

# Brief Analysis of Domestic Priority System for Designs and Major Applicable Principles

Xu Yuanyuan, Lv Xiao\* and Xu Qingping\*

## I. Introduction

The fourth revision of the Patent Law of the People's Republic of China (hereinafter referred to as the Patent Law) further improves the design protection system, wherein one of the crucial changes is to add the domestic priority system for designs. According to Article 29.2 of the revised Patent Law, where, within six months from the date on which an application for a patent for design was first filed in China, any applicant files with the patent administration department under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority. Therefore, the domestic priority system for designs has been established in the patent law.

## II. Legislative background of domestic priority system for designs

The establishment of the domestic priority system for designs is not only a practical demand of innovative entities for design innovation, but also an embodiment of gradual enhancement of China's design protection system. To be specific, the China's Patent Law sets forth the principle of unity of design patent applications, that is to say, one design patent application shall be limited to one design, and meanwhile there is also an exception. The Patent Law, before its 2008 revision, stipulated that the exception only includes "designs incorporated in a set of products", i.e., two or more designs incorporated in products that belong to the same class and are sold or used in sets may be filed as one application, thereby meeting the practical demands for design innovation to some extent. The Patent Law after revision in 2008 was added with a system for similar designs,

which allows "two or more similar designs incorporated in one product" to be filed as one application, thereby further resolving the practical issues as to design innovation. In the fourth revision of the Patent Law, a "partial design" is incorporated into the patent law for protection, the China's accession into the Hague Agreement Concerning the International Registration of Industrial Designs was put on the agenda, and the domestic priority system for designs came into being. The establishment of the domestic priority system for designs provides a strong guarantee of equal protection for domestic and foreign design patent applications, and effectively avoids the unreasonable phenomenon that different routes for application will affect whether a domestic priority can be enjoyed. It is evident that the creation of the domestic priority system for designs reflects the ever-improving historical evolution of the design protection system.

## III. The significance of the domestic priority system for designs

Similar to a foreign priority for a design, a domestic priority can also enable an applicant to enjoy the preferential treatment granted by the priority<sup>1</sup>.

First of all, on the condition that the unity requirement is met, an applicant can combine several earlier applications into one subsequent application by claiming the domestic priority, which, on the one hand, avoids patent instability as a result of possible conflicting applications or double patenting which the several earlier applications may constitute or cause, and, on the other hand, can reduce the annual fees that must be paid for the sake of cost saving.

Second, the applicant is allowed to convert the patent application type within the priority period, and the domestic

priority system for designs offers designs with more flexible rules for patent type conversion. Rule 35 of the Implementing Regulations of the Patent Law of the People's Republic of China (hereinafter referred to as the Implementing Regulations) newly revised in 2023 reads that "where a design patent applicant claims the domestic priority, if the earlier application is one for an invention or utility model patent, he or it may file a design patent application on the same subject matter based on the design as shown in the drawings; if the earlier application is one for a patent for design, he or it may file a design patent application on the same subject matter... Where an applicant claims the domestic priority, the earlier application shall be deemed to have been withdrawn from the filing date of the subsequent application, unless the design patent applicant claims the domestic priority based on the patent application for invention or utility model."

