



[THE RELEVANT SYSTEMS]

Study of Practices of Priority Rights for Industrial Designs by ID5 Offices



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JPO

The Study of Relevant Systems

1. Background and Purpose

Although Article 9 of the Design Act provides that two or more design rights should not be granted for one creation based on the purport of eliminating overlapped rights, in an actual design development there is a situation that design variations are created from one design concept.

Therefore, only if applications for such design variations are filed by the same applicant, before the publication date of the Design Bulletin of the principal design and provided that the design variations are similar to the principal design, they are exceptionally protected as related designs as those having equivalent value as the principal design. Design rights conferred on the principal design and the related designs can be enforced respectively.

(73.1 of the Examination Guidelines for Design)

*It should be noted that the Related Design System is not such a system as that the filing date of the related designs has retroactive effect to the filing date of the principal design.

2. Legal Provisions

Design Act:

Article 10 (Related designs), Article 21 (Duration of design rights), Article 22 (Transfer of the design right of a Related Design), Article 27 (Exclusive license)

3. The Principle of Judgment on the Subject Matter

In order for a design in a design application to be registered as a related design under Article 10(1) of the Design Act, it must comply with all of the following requirements.

(1) The design application is filed by the same applicant as that of the principal design.

- (2) The design application pertains to a design similar to the principal design.
- (3) The design application is filed on or after the filing date of the application of the principal design and before the publication date of the Design Bulletin of the principal design (even in the case of a secret design, before the first publication date of the Design Bulletin of the principal design which does not show the contents of the application and the drawing).

(73.1.1 of the Examination Guidelines for Design)

(7.1 Sample case No.1)

4. Formality Requirements

4.1 Time Limit of Claiming Right

Application of a related design is filed by creating the column of "Indication of the Principal Design" and stating the filing number of the principal design in the application. It is possible to indicate the principal design at the time of filing or as an amendment while the application is pending examination or appeal/trial.

4.2 Fee

4.2.1 Whether the fee should be charged according to the number of designs involved?

It is required to pay the filing fee for a normal design application by each design. (No other fees are required.)

4.2.2 What is the fee for each design?

The fee for each design is JPY 16,000 as the design application filing fee.

4.2.3 What is the time limit for payment of fee?

At the time of filing.

4.3 Declaration of Claiming Priority

Whether the declaration in subsequent application is compulsory?

N.A. (The "Indication of the Principal Design" with the filing number of the principal design is necessary.)

4.4 Copy of Previous Application Documents

Whether the copy of previous application documents should be submitted?

It is not necessary.

5. Procedure Requirements

5.1 Amendment or Withdrawal of Declaration

5.1.1 Whether the application number of the previous application indicated in declaration may be modified?

Amendment to change the principal design is allowed.

5.1.2 Whether the declaration may be withdrawn?

Amendment to delete the indication of the principal design is allowed.

5.2 The Applicant(s) of the Subsequent Application and the Previous Applicant(s)

5.2.1 Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?

Applicant(s) must be the same.

5.2.2 If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), how to deal with?

The subsequent application will be refused in accordance with Article 9 of the Design Act since the applicant is not the same.

5.3 Notifications Involved in the Examination

5.3.1 In what condition shall the examiner invite the applicant to make amendments?

Since a design cannot be registered as a related design when it is determined that the design is not similar to the principal design designated by the applicant, amendment of deleting (or changing) the indication of the principal design will become necessary.

5.3.2 In what condition shall the examiner issue a notification to inform the applicant the claim is deemed to be waived?

We do not issue such a notice to applicants. An application filed as a related design with the indication of the principal design will not be deemed to be waived, without any procedures taken by the applicant.

When an examiner determines that the design filed as a related design is not similar to the principal design designated by the applicant, the examiner will send a notice of reasons for refusal in accordance with Article 10(1) of the Design Act.

5.3.3 What is the time limit for the applicant to response to the notification?

Residents in Japan: 40 days. Residents abroad: 3 months

5.4 Restoration of Claim to Right

Please list the situations in which the applicant may request to restore the right of claiming?

N.A. (It is possible to add the indication of the principal design by making an amendment while the application is pending examination or appeal/trial.)

5.5 The Relation between the Subsequent Application and the Previous Application

5.5.1 After the subsequent application own a design patent right, does the previous application have to be waived?

No.

5.5.2 When the subsequent application and the previous application act their rights, do they have to be act all together?

It is possible to exercise rights independently for the principal design and the related design. However, it is not possible to transfer the rights independently of each other.

6. Judgment of the Same Subject Matter

6.1 Principle of Judgment

It is necessary for the design to be similar to the principal design and not an identical design.

6.2 Patent Type

If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim right on the basis of the previous application.

It is not possible.

6.3 The indication

If the indication between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

It is possible for a design to be registered as a related design even when the indications (which we interpreted as articles to the design) are different, provided that the designs are determined to be similar to each other due to the fact that the usage and function of the articles and the forms are similar to (or the same as) each other.

6.4 The entire and Partial Design

6.4.1 If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be similar, it is not possible.

6.4.2 If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be similar, it is not possible.

6.4.3 The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Whether the subsequent application may claim the right of the previous application?

If the designs are in a relation that can be determined as being similar, the design in the subsequent application may be registered as a related design.

(7.2&7.3 Sample case No.2 and No.3)

6.4.4 If the previous application is a design of an entire product, the subsequent application is a partial design of the product, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be similar, it is not possible.

6.4.5 For GUI applications, if the previous application is the interface, the subsequent application is an entire product which contained the GUI, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be similar, it is not possible. (The appearance of a GUI itself will not be considered as being a design.)

6.5 The Color

If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of the previous application?

If the designs are in a relation that can be determined as being similar, the design in the subsequent application may be registered as a related design.

(7.4 Sample case No.4)

6.6 The Number of View

6.6.1 If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

Regardless of the form of representation, if the designs are in a relation that can be determined as being similar, the design in the subsequent application may be registered as a related design. However, this is on condition that the stereoscopic drawing of the previous application is acknowledged as fully disclosing the design on its own.

6.6.2 If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

Regardless of the form of representation, if the designs are in a relation that can be determined as being similar, the design in the subsequent application may be registered as a related design. However, this is on condition that the stereoscopic drawing of the subsequent application is acknowledged as fully disclosing the design on its own.

6.7 The Type of View

If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of the previous application?

If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of the previous application?


Regardless of the form of representation, if the designs are in a relation that can be determined as being similar, the design in the subsequent application may be registered as a related design.

(7.5 Sample case No.5)




7. Cases of related designs

7.1 Sample case No.1

Related Design System

	Principal Design (Previous application)
Reproduction*	
Product indication	Automobile
Registration No.	1449168
Filing date	Oct. 18, 2011

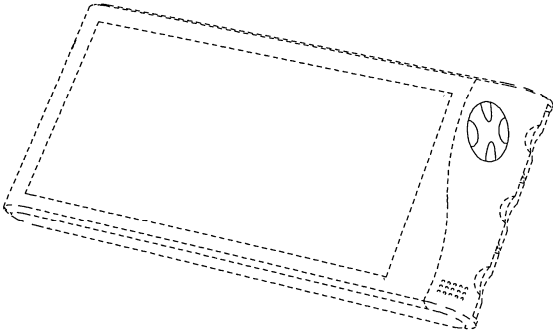
	Related Design (Subsequent application)	Related Design (Subsequent application)	Related Design (Subsequent application)
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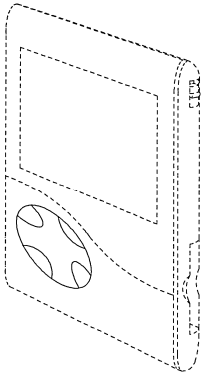
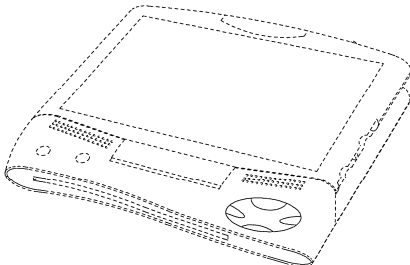
Reproduction*			
Product indication	Automobile	Automobile	Automobile
Registration No.	1449853	1464782	1464783
Filing date	Oct. 18, 2011	Jul. 19, 2012	Jul. 19, 2012

*Only a representative view is illustrated.

