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Recommended Citation
Samuel E. Kielar, Comment: Loosening the Grasp of Restriction by Allowing Multiple Claims in Design Patents, 68 Buff. L. Rev. 1169 (2020).
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Comment: Loosening the Grasp of Restriction by Allowing Multiple Claims in Design Patents

SAMUEL E. KIELAR†

I. INTRODUCTION

When drafting a patent application, patent practitioners are concerned about receiving a restriction requirement.1 There is a desire to claim as much as possible in a single application,2 but the United States Patent and Trademark Office (USPTO) may require claims to be restricted out of a single application if they are considered to be directed to

†J.D., 2020, University at Buffalo School of Law; B.S. Mechanical Engineering, 2015, University at Buffalo. Registered Patent Agent; Publications Editor, Buffalo Law Review. I would like to thank the members of the Buffalo Law Review for their time and effort in revising this Comment; Professor Mark Bartholomew for his insightful review of an earlier draft of this Comment; and Charles Rauch of Hodgson Russ LLP for his continued mentorship, wisdom, and passion in the seldom reviewed area of design patent law.

1. See Kenneth Horton, How to Deal With Restriction Requirements in Patent Applications, INSIDECOUNSEL (Feb. 15, 2015), https://www.kmclaw.com/newsroom-articles-327.html (“One of the most frustrating documents to receive from a patent examiner handling your patent application is a restriction requirement.”).

2. Gene Pierson, What is a Patent Restriction Requirement under 37 CFR 1.142?, PIERSON INTELL. PROP.: ATT'Y BLOG (Jun. 10, 2013), http://piersonpatentlaw.com/what-is-a-patent-restriction-requirement-under-37-cfr-1-142/ (“With the recent increase in filing fees, there may be a strong desire to include patent claims directed to a plurality of related, but separate inventions into one patent application.”).
independent and distinct inventions. Accordingly, a patent practitioner must carefully consider whether to include multiple claimed embodiments of an invention in a single application, which may be subject to restriction, or to file multiple applications for each embodiment, thus avoiding restriction altogether. The consideration is more difficult when drafting a design patent application. The standard for restriction practice in design patent prosecution is unclear and it is difficult to overcome. As it leaves discretion up to the examiner handling the application, a restriction requirement may vary between examiners. Furthermore, applicants often do not know which embodiment’s design will be commercially pursued, so they will want to seek protection of all possible embodiments. Thus, patent practitioners may

3. 37 C.F.R. § 1.142(a) (2009) (“If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction . . . .”).

4. See Bryan K. Wheelock, The “State” of Embodiments in Design Patents, LEXIOLOGY (Dec. 19, 2018), https://www.lexology.com/library/detail.aspx?g=d0ac5d43-bed7-4ceb-86a2-c78ef306a80 (“Thought should be given to whether the same protection can be achieved through a single embodiment with unimportant details shown in dashed lines (and thus excluded from the scope of the claims), and/or whether multiple applications would provide better protection (albeit at a higher cost).”).

5. See Jason Du Mont & Mark D. Janis, Disclosing Designs, 69 VAND. L. REV. 1631, 1669 (2016) (“Restriction practice provides the final example of an effort to apply utility patent rules to design disclosures. It yields yet additional rhetoric, and potentially additional confusion, on what constitutes the protected subject matter in a design patent.”)

6. See id. at 1670–74 (discussing restriction practice in design patents to be unpredictable and unclear).


opt for a “wait and see” approach, where all embodiments are filed in a single application but some are cancelled in a preliminary amendment prior to receiving the first office action, or hope to get lucky with an examiner who will not issue a restriction requirement.9 Such a practice is inconsistent and costly for applicants,10 and it may have adverse effects in litigation.11

This Comment identifies the issues related to restriction requirements in design patents, and how allowing multiple claims in a design patent would solve some of these issues. Part II of this Comment analyzes the statutory basis for a restriction requirement, 35 U.S.C. § 121, and its differing application in utility12 and design13 patent applications. Part III discusses the longstanding requirement of a single claim in design patents as it applies to restriction requirements. Part IV describes how the USPTO’s “inventive concept” standard for restriction is applied, and its inconsistency with the seemingly similar “unity of invention” standard. Part V identifies the impacts of receiving a restriction requirement with respect to claim scope, cost, priority, and the differing effects to utility and design patent applications. Part VI explains how design patent examiners may have a perverse

consider all possible variations of the design and not limit the application to a specific one.


10. See infra Section V.B.

11. See infra Section V.A.


incentive to require restriction due to their search strategy and the “count” system. Part VII revisits the reasoning of *ex parte Wiessner* that established the single claim requirement in order to consider the possibility of including multiple claims in a design patent as a remedy for restriction requirements. Part VIII offers options for the USPTO to implement multiple claims in a design patent, drawn from the EUIPO’s industrial design system and U.S. utility patents.
II. STATUTORY ANALYSIS OF REQUIREMENT FOR RESTRICTION

Section 121 of the Patent Act provides the statutory basis for a restriction requirement. It states that restriction may be required if there are two or more claimed independent inventions in a single patent application. This requirement applies to all patent applications, with no distinction made between utility patents and design patents. The statutory language indicates that restriction is permissible, not always required. The decision to issue a restriction requirement is thus up to the specific examiner, and whether he finds there to be independent and distinct inventions.

Restriction Requirement in Utility Patent Applications

The USPTO offers specific guidance to examiners regarding restriction requirements in utility patent applications. It instructs that restriction may be required where two or more claimed inventions would be able to support separate patents and are either independent or distinct. In addition, it limits restriction to situations

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15. Id. ("If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.").
16. See In re Kelly, 200 U.S.P.Q. 560 (Comm’r Pat. & Trademarks 1978) ("Since there is no specific provision relating to requirements for restriction in a design application, the standard of 35 USC 121 is applicable.").
17. The Patent Act uses "shall" for mandatory requirements. See, e.g., 35 U.S.C. § 112(a) ("The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.") (emphasis added).
18. MPEP § 808.02 (8th ed. Rev. 9, Aug. 2012) ("[T]he examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.").
20. Id. ("Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are
where examination of the claims would require a serious search burden. Accordingly, there are two criteria for a proper restriction requirement in a utility patent application: (A) the inventions must be independent or distinct as claimed; and (B) there would be a serious search burden on the examiner if restriction were not required. Given this two-prong test, applicants may traverse the restriction requirement by successfully arguing against either prong. Regarding the second prong, the examiner may assert that there is a serious search burden by identifying separate classifications or fields of search for the independent claimed inventions. If the examiner does not provide evidence of the serious search burden, the restriction may be traversed on this basis alone, and the embodiments can be maintained in a single application.

