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PATENT APPLICATION SERVICES

Filing U.S. Design Patent Application

This newsletter provides an overview of important aspects of U.S. design patent applications. U.S. design patents represent a peculiar form of intellectual property protection. Unlike utility patents, there is no prerequisite of a useful function. Unlike copyright rights, in an infringement action there is no defence of independent creation. Finally, unlike trade dress rights (distinguishing guise in Canada), there is no issue of secondary meaning. Nevertheless, as with other types of patents, the owner of a design patent is entitled to prevent others from making, using, offering for sale, selling, or importing products that contain the patented design. Because design patents occupy such a peculiar niche in intellectual property law, they provide the opportunity for catastrophic mistakes by the unwary.

The U.S. Patent Office will issue a design patent for any "new, original and ornamental design for an article of manufacture," and the range of articles that patented designs cover is almost limitless. A fashion or luxury goods company, whose customers purchase products in large part because of their designs, will realize the greatest value of a design, and will benefit most from design patents. An applicant must be aware that although the design is for an article of manufacture, the subject matter that will be claimed is not the article itself. As the Manual of Patent Examining Procedure ("MPEP") emphasizes, "in general terms, a 'utility patent' protects the way an article is used and works (35 U.S.C. 101), while a 'design patent' protects the way an article looks (35 U. S.C. 171)." Thus, whereas a ring and a watch are functional, and utility patents may cover their functions, many of the features that distinguish them from other rings and watches typically are not functional. These aspects may be covered by design patents.

The MPEP's noting of the distinction between the two types of patents is not gratuitous. It underscores the fact that there are significant differences in the statutory, regulatory, and administrative frameworks under which the U.S. Patent Office reviews and analyzes claims for these different types of intellectual property rights. In fact, there are at least twelve differences between prosecution of applications for design patents and prosecution of utility applications.

1. A design patents contain only one claim, which, by definition, must be an independent claim.

2. The words in the claim of a design patent may only refer to a figure. For example, a claim may be worded: "The ornamental design for [the product] as shown."

3. While utility patents are in force for twenty years from their earliest effective filing date, design patents expire fourteen years after issuance.

4. No maintenance fees are required to be paid during the life of a design patent. In contrast, maintenance fees must be paid three times during the life of a utility patent.

5. Design patents are less expensive to file than utility patents.

6. Design patent applicants may not make use of the Patent Cooperation Treaty.

7. Design patents may claim priority to a foreign application in a country that subscribes to the Paris convention only if the U.S. design patent application is filed within six months of the foreign application. In contrast, this period is one year for utility patents.

8. Design patent applications cannot make use of the Request for Continued Examination procedure, while utility patent applicants can.

9. Design patent applicants can make use of the Continued Prosecution Application procedure, while utility patent applicants cannot.

10. Examiners of design patent applications have no discretion as whether to issue a restriction requirement, while examiners of utility patent applications do have discretion.

11. Design patent applicants cannot claim priority to provisional applications, while utility patent applicants can.

12. There is no pre-issuance publication of design patent applications, while there is pre-issue publication of utility patent applications.

The applicant for a design patent must be aware of the fact that unlike a utility application, where broad claims as well as the narrow claims specifically tailored to the commercial embodiment are simultaneously prosecuted, this is not usually possible in a design patent application. Instead, different applications, including continuation or divisional applications, may be necessary. Therefore, when a design contains a combination of a number of elements, the applicant must also consider which permutations of elements will provide the necessary coverage, while remaining patentable over the prior art. The latter point may prove particularly difficult given that most prior art searching techniques involve using words and phrases. With this knowledge, the applicant must decide how to work within the U.S. Patent Office procedures to maximize the scope of coverage.

In certain luxury goods markets, the timeframe in which the design is most valuable is less than the time that a design patent would be in force. Thus, it is critical that the applicant appreciate the way that the U.S. Patent Office will treat applications for design patents, work within these parameters to obtain the broadest coverage possible as quickly as possible, and understand these issues before filing any patent applications.