

Appellant's Brief

BRIEF FOR APPELLANT

In The
United States Court of Appeals
For The Federal Circuit

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MAR 30 1989

FRANCIS X. GINDHART
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89-1241

RACING STROLLERS, INC.,
Plaintiff-Appellant,

v.

TRI INDUSTRIES, INC., JAY PAULSON,
PAULSON MARKETING and TIM GALLIGAN,
Defendants-Appellees.

On Appeal From the United States District Court
For the District of Minnesota, Fourth Division
The Honorable James M. Rosenbaum

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CERTIFICATE OF INTEREST

Counsel for the appellant certifies the following:

1. The full name of every party or amicus represented by us is:

Racing Strollers, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by us is:

None

3. The publicly held affiliates of any corporate party or amicus represented by us are:

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by us in the trial court or are expected to appear in this court are:

Albert L. Underhill
Merchant, Gould, Smith, Edell, Welter & Schmidt

George C. Rondeau, Jr.
Maurice J. Pirio
Seed and Berry

STATEMENT OF RELATED CASES

1 No other appeal in or from this civil action in the
2 district court was previously before this or any other appellate
3 court under the same or similar title. Appellant knows of no
4 other case pending in this or any other court that will directly
5 affect or be directly affected by this court's decision in this
6 appeal.

7 However, appellant is informed that the United States
8 Patent and Trademark Office is regularly granting design patents
9 claiming priority based upon earlier-filed utility applications,
10 and believes that this decision will affect the validity of at
11 least some of these patents and the granting of further design
12 patents by the United States Patent and Trademark Office.

STATEMENT OF JURISDICTION

1 The district court in this action has original jurisdiction
2 of a claim for patent infringement pursuant to 28 U.S.C.
3 § 1338(a).

4 This appeal is from the district court's order certifying
5 that this appeal involves a controlling question of law as to
6 which there is substantial ground for difference of opinion, and
7 certifying that an immediate appeal may materially advance the
8 ultimate termination of the litigation. 28 U.S.C. § 1292(b).
9 The Court of Appeals for the Federal Circuit has exclusive
10 jurisdiction of such appeals pursuant to 28 U.S.C. §§ 1291(c)(1)
11 and 1295(a)(1).

12 Appellant filed its Petition for Leave to Appeal in a
13 timely manner pursuant to 28 U.S.C. § 1292(b). The order of the
14 district court was entered on December 14, 1988. Appellant then
15 filed its petition on December 22, 1988, within the ten (10) day
16 prescribed period. This court granted the petition on
17 January 6, 1989.

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STATEMENT OF THE ISSUE

Whether this court should overrule the 1954 Court of Customs and Patent Appeals holding that a design patent application cannot be filed as a division of an earlier-filed utility application and thus is not entitled to the benefit of the earlier filing date of the utility application when no statute so limits the rights of a design applicant.

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STATEMENT OF THE CASE

This appeal arises out of a design patent infringement claim brought in the United States District Court for the District of Minnesota by the appellant (Appendix, pp. 3-12, hereinafter "App"). The district court denied appellant's application for a temporary restraining order, but the court stated that the order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation (App, pp. 1-2). Appellant then filed a petition for leave to appeal with this court (App, pp. 13-18). On January 6, 1989, this court granted the petition (App, pp. 19-21). The question of law on appeal is

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Whether an application for a design patent filed as a division of an earlier filed application for a utility patent is entitled to the benefit of the earlier filing date of the utility application under 35 U.S.C. § 120 and 35 U.S.C. § 121

1 (App, p. 20). In its order granting the petition, this court
2 held in abeyance appellant's Motion to Expedite pending
3 resolution of appellant's Suggestion for Hearing In Banc (App,
4 p. 20).

5 The proceedings in the district court have not been stayed.
6 Appellees have served interrogatories and requests for
7 production of documents upon appellant, and appellant has
8 responded. Appellant has served interrogatories and requests
9 for production of documents upon appellees.

10 Appellant is assignee of United States Letters Patent No.
11 Des. 297,525 entitled "Frame for a Baby Stroller," which issued
12 on September 6, 1988 (App, pp. 71-73). The application for the
13 design patent was filed on April 14, 1986 (App, p. 71). The
14 design patent application was a division of the Utility
15 Application Serial No. 663,450, filed on October 22, 1984 (App.
16 p. 71). Appellant first sold baby strollers embodying the
17 patented design more than one year before the April 14, 1986
18 filing date for the design application, but within one year
19 before the filing date of the utility application (App, p. 27).