Restriction Requirements in Design Patent Applications

The USPTO also offers specific guidance to examiners regarding restriction requirements in design patent applications. It instructs that restriction is required where there are two or more patentably distinct designs in a single application. However, unlike in utility patent applications, able to support separate patents and they are either independent or distinct.

21. Id. ("If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.").

22. Id. ("There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) [t]he inventions must be independent or distinct as claimed; and (B) [t]here would be a serious burden on the examiner if restriction is not required.").


24. Id. ("Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.").

25. MPEP § 1504.05 (9th ed. Rev. 3, Jan. 2018) ("[T]he examiner will require restriction in each design application which contains more than one patentably distinct designs.").
there is no additional requirement of a serious search burden for design patent applications. In order to traverse the restriction, applicants must successfully argue that (A) the embodiments have overall appearances with basically the same design characteristics; and (B) the differences between the embodiments are insufficient to patentably distinguish one design from the other. In addition to this admission on the record that the claimed embodiments are not patentably distinct, specific evidence must be provided in order to successfully traverse the restriction. Accordingly, it is much more difficult to traverse a restriction requirement in a design patent application than in a utility patent application.

The strict requirement for restriction in design patent applications is drawn from the longstanding requirement that a design patent is limited to a single claim. Nonetheless, the USPTO has adopted a different interpretation of section 121 for utility and design patents. If the restriction could be more easily traversed, then the single claim limitation may not be as absolute as intended. But where there would be no serious search burden, the restriction does not make sense. In a design patent application, a requirement for a serious search burden would likely never be met, as multiple embodiments are usually found in the same classification, and applications containing independent articles are not generally filed in a single application.

26. Id. (“The issue of whether a search and examination of an entire application can be made without serious burden to an examiner is not applicable to design applications when determining whether a restriction requirement should be made.”) (citation omitted).
27. Id.
28. Id. (“Without evidence, such an admission is merely a conclusory statement.”).
29. 37 C.F.R. § 1.153(a) (2012) (“More than one claim is neither required nor permitted.”).
30. MPEP § 1504.05(l) (9th ed. Rev. 3, Jan. 2018) (“This situation may be
III. THE LONGSTANDING REQUIREMENT OF A SINGLE CLAIM

Section 112 of the Patent Act, which prescribes the requirements for the specification of utility and design patents, provides that “[t]he specification shall conclude with one or more claims.”31 Section 171, which prescribes specific requirements for design patents, provides incorporation language in that “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”32 Because the statute does not prescribe a different requirement for the claim of a design patent, section 112 would seem to permit a design application to conclude with more than one claim.

However, the USPTO currently follows a different interpretation of section 112 with respect to design patents.33 This interpretation is found in 37 C.F.R. § 1.153, which provides that “[m]ore than one claim is neither required nor permitted.”34 The Court of Customs and Patent Appeals addressed the apparent conflict between the statute and the promulgated rule in In re Rubinfield.35 Applying the standard of review set forth in ex rel. Steinmetz v. Allen,36 the court determined that the statute “does not necessarily mean that every applicant shall, as a matter of right, be entitled to present a plurality of claims regardless of the nature of the rarely presented since design patent applications are seldom filed containing disclosures of independent articles.”).

32. Id. § 171.
34. 37 C.F.R. § 1.153(a).
36. United States ex rel. Steinmetz v. Allen, 1903 Dec. Comm’r Pat. 578, 585–86 (“If there be no such inconsistency with the express provisions of the statute the rules are valid and have the force and effect of law in all matters to which they relate. They are certainly not to be declared invalid upon any consideration of doubtful construction, but only for such conflict or inconsistency with the statute law upon the subject as shall be made plainly to appear.”).
invention involved.”37 The Court relied in part on the reasoning of the Commissioner in ex parte Wiessner38 that there was no useful purpose that could be served by the inclusion of more than one claim in a design patent application,39 and it also relied on the uniform practice of the Patent Office to allow only one claim in a design patent since that decision.40 Accordingly, the court held that there was “no sound reason for disturbing the long-standing practice of the Patent Office, embodied in Rule 153, which limits design applications to a single claim.”41 Post Rubinfield, the USPTO has maintained this position and continues to allow only one claim in a design patent.42

37. In re Rubinfield, 270 F.2d at 395.
40. Id. at 396.
41. Id.
42. Oake, supra note 33, at 21.
IV. The Inconsistency of the “Inventive Concept” Standard

Although a design patent is limited to a single claim, multiple embodiments of a design may be illustrated in a single application.43 Such embodiments may only be included if they involve a single inventive concept.44 In determining whether the embodiments involve a single inventive concept, the USPTO instructs examiners to apply a two-part test: (1) that the embodiments appear basically the same; and (2) that the differences in the embodiments do not render them patentably distinct or are obvious in view of the prior art.45 If both criteria are met, then the multiple embodiments may be retained in a single application.46

In Rubinfield, the applicant’s disclosure included a first embodiment (figures 1–4) showing a design of a floor waxer47 and a second embodiment (figures 5–8) showing a design of a similar floor waxer:48

43. MPEP § 1504.5(II)(A) (9th Ed. Rev. 3, Jan. 2018) (“It is permissible to illustrate more than one embodiment of a design invention in a single application.”).

44. In re Rubinfield, 270 F.2d at 396 (“The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim. Such embodiments can be presented only if they involve a single inventive concept; and such a concept can be protected by a single claim.”).

45. MPEP § 1504.05(II)(A) (9th ed. Rev. 3, Jan. 2018) (“It must first be determined whether the embodiments have overall appearances that are basically the same as each other. If the appearances of the embodiments are considered to be basically the same, then it must be determined whether the differences are either minor between the embodiments and not a patentable distinction, or obvious to a designer of ordinary skill in view of the analogous prior art.”).

