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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Design patent

3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

Article 23, Patent Law regulates that “ Any design for which a patent is granted shall not be attributed to the existing design, and no entity or individual has, before the date of application, filed an application with the patent administrative department of the State Council on the identical design and

recorded it in the patent documents published after the date of application” , which means that an allowable design should not be a prior design. In addition, China requires world wide novelty.

b) non-obviousness

c) inventive step

Article 23, Patent Law regulates that “As compared with the existing design or combination of the existing design features, the design for which a patent is granted shall have distinctive features” , which is comparable to the inventive step as in other jurisdictions.

d) individual character

e) originality

f) aesthetic

Article 2, Patent law regulates that “The term “design” refers to any new design of a product's shape, pattern or a combination thereof, as well as the combination of the color and the shape or pattern of a product, which creates an **aesthetic feeling** and is fit for industrial application”, which means that the aesthetical factor is considered as one of criteria for allowable design patents.

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

As defined in Article 2, any allowable design shall has aesthetic consideration.

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

As explained in the decision made by the Supreme Court (Gree v PRB retrial case decided in 2011), the court has the opinion that if an overall appearance is dictated solely by its technical function, it is not patentable as design patent.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

If a feature in the whole design is solely designed for implementing a function without considering aesthetic aspect, the feature is removed from consideration when assessing the patentability/infringement of the whole design.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

It is regulated in Article 11 of the Interpretation 1 regarding patent infringement issued by the Supreme Court that the feature that is mainly decided by technical function shall not be considered when making infringement comparison.

Further, as decided in cases issued by the Supreme court (PRB v Dijun ZHANG retrial case decided in 2012, and Tongling v PRB retrial case decided in 2012), the court clarifies that when determining whether or not a feature is functional, the need to achieve the technical function without considering aesthetic aspect of the feature is the only relevant factor when the portion in question is selected.

The Supreme court has the opinion in the case PRB v Dijun ZHANG that even if there are alternative appearances for the portion to obtain the same function result, it does not means in certain that the feature in question is not functional. In case that there are only limited designs for a feature in order to achieve certain technical function, the feature selected is still functional. Otherwise, monopoly is granted to the feature which is only for function without considering aesthetic aspect thereof.

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

It is regulated in Article 11 of the Interpretation 1 regarding patent infringement issued by the Supreme Court that the feature that is mainly decided by technical function shall not be considered when making infringement comparison.

Further, as decided in cases issued by the Supreme court (PRB v Dijun ZHANG retrial case decided in 2012, and Tongling v PRB retrial case decided in 2012), the court ruled that a feature that is regarded as functional shall not be considered and has no contribution to the overall visual effect of the whole design.

b) any portions deemed functional will not be taken into account when assessing validity

It is regulated in Article 11 of the Interpretation 1 regarding patent infringement issued by the Supreme Court that the feature that is mainly decided by technical function shall not be considered when making infringement comparison.

Further, as decided in cases issued by the Supreme court (PRB v Dijun ZHANG retrial case decided in 2012, and Tongling v PRB retrial case decided in 2012), the court ruled that a feature that is regarded as functional shall not be considered and has no contribution to the overall visual effect of the whole design.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

It is advised to clarify design does not protect the appearance that is dictated solely by function without considering aesthetic aspect. In addition, it shall clarify how to decide whether or not an appearance or a feature is solely decided by function.

b) the requirements for protection of a design

It is advised to list specifically the requirements for protection of a design, so as to make it predictable for applicants when considering design filing strategy and enforcement strategy.

- c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

It is advised to clarify design does not protect the appearance that is dictated solely by function without considering aesthetic aspect. In addition, it shall clarify how to decide whether or not an appearance or a feature is solely decided by function.

- 10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

III. Proposals for harmonisation

- 11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

Design is what people see. Having a common standard for the substantial issues regarding design would make the public around the world understand clearly and easily how to use the design right to protect them.

- 12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

Same as 11)

- 13) If so, what should that right be called?

Design patent

- 14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

- a) novelty

It is advised to have absolute novelty bar.

b) non-obviousness

c) inventive step

It is advised to make the determination similar as invention patent, i.e., non-obvious plus visual effect.

d) individual character

e) originality

f) aesthetic

A design must have aesthetic effect. Otherwise it is confused with utility or utility model patents.

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

Otherwise, it blurs the definition of design which protects the aesthetic aspect of a design.

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

This factor is objective. As long as applicant/patentee can provide evidence supporting the availability of alternative appearances, it means that aesthetic aspect is considered when choosing the design.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

The feature that is solely functional shall be removed from the contribution visual effect. However, the relationship (position, ratio etc.) of the portion to other parts in the overall design shall be protected, if the relationship brings visual effect that is novel.

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

This factor is objective. As long as applicant/patentee can provide evidence supporting the availability of alternative appearances, it means that aesthetic aspect is considered when choosing the design.

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

The functional element itself shall be removed from the contribution of the whole design, but the relationship between the functional element and other elements such as the ratio, position etc. shall be considered.

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

Design protects the appearance of a product, which is sellable around the world. Therefore, when determining the scope of a design, harmonized standard would make the design patentability predictable in every jurisdiction.

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Design shall protect the appearance. When a design is solely for achieving function without considering aesthetical aspect, the design is not patentable. But if there are alternatives for achieving the same function, usually the design shall be patentable. For a feature in an overall design which is solely for achieving function without considering aesthetical aspect, the feature itself could be ignored but the relationship between the feature and other features which can bring visual effect shall not be ignored and shall be considered when assessing infringement and validity. In determining whether or not a feature is function, alternative design is a test tool.

Summary