

# Design Patents

A **design patent** is a form of legal protection granted to the ornamental design of a functional item. Design patents are a type of industrial design right. Ornamental designs of jewelry, furniture, beverage containers (Fig. 1) and computer icons are examples of objects that are covered by design patents.

A similar concept, a registered design can be obtained in other countries.

In Kenya, Japan, South Korea and Hungary, industrial designs are registered after performing an official novelty search. In the countries of the European Community, one needs to only pay an official fee and meet other formal requirements for registration (e.g. Community design at OHIM, Germany, France, Spain).

For the member states of WIPO, cover is afforded by registration at WIPO and examination by the designated member states in accordance with the Geneva Act of the Hague Agreement.

A US design patent covers the ornamental design for an object having practical utility. An object with a design that is substantially similar to the design claimed in a design patent cannot be made, used, copied or imported into the United States. The copy does not have to be exact for the patent to be infringed. It only has to be substantially similar. Design patents with line drawings cover only the features shown as solid lines. Items shown as dotted lines are not covered. This is one of the reasons Apple was awarded a jury verdict in the US case of Apple v Samsung. Apple's patent showed much of their iPhone design as broken lines. It didn't matter if Samsung was different in those areas. The fact that the solid lines of the patent were the same as Samsung's design meant that Samsung infringed the Apple design patent.

Computer images[edit]

Both novel fonts and computer icons can be covered by design patents. Icons are only covered, however, when they are displayed on a computer screen, thus making them part of an article of manufacture with practical utility. Screen layouts can also be protected with design patents.

## The Design Patent Application Process

The preparation of a design patent application and the conducting of the proceedings in the USPTO to obtain the patent is an undertaking requiring the knowledge of patent law and rules and Patent and Trademark Office practice and procedures. A patent attorney or agent specially trained in this field is best able to secure the greatest patent protection to which applicant is entitled. It would be prudent to seek the services of a registered patent attorney or agent. Representation, however, is not required. A knowledgeable applicant may successfully prosecute his or her own application. However, while persons not skilled in this work may obtain a patent in many cases, there is no assurance that the patent obtained would adequately protect the particular design.

Of primary importance in a design patent application is the drawing disclosure, which illustrates the design being claimed. Unlike a utility application, where the "claim" describes the invention in a lengthy written explanation, the claim in a design patent application protects the overall visual appearance of the design, "described" in the drawings. It is

essential that the applicant present a set of drawings (or photographs) of the highest quality which conform to the rules and standards which are reproduced in this guide. Changes to these drawings after the application has been filed, may introduce new matter, which is not permitted by law (35 U.S.C. 132). It is in applicant's best interest to ensure that the drawing disclosure is clear and complete prior to filing the application, since an incomplete or poorly prepared drawing may result in a fatally defective disclosure which cannot become a patent. It is recommended that applicant retain the services of a professional draftsman who specializes in preparing design patent drawings. Examples of acceptable drawings and drawing disclosures are included in this Guide so that applicant will have some idea of what is required and can prepare the drawings accordingly.

### **Filing An Application**

In addition to the drawing disclosure, certain other information is necessary. While no specific format is required, it is strongly suggested that applicant follow the formats presented to ensure that the application is complete.

When a complete design patent application, along with the appropriate filing fee, is received by the Office, it is assigned an Application Number and a Filing Date. A "Filing Receipt" containing this information is sent to the applicant. The application is then assigned to an examiner. Applications are examined in order of their filing date.

### **Examination**

The actual "examination" entails checking for compliance with formalities, ensuring completeness of the drawing disclosure and a comparison of the claimed subject matter with the "prior art." "Prior art" consists of issued patents and published materials. If the claimed subject matter is found to be patentable, the application will be "allowed," and instructions will be provided to applicant for completing the process to permit issuance as a patent.

The examiner may reject the claim in the application if the disclosure cannot be understood or is incomplete, or if a reference or combination of references found in the prior art, shows the claimed design to be unpatentable. The examiner will then issue an Office action detailing the rejection and addressing the substantive matters which effect patentability.

This Office action may also contain suggestions by the examiner for amendments to the application. Applicant should keep this Office action for his or her files, and not send it back to the Office.

### **Response**

If, after receiving an Office action, applicant elects to continue prosecution of the application, a timely reply to the action must be submitted. This reply should include a request for reconsideration or further examination of the claim, along with any amendments desired by



the applicant, and must be in writing. The reply must distinctly and specifically point out the supposed errors in the Office action and must address every objection and/or rejection in the action. If the examiner has rejected the claim over prior art, a general statement by the applicant that the claim is patentable, without specifically pointing out how the design is patentable over the prior art, does not comply with the rules.

In all cases where the examiner has said that a reply to a requirement is necessary, or where the examiner has indicated patentable subject matter, the reply must comply with the requirements set forth by the examiner, or specifically argue each requirement as to why compliance should not be required.

In any communication with the Office, applicant should include the following items:

1. Application number (checked for accuracy).
2. Group art unit number (copied from filing receipt or the most recent Office action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

It is applicant's responsibility to make sure that the reply is received by the Office prior to the expiration of the designated time period set for reply. This time period is set to run from the "Date Mailed," which is indicated on the first page of the Office action. If the reply is not received within the designated time period, the application will be considered abandoned. In the event that applicant is unable to reply within the time period set in the Office action, abandonment may be prevented if a reply is filed within six months from the mail date of the Office action provided a petition for extension of time and the fee set forth in 37 CFR § 1.17(a) are filed. The fee is determined by the amount of time requested, and increases as the length of time increases. These fees are set by Rule and could change at any time. An "Extension of Time" does not have to be obtained prior to the submission of a reply to an Office action; it may be mailed along with the reply. See insert for schedule of current fees. Note: an extension of time cannot be obtained when responding to a "Notice of Allowance and Fee(s) Due."

