REFERENCE VIEW IN DESIGN PATENT

Featured Article

In comparison with the invention and utility model patents, the design patent is relatively unique. As is well known, one of focus legal documents of a design patent is drawings or photographs. "Reference View", as a special view, is widely used in design patents. However, the legal status of the reference view has always been controversial. The following is the discussion about the legal status of reference view based on relevant provisions and cases.

I. Relevant Provisions on Legal Status of Drawings or Photographs

According to Article 27 of the new *Patent Law* (the fourth version) effective on June 1, 2021, where an application for a patent for design is filed, a request, drawings or photographs of the design and a brief explanation of the design shall be submitted; and the relevant drawings or photographs submitted by the applicant shall clearly indicate the design of the product for which patent protection is sought.

Article 64.2 of the new *Patent Law* prescribes that the extent of protection of the patent right for design shall be determined by the design of the product as shown in the drawings or photographs, and the brief explanation may be used to interpret the design of the product as shown in the drawings or photographs.

According to Rule 27.2 of the current *Implementing Regulations of the Patent Law* (corresponding to the third version of the *Patent Law*), the applicant shall, in respect of the subject matter of the product incorporating the design which is in need of protection, submit the relevant drawings or photographs.

It follows then that the *Patent Law and the Implementing Regulations of the Patent Law* both prescribe the legal status of the drawings or photographs, that is, the drawings or photographs as essential documents are used to determine the protection scope of the design patent. However, at the level of the laws and regulations, there is no further subdivision of drawings or photographs, in other words, there are not differentiated rules on the specific representation forms and corresponding legal senses of the drawings or photographs. In practice, not all drawings or photographs without exception can be used to determine the protection scope of the design patent right, for example, reference view.

II. General Requirements for Drawings or Photographs in Design Patents

In a design patent, for protecting a whole or part of a design for a product, there is no limitation to the number of the submitted drawings or photographs, as long as the submitted drawings or photographs may clearly show the claimed design for the product. The applicant is relatively free to adopt appropriate drawings or photographs according to the concrete conditions of the claimed product. For

so far as the product with a three-dimensional, in addition to six side (orthographic) views (i.e., front, back, left, right, top, and bottom views) and perspective view, if necessary, the exploded view, the cutaway view, the sectional view, the enlarged view, the view for state in variation, the reference view and so on can also be submitted for clearly showing the appearance and design information of the product.

For line drawings, it is necessary to comply with the relevant provisions on normal projection, width of lines, and section mark of the state standards of technical drawing and mechanical drawing.

For photographs, in addition to obey the provisions on normal projection, it is necessary to ensure adequately clear photographs, plain background of the photographs, no strong light, blinking, shadow, reflection, etc. Generally, the photographs should also avoid including additional inside filling or liner kept therein.

Besides line drawings and photographs, rendering drawings, just like a representation form between line drawings and photographs, may be adopted in design patent, and should also meet the above mentioned requirements related to line drawings and photographs.

III. Basis and Source of Legal Status for Reference View in Drawings or Photographs

Reference view, as a special type of drawing in design patent, is somewhat different from other formal views for determining the scope of protection, and is not strictly limited by the above general requirements for drawings and photographs. Reference view may show the claimed product itself, or further contain other contents other than the product. Thus, in practice, reference view is used more freely in a variety of forms, and thereby the examination standard about reference view is relatively lower than formal views.

According to the *Guidelines for Patent Examination,* the applicant may submit reference view, which is usually used to indicate the purpose of use, method or place of use of the product incorporating the design[1]; and the published comparative design includes reference view for state in use, even though reference view for state in use contains design which has not been claimed, the non-claimed design could be used to compare with the patent concerned to decide whether they are identical or substantially identical[2] .

Although the *Guidelines for Patent Examination* provides specific interpretations to reference view, the information conveyed by the expressions such as “usually used to” and “could be used to” looks vague and fails to reach every aspect, resulting the legal status of reference view ambiguous. The current mainstream understanding is that reference view is not a formal view, since it is usually used to indicate the purpose of use, method or place of use of the product as claimed, and assists in the classification of designed product. Further, depending on different purposes of the submitted reference views, some reference views show the design of the product itself to be protected, while some reference views not only show the product to be protected itself but also include other elements rather than the product. Generally, based on different purposes for the use of reference view, reference view may have various view names, such as, reference view for state in use, reference view for state in variation, reference view for exploded state, reference view for state in combination, reference view for showing power-on state and so forth; and, various drawn contents which are forbidden to be used in formal views, such as, hatching lines, index lines, dimension lines, text annotations, etc., may be adopted in reference view also. In principle, the contents shown in reference views, which beyond the formal views, do not belong to the scope of protection.

