

# General Information on United States Design Patents

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(fees are current as of 15 April 2006)

## 1. What does a design patent cover?

*“The design for an article consists of the visual characteristics or aspect displayed by the article. It is the appearance presented by the article which creates an impression through the eye upon the mind of the observer.”*

USPTO Manual of Patent Examining Procedure § 1502

A design patent does not cover any functional mechanical, electrical or chemical aspects of an article, machine or composition of matter.

### IMPORTANT

**The design must meet the general requirements of novelty and non-obviousness in order to issue as a granted design patent. In the United States, obtaining a design patent is not just a registration process, but the application is carefully examined for patentability just like any other utility patent application.**

## 2. What are the government fees associated with a design patent?

There are three filing/processing fees required to file a design patent application:

	Large Entity*	Small Entity*
Filing Fee	\$200	\$100
Search Fee	\$100	\$50
Examination Fee	\$130	\$65
Total	\$430	\$215

If the application is patentable, either as filed or as the consequence of being amended, the fee to issue the patent is:

	Large Entity*	Small Entity*
Issue Fee	\$800	\$400

Issued design patents have **no** after-issue maintenance fee, annuity or tax, as there is for utility patents.

\*A “Large Entity” is a business entity that has more than 500 employees and a “Small Entity” has less than 500 employees.

## 3. What is the process for obtaining a Design Patent?

The first step is filing a design patent application with the USPTO. The application includes one or more drawings showing the ornamental features of the design. Not all of physical features of an article need to be considered as part of the claimed ornamental design. Those features of the drawing that show ornamental aspects of the designs that the applicant wishes to claim as his invention are drawn in solid lines and those aspect that are **not** part of the claimed design are drawn in broken lines.

The application will be reviewed by a patent examiner. If the examiner thinks the design as shown is patentable, a Notice of Allowance will be mailed to the applicant. If the examiner doesn't think the design is patentable, he will mail a letter called an Office Action, which will describe in detail the reasons that support his belief that the design is not patentable. The applicant, through his attorney of record will respond to the objections raised by the Examiner.

If the Examiner is not persuaded by the Applicant's arguments, a final rejection will be issued. The Applicant then may appeal to an internal administrative USPTO appeal board and ultimately file a court action in a United States Federal Court. Other options may be available.

**Please note that there is no pre-issuance publication of design patent applications.**

#### **4. What are the legal fees for obtaining a Design Patent?**

Typical charges are \$1000.00 for preparing and filing a design patent. This does not cover government filing fees (see paragraph 2 above) or costs of third party draftsmen to prepare formal drawing necessary for the design patent application.

Additional legal fees will likely be incurred in order to respond to office actions from USPTO and preparing papers for issuance of the patent (assuming the patent will ultimately be placed in condition for allowance).

The time to respond to Office Actions will be billed at the then current hourly charge (\$250/hr as of the date of this notice). Because each application and each Office Action present unique legal issues, there is no way to determine ahead of time the costs to respond to an Office Action. After having received each Office Action, the client will be informed of the maximum charge to respond to that particular Office Action and will only proceed after having been authorized to do so by the Client. The actual costs to respond may be less than the maximum provided, but regardless of the time it takes, the Client will not be charged more than the maximum charge provided.

There is fixed fee of \$500.00 to prepare an allowed application for issuance (does not include government issue fees).

Please note that the fees cited in this paragraph are for design patent applications submitted with standard drawings. If the inventive design needs to be represented by color or by photographs (see paragraph 8 below), then a specific quote for legal fees will be submitted for Client's approval before work begins.

#### **5. Are there other legal or administrative fees?**

If communications can be handled via e-mail, then there generally isn't any additional charges for communication. If faxes are required, particularly to recipients outside of the United States, then actual costs for the long distance phone call will be charged, but there is no standard per page facsimile transmission charge.

There is no charge for simply handling and/or processing incoming communications.

There is no charge for routine mailings. However, if overnight or overseas delivery is required, the client will be billed only for the actual cost of the service. Such overnight/overseas delivery can be charged to Client's courier account number if the clients wishes to provide us with that information.

## **6. How long will it take for the design patent to issue?**

As of August 2005, the design patent examination group in the USPTO is taking 12 months to send the first office action. A sampling of the design patents that issued on 02 August 2005 indicated that the shortest period between filing and issuance was 12 months and the longest time was 2 years 5 months.