To ensure that a time period set for reply to an Office action is not missed; a "Certificate of Mailing" should be attached to the reply. This "Certificate" establishes that the reply is being mailed on a given date. It also establishes that the reply is timely, if it was mailed before the period for reply had expired, and if it is mailed with the United States Postal Service. A "Certificate of Mailing" is not the same as "Certified Mail." A suggested format for a Certificate of Mailing is as follows:

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on (DATE MAILED)"

(Name - Typed or Printed)

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Signature\_\_\_\_\_

Date\_\_\_\_\_

If a receipt for any paper filed in the USPTO is desired, applicant should include a stamped, self-addressed postcard, which lists, on the message side applicant's name and address, the application number, and filing date, the types of papers submitted with the reply (i.e., 1 sheet of drawings, 2 pages of amendments, 1 page of an oath/declaration, etc.) This postcard will be stamped with the date of receipt by the mailroom and returned to applicant. This postcard will be applicant's evidence that the reply was received by the Office on that date.

If applicant changes his or her mailing address after filing an application, the Office must be notified in writing of the new address. Failure to do so will result in future communications being mailed to the old address, and there is no guarantee that these communications will be forwarded to applicant's new address. Applicant's failure to receive, and properly reply to these Office communications will result in the application being held abandoned. Notification of "Change of Address" should be made by separate letter, and a separate notification should be filed for each application.

### **Reconsideration**

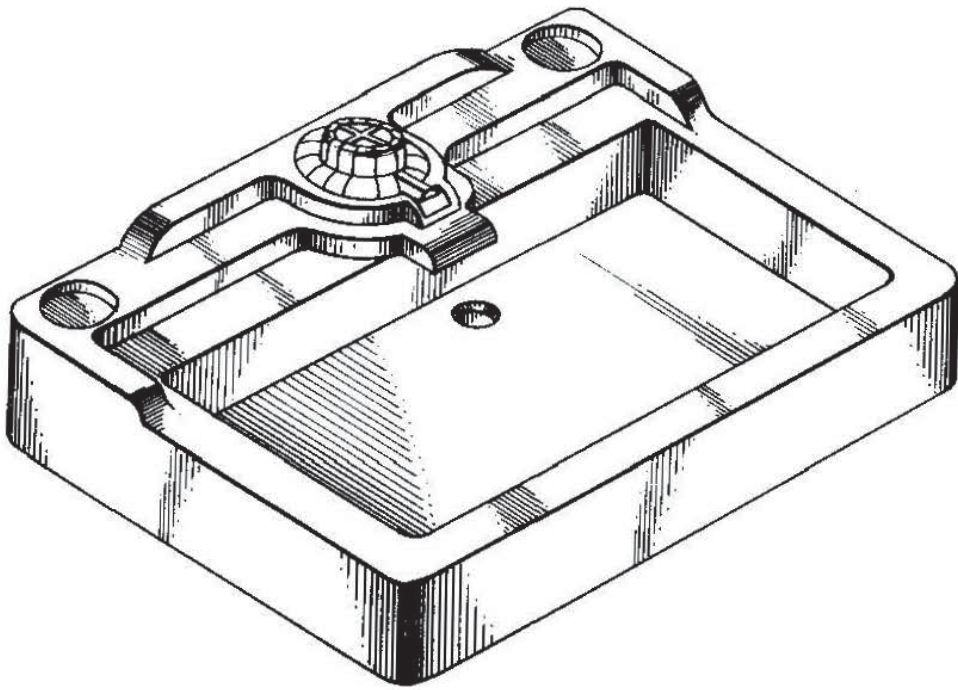
Upon submission of a reply to an Office action, the application will be reconsidered and further examined in view of applicant's remarks and any amendments included with the reply. The examiner will then either withdraw the rejection and allow the application or, if not persuaded by the remarks and/or amendments submitted, repeat the rejection and make it Final. Applicant may file an appeal with the Board of Patent Appeals and Interferences after given a final rejection or after the claim has been rejected twice. Applicant may also file a new application prior to the abandonment of the original application, claiming benefit of the earlier filing date. This will allow continued prosecution of the claim.

