

NEWSLETTER

知产快报

● From the perspective of maximizing protection the design conception and inspire passion/enthusiasm for design, the partial design system is an effective system and is welcomed by those applicants, with increasingly applying in many countries or regions. In China, an industrial power, the design should be given great protection. Before the establishing of partial system, a clarity illustration of essential feature by use of similar designs, appropriate description of essential feature in the application document, appropriate use of cross-section views and views of usage state, can help to better protect the essential feature and get a favorable result in invalidation and infringement determination.



A BRIEF ANALYSIS ON BOTH THE PARTIAL DESIGN SYSTEM AND THE STRATEGY FOR PROTECTION OF ESSENTIAL FEATURES IN A CHINESE DESIGN APPLICATION

1. Partial Design

The “partial designs” refer to those designs made with respect to a certain part of a product/article, such as the peak of a hat, the handle of a toothbrush, or the knob of a microwave oven, etc. For instance, in a famous American case *In re Zahn* (1976), in the application document the drillstock section is claimed for protection and is illustrated with solid lines, while the disclaimed drill bit section is illustrated by dotted lines, as shown below.



The applicant filed such an application document with the purpose that all those products with such drillstock design as shown would infringe his right, regardless of the design of the drill bit of the products. In this way, obviously, a maximizing protection to the essential feature of the design, as well as a maximized scope of the applicant’s right, can be obtained.

The Partial Design System has become a relatively mature system for design protection in many countries or regions, such as the United States, Europe, Japanese, Korea, etc. After the case *In re Zahn* in 1976, the USPTO revised the definition of design in Section 1502m, Guidelines of Patent Examination (U.S.) as that “design means any design included in or applied to an industrial product (or a part thereof)”, and thus the partial design become a patentable subject matter.

In 1998, Japan modified the Design Act to propose the protection for partial design. According to Article 2 of Japanese Design Act, “design” means the shape, patterns or colors, or any combination thereof, of an article (including a part thereof), which create an aesthetic impression through the eye. Besides, the

following diagram illustrates the statistics of filings of both partial design and related design in Japan from 2012 to 2016, in which the annual left column (pink) represents the partial design. It can be seen from the picture that the filings of partial design is generally increasing year by year, reached about 40% of the total design patent application filings in 2016.

部分意匠、関連意匠の出願件数及び出願件数割合の推移



(資料)特許庁作成

In Korea, the protection for partial design stated in 2001. The Korean Design Protection Act prescribes: “design” means any design of the shape, the pattern, or their combination, or the combination of the color with shape or pattern, of a product (including a part of the product and the typeface), which create an aesthetic feeling through a visual sense.

In December 2001, European Council passed the Council Regulation (EC) on Community Design, in which the Rule 3 prescribes: “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation.

In the local patent practice of these countries or regions, the claimed or unclaimed part of the design is generally represented by solid lines or dotted/broken line or the like in the design drawings. In addition, in Europe, Japan and Korea, for example, the part to be claimed can also be represented in combination with color, shade or other performance.

2. Chinese regulations

In Section 7.4 (3) and (4), Chapter 1, Part I of Guidelines for Patent Examination, two nonpatentable situations for design for patent are stipulated as follows: (3) *any component part of the product which cannot be partitioned or sold and used independently, such as the heel of socks, the peak of a hat, the handle of a cup, and so on;* (4) *in the case of any product consisting of several component parts which have different shape or pattern, if each component part itself cannot be sold and used independently, such component part is not the subject matter under protection of the patent for design. For example, a jigsaw toy consisting of plug-in pieces of varied shape is a patentable subject matter only when one application relating to all the pieces is filed.* From this, it can be seen that the partial design is not yet a patentable subject matter in China.

On April 1, 2015, the State intellectual property office of China (SIPO, now known as CNIPA) released the Revising Draft of Patent Law (Draft for Invitation of Recommendation) to the public. In Art 2 of the Draft it is prescribed that "design" means *any new design of the shape, the pattern, or their combination, or the combination of the color with shape or pattern of the product or a part thereof, which creates an aesthetic feeling and is fit for industrial application.* We can see that the Draft for invitation of recommendation proposed definitely that the partial design is to be supplemented as a patentable subject matter. However, those parties, as being effected by sorts of factors, cannot reach an agreement on this clause in numbers of modifications for the draft, and thus the term of "partial design" is not presented in the "Draft Amendments to Patent Law" published in NPC network, early 2019. This may mean that a partial design system will not be established in this amendment to the Patent Law.

On April 4, 2019, China National Intellectual Property Administration (CNIPA) released "Notification for Soliciting Public Opinion on 'Revising Draft of Patent Law (Draft for Invitation of Recommendation)'" , as well as released the Revising Draft of Guidelines for Patent Examination (Draft for Invitation of Recommendation)', in which the requirement for filing the drawing for GUI design. Specifically, the original provision *"as for the design of product including graphical user interface (GUI), design views for the whole product shall be filed. Where the GUIs are dynamic designs, the applicant shall file at least one view of the aforementioned design views for the whole product for one state; and can only file views of the key frames for the other*

states" is cancelled, while a new provision "the design of product including graphical user interface (GUI) shall meet the provision of Section 4.2, Chapter 3 of the present Part. Where the essential features of the design of the product involve the GUI only, the applicant can file one orthographic projection view of the side the GUI concerned. The view shall clearly indicate the category of the product incorporating the GUI, as well as clearly indicate the design of GUI and its magnitude, position and proportional relation in the product" is added. From this, it can be seen that, comparing with before, the requirement for filing the drawing for GUI design is somewhat simplified, and maybe such provision as *"as for the design of product including graphical user interface (GUI), design views for the whole product shall be filed"* will become a history, and so to speak, the GUI design may become a forerunner, or an experimental field, for partial design system in China.