46. Id.


The difference between the two embodiments is that the second embodiment has a longer base than the first embodiment, and it additionally includes brace members. The court found these differences to be immaterial, so it did not render them to be patentably distinct. Accordingly, the court reversed the examiner's restriction of these embodiments and found that they have a single inventive concept. The patent ultimately issued including both embodiments.

Of significance with the two-part test is that the determination must be made in view of the prior art. In order to pass the first part of the test, the embodiments ordinarily will fall within the same or related classifications. Accordingly, when the examiner reaches the second part of the test, he must at least perform a preliminary search within those classifications to determine whether the differences between the embodiments would render them patentably distinct. If the standard for restriction that required an otherwise serious search burden found in utility patent prosecution was applied to designs, there would almost never be an argument for a serious search burden, as the embodiments fall in the same or related classifications, and the search had to have already been at least partially performed.

49. In re Rubinfield, 270 F.2d at 394 ("The designs of Figures 1 to 4 and 5 to 8 differ primarily in that the latter includes certain braces not present in the former.").

50. Id. ("Apparently appellant could have presented a single set of drawings showing the braces in dotted lines, as "immaterial" parts, and seemingly no objection would have been made by the Patent Office, although the substance of the disclosure would have been substantially what it is now.").

51. See id. at 396.


54. See infra Part VI (discussing examiner search strategy and classification system).
Unity of Invention

Similar to the “inventive concept” standard, an international (utility) patent application must comply with the “unity of invention” standard. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. A “special technical feature” refers to a claim feature that is a novel and non-obvious contribution over the prior art. Lack of unity may be evident before consideration of the prior art if the independent claims do not share common technical features, or if after consideration of the prior art those shared features do not constitute a contribution over the prior art. This standard is generally straightforward, as the specific limitations of the independent claims can be matched up and compared to the prior art. It would be much harder to articulate a “special technical feature” that would link multiple embodiments of a design patent application, because the claim is to the design as shown in the drawings, with limited further description.

55. See 37 C.F.R. § 1.475(a) (1993) (“An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’]).”.


57. 37 C.F.R. § 1.475(a) (“The expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”).

58. MPEP § 1850(II) (9th ed. Rev. 4, June 2020) (“Lack of unity of invention may be directly evident ‘a priori,’ that is, before considering the claims in relation to any prior art, or may only become apparent ‘a posteriori,’ that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present a priori as A is common to both claims. However, if it can be established that A is known, there is lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.”).
Both the “inventive concept” standard and the “unity of invention” standard require a comparison to the prior art. However, they reach different conclusions based on that comparison. The “inventive concept” standard requires restriction where the embodiments are each patentably distinct or obvious over the prior art. In contrast, the “unity of invention” standard allows multiple inventions to be maintained in a single application if they share a feature that is a contribution over the prior art. Again, the distinction appears to fall upon the requirement that a design patent is limited to a single claim. If the design embodiments are patentably distinct, then they would be considered separate claims, and thus they must be applied for in separate design patent applications. In contrast, utility applications may include multiple patentably distinct claims, and it is only required that they share a common special feature in order to be kept in a single application.
V. THE IMPACTS OF RESTRICTION REQUIREMENTS

Restriction requirements impact patent applicants in various ways, including claim scope, costs, and benefit of priority. These impacts affect applicants differently between design patents and utility patents, often being harsher and stricter upon the design patent applicant.

A. The Impact of Restriction Requirements on Claim Scope

Utility Patent Claim Scope

The scope of a utility claim is the “broadest reasonable interpretation of the claims in light of the specification.”59 The meaning of claim terms is based on their ordinary meaning or special definition given in the specification, and must be consistent with its use in the specification.60 In utility applications, a restriction requires the applicant to elect a set of claims to proceed with examination, while the unelected claims must be withdrawn.61 A divisional application may be filed to gain protection for the unelected claims, but they may be rejoined if they are found to require all the limitations of an allowable claim.62 Although the subject matter of unelected claims is not protected, the scope of the allowed elected claims is not limited by the unelected claims. Accordingly, applicants do not need to file divisional

59. MPEP § 2111 (9th ed. Rev. 4, June 2020).
60. Id. (“[T]he meaning given to a claim term must be consistent with the ordinary and customary meaning of the term (unless the term has been given a special definition in the specification), and must be consistent with the use of the claim term in the specification and drawings.”).
61. MPEP § 821 (9th ed. Rev. 2, Nov. 2015) (“All claims that the examiner finds are not directed to the elected invention are withdrawn from further consideration by the examiner . . . .”).
62. MPEP § 821.04 (9th ed. Rev. 4, June 2020) (“Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits. In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim.”)
applications merely to maintain claim scope. Applicants would only need to file divisional applications in order to pursue previously unclaimed subject matter.

**Design Patent Claim Scope**

The scope of a design patent claim is determined from its drawings.\(^6^3\) The drawings must be viewed in the context of the closest prior art.\(^6^4\) When restriction is required in a design patent application, the applicant is required to elect a claim to proceed with examination, while the unelected claims must be canceled.\(^6^5\) These unelected claims are considered to be surrendered and available to the public domain\(^6^6\) unless claimed in a divisional application filed before issuance of the original application.\(^6^7\) Accordingly, the scope of the elected design claim is limited by the prior art as well as any unelected designs. This severe limitation gives a strong incentive to applicants to file divisional applications after receiving a restriction requirement. The following example cases illustrate situations where unelected designs affected the patent owner's case in an action for infringement.

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63. Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC, 739 F.3d 694, 702 (Fed. Cir. 2014), ("[I]n determining the scope of the claimed design, '[i]t is the drawings of the design patent that provide the description of the invention.'" (quoting In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998)).

64. See Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 676 (Fed. Cir. 2008) ("[T]he ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art.").

65. MPEP § 818 (9th ed. Rev. 2, Nov. 2015) ("In the reply to the restriction requirement, applicant must elect one invention for examination.").

66. See Pac. Coast Marine Windshields, 739 F.3d at 703 ("By cancelling figures showing [the unelected designs], the applicant surrendered such designs and conceded that the claim was limited to what the remaining figure showed.").

