ID5

Assessment of Designs

Revision History

Version	Date	Lead Office
1.0	03/01/2022	EUIPO

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1. Background

In all five Partner countries of ID5 novelty is a requirement for protection of an industrial design. While the legal definition of novelty varies from office to office, the minimum standard common to all legislations is the presumption that a design does not fulfil the requirement of novelty where an identical design ('prior design') has become known to the public prior to the date of commencement of the design protection sought for.

The Partners have proceedings in place to rule on the novelty of a design by substantive examination. The essence of the examination is the comparison of the design with a prior design. However, this comparison is not straightforward. While the design under examination is represented by graphical representations in more or less advanced degrees of abstraction often showing only a part of product, the prior design is usually incorporated in a complete product known to the public, e.g. a product sold on the market. Thus, design examiners are facing the challenge to compare an abstract representation of the examined design with a real-life product incorporating a prior design.[1]

The fundamental first step in the comparison of the examined design with a prior design is the assessment of the examined design, i.e. the interpretation of the graphical representation of the examined design. The examiner must decode the elements of the representation in order to extract the shapes and features of the examined design. For instance, where the examined design is represented in a drawing, the examiner must interpret the various types of lines and shadings of the drawing. Where the examined design is a sequence of snapshots representing an animated object, the examiner must seek understanding of how the animation works.

Where the evidence for the prior design is also given in the form of graphical representations, the examiner must apply interpretation as well to the representations of the prior design.

Once the examination has passed the step of interpreting the respective graphical representations of the opposing designs, it is possible to proceed to the evaluation as of whether the designs are identical or not. This evaluation is usually straightforward. Where the designs are identical in all features, the examined design is ruled to lack novelty in view of the prior design.

The interpretation of the graphical representation of the examined design is usually more challenging than that of the prior design. While the examined designs are often represented in highly abstract form, prior designs usually become known to the public in a form easy to understand by the consumers targeted by the products incorporating the prior design, such as the products itself or photos of them depicted in sales catalogues.

Knowledge on how the graphical representation of a design is interpreted by examiners when ruling on the novelty of the design is crucial for users applying for design protection. The art of creating a graphical representation for a design application with a broad scope of protection consists in using graphical elements which only disclose the essential features of the design. Ideally, the scope of protection is extended to the limit of the prior art, i.e. just leaving all prior designs outside to maintain novelty. The more abstract is the graphical representation, the broader is the scope of protection. For instance, a piece of furniture may be represented by a minimalistic drawing showing only contours, leaving aside all features related to material and colour, thereby keeping the scope of protection broad enough to include all furniture with the same contours irrespective of material and colour. The choice of graphical elements is often made with the knowledge of the relevant prior designs since users usually know the market in which they operate.

Where a user chooses to represent a design by drawings according to the practice of the receiving IP Office, the decoding of the drawings is easy since the graphical elements of drawings are defined by that practice. Most IP Offices have well-established practices for drawings and made them known to the users by publications of guidelines. However, where the user chooses a less traditional form of graphical representations such as computer generated images for interior designs, sequences of snapshots for animated icons, exploded or cross-section views for complex products, element views for set of articles, etc., and any combination thereof, the IP Office concerned may not have a well-established practice manifested in guidelines for users.

[1] As to the challenge of comparing an abstracted graphical representation of a registered design with a real-life product, see for example UK Supreme Court judgment UKSC 12 (2016), PMS International Limited v Magmatic Limited, $$59ff

The principal objective of the project is to collect the practices of the Partners in a single Handbook and make them available to the users.

The Handbook will address the substantive examination of designs as it relates to interpretation and assessment of the designs within the context of ruling on novelty.

2. Project Definition

2.1. Project objectives

The project aims to produce a Handbook explaining how and when the examiners of the five Partner Offices assess designs starting with the fundamental step of interpreting the graphical representations of designs fulfilling the view and drawing requirements.

The Handbook will help applicants better understand substantive examination by explaining how the five Partner countries interpret and assess the graphical representations of their applications.

The resources required for the present project are similar to the one for the Catalogue in gathering of information of practises currently applied by the partners of ID5.

In Phase 1 of the proposed project, the leading office will prepare a questionnaire seeking specific information on how the comparison between the examined design and the prior design is carried out. The questionnaire will be on an advanced technical level and hence targets the experts of the Partners, in particular officials in charge of the examination of novelty of designs.

