

# **A Guide To Filing A Design Patent Application**

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<http://www.uspto.gov/web/offices/pac/design/toc.html#improper>

# Definition of a Design

- A design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture. Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation. A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture.

# Types of Designs and Modified Forms

- An ornamental design
  - may be embodied in an entire article
  - or only a portion of an article,
  - or may be ornamentation applied to an article. If a design is directed to just surface ornamentation, it must be shown applied to an article in the drawings, and the article must be shown in broken lines, as it forms no part of the claimed design.
- A design patent application may only have a single claim (37 CFR § 1.153). Designs that are independent and distinct must be filed in separate applications since they cannot be supported by a single claim.

# The Difference Between Design and Utility Patents

- a “utility patent” protects the way an article is used and works (35 U.S.C. 101),
- a "design patent" protects the way an article looks (35 U.S.C. 171).
- Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance. While utility and design patents afford legally separate protection, the utility and ornamentality of an article are not easily separable. Articles of manufacture may possess both functional and ornamental characteristics.

# Improper Subject Matter for Design Patents

- A design for an article of manufacture that is dictated primarily by the function of **the article lacks ornamentality and is not proper statutory subject matter** under 35 U.S.C. 171.
- Specifically, if at the time the design was created, there was no unique or distinctive shape or appearance to the article not dictated by the function that it performs, the design lacks ornamentality and is not proper subject matter.
- 35 U.S.C. 171 requires that a design to be patentable must be “**original.**” Clearly a design that simulates a well-known or naturally occurring object or person is not original as required by the statute.
- Furthermore, subject matter that could be considered **offensive to any race, religion, sex, ethnic group, or nationality is not proper subject matter for a design patent application** (35 U.S.C. 171 and 37 CFR § 1.3).

# Invention Development Organizations

- Invention Development Organizations (IDO) are private and public consulting and marketing businesses that exist to help inventors bring their inventions to market, or to otherwise profit from their ideas.
- **Some IDOs will automatically recommend that you pursue patent protection for your idea with little regard for the value of any patent that may ultimately issue.** For example, an IDO may recommend that you add ornamentation to your product in order to render it eligible for a design patent, but not really explain to you the purpose or effect of such a change.
- Because design patents protect only the appearance of an article of manufacture, it is possible that minimal differences between similar designs can render each patentable.
- Therefore, even though you may ultimately receive a design patent for your product, the protection afforded by such a patent may be somewhat limited. Finally, you should also be aware of the broad distinction between utility and design patents, and realize that a design patent may not give you the protection desired.

# Elements of a Design Patent Application

- (1) Preamble, stating name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied;
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Description of the figure(s) of the drawing;
- (5) Feature description;
- (6) A single claim;
- (7) Drawings or photographs;
- (8) Executed oath or declaration.
- In addition, the filing fee, search fee, and examination fee are also required. If applicant is a small entity, (an independent inventor, a small business concern, or a non-profit organization), these fees are reduced by half.

# Elements of a Design Patent Application

- Fees:
  - the filing fee,
  - search fee,
  - examination fee
- If applicant is a small entity, these fees are reduced by half.
  - an independent inventor,
  - a small business concern,
  - a non-profit organization),