67. See 35 U.S.C. § 121 ("A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.")
Example Case #1

In Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC,\(^68\) restriction impacted the patent owner’s infringement suit. The applicant filed a design patent application claiming an “ornamental design of a marine windshield with a frame, a tapered corner post with vent holes and without said vent holes, and with a hatch and without said hatch, as shown and described.”\(^69\) The drawings included multiple embodiments of the claimed design with different vent hole configurations.\(^70\) The examiner issued a restriction requirement, finding five patentably distinct groups of designs:\(^71\)

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68. *Pac. Coast Marine Windshields*, 739 F.3d at 694.

69. *Id.* at 697.

70. *Id.*

71. *Id.* at 698 (“The examiner . . . identified the five distinct groups of designs as windshields with: (1) four circular holes and a hatch (figure 1); (2) four circular or square holes and no hatch (figures 7 & 12); (3) no holes and a hatch (figure 8); (4) no holes and no hatch (figure 9); and (5) two oval or rectangular holes and a hatch (figures 10 & 11).”).
In response to the restriction, the applicant elected the first embodiment, amending the application to remove the additional figures and corresponding description.72 The amended application ultimately issued,73 and the applicant filed a divisional application directed to one of the unelected groups, which also became an issued patent.74 However, divisional applications were not filed for the other unelected groups.75

Pacific Coast, the owner of both patents, brought suit against Malibu Boats alleging infringement of the '070 patent.76 The district court granted Malibu Boats’ motion for partial summary judgment for non-infringement based on prosecution history estoppel, finding that the applicant surrendered the unelected designs “in order to obtain the patent,” and that the accused design was within the scope of the surrendered design.77 The Federal Circuit agreed that the applicant surrendered the unelected designs to secure the patent after the restriction requirement.78 However, the court did not agree that the accused “three-hole” design was within the surrendered scope between the claimed “four-hole” design and the unelected “two-hole” design.79 Accordingly, the case was remanded to determine whether the accused design was within the scope of the patented design or the surrendered design.80 While the case settled before the trial court reconsidered the issue, it was certainly costly for the patent owner to appeal the issue to properly determine the elected claim scope.

72. Id.
75. Pac. Coast Marine Windshields, 739 F.3d at 699.
76. Id.
77. Id.
78. Id. at 703.
79. See id. at 704.
80. Id. at 705.
Example Case #2

A similar situation arose in Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co.,\(^81\) where the defendant asserted prosecution history estoppel as a defense for infringement.\(^82\) The applicant Advantek filed a design patent application for a kennel design, where Figures 1–4 show the kennel without a cover, and Figure 5 shows the kennel with a cover:\(^83\)


\(^{82}\) Id. at 1214.

\(^{83}\) See id. at 1213.
The examiner required restriction between the embodiment without the cover and the embodiment with the cover. Advantek elected the first group, and the patent issued with Figures 1–4. Advantek sued Walk-Long for design patent infringement. Walk-Long argued that since its product includes a cover, prosecution history estoppel bars infringement. The district court granted Walk-Long’s motion for summary judgment on the issue, finding that Advantek surrendered the kennel design with the cover to secure the patent. On appeal, the Federal Circuit reversed, concluding that the accused product falls outside of the scope of the surrendered design. Because Walk-Long’s product includes the same skeletal structure claimed by Advantek’s patent, it could infringe, regardless of the claim scope surrendered during prosecution. However, it further noted that the damages would have to be limited to the infringement of the skeletal structure, not the entire accused product which included the cover.

Although the restriction in this case was not entirely detrimental to the plaintiff’s infringement action, it did provide road blocks in the litigation. Furthermore, the plaintiff’s potential damages were limited due to the

84. Id. at 1214.
85. Id.
87. Advantek, 898 F.3d at 1214.
88. Id.
89. Id. at 1215.
90. Id. at 1216–17.
91. Id. (“A competitor who sells a kennel embodying Advantek’s patented structural design infringes the D’006 patent, regardless of extra features, such as a cover, that the competitor might add to its kennel.”).
92. Id. at 1217 n.2 (“Of course, if the accused skeletal structure is only a component of an accused multicomponent product, Advantek would only be able to seek damages based on the value of the component, not the product as a whole.”) (citing Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 434–35 (2016)).
restriction. If Advantek filed a divisional application to protect the unelected kennel design with the cover, it would be entitled to the damages from the entire accused product if infringement is found. However, with the surrender of the unelected design, the damages are limited to the portion of the accused design that infringes the skeletal structure. Accordingly, applicants should be sure to file divisional applications to avoid unnecessary reductions to damages.

B. The Cost of Restriction in Design and Utility Patents

Cost of a Utility Patent

The fees required for filing a utility patent application are the filing, search, and examination fees. For an undiscounted applicant, the basic filing fee is $300.00, the search fee is $660.00, and the examination fee is $760.00. Accordingly, the total fee due at the time of filing is $1,720.00. This fee is sufficient as long as there are no more than three independent claims or twenty total claims. For each independent claim in excess of three, an additional fee of $460.00 is required. For each claim in excess of twenty, an additional fee of $100.00 is required. By payment of these additional fees, an applicant could include three additional independent claims or seventeen additional dependent claims before reaching the cost of filing a new

93. The USPTO has three fee structures based on type of entity: (1) undiscounted (full price); (2) small entity (half price); and (3) micro entity (quarter price). See 37 C.F.R. §§ 1.27, 1.29 (2015).
94. 37 C.F.R. § 1.16(a) (2017).
95. Id. § 1.16(k).
96. Id. § 1.16(o).
97. ($300) + ($660) + ($760) = $1,720.
98. 37 C.F.R. § 1.16(h).
99. Id. § 1.16(i).
100. ($460) × (3) = $1,380.
101. ($100) × (17) = $1,700.
application. When factoring in the issue fee of $1,000.00, an applicant could include five additional independent claims or twenty-seven additional dependent claims before reaching the cost of an issued patent. When factoring in the patent practitioner’s cost to the applicant in handling multiple applications, the relatively low cost of excess claim fees is an even more attractive option.

Although excess claim fees do not guarantee that the filed number of claims will remain in the issued patent, e.g., due to a restriction requirement, there is no limit to the number of claims in the issued patent, and the issue fee remains the same regardless of the number of claims.

