



Featured Article

PARTIAL DESIGN APPLICATIONS BEING NO LONGER "LOOKING AT FLOWERS IN THE FOG"

—Stage reviews based on current partial design examination opinions

In order to continuously adapt to the development of social economy and the requirements of innovation subjects, and to bring the Chinese patent system more to be in line with international practices, one of the highlights of the new Patent Law (fourth version) effective since June 1, 2021 relates to the reform of the design patent system, especially introducing partial design as eligible object for design patent protection¹. The protection for partial design helps to clarify the design locations and contents, making the claimed protection scope for the target design more accurate, and easier to remove interfering factors so as to facilitate more objective judgments in the invalidation and infringement of the rights.

Although the corresponding implementation rules and examination guidelines for the new Patent Law have not yet been issued, and how to prepare partial design applications was once in a state of "looking at flowers in the fog", recently, the China National Intellectual Property Administration ("CNIPA")

1. "Design" means a new design of the shape, pattern, or a combination thereof, as well as a combination of the color with shape and/or pattern, of the entirety or a portion of a product, which creates an aesthetic feeling and is fit for industrial application.

has started the examination of partial design applications and issued corresponding rectification notifications/office actions (hereinafter collectively referred to as "examination opinions"), and even a number of partial design applications have passed through the preliminary examinations and authorized to announce, all of which make the author have a feeling of "dispelling the clouds to see the sun".

Based on the arrangement of common problems about "brief description" and "drawings or photographs" raised in examination opinions for a number of partial design cases as mentioned below, it is hopeful that, at least before the official implementation rules and examination guidelines are issued, the prepared documents for partial design applications to be submitted may conform to the current examination practices to the greatest extent, and the frequency of receiving examination opinions may be lowered as much as possible for speeding up the examination procedure, such that not only the consumption of administrative resources may be reduced to some extent, but also the time and economic costs brought to the applicants may be decreased to a certain degree so as to protect the rights and interests of the applicants.

I. Brief Description of Partial Design Application

As we all know, the brief description of the design patent should contain at least the title of the product incorporating the design, the usage of the product incorporating the design, the design points of the design application, and a representative view for best showing the design points. For partial design applications, the following requirements are usually set forth in the current examination opinions in aspects to the title, the usage, and the design points.

1. Title of the Product Incorporating the Partial Design

From the current examination opinions, the title of the product incorporating the partial design needs to reflect both the whole of the product and the part of the product to be protected, i.e., the title needs to clearly express the claimed part of the product in combination with drawings or photographs.

Usually, the expression of the title may be "the name of the entire article" plus "the name of the claimed part in the article", "the name of the entire article" plus "the position of the claimed part in the article", "the name of the entire article" plus "main body" or the like.

For example, if the designed portion to be protected is a base of a television set (TV), and the drawings or photographs show a television as a whole, and only the base

thereof is the claimed part for example drawn with solid lines, the title of the partial design application may be named as "Base of TV" or "TV base"; while, it is not advisable to independently name the title only as the name of the entire article or only as the name of the claimed part in the article, for example, "TV" or "Base", since there would be a high probability that the CNIPA issues an examination opinion that the title of the product incorporating the partial design does not clearly indicate the claimed part and thereby does not meet the requirements of, for example, Rule 16² of the Implementing Regulations of the Patent Law.

While, for partial design application of Graphical User Interface ("GUI"), it is temporarily allowed to replace the keyword "display screen panel" with "electronic device" in the title, and at the same time, the title should include not only the keyword "graphical user interface" with a certain function but also the specific name of the part of the interface to be protected, for example, "search bar of mobile payment graphical user interface of electronic device".

2. Rule 16 of the Current Implementing Regulations of the Patent Law: The request of application for patent for invention, utility or design shall state the following: (1) the title of the invention, utility model or design; ...”

3. Rule 28 of the Implementing Regulations of the Patent Law in a certain suggested version: The brief description of application for patent for design shall indicate the title and the use of the product

2. Usage of the Product Incorporating the Partial Design

Regarding the usage of the product incorporating the partial design, although there are somewhat differences among the current examination opinions, it is usually required to indicate at least the usage of the claimed part of the product, otherwise it would be considered to not meet the requirements of, for example, Rule 28³ of the Implementing Regulations of the Patent Law. In the author’ s opinion, it is advisable to clearly state the usage of the whole product and the usage of the claimed part in the brief description.

For example, the usage of the product incorporating the partial design can be written as follows: the whole product is used for ..., and the claimed part of the product is used for When drafting the usage, please note that the expressions of the entire article and the claimed part thereof should correspond to those in the title of the product incorporating the partial design, otherwise, it will be considered unclear.

incorporating the design, and designate a drawing or photograph capable of best showing the essential feature of the design. Where a view of the product incorporating the design is omitted or where concurrent protection for color is claimed, it shall be indicated in the brief explanation.... If a partial design application is filed, the part to be protected shall be indicated in the brief description if necessary.

For the case where the title of the GUI partial design application contains "electronic device" instead of the keyword "display screen panel", at present, it is not necessary to exhaustively list the final products to which the GUI display screen panel is applied.

3. Design Points of the Partial Design

Since the original intention of the partial design application is to protect the claimed part, the design points of the partial design application should only lie in the part to be protected according to Rule 28 of the Implementing Regulations of the Patent Law.

In other words, the description of the design points can follow the way of the entire design application to specify the design elements (shape, pattern, color or its combination) of the claimed part of the product, and reflect the design points aiming to the claimed part of the product, for example, the design point of a partial design application lies in the combination of the shape and the pattern of the claimed

part of the product, the design point of the partial design application lies in "the shape shown with the solid lines" if the views are drawn by using the combination of solid and broken lines, etc.