# FEEES

## USPTO Fee Schedule, effective September 30, 2007

Fee Code	37 CFR	Description	Fee	Small Entity Fee (if applicable)
<b>Patent Application Filing Fees</b>				
1011/2011	1.16(a)(1)	Basic filing fee - Utility <i>filed on or after December 8, 2004</i>	310.00	155.00
4011†	1.16(a)(1)	Basic filing fee - Utility (electronic filing for small entities) <i>filed on or after December 8, 2004</i>	n/a	75.00
1001/2001	1.16(a)(2)	Basic filing fee - Utility <i>filed before December 8, 2004</i>	810.00	405.00
1201/2201	1.16(h)	Independent claims in excess of three	210.00	105.00
1202/2202	1.16(i)	Claims in excess of 20	50.00	25.00
1203/2203	1.16(j)	Multiple dependent claim	370.00	185.00
1051/2051	1.16(f)	Surcharge - Late filing fee, search fee, examination fee or oath or declaration	130.00	65.00
1081/2081	1.16(s)	Utility Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	260.00	130.00
1012/2012	1.16(b)(1)	Basic filing fee - Design <i>filed on or after December 8, 2004</i>	210.00	105.00
1002/2002	1.16(b)(2)	Basic filing fee - Design <i>filed before December 8, 2004</i>	360.00	180.00
1017/2017	1.16(b)(1)	Basic filing fee - Design (CPA) <i>filed on or after December 8, 2004</i>	210.00	105.00
1007/2007	1.16(b)(2)	Basic filing fee - Design (CPA) <i>filed before December 8, 2004</i>	360.00	180.00
1082/2082	1.16(s)	Design Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	260.00	130.00
1013/2013	1.16(c)(1)	Basic filing fee - Plant <i>filed on or after December 8, 2004</i>	210.00	105.00
1003/2003	1.16(c)(2)	Basic filing fee - Plant <i>filed before December 8, 2004</i>	570.00	285.00
1083/2083	1.16(s)	Plant Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	260.00	130.00
1014/2014	1.16(e)(1)	Basic filing fee - Reissue <i>filed on or after December 8, 2004</i>	310.00	155.00
1004/2004	1.16(e)(2)	Basic filing fee - Reissue <i>filed before December 8, 2004</i>	810.00	405.00
1019/2019	1.16(e)(1)	Basic filing fee - Design Reissue (CPA) <i>filed on or after December 8, 2004</i>	310.00	155.00
1009/2009	1.16(e)(2)	Basic filing fee - Design Reissue (CPA) <i>filed before December 8, 2004</i>	810.00	405.00
1204/2204	1.16(h)	Reissue independent claims in excess of three	210.00	105.00
1205/2205	1.16(i)	Reissue claims in excess of 20	50.00	25.00
1084/2084	1.16(s)	Reissue Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	260.00	130.00
1005/2005	1.16(d)	Provisional application filing fee	210.00	105.00
1085/2085	1.16(s)	Provisional Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	260.00	130.00
1052/2052	1.16(g)	Surcharge - Late provisional filing fee or cover sheet	50.00	25.00

# FEEES

Patent Search Fees				<a href="#">Back to Top</a>	
1111/2111	1.16(k)	Utility Search Fee	510.00	255.00	
1112/2112	1.16(l)	Design Search Fee	100.00	50.00	
1113/2113	1.16(m)	Plant Search Fee	310.00	155.00	
1114/2114	1.16(n)	Reissue Search Fee	510.00	255.00	
Patent Examination Fees				<a href="#">Back to Top</a>	
1311/2311	1.16(o)	Utility Examination Fee	210.00	105.00	
1312/2312	1.16(p)	Design Examination Fee	130.00	65.00	
1313/2313	1.16(q)	Plant Examination Fee	160.00	80.00	
1314/2314	1.16(r)	Reissue Examination Fee	620.00	310.00	
Patent Post-Allowance Fees				<a href="#">Back to Top</a>	
1501/2501	1.18(a)	Utility issue fee	1,440.00	720.00	
1502/2502	1.18(b)	Design issue fee	820.00	410.00	
1503/2503	1.18(c)	Plant issue fee	1,130.00	565.00	
1511/2511	1.18(a)	Reissue issue fee	1,440.00	720.00	
1504	1.18(d)	Publication fee for early, voluntary, or normal publication	300.00		
1505	1.18(d)	Publication fee for republication	300.00		
Patent Maintenance Fees				<a href="#">Back to Top</a>	
1551/2551	1.20(e)	Due at 3.5 years	930.00	465.00	
1552/2552	1.20(f)	Due at 7.5 years	2,360.00	1,180.00	
1553/2553	1.20(g)	Due at 11.5 years	3,910.00	1,955.00	
1554/2554	1.20(h)	Surcharge - 3.5 year - Late payment within 6 months	130.00	65.00	
1555/2555	1.20(h)	Surcharge - 7.5 year - Late payment within 6 months	130.00	65.00	
1556/2556	1.20(h)	Surcharge - 11.5 year - Late payment within 6 months	130.00	65.00	
1557	1.20(i)(1)	Surcharge after expiration - Late payment is unavoidable	700.00		
1558	1.20(i)(2)	Surcharge after expiration - Late payment is unintentional	1,640.00		
Miscellaneous Patent Fees				<a href="#">Back to Top</a>	
1801/2801	1.17(e)	Request for continued examination (RCE) (see 37 CFR 1.114)	810.00	405.00	
1808	1.17(i)	Processing fee, except in provisional applications	130.00		
1803	1.17(i)	Request for voluntary publication or republication	130.00		
1802	1.17(k)	Request for expedited examination of a design application	900.00		
1804	1.17(n)	Request for publication of SIR - Prior to examiner's action	920.00*		
1805	1.17(o)	Request for publication of SIR - After examiner's action	1,840.00*		
1806	1.17(p)	Submission of an Information Disclosure Statement	180.00		
1807	1.17(q)	Processing fee for provisional applications	50.00		
1809/2809	1.17(r)	Filing a submission after final rejection (see 37 CFR 1.129(a))	810.00	405.00	
1810/2810	1.17(s)	For each additional invention to be examined (see 37 CFR 1.129(b))	810.00	405.00	
1814/2814	1.20(d)	Statutory disclaimer	130.00	65.00	