7.2 Sample case No.2

Related Design System (Partial design; position, size and scope)

	Principal Design (Previous application)
Reproduction*	
Product indication	Memory card data player
Registration No.	1096515
Filing date	Sep. 30, 1999

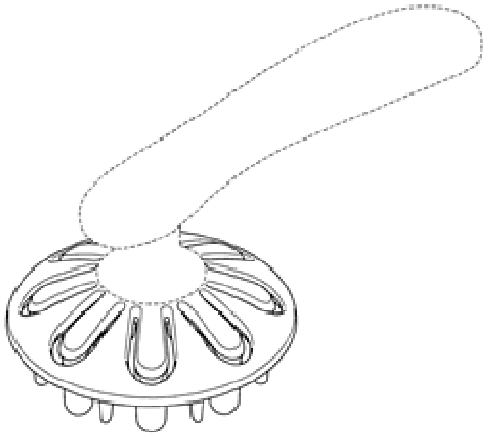
	Related Design (Subsequent application)	Related Design (Subsequent application)
Reproduction*		
Product	Memory card audio data player	Memory card audio data player

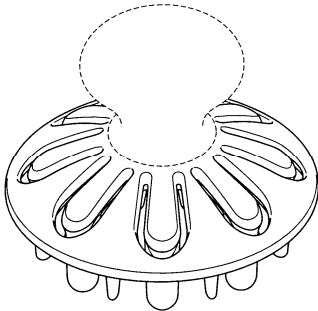
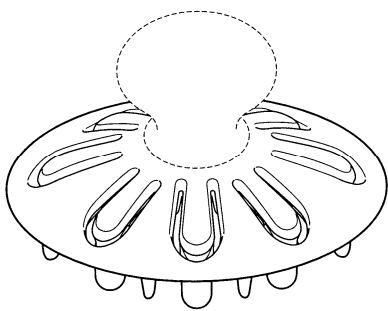
indication		
Registration No.	1100368	1100369
Filing date	Sep. 30, 1999	Sep. 30, 1999

*Only a representative view is illustrated.

7.3 Sample case No.3

Related Design System (Partial design; position, size and scope)


	Principal Design (Previous application)
Reproduction*	
Product indication	Massage appliance
Registration No.	1390571
Filing date	Sep. 14, 2009



	Related Design (Subsequent application)	Related Design (Subsequent application)
Reproduction*		
Product indication	Massage appliance	Massage appliance
Registration No.	1416519	1416520
Filing date	Apr. 6, 2010	Apr. 6, 2010

*Only a representative view is illustrated.

7.4 Sample case No.4

Related Design System (Color)

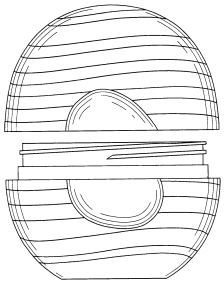
	Principal Design (Previous application)
Reproduction*	
Product indication	Packaging box
Registration No.	1370744
Filing date	Mar. 25, 2009




	Related Design (Subsequent application)	Related Design (Subsequent application)
Reproduction*		
Product indication	Packaging box	Packaging box
Registration No.	1371006	1371007
Filing date	Mar. 25, 2009	Mar. 25, 2009

*Only representative views are illustrated.

7.5 Sample case No.5

Related Design System (Type of view)

	Principal Design (Previous application)
Reproduction*	
Product indication	Container for cosmetics
Registration No.	1523799
Filing date (Priority date)	Jul. 14, 2014 (Jan. 13, 2014)

	Related Design (Subsequent application)	Related Design (Subsequent application)	Related Design (Subsequent application)
Reproduction*			
Product indication	Container for cosmetics	Container for cosmetics	Container for cosmetics
Registration No.	1532068	1532069	1532070
Filing date (Priority date)	Oct. 21, 2014 (Apr. 23, 2014)	Oct. 21, 2014 (Apr. 23, 2014)	Oct. 21, 2014 (Apr. 23, 2014)

*Only a representative view is illustrated.

7.6 Colour

Did color play a role in the judgment?



The initial application



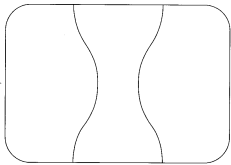
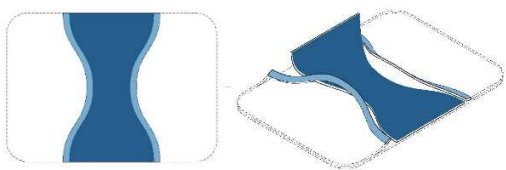
The related application

In this case, the designs of the subsequent applications may be registered as related designs because they have the same shape and pattern as the design of the initial application. The only difference between them is the color. Shape, pattern and color are the elements that constitute a design, and the commonality of the shape and pattern of these designs produces a unique characteristic compared with prior designs. Therefore, the designs of the subsequent applications may be determined as being similar to the design of the initial application.

Related designs must be similar to the principal design (Art. 10(1) of the Design Act), and a design right is an exclusive right to work not only the registered design but also similar designs thereto (Art. 23 of the Design Act).

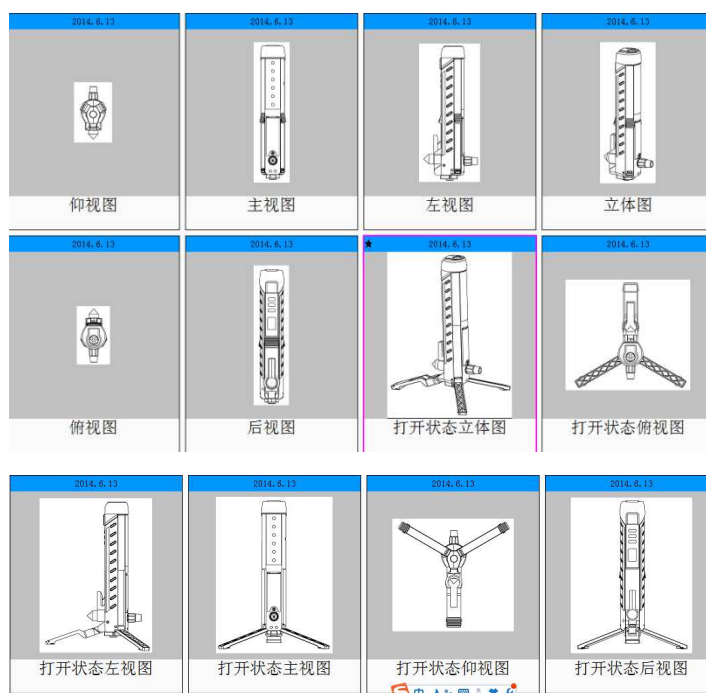
Generally, since the element of mere color has the nature of selection rather than creation, it will give a smaller influence on the determination of similarity compared with the elements of shape and pattern. (22.1.3.1.2 (5) (iv) of the Examination Guidelines for Design)

However, actual practices are made depending on varied/different circumstances. For example, in the following court case (Intellectual Property High Court), the filed design was decided as not being similar to the prior design (published design) because of its characteristic feature of pattern which is derived from the unusual coloring.

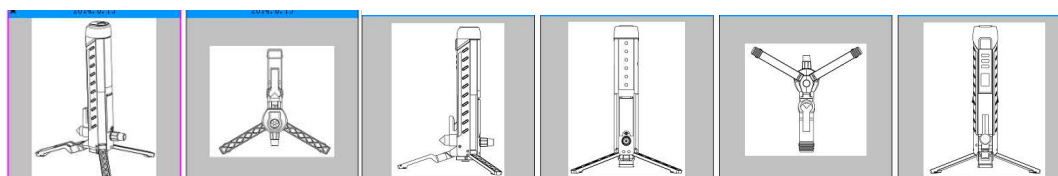
	
<i>Prior design</i>	<i>Filed design (Colored part is claimed as a partial design)</i>
<i>Designs of “Sticking plaster”</i> (Only representative views are illustrated.)	

7.7 Variable states

If the initial application is a product of variable states which can be closed and open, then may the related application be a product with only open states?



The initial application



The related applications

The determination of similarity between the designs with and without the disclosure of a specific variable state would depend largely on whether or not such a form-changing behavior is presumed as a matter of course on the basis of the ordinary knowledge on the product and the product field concerned.

In general,

- If the form-changing behavior is not characteristic and novel, the design of the subsequent application would be determined as being similar to the design of the initial design. In this case, the design of the subsequent application may be registered as a related design;
- If the form-changing behavior is very discriminative compared with other prior designs, the design of the subsequent application would be determined as not being similar to the design of the initial design. In this case, the design of the subsequent application may not be registered as a related design. Instead, it may be registered as an independently (ordinarily) filed design as long as it fulfills the other requirements for registration.

There may also be a possibility that the design of the subsequent application is deemed as substantially the same as the design of the initial application, i.e. where the form-changing behavior is common and the entire form of the design can be accurately recognized regardless of the presence of a variable state. In this case, the design of the subsequent application may not be registered as a related design because it is not similar to but the same as the principal design.

7.8 Different types

If the initial application is a product with a car photograph, and in the brief explanation the applicant identifies the product as a car, then may the related application be a car toy?

If the initial application is a product with a car photograph, and in the brief explanation the applicant describes the product as a car or toy car, then may the related application be a car toy?

