Strong Design Patents in China: The Power of Similar Designs

Design matters. Design patents have become an important asset in many intellectual property portfolios since Apple's design patents took center stage in Apple Inc. v. Samsung Electronics Co. How to build a strong design patent portfolio in China?

Chinese Patent Law defines three distinct types of patent protection , i.e., invention, utility model and design. Whereas an invention/utility model protects the way a product technically works and a design protects the way a product ornamentally looks, there may exist an overlapped scope. In fact, although the invention/utility model and the design afford legally separate protection, the technicality and ornamentality of a product are not easily separable and in many scenarios are complementary to each other.

The Patent Law, revised in 2009, introduced a combination application system[1] for a design with multiple embodiments of the same product, which broadens the design patent protection. Especially, based on the existing design combination application system, it is allowable to protect no more than ten (10) similar designs in one design patent application[2].

The combination application system for similar designs optimizes the previous system and brings many benefits to applicants. To take full advantage of design patent protection in China, we discuss in the following the power of the combination application system for similar designs.

Optimizing application resources

In the aspect of the intellectual property protection, it is common for an applicant to seek a balance among various factors, such as demands, markets and costs, and then to determine suitable intellectual protection strategies.

Generally, there is a relevant shorter cycle to obtain an idea about a product appearance, which is implemented more easily, enters the markets more quickly and impacts on the consumers more directly. Also, it is possible to derive a plurality of designs from the idea. Whereas, the preparation to the documents for filing a design application is simpler than an invention/utility model application, and the design patent right will be obtained sooner after a preliminary examination, without substantive examination. At present, according to the Chinese Patent Office, the pending time for a design in the office is about 3.7 months.

In general, in comparison with an invention/utility model, a design has a shorter creation-preparation-examination-authorization cycle, but with an equivalent judicial protection. Therefore, the applicant should pay more attention to the design to balance the application resources when determining the intellectual property protection strategies.

In view that an applicant may only file one design application to protect a plurality of designs so as to substantively broaden the protection scopes, the combination application system for similar designs strengthens the integration of all the application resources, and makes the applicant to have more options to optimize the application strategies with lower costs.

Avoiding "double patenting"

It is prescribed in § 11.1 "*Principles of Judgment*" of Chapter 3 in Part I of the Guidelines for Patent Examination (the "Guidelines"), "*In the judgment of whether or not two or more designs constitute 'identical invention-creation' stated in Article 9[3], it shall be determined on the basis of the designs of the products as shown in the drawings or photographs of the two patent applications for design or patents for design. Identical designs means that the two designs are identical or substantially identical.*"

Regarding "*Substantially Identical Designs,*" the Guidelines (Part IV, Chapter 5, § 5.1.2) specify:

[1] Article 31.2 of the Patent Law: An application for a patent for design shall be limited to one design. Two or more similar designs for the same product or two or more designs which are incorporated in products belonging to the same class and sold or used in sets may be filed as one application.

[2] Rule 35.1 of the Implementing Regulations of the Patent Law: Where two or more similar designs of the same product are filed in one application in accordance with the provisions of Article 31.2 of the Patent Law, the other designs of the product shall be similar to the main design indicated in the brief explanation. The number of similar designs contained in an application for patent for design shall not exceed 10.

[3] Article 9 of the Patent Law: For any identical invention-creation, only one patent right shall be granted. Where an applicant files on the same day applications for both patent for utility model and patent for invention relating to the identical invention-creation, and the applicant declares to abandon the patent for utility model which has been granted and does not terminate, the patent for invention may be granted.
Where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

