

Study of design Non-Patent literature data resources among ID5 Offices (CNIPA/JPO)

(Final Report)

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Document Date

2021-11-15

**Report on Non-patent Literature Data Resources among ID5 offices**

The quality of design search and examination depends not only on available patent literature data resources, but also on available non-patent literature data resources, especially Internet data. Non-patent literature data resources, especially Internet data, are becoming more and more important to the stability of design rights. In order to help the examiners make effective use of the non-patent literature data resources and improve the quality and efficiency of examination, ID5 offices distributed a questionnaire on practices about non-patent literature data resources in ID5 offices. This report is based on the information from the questionnaire, and by comparing the practice and experience of accessing,collecting, using and maintaining non-patent literature data resources, the ID5 offices hope to learn from each other and explore the best practice.

**1. Collection scope of design NPL data**

1-1 Use of NPL data in examination of design applications in ID5 offices

|  |  |
| --- | --- |
| CNIPA, KIPO, JPO and USPTO | During examination, examiners need consider the NPL data |
| EUIPO | During examination, examiners need not consider the NPL data  EUIPO is not an examining office and does not consider prior art in examination procedure. During invalidity proceedings only the parties provide the prior art. The EUIPO is not entitled to search for the prior art ex officio. |

1-2 Collection of NPL data in ID5 offices

|  |  |
| --- | --- |
| CNIPA,KIPO, JPO and USPTO | The office collects NPL data |
| EUIPO | The office does not collect NPL data |

1-3 Source of NPL data in ID5 offices

|  |  |
| --- | --- |
| CNIPA | Internet websites, and commercial data service |
| EUIPO | NA |
| JPO | Magazines and brochures, both published in Japan or a foreign country, and the Internet. |
| KIPO | Catalogs, magazines, internet websites, etc. |
| USPTO | Magazines and digests (both in paper and electronic form) corresponding to each class in the classification scheme. For example, subscriptions include automobile magazines for class D12 and architecture magazines for D25, to name a few. |

1-4 The proportion of Internet NPL data and non-internet NPL data in your database

(Any NPL data, if only collected from internet, fall into the coverage of “internet NPL data”. In the case that the NPL data is provided to examiners by intranet, if it is collected from internet, it is regarded as the internet NPL data)

|  |  |
| --- | --- |
| CNIPA | More than 50% |
| EUIPO | NA |
| JPO | In FY 2019, JPO creates Internet NPL data and Non-internet NPL data, roughly, in the ratio of six to four. |
| KIPO | NA |
| USPTO | NA |

**2. Collection methods of design NPL data**

2-1 Who collects design NPL data and processes them into NPL database

|  |  |
| --- | --- |
| CNIPA | Third parties entrusted by CNIPA |
| EUIPO | NA |
| JPO | JPO and a third party entrusted by JPO  (JPO makes a plan for the yearly data collection and governs the actual data selection. The tasks of data collection and digitization of NPL are outsourced to private service providers.) |
| KIPO | A third party entrusted by KIPO |
| USPTO | NA  (While Examiners access NPL from the internet and utilize the print and online NPL provided in the magazines and online subscriptions, no design NPL data is processed into a NPL database.) |

2-2 Types of design NPL database IP office use

|  |  |
| --- | --- |
| CNIPA | Collection for un-patentable objects, such as national emblem and national flag with text description; collection for design image data and bibliographic |
| EUIPO | NA |
| JPO | Collection of design image data and bibliographic information captured from selected Internet websites and maintained for the use of off-line retrieval  (The same applies to the NPL database deriving from magazines and brochures as well as the Internet.) |
| KIPO | Collection of design image data and bibliographic information captured from selected Internet websites and maintained for the use of off-line retrieval |
| USPTO | NA  (USPTO does not have this particular information as we do not load any design NPL into a database) |

2-3 IP office maintain its own in-house NPL database, or utilize a third party’s database

|  |  |
| --- | --- |
| CNIPA | CNIPA owns a small in-house NPL database for un-patentable objects, while the other NPL data used is from a third party’s database via internet. |
| EUIPO | NA |
| JPO | JPO maintains its own in-house NPL database. |
| KIPO | KIPO has accumulated in-house NPL database |
| USPTO | NA |

2-4 Whether the internet NPL data resource is integrated into the office’s data resource system for use through the manner of accessing to the internet website

(The manner of accessing to the internet website means IPO only gives the URLs of websites to examiners)

|  |  |
| --- | --- |
| CNIPA | No |
| EUIPO | NA |
| JPO | No. JPO maintains a closed database (containing images and publication dates, etc.) that does not require internet connection. JPO examiners are also allowed to perform Internet searches at their own discretion. (See 4-5) |
| KIPO | No |
| USPTO | NA. The NPL information utilized by Examiners is cited on the Notice of References cited, with corresponding bibliographic data or URL links, which applicant can then access on their own. |

