

Summary of United States Law Respecting Design Patents

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I. INTRODUCTION

The purpose of this article is to familiarize the reader with the requirements of a design patent application and the rights afforded by an issued design patent, to the extent that those requirements and rights vary from utility patent applications and utility patents. Unless a proper design application is filed, rights will be limited or non-existent. Accordingly, it is essential that a proper design application is filed. Thus, this article summarizes United States statutory and regulatory law regarding obtaining, maintaining, and enforcing patents for design inventions, with emphasis on the requirements of the design application. The following sections review the statutory and regulatory law on those issues.

II. STATUTORY LAW

This section quotes the statutory law, section by section, and provides comments and analysis. United States design law is specified in chapter 16 of 35 United States Code (USC). This subsection includes 35 USC §§ 171, 172, and 173. These sections read as follows.

CHAPTER 16 — DESIGNS

See, § 171 Patents for designs; § 172 Right of priority; §173 Term of design patent.

35 USC § 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.

35 USC § 172 Right of priority

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs. (Amended Dec. 8, 1994, Public Law 103-465, sec. 532(c)(2), 108 Stat. 4987)

35 USC § 173 Term of design patent

Patents for designs shall be granted for the term of fourteen years from the date of grant. (Amended Aug. 27, 1982, Public Law 97-247, § 16, 96 Stat. 321; Dec. 8, 1994, Public Law 103-465, § 532(c)(3), 108 Stat. 4987.)

35 USC § 171 specifies that design patent protection is available for ornamental designs of an article of manufacture. Case law has broadly construed these terms so that they cover, for example, computer GUIs and images projected onto artificial waterfalls. Hence, United States design patent protection is widely available. The section stating that the provisions for patents

for inventions apply to design patents relates to the substantive requirements for patentability, non-obviousness and disclosure, as well as the formal requirements of an inventor's declaration and fee payments.

United States statutory section 35 USC § 41 specifies requirements for maintenance fees. It reads as follows.

35 USC § 41 Patent fees; patent and trademark search systems

... (b) MAINTENANCE FEES. The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

(1) 3 years and 6 months after grant, \$900.

(2) 7 years and 6 months after grant, \$2,300.

(3) 11 years and 6 months after grant, \$3,800. Unless payment of the applicable maintenance fee is received in the United States Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force. (Dec. 8, 2004, Public Law 108-447, sec. 801, 118 Stat. 2809.)

This section specifically excludes design patents from the requirement for maintenance fee payments. As a result, design patents are not subject to maintenance fee payments in order to stay in force until the end of their statutorily defined term.

United States statutory section 35 USC § 41 specifies requirements for confidentiality and publication of United States patent applications. It reads as follows.

35 USC § 122 Confidential status of applications; publication of patent applications

...(2) EXCEPTIONS.

(A) An application shall not be published if that application is

(i) no longer pending;

(ii) subject to a secrecy order under section 181 of this title;

(iii) a provisional application filed under section 111(b) of this title; or

(iv) an application for a design patent filed under chapter 16 of this title.

This section shows that design applications will not be published. That is, a design patent will be published, but a pending or abandoned design application shall not be published. One consequence of this limitation is that competitors are not able to identify their potential infringement of a pending design application. On the other hand, prosecution of design applications is relatively swift, with most design applications issuing within 2 years of filing date (compared with several years on average to issuance of a U.S. utility application).

United States statutory law contains limitations on exporting technical data outside the United States. Those limitations encompass design patents as specified by sections 35 USC § 184, 185, and 186. Those sections, in pertinent part, reads as follows.

35 USC § 184 Filing of application in foreign country

Except when authorized by a license obtained from the Commissioner of Patents, a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner of Patents pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title. The term “application” when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof. The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181. (Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(1), 102 Stat. 1567; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(B)).)

35 USC § 185 Patent barred for filing without license.

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another’s making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and

the patent does not disclose subject matter within the scope of section 181 of this title. (Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(2), 102 Stat. 1568; Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904)

35 USC § 186 Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both. (Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(3), 102 Stat. 1568.)

35 USC § 187 Non-applicability to certain persons.

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

United States law provides one additional remedy for infringement of a design patent, in addition to remedies otherwise available (injunction, damages). This additional remedy is specified in 35 USC § 289 which reads as follows.

