

Transatlantic IP: the United States perspective on design patents for EU business

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Marianna KONDAS – International Cooperation Department, EUIPO
18 June 2024

PROGRAMME

50'
Presentation

1. The importance of protecting designs
2. What is a protectable design?
3. Patentability/registrability requirements
4. Examples
5. Application process & timing
6. How to file?
7. Attorneys & resources

10'
Questions and answers

1

The importance of protecting designs

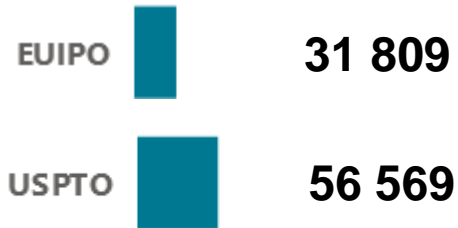


By the numbers

Over 1 million US design patents granted since 1843

Over 1.8 million registered EU designs since 2003

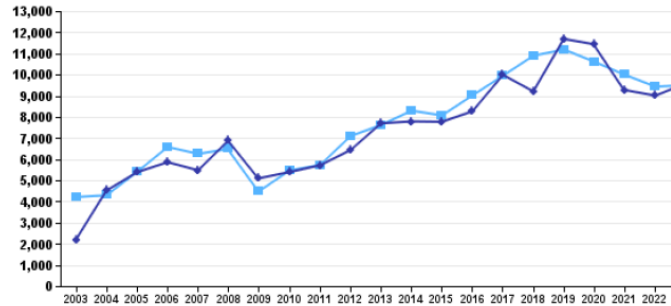
NUMBER OF APPLICATIONS 2023



OVERALL NUMBER OF REGISTRATIONS 2023



By the numbers



US - UNITED STATES OF AMERICA

RCDs Received by Year

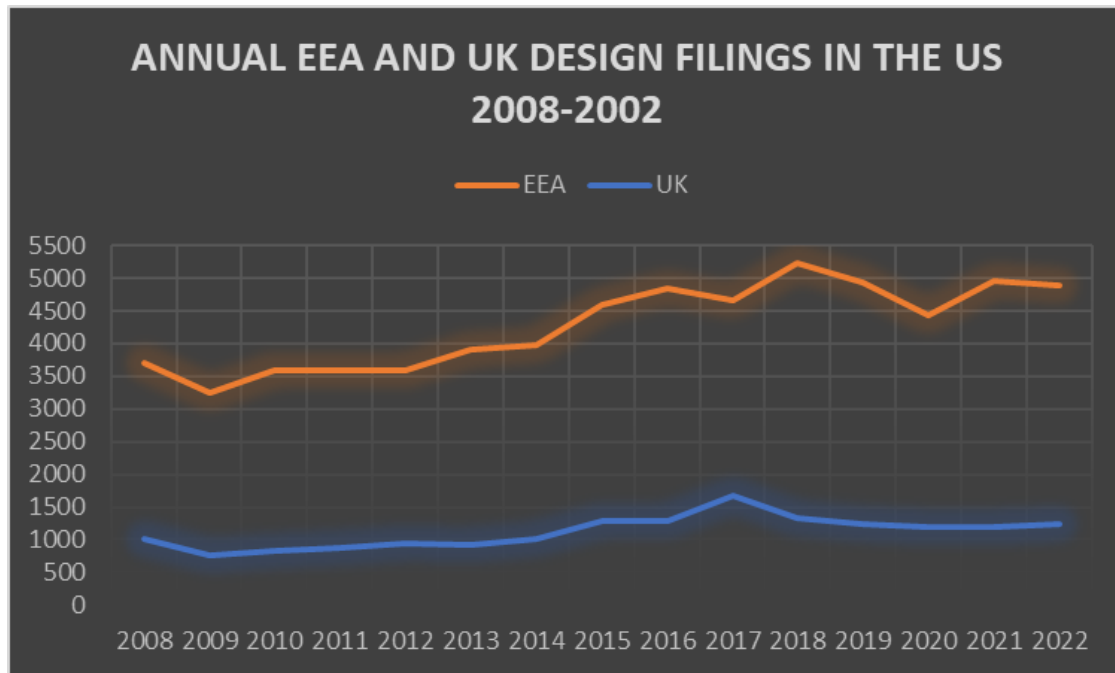
	US
2003	4,206
2004	4,294
2005	5,398
2006	6,575
2007	6,248
2008	6,482
2009	4,485
2010	5,465
2011	5,721
2012	7,089
2013	7,614
2014	8,291
2015	8,069
2016	9,014
2017	9,949
2018	10,892
2019	11,182
2020	10,603
2021	9,983
2022	9,428
2023	9,496
2024	616
Σ	161,100

RCDs Published by Year

	US
2003	2,197
2004	4,520
2005	5,385
2006	5,855
2007	5,471
2008	6,896
2009	5,095
2010	5,392
2011	5,710
2012	6,430
2013	7,695
2014	7,785
2015	7,767
2016	8,262
2017	9,981
2018	9,199
2019	11,683
2020	11,429
2021	9,265
2022	9,003
2023	9,585
2024	966
Σ	155,571

