

# Tentative Analysis of Role of Brief Description of Design in Patent Right Affirmation and Infringement Determination

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It is provided in Article 27 of the Patent Law entering into force on 1 October 2009 (the new Patent Law) that “where an application for a patent for design is filed, a request, drawings or photographs of the design and a brief explanation of the design shall be submitted”, which shows that after the new Patent Law entered into force, the brief explanation of a design has become an integral part of a design patent application. In Rule 29 of the Implementing Regulations of the Patent Law as of 1 February 2010 (Implementing Regulations of the new Patent Law) is provided that “the brief explanation of a design shall indicate (1) the name; (2) the use of the product incorporating the design; (3) the essential portion of the design; and (4) a drawing or photograph best showing the essential portion of the design. Where a colour is claimed or a view of the product incorporating the design is omitted, it shall also be indicated in the brief explanation”. In the Guidelines for Examination issued in 2010, more detailed provisions will be set forth on the requirements for how each preceding parts be drafted in the Part on Preliminary Examination of Designs. Given that an applicant should have full understanding of his or its design patent application, it seems that he or it would not find it difficult to draft the brief explanation under this provision. However, Article 59 of the new Patent Law provides that the brief explanation may be used to explain the design incorporated in the product as shown in the drawings or photographs. As a result, the possible impact of the brief explanation on the extent of protection of the design and its role in design patent right affirmation and infringement procedure have become issues requiring attention from, and analysis and discussion, in the IP community.

Before taking a closer look at the issues, it needs first to ascertain the legal position of the brief explanation of a design. Article 59 of the new Patent Law provides: “The extent of protection of the patent right for invention or utility model shall be determined by the terms of the claims. The description and the appended drawings may be used to interpret the claims. The extent of protection of the patent right for design shall be determined by the product incorporating the patented design as shown in the drawings or photographs. The brief explanation may be used to interpret the product incorporating the design as shown in the position of the drawings or photographs.” This shows that the drawings or photographs of a patented design is analogous to that of the claims of an invention or utility model, and the brief explanation of a design to the description and appended drawings of an invention or a utility model. The extent of protection of a design patent is determined by the design incorporated in the product as shown in patented drawings. The brief explanation of a design is used to help to interpret the extent of protection of a design patent when necessary. Then, under what circumstances is a brief explanation of a design used to interpret the extent of protection of a design, how to interpret it, and what impact does it have on the interpretation? The writer will try to analyse each items contained in the brief explanation of a design:

(i) Name of the product. It is required that, in China, a design patent have a product as its carrier, and the patent protect the design incorporated in the product. The name of the product and patented drawings together define the extent of protection of the design patent, which covers all the identical or similar designs of identical or similar classes.

Therefore, the extent of protection of the same patented drawings of design incorporated in products, such as “auto-mobile” or “toy automobile”, is obviously different. Nonetheless, since the name of the product in the brief explanation must be the same as that in the request of the filed application for a patent for the design, no change has actually been made in the way the name of the product defines the extent of protection of a design in the Patent Law after the recent amendments made thereto.

(ii) Use of the product. The claims do not specify the use of a product, nor is it possible for the use of a product to be directly and undoubtedly identified with patented drawings or photographs. For that reason, the use of the product in the brief explanation is an important basis on which the use of a patented design is determined. Besides, the use of the product determines the class of the product, and whether a product is identical or similar in class is the basis for the comparison made for similarity when affirming the patent right for the design, and, as well, the premise to determine whether the design constitutes an infringement. Therefore, the use of a product has impact on the extent of protection of a design patent, and defines the scope of the prior designs of the patented design and the class of allegedly infringing product. Given that an applicant should have accurate and objective understanding of his or its product, where it is not contradictory with the drawings or photographs of the patented design, the use of the product as specified in the brief explanation should be determined or confirmed in both patent right affirmation and patent infringement litigation.