In Phase 2, the leading office will collect the replies to the questionnaire and eventually seek clarification in bilateral contacts with the respective national experts if necessary.

In Phase 3, the leading office will create a draft of the Handbook and circulate it for comments until a final version is agreed and approved by the Partners.

2.2. Project scope and exclusions

What is in the scope of the project:

The project is merely seeking to gather information on current practices and make them available to the users.

What is out of the scope of this project:

The project does not seek amendments to legislation or changes of practice of the partner countries.

Examples will not be evaluated based on patentability.

2.3. Outline products/deliverables and/or desired outcomes

The project deliverable will be a Handbook on the Assessment of Designs.

3. Outline Project Plan:

Date	Deliverable/milestone
January 2022	Draft Project Brief circulated to Partners
March 2022	Partners provide comments on the Draft Project Brief and the Questionnaire
Midterm meeting 2022	Discussions on the Draft Project Brief
October 2022	Project's approval at Annual Meeting
November 2022	Lead office circulates questionnaire to the Partners to be filled in
February 2023	Receive answers for the questionnaire from the Partners
April 2023	Lead office circulates draft Handbook for comments
Midterm meeting 2023	Partners discuss progress on the Handbook
August 2023	• Partners provide final comments on Handbook
ID5 Annual Meeting – 2023	➢ **Present results on the Handbook, discuss with Users;**

4. Roles and Responsibilities

Lead Office:

1. Shares information on the deliverables with the Partners;
2. Prepares and chairs the exchange of views on context risks of shared interest;
3. Present the deliverables of the project during the ID5 Annual Meeting.

Participating Offices

1. In response to the Lead Office, to submit information requested and participate in the revision and reviewing cycles;
2. To actively participate in the meetings organised with a view to creating or presenting the projects' deliverables.

5. Acceptance Criteria for the deliverables

The lead office will integrate and address comments received during the revision exercise. Deliverables discussed during midterm meetings and approved during annual meetings prior to their publication and dissemination.

6. Financial arrangements

1. The ID5 Partners will bear their own expenses for transportation, accommodation, and travelling during the arranged meetings.

2. The ID5 Partners will bear parts of the costs according to the agreed responsibilities, e.g., KIPO hosting the reports on the ID5 website, EUIPO the costs of coordination and creation of the deliverables, etc.

Annex

Questionnaire to the Assessment of Designs[2]

The questionnaire is a fact-finding exercise on how to interpret graphical representations of the opposing designs by way of examples and how to assess the novelty comparing the opposing designs as interpreted from the respective representations.

The Partners are invited to answer the questions and give their reasoning supporting their answers.

In brief, the questionnaire addresses the following topics:

- How to deal with blank surfaces in drawings of examined designs? Are they understood as being empty of features and hence different to surfaces having features in prior design?

- How to deal with features visible in the prior design but not in the examined design? Do they mark a difference?

- Does a sequence of snapshots (stand stills) representing an examined design of an animated item constitute in itself a feature, i.e. would a prior design encompassing the same stages but in a different sequence be considered as being a different design?

- Is the nature of the product taken into account when assessing the design? For instance, would a simple rectangle be considered a new design only because it applies to a smartphone? Would the well-known shape of a golf ball be considered new if the applicant claims it is not a golf ball but a soap or a piece of chocolate?

- Can internal features visible only in exploded and cross-section views but not visible from outside establish novelty when comparing to a prior design which is represented only from outside? If not, what is the purpose of a cross-section or an exploded view if the features made visible in these views do not count?

- How to evaluate elements in representations which are clearly visible but seem not to be essential, e.g. a trade mark or an explanatory element?

- Can features of an examined design which are solely dictated by technical function establish its novelty when these features are not present in the prior design?

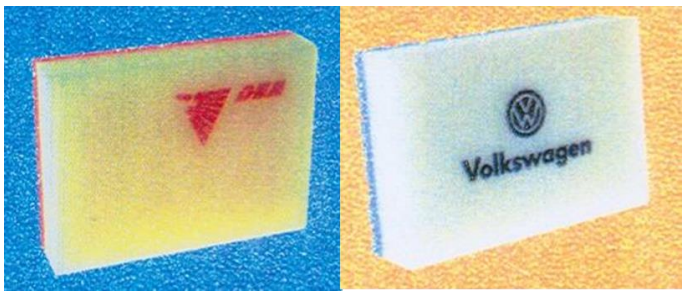
- Can feature of the examined design which are not visible in the normal use establish its novelty when these features are not present in the prior design?

