

ID5 Project Proposal

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

Lead Office: State Intellectual Property Office (SIPO)

Background

The five Partner Offices have certain diverse laws and practices regarding the priority right system for industrial designs. To better understand the difference of domestic and foreign priority right systems and satisfy the demands of applicants, an in-depth comparative study on the priority right systems for industrial designs should be conducted. With the study results, Partners will then distinctly understand the standards in regard to the priority right system.

Project Definition

The aim of the project “Study of Practices of Priority Rights for Industrial Designs by ID5 Offices” is to give a clear overview of current laws and practices of ID5 Partners’ priority right system for industrial designs. The Study will establish a catalog to summarize the similarities and differences among ID5 Partners.

Currently, the five Partner offices all have foreign priority right systems under the Paris Convention, which enable applicants to apply for a national industrial design application while claiming the benefit of the filing date of an earlier foreign application, so as to facilitate obtaining protection for the same design in different countries.

In addition, China plans to introduce domestic priority right system of design patent in the fourth modification of patent law, in order to make it possible for applicants to file applications on the basis of the previous national application. Nowadays, We know that other Partner Offices don’t have the systems called “domestic priority right”, but other systems may be used to play a similar role, such as the related design system of JPO and KIPO, the continuing application/continuation-in-part applications system of USPTO, and the application conversion system(invention patents or utility model patents are converted into design patents).Such systems enable a subsequent application to be filed on the basis of the previous national application, even if the design right of the subsequent design will not take effect retroactively to the filing date of the previous design. All the above systems are the objects of this study.

Besides those, the exhibition priority right system of EUIPO should also be considered.

For fully understanding, the contents of the project shall consist of two sessions, one is The Comparative Study of Foreign Priority Right System, the other is The Comparative Study of Relevant Systems. They should be conducted step by step. Firstly, we will focus on the Foreign Priority Right System, then the Relevant Systems. Each study should be accomplished through the comparison of current laws and practices among ID5 Partners. If necessary, practical case for analysis would be complemented. At a later stage, according to the study outcome and partners' demands, a user-friendly version of the Study outcome may be offered.

The Comparative Study of Foreign Priority Right System will compare practices in Partner Offices for applying for a national industrial design application on the basis of the earlier foreign application under the Paris Convention. The Study is divided into three parts: Formality Requirements, Procedure Requirements and Judgment of the Same Subject Matter.

The contents in the Study of Relevant System are similar with those involved in the Study of Foreign Priority Right System. They are mainly about domestic priority right of design patent in China and the Relevant Systems referred to above, including the Background and Purpose of These Systems , Formality Requirements, Procedure and Substantive Requirements, etc.

The Structure of the Study and the List of Items are found in appendix A.

The Study shall be created in collaboration with all Partners. The structure of the Study will be agreed by the Partners and each of them will provide the respective contents on its national/regional requirements. However, the Lead Office will be in charge of drafting a proposal for the structure of the Study and will act as an editorial office compiling the contributions from the Partners. The Study will be distributed among the Partners for comments. A proposed project timeline is found in Appendix B

Project Scope and Exclusions

In scope:

- Establish a catalog of the Study allowing a comparison of the differences of laws and practices for applying for a national industrial design application on the basis of the earlier foreign application under the Paris Convention among ID5 offices. If necessary, collect practice cases.

- Create a catalog to summarize the differences of laws and practices on the Relevant Systems among ID5 offices. If necessary, collect practice cases.
- According to the study outcome and Partners' demands, a user-friendly version of the Study outcome with compact and clear characteristic would be offered.

Out of Scope:

- On the basis of this enhanced knowledge the Partners may or may not decide on a later stage to strive for convergence of requirements related to priority right system, and the project do not try to give advice on changes about priority right laws and practices.
- The project does not seek to involve external users. At the present stage the Study is intended for internal use by the Partners only. At a later stage a user-friendly version of the Study may be made available to external users on the ID5 website.

Desired Outcome

The desired outcome of the Study is to enlarge and update the knowledge of each Partner about priority right laws and practices in other countries for industrial design, to enhance communication and mutual trust among ID5 offices , and also to help the users to file applications more easily and effectively

Resource

According to the workload partition of the Lead Office and Participate Offices, the Lead Office needs the effort about 0.5FTE, and other Participate Offices need the effort about 0.2FTE respectively.