35 USC § 289 ADDITIONAL REMEDY FOR INFRINGEMENT OF DESIGN PATENT

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties. Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

This section provides for damages for "any colorable imitation" in addition to actual infringement of the design. While not specifically addressing this point, the recent en banc decision of the Court of Appeals in the Federal Circuit in the *Egyptian Goddess* case, eased the burden for design patentees to prove infringement.

III. REGULATORY LAW - 37 CODE OF FEDERAL REGULATIONS ("CFR")

United States regulatory law regulates the application, examination, and grant of design patents by the United States Patent and Trademark Office (USPTO). The regulations are contained in 37 CFR. However, the USPTO also publishes a procedure manual called the Manual of Patent Examination Procedure (MPEP) which is binding instruction on the examiners and provides guidance to patent applicants. Most of the relevant guidelines for prosecuting design patent applications appear in the MPEP, and therefore we include another section in this paper discussing the relevant MPEP sections after discussing in this section the relevant rules in 37 CFR.

37 CFR §§ 1.151 to 1.157 contain the following rules specifically directed to design patents.

DESIGN PATENTS

§ 1.151 Rules applicable

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

§ 1.152 Design drawings

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article. [53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.153 Title, description and claim, oath or declaration

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63. [24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; para. (b), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.154 Arrangement of application elements in a design application

(a) The elements of the design application, if applicable, should appear in

the following order:

- (1) Design application transmittal form.
 - (2) Fee transmittal form.
 - (3) Application data sheet (see § 1.76).
 - (4) Specification.
 - (5) Drawings or photographs.
 - (6) Executed oath or declaration (see § 1.153(b)).
- (b) The specification should include the following sections in order:
- (1) Preamble, stating the 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 or figures of the drawing.
 - (5) Feature description.
 - (6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type. [24 FR 10332, Dec. 22, 1959, para. (e), 48 FR 2713, Jan. 20, 1983, effective date Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a)(3) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.155 Expedited examination of design applications

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

- (1) The application must include drawings in compliance with § 1.84;
 - (2) The applicant must have conducted a pre-examination search;
- and
- (3) The applicant must file a request for expedited examination including:

- (i) The fee set forth in § 1.17(k); and
- (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section. [47 FR 41277, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b)-(d) amended, paras. (e) and (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

First, rule 1.155 is generally not relevant since design applications are examined and prosecuted relatively promptly. I would not advise requesting expedited examination without the presence of extraordinary business circumstances. Second, the reference in rule 1.153 to rule 1.63 is a reference to the requirement for an inventor declaration having the same requirements as for a utility patent application. Third, the reference in rule 1.152 to rule 1.84 is a reference to the rule specifying formal requirements for a drawing in a utility patent application.

Rule 1.84 contains a great many requirements, and it is reproduced in full below.

§ 1.84 Standards for drawings

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) Black ink. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings;

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at 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.

(b) Photographs.

(1) Black and white. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits

of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) Color photographs. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) Identification of drawings. Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to § 1.121(d). If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet" pursuant to § 1.121(d)(1).

(d) Graphic forms in drawings. Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) Type of paper. Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) Size of paper. All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

- (1) 21.0 cm. by 29.7 cm. (DIN size A4), or
- (2) 21.6 cm. by 27.9 cm. (8 ½ by 11 inches).

(g) Margins. The sheets must not contain frames around the sight (i.e., the usable surface), but should have scan target points (i.e., cross-hairs) printed on two cater-corner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 ½ by 11 inch) drawing

sheets.

(h) Views. The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) Exploded views. Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) Partial views. When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) Sectional views. The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross

section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) Alternate position. A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) Modified forms. Modified forms of construction must be shown in separate views.

(i) Arrangement of views. One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) Front page view. The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

(k) Scale. The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale 1/2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(l) Character of lines, numbers, and letters. All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) Shading. The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of

this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) Numbers, letters, and reference characters.

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least 32 cm (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) Lead lines. Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those

which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) Arrows. Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) Copyright or Mask Work Notice. A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of 32 cm. to 64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 USC § 401) and “*M* John Doe” (17 USC § 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) Numbering of sheets of drawings. The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) Numbering of views.

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation “FIG.” Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation “FIG.” must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) Security markings. Authorized security markings may be placed on the

drawings provided they are outside the sight, preferably centered in the top margin.

