

# Probing into Hot Issues of Design Patent

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The third amendment to the Patent Law has brought considerable changes in the standards for the grant of design patent, and hot issues of design patent grant and infringement standards are constantly emerging. This article will be probing into some hot issues of designs, proposing that the specific issue of the role of reference view of state in use should be analysed according to facts of specific cases, and the reference view should not be simplistically excluded from the extent of protection; a design should be assessed from the statutory hypothetical person who has the common, general knowledge of the space for making design in a product, is not one of a particular type in real life, and should not be simply, literally understood as an average consumer; main point of design can serve as a basis for determining the extent of protection only when it has notable impact on the overall visual effect; a similar design is an exception to the one-design application system, and some parts of design may be invalidated, surrendered, licensed, but only a design as a whole can lose its validity and can be assigned.

Prior to the third amendment to the Patent Law, the design infringement and affirmation procedures both involve determination of two identical or similar designs. Two similar designs are assessed with separate comparison made between products of identical or similar class, through overall

observation and comprehensive judgment. If identical or similar in shape, the two are found similar. After the Patent Law amended for the third time went into force on 1 October 2009, the design infringement and affirmation standards began to take on different road. On the basis of assessment of identical or similar designs, the similar inventiveness requirement is added to the patent grant standard, that is, products of different (dissimilar) classes, in the presence of the teaching of transformation in use or combination, may be used to assess the patentability of a design. As a sword having double blades, in the patent system, the right affirmation standard restraining double patenting doubtlessly should be compatible with the infringement standard, or it would cause disorder in market operation: it is impossible for one business to bear the legal consequence of being accused many times of infringing the same subject matter of a patent right. For that reason, the issues of standard for determination of identical or similar designs are hot issues in infringement cases and, as well, in cases involving patent right affirmation, such as, the ability of those from whose perspective determination is made, the way to apply overall observation and comprehensive judgment, the role of the main point of design pointed out in the brief explanation, issues relating to subject matter protected under the design patent (sole func-

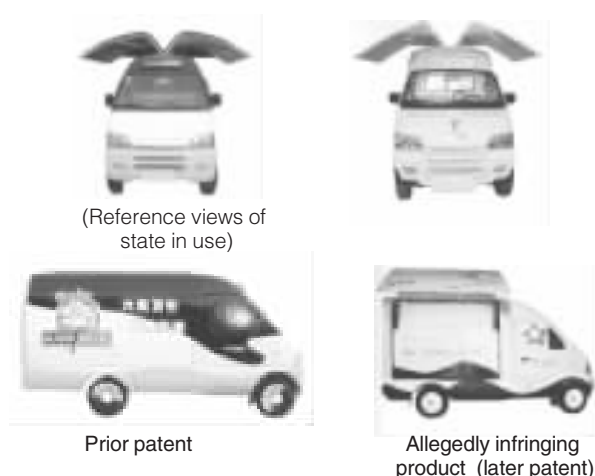


tional definition determination), construction of scope of a design (the legal position of reference view of state in use), and the sufficiency of disclosure of reference shown in three-dimensional views. Along with the implementation of the new Patent Law, new issues will constantly come up, such as those of the standard for determining two-dimensional printing article mainly functioning as an indication, the standard for determining similar designs and the legal consequence thereof, and naming of those from whose perspective determination is made under the new grant standard. Following is an analysis of, and exploration into, some of these important issues.

## I. Legal position of reference view of state in use

On the matter of legal position of the reference view of state in use, there have been two different views in the community. No express provisions are set forth in the Patent Law and its Implementing Regulations concerning whether a reference view of state in use is the basis for construe the scope of a design. The only provision found in the Guidelines for Patent Examination is: "reference views are usually used to facilitate understanding of the fields, methods of use, places of use or purposes of use of the design being examined." Different interpretation of this provision has caused conflicting opinions. Following cases may show the confusion caused by relevant arguments.

### Case 1: Infringement case involving dining vehicle



In the case, the involved allegedly infringing product was similar to the reference view of state in use of the patent in shape, and could be found similar to the patented product

on the whole. The matter is that, under the Guidelines for Patent Examination, if the title of the view of the patent was a view showing a varied shape, then it certainly fell within the extent of protection, or only the other view could be compared with the allegedly infringing product and evaluated. In that case, it was likely to draw an entirely different conclusion. Consequently, there is a puzzlement: is the extent of protection of a design determined by the formal title of views, or by the content shown therein? The following case further shows the puzzlement on the issue.