In both cases, the latter design may not be registered as a related design.

As a matter of principle, two designs are determined as the same or similar only when the usage and function of the article on which the design is based have significant commonality (22.1.3.1.2 (2) of the Examination Guidelines for Design).

In the first case, the design of the subsequent application is determined as not being similar to the design of the initial application because the usage and function of a “car toy” is quite different from those of a “car”.

In the second case, the initial application may not be granted registration as it is, i.e. the indication of product “car or toy car” is not admissible. The applicant may have the option of amending the indication into either “car” or “toy car” by submitting an amendment. However, if “toy car” is selected, the designs of the initial application and the subsequent application will become identical, and thus the latter cannot be registered as a related design. In contrast, if “car” is selected, the designs of the initial application and the subsequent application will be determined as not being similar as mentioned above, and thus the latter cannot be registered as a related design either.

Conversion of Applications from Patent Applications or Utility Model Applications

1. Background and Purpose

Conversion of application does not mean conversion of the contents of the application, but conversion of the format of the application between an original patent or utility model application and a (converted) design application.

Conversion of application may be utilized in such occasion as where a patent application was filed on the technical effect of a certain invention consisting of a new configuration but rejected, then design registration is sought for its aesthetic aspect in turn.

Where conversion is made, the new design application is deemed to have been filed at the time of the filing of the original patent or utility model application, and the original patent or utility model application is deemed to have been withdrawn.
(92.1 of the Examination Guidelines for Design)

2. Legal Provisions

Design Act

Article 13 (Conversion of application)

3. The Principle of Judgment on the Subject Matter

In order for a new design application resulting from the conversion to be deemed to have been filed at the time of the filing of the original patent or utility model application, it must comply with the following requirements.

- The design in the new converted design application shall be clearly recognized from the initial contents of the description and drawings of the original patent or utility model application, and,
- The design in the new converted design application shall be identical with the design described in the initial description and drawings of the original patent or utility model application.

(92.1.1 of the Examination Guidelines for Design)

4. Formality Requirements

4.1 Time Limit of Claiming Right

In the case of the conversion from a patent application, within three months from the date when the certified copy of the examiner's decision to the effect that the patent application is to be refused has been served.

In the case of the conversion from a utility model application, while the original utility model application is pending before the Office.

(92.1.1 of the Examination Guidelines for Design)

4.2 Fee

4.2.1 Whether the fee should be charged according to the number of designs involved?

It is required to pay the filing fee for a normal design application by each design. (No other fees are required.)

4.2.2 What is the fee for each design?

The fee for each design is JPY 16,000 as the design application filing fee.

4.2.3 What is the time limit for payment of fee?

At the time of filing.

4.3 Declaration of Claiming Priority

4.3.1 Whether the declaration in subsequent application is compulsory?

It is compulsory. Converted applications must be filed by using a prescribed form of

application prepared for the conversion of application.

4.3.2 When shall the declaration be submitted?

At the time of filing.

4.3.3 What information shall be contained in the declaration?

- Statement to the effect that the design application is filed in accordance with the provision of Article 13(1) (or (2)) of the Design Act as a special matter.
- Indication of the original application (Filing number and filing date)

4.4 Copy of Previous Application Documents

Whether the copy of previous application documents should be submitted?

It is not necessary.

5. Procedure Requirements

5.1 Amendment or Withdrawal of Declaration

5.1.1 Whether the fee should be charged according to the number of designs involved?

Whether the application number of the previous application indicated in declaration may be modified?

Amendment can be made only in the cases where the “statement” and the “filing date of the previous application” are correctly stated in the declaration.

5.1.2 Whether the declaration may be withdrawn?

It is not allowed to withdraw the declaration as there is no provision in the national laws.

5.2 The Applicant(s) of the Subsequent Application and the Previous Applicant(s)

5.2.1 Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?

The applicant of the new design application resulting from the conversion must be the same as the applicant of the original patent or utility model application. However, where the new applicant has legitimately succeeded to the right to obtain a design registration from the original applicant of a patent or utility model application, the applicant is found to be the same.

(92.1.1 of the Examination Guidelines for Design)

5.2.2 If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), how to deal with?

In principle, such converted application will be dismissed as an unlawful procedure. (Article 18-2(1) of the Patent Act as applied mutatis mutandis pursuant to Article 68(2) of the Design Act.)

However, amendment of the applicant is allowed when it is obvious that an error was made at the time of preparing the filing documents provided that the procedure was undertaken by a representative whose rights to represent can be confirmed.

5.3 The Relation between the Subsequent Application and the Previous Application

5.3.1 After the subsequent application own a design patent right, does the previous application have to be waived?

Where an application (patent application or utility model application) is converted, the original application is deemed to have been withdrawn.

(Article 13(4) of the Design Act).

5.3.2 When the subsequent application and the previous application act their rights, do they have to be act all together?

No, they do not.

6. Judgment of the Same Subject Matter

6.1 Principle of Judgment

The design in the new converted design application shall be clearly recognized from the initial contents of the description and drawings of the original patent or utility model application, and The design in the new converted design application shall be identical with the design described in the initial description and drawings of the original patent or utility model application.

(92.1.1 of the Examination Guidelines for Design)

6.2 Patent Type

If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim right on the basis of the previous application.

It is possible.

6.3 The indication

If the indication between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

It is necessary that the indication (which we interpreted as article to the design) is substantially the same.

6.4 The entire and Partial Design

6.4.1 If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may claim the right of the previous application?

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, whether the subsequent application may claim the right of the previous application?

The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Whether the subsequent application may claim the right of the previous application?

If the previous application is a design of an entire product, the subsequent application is a partial design of the product, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be identical, it is not possible.

6.4.2 For GUI applications, if the previous application is the interface, the subsequent application is an entire product which contained the GUI, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be identical, it is not possible. (The appearance of a GUI itself will not be considered as being a design.)

6.5 The Color

If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of the previous application?

As the designs will not be determined to be identical, it is not possible.

6.6 The Number of View

6.6.1 If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

Regardless of the form of representation, it is possible, if the designs are in a relation that can be determined as being identical. However, this is on condition that the stereoscopic drawing of the previous application is acknowledged as fully disclosing the design on its own.

6.6.2 If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

Regardless of the form of representation, it is possible, if the designs are in a relation that can be determined as being identical. However, this is on condition that the stereoscopic drawing of the subsequent application is acknowledged as fully disclosing the design on its own.

6.7 The Type of View

If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of the previous application?

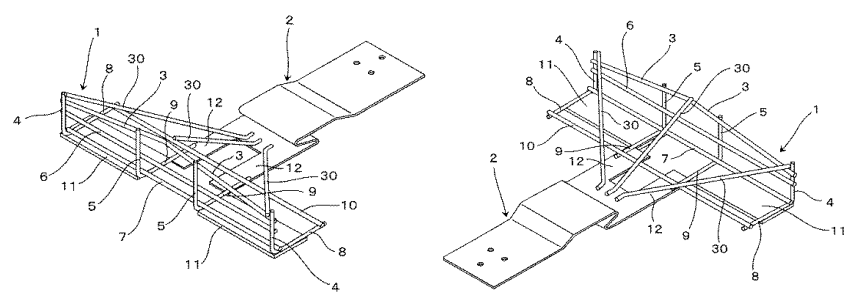
If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of the previous application?

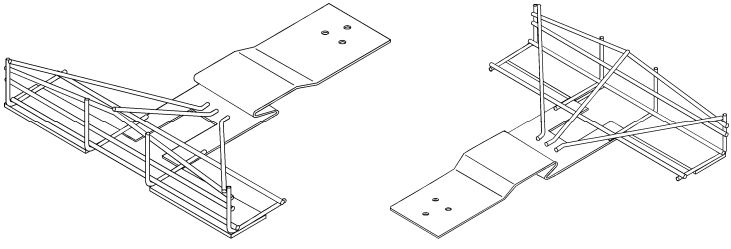
Regardless of the form of representation, it is possible, if the designs are in a relation that can be determined as being identical.

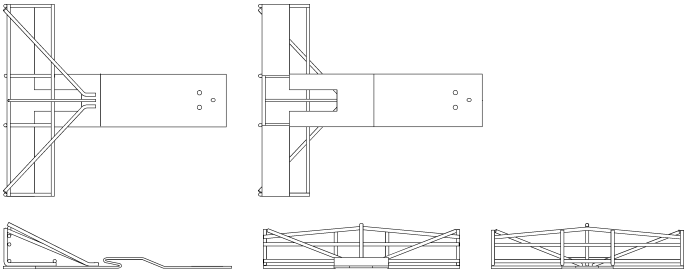
7. Cases

Sample case

Conversion of applications from Patent Applications

	Original Patent Application
Drawings contained in the patent application	
Title of invention	Roof snow guard
Application No.	P2012-110250
Filing date	Jun. 14, 2012

	Converted Design Application
Reproduction	

	
Product indication	Roof snow guard
Application No.	D2015-2306
Registration No.	1529824
Filing date	Jun. 14, 2012 (retroactive)

KIPO

Related design system

1. Background and Purpose

Notwithstanding Article 33(1) and 46(1) and (2), the owner of a design right or the applicant for the registration of a design may have designs similar only to the principal design registered as related designs, only if he/she files an application for the registration of such related designs within one year of the filing date of the application for the registration of the principle design.

