

# NEWSLETTER

## 知产快报

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## Latest Developments of Chinese Design Patent Practices in 2019

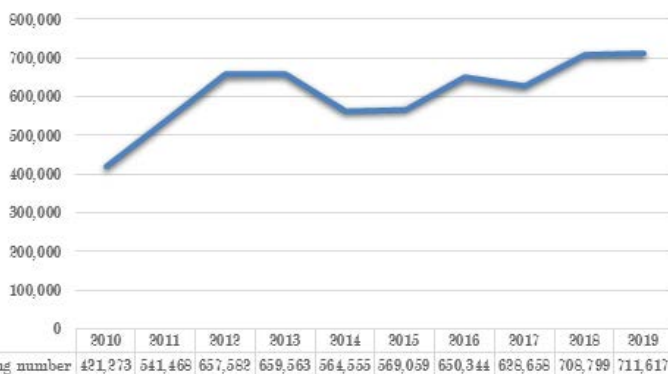
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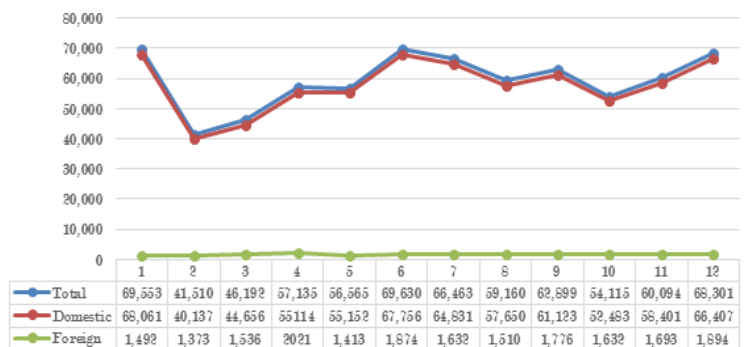
### I. Data of Chinese Design Applications Filed in 2019<sup>1</sup>

In the recent several years, the total numbers of Chinese patent applications have continued to lead the world. In 2019, in spite of the slight decline in the number of Chinese invention applications, the filing number of utility model applications and the filing number of design applications each is still keeping growth.

The graph below shows the overall situations of Chinese design applications filed in the past ten years from 2010 to 2019. As can be seen from this graph, the total number of Chinese design applications filed in 2019 reaches a record high.



Another graph below shows the situations of design applications monthly filed by Chinese and foreign applicants from January to December in 2019.



According to the official data, in 2019, the number of design applications filed by Chinese applicants and the number of design applications filed by foreign applicants each reached a record high (the specific data are not provided herewith). While, from the total filing number and the filing numbers for the Chinese and foreign applicants per month in 2019, it can be seen that the main contributors to the increasing Chinese design filing number in 2019 are Chinese domestic applicants.

From these data, it also shows, although China is a big manufacturing country, more and more Chinese enterprises have begun to attach importance to research and development of products, going from "Made in China" to "Created in China".

### II. Impacts of Amendments to the Guidelines for Patent Examination in 2019 on Design Patents

Although the fourth revision of the Chinese Patent Law has not yet been determined, under

<sup>1</sup> Data source: CNIPO's official website, <http://www.cnipo.gov.cn/>.

the needs of the rapid development of new technologies, China National Intellectual Property Administration (“CNIPA”) summed up the beneficial experiences in the examination work during recent several years and announced to implement the revised Guidelines for Patent Examination<sup>2</sup> from November 1, 2019, for clarifying and optimizing the unclear contents in the existing regulations so as to respond to the new demands concerning examination rules and examination modes raised by the innovation subjects.

### *1. Amendments directly aiming to the design patents in the Guidelines for Patent Examination*

With the acceleration of the process of informatization, digitization and intelligence, electronic products have increasingly affected people's lives, and graphical user interfaces (hereinafter referred to as "GUIs") have occupied a place in product design. Under the background of the strong need for protections of GUIs at present, in view that the GUI itself has unique product features, one of the major revisions of the Guidelines for Patent Examination relates to design applications involving GUIs (hereinafter referred to as “GUI designs”), mainly prescribing how to prepare the submission documents thereof so as to improve relevant examination rules. Hereafter, the specific revision contents would be introduced.