20 Appellant brought suit based upon appellees' infringement
21 of the design patent (App, pp. 3-12). At a hearing to consider
22 an application for a temporary restraining order, appellees
23 contested the validity of appellant's patent (App, p. 27).
24 Appellees argued that, according to In re Campbell, 212 F.2d
25 606, 101 U.S.P.Q. 406 (C.C.P.A.), cert. denied, 348 U.S. 858
26 (1954), a design application cannot be a division of a utility

1 application and obtain the benefit of the earlier utility
2 application filing date under 35 U.S.C. §§ 120 and 121 (App, p.
3 31). Appellees argued that since sales of strollers embodying
4 the patented design occurred more than one year before the
5 filing date of the design application, the design patent would
6 likely be held invalid at a trial pursuant to 35 U.S.C. § 102(b)
7 (App, pp. 27-28). Appellant, on the other hand, asserted that
8 the Court of Appeals for the Federal Circuit decision in
9 Kangaroo U.S.A., Inc. v. Caldor, Inc., 778 F.2d 1571, 228
10 U.S.P.Q. 32 (Fed. Cir. 1985) and the subsequent Patent and
11 Trademark Office Board of Appeal decision Ex parte Duniau, 1
12 U.S.P.Q. 1652 (P.T.O. Bd. of App. & Inter. 1986) indicated that
13 the Federal Circuit would likely not follow Campbell (App, pp.
14 28-31). Nevertheless, the district court felt compelled by
15 stare decisis to follow Campbell (App, pp. 1-2 and 67-68). The
16 temporary restraining order was denied on the basis that the
17 design patent would likely be held invalid at trial unless the
18 decision in Campbell was overruled (App, pp. 1-2 and 67-68).

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SUMMARY OF THE ARGUMENT

This court should overrule the Campbell holding that a design patent application can never be entitled to the benefit of the filing date of an earlier-filed utility application. Congress mandated that a design patentee is entitled to all the benefits of the patent law, unless the statute specifically provides otherwise. The Campbell court failed to recognize this. When faced with the converse situation, this court held that a utility application can claim the benefit of an earlier-filed design application because no statute prohibits such a claim. Similarly, no statute prohibits a design application from claiming priority based upon a utility application.

The Campbell court incorrectly assumed that a utility application could never disclose a design. This assumption is inconsistent with the requirements of 35 U.S.C. § 112, especially when, as in Campbell, the drawings in the utility and design applications showed the same device. This court should rule that a design application is entitled to the benefit of the earlier filing date of a utility application, when the disclosure in the utility application meets all the requirements of Section 112 as applied to the design.

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ARGUMENT

THIS COURT SHOULD OVERRULE THE CAMPBELL HOLDING THAT A DESIGN APPLICATION CANNOT BE A DIVISION OF A UTILITY APPLICATION.

This court should overrule the 1954 Court of Customs and Patent Appeals (C.C.P.A.) holding that a design patent application cannot be a division of a utility application, and thus the design application is not entitled to the benefit of the earlier filing date of the utility application. In re Campbell, 212 F.2d 606, 101 U.S.P.Q. 406 (C.C.P.A.), cert. denied, 348 U.S. 858 (1954). While this court adopted the holdings of the C.C.P.A. as precedent, this court has the power, when sitting in banc, to overrule a holding of the C.C.P.A. with an appropriate explanation of the factors that compel removal of the holding as precedent. South Corp. v. United States, 690 F.2d 1368, 1370 n.2, 215 U.S.P.Q. 657, 658 n.2 (Fed. Cir. 1982).

This court should remove the Campbell holding as precedent because (A) the Campbell court deprived a design patent applicant an important benefit of the patent law, (B) the Campbell court incorrectly reasoned that a utility patent application can never disclose a design, and (C) the Campbell holding is inconsistent with subsequent decisions of this court and other tribunals.

1 A. The Campbell Court Ignored The Rule That The Laws
2 Relating To Patents For Inventions Apply With Equal
 Force To Patents For Designs.

3 The Campbell court ignored the congressional mandate that
4 the provisions of the patent law "relating to patents for
5 inventions shall apply to patents for designs, except as
6 otherwise provided." 35 U.S.C. § 171. In Campbell, the
7 C.C.P.A. held that a design patent application cannot base
8 filing-date priority upon an earlier-filed utility patent
9 application. Campbell, at 609, 101 U.S.P.Q. at 409. Congress,
10 however, mandated that:

11 [a]n application for patent for an invention disclosed
12 in the manner provided by the first paragraph of
13 section 112 of this title in an application previously
14 filed in the United States . . . which is filed by an
15 inventor or inventors named in the previously filed
16 application shall have the same effect, as to such
17 invention, as though filed on the date of the prior
 application, if filed before the patenting or
 abandonment of or termination of proceedings on the
 first application . . . and if it contains or is
 amended to contain a specific reference to the earlier
 filed application.