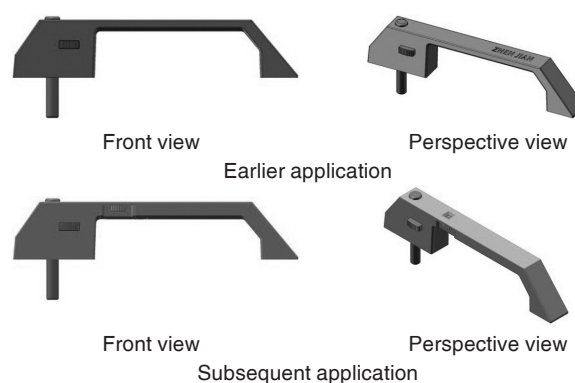
According to the above provisions of the Implementing Regulations, the earlier applications that serve as the basis for priority of a design are not limited to designs, and also include inventions or utility models; and where the earlier application serving as the basis for priority is an invention or utility model, it shall not be deemed to have been withdrawn from the filing date of the subsequent application, which is different from the situation where a design serves as the basis for priority. Why shall the earlier design application serving as the basis for priority be deemed to have been withdrawn from the filing date of the subsequent application, but the earlier invention or utility model application not? The major reason is that the former is to prevent double patenting, whereas the latter is in no way bothered by double patenting as the subject matter (technical solution) protected by the invention or utility model patent is different from that (product appearance) protected by the design patent. For this reason, the domestic priority system for designs is born with an advantage that the subsequent design application can claim a priority to an earlier design application, as well as that to an earlier invention or utility model application, as long as the requirements like the priority period are satisfied. That is to say, a design patent may be further derived from the drawings of the invention or utility model patent application, in such a way to confer further protection on the design innovations in the invention or utility model patent, and moreover achieve the mutual conversion between overall designs and partial designs. In addition, the domestic priority system for designs provides multi-dimensional and

all-round protection for design innovations.

The significance of the domestic priority system for designs will be further expounded by the following cases.

#### Case I:

In this case, the earlier and subsequent applications, which are two patents owned by the same applicant, relate to the design of lock products<sup>2</sup>. It can be known through comparison that the difference therebetween only lies in that the subsequent application has a combination lock with respect to the earlier application, to be specific, the subsequent application is added with a small component in the middle left of the beam of the lock as compared with the earlier application. It can be seen that the subsequent application relates to an improved design of a product over the earlier application.



Before the establishment of the domestic priority system for designs, patent applications which are filed on different dates but highly similar, like in the above case, may be faced with the problem of resulting in conflicting applications or double patenting, thereby exposing the subsequent application to the risk of being invalidated. However, after the establishment of the domestic priority system for designs, where the applicant forms a design scheme of the subsequent application through design improvement after the filing of the earlier application, if other requirements for the priority are satisfied, the applicant may file a similar design application that include the earlier and subsequent applications while claiming the priority to the earlier application, in such a way to combine these two patent applications and thereby protect patent applications for a series of gradually improved designs. Thus, under such circumstances, the earlier application shall be deemed to have been withdrawn from the filing date of the subsequent application.

#### Case II:

If the earlier application that serves as the basis for pri-

ority stems from an automobile design in the drawings of an invention or utility model patent application and the subsequent application claiming the priority seeks to protect the design of a component of the automobile, this is a case protecting the design innovation in the drawings of the invention or utility model patent application. Thus, a design patent application can be further derived from the invention or utility model patent application, thereby protecting innovation from multiple dimensions.



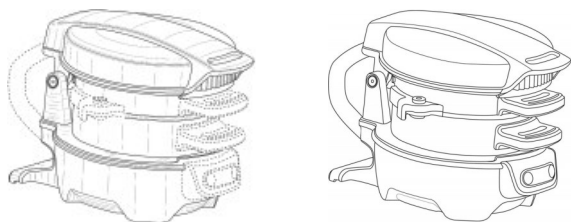
Earlier application

Subsequent application

Of course, if the earlier application in this case is a design patent application and the subsequent application protects a component of the earlier application, which is the conversion from an overall design to a partial design, the subsequent application can also include both the overall design and the partial design with the claim of a priority in a bid to protect both of them where the earlier application is deemed to have been withdrawn.

#### Case III:

This case relates to the product design of a sandwich maker<sup>3</sup>. The earlier application seeks to protect the partial design of the sandwich maker, whereas the subsequent application claims the overall design thereof. On the prerequisite that the requirement for priority is met, the domestic priority system for designs enables the conversion between the partial design and the overall design. Similarly, the subsequent application can also include both the overall design and the partial design to protect both of them by means of a priority claim.



Earlier application

Subsequent application

To sum up, the establishment of the domestic priority system for designs provides a more powerful guarantee for innovative activities in the field of designs, endows innovative entities with more flexible choices, and offers the innovative entities a further opportunity to choose a suitable pat-

ent application type.

