

**INTERNATIONAL INDUSTRIAL DESIGN PROTECTION:
Priority application preparation and downstream considerations**

Stuart Irvine, FPA Patent Attorneys Pty Ltd
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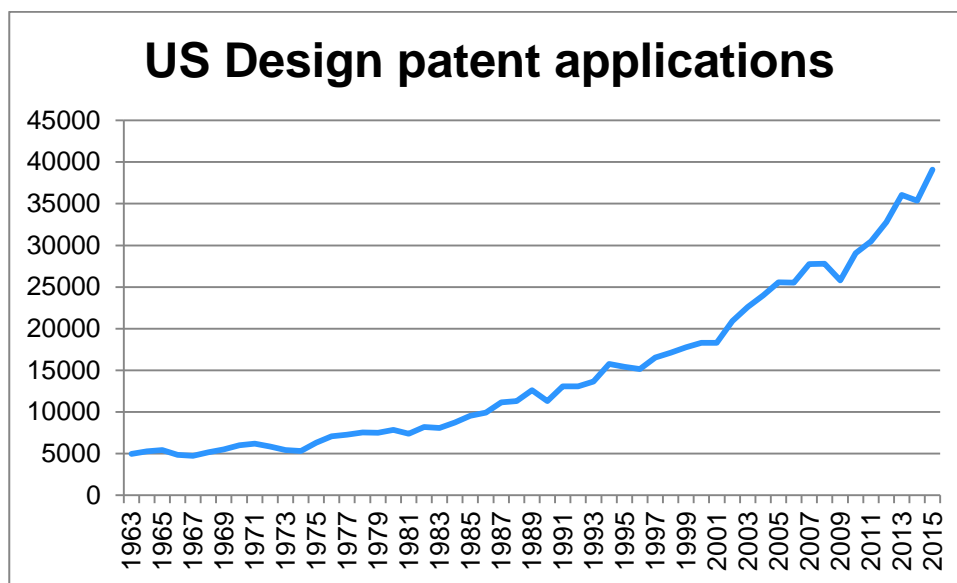
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I. Introduction

In recent years the attention paid to industrial design has increased. Functionality is no longer enough, with consumers increasingly wanting products that are also stylish and aesthetically beautiful.

This increased attention has seen a matching increase in registered design right activity. At least in the US context, this increased activity can very easily be seen by looking at design patent filings¹:



Internationally, Design rights are provided for by the Paris Convention (with 177 contracting parties) and the Hague agreement (67 contracting parties).

Despite these international agreements there is a significant lack of harmonization in the treatment of registered design rights. This is not unexpected, and is of course also true for utility patents – but the lack of conformity is perhaps even more pronounced for design rights.

The purpose of this paper is to flag and briefly discuss various areas in which design laws can differ rather than provide a substantive analysis on each and every issue. As always, local attorneys in the jurisdictions of interest will always be the best guide, however hopefully this paper will assist practitioners to look forward early in the application process and either avoid potential downstream issues or, at the least, be in a position to deal with them as efficiently as possible.

¹ Based on design patent application numbers from USPTO: U.S. Patent Statistics Chart Calendar Years 1963 – 2015": https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm. Accessed 21 March 2018.

This paper is separated into two main sections. The first section deals with design drawings and jurisdictional differences which – where possible – should be considered during the preparation of a priority design application. The second section briefly looks at differences which may be relevant when choosing to file in a particular jurisdiction, but that do not typically impact the manner in which a priority application is prepared.

The authors are registered Australian and New Zealand patent attorneys. Where possible, reference to the laws and practice of various foreign jurisdictions are provided by way of illustration. Every effort has been made to ensure these examples are accurate, but it is always possible that subtleties and nuances of foreign law may be overlooked and, of course, that laws change.

II. Registered design rights

By way of a very high level introduction, a registered design protects the appearance of an article of manufacture or product. The appearance of an article arises out of visual features which may include three dimensional features (such as shape and configuration) and/or two dimensional features (such as pattern and ornamentation).

Registered design rights bear many similarities to utility patent rights. There are often procedural commonalities and, at least at a high level, analogous considerations of novelty/obviousness in light of prior art.

Registered designs are covered by Section 4 of the Paris convention which provides that:

4(A)(1) Any person who has duly filed an application ... for the registration of ... an industrial design... , in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

4(C)(1) The periods of priority referred to above shall be ... six months for industrial designs

In addition to registered design rights, some jurisdictions (e.g. Europe) also provide for unregistered design rights – these are not covered by this paper.

III. Drawing considerations

This section outlines various considerations to be taken into account when preparing drawing for a design application.

This is not, of course, an exhaustive list of all issues that can arise in all jurisdictions. Rather, it is an overview of some of the more common issues.

From this section it will become apparent that there are, in many cases, advantages to filing a priority application that includes additional embodiments or representations to those required in the jurisdiction the priority application is filed in. Considerations surrounding the inclusion of such additional embodiments/representations in a priority application are discussed at the end of this section.

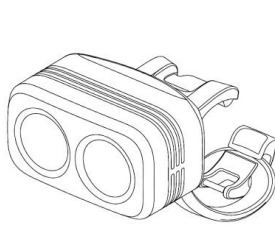
A. General drawing requirements

The general requirement is that a design application includes reproducible drawings that clearly show the visual features for which protection is sought.