(1) The amendments provide the definition of GUI design in the Chinese patent system

According to the amendments of the Guidelines for Patent Examination, GUI design is defined as such a design of a product whose essential design features include a graphical user interface. Before this, there was no official definition and interpretation about GUI design per se.

(2) The amendments standardize the title of the product incorporating GUI design.

According to the amendments of the Guidelines for Patent Examination, for the design relative to non-dynamic GUI, its product title should include at least three elements, they are:

<sup>2</sup> Announcement of the National Intellectual Property Administration for Amending the Guidelines for Patent Examination (No. 328), [http://www.gov.cn/xinwen/2019-09/26/content\\_5433360.htm](http://www.gov.cn/xinwen/2019-09/26/content_5433360.htm).

① the name of the relevant product to which the GUI is applied to; ② the keyword such as “graphical user interface” or “GUI”; and ③ the main use purpose of the GUI.

While, for the design relative to dynamic GUI, its product title should include at least four elements, they are: ① the name of the relevant product to which the GUI is applied to; ② the keyword such as “graphical user interface” or “GUI”; ③ the main use purpose of the GUI; and ④ the keyword such as “dynamic”. In other words, in addition to the three-element requirement of the product title for non-dynamic GUI design, the product title for dynamic GUI design should further include the keyword “dynamic” or the like.

(3) The amendments provide minimum requirements to the drawings or photographs of GUI design application.

In the case that the essential features of a design application only lie in GUI, at least one orthographic view of a display screen panel containing the GUI should be submitted. If it is necessary to clearly show the size, position and scale of the GUI with respect to the final product, the orthographic view of the side of the final product concerning the GUI should be submitted.

If the GUI design is dynamic, at least one state of the orthographic view concerning GUI should be filed as front view. For the remaining state(s), the view(s) of the key frame of the GUI may be submitted as variation state view(s), and the submitted view(s) should be able to uniquely determine the complete changing process of the animation in the dynamic patterns. Marking variation state view(s) should follow the order of the dynamic changing process.

Regarding the GUI for operating a projection device, in which case the GUI and the device are relatively separated, in addition to the view(s) of the GUI, at least one view for clearly showing the projection device should be submitted.

These provisions avoid the applicant from having to submit a set of relative views of the product, i.e., the GUI design carrier, which might belong to a prior design, when the applicant files a GUI design application. Thus, it is tended to take another way to achieve similar effects to the partial design system which is not applicable in

China at present. Furthermore, the above provisions also help to clarify the substantive protection contents and thereby the protection scopes of GUI designs.

(4) The amendments standardize how to draft the brief description of GUI design application.

Concerning a GUI design, the use purpose of GUI should be clearly stated in the brief explanation and corresponds to the purpose reflected in the product title.

If only an orthographic view of a display screen panel containing GUI is submitted, the final products, to which the display screen panel containing GUI is applied to, should be exhaustive to list.

If necessary, the area of the GUI on the product, the human-computer interaction way of GUI, and the changing process of GUI should be described in the brief explanation.

In the author's view, the above-mentioned provisions of the brief description may help to clarify the protect scope of the object to be claimed in the subsequent invalidation or infringement procedure (if any), such that the granted design shown in the drawings can be more objectively evaluated and judged.

*2. Available examination orders proposed by the amendments of the Guidelines for Patent Examination also provide impacts on design patent.*

The amendments to the Guidelines for Patent Examination specify four kinds of examination orders for invention, utility model and design, i.e., general principle, prioritized examination, delayed examination, and substantive examination initiated by CNIPA. For design applications, the first three orders are available.

#### (1) General principle

A Chinese design application can be authorized after passing the preliminary examination. Thus, generally, the preliminary examination order of design applications should follow the order of filing.

#### (2) Prioritized examination

For design applications, which are relative to the industries importantly developed or encouraged by the state or local governments, are of great significance to the national or public interests, or have certain needs in market activities or the like, the applicants may request prioritized examinations, and after approval, the relevant examination procedures would be prioritized.