Cost of a Design Patent

The fees required for filing a design patent application are also the filing, search, and examination fees. For an undiscounted applicant, the basic filing fee is $200.00, the search fee is $160.00, and the examination fee of $600.00. Accordingly, the total fee due at the time of filing is $960.00. Unlike utility applications, there is no option to pay an additional fee for excess claims. Any additional claims must be filed in a separate application, i.e. for an additional $960.00, and an additional issue fee of $700.00 must ultimately be paid.

With these additional fees, applicants are much more concerned with restriction requirements. If the examiner does not issue a restriction requirement, the embodiments of the design remain in a single application, and they are

102. 37 C.F.R. § 1.18(a)(1).
103. ($460) × (5) = $2,300.
104. ($100) × (27) = $2,700.
105. 37 C.F.R. § 1.16(b).
106. Id. § 1.16(l).
107. Id. § 1.16(p).
108. ($200) + ($160) + ($600) = $960.
109. 37 C.F.R. § 1.18(b)(1).
covered by a single set of fees. However, if restriction is required, the applicant is almost forced to file divisional applications for the unelected embodiments and pay additional sets of fees just to protect the claim scope of the elected embodiment, as explained in Section V.A, supra.

C. Priority in Utility and Design Patents

Priority Claims in Utility Patents

In utility patent applications, applicants can be selective in their claim scope without limiting their right to claim priority in future continuation applications. The specification of a utility patent application generally includes a large volume of possibly patentable subject matter, e.g., different unique components of a device, how the device is manufactured, a larger system that uses the device, or a method of using the device.¹¹⁰ When the application is filed, the claims may be directed to only a single aspect of described in the specification. As long as an application is pending, the applicant can file additional continuation applications with different sets of claims directed to the additional subject matter.¹¹¹ Accordingly, the applicant can decide over time if it wants to pursue claims to this additional subject matter, or pursue narrower claims directed to a specific commercial embodiment. The original claim scope does not limit or affect the applicant’s ability to pursue these other claims, it is only necessary that the original specification supports them.¹¹²

¹¹⁰ See Gene Quinn, Tricks & Tips to Describe an Invention in a Patent Application, IPWATCHDOG (Dec. 26, 2015) http://www.ipwatchdog.com/2015/12/26/tricks-tips-for-describe-an-invention-in-a-patent-application-2/id=64133/ (“You don’t want to just describe the best version of your invention, but rather you want to describe every version of the invention that can work at all, no matter how crudely.”).

¹¹¹ 4A DONALD S. CHISUM, CHISUM ON PATENTS § 13.04[1] (2019) (“[A] continuation application is entitled to the benefit of the filing date of a prior application only if the enabling disclosure of the latter is commensurate in scope with the claims of the former.”).

¹¹² Id. § 13.04[3] (“[A] continuation application is entitled to the benefit of the filing date of a prior application only if the claims of the former are for an
These supported claims are given the benefit of the earlier filing date for priority.\textsuperscript{113}

**Priority Claims in Design Patents**

In design patent applications, the claim scope of the originally filed application severely limits the right to claim priority in future continuation applications. For a continuation application to gain the benefit of the earlier filed application, it can only be a modification of the original claim.\textsuperscript{114} For example, the continuation application may claim a specific portion of the design through the use of broken lines or surface boundary lines.\textsuperscript{115} However, the continuation application does not gain priority if it claims a different embodiment of the original design.\textsuperscript{116} Accordingly, it is important for applicants to file all of their embodiments at the same time because the earlier filed embodiment may be prior art that would affect the patentability of the later filed embodiment. Instead of filing each embodiment as a separate application on the same day, patent practitioners often group related embodiments into single applications. Then a restriction requirement will require divisional applications to be filed, and the priority date may be maintained across all embodiments. This still places the burden on the applicant to decide which embodiments will be needed to protect its commercial products. Unlike utility

\footnotesize{\textsuperscript{113} Id.}

\footnotesize{\textsuperscript{114} See In re Owens, 710 F.3d 1362, 1366 (Fed. Cir. 2013) ("When an issue of priority arises under § 120 in the context of design patent prosecution, one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application.").}

\footnotesize{\textsuperscript{115} Id. at 1369 ("Unclaimed boundary lines typically should satisfy the written description requirement only if they make explicit a boundary that already exists, but was unclaimed, in the original disclosure.").}

\footnotesize{\textsuperscript{116} 1 DONALD S. CHISUM, CHISUM ON PATENTS § 23.04[4] (2019) ("An attempt to claim a separate portion of an entire design disclosed in the parent (original) application would violate the “new matter” prohibition and the Section 112/1 written description requirement (and deprive the continuation of the benefit of the parent’s filing date) . . . ").}
applications, where the applicant can decide later to pursue subject matter not found in the originally filed claims, the applicant in a design application must make all of its claims at that first filing date.
VI. EXAMINER INCENTIVES TO REQUIRE RESTRICTION

The USPTO is organized in Technology Centers, (“TCs”), which handle patent applications covering certain areas of technology.117 All design patent applications are handled by TC 2900.118 This technology center is unique because its requirements for examiners are different than the other TCs.119 In general, patent examiners must have a technical or scientific background related to the patents they are examining.120 This corresponds to the requirements for becoming a registered patent practitioner.121 However, design patent examiners do not need a technical or scientific


118. Id. (“Technology Center 2900 provides examination for patent applications including Designs.”).


121. USPTO Office of Enrollment and Discipline (OED), General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases before the United States Patent and Trademark Office, 3 (Feb. 2020) (“An applicant applying for the examination must demonstrate to the Director of the Office of Enrollment and Discipline (OED) that he or she possesses the scientific and technical training necessary to provide valuable service to patent applicants. Applicant bears the burden of showing the requisite scientific and technical training. To be admitted to the examination, each applicant must demonstrate possession of the required scientific and technical training.”).
background, and they can qualify with an art degree.\textsuperscript{122} This has two interesting implications: (1) design patent examiners would not be qualified to prosecute design patent applications,\textsuperscript{123} and (2) patent practitioners prosecuting design patents do not have the artistic background as required for examiners.\textsuperscript{124} This may make design patent prosecution more difficult and variable between examiners due to their disconnect from having any technical or legal background. In particular, design patent examiners may be unlikely to stay apprised of current case law beyond what is provided in the MPEP or other USPTO guidance. Further, their artistic background may not provide an adequate basis for making purely legal arguments or being responsive to a practitioner’s arguments, for example, an attempt to traverse a restriction requirement.

