DESIGN PATENT PERSPECTIVE:
The Design Patent Application
PART 2

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The five items absolutely necessary for a complete design patent application are: (1) title, (2) specification with figure descriptions and one claim, (3) drawings, (4) an oath or declaration, and (5) fees. In last month's column we discussed the title. Now we will discuss the specification and introduce the claim and drawings.

The written description in a design patent specification usually is very simple. In contrast to word rich utility patent descriptions that must adequately describe and enable an invention, the primary role of the written description in a design patent specification is to briefly describe the drawings that constitute the claim. This typically is done with figure descriptions that indicate each view of the design drawings.

Figure descriptions do not have to follow any particular format, but they must describe the drawing views clearly and accurately.[1] When they do not, an examiner likely will object and offer a suggestion on how to improve the description. Here are some examples of descriptions objected to by examiners, together with suggested corrections, drawn from design patent prosecution histories:

FIGURE AND NUMBERING ERRORS:

Figure descriptions typically are in the form "FIG. 1 is a [type of view] of an [article of manufacture] showing my new design;" 37 CFR 1.84(u) provides that "[v]iew numbers must be preceded by the abbreviation "FIG." Some specifications improperly are submitted in the form "Figure" or "Fig.", and this is changed before publication to the proper form.

View descriptions "must be numbered in consecutive Arabic numerals, starting with 1 …."[2] Sometimes view descriptions of first embodiments are labeled as 1A, 1B, 1C, etc. and view descriptions of second embodiments labeled as 2A, 2B, 2C, etc. This is improper and the drawings must be renumbered 1, 2, 3, 4, 5, 6, etc.[3] Another error is to reference a single view as "FIG. 1." When only a single view is used to illustrate the claimed invention, "it must not be numbered and the abbreviation 'FIG.' must not appear."[4] For example, a single figure should be described as "[t]he FIGURE is a front view of a display screen with graphical user interface showing the new design" or "[t]he single FIGURE is a front view of a display screen with graphical user interface."

VIEW DESCRIPTION ERRORS:

Design patent drawings "must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design."[5] 37 CFR 1.74 provides that "[w]hen there are drawings, there shall be a brief description of the several views of the drawings …." The standard design patent drawing views are plan views (top and bottom), elevational views (front, back, right, and left), and a perspective view. Examples of additional views that can be included are sectional, exploded, separate parts, and alternate positions.

An examiner may object and correct if the examiner believes the view is not fully described. For example, "front view" has been corrected to "front elevational view," "top view" corrected to "top plan view," "plan view" corrected to "top plan view" or "bottom plan view," and "side elevational view" corrected to "left side elevational view" or "right side elevational view."[6] Other examiners may not believe adding the terms "plan" or "elevational" to the view description is necessary in the context of the particular design patent drawings, but when the view is fully and correctly described with such terms, it should avoid objections from all examiners.

Word order also is considered important by some examiners. For example, "front perspective view from above and one side" has been corrected to "top, front and left side perspective view" and "elevational view of the other side thereof" corrected to "left side elevational view." Finally, top and bottom views are "plan" views and side views are "elevational views," so it is incorrect to state "top elevational view" or "side plan view."

EMBODIMENT ERRORS:

If a design invention has multiple embodiments, then this must be clear in the figure descriptions. Multiple embodiments should be referred to as "first embodiment," "second embodiment," etc. It is improper to refer to multiple embodiments in vague terms. For example, "an illustrative embodiment" and "an embodiment" should be "a first embodiment" or "a second embodiment," etc. Another common error is using the term "embodiment" when there is only one embodiment. For example, the phrases "an embodiment of the invention," "of the embodiment," and "the embodiment" should be removed if only one embodiment exists.[7]

When only one embodiment is illustrated, it is proper to use the term "thereof" when referring back to the sole embodiment. For example, "FIG. 1 is a top, front, right perspective view of [an article of manufacture] showing my new design; FIG. 2 is a top plan view thereof." However, when multiple embodiments exist, the figure descriptions related to the second through last embodiments and that follow the figure description introducing the embodiment should refer to the first figure

number introducing the embodiment. For example, "FIG. 5 is a top plan view of a second embodiment thereof; FIG. 6 is a perspective view thereof;" should be "FIG. 5 is a top plan view of a second embodiment thereof; FIG. 6 is a right side elevational view of FIG. 5;". When embodiment drawings are removed due to restriction requirements, the removed embodiments obviously should be removed from the figure descriptions as well.

