

A Study on Improvement of Design Determination Methods

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According to the Transitional Measures for the Implementation of the Amended Patent Law (the Patent Law as of 2009), the former Patent Law (namely the Patent Law as of 2001) applies to design patents filed before 1 October 2009, and the Patent Law as of 2009 applies to those filed after said date. For that reason, within a considerable period of time, the Patent Reexamination Board (PRB) will have to apply the two versions of the Patent Law to design patent filed before and after that date, and this requires improved method for determining designs within the framework of both the Patent Law as of 2001 and that as of 2009.

I. Improving method for determining designs within the framework of the Patent Law as of 2001 in China

Article 23 of the Patent Law as of 2001 provides that “any design for which patent right may be granted must not be identical with or similar to any design which, before the date of filing, has been publicly disclosed in publications in the country or abroad or has been publicly used in the country...”, and the Guidelines for Patent Examination as of 2006 provides that “identical or similar designs shall be determined” under the doctrine of “overall observation and comprehensive determination”, that is, a patent in suit and a prior design should be globally observed, and whether the difference between them has a notable impact on the overall visual effect should be determined through comprehensively taking account of the following six factors: (1) generally, the design changes in the parts which can be seen easily when in use have more notable impact on the overall visual effect than the design changes in the parts which cannot be seen easily or cannot be seen at all; (2) where designs in some parts of a product are provided to be usual designs commonly known for the kind of product, the changes in other

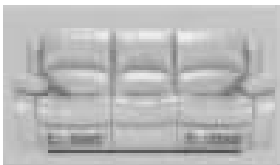
parts have more notable impact on the overall visual effect; (3) if all relevant factors are considered comprehensively, and the difference lies only in minor changes in some fine details, the difference is not sufficient to have notable impact on the overall visual effect; (4) where the dimensions are different, if the change in dimension only leads to enlarged or reduced size of the product as a whole, it does not have notable impact on the overall visual effect; (5) substitution of materials which does not bring any change in the design or is only a customary selection for the product incorporating the design generally does not have notable impact on the overall visual effect; and (6) the function, internal structure or technical performance of a product does not have notable impact on the overall visual effect. According to the analysis of the statistics of the cases of patent examination in the past, we have discovered that divided views are most likely to occur on determination of the factors of “usual designs” and “difference lying only in minor changes in some fine details”.

As in the “three-seat sofa” case, the PRB concluded in the Examination Decision No. 13120 that the patent in suit and the prior design were similar in the overall structural shape and contour; the size and proportion between the back waist pillows, that between the cushion and foot pad, and whether the back part of the back is vertical and whether there are decorative parti-coloured lines on the back pillows were all minor differences; said partial differences do not have notable impact on the overall visual effect; hence, under the “overall observation and comprehensive determination”, the patent in suit was similar to the prior design, so contrary to Article 23 of the Patent Law.

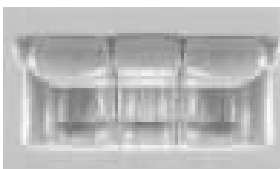
The trial court concluded that according to the provisions on the identical or similar design determination doctrine set forth in Section 4, Chapter 5 of Part 4 of the Guidelines for Patent Examination, where designs in some parts of a product are proved to be usual designs commonly known

for the kind of product, the changes in other parts have more notable impact on the overall visual effect. The patent in suit and the prior design were both designs of a three-seat sofa, which comprised three seats, armrests on both sides, back; on the back were disposed back and waist cushions; the seats of the sofa comprised the back cushion, waste cushion, seat cushion and foot pad arranged from top down. Said features were the common design of a three-seated sofa, and attention should be given to the impact of the other design changes on the overall visual effect when determining whether the two patents for the design of sofa were identical or similar. Besides the common design, many differences in the other aspects of the design of the patent in suit and the prior design were sufficient to create different overall visual effect on the part of the consumers; hence they were dissimilar designs.