(w) Corrections. Any corrections on drawings submitted to the Office must be durable and permanent.

(x) Holes. No holes should be made by applicant in the drawing sheets.

(y) Types of drawings. See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.173(a)(2) for reissue drawings. [24 FR 10332, Dec. 22, 1959; 31 FR 12923, Oct. 4, 1966; 36 FR 9775, May 28, 1971; 43 FR 20464, May 11, 1978; 45 FR 73657, Nov. 6, 1980; paras. (a), (b), (i), (j), and (l) amended, paras. (n), (o), and (p) added, 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989; revised, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (c), (f), (g), and (x) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a)(2)(i), (b), (c) & (g) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), (j), (k), (o), and (x) revised, and para. (y) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2), (e), and (j) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; para. (a)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004; para. (y) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004]

Rule 1.84 is also relevant to design application examination. It reads as follows.

§ 1.85 Corrections to drawings

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; revised, 65 FR 54604,

Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

Rule 1.114 is also relevant to design applications. It reads in relevant part as follows.

§ 1.114 Request for continued examination

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) ... (e) The provisions of this section do not apply to: ... (4) An application for a design patent... [Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000; para. (d) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004].

Pursuant to rule 1.114, the normal procedure for requesting continued examination applicable to utility applications is not applicable to design applications.

Rule 1.211 relates to publication of patent applications. It promulgates the limitation imposed by statute that design applications are not published.

Rule 1.362 relates to payment of maintenance fees. It promulgates the limitation imposed by statute that maintenance fees are not required for design patents.

Rules 1.701 and 1.702 relate to extension to patent term due to delays in the patent being issued by the USPTO. However, design patents are excluded from these forms of patent term extension.

Rule 5.11 refers to the requirement to obtain a license before filing a patent in another country, specifically including design patents in this requirement.

IV. REGULATORY LAW - MPEP CHAPTER 1500 - DESIGN PATENTS

Chapter 1500 of the MPEP is devoted to design patent application examination. Since the MPEP Rev. 5, Aug. 2006 version of this chapter is 62 pages long, we only excerpt pertinent passages in this article. However, most of the procedural limits and requirements imposed on design patent applications appear only in MPEP 1500. We cover those limitations in this section.

MPEP § 1503.01 states the following regarding the title and claim.

The title may be directed to the entire article embodying the design while the claimed design shown in full lines in the drawings may be directed to only a portion of the article. However, the title may not be directed to less than the claimed design shown in full lines in the drawings. A title descriptive of the actual article aids the examiner in developing a complete field of search of the prior art and further aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, and 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 issued. For example, a broad title such as “Adapter Ring” provides little or no information as to the nature and intended use of the article embodying the design. If a broad title is used, the description of the nature and intended use of the design may be incorporated into the preamble. Absent an amendment requesting deletion of the description, it would be printed on any patent that would issue. When a design is embodied in an article having multiple functions or comprises multiple independent parts or articles that interact with each other, the title must clearly define them as a single entity, for example, combined or combination, set, pair, unit assembly. Since 37 CFR § 1.153 requires that the title must designate the particular article, and since the claim must be in formal terms to the “ornamental design for the article (specifying name) as shown, or as shown and described,” the title and claim must correspond. Amendments to the title, whether directed to the article in which the design is embodied or its environment, must have antecedent basis in the original disclosure and may not introduce new matter. *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Inter. 1992). In view of the foregoing, the title should correspond to the article in which the design is embodied.

MPEP § 1503.01 states the following regarding permissible inclusions in the description.

II. DESCRIPTION

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. In *re Freeman*, 23 App. D.C. 226 (App. D.C. 1904). However, while not required, such a description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper. *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm’r Pat. 1919). 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. In addition to the figure descriptions, the following types of statements are permissible in the specification:

(A) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure. Such a description, if provided, must be in the design application as originally filed, and may not be added by way of amendment after the filing of the application as it would be considered new matter.

(B) Description disclaiming portions of the article not shown in the drawing as forming no part of the claimed design.

(C) Statement indicating the purpose of broken lines in the drawing, for example, environmental structure or boundaries that form no part of the design to

be patented.