In the *Guidelines for Patent Infringement Determination (2017)* issued by the Beijing

1 See *Guidelines for Patent Examination,* Part I, Chapter 3, Section 4.2 “drawings or photographs”

2 See *Guidelines for Patent Examination,* Part IV, Chapter 5, Section 5 “Examination in Accordance with Article 23.1”

Higher People's Court, it is prescribed that reference view is usually used to indicate the purpose of use, method or place of use of the product incorporating the design, and may not be used to determine the protection scope of the design patent for the product with variation states[3].

Thus, with regard to the design patent for the product with variation states, the rules of adjudication determined by the Beijing Higher People's Court raises that reference view cannot be used to determine the scope of protection of the design patent right. In other words, a product may have two or more variable states, but only the state(s) shown by formal views is/are desired to be protected by the applicant, and reference view, as the name suggests, is only used for reference. According to the Beijing Higher People's Court, reference view has basically no legal effect in determination of the protection scope of the design patent with variable states.

The *Summary of the Annual Report on Intellectual Property Cases of the Supreme People's Court (2018)* publishes that reference view for state in use has a limiting effect on determination of protection scope of design patent right under certain circumstances. If there is an obvious contradiction with the brief description of the design patent without considering the influence of reference view for state in use on the protection scope of the design patent right, the People's Court should consider reference view for state in use when determining the protection scope of the design patent right.

In the *Guidelines for Handling Cases of Administrative Adjudication Concerning Patent Infringement Disputes* issued by the China National Intellectual Property Administration (CNIPA) in December 2019[4], it is pointed out, when determining the protection scope of a design patent right, the shape, pattern or color of orthographic view, perspective view, expanded view, cutaway view, sectional view, enlarged view, and view for state in variation (excluding internal structures in cutaway views, sectional views, etc.), reference view usually indicates the use, method of use or place of use of the product, and assists in determination of the protection scope of the design patent right from the perspective of the product category. The contents included in reference view but not shown in other views should be excluded. If there is a difference between reference view and other views, the content represented in the other views shall prevail. The other views except for reference view can be used to determine the shape, pattern or color of the design patent. When the classification of product cannot be determined based on the product name, the classification number, and the basic views of the product, other views of the product, especially reference view for state in use, also provide an important basis for determining the classification of product incorporating the design.

It can be seen, with the development of judicial practice, different judgment voices have emerged about reference view, that is, when determining the protection scope of the design patent right, in some specific circumferences, for example reference view of state in use may be considered rather than completely ignored.

It can be understood, from the regulations successively introduced one after another, there is still not a clear legal provision about the legal status of reference view, and a controversy is remained to some certain extent. In the practical handling of specific cases, the Court is likely to take account of the position and role of reference view in the design patent as appropriate based on the specific circumstances of the case the Court hears.

Several cases are listed below to illustrate the consideration and determination of reference view in actual cases.

3 See *Guidelines for Patent Infringement Determination (2017),* Item 92

4 See *Guidelines for Handling Cases of Administrative Adjudication Concerning Patent Infringement Disputes,* Chapter 5, Section 2 "Design Patent Infringement Determination"

IV. Case Review Related to Reference View

1. "Sofa Bed" Case

This case is a relatively earlier invalidation case for a design patent entitled sofa bed. When determining the scope of protection of this design patent, the Patent Reexamination Board and the Beijing No. 1 Intermediate People's Court (i.e., the Court of First Instance) both held that reference view for state in use should be excluded from the scope of patent protection. The second-instance judgment[5] of the Beijing Higher People's Court supported the above comment in the invalidation decision[6] and the first-instance judgment[7].