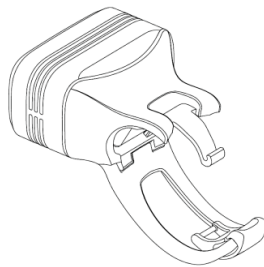
The typical starting point for a design application is a set of line drawings that illustrate all aspects of a product. For example, consider the Knog® Blinder Road 250 product:



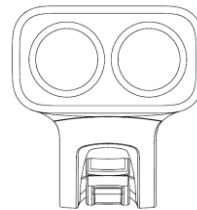
Typical design drawings for this product would be (and are)²:



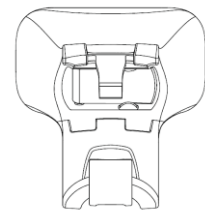
Front perspective view



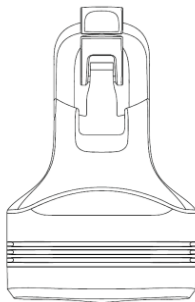
Rear perspective view



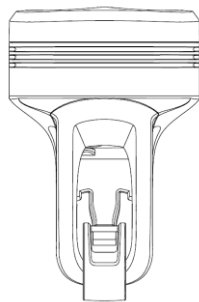
Front view



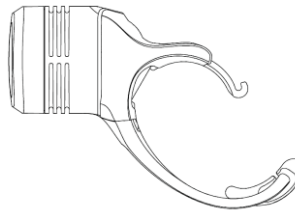
Rear view



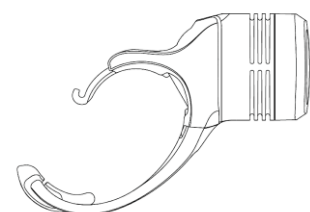
Top view



Bottom view



Right side view



Left side view

² Chinese design ZL201330209980.2.

In addition to these ‘normal’ views, it can be useful – and in some cases necessary – to include additional views (e.g. sectional views, cut-away views, exploded views), and/or to include views of the design in different configurations (discussed further below).

Some jurisdictions do not prescribe the precise views required for a design application. Other jurisdictions are stricter in this regard.

For example, where a design relates to the three-dimensional appearance of a product the Chinese patent office requires at least one perspective view together with orthographic projections of the six sides (unless opposite views are identical/symmetrical and stated to be so). Notably, China requires these views regardless of whether they would normally be seen and/or have any visual features of interest. If necessary to understand the appearance of the product, Chinese law also requires additional views (such as exploded, cut-away and/or sectional views) to be filed³.

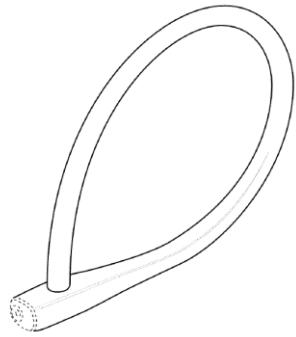
In contrast, in the United States, a single view can in some circumstances be sufficient to fully illustrate the scope of the design. Consider, for example, the Knog® Kabana cable lock shown below:



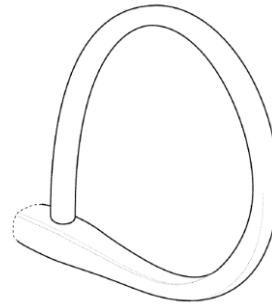
Knog® Kabana cable lock

In the US, design patent 704,033 in respect of this lock was granted with two figures only (and it is possible that a single figure would have been acceptable):

³ Chinese Guidelines for Examination. Part I, Chapter 3, Section 4.2. From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=298963. Accessed 23 March 2018.



Front perspective view



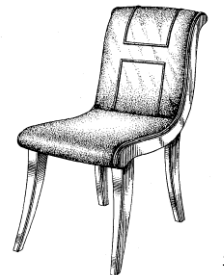
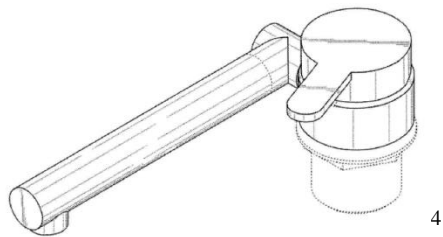
Rear perspective view

Had these two figures been the sole disclosure in the priority application, however, problems would arise in China – and any other jurisdictions that are prescriptive in terms of the views required. It would also give rise to problems in the event an objection is made that the views are not, in fact, sufficient to fully illustrate the design.

While line drawings are typically used (and often preferable), a number of jurisdictions also accept photographs or renderings. Even if formally accepted, however, photographs in particular can be problematic, for example where they capture extraneous ‘environment’ detail that is not intended to be the subject of the design.

B. Shading and stippling

Surface shading and/or stippling are often used in design drawings to assist in the illustration of three-dimensional surface contours – e.g.:

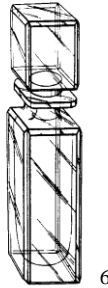


Surface shading techniques can also be used to indicate visual properties of materials (noting that for designs it is the appearance of the material that is relevant rather than the actual material).

For example, transparency and reflectiveness are typically illustrated by oblique shade lines. In the following example, these are used to illustrate transparency:

⁴ USD 665,479.

⁵ USPTO Design Patent Application guide. <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#drawex>. Accessed 21 March 2018.