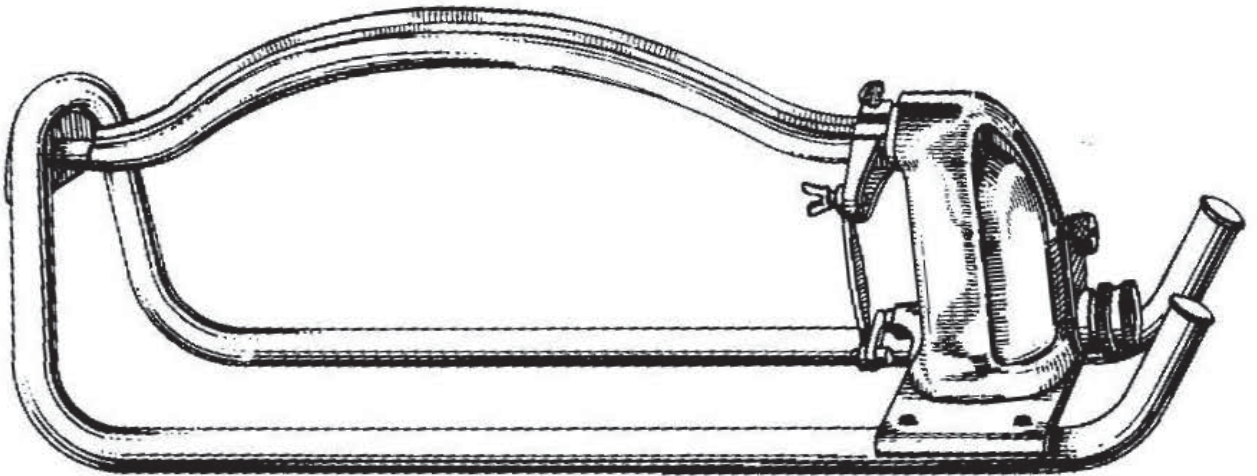
### **Drawing Examples**

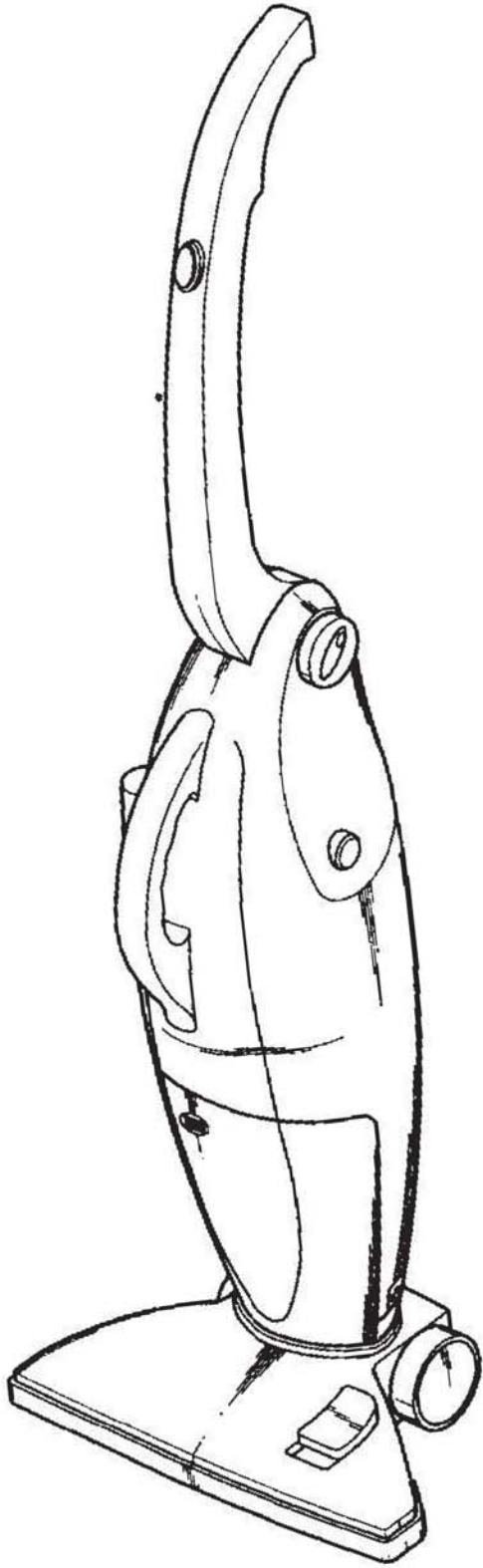
The two types of shading commonly employed in design patent application drawings are straight-line surface shading and stippling. Individually or in combination, they can effectively represent the character and contour of most surfaces.