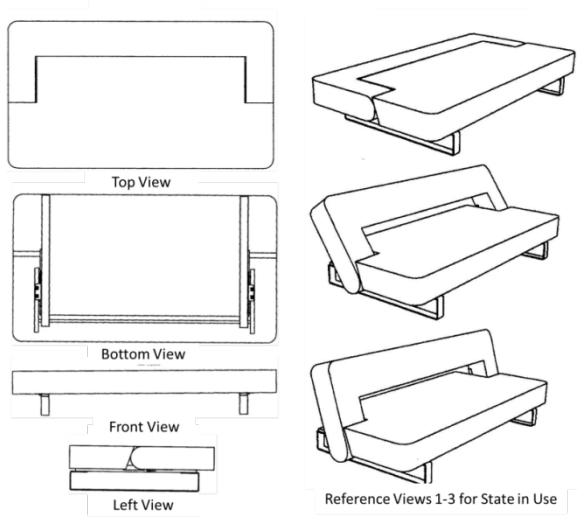

Figure 1 - Drawings of the Concerned Patent in "Sofa Bed" Case

In this case, the Beijing Higher People's Court held that reference view for state in use is generally only used to understand the use method or use of the compared design to determine the product classification, but should not be used to judge whether it is identical or similar to the previous design. As far as this patent is concerned, the product shown in front, top, left and bottom views is a bed, and thereby the protection scope of the patent should be the design of the bed as shown in these views. Although it can be known from the title "sofa bed" and the reference view for state in use in patent has two states in use, one is used as a sofa and the other is used as a bed. Since the state used as a sofa is only shown in reference views for state in use, but not shown in front, back, left, right, top, and bottom views, it should be understood that the applicant did not want to protect the design of the product as a sofa before filing the application.

Further, it is clarified in this case, when the design of product with variable states is the compared design, the comparison about the state in use should be based on the *"View for State in Use". "Reference View for State in Use"* may involve other shape, pattern or color not involved in the protection scope of the design patent; while, *"View for State in Use"* is forbidden to involve other shape, pattern or color not belonging to the protection scope. Although the difference between the both view names lies in only one word, the both views have different functions.

For this case, from the Patent Reexamination Board to the Court of First Instance and then to the Court of Second Instance, the three parties reached a consensus on the legal position and value of reference view in the design patent during the confirmation of the design patent right, i.e., reference view may not be considered when determining the protection scope of the design patent.

The very important significance of this case is that, during the confirmation procedure of the patent right, it is clarified that reference view may not be used in determination of protection scope, such that the trust interests of the public may be maintained to a certain extent at that time.

2. "Electric Retractable Door" Case

This case relates to an infringement dispute about a design patent. The concerned design patent includes front, back, left, right and perspective views, as well as two reference views

5 See the administrative judgment (2008) Gao Xing Zhong Zi No. 10, made by the Beijing Higher People's Court

6 See the invalidation decision No. 8896, made by the Patent Reexamination Board

7 See the administrative judgment (2007) Yi Zhong Xing Chu Zi No. 97, made by the Beijing No. 1 Intermediate People's Court (2007)

and thereby is omitted; and the top view is not visible in the normal state and thereby is omitted.

Figure 2 - Drawings of the Concerned Patent in "Electric Retractable Door" Case

There are two alleged infringing products in this infringement dispute, and in the evidences provided by the petitioner (i.e., the patentee of the design patent), the design features of the alleged infringing products can only be seen from the perspective of front and left views.

The Court of First Instance[8] held, in the case where the design patent is jointly determined by design features shown from multiple perspectives such as front, rear, left, right and perspective views, only by comparing the existing evidences for the alleged infringing products and the design patent, it may not draw a conclusion that the alleged infringing product is identical or similar to the design patent, so there is not an infringement.

The Court of Second Instance[9] supported the first-instance judgment that the protection scope of the concerned patent shall be determined according to front, rear, left, right and perspective views, and reference view 1 for state in use and reference view 2 for state in use may not be deemed as basis for determining the protection scope. Based on this, the comparison alleged infringing product and the design shown by front view, rear, left, right and perspective views of the design patent, so as to judge whether the designs are identical or similar.

The Court of Retrial[10] revoked the judgments of the first and second instances and pointed out whether reference view would influence the protection scope of a design patent cannot be treated as the same. The brief description has an interpretation effect on the protection scope of the design patent right, and should be combined with the drawings of the design patent so as to comprehensively understand the protection scope of the design patent.

