

Design Patent Application Prosecution

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A Practice Note providing an overview of US design patent application prosecution procedures at the US Patent and Trademark Office (USPTO) (35 U.S.C. § 111(a); 37 C.F.R. § 1.53(b)) or the US national processing of an international design application filed under the Hague Agreement (35 U.S.C. §§ 382 and 389). Topics include pre-examination formalities, restriction practice, responding to office actions, and post-allowance strategies. This Note highlights the significant differences between design and utility patent prosecution, focusing on the legal standards, application requirements, and potential pitfalls specific to protecting nonfunctional, ornamental designs. It also offers practical guidance for navigating common prosecution scenarios to maximize the value and likelihood of success for a design patent.

Design patents, which protect nonfunctional ornamental designs embodied in or applied to an article of manufacture, can be a key protection strategy for a product that includes ornamental features, either independently or with complementary forms of protection, such as utility patents, copyright, trademark, and trade dress.

While the US Patent and Trademark Office (USPTO) examines design patent applications under many of the same statutes, rules, and procedures as for utility patents, there are significant differences in:

- The scope of eligible subject matter and protection.
- The application of the relevant legal standards and requirements.
- The typical USPTO rejections and applicant response options and considerations.

Patent counsel seeking design patent protection for their clients should understand the unique nature and scope of design patents, how to develop an effective filing strategy, and the specific rules and best practices for filing and prosecuting applications to enhance success rates and commercial value.

This Note provides an overview of design patent prosecution procedures at the USPTO, including

comparisons, differences, special considerations, and potential pitfalls relative to utility patent prosecution.

Overview of Design Patents and Prosecution

Design Patent Fundamentals

Design patents protect ornamental designs embodied in or applied to an article of manufacture (or a portion), not the article itself. A design can include surface ornamentation as well as configuration of an article and may include a display having a static or dynamic graphical user interface or computer-generated icon. (35 U.S.C. § 171; MPEP §§ 1502 and 1504.01(a).)

The USPTO issues design patents under many of the same statutory and procedural requirements as utility patents, but with key differences in subject matter eligibility, enforceable term, and other aspects. For example, like utility patents, a claimed design must be original (novel) and nonobvious (35 U.S.C. §§ 102, 103, and 171 to 173).

While the scope of a utility patent is defined by its claim language, a design patent's essence is its drawings, which are linked to a single claim. This single formal claim, typically reciting "[I/We] claim: The ornamental design for a/an [article of manufacture] as shown and described," essentially incorporates the application's drawing figures and the associated descriptions from the specification. However, case law has developed to emphasize the particular article recited in the claim in determining a design patent's patentability and scope.

In a design patent infringement analysis:

- The accused design must be applied to (or incorporated in) the same article of manufacture as that claimed (*Curver Luxembourg SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336, 1340, 1343 (Fed. Cir. 2019)).
- Comparison prior art used to provide a frame of reference must be applied to (or incorporated in) the same article of manufacture identified in the claim (*Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363, 1378-79 (Fed. Cir. 2023)).

To anticipate under Section 102, a prior art reference must disclose the claimed design as applied to (or incorporated in) the same article of manufacture as the article recited in the claim (*In re Surgisil, LLP*, 14 F.4th 1380, 1382 (Fed. Cir. 2021)).

For Section 103 obviousness:

- The available prior art includes "not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs" (*Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997)).
- A primary obviousness reference "will typically be in the same field of endeavor as the claimed ornamental design's article of manufacture, but need not be, so long as it is analogous art" (*LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280, 1298 (Fed. Cir. 2024) (en banc)).

For more on design patent fundamentals and design patent applications, see:

- [Practice Note, Design Patents: Overview: Nature of Design Patent Protection.](#)
- [Practice Note, Patent Prosecution: Preparing and Filing Design Patent Applications.](#)

- [Design and Utility Patents Key Differences Chart: Patentability Requirements.](#)

Comparison with Utility Patent Application Prosecution

USPTO utility and design patent application prosecution both involve:

- A determination of the application's compliance with procedural and substantive patentability requirements (35 U.S.C. §§ 101, 131, and 171; MPEP §§ 701 and 1504).
- Examination under the same USPTO procedural rules and practices. Design prosecution follows a similar basic correspondence cadence of USPTO office actions, applicant responses and amendments, and may include examiner interviews and petitions practice. (37 C.F.R. §§ 1.151 and 1.1061; MPEP § 1504.)

As with utility patent application prosecution:

- Prosecution history disclaimer and prosecution history estoppel can limit a design patent's scope (*Top Brand LLC v. Cozy Comfort Co.*, 143 F.4th 1349, 1357 (2025); *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014); see [Practice Note, Patent Claim Construction: Overview: Prosecution History.](#))
- Applicants are bound by the duty to disclose information material to patentability to the USPTO (37 C.F.R. § 1.56; see Duty of Disclosure).

For general information on these procedures, see [Practice Note, Patent Prosecution: Overview: USPTO Examination.](#)

Key differences in prosecuting utility versus design patent applications arise from the unique nature of design patent protection and the specific legal and regulatory nuances involved. To avoid common pitfalls, patent counsel should be familiar with the following differences, including:

- Different application parts and requirements (37 C.F.R. § 1.152 to 1.154; MPEP § 1503). A design patent application must include a claim to receive a filing date (37 C.F.R. § 1.53(b); MPEP § 1503.01(III)).
- Design patent applications cannot claim benefit to provisional patent applications (35 U.S.C. § 119(e)(2); 37 C.F.R. § 1.53(c)(4)) and are limited to a six-month foreign right of priority under the Paris Convention (35 U.S.C. § 172; 37 C.F.R. § 1.55(b)(1); see Benefit and Priority Claims).

Design Patent Application Prosecution

- Except for international (Hague Agreement) design applications that designate the US, US design patent applications are not published before patent issuance (see US Design Applications Not Published).
- Unlike Patent Cooperation Treaty (PCT) international patent applications that require submission of additional forms and fees on entering the US national phase, an international design patent application designating the US automatically enters national examination after publication (see National Examination of Hague Agreement Applications).
- Requests for continued examination (RCE) are unavailable (37 C.F.R. § 1.114(e)(4)) but design patent applicants can file continued prosecution applications (CPA) (37 C.F.R. § 1.53(d); see Continued Prosecution Applications and Continuing Applications), unless the application is a US national part of an international design application filed under the Hague Agreement.
- Prosecution of a design patent application typically proceeds more quickly than a utility application and some procedures available for expediting prosecution are different (see Expediting Design Application Prosecution).
- A new design patent's enforceable term is 15 years from its issue date, with no maintenance fees necessary (see 15 Year Term from Issuance).
- Filing, search, and examination fees for design patent applications are lower than the corresponding utility patent application fees. Design patent application issue fees are slightly higher than utility patent application issue fees. (See [USPTO: Patent Application Filing Fees](#).)
- A USPTO design patent practitioner or patent practitioner can prosecute a design patent application (MPEP § 1502.02; see [Legal Update, USPTO Begins Accepting Applications for New Design Patent Bar](#)).