Many jurisdictions permit drawing techniques such as these to be used, and in some countries they can be mandatory. For example, Section 1503.02 of the US Manual of Patent Examining Procedure provides:

“Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented.”

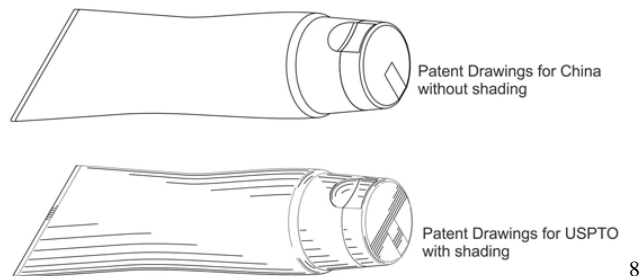
And:

“Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror.”

In other jurisdictions, however, the position is the exact opposite. China, for example, does not allow either shadow lines or broken lines and the Chinese Patent Office will object to any drawing exhibiting them⁷.

Given the various – and at times mutually exclusive – requirements, priority applications for designs that are likely to be pursued in China (or other countries that prohibit surface shading) are often prepared with multiple embodiments: e.g. a ‘shaded’ embodiment and a ‘clean’ embodiment.

For example:



Removing shading from drawings is generally not problematic. That said, being able to rely on a ‘clean’ set of drawings that were in the priority application will almost always be simpler and less open to dispute.

⁶ USPTO Design Patent Application guide. <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#drawex>. Accessed 21 March 2018.

⁷ Chinese Guidelines for Examination. Part I, Chapter 3, Section 4.2.4(3). From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=298963. Accessed 23 March 2018.

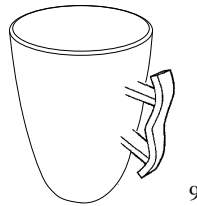
⁸ NBG Newsletter: Volume 3 November 2012 Patent Drawings Shading, when and where to use it. <http://nbgdrafting.com/newsletter/volume-3-november-2012-patent-drawings/>. Accessed 21 March 2018.

The opposite, however – i.e. adding shading to drawings –can be far more problematic. If ‘clean’ drawings filed with a priority application do not allow the contours of a product to be clearly determined a clarity type objection may be raised. The obvious way to address such an objection is to add shading to define the contours. Almost by definition, however, any attempt to make such an amendment has a high likelihood of being considered an amendment that adds new matter – and either will not be permissible or will compromise the priority claim.

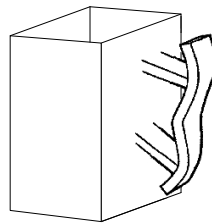
C. Emphasising particular features: broken lines and shading

In many cases, it is a particular feature or combination of features of a product that are important rather than the appearance of the product as a whole.

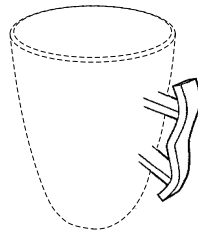
By way of simple example, consider a ceramic coffee cup with a new handle:



Given it is the handle that is new, the applicant would presumably wish to protect the handle independently of the cup body. For example:

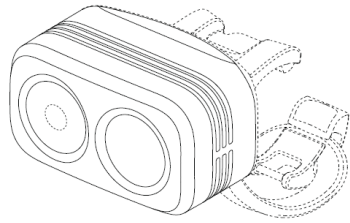


Where the focus of protection is a subset of the features illustrated, the conventional approach is to show features that are to be disregarded in broken lines – for example:

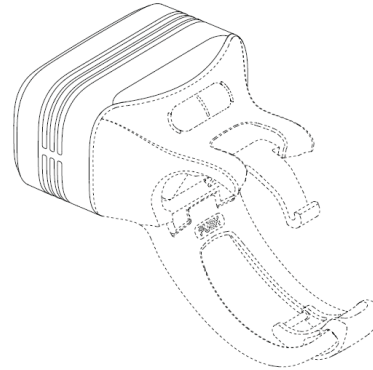


As a further example of this, consider again the Knog® Road 250 product discussed above. Rather than protecting all features it may be desirable to focus protection on the ‘light body’ part of the product rather than the clasp/closure. Normal practice in this case is to provide a set of drawings with the clasp/closure in broken lines. For example:

⁹ Example adapted from Australian design registration 312524.



Front perspective view



Rear perspective view

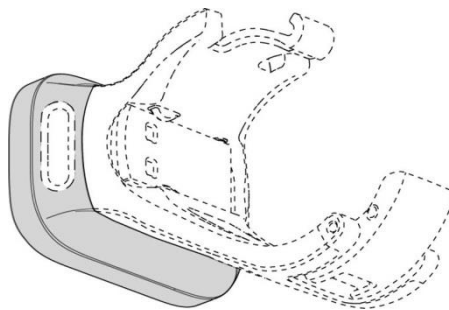
In many jurisdictions, broken lines are accepted and understood (by law, practice, or convention) to illustrate features for which protection is not sought. For example, the use of broken lines (or blurring or colour shading) to exclude features for which protection is not sought is well established in European Community Designs¹⁰.

This is not, however, the case in all jurisdictions – and even where broken lines are permitted their operation may differ.

For example, and as mentioned above, China does not permit the use of broken lines¹¹. Nor does Brazil – at least for designs relating to three-dimensional objects¹².