* Principal design can be interpreted as Previous application and Related design can be interpreted as Subsequent application.

* The Related Design System is different from the Priority Claim System in that the related designs are not retroactively effective to the filing date of the principal design.

2. Legal Provisions

Article 35(Related Designs), Article 62(Decisions to Reject Application for Design Registration)

3. The Principle of Judgment on the Subject Matter

- 1) Where a related design is filed more than one year after the filing date of the principal design, no design is eligible for registration under Article 35(1) of the Design Protection Act.
- 2) No design that is similar only to the related designs is eligible for registration under Article 35(2) of the Design Protection Act.
- 3) Where an exclusive license has been granted for the design right to a principal design, no related design is eligible for the design registration.

4. Formality Requirements

4.1 Time Limit of Claiming Right

Within one year of the filing date of the application for the registration of the

principle design.

4.2 Fee

4.2.1 Whether the fee should be charged according to the number of designs involved?

The fee should be paid per design as the application for the ordinary design.

4.2.2 What is the fee for each design?

Examined design : KRW 94,000 per design

Partially-examined design : KRW 45,000 per design.

4.2.3 What is the time limit for payment of fee?

At the time of filing an application.

4.3 Declaration of Claiming Priority

4.3.1 Whether the declaration in subsequent application is compulsory?

It has to be indicated in an application.

4.3.2 What information shall be contained in the declaration?

1) Whether the application is filed for the registration of an independent design or a related design

2) The design registration number or the design registration application number of the principal design.

4.4 Copy of Previous Application Documents

Whether the copy of previous application documents should be submitted?

It is not necessary.

5. Procedure Requirements

5.1 Amendment or Withdrawal of Declaration

5.1.1 Whether the application number of the previous application indicated in declaration may be modified?

It is possible to modify the principal design.

5.1.2 Whether the declaration may be withdrawn?

It is possible to withdraw it.

5.2 The Applicant(s) of the Subsequent Application and the Previous Applicant(s)

5.2.1 Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?

Applicants must be the same.

5.2.2 If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), how to deal with?

An notification of refusal shall be provided.

5.3 Notifications Involved in the Examination

5.3.1 In what condition shall the examiner invite the applicant to make amendments?

An applicant for design registration may make an amendment to change an application for the related designs to the independent designs or vice versa.

5.3.2 In what condition shall the examiner issue a notification to inform the applicant the claim is deemed to be waived?

When the design filed as a related design is not similar to the principal design designated by the applicant.

5.3.3 What is the time limit for the applicant to respond to the notification?

Within 2 months

5.4 The Relation between the Subsequent Application and the Previous Application

When the subsequent application and the previous application act their rights, do they have to be acted all together?

The Principal design right and the related design right can be acted independently. However, the right holder of principal design and related design shall be the same person. (note: the exclusive license for the design rights to a principal design and designs related thereto shall be granted to the same person in a bundle.

6. Judgment of the Same Subject Matter

6.1 Principle of Judgment

The related design is similar only to his/her registered design or filed design for the registration.

6.2 Patent Type

If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim right on the basis of the previous application.

It will not be allowed.

6.3 The indication

If the indication between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

- 1) If the product indication of the principal application is reasonable, the product indication of the related application should be the same as the principal application's.
- 2) If the product indication of the related application is more reasonable and appropriate than the principal application's product indication, there is no need to match them.

6.4 The entire and Partial Design

6.4.1 If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may claim the right of the previous application?

If the principal design is a partial design, the related design should be a partial design.

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, whether the subsequent application may claim the right of the previous application?

If the principal design is a partial design, the related design should be a partial design.

6.4.2 The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Whether the subsequent application may claim the right of the previous application?

It is possible if the related design is similar only to his/her registered design or filed design for the registration.

6.4.3 If the previous application is a design of an entire product, the subsequent application is a partial design of the product, whether the subsequent application may claim the right of the previous application?

If the principal design is an entire product, the related design should be an entire product.

6.4.4 For GUI applications, if the previous application is the interface, the subsequent application is an entire product which contained the GUI, whether the subsequent application may claim the right of the previous application?

If the principal design is the interface and the related design is an entire product of GUI, it cannot be registered as a related design. Because new designs apart from interface are added to the related design.

As the GUI should be applied to an article, only interface cannot be registered.

6.5 The Color

If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of the previous application?

It is possible if the related design is similar only to his/her registered design or filed design for the registration.

6.6 The Number of View

6.6.1 If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

It is possible if the related design is similar only to his/her registered design or filed design for the registration.

6.6.2 If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

It is possible if the related design is similar only to his/her registered design or filed design for the registration. Meanwhile, KIPO requires drawings to show the overall shape of the design.

6.7 The Type of View

If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of the previous application?



It is possible if the related design is similar only to his/her registered design or filed design for the registration.

If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of the previous application?

It is possible if the related design is similar only to his/her registered design or filed design for the registration.

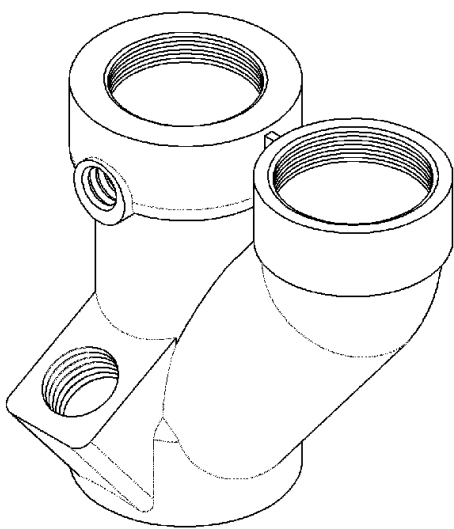
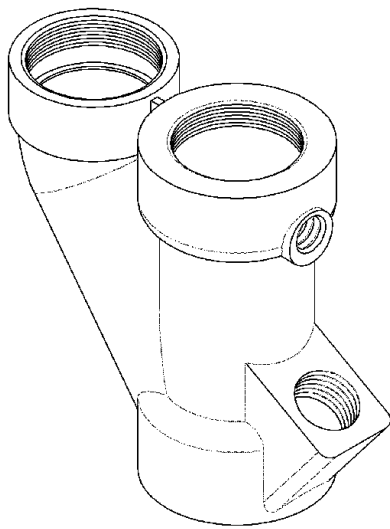
7. Cases of related designs

7.1 Related design/ Entire design

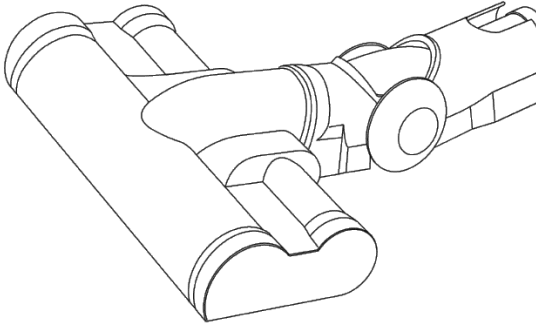
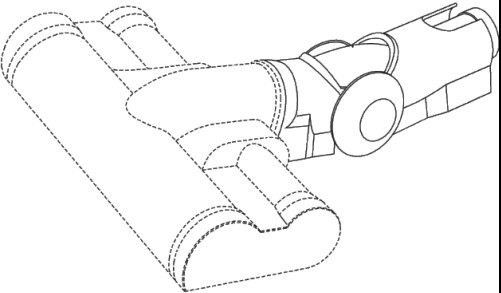
	a principal design (Previous)	a related design (Subsequent)
Presentation		
Product Indication	Cosmetic package	Cosmetic package
Application number	30-2014-43504	30-2014-43518
Filing date	Sep. 5, 2014	Sep. 5, 2014
Registered date	Mar 30, 2015	Apr. 1, 2015
Explanation	<ul style="list-style-type: none"> ▪ Only when a subsequently-filed design is similar to the applicant's own designs (previously filed or registered) and different from designs filed/registered or published by another person prior to the filing date of the later design, it will constitute 'a related design' ▪ Related designs should be submitted within one year of the filing date of the application for the registration of the principal design. <p>While a principal design and a related design can be filed on the same day, the</p>	

	<p>principal design should be filed earlier than the related design.</p> <ul style="list-style-type: none"> ▪ To be registered as a related design, the relationship between the principal design and the related design should be one of the followings. Finished product-Finished product/ Component-Component/ A set of articles -A set of articles/ Partial design-Partial design ▪ Basically, the product indications of a principal design and a related design shall be the same while there are exceptions.
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7.2 Related design/ Partial design

	a principal design (Previous)	A related design (Subsequent)
Presentation		
Product Indication	Supply device of foaming machine	Supply device of foaming machine
Application number	30-2017-0033292	30-2017-0037407
Filing date	Jul. 19, 2017	Aug. 11, 2017
Registered date	Mar. 6, 2018	Apr. 18, 2018
Explanation	<ul style="list-style-type: none"> ▪ Only when a subsequently-filed design is similar to the applicant's own designs (previously filed or registered) and different from designs filed/registered or published by another person prior to the filing date of the later design, it will constitute 'a related design' ▪ If a principal design is a partial design, the design related to the principal design (namely, a related design) shall be a partial design. 	