### Case 2: Right-affirmation case involving a couch

The reference view of state in use of the patent in suit showed that the back and foot part of the couch might be adjusted at various angles to be turned into a sleeping chair, but this state was not visible in the views of the reference, which only showed an ordinary couch. In other words, the reference did not disclose the state visible in the reference view of state in use of the patent in suit.



The patent in suit

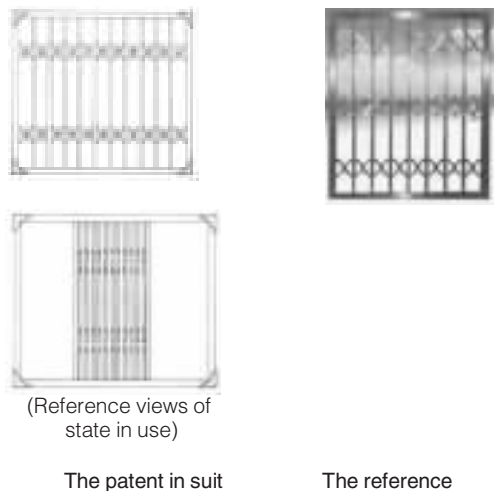
The reference

During the right affirmation procedure, the patentee argued that as the reference view of state in use showed, the state of use of the patent in suit was changeable, but the prior design did not disclose the various states of use like the patent in suit. The two were notably different in the state of use. It was concluded in the invalidation examination decision that the state of use of the patent in suit was disclosed in the reference view of state in use. Under the Guidelines for Patent Examination, it fell outside the extent of protection of a

design patent. Therefore, it was decided to compare the design as shown in the hexahedral view and three-dimensional view for identicalness or similarity, and the patent in suit was finally declared invalid. A request was filed to the trial court to review the decision. The first-instance decision cancelled the invalidation decision on the ground that the two designs were dissimilar, without making any comments on the determination of the four reference views of state in use. The following case shows the different roles reference views of state in use have in different cases while the conclusions were not controversial.

Case 3: Right affirmation case involving “shielding window”

The text of the published granted patent included a view entitled “reference view of state in use of shielding window”, in which the rails of the shielding window shown were drawn in. The reference was from a press commercial showing only one state and did not show the drawn-in state of the reference shielding window.



It was concluded in the invalidation examination decision that the reference view of the open shielding window in the patent in suit showed still another state of the patented product besides the one as shown in the main view. It indicated the state of all the connecting parts of the patented shielding window when in an open position. Since the patented product in normal use should be in the open state as shown in the main view, the reference view showing the open state of the shielding window was not sufficient to have notable impact on the overall visual effect of the patented product, so the patent in suit was declared invalid. Upon the first and final instance hearings, the conclusion of the invali-

dated decision was maintained, but the two court decisions made it clear that the state of product as shown in the reference view fell outside the extent of protection of the compared design.

The two provisions in the Patent Law and its Implementing Regulations concerning the legal position of views of a design, namely Article 59, paragraph two and Rule 27, paragraph two, both do not exclude the reference view of state in use from the extent of protection. For this matter, any such simplistic exclusion in the right affirmation procedure involving double patenting determination or conflicting applications and in the infringement proceedings is baseless in terms of law.

Section 4.2, Chapter 3 of Part 1 of the Guidelines for Patent Examination provides, if it can be understood as exclusion of the reference view of state in use from being used as a basis for design construction, then, the aim of the provision is to meet the obligation to notify beforehand, leading the applicant to produce drawings in a correct way. But this provision was set forth in the right affirmation procedure before the Guidelines for Patent Examination as of 2010, whether it has the function to notify beforehand is open to question. What is more, this provision was added to the Guidelines for Patent Examination in 2006 they were amended. It is obviously unfair for a rightholder who filed a patent application before that to exclude reference view of state in use when the extent of protection is determined: he, at the time of filing the application, was not aware that views all showing a design were treated differently in terms of legal position. But patents of the type are now still valid. Many patents involved in right affirmation procedure and infringement lawsuit are of the type.

