

Q&A: Design patent bar: what it means and who benefits

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Morgan Lewis patent attorney John Hemmer explains the opportunities the U.S. Patent and Trademark Office's new design patent bar provides.

In November, the USPTO published its final rule announcing the amendments to the rules of practice before the agency, aiming to accommodate those who thought the nature of design patents warranted a change. The rule came into effect Jan. 2.

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But many do not understand what this rule is, the rulemaking process, or what led to this rule.

Thomson Reuters: First off, what qualifications do those who practice before the USPTO, like yourself, need to have?

John Hemmer: To practice before the USPTO for patent matters, individuals must qualify and pass the USPTO's patent bar exam. Traditionally, the qualifications included having an undergraduate or graduate degree in engineering or science. We also need to adhere to ethical standards set by the USPTO, maintain professional conduct and maintain good standing within our respective legal jurisdictions and with the USPTO.

TR: Why have a patent bar at all?

JH: The patent bar is to ensure that individuals representing clients before the USPTO have the necessary knowledge and skills to navigate the complexities of patent laws and procedures, and the technical skills to work with inventors to explain what was invented and how it differs from prior art.

TR: Prior to the rulemaking, there was a single patent bar for those who practiced before the USPTO. With the separate design patent bar that was just created, what aspects of the process are different?

JH: Applicants applying for the design patent bar do not need a technical degree. To sit for the design patent bar, applicants must have a degree in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, art teacher education or an equivalent.

TR: Will the establishment of the design patent bar affect those already registered to practice before the USPTO?

JH: I don't see this development as having a dramatic impact, at least not immediately, on design practice, but generally I see this as a positive development. A design patent bar will increase the pool of qualified applicants, including former design patent examiners, that can be hired to work on design matters. Historically, it has been challenging to staff agents and associates with engineering and advanced degrees on design matters, given the lower budgets for design patents and because industrial design may not be of interest to those who chose to study engineering or science rather than industrial design. The creation of the design patent bar should also help the USPTO attract more and higher-quality design patent examiners who may now have a career path in industry after they leave the USPTO.

TR: The USPTO has given patent protection to original designs since the 1800s. Obviously, this process has existed in harmony with the issuance of utility patents. Why is the USPTO changing the process now?

JH: The USPTO director, Kathi Vidal, has expressed that the motivation was to increase diversity within the patent field by broadening the qualifications for who can prosecute design patent applications.

TR: What challenges could this new process present?

JH: As with any change to a registration system, some existing patent attorneys are concerned about a decrease in qualified practitioners. There is also a concern that the design patent bar may result in confusion among the public such that design attorneys or design agents will be viewed as the design experts. However, the design bar requires the same exam as the standard patent bar and those who are only design barred must include a notation under their signature that they are design barred. It seems unlikely to me that the general public will view those who have the design bar as the design experts. There are other ways of highlighting design expertise and you may start to see design practitioners who pass the standard patent bar note that they are barred to practice both utility and design patents before the USPTO.

TR: Are design patents so different from utility patents that this change was needed? What are some differences to the way these patents protect original works?

JH: Design patents are fairly different from utility patents. The USPTO and courts seem to be struggling with how to fit design law

within the utility patent framework. That being said, the creation of the design bar does not address these issues, it simply allows more people to become design practitioners.

While the U.S. ties design protection to the utility patent rules, there is overlap between design patent protection and trademark and copyright protection. In fact, most of the world outside the United States treats designs (often referred to as industrial, registered or community designs) completely separately from utility patents. Attorneys who are advising clients on trade dress and copyright protection will typically consider design protection and

vice versa. The creation of the patent bar may be an opportunity for legal departments to bring in additional team members and potentially further strengthen the ties between patent, trademark and copyright practices.

TR: Will we see an increase in applications for design patents?

JH: Yes, but not as a result of the design patent bar. Design patents will continue to increase due to the desire for engaging, intuitive and enjoyable user experiences and companies' investment in creating and protecting these designs.

About the author



John Hemmer is a partner in the intellectual property group at **Morgan, Lewis & Bockius LLP** in Philadelphia, where he focuses on patent counselling in the mechanical engineering, industrial design and life science fields. He collaborates with clients to help them identify patenting opportunities, protect and leverage competitive advantages, manage patent portfolios and avoid patent infringement. He also works with clients on potential litigation, freedom-to-operate and due diligence assessments in the context of joint development, licensing and corporate transactions. He can be reached at john.hemmer@morganlewis.com.

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