(See Design and Utility Patent Application Comparison Table.)

US Design Applications Not Published

Unlike utility patent applications, the USPTO does not publish design patent applications (35 U.S.C. § 122(b)(2)(a)(iv)). Instead, a design patent becomes public only on its issue date, at which time its file history also becomes publicly available (37 C.F.R. § 1.11(a)). Once issued, the design patent qualifies as prior art at its effective filing date (35 U.S.C. § 102(a)(2)). For

information on determining prior art status of a design patent, see [Practice Note, Prior Art: Determining the Status of a Reference](#).

In contrast, international design patent applications filed under the Hague Agreement are typically published 12 months after filing, unless the applicant requests earlier publication. Additionally, the US prosecution files of international design applications designating the US are publicly available throughout their US examination (see National Examination of Hague Agreement Applications).

15 Year Term from Issuance

The enforceable term of a design patent is 15 years from its issue date for applications filed on or after May 13, 2015 (35 U.S.C. § 173). For design patents issuing from applications filed before that date, the term is 14 years from the issue date. Unlike utility patents, design patents are not eligible for patent term adjustment (PTA) under 35 U.S.C. § 154(b) (MPEP §§ 1504.04 and 2710). For information on PTA, see [Practice Note, Patent Term Adjustment](#). However, design patent applications are potentially subject to double patenting conflicts with other design patents (MPEP § 1504.06; see [Practice Note, Double Patenting: Design and Design-Utility ODP Rejections](#)).

Duty of Disclosure

Patent applicants' duty of candor and information disclosure statement (IDS) practice apply to design applications (37 C.F.R. § 1.56). As with utility and plant patent applications, the duty is typically satisfied by disclosing all known information material to patentability in one or more IDSs (37 C.F.R. § 1.97).

Counsel should consider IDS timing in design patent applications, particularly in relation to the examiner's first action. If the examiner allows the application without a first office action or issues an *Ex parte Quayle* action, prosecution on the merits is closed (see *Ex Parte Quayle* Action). Accordingly, if the applicant still needs to file an IDS, it may be necessary to file a continuation patent application (CPA), which will incur additional fees and delay to have it considered.

The fees for filing IDSs that cause the cumulative number of applicant-provided references to exceed 50 (37 C.F.R. § 1.17(v)(1)), 100 (37 C.F.R. § 1.17(v)(2)), and 200 (37 C.F.R. § 1.17(v)(3)) items of information apply to both design and utility patent applications.

For more information on the USPTO duty of candor and information disclosure and compliance practices, including the content and timing of filing an IDS, see [Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure](#).

National Examination of Hague Agreement Applications

An international design patent application filed under the Hague Agreement system is normally published 12 months after its international registration date with the possibility of damages based on provisional rights (MPEP § 2901(II)(C)); see [Practice Note, US Design Patents and the Hague Agreement Concerning Industrial Designs: Provisional Rights](#).

Unlike a PCT application, substantive national examination of a Hague Agreement international design patent application starts automatically after its publication and is usually completed within 12 months after of the international application's publication (37 C.F.R. § 1.1062; MPEP § 2920.05; see [Practice Note, US Design Patents and the Hague Agreement Concerning Industrial Designs: National Examination](#)).

In some instances, it may be desired to convert an international (Hague Agreement) design application designating the US to a regular US design patent application. Conversion is only possible before the international design application's publication and requires a grantable petition under 37 C.F.R. § 1.1052(a) (MPEP § 2914).

For more information, see [Practice Note, US Design Patents and the Hague Agreement Concerning Industrial Designs: Notable Rules of Practice Concerning US-Designated IDAs](#).

Design Application Filing and Initial Processing

Successful prosecution of design patent applications depends on good planning and execution during initial preparation and filing, since no new matter may be added after the filing date.

To receive a filing date, a US design patent application must include at least:

- A specification, including a single claim.
- Drawings.

(37 C.F.R. 1.53(b); MPEP § 1503.)

Design patent applicants should pay particular attention to:

- The availability and timing of benefit and priority claims (see [Benefit and Priority Claims](#)).
- The drawings and issues pertaining to the inclusion of color or photographs (see [Design Drawings Including Color Drawings](#)).
- Filing a power of attorney with the application or as soon thereafter as possible (see [Power of Attorney](#)).
- Foreign filing and foreign filing license considerations (see [Foreign Filing](#)).

Applicants should also consider options for expediting prosecution, some of which are different in design patent applications than in utility patent applications (see [Expediting Design Application Prosecution](#)).

For detailed information on preparing and filing design patent applications, see:

- [Practice Note, Design Patents: Overview: Design Patent Application](#).
- [Practice Note, Patent Prosecution: Preparing and Filing Design Patent Applications](#).
- [Standard Document, Design Patent Application](#).

For a collection of resources concerning patent application preparation and filing, see [Patent Application Preparation and Filing Toolkit](#).

For the requirements of a Hague Agreement international design application (37 C.F.R. §§ 1.1021 to 1.1025), see [Practice Note, Patent Prosecution: Preparing and Filing Design Patent Applications: Filing an International Design Patent Application](#).

Benefit and Priority Claims

When prosecuting a design patent application, counsel must understand important differences in the relevant requirements for claiming domestic benefit and foreign priority that differ from the corresponding utility application provisions.

Foreign Priority Claims

To claim priority of a foreign application, a US design patent application must be filed within six months after the earliest date on which any foreign application disclosing the claimed design was filed (35 U.S.C. § 172; MPEP § 1504.10). An unintentional delay in filing the US design patent application of

up to two months from the expiration of this six-month window may be excused by petition under 37 C.F.R. § 1.55(c) (MPEP § 213.03).

The applicant must claim priority and file a certified copy of the foreign priority document during the design patent application's pendency (37 C.F.R. § 1.55(g)), and before the issue fee is paid to assure inclusion of the priority data on the issued design patent. An unintentional delay in filing the priority claim after the design patent issues may be excused by petition under 37 C.F.R. § 1.55(e). The certified copy deadline for utility applications (the later of four months from filing or 16 months from the earliest priority date under 37 C.F.R. § 1.55(f)(1)) does not apply to design patent applications.

Despite the later deadline, design patent applicants should not delay filing the certified copies (or [World Intellectual Property Organization Digital Access Service](#) (DAS) codes, if the priority application was filed in a country that provides electronic access to certified priority documents through the World Intellectual Property Organization (WIPO)). For information on the electronic document exchange, see [USPTO: Electronic Priority Document Exchange \(PDX\) Program](#). If a certified copy of a foreign priority application is not filed (or if the USPTO's retrieval of the certified copy cannot be confirmed) before the issue fee is paid, the USPTO may omit the foreign priority data from the design patent's front page. This can result in a defective priority claim. (37 C.F.R. § 1.55; MPEP § 215.02.) Additionally, patent counsel must confirm that the relevant priority document (or document to which the DAS Code applies) is the priority application as filed, as opposed to a granted design registration or other publication of the priority design.