#### **Straight-line Surface Shading**

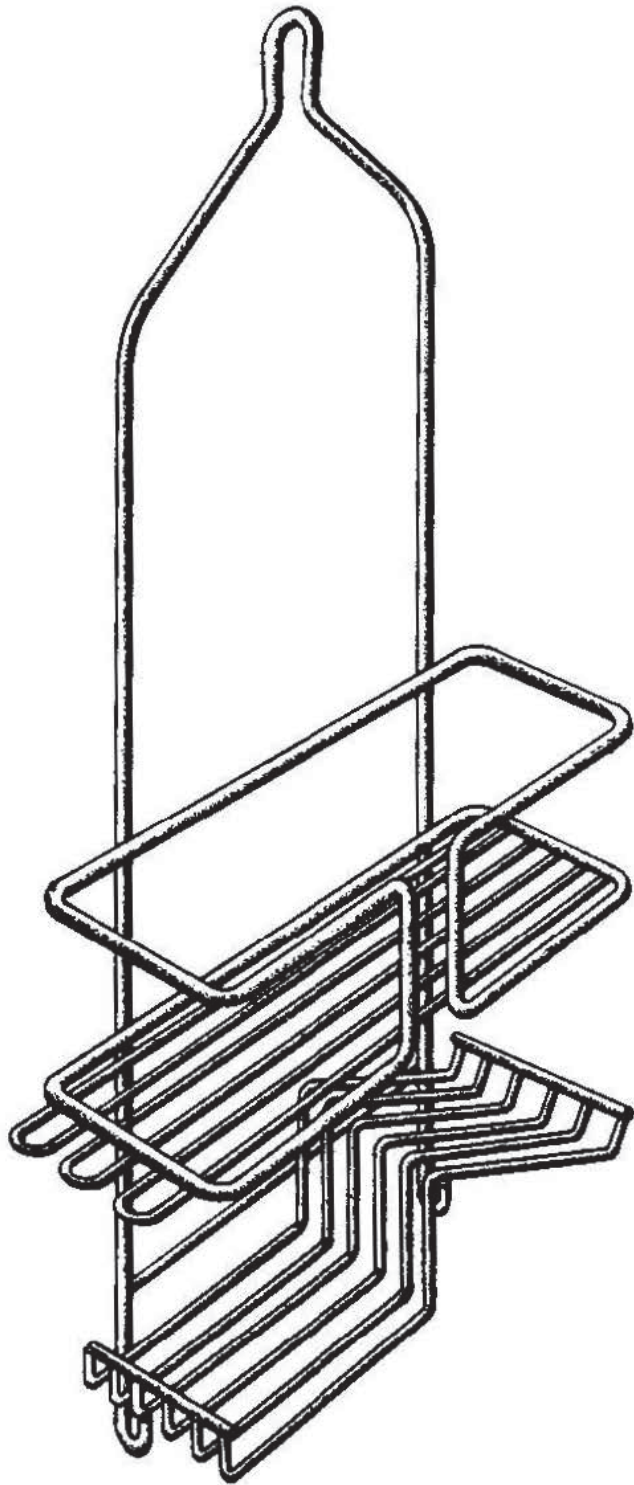




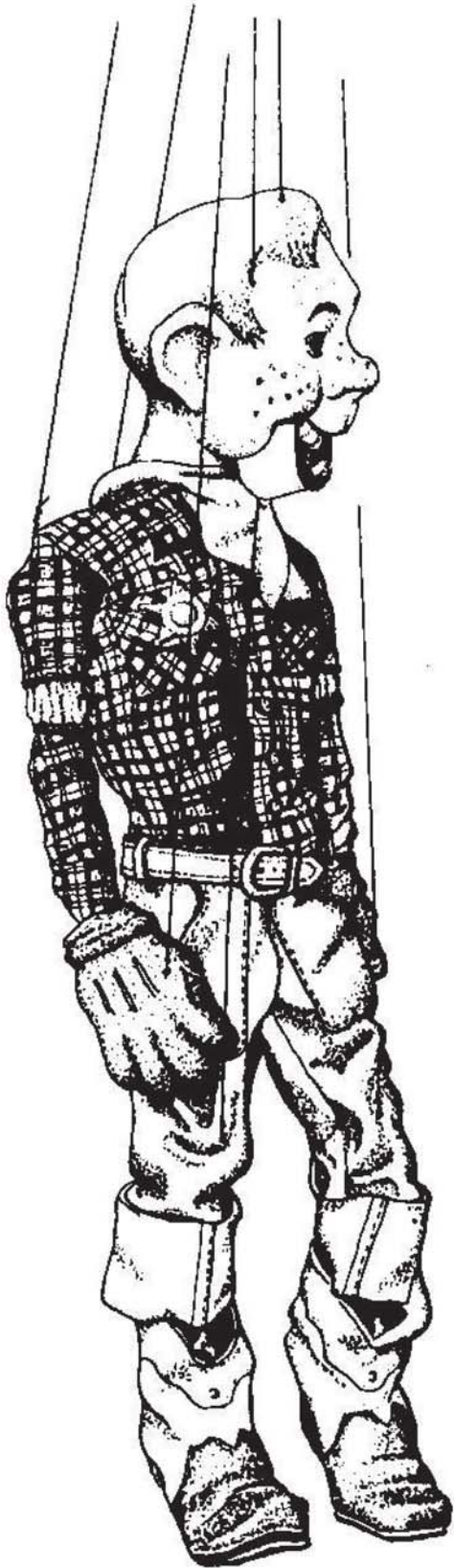




**Stippling**

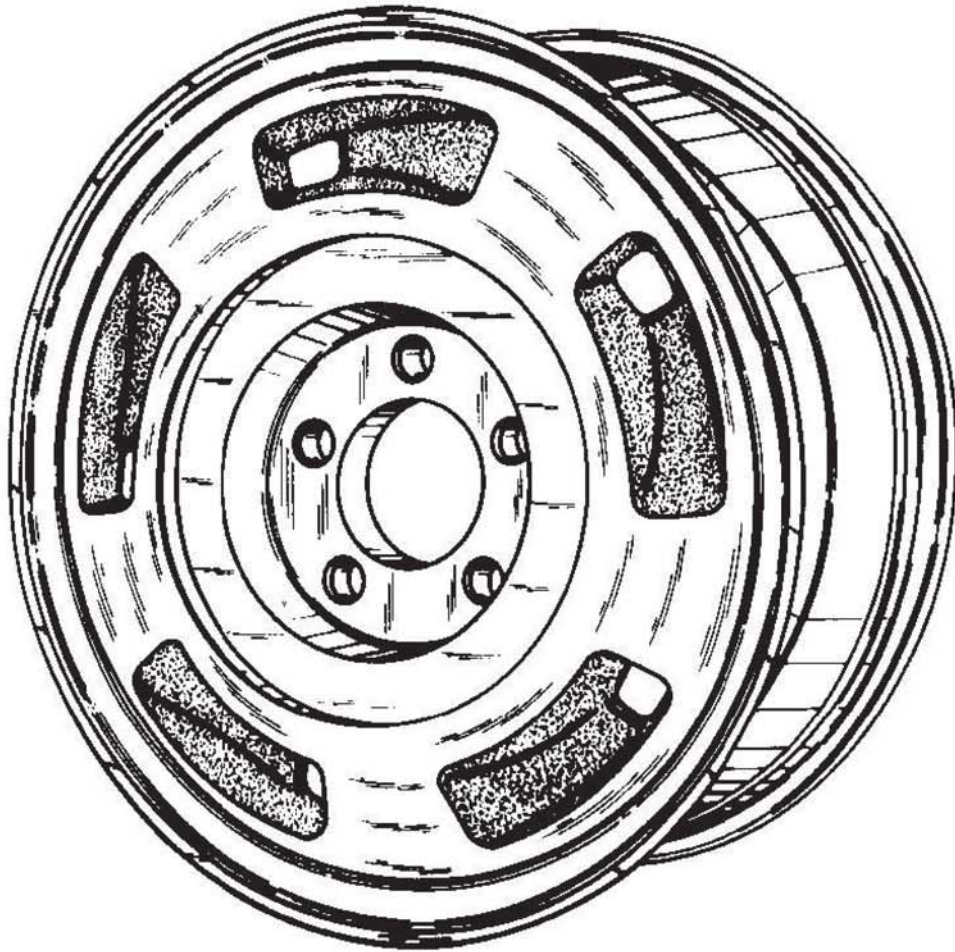


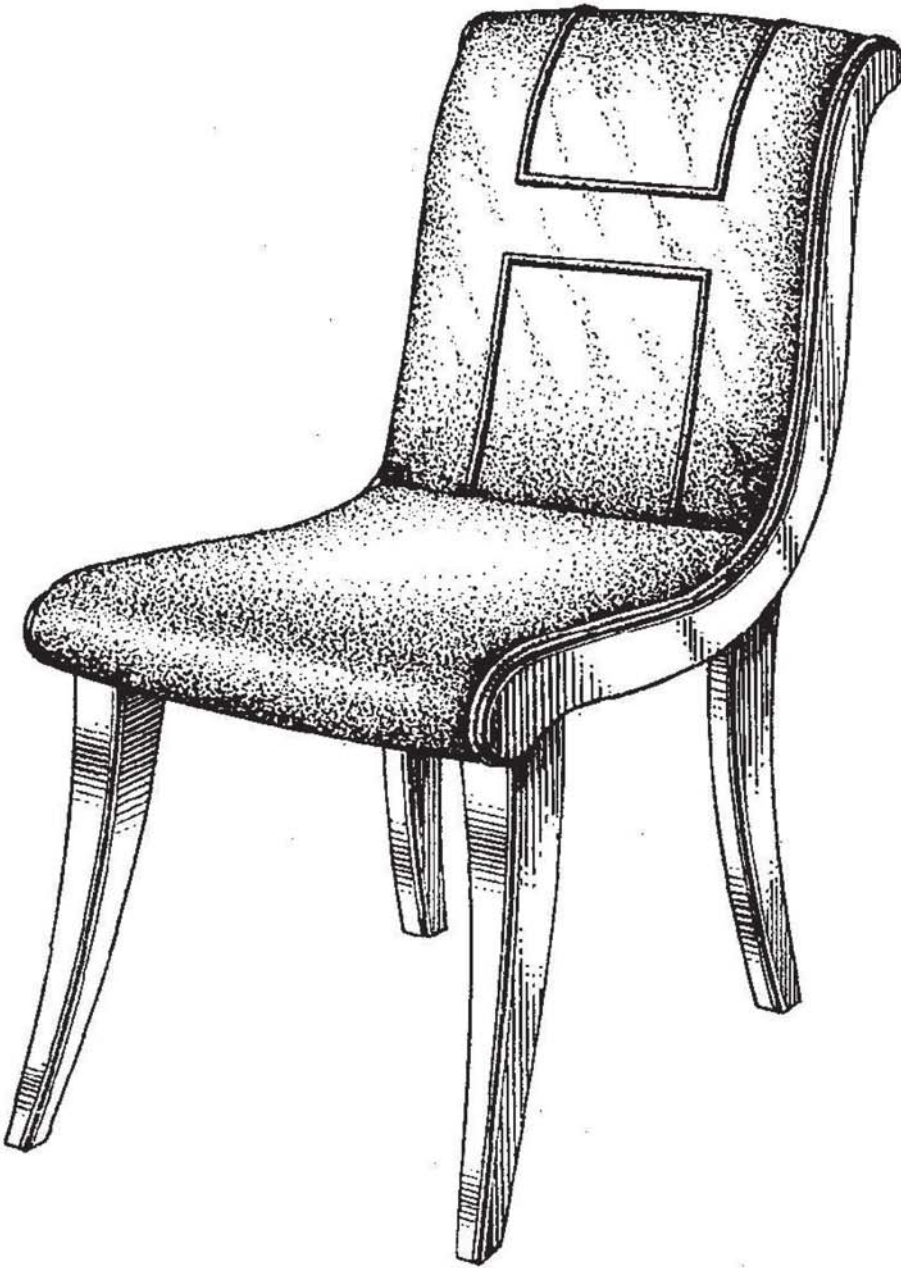




Combination of Straight Line Shading and Stippling

Note that both stippling and straight-line surface shading, while permissible on the same object to show surface contrast, should not be used together on the same surface.