4. Necessary Supplementary Explanation of the Partial Design

According to Article 1⁴ of the "Notice of the China National Intellectual Property Administration on the Interim Measures for the Implementation of the Revised Patent Law (No. 510)" (hereinafter referred to as "interim measures No. 510") effective since January 11, 2023, for partial designs represented in a manner other than the combination of solid and broken lines, the claimed part should be stated in the brief description. For example, when a partial design application is represented by shading with semi-transparent color blocks to distinguish the claimed and unclaimed parts of the product, or by combination of solid and broken lines together with other ways (such as, cycling with dotted line, covering with color blocks, etc.) to indicate the claimed and unclaimed

4. Article 1 of the Notice of the China National Intellectual Property Administration on the Interim Measures for the Implementation of the Revised Patent Law (No. 510): From June 1, 2021 (including the date, the same below), the patent applicant may submit an application for a patent for partial design of the product to be protected in paper form or electronic form in accordance with Article 2, paragraph 4, of the Patent Law.

Where an applicant files an application for patent for partial design, the applicant shall submit views of the

whole product, and indicate the content to be protected by combining the solid and dashed or by other means. If the part to be protected contains a three-dimensional shape, the submitted views shall include a perspective view that can clearly show the part; if the contents that need to be protected are not indicated in the view of the whole product by using solid and dashed lines, the part that requires protection shall be clearly stated in the brief description.

parts of the product, it is necessary to provide an auxiliary explanation in the brief description to clarify the scope of the claimed part.

II. Matters Needing Attention in Drawings or Photographs of Partial Design

First of all, according to "No. 510 provisional measures", in a partial design application, it is needed to submit the views for showing the whole product, in which the claimed part of the product is required to indicate through a combination of solid and broken lines or through other ways. If the claimed part of the product contains a three-dimensional shape, the views to be submitted should include perspective view(s) for clearly showing the claimed part.

From current examination practices, the drafting ways for partial designs are relatively open and friendly for the applicants. The applicants can choose the drafting ways for clearly indicating the claimed part according to the local portion(s) of the product. However, special attention should be paid to the fact that the boundaries between the claimed part and the unclaimed part need to be clearly shown, and the boundaries reflected in each view should be consistent; otherwise, there might be a problem of non-clarity.

In addition, not only the claimed part(s) but also the unclaimed part(s) need to be

made in accordance with the provisions of the state standards of technical drawing and mechanical drawing, such as the correct normal projection between the views one another, consistent line width, etc., except for the special drafting modes, such as broken lines, dotted lines, color blocks or the like used for distinguishing the claimed part and the unclaimed part. That is, the drawing requirements or standards for the unclaimed part of the product would not be lowered simply although the unclaimed part of the product is not required to protect.

1. Drafting Mode of Combination of only Solid and Broken Lines

According to the existing experiences for partial design applications, in addition to the fact that the claimed part is drawn with solid lines and the unclaimed part is drawn with broken lines, drawing with both solid lines and broken lines should meet the same drawing requirements or standards, such as, correct orthographic relationship, consistent line width and line depth; clearly visible solid lines and broken lines, all lines not crowded and being recognizable; etc.

Thus, do not irregularly and incorrectly draft the unclaimed part in broken lines because the part is not protected and then is belittled, which may lead to defect of unclarity, and let the applicant even face the dilemma in making modifications difficultly.

2. Drafting Mode of Covering with Semi-transparent Color Block

According to current practice, semi-transparent color blocks may be used to cover the unclaimed part for representing the part not be protected; however, the uncovered and covered parts of the product in all views (i.e., the claimed part without blocks and the unclaimed part with blocks) need to be consistent with each other, otherwise there would be an issue of unclear protection scope.

3. Drafting Mode of Combination of Solid and Broken Lines together with other Drawing Way(s)

For some partial design applications, it may be hard to represent the claimed and unclaimed parts of the product by combination of only solid and broken lines, and thereby it is necessary to illustrate the claimed part or the unclaimed part by further combining other ways (such as, covering, boundaries, or the like).

For example, if it is necessary to cycle the claimed part to indicate the boundaries between the claimed part and the unclaimed part so as to clearly distinguish the both, it is advised to use dotted lines, which is different from solid and broken lines and would not lead to any confusion with contour lines shown by solid and broken lines, and make the boundaries cycled by the dotted lines consistent in all side views and perspective views, for ensuring the claimed part clear enough.

In fact, in addition to the drafting mode of combination of solid and broken lines together with other drawing way(s), the drafting mode of covering with semi-transparent color block can also be used together with other drawing way(s), depending upon the specific cases.

In short, no matter what expression form the drawing or photographs in partial design application is adopted, the basic requirement is to clearly and correctly present the relevant part of the product to be protected, otherwise it may cause substantive defects which can not be effectively overcome.

Conclusion

Before the issuance of the new implementation rules and examination guidelines, the regulatory requirements on the partial design application are likely to be improved dynamically.

At present, in practical operation, there are indeed some uncertain problems resulting somewhat confusion, for example: under what circumstances there is a possibility to change solid and broken lines with each other; how to identify that the claimed part is relatively independent or can constitute a relatively complete unit and thereby is an eligible subject matter; whether there is a logical contradiction between the fact that the whole design and the partial design are refused to be submitted in one design application and the fact that the whole design and the partial design respectively

submitted in separate design applications are deemed to be substantially same; etc.

Thus, the above information is arranged only for work reference at this stage before the introduction of the new regulations and guidelines. It is hopeful that the above practical information can assist the

applicants to prepare documents for partial design applications, which may meet the practical requirements to a certain extent. The author will continue to pay attention to and track the latest trends about the partial design protection system, and continue to share updates (if any) with you when appropriate.

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If you need special legal opinions, please consult our professional consultants and lawyers.

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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.