

Helpful Hints for Obtaining Quality Design Patents or Registrations

Originally printed in December 2009 IPO Committee Newsletter

Marcus P. Dolce

Price, Heneveld, Cooper, DeWitt & Litton, LLP

Grand Rapids, MI

mdolce@priceheneveld.com

When preparing design applications for filing in countries or regions foreign to your own, there are several considerations that should be reviewed to ensure that you obtain the best protection available. This article will not outline what should be done for each country or region. Instead, this article will focus on the questions that should be asked before you file your design application. Moreover, this article will not focus on questions that are general to all foreign patent systems and is not specific to only design applications (e.g., do you need a foreign filing license to file in another country).

Question #1: Does the foreign country have any provision for filing after a public disclosure?

The first question that may be relevant is whether the foreign country or region allows for filing of a design application after a public disclosure. Most countries or regions do not allow for filing of a design application after the design has been publically disclosed. However, some countries or regions will allow for design protection when the application is filed after the design has become publically disclosed. Examples include the United States and Canada. Furthermore, some countries or regions will allow for design protection when the application is filed after the design has become publically disclosed even though they would not allow for utility or invention protection after public disclosure of the invention. An example of such a system is the Community Design Registration in Europe which allows for registration of designs if an application is filed after the design has been publically disclosed by the designer filing the application.

Question #2: How many designs can be filed in a single application?

A design application may have multiple, although related, embodiments. Some countries or regions will not allow an applicant to file multiple embodiments in a single application. Furthermore, some countries may require an applicant to state that their designs are related. You should ask your foreign associate for the best manner of proceeding when you have multiple, but related, embodiments. For the most part, the resolution will require you to file multiple applications. However, you need to determine if the multiple embodiments should be filed in a single application or in multiple applications at the outset.

Question # 3: Does the entire design in the application need to be sold as an individual product?

Some countries or regions require that the design in an application be sold as an individual product in order to be covered by their design patent or registration laws. Therefore, if your design is a portion of a

larger product and your design is not sold separately, you should determine if you can file for protection of such a design in your country or region of choice. If you cannot file for protection of your design which is a portion of a larger product, you should determine if you want to file for protection on the larger product or forgo design protection in that country or region.

Question # 4: Are the drawings that you filed in your home country or regional design protection office acceptable for filing in other countries or regional offices?

Drawings for design can include surface shading to show character or contour of the surfaces represented in the drawings. Drawings can also include broken or phantom lines to show environmental structure. Not all countries or regions allow surface shading and/or broken or phantom lines in their design applications. Accordingly, you should alter your design drawings to conform to the requirements of the selected country or regional office. While you may be able to change the drawings after filing to remove the surface shading or to remove the broken or hidden lines (or to change the broken or hidden lines to solid lines), waiting to make such changes may delay the prosecution of your design application. Furthermore, if broken or hidden lines are allowed, you should determine if a statement explaining the broken or hidden lines is required in the application or if the use of broken or hidden lines is understood as not forming part of the claimed design absent any explanation.

Question # 5: Do you need to show or explain the environment in which the design is used?

Some country or regional design protection offices require the applicant to state the environment in which the design is used in order for that office to classify the design according to their classification system (e.g., Locarno Classification). You should ask if the country or regional design protection office requires the applicant to state the environment along with where such a design would be classified or if the country or regional design protection office will assign a classification without input from the applicant.

Question #6: When must a divisional application be filed?

This question is related to Question #3 above and you should be aware of the answer if you have multiple designs or embodiments in your application. You should be ready to file any divisional applications before the deadline for filing such applications has passed. For example, in some countries, you must file your divisional application before the parent application is allowed. While you may not need to know the answer of this question before the application is filed, you should know the answer if you have multiple designs in a single application.

Conclusion

While the above questions are by no means an exhaustive list of questions that should be asked when undertaking the filing of an application for design protection, one should keep these questions in mind in order to not only expedite that prosecution of your application but to potentially obtain the broadest possible protection for your design.