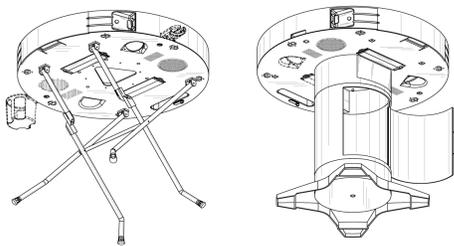


Issue 1: More than one design

One of the most common reasons design patent applications are rejected is the disclosure of more than one design. In such cases the USPTO will issue a “restriction requirement”, limiting the application to one design. Responding to a restriction requirement is usually not a problem. In some cases examiners can be convinced that the two embodiments are similar enough to not be distinct and thus allowable in one application. In most cases, however, election of one design is required. The non-elected design can be patented in a divisional patent application.



Example 1: Designs that were subject to restriction.

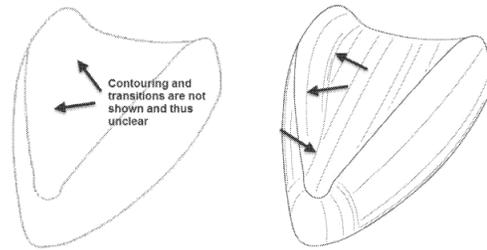
Best Practice: Review the design closely for common elements. If possible, claim only the common element and not the entire object. For example: If a set of grill utensils all have a common and novel handle, claim only the handle and show remaining portions of the utensil in broken lines. Explain in the description which part of the design is claimed and which is not.

Issue 2: Insufficient Disclosure

A US design patent must show the claimed object in enough detail to create an exact copy based on just the drawings. If a design is rejected for being unclear an applicant usually has two options:

1. Disclaim the unclear portions of the design by converting them to broken lines. This works, if only a detail is unclear which can be omitted (e.g. the depth of a hole; the hole itself can then be disclaimed).
2. If the entire design is unclear a “Continuation in Part” application may be required to intro-

duce new matter, yet keep the priority date to not face a rejection over the existing application.



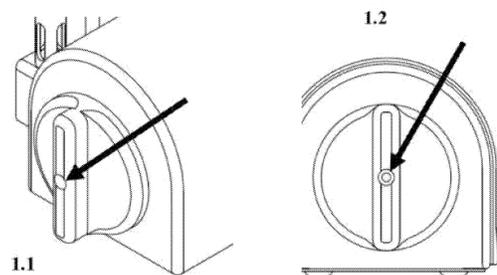
Example 2: Lack of disclosure due to missing surface shading.

Example of a catch-22 problem: The original drawing (left) was rejected for being indefinite since the surface was not clearly defined. The amended drawing (right) was rejected for introducing new matter.

Best Practice: File applications with detailed shading to show surfaces. Include six views, one plan view of each side and additional perspective views. Each side should be in a perspective view. Realistic computer renderings or photos will work, but ensure that surfaces are neither too light nor too dark which could prevent the shape to be recognizable. Formal line drawings with straight line shading are ideal (which requires a skilled drafts-person to get right). In original US design patent applications we sometimes file an “Appendix to the specification” with additional photos, computer rendering etc. to reduce any possible risk of facing future “new matter” rejections.

Issue 3: Inconsistent Drawings

Whenever different views of a design are prepared separately it can occur that the drawings become inconsistent.



Example 3: Inconsistent drawings

Luckily, correction of inconsistencies usually does not present new matter problems. The best practice to avoid inconsistencies in the first place is to base design patent drawings on a 3D model or photos of an actual prototype – which should guarantee consistency between views.

Issue 4: Poor Quality of Drawings



Example 4: Poor quality

The USPTO is very stringent in regards to the quality of design patent drawings. This design was rejected because the “overall image quality is poor and excessively dark”. The examiner described the images as “pixelated, blurred, rough, and poorly lit”.

Best Practice: Zoom into the drawings and make sure lines appear smooth even at 4x level. Make sure the light source in CAD renderings is not too focused as to create harsh shadows that obfuscate the shape of the object. Graphics should use the available space on an A4 page at 300 dpi.

Issue 5: Undelivered Mail

Our review of Hague applications indicates that in quite a few cases the USPTO was unable to reach international applicants and letters were returned undelivered. In such cases the applicant may not even be aware that they missed a deadline and lost their application. It does not help that the USPTO uses US-style addressing (Basel, CH-4010 instead of CH-4010 Basel).

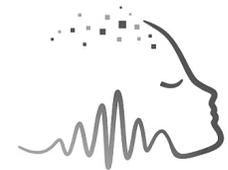


Best Practice: Monitor the US application for office actions and do not trust that you will receive pa-

per communication. At Smartpat we use a proprietary tool to monitor USPTO files automatically. File a power of attorney and make sure the USPTO communicates directly with the US practitioner if the application is rejected for any reason.

Issue 6: Claiming Logos or Icons

In some instances, applicants attempt to obtain a patent for a graphics design such as a logo or an icon. Unfortunately, those attempts are doomed to fail. 35 U.S.C. §171 states that whoever invents any new, original, and ornamental design *for an article of manufacture* may obtain a patent therefore. The design of an icon or a logo by itself is thus not patentable. The same design applied to a physical object such as a shirt, a greeting card, or even an electronic display screen would be patentable.



General Practice Rules

1. When amending drawings: Don't just remove features – convert them to broken line instead.
2. Take the USPTO seriously when the Office Action states that a response must be submitted by a US practitioner – or risk abandonment.
3. The USPTO does not allow CPA of an international design application. File a continuation or continuation in part instead.
4. Keep the Hague numbering (1.1, 1.2, ...) instead of following the US standard (Fig. 1, Fig. 2, ...). Don't use “FIG.” in the drawings.
5. If in doubt: Call the examiner to get things moving forward.

Questions?

This practice tip was prepared by Axel Nix. Since 2012, Smartpat has obtained more design patents for small entity clients in DE, AT and CH than any other US firm. Please call or email if you have any question.