ARTICLE OF MANUFACTURE NAMING ERRORS:

The figure descriptions should include the article of manufacture as it is named in the title. For example, in a design patent application titled "bottle with pump," the figure description containing "bottle" should be changed to "bottle with pump." Extraneous phrases should be omitted. For example, "FIG. 1 is a top, front, and side perspective view of a Tie and Accessories Arranged in a Box *showing another arrangement* according to my new design" (emphasis added) should be "Fig. 1 is a top, front and side perspective view of a Tie and Accessories Arranged in a Box showing my new design"

POSITION ERRORS:

When design patent inventions are illustrated in different positions, two separate drawings must be used (rather than using just one drawing with the alternate position shown in broken lines).[8] The figure descriptions should describe the alternate position correctly. For example, the alternate position description "of a flattened ribbon" has been corrected to "of a ribbon shown in a flattened position" and "of a ribbon showing the two bands" corrected to "of the ribbon of FIG. 1 showing the two bands in an open position."

DUPLICATIVE AND FLAT, NON-ORNAMENTED VIEWS:

The MPEP provides that "[v]iews 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."[9] A correct figure description example is "FIG. 2 is a left side elevational view thereof, the right side being a mirror image."[10] Another example statement is "[t]he rear of the jewelry cabinet is flat and unornamented."[11]

In addition to the mandatory figure descriptions discussed above, a design patent application optionally may contain other statements in the specification including: (1) a description of the appearance of portions of the design not illustrated in the drawings; (2) a description disclaiming article portions not shown in the drawings as forming no part of the claimed design; (3) a statement explaining the purpose of broken lines; (4) a description explaining the nature and environmental use of the claimed design; and (5) a "characteristic features" statement describing a particular design feature considered by applicant to be novel or nonobvious over the prior art.[12] These permissible statements will be addressed in a future column. However, since broken line statements are so common, they are discussed below.

BROKEN LINE STATEMENTS:

Broken lines are used in design patent drawings most commonly to disclose related but unclaimed environment, to indicate unclaimed portions of the article of manufacture, and to define the boundaries of the claimed design.[13] Broken lines also may be used to illustrate a portion of the claimed design such as stitching or fold lines.[14] Broken lines may not be used to show alternate design positions, to indicate the relative importance of design portions, or to show hidden planes and surfaces.[15] Since broken lines can have multiple purposes in design patent drawings, the purpose of the broken lines must be made absolutely clear in the specification statement.

Many issued design patents contain the statement that broken lines "are for illustrative purposes only and form no part of the claimed design." Examiners now have begun to object to this statement because the phrase "illustrative purposes only" does not adequately describe the purpose of the broken lines.[16] To avoid such an objection, broken lines should be described as representing either unclaimed portions of the article, boundaries of the claim, or the environment in which the design is embodied.[17]

For example, the statement "[t]he broken lines of Figs. 1-3 are for illustrative purposes only and form no part of the claimed design" should be changed to "[t]he broken lines of Figs. 1-3 illustrate portions of the [article of manufacture] that form no part of the claimed design" or (as appropriate) "[t]he broken lines of Figs. 1-3 illustrate environmental matter and form no part of the claimed design."

The statement "[t]he short broken lines on the cervical collar are for illustrative purposes only and form no part of the claimed design" should be changed to "[t]he broken lines illustrate portions of the cervical collar that form no part of the claimed design" and the statement "[t]he portions depicted in broken lines are not part of the claimed design" should be changed to "[t]he broken lines shown in the drawings illustrate portions of the box compact that form no part of the claimed design."

When broken lines are used for both unclaimed structure and environment in the drawings, the description should be stated clearly. For example, "[t]he broken line showings of the text in the drawings illustrate portions of the graphical user interface that form no part of the claimed design. The broken line showing of the portion of the display screen illustrates the environment of the claimed design and forms no part thereof." Similarly, an example of a proper description of broken lines being used for claim boundary and environment is "[t] he 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."

