

How to Construe “Aesthetic Appeal” in Definition of Design in Patent Law

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This article argues that “aesthetical appeal” in a design more exactly means “for aesthetic appeal”. A design incorporated in a product or a product design and developed for or mainly for achieving “an aesthetic appeal” is a subject matter susceptible to the design patent protection; a product design developed for or mainly for performing “a function” is not. It is recommended in this article that the following provision should be added to the Guidelines for Patent Examination that a product design that is functionally or primarily functionally defined and one that is hidden in actual use of the product are not subject matter susceptible to the design patent protection.

I. How to construe “aesthetically appealing”

In the Patent Law, a design is defined as “being a new design of a product’s shape, pattern or the combination thereof, or the combination of its colour, shape and/or pattern, which is aesthetically appealing and industrially applicable.”

The Legislative Affairs Commission of the Standing Committee of the National People’s Congress had had long discussion on the matter of whether “aesthetically appealing” should be changed into “ornamental” in the definition of design in the course of the third amendment to the Patent Law, and finally decided to have kept the wording intact for these reasons: first, both the expressions or wording of “ornamental” and “aesthetically appealing” were used in the rel-

evant laws of many other countries, and design was not defined in Articles 25 and 26 of the TRIPS Agreement, which showed that it did not mean to harmonise the definition of design in the laws of the member states; second, the term, aesthetically appealing, was used mainly to indicate that in determination of whether something was susceptible to the design patent protection, attention should be paid to a person's perception towards a product design, rather than the functional or technical effect of the product, which was the essential difference between a design and an invention or a utility model. The term "aesthetically appealing" should be construed broadly, not subject to the impact of a person's perception of something "aesthetic" or "not aesthetic"; and third, in the real life there had never been a case in which a design was rejected for patenting or a design patent declared invalid for being "not aesthetic".¹

The writer is for the view that the function to require the "aesthetic appeal" of a product design is to determine whether a product design is a subject matter susceptible to the design patent protection. "Being aesthetically appealing" is the pre-condition for a product design to be a subject matter susceptible to the design patent protection, but so far there has never been a case where a subject matter is not susceptible to the design patent protection for its not lack of "aesthetical appeal" so that the design is rejected for patenting or a design patent declared invalid, which exactly shows that the statutorily required "aesthetic appeal" does not perform the function, in our real life, to define a subject matter susceptible to the design patent protection, and the legislative aim of the requirement of "aesthetic appeal" has, in fact, not been achieved.

The requirement of "aesthetic appeal" in the definition of design has the function to define the scope of the subject matters susceptible to the design patent protection, and exclude all subject matters not susceptible to the design patent protection. The following view is indisputable: even being "aesthetically appealing", a product design functionally or primarily functionally determined is not a subject matter susceptible to the design patent protection. It is clearly provided in Article 25 of the TRIPS Agreement that protection does not extend to designs dictated essentially by technical or functional considerations. Paragraph 1 of §171 of 35 U. S. C. provides that whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. In the United States, "being ornamental" is one of the

conditions for a product design to obtain a design patent protection, and only an ornamental or mainly ornamental product design is the statutory subject matter susceptible to the design patent protection.

To enable "aesthetic appeal" to function to exclude product designs dictated by or mainly dictated by functional considerations from the design patent protection, the "aesthetic" in the "aesthetically appealing" should not be construed as a concept corresponding to "unaesthetic", and "being aesthetically appealing" not as an aesthetic or unaesthetic matter, rather as a matter a product design is designed for achieving aesthetic appeal or function. A design for achieving aesthetic appeal corresponds to one for achieving a function; if a product design is created for or mainly for achieving aesthetic appeal, it is a subject matter susceptible to design patent protection; if a product design is created for or mainly for achieving a function, or it is dictated by or mainly dictated by functional considerations of the product, then said product design is not the subject matter susceptible to design patent protection. Thus, if an aesthetically appealing product design is construed as a product design for achieving aesthetic appeal, the statutorily required "aesthetic appeal" in the definition of design may function to define the scope of subject matters susceptible to design patent protection.