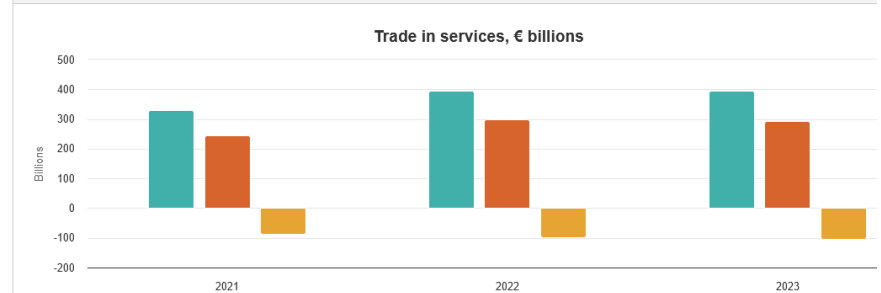
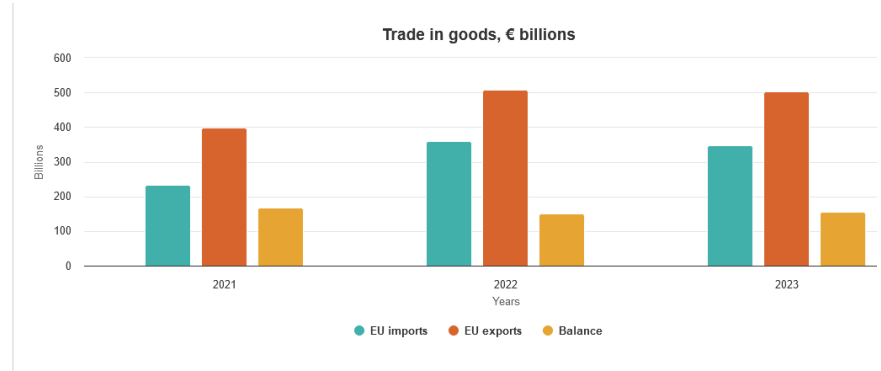
By the numbers – EEA and UK filings in the US

YEAR	EEA	UK
2008	3712	1009
2009	3247	757
2010	3593	838
2011	3597	878
2012	3594	938
2013	3909	914
2014	3984	1010
2015	4598	1295
2016	4837	1287
2017	4664	1678
2018	5221	1336
2019	4942	1230
2020	4422	1201
2021	4945	1203
2022	4891	1234



By the numbers

- **EU-US bilateral trade and investment relationship is the world's largest and most integrated.**
- **EU-US bilateral trade is at historical highs, with over €1.6 trillion in 2023.**
- **US is EU's number one trading partner in services.**





2

What is a protectable design?

What is protected?

U.S. Design Patents

Protect ornamental appearance of an article

Covers:

- Shape
- Configuration
- Surface ornamentation
- Combinations

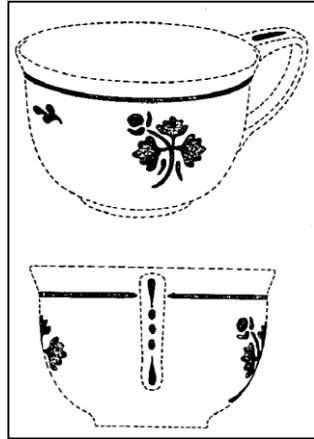
Registered EU Designs

Protect the visual appearance

Covers:

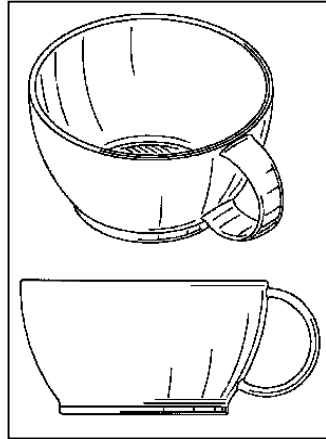
- Product
- Part of a product
- i.e. lines, contours, colours, shape, texture and/or materials
- Ornamentation

Examples



(1)

Surface
ornamentation
applied to an article



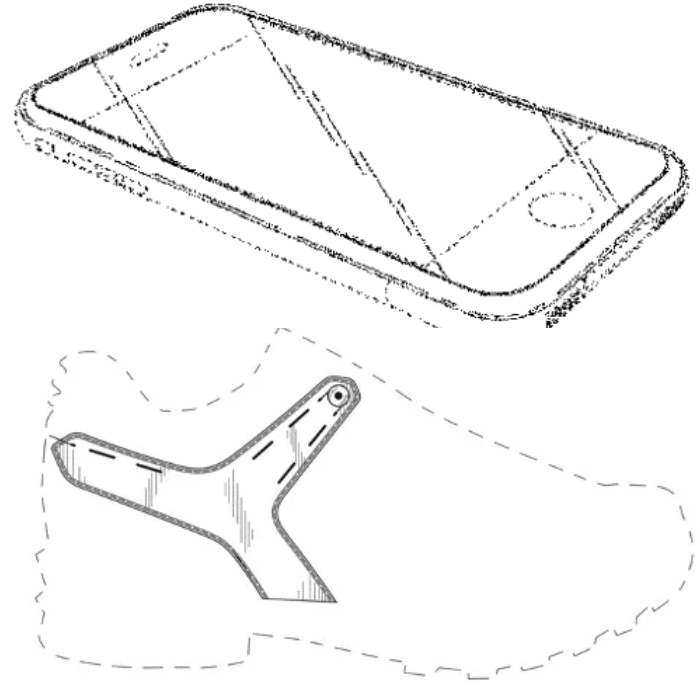
(2)

Configuration
embodied
in an article



(3)

Configuration
and surface
ornamentation for an
article



3

Patentability/registrability requirements



What is protected?

U.S. Design Patents

Protect ornamental appearance of an article

35 USC 171

“[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor”

- To satisfy this requirement - applicants are required to indicate the design as applied to or embodied in an article of manufacture

Registered EU Designs

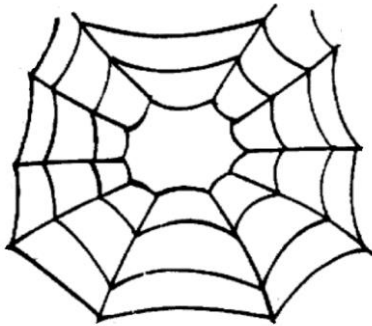
Protect the visual appearance

A product can be any industrial or handicraft item, including packaging, graphic symbols and typefaces

- representations of ornamentation should not include the product to which it will be applied, or they should disclaim the product

Design “for an article of manufacture”