(D) Description denoting the nature and environmental use of the claimed design, if not included in the preamble pursuant to 37 CFR § 1.154 and MPEP § 1503.01, subsection I. It is the policy of the Office to attempt to resolve questions about the nature and intended use of the claimed design prior to examination by making a telephone inquiry at the time of initial docketing of the application. This will enable the application to be properly classified and docketed to the appropriate examiner and to be searched when the application comes up for examination in its normal course without the need for a rejection under 35 USC § 112 prior to a search of the prior art. Explanation of the nature and intended use of the article may be added to the specification provided it does not constitute new matter. It may alternately, at applicant's option, be submitted in a separate paper without amendment of the specification.

(E) A "characteristic features" statement describing a particular feature of the design that is considered by applicant to be a feature of novelty or non-obviousness over the prior art (37 CFR 1.71(c)).

This type of statement may not serve as a basis for determining patentability by an examiner. In determining the patentability of a design, it is the overall appearance of the claimed design which must be taken into consideration. *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Leslie*, 547 F.2d 116, 192 USPQ 427 (CCPA 1977). Furthermore, the inclusion of such a statement in the specification is at the option of applicant and will not be suggested by the examiner.

In view of the foregoing, it is generally advisable to review the figures and the article of manufacture to which they relate and determine whether to: describe the appearance of portions of the claimed design which are not illustrated in the drawings; disclaimers or portions of the article not shown in the drawings; description of the meaning of any broken lines (whether they illustrate environmental structure or boundaries that form no part of the claimed design); nature and environmental use of the claimed design; and whether to identify a characteristic feature. Obviously, identification of a characteristic feature for purposes of novelty and non obviousness may be detrimental as to scope of protection, patentability, and invalidity and therefore is not generally advisable.

MPEP1503.01 states the following regarding impermissible inclusions in the description.

(A) A disclaimer statement directed to any portion of the claimed design that is shown in solid lines in the drawings is not permitted in the specification of an issued design patent. However, the disclaimer statement may be included in the design application as originally filed to provide antecedent basis for a future amendment. See *Ex parte Remington*, 114 O.G. 761, 1905 C.D. 28 (Comm'r Pat. 1904); *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967).

(B) Statements which describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image of that shown or has a shape and appearance that would be

evident from the one shown, are not permitted in the specification of an issued design patent. However, such statements may be included in the design application as originally filed to provide antecedent basis for a future amendment. In addition, statements which attempt to broaden the scope of the claimed design beyond that which is shown in the drawings are not permitted.

(C) Statements describing matters that are directed to function or are unrelated to the design. In view of the foregoing, any application disclaiming structure shown in the drawings solid lines, describing of unillustrated embodiments of the claimed design, or describing function, will need to be amended prior to allowance.

MPEP § 1503.01 states the following regarding the claim.

III. DESIGN CLAIM

The requirements for utility claims specified in 37 CFR § 1.75 do not apply to design claims. Instead, the form and content of a design claim is set forth in 37 CFR § 1.153:

(a)... The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown or as shown and described. More than one claim is neither required nor permitted.

A design patent application may only include a single claim. 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.” The description of the article in the claim should be consistent in terminology with the title of the invention. See MPEP § 1503.01, subsection I. When the specification includes a proper descriptive statement of the design (see MPEP § 1503.01, subsection II), or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words “and described” must be added to the claim following the term “shown”; i.e., the claim must read “The ornamental design for (the article which embodies the design or to which it is applied) as shown and described.” Full lines in the drawing show the claimed design. Broken lines are used for numerous purposes.

Under some circumstances, broken lines are used to illustrate the claimed design (i.e., stitching and fold lines). Broken lines are not permitted for the purpose of identifying portions of the claimed design which are immaterial or unimportant. See *In re Blum*, 374 F.2d 904, 907, 153 USPQ 177, 180 (CCPA 1967) (there are “no portions of a design which are ‘immaterial’ or ‘not important.’ A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.”). See also MPEP § 1503.02, subsection III.

In view of the foregoing, the design application must contain a single claim using the magic phrase noted above, optionally added "and described" when the specification includes a proper descriptive statement. In view of the foregoing, it is also important to specify in the

description the purpose of broken lines.

MPEP § 1503.02 states the following regarding the drawings.

