application under 35 U.S.C. chapter 16 in the Office together with a corresponding request under 37 CFR 1.155 by EFS-Web, mail, or by hand-delivering the application papers and the request to the Customer Service Window located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314. For applicants who choose to file a design application under 35 U.S.C. chapter 16 and the corresponding request under 37 CFR 1.155 via EFS-Web, the document description “Req for Expedited Processing, Design Rocket Docket” should be used to ensure efficient processing of the request. For applicants who choose to file a design application under 35 U.S.C. chapter 16 and the corresponding request under 37 CFR 1.155 by mail, the envelope should be addressed to:

Mail Stop Expedited Design
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

A request under 37 CFR 1.155 may also be made for a previously filed design application. "Mail Stop Expedited Design" should also be used when filing a request for expedited examination under 37 CFR 1.155 by mail in a previously filed design application. A subsequently filed request under 37 CFR 1.155 may also be filed via EFS-Web. In such a case, the document description “Req for Expedited Processing, Design Rocket Docket” in EFS-Web should be used for the request to ensure efficient processing. In addition, a subsequently filed request under 37 CFR 1.155 may be filed by facsimile to the centralized facsimile number 571-273-8300.

To facilitate processing of a Request for Expedited Examination, the Office strongly encourages use of Form PTO/SB/27 available at **www.uspto.gov/patent/patents-forms**. If Form PTO/SB/27 is not used, then the notations “REQUEST FOR EXPEDITED EXAMINATION OF A DESIGN APPLICATION (37 CFR 1.155)” and “Doc Code: ROCKET” should be included at the top of the first page of the request, and for a subsequently filed request the corresponding application number should also be identified.

Requests for expedited examination under 37 CFR 1.155 are evaluated by the Director of Technology Center 2900. Expedited examination will be initiated provided the application is in condition for examination and a complete request under 37 CFR 1.155 (including the fee specified at 37 CFR 1.17(k)) qualifies the application for expedited examination.

Upon a decision by the Director of Technology Center 2900 to grant the request for expedited examination, the application is dispatched to an examiner for expedited examination. In addition, the applicant is notified that examination is being expedited. Expedited treatment under 37 CFR 1.155 occurs through initial examination processing and throughout the entire prosecution in the Office. Whereas, an application granted special status

pursuant to a successful "petition to make special" under MPEP § 708.02 is prioritized while it is on the examiner's docket so that the application will be examined out of turn responsive to each successive communication from the applicant requiring Office action. For a patentable design application, the expedited treatment under 37 CFR 1.155 would be a streamlined filing-to-issuance procedure. This procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps.

Although a request under 37 CFR 1.155 may be filed subsequent to the filing of the design application under 35 U.S.C. chapter 16, it is recommended that the request and corresponding design application be filed together in order to optimize expeditious processing. Any request under 37 CFR 1.155 in an international design application designating the United States should be filed after publication of the international design application pursuant to Hague Agreement Article 10(3), as publication of the international design application is required in order to qualify for expedited examination. See 37 CFR 1.155(a)(1). Any request under 37 CFR 1.155 filed in an international design application will generally not be acted upon prior to publication of the application pursuant to Article 10(3). Applicants filing international design applications and seeking expedited examination in the United States may wish to consider requesting the immediate publication of the international design application after registration pursuant to Rule 17(1) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement.

The Office will not examine an application not in condition for examination even if the applicant files a request for expedited examination. See 37 CFR 1.155(b).

If the Office finds that a request for expedited examination fails to comply with one or more of the requirements under 37 CFR 1.155, but the application is otherwise complete, the applicant will be promptly notified of the deficiency. Applicant may submit a renewed request under 37 CFR 1.155 to rectify the deficiency. Unless all requirements under 37 CFR 1.155 are timely met, the application will await action in its regular turn.

1505 Term of Design Patent [R-08.2017]

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

Patents issued from design applications filed on or after May 13, 2015 shall be granted for the term of fifteen years from the date of grant.

On December 18, 2012, the Patent Law Treaties Implementation Act of 2012 (PLTIA) was signed into law. The PLTIA among other things sets forth provisions implementing the 1999 Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs ("Hague Agreement"). These provisions (Title I of the PLTIA) took effect on May 13, 2015. As a result, U.S. design patents resulting from applications filed on or after May 13, 2015 have a 15 year term from the date of grant. However, patents issued from design applications filed before May 13, 2015 have a 14 year term from the date of grant.

1506-1508 [Reserved]

1509 Reissue of a Design Patent [R-11.2013]

See MPEP Chapter 1400 for practice and procedure in reissue applications. See also MPEP § 1457 regarding design reissue applications.

For design reissue application filing, search and examination fees, see 37 CFR 1.16(e). For the fee for issuing a reissue design patent, see 37 CFR 1.18(a).

