DESIGN PATENT PERSPECTIVE:
The Design Patent Application
PART 1

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An average of just over four hundred new design patents issue every Tuesday. Each one has an electronic image file wrapper publicly available through the Patent Application Information Retrieval (PAIR) system at uspto.gov.

If you peruse the application papers in these file wrappers, you will notice there is not one standard way to apply for a design patent. Different applications often contain different types of forms and other documents, and similar documents in different file wrappers may contain different information, or may not be worded the same.

You also will notice there are quite a few mistakes being made in the applications. Some of these mistakes are without serious consequence and are often corrected by examiner's amendment in the notice of allowance. Other mistakes do not affect the substance of the patent claim, but result in increased delay and expense in the prosecution process. Unfortunately, other mistakes can affect the substance of the patent claim – and often in ways not so readily apparent. After the new Leahy-Smith America Invents Act becomes fully effective, the consequences of some of these common design patent application mistakes may become severe.

What are these mistakes and how can they be avoided? What is the best way to apply for a design patent? And what information in a design patent application is required, what is optional, and what information is recommended, and why? This article begins a series on design patent applications and the prosecution process where these questions will be addressed and other issues will be explored.

Let's start with the information that is absolutely necessary for a design patent application. 35 U.S.C. § 171 provides that a design patent may be obtained for any new, original, and ornamental design for an article of manufacture subject to various other conditions and requirements in Title 35. This section also states [t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided. Two such provisions in 35 U.S.C. § 112 are that a patent specification must clearly and completely describe the invention and must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter.

Various sections of the Code of Federal Regulations (CFR) are applicable to patent applications generally and expand upon the statutory requirements. 37 CFR 1.51 provides that a complete nonprovisional application comprises (1) a specification as prescribed by 35 U.S.C. 112, including a claim or claims, (2) an oath or declaration, (3) drawings, when necessary, and (4) the prescribed filing fee, search fee, examination fee, and application size fee.[1] 37 CFR 1.74 provides that "[w]hen there are drawings, there shall be a brief description of the several views of the drawings …."

Two additional regulations specifically apply to design patents. 37 CFR 1.152 states in relevant part [t]he 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. 37 CFR 1.153 states: (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 [and] (b) [t]he oath or declaration required of the applicant must comply with § 1.63."

So in sum, the only items that are *absolutely necessary* to file a design patent application are: (1) a title; (2) specification with reference to the drawing(s), brief description of the drawing[s], and one claim; (3) drawing(s) that comply with the requirements of § 1.84; (4) an oath or declaration that complies with the requirements of § 1.63; and (5) appropriate fees.

Before discussing these requirements, two other preliminary matters should be mentioned. First, not all these requirements must be satisfied to receive an application number and filing date from the USPTO. Any papers received by the USPTO that purport to be a patent application will be assigned an application number for identification purposes.[2] Further, an application will receive a filing date when an adequate specification with claim and any required drawing are filed in the USPTO.[3] Required fees and an oath or declaration may be filed later within a given period of time and with payment of any required surcharge.[4]

Second, many design patent applications follow, at least in part, the arrangement mentioned in 37 CFR 1.154 §§ (a) and (b). Section (a) provides "[t]he 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))." Note that the only absolutely required elements in this list are the specification, drawings or photographs, and executed oath or declaration.

Section (b) provides "[t]he 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." Note that the only absolutely required elements in this list are the description of figure or figures in the drawing and a single claim. The optional elements in the above lists will be discussed in later parts of this series.

So let's begin with a discussion of the **Title**. The title of a design is of "great importance" in a design application because it "serves to identify the article in which the design is embodied by the name generally used by the public."[5] It should be short, specific, and descriptive,[6] and should not use brand names or marketing terms.[7] The title may identify the entire article even though only a portion is claimed, or it may identify the portion of the article embodying the design.[8] The title may not be directed to less than the claimed design.[9]

The MPEP describes four purposes of a properly descriptive title: (1) to aid "the examiner in developing a complete field of search of the prior art"; (2) to aid "in the proper assignment of new applications to the appropriate class, subclass, and patent examiner"; (3) to aid in "the proper classification of the patent upon allowance of the application"; and (4) to help "the public in understanding the nature and use of the article embodying the design after the patent has issued."[10]

Although the title must be descriptive, it does not define the scope of the claim.[11] This is because the title may describe the entire article even though only a portion of the article is claimed. For example, if the title says "Drill bit" and only the shank of the drill bit is claimed, then the scope of the claim is the shank and not the entire drill bit.[12]

The title must correspond with both the claim and the figure descriptions.[13] If it does not, an objection will be made and the title or specification must be amended to provide complete consistency. A title may contain open-ended language such as "or the like" and "or similar article" when referring to *environment*, but not when referring to the claimed design.[14] When an article has multiple functions or multiple independent parts that relate or interact with each other, the title must define them as a single entity by use of such terms as set, combination, or pair.[15] If it is necessary to amend the title, the amendments must not introduce new matter.[16] Finally, the title should appear as a heading on the first page of the specification unless it is supplied in an application data sheet under 37 CFR 1.76.[17]

The following are ten recent examples of title mistakes with their corrections and explanations for why the original titles were changed:

- *Par36 Lamp* changed to **Lamp** – changed to a name generally known and used by the public;
- *Palette Knife and Painting Tool* changed to **Palette Knife** – changed because the second phrase was considered redundant and unnecessary since it merely adds a more general description of the first part of the title;
- *Lite Panel* changed to **Light Panel** – changed because it was too confusing;
- *Portable Heat Welding Machine* [title] and *Portable Heat Welding Machine Housing* [claim and drawing descriptions] changed to **Portable Heat Welding Machine** – changed to eliminate inconsistency between title, claim, and drawing descriptions;
- *Combined Weighing Instrument* changed to **Display Device with Graphical User Interface for a Combined Weighing Instrument** – changed because it was too ambiguous and indefinite for the examiner to make a proper search;
- *Temporary Transfer Tattoo* [in figure descriptions] and *Areolar Tattoo* [in declaration and claim] changed to **Temporary Transfer Sheet for an Aerolar Tattoo** – changed for consistency and because the title did not describe the article of manufacture in which the claimed design is embodied;
- *Helmet Padding System* changed to **Helmet Pad** – changed because "system" is not an article of manufacture;
- *Display Screen with User Interface* changed to **Display Screen with Graphical User Interface** – changed to designate the particular article so the claim will be directed to the ornamental design for the article;
- *Exhaust Ventilator* changed to **Roof Exhaust Ventilator** – changed to correspond with the drawing description; and
- *Lighting Fixtures* changed to **Lighting Fixture** – changed to reflect a single article of manufacture.

In future columns we will consider other aspects of the design patent application, including the inventor's oath or declaration and their new requirements in the America Invents Act, the specification including drawing descriptions and claim, the drawings, and other elements as well. A special focus will be on drawing mistakes, how to avoid them, and how to potentially correct them without introducing new matter. In the past a relatively simple fix has been to convert any non-enabled portion of the claimed design to broken lines. We will consider the potential trouble this may cause for validity and enforcement in litigation proceedings and what other prosecution options may be available.

Finally, there is the important question of how the disclosure provisions in section 102(b) of the America Invents Act will impact design patent practice. This section provides, in general, that disclosures made one year or less before the effective filing date are not prior art if (A) the disclosure was made by the inventor or by another who obtained the subject matter from the inventor, or (B) a third party disclosure was made after the subject matter had been disclosed by the inventor or by another who obtained the subject matter from the inventor.

There will be many interpretation issues under new section 102(b).[18] For example, to what extent must a disclosure fully enable the eventual design patent to qualify as an inventor disclosure under (A) or a blocking disclosure under (B)?[19] This is a very important question in design patent practice because design patent drawing standards are exacting and often violated. Indeed, the electronic file wrappers of issued design patents reveal many examples of drawings that do not enable the desired design claim – and these drawings typically were submitted after being reviewed and modified by a patent agent or patent lawyer. Given this error rate, design drawings that may be publicly disclosed by inventors prior to legal review likely will fail to enable desired claims to an even greater degree.

The enablement issue raises other important questions. What is the result if the designer inventor discloses a non-enabling design, a third party copies the design and makes changes to enable it, and then the third party discloses the enabled design - and both parties file for a design patent? Who is the inventor, what is considered prior art for anticipation and obviousness purposes, and can the non-enabled disclosure block the enabled one? Since we are within the one-year period of when the AIA fully implements (on March 16, 2013), these are the type of questions that designer inventors and their competitors should consider now. If 102(b) disclosures must be fully enabling to be effective, then it becomes critically important to properly prepare the design drawing disclosures - a topic we will take up in next month's column.

ENDNOTES

1. *See* 37 CFR 1.51.
2. *See* 37 CFR 1.53.
3. *Id.*
4. *See* 37 CFR 1.53 (f).
5. See *In re Zahn*, 617 F.2d 261, 265 (CCPA 1980); *see also* MPEP 1503.01 (I.), page 1500-3.
6. *See* 37 C.F.R. 1.72 ("The title of the invention may not exceed 500 characters in length and must be as short and specific as possible.").
7. *See A Guide to Filing a Design Patent Application*, page 3, available at USPTO.gov.
8. *See* MPEP 1503.01 (I.), page 1500-3.
9. *Id.*
10. *Id.*
11. *Id.*
12. *See In re Zahn*, 617 F.2d 261 (CCPA 1980).
13. *Id.*
14. *Id.* at 1500-4.
15. *Id.* at 1500-3.
16. *Id.* at 1500-4.
17. *See* 37 CFR 1.72(a).
18. *See generally*, Donald S. Chisum, *America Invents Act of 2011: Analysis and Cross-References*, 19-23 (Dec. 5, 2011) (available at http://www.chisum.com/wp-content/uploads/AIAOverview.pdf)
19. *See* Harold C. Wegner, *Patent Practice under the Leahy Smith America Invents Act*, pages 63-70 (quoting the statement of Senator Hatch that "[T]he important point is that if an inventor's disclosure triggers the [prior art] bar with respect to an invention, which can only be done by a disclosure that is both made available to the public and enabled, then he or she has thereby also triggered the grace period…. If a disclosure resulting from the inventor's actions is not one that is enabled, or is not made available to the public, then such a disclosure would not constitute patent-defeating prior art [ ] in the first place.") (emphasis added).