Every design patent application must include either a drawing or a photograph of the claimed design. As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be clear and complete, and that nothing regarding the design sought to be patented is left to conjecture. When inconsistencies are found among the views, the examiner should object to the drawings and request that the views be made consistent. *Ex parte Asano*, 201 USPQ 315, 317 (Bd. Pat. App. & Inter. 1978); *Hadco Products, Inc. v. Lighting Corp. of America Inc.*, 312 F. Supp. 1173, 1182, 165 USPQ 496, 503 (E.D. Pa.1970), vacated on other grounds, 462 F.2d 1265, 174 USPQ 358 (3d Cir. 1972). When the inconsistencies are of such magnitude that the overall appearance of the design is unclear, the claim should be rejected under 35 USC § 112, first and second paragraphs, as non-enabling and indefinite. See MPEP § 1504.04, subsection I.A.

In view of the foregoing, it is essential the drawing or drawings show the complete design and that the views are consistent with one another. Inconsistencies in the figures may not be correctable and therefore may result in abandonment of the application.

The examiner's form paragraph in this issue is instructive, again from MPEP § 1503.02:

15.48 Necessity for Good Drawings

The necessity for good drawings in a design patent application cannot be overemphasized. As the drawing constitutes the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness, that nothing regarding the design sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity (35 USC § 112, first paragraph). Moreover, an insufficient drawing may have a negative effect with respect to the effective filing date of a continuing application.

MPEP § 1503.02 further states the following regarding the views provided by the drawings.

I. VIEWS

The drawings or photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed, which may include the front, rear, top, bottom and sides. Perspective views are suggested and may be submitted to clearly show the appearance of three dimensional designs. 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. Views that are merely duplicative of other views of the design or that are flat and include no surface ornamentation may be omitted from the drawing if the specification makes this explicitly clear. See MPEP § 1503.01, subsection II. For example, if the left and right sides of a design are identical or a mirror image, a view should be provided of one side and a statement made in the drawing description that the other side is identical or a mirror image. If the design has a flat bottom, a view of the bottom may be omitted if the specification includes a statement that the bottom is flat and devoid of surface ornamentation. The term “unornamented” should not be used to describe visible surfaces which include structure that is clearly not flat. *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 131 USPQ 413 (D. Del. 1961).

Sectional views presented solely for the purpose of showing the internal construction or functional/ mechanical features are unnecessary and may lead to confusion as to the scope of the claimed design. *Ex parte Tucker*, 1901 C.D. 140, 97 O.G. 187 (Comm’r Pat. 1901); *Ex parte Kohler*, 1905 C.D. 192, 116 O.G. 1185 (Comm’r Pat. 1905). Such views should be objected to under 35 USC § 112, second paragraph, and their cancellation should be required. However, where the exact contour or configuration of the exterior surface of a claimed design is not apparent from the views of the drawing, and no attempt is made to illustrate features of internal construction, a sectional view may be included to clarify the shape of said design. *Ex parte Lohman*, 1912 C.D. 336, 184 O.G. 287 (Comm’r Pat. 1912). When a sectional view is added during prosecution, the examiner must determine whether there is antecedent basis in the original disclosure for the material shown in hatching in the sectional view (37 CFR § 1.84(h)(3) and MPEP § 608.02).

In view of the foregoing, views from multiple directions are desirable. However, they need to be entirely consisting to avoid a potentially fatal indefiniteness rejection as noted above. If views from all sides of a 3 dimensional design are not included, the specification should contain an appropriate statement (e.g., the bottom is flat and devoid of surface ornamentation). MPEP1503.02 further states the following regarding surface shading the drawings.

II. SURFACE SHADING

While surface shading is not required under 37 CFR § 1.152, it may be necessary in particular cases to shade the figures to show clearly the character and contour of all surfaces of any 3-dimensional aspects of the design. Surface shading is also necessary to distinguish between any open and solid areas of the article. However, surface shading should not be used on unclaimed subject matter, shown in broken lines, to avoid confusion as to the scope of the claim.