The term of a design patent may not be extended by reissue. See *Ex parte Lawrence,* 70 USPQ 326 (Comm'r Pat. 1946). If a reissue application is filed for the purpose of correcting the drawing of a design patent, either by canceling views, amending views or adding new views, the provisions of 37 CFR 1.173(b)(3) must be followed. All changes to the patent drawing shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawing. A

marked-up copy of any amended drawing figure, including annotations indicating the changes made, should be submitted. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and it must be presented in the amendment or remarks section that explains the change to the drawing.

A reissue application must be filed with a copy of all drawing views of the design patent regardless of whether certain views are being cancelled or amended in the reissue application. Inasmuch as the drawing is the primary means for showing the design being claimed, it is important for purposes of comparison that the reissue of the design patent shows a changed drawing view in both its canceled and amended versions and/or show a previously printed drawing view that has been canceled but not replaced. In addition to drawing views that are unchanged from the original design patent, the drawing in the reissue application may include the following views, all of which will be printed as part of the design reissue patent:

(1) CANCELED drawing view. Such a drawing view must be surrounded by brackets and must be labeled as "Canceled." For example, FIG. 3 (Canceled). If a drawing view is canceled but not replaced the corresponding figure description in the reissue specification must also be cancelled. However, if a drawing view is cancelled and replaced by an amended drawing view the corresponding figure description in the reissue specification may or may not need to be amended.

(2) AMENDED drawing view. Such a drawing view must be labeled as "Amended." For example, FIG. 3 (Amended). When an amended drawing view is present, there may or may not be a corresponding canceled drawing view. If there is such a corresponding canceled drawing view, the amended and canceled drawing views should have the same figure number. The specification of the reissue application need not indicate that there is both a canceled version and an amended version of the drawing view.

(3) NEW drawing view. Such a drawing view must be labeled as "New" For example, FIG. 5 (New). The new drawing view should have a new figure number, that is, a figure number that did not appear in the original design patent. The specification of the reissue application must include a figure description of the new drawing view.

If a drawing view includes both a cancelled and amended version, and the change in the amended version is for the purpose of converting certain solid lines to broken lines, the reissue specification must include a statement indicating the purpose of the broken lines.

1510 Reexamination [R-08.2012]

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

1511 Protest [R-08.2012]

See MPEP Chapter 1900 for practice and procedure in protest.

1512 Relationship Between Design Patent, Copyright, and Trademark [R-07.2015]

I. DESIGN PATENT/COPYRIGHT OVERLAP

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

See form paragraph 15.55 which repeats this information.

II. INCLUSION OF COPYRIGHT NOTICE

It is the policy of the U.S. Patent and Trademark Office to permit the inclusion of a copyright notice

in a design patent application, and thereby any patent issuing therefrom, under the following conditions.

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

(B) The content of the copyright notice must be limited to only those elements required by law. For example, "© 1983 John Doe" would be legally sufficient under 17 U.S.C. 401 and properly limited.

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

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

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

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

See form paragraph 15.55 which repeats this information.

¶ 15.55 Design Patent-Copyright Overlap

There is an area of overlap between Copyright and Design Patent Statutes where an 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*, 493 F. 2d 1389, 181 USPQ 331 (CCPA 1974). In *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (U.S. 1954), the Supreme Court noted the election of protection doctrine but did not express any view on it since a Design Patent had been secured in the case and the issue was not before the Court.

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 examiner will not object to the notice 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 copyrights 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 examiner will object to the copyright notice as improper.

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

III. DESIGN PATENT/TRADEMARK OVERLAP

A design patent and a trademark may be obtained on the same subject matter. The CCPA, in *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 USPQ 575 (CCPA 1964), later reaffirmed by the same court at 372 F.2d 539, 152 USPQ 593 (CCPA 1967), held that the underlying purpose and essence of patent rights are separate and distinct from those pertaining to trademarks, and that no right accruing from one is dependent or conditioned by the right concomitant to the other.

See form paragraph 15.55.01 which repeats this information.

¶ 15.55.01 Design Patent - Trademark Overlap

A design patent and a trademark may be obtained on the same subject matter. The Court of Customs and Patent Appeals, in *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 USPQ 575 (CCPA 1964), later reaffirmed by the same court at 372 F.2d 539, 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 the one is dependent upon or conditioned by any right concomitant to the other.

IV. INCLUSION OF TRADEMARKS IN DESIGN PATENT APPLICATIONS

A. Specification

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

B. Title

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

C. Drawings

When a trademark is used in the drawing disclosure of a design application, the specification must include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the registered trademark. Form paragraph 15.76 may be used.

¶ 15.76 Trademark in Drawing

The **[1]** forming part of the claimed design is a registered trademark of **[2]**. The specification must be amended to include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the trademark.

Examiner Note:

1. In bracket 1, identify the trademark material.
2. In bracket 2, identify the trademark owner.

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

1513 Miscellaneous [R-11.2013]

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

Effective May 8, 1985, the Statutory Invention Registration (SIR), 35 U.S.C. 157, and 37 CFR 1.293-1.297 replaced the former Defensive Publication Program. The Statutory Invention Registration (SIR) Program applies to utility, plant, and design applications. Effective March 16, 2013, the provisions of 35 U.S.C. 157 were repealed.