It is provided in Chapter 5 of Part IV of the Guidelines for Patent Examination as of 2010 that "a particular shape defined by the function of the product shall generally has no significant impact on the overall visual effect"². This provision is obviously related to the absence of the provision in the Patent Law on excluding product designs dictated by or mainly dictated by functional considerations from the design patent protection. However, when examination is made as to whether a design for which patent is applied for is identical with or similar to any prior design, determining that a product design solely determined by the function thereof has no significant impact on the overall visual effect cannot fully address the issue, and, sometimes, has unfair consequence. For example, the main part of a design for which patent is applied for is functionally determined, so is the prior design compared therewith, but the minor part of the design for which patent is applied for is ornamental, and is not identical with or is dissimilar to that of an ornamental prior design. In case like this, as a functionally determined product design is viewed as having no significant impact on the overall visual effect, examination is made with account taken of, or mainly

of, the different or dissimilar ornamental part, and the conclusion would be that the product design for which patent is applied for is not identical with, or is dissimilar to, the prior design, and may be deemed patentable, thus granted the patent.

Here, however, it is essentially not a matter of whether a design for which patent is applied for is identical with or similar to the prior design, but one of whether the mainly functionally dictated product design is a subject matter susceptible to design patent protection. Before the examination is made as to whether the product design for which patent is applied for is identical with or is similar to a prior design, it should be first determined whether the product design for which patent is applied for is a subject matter susceptible to design patent protection. If the product design for which patent is applied for is or is mainly functionally dictated, said product design is not a subject matter susceptible to design patent protection, and, the application should be rejected accordingly, without the need to examine it as to whether it is identical with or similar to any prior design.

The Patent Law as amended for the third time clearly provides for the conditions of novelty and notable distinctiveness of patentable designs. It is provided in Chapter 3 of Part I of the Guidelines for Patent Examination that “aesthetic” means that when judging whether the subject matter is patentable, the visual perception of the appearance of the product shall be taken into consideration, but not the function or technical effect of the product”.³ It seems that people have realised that the mission of “aesthetic appeal” in the definition of design is to define the scope of subject matters susceptible to design patent protection; but it is only a provision in principle, and “aesthetic appeal” is potentially understood as meaning “aesthetic” and “unaesthetic”, so the provision can not exclude the product designs dictated by or mainly dictated by functional considerations from the patentability. The Guidelines for Patent Examination as of 2010, following the provisions set forth in the Guidelines for Patent Examination as of 2006, have failed to give the circumstances under which a product design dictated by or mainly dictated by functional considerations is excluded from patentability. Therefore, the writer would like to suggest adding the provision that “the circumstance under which product designs dictated by or mainly dictated by functional considerations are not susceptible to the design patent protection” to section 7.4 of Preliminary Examination of Application for Design Patent, Chapter 3 of Part I of the current

Guidelines for Patent Examination so that the statutory requirement of “aesthetic appeal” would specifically apply to the examination of design patent applications, and product designs dictated by or mainly dictated by functional considerations are excluded from patentability as subject matters not susceptible to the design patent protection.⁴

Additionally, not only the preliminary examination of application for design patent should be, according to the law basis of “aesthetic appeal”, added the provision that product designs dictated by or mainly dictated by functional considerations be excluded from the scope of subject matter susceptible to design patent protection, but also should corresponding provisions be set forth for the design patent invalidation proceedings to enable the public, competitors included, to request, on the “aesthetic appeal” ground, for invalidation of any issued patent for product design dictated by or mainly dictated by functional considerations.

II. Whether designs of products hidden when in use are subject matters susceptible to design patent protection

In the United States, a product design is ornamental in two meanings: one, a product design is ornamental or mainly ornamental; two, a product design attracts people's attention. By product design attracting people's attention is meant that when in normal use an ornamental product design attracts people's attention. A product in normal use is meant the process from the manufacture or eventual assembly to destruction, consumption or end of the product. Regarding products hidden when in use, the U.S. courts take the view that normally, a design should not be impatentable because its product is hidden when in normal use. While almost all products are visible when they are made or fixed when in use, this does not make design of products hidden when in use legitimately patentable. But the preceding empirical rule is not decisive. In a case, it must be asked whether there is a stage in the life of a product, its design attracts people's attention. In other words, if a product's ornamental design attracts people's attention after the product is made before it is put in a hidden place, the ornamentality is a basis for patentability.⁵

After a product design that is aesthetically appealing is understood as a product design for achieving aesthetic appeal, as in the U.S.A., it should be further required that a

product design created for achieving aesthetic appeal is what people pay attention to in normal use. If people pay no attention to the design of a product in normal use, it is unnecessary to patent the design. As no attention is paid to the product design, it is unnecessary to give the product design monopoly for the purpose to encourage people to constantly make innovation of the product design. That a product design attracts people's attention when the product is put to normal use embodies the intrinsic requirement for a product design created for achieving aesthetical appeal.