Japan does allow the use of broken lines to disclaim portions of a design, however imposes quite specific rules with respect to how broken lines are illustrated.

Japan also allows for shading to be used – with an appropriate disclaimer – to describe the particular features/section of interest. For example:



¹⁰ European Union Intellectual Property Office (EUIPO). Guidelines for Examination of Registered Community Designs . Section 5.3.

¹¹ Chinese Guidelines for Examination. Part I, Chapter 3, Section 4.2.4(3). From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=298963. Accessed 23 March 2018.

¹² Wolters Kluwer. *Industrial Design Rights: An International Perspective*. Second Edition. §3.07[B].

As another example, Australia permits the use of broken lines, but features shown in broken lines are not entirely disregarded in validity and infringement considerations. Instead, broken lines can be used (together with an appropriate explanatory statement) to effectively de-emphasise the relevance of certain features within the broader, overall appearance provided by a design¹³.

The varying treatment/permissibility of broken lines can also apply to other drawing annotations and techniques – for example, using dot-dash (or other specific line formats) to indicate particular regions of a product, applying different shadings to indicate contrasting appearances, etc.

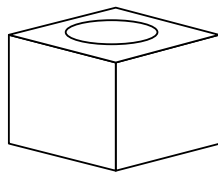
The discussion of partial products below is also relevant to the protection of particular features of a product.

D. Sectional/cut-away views

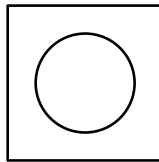
For some products, relying solely on ‘normal’ elevation, plan, and perspective views can leave the appearance difficult – or even impossible – to determine.

This is commonly encountered where products include recessed features – and while it is usually less of an issue where surface shading techniques are used it can still be a problem.

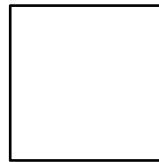
For example, consider the following hypothetical product:



Perspective view



Top/bottom view

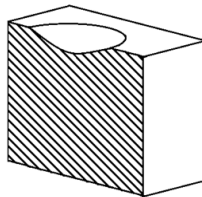


Left/right side view

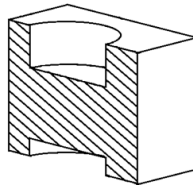


Front/rear view

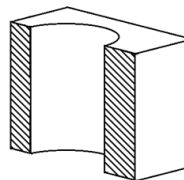
From these drawings, the true nature of the circular feature is not at all clear (and even surface shading may not be sufficient to clarify the product). For example, any of the following section views are entirely consistent with the views above:



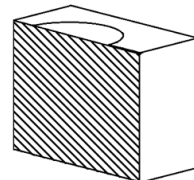
Possibility 1



Possibility 2



Possibility 3



Possibility 4

Where even the potential for ambiguity arises from normal plan/elevation/perspective views (with or without shading), it is good practice to include sectional and/or cut away views to

¹³ Australian Designs Act 2003. See, for example, Section 19.

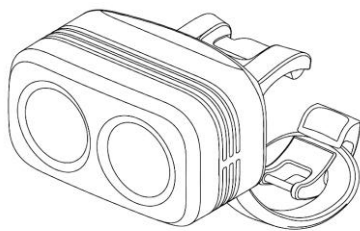
resolve this ambiguity. In some jurisdictions views such as this will be mandatory if they are necessary to interpret the design.

E. Configuration and exploded views

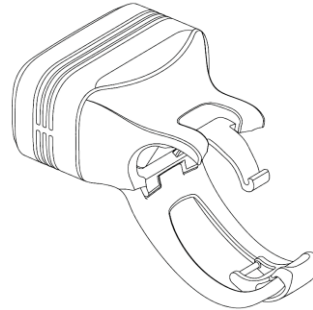
For completeness, additional types of drawings may be appropriate (or necessary) where a single product has multiple configurations – e.g. components that are separable or movable relative to one another during normal use.

Configuration and/or exploded views are generally used for such products.

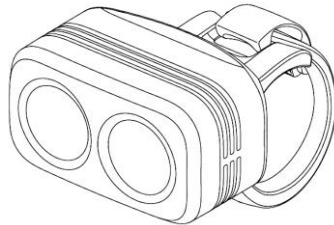
For example, The Knog® Blinder Road 250 has an open configuration (illustrated in the drawings above) and a closed configuration. Given this, additional drawings showing the closed configuration may be appropriate – e.g.:



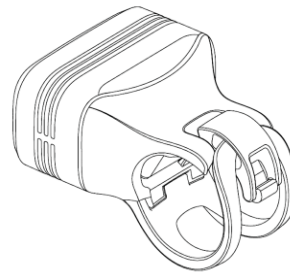
Front perspective view
(open configuration)



Rear perspective view
(open configuration)



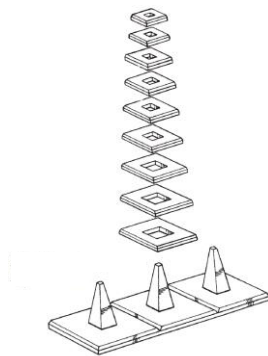
Front perspective view
(closed configuration)



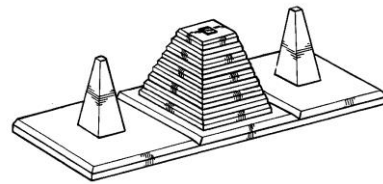
Rear perspective view
(closed configuration)

The following ‘Towers of Hanoi’ puzzle provides an example of where an exploded view may be appropriate¹⁴:

¹⁴ USPTO Design Patent Application guide. <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#drawex>. Accessed 21 March 2018.