**3. Collecting, processing and saving of design NPL data**

3-1 The NPL data collecting standard in IP office

（NPL data collecting standard means the requirements mentioned office guide, rules, laws and etc., as the basis to choose the images to NPL database）

|  |  |
| --- | --- |
| CNIPA | A third party collects the images of un-patentable objects according to the Patent law, and then delivers the images to CNIPA. |
| EUIPO | NA |
| JPO | On the basis of the provisions of the Design Act regarding the requirements for protection, JPO collects useful information on the latest designs from among the design information appeared in a distributed publication or the design information made publicly available through the Internet. |
| KIPO | Information is collected by the authorized company through catalogue, internet search, or on-site collection method, and then submitted to KIPO after processing all collected data. |
| USPTO | NA |

3-2 The NPL data processing standard in IP office

(NPL data processing standard includes but not limits to document format, dpi, size and etc.)

|  |  |
| --- | --- |
| CNIPA | Format: JPG or TIF  dpi :300 x 600 ~600 x1000 |
| EUIPO | NA |
| JPO | [Image data] JPEG format. The size of representing image is 640x480 dots.  [Bibliographic data] CSV format. The data includes document identification number, publication date, received date, publisher, design class, etc. |
| KIPO | 1. The image files are generated a) each image of the published design only b) the entire page (screenshot) that contains the image of the published design and collecting information data of the design, such as the date of the publication and the source of the disclosure.  2. The filename of the published design is saved as the maintenance number, and the image format is submitted in JPG format.  3. The images of the object must show clear representation of the published design. |
| USPTO | NA |

3-3 The NPL data classification standard in IP office

(NPL data classification includes Locarno Classification, National Classification, National Economy Industry Classification, etc.)

|  |  |
| --- | --- |
| CNIPA | NA |
| EUIPO | NA |
| JPO | Japanese national design classification. |
| KIPO | NPL data of KIPO is classified according to the National Classification and Locarno Classification. |
| USPTO | NA |

3-4 The method/mechanism of securing the date of collection/disclosure of each image in the data processing procedure

(Data processing procedure includes but not limits to scanning, change of format or size, digitalization etc.)

|  |  |
| --- | --- |
| CNIPA | NA |
| EUIPO | NA |
| JPO | [Magazines] Issue dates and received dates are recorded and maintained.  [Brochures] Issue dates, received dates and publication dates are recorded and maintained.  [Internet information] Publication dates are recorded and maintained by obtaining time stamps from a TSA (Time-Stamping Authority). |
| KIPO | 1. The date of the issuance is recorded by year, month, and date as shown in the source of the published design.  2. Where only the year is issued, and the previous year from the year of collecting NPL data is recorded for the publication, record the last day of the previous year as the publication date.  3. Where the issued year is same as the collection date, record the year of the date of collection as the publication year.  4. Where the year and month of issue are obtainable, the last date of the month is recorded as the receipt date. If the month is the same as the month of the receipt of the NPL, record the receipt date as the published date.  5. To cite a news article from a website, the date entered in the article is used; however, since the date of publication and final modification are often different, the final date should be confirmed and it is regarded as the date of publication when the article was revised.  6. (In case of no publication date available) Even if the publication date of a reference design is not revealed online, the design can be cited where it (such as photo, etc.) appears with the date of uploading in the 'user reviews' or 'inquiry bulletin boards'. In regard to reviews with no photos, the use of design as a reference will be determined by comprehensively checking whether the product and the content of reviews or inquiries are consistent with each other; the design can be used for citation when it is decided so.  7. In principle, a single page of screenshot that covers URL, image of products, and date of publication should be taken when citing the design searched online; however, if it is inevitable, multiple screen shots are allowed where the captured screens are overlapped each other enough to show the interconnection. |
| USPTO | NA |

**4. Maintaining and using of design NPL data**

4-1 Whether the collected design NPL data are used in the same way as the other design patent literature data

(The same way means the NPL data and PL data share the same IT system, the same interface and the same index)

|  |  |
| --- | --- |
| CNIPA | YES |
| EUIPO | NA |
| JPO | YES (Both NPL data and PL data are used in the same IT system.) |
| KIPO | YES |
| USPTO | YES (If the NPL qualifies to be used as prior art under 35 USC 102 or cited as relevant by the applicant, then it can be utilized in the same was as other design patent literature data.) |

4-2 Whether the examiners are allowed to make free use of the internet for the purpose of prior design search and cite internet information as a ground of refusal other than the NPL data provided by IPO

|  |  |
| --- | --- |
| CNIPA | YES |
| EUIPO | NA |
| JPO | YES, they are allowed to do so. |
| KIPO | Yes. In addition to NPL data of our office, examiners are free to use internet source as the grounds for refusal. |
| USPTO | Yes. The Internet is an Office-approved search tool that may be considered when planning and conducting a search for an application. The USPTO does place some limits on the use of the internet for the purposes of prior art searching and has published a Patent Internet Usage Policy to establish a policy for use of the Internet by the patent examining corps and other organizations within the USPTO. See Internet Usage Policy, 64 F.R. 33056 (June 21, 1999). Articles 9 and 10 therein are pertinent to internet searching and documenting search strategies. Article 9 primarily addresses using the internet for unpublished application (e.g. U.S. design patent application) searches. As mentioned therein, it is necessary that internet searches related to unpublished applications MUST be limited to the general state of the art and formulated in such a way that protects the confidential proprietary intellectual property.  Regarding the use of internet information as a ground of refusal, the USPTO does not distinguish between internet information and other information in terms of prior art. Applicability of prior art is controlled by date of publication and public accessibility, regardless of source. See MPEP 2128(II)(a) for discussion of particular court decisions regarding whether an electronic publication is considered to be a “printed publication” within the meaning of 35 U.S.C. 102(a)(1) and pre-AIA 35 U.S.C. 102(a) and (b). |