For designs of products hidden when in use, however, this writer thinks that the U.S. practice is not fair. Now that for a product hidden when eventually in actual use, people pay attention to their function, not the design of the product. Even before it is hidden, the design of the product might attract people's attention, but the real value of the product lies in its function and effect in actual use, so it is unnecessary to give the design patent monopoly because the product design attracts people's attention before it is hidden away in a certain period of time.

In *In re webb*, the U.S. CAFC concluded that the design of ornamental vitamin pills attracted people's attention before they were taken, said design could be a subject matter susceptible to the design patent protection. For this writer, for such vitamin pills to be taken, innovation of the pills *per se*, not the ornamental design of the shape of pills should be encouraged; hence it is unnecessary to protect the design of such pills to be taken. The writer takes the same view as that of the USPTO that even if a product design is observable in the commerce life of the product in a certain period of time, said product design is not a subject matter susceptible to the statutory design patent protection so long as it is invisible when the product is in actual use.⁶

The practical situation in China is that there are a lot of patents issued to designs of products hidden when in actual use. This writer searched, on the official website of the SIPO on 21 March 2012, 29,645 patents for designs of section steel, 123 patents for designs of compressor of air-conditioners, and 55 patents for designs of CPU radiators. All the products, such as section steel, compressor of air-conditioners, and CPU radiators, are products hidden when in actual use. It is unnecessary to patent them, but now quite a lot of patents have been issued therefor.

Whether designs of cross section of section steel or other section products should be patentable or not is a controversial issue. As the provisions of the Guidelines for Patent

Examination show, it is affirmed that such designs are patentable subject matter. The Guidelines for Patent Examination as of 2001 provided that the cross section of section steel is the main part of such products⁷. The same provision has been set forth in the Guidelines for Patent Examination as of 2010 and the Guideline for Examination as of 2006 that "since the contour of the cross section of section steel is usually rectangle, the change in other parts of the cross section has more notable effect"⁸.

There is a view that it is possible for designs of cross section of section steel to be subject matter susceptible to design patent protection, and it is further believed that since section steel products mostly function to support and insert different types of building materials, such as glass, rubber sealing strips, metal connecting pieces and plastic connecting pieces, invention-creation of section steel products fully focus on designing various shapes of section products for supporting members, including grooves and convex folding edges for inserting and connecting section steel to achieve the best match or connection between building members. All these factors form the shape of cross section material, and this is where people's invention-creation lies. The different shapes of the cross section of section steel determine the various supports for other connecting pieces and connection when the section steel is in normal use, with all its function fully embodied in the cross section shape of the section products, which is the key point of protection therefor. If we only consider the surface shape of section steel, not its cross section shape, it is actually impossible to protect the particular use and function of section steel, only with a result destructive to people's zeal for developing new types of section steel, detrimental to technological progress, and contrary to the legislative aim of the Patent Law.⁹

For this writer, this view obviously does not hold water. First of all, if it is true that "the different shapes of the cross section of section steel determine the various supports for connecting pieces and connections with other connection members when the section steel is in normal use", then the shape of the cross section of section steel is entirely dictated by functional considerations, and the shape of cross section is not a subject matter susceptible to design patent protection. Then, even if some shape of cross section is not or not mainly dictated by functional considerations, rather is ornamental, but the cross section of section steel is invisible and hidden away when section steel is in actual use, it is unnecessary to give it the patent monopoly to encourage innova-

tion of these ornamental shapes. Next, a technical solution “determining the various connecting pieces and connections with other connection members when the section steel is in normal use” should be subject matter of protection for an invention or utility model patent if it is patentable as such and susceptible to the design patent protection. Not protecting design of cross section of section steel would not cause the result destructive to people’s zeal for developing new types of section steel, detrimental to technological progress, and contrary to the legislative aim of the Patent Law. The design patent is not legislatively to promote technological progress, but to spur creation of aesthetically appealing designs for products, so absence of protection for design patent would not be detrimental to technological progress in relation to section steel.