The brief description of the concerned patent indicates that the claimed product has two different states, i.e., "normal state" and "use state". However, front, rear, left, right and perspective views of the concerned patent only show the design of the electric retractable door in a retracted state, while the design of the electric retractable door in an expanded state is only shown in reference views 1 and 2 for state in use. The normal consumers may clearly understand the product of the concerned patent has variable states when combining the brief description, the drawings and the title of the concerned patent. The reference views 1 and 2 for state in use illustrate the design of the product in the expanded state. That the reference views 1 and 2 of the concerned patent are deemed to have no effect to the protection scope would obviously contradict with the brief description of the concerned patent. To sum up, by using the brief description to interpret the design of the product shown in the drawings, the contents in the reference views 1 and 2 for state in use should be taken into consideration so as to determine the protection scope of the concerned patent. Moreover, based on the characteristics of such product, as well as the front and side views of the alleged infringing product in its expanded state, the normal consumers can reasonably presume the retracted state and the back view of the alleged infringing product, and such presumption of fact has reached a high degree of

8 See the civil judgment (2015) Yue Zhi Fa Zhuan Min Chu Zi No. 589, made by the Guangzhou Intellectual

9 See the civil judgment (2015) Yue Gao Fa Min San Zhong Zi No. 662, made by the Guangdong Higher People's Court

10 See the civil judgment (2018) Supreme Fa Min Zai No. 8, made by the Supreme People's Court

probability. After comparison, one of the two alleged infringing products falls within the protection scope of the concerned patent and constitutes an infringement.

The case broke the existing thinking inertia that reference view has no contribution to determine the protection scope of the design patent. In this case, based on the fundamental awareness of the normal consumers and the design information conveyed by the brief description of the design patent, the Court of Retrial made a comprehensive judgment, that is, in some specific cases, reference view for state in use should be considered when determining the protection scope. It can be seen, this case attempted to make a certain degree of breakthrough in aspect of the legal status of reference view, and was selected into *Summary of the Annual Report on Intellectual Property Cases of the Supreme People's Court (2018).*

3. "Running Machine with Graphical User Interface" Case

This case is an invalidation case for a design patent[11]. The concerned design patent totally includes 26 drawings, seven of which are formal views (i.e., front, back, left, right, top, bottom and perspective views) of the product design of the running machine, and nineteen of which are reference views of interface variation, and the brief description clearly states that the main points of the product involve the shapes and the graphical user interface contents on the display screen.

Figure 3 - Three drawings of the Concerned Patent in "Running Machine with Graphical User Interface" Case

In this case, the Reexamination Board determines: in combination with the product name of the concerned patent, and the above-mentioned main points of the product, as well as the relevant contents of the graphical user interfaces, the concerned patent clearly represents to include the design of the running machine involving the graphical user interface as a whole. The nineteen reference views for interface variation have apparent defects of incorrect view names, which should actually be understood as views for interface variation to be claimed. Therefore, the panel comprehensively considered the patent documents and determined that the protection scope of the design patent should jointly consider the six side views, the perspective view, and the nineteen views about the graphical user interface.

The decision of this case was made after the "Electric Retractable Door" Case. It can be seen that reference view may be identified as formal view due to obviously improper naming. It looks that the legal role of the reference view should be determined comprehensively on a case-by-case basis.

4. "Seasoning Can" Case

This case is an invalidation case for a design patent[12]. The cited comparative design in this case is a Chinese design patent filed before but published after the filing date of the concerned patent, which involves reference views.

In this case, the Reexamination Board pointed out that the comparative design shows that components 1 to 4 can be separated from component 5, and the reference views for state in combination show an arrangement of components 1 to 4 in combination with component 5. However, it can be conceived that there are multiple combinations of components 1 to 4 and component 5, and the multiple combinations should include the same arrangement as that shown in the concerned

11 See the invalidation decision No. 43456, made by the Patent Reexamination Board

12 See the invalidation decision No. 23266, made by the Patent Reexamination Board

design will present the same visual effect as the concerned patent. Therefore, the concerned patent and the comparative design relate to the same design, and the comparative design constitutes a conflicting application of the concerned patent.

As far as this case is concerned, when judging whether an earlier design patent used as a comparative design constitutes a conflicting application for the concerned patent, the entire contents of the earlier design patent should be used as the basis for judgment. Although the reference views in the earlier application do not belong to the protection scope, the reference views are still taken into account when comparing with the concerned patent.