Two additional common errors are including a broken line statement when the drawings do not have any broken lines and placing the statement in the wrong location. If there are no broken lines in the drawings, it is improper to include a broken line statement. When a statement is properly included, it should be placed after the view descriptions.[18]

THE CLAIM:

Design patent claims typically are written in the form "[t]he ornamental design for an [article of manufacture] as shown."[19] If a written description (such as a broken line statement) is included in the specification, then the typical form is "[t]he ornamental design for an [article of manufacture] as shown and described."[20] The claim should describe the article of manufacture with the same words that are used in the title.[21]

37 CFR 1.153 provides that "[m]ore than one claim is neither required nor permitted." 35 U.S.C. 112 provides in relevant part that "[t]he specification shall conclude with one *or more* claims …."

(emphasis added). Early in design patent jurisprudence more than one claim was allowed in each design patent. Indeed, in the first design patent case decided by a court, *Root v. Ball*,[22] the judge held that "the same [design] patent may include a patent for a combination, and an invention of some of the parts of which the combination consists."[23]

The "one claim" requirement for design patents originated in case law, based on the general rationale that only one design patent claim should be allowed per article of manufacture because the ordinary observer looked to the overall design of the article to determine infringement.[24] In *Ex Parte Gerard*,[25] the court stated "[i]n dealing with designs, patented or unpatented, ordinary observers judge of the designs as a whole, and are not called upon to dissect and analyze it with accuracy. To permit claims for parts that belong to details which possess no distinct and visible resemblance to and create in the mind no impression of the whole design would be to set traps for the unskilled and unwary."[26] In 1959, the Court of Customs and Patent Appeals (CCPA) reaffirmed the rule of only one claim per design patent.[27]

But in 1980, a fundamental shift in design patent law occurred. The CCPA held in *In re Zahn*[28] that a design patent applicant could claim just a *portion* of the article of manufacture (in this case just the shank portion of the drill bit) and that portion claiming did not violate either 35 U.S.C. § 171 or 35 U.S.C. § 112 (description and enablement). A strong argument exists that portion claiming undercuts the rationale used to limit design patents to only one claim. Following *In re Zahn*, the issue of whether design patents should be allowed to have "one or more claims" has not been revisited – but it should be. It makes sense to allow multiple claims in a design patent. Protection would be strengthened, cost would be less, and it would be consistent with the international trend regarding industrial designs. We will expand upon this discussion in next month's column.

THE DRAWINGS:

The drawings (or photographs) in a design patent application are critically important because they constitute the entire visual disclosure of the claim. Design patent drawings must comply with the requirements of 37 CFR §§ 1.152 and 1.84. A future column will explore these drawing requirements in detail, but in this brief introduction, some potential challenges and problems are mentioned.

The claimed design must be fully described and enabled by the drawings and associated description, if any. Design patent file wrappers contain many examples of drawings that are inadequate because they do not fully and clearly illustrate the design. Often drawing inadequacies cannot be cured due to the prohibition of introducing new matter into the application. The usual solution suggested by examiners is to place the unclear portion of the design in broken lines, which disclaims the portion and solves the problem. The conversion from solid lines to broken lines usually has the benefit of eliminating detail and strengthening the ability of the design patent claim to capture more designs as infringements – but it may create other serious problems as well.

First, eliminating a portion of the design claim may make the patent more vulnerable to a prior art challenge. Less detail usually increases the ability of a prior art design to serve as an anticipating reference or as a primary or secondary reference in an obviousness challenge.

Second, elimination of detail may make infringement harder to prove against a design that otherwise may have infringed. Consider an example of a design consisting of an ornamental border and interior. If the interior is not properly disclosed by the drawings, it will need to be converted to broken lines to avoid an enablement rejection and potential new matter rejection. However, a competitor now is free to copy the interior and combine it with an ornamental border altered just enough from the claimed border that it can avoid infringement under the ordinary observer test (when only the borders are compared). The borders and interiors when viewed together may create enough customer confusion to satisfy the ordinary observer test, but because the interior portion was disclaimed, it cannot be part of the comparative analysis. In such a case the applicant has given competitors an opportunity to substantially and freely copy the original design – all because the interior was not properly illustrated in the drawing.

