Chapter 1500 Design Patents

The right to a patent for a design stems from:

35 U.S.C. 171. Patents for designs. Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

1501 Rules Applicable [R–20]

Rule 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.

Rules 152–155, which relate only to design patents, are reproduced in the sections of this chapter.

1502 Definition of a Design

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

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

A design is inseparable from the object 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.

1503 Elements of a Design Application [R–35]

A design application has essentially the elements required of an application for a patent for a "mechanical" invention or discovery (see Chapter 600). However, unlike the latter where a preamble to the specification is no longer required, a preamble still remains a requirement in a design application (rule 154).

If the single signature form is used it must be accompanied by a separate sheet of specification which includes a preamble.

In design applications, in addition to the instruction set forth in §§ 605.04 to 605.05(a) pertaining to signature and name, if the name is typewritten without the middle initial or name, but the signature contains the middle initial or name, amendment should be required that the typewritten name conform with applicant's signature.

1503.01 Specification and Claim [R–35]

Rule 153. Title, description and claim, oath or declaration. (a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with rule 65 except that the period of twelve months specified therein with respect to foreign applications is six months in the case of designs.

Rule 154. Arrangement of specification. The following order of arrangement should be observed in framing design specifications:

(a) Preamble, stating name of the applicant and title of the design.

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

(c) Description, if any.

(d) Claim.

(e) Signature of applicant. (See rule 57.)

If applicant is entitled under 35 U.S.C. 120 to the benefit of an earlier U.S. filing date, the statement that, "This is a division [continuation, continuation-in-part] of design application Serial No. _____, filed _____." should appear immediately before the claim heading.

A design application cannot be considered to be a division of a utility application, and is not entitled to the filing date thereof, even though the drawings of the earlier filed utility application show the same article as that in the design application. In re Campbell, 1954 C.D. 191; 101 USPQ 406: Certiorari denied, 348 U.S. 858.

Title

The title is of great importance in a design application. It serves to identify the article in which the design is embodied and which is shown in the drawing, by the name generally used by the public. The title should be to a specific definite article. Thus a stove would be called a "Stove" and not a "Heating Device." The same title is used in the petition, in the preamble to the specification, in the description of the drawing, and in the claim. The title of the article being claimed in a design patent must correspond to the name of the article shown in solid lines in the drawing.

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

The title implies that the type of article named is old, but that the form shown is new. The title may particularize the type of article named by specifying a use "Bottle for Perfume" or by indicating a structural type—"Vacuum Bottle."

Description

Any description of the claimed design in the specification other than a brief description of the drawing figures is generally not necessary, for as a rule the illustration is its own best description. If there is a special description it should be of the appearance of the article. Special descriptions denoting the nature and environmental use of the claimed design are permissible where an appropriate title cannot satisfy this requirement. Special descriptions describing the construction of the claimed design are not permitted.

Where there is a particular feature of novelty in a case, this feature should be described in the specification by means of a "characteristic" feature clause, rule 71(c).

Statements in the specification which describe or suggest modifications of the design shown on the drawing are not permitted.

A disclaimer directed to any portion of the claim design invention is improper and not permitted in a design application. (35 U.S.C. 112). See Ex parte Remington, 114 O.G. 761, 1905 C.D. 761 and Ex parte Blum, 153 USPQ 177.

Claim

A claim is required and should be in formal terms to the ornamental design for the article (as specified in the title) as shown. Only one claim is permissible. (In re Rubinfield, 1959 C.D. 412; 123 USPQ 210.)

The claim may include the words "and described" following "shown." If there is any descriptive or declaratory matter in the specification other than the brief descriptions or definitions of the drawing figures, the words "and described" must follow "shown."

1503.02 Drawing [R-35]

Rule 152. Drawing. The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented.

The necessity for good drawings in a design application cannot be overemphasized. As the drawing constitutes substantially 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 shape, configuration and surface ornamentation of the article sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity. (35 U.S.C. 112.)

The ornamental design which is being claimed must be shown in solid lines in the drawing. Dotted lines for the purpose of indicating unimportant or immaterial features of the designed article are not permitted. There are no portions of a claimed design which are immaterial or unimportant. In re Blum, 852 O.G. 1045; 153 USPQ 177.

The drawing disclosure should make clear the article on which design patent protection is sought. Environmental structure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be adequately indicated by a reasonably concise title or statement in the specification as set forth in § 1503.01. Such showing by broken lines should not be in a manner as to obscure or confuse the appearance of the claimed design (note 35 U.S.C. 112). In general, such broken lines should not intrude upon or cross the showing of the claimed design; and should not be of heavier weight than the lines used in depicting the claimed design. Where a broken line showing of environmental structure must necessarily cross or intrude upon the representation of the claimed design, an il-

lustration of the article with the broken line showing of environmental structure may be included as a separate figure in addition to the figures fully disclosing the article itself for which the design protection is sought. The specification should make it clear that the structure shown in broken lines is not part of the design sought to be patented.

