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New design patent practice explained

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Design patents in Taiwan are becoming broader. This has opened up new opportunities for IP owners who want to maximise the protection available to them

Significant changes have been made to design patent practice in Taiwan since January 1 2013. In particular, partial designs can now be protected, and protection by associated design patent has been replaced by derivative design patent. Furthermore, icons and graphical user interfaces (GUI) have become patentable subject matter, and a set of designs can be included in a single design application.

Partial design

Under the new patent practice, a design patent application can focus on either a complete or partial design. Under previous patent law, a patented design had to consist of configurations, patterns and colours or combinations thereof of a complete article. In other words, if the patented design embodied in a complete article contained multiple features of which some were novel and others were conventional while a counterfeit only copied the novel features (but not all the features) of the design, such counterfeiting might not fall within the scope of the design patent. To prevent infringers from evading liability by using the above strategy, the concept of "partial design," which allows for focusing only on a design's novel feature(s), has been added to the new patent practice as a patentable design.

Expressing a partial design in drawings

Under the new design patent practice, solid lines are typically used to illustrate claimed portions of an article, and phantom or broken lines are used for the unclaimed portions of the article. Alternatively, colouring certain areas of an article with grey scale or translucency can be used to indicate the unclaimed portions of the article. Furthermore, a statement such as "the unclaimed portion is illustrated in broken lines" should be included in the design description section of the specification.

It is required that the drawings or photographs contain a sufficient number of views to clearly and sufficiently disclose the claimed partial design so that persons skilled in the art can understand the claimed design and be enabled to practice the same. Those views of an article that do not show the claimed partial design can be omitted.

Partial designs can be classified as (1) a component of an article (see the base of the indication light as shown below in figure A); (2) a partial feature of an article (see the surface patterns on the running shoe as shown below in figure B and the contours of a remote control as shown below in figure C); and (3) multiple components/features of an article (see portions of a desk lamp as shown below in figure D and portions of a package as shown below in figure E). In cases containing multiple components/features of an article as shown in figures D and E, even though there is more than one component/feature, they should be considered as a whole, and treated as a single design. The two or more components/features of such a design cannot be separately enforced.

Interpreting a claimed partial design

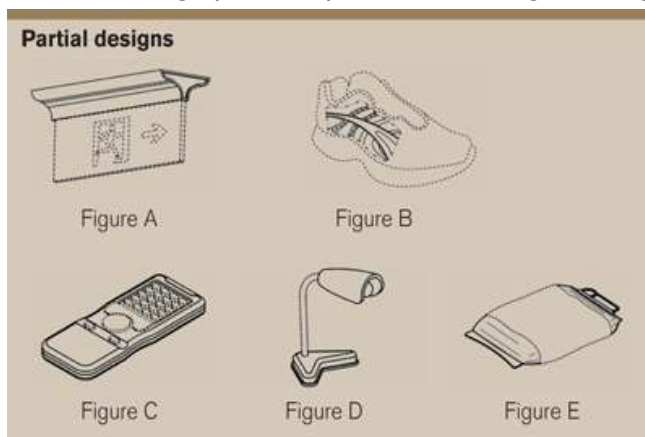
The scope of a partial design is based on the claimed portion (in solid lines) shown in the drawings. The unclaimed portion (in broken lines) can be used to interpret the article that embodies the partial design

or the relationship between the environment surrounding the claimed portion and the claimed portion itself. The specification of a design patent application can be referenced for interpreting the partial design if necessary.

Derivative design patents

It is required when applying for a design patent that an application be filed for each separate new design. Therefore, including more than one specific design/embodiment in a single design application is not allowed. Based on the first-to-file principle, when there are two or more identical or similar design applications independently filed, only the first application can be allowed. For two or more similar designs owned by the same person, a design patent application can be filed to cover one of the designs, and derivative design patent applications can be filed to cover the rest. Such an arrangement is an exception to the first-to-file principle.

The *Patent Infringement Assessment Guidelines* issued by the Intellectual Property Office in 2004 provide that the scope of a design patent covers any design that is the same as or similar to the design shown in the design patent. Therefore, if two designs are the same or similar, their patent rights overlap and one of them (if they are filed on different dates, the latter) is prohibited from being patented according to the first-to-file principle. If the same or similar design patents are owned by the same applicant, this is called double patenting. A derivative design by its definition is similar to the original design. Thus, the derivative design patent system, as an exception to the first-to-file principle, seems to solve the double patenting problem of design patents. It is well understood that double patenting is prohibited so as to prevent the same applicant from prolonging the term of the same exclusive patent right from an earlier filed patent application. Therefore, under the new patent practice the term of a derivative design patent expires when its original design patent expires.