Disembodied Design



Embodied Design

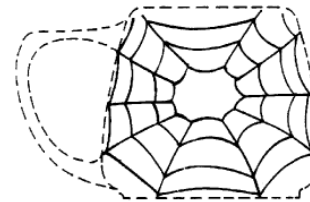


Fig. 1

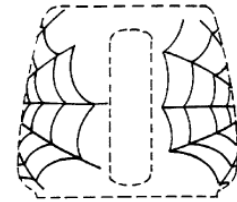


Fig. 2

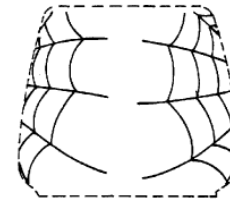


Fig. 3

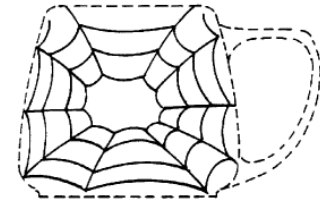


Fig. 4

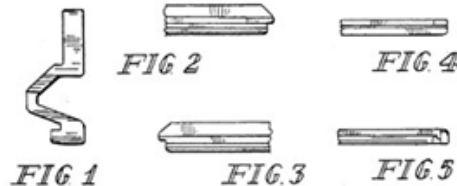
What is protected?

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Protect ornamental appearance of an article

35 USC 171

An ornamental feature or design has been defined as one which was “created for the purpose of ornamenting” and cannot be the result of or “merely a by-product” of functional or mechanical considerations.



Registered EU Designs

Protect the visual appearance

Article 8(1) CDR

‘a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function’

-> not examined ex officio, only if there is an invalidity request

What is protected?

U.S. Design Patents

New and Non-obvious

35 USC 102 & 103

novelty - whether, in the eye of an “ordinary observer,” two designs are substantially the same in overall visual appearance

non-obviousness - the ultimate question is whether differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious to a person of ordinary skill in the pertinent art at the time of the invention.

Registered EU Designs

New and Individual Character

novelty not predated by an identical design

individual character - the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public

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Registered EU Designs

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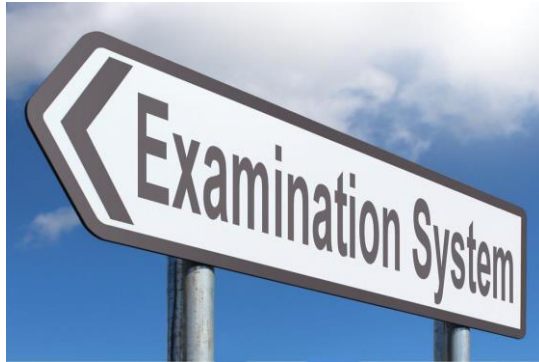
individual character - the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public

Different Systems of Protection

U.S. Design Patents

Examination

Applications substantively examined
ex officio for earlier prior art



Registered EU Designs

Registration

No ex officio examination, only if contested by
a third party (invalidity claim)





4

Examples

ANIMATED DESIGNS/GUIs

How would these be reviewed?

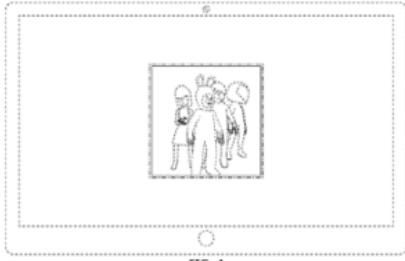


FIG. 4

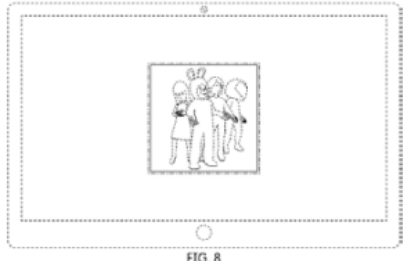


FIG. 8

D768,722 titled “Display Screen with Animated Graphical User Interface”

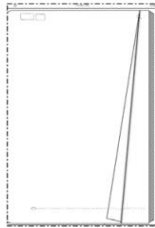


FIG. 1

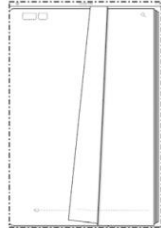


FIG. 2

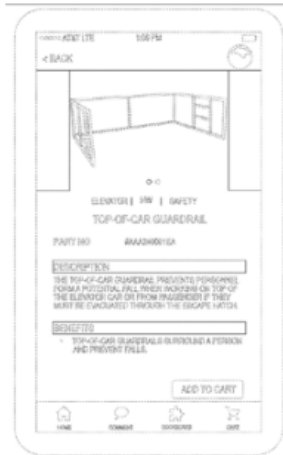
D670,713 Titled “Display Screen or Portion Therefor with Animated Graphical



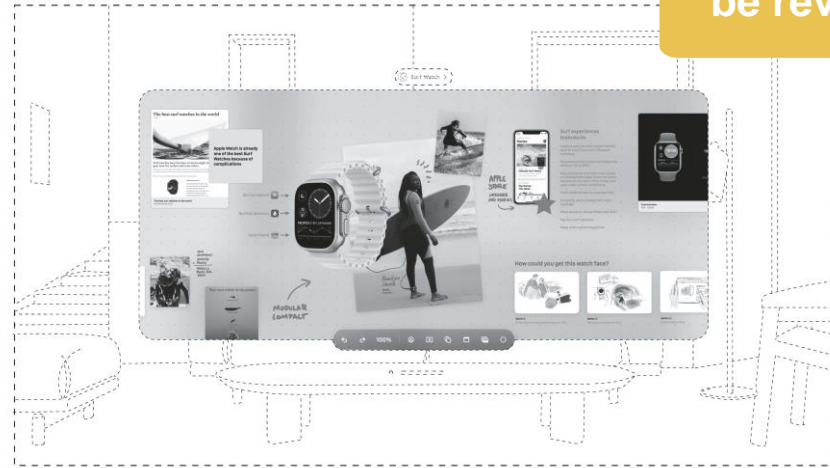
RCD 1788159-0001

GRAPHICAL USER INTERFACES

How would these
be reviewed?