Under prioritized examination, the examination process of the prioritizedly-examined design application is expected to be finished within two months, and the finishing date is the date on which the examiner issues a notice of authorization or issues a rejection decision. In the reexamination process after rejection, there is no prioritized reexamination process for design applications. However, there is a prioritized process in an invalidation process for a design patent, and the accelerated invalidation cases relative to the design patents are expected to be completed within four months.

In the present examination practice, when a design application is during a prioritized preliminary examination period, the specified time limit for the applicant to respond to an Office Action/Notification is only fifteen days from the "issue date", which is the date indicated on the Office Action/Notification. While, the specified time limit for responding to the Office Action/Notification during a prioritized invalidation period is as same as that in a common case.

Further, for a prioritizedly-examined design application, any voluntary amendment or any deferred response thereto would result in the termination of the prioritized examination process. After that, the application will be proceeded with according to common process.

#### (3) Delayed examination

It is possible to file a request of deferred examination for a design application at the time when filing the design application. The delayed period may be 1 year, 2 years or 3 years from the effective date of the deferred examination request. After the deferred period has expired, the application will be examined in order. When necessary, the CNIPA may initiate the examination procedure on its own and notify the

applicant that the delayed examination period requested by the applicant is terminated.

At present, the deferred examination system, as a new system, has not yet established withdrawal procedures, announcement procedures, special third-party opposition procedures etc.

*3. The amendments of the Guidelines for Patent Examination about the timing of passively filing another divisional application based on an existing divisional application also apply to design applications.*

Concretely, when an examiner raises a unity objection against an existing divisional application, another divisional application may be filed during the mentioned divisional application is still pending.

In addition, the applicant(s) for a divisional application must be the same as the one(s) for its basic application when the divisional application is filed. Otherwise, the divisional application would be deemed not to be filed.

*4. The examination ways for multiple combination modes in prior art during invalidation procedures proposed by the amendments of the Guidelines for Patent Examination are also available to design patents.*

In order to reduce the burdens of the relevant parties and the panels and to make the invalidation examination more targeted and more efficient, when, in the invalidation procedure of design patents, there are for example multiple prior designs as well as multiple combination and comparison ways submitted for challenging inventiveness, the most important combination and the closest prior design should be specified as main combination. If the main combination is not specified, the first combination of prior designs mentioned in the invalidation request would be the most important combination by default.

Although the panels will examine all the combinations, the specified most important combination will be the key point of the examination during the oral hearing, and the examination decision will focus on the most

important combination and provide brief comments about other evidence combinations.













### **III. Enlightenment from the Announced Design Case in the Gazette of the Supreme People's Court in 2019**

The cases announced in the Gazette of the Supreme People's Court relate to typical cases of various legal cases that are formally selected by the Supreme People's Court under applicable laws and judicial interpretations, and thereby are very authoritative, professional and instructive.

In the Gazette of the Supreme People's Court in 2019, totally 38 typical cases are announced, in which there is one design patent infringement dispute case of Shanghai M&G Chenguang Stationery Inc. ("Chenguang") v. Deli Group Co., Ltd. et al. ("Deli et al.") relative to a design patent ZL200930231150.3 entitled "Pen (AGP67101)". This infringement dispute case was also selected as one of typical cases of the Shanghai Intellectual Property Court in 2016.

The scenario of this case is:

On January 21, 2016, Chenguang as the plaintiff conducted a lawsuit with the Shanghai Intellectual Property Court, suing Deli et al. infringing its patent right by manufacturing or selling Deli A32160 gel pens (i.e., the alleged infringing product) which belong to the same design as the design patent ZL200930231150.3 (CN301291375S). As one of the defendants, Deli submitted a request for invalidating the concerned patent to the Patent Reexamination Board ("PRB") of the State Intellectual Property Office on March 18, 2016, based on the ground that the concerned patent is substantively identical to the prior design CN300885158D and therefore does not meet the novelty requirement of Article 23.1 of the Patent Law. In the invalidation case, the PRB did not support Deli's claims and ultimately made a decision that the whole patent right is valid. And, the Shanghai Intellectual Property Court made a judgment that Deli et al. infringed the concerned design patent and should bear the corresponding civil liability.

