



# Common Issues in U.S. Design Patent Applications

February 13, 2025

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TC 2900

# Most Common Design Rejection?

## 35 U.S.C. 112 Specification

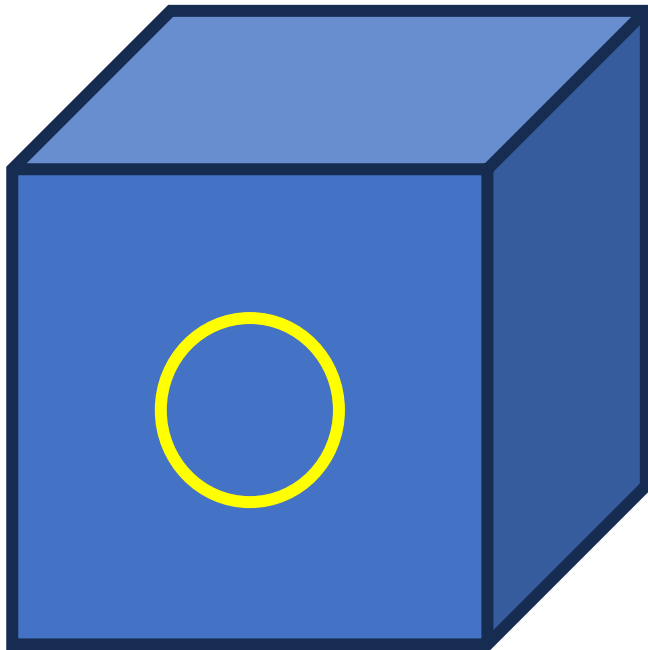
(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

# Most Common Design Rejection?

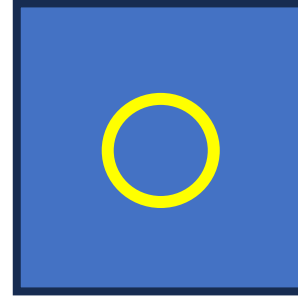
- How many drawing views are needed?
  - Would you ever need more than 7 views?
  - Could you have less than 7 views?
  - *In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018).
    - “Some designs may be capable of being understood from a single, two dimensional plan view perspective. For example, a single 2D plan view may sufficiently close a design that does not claim three dimensional aspects.” USPTO Presentation, Technology Center 2900, Federal Circuit Decisions: *Maatita*, *Curver*, and *SurgiSil*, slide 9, FY 2023-Q1.
    - “There is no *per se* rule that a design claim will, or will not, always meet the enablement and definiteness requirements of 35 U.S.C. 112 when the claimed design is visually disclosed using a single, two dimensional plan view.” *Id.*

