Protection of Industrial Designs

U.S. Design Patents

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Protection of Industrial Designs

**U.S. Design Patents**

**Industrial Designs, Designs, Design Patents**

The property protected is the appearance of the article.

35 U.S.C. § 171
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The Statute:

35 U.S.C. § 171

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.

35 U.S.C. §§ 184, 189, 196
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Scope of Protection:

(1) Surface ornamentation applied to an article

(2) Configuration embodied in an article

(3) Configuration and Surface ornamentation for an article

35 U.S.C. § 171
Scope of Protection:

The scope of protection may be directed to less than the entire article.

35 U.S.C. § 112
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Separated parts may be displayed as part of the whole design.

**Article**

**Scope**

Tea Pot with Insert

assembled

exploded

35 U.S.C. § 112
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Alternative positions may be included in the claim.

Article

Scope

Infringement

Coffee Machine

**FIG. 1**

*alternate position*

**FIG. 23**

35 U.S.C. § 112
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Portions shown separately along with the whole do not get separate protection.

Coffee Machine

Portion of the Coffee machine

Portion of the Coffee machine

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Separate patents can be used to receive protection for separate portions.

Trash Container

Combined dust pan and trash container lid

35 U.S.C. § 112
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**U.S. Design Patents**

Variants of a design may be included in the same patent when the differences are minor.

35 U.S.C. § 112
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**U.S. Design Patents**

Variants of a design may be included in the same patent when they are basically the same, and when the differences are “obvious” in view of prior art of record.

Combined wine bottle holder and wine decanting stand

35 U.S.C. § 112
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**U.S. Design Patents**

Variants of a design may be included in the same patent when they are basically the same and when the differences are “obvious” in view of prior art of record.

35 U.S.C. § 112
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**U.S. Design Patents**

Variants of a design may be included in the same patent when the differences are “obvious” in view of case law.

Exact proportioning involves only ordinary skill.

*In re Stevens*, 81 USPQ 362 (CCPA 1949)

35 U.S.C. § 112
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**U.S. Design Patents**

Separate patents covering variants of a design provides thorough protection. Each design is considered “patentably distinct.”

35 U.S.C. § 112
A design is not protected for features that are present for functional reasons only.

In construing the claimed design, this court first notes that only “the non-functional aspects of an ornamental design as shown in a patent” are proper bases for design patent protection.


35 U.S.C. § 112
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There is an additional remedy for infringement of design patents, which is not available to other types of patents.

For all U.S. patent infringers, the infringer is liable for:

"... damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, ..." 35 U.S.C. 284

For design patents the infringer:

“... shall be liable to the owner to the extent of his total profit, ...” 35 U.S.C. 289

35 U.S.C. §§ 184, 189, 196
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**U.S. Design Patents**

**Classification**

- The US classifies all designs in 33 classes: **D1** to **D99**, and innumerable subclasses.

- Every patent has at least one original classification (**OR**) and possibly cross references (**XRs**)


- If in doubt, use definitions...
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**Classification Systems**

- **US Design Classification:**
  
  e.g.: **D12/550**

- **Locarno (Internat’l Designs):**
  
  e.g.: **12-15**

- **IPC (Internat’l Utility Classes):**
  
  e.g.: **B60B**
When applying for a design patent...

What Does the Applicant Submit?
Applying for a Design Patent

"Design Patent"

Download and fill out a PTO/SB 18 "Design Patent Application Transmittal"
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Drawings:

- Show all parts of the design you claim
- Perspective is helpful
- Show parts not claimed with broken lines

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Applying for a Design Patent

Fig. 4

Fig. 6

Fig. 5
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Applying for a Design Patent

Fig. 7
Applying for a Design Patent

**Specification:**
- Describe each figure
- Describe broken lines
- Include claim

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1
2
3 Hon. Commissioner for Patents
4 Mail Stop: Designs
5 P.O. Box 1450
6 Alexandria, VA 22313-1450
7
8
9 Dear Sir:
10
11 Be it known that I, Carlos E. Puerto, citizen of the United States of America, have invented a new original and ornamental design for a HELMET BAR B QUE of which the following is a specification, reference being had to the accompanying drawing, forming a part thereof, wherein:
12
13 Figure 1 is a top plan view of a helmet bar b que;
14 Figure 2 is a right elevational view thereof;
15 Figure 3 is a bottom elevational view thereof;
16 Figure 4 is a front elevational view thereof;
17 Figure 5 a left elevational view thereof;
18 Figure 6 a rear elevational view thereof; and
19 Figure 7 is an isometric view thereof, showing my design.
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Applying for a Design Patent