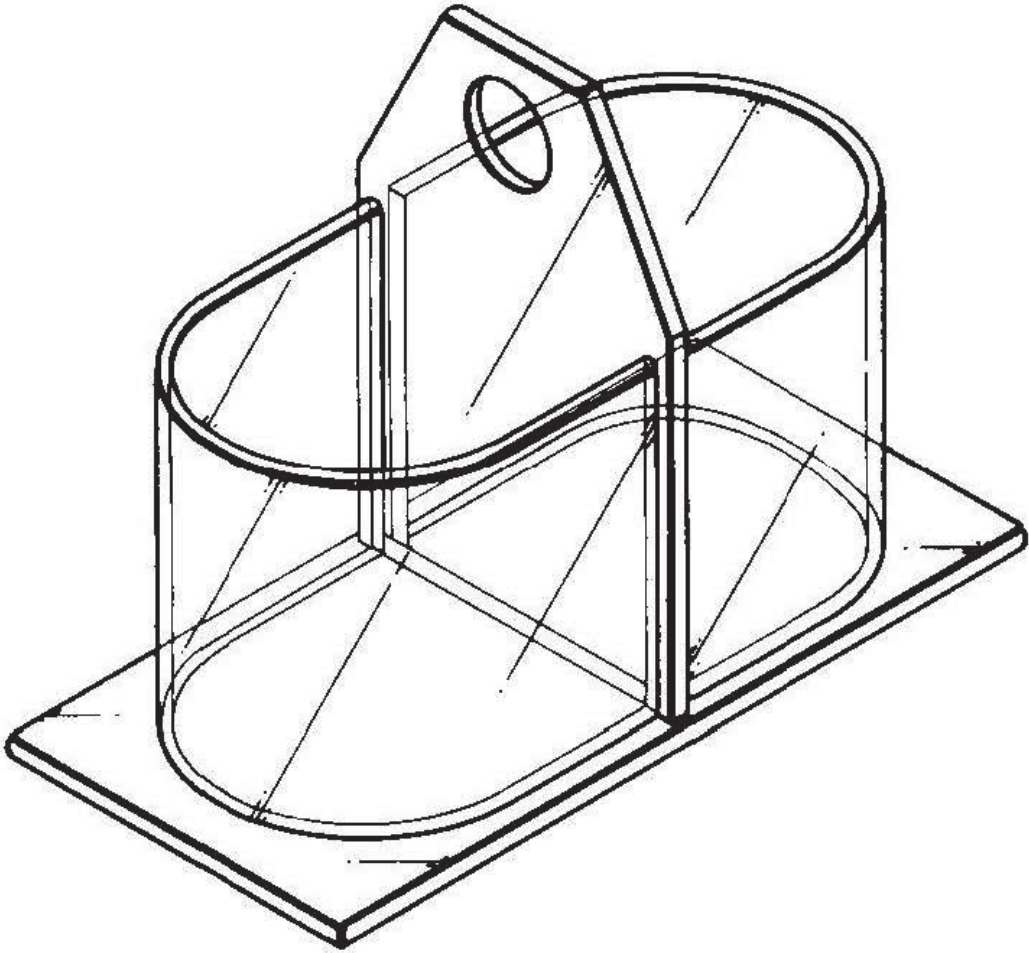


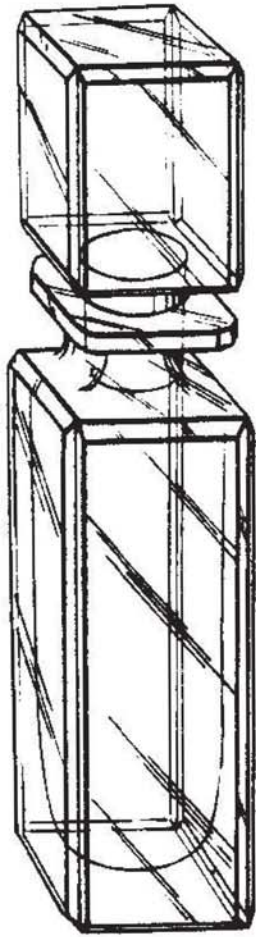


**Transparent Materials**

Note that elements visible behind transparent surfaces should be shown in light, full lines, not broken lines.