(iii) Essential point of design. By the essential point of design is meant the major difference of a patented design from any existing design. It is worth noting that the brief explanation of one design as drafted by one person is likely to be different from that by another in the essential point of design presented because the prior design he identifies is different. For example, the patented design as shown below is different, in different aspects, from the prior designs respectively. However, as for a particular patented design, its extent of protection is defined by both the product incorporating it and the patented drawings. Said extent of protection is naturally clear and definite. The way in which the essential point of a design is drafted at the time of filing an application does not change the product incorporating the patented design, nor the patented drawings or photographs of said design; hence, it has no impact on the extent of protection of the

patented design. In other words, the extent of protection of the design will not vary due to the way the essential point of design is presented in the brief explanation.



Patented design

Prior designs

Some scholars pointed out, for a design application, the main point of design should be drafted according to the findings of the prior design search and study to seek better protection therefor by drafting the main point of design of the design patent.<sup>1</sup> For this writer, it is a good desire to require one to objectively and accurately describe the main point of design in the design application, but it is practically difficult to do so. On the one hand, any search and study would yield insufficient results, and graphic design search is even more difficult. On the other, an applicant, as a civil entity, tries to seek maximum benefits, and would be unwilling to waste time and money to do the search and study. Even if he does so, he would be unwilling to draft the main point of design in a quite truthful manner.

In the patent affirmation and infringement procedure, giving special attention to the essential point of design as stated by an applicant himself is easy to result in disregarding the impact of the other parts of the design on the determination of the design. For this matter, in the Guidelines for Examination as of 2001 is introduced the method of major part determination with a view to make it easier to determine that two designs are dissimilar. In the patent-related judicial practice after that, the application of the method of major part determination causes quite a lot of contradiction and trouble.<sup>2</sup> The method of major part determination has been deleted from the Guidelines for Examination as of 2006, and the similarity of design is to be to the doctrine of “global ob

servations and comprehensive judgment”. However, debate on the essential point of design does not end. On the one hand, in hearing right affirmation cases, patentees often try to stress the essential point of design of a patent in suit to demonstrate its patentability; on the other, in the patent infringement litigation, an alleged infringer also often tries to argue for the untenability of infringement claim on the ground that the allegedly infringing product does not cover the main points of the design of the patent involved. In Article 12 of the Supreme People’s Court’s Interpretation of Several Issues Concerning Application of Law to Trial of Cases of Dispute over Patent Infringement as issued on 18 June 2009 for comments, the essential point of design is used to serve as the standard for determining non-infringement of design. The way of judgment is exactly the same as the method of major part determination. When one tries to quickly find non-constitution of an infringement, the impact of the other parts of the design on the global visual effect of the design is totally disregarded once more. Fortunately, the provision to this effect has been deleted in the Supreme People’s Court’s Interpretation of Several Issues Concerning Application of Law to Trial of Cases of Dispute over Patent Infringement as officially adopted on 21 December 2009 upon having accepted the views of people from all walks of life, and in the Interpretation has specified that comprehensive determination should be made on the basis of the global visual effect of a design, which exactly conforms to the global observations and comprehensive judgment doctrine followed in determining similar design as established in the Guidelines for Examination. The global observations and comprehensive judgment doctrine is a basic principle for assessing similarity of a design since what a design patent protects is the whole inseparable design as shown in the patented drawings, not only what a design patent is different from the prior design, even not merely what it is different from the combination of all the designs relative to the prior design.

It is true that the design patent legislation is meant to encourage innovation, and in applying the doctrine of global observations and comprehensive judgment, the various parts of a design do not play the same role, and specific examination *ad hoc* is necessary. Through years of practice in examination of design patents, the Patent Reexamination Board found out several universally applicable factors for consideration, and put them in the relevant chapters and sections relevant to the assessment of design similarity in the Guidelines for Examination as of 2010. To be specific in par-