"*[t]he judgment of substantially identical designs is only limited to designs of the same or approximate category of products. ... If a normal consumer can see from the overall observation of the patent concerned and the comparative design, that their difference simply falls into the following circumstances, then the patent concerned and the comparative design are substantially identical: (1) the difference lies in only slight changes in some fine details which cannot be noticed paying normal attention, for example the designs of venetian blind differ only in the number of slats; (2) the difference exists in the parts which cannot be seen easily or cannot be seen at all when in use, however, the circumstance where there is evidence showing that the special design in the parts which cannot be seen easily has notable visual effect for a normal consumer makes an exception; (3) the difference is a result of the substitution of one design element as a whole by said design element of the usual design commonly known for the category of product, for example, changing the shape of a cookie jar with pattern and colour from the cube to the cuboid; (4) the difference exists in that the patent concerned is simply a repeated and continuous arrangement or an increase/decrease in the continuous number of the comparative design as a design unit following the normal arrangement of the category of product, for example, repeated and continuous arrangement of the rows of the seat in cinema or an increase/decrease in the number of the rows of seats; and (5) the difference exists in that the patent concerned and the comparative design are a mirror image.*"

It is further prescribed in § 9.1.2 "*Similar Designs*" of Chapter 3 in Part I of the Guidelines, "*[w]hen an application involves similar designs during preliminary examination, the application shall be examined whether the design obviously does not meet the requirements of Article 31.2. Normally through overall observation, if the other designs and the main design have same or similar design features, and if the difference between them lies in slight changes in some fine details, usually design of this category of the products, the repeated and continuous arrangement of a design unit or mere change of colour element, they are considered as similar designs.*"

It is easy to find, for some similar designs, it is suitable to protect all of them by filing them as similar designs in one design application, but it is hard to protect all of them by filing separate design applications, respectively, since there is a risk that these similar designs are deemed substantively identical and may raise a double patenting issue.

Harmonizing filing requirements across countries/regions

There are different design protection systems in different countries and regions. In terms of the practical operations, the introduction of the combination patent system for similar designs in China narrows the differences between the design protection system in China and those in the foreign jurisdictions.

In some countries and regions, for example, US, EU, JP, KR, TW, as well as in the Hague Agreement concerning the international registration of industrial designs, a "partial design" is applicable, in which the portion of the product illustrated by solid lines is claimed as protection portion, while the portion of the product illustrated by broken lines is disclaimed as non-protection portion, which is quite different from the "overall design protection system"[4] in China, in which only the design of an entire part/product, which may be partitioned or sold and used independently, can be protected.

In the Chinese patent practice, if a Chinese design application claims a foreign priority right including a partial design, it is usual to convert all the broken lines to solid lines, in order to meet requirements of the "overall design protection system" in China, and to state the essential features in a brief description if necessary. However, this conversion does not reach the protection intention of the partial design in the foreign priority document.

For this, by means of the combination application system for similar designs, it is much possible to form a plurality of embodiments, by converting and/or erasing some dashed lines based on the maintenance of the claimed protection portion, and protect them in one design application, so as to be close to the partial design protection extent in the priority document. Thus, the gaps among different design protection law systems will be narrowed.

Conversely, if a Chinese design application is planned to be claimed as a priority overseas, it is recommended to take account of the design practices of the target countries and regions and then determine the filing strategies in advance. For example, one Chinese design application may include a plurality of similar designs or even partial designs and reference designs, for ensuring there are enough design information in the Chinese priority to be claimed in the target countries and regions. In such way, the applicant can use unchanged to cope with changes.

It can be said that the combination application system for similar designs in China has become a bridge for connecting different law systems.

[4] According to § 7.4 "Nonpatentable Situation for Design for Patent" of chapter 3 in Part I of the Guidelines, "According to Article 2.4, the following situations are ineligible for patent protection for design: ... (3) any component part of the product which cannot be partitioned or sold and used independently, such as the heel of socks, the peak of a hat, the handle of a cup, and so on."

Increasing stability of patent right

When assessing novelty and inventive step of a design, each similar design should be judged separately. Thus, it is necessary to compare each similar design with a comparative design. Therefore, during an invalidation proceeding for a multiple design patent, the design(s) lack of patentability will be held invalid, while the design(s) with patentability will be valid. As a result, there might be three decisions for a multiple design application: invalid in whole, invalid in part and valid in whole.