An independent right

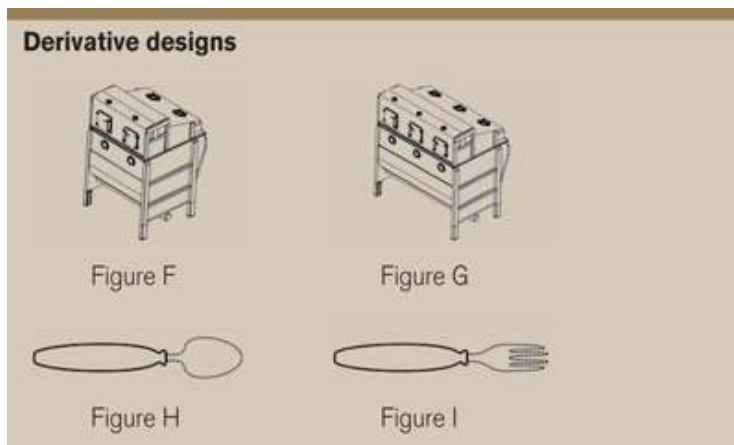
The patent right of a derivative design patent can be enforced independently from other related design patents, and the derivative design patent has its own scope of similarity (protection). The scopes of similarity of the original design patent and the derivative design patent should overlap in their shared core design concept. Accordingly, a derivative design patent is independent from, but expires on the same date as, its original design patent. The same person cannot file a derivative design patent application in which the design is similar to that in another related design patent application but dissimilar to that in the original design patent application. The rationale here is to avoid unreasonably extending the original design patent's scope of similarity.

Furthermore, the filing date of a derivative design patent application cannot be earlier than that of the original design patent application. A derivative design patent application also cannot be filed after

issuance of the original patent application. In other words, a derivative design patent application shall be filed while the original patent application is pending. A design patent application can be converted into a derivative design patent application and vice versa. The filing date of the converted patent application is the same as that of the design application before the conversion.

Different types of derivative designs

As mentioned above, for similar designs, one can be designated as an original design and the others as derivative designs. The term "similar designs" means: (1) similar designs embodied in the same article (see figures F and G below in which the two stoves differ only in their number of components); (2) identical designs embodied in similar articles (see figures H and I below in which the same design (handle) is respectively embodied in a spoon and a fork); and (3) similar designs embodied in similar articles.



Dealing with priority documents

Under the new patent practice, to meet the one-embodiment requirement, if a priority document (such as a US priority document) contains multiple embodiments, the applicant for the corresponding Taiwan patent applications needs to decide whether to file one embodiment as the original and the rest as derivative design patent applications of the original, or to file separate independent design patent applications for each embodiment at the beginning. Alternatively, the applicant can wait until an office action has been received to respond (i.e. by designating one embodiment as the parent and filing divisional applications covering the rest, or by choosing one as the original and converting the rest to derivative design patent applications).

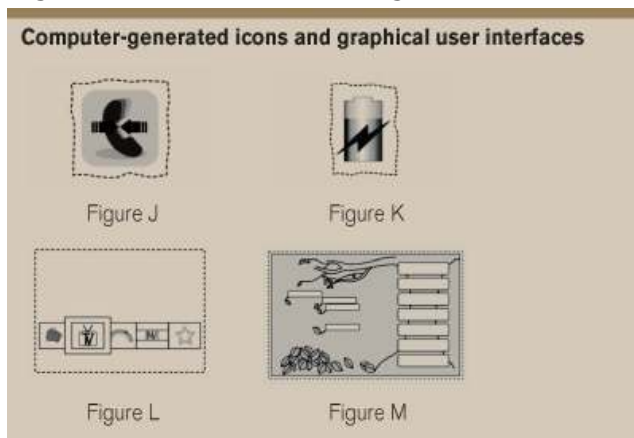
Although such decisions should be made case-by-case, it is generally advisable to initially file an original and derivative design patent application unless meeting the six-month priority claim requirement is important and there is insufficient time to arrange for such derivative design patent applications. Since a derivative design, like a regular design, has its own scope of similarity, there is no advantage in initially filing separate regular design patent applications for each embodiment. The terms of the separately filed design patent applications will be the same as those of the original and the derivative design applications. Furthermore, if the applicant chooses to file separate regular design patent applications, the examiner may issue an office action (responding to which would incur additional costs) requiring one design patent application to be designated as the original and the rest to be converted into derivative design patent applications if the examiner considers the designs insufficiently distinctive from each other.