If the applicant does not timely file the certified copy of the foreign priority document, a design patent can be corrected by certificate of correction with a grantable petition showing good and sufficient cause for the delay (37 C.F.R. § 1.55(g); MPEP § 216.01).

For more information on making and correcting foreign priority claims, see [Practice Note, Patent Prosecution: Domestic Benefit and Foreign Priority Claims: Foreign Priority Claim Requirements](#) and [Late and Corrected Domestic Benefit and Foreign Priority Claims](#).

Domestic Benefit Claims

A design patent application may not claim the benefit (35 U.S.C. § 119(e)) of a provisional patent application filed under 35 U.S.C. § 111(b).

However, continuing patent application practice under 35 U.S.C. § 120 (continuation, divisional, and continuation-in-part (CIP) applications) is permitted for design patent applications as for utility applications (MPEP § 1504.20; see [Continued Prosecution Applications and Continuing Applications](#)).

Design Drawings Including Color Drawings

With careful planning and high-quality drawings prepared following the USPTO's guidelines for design patent application drawings, design patent prosecution can proceed smoothly. For information on preparing drawings, see [Practice Notes, Patent Prosecution: Preparing and Filing Design Patent Applications: Formal Drawings](#) and [Patent Drafting: Preparing Formal Drawings](#).

It is unnecessary to file a petition to include color drawings or photographs in a design patent application (37 C.F.R. § 1.84; MPEP § 1503.02). However, the USPTO does not permit the use of both line drawings and photographs as different views of a single embodiment within a design patent application (37 C.F.R. § 1.152). The specification of an application that includes photographs or color drawings must contain, or be amended to contain, the statement "The file of this patent contains at least one drawing/photograph executed in color. Copies of this patent with colored drawing(s)/photograph(s) will be provided by the Office upon request and payment of the necessary fee." (37 C.F.R. § 1.84(a)(2)(iii); see [Practice Note, Patent Prosecution: Preparing and Filing Design Patent Applications: Representing Color](#).)

Power of Attorney

In 2024, the USPTO introduced a separate design-only patent practitioner bar. This form of practitioner registration authorizes individuals with educational backgrounds in non-technical disciplines including industrial design, product design, architecture, applied arts, graphic design, fine and studio arts, or art teacher education, or a degree equivalent to one of these degrees, and who meet other eligibility requirements, to obtain agent or attorney registration to represent others only in design patent matters. A practitioner holding either a regular or design registration may handle design patent application matters at the USPTO ([Practice Note, USPTO Patent Prosecution Professional Responsibility: Overview](#):

[USPTO Registration and Rules of Professional Conduct](#); see [Legal Update, USPTO Issues Final Rule Establishing Separate Design Patent Bar](#)).

Whether practicing as a design-only USPTO practitioner or under standard patent attorney or patent agent registration, counsel should file a power of attorney (POA) with the design patent application or as soon as possible after filing. Design patent examiners often issue restriction requirements or propose amendments by telephone to streamline prosecution, but they are not permitted to contact registered representatives of design patent applicants unless an accepted power of attorney is on file. Without an accepted POA, the examiner may not initiate a telephone interview that might place the application in condition for allowance, or in better condition for examination on the merits, and instead may proceed directly to issuing a written restriction requirement or other office action. For information on client engagement and powers of attorney, see [Practice Notes, Patent Prosecution: Power of Attorney and Acting in a Representative Capacity](#) and [USPTO Patent Prosecution Professional Responsibility: Overview](#).

Foreign Filing

Under the Paris Convention, the deadline to file corresponding design applications outside the US that claim priority to a US design patent application is six months from the earliest US filing date (unlike the 12-month window for claiming priority to utility patent applications).

If the first-filed application is filed with the USPTO, applications outside the US should not be initiated until an official filing receipt is received with an indication that a foreign filing license is granted. For designs invented in the US, if the first-filed application is to be filed with a patent office other than the USPTO (or on the same date), the applicant should first file a petition with the USPTO for an expedited foreign filing license and file the non-US applications only after receiving the license. A Hague Agreement international application may be filed with the USPTO as an office of indirect filing or the International Bureau (IB) of WIPO. If filed with the IB, the applicant must first obtain a foreign filing license from the USPTO.

For information on foreign filing licenses, see [Patent Prosecution: Foreign Filing License Checklist](#) and [Practice Note, Patent Prosecution: Petitions: Expedited Foreign Filing License](#).

Expediting Design Application Prosecution

Regular design patent application prosecution is typically faster than utility applications. USPTO data available at its [Data Visualization Center](#) show design application filings and the USPTO's inventory of pending applications are growing. For fiscal year 2024, applicants filed about 63,000 design patent applications (up from about 38,000 in 2015) and the USPTO held an inventory of about 82,000 unexamined applications (up from about 39,000 in 2015). By comparison, the unexamined utility application inventory was about 800,000 in 2024. The average time a design application is pending before a first office action was 16 months in 2024 (up from 14 months in 2015). This compares to about 23 months for a utility patent application. The allowance rate for design patent applications is consistently over 80%.

To expedite design patent application prosecution, applicants can:

- Petition for accelerated examination with the required documentation (see [Accelerated Examination](#)).
- File a petition to make special based on the inventor's age or health (37 C.F.R. § 1.102(c); see [Practice Note, Expediting Patent Prosecution: Petitions to Make Special Based on Applicant's Health or Age](#)).
- With a Hague Agreement international design application designating the US, request early publication. Designated offices that require substantive examination, including the USPTO, have 12 months from a Hague application's publication date to conduct a substantive examination and issue a notice of allowance or final rejection (37 C.F.R. § 1.1062(b); MPEP § 2920.05).

Procedures not available for design patent applications include:

- Prioritized (Track One) examination under 37 C.F.R. § 1.102(e).
- Expedited examination under 37 C.F.R. § 1.155 (90 Fed. Reg. 39124 (Aug. 14, 2025); see [Legal Update, USPTO Suspends Expedited Examination of Design Patent Applications](#)).
- The Global Patent Prosecution Highway.
- The Quick Path IDS program.

- The Expanded Collaborative Search Pilot program.

For more information on expediting patent prosecution, see [Practice Note, Expediting Patent Prosecution](#) and [Expediting Patent Prosecution Chart](#).

