

**Keywords:** filing date; division; design patent; utility patent

**General:** 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.

*Racing Strollers Inc. v. TRI Industries Inc.*

11 U.S.P.Q.2d 1300 (Fed. Cir. 1989)

Decided June 26, 1989

**I. Facts**

Racing Strollers, Inc. (appellant) was the assignee of design patent '525 related to a "Frame for a Baby Stroller." Racing Strollers, Inc. sued TRI Industries, Inc., and other defendants, in the U.S. District Court for the District of Minnesota for infringement of the '525 design patent. During the trial, a question of law concerning the filing date of the patent was raised, and an interlocutory appeal was granted. The question of law concerned the Court of Customs and Patent Appeals' earlier holding in *In re Campbell* (1954). Since Racing Strollers, Inc. was requesting the court overrule the *Campbell* decision, Racing Strollers, Inc. requested, and was granted a hearing in banc. The hearing was held June 7, 1989.

Several relevant events occurred preceding the filing of the design patent '525 and the resulting lawsuit. On October 22, 1984, a utility patent was filed that was later abandoned. Racing Strollers, Inc. admittedly sold strollers embodying the patented design more than 1 year before the filing date of the application for the design patent, but less than 1 year before the 1984 utility patent application. The application for the design patent '525 was filed April 14, 1986, but stated on the face of the patent to have been a division of the utility application filed October 22, 1984.

Shortly after the suit was filed, Racing Strollers, Inc. applied for a temporary restraining order that the defendant opposed. The District Court denied the TRO because the plaintiff had not sustained the burden of establishing a reasonable likelihood of success on the merits. The court reasoned that the sale of the strollers more than 1 year prior to the filing date of the design application would invalidate the design patent under 35 U.S.C. §102(b). Racing Strollers, Inc. countered that the design patent was entitled to priority as of the filing date of the utility patent in 1984. The sales of the strollers occurred less than 1 year before the filing date of the utility patent. The defendant relied on *Campbell* (1954) which held that a design patent cannot be a division of a mechanical (utility) patent, and therefore, the design patent cannot benefit from the earlier filing date of the utility application.

In denying the TRO, the trial judge indicated that he did not find any indication that *Campbell* had been overruled. However, in the court's amended denial of the TRO, the trial judge recognized the order involved a question of law, and suggested certifying the legal question for interlocutory appeal. The Appeal was addressed in this decision by the Federal Circuit Court.

**II. Issues**

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?

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### III. Discussion

A. Yes. Giving a patent application the benefit of the earlier filing date of another earlier filed application has a statutory basis. The court makes reference to 35 U.S.C. §§ 112, 120, 121, 171. Acting in series, these sections provide statutory authority to allow the priority filing date of a design patent filed as a division of the earlier filed utility patent.

Section 121 pertains specifically to “Divisional applications,” and contains operative language “If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application.”

Furthermore, section 120 requires that in the earlier application being relied on, the invention subsequently claimed is “disclosed in a manner provided by the first paragraph of section 112.”

Section 112 requires a written description of the invention as well as setting forth the “best mode contemplated by the inventor.” For an ornamental design, like the present case (provided for in §171), there is only one “best mode” and it can be described only by illustrations showing what it looks like. Accordingly, meeting the requirements of §112 for an ornamental design requires that the earlier application contain illustrations, in whatever form they may take, depicting the ornamental design illustrated in the later application.

In view of the statutory authority, the court expressly overruled the *Campbell* decision (the decision relied on by the defendant and the District Court to deny the TRO request by Racing Strollers, Inc.). The court recognized a party’s right to all provisions covered under the patent statutes. Further, the court explained that the rights granted in §120 are mandatory. In the case of a design patent, relevant §171 provides that “the provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” Since there are no “otherwise provided” statutes that separate or remove design patents from §120, design patents are also afforded the rights under §120.

In explaining its reason for overruling the *Campbell* opinion, the court expressed the belief that the *Campbell* decision was based on faulty reasoning as discussed above. In addition, the court points to the fact that the *Campbell* opinion was written more than one year after the effective date of the 1952 Patent Act, and made no mention of §§120, 121, or 112. The *Campbell* court made reference to the prior statute, R.S. 4888, and cited it as current law, even though the 1952 act expressly states that it applied to proceedings on applications pending on January 1, 1953.

Further, the court addresses the inconsistent reference to *Campbell* in the 1983 MPEP. The court dismisses this concern by explaining the “loose-leaf” nature of the MPEP and the piecemeal fashion in which it is updated. The court explained that inconsistencies are not surprising and later updates to the MPEP should be made consistent with the opinion. The court concluded by reminding that the MPEP does not have force of law.

**§ 112. Specification**

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 of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such 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 or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

**§ 121. Divisional applications**

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. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. 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. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

**§ 171. Patents for designs**

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.