Exploded view



Assembled view

It is a matter of judgement as to whether or not a single configuration of a product or multiple configurations should be shown. As a general proposition, however, if a single configuration of a product that has multiple configurations is to be illustrated, the configuration should be that of the product as it will most likely be shipped or sold. This is to try and avoid a manufacturer/importer/seller arguing non-infringement on the basis that a product as manufactured/imported/sold does not look like the illustrated configuration of the design and it is only after the end user manipulates the product in a certain way that any visual similarities occur.

It should be noted that neither sectional nor exploded views should be used to show detail that is hidden during normal/non-destructive use of a product. As far as the authors are aware there are not any jurisdictions that require such details to be shown, and in many cases they may well lead to objections.

F. Environment views

In some cases, environment views are used to show a product in use.

Environment views are not typically problematic, insofar as they can simply be omitted in any jurisdiction where they could otherwise cause issues.

When preparing environment views, however, it is good practice to ensure that they do not either:

- provide information in respect of the actual product which cannot be discerned from other views; or
- obscure design details not clearly visible elsewhere.

Environment views can also become an inadvertent issue when photographs instead of line drawings are used as the primary form of illustration of a design. For example, although not intended to be part of the design a table on which a product is resting (or other extraneous objects in photographs) effectively turn the primary design representations into environment

views. In such cases care should be taken that all extraneous material is de-emphasised or clearly identified as such in the application papers.

G. Maximum number of views

For European Community Design applications, a maximum of seven different views of a design are permitted.¹⁵

Where more than seven views are filed, the views are considered in order with the 8th and any further views disregarded¹⁶. Given this, if more than seven views are to be filed in a Community Design application the order of the views should be carefully considered. Where appropriate, a single drawing to illustrate multiple views can also be useful and provide more ‘room’ for further views. For example, if left and right side views are identical or symmetrical, a single drawing with an appropriate description can be used instead of two drawings.

To the best of the authors’ knowledge this is not an issue elsewhere. Nonetheless, it is a significant limitation in a significant jurisdiction so worth being aware of, especially if considering using a Community design as a priority application for other jurisdictions.

H. Multiple embodiments and/or alternative representations

As discussed above, there are circumstances where including multiple embodiments and/or alternative representations of a design in a priority application can be beneficial. For example, and depending on the circumstances, it may be advantageous to include:

- shaded drawings;
- drawings with broken lines indicating non-claimed (or at least de-emphasised) portions of the design;
- ‘clean’ drawings (without surface shading/stippling or broken lines);
- photographs or renderings;
- cut-away/sectional views;
- views of different configurations.

Different jurisdictions will no doubt provide different ways to include multiple embodiments and/or additional representations in a design application. Considerations in this regard will generally be:

- Whether there are any costs associated with including multiple embodiments, for example if official fees are charged on a per-embodiment basis.
- The level of certainty that the manner in which additional representations/embodiments are included will be able to properly support a priority claim in foreign jurisdictions.

¹⁵ European Community Design implementing regulation. Article 4(2).

¹⁶ European Union Intellectual Property Office (EUIPO). Guidelines for Examination of Registered Community Designs. Section 5.1.

- The ability to amend the original application after filing in order to put it in the desired state for the jurisdiction in which it was filed (e.g. by deleting additional embodiments or views that are not required in that jurisdiction).

The US, for example, provides two potential mechanisms for including embodiments or representations in a design patent application that may not ultimately be needed/desired in the US itself. These options are to include multiple embodiments in the main application and/or to include additional material in an appendix.

1. Including multiple embodiments in the main application

Where multiple embodiments are included in the main application, care should be taken to remove any embodiments that are not ultimately to be pursued in a preliminary amendment.

If this is not done, and a restriction requirement issues, removal of an embodiment in response to the restriction requirement may be considered surrender of that embodiment (unless, of course, it is pursued in a divisional application)¹⁷.

2. Use of an appendix

Including additional embodiments or representations in an appendix is another option.

The advantage of this approach is that it avoids the need to make any preliminary amendment.

It is, however, more uncertain from a priority claim perspective. The question that arises in this regard is whether, for a given jurisdiction, priority can be claimed to an embodiment or representation that was included in an *appendix* of a US priority application. How this question is answered in a given jurisdiction will ultimately come down to the implementation of the Paris Convention priority claim provisions in that jurisdiction.

For example, the authors understand that at least in South Korean the Patent Office has refused to allow the appendix of a US design patent application to be used as the basis for a priority claim.

IV. Downstream considerations

This section outlines various areas that may not need to be considered at the time of filing a priority application, but which may impact a decision on whether or not to file in a foreign jurisdiction.

Once again, this should not be treated as an exhaustive list of differences between jurisdictions. Rather it is an overview of some of the more common areas where potentially important differences arise.

A. Disclosure prior to filing and grace periods

As with utility patents, public disclosure of a design prior to filing can be problematic.

¹⁷ *Pacific Coast Marine Windshields, Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014).

