**ID5 — INDUSTRIAL DESIGN FORUM**

*Conclusions of the Phase I Comparative Study of Practices Concerning Product Indications and Closure of Project*



**Comparative Study of Practices Concerning Product Indications**

***EUIPO Lead***

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**SUMMARY**

The aim of this project was to develop a better understanding of the respective differences among practices of the ID5 Offices. The project was contemplated as consisting of potentially two phases:.

**Phase I:** Preliminary comparative study of legal provisions and practices regarding productindications.

**Phase II:** Creation of an ID5 product indication database. This phase depend~~s~~ed on theconclusions derived at the completion of the preliminary study described in phase 1.

Following a short-term pilot phase after completion of Phase I, the Partners reached consensus to not pursue Phase II and proceeded to closure of project.

For the purpose of phase 1 the Partners were requested to submit information based on their Regulations and Guidelines about their established acceptability criteria for indications of product, grounds for objection, as well as practices of ex-officio amendment of product indications or suggestions for amendment and the effects of those practices to the registration and scope of protection of a design.

Partners were also requested to provide information about their established practices on specific types of products.

As agreed later among the Partners the information was provided in the form of answers to a questionnaire prepared by the Lead Office.

The information received can be summarized as follows:

***General practice***

The general requirements for indication of product/title of article filed in an application for design registration possess many similarities in the Partners´ practices.

A design application must include an indication of the product which the design is intended to be incorporated in or applied to.

The indication of product must correspond to the representation of the design and be worded in such a way as to describe clearly the nature of the product and to enable classification.

When any of the above requirements is not fulfilled the Offices object the application and ask the applicant to amend the irregularity.

* Amendments upon applicant´s request

In principle, amendments of the product indication are allowed before the registration of the design by all Offices provided such amendment is not beyond the scope of the original application and does not introduce new matter. Amendments in the indication of product are not allowed at post registration stage except for amendments of errors attributed to the Offices. However, according to the USPTO practice the designated article of manufacture



may be amended pursuant to a reissue application, a re-examination proceeding, an inter-partes review, or a post grant review.

* Ex officio amendments

The Offices in general do not amend the product indication ex officio except for typos (KIPO) or obvious and formal defects (CNIPA). The only exception is EUIPO which applies a more flexible practice. Where an applicant uses terms that are not in the Locarno Classification or the database of product indications provided by the Office, the examiner will, in straightforward cases, substitute *ex officio* the wording used by the applicant with an equivalent or more general term listed in the Locarno Classification or the database of product indications. The purpose of this is to avoid having to translate terms into all the EU languages, which would result in delays in processing the application.

***Practice on specific types of products***

* Set of articles

In case of set of articles the term “set” must be stated (JPO, KIPO, USPTO, EUIPO) while following the practice of CNIPA the indication of product without the term set is also acceptable. The USPTO requires additionally a descriptive statement making it clear that the claim is directed to the collective appearance of the articles shown. Where a design represents a set of products, and these products are indicated in the application the JPO, KIPO and USPTO will send a request for correction, CNIPA will accept the indication as such, while EUIPO will replace ex officio that indication by ‘Product(s) X (Set of -)’.

* Parts of products

In case of designs that form parts of other products all Offices except CNIPA and EUIPO require the design to be indicated with the name of the product as a whole. The title of the design identifies the article in which the design is embodied. CNIPA requires designs that form the part of other products to be indicated with their name and not as “parts of” the product. However, in China protection cannot be granted for parts of a product which cannot be separated from the main product, sold or used independently. EUIPO requires the suffix “part of” to be included in the product indication. Where a design represents the appearance of one part of a product, and that product as a whole is indicated in the application the examiner will replace that product indication by the indication ‘Product(s) X (Part of -)’, provided both the part in question and the product as a whole belong to the same class of the Locarno Classification.

