

NEWSLETTER

知产快报

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Intellectual Property Protection for Industrial Designs

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I. Legal system for the protection of industrial designs

China has established a comprehensive intellectual property protection system, including the Trademark Law, the Patent Law, the Copyright Law, and corresponding administrative regulations and judicial interpretations. In addition, the Anti-Unfair Competition Law also involves intellectual property protection, which constitutes the framework of intellectual property protection systems.

1. Patent protection for industrial designs

The Chinese Patent Law clarifies the patent protection for design. Article 2, paragraph 1 of the Patent Law stipulates that the invention and creation refers to inventions, utility models and designs; Article 2, paragraph 1 stipulates that the design means any new design of the shape, pattern or their combination, or the combination of the color with shape or pattern, of a product, which creates an aesthetical feeling and is fit for industrial application. Article 42 of the Patent Law stipulates that the term of the design patent right shall be ten years, counting from the date of filing.

Meaninglessly, the design can be protected according to the design patent in China.

2. Copyright protection of industrial designs

Article 3 of the Copyright Law stipulates that works include (4) fine arts and architectural works; Article 4 (8) of the Regulations for the Implementation of the Copyright Law stipulates, that works of fine art are two-or three-dimensional works created in lines, colors or other medium which, when being viewed, impart aesthetic effect, such as paintings, works of calligraphy, sculptures and works of architecture.

Therefore, when a design having an aesthetical feeling, which is composed of the shape, pattern, a color or their combination, constitutes a work in the sense of the Copyright Law, it can be protected by the Copyright Law.

3. Trademark protection for industrial designs

Article 8 of the Trademark Law stipulates that any mark that distinguishes the goods of natural persons, legal persons or other organizations from those of others, including words, figures, letters, numbers, three-dimensional signs, color combinations and sounds, etc., or a combination thereof, can be applied for registration as a trademark; Article 9 stipulates that the trademark applied for registration should have distinctive features that are easy to identify and must not conflict with the legal rights previously obtained by others.

The design is composed of a shape, a pattern, a color, or a combination thereof, and the trademark is composed of characters, patterns, shapes, or a combination thereof. They both include the elements such as shapes and patterns. When the design is distinctive due to its discernibility and indication, it can be protected by the Trademark Law.

4. Anti-unfair competition protection of industrial designs

Article 6 of the Anti-Unfair Competition Law stipulates that the operator shall not implement the following confusing behavior, which may be misunderstood as being a product of another person or having a specific connection with others: (1) unauthorized use of the same or similar identification of the name, packaging, decoration, etc. of the product of another person that has certain influence.

When the appearance of a commodity constitutes a unique decoration of a well-known

commodity, if the use of the design by another person is sufficient to cause the relevant public to confuse or misunderstand the source of the commodity, such post-use behavior may improperly utilize the goodwill of the person, which constitutes unfair competition and can be protected by the Anti-Unfair Competition Law.

In summary, for the industrial design, China has built a very comprehensive intellectual property protection system, and it can be protected according to the Patent Law, the Copyright Law, the Trademark Law and the Anti-Unfair Competition Law.

II The competition for multiple protection systems for industrial designs

As mentioned above, multiple intellectual property rights can be used for the protection of the industrial designs. However, when the industrial design of the right holder is infringed by others, the right holder cannot repeatedly claim that these rights have been infringed, and can only choose one right to claim. For the infringer, an infringing entity has implemented an infringement, which belongs to the concurrence of legal liabilities.

In addition, the protection period of the design patent right is only ten years; the copyright has a relatively long period of protection, the trademark right can be renewed indefinitely, and its protection period is theoretically unlimited; and the Anti-Unfair Competition Law does not have a deadline, its protection period is also unlimited. Whether can the public freely implement the design after the design patent is invalid or expires?

In most cases, if a design patent expires due to the expiration of the protection period or other reasons, the design enters the public domain and is freely available to anyone. However, if the design belongs to other intellectual property rights, the termination of a right does not of course lead to the loss of other rights. In the field of intellectual property, an object may be subject to multiple intellectual property rights. Therefore, after the design patent is invalid, or expires, the design does not necessarily enter the public domain, and it can still be protected if it meets other legal requirements.

III. Two typical cases

Case 1: Shanghai Zhonghan Chenguang Stationery Manufacturing Co., Ltd. (hereinafter Chenguang Company) vs Ningbo Weiyada Stationery Co., Ltd. (hereinafter Weiyada Company) for infringement of intellectual property rights

The plaintiff, Chenguang Company, owned a design patent of ZL 02316156.6 for the gel pen, but it expired on October 22, 2005. In 2008, the plaintiff sued Weiyada Company before the Shanghai Second Intermediate People's Court on the grounds of the infringement of the unique name, packaging and decoration of well-known commodities. This case had gone through multiple trials in the first, second and retrial, and was a typical case with greater influence (see ((2008)Hu Er Zhong Min Wu(Zhi)Chu No. 112; (2008) Hu Gao Ming San (Zhi) Zhong No. 100; (2010) Min Ti No. 16) .

This case is a typical case in which the right holder filed a lawsuit under the Anti-Unfair Competition Law after the design patent right expired. In the retrial of the case ((2010) Min Ti No. 16), the Supreme People's Court clearly stated if the design of goods granted a design patent can be protected under the Anti-unfair Competition Law after the patent right expired. The Supreme People's Court confirmed the multiple protection of an intellectual property object, indicating the Anti-Unfair Competition Law can provide limited and additional supplementary protection for certain civil rights under certain conditions in addition to intellectual property law.

Case 2: Intellectual Property Infringement Disputes of Jaguar and Land Rover Co., Ltd. (hereinafter referred to as Land Rover) and Jiangling Holdings Co., Ltd. (hereinafter referred to as Jiangling Company)

Land Rover had a design patent of ZL201130436459.3, which was declared invalid in 2016. In June 2016, Land Rover filed a lawsuit before Beijing Chaoyang District People's Court on the grounds of copyright infringement and unfair competition. In March 2019, Beijing Chaoyang District People's Court made the first-instance judgments, in which the court held that Jiangling Company constituted unfair competition, but rejected the dispute of

copyright infringement.

In the copyright infringement case, the court held that the appearance of Land Rover's car did not reach the height of artistic creation required by the art work as a whole, and was not a fine work, nor a practical art work. Thus, the court rejected Land Rover' claims in the copyright infringement case.

In the anti-unfair competition case, the court held that the appearance of the car involved in the case was a "decorative decoration" protected by Article 6(1) of the Anti-Unfair Competition Law. The behavior of Jiangling Company constitutes an unfair competition act that uses the same or similar logos of other goods that have certain influence. Finally, the court supported Land Rover's claims in the case of

anti-unfair competition.

In the judgments of two cases, the courts affirm the multiple protections of the design. Even if the design patents expire or is declared invalid, there is still the possibility of protection by other rights. However, the termination or invalidation of the design patent right at least causes the public to receive a signal that the design may have entered the public domain, and therefore the right holder who claims that the design is protected by other rights should provide more sufficient evidence to prove that the design should still be protected by other laws.

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

For further information, please contact the attorney listed below. General e-mail messages may be sent using LTBJ@lungtin.com which also can be found at www.lungtin.com

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