4-3 Whether the examiners are given the permission of integrating their personally collected NPL data into your office’s NPL database

|  |  |
| --- | --- |
| CNIPA | YES(only available to the examiner upload the data) |
| EUIPO | NA |
| JPO | No (However, as for the NPL design information appeared in magazines and brochures, examiners may ask the Design Division to save personally collected data into the NPL database.) |
| KIPO | No |
| USPTO | No |

4-3-1 If IPO’s answer to 4-3 is yes, the mechanism for verifying and uploading the personally collected NPL data:

|  |  |
| --- | --- |
| CNIPA | Examiners are given the permission of send their personally collected NPL data to NPL database management group (staffs from examination departments and IT department), and those data would be integrated into the NPL database after checked and approved by management group. |
| EUIPO | NA |
| JPO | As for the NPL design information appeared in brochures, for example, the collection date of the brochure by JPO examiner is recorded together with the publication date. |
| KIPO | NA |
| USPTO | NA |

4-4 When IP office allows examiners to use their own collected NPL data as reference, any practice of perpetuation of evidence for those data, institute (in/out of your office) is entitled to do the perpetuation of evidence:

(The perpetuation of evidence means the preservation of the NPL data to assure that data will be available for possible use at a later trial or appeal.

For instance, an examiner finds a photo from a commercial website as reference for a design application, but there is possibility that that photo might be withdrawn from the website, so when the examiner decides to use the photo as reference, he/she has to take some steps to convince others the exact photo was really published in that website.)

|  |  |
| --- | --- |
| CNIPA | CNIPA uses the service for perpetuation of evidence |
| EUIPO | NA |
| JPO | [Magazines and brochures] The original copy of the collected published material is kept by the office.  [Internet information] Examiners print out the web page on which the cited design and its publication date are indicated, and the office keeps these hard copies. (See 4-5) |
| KIPO | The examiner uses a separate internet system from the internal network (Intranet) of KIPO and is permitted to capture and transmit the images from external internet service to the Intranet as a reference for the grounds of refusal. And all the record of the office action and the examiner's search history and the background of their judgment are stored to the Intranet for the documentation. |
| USPTO | If an examiner uses NPL, such as photo from a commercial website, the examiner does provide a copy of the NPL, which includes the photo, and information regarding the date the photo was retrieved from the website, the date of publication, and the website it was accessed from, in the Notice of References cited, which accompanies the Office action in which the NPL is cited. Regarding the steps the examiner has to take to convince others the exact photo was really published, prior art disclosures on the internet or on an online database are considered to be publicly available as of the date the item was publicly posted. Absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a)(1) and pre-AIA 35 U.S.C. 102(a) or (b). However, it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center (STIC) to find the earliest date of publication or posting. |

4-5 The practice IP office use to guarantee the security when the examiners use pictures from a publicly accessible/viewable internet website to do the examination work：

(Security: Usually examiners do examination in the intranet environment, so if IPO allows examiners to use data from a publicly accessible/viewable internet website, a linkage between intranet and internet might be established, which could raise some security concerns.)

|  |  |
| --- | --- |
| CNIPA | CNIPA separates intranet environment from internet |
| EUIPO | NA |
| JPO | For security reasons, JPO separates its internal IT system for examination work from the Internet.  When examiners cite internet information that was found through the Internet search in an office action, they print out the web page on which the cited design and its publication date are indicated, and attach a scanned copy of that web page to the office action. (See 2-4 and 4-4) |
| KIPO | The examiner uses separate systems for internal and external search, and the external reference only can be transferred to the internal system, and the opposite way is impossible. Therefore there are no security issues between the two systems. |
| USPTO | The USPTO allows examiners to access both the internet and intranet from the same computer. The USPTO has internal policies, which govern internet use by employees. See answer to 4-2 above. As long as examiners follow these rules they can utilize the internet information. Further, there has been no comparative study in the security issue mentioned above. |

4-6 Whether IP office provide the collected design NPL data to the public

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| --- | --- |
| CNIPA | NO |
| EUIPO | NO |
| JPO | JPO publishes bibliographic information of the collected NPL design data through the J-PlatPat. However, the scope of publication of image data is limited to those for which publisher’s permission has been obtained. |
| KIPO | NO. The collected NPL data is not disclosed to the public due to copyright or other issues, only used for internal purposes. |
| USPTO | NO. The USPTO does not collect or provide NPL data to the public other than individual NPL citations which are provided in each Office action, when utilized as part of the file. |