18 35 U.S.C. § 120 (emphasis added). Section 120 is applicable to
19 all patent applications, not just utility applications.
20 Congress made no special exclusion or limitation for design
21 applications, and Congress did not indicate that it intended
22 design applications not to be entitled to the priority of an
23 earlier-filed design application or utility application.
24 Congress placed no limitation on the type of application upon
25 which priority could be based and only required that the
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1 application upon which priority is based satisfy the disclosure
2 requirements of Section 112.

3 This court recently held that no statute prohibits a
4 utility application from claiming priority based upon a
5 disclosure in a design application.¹ Kangaroo U.S.A., Inc. v.
6 Caldor, Inc., 778 F.2d 1571, 1574, 228 U.S.P.Q. 32, 33 (Fed.
7 Cir. 1985). Similarly, no statute prohibits a design
8 application from claiming priority based upon a disclosure in a
9 utility application. Congress gave no indication that a later-
10 filed design patent application could not claim priority based
11 upon a utility patent application and receive equal treatment
12 with utility applications under Sections 120 and 121.

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15 ¹ This statement was indeed a holding of the case because it
16 was necessary for the court's decision. In Kangaroo, the
17 patentee asserted that the earlier-filed design application
18 adequately disclosed the invention claimed in the utility
19 application. The issue was whether the claim to priority
20 constituted inequitable conduct, in particular, whether the
21 patentee possessed the requisite intent to deceive. If, as a
22 matter of law, a utility application could never base priority
23 upon a design application, then a misrepresentation as to the
24 adequacy of the disclosure would never be material. If the law
25 were so, such a misrepresentation could not be material because
26 it could have no causal relation to the issuance of the patent;
thus, it could not constitute inequitable conduct. N.V. Akzo v.
E.I. du Pont de Nemours & Co., 810 F.2d 1148, 1153, 1 U.S.P.Q.2d
1704, 1708-09 (Fed. Cir. 1987). Therefore, it was necessary for
this court, as it was for the lower court, to first hold that a
utility application could base priority upon an earlier-filed
design application. Kangaroo U.S.A., Inc. v. Caldor, Inc., 585
F. Supp. 1516, 222 U.S.P.Q. 703 (S.D.N.Y. 1984), vacated, 778
F.2d 1571, 228 U.S.P.Q. 32 (Fed. Cir. 1985). A
misrepresentation, even if intended to deceive, cannot
constitute inequitable conduct unless it is material. Corona
Cord Tire Co. v. Dovan Chemical Corp., 276 U.S. 358, 373-74
(1928).

1 In fact, Congress was very specific that it wanted the
2 provisions of Title 35, the patent statute, applied equally to
3 patents for designs except as specifically provided in Title 35.
4 35 U.S.C. § 171. Further, whenever Congress did want design
5 patents to be treated differently than utility patents it
6 clearly indicated so in Title 35. For example, Congress
7 provided that the fees for filing a design application were to
8 be different than the fees for filing a utility application. 35
9 U.S.C. § 41. Also, Congress provided that the term of a design
10 patent was to be 14 years, while the term of a utility patent
11 was to be 17 years. 35 U.S.C. §§ 154 and 173.

12 In short, the patent law does not support the Campbell
13 holding that denies design patent applications treatment
14 equivalent to that given to utility patent applications by
15 preventing priority based upon earlier-filed utility patent
16 applications.

17 The United States Supreme Court recently reiterated its
18 long-standing position that the courts should not place judicial
19 limitations on the rights of a patent applicant. The Court
20 cautioned that courts "should not read into the patent laws
21 limitations and conditions which the legislature has not
22 expressed." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206
23 U.S.P.Q. 193, 196 (1980) (quoting United States v. Dublier
24 Condenser Corp., 289 U.S. 178, 199, 17 U.S.P.Q. 154, 162
25 (1933)). The Campbell court, ignoring this long-standing
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1 position of the Supreme Court, placed a judicial limitation upon
2 a design patent applicant which the Congress did not express.

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4 B. The Campbell Court Incorrectly Held That A Design
Cannot Be Disclosed In A Utility Application.