# Sufficiency of Views?



ISO

FRONT



REAR



TOP



BOTTOM



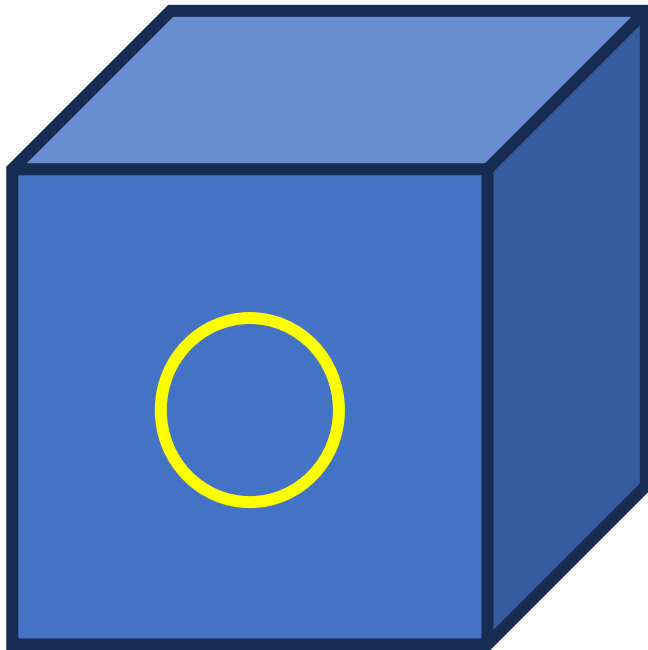
LEFT



RIGHT

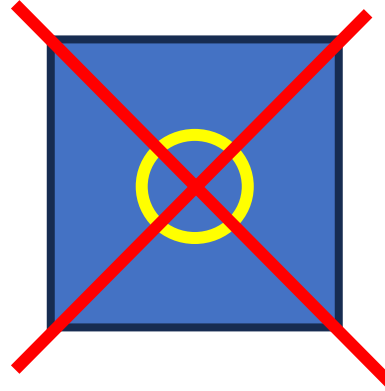


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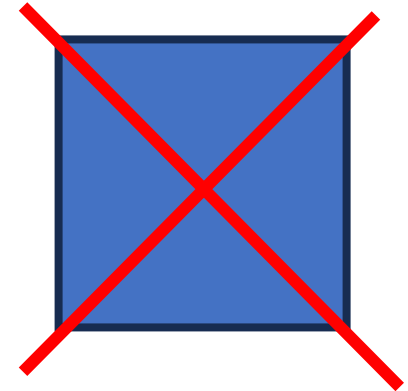


ISO

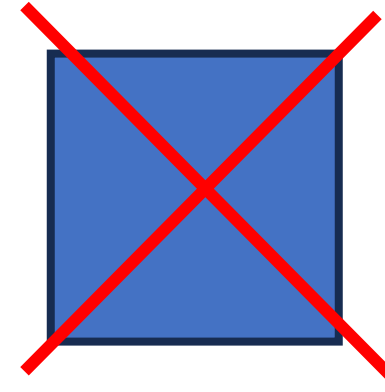
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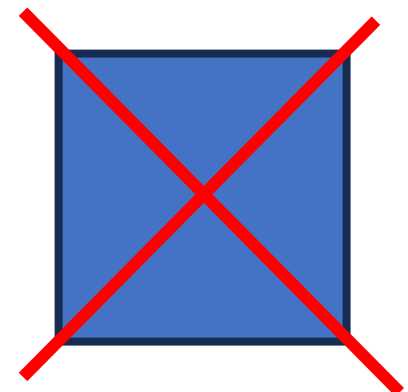
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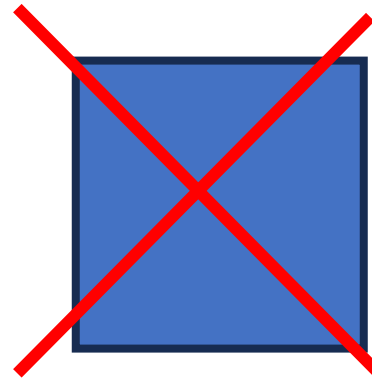
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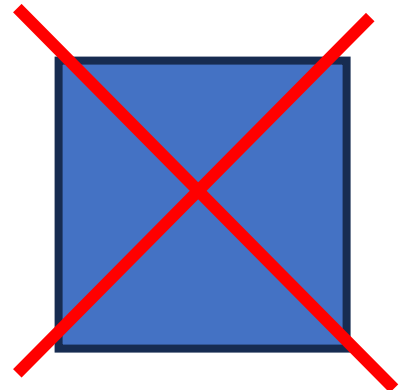
BOTTOM