Accelerated Examination

Although the USPTO terminated the accelerated examination program for utility patent applications, design patent applicants can petition for accelerated examination (a procedure distinct from the now-terminated 37 C.F.R. § 1.155 expedited examination of design applications process). The requirements for a grantable petition to accelerate examination are stringent. The applicant must file the petition with the application, and the petition must be accompanied by a fee, a pre-examination search, and an examination support document, including an IDS. Additionally, for each reference listed in the IDS, the applicant must provide a detailed explanation of how the claimed design is patentable over the reference. (37 C.F.R. § 1.102; MPEP § 708.02(a); [Practice Note, Expediting Patent Prosecution: Accelerated Examination for Design Patent Applications](#) and [Legal Update, USPTO Discontinues Accelerated Examination Program for Utility Patent Applications](#).)

Responding to Restriction Requirements

Examiners frequently raise restriction requirements asserting that an application's drawings showing multiple versions, or embodiments, of a claimed design are independent and distinct (35 U.S.C. § 121; 37 C.F.R. §§ 1.141 and 1.142; MPEP § 1504.05). The USPTO applies the Section 103 obviousness standard to determine whether multiple embodiments of a claimed design are distinct or involve a single inventive concept (MPEP § 1504.05(II)(A)). Designs are independent if they are embodied in two or more articles with no apparent relationship (MPEP § 1504.05(I)). However, restriction is unnecessary if different embodiments of a design patent application are considered patentably indistinct from one another (*In re Rubinfield*, 270 F.2d 391 (C.C.P.A. 1959)).

The applicant's response to a restriction requirement must at least provisionally elect one of the versions, or embodiments, even if challenging (traversing) the restriction. The election response may challenge (traverse) the restriction requirement with written arguments and request withdrawal or modification

of the requirement (37 C.F.R. § 1.143). If the applicant is not traversing the restriction, the response should cancel the drawing figures showing each non-elected design embodiment, along with the corresponding descriptions of those figures (see [Amending the Application](#)). The initial (extendable) time period in which to respond to a written restriction requirement is two months, as opposed to three months for substantive office actions. After timely traversing an initial restriction requirement, the applicant may petition from a final restriction requirement (37 C.F.R. § 1.144; MPEP § 808.01).

An important consideration after responding to a restriction requirement is the potential need to file divisional patent applications directed to non-elected embodiments before the issuance or abandonment of the application in which the restriction requirement is raised. A divisional application is generally shielded from obviousness double patenting (ODP) under the safe harbor of 35 U.S.C. § 121. Additionally, not filing a divisional application could be construed (due to prosecution history estoppel) as dedicating to the public any non-elected designs that are not pursued in divisional applications. (See [Divisional Applications](#).) Therefore, the decision of whether to traverse a restriction requirement should weigh the potential benefits of the safe harbor against the disadvantages of having to file multiple design applications to cover each of the original design embodiments.

When responding to a restriction requirement during the USPTO examination of a Hague Agreement international design application, it is necessary to preserve the original figure numbering from the international application. For example, if the figure numbering of the original application included two embodiments in figures 1.1, 1.2, 1.3, ..., 2.1, 2.2, 2.3, ..., and the second embodiment is elected, the figures of the elected embodiment must maintain the "2.1, 2.2, 2.3, ..." numbering (MPEP § 2909.02). However, the figures of a divisional application directed to the non-elected embodiment should be renumbered, according to the US rules, consecutively as "1, 2, 3, ..." (37 C.F.R. §§ 1.84(u) and 1.152).

If joint inventors are named in a multi-embodiment design patent application, counsel should reevaluate the application's inventorship when making an election in case one or more of the named individuals made an inventive contribution to less than all the originally filed embodiments. For information on inventorship determinations, see [Practice Note, Patent](#)

[Inventorship Determinations, Joint Inventorship, and Correction Proceedings: Inventor or Joint Inventor of at Least One Claim.](#)

For more information on restriction requirements, see [Practice Notes, Patent Prosecution: Preparing and Filing Design Patent Applications: Restriction Practice](#) and [Patent Prosecution: Overview: Responding to a Restriction Requirement.](#)

Responding to Non-Final and Final Office Actions

The timing, procedural requirements, and response options during prosecution on the merits are similar for design and utility patent applications. As with utility patent applications, the applicant's response to a non-final rejection is under 37 C.F.R. § 1.111. (See [Practice Notes, Patent Prosecution: Overview: Responding to the Initial Non-Final Office Action](#) and [USPTO Patent Office Action Responses.](#))

A design examiner's office action may include any of the following, which can require design-specific response tactics:

- Alleged indefiniteness or lack of written description under Section 112 is a common design patent application rejection (see [Definiteness and Written Description](#)).
- Objections asserting non-compliance with USPTO design patent drawing standards (see [Amending the Drawings](#)).
- Prior art rejections (see [Prior Art Rejections](#)).

The response may:

- Require application amendments (see [Amending the Application](#)).
- Warrant requesting an examiner interview (see [Examiner Interviews](#)).

After a final rejection, a design patent applicant has limited procedural options (see [Responding to a Final Office Action](#)).

For a collection of resources concerning office action responses, see [USPTO Patent Office Action Response Toolkit](#).

Definiteness and Written Description

The USPTO may reject a design patent application under Section 112(b) as indefinite for alleged

ambiguities or inconsistencies between different drawing figures, poor line quality, or lack of (or improper) shading. If a rejection relies on minor inconsistencies between views or drafting errors, counsel should consider:

- Amending the drawing figures as necessary to resolve the inconsistencies (provided this can be accomplished without impermissibly adding new matter).
- Arguing that any errors or inconsistencies do not render the claimed design indefinite, as the drawings are sufficient to reasonably appraise one skilled in the art for the metes and bounds of the invention under the ordinary observer test (see *Ex parte Asano*, 1978 WL 21280, at *3 (B.P.A.I. Nov. 27, 1978); MPEP § 1504.04(II); see [Legal Update, Ordinary Observer Test for Design Patent Definiteness: Federal Circuit](#)).

A written description rejection may assert a lack of support in the application as originally filed for a drawing amendment (MPEP § 1504.04(I)(B), (C)). If the rejection resulted from a drawing amendment made to clarify a detail of the claimed design, counsel should consider:

- Further amending the drawing figures to disclaim the relevant detail that was originally unclear, such as by converting solid lines to broken lines or representing the disclaimed detail in half-tone relative to the positively claimed portions of the drawing figures.
- Amending the specification to include a statement that the disclaimed aspects designate portions of the article, or environment (if applicable), that form no part of the claimed design.

For information on Section 112 compliance in design patent applications, see [Practice Note, Patent Prosecution: Preparing and Filing Design Patent Applications: Section 112 Compliance Considerations](#).

Prior Art Rejections

Obtaining Higher Resolution Prior Art Drawings

If the body of an examiner's office action includes embedded copies of drawings from the application or the prior art, such as annotated figures or portions of figures, it can be helpful to download a higher quality DOCX version of the office action from the

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USPTO's [Patent Center](#). This is because embedded images can become pixelated when converted to PDF format and may not have sufficient detail or resolution necessary to fully appreciate, and if necessary, convey all aspects of an objection or rejection to an inventor or draftsman.