As of April 2018, Technology Center 2900 was comprised of 13 Supervisory Patent Examiners and 183 Patent Examiners.\textsuperscript{125} In 2017, over 43,000 design applications were filed.\textsuperscript{126} In order for this small number of examiners to handle this large volume of applications, the USPTO has a system to manage their productivity. The combination of examiner search strategy and this production system creates


\textsuperscript{124} \textit{Id.} (“[L]awyers who prosecute design patents do not—at least in most cases—have any expertise in art or design.”).


\textsuperscript{126} \textit{See id.}
an incentive for examiners to require restriction in design patent applications.

A. Examiner Search Strategy

Due to a design patent’s focus on its illustrations rather than its written description, a text-based query is of limited value when searching for prior art. The title of a design patent is generally a categorical description of the patented article. The description merely indicates the perspectives of the views provided in the drawings. The omnibus claim used in design patents only refers to the article as shown in the drawings. Accordingly, highly-specific text searches will often render too few results, and generic text searches will often render voluminous results.

Instead of relying upon a text-based search, patent examiners will often utilize a classification-based search. All patent applications are classified according to the United States Patent Classification (USPC) system. The USPC

127. MPEP § 904.02 (9th ed. Rev. 4, June 2020) (“Examiners will recognize that it is sometimes difficult to express search needs accurately in textual terms.”).

128. MPEP § 1503(I) (9th ed. Rev. 3, Jan. 2018) (“The title of the design identifies the article in which the design is embodied by the name generally known and used by the public.”).

129. See id. § 1503(II) (“Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.”).

130. Id. § 1503(III) (“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.’”).

131. MPEP § 904.02 (9th ed. Rev. 4, June 2020) (“The traditional method of browsing all patent documents in one or more classifications will continue to be an important part of the search strategy when it is difficult to express search needs in textual terms.”).

includes 33 classes of subject matter for design patents.\footnote{133}{Id.} Each design class is organized into subclasses, and further into subordinate subclasses.\footnote{134}{Id.} By searching using the USPC, examiners can effectively narrow the results by class, subclass, and subordinate subclasses.\footnote{135}{See id.} The USPC also includes search notes which aid the examiner’s search by explaining the subject matter found in a specific subclass.\footnote{136}{Id. ("A subclass is a collection of design patents found in a Design Class, which pertain to a particular function, a specific functional feature, or distinctive ornamental appearance or form. For example, the subject matter in class D6, Furnishings, is classified by function into broad subclasses of similar types of furnishings-seating, work surfaces, storage, furniture parts and elements, etc. Because there are so many patented designs for the same general types of furnishings, this subject matter is further classified into subordinate or “indented” subclasses to promote efficient access to specific types of industrial designs.").}

Due to the large number of applications in each patent examiner’s docket, examiners often employ aggregate searching techniques.\footnote{137}{During a panel discussion attended by the author at USPTO Design Day 2017, primary patent examiners Philip Hyder and Darlington Ly discussed aggregate searching as a common practice for design patent examiners. See Elizabeth D. Ferrill, Reflections on USPTO Design Day 2017: What’s Next?, PROSECUTION FIRST BLOG (Apr. 27, 2017) https://www.finnegan.com/en/insights/blogs/prosecution-first/reflections-on-uspto-design-day-2017-whats-next.html.} If an examiner has multiple applications in their docket that overlap classes or subclasses of the USPC, he may keep track of prior art that may be material to the patentability of each application during a single search.\footnote{138}{Id.} This method is efficient because an examiner can reduce the total number of searches he needs to perform, while handling a large number of cases.
These aspects of the search strategy should make patent examiners indifferent to require restriction in design patent applications. As long as the multiple embodiments of the design are related by even a minimal degree, there will likely be overlap of the classes and subclasses that need to be searched. The relative search burden does not change whether the embodiments remain in a single application or are restricted into separate applications. However, when considered in view of the examiner production system, there becomes an incentive for examiners to require restriction.

B. The Count System

Patent examiners receive credit for their work during the examination of a patent application based on a Patent Examiner Production, or “Count” System. Under the count system, examiner productivity is based on the number of Production Units (“PUs”) achieved relative to a production goal. The formula for the production goal is \[(\text{Number of Examining Hours}) \times (\text{Seniority Factor}) / (\text{Technology Complexity})\]. The number of examining hours includes the time spent reviewing the application, analyzing the claims, searching for prior art, considering prior art, writing office actions, and addressing applicant’s responses. The seniority factor and technology complexity provide adjustments to the examiner’s production goal based on the


140. Rezende Simmons, supra note 139, at 34.

141. Examination Time and the Production System, supra note 139.

142. Id.
seniority level and the classification of the patent application being examined. 143

Each Production Unit is equal to 2 “counts,” where a fraction of a count is awarded throughout the examination process. 144 For example, a first action on the merits receives 1.25 counts, a final rejection receives 0.25 counts, and an allowance or disposal receives 0.5 counts, totaling 2 counts. 145 Notably, issuing a restriction requirement receives zero counts. 146

John Penny and Joshua Rudawitz argue that since the count system provides an incentive for examiners to dispose of cases quickly, it should be viewed as beneficial to applicants. 147 However, the count system instead provides an incentive for examiners to maximize the counts received while minimizing the number of examining hours per production unit. 148 The aggregate searching strategy allows examiners to spend less time searching for prior art per application, efficiently maximizing their counts. But a restriction requirement provides an even stronger advantage. When an examiner requires an embodiment of a design patent application to be restricted out, the applicant must file a divisional application to pursue protection for that embodiment. This results in a scenario of possible count multiplication. A single application that could only receive a

143. See id.
144. Id.
145. Id.
148. Pierson, supra note 2 (“Examiners may use this tactic because they will be able to quickly increase their counts due to only having to learn one specification and somewhat similar claims.”).
total of 2 counts has birthed divisional applications that each provide additional credit of 2 counts.