Each application is unique and there is no way to predict how long any particular application will take to process. **Because each design patent is carefully examined and compared to existing prior art design, there is no way to determine ahead of time if any particular application will be granted.**

## **7. What documents or information is needed from the inventor or applicant to file a design patent application?**

Inventors will need to sign a declaration and a power of attorney. In addition, drawings, which the meet the formal requirement of the United States Patent and Trademark Office will need to be filed along with the application.

Because the drawings in a design patent are the critical part of the application, it is recommended that we arrange for the drawings to be prepared by a professional third party draftsman. Ideally, the Client would provide actual samples of the product containing the design, if practicable, or detailed photographs can be used as the basis for generating the drawings. Sometimes computer CAD files can be used by the patent draftsman to prepare the drawings.

## **8. Can the design be represented by photographs?**

*“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).”* MPEP 1500-10.

*“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.”* MPEP § 1503.02.

Color photographs should only be used if color is an integral part of the design. Color photographs can only be used after a petition has been filed and granted by the USPTO. The charges to prepare and file a petition to use colored photographs is not covered in the standard design patent preparation and filing fee discussed in paragraph 3.

In ink drawings, only the ornamental aspects that are being claimed as the patentable design are drawn in solid lines. Other parts of the product, which might not contain patentable ornamentation, are drawn in dashed lines. Such distinction is not possible with photographs.

In a photograph, everything shown in the photograph is considered to be claimed subject matter, which may result in a weaker patent.

## 9. Additional Information

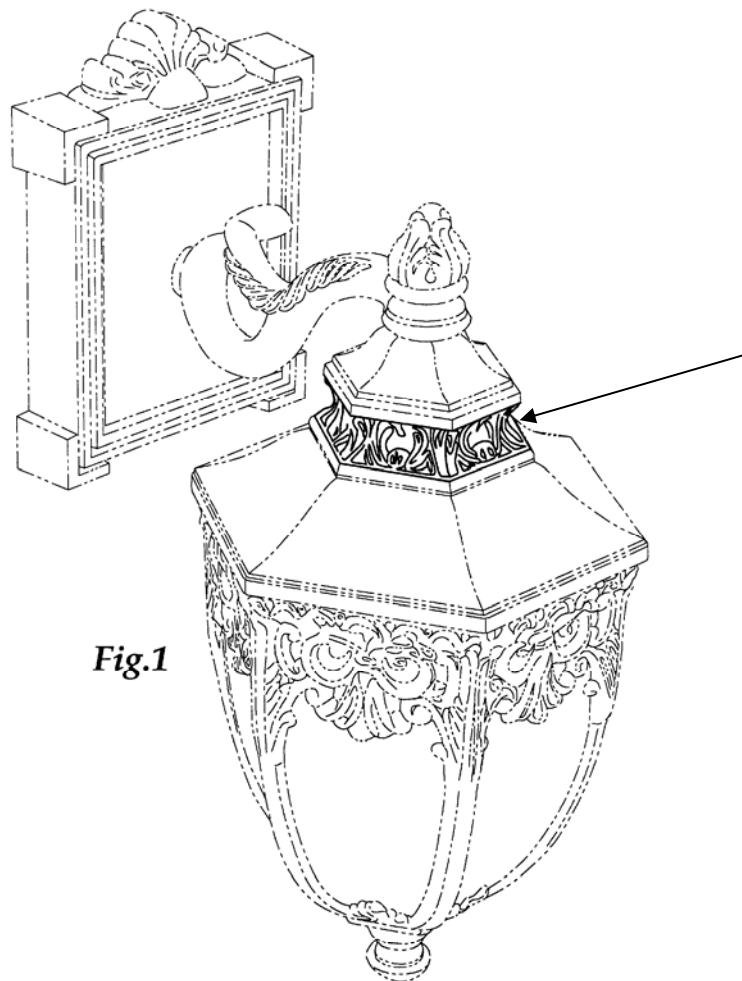
You may find the following information from the United States Patent and Trademark Office to be useful:

<http://www.uspto.gov/web/offices/pac/design/definition.html#title>

## 10. Example Design Patent Drawing

The drawing below shows most of the lamp in broken line form. It is only the small band near the top of the hanging portion that is being claimed in this design patent and is therefor drawn in solid lines. The arrow points to the claimed portion of the drawing.

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## **11. Other Considerations**

Ornamental aspects of any article of manufacture should always be evaluated in light of possible overlap with other intellectual property rights such as copyright, trade dress, and utility patents. The overlap of these various intellectual property rights can be complicated and should be evaluated and discussed carefully.