7.3 Unregistrable as a related design (✕)

	a principal application (Previous)	a related design (Subsequent)
Presentation		
Explanation	▪ In case a principal design is an entire design and the design related to the principal design is a partial design, it cannot be registered as a related design.	

7.4 Colour

Did color play a role in the judgment?



The initial application



The initial application

The related application



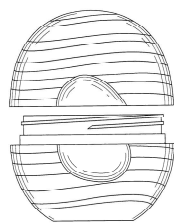
The related application

Yes. As a design similar only to the principal design can be registered as a related

design, these designs can be registered as related designs since their appearance and shape are similar except for colors.

7.5 The Type of View

7.5.1 If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may be registered as a related design?



The initial application



The related application

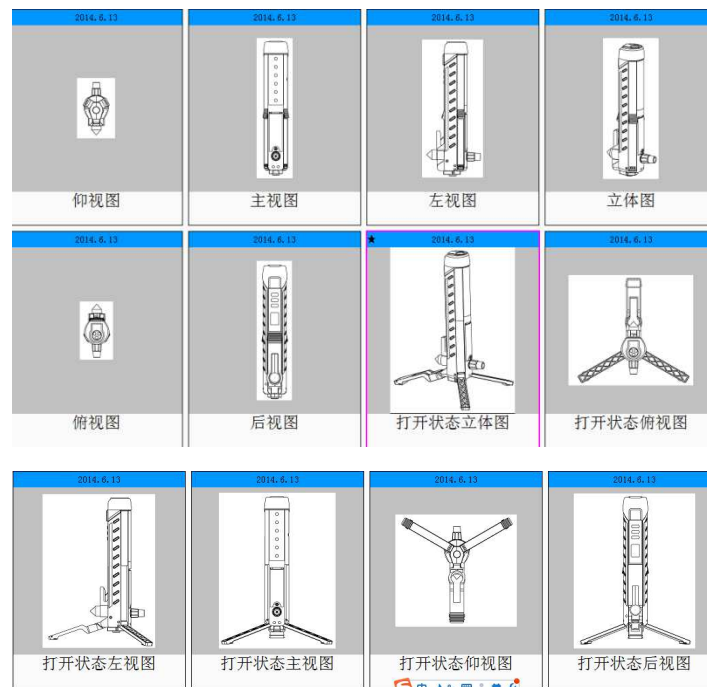
Yes. As answered in Question A above, these designs can be registered as related designs since their appearance and shape are similar except for colors.

7.5.2 If the initial application is a car, may the divisional application be a tire? We can see the tire was installed in the car

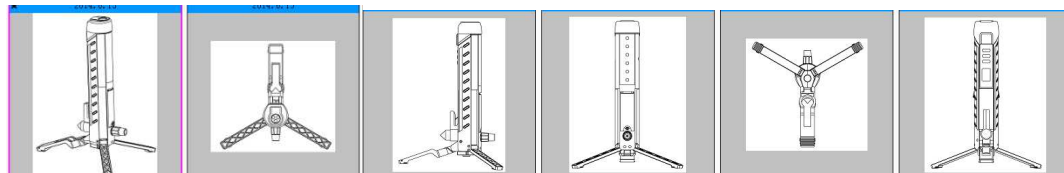
The initial application is allowed to be divided for a car and a tire only when it violates the principle of a single application for a single design and also the tire is not integrated in the car (separated from the car). Furthermore, the entire appearance/shape of the tire and car should be fully disclosed.

7.6 Variable states

If the initial application is a product of variable states which can be closed and open, then may the related application be a product with only open states?



The initial application



The related application

No. If the principal application is a dynamic design and the related application is a design which shows one of a static image of the dynamic design, generally, it is not allow to be registered as the principal and related design. However, it can be case by different case.

7.7 Different types

If the initial application is a product with a car photograph, and in the brief explanation the applicant identifies the product as a car, then may the related application be a car toy?

If the initial application is a product with a car photograph, and in the brief explanation the applicant describes the product as a car or toy car, then may the related application be a car toy?

No. This case will be refused since it violates the principle of a single application for a single design under which only one product can be indicated in the application. Thus, a car and a toy car need two individual applications. On top of that, a car and a toy car cannot be registered as principal and related designs since they do not fall into the same/or similar product category. Similar articles mean that items which fall into the same product category whose purposes are identical and functions are different.

Related design means the design is similar only to his/her registered design or the design claimed in the application pending for design registration. The similarity between two designs is considered by two aspects, the similarity of the article and the similarity of the design itself. Therefore, if an initial filed design is a car and a related filed design is a toy car, the subsequent application cannot be registered as a related design due to the difference between articles. Thus, two applications shall be filed in an independent application respectively.

EUIPO

Exhibition priority

1. Background and Purpose

The purpose of exhibition priority is to give effect, in European Union (EU) law, to Article 11 of the Paris Convention.

A Community design application priority may claim priority from the date of disclosure of the product in which the Community design is incorporated, within 6 months from the date of first disclosure at an officially recognised exhibition falling within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928 and last revised on 30 November 1972 (see Article 44 CDR).

The effect of the exhibition priority is that the date of first disclosure at an officially recognised exhibition is deemed to be the date of filing of the application for a registered Community design for the purposes of assessing the Community design's novelty and individual character (Articles 5, 6 and 7 of the Community design regulation n° 6/2002 of 12 December 2001, hereinafter "CDR"), the existence of a right of prior use in respect of the Community design (Article 22 CDR), the existence of an earlier design having an earlier date of protection (Article 25(1)(d) CDR) and the calculation of the term of deferment of publication if deferment was requested (Article 50(1) CDR) (see Article 43 CDR).

2. Legal Provisions

Articles 43 and 44 CDR

3. The Principle of Judgment on the Subject Matter

There is no case-law on this issue so far, and the Office has never been confronted with the issue of whether the application for the Community design must consist of the same subject-matter as the product disclosed at an international exhibition.

4. Formality Requirements

4.1 Time Limit of Claiming Right

The applicant can claim exhibition priority within six months of the first disclosure at an officially recognised exhibition. Evidence of the disclosure must be filed (Article 44(1) and (2) CDR).

4.2 Fee

No fee

4.3 Declaration of Claiming Priority

4.3.1 Whether the declaration in subsequent application is compulsory?

Claiming exhibition priority is optional. If the applicant does not claim exhibition priority, the date of filing of the application is used for the purposes of assessing the Community design's novelty and individual character (Articles 5, 6 and 7 CDR), the existence of a right of prior use in respect of the Community design (Article 22 CDR), the existence of an earlier design having an earlier date of protection (Article 25(1)(d) CDR) and the calculation of the term of deferment of publication if deferment was requested (Article 50(1) CDR).

4.3.2 When shall the declaration be submitted?

Like 'priority' deriving from Article 4 of the Paris Convention, exhibition priority can be claimed either when filing a Community design application or at the latest within one month of the filing date (Article 9(2) of Regulation n° 2245/2002 of 21 October 2002 implementing CDR, hereafter "CDIR").

4.3.3 What information shall be contained in the declaration?

(1) Where the exhibition priority is claimed in the Community design application, the applicant shall, together with the application or at the latest within three months of

the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition (Article 9(1) CDIR).

(2) Where the applicant wishes to claim an exhibition priority subsequent to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first disclosure of the product in which the design was incorporated or to which it was applied, shall be submitted within one month of the filing date.

The certificate issued at the exhibition by the authority responsible for the protection of industrial property shall be submitted to the Office within three months of receipt of the declaration of priority (Article 9(2) CDIR).

4.4 Copy of Previous Application Documents

4.4.1 Whether the copy of previous application documents should be submitted?

A certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition must be filed.

That certificate shall declare that the design was incorporated in or applied to the product and disclosed at the exhibition, and shall state the opening date of the exhibition and, where the first disclosure of the product did not coincide with the opening date of the exhibition, the date of such first disclosure.