LEFT

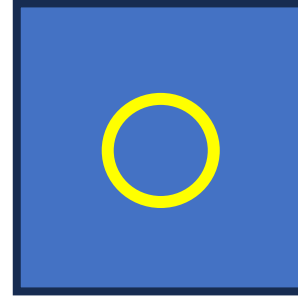


RIGHT

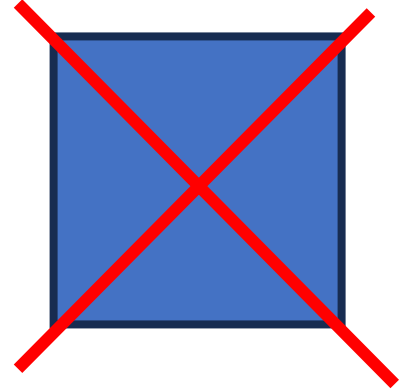


# Sufficiency of Views?

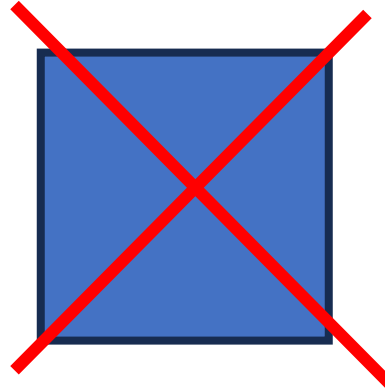
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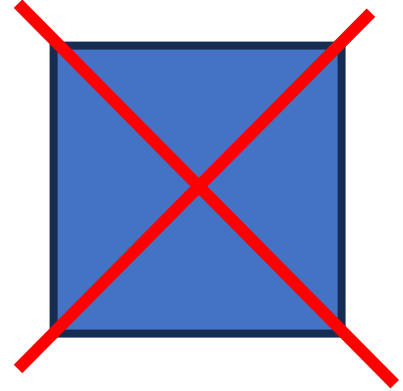
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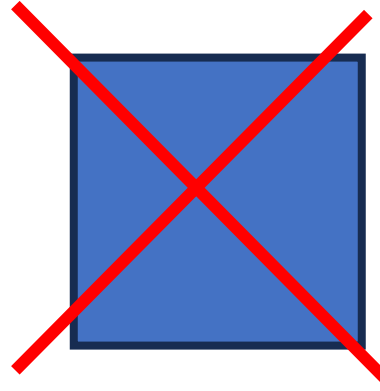
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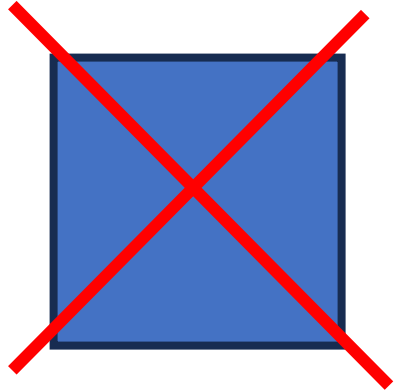
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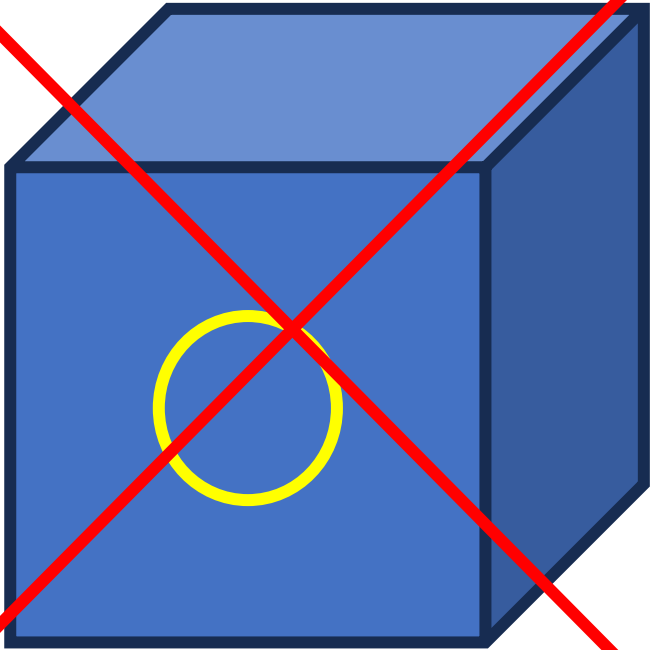
LEFT