## IV. Major principle for applying domestic priority system for designs

The principle for applying the domestic priority system for designs is mainly to verify a priority. Generally speaking, the following three aspects must be verified to decide whether a priority can be claimed: first, whether the earlier application serving as the basis for priority claim involves the same subject matter as the subsequent application which claims the priority; second, whether the earlier application is the first application with the same subject matter; and third, whether the filing date of the subsequent application meets the requirement for priority period.

In examination practice, whether the earlier application and the subsequent application have the same subject matter is the hard nut to crack in the verification of the priority to a design. In the light of the provisions of the Guidelines for Patent Examination, designs with the same subject matter shall meet both of the following two conditions: (1) both designs are for the same product; and (2) the claimed design in the subsequent application is clearly shown in the first application. It is further stipulated therein that where the pictures, photographs, or drawings of the claimed design in the subsequent application are not completely consistent with those of the first application, but based on the application documents of the two, the claimed design in the subsequent application has been clearly shown in the first application, it may be determined that the claimed design in the subsequent application has the same subject matter as that of the design in the first application, and thus may enjoy the priority of the latter.

The general principles for determining whether design applications have the same subject matter will be further expounded by the following cases.

#### Case IV:

In this case, the earlier application serving as the basis for priority claim is the design of a “label” used on packaging containers, and the subsequent application claiming the priority is the design of the “packaging container”. How should we judge whether the earlier application and the subsequent application have the same subject matter?



First, as known from the design drawings of the earlier and subsequent applications, the earlier application comprises three views, which are respectively the front view of the label and two reference views showing the state of the label used on the packaging container; and the subsequent application also comprises three views, which are respectively the front and perspective views of the packaging container and the enlarged view of the label used on the packaging container. According to the drawings, the earlier application protects the design of the label, and the subsequent application protects the design of the packaging container.

Second, it can be seen through comparison between the views of the earlier and subsequent applications that the views of the two applications demonstrate the same design, but are named differently. To be specific, the front and perspective views of the packaging container in the subsequent application correspond to the two use state reference views of the earlier application, respectively, and the enlarged view of the label used on the packaging container in the subsequent application corresponds to the front view of the label in the earlier application.

Although the drawings in the earlier application are not completely consistent with those in the subsequent application, it can be known from the drawings of the two designs that the views of the subsequent application correspond to those of the earlier application in a one-to-one relationship, that is to say, the design of the packaging container claimed in the subsequent application has been clearly

shown in the views of the label used on the packaging container in the earlier application. Thus, it can be determined that the design claimed in the subsequent application has the same subject matter as that in the earlier application, and can enjoy the priority.

There is a view that the earlier application protects a label, whereas the subsequent application protects a packaging container. Since they protect different products, they do not pertain to designs having the same subject matter. Is this view tenable?

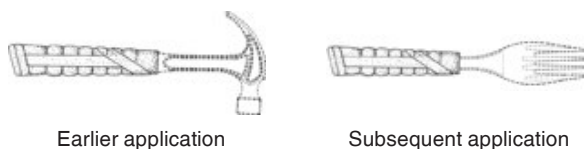
The Guidelines for Patent Examination specify in the Section entitled General Principle for Verification of Right of Priority that the verification of whether the earlier and subsequent applications have the same subject matter is to judge whether the technical solutions contained in the claims of the subsequent application are clearly described in the documents of the earlier application, which comprise the description and claims. As long as the technical solutions contained in the claims of the subsequent application are clearly described in the documents of the earlier application, it shall be determined that the earlier application has the same subject matter as the subsequent application. Although the Guidelines for Patent Examination expound the general principle for verification of the same subject matter by taking invention or utility model patent applications as an example, the general principle for verification of priority of a design patent application should be consistent with that for an invention or utility model patent application as they are all subject to regulation by the Patent Law. The verification of the same subject matter between design applications requires that “the claimed design in the subsequent application is clearly shown in the first application”, wherein the term “shown” corresponds to the term “described”, which also means that they are the same principle.