If the office action relies on prior art design patents in rejecting a claimed design, counsel should consider downloading a high-resolution version of the drawings of the cited patents. High resolution versions of design patents are often accessible in the Patent Center system under "Supplemental Content," often listed in connection with a tab such as "US Patent Color" (even if the drawings are not actually in color) or "Design Drawings." For newer design patents, an eGrant of the design patent may be available to download from the "Application Data" tab, which is higher resolution than the copy of the design patent retrieved using the USPTO's Patent Public Search tool. Subtle, but potentially important, distinctions may exist between a claimed design and a prior art design that might not immediately be visible when comparing a lower-resolution image of a prior art design patent to drawings of the claimed design but become more apparent when comparing a high-resolution image of the prior art drawings to the claimed design. (See [Panasonic Corp. v. Getac Tech. Corp.](#), 19-cv-01118 (C.D. Cal. Aug. 3, 2020) (claim construction order recognizing image degradation in issued design patents and determining it appropriate to reference the higher resolution images available electronically from the USPTO Supplemental Complex Repository for Examiners ("SCORE") to determine the scope of a design patent).)

Novelty

Under the ordinary observer test, a design patent claim is anticipated under Section 102 if a single prior art reference discloses a design for the same article of manufacture as claimed, which would appear to an ordinary observer to be substantially the same as the claimed design. In addition to arguing differences in designs, applicants can challenge an anticipation rejection based on an applied prior art reference does not disclose a design for the same article of manufacture as the claimed design. (*In re SurgiSil, L.L.P.*, 14 F.4th at 1382; MPEP § 1504.02; see [Practice Note, Design Patents: Overview: Novelty](#).)

Counsel should also consider how the prior art drawings appear relative to the drawings of the claimed design from all angles of a multi-view

design. Differences, even in only one or a few views, may support an argument that the differences would be important to an ordinary observer or result in a substantially different overall design, notwithstanding similarities between views from one or more individual directions.

For general information on Section 102 anticipation and responding to anticipation rejections, see [Practice Notes, Patent Litigation: Anticipation Defense and Patent Prosecution: Patent Document and Printed Publication Prior Art Rejections \(Predictable Technologies\): Section 102 Rejection and Response](#).

Nonobviousness

The USPTO applies a flexible approach to Section 103 obviousness of designs, similar to that for utility patent applications. Under *KSR Int'l Co. v. Teleflex Inc.* and *LKQ Corp.*, the examiner makes factual determinations about the scope and content of the prior art, differences between the prior art and the claimed design, and the level of ordinary skill in the art. Evidence of secondary considerations, such as commercial success and industry acclaim, might also be relevant, and if submitted, must be considered. (*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007); *LKQ Corp.*, 102 F.4th at 1291; MPEP § 1504.03.)

A proper obviousness rejection must identify a primary reference. This reference need not be "basically the same" as the claimed design, but needs to be:

"[S]omething in existence—not...something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature."

(*LKQ Corp.*, 102 F.4th at 1298 (quoting *In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950)).)

The primary reference is typically in the same field of endeavor as the article of manufacture of the claimed ornamental design, but it need not be if the primary reference is analogous art. The rejection can rely on the primary reference alone or incorporate design elements from secondary prior art references. Next, the differences between the prior art designs and the claimed design must be determined, comparing the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field

of the claimed article of manufacture. The examiner should also consider the knowledge of a designer of ordinary skill who designs articles of the type being examined. (*LKQ Corp.*, 102 F.4th at 1298-1300.)

The rejection should identify the claim as obvious under Section 103 if an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the design of the primary reference to create the same overall visual appearance as the claimed design (*LKQ Corp.*, 102 F.4th at 1299; MPEP § 1504.03; [USPTO: Updated Guidance and Examination Instructions for Making a Determination of Obviousness in Designs in Light of *LKQ Corp. v. GM Global Technology Operations LLC* \(May 22, 2024\)](#)).

One way to challenge an obviousness rejection is to challenge the prior art based on that it is not a design for an article of manufacture in the same field of endeavor as, or analogous to, the article of manufacture of the claimed design (see *LKQ Corp.*, 102 F.4th at 1297, 1298).

As with an anticipation rejection, counsel should consider how the prior art drawings applied in an obviousness rejection appear relative to the drawings of the claimed design from all angles of a multi-view design. If there are differences, even in only one or a few views, the response can explain that these differences would be important to an ordinary designer in the field to which the claimed design pertains or result in a substantially different design.

If relying on evidence of objective indicia of nonobviousness, such as commercial success or industry acclaim, it can be difficult to establish the necessary nexus between successful sales and a claimed design, particularly if the drawings of the design patent application disclaim significant aspects of the article of manufacture that gave rise to the sales to be relied on (see *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1277 (Fed. Cir. 2021)). A nexus between evidence of secondary considerations of nonobviousness, such as commercial success or industry acclaim, is presumed if the evidence is tied to a specific product that is coextensive with the claimed invention, meaning that the product “is the invention disclosed and claimed” (*Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988))).

The *Campbell Soup* court explained:

”A product is ‘essentially the claimed invention’ when, for example, ‘the unclaimed features amount to nothing more than additional insignificant features.’”

”In determining coextensiveness, the question is not whether unclaimed features are insignificant *to a product’s ornamental design*. The question instead is whether unclaimed features are ‘insignificant,’ period.”

”[W]e reject the proposition that a product satisfies the coextensiveness requirement in the design patent context merely if its unclaimed features are *ornamentally* insignificant.”

(*Campbell Soup Co.*, 10 F.4th at 1276-77 (emphasis original; citations omitted).)

For information on secondary considerations in the utility patent context, see [Practice Note, Patent Litigation: Obviousness Defense: Secondary Considerations of Nonobviousness](#).

Amending the Application

Design patent applications are amended in generally the same manner as utility applications (see [Practice Note, USPTO Patent Office Action Responses: Amendments](#)).

Amending the Drawings

Drawing amendments may be necessary in response to an examiner’s objections (see [Design Drawings Including Color Drawings](#)).

The response should present drawing amendments as:

- A clean set of the amended drawings with each sheet provided under the header “Replacement Sheet.”
- Although not required, a set of corresponding marked-up sheets under the header “Annotated Sheet,” with annotations describing the amendments and drawing edits indicated in red or by highlighting, and changes to figure numbering indicated with strike throughs and underscores.

(37 C.F.R. §§ 1.84 and 1.121(d); see [Practice Note, Patent Drafting: Preparing Formal Drawings: Drawing Correction Procedures](#).)