In addition, during the affirmation of patent rights, the patentee may abandon one or more designs in a multiple design patent.

Improving enforceability against infringement

In the *Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Cases Involving Patent Infringement Disputes* (No. 21 [2009] of the Supreme People's Court) effective as of January 1, 2010, the determination of design infringement depends on the assessment of whether the design of an allegedly infringing product is identical with or similar to the subject-matter of a design patent[5]. However, a clear definition of the reference person in the eyes of whom another design infringes upon the patented design is not available. The "normal consumer" according to the Guidelines only decides whether a patented design corresponds to prior designs. Nevertheless, in accordance with the Judicial Interpretations, a people's court should assess identity or similarity on grounds of the knowledge and cognitive capacity of normal consumers of the products incorporating the design, which, however, remains silent on the question of how to proceed if buyers and users belong to different groups of people.

Given this uncertainty, for protecting the intellectual property of a design, it is advisable to use the combination application system for similar designs.

Taken the product with various states as an example. According to § 5.2.5.2 "Product of Variable Status" of Chapter 5 in Part IV of the Guidelines, it states that "*[a] product of variable states means a product, which can be in various states when on sale or in use.*"

According to Interpretations of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Cases Involving Patent Infringement Disputes (II) (No.1 [2016] of the Supreme People's Court) effective as of April 1, 2016, it is prescribed by Article 17, "*[a]s regards the design patent of a product in active variations, if an alleged infringing design is identical or similar to the designs of all the various use states illustrated in the diagram of variations, the competent people's court shall determine that the alleged infringing design falls under the scope of patent protection; if the alleged infringing design lacks the design of a certain use state or is neither identical nor similar to the design of a certain use state, the competent people's court shall determine that the alleged infringing design does not fall under the scope of patent protection.*"

That is, the design patent protection for the product with various states is relatively weak. Therefore, it is recommended to adopt the design combination application strategy, to protect the product with different designs in a design application, for example, the first design without various states, the second design with one various state, the third design with two various states, and so forth, such that the multiple designs can stand there for obtaining more effective defense ability.

Conclusion

In short, the Chinese patent system provides for easily and quickly obtainable design protection. Without doubt, design protection is a significant element of IP law, and gains much attention due to more common and easier enforcement. More in China, proper application of the combination application system for similar designs may get double results with half the effort.

[5] Article 11 of the Interpretations (No. 21 [2009]): The people's Court shall make a comprehensive judgment in view of the overall visual effects of the design based on the design feature(s) of the patented design and the accused infringing design when determining the identity or similarity of designs. The design features that are mainly determined by the technical function and the features that do not affect the overall visual effects such as product material, internal structure and so on shall not be considered.
The following factors usually have more impact on the overall visual effects of a design:
(1)Parts that are easily observed in the ordinary use state of the product versus other parts of the product;
(2)Design features of the patented design distinguishing from the prior designs versus other design features.
The People's Court shall find the accused infringing design and the patented design identical in the absence of difference in overall visual effects; and find them similar in the absence of substantial difference in overall visual effects.

The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

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Ms. Huang has been helping clients secure and protect their patent rights. This experience includes international patent portfolio management, patent application preparation and prosecution before the Chinese Patent Office, patent appeals and invalidations before the Patent Reexamination Board and Beijing courts. Ms. Huang has successfully secured patent protection on behalf of individual inventors, large international corporations and companies of various sizes in between. In addition, as a Supreme People's Court appointed patent litigation attorney, she has been representing clients in enforcing their patent rights. Ms. Huang's practice focuses on mechanical and electro-mechanical systems and devices in the fields of home appliances, engineering mechanics, automation manufacture, semiconductors, printing facilities, medical devices, and computers. Ms. Huang has extensive experience counseling clients with respect to industrial design protection.