5 The Campbell court believed that a utility application
6 cannot disclose a design. Campbell at 609, 101 U.S.P.Q. at 409.
7 In Campbell, the parties stipulated that drawings of the
8 earlier-filed utility application showed the same device as
9 shown by the drawings of the design application. Id. at 608,
10 101 U.S.P.Q. at 409. The court stated that to amend the
11 application to put it in design form, the applicant would need
12 to (1) delete the specification originally filed, with the
13 exception of the description of the design figures, and file the
14 usual form of design specification, (2) cancel all of the
15 mechanical claims and substitute the usual form of the design
16 claim, (3) cancel the original oath and substitute the usual
17 design oath, and (4) cancel all of the drawings with the
18 exception of the design figures. Id. at 609, 101 U.S.P.Q. at
19 409. The court recognized that it is not unusual to do each one
20 of these cancellation and substitution steps. Id. However, the
21 court then concluded that an application so amended would not be
22 a continuation or division of the first, "but an application for
23 an alleged invention not previously disclosed in the earlier
24 application." Id. (emphasis added). Such a conclusion is
25 unsupportable and incorrect.
26

1 No statute limits the amending of an application. An
2 applicant may freely amend the application, so long as no new
3 matter is introduced into the disclosure of the invention. 35
4 U.S.C. § 132. The Campbell court limited the amending process
5 by not allowing a utility application to be amended to the
6 format of a design application. The C.C.P.A., quoting the
7 Supreme Court, has stated that "[a] party seeking a right under
8 the patents [sic] statutes may avail himself of all their
9 provisions, and the courts may not deny him the benefit of a
10 single one. These are questions not of natural but of purely
11 statutory right." In re Hogan, 559 F.2d 595, 603, 194 U.S.P.Q.
12 527, 535 (C.C.P.A. 1977) (quoting United States v. American Bell
13 Telephone Co., 167 U.S. 224, 247 (1897)). The Campbell holding
14 impermissibly deprives a design applicant of a benefit of the
15 patent law.

16 Moreover, no statute states that a utility application
17 cannot disclose a design. The Campbell analysis, to the
18 contrary, is inconsistent with the Section 112 requirements for
19 a design application. This court has ruled that Sections 112
20 and 120 only require that "the design claimed in the second
21 application must be the same design disclosed in the parent
22 application." In re Salmon, 705 F.2d 1579, 1581, 217 U.S.P.Q.
23 981, 983 (Fed. Cir. 1983) (a design application claiming
24 priority on earlier-filed design application). Assuming that
25 the same device is shown in both the utility and design
26 applications (as they were in Campbell and are in the present

1 situation before this court), then the design is disclosed in
2 the utility. This satisfies the requirement of Section 112
3 because it is the same disclosure that would be a sufficient
4 disclosure in a design application not claiming priority.

5 C. The Campbell Reasoning Is Inconsistent With Subsequent
6 Decisions Of This Court, The Court Of Customs And
7 Patent Appeals, The Patent And Trademark Office Board
8 Of Appeals, And The Commissioner Of Patents And
9 Trademarks.

10 This court has held that no statute prohibits a utility
11 patent application from being a division of an earlier-filed
12 design patent application. No logical justification exists for
13 why the converse should not be true. Moreover, other tribunals
14 have been forced to distinguish Campbell, because Campbell
15 incorrectly states the law.

- 16 1. No statute justifies allowing a utility
17 application to claim the benefit of an earlier-
18 filed design application but not allowing the
19 converse -- a design application to claim the
20 benefit of an earlier-filed utility application.

21 This court has held that no statute prohibits a utility
22 patent application from claiming priority based upon a
23 disclosure in a design application.² Kangaroo U.S.A., Inc. v.
24 Caldor, Inc., 778 F.2d 1571, 1574, 228 U.S.P.Q. 32, 33 (Fed.
25 Cir. 1985). The Campbell court many years earlier when faced
26 with the converse situation -- a design application claiming

2 The C.C.P.A. when confronted with a similar issue
several years earlier specifically declined to decide whether a
utility application could be a continuation-in-part of a design
application. In re Berkman, 642 F.2d 427, 429 n.3, 209 U.S.P.Q.
45, 46 n.3 (C.C.P.A. 1981).

1 priority based upon an earlier-filed utility application --
2 refused to allow the claim of priority. No statute justifies
3 this disparity in treatment of utility and design applications,
4 and 35 U.S.C. § 171 prohibits it.