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APPENDIX A

Study of Practices of Priority Rights for Industrial Designs by ID5 Offices Session one : The Comparative Study of Foreign Priority System

Study Items		
Relevant Legal Provisions		
Formality Requirements	Time Limit of Claiming Priority	
	Fee	Whether the priority fee should be paid according to the number of designs involved?
		What is the fee for each priority claim?
		What is the time limit for payment of fee?
	Declaration of Claiming Priority	Whether the declaration of claiming priority is compulsory?
		When should the declaration be submitted?
		What information should be contained in the declaration?
	A certified copy of Previous Application Documents	Whether the Copy of Previous Application Documents should be submitted?
		When should the copy be submitted?
		What are the requirements of the format of the copy?
		Whether a translation version of the copy in native language should be submitted?
Procedure Requirements	Amendment of Declaration	Whether the filling date of previous application which indicated in priority declaration may be modified?
		If possible, until when should the amendment be submitted?
		Whether the names of the countries or

		intergovernmental organizations indicated in priority declaration may be modified?
		Whether the application number of the previous application indicated in priority declaration may be modified?
	Priority Assignment	Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?
		If the applicant(s) of the subsequent application is entirely or partially different from the previous applicant(s), whether a document certifying the assignment of the right of priority is required?
		Is there any other requirements related to the applicant(s) of the subsequent application and the previous applicant(s)?
	Notifications Involved in the Priority Examination	In what condition shall the examiner invite the applicant to make amendments?
		In what condition shall the examiner issue a notification to inform the applicant that the claim is deemed to be waived?
		What is the time limit for the applicant to response to the notification?
	Restoration of Claim to Right of Priority	Please list the situations in which the applicant may request to restore the right of claiming priority?
		Please list the situations in which the right of claiming priority may not be restored?
	Withdrawal of Claim to the Right of Priority	Whether the declaration of claiming priority may be withdrawn?
Judgment of the Same Subject Matter	Principle of Judgment	

	Patent Type	If the previous application is an invention or utility model, the subsequent application is a design, whether the subsequent application may claim the priority on the basis of the previous application.
	Indication of the product	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?
	The entire and Partial Design	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 priority 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 can claim the right of priority 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 priority 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 priority of the previous application?
		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 priority?
	The Color	If the color between the previous application and the subsequent application is different, whether the subsequent application may claim the right of priority of the previous application?

	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 priority 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 priority of the previous application?
	The Type of View	If the previous application uses photograph, the subsequent application uses drawing, whether the subsequent application may claim the right of priority of the previous application?
		If the previous application uses drawing, the subsequent application uses photograph, whether the subsequent application may claim the right of priority of the previous application?
	Multiple Priorities	If the previous applications are designs of spare parts, the subsequent application is a design of a whole product containing those spare parts, whether the subsequent application may claim the right of priority of the previous application?
Others	Other Rules and Practices that not Contained in the Provisions Above	

If possible, please submit cases for explanation.

Session two : The Study of Relevant Systems

Study Items
Name of the Relevant System
Background and Purpose
Legal Provisions
The Principle of Judgment on the Subject Matter

Formality Requirements	Time Limit of Claiming Right	
	Fee	Whether the fee should be charged according to the number of designs involved?
		What is the fee for each design?
		What is the time limit for payment of fee?
	Declaration of Claiming Priority	Whether the declaration in subsequent application is compulsory?
		When shall the declaration be submitted?
		What information shall be contained in the declaration?
	Copy of Previous Application Documents	Whether the copy of previous application documents should be submitted?
		When should the copy be submitted?
		What are the requirements of the format of the copy?
	Other Requirements if There is Any.	
Procedure Requirements	Amendment or Withdrawal of Declaration	Whether the filling 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?
		Whether the declaration may be withdrawn?
	The Applicant(s) of the Subsequent Application and the Previous Applicant(s)	Whether the applicant(s) of the subsequent application shall be the same as the previous applicant(s)?
		If the applicant(s) of the subsequent application is entirely or partially different

		from the previous applicant(s), how to deal with?
	Notifications Involved in the Examination	Whether different notifications may be issued in the examination?
		In what condition shall the examiner invite the applicant to make amendments?
		In what condition shall the examiner issue a notification to inform the applicant the claim is deemed to be waived?
		What is the time limit for the applicant to response to the notification?
	Restoration of Claim to Right	Please list the situations in which the applicant may request to restore the right of claiming ?
		Please list the situations in which are not allowed for the applicant to restore the right of claiming?
	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 ?
		When the subsequent application and the previous application act their rights, do they have to be act all together ?
Judgment of the Same Subject Matter	Principle of Judgment	
	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 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?
	The entire and Partial Design	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 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?
		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?
	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?
	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?
	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?
Others	Other Rules and Practices that not Contained in the Provisions Above	