Besides, designs shown in the reference views of state in use are mostly those in varied states, but Section 5.2.5.2, Chapter 5 of Part 4 of the Guidelines for Patent Examination provides: “a product of variable states means a product, which can be in various states when on sale or in use. As for a comparative design, such a product in all its variable states may be compared with the patent concerned. As for the patent concerned, such a product shall be taken only in its state of use to compare with a comparative design, and the judgment shall be made considering comprehensively the design of the product in its various states of use.” Therefore, the title of a view, not the content shown therein, becomes the basis for determining the extent of protection. In the absence of prohibitive provision in the Patent Law and its

Implementing Regulations, whether such “sudden death” exclusion is sound in the theory of law is open to question.

For this writer, to date, where contents shown in reference views of state in use are rather confusing, they should be treated differently according to the specific facts of different cases, with account taken of the three circumstances about the legal role of reference views. One, if it shows another one or several states in use of a protected product, it should be treated according to the view showing the states in use, making comparison with the design for identicalness or similarity under the relevant rules. Two, if it includes other content, all its contents irrelevant to the design incorporated in the protected product, such as background, people and other products used along with it, are excluded. Three, under some circumstances, the design incorporated in the patented product shown in a reference view somewhat differs from that shown in its hexahedral front projection view. For example in the latter view the product has some additional ornamental words or patterns, such view then may be excluded when determining the extent of protection thereof.

## II. Capability of average consumers from whose perspective determination is made

From whose perspective to determine design patent has long been controversial. As early as seven years ago, the Beijing Higher People's Court wrote to the Patent Reexamination Board (PRB) to make judicial recommendation in respect of the matter, holding that the determination should be made from the perspective of a designer in the art. Considering that the design patent grant standard in force at the time was similar to the novelty standard in China, when the grant standard remained unchanged, it was improper to modify the determination perspective in order to avoid conceptual confusion on the standard. The Guidelines for Patent Examination do not change the determination perspective, but specify, in detail, the capability of those from whose perspective determination is made.

Under the Guidelines for Patent Examination as of 2006, the average consumers have the common, general knowledge of the design in the product. With constant contact with and attention paid to products of some class, they know about the function and technical specification of the relevant products, and sometimes even propose improvements. They

also know about the state of the art of the design, including the developments, the common and even variable content of designs. While they are likely not to know about the process requirement to make the design, nor about how some visual effect is achieved through the design, they know where changes are rare, and what the common designs are. Since they see the relevant products, they are able to quickly distinguish different designs from each other, and disregard the familiar, invariable content of design. After the amendment made to the Patent Law in 2008, the grant standard similar to the novelty standard was introduced, so that the denotation and connotation of the concept of average consumers changed. Under the Guidelines for Patent Examination as of 2010, the “average consumers” should be additionally capable of knowing about the common means of design. For example, they, with the help of the inspiration of a relevant design, are capable of determining that the designs of some class of products are derived from transformation or piecing-together of designs. The capability enables average consumers to almost reach the level of a designer incapable of creative design. In this aspect, the words “average consumers”, in literal meaning, are not accurate. But since average consumers are those established in law as the people from whose perspective determination is made, then it is their capability that requires our attention.

An average consumer is a statutory hypothetical person who is capable as one to make his determination, and is not a specific type of person in the real world as his capability of identifying the differences between the products of the same class is different from that of those in the real world. That is, it is difficult for him to see the differences in small detail between the design elements of designs. For that matter, disregarding the differences in small detail makes it hard to set the two designs apart from each other. That is, the differences in small detail cause two designs to leave the same overall visual effect with the average consumers. The average consumers are different from ordinary consumers in the art in that the latter refer to a specific group of people, who unconsciously add something irrelevant to their determination of design of products due to individual variations in terms of inherent perceptiveness, age and experiences. By contrast, average consumers will remove all these interruptions, and arrive at an objective conclusion. In the past, we often took some type of people in the real world as those from whose perspective to make the determination. They are the people who have the most common-sense knowledge of

the product, but not a particular group of people in the real world.

To determine whether the difference of a design from a prior design possesses inventiveness on the basis of the knowledge level and cognitive capability of the average consumers needs to rely on the knowledge of state of art of the field to which the relevant product pertains. That is, to understand the knowledge level and cognitive capability of average consumers is, after all, knowledge of the state of the art of the existing design for the purpose to find whether the difference of a design from a prior design is a patentable innovation or creation. One important issue in the finding is what the state of art in the field of the product offers as the base on which the innovation of the design is made, that is, how large the space for innovation of design is left by the function of the product *per se*, the development of the relevant technology and the existing designs (freedom of design). If the space for design of some relevant product is very limited, then some relatively specific, fine difference of a design from the existing design may be deemed to be a point of innovation, otherwise, not. Therefore, an average consumer's understanding of the space for design (freedom of design) is an important capability of common-sense understanding of the existing designs, a capability that is of great realistic significance to the determination of design patentability and the patent infringement finding.