With practically all articles, except flat, thin goods, such as fabrics, at least two views are necessary, showing the article in three dimensions.

The drawing figures should be appropriately surface shaded to show character or contour of the surface represented. This is of particular importance in the showing of three dimensional articles where it is necessary to clearly delineate plane, concave, convex, raised and depressed surfaces of the article and distinguish between open and closed areas thereof.

While a sectional view that more clearly brings out the design is permissible (ex parte Lohman, 1912 C.D. 336; 184 O.G. 287) those that are presented for the evident purpose of including purely structural features, or exhibiting mechanical functions, are not favored. It is the article as seen by the observer, and not internal structure, which should be shown.

In design applications, as in "mechanical" cases, additional or amended illustration involving new matter is refused entry (35 U.S.C. 132, rule 118). In a design case, erasure of original disclosure may constitute new matter.

The practice of including in the application papers when filed a photograph of the article, or in the case of a flat, thin article such as cloth, a sample showing a complete unit of the design, is permissible and may be followed.

1504 Examination [R–35]

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

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

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

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

However, it more often occurs that the reference differs in some respects from the design claimed and the question of unobviousness is thus presented. Is the difference in configuration or ornamentation in the claimed design unobvious and does the difference add to its ornamental value? Is the difference for structural or functional reasons, or for the purpose of ornamentation? See § 706.

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

It is permissible, in a proper case, to illustrate more than one embodiment of a design invention in a single application. However, such embodiments can be presented only if they involve a single inventive concept and are not patentably distinct from each other. An unreasonable number of embodiments of the same invention will not be permitted. The disclosure of plural embodiments does not require or justify more than a single claim which claim must be in formal terms to the ornamental design for an article as shown and described. In re Rubinfield 1959 C.D. 412; 123 USPQ 210.

If two or more patentably distinct articles are disclosed and attempted to be claimed in a single design application, the examiner may require that the application be restricted to one invention. When a requirement for restriction is made, action on the merits of the claim will ordinarily be held in abeyance.

Procedures for handling restriction and double patenting situations are fully covered in Chapter 800 and for interference issues in Chapter 1100.

A utility patent and a design patent may be based on the same subject matter; however, there must be a clearly patentable distinction between them. Where the utility invention as defined by the claims cannot be made without infringing the design, double patenting exists and two patents cannot issue; but no double

patenting is present where a device can be made in accordance with the claims of the utility patent that has an appearance so different from the design as not to infringe the same. (In re Barber, 1936 C.D. 184; 465 O.G. 724; In re Thorington et al, 163 USPQ 644.)

With respect to copies of references provided without charge to applicant in design applications see § 707.05(a). [R–42]

1505 Allowance and Term of Design Patent [R–35]

35 U.S.C. 173. Term of design patent. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

Rule 155. Issue and term of design patents. If, on examination, it shall appear that the applicant is entitled to a design patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of an issue fee in an appropriate amount dependent on the duration of the term desired by the applicant. If this issue fee is not paid within three months of the date of the notice of allowance, the application shall be regarded as abandoned. If this fee is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing of sufficient cause for the late payment, it may be accepted by the Commissioner as though no abandonment had ever occurred.

35 U.S.C. 41(a). Patent fees. 3. In design cases: a. On filing each design application, $20. b. On issuing each design patent: For three years and six months, $10; for seven years, $20; and for fourteen years, $30.

There is a standard filing fee for all design applications. There is also an issue fee which varies according to the term elected for issue. It is no longer necessary for applicants to request notification prior to allowance to afford them the opportunity to choose a longer term. The choice of term is incorporated into the formal notice of allowance form. No design patent will issue unless an issue fee is paid.

The term of a design patent may not be extended by reissue. Ex parte Lawrence, 1946 C.D. 1; 70 USPQ 326. The fee for a design reissue application is $65 (35 U.S.C. 41(a) 4).

1506 Foreign Filing Dates [R–35]

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

The provisions of 35 U.S.C. 119 apply also to design applications. However, in order to obtain the benefit of an earlier foreign filing date, the United States application must be filed within six months of the earliest date on which any foreign application for the same design was filed.

Registration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119 and 35 U.S.C. 102(d), whether the foreign grant is published or not, Ex parte Weiss, 852 O.G. 255; 159 USPQ 122.

The time for filing the papers required by the statute is the date for payment of the issue fee unless earlier required as specified in rule 55. See § 201.14(a).

U. S. GOVERNMENT PRINTING OFFICE : 1974 O - 561-420