The patent in suit



Main view



Bird's-eye view

The reference design



Main view



Bird's-eye view

Also in the case involving motorcycle wheels, the PRB concluded in the Examination Decision No.13658 that since a motorcycle wheel consisted of the rim, spoke and hub, the circular rim should be deemed to be a common design. Relative to rim, the design of spoke had a more notable impact on the overall visual effect. While the patent in suit and the prior design were different in the arch of the two sides of the spoke, the difference in arch was minor, so was the difference in the concave groove of the spoke, which did not have a notable impact on the overall visual effect. The difference in the hub of the patent in suit and the prior design lay in the fact that there were four reinforcing rods and nut holes in the hub of the patent in suit, which were absent in the prior design. When in use, part of the hub was covered by the supporting frame; hence it did not have a notable impact on the overall visual effect. The similar overall shape of the

wheels gave consumers an impression in relation to the overall visual effect that they were similar; hence the patent in suit and the prior design were similar designs.

The patent in suit



Main view



Rare view

The reference



Main view



Rare view

The trial court concluded that a wheel of a motorcycle, consisting of rim, spoke and hub, was defined by its function, and, for that matter, there was limited room for change in design. In the case, the patent in suit and the prior design were different in the following aspects; 1) as for the shape of the spoke, that of the patent in suit was straight at both sides while that of the prior design slightly curved; 2) as for the concave grooves on the spoke, the central part on one side of the spoke of the patent in suit was in the shape of concave groove while the central parts of the two sides of the spoke of the prior design were in such shape; and 3) as for the shape of the hubs, there were nut holes in the surface of the hub of the patent in suit while there was not on that of the prior design. These differences had notable impact on the overall visual effect in respect of the products of motorcycle wheels which had limited room for design; consumers of the product were capable of distinguishing them and free from confusion; hence the patent in suit and the prior design were not similar designs.

The court of appeal upheld the former decision on substantially the same ground.

Dissatisfied with the decision, the PRB appealed to the Supreme People's Court, which made the Administrative Judgment No. Xingtizi 6/2010 upon reviewing the case to have reversed the two former decisions and upheld the PRB's decision.

It was worth noting that in the above two cases, the courts made the determination in substantially the same manner as to the identicalness and similarity between the patent in suit and the prior design. In other words, the courts made the same ascertainment of the facts of the case, but drawn diametrically different conclusions. This shows that

the method for design similarity determination is relatively subjective in determining the factors of “common design” and “difference in small detail” and identifying the effect thereof, likely resulting in conflicting views in the examination conclusion.

For this writer, as for determination of “common design”, a long-standing mistaken idea is that finding part of a patent in suit to be common design is directly followed a conclusion that change in the other parts has notable impact on the overall visual effect. The resulting paradox is that when some part of a design in suit is identical with the corresponding part of a design, but it is not a common design, it is possible to conclude, upon overall observation and comprehensive determination, that the change of the other part is not sufficient to have notable impact on the overall visual effect; hence the two designs are held similar, so the patent in suit should be invalidated. But when a part of the former is proven to be a common design, the influence of said part is totally disregarded, but it is then directly concluded that change in the other part has notable impact on the overall visual effect; hence the two designs are determined as dissimilar, and the design in suit should be kept valid. This method of determination obviously goes against the initial purpose of the legislation to encourage innovation; it has actually substituted the whole design with a part other than the “common design” when making an overall determination. The method is contrary to the doctrine of “overall observation and comprehensive determination”. For this matter, the writer would like to recommend that the said circumstance (2) of the Guidelines for Patent Examination be amended as the following: “where designs in some parts of a product are proved to be designs commonly known for the kind of product, the changes in these parts do not have notable impact on the overall visual effect, and the average consumers would pay more attention to the changes in the other parts thereof”. That is, in case like this, it is only necessary to determine that the “common design” has made no contribution to the innovation, and the average consumers will pay attention to the other parts. Whether the change of the latter is sufficient to have notable impact should be determined according to specific circumstances. The preceding amendment has the purpose of not protecting common designs; the above paradox will no longer exist; and the requirement for “innovation” is embodied. As in the above “three-seat sofa” case, if the overall shape of said sofa is determined as a common design, then it does not have notable impact on the

overall visual effect, and the average consumers would focus their attention more on other changes. Whether the other parts are “slight changes in small details” need to be further analysed and determined when the overall state of the art of the prior design is fully understood.