The certificate shall be accompanied by an identification of the actual disclosure of the product, duly certified by that authority (Article 9(1) CDIR).

4.4.2 When should the copy be submitted?

At the latest within three months from the filing date of the Community design application, if exhibition priority is claimed in the application (Article 9(1) CDIR), or at the latest within three months following the filing of the claim to exhibition priority,

if exhibition priority is claimed subsequently to the filing of the application (that is, at the latest within one month of the filing date) (Article 9(2) CDIR).

4.4.3 What are the requirements of the format of the copy?

The certificate issued at the exhibition by the authority responsible for the protection of industrial property shall be drafted in one of the languages of EUIPO (English, French, German, Spanish, Italian) or accompanied by a translation.

5. Procedure Requirements

5.1 Amendment or Withdrawal of Declaration

Whether the declaration may be withdrawn?

No

5.2 The Applicant(s) of the Subsequent Application and the Previous Applicant(s)

5.2.1 Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?

The proprietor named in the certificate issued at the exhibition by the authority responsible for the protection of industrial property must be the same as the applicant for the Community design.

5.2.2 If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), how to deal with?

The applicant for the Community design will be asked to remedy the deficiency by providing a certificate mentioning this applicant.

5.3 Notifications Involved in the Examination

5.3.1 Whether different notifications may be issued in the examination?

Notifications will be issued if deficiencies are found.

The Office will limit itself to verifying whether the formalities relating to an exhibition priority claim have been satisfied (Article 45(2)(d) CDR), that is,

- whether the filing date of the Community design falls within the six-month period following the first display of the product;
- whether priority was claimed when filing the application or within one month of the filing date;
- whether the application or the subsequent declaration of priority gives details of the name of the exhibition and the date of first display of the product;
- whether the exhibition was a world exhibition within the meaning of the Convention on International Exhibitions of 22/11/1928;
- whether the certificate issued at the exhibition by the responsible authority was submitted in due time;
- whether the proprietor named in this certificate is the same as the applicant.

5.3.2 In what condition shall the examiner invite the applicant to make amendments?

Some deficiencies cannot be remedied (filing of the claim to exhibition priority or of the supporting documents), some others can. The examiner may, for instance, invite the applicant to make amendments in respect of the details of the name of the exhibition and the date of first display of the product, or the name mentioned in the certificate, or to submit a document establishing that the certificate was issued by the responsible authority.

5.3.3 In what condition shall the examiner issue a notification to inform the applicant the claim is deemed to be waived?

If the deficiencies are not remediable or are not remedied within the time limit set by the Office (see below), the Office will inform the applicant of the loss of the priority right and of the possibility of requesting a formal (i.e. appealable) decision on that loss (Article 46(1) and (4) CDR; Article 40(2) CDR).

5.3.4 What is the time limit for the applicant to respond to the notification?

Where remediable deficiencies are found, the examiner will request the applicant to remedy them within a time limit no shorter than the three-month time limit for submitting the certificate referred to above.

5.4 Restoration of Claim to Right

5.4.1 Please list the situations in which the applicant may request to restore the right of claiming?

If an applicant does not comply with the time limit for (i) submitting his claim to exhibition priority or (ii) the declaration in support of this claim, the claim of exhibition priority will be refused which implies a loss of right for this applicant.

Only in those cases he can apply for the reinstatement (same thing as restoration) of his right to claim exhibition priority. He must show that the below conditions are met:

The applicant who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence of causing the loss of any rights or means of redress.

Reinstatement/restoration of the right may be applied in respect of the time limit for

claiming exhibition priority, or the three-month time limit for providing the declaration.

5.4.2 Please list the situations in which are not allowed for the applicant to restore the right of claiming?

The application for reinstatement/restoration shall only be admissible within the year immediately following the expiry of the unobserved time limit (Article 67(2) CDR).

The application for reinstatement/restoration must also be filed in writing within two months of the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period (Article 67(2) CDR).

5.5 The Relation between the Subsequent Application and the Previous Application

After the subsequent application own a design patent right, does the previous application have to be waived?

It is difficult to understand it in the context of the exhibition priority. In the context of exhibition priority, there is no 'previous application' and 'subsequent application' as in priority claims under Article 4 of the Paris Convention. There is only an application for a design which has been disclosed (and not filed) at an international exhibition.

6. Judgment of the Same Subject Matter

6.1 Principle of Judgment

There is no case-law on this issue so far.

The EUIPO practice is to consider that the product disclosed at an officially recognised exhibition must be identical to that of the corresponding Community design, without the addition or suppression of any features.

An exhibition priority claim is however valid if the Community design and the previous application for a design right or a utility model differ only in immaterial details within the meaning of Article 5 CDR.

6.2 Patent Type

If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim right on the basis of the previous application.

The disclosure at an officially recognised international exhibition must concern a product (Article 44 CDR). Whether this product is also covered by a patent application or a utility model is irrelevant.

6.3 The indication

If the indication between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

It is difficult to understand it in the context of the exhibition priority. In the context of exhibition priority, there is no 'previous application' and 'subsequent application' as in priority claims under Article 4 of the Paris Convention. There is only an application for a design which has been disclosed (and not filed) at an international exhibition

6.4 The entire and Partial Design

6.4.1 If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may claim the right of the previous application?

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, whether the subsequent application may claim the right of the previous application?

The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Whether the subsequent application may claim the right of the previous application?

In the context of exhibition priority, there is no 'previous application' and 'subsequent application' as in priority claims under Article 4 of the Paris Convention. There is only an application for a design which has been disclosed (and not filed) at an international exhibition

6.4.2 If the previous application is a design of an entire product, the subsequent application is a partial design of the product, whether the subsequent application may claim the right of the previous application?

For GUI applications, if the previous application is the interface, the subsequent application is an entire product which contained the GUI, whether the subsequent application may claim the right of the previous application?

If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of the previous application?

A Community design consists of ‘the appearance of the whole or a part of a product’ (Article 3(a) CDR).

The disclosure at an officially recognised international exhibition must concern a product (Article 44 CDR).

It is difficult to imagine that only ‘part of a product’ would be disclosed at an international exhibition. This fact could militate in favour of allowing exhibition priority in respect of an application for a Community design which consists of a partial design that is, which represents only part of the entire product disclosed at the international exhibition.

Such a position would however conflict with the EUIPO practice in respect of priority claims under Article 4 of the Paris Convention, which is to consider that the subject-matter of the previous application must be identical to that of the corresponding Community design, without the addition or suppression of any features.

There is no case-law on this issue so far, and the Office has not yet defined an established practice.

6.5 The Number of View & The Type of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of the previous application?

If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of the previous application?

The product which was disclosed at the international fair was in principle not the subject of a previous design application. The issue of the number or type of views is therefore different as in the case of priority under Article 4 of the Paris Convention.

The certificate issued at the exhibition by the authority responsible for the protection of industrial property 'shall be accompanied by an identification of the actual disclosure of the product, duly certified by that authority' (Article 9(1) CDIR).

There is no specific requirement set out in the CDR/CDIR about how the actual disclosure should be identified.

Given the exceptional nature of exhibition priority and the very low number of cases, the Office has not yet been confronted to the situation described in the question, and has not defined an established practice.

USPTO

Continuation (-In-Part) Application

1. Formality Requirements

1.1 Time Limit of Claiming Right

When a later-filed application is claiming the benefit of a prior-filed non-provisional application under 35 U.S.C. 120, 121, 365(c), or 386(c), the later-filed application must be copending with the prior application or with an intermediate non-provisional application similarly entitled to the benefit of the filing date of the prior application.

Copendency requires that the later-filed application must be filed before:

- (A) the patenting of the prior application;
- (B) the abandonment of the prior application; or
- (C) the termination of proceedings in the prior application .

If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. See MPEP § 211.01(b), subsection I.

When a later-filed international design application designating the United States is claiming the benefit of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c), the later-filed application must be copending with the prior application or with an intermediate application similarly entitled to the benefit of the filing date of the prior application. In determining whether an international design application designating the United States is copending with a prior-filed application, it is the U.S. filing date of the international design application that is relevant, which may or may not be the same as the international filing date assigned by the International Bureau. See MPEP § 2920.05(e).

1.2 Fee

No fee is required to claim benefit.

1.3 Declaration of Claiming Priority

1.3.1 Whether the declaration in subsequent application is compulsory?

a claim for benefit must be filed in order for a later-filed application to be entitled to the benefit a prior-filed application.

1.3.2 When shall the declaration be submitted?

For a design application or a non-provisional international design application, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be submitted during the pendency of the later-filed application.

1.3.3 What information shall be contained in the declaration?

Benefit claims under 35 U.S.C. 120, 121, 365(c), and 386(c) must identify the prior application by application number, by international application number and international filing date, or by international registration number and international filing date under 37 CFR 1.1023.