In this case, although the earlier application protects the design of the label, the design of the packaging container of the subsequent application has been clearly recorded in the drawings of the earlier application. The earlier and subsequent applications protect different product designs, but the designs thereof are completely identical. Hence, the design of the packaging container of the subsequent application has been clearly shown in the earlier application, and the earlier and subsequent applications involve designs having the same subject matter.

Case V:

In this case, the earlier application is directed to the de-

sign of a hammer, whereas the subsequent application relates to the design of a fork. The designs of the earlier and subsequent applications, except for the handle, are indicated by dashed lines, which means they both protect the partial design (handle) of a product. Do the earlier and subsequent applications relate to designs having the same subject matter?



In this case, the earlier and subsequent applications both relate to a partial design. In the determination of the scope of protection of a partial design, consideration shall be given to the shape, pattern and color of the claimed part, as well as the position and proportion of the part in the entire product. That is to say, the claimed part of a partial design is the kernel to the determination of the scope of protection; however, other parts also delimit the scope of protection to some extent. Thus, in the verification of the priority of a partial design, account shall be taken of the claimed partial design, and the overall design of the subsequent application, including the part denoted by dashed lines, thereby analyzing and deciding whether the overall design of the subsequent application is shown in the earlier application.

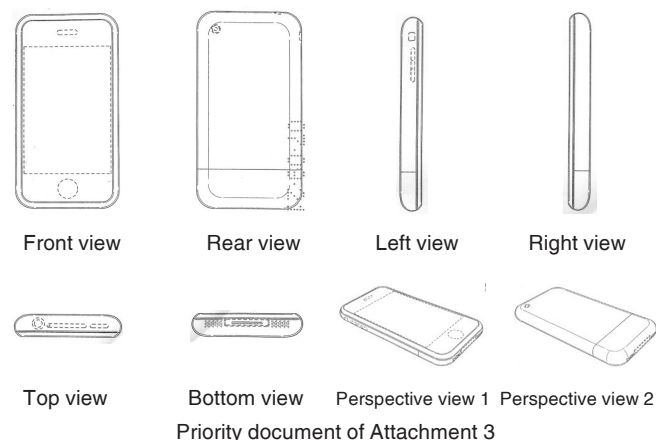
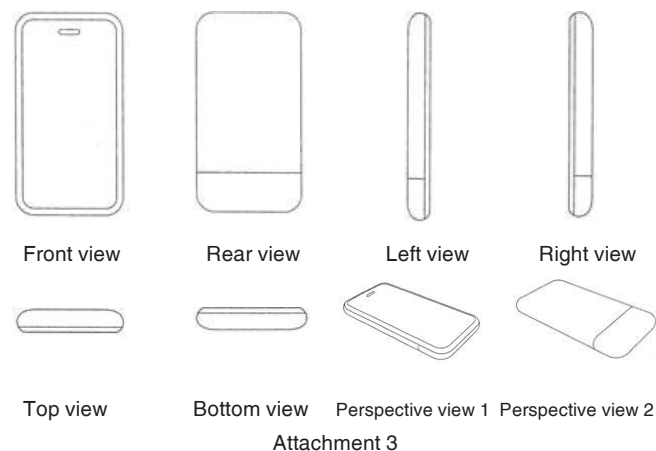
In this case, the earlier and subsequent applications both protect the partial design (i.e., handle) of the product. However, the earlier application relates to the design of a hammer, which is different from the design of a fork as claimed in the subsequent application. The design of a fork in the subsequent application is not recited in the earlier application. Therefore, the claimed design in the subsequent application is not clearly shown in the earlier application. They do not pertain to the designs having the same subject matter.

This case further expounds that the principles for identifying designs with the same subject matter are consistent with the principles for identifying invention and utility model patent applications with the same subject matter, efforts shall be made to verify whether the content recited in the earlier and subsequent applications has undergone changes and what changes have been made, and it shall be deemed that the two applications involve the same subject matter as long as the product design of the subsequent application is clearly recited in the documents of the earlier ap-

plication.