The Paris Convention requires its signatories to provide a grace period where disclosure is made at an officially recognized international exhibition.¹⁸

In addition, many jurisdictions provide mechanisms for ignoring unauthorised disclosure of a design prior to filing. Such provisions are typically accompanied by a requirement to file an application within a certain time from the first unauthorized disclosure (for example, in Australia the period is 6 months¹⁹), and may also be tied to a requirement to provide notice of the prior unauthorized disclosure at the time of filing.

Far less uniformity, however, exists with respect to the existence and operation of generic grace periods: i.e. grace periods that operate for any self-disclosure.

Some jurisdictions – for example China and Australia – do not provide any generic grace period. Accordingly, if a design is disclosed by or on behalf of the owner prior to filing (and not at an officially recognized international exhibition) it will usually not be possible to obtain valid protection.

Other jurisdictions do provide generic grace periods. The typical variables that accompany generic grace periods are:

- the length of the grace period – i.e. how long after the first disclosure an Applicant has to file a design application;
- whether the relevant date for the grace period is the filing date of a priority application from which convention is claimed or the date of filing an application in the jurisdiction in question; and
- whether the Patent Office of the jurisdiction requires notification of the prior disclosure (and, if so when).

To exemplify these different requirements, consider for example:

Jurisdiction	Requirement
Canada	The Canadian application must be filed within 1 year from disclosure. ²⁰
European Union	Either a Community Design or priority application must be filed within 1 year from disclosure. ²¹
Japan	The Japanese application must be filed within 6 months of disclosure, and must be accompanied by statement notifying the Patent Office of disclosure. ²²

¹⁸ Paris Convention. Article 11(1).

¹⁹ Australian Designs Act 2003. Section 17(1)(b). Australian Designs Regulations 2004. Regulation 2.01(3).

²⁰ Canadian Industrial Design Act. Section 6(3).

²¹ European Community Design Regulation. Article 7(2).

²² Japanese Design Act (Act No. 125 of 1959). Article 4(2). From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=368179

Given the subtleties that can exist with respect to grace periods – and, indeed, precisely what constitutes public disclosure – it is always worth exploring this with agents in jurisdictions of interest. They will, of course, be in the best position to advise on whether disclosure is actually disclosure, whether any grace period can apply, and if so the conditions necessary to make use of the grace period.

B. Entitlement

Entitlement considerations for designs are largely the same as those in respect of utility patents, and will not be discussed in detail in this paper.

Generally speaking, however, the issues relate to:

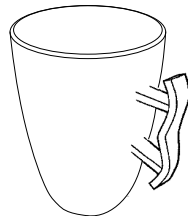
- ensuring entitlement to the design (from the designers); and, where priority is claimed,
- ensuring entitlement to claim priority (from the applicant of the priority application).

The variable element in this regard is typically timing, for example whether entitlement must be perfected at the time of filing an application or at the time of grant/registration.

C. Partial products

As discussed above, it is common to want to focus protection on a particular feature/combination of features rather than the appearance of an entire product.

The example provided above in this regard was a ceramic mug with a new handle:



For present purposes, this cup is to be considered a unitary product: i.e. the cup is manufactured as a whole, rather than the handle and cup portion being manufactured separately before being assembled into the final product.

In some jurisdictions, designs in respect of partial products are permitted – i.e. designs in respect of integral parts of a larger product even if those parts are not manufactured separately. Europe is an example of such a jurisdiction, where a Community Design is defined as “the appearance of the whole or a part of a product”²³.

In such countries a design application for a cup handle is permissible – e.g.:

²³ European Community Design Regulation. Article 3(a).



Or, as a further example:



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The more common position, however, is that a design must be in respect of and show an entire article or product, even if protection is ultimately to be focussed on only part of that article/product.

This is the case, for example in the US, Canada, Australia, and Japan (where although the Article 2 of the Designs Act defines ‘article’ as including part of an article, the drawings are required to show the entire article²⁵).

Some jurisdictions are even stricter – for example, New Zealand legislation defines a product as “any part of an article if that part is made **and** sold separately.”²⁶

1. Textual description implications

As well as being a potential issue for representations, partial products may have a bearing on the textual description of the product – for example in the product name/title and/or other descriptive text.

For example, even if the only features of interest are a cup handle, referring to the product as a ‘cup’ or ‘cup with handle’ (as opposed to simply ‘cup handle’) may end up

²⁴ European Community Design 001874264-0003: Shopping cars (part of -) (handles for -)

²⁵ Japanese Examination Guidelines for Design Part VII, 71.2.2(1).
http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/design_es/0701.pdf

²⁶ New Zealand Designs Act 1953, Section (2)(1). Emphasis added.

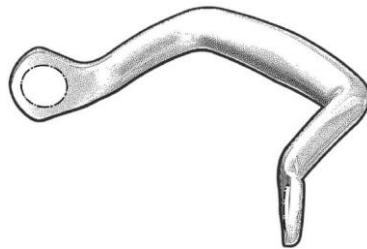
being useful in certain jurisdictions which could otherwise object that a ‘cup handle’ is not (unless separately manufactured) a valid product.

2. Note on partial products

This section deals with integral parts of products. This is distinct to component parts of complex products which are separately manufactured.

There would be no partial product issues in the example above if the cup portion and handle were manufactured separately. In this case both the cup portion and handle would generally be considered products in their own right.

For example, with the possible exception of New Zealand the authors are not aware of any jurisdiction which would take issue with the following ‘handle’ – on the basis that it is clearly intended to be manufactured as a separate product:



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D. Screen displays

Screen display designs are another type of design that is treated very differently in different jurisdictions.