The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed non-provisional application, international application, or international design application.

The specific reference to the prior-filed application must be included in an application data sheet (37 CFR 1.76). See MPEP § 1504.20.

1.4 Copy of Previous Application Documents

Whether the copy of previous application documents should be submitted?

A copy of the previous application documents is not required.

1.5 Other Requirements

Each prior-filed application must either be:

- (i) a non-provisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in 37 CFR 1.53(b) or (d) for which the basic filing fee set forth in 37 CFR 1.16 has been paid within the pendency of the application;
- (ii) an international design application entitled to a filing date in accordance with 37 CFR 1.1023 and designating the United States; or
- (iii) an international application entitled to a filing date in accordance with PCT Article 11 and designating the United States. See 37 CFR 1.78(d)(1) and MPEP § 1504.20.

A design application cannot claim the benefit of a provisional application under 35 USC 119(e). See 37 CFR 1.78(a). An international design application designating the United States may not claim benefit to a provisional application. See MPEP § 2920.05(e).

2. Procedure Requirements

2.1 Amendment or Withdrawal of Declaration

2.1.1 Whether the filing date of previous application which indicated in declaration may be modified?

Whether the application number of the previous application indicated in declaration may be modified?

Yes, an applicant may correct a benefit claim in a design application by filing a corrected application data sheet in compliance with 37 CFR 1.76(c) that corrects the reference to the prior-filed application, in conjunction with a request for a corrected filing receipt, during the pendency of the later-filed design application. An application data sheet filed after final rejection or allowance is not entered as a matter of right

and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively. See MPEP § 211.02(a).

2.1.2 Whether the declaration may be withdrawn?

Yes, an applicant may delete a benefit claim in a design application by filing a corrected application data sheet in compliance with 37 CFR 1.76(c) that deletes the reference to the prior-filed application, in conjunction with a request for a corrected filing receipt, during the pendency of the later-filed design application. An application data sheet filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively. See MPEP § 211.02(a), subsection III.

2.2 The Applicant(s)

2.2.1 Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?

The later-filed application must name the inventor or at least one joint inventor named in the prior-filed application for a benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c). See MPEP § 211.01, subsection II.

2.2.2 If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), how to deal with?

The later-filed application must name the inventor or at least one joint inventor named in the prior-filed application for a benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c). See MPEP § 211.01, subsection II.

2.3 Notifications Involved in the Examination

2.3.1 Whether different notifications may be issued in the examination?

Notifications may be issued when applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c).

For example, notifications may be issued under the following conditions:

When the disclosure of the prior-filed application fails to provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112(a) except for the best mode requirement. See MPEP § 211.05.

When an application, which claims the benefit of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c) contains new matter relative to the prior-filed application, and purports to be a “continuation,” “division,” or “divisional application” of the prior-filed application. See MPEP § 211.05.

When the benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c) is improper because there is no copendency between the applications. See MPEP § 211.01(b), subsection I.

2.3.2 In what condition shall the examiner invite the applicant to make amendments?

The claimed design in a continuation application and in a divisional application must be disclosed in the prior-filed application. If this condition is not met, the application is not entitled to the benefit of the earlier filing date and the examiner should notify applicant accordingly by specifying the reasons why applicants not entitled to claim the benefit under 35 U.S.C.120.

The examiner should also require applicant to change the relationship (continuation or divisional application) to continuation-in-part or delete the benefit claim. See MPEP § 1504.20.

2.3.3 In what condition shall the examiner issue a notification to inform the applicant the claim is deemed to be waived?

Except as provided for in 37 CFR 1.78(e), the failure to timely submit the reference required under 35 U.S.C. 120 and 37 CFR 1.78 in a design application during its pendency is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c) or 386(c). See 37 CFR 1.78(d)(3)(iii) and MPEP § 1504.20. When a benefit claim is filed after the required time period and without a petition as required by 37 CFR 1.78, the applicant should be informed that the benefit claim was not entered and that a petition needs to be filed.

See MPEP § 211.03. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the USPTO.

2.3.4 What is the time limit for the applicant to respond to the notification?

Unless filed with a petition under 37 CFR 1.78, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be submitted during the pendency of the later-filed application. See 37 CFR 1.78(d) and MPEP § 211.03.

2.5 The Relation between the Subsequent Application and the Previous Application

2.5.1 After the subsequent application owns a design patent right, does the previous application have to be waived?

A claim for benefit of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c) does not constitute a request to expressly abandon or waive the prior

application.

Also note, where two or more applications filed by the same applicant or assignee contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. See 37 CFR 1.78(f).

2.5.2 When the subsequent application and the previous application act their rights, do they have to be act all together?

All parties having any portion of the ownership in the previous patent application must act together as a composite entity in matters pertaining to the previous patent application before the USPTO. Likewise, all parties having any portion of the ownership in the subsequent patent application must act together as a composite entity in matters pertaining to the subsequent patent application before the USPTO. See MPEP § 301.

3. Judgment of the Same Subject Matter

3.1 Principle of Judgment

To be entitled to the benefit of any prior-filed application(s), the invention claimed in the later-filed application must be supported in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 211.05.

3.2 Patent Type

If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim right on the basis of the previous application.

Yes. Where the conditions of 35 U.S.C. 120 are met, a later-filed design application may be considered a continuing application of an earlier utility application. Under 35

U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

3.3 The indication

If the indication between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

3.4 The entire and Partial Design

3.4.1 If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may claim the right of the previous application?

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application whether the subsequent application may claim the right of the previous application?

If the previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Whether the subsequent application may claim the right of the previous application?

If the previous application is a design of a entire product, the subsequent application is a partial design of the product, whether the subsequent application may claim the right of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

3.4.2 For GUI applications, if the previous application is the interface, the subsequent application is a entire product which contained the GUI, whether the subsequent application may claim the right of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed

application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20. Note that an application directed to the interface alone may not comply with the “article of manufacture” requirement of 35 U.S.C. 171. See MPEP 1504.01(a), subsection I.

3.5 colour

If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

3.6 The Number of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, whether the subsequent application may claim the right of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

3.7 The Type of View

If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of the previous application?

If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of the previous application?

In order to claim the benefit of the prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application must be supported by the prior-filed application in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 2163.03, subsection II and MPEP § 1504.20.

4. Cases

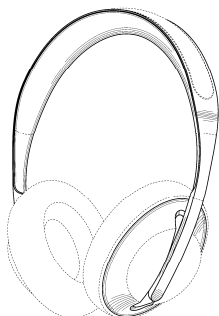
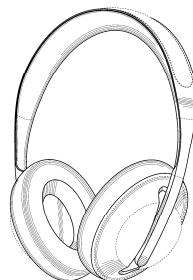
USPTO would like to note the following:


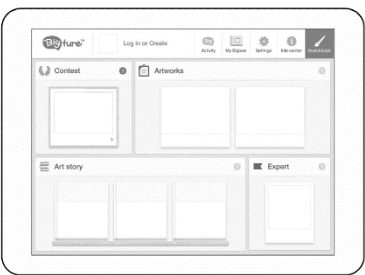
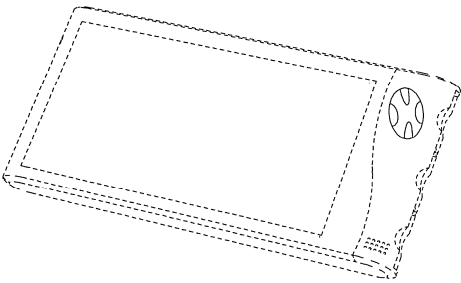
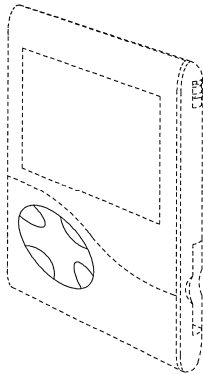
We cannot comment on examples drawn from pending applications and have proceeded in providing responses to the below examples based on the understanding that these examples are not drawn from pending applications.

We also note that answers are limited to the specific figures and descriptions provided and should not be interpreted as setting forth a per se rule.