RIGHT



ISO

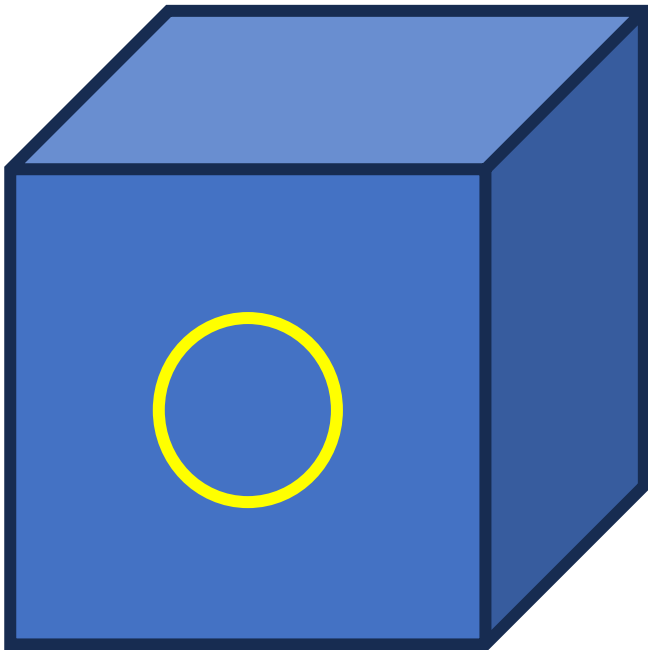


# How Can I Amend My Application?

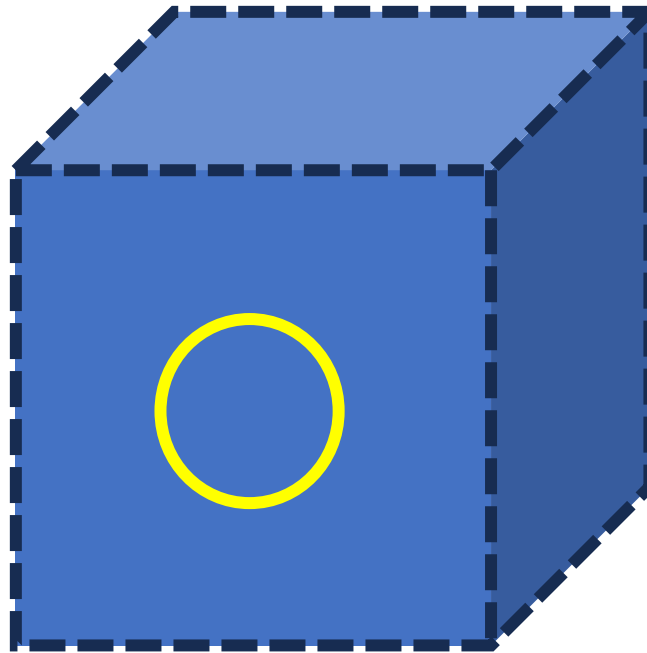
- What amendments are allowed to the specification?
- Can I add views? Delete views?
- Can I amend between solid lines and dashed lines?

# How Can I Amend My Application?

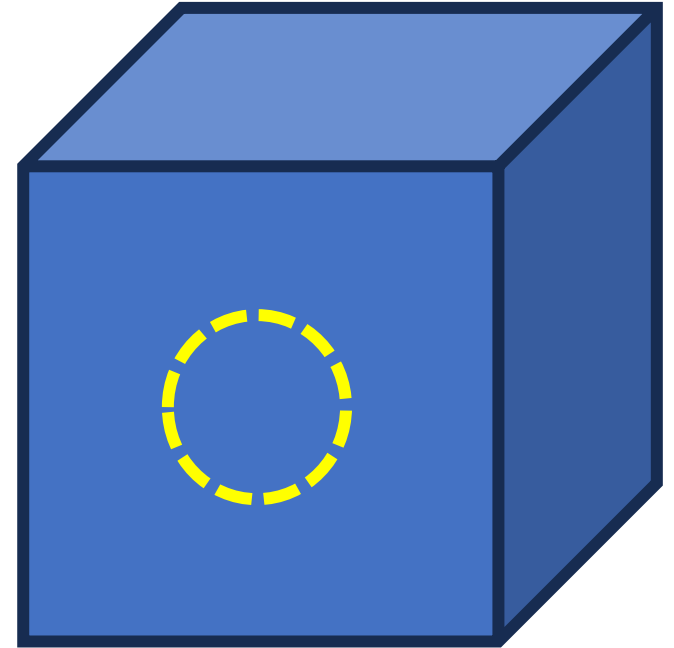
- Changing line types



vs



vs

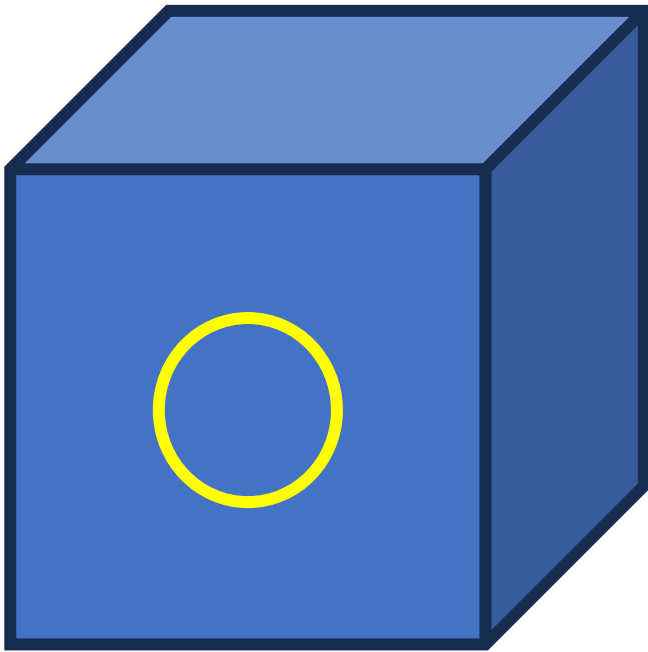


- Could I run into a new matter rejection?