When responding to an office action with drawing amendments, the body of the written office action

response should summarize the amendments to each figure, such as in a section captioned “Amendments to the Drawings” (see [Practice Note, Patent Drafting: Preparing Formal Drawings: Post-Filing Drawing Procedures](#)).

Amending the Specification

Minor specification amendments can be made in the body of the response, such as in a section captioned “Amendments to the Specification.” More extensive amendments may be presented as both marked-up and clean versions of a substitute specification (see [Practice Note, USPTO Patent Office Action Responses: Specification Amendments](#)). The headers of both the marked up and clean versions of the substitute specification should indicate the version (marked up or clean) of the substitute specification, and that no new matter is added.

Amending the Claim

Amendments to the written claim of a design patent application should appear on a separate page of the response. Because there is only one claim in a design application, the claim should not be numbered, and the section should have the heading “Amendments to the Claim” or “Claim Amendments.”

Examiner Interviews

Before submitting a written response to a USPTO office action, the applicant should consider interviewing the examiner (37 C.F.R. § 1.133), which can advance prosecution by building a mutual understanding of the issues.

Before the interview, it can be helpful to file an authorization for internet communications in a patent application ([USPTO: Form PTO/SB/439](#)) and email the examiner a proposed amendment, proposed annotated sheets (showing amendments), and proposed clean replacement sheets (incorporating proposed drawing amendments).

After the interview, the examiner and the applicant exchange written interview summaries to make the substance of the interview part of record (37 C.F.R. §§ 1.2 and 1.133; MPEP 713.04). The applicant should submit an interview summary within 30 days after the interview or with the next office action response. In some cases, the examiner may issue an interview summary indicating that an applicant interview summary is unnecessary.

The examiner may grant an interview after a final office action but is not required to do so (see [Responding to a Final Office Action](#)).

For more information on examiner interviews and arranging interviews, see [Practice Note, Patent Prosecution: Examiner Interviews and Standard Document, Examiner Interview: Agenda Letter \(Patent\)](#).

Responding to a Final Office Action

The examiner typically makes the second office action final (37 C.F.R. § 1.113), after which the applicant’s response options are more limited than in responding to a non-final action (see [Practice Note, Patent Prosecution: Overview: Final Office Action](#)).

One of the following must occur by the response deadline:

- The USPTO allows the application based on the applicant’s response to the final action (see [Allowance and Issue](#)).
- The applicant files a CPA (see [Continued Prosecution Applications](#)).
- The applicant files a notice of appeal to the PTAB (37 C.F.R. § 41.31). For information on PTAB appeals and judicial review, see [Practice Note, Patent Prosecution: PTAB Appeals](#).
- The application becomes abandoned, which can be in favor of a new continuing application (see [Continuations, Continuations-in-Part, and Divisionals](#)).

(37 C.F.R. § 1.116.)

The examiner may, but is not required to, grant an interview after a final office action. MPEP Section 713.09 provides that a single after-final interview may be granted if the examiner is convinced, after being briefly presented with the purpose and proposed content of the interview, that allowance or clarification for an appeal is likely with only nominal further consideration. After a final office action in a design patent application, it may still be possible to submit amendments and arguments, particularly if minor, to obtain allowance. Applicants have an incentive to file a response within two months after a final office action because examiners are encouraged to issue an advisory action, if not allowing the application, before the initial three-month response due date. This, in turn, should leave the applicant enough time to file a

CPA (37 C.F.R. § 1.53(d)) or a continuation application (35 U.S.C. § 120) without having to pay extension of time fees (MPEP § 706.07(f); see [Practice Note, Patent Prosecution: Final Rejections: Variable Three-Month Reply Period](#); see also Continued Prosecution Applications and Continuing Applications).

For more information about responding to final office actions, see [Practice Note, Patent Prosecution: Final Rejections](#).

Ex Parte Quayle Action

When a design patent application is in condition for allowance except for minor formalities, such as the wording of figure descriptions, the need to delete non-elected drawing figures, or for clarification of a broken line disclaimer statement, the examiner may issue an *Ex parte Quayle* action. This action closes prosecution on the merits and sets a shortened statutory period of two months (extendable by up to an additional four months) in which the applicant can file a response addressing the formal objections (MPEP § 714.14).

Allowance and Issue

The examiner issues a notice of allowability when the application is in condition for allowance. The issue fee is due three months after notice of allowance, which deadline is non-extendable (37 C.F.R. § 1.311(a)).

A key decision after allowance is whether to file:

- A divisional application to claim non-elected subject matter canceled in response to a restriction requirement (see [Responding to Restriction Requirements and Divisional Applications](#)).
- A continuation application to pursue variations of the allowed design (see [Continuations, Continuations-in-Part, and Divisionals](#)).

After the applicant pays the issue fee, the USPTO provides a notification with a scheduled issue date and design patent number. The patent electronically issues in as little as three to four weeks after the issue fee payment. Therefore, applicants should file any continuing applications as soon as possible after receiving a notice of allowance to maintain the necessary copendency (see [Practice Note, Patent](#)

[Prosecution: Continuing Patent Applications: File a Continuing Patent Application by the Issue Date](#)).

Applicants should consider obtaining and recording a newly executed confirmatory assignment from all inventors to preserve assignor estoppel against post-issuance validity challenges by the inventors (see *Minerva v. Hologic*, 594 U.S. 559, 576 (2021)). In one case, a district court order deemed the Federal Circuit's 2024 en banc *LKQ* decision (see [Nonobviousness](#)) a “material change in the law” of obviousness, such that a design patent assigned pre-*LKQ* was not subject to assignor estoppel, even though the patent was not substantively amended after the assignment was executed (*Kong Company v. Bounce Enterprises, LLC*, 1:22-cv-02001-DDD-SBP (D. Colo. Mar. 27, 2025) (Order Granting in Part Plaintiff's Motion for Partial Summary Judgment on Assignor Estoppel)).

For general information on patent assignments and assignor estoppel, see [Practice Notes, Patent Prosecution: Ownership and Assignment](#) and [Patent Litigation: Assignor Estoppel Doctrine](#).

In addition, applicants must reconfirm their entity status for fee payments before paying the issue fee. If the applicant is no longer eligible for micro or small entity status, counsel should file a change of status and pay the issue fee at the appropriate rate, even if the notice of allowance listed an issue fee at a discounted rate. If the application was filed under micro-entity status, it is necessary to re-evaluate whether the application still qualifies for micro-entity status each time a fee is paid, including the issue fee. (37 C.F.R. § 1.29; see [Practice Notes, Patent Prosecution: Official Fee and Expense Considerations: Applicant Entity Size](#) and [USPTO Patent Prosecution Professional Responsibility: Overview: Practitioner's Implied Certifications When Filing Papers](#).)

For more on allowance and issue generally, see:

- [Practice Note, Patent Prosecution: Overview: Allowance and Issue](#).
- [Allowed Patent Application Review Checklist](#).
- [Issued Patent Review Checklist](#).