D822,038 Display screen or portion thereof with graphical user interface



RCD 15043125-0003
Static image for Graphical user
interfaces (part of -)

ICONS & LOGOS

How would these
be reviewed?



RCD 003001494-0002

RCD 000754098-0001

 **iPhone**



D586,822 titled “Portion of a display screen showing an icon”

Get-ups



RCD 9202468-0001



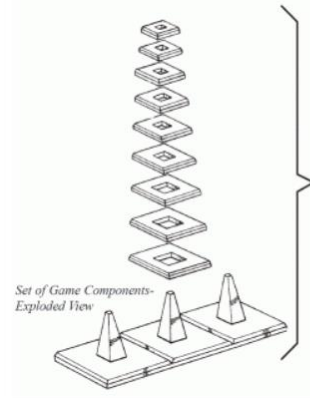
USD 639,453

How would these
be reviewed?

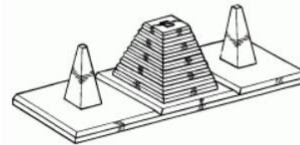
SET OF ARTICLES



RCD No 938 709-0001

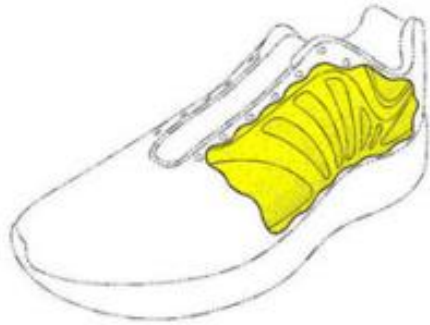


Set of Game Components - Fully Assembled View:

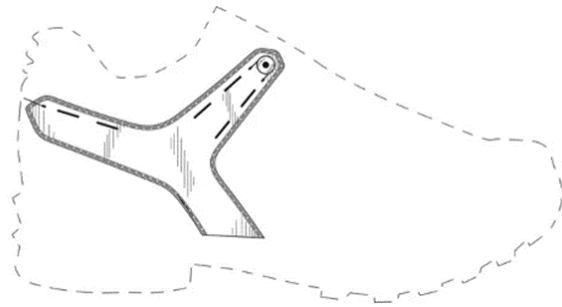


How would these
be reviewed?

PART OF A PRODUCT



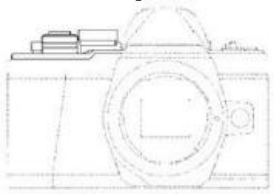
RCD 00229752-0001



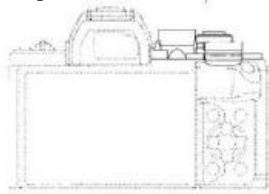
How would these
be reviewed?

PART OF A PRODUCT

(dotted line)



Front view



Back view

(shading)



How about
these?

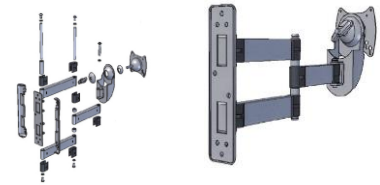
(blurring)



(boundaries)



(exploded views)





Check
what is
acceptable



Select
what is best
in your case



See
some
examples

OPTIONS FOR REPRESENTATIONS IF MY DESIGN...

- ...has multiple parts or states
(consider transformable product)



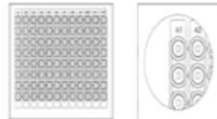
- ...must clarify which part I want to protect
(consider disclaimers)



- ...is animated (consider multiple views)



- ...has features I want to make clearly visible
(consider detail or magnified views)