ticular cases, common points found in comparison of an involved patent with a prior design a party presented as evidence certainly do not have any significant impact on the global visual effect. Whether the different point has any significant impact on the global visual effect needs to be determined comprehensively under the pertinent provisions of the Guidelines for Examination. Likewise, in patent infringement procedure, where no account is taken of a prior-design defence, if the allegedly infringing product is exactly identical with a patent involved, it indeed constitutes an infringement; but if they are different, determination should be made depending on how much impact the different point has on the global visual effect of the design. One should not arbitrarily establish infringement only in the presence of such difference. In other words, in the patent right affirmation and infringement procedure, similarity of design is assessed to find out difference between the particular design of an involved patent and that as shown in the evidence of the case, and then to identify its impact of said difference on the global visual effect. Obviously, in both the patent right affirmation and infringement procedure, what is assessed is the difference between the particular design of an involved patent and that as shown in the existing evidence. As regards the essential point of a design presented in the brief explanation, on the one hand, as aforementioned, it has no impact on the extent of protection of the design, it neither enhances the position of the corresponding parts of the patented drawings, nor means surrendering or weakening the other parts thereof; on the other hand, it is not naturally related, whatsoever, to the particular design as shown in the evidence of the case. Therefore, the main point of design mentioned in the brief explanation can not serve as evidence for claiming that the patent in suit is patentable in the patent affirming procedure, nor as evidence to show infringement or ground for non-infringement defence in the patent infringement procedure. The function of the main points of design as presented in the brief explanation is embodied in helping the public to understand the design.

(iv) Designating a drawing or photograph that best presents the essential point of a design. In the future, only one drawing or photograph will be published in the Design Patent Gazette. A drawing or photograph that is designated will be used in the Patent Gazette. Designation of one drawing or photograph best showing the essential point of design enables the public to understand the features of said design as much as possible. Like the legal position of the main point

of design in the brief explanation, the designation has no impact on the extent of protection of a design patent, and its legal position is not different from that of the other non-designated patented drawings.

(v) Claiming colour(s). Since the Patent Gazettes are printed in black and white in China, any applicant claiming design colour(s) is required to mention this in the brief explanation, so as to enable the public to know that the design patent protects colour(s), and further search the drawings or photographs containing the claimed colour(s) if necessary. If colour(s) is (are) not claimed, then the patented design does not protect colour(s) even though colour drawings were filed at the time of application. For that matter, claiming colour(s) in the brief explanation defines the extent of protection of the design patent. It is worth noting that defining the extent of protection with colour(s) does not mean natural narrowing of the extent of protection, which should be specifically determined according to its impact on the global visual effect of the product. Generally speaking, in most three-dimensional products, shape is given the most attention by the average consumers, and the pattern and colour(s) have less impact. By contrast, in case of a two-dimensional product or when the global shape of a three-dimensional product is of a common design, pattern and colour(s) have more impact. An applicant may decide whether to claim colour(s) on the basis of the product incorporating the design and the special characteristics of the design.

(vi) Indicating symmetric views or deleting views. Deleting a view has no impact on the extent of protection of a design while indicating symmetric views is equivalent to disclosing the symmetric views, which defines the extent of protection of the design.

In the patent examination practice, it is possible for an applicant to have failed to specify the claimed colour in the main point of design, but he stresses that the main point of design, relative to the prior design, lies in the graphic design and colour. Regarding this, the writer believes that the applicant's stressing that the main point of design contains colour shows that he attaches importance to colour; hence the examiner should issue to the applicant an office action, reminding him to claim colour, and specifies it in the brief explanation.

In conclusion, the writer believes that in the patent affirmation and infringement procedure, the various parts of the brief explanation of a design, an integral part of the Patent Gazette, have different impact on the extent of protection of

a design. The name of a product, its use, claiming colour(s) and indicating symmetric views directly define or have impact on the extent of protection of a design patent, while the essential point of a design, designating a drawing or photograph that best demonstrates the essential point of a design and deleting views have a function to facilitate the public to better understand a design, but have no impact on the extent of protection of a design patent. ■

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<sup>1</sup> Wu Guanle, How to Seek Better Protection for Design Patent after the Amendment to the Patent Law published in the Selection of Papers at the First IP Forum held during the Annual Meeting of All-China Patent Agents Association in 2010.

<sup>2</sup> See Zhong Hua, Tentative Analysis of Ways to Determine Identical or Similar Parts of Design, the China Patents Agency, 2005, Issue 2.