For a collection of resources concerning patent application allowance and issue, see [Patent Allowance and Issuance Toolkit](#).

Continued Prosecution Applications and Continuing Applications

Continued Prosecution Applications

US design patent applicants are not eligible to file RCEs (37 C.F.R. § 1.114(e)(4)). However, design patent applicants may instead file a CPA, which serves a similar purpose and has a similar effect to an RCE (37 C.F.R. § 1.53(d); MPEP § 201.06(d)), if the application was not initiated as the US designation of an international Hague Agreement design patent application (designated by a “35/” two-digit series number of an 8-digit application number (XX/YYY,YYY)).

Continuations, Continuations-in-Part, and Divisionals

A design patent application can claim the benefit of an earlier filed design or non-provisional utility patent application (35 U.S.C. § 120; MPEP § 1504.20).

Even if there was no restriction requirement during prosecution, a continuation application can be used to pursue variations of the original design, such as by converting between solid and broken lines or by including embodiments previously canceled by preliminary amendment. Converting original solid line structure to broken lines, or original broken line structure to solid lines, is not considered new matter (MPEP § 1504.04). The continuation application's claimed design must be fully supported in the parent application to be entitled to its earlier filing date (*In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013)).

For information about continuing application practice and filing conditions and requirements, see [Practice Note, Patent Prosecution: Continuing Patent Applications](#).

The USPTO fees for filing continuing applications with a benefit claim more than six years (37 C.F.R. § 1.17(w)(1)) and more than nine years (37 C.F.R. § 1.17(w)(2)) from the earliest application to which priority benefit is claimed applies to design patent applications (see [Practice Note, Patent Prosecution: Continuing Patent Applications: Additional Fees for Continuing Applications Filed After More Than Six and Nine Years](#)).

Divisional Applications

In a design patent application that is subjected to restriction, it is important to consider filing a divisional application during its pendency to claim any disclosed design embodiments that were withdrawn and canceled in response to a restriction requirement.

Failure to file divisional applications to pursue non-elected designs can be considered a form of file history estoppel, effectively dedicating those non-elected designs to the public (*Pac. Coast Marine Windshields*, 739 F.3d at 694, 702-03; but see *Advantek Mktg., Inc. v. Shanghai Walk-Long Tools Co.*, 898 F.3d 1210, 1217 (Fed. Cir. 2018) (holding that no estoppel or surrender applies where the elected design embodiment was broader than, and encompassed, a narrower non-elected embodiment)). Additionally, a divisional design patent application filed as a result of a restriction requirement is protected by Section 121's safe harbor, preventing a design patent that issues on either application from being used as an ODP reference against the other, either in the USPTO or in the courts (35 U.S.C. § 121; *Boehringer Ingelheim Int'l GmbH v. Barr Lab'ys, Inc.*, 592 F.3d 1340, 1353 (Fed. Cir. 2010)).

A practical implication is that a terminal disclaimer is not necessary because there would be no ODP conflict with the originally restricted design patent or application. Further, because US design patents have a term of 15 years from their issue date (rather than a term calculated based on an earliest non-provisional filing date, as is the case for utility patents), a series of divisional design patents can be filed and prosecuted so that the last-to-issue design patent expires significantly later than the first-to-issue design patent. To maintain the consonance necessary to preserve the safe harbor, a divisional application must be filed “as a result of” a restriction requirement in the immediately preceding application. (See [Practice Note, Double Patenting: Divisional Application Double Patenting Safe Harbor](#).)

A divisional design application filed because of a multi-way restriction should include all non-elected embodiments of the parent design patent application. Supplying a copy of the restriction requirement from the parent application (such as by identifying the restriction requirement in an IDS filed with the first divisional design patent application) encourages the examiner to make a similar restriction requirement in the first divisional application, which may be desirable

Design Patent Application Prosecution

to maximize the safe harbor benefits of 35 U.S.C. § 121 and the later-expiring terms of design patents issuing on divisional applications.

On the other hand, filing a preliminary amendment canceling all but one embodiment to avoid a restriction requirement carries risk. This tactic, while preserving the potential right to file a further application directed to other non-elected design embodiments from the parent case, jeopardizes the ODP safe harbor protection for these future divisionals, as each subsequent divisional application would be subject to an argument that it was not filed as a direct result of a restriction requirement in its immediately preceding parent application. (See *Boehringer Ingelheim Int'l GmbH*, 592 F.3d at 1353; *Ex parte Sauerberg*, 2017 WL 150016 (P.T.A.B. Jan. 10, 2017).)

Continuation-in-Part Applications

CIP applications are available as a form of continuing application for design patent applications (37 C.F.R. § 1.53(b)). However, because design patent applications only include one claim to an overall design, any new matter introduced when filing a continuing application would likely deprive the claimed design of the benefit of the filing date of any earlier application. This contrasts with a utility CIP where different claims may have different effective filing dates. Unless there is a particular strategic reason for filing a design CIP, such as to preserve a potential continuity claim for one or more subsequent applications, a CIP application may not be as practical an option in the design patent context as one may be in utility patent practice.

Post-Grant Considerations

The term of a design patent issuing on an application filed on or after May 13, 2015 is 15 years from its issue date (35 U.S.C. § 173) and PTA is not available (MPEP § 2710; see 15 Year Term from Issuance).

No maintenance fees are required to keep a design patent in force for its full term (37 C.F.R. § 1.362(b)). Although maintenance fees are not required, it is important to keep representative address information current with the USPTO even post-issuance to assure timely receipt of documents, such as third party PTAB petitions.

Design patent owners should consider marking patented products (or employing suitable virtual patent marking practices) to maximize the right to collect damages (35 U.S.C. § 287).

Like utility patents, design patents are subject to post-grant challenges, including ex parte reexaminations, petitions for post-grant review, and petitions for *inter partes* review (IPR). For more information concerning USPTO post-prosecution proceedings, see [Practice Note, USPTO Post-Prosecution Patentability Proceedings](#) and [USPTO Post-Prosecution Patentability Proceedings Chart](#).

For information on patent correction proceedings, see [Practice Notes](#):

- [Patent Correction: Reissue Applications](#).
- [Patent Correction: Statutory and Terminal Disclaimers, Certificates of Correction, and Inventorship](#).
- [Ex Parte Patent Reexamination and Supplemental Examination](#).

For more in post-grant considerations generally, see [Practice Note, Patent Prosecution: Overview: Post-Grant Considerations](#) and [Issued Patent Review Checklist](#).

Design and Utility Patent Application Comparison Table

	Utility Patent Application	Design Patent Application
Patent Eligible Subject Matter	Functional characteristics or features of a useful process, machine, manufacture, or composition of matter (35 U.S.C. § 101).	Nonfunctional, ornamental characteristics of an original article of manufacture (35 U.S.C. § 171; MPEP §§ 1502 and 1504.01(c)(I)). A design patent can cover the same article as a utility patent but protects distinct ornamental (as opposed to functional) aspects of it.