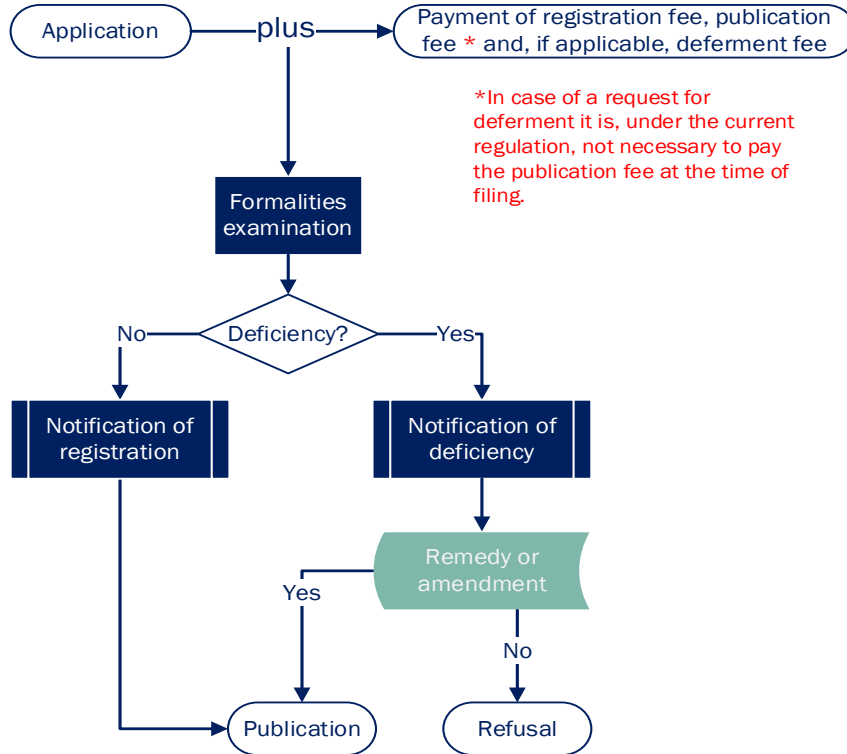




5

Application process & timing

Examination workflow



QUALITY

CONSISTENCY

PRODUCT INDICATION

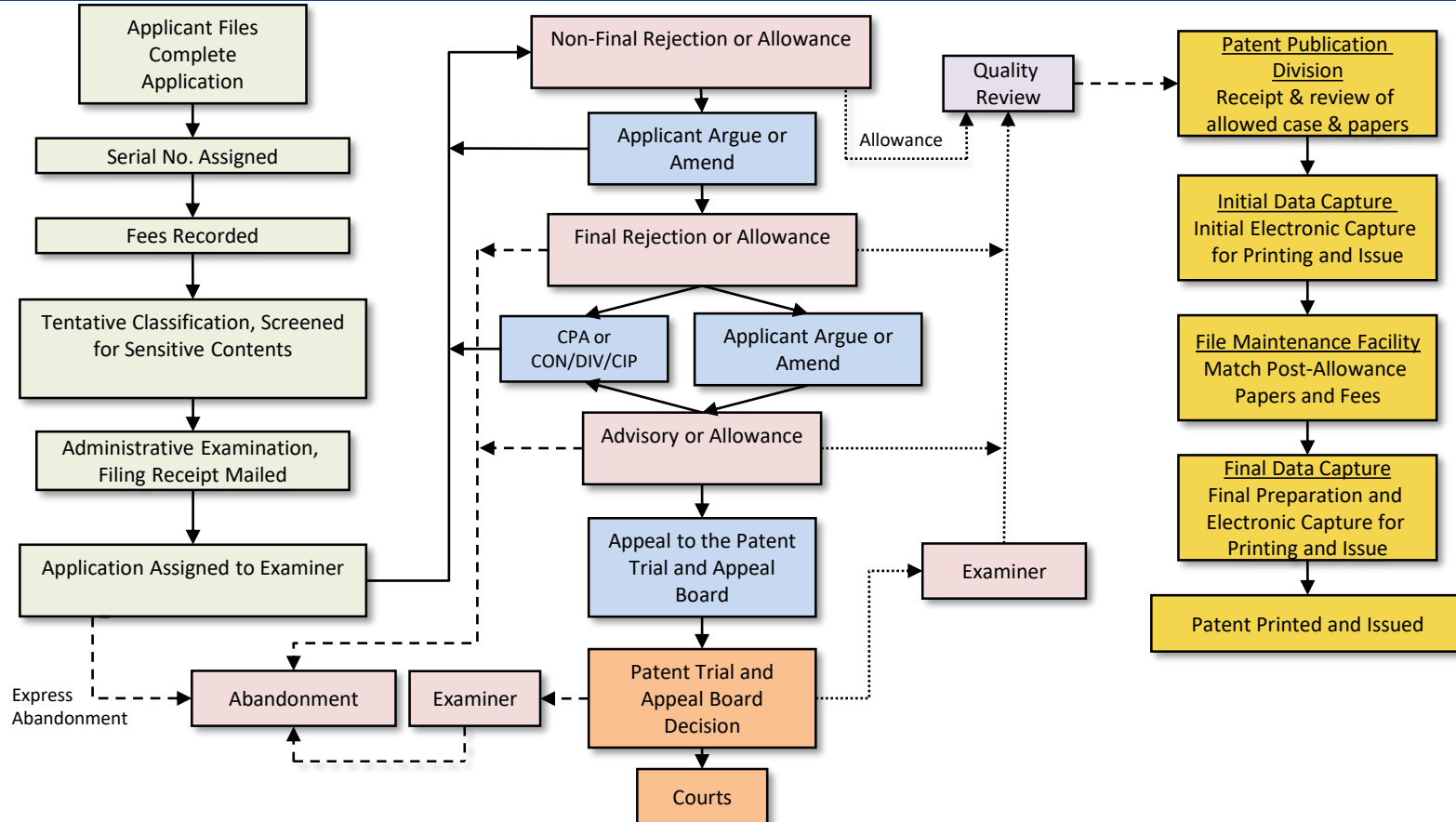
APPLICANT EEA

FEES

**DESIGN
DEFINITION**

**PUBLIC
POLICY &
MORALITY**

Path to design protection in the US



Finding prior art at the USPTO

Looking for prior art

- PE2E and internal patent search databases (including international databases)
 - Classification
 - Inventor
 - Assignee
 - Image/Text
- External Databases
- Websites

Process

- Examiners are grouped by classifications
- Similar applications can be batch processed

First action

U.S. Design Patents

Registered EU design

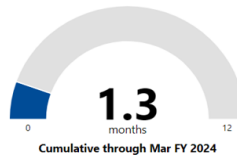
Design Data March 2024

Rocket Docket

Design First Office Action Pendency



VS



Fast track (2 days) / Standard track (7 days)

Term of protection

U.S. Design Patents

Set Term

**One time issuance fee for 15
years protection
(counts from issue)**

Registered EU design

Renewable Term

**Up to 25 years from filing
(renewable every five years)**

Priority filing



U.S. Design Patents

Paris Convention

Priority: 6 months

STATISTICS ON EXCHANGING PRIORITY DOCUMENTS



Registered EU design

Paris Convention

Priority: 6 months



➤ 300 – 500 priority claims EU ↔ USA

Priority requirements

U.S. Design Patents

“Perfecting” Priority

- max. 6 months before the filing date
- up to the payment of the issuance fee and correctable thereafter
 - examiner may require if there is an intervening reference
- certified copy of the previous filing or provide a WIPO DAS code

Registered EU design

Obtaining Priority

- max. 6 months before the filing date
- at the time of filing or within 1 month
- copy of the previous filing or provide a WIPO DAS code

Publication and deferment

U.S. Design Patents

No publication if rejected/refused

- **Publication once design is granted**
 - Hague cases will publish regardless of the outcome
- **Deferment?**