For determination of “slight changes in small details”, the writer believes that only on the basis of understanding of the overall state of the art of the prior design is it possible to make a correct determination. In the review of the “motorcycle wheel” case, in respect of the conclusions made by the courts of first and second instance that there was limited room for design incorporated in the motorcycle wheels, and the difference in the hubs of the patent in suit and the prior design was not slight changes in small details, the PRB presented a lot of drawings of the prior design for the Supreme People’s Court to review (See the drawings below).



The Supreme People’s Court finally decided that as the evidence from the PRB showed, even if the motorcycle wheel consisted of rim, spoke and hub, and is subject to the restriction of the function set, its spoke could be made in any shape so long as it met the requirement of equilibrium of forces, so there is relatively much room for design. Besides, the Supreme People’s Court determined, on the basis of this, that the difference in the hubs of the patent in suit and the prior design was slight change in small detail; hence it reversed the former two judgments, and upheld the PRB’s decision. It is thus shown that after the patent in suit and the prior design were compared and points of difference identified, a correct determination of whether a part is “slight change in small detail or not” requires full understanding of the state of the art of the prior design.

II. Reconstructing method for determining design in China within the framework of the amended Patent Law

In China, designs, inventions and utility models are all protected under the same patent law. Article 23, paragraphs one and two, of the Patent Law as of 2009 has respectively set forth two substantive provisions on patent grant, which are similar to those on novelty and inventiveness and substantially consistent with those for grant of patents for inventions and utility models set forth in Article 22. For this reason, it is possible to draw on the methods for determination of novelty and inventiveness of invention patents to reconstruct, fully in the light of the characteristics of designs, more workable methods for determining designs under the amended Patent Law.

1. Methods for determining “novelty” of designs

Article 23, paragraph one, of the Patent Law provides: “any design for which patent right may be granted shall not be a prior design, nor has any entity or individual filed before the date of filing with the patent administration department under the State Council an application relating to the identical design disclosed in patent documents announced after the date of filing”; and Article 22, paragraph two, of the Patent Law provides: “novelty means that the invention or utility model does not form part of the prior art, nor has any entity or individual filed previously before the date of filing with the patent administration department under the State Council an application relating to the identical invention or utility model disclosed in patent application documents published or patent documents announced after the said date of filing”. The two provisions practically coincide, and, for this matter, we may believe they are the provisions on “novelty” of designs. “Forming part of...” in the “forming part of the prior art (design)” and “identical” in “the identical invention or utility model (design)” are narrow in meaning. What’s more, it is not appropriate to make interpretation of obviously different scope in the same law. Therefore, if we draw on the standard and the methods for determination of novelty of invention patents, the examination of the novelty of designs is confined to what is identical and substantially identical of a design, no longer including what is “similar” provided for in the former Patent Law. Meanwhile, in the presence of provision in Article 23, paragraph two, of the amended Patent Law with higher standard for patent grant set forth, it is unneces-

sary for one to be concerned about the presence of any lower standard for patenting design. For the standards for the examination of “conflicting applications” which are lower than those within the framework of the former Patent Law, since references are not prior designs, such lower standards do not run counter to the aim of the legislation “to encourage innovation”. To sum up, to make conclusion of the examination as objective as possible, we may define the determination of “novelty” of designs as similar to the category of “facts ascertainment”. It is recommended that the principle for the determination of “novelty” of designs be established.