Icons and graphical user interfaces

Computer-generated icons and graphical user interfaces (GUI) applied to an article are patentable subject matter under the new patent practice. Icons and GUI are a type of graphic interface that allows users to interact with electronic devices through a display or screen. Unlike traditional patentable design subject matter in which a design is permanently embodied in an article, icons and GUI appear only when the concerned electronic devices are powered on. The term "computer-generated icons" usually refers to a single graphic unit (see figures J and K above), while GUI usually refers to a complete view composed of a plurality of graphic units and a background image (see figures L and M above).

Icons and GUI can be expressed in a static or dynamic form (changeable graphic image design). The latter means that during usage, the appearance of the design varies. For example, when the user moves the cursor to pass through or clicks on an icon or GUI, the appearances vary. For icons or a GUI expressed in a dynamic form, two or more views showing the icons/GUI before and after the change, and/or the key view(s) showing the progresses of the change are required. The sequences of the views showing the dynamic form also need to be indicated in the design description section of the specification. The different views showing different statuses of the icons or GUI should be considered as a whole, and together represent a single design. They cannot be enforced separately.

Design applications involving icons or a GUI can be given titles such as "Icons of screen" or "GUI of display" or, more specifically, "Icons of cell phone" or "GUI of ATM". However, the terms "icons" or "GUI" themselves cannot serve as the title of such an application because they would be considered too vague to reflect the claimed design.



A set of designs

Two or more articles under the same classification and which are customarily sold or used in a set can be filed in a single design application. The term "classification" refers to the main classification of an article's Locarno International Classification. A set of designs is considered as a whole, and each individual design cannot be separately enforced.

Examples of articles that are customarily sold in a set include a tea set (comprising tea cups, a tea pot and a tea tray), a tableware set (comprising knives, forks and spoons), and a hand tool set (comprising drills, wrenches and screwdrivers). Examples of articles that are customarily used in a set include: a jewellery set (comprising finger rings, necklaces, and earrings), a stationery set (comprising pencils, erasers, rulers and a pencil box), and a stereo set (comprising an audio player, speakers and an amplifier).

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Hsiu-Ru Chien graduated from the Zoology Department (now reorganised as the Life Science Department), Science College of the National Taiwan University, and obtained two master degrees respectively from National Chiao-Tung University (Master of Management Science) and National Cheng-Chi University, Department of Law (LLM).



Being an attorney-at-law and also a certified patent attorney, Hsiu-Ru started her patent-specialised career as a patent engineer in the chemical group of the patent and technology department in Lee and Li, and has extensive experience in patent prosecution, patent infringement litigation, patent invalidation actions and administrative remedy procedures. She recently passed the Chinese patent bar exam in 2013. Hsiu-Ru periodically publishes patent law-related articles, especially reviews on Taiwan patent litigation practices, Intellectual Property Court's judgments and developments in Taiwan patent system, in well-known foreign journals such as *World Intellectual Property Report*, and *International Law Office Newsletter*.

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Michael is a counselor in the patent department of Lee and Li. He focuses his practice on patent law, with a particular emphasis on patent infringement assessment, patent validity assessments and design patents. Michael has many years of experience in patent litigation support, patent invalidation/cancellation actions, administrative suits and patent prosecutions in both China and Taiwan. He also drafts Chinese and English patent specifications, prepares responses to office actions and conducts patent searches. Michael was admitted to the bar in New York and Massachusetts in 2005. He has also been a patent attorney (agent) in Taiwan and in China since 1998 and 2012, respectively, and recently passed the Chinese bar exam in 2013. Michael periodically publishes patent law-related articles in both English and Chinese in respected local journals such as the *Taiwan Intellectual Property Right Journal*, *Science & Technology Law Review and National Science*, *Taiwan Patent Attorneys Journal* and *Technology Law Symposium*.