Although it is not guaranteed, an examiner who issues a restriction in the parent application is likely to see the child application in their docket because of the relatively small number of examiners that comprise TC 2900. Accordingly, the examiner that issues the restriction is likely to directly receive the benefit of the count multiplication. Because he has already performed the prior art search in the parent application (or may perform an aggregate search at the same time), the examiner has a head start on the prior art search, thus further reducing the required number of examining hours. In addition, the parent and child applications are often prepared by the same patent practitioner, so they are likely to present similar objections to the specification or drawings. So, in the absolute ideal case (for the examiner), he will be able to essentially reproduce the office actions and prior art search results prepared for the parent application to use for the child applications, taking the absolute minimal number of examining hours, while still receiving the maximum of 2 counts.

In summary, not only is there a reduced search burden for design patent examiners using classification and aggregate searching techniques, they may be able to take advantage of count multiplication by requiring restriction to handle similar divisional applications with minimal effort. Accordingly, examiners may have a perverse incentive to require restriction for their own benefit, and not for the reasons required by the USPTO.
VII. REVISITING THE REASONING IN *EX PARTE WIESSNER*

After recognizing the issues with restriction requirements in design patents, we must return to the root of the problem: the requirement for a single claim. The Commissioner in *ex parte Wiessner* essentially provides three reasons for the single claim requirement for design patents.\(^ {149}\) Although this reasoning was upheld in *in re Rubinfield*, the landscape of design patent law since then requires the issues to be reconsidered, as suggested by Robert Oake.\(^ {150}\) Accordingly, we address each reason in turn below.

A. Wiessner’s First Reason

The Commissioner first asserted that the concept of claim dependency or combination/sub-combination claims existing in utility patent practice should not apply to design patents.\(^ {151}\) In other words, the entire design and just a portion of the same design cannot be claimed in a single design patent.\(^ {152}\) The Commissioner relied upon the Supreme Court decision in *Gorham Co. v. White* which found “[a] patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it.”\(^ {153}\)

William Simonds, in his treatise *The Law of Design Patents* published in 1874, did not agree with the Commissioner’s interpretation of *Gorham Co. v. White*.\(^ {154}\) Simonds explained that these paragraphs “seem, at first glance, to militate against the allowance of more than one

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150. *Id*.
clause of claim." But after review of the decision of the court below, Simonds asserts that “this language has no relation whatever to the question of whether a design patent may have one or more claims, [and it] is used solely for the purpose of negativing the idea advanced by the judge below.” Instead, Simonds concludes that the courts and the Patent Office are both committed to the doctrine of allowing multiple claims in a design.

If we are to agree with Simonds’s assertion, we can recognize the Commissioner’s erroneous reliance on dicta in Wiessner. This error was exacerbated in Rubinfield, which relied heavily on the reasoning of Wiessner to establish the long-standing requirement of a single claim. Over 120 years later, this fundamental requirement for design patents still stands, possibly in error. Although the courts and Patent Office today do not seem “committed to the doctrine of allowing multiple claims in a design” as Simonds concluded in 1874, there still exists the possibility of making the change.

B. Wiessner’s Second Reason

The Commissioner next asserted that the only purpose for allowing claims on distinctive and separate parts is “to point out those predominant and controlling features in a design the use of which alone would be regarded as preserving the identity of a design, even when other parts are omitted.” In other words, if an ordinary observer would not be likely to recognize the sameness or resemblance between the segregated parts and the whole design, the separate claims should not be allowed. Since the ordinary

155. WILLIAM EDGAR SIMONDS, THE LAW OF DESIGN PATENTS 197 (1874).
156. Id. at 198.
157. Id.
158. Id.
160. Oake, supra note 33, at 21.
observer looks to just one overall design to determine infringement “[t]o permit claims for parts that belong to details which possess no distinct and visible resemblance to and create in the mind no impression of the whole design would be to set traps for the unskilled and unwar[y].”

The Commissioner’s concern regarding the confusion of an ordinary observer in discerning a combination and sub-combination in a single application seems weak. First, it is now common practice to claim only a portion of an article’s design. As held in In re Zahn, a design patent can be granted for the ornamental design of only a portion of an article of manufacture. Accordingly, the mere presence of a portion claim is unlikely to cause confusion for the ordinary observer familiar with current design patent practice. Second, the ordinary observer is not a real person, but rather an artificial construction of the courts used to determine infringement. The ordinary observer may know more about prior art and see less than a real person would. Accordingly, any argument that this artificial ordinary observer would be confused by a full claim and a portion claim in the same design patent (or otherwise distinct embodiments) seems to be a minimal concern.

C. Wiessner’s Third Reason

The Commissioner also asserted that “the only apparent reason for allowing [multiple claims] in one [design patent] instead of requiring separate applications is to save the

162. Oake, supra note 33, at 22.
163. Id.
164. See In re Zahn, 617 F.2d 261, 268 (C.C.P.A. 1980) (“There is a distinction to be observed between parts of the total article illustrated, in which a new design is embodied, and parts of that article which embody none of the design.”).
165. Oake, supra note 33, at 22.
166. Id.
applicant the additional expense and trouble.”\textsuperscript{167} This reason alone was not enough for the Commissioner to allow multiple claims in a design patent, particularly in light of the other reasons.\textsuperscript{168}

As explained above, there are numerous reasons why multiple claims should be allowed in a design patent beyond cost savings for applicants, most of which are drawn from restriction requirements. First, restrictions in design patent applications are difficult to traverse because there is no requirement for a serious search burden\textsuperscript{169} and the ambiguity of the “inventive concept” standard.\textsuperscript{170} Second, restriction requirements in designs are more troublesome than in utility patent applications because of their impact on claim scope from unelected designs.\textsuperscript{171} Finally, examiners may have a perverse incentive to require restriction in design patent applications to boost their production via count multiplication.\textsuperscript{172} However, each of these issues could be mitigated by simply allowing multiple claims in a single design patent application.

\begin{flushleft}
\textsuperscript{167} Ex parte Wiessner, 1898 Dec. Comm’r Pat. 236, 242.
\textsuperscript{168} Oake, supra note 33, at 21.
\textsuperscript{169} See supra Part II.
\textsuperscript{170} See supra Part IV.
\textsuperscript{171} See supra Section V.A.
\textsuperscript{172} See supra Part VI.
\end{flushleft}
VIII. THE POSSIBILITY OF MULTIPLE CLAIMS IN A DESIGN PATENT

Because 35 U.S.C. § 112 would permit multiple claims in a design patent, the USPTO would be free to modify its interpretation for design patents found in 37 C.F.R. § 1.153, and it has good reason to do so. In the early 2000’s, the Patent Office may have been open to allowing multiple claims in design patents and reached out to the design patent bar at an AIPLA meeting to determine whether this change would be desired.\textsuperscript{173} However, it appears that not enough organized positive response was made as the change was not pursued at that time or in the America Invents Act.\textsuperscript{174} Nonetheless, it may be beneficial to consider the options that the USPTO would have in changing this rule to allow multiple claims in a single design patent, and thus alleviate the present issues with restriction requirements.