Registered EU design

Always published

- **Publication Community Designs Bulletin / EUIPO website**
- **Deferment?**

Grace period

U.S. Design Patents

Available for designs

**12-month period before the
effective filing date or
priority date**

Registered EU design

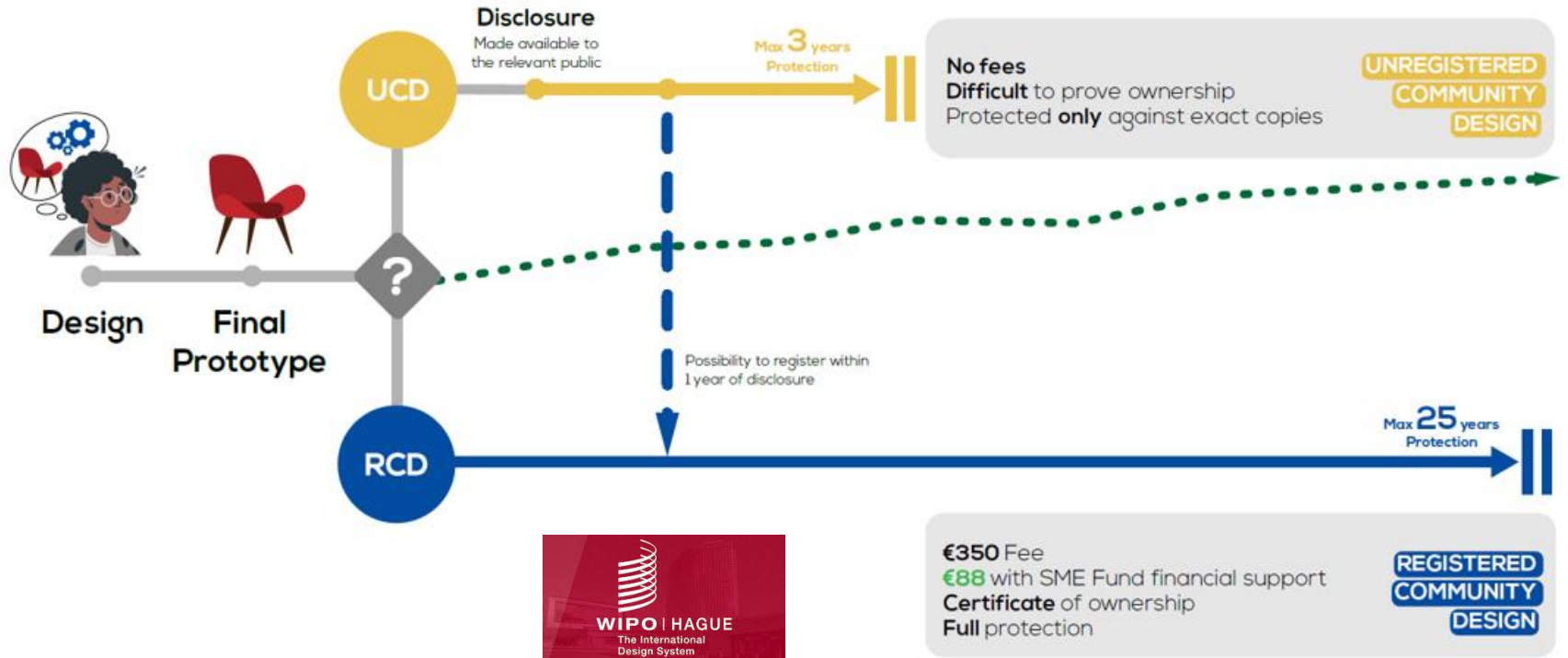
Available for designs

**12 months preceding the date of
filing or the priority date**

6 How to file?



Path to design protection in the EU



Resources: Apply now

Designs

They're everywhere! Anything touched by a human hand has a design.



... > How to apply > Apply now

Before applying ^

How to apply v

[Apply now](#)

After applying ^

Apply now

The EUIPO offers three types of forms depending on your needs.

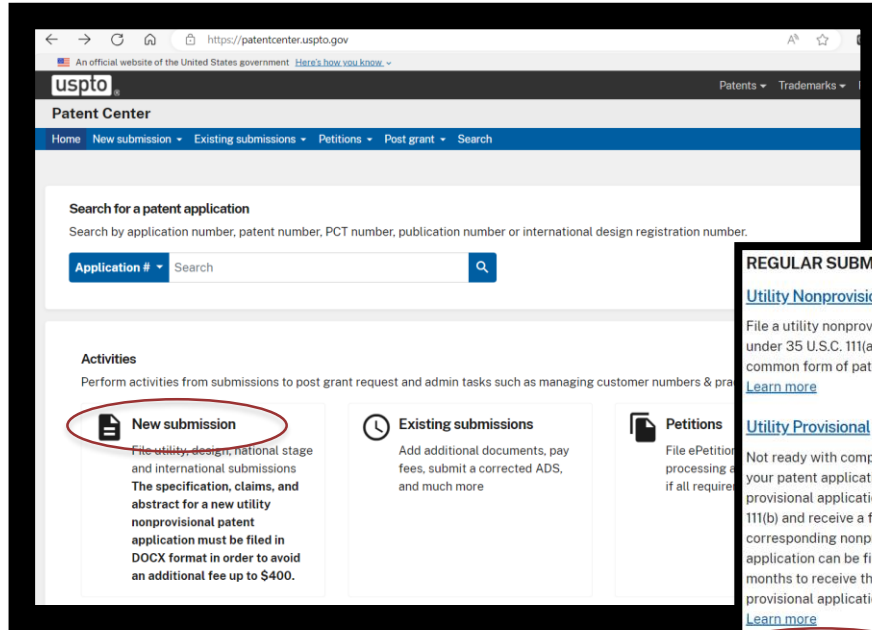
Before applying, make sure that the representation of your design is acceptable: [How to apply](#)

The EUIPO doesn't issue invoices. Our fees are exempt from VAT.