- How to assess the novelty of an interior design (e.g. a flagship store)? What are the constituting features of an interior design? Is the arrangement of items of an interior design (e.g. arrangement of pieces of furniture) a feature which can establish novelty when all the items are known from a prior design but with a different arrangement?

- How to assess graphical user interfaces? What are the constituting features of the design?

[2] Further revisions of the questionnaire may take place after approval of the project

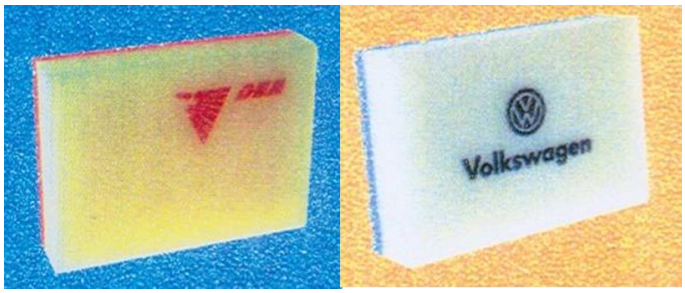
1) Is the examined design substantially different in view of the prior design?



examined design prior designs

Main issue:
- How to deal with features present in the prior design but not in the examined design?
- How to interpret representations of black&white photos? Do they cover all colors?

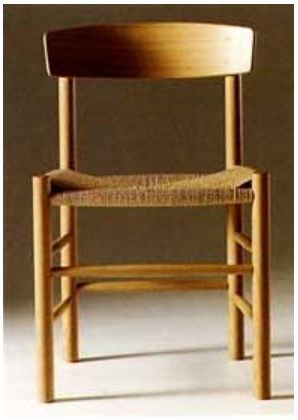
2) Is the examined design substantially different to the prior design?



examined design prior designs

Main issue:
- How to deal with features present in the prior design but not in the examined design?
- Is a different color in the examined design enough to establish its novelty?

3) Is the examined design substantially different to the prior design?

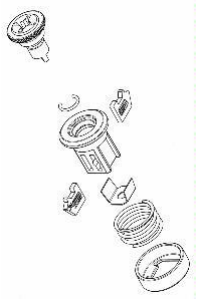


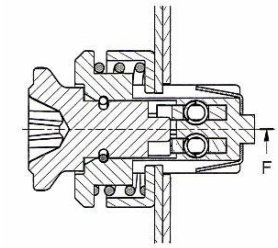
examined design

prior design

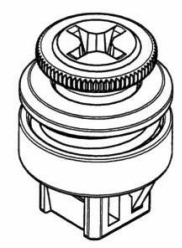
Main issue:
- How to deal with features of material (here: wood) claimed in the examined design but not visible in the prior design?
- Is the feature of material enough to establish its novelty?

4) Is the examined design substantially different to the prior design?





examined design
(only exploded and cross-section views on file)



prior design

Main issue:
- Can novelty be established by interior features only visible in cross-section and exploded views of the examined design?
- Does the examiner need to seek understanding and take into account how the examined design appears from outside when only exploded and/or cross-section views are on file?

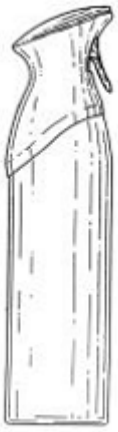
5) Is the examined design substantially different to the prior design?

examined design

prior design

Main issue:
- How to deal with features present in the prior design but not in the examined design when these features alter the appearance of the prior design?
- How to interpret blank surfaces in compute generated graphical representations looking like black&white photos?

6) Is the examined design substantially different to the prior design?



examined design

prior design

Main issue:
- How to deal with features present in the prior design but not in the examined design? May they be simply ignored?

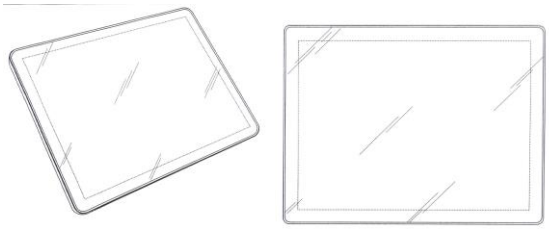
7) Is the examined design substantially different to the prior design?

examined design
(animate icon)

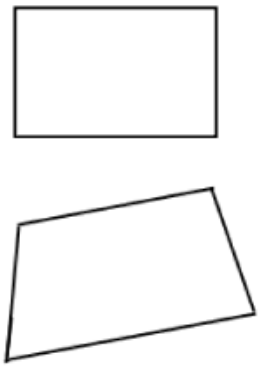
prior design

Main issue:
- Is animation a feature which in itself may establish novelty?