* Ornamentation (Locarno 32-00)

As regards designs for ornamentation they are not per se subject matter for design protection in Japan, China and the US. In these countries surface treatments should be indicated with the name of the article which they will be applied to and be disclosed together with said article. In Korea an application for ornamentation can be filed as partial design of the product to which it is applied and should be indicated with the name of the product as a whole. The European Design Regulation grants protection to designs for ornamentation, logos, graphic symbols or surface patterns (Locarno class 32-00) separately from the articles



which they are applied to. Where the design represents ornamentation for a given product, and only that product as a whole is indicated in the application, the examiner will replace that product indication by the indication ‘Product(s) X (Ornamentation for -)’. The product will thus be classified under Class 32-00 of the Locarno Classification. The same practice is applied to *graphic symbols, logos* and *surface patterns*.

“Get ups” (also in Locarno class 32-00) are granted protection only in EUIPO which accepts designs with this product indication for the arrangements of the interior of a space. While the terminology “get up” is not utilized, depending on the circumstances, interior space may be protected in the United States. Get ups are not granted protection in any other of the Partner Offices.

* Screen displays, icons, GUI (Locarno 14-04)

Screen displays, icons and graphical user interfaces cannot be protected individually in Japan, Korea and China and should always be indicated with the name of the electronic device where they appear or in which they are incorporated. The USPTO considers designs for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection. EUIPO also grants protection to such designs. These product indications can be used individually without the name of the article they are embodied in.

* Multifunctional products

Multifunctional products should be indicated with several terms that correspond to all its functions (EUIPO) or one single term that combines all functions (JPO). On the other hand, according to the practices of KIPO and CNIPA the product indication for a multipurpose product should be based on the main function of the product. In USPTO when a design is embodied in an article having multiple functions or comprises multiple independent parts or articles that interact with each other, the title must clearly define them as a single entity, for example, combined or combination, set, pair, unit assembly.

JPO, KIPO and CNIPA apply the principle of a single application for a single design thus only one product indication per design is permitted. USPTO allows substantial latitude in the descriptive language of the title/claim. EUIPO allows more than one product indication for the same design independently whether these indications belong to the same or different Locarno classes/subclasses.

***Acceptability criteria for product indications/titles***

The acceptability criteria applied by the Offices as regards the terms/titles used for indicating the product in which the design will be embodied also vary.

USPTO applies a flexible practice. The applicant has substantial latitude in the descriptive language of the title/claim. The examiner should only require amendment of the title/claim if the language is clearly misdescriptive, inaccurate, or unclear.

In the rest Offices´ practices, in general, the following are refused:

* terms containing a trademark
* generic/abstract terms not clearly indicating the use of the product
* terms describing structure, technical effect, shape colour, material or pattern
* terms containing name of model, codes, specification, size, scale or numerical unit of the product
* terms not in the working language(s) of the Office

However, the Offices apply diverse exceptions concerning descriptive adjectives in the indications.

As for the number of words indicating a product, CNIPA requires a max of 20 Chinese characters while EUIPO a max of 4 words (as per EU harmonised standards). In the rest of the Offices the number of words is irrelevant.

Regarding symbols and signs, square brackets (as per Locarno) are allowed in JPO and EUIPO practice, KIPO allows any brackets used to include explanatory details, while in CNIPA there are no rules to forbid the use of any punctuation signs.

***Scope of protection, invalidation of designs***

In Japan, according to the national Design Act, the product indication affects the scope of protection of the design. Consequently, the product is also important for the pre-registration examination (mandatory) and the post-registration examination (optional) which is conducted by JPO as trial for invalidation of design registrations. In the United States, the title may also affect the scope of the rights.

In the rest Offices the product indication does not affect the protection of the design. However, in the invalidation proceedings it serves as a reference that aids the examiner to determine the category of the product (KIPO, CNIPA) and develop a complete field of search of prior art (USPTO). In EUIPO the product indications is used to define the “informed user” for the type of products in question and the “degree of designer´s freedom”, both important factors in the assessment of the individual character of a design when compared with prior art.

The material has been updated on:

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No changes made in the original report by the other Partners