Third, as mentioned in last month's column, section 102(b) of the new America Invents Act provides, in general, that disclosures made one year or less before the effective filing date are not prior art if (A) the disclosure was made by the inventor or by another who obtained the subject matter from the inventor, or (B) a third party disclosure was made after the subject matter had been disclosed by the inventor or by another who obtained the subject matter from the inventor. A significant issue is whether a disclosure must fully illustrate and enable a design patent claim to qualify as an inventor disclosure under (A) or a blocking disclosure under (B). Until this issue is fully resolved and explained by the courts, a cautious approach requires that pre-filing disclosures be fully capable of serving as design patent drawings.

Under the cautious approach, an applicant should not publish a disclosure until it is thoroughly checked to ensure it fully illustrates and enables what is intended as the design patent claim. Two tips may be helpful here. First, one way that design patent applicants have overcome drawing objections and rejections is to point out that the deficiency in a particular design feature contained in one drawing is illustrated (or can be determined) from other drawings that also were included in the disclosure. In other words, the applicants successfully argue that when the drawings are taken together as a whole, it reasonably can be concluded that the applicant had possession of and fully disclosed the entire design desired to be claimed. The lesson is that when disclosing, it may be helpful to have more drawing disclosures rather than less drawing disclosures. A potential problem with many drawing disclosures is inconsistencies between the drawings, but this problem is usually easier to overcome than the problem of lack of disclosure, particularly when the inconsistencies are minor.

A second tip is that it may be helpful to accompany the pre-filing drawing disclosure with a written description disclosure. The primary reason *utility* patent drawings usually can be modified without incurring new matter rejections is that the written description in the specification is detailed and usually indicates that the desired modification was disclosed originally with words. Written descriptions are permissible in design patent specifications (or separate papers) as well,[29] and a carefully drafted written description may be able to serve as an antecedent basis "safety net" to convert an otherwise non-enabling drawing disclosure into one that can fully provide the benefits under section 102(b) of the new America Invents Act.

In next month's column we will explore the benefits of and make the case for

multiple claims in a design patent. We also will discuss the complex requirements and common errors made in design patent drawings.

ENDNOTES

1. *See* MPEP § 1503.01, subsection II.
2. 37 CFR 1.84(u).
3. For an example, see the notice of allowance in D666,560.
4. *Id.*
5. 37 CFR 1.152.
6. For an example, see the notice of allowance in D666,501.
7. For an example, see the notice of allowance in D666,330.
8. *Id.*
9. MPEP § 1503.02, subsection I.
10. *See A Guide to Filing a Design Patent Application*, page 9, available at www.uspto.gov.
11. *Id.* at 8.
12. *See* MPEP § 1503.01, subsection II.
13. *See* MPEP § 1503.02, subsection III.
14. *Id.*
15. *Id.*; 37 CFR 1.152.
16. *See* MPEP § 1503.01, subsection II(C) (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.); *see also In re Blum*, 153 USPQ 177 (CCPA 1967) (often cited by examiners in support of the objection); For examples of such recent objections and corrections, see the notice of allowance in the following design patents: D666,403; D666,631; D666,708; D666,302; D666,305; D666,760; and D666,773.
17. *See In re Blum*, 153 USPQ 177 (1967).
18. *See* 37 CFR 1.154 (b).
19. *See* MPEP § 1503.01, subsection III.
20. *Id.*
21. *Id.*
22. 4 McLean, 177 (1846).
23. *See also* Simonds, *The Law of Design Patents*, page 198 (1874) ("It will thus be seen that the courts and the Patent Office are both committed to the doctrine of allowing claims to specific features of a design, both singly and in combination.").
24. *Ex Parte Wiessner*, 1898 C.D. 236, 85 O.G. 937.
25. 43 O.G. 1235.
26. *Id.* (as quoted in *Ex Parte Wiessner*).
27. *In re Rubinfield* , 270 F.2d 391 (CCPA 1959).
28. 617 F.2d 261 (CCPA 1980).
29. *See* MPEP section 1502.01 II ("[W]hile not required, such a [written] 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) …. In addition to the figure descriptions, the following types of statements are permissible in the specification: (A) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure.").