

Extracts from

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Manual of Patent Examining  
Procedure (MPEP)

Chapter 1500

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

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¶ 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.

### 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 design claim 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.

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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.<

¶ 15.62 Amend Claim “As Shown”

For proper form (37 CFR 1.153), the claim [1] amended to read: “[2] claim: The ornamental design for [3] as shown.”

**Examiner Note:**

1. In bracket 1, insert --must be--.
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), 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--.
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--.

## 1503.02 Drawing [R-5]

*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 applica-

tion. 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, 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 [I].

**Examiner Note:**

In bracket 1, insert statutory or regulatory basis for objection and an explanation.

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¶ 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.

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¶ 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 drawings in compliance with the requirement therefor, care must be exercised to avoid introduction of anything which could be construed to be new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121.

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, 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. *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). Such views should be objected to under 35 U.S.C. 112, second paragraph, and their cancellation should be required. 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, 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.<

Form paragraph 15.49 may be used to notify applicant that surface shading is necessary.

### ¶ 15.49 Surface Shading Necessary

The drawing figures should be appropriately and adequately shaded to show clearly the character and/or contour of all surfaces represented. See 37 CFR 1.152. This is of particular importance in the showing of three (3) dimensional articles where it is necessary to delineate plane, concave, convex, raised, and/or depressed surfaces of the subject matter, and to distinguish between open and closed areas. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast.

## 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. *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. 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. 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. *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 *Design Claimed Shown in Full Lines*

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 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*

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.

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¶ 15.50.02 *Description of Broken Lines*

The following statement must 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. --

The above statement [3] inserted in the specification preceding the claim.

**Examiner Note:**

1. In bracket 1, insert name of structure.
2. In bracket 2, insert --portions of the "article"-- or --environmental structure--.
3. In bracket 3, insert --must be-- or --has been--.

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¶ 15.50.03 *Objectionable Use of Broken Lines In Drawings*

Dotted lines or broken lines used for environmental structure should not cross or intrude upon the representation of the claimed design for which design protection is sought. Such dotted lines may obscure the claimed design and render the disclosure indefinite (35 U.S.C. 112).

¶ 15.50.04 *Proper Drawing Disclosure With Use of Broken Lines*

Where 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 addi-

tion to the figures showing only claimed subject matter, 35 U.S.C. 112, first paragraph.

¶ 15.50.05 *Description of Broken Lines as Boundary of Design*

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

-- The broken line(s) which define the bounds of the claimed design form no part thereof.--

#### 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 prohibited 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 II.

#### V. PHOTOGRAPHS AND COLOR DRAWINGS

Drawings are normally required to be submitted in black ink on white paper. See 37 CFR 1.84(a)(1). Photographs are acceptable only in applications in which the invention is not capable of being illustrated in an ink drawing or where the invention is shown more clearly in a photograph (e.g., photographs of ornamental effects are acceptable). See also 37 CFR 1.81(c) and 1.83(c), and MPEP § 608.02.

Photographs submitted in lieu of ink drawings must comply with 37 CFR 1.84(b). Only one set of black and white photographs is required. Color photographs and color drawings may be submitted in design applications if filed with a petition under 37 CFR 1.84(a)(2). Petitions to accept color photographs or color drawings will be considered by the Primary Examiners as delegated by the TC Director. A grantable petition under 37 CFR 1.84(a)(2) must explain that color drawings or color photographs are necessary because color is an integral part of the claimed design. Any other explanation as to why color drawings or color photographs are necessary will normally not be acceptable. A grantable petition must also be accompanied by: (1) the fee set forth in 37 CFR 1.17(h); (2) three sets of the color photographs or color drawings; and (3) an amendment to the specification inserting the following statement --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, first and second paragraphs, as nonenabling and indefinite.

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

When filing informal photographs or informal 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 § 1504.04, subsection II.

Color photographs and color drawings may be submitted in design applications if filed with a petition under 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 formal 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 a surface for color may interfere with a clear showing of the design as required by 35 U.S.C. 112, first paragraph, as surface shading cannot be used to define the contours of the design.

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 formal 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 1504.04, subsection II. Note also 37 CFR 1.152, which requires that the disclosure in formal photographs be limited to the design for the article claimed.

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#### ¶ 15.05.041 *Informal Color Drawing(s)/Photograph(s) Submitted*

Informal color photographs or drawings have been submitted for the purposes of obtaining a filing date. When formal 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). 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.

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 informal 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. In these situations, applicant may file a petition to accept formal color drawings or color photographs under 37 CFR 1.84(a)(2).

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#### ¶ 15.45 *Color Photographs/Drawings As Informal Drawings*

For filing date purposes, in those design patent applications containing color photographs/drawings contrary to the requirement for ink drawings or black and white photographs, the Office of Initial Patent Examination has been authorized to construe the color photographs/drawings as informal drawings rather than to hold the applications incomplete as filed. By so doing, the Patent and Trademark Office can accept the applications without requiring applicants to file petitions to obtain the original deposit date as the filing date. However, color photographs or color drawings are not permitted in design applications in the absence of a grantable petition pursuant to 37 CFR 1.84(a)(2). Before the color photographs or color drawings in this application can be treated as formal drawings, applicant must submit [1].

#### **Examiner Note:**

In bracket 1, insert --a petition--, --the fee--, --statement in the specification--, --explanation of why color disclosure is neces-

sary-- , and -- three full sets of color photographs or color drawings-- .

## 1504 Examination [R-2]

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 Official 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*, 1935 C.D. 11, 453 O.G. 213.

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.

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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. 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 draftsman familiar with design practice to prepare the formal drawings. Applicant should also be notified that the U.S. Patent and Trademark Office cannot aid in the selection of a draftsman. 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.

Applicant is advised of the availability of the publication “Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office.” This publication is for sale by the

Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

¶ 15.66.01 *Employ Services of Professional Patent Draftsperson (Design Application Only)*

As the value of a design patent is largely dependent upon the skillful preparation of the drawings, applicant might consider it desirable to employ the services of a professional patent draftsman familiar with design practice. The U.S. Patent and Trademark Office cannot aid in the selection of a draftsman.

**Examiner Note:**

This form paragraph should only be used in *pro se* applications where 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.

## 1504.01 Statutory Subject Matter for Designs

### 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.

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:

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.

¶ 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.

¶ 15.44 *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, 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-5]

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.’ ” *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. 37 CFR 1.71 and 1.152-1.154.

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.

(1) Review the drawing to determine whether a computer screen, monitor, other display panel, or portion thereof, is shown. 37 CFR 1.152.

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.” 37 CFR 1.152. In addition, the drawing must comply with 37 CFR 1.84.

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

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. 37 CFR 1.71. 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, first paragraph.

(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 formal requirements of the Rules of Practice in Patent Cases. 37 CFR 1.71, 1.81-1.85, and 1.152-1.154. Suggest amendments which would bring the disclosure into compliance with the formal 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.

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### 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-5]

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. *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-5]

#### 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. *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.” *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.” *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.” *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240, 231 USPQ 774, 778 (Fed. Cir. 1986). The court in *Smith v. M & B Sales & Manufacturing*, 13 USPQ2d 2002, 2004 (N. D. Cal. 1990), states that 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.” *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. The court in *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992), stated that “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 the holding of the court in *In re Carletti et al.*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964), that 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.’” *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. *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. *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.” *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.” *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. \*\* *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. *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.

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**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 the demand for the article. *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. *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. *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.” *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. *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” as required by the court in *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. *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. *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.” *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.

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. *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” as required by the court in *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.” *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.