While no standard definition exists, ‘screen display’ designs in this context refer to designs in respect of graphical user interfaces (or elements thereof) that are transiently displayed on a screen under the control of software/hardware/firmware.

These types of designs are the subject of the paper and presentation by Tracy Durkin in the 2018 Designs Bootcamp so will not be discussed in detail here.

By way of very general overview, however, the types of issues that can arise are:

- Whether they are protectable at all (often due to their transient nature: when a screen or display is powered off there are no visual features).
- If they are protectable, are they protectable in their own right or only in the context of hardware (i.e. the electronic device or screen on which the display is presented)?
- If hardware must be illustrated, must it be an entire device or is a basic representation (e.g. a rectangular outline) of the device acceptable?

²⁷ Australian design registration 201614592.

- If the entire device must be illustrated, what are the implications from an infringement perspective? For example, will the same GUI features presented by a device with a different appearance to that illustrated infringe?
- How does the jurisdiction in question treat infringement more generally? For example, what are the implications of the fact that the device as imported/sold has a blank screen and it is not until the device is operated by a user that it shows the screen display features of the design?

E. Functional designs: form dictated by function

Generally speaking, the fact that a design (or design feature) serves both a functional and aesthetic purpose is not problematic.

Issues can arise, however, where the appearance of features are dictated solely by function. See, for example:

- Europe: “A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.”²⁸
- Japan: “the following designs shall not be registered: a design solely consisting of a shape that is indispensable for securing functions of the article.”²⁹
- Canada: “No protection afforded by this Act shall extend to (a) features applied to a useful article that are dictated solely by a utilitarian function of the article;”³⁰

In practice this is, perhaps, a relatively rare occurrence given the visual appearance of most products is not entirely constrained by function.

Where it can arise, however, is in respect of products for which form and function can be argued to be inextricably entwined. Impellers/propellers are a potential example of such products, insofar as almost any change to shape (e.g. of the blades) will have a functional impact.

F. Restrictions on ‘must-fit’ or ‘must-match’ designs

Another area in which functionality can cause an issue is for component parts of complex products which require a particular shape. This may be to allow the component part to connect/interoperate with the rest of the complex product (referred to as ‘must-fit’ designs), or to restore a complex part to its original appearance (referred to as ‘must-match’ designs).

An example of ‘must-fit’ designs are designs in respect of printer cartridges and the like, given a cartridge must typically have a very particular shape (and hence appearance) in order to fit within the printer.

²⁸ European Community Design Regulation. Article 8(1).

²⁹ Japanese Design Act (Act No. 125 of 1959), Article 5(iii). From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=368179.

³⁰ Canadian Industrial Design Act. Section 5.1(a).

For ‘must-match’ designs, a common example is automotive spare parts, where (for example) a bumper must have a particular appearance if the original appearance of the car is to be restored.

‘Must-fit’ and ‘must-match’ designs are recognised in certain jurisdictions and can be precluded from design protection. For example, the European Community Design Regulation does not permit protection in respect of ‘must-fit’ designs:

A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.³¹

Japan also precludes registration of ‘must-fit’ designs³².

G. Spare part infringement defence

An alternative way that ‘must-fit’/‘must-match’ type designs can be handled is not by refusing registration but by providing a defence to design infringement.

Where enacted, a spare part infringement defence generally applies where a component part of a complex product is used to restore a complex product to its original appearance.

Australia is an example jurisdiction that provides a spare part infringement defence.³³

At various times the US has considered similar provisions in respect of automobile spare parts – most recently in the ‘Promoting Automotive Repair, Trade, and Sales Act of 2017’.³⁴

As the name suggests, spare part infringement defences typically operate only to provide an infringement exemption where products are used as spare parts. Phrased alternatively, a component part of a complex product that is not used to restore a complex product to its original appearance can still infringe a design right.

If the primary value of a design is in the spare part market, consideration should be given to how jurisdictions of interest treat spare (and, as discussed above, ‘must-fit’/‘must-match’) parts prior to filing.

H. ‘Hidden’ designs

Designs in respect of products which are hidden from view during normal use can also be problematic.

For example, European Community Design protection can only be obtained for a component part of a complex product where:

³¹ European Community Design Regulation. Article 8(2).

³² Japanese Design Act (Act No. 125 of 1959). Article 5.3. From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=368179.

Wolters Kluwer. *Industrial Design Rights: An International Perspective*. Second Edition. §11.03[A][2].

³³ Australian Design Act 2003. Section 72.

³⁴ *Promoting Automotive Repair, Trade, and Sales Act of 2017*, S. 812, 115th Cong. § 2 (as introduced in Senate, Apr. 4, 2017).

“...the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter;”³⁵

‘Normal’ use in this regard does not include “maintenance, servicing or repair work”³⁶.

In a similar vein, it has been held in Canada that:

... the Act does not protect a functional article where the significant design features are hidden when the article is in use and were never intended to be admired by or sold to the public at large.³⁷

I. Multiple embodiments

Another area in which jurisdictions differ is the treatment of design applications with multiple embodiments or variations. The different treatments can have a significant impact on both strategy and cost. For example, in some jurisdictions it can be beneficial to file multiple designs in a single application and divide them into separate applications at a later stage. In other jurisdictions the reverse is true.