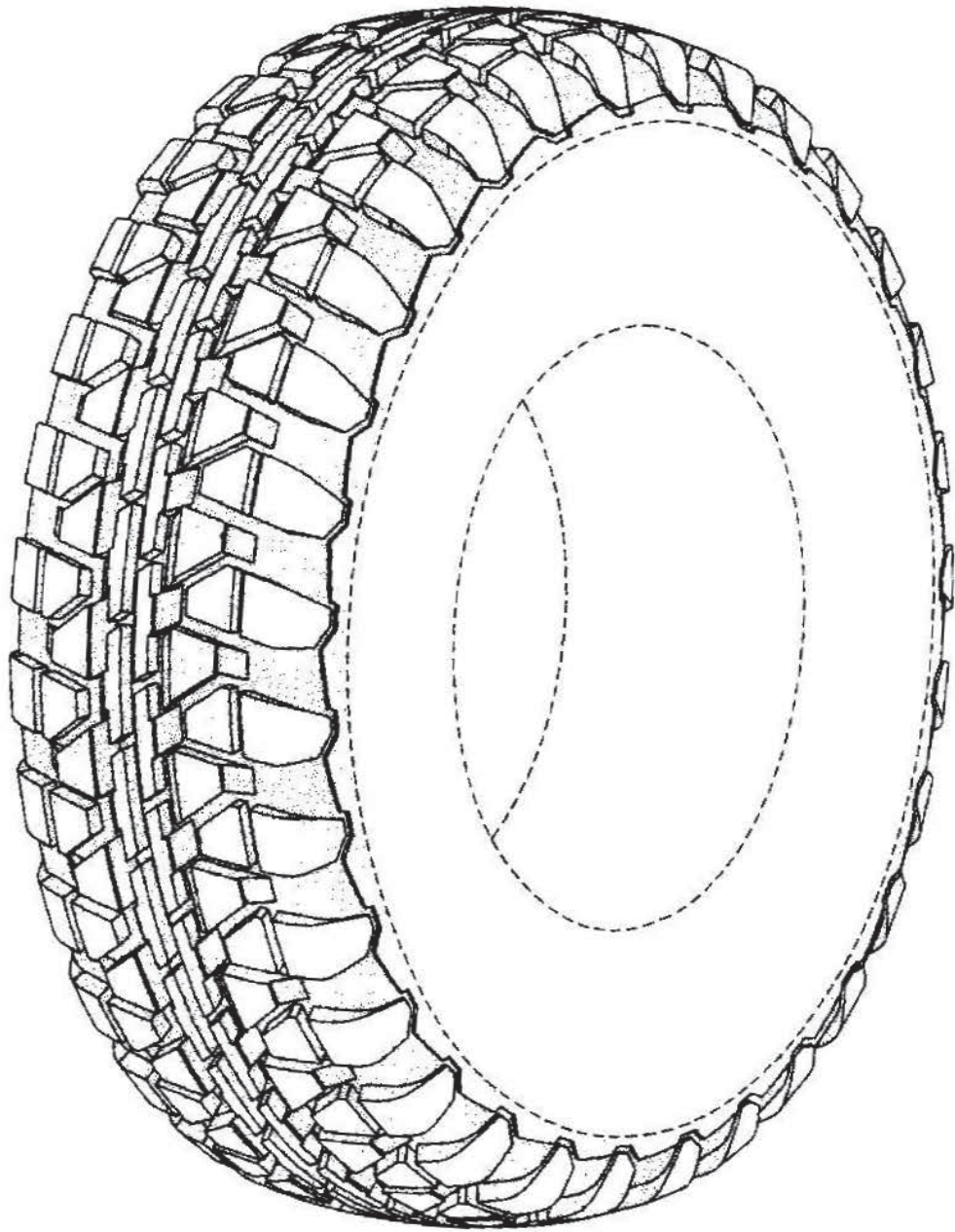




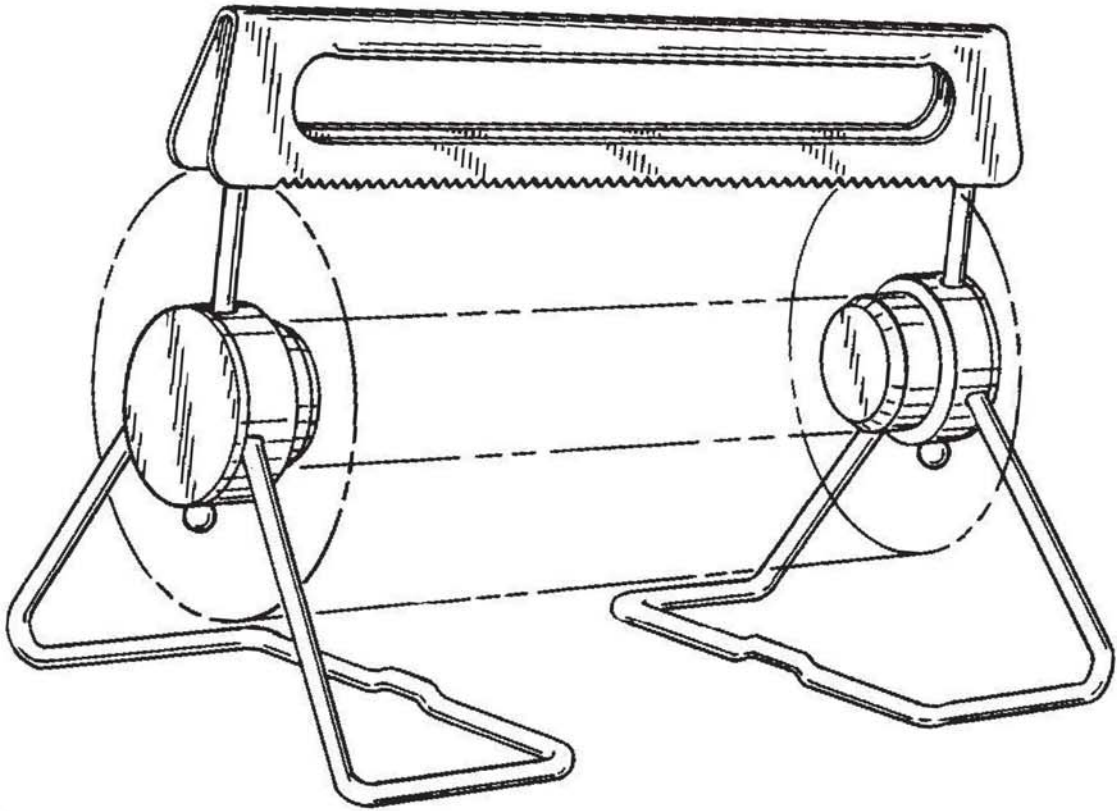


### **Broken Line Disclosure**

Broken lines may be used to show environment and boundaries that form no part of the claimed design.