# The Preamble

- The Preamble, if included, should state the
  - name of the applicant,
  - the title of the design,
  - a brief description of the nature and intended use of the article in which the design is embodied.
- All information contained in the preamble will be printed on the patent, should the claimed design be deemed patentable.

# The Title

- The Title of the design must identify the article in which the design is embodied by the name generally known and used by the public.
- Thus, applicants are encouraged to provide a specific and descriptive title.
- Marketing designations are improper as titles and should not be used.
- A title descriptive of the actual article
  - aids the examiner in developing a complete field of search of the prior art.
  - aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, as well as the proper classification of the patent upon allowance of the application.
  - It also helps the public in understanding the nature and use of the article embodying the design after the patent has been published. Thus, applicants are encouraged to provide a specific and descriptive title.

# The Figure Descriptions

- The Figure Descriptions indicate what each view of the drawings represents, i.e., front elevation, top plan, perspective view, etc.
- Any description of the design in the specification, other than a brief description of the drawing, is generally not necessary since, as a general rule, the drawing is the design's best description. However, while not required, a special description is not prohibited.
- In addition to the figure descriptions, the following types of statements are permissible in the specification:
  - 1. A description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure (i.e., “the right side elevational view is a mirror image of the left side”).
  - 2. Description disclaiming portions of the article not shown, that form no part of the claimed design.
  - 3. Statement indicating that any broken line illustration of environmental structure in the drawing is not part of the design sought to be patented.
  - 4. Description denoting the nature and environmental use of the claimed design, if not included in the preamble.

# **A Single Claim**

- **A design patent application may only include a single claim. The claim defines**
  - **the design which applicant wishes to patent, in terms of the article in which it is embodied or applied.**

# Drawings or Black and White Photographs

- Every design patent application must include either
  - a drawing
  - or a black and white photograph of the claimed design.
- Drawings are normally required to be in black ink on white paper.
- Black and white photographs, in lieu of drawings, are permitted subject to the requirements of 37 CFR §1.84(b)(1) and §1.152.

# Color Drawings or Color Photographs

- The Office will accept color drawings or photographs in design patent applications only after the granting of a petition filed under 37 CFR §1.84(a)(2), explaining why the color drawings or photographs are necessary. Any such petition must include the fee set forth in 37 CFR § 1.17(h), three sets of color drawings or photographs, and the specification must contain the following language before the description of the drawings:
  - "The patent or application file contains a least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee."
  - If color photographs are submitted as informal drawings and the applicant does not consider the color to be part of the claimed design, a disclaimer should be added to the specification as follows: "The color shown on the claimed design forms no part thereof." Color will be considered an integral part of the disclosed and claimed design in the absence of a disclaimer filed with the original application. A disclaimer may only be used when filing color photographs as informal drawings, as 37 CFR §1.152 requires that the disclosure in formal photographs be limited to the design for the article claimed.

# The Views

- The drawings or photographs should contain a sufficient number of views to completely disclose the appearance of the claimed design,
  - i.e., **front, rear, right and left sides, top and bottom**. If a perspective view is submitted, the surfaces shown would normally not be required to be illustrated in other views if these surfaces are clearly understood and fully disclosed in the perspective.
- While not required, it is suggested that perspective views be submitted to clearly show the appearance and shape of three-dimensional designs.

# The Oath or Declaration

- The oath or declaration required of the applicant must comply with the requirements set forth in 37 CFR §1.63.

# The Design Patent Application Process

- 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.

# 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.

# 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.