This writer would like to suggest adding a provision regarding the “circumstance under which designs of products hidden when in use are not susceptible to the design patent protection to Section 7.4, Chapter 3 Preliminary Examination of Design Patent Applications of Part I of the Guidelines for Patent examination. Likewise, there should be such provision not only in the preliminary examination of design patent applications, but also corresponding provisions in the design patent invalidation proceedings for the public, competitors included, to file requests for invalidation of relevant design patents under the provision after such design patents are issued.

III. How to treat patented design dictated by or mainly dictated by functional considerations in infringement litigation

In design patent infringement litigation, for this writer, the court is not responsible for reviewing whether a patented design being enforced is a product design dictated by or mainly dictated by functional considerations. If a defendant alleges that the patented design a plaintiff has enforced is one dictated by or mainly dictated by functional considerations, the defendant may request invalidation of the corresponding design patent, and the court hearing the case may decide whether or not to suspend the proceedings depending on the specific circumstances and according to the likelihood of invalidation of the design patent in suit.

In finding infringement, if such a patented design in-

cludes some functional design feature, it, as a whole, is not mainly dictated by functional considerations, this writer thinks that we may draw on the U.S. Courts’ practice in case like this: If a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design. The patentee “must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.”¹⁰

Under Article 11 of the Supreme People’s Court’s Interpretation of Several Issues Relating to Law Application to Adjudication of Cases of Dispute Arising from Patent Infringement, product design mainly dictated by functional considerations should not be considered in determining identical or similar designs. This provision of the judicial interpretation is essentially consistent with the provision of the Guidelines for Patent Examination that “a particular shape dictated solely by functional consideration does not have notable effect on the overall vision effect”. As mentioned above, however, applying this provision to finding infringement might have unfair consequence under some circumstances.

In hearing infringement cases, if a product of a patented design is in a hidden place when in actual use, even if a defendant has requested the PRB to invalidate the corresponding patent, it is unnecessary for the court to suspend its proceedings, rather the court may directly decide that the infringement accusation is not tenable. As it is easy to find that a product is hidden when in use, the following situation would not arise in the same case: the PRB determines that the product is not in a hidden place when in use, but the court finds it is. Then the court may decide that there is no issue of consumers’ visual confusion on the ground that the product of a patented design is in a hidden place when in use, nor is it necessary to find whether the design is identical or similar, so as to directly decide on non-infringement of the design patent. ■

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¹ The Legal Affairs Department of the State Intellectual Property Office, Guided Reading of the Third Amendment to the Patent Law, the Publishing House of Intellectual Property, 2009, Pp.32-33.

² The State Intellectual Property Office, the Guidelines for Patent Examination as of 2010, the Publishing House of Intellectual Property, P.405.

³ The State Intellectual Property Office, the Guidelines for Patent Examination as of 2010, the Publishing House of Intellectual Property, P.83.

⁴ If the design part of a product for which the design patent is applied for is dictated, but not mainly dictated, by functional considerations, said product design is a subject matter susceptible to design patent protection. When comparison is made between such product design and a prior design as to whether they are identical or similar, reference is suggested to be made to the U.S. method of comparison: take the first step to determine whether the two designs are visually identical or similar as a whole; if they are, take the second step to find whether the identicalness in overall visual effect or substantial similarity of the two designs results from a ornamental feature. Only if the two steps show they are they found identical or similar.

⁵ See *In re Stevens*, 173 F.2d 1015, 1016, 81 USPQ 362, 362-63 (CCPA 1949); *In re Webb*, 916 F.2d 1553, 1557-58, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

⁶ *In re Webb*, 916 F.2d 1553, 1557-58, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

⁷ The State Intellectual Property Office, the Guidelines for Patent Examination as of 2001, the Publishing House of Intellectual Property, P. 485

⁸ The State Intellectual Property Office, the Guidelines for Patent Examination as of 2010, the Publishing House of Intellectual Property, P.484.

⁹ Wang Xiajun, Protection of Design of Section Steel Products carried in the Design Examination Department of the State Intellectual Property Office (ed.), Designs and IP Protection, the Publishing House of Intellectual Property, 2002, Pp.40-41.

¹⁰ For the detail of the U.S. standards for finding design patent infringement, see U.S. Standards for Finding Design Patent Infringement, carried in Zhang Xiaodu, Patent Infringement Finding, the Publishing House of Law, 2008, Pp. 171-186. For the detail of adjustment of the U. S. standards for finding design patent infringement, see Zhang Xiaodu, New Changes in U.S. Standards for Finding Design Patent Infringement, carried in the China Invention & Patent, 2009, issue 4.