[More information on our fees](#)

<https://www.euipo.europa.eu/en/designs/how-to-apply/apply-now>

Resources: Apply now



The screenshot shows the USPTO Patent Center website. The navigation bar includes 'Home', 'New submission', 'Existing submissions', 'Petitions', 'Post grant', and 'Search'. A search bar is present with the text 'Search for a patent application' and a search button. Below the search bar, there are three activity cards: 'New submission' (circled in red), 'Existing submissions', and 'Petitions'. The 'New submission' card contains the text: 'File utility, design, national stage and international submissions. The specification, claims, and abstract for a new utility nonprovisional patent application must be filed in DOCX format in order to avoid an additional fee up to \$400.'

<https://patentcenter.uspto.gov/Center> - USPTO

REGULAR SUBMISSIONS

[Utility Nonprovisional](#)

File a utility nonprovisional application under 35 U.S.C. 111(a), the most common form of patent application
[Learn more](#)

[Utility Provisional](#)

Not ready with complete details for your patent application? File a provisional application under 35 U.S.C. 111(b) and receive a filing date. A corresponding nonprovisional application can be filed within 12 months to receive the benefit of a provisional applications filing date
[Learn more](#)

[Design Nonprovisional](#)

File a design application under 35 U.S.C. 171 for any new, original, and ornamental design for an article of manufacture
[Learn more](#)

PATENT INITIATIVES

[Track One Prioritized Examination](#)

Need to fast track your application? File a utility nonprovisional application under 35 U.S.C. 111(a) using the USPTO's Prioritized Patent Examination Program (Track One)
[Learn more](#)

[Accelerated Examination - Utility](#)

File a utility nonprovisional application under 35 U.S.C. 111(a) and a qualifying petition to make special under the Accelerated Examination program
[Learn more](#)

[Accelerated Examination - Design](#)

File a design nonprovisional application under 35 U.S.C. 171 and a qualifying petition to make special under the Accelerated Examination program
[Learn more](#)

INTERNATIONAL APPLICATIONS

[International \(PCT\) Application](#)

File an international patent application in accordance with the Patent Cooperation Treaty (PCT) to seek protection simultaneously in a large number of countries. The granting of patents remains under the control of the national or regional patent offices in what is called the "national phase"
[Learn more](#)

[International Design \(Hague\) Application](#)

File an international design application through the USPTO as an office of indirect filing, in accordance with the "Hague Agreement," to seek protection for up to 100 industrial designs in designated member countries
[Learn more](#)



7

Attorneys & resources

Mandatory representation for non-EEA



Legally qualified practitioner in EU

Professional representative from list

eSearch plus
The EUIPO's database
access

Trade marks | Designs | Owners | **Representatives** | Daily publication

Search criteria

Sort results by: Representative ID number (v) Ascending (v)

Representative ID number contains (v) [] *

and (v) Representative name contains (v) [] *

Clear criteria | Reset to default | Search

Add search criteria from below

Representative information

- Representative ID number
- Representative name
- Representative organisation
- Representative's nationality
- Type

Location

- Town
- Country
- Fax

Employee of another natural or legal person

- real and effective industrial or commercial establishment
- economic connections
- SME fund

Representation at the USPTO

Any inventor may apply for a patent “pro se” at the USPTO

<https://www.uspto.gov/patents/basics/using-legal-services/pro-se-assistance-program>

Patent process training

To assist applicants at all stages of the patent examination process the Office of Patents Stakeholder Experience (OPSE) also provides ongoing education:

[Expand all](#) | [Collapse all](#)

- > Tools for filing an application
- > Quick Clinic Video Series
- > Knowledge packs for pre-filing
- > Prior Inventor Info Chats

Pro se resources

The following listings of resources are not exhaustive of all the educational materials available to pro se applicants at www.uspto.gov, but provides consolidated access to educational information addressing common questions of applicants at various stages of the [patent examination process](#).

- > Prior to filing
- > During examination (after filing)
- > After final rejection (prosecution closed)
- > After allowance or abandonment

Filing a patent application on your own

Pro Se Assistance Program

The patent process is a complex set of [laws, regulations, policies and procedures](#); therefore, the USPTO always recommends using a [registered patent attorney or agent](#) to assist in preparing your application. The USPTO also recognizes that the cost of legal assistance is prohibitive for many applicants, particularly independent inventors and small businesses. The Pro Se Assistance Program is dedicated to help independent inventors and small businesses meet their goal of protecting valuable intellectual property.

The Pro Se Assistance Program provides outreach and education to applicants (also known as “pro se” applicants) who file patent applications without the assistance of a registered patent attorney or agent. USPTO employees cannot give legal advice. However, through increased assistance and resources for independent inventor and small business communities, the program aims to increase the quality of pro se applications and assist pro se applicants with making informed decisions regarding their patent applications.

Why is educating yourself about intellectual property protection important?

Intellectual property protection is critical to safeguard products and services from imitation, attract and secure funding from outside investors and promote the overall commercial success of any enterprise. In addition, the value of a patent is largely dependent upon skilled preparation and prosecution. Educating yourself is an important first step to develop an intellectual property strategy that can yield substantial economic benefits for your company and endeavors.

Representation at the USPTO

- USPTO ***always*** recommends using a ***registered patent attorney or agent*** to assist in preparing your application
- **Only registered patent attorneys/agents** may practice before the USPTO
- **Requirements** for being a registered patent attorney or agent
 - **Only U.S. citizens or permanent residents** can be registered to practice law in patent matters before the USPTO
 - Individuals seeking registration or recognition must meet the requirements including the legal, scientific, and technical qualifications, as well as good moral character and reputation
 - **Examination**



Representation at the USPTO

- **Design Bar (starting 2024)**
 - Applicants must have a bachelor's, master's, or doctorate of philosophy degree in any of the following areas (or its equivalent) from an accredited college or university: Industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education.