A. How the EU handles multiple designs

In Europe, patent applications can be filed with the European Union Intellectual Property Association (EUIPO) in order to have patent protection in all EU member states. Design patent applications with the EUIPO are called registered community designs. A single registered community design application may include an unlimited number of designs, and the designs do not need to be related to one another.\textsuperscript{175} The only requirement is that each design

\textsuperscript{173} Oake, \textit{supra} note 33, at 22 (citing telephone interview with Jim Gandy, Design Patent Examiner, Supervisor and Practice Specialist, United States Patent and Trademark Office June 1972 - February 2005).

\textsuperscript{174} Id.

falls within one of the 32 Locarno classes.176 The subclasses of each design, however, may be different.177 This requirement is referred to as the “unity of class.” An application may be divided, i.e. restricted, if the designs fail to have unity of class.178

The USPTO could adopt a similar standard to the “unity of class” because it reduces the requirement for restriction and is an easier standard to apply. When examiners search for prior art with respect to a design patent application, it is common practice to consider search results applicable to several applications at the same time. This is for efficiency, and due to the difficulty in searching for designs in general. Examiners cannot search for an image and the text describing the drawings of a design patent is generally too generic to improve a text search. Therefore, examiners usually rely on a classification-based search query. With the unity of class requirement, designs that are included in the same classification will remain in a single application and the examiner will subsequently search for related designs in that class and related subclasses for each design at the same time. With current USPTO standards, designs in the same class may be restricted out of the same application, duplicating the examiner’s need to search the class and duplicating the number of applications.

176. Id. at 63 (“As a rule, all the product(s) indicated for the designs contained in a multiple application must be classified in only one of the 32 Locarno classes.”).
177. Id. (“For instance, a multiple application is acceptable if it contains one design with the product indication Motor vehicles (Class 12, subclass 08) and one design with the product indication Vehicle interiors (Class 12, subclass 16), or if both designs indicate both these terms. This is an example of two designs in different subclasses but in the same class, namely Class 12 of the Locarno Classification.”).
178. Id.
B. How utility patent applications handle multiple independent claims

In utility applications, independent claims in excess of three require the payment of an additional fee of $460.00.\textsuperscript{179} This fee is presumably imposed to cover any additional search and examination time required by the examiner to handle the extra claim. Filing costs are presumably saved because an additional application covering this claim does not need to be processed. Accordingly, the sum of the search fee and examination fee of a utility application is $1,420.00.\textsuperscript{180} However, this is based upon a total of three independent claims, so the portion attributable to a single independent claim would be about $473.00.\textsuperscript{181} The actual fee charged of $460.00 is close to this amount, about 2.75% less.\textsuperscript{182}

The same payment calculation could be applied to design patents. Again, ignoring the filing fee, the search fee and the examination fee total $760.00.\textsuperscript{183} Since this is based on the search and examination of a single claim, no further division is required. But applying the same discount rate from the utility calculation, the fee could be about $740.00.\textsuperscript{184} It could further be argued that the search fee could be reduced since the multiple claimed designs could be searched in the same search query via classification. Although this is near the cost of filing a complete and separate application, cost to the applicant is saved at issuance, as a single issue fee may be paid to cover both claimed designs in a single issued patent.

\textsuperscript{179} 37 C.F.R. § 1.16(h).
\textsuperscript{180} ($660) + ($760) = $1,420.
\textsuperscript{181} ($1,420) ÷ 3 ≈ $473.
\textsuperscript{182} [($473) – ($460)] × [(100) ÷ ($473)] ≈ 2.75%.
\textsuperscript{183} ($160) + ($600) = $760.
\textsuperscript{184} ($760) – [(($760) × 2.75%)] ≈ $740.
C. Combination of Systems

The USPTO could adopt a combined system, that draws from both EU practice and utility applications. Issued design patents already include a Locarno Classification. This Locarno classification step could be performed along with the U.S. classification prior to examination. Regardless, the USPTO could use a “unity of class” requirement based on either classification system. The USPTO could then implement the extra fee in cases where there is “unity of class” but the designs do not share an “inventive concept.”

This would result in three scenarios for a design application filed with multiple embodiments:

Scenario 1: No Unity of Class

This scenario reflects current restriction practice. The embodiments of the application are so different that they do not fall within the same classification. Accordingly, restriction must be required.

Scenario 2: Unity of Class and Shared Inventive Concept

This scenario also reflects current restriction practice. The embodiments of the applications are similar enough to say that they share an “inventive concept.” Accordingly, the embodiments can be maintained in a single application.

Scenario 3: Unity of Class but No Shared Inventive Concept

This scenario would implement the proposed combined system. The embodiments fall within the same classification, but they are too different to be considered as sharing an “inventive concept.” Accordingly, the applicant should have the option to pay an additional fee in order to maintain the

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185. MPEP § 907 (9th ed. Rev. 2, Nov. 2015) (“U.S. design patents prepared for issue after June 30, 1996 and international design applications include a Locarno International Classification designation as part of the bibliographic data.”).
embodiments in a single application, or to file a divisional application directed to the other embodiment.
IX. CONCLUSION

The USPTO’s interpretation of the requirement for restriction as it applies to design patent applications imposes unnecessary burdens on applicants. Traversal of a restriction requirement is difficult, and examiners have an incentive to issue them. With the proposed changes to design practice described above, these burdens and difficulties may be alleviated. This change does not require a complete reversal of the long-standing requirement of a single claim (although that may be possible). Instead, by focusing on the scenario where embodiments have a unity of class but fail to share an inventive concept, the single claim requirement can be loosened to accommodate these embodiments in a single application, thereby mitigating the burdens to applicants.