1 The broken lines are for environmental purposes only and
2 form no part of the claimed design. The design shown is not to be
3 limited to any particular size and may be scaled larger or smaller.
4
5 **I Claim:**
6 The ornamental design for a helmet bar b que as shown and
7 described.
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Applying for a Design Patent

**Declaration:**

- **Required**
- **Form** AIA/01 or AIA/02
- **No corrections permitted after filing**
### Electronic Acknowledgement Receipt

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<td>Confirmation Number:</td>
<td>4505</td>
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<td>Title of Invention:</td>
<td>HELMET BAR &amp; DUE</td>
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<tr>
<td>First Named Inventor/Applicant Name:</td>
<td>Carlos E. Pando</td>
</tr>
<tr>
<td>Customer Number:</td>
<td>59110</td>
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<td>Albert Bodas</td>
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- Submitted with Payment: yes
- Payment was successfully received in RAM: $2718
- RAM confirmation Number: 585
- Deposit Account:  

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**Applying for a Design Patent**

**USE EFS (Electronic Filing System)**

**USPTO.gov**

http://www.uspto.gov/ebc/index.html
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**Rob’s Rules for Effective Design Applications**

Any legal opinions expressed in this presentation do not necessarily represent USPTO policy. Attendees are reminded that the discussions in this event are not a substitute for formal legal training, and that they are not being educated as to what the law is and how it should be applied.
GOLDEN RULE

A picture really is worth a thousand words.

Spend as much time and care on the design drawings and specification as you would on a similar utility application.
Disclosure

Photographs & CAD Drawings are permitted but reproduction may be problematic; ink drawings are best.
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MULTIPLE EMBODIMENTS

Make sure subsequent embodiments are fully disclosed with drawings...:
MULTIPLE EMBODIMENTS

Make sure subsequent embodiments are fully disclosed

...or description in the specification:
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**TITLES**

Make sure titles are directed to the article of manufacture in which the design is embodied.

The title does not establish the scope of the claim.
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The title does not establish the scope of the claim so no need to be coy or overly generic.

**Bad Title:**  ADAPTER

**Good title:**  ADAPTER RING FOR TOILET PRESSURE VALVE
Rob’s Rules for Effective Design Applications

Don’t send all your utility references; cite prior art with similar appearances only.

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CITATION OF PRIOR ART

EXAMPLE OF PRIOR ART

Don’t send all your utility references; cite prior art with similar appearances only.
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Rob's Rules for Effective Design Applications

CITATION OF PRIOR ART

Many citations do not help your case and will annoy the examiner.
CITATION OF PRIOR ART

Limit your citations to scope similar to the claim. If it’s to a gunstock, don’t cite scopes, barrels, bullets, pistols, slingshots, etc.

Rob’s Rules for Effective Design Applications

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US D685,873 S
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** CITATION OF PRIOR ART **

Limit your citations to scope similar to the claim. If it’s to a gunstock, don’t cite scopes, barrels, bullets, pistols, slingshots, etc.
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When attempting to overcome a rejection on art by broadening the claim, use existing edges to define new claim boundaries.
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**Written Description Requirement of 35 USC 112A**

**In re Owens,**
106 USPQ2d 1248 (CAFC 2013)
...the question for written description purposes is whether a skilled artisan would recognize upon reading the parent's disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.

*In re Owens*, 106 USPQ2d 1248 (CAFC 2013)
It does not Follow...that an applicant, having been granted a claim to a particular design element, may proceed to subdivide that element in subsequent continuations however he pleases.

*In re Owens*, 106 USPQ2d 1248 (CAFC 2013)
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**U.S. Design Patents**

- **Certificates of Correction**
- **CPAs**

(**RCEs** are not available for Design Patents)
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