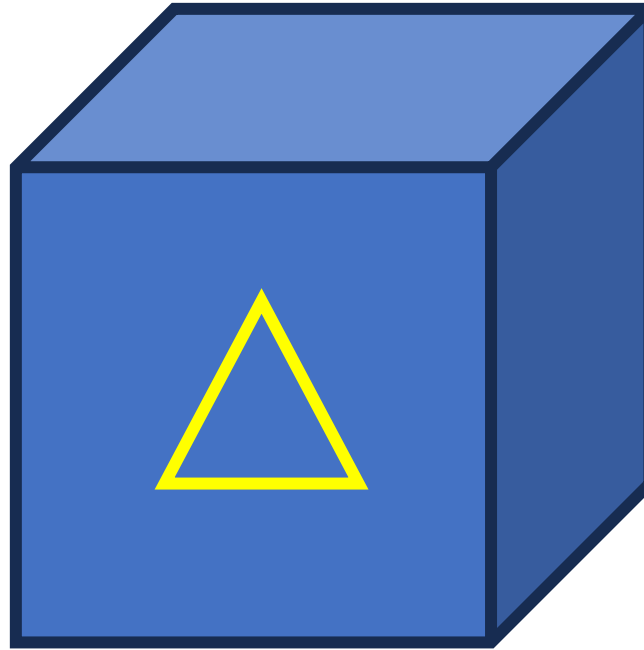


# Restriction Practice

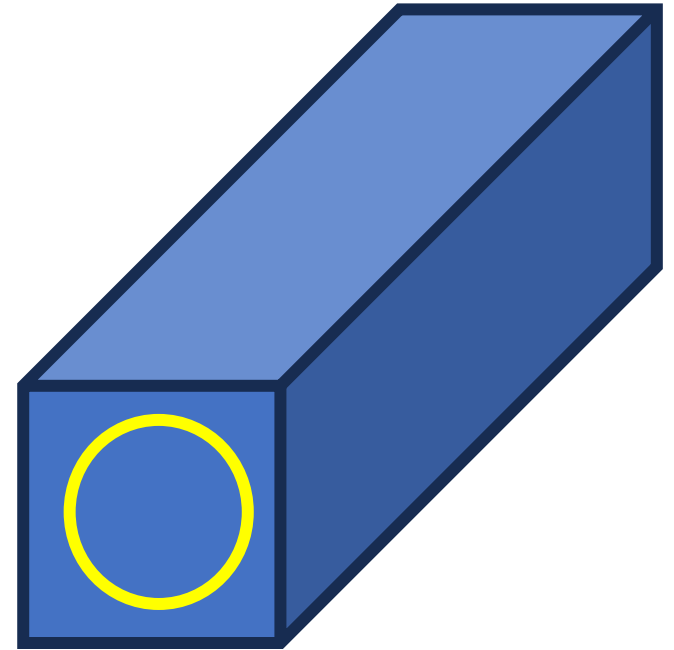
- How different do designs have to be to draw a restriction?



**vs**



**vs**



# Other Design Patent Issues

- Are there other line types other than just solid and dashed?
- How do you claim things like texture and materials?
- Can you use color in design patent applications?
- Can my drawings be photographs?
- Is claiming priority different for design patent applications?
- Can I file an RCE if I receive a Final Rejection?

# What Are Appendices?

MPEP 1121(II) – Appendices:

“Appendices, other than those containing “Sequence Listings” (for applications filed before July 1, 2022), “Sequence Listing XMLs” (for applications filed on or after July 1, 2022), or “Large Tables”, are not printed if they are contained on pages located after the claims. If the application includes multiple claim sets in the specification, the Office may treat pages located after the first set of claims as appendices. Note that computer program listings may be printed if they are included in the specification before the claims, but that “Computer Program Listing Appendices” that are submitted via the USPTO patent electronic filing system or on a read-only optical disc in accordance with 37 CFR 1.96(c) and 37 CFR 1.52(e) are not printed as part of the patent or patent application publication.