8) Is the examined design substantially different to the prior design?



examined design
(iPad)



prior design

Main issue:
- Where the claimed features of a design consist only of a simple geometrical shape (here: a rectangle), may this design have novelty?

9) Is the examined design substantially different to the prior design?

examined design

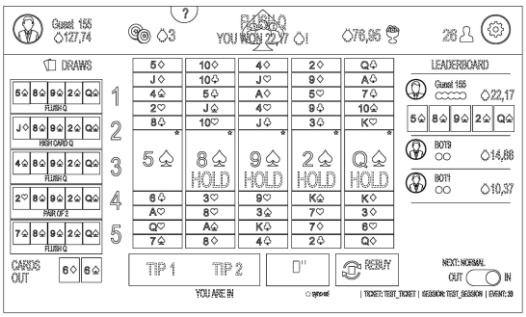
prior design

Main issue:

- How to assess an interior design? What are the constituting (essential) features of the design?

10) Is the examined design substantially different to the prior design?

examined design



prior design

Main issue:

- How to assess the novelty of a graphical user interface? What are the constituting (essential) features of the design?

11) Please verify or update the below information from the ID5 ‘Catalogue of Eligibility for Industrial Design Protection’ (2017)

4.1. Is the novelty of a design judged and when is the initial novelty judged?

CNIPA

☒ Yes ☒ Decision to grant

Article 23.1 :

Any design for which patent right may be granted shall not be a prior design, nor has any entity nor individual filed before the date of filing with the patent administration department under the State Council an application relating to the identical design and disclosed in pat ent documents announced after the date of filing.

EUIPO

☒ Yes ☒ Request for Invalidation Trials

Art. 5 CDR

1. A design shall be considered to be new if no identical design has been made available to the public:

(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has
first been made
available to the public;
(b) in the case of a registered Community design, before the date of filing of the applic
ation for registration of the design for which protection is
claimed, or, if priority is claimed, the date of priority.
2. Designs shall be deemed to be identical if their features differ only in immaterial details.

JPO

☒ Yes ☒ Decision to grant
Article 3(1) of the Design Act.
Article 3 (1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the said design, except for the following:
(i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;
(ii) Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration; or
(iii) Designs similar to those prescribed in the preceding two items.
Part II, Chapter II of the Examination Guidelines for Design "Novelty".
As to the Examination Guidelines for Design above, please refer to the following:
http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/design_es/0202.pdf

KIPO

☒ Yes (In the case of designs that fall under Locarno Classification 2, 5, or 19, during determination of registration, the novelty is not
judged) ☒ Decision to grant
[Design Protection Act]
Article 33 (Requirements for Design Registration)
(1) A design that may be used for an industrial purpose is eligible for design registration, except in any of the following cases:
1. A design publicly known or worked in the Republic of Korea or a foreign country before an application for design registration is filed;
2. A design described in a printed publication distributed in the Republic of Korea or a foreign country or made available for public use via
telecommunications lines before an application for design registration is filed;
3. A design similar to any of the designs specified in subparagraph 1 or 2.
[Design Examination Standards]
Part4, Chapter 3 Novelty
1)~4)

USPTO

☒Yes ☒ Decision to grant
35 U.S.C. 102: Conditions for patentability; novelty (see MEP 1504.02)
(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—
(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.
A claimed design may be rejected under 35 U.S.C. 102 when the invention is anticipated (or is "not novel") over a disclosure that is available as prior art. In design patent applications, the factual inquiry in determining anticipation over a prior art reference is the same as in utility patent applications. That is, the reference "'must be identical in all material respects.'" Hupp v. Siroflex of America Inc., 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997). For anticipation to be found, the claimed design and the prior art design must be substantially the same. Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1313, 59__ USPQ2d 1472 __, 1475__ (Fed. Cir. 2001) (citing Gorham Mfg. Co. v. White, 81 U.S. 511, 528 (1871)).
In International Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239-40, 93 USPQ2d 1001, 1005 (Fed. Cir. 2009), the Federal Circuit held that the ordinary observer test is "the sole test for anticipation."