5 The Patent and Trademark Office Board of Appeals and
6 Interferences no longer follows Campbell, but rather follows the
7 reasoning of KangaROOS. Ex parte Duniau, 1 U.S.P.Q.2d 1652,
8 1654 (P.T.O. Bd. of App. & Inter. 1986). In Duniau, the Board
9 permitted a design patent application to claim priority based
10 upon an earlier-filed utility patent application. The examiner
11 argued that a design application cannot claim priority based
12 upon an earlier-filed utility application in light of Campbell,
13 but the Board rejected the examiner's argument. Id. Indeed,
14 the Commissioner of Patents and Trademarks recognizes this lack
15 of justification and is regularly issuing design patents that
16 base priority upon an earlier-filed utility application.³

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18 2. The Court of Customs and Patent Appeals and the
19 Board of Appeals have distinguished Campbell
because it is not consistent with congressional
intent.

20 In 1982 even the Court of Customs and Patent Appeals took
21 the effort to distinguish the 1954 Campbell decision when the

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23 ³ Appellant's design patent application which resulted
24 in the design patent in suit was issued by the Commissioner with
25 a claim and priority based upon an earlier-filed utility
26 application, even though the claim for priority was initially
rejected by the examiner relying upon an out-of-date section of
the Manual of Patent Examining Procedure citing the holding of
Campbell (35 U.S.C. § 6, App, p. 33).

1 Patent and Trademark Office Board of Appeals tried to apply
2 Campbell by analogy to a continuation of a reissue patent
3 application. In re Bauman, 683 F.2d 405, 214 U.S.P.Q. 585
4 (C.C.P.A. 1982). The Bauman court distinguished Campbell noting
5 that the Campbell court based its holding on the fundamental
6 difference between the disclosure requirements for a design and
7 utility application. Id. at 409, 214 U.S.P.Q. at 589. The
8 distinction made in Campbell between design and utility
9 applications could not withstand scrutiny then, and cannot now.

10 The disclosure requirements for both a design patent
11 application and a utility patent application are the same. 35
12 U.S.C. § 112. Section 112 applies equally to utility and design
13 patent applications. 35 U.S.C. § 171. Although the Patent and
14 Trademark Office requires different formats for design and
15 utility patent disclosures, Congress has mandated that both
16 disclosures must describe the invention sufficiently to enable
17 any person skilled in the art to which it pertains to make and
18 use the invention and set forth the best mode contemplated for
19 carrying out the invention. 35 U.S.C. § 112; 37 C.F.R. § 1.51
20 et seq. and § 1.151. Congress did not mandate any fundamental
21 difference between the Section 112 requirements of design and
22 utility applications. Consequently, the law does not support
23 perpetuation of the Bauman distinction, one made only to justify
24 a holding inconsistent with Campbell and to avoid following the
25 incorrect Campbell holding.

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1 The Board of Appeals, before its Ex parte Duniau decision,
2 also found it necessary to distinguish Campbell. Ex parte
3 Solomons, 201 U.S.P.Q. 42 (P.T.O. Bd. of App. 1978). In
4 Solomons, the Board reversed an examiner's decision that a plant
5 patent application could not claim priority upon an earlier-
6 filed utility application. The Board distinguished Campbell by
7 stating that the "statutory requirements were different in
8 Campbell as were the terms of the grants and the statutory
9 fees." Id. at 43. No statute supports the conclusion that this
10 distinction should prevent a claim of priority. Rather, the
11 Board made the distinction out of necessity to avoid the
12 incorrect holding of Campbell. The patent laws relating to
13 patents for inventions apply equally to plant patents, design
14 patents, and utility patents, except as otherwise specifically
15 provided in Title 35. 35 U.S.C. § 161 and § 171.

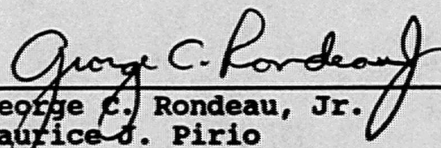
16 In short, the C.C.P.A. and the Board of Appeals
17 distinguished and narrowly construed Campbell because no statute
18 supports the incorrect holding that a design patent application
19 cannot claim priority based upon an earlier-filed utility patent
20 application.

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CONCLUSION

This court should overrule Campbell. The Campbell court was wrong and is no longer followed. No statutory justification exists for prohibiting design patent applications from claiming filing-date priority based upon earlier-filed utility patent applications. No court has the power to deprive, as the Campbell court did, an applicant a benefit of the statute. This court should reaffirm that a design applicant is entitled to every benefit of the patent statute. This court should rule that a design patent application filed as a division of an earlier-filed utility patent application is entitled to the benefit of the earlier filing date of the utility patent application under 35 U.S.C. §§ 120 and 121.

Respectfully submitted,


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