#### Case VI:

This case involves the verification of the priority, and specifically, the determination of whether the design as shown in Attachment 3 can enjoy the priority<sup>4</sup>.



In this case, Attachment 3 and its priority document show the same product, namely, the design of a mobile communication device. The main differences therebetween are that the views in the priority document show the components of the mobile communication device, such as the earpiece, screen, operation button and socket, in dashed lines, whereas Attachment 3 has no design of relevant parts shown by dashed lines in the priority document, except for the earpiece denoted by solid lines, instead of dashed lines. Furthermore, the priority document of Attachment 3 relates to a communication device with the shape and position of such components as the earpiece, screen, operation button and socket clearly indicated. Although these components are denoted by dashed lines and not defined to have a specific shape, it cannot be deemed that the product de-



sign may not have these components. Thus, Attachment 3 does not have those components denoted by dashed lines with respect to its priority document. Although the components of Attachment 3 are all shown in the priority document, the mobile communication device without a screen boundary and operation button as shown in Attachment 3 is similar to the design of a full-screen mobile phone, which is obviously different from the design as shown in the priority document. Nor does the priority document show the design of the communication device without those components as indicated in Attachment 3. Hence, they are not designs having the same subject matter. It can thus be seen that the verification of the priority requires not only the visual judgment on whether the earlier application comprises the views of the subsequent application, but also the judgment on whether the earlier application clearly shows the product design of the subsequent application.

## V. Conclusion

The domestic priority system for designs added through the fourth revision of the Patent Law is an epitome of China's constant efforts to improve the design protection system. By claiming the domestic priority to a design, it is possible to combine several earlier applications into one subsequent application, in such a way to prevent them from constituting conflicting applications or double patenting, and meanwhile reduce the annuities that need to be paid for the sake of cost saving. It is particularly noteworthy that under the domestic priority system for designs, the design of the subsequent application can claim a priority to an earlier design application, or to an earlier invention or utility model application, and the mutual conversion between an overall design and a partial design can be achieved. In addition, the domestic priority system for designs endows innovative entities with more flexible choices and provides multi-dimensional and all-round protection for design innovations.

The determination of designs having the same subject matter is the key and hard nut to crack in the verification of the priority. What needs to be emphasized is that designs having the same subject matter do not mean that the claimed design of the subsequent application must be completely identical with the design as shown in the pictures, photographs or drawings of the first application. If it can be known from the application documents thereof that the claimed design of the subsequent application has been

clearly shown in the first application, it can be determined that the claimed design of the subsequent application has the same subject matter as that of the design of the first application, and can enjoy the priority. In examination practice, the general principles for verification of the priority to design shall be accurately grasped on the basis of the legislative purpose of the priority system, thereby avoiding the rejection to a priority claim due to incomplete identicalness between the earlier and subsequent applications. ■

The authors' affiliation: The Re-examination and Invalidation Department of the Patent Office, the CNIPA

\* All authors contributed equally to this article.

<sup>1</sup> Yin Xintian (2011). Introduction to the Patent Law. Intellectual Property Publishing House.

<sup>2</sup> The Invalidation Decision No. 562150 issued by the CNIPA.

<sup>3</sup> The Invalidation Decision No. 29770 issued by the CNIPA.

<sup>4</sup> The Invalidation Decision No. 17985 issued by the CNIPA.

## “Intellectual Property Protection in China 2023” White Paper Officially Released

The “Intellectual Property (IP) Protection in China 2023” White Paper was officially released recently. The White Paper outlines the progress and achievements of China's IP protection in 2023 from five aspects: protection effectiveness, institutional construction, examination, grant and registration, cultural development, and international cooperation.

Since 1998, China has been publishing annual white papers on IP protection for more than 20 consecutive years. These documents have become authoritative materials demonstrating the Chinese government's firm stance on strict IP protection, helping domestic and international communities understand the *status quo* of IP protection in China.

Source: CNIPA