1) Identical designs

If the patent in suit and the prior design or a design filed by any entity or person with the Patent Office before the filing date of the design in suit and published after that date, are compared, and the two are found identical in the class of product and substantially identical in the relevant elements (shape, pattern or colour), and identical in overall visual effect, they are identical designs.

2) One-to-one comparison

When determination is made as to whether a design is identical or not, a design patent should be compared with an existing design or a design filed earlier and published later on a one-to-one basis. It should not be compared with a plurality of existing designs or those filed earlier and published later.

Meanwhile, according to the special characteristics of designs and those of taking a product as a carrier of a design in China and on the basis of the experience gained in design patent examination in China, following are the common circumstances where a design does not possess “novelty”:

(1) the class of product is identical, and the design thereof is exactly identical;

(2) the class of product is identical, and the design thereof is only slightly different;

(3) the class of product is identical, and the design thereof is different only in one colour.

Circumstance (1) includes those where the difference lies in function or internal structure without showing difference in design since the purpose of the design patent is to protect aesthetically appealing design, not those making functional improvement and representing technical progress; function and internal structure of a product that are not embodied as design differences are not subject matters eligible for the design patent protection, so they are not con-

sidered for design patent protection.

2. Method for assessing “inventiveness” of design

Article 23, paragraph two, of the Patent Law provides: “any design for which patent right may be granted shall significantly differ from any prior design or combination of prior design features”; and Article 22, paragraph three, of the Patent Law provides: “inventiveness means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress, and that the utility model has substantive features and represents progress” As the comparison of the two provisions show, the style of the legislation thereof is substantially consistent, with the meaning that compared with the prior art (prior design or combination of prior design features), an invention has prominent substantive features, a utility model has substantive features, and a design has notable difference. But points of difference also exist, that is, it is also provided that an invention should represent “notable progress”, and a utility model represent “progress”; but it is not further provided that a design should be “more aesthetically appealing” as it is difficult to evaluate “aesthetic appeal”. For this reason, in the design examination in various countries only “different overall visual effect” and “different aesthetic appeal” are stressed, and it is impossible to require a design to be “more aesthetically appealing”.

In respect of the examination of inventions and utility models, it is specified in the Guidelines for Patent Examination that novelty and inventiveness are assessed from the perspective of “a person skilled in the art”. As for designs, it is still specified in the Guidelines for Patent Examination as of 2010 that they are evaluated from the perspective of “average consumers”, and it is provided that “an average consumer” has the common-sense knowledge of the design of the identical or similar class of products and the common method for making the design, which makes it possible to determine not only identical and substantially identical designs, but also, obvious difference of designs from prior designs and combination of their features. Regarding this, the writer believes that (1) it is far fetched to add the required knowledge of “the common method of design” to the original meaning of the “average consumers”. In the U.S.A. and Japan, the inventiveness of a design is evaluated from the perspective of “a designer in the art”, and it is difficult for the knowledge base and ability of “the average consumers” to determine the circumstance of “combination comparison”; (2) like an invention or utility model, a design is an invention-

creation made or accomplished by one having acquired the relevant technology (design), so it is more convincing for a skilled person (designer) in the art to determine whether an invention-creation has reached a sufficiently high level of innovation and made enough contribution on the basis of the prior art (design) to be granted the right of monopoly within a period of time under the Patent Law; (3) it is easy in our daily life for the “average consumers” to be confused with “the ordinary consumers”, and with “the relevant sector of the public” from whose perspective identical or similar marks are determined to such an extent as to confuse the standards for design patent grant with those for determining trademark confusion, which renders it insufficient to embody the initial purpose of the legislation governing design patent to “encourage innovation”, rather than “indicate products”. In conclusion, the writer would like to recommend taking “the designers in the art” as those from whose perspective to evaluate the “inventiveness” of a design. In addition, considering that the “novelty” and “inventiveness” of the invention or utility model are evaluated from the perspective of “a skilled person in the art”, and that the above evaluation of the novelty of a design is relatively objective, it is legislatively and technologically possible for, both the “novelty” and “inventiveness” of a design to be evaluated from the perspective of “a designer in the art”.