Some jurisdictions allow multiple designs (or embodiments) to be included in a single design application. The United States is one such jurisdiction, though if embodiments are found to be patentably distinct during examination, divisional design patents may be required to protect all original embodiments, or risk an effective disclaimer of the excluded subject matter. Irrespective of which embodiments are ultimately pursued (and, indeed, which embodiments are even intended to be pursued in the original country of filing), the ability to file different embodiments without incurring additional filing fees – and thus establish a priority claim for those embodiments – can be valuable. For example, and as discussed above, this allows the filing of a ‘shaded’ embodiment and a ‘clean’ embodiment (without shading) in a single application.

In contrast, the European Union treats each variation shown in the drawings of a design application as an entirely separate design. As a consequence, a single US design including multiple patentably indistinct embodiments may end up as multiple European designs. Despite this, the Community Design system operates such that pursuing multiple designs in a single application can be done quite cost effectively: provided they belong to the same Locarno Classification up to 100 designs can be filed in a single application³⁸ and a decreasing fee scale applies.

China is different again, and provides two alternative systems for dealing with multiple designs. The first allows an unlimited number of designs to be included in one application provided the designs are incorporated into products which belong to the same Locarno classification and are usually sold and used together in sets. The second system allows up to 10 designs to be included in one application if they are considered “similar” designs. This requires the applicant to designate a main design and the subsequent designs are “affiliated”

³⁵ European Community Design Regulation. Article 4.2(a).

³⁶ European Community Design Regulation. Article 4.3.

³⁷ Wolters Kluwer. *Industrial Design Rights: An International Perspective*. Second Edition. §4.07[A][2].

³⁸ European Union Intellectual Property Office (EUIPO). Guidelines for Examination of Registered Community Designs . Section 12.1.2.1.

designs that must share the same core design elements as the main design. This can be used to protect multiple versions of the same core design, e.g. products with the same product silhouette but having a different number of a particular element, for example a car headlight assembly of the same external shape that has versions with 2 lights, or 4 lights or 6 lights.

J. Publication

Another consideration to be taken into account when filing internationally is publication.

While utility patent applications are almost universally published at 18 months from the priority date, there is greater variation for design applications.

For example, the publication of European Community designs can be delayed for up to 30 months from the priority date upon request³⁹. In Japan there is an option to request that the design be kept secret for a period of up to 3 years from the date of registration⁴⁰.

At the other end of the spectrum, Australian designs are published on registration which in the normal course occurs at around 7 to 8 months from the earliest priority date.

Where there is sensitivity to publication, therefore, it is worth letting agents know this so they can advise on normal publication timelines and/or mechanisms for delay.

K. Procedural differences

Although it will not necessarily impact on the decision of where to file, it is worth noting high level procedural differences that exist.

In some jurisdictions, design applications are substantively examined as a matter of course. In these jurisdictions a granted or registered design right is one that has been examined and is enforceable. The United States, Canada, Japan, New Zealand, Taiwan and Thailand are all jurisdictions which examine designs as a matter of course.

In other jurisdictions, substantive examination is optional – though must normally be successfully concluded before a design becomes enforceable. China and Australia are examples of such jurisdictions. In Australia, for example, a registered design is not enforceable unless it has also been certified.

In still further cases, substantive examination is not performed as a matter of course or required before seeking to enforce a design. The European registered Community design is an example of such a right.

The point to be made here is perhaps a simple one of terminology – and that a design should not be assumed to be enforceable simply because it has an official status of ‘registered’ or the like.

L. Term

Another area of significant inconsistency in international design laws is the duration of protection offered.

³⁹ European Community Design Regulation. Article 50.1.

⁴⁰ Japanese Design Act (Act No. 125 of 1959), Article 14(1). From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=368179

The Hague Agreement Concerning the International Registration of Industrial Designs requires signatories to offer a minimum 15 year term⁴¹. Some countries offer this while some offer a longer term.

Other jurisdictions (which are not signatories to the Hague agreement) offer a shorter term – for example, Australia which offers only 10 years.

The table below outlines the terms offered in some key jurisdictions.

Jurisdiction	Term
Australia	10 years from the application date. ⁴²
Canada	10 years from the date of registration. ⁴³
China	10 years from the application date. ⁴⁴
European Union	25 years from the filing date. ⁴⁵
Japan	20 years from the date of registration. ⁴⁶
United States	Application filed before 13 May 15: 14 years from issue date. Application filed after 13 May 15: 15 years from issue date. ⁴⁷

V. Conclusion

As will be appreciated from the above, there are a number of areas where designs are handled very differently.

Exploring all differences and all jurisdictions would, of course, be a daunting task. Hopefully, though, this paper will serve to highlight at least some of the more common issues that can arise.

⁴¹ Hague Agreement Concerning the International Registration of Industrial Designs. Geneva Act 1999 Article 17.

⁴² Australian Designs Act 2003. Section 46(1).

⁴³ Canadian Industrial Design Act. Section 10(1).

⁴⁴ Patent Law of the People's Republic of China (as amended up to the Decision of December 27, 2008). Article 42. English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=178664.

⁴⁵ European Community Design Regulation. Article 12.

⁴⁶ Japanese Design Act (Act No. 125 of 1959), Article 21. From English translation available at WIPO: http://www.wipo.int/wipolex/en/text.jsp?file_id=368179.

⁴⁷ 35 U.S.C. 173.