Figure 4 - Drawings of the Concerned Patent in "Seasoning Can" Case

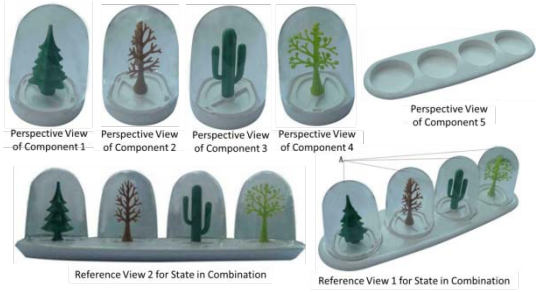

Figure 5 - Drawings of the Conflicting Application Cited in "Seasoning Can" Case

5. "Handle" Case

This case relates to an infringement dispute about a design patent, and has the same effect as the aforementioned "Seasoning Can" Case in the use of reference view.

In this case, the accused infringer cited an earlier Chinese design patent filed before but published after the filing date of the concerned patent, as a conflicting application. The design of the product shown in the reference view for state in use in the conflicting application is substantively identical to the alleged infringing product. Finally, the accused infringer's non-infringement defense by using the design in the conflicting application is established, so the infringement was not established. In this case, the claim of using the conflicting application for non-infringement defense was supported by the first instance[13], the second instance[14] and the retrial[15].

Figure 6 - Drawings of the Concerned Patent in "Handle" Case

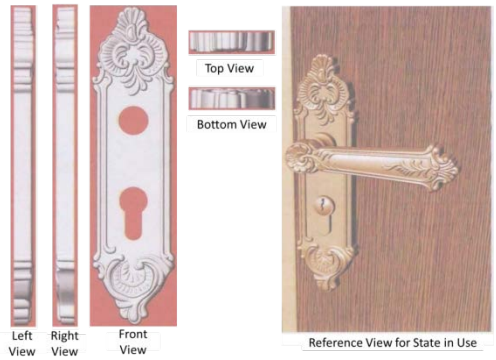

Figure 7 - Drawings of the Conflicting Application Cited in "Handle" Case

From the author's point of view, the legislative intent of conflicting application is mainly to reflect the principle of first-to-file principle, while avoiding repeated granting. Although the reference view is not necessarily considered to be part of the protection scope of the conflicting application, the information disclosed therein is actual contents of the conflicting application, and can thereby destroy the novelty of the later filed application based on the first-to-file principle.

13 See the civil judgment (2014) Hu Yi Zhong Min Wu (Zhi) Chu Zi No. 20, made by the Shanghai No. 1 Intermediate People's Court

14 See the civil judgment (2014) Hu Gao Min San (Zhi) Zhong Zi No. 52, made by the Shanghai Higher People's Court

15 See the Civil Ruling (2014) Minshen Zi No. 1772, made by the Supreme People's Court

V. Inspirations from Administrative and Judicial Practices to Use of Reference View in Design Application

Through the review of the above cases, the drawings named "reference view" in a design patent might have the same legal status as formal views under certain circumstances.

Usually, the patentee does not want to bring the design shown in reference view into the patent protection scope, such that there is a high probability that the design shown in reference view, which is not shown by the formal views, will be considered as a contribution, does not belong to the protection scope, and has no legal restriction to the third parties. However, the legal status of reference view is not a one-size-fits-all approach and should be determined according to the specific circumstances and other information in the design patent.

From the author's point of view, the original legislative intention of reference view is for use of reference, not to limit the protection scope of the design. As part of the original disclosure, it can be used against third parties to obtain a design patent right later which is identical or substantively identical to the disclosure; and only in some certain cases, reference view might have the same legal status of formal views. It is recommended that, after the protection scope to be claimed is determined, the use of reference view may be considered as appropriate in the following (but non-exhaustive) situations.

1. It is necessary to indicate the purpose, use method, use place, use scenario, etc. of the product to be claimed;
2. It is necessary to represent elements other than the claimed design;
3. It is necessary to display or explain the special parts of the product;
4. The special material of the product needs to be explained;
5. For products with variation states, the applicant wants to show the changing process or trend, but does not want to protect the relevant state of the changing process or trend;
6. In the GUI application, since some images in the interface is expressed for example by means of color blocks, it is necessary to show the concrete image by referring to reference view to facilitate understanding; and so on.

In short, in order to prevent the adverse consequences caused by the improper use of view name, please do not ignore or underestimate the legal sense and practical role of reference view. When preparing a design application, it is necessary to rationally determine the application strategy, clarify the expected protection scope, correctly use the view names, and if necessary, lay out the information to be disclosed in reference view, so as to achieve a multiplier effect during potential invalidation and infringement procedures.

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