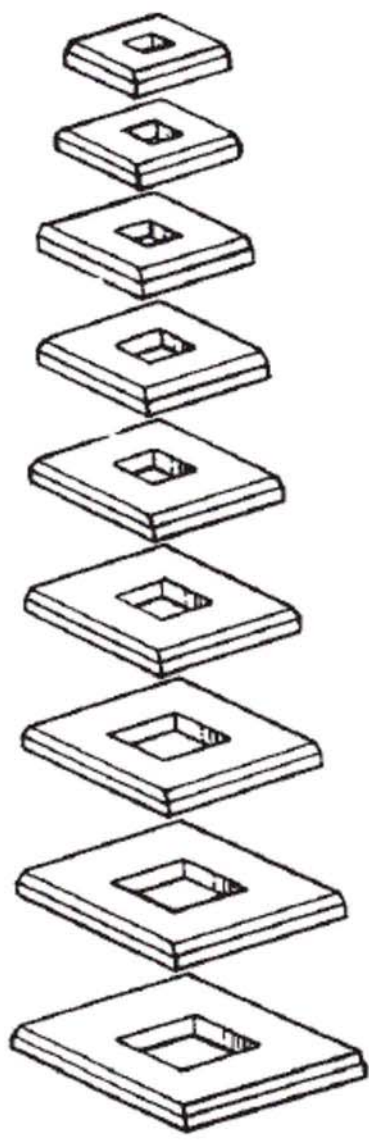




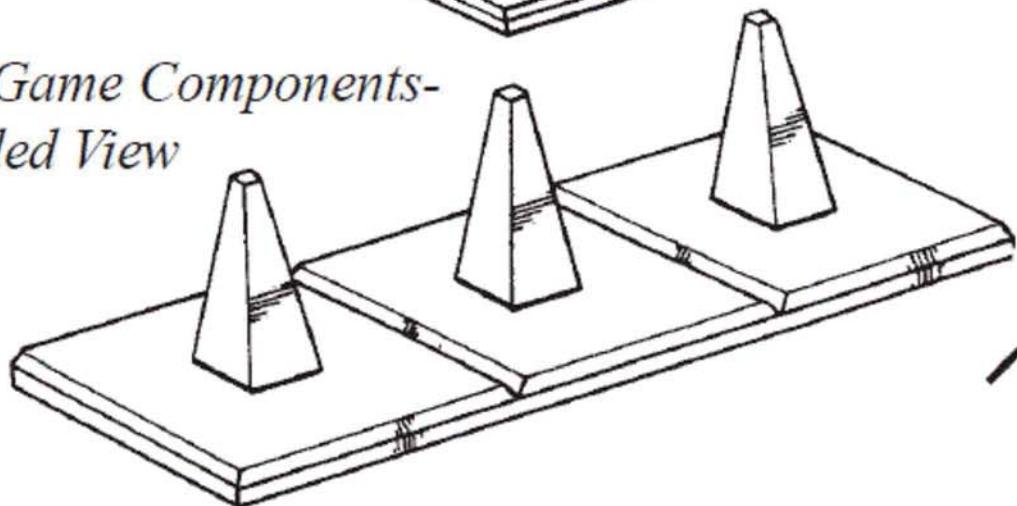


**Exploded View**

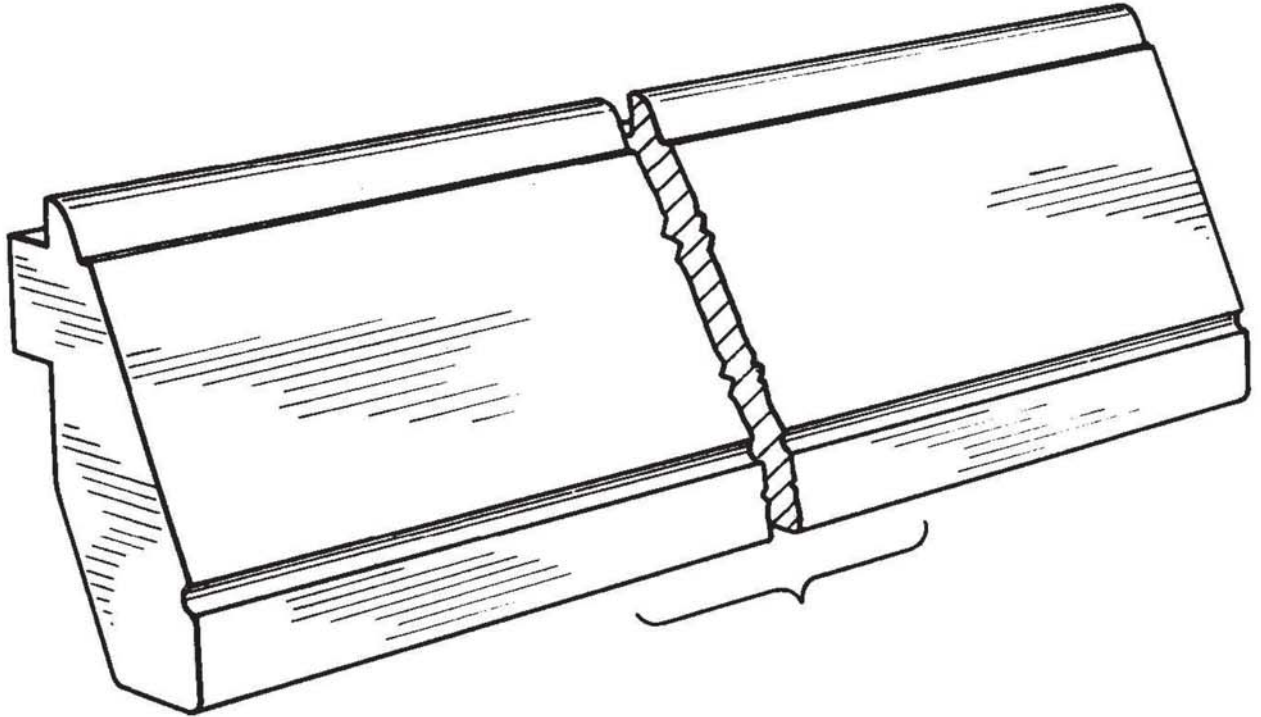
An exploded view is only supplementary to a fully assembled view. A bracket must be employed to show the association of elements.



*Set of Game Components-  
Exploded View*

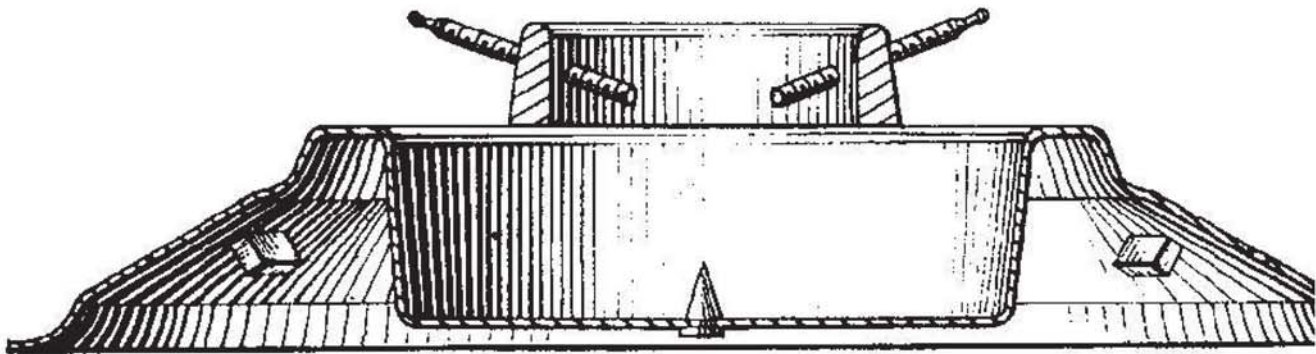


views with a break, the claim will be understood to be directed only to the design for the portions of the molding that are shown. A description in the specification must explain that the appearance of any portion of the article between the break lines forms no part of the claimed design.



### **Cross-sectional View**

Cross-sections may be employed to clarify the disclosure and to minimize the number of views.



### **Multiple Embodiments**

Multiple embodiments of a single concept may be filed in one design application, so long as their appearance and shape are similar, as shown below.