3. Brief Analysis on Protection of Essential Features

In current situation that the partial design system has not yet established in China, in order to protect an applicant's design in the application process, we hereby provide the following suggestions for reference:

Firstly, an applicant can use the Similar Design System. That is, to determine a main design, for which those design elements, except for the essential features, may be minimized so as to highlight the latter, to thereby highlight the influence of these essential features on the overall visual effect. On this basis, other similar designs may be added several unessential features. In accordance with the provisions of Guidelines for Patent Examination, no more than 10 similar designs in one application may be claimed.

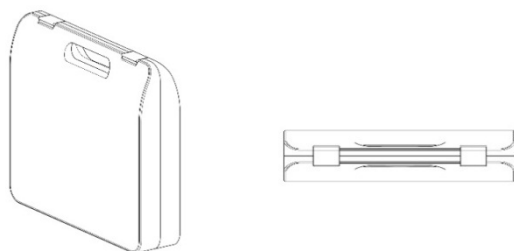
Secondly, the drafting of "the essential features of the design application" in the brief explanation should be valued. In practice, when drafting the "essential feature" of the design, in many design applications it merely be described as "(the essential feature) involve the shape and pattern of the product", the author think such general description in many situations may not benefit the extent for protection of the design, and even in a patent invalidation and infringement litigation this may become an obstacles to claim essential feature(s). In order for appropriately revealing the essential features,

the applicant may use such language as “the essential feature particularly lies in the xxx”. In the situation that the essential feature can hardly be described simply, it can be denoted by an arrow or an indication line, for example, denoted as “portion A”, or even an enlarged view of portion A or a view showing an usage state can be added as well.

In China, those main bodies to judge designs to be identical or similar are “normal consumers”, and the criterion for judgement is “overall observation and comprehensive judgement”. If the applicant only improves a certain part of a product, which part is not yet a separate product that cannot be sold and used independently, so that the design of the whole product incorporating this particular portion needs to be filed in a design application. In such case, the visual effect of the particular portion may be weakened, due to the judgement criterion of “overall observation and comprehensive judgement”, and thus may not be considered (when falling into a “comprehensive judgement”). Accordingly, in order for highlighting the certain part to a greater degree to make it sufficient to determine the distinguishing feature between the claimed design and the prior art by using this portion, it is recommended that the applicant can do the following works to the application document so as to increase the weight of the particular part in the “overall observation and comprehensive judgement” to the design:

(1) In a design for a product, drawing and adding a cross-section view or a cutaway view, for a portion containing a certain part.

For example, an application (storage bag) to be filed includes two figures as follows:

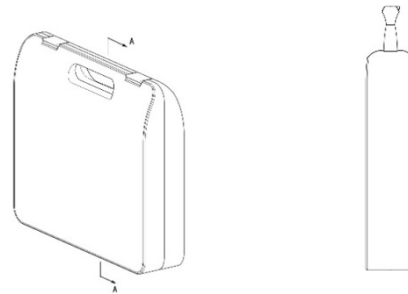


Perspective View

Bottom View

As shown from the two figures, the handle of the storage bag seems somewhat sunk, whereas this sunk part fails to be represented clearly. Here, a cross-section view for illustrating the

handle part can be used for highlighting the specific shape of the handle. The perspective view (with denoting the cutting position) and the cross-section view may be as follows:



Perspective View

Cross-section View

With the cross-section View as shown above, the representation for the handle sunk part become clearer.

(2) Adding several views showing different usage states of the product that can reflect the changes of a certain part of the product in use. For example, an application (named “Book Clipping Plate”) to be filed includes a perspective view as follow:



Perspective View of Book Clipping Plate

Assuming the essential design feature is the clip, and other parts are all of the conventional or prior design, and also assuming the clip cannot be sold and used independently. In this situation, a view showing the usage state(s) of the clip in the product of book clipping plate can be filed together with other views, which may increase the weight of the clip in the book clipping plate

so as to highlight the essential feature.

For example, the views of usage state may be as follows:



View 1 of usage state



View 2 of usage state

With the views of usage state as presented above, to increase the weight of the clip in the overall product is increased, which is

advantageous for claiming a relevant right in invalidation and infringement litigation.

4. Conclusion

From the perspective of maximizing protection the design conception and inspire passion/enthusiasm for design, the partial design system is an effective system and is welcomed by those applicants, with increasingly applying in many countries or regions. In China, an industrial power, the design should be given great protection. Before the establishing of partial system, a clarity illustration of essential feature by use of similar designs, appropriate description of essential feature in the application document, appropriate use of cross-section views and views of usage state, can help to better protect the essential feature and get a favorable result in invalidation and infringement determination.

The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

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