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Derek Fahey is a licensed and registered patent attorney at The Plus IP Firm. The Plus IP Firm helps businesses and inventors protect their ideas, concepts and creations with patents, trademarks and copyrights.

Professional team to work with. Domain expertise is strong, with specific mention to Derek. He is a pleasure to work with and his depth of technology understanding is more than sufficient to articulate documentation that fully grasps our IP with a view to ensuring we can remain unique. Great



Multiple Embodiments in a Design Patent

Can You Have Multiple Designs in a Design Patent?

Yes. In certain instances, a design patent may include multiple designs or ‘embodiments.’ Filing a design patent application with multiple embodiments may save you both time and money. However, you may only obtain a design patent for multiple embodiments if the amount of variation between the embodiments is small and not significant. This article briefly touches on some of the issues associated with design patent applications with multiple embodiments.

Are There Any Specific Requirements for a Design Patent Application with Multiple Embodiments?

Yes. Like design patent application with a single embodiment, a design patent application with multiple embodiments, must satisfy the enablement requirement (35 U.S.C. § 112). Therefore, the differences between the embodiments must be identified either in the figure descriptions or by way of a descriptive statement in the specification.

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Firm, thank you all.*

*Jason Bennick
GA TELESIS LLC*

For example, if a cabinet's design has a front door such that only one of the views of the design - the front view - that has two different embodiments, then that front view figure's description for the second embodiment should state that this view "is a second embodiment of Figure [insert appropriate figure no.], with the only difference being the configuration of the front door; it being understood that all other surfaces are the same as those of the first embodiment." The obviousness standard under 35 U.S.C. §103 must be applied in determining whether multiple embodiments may be retained in a single application. *See* MPEP § 1504.03.

Will My Design Patent Application Get Rejected if I Include Multiple Embodiments?

A rejection is always possible for various reasons such as novelty, obviousness, non-patentable subject matter, enablement, and double patenting. If your design patent application has multiple embodiments, then the examining patent attorney ("Examiner") at the United States Patent and Trademark Office ("USPTO") must determine if the embodiments are "patentably distinct" from one another. *See* MPEP § 1504.05. The term "patentably distinct" means that your application having multiple embodiments will be allowed only if the multiple embodiments involve a single inventive concept. Two designs involve a single inventive concept if the two designs are patentably indistinct according to the standard of non-statutory double patenting. *See In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). The degree of variation between the embodiments when determining whether they are patentably distinct will depend upon the Examiner's discretion in deciding whether the inventions are distinct.

When an Examiner examines a design patent application with multiple embodiments, the Examiner

must first determine if the embodiments have overall appearances that are essentially the same as one another. If the appearance of the embodiments is considered to basically be the same, then it must be determined if 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 prior art. If an application's embodiments meet both of the above criteria, they may be retained in a single application.

When are Designs Distinct?

Differences in the features of the embodiments may be considered insignificant if those differences are *de minimis* or obvious to a designer of ordinary skill in the art. Designs are not distinct inventions if: (a) the multiple designs have overall appearances with basically the same design characteristics; and (b) the differences between the multiple designs are insufficient to patentably distinguish one design from the other. To determine if certain features are *de minimis*, it is best to consult with an experienced patent attorney.

What Happens if the Examiner Finds a Large Degree of Variation and Independently Distinct Patentable Designs?

If an Examiner finds a large degree of variation and independently distinct patentable designs in a single design patent application, then the Examiner will issue "a restriction requirement." In a restriction requirement, the Examiner will explain why the Examiner is of the opinion that there are two distinct designs in the design patent application and require the applicant to select one of the distinct designs for examination. In response to the restriction requirement, an applicant may argue that the

embodiments are not patently distinct inventions. Alternatively, the applicant could elect one of the designs to be examined during the examination of the patent application. Additionally, an applicant may file a continuation application to prosecute the remaining embodiments before the first application, which was subject to the restriction requirement, matures into a design patent. The continuation application will have the benefit of the filing date of the first application.

The patent attorneys and team members at The Plus IP Firm have assisted clients in acquiring hundreds of design patents in a variety of areas and fields. If you have any questions regarding patents, filing design patent applications and design patent applications with multiple embodiments, then contact the patent attorneys The Plus IP Firm.