Drawing on the method for determine the “obviousness of an invention patent”, following principles are recommended for evaluating the “inventiveness” of a design:

1) From whose perspective to make determination

Whether a design is obviously different compared with the prior art and design features thereof is determined from the perspective of “a designer in the art”.

The “designer in the art” refers to a hypothetical “person”, who is supposed to know all the common designs in the art of the design prior to the date of filing or priority, has access to all prior designs in the art, and should have the ability to use the common means of design before said date, but possess no inventive capability.

2) How to make determination

Step one: identify the closest prior design;

Step two: identify the distinctive design features of the closest design;

Step three: determine whether said distinctive design features are obviously different to the designer in the art.

In the above three steps, what is to be determined is whether the prior design, as a whole, gives some inspiration

on design, that is, whether the prior design has given the inspiration on applying said distinctive design features to the closest prior design. This inspiration enables a designer in the art to combine said distinctive design features with the closest prior design to obtain the claimed design. Under the following circumstances, the inspiration is generally believed to be present in the prior design compared to the closest design:

- (1) the design is only slightly different in small details;
- (2) said difference is part of the general knowledge of designs, including known designs and means of design;
- (3) said difference is exactly identical with or only slightly different from the disclosed design features of the other prior designs, and is identical in function and in overall visual effect; and
- (4) said difference is exactly identical with or only slightly different from other design features that do not take a product as their carrier, and is identical in function and in overall visual effect.

However, to the preceding circumstances, anything that produces unexpected, unique overall visual effect upon combination is an exception.

The general knowledge of designs covers (1) known shapes of the designs in the art or similar art; (2) known patterns and colours, not subject to regional limitation; and (3) known means of design.

The slight difference in small details means that said difference is in a place where it is not visible or not readily visible when the product incorporating the design is in normal use, or it is proportionally small in the entire design. Whether a difference is “slight”, as mentioned above may be correctly determined only on the basis of full knowledge of the overall state of art of the prior design.

The other design features mentioned in circumstance (4) include pure design and part of it that do not take a product as their carrier, such as a whole copyrighted work or whole work of trademark, and a part thereof, with the shape, pattern and colour of substantiated products, such as natural objects and buildings also included.

Whether the difference between the patent in suit and the prior design is a design feature disclosed in other references or known knowledge of designs, more objective conclusion of examination is made by adducing evidence. Of course, for any design knowledge known to the public, it is not necessary to adduce evidence, and it is possible to explain the matter in the examination decision.

In order not to make the standards for evaluating the inventiveness of a design more demanding than the overall level of the design regime in China, reference may be made to the utility model patent evaluation method, with slight control over the number of the field of the prior design and the prior designs:

(1) Field of prior design

In respect of the design patent, examination is usually focused on the field of the product incorporating a design and that of the product in a similar class. If a design of a different field gives clear inspiration on use of it in the field of a design in suit, then said design of the different field is taken into consideration.

(2) Number of prior designs (including prior designs and other design features)

As for the design patent, one to three prior designs may usually be cited for evaluation of its inventiveness; for a design patent generated by “simple addition” of prior designs and other design features, multiple prior designs and other design features may be cited for the purpose as circumstances so require.

For example, for the following “litterbin” case, the difference in the opening of the patent in suit and the prior design was disclosed in prior design 2, and the difference in the door frame of the two in design 3. The sign on the litterbin, something known to the public, can be directly identified, and proved by adduced evidence when necessary. On the basis of this, it is possible to be determined that the patent in suit and the combination of the prior designs 1 to 3 are not “obviously different”. ■



The patent in suit



Prior design 1



Prior design 2



Prior design 3



Adduced evidence of the signs known to the public

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