Design Patent Application Prosecution

	Utility Patent Application	Design Patent Application
Specification	Written description satisfying 35 U.S.C. § 112(a) (MPEP § 2163(I)).	Design title, name of the article, and descriptions of the drawings satisfying 35 U.S.C. § 112(a) (37 C.F.R. § 1.153; MPEP § 1503.01).
Claims	<p>At least one claim reciting the invention's essential elements (35 U.S.C. § 111(a); 37 C.F.R. § 1.75).</p> <p>No claim is needed at the time of application's filing to be accorded a filing date (37 C.F.R. § 1.53(b); MPEP §§ 601.01(a) and 702).</p>	<p>Only one claim in the format: "[I/We] claim: The ornamental design for [ARTICLE] as shown [and described]" (37 C.F.R. § 1.153(a); MPEP § 1503.01(III)).</p> <p>Must include claim for application to be accorded a filing date (37 C.F.R. § 1.53(b)).</p>
Drawings	<p>Required where necessary to understand the claimed invention (35 U.S.C. § 113).</p> <p>Color drawings are permitted with a granted petition (37 C.F.R. § 1.84(a)(2); MPEP § 608.02).</p>	<p>Drawings must show the design with a sufficient number of views embodying the entire claimed design and the article of manufacture embodying it (MPEP § 1503.02).</p> <p>Color drawings are permitted without petition (37 C.F.R. § 1.84(a)(2); MPEP § 608.02).</p>
International Applications	The PCT allows an applicant to file a single international patent application, which must be followed by national or regional phase entry in the sought-after PCT-member states or regions (see Practice Note, PCT Patent Applications: Filing in the US Receiving Office).	The Hague Agreement Concerning the International Registration of Industrial Designs allows US applicants, and applicants from other Hague Contracting Parties (member countries and regions), to file a single international application for design registration with the potential to obtain design protection in countries and regions designated in the international filing (see Practice Note, US Design Patents and the Hague Agreement Concerning Industrial Designs).
Benefit of Provisional Applications	May claim the benefit of an earlier provisional patent application if the nonprovisional is filed within one year after the provisional (35 U.S.C. § 111(b)).	May not claim the benefit of an earlier provisional patent application (35 U.S.C. § 119(e); 37 C.F.R. § 1.53(c)(4)).
Continuing Applications	Yes (35 U.S.C. § 120).	Yes (35 U.S.C. § 120; MPEP § 1504.20).
RCE and CPA	<p>RCE available (37 C.F.R. § 1.114).</p> <p>CPA is unavailable (37 C.F.R. § 1.53(d)(1)(i)).</p>	<p>RCE is unavailable (37 C.F.R. § 1.114(e)(4)).</p> <p>CPA available (37 C.F.R. § 1.53(d)(1)(i)).</p>

Design Patent Application Prosecution

	Utility Patent Application	Design Patent Application
Foreign Filing License Required?	Yes	Yes
Foreign Priority Claims	Within 12 months of the earliest priority application filing date (35 U.S.C. 119; 37 C.F.R. § 1.55(b)).	Within six months of the earliest priority application filing date (35 U.S.C. §§ 119 and 172; 37 C.F.R. § 1.55(b)).
Publication of Pending Applications	The USPTO publishes nonprovisional patent applications 18 months after the earliest US filing date (35 U.S.C. § 122(b); 37 C.F.R. § 1.211(a)).	US design applications not published until issuance (35 U.S.C. § 122(b)(2)(A)(iv); 37 C.F.R. § 1.211(b)). Hague Agreement applications designating the US are published, typically at 12 months (MPEP § 2901).
USPTO Application and Prosecution Rules Applicable	37 C.F.R. §§ 1.51 to 1.146.	37 C.F.R. §§ 1.51 to 1.146 and 1.151 to 1.154.
Restriction Practice	Restriction between independent or distinct inventions is discretionary (35 U.S.C. § 121; MPEP § 803).	Restriction between patentably distinct designs is mandatory (MPEP § 1504.05).
Duty of Disclosure and IDS?	Yes (37 C.F.R. § 1.56).	Yes (37 C.F.R. § 1.56).
Expedited Examination	Track One prioritized examination (37 C.F.R. § 1.102(e); MPEP § 708.02(b)). Petitions to make special based on an inventor's age or health (37 C.F.R. § 1.102(c)). Patent Prosecution Highway (PPH) Program (MPEP § 708.02(c)).	Accelerated examination (MPEP § 708.02(a)). Petitions to make special based on an inventor's age or health (37 C.F.R. § 1.102(c)).
Level of Skill in the Art	Novelty, obviousness, and specification: based on the perspective of a person of ordinary skill in the art (MPEP § 2141.03).	Novelty: Based on an ordinary observer's perspective. Obviousness and specification: Based on an ordinarily skilled designer's perspective (MPEP § 1504.03 (I)(C)).
Novelty Test (35 U.S.C. § 102)	A single prior art reference or event anticipates a claimed invention if it discloses each element of the invention as arranged in the patent claim and enables one of ordinary skill in the art to practice the claimed invention.	A single prior art reference anticipates the claimed design if it discloses a design for the same article that would appear substantially the same to an ordinary observer (see Practice Note, Design Patents: Overview: Novelty).

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	Utility Patent Application	Design Patent Application
Obviousness Prior Art (35 U.S.C. § 103)	Based on the <i>Graham v. John Deere Co. of Kansas City</i> inquiries and <i>KSR (Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966); KSR Int'l Co. 550 U.S. 398)</i> . Obviousness prior art references must be analogous: from the same field of endeavor as the claimed invention (analogous) or reasonably pertinent to the problem the inventor faced (MPEP § 2141.01(a)(I)).	Based on the <i>Graham</i> inquiries and <i>KSR</i> applying analogous prior art (<i>Graham</i> , 383 U.S. 1; <i>KSR Int'l Co.</i> , 550 U.S. 398; <i>LKQ Corp.</i> , 102 F. 4th at 1295).
Maintenance Fees Due?	Yes (35 U.S.C. § 41(b); 37 C.F.R. § 1.362; MPEP §§ 2501 and 2504).	No (35 U.S.C. § 41(b)(3)).
Enforceable Term and Patent Term Adjustment	From the issue date to 20 years from earliest US non-provisional filing date (35 U.S.C. § 154(a)(2)). PTA is available (35 U.S.C. § 154(b)).	15 years from the issue date for applications filed on or after May 13, 2015. Earlier design patents have a term of 14 years from the issue date. (35 U.S.C. § 173; MPEP § 1505.) PTA is not available (35 U.S.C. § 154(b); MPEP §§ 1504.04 and 2710).

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