### III. Overall observation, comprehensive judgment and main point of design

The role of main point of design has also long been an issue of debate in the community. Especially after the Patent Law was amended for the third time in 2008, Article 59, paragraph two, of the Patent Law expressly provides that it has the function to interpret the extent of protection. Besides, Rule 28 of the Implementing Regulations of the Patent Law clearly specifies the main point of design as something essential in the brief explanation, thus further enhancing this function in determination of the extent of protection. Therefore, there is a view that the extent of protection should be determined by the main point of design, a view to which the writer does not agree.

Under Section 4.3, Chapter 3 of Part 1 of the Guidelines for Patent Examination as of 2010, "the essential features mean that the shape, pattern or their combination, or the combination of the colour with shape or pattern, or the posi-

tion, which is different from prior design. The description of the essential features shall be compendious". Section 6.1, Chapter 5 of Part 4 provides: "it should be noted that the design designated by the essential features of the design in the brief explanation does not necessarily have a notable influence on the overall visual effect ...". For example, as to the auto design, the brief explanation points out that the essential features of the design lie in the bottom side of the automobile, however, the design of the bottom side does not have a notable influence on the overall visual effect of it."

For this writer, the main point of design in the brief explanation is what the design applicant wishes to be claimed, and design the patentee pays his attention to. But according to the relevant grant standard and infringement determination standard, that is, when identical or similar product designs are compared with each other, it should be considered, from the perspective of average consumers, whether they are similar in the overall visual effect, rather than considering the content of partial design. Therefore, overall observation and comprehensive judgment in combination with the point of innovation (the main point of design has notable impact on the overall visual effect) are the correct way of making the determination: if the main point of design has notable impact on the overall visual effect, then it is the basis for the determination; if the main point of design is too small or in a position invisible to or unsuitable for the perception of average consumers, having no notable impact on the overall visual effect, then it is not.

### IV. Consolidated similar design application system

In 2008, the Patent Law was amended for the third time by adding the consolidated similar designs application system originally for the aim to address the issue of an applicant's similar designs being precluded from patent protection. It is an exception to the unity of design, and different from the similar systems of the other nations and regions, such as the associated designs system in Japan, the combined designs system in the Taiwan region, the similar designs system in Korea, and multiple application system in the EU. The consolidated similar designs application means that one patent includes several independent designs, which are incorporated in one product (one of the identical function) and similar in shape. Section 9.1.2, Chapter 3 of Part 1 of the Guidelines for Patent Examination provides that "normally,

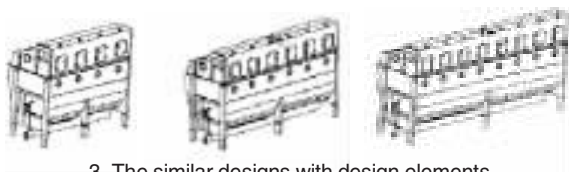
through overall observation, if the other designs and the main design have the same or similar design features, and if the difference between them lies in slight changes in some fine details, usual design of this category of the products, the repeated and continuous arrangement of a design element or mere change of colour, they are considered as similar designs.” The similar designs are exemplified in the following.



1. The similar designs partially different in small details



2. The similar designs different in the common design used in the product of the class



3. The similar designs with design elements repeatedly arranged

It is possible for each design of a similar design patent to be invalidated, that is, a design patent can be partially invalidated. This provision results from the logic consideration that “similarity is not naturally “spread”, that is for basic design A, similar design B and similar design C, if prior design D is similar to design B, it is not necessarily similar to A or C. For example, for designs with the continuous elements repeatedly arrangement and the designs similar to the main design in the middle, if a prior design is similar to the design at one end, it is not necessarily similar to the design at other end. But in practice, it is more likely for similarity to spread. For this writer, for protection of similar designs in consolidated application, a patentee may surrender or license several designs within the design patent. But, as one patent right, it should lose its validity or be assigned altogether as one patent right for the purpose to maintain the stability of the order of the market operation.

For all the preceding hot issues around the design

patent, we have to search continuously for correct way to address them in practice. It is hoped that this article will draw further excellent studies in the future in our joint efforts to further improve the system for the protection of design patents and to ensure smooth sailing of the market oriented economy. ■

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