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Designs

Taiwan Requirements on Comprehensive Disclosure of Partial Design Drawings

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The Taiwan Patent Act requires that the specification and drawings of a design patent application be clear and sufficiently disclose the claimed design so as to enable persons with ordinary skill in the art to understand the design and implement it. In the latest revision of the Patent Act (the 2012 Patent Act), the concept of "a design for a portion of an article (i.e. 'a partial design')" was introduced into the patent system as a legitimate, patentable subject matter.

However, as a "partial design" only involves the appearance of certain segments of an article or the features of the article viewed from only one direction, the question arises as to what degree of disclosure should the drawings of a partial design application provide so that the patent office would consider the disclosure clear and comprehensive. Some observation regarding the practices since the 2012 Patent Act came into force on January 1, 2013 are discussed below.

Claimed Features and Unclaimed Portions

In principle, the drawings of a partial design should include disclosure of the "claimed design features" and illustration of the "unclaimed portion". The "description of design" section in the specification must clearly point out which portions shown in the drawings are not claimed design features. For example, the description of design will typically state: "the portions illustrated by dotted lines form no part of the claimed features" or "the portions inside the boundary formed by chain lines (phantom lines) are those to be claimed and the chain lines themselves are not part of the claimed features," etc.

Perspective and Directional Views

According to the previous version of the Patent Examination Guidelines, "[t]he drawings of a design application have to include one perspective view and six directional views (i.e. front view, rear view, left view, right view, top view and bottom view), or at least two perspective views. The applicant can provide other auxiliary drawings. The drawings of a design application shall each be annotated with a name; if any drawing is omitted because of symmetry, identity or other reasons, the reasons shall be given in the description of drawings in the specification."

The patent office had required that the drawings of a design application include "one perspective view and six directional views" or in other words at least two perspective views so as to disclose the design features of the article visible from all directions. If persons skilled in the art are able to infer the features of one view by referring to another view(s) because of symmetry or identity, the applicant could omit that view and briefly explain why the view was omitted in the specification.

However, the latest version of the Patent Examination Guidelines stipulate that "[f]or a design for a three-dimensional article, the applicant *generally* has to provide a perspective view and other views (such as another perspective view, or six directional views [i.e. front view, rear view, left view, right view, top view and bottom view] etc.), in order to sufficiently disclose the design visible from different directions. If some views only have features which are *not likely to be noticed by consumers during purchase or use, or if the design relates to a layout or for a paper-like article such that the side views do not contain any design feature, these views can be omitted.*"

The new guidelines provide an example that the rear view of say a wall clock could be omitted. In other words, the new Guidelines explicitly provide that if a certain view is not important to consumers during purchase or if it does not contain any design feature, the applicant can state in the specification the reason why that view is omitted.

Nevertheless, in actual practice