Lack of appropriate surface shading in the drawing as-filed may render the design non-enabling and indefinite under 35 USC. § 112, first and second paragraphs. Additionally, if the surface shape is not evident from the disclosure as filed, the addition of surface shading after filing may comprise new matter. Solid black surface shading is not permitted except when used to represent the

color black as well as color contrast. Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror. Contrast in materials may be shown by using line shading in one area and stippling in another. By using this technique, the claim will broadly cover contrasting surfaces unlimited by colors. The claim would not be limited to specific material either, as long as the appearance of the material does not patentably depart from the visual appearance illustrated in the drawing. In view of the foregoing, surface shading in the application as filed is essential when surface shading is necessary to distinguish between open and closed solid areas or other 3 dimensional contours.

MPEP § 1503.02 further states the following regarding broken lines.

III. BROKEN LINES

The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design. *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof. A boundary line may be shown in broken lines if it is not intended to form part of the claimed design. Applicant may choose to define the bounds of a claimed design with broken lines when the boundary does not exist in reality in the article embodying the design. It would be understood that the claimed design extends to the boundary but does not include the boundary. Where no boundary line is shown in a design application as originally filed, but it is clear from the design specification that the boundary of the claimed design is a straight broken line connecting the ends of existing full lines defining the claimed design, applicant may amend the drawing(s) to add a straight broken line connecting the ends of existing full lines defining the claimed subject matter.

Any broken line boundary other than a straight broken line may constitute new matter prohibited by 35 USC § 132 and 37 CFR § 1.121(f). However, broken lines are not permitted for the purpose of indicating that a portion of an article is of less importance in the design. *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967). Broken lines may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. The use of broken lines indicates that the environmental structure or the portion of the article depicted in broken lines forms no part of the design, and is not to indicate the relative importance of parts of a design. In general, when broken lines are used, they should not intrude upon or cross the showing of the claimed design and should not be of heavier

weight than the lines used in depicting the claimed design. When broken lines cross over the full line showing of the claimed design and are defined as showing environment, it is understood that the surface which lies beneath the broken lines is part of the claimed design. When the broken lines crossing over the design are defined as boundaries, it is understood that the area within the broken lines is not part of the claimed design. Therefore, when broken lines are used which cross over the full line showing of the design, it is critical that the description of the broken lines in the specification explicitly identifies their purpose so that the scope of the claim is clear. As it is possible that broken lines with different purposes may be included in a single application, the description must make a visual distinction between the two purposes; such as --The broken lines immediately adjacent the shaded areas represent the bounds of the claimed design while all other broken lines are directed to environment and are for illustrative purposes only; the broken lines form no part of the claimed design.-- Where a broken line showing of environmental structure must necessarily cross or intrude upon the representation of the claimed design and obscures a clear understanding of the design, such an illustration should be included as a separate figure in addition to the other figures which fully disclose the subject matter of the design. Further, surface shading should not be used on unclaimed subject matter shown in broken lines to avoid confusion as to the scope of the claim.

In view of the foregoing, the most important point is to describe the meaning of each broken line, such as illustrating environment and forming no part of the claimed design, and such as representing bounds of the claimed design.

MPEP § 1503.02 states the following regarding surface treatment.

IV. SURFACE TREATMENT

The ornamental appearance of a design for an article includes its shape and configuration as well as any indicia, contrasting color or materials, graphic representations, or other ornamentation applied to the article (“surface treatment”). Surface treatment must be applied to or embodied in an article of manufacture. Surface treatment, per se (i.e., not applied to or embodied in a specific article of manufacture), is not proper subject matter for a design patent under 35 USC § 171. Surface treatment may either be disclosed with the article to which it is applied or in which it is embodied and must be shown in full lines or in broken lines (if unclaimed) to meet the statutory requirement. See MPEP § 1504.01. The guidelines that apply for disclosing computer-generated icons apply equally to all types of surface treatment. See MPEP § 1504.01(a). A disclosure of surface treatment in a design drawing or photograph will normally be considered as prima facie evidence that the inventor considered the surface treatment shown as an integral part of the claimed design. An amendment canceling two-dimensional surface treatment or reducing it to broken lines will be permitted if it is clear from the application that applicant had possession of the underlying configuration of the basic design without the surface treatment at the time of filing

of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998). Applicant may remove surface treatment shown in a drawing or photograph of a design without such removal being treated as new matter, provided that the surface treatment does not obscure or override the underlying design. The removal of three-dimensional surface treatment that is an integral part of the configuration of the claimed design, for example, removal of beading, grooves, and ribs, will introduce prohibited new matter as the underlying configuration revealed by this amendment would not be apparent in the application as originally filed. See MPEP § 1504.04, subsection II.