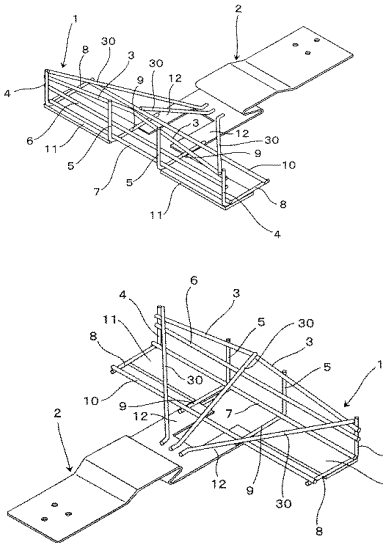
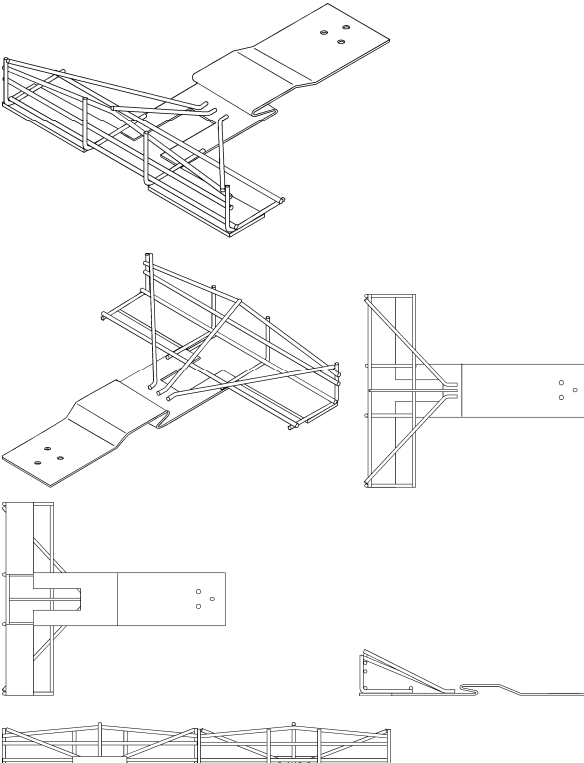
Under the laws of the United States, there are no per se rules as to whether a subsequent application is entitled to the benefit of the filing date of an earlier application. Each application is individually evaluated in view of its specific circumstances and contents. In order to claim the benefit of a prior-filed application under 35 U.S.C. 120, the invention claimed in the later-filed application (i.e., the continuation, divisional, or continuation-in-part) must be supported by the prior-filed application in the manner provided by 35 U.S.C. 112(a), i.e., the disclosure of the application relied upon reasonably conveys to those skilled in the art that the

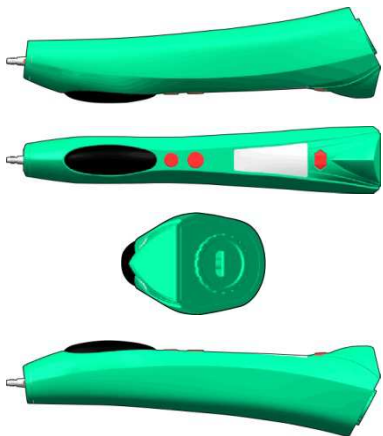

inventor had possession of the claimed subject matter as of the filing date. See MPEP 2163.03, subsections II and III, MPEP 1504.20 and MPEP 1504.04, subsection I.

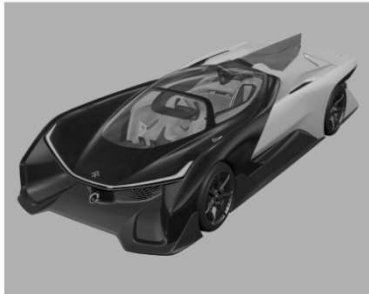
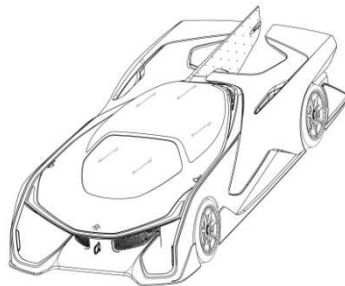
Questionnaire	The previous application	The subsequent application	Answer	Note
The entire And Partial Design			<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No	It appears that the figure for the design of the previous application reasonably conveys to those skilled in the art that the inventor had possession of the design claimed in the subsequent application. Therefore, the subsequent application may be entitled to the benefit of the filing date of the previous application.
	If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, whether the subsequent application may be registered as a continuation application?			

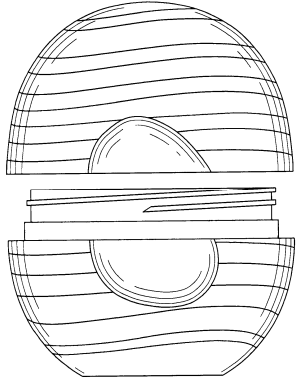
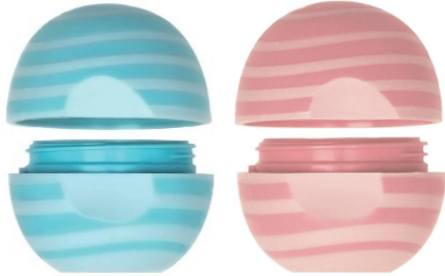
<p>The entire And Partial Design</p>			<p><input checked="" type="checkbox"/> Yes</p> <p><input type="checkbox"/> NO</p>	<p>It appears that the figure for the design of the previous application reasonably conveys to those skilled in the art that the inventor had possession of the design claimed in the subsequent application. Therefore, the subsequent application may be entitled to the benefit of the filing date of the previous application.</p>
<p>The entire Design</p>			<p><input type="checkbox"/> Yes</p> <p><input checked="" type="checkbox"/> NO</p>	<p>The design shown in the drawing of the subsequent application appears to be a different design from the design shown in the drawing of the previous application (e.g., differences in position and size of dial). Therefore, the previous application does</p>

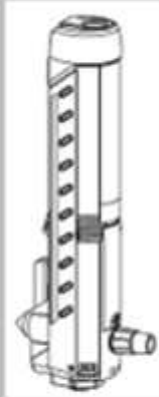
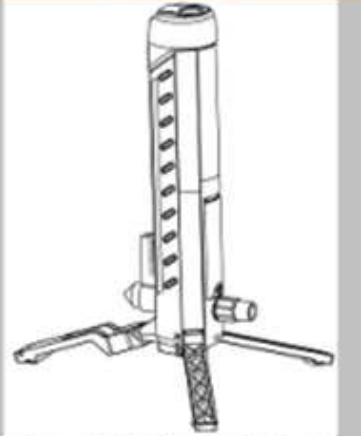
	If the previous application is a partial design, the subsequent application also is a partial design with the different position, size or scope, whether the subsequent application can registered as a continuation application?		not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of the filing date of the previous application.	
The Color			<div><input type="checkbox"/> Yes</div> <div><input checked="" type="checkbox"/> NO</div>	Because the color disclosed in the figure for the design of the previous application appears to be different from the color disclosed in the figure for the design of the subsequent application, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent
	If the color between the previous application and the subsequent application is different, whether the subsequent application may be registered as a continuation application?			

			application may not be entitled to the benefit of the filing date of the previous application.	
The Number of View			<div><input type="checkbox"/> Yes</div> <div><input checked="" type="checkbox"/> NO</div>	Details shown in some of the views of the design of the subsequent application are not clearly visible in the stereostopic drawing of the design of the previous application. Therefore, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of the filing date of the

	If the previous application only has a stereoscopic drawing, the subsequent application has five-side views, whether the subsequent application may be registered as a continuation application ?			previous application.
The Number of View			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> NO	Details shown in the figure for the design of the subsequent application are not clearly visible in the four views of the design of the previous application (e.g., the yellow nodes at the tip of the device and contouring details of the front of the object). Therefore, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of
				
	If the previous application has four views, the subsequent application only has a stereoscopic drawing, whether the subsequent application may be registered as a continuation application ?			

				the filing date of the previous application.
The Type of View			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> NO	The design shown in the drawing of the subsequent application appears to be a different design from the design shown in the photograph of the previous application (e.g., contours in the hood windshield region shown in the photograph are not shown in the drawing). Therefore, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of the filing date of the previous application.
	If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may be registered as a continuation application ?			

<p>The Type of View</p>			<p><input type="checkbox"/> Yes</p> <p><input checked="" type="checkbox"/> NO</p>	<p>The design shown in the photographs of the subsequent application appears to be a different design from the design shown in the drawing of the previous application (e.g., the colors shown in the photograph are not shown in the drawing). Therefore, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of the filing date of the previous application.</p>
	<p>If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may be registered as a continuation application?</p>			

<p>The Variable states</p>	<p>2014. 6. 13</p>  <p>立体图</p>	<p>★ 2014. 6. 13</p>  <p>打开状态立体图</p>	<p><input type="checkbox"/> Yes</p> <p><input checked="" type="checkbox"/> NO</p>	<p>The design shown in the drawing of the subsequent application appears to be a different design from the design shown in the drawing of the previous application (e.g., details of the three legs shown in the drawing of the subsequent application are not shown in the drawing of the previous application). Therefore, the previous application does not appear to reasonably convey to those skilled in the art that the inventor had possession of the design claimed in the subsequent application, and the subsequent application may not be entitled to the benefit of the filing date of the previous application.</p>
	<p>If the previous application is a product of variable states with open state , then may the continuation application be a product with only open state?</p>			

