

PETITION FOR

REHEARING

BY

APPELLANT

SUGGESTION FOR HEARING IN BANC

RECEIVED
DEC 22 1988
United States Court of Appeals
For the Federal Circuit

In The **MISCELLANEOUS**
DOCKET **89-1241**
United States Court of Appeals
For The Federal Circuit

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
FEB - 1 1989
FRANCIS X. GINDHART
CLERK

RACING STROLLERS, INC.,
Plaintiff/Appellant,

v.

TRI INDUSTRIES, INC., JAY PAULSON,
PAULSON MARKETING and TIM GALLIGAN,
Defendant/Appellees.

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

GEORGE C. RONDEAU, JR.
MAURICE J. PIRIO
SEED AND BERRY

6300 COLUMBIA CENTER
SEATTLE, WASHINGTON 98104-7092
(206) 622-4900

Attorneys for Appellant
Racing Strollers, Inc.

CERTIFICATE OF INTEREST

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26

Counsel for the appellant certifies the following:

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

None

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

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency 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

WDPLAV1

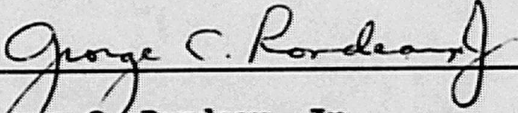
TABLE OF CITATIONS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26

<u>CASES</u>	<u>Page</u>
<u>Ex parte Duniau</u> , 1 U.S.P.Q.2d 1652 (PTO Bd. of App. 1986)	1
<u>In re Campbell</u> , 212 F.2d 606, 101 U.S.P.Q. 406 (C.C.P.A.), <u>cert. denied</u> , 348 U.S. 858 (1954)	1
<u>KangaROOS U.S.A., Inc. v. Caldor, Inc.</u> , 778 F.2d 1571, 28 U.S.P.Q. 32 (Fed. Cir. 1985)2
<u>South Corporation v. United States</u> , 690 F.2d 1368, 1370 n.2, 215 U.S.P.Q. 657, 658, n.2 (Fed. Cir. 1982) (<u>in banc</u>)	1, 3
 <u>FEDERAL STATUTES</u>	
35 U.S.C. § 112	1
35 U.S.C. § 120	1
35 U.S.C. § 121	1

1 Based on my reasoned and studied professional judgment, I
2 believe this appeal requires answers to one precedent-setting
3 question of exceptional importance:

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

8 
9 _____
10 George C. Rondeau, Jr.

11 Attorney of Record for Appellant

12 This Court, sitting in banc, has the power to overrule a
13 holding of the Court of Customs and Patent Appeals, which this
14 Court has adopted as precedent. South Corporation v. United
15 States, 690 F.2d 1368, 1370 n.2, 215 U.S.P.Q. 657, 658, n.2
16 (Fed. Cir. 1982) (in banc). Appellant is requesting this Court
17 to overrule the holding of In re Campbell, 212 F.2d 606, 101
18 U.S.P.Q. 406 (C.C.P.A.), cert. denied, 348 U.S. 858 (1954).
19 Campbell holds that a design patent application cannot be a
20 division of a utility patent application, even though the
21 utility application discloses the design as provided in the
22 first paragraph of 35 U.S.C. § 112.

23 The United States Patent and Trademark Office (PTO) has
24 been disregarding Campbell and issuing design patents that are a
25 division of a utility patent application. Ex parte Duniau, 1
26

1 U.S.P.Q.2d 1652 (PTO Bd. of App. 1986). Indeed, appellant's
2 design patent application was a division of appellant's earlier
3 filed utility application and was issued by the Commissioner of
4 Patents after initially being rejected, based upon Campbell.
5 The PTO is issuing these patents based upon this Court's
6 reasoning in Kangaroo U.S.A., Inc. v. Caldor, Inc., 778 F.2d
7 1571, 28 U.S.P.Q. 32 (Fed. Cir. 1985) and the decision in Ex
8 parte Duniau.

9 When appellant sought to enforce his patent rights in this
10 action by way of a temporary restraining order, the district
11 court felt compelled by stare decisis to follow Campbell.
12 Unless the application for the design patent is entitled to the
13 benefit of the earlier filing date of the utility application,
14 the design patent is invalid as a result of a sale more than one
15 year prior to the design application filing date, but less than
16 one year prior to filing the utility application. The court
17 denied the temporary restraining order on the basis that
18 appellant's design patent would likely be held invalid at the
19 trial in view of Campbell, unless overruled. The court,
20 however, recognized that a controlling question of law was
21 involved as to which there is a substantial ground for
22 difference of opinion and certified this interlocutory appeal.

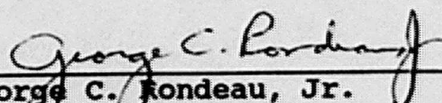
23 Appellant, and other patentees who own design patents which
24 were filed as divisional applications based on a utility
25 application, are in an anomalous situation. On the one hand,
26 they have expended considerable amounts of money, time, and

1 effort in obtaining patents for their designs, which they
2 believe are valid, and which are presumed valid under 35 U.S.C.
3 § 282. On the other hand, based on Campbell, if not overruled,
4 these patents are invalid because they are not entitled to the
5 filing date of the earlier filed utility application. This
6 uncertainty between invalidity and validity deprives "the bar
7 and the public of the stability and predictability essential to
8 the effort of a free society to live under a rule of law."
9 South Corp., 690 F.2d at 1370, 215 U.S.P.Q. at 658.

10 Unless this question is answered by the Court, sitting in
11 banc, the PTO will likely continue to abide by the reasoning in
12 KangaROOS and continue to issue design patents on applications
13 filed as divisional applications based on earlier filed utility
14 applications. Conversely, district courts, as did the district
15 court in this action, may decide that Campbell is still good law
16 and assume it their duty to invalidate the design patents.

17 Appellant respectfully suggests that an in banc hearing of
18 this court is necessary and appropriate to consider appellant's
19 request to overrule Campbell and resolve this uncertainty.

20 DATED: December 21, 1988

21
22 
23 George C. Rondeau, Jr.
24 Maurice J. Pirio
25 SEED and BERRY
26 6300 Columbia Center
Seattle, Washington 98104-7092

Attorneys for Appellant

WDPL4V5