Each partner will answer the questions regarding their systems, if the questions are not related to the system, you can skip them
If possible, please submit cases for explanation.

APPENDIX B

Proposed Project Timeline

Study of Practices of Priority Rights for Industrial Designs by ID5 Offices	
February 2016	February 2016, the Lead Office submits the project proposal
May 2016	The Partners submit observations on the project proposal by 31st May 2016.
June 2016	The Lead Office collects the observations of the Partners for discussion at the mid-term meeting of the ID5.
July-August 2016	The Partners submit the amended project proposal by 1st Aug 2016
August-September 2016	The Partners submit observations on the amended project proposal by 1st Oct 2016.

2016 ID5 Annual Meeting	<p>The Lead Office collects the observations of the Partners and submits the final project proposal for approval by the Partners at the 2016 annual meeting of the ID5.</p> <p>Deliverable: Project Proposal</p>
After 2016 ID5 Annual Meeting - February 2017	<p>The Partners finish their contributions to the Study of Foreign Priority System and submit them to the Lead Office. If necessary, the Partners could submit cases for explanation.</p> <p>Deliverable: Contributions by Partners</p>
March-May 2017	<p>The Lead Office compiles the contributions from the Partners and creates a first draft of the Study which is submitted to the Partners.</p> <p>Deliverable: First draft study by Lead Office</p>
June-July 2017	<p>The first draft of the study is submitted for discussion by the Partners at the 2017 mid-term meeting of the ID5. Partners submit observations regarding the first draft before July 31st 2017.</p> <p>Deliverable: Approval of first draft at midterm meeting of ID5</p>
August- September 2017	<p>The Lead Office compiles the observations and prepares a final draft to be distributed to the Partners before ID5 Annual Meeting.</p> <p>Deliverable: Final draft of Foreign Priority Systems' Study</p>
2017 ID5 Annual Meeting	<p>The final draft of the Study is submitted for approval by the Partners at the 2017 annual meeting of the ID5.</p> <p>Deliverable: Approval of final draft at annual meeting of ID5</p>
After 2017 ID5 Annual Meeting - January 2018	<p>a user-friendly version of the Study on Foreign Priority Systems will be offered and published on the ID5 website by 1st Jan 2018. The Partners may translate the Study in their respective office languages and publish it on their own.</p> <p>Deliverable: User-friendly version of Study referred to Foreign Priority Systems</p>
January - March 2018	<p>The Partners finish their contributions to the Study of Relevant System and submit them to the Lead Office by 31st Mar 2018. If necessary, the Partners could submit cases for explanation.</p> <p>Deliverable: Contributions by Partners</p>
April -July 2018	<p>The Lead Office compiles the contributions from the Partners and creates a first draft of the Study. The first draft of the study is submitted for discussion by the Partners at the 2018 mid-term meeting of the ID5.</p>

	<p>Partners submit observations regarding the first draft before July 31st 2018.</p> <p>Deliverable: Approval of first draft at midterm meeting of ID5</p>
August- September 2018	<p>The Lead Office compiles the observations and prepares a final draft to be distributed to the Partners before ID5 Annual Meeting.</p> <p>Deliverable: Final draft of Relevant Systems' Study</p>
2018 ID5 Annual Meeting	<p>The final draft of the Study is submitted for approval by the Partners at the 2018 annual meeting of the ID5.</p> <p>Deliverable: Approval of final draft at annual meeting of ID5</p>
After 2018 ID5 Annual Meeting (tentative)	<p>If necessary, a user-friendly version of the Study will be offered and published on the ID5 website. The Partners may translate the Study in their respective office languages and publish it on their own.</p> <p>Deliverable: User-friendly version of Study</p>