Concerned Patent	Invalidation Phase Prior Design CN300885158D	Infringement Phase Infringing Product Deli A32160 gel pen
		
		
		
		
Comparison Conclusion	Since two designs are not substantively same, the invalidation ground is not supported, and thereby the patent right remains valid.	There exists patent infringement.

The product design protected by the Chinese patent law includes three design elements, i.e., shape, pattern and color. Generally, the judgment of whether a design is same as or similar to a comparative design is a comprehensive judgment of the shape, pattern, and color design of the same or similar products. However, due to the stronger subjectivity of such judgment, determination of identity or similarity often faces dilemmas in invalidation or infringement procedures.

The significance of this typical case is how to apply the principle of "overall observation and comprehensive judgment".

The essential features of the concerned patent lie in the shape of the product. During the invalidation process, the essential features of the cited comparative design also lie in the shape. The PRB mainly compared the shapes of the pen holder as well as the pen cap with the pen clip thereon, which are deemed easily attract the attention of ordinary consumers, and then made a decision that the design patent and the comparative design are substantially different.

In the corresponding infringement litigation case, the alleged infringing product was a real product with design elements involving shape, pattern and color. In the process of infringement comparison, how to conduct "overall observation" and how to make "comprehensive judgment" become a key to the case judgment. In the infringement judgment of this case, the concerned design and the alleged infringing product were considered in terms of the shapes of the main body of the pen holder, tip of the pen holder, main body of the pen cap and tip of the pen cap, the proportion of the length of the pen cap relative to the pen holder, the connection mode between the pen clip and the pen cap, the length of the pen clip extending out of the pen cap and so on, and it was found finally that the alleged infringing product has the similar design style with the patented design in shape as a whole. In the meantime, the pattern and color of the alleged infringing product are only deemed as additional design elements based on the patented design.

Thus, the referee summary of this infringement dispute case is: the judgment principle of "overall observation and

comprehensive judgment" should be followed when judging similarity of designs. In the specific case, the identical and different features between an alleged infringing design and a patented design should be examined, from which the objective analysis of the overall visual effects should be conducted so as to avoid the influence of subjective factors. Where any person implements the patented design without any creative effort by simply changing or adding design elements as well as patterns and colors, which are not substantial differences from the patented design, such behaviors constitute an infringement on the design patent right.

The enlightenment of this typical case is that, for design patents that do not include color and pattern in the protection scope (that is, the essential features of the design patents only lie in shapes thereof), the design elements of the alleged infringing product such as color and pattern are additional design elements on the infringed design, do not provide substantial impacts on the judgment of infringement, and thereby should be excluded from consideration.

It is to prevent infringers from adding additional design elements such as patterns, colors, etc. to go around patent infringements.

#### IV. Summary

Design patent is an important type of intellectual property rights, has dual characteristics of artistry and practicability, and can stimulate consumers' purchase desires through different design styles such as creativity, aesthetics, uniqueness, decoration or the like. With the high-quality development in the field of product design, the Chinese design protection system and corresponding judicial practices are continuously improved, and the adjudication standards are becoming clearer and clearer. It is believed, after the fourth amendment of the Chinese Patent Law is determined and implemented, the Chinese design patent system will be much closer to the international standards and play a more important and positive role in the Chinese market.

*The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.*

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Ms. Yan Huang has expertise in patent drafting, patent prosecution, patent reexamination, patent invalidity, patent litigation, patent due diligence and freedom to operate investigation, patent layout, patent analysis, etc., she handled a large number of cases of domestic and foreign clients, and is very experienced in patent legal services in the fields of mechanical engineering and mechanical automation, such as, home appliances, engineering mechanics, automation manufacture, semiconductors, printing facilities, paper apparatuses, medical devices, computer equipment and so forth. Ms. Huang joined Lung Tin in February 2002, and has participated in many important and difficult cases.

Ms. Huang was licensed to practice as a Chinese Patent Attorney in 2007 and was appointed as a patent litigation attorney by the Supreme People's Court in 2013.