Representation at the USPTO

USPTO ***always*** recommends using a ***registered patent attorney or agent*** to assist in preparing your application

Finding a patent practitioner

Finding a registered patent practitioner

The Office of Enrollment and Discipline (OED) maintains a [register of active patent practitioners](#) who are eligible to represent others before the United States Patent and Trademark Office (USPTO) in all patent matters, or design patent matters only. Only registered patent attorneys and agents, and individuals granted limited recognition, may represent patent applicants before the USPTO in all patent matters, including utility, design, plant matters. Registered design patent attorneys and design patent agents may represent patent applicants before the USPTO in design patent matters only. Individuals not listed on the register are generally unable to represent others before the USPTO in patent matters.

While OED maintains the register, the USPTO cannot aid in the selection or recommendation of an attorney or agent. You may also consider the services of the Law School Clinic Certification or Patent Pro Bono programs.

<https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner>

Resources

Topics in designs

Basic questions

- Application and registration procedure
- Time limits and deadlines
- Fees and their payments
- Representation before the office
- Search availability
- The Register
- Unregistered community design
- Invalidity
- Appeal
- International registration
- Enlargement of EU

Basic questions

- What does design mean?
- What are the requirements for protection of a design in the EU?
- What is a registered Community design?
- What in an unregistered Community design?
- How is the scope of protection different between a registered Community design (RCD) and an unregistered Community design (UCD), and how do the rights they confer differ?
- What are the differences between a registered and an unregistered Community design?
- How long is a registered Community design valid for?
- What are the advantages of a registered Community design (RCD) compared with national protection schemes?

<https://www.euipo.europa.eu/en/the-office/help-centre/design/faq-basic-questions>

Additional resources at the USPTO

Intellectual property legal assistance programs

The cost of hiring competent legal representation is often a barrier when applying for a patent or trademark. The [Office of Enrollment and Discipline](#) oversees two programs that provide applicants with free options for acquiring intellectual property protection.

Patent Pro Bono Program

The [Patent Pro Bono Program](#) is a nationwide net-
work of volunteer patent practitioners and
attorneys who provide free legal assistance to
inventors and small businesses that meet qual-
ifying criteria. The program is administered
locally and each have their own requirements.

Patent Pro Bono Program

Startup resources



Intellectual property (IP) challenges specific to startups, including securing funding and guarding against infringement. As a startup, you may face unique challenges such as filing a patent or registering a trademark, check out [these resources for inventor and entrepreneur](#).

For more information, visit a wide variety of government agencies, including the [Small Business Administration \(SBA\)](#) and [Small Business Development Centers \(SBDCs\)](#). These agencies can assist you at every stage of your startup journey.



INVENTOR & ENTREPRENEUR RESOURCES



Get started

Learn about types of intellectual property (IP) and how to protect your idea or product.



Before you apply

Search existing patents and trademarks to find out if your idea is unique. If it is, create an account.




Get help to apply

Set yourself up for success by learning via USPTO's free resources and find expert help.



Apply for IP rights

Submit your application for a patent or trademark. See if you qualify for reduced patent fees.



Find funding

Access capital
There are many sources of startup resources



Engage experts

Get advice and assistance
Find mentors, partnerships, and



Questions and answers

How does the appendix work and how can EU applicant benefit from it?

Questions and answers

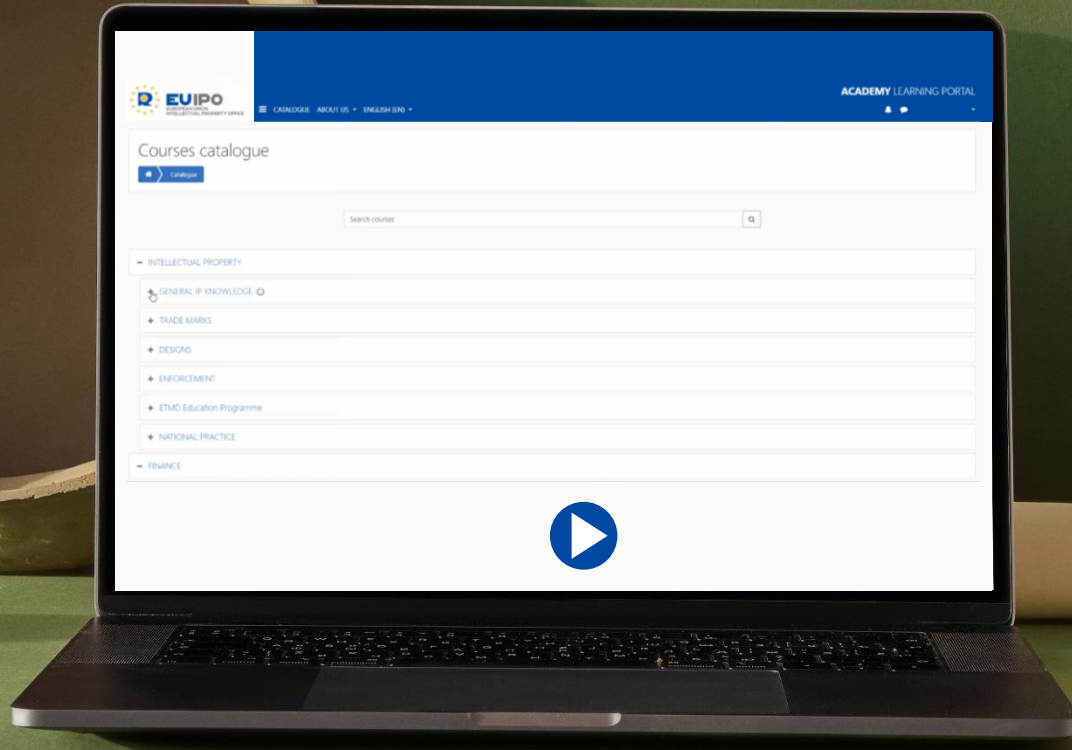
Can we expect less rigorous design examination by USPTO in short (or longer) term; i.e. a practice closer to the European one?

Questions and answers

Please be so kind to enlighten us on the Information Disclosure Statement and the scope to the prior art that has to be disclosed



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