In view of the foregoing, it is very important to not include surface treatment of the article, unless it forms part of the claimed design.

MPEP § 1503.02 states the following regarding photographs and color drawings.

V. PHOTOGRAPHS AND COLOR DRAWINGS

Drawings are normally required to be submitted in black ink on white paper. See 37 CFR § 1.84(a)(1). Photographs are acceptable only in applications in which the invention is not capable of being illustrated in an ink drawing or where the invention is shown more clearly in a photograph (e.g., photographs of ornamental effects are acceptable). See also 37 CFR §§ 1.81(c) and 1.83(c), and MPEP § 608.02. Photographs submitted in lieu of ink drawings must comply with 37 CFR 1.84(b). Only one set of black and white photographs is required. Color photographs and color drawings may be submitted in design applications if filed with a petition under 37 CFR § 1.84(a)(2). Petitions to accept color photographs or color drawings will be considered by the Primary Examiners as delegated by the TC Director. A grantable petition under 37 CFR § 1.84(a)(2) must explain that color drawings or color photographs are necessary because color is an integral part of the claimed design. Any other explanation as to why color drawings or color photographs are necessary will normally not be acceptable. A grantable petition must also be accompanied by: (1) the fee set forth in 37 CFR 1.17(h); (2) three sets of the color photographs or color drawings; and (3) an amendment to the specification inserting the following statement --The file of this patent contains at least one drawing/photograph executed in color. Copies of this patent with color drawing(s)/photograph(s) will be provided by the Office upon request and payment of the necessary fee.-- See 37 CFR § 1.84(a)(2)(iii) and MPEP § 608.02.

If the photographs are not of sufficient quality so that all details in the photographs are reproducible, this will form the basis of subsequent objection to the quality of the photographic disclosure. No application will be issued until objections directed to the quality of the photographic disclosure have been resolved and acceptable photographs have been submitted and approved by the examiner. If the details, appearance and shape of all the features and portions of the design are not clearly disclosed in the photographs, this would form the basis of a rejection of the claim under 35 USC § 112, first and second paragraphs, as

non-enabling and indefinite. Photographs and ink drawings must not be combined in a formal submission of the visual disclosure of the claimed design in one application. The introduction of both photographs and ink drawings in a design application would result in a high probability of inconsistencies between corresponding elements on the ink drawings as compared with the photographs.

When filing informal photographs or informal drawings with the original application, a disclaimer included in the specification or on the photographs themselves may be used to disclaim any surface ornamentation, logos, written matter, etc. which form no part of the claimed design. See also MPEP § 1504.04, subsection II. Color photographs and color drawings may be submitted in design applications if filed with a petition under 37 CFR § 1.84(a)(2). Color may also be shown in pen and ink drawings by lining the surfaces of the design for color in accordance with the symbols in MPEP § 608.02. If the formal drawing in an application is lined for color, the following statement should be inserted in the specification for clarity and to avoid possible confusion that the lining may be surface treatment --The drawing is lined for color.-- However, lining a surface for color may interfere with a clear showing of the design as required by 35 USC § 112, first paragraph, as surface shading cannot be used to define the contours of the design. If color photographs or color drawings are filed with the original application, color will be considered an integral part of the disclosed and claimed design. The omission of color in later filed formal photographs or drawings will be permitted if it is clear from the application that applicant had possession of the underlying configuration of the basic design without the color at the time of filing of the application. See *In re Daniels*, 144 F.3d 1452, 1456-57, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998) and MPEP § 1504.04, subsection II. Note also 37 CFR § 1.152, which requires that the disclosure in formal photographs be limited to the design for the article claimed.

In view of the foregoing, filing of photographs and color drawings raises procedural complications that are generally not necessary and should be avoided, if feasible. It is also inadvisable to file an application with photographs constituting informal drawings, since it is not certain that drawings may be filed based upon those photographs without constituting improper new matter. However, if a design application is filed with photographs constituting informal drawings, it is critical that the application as filed include a disclaimer of surface ornamentation.

The remainder of MPEP chapter 1500 deals with examination of the application for compliance with the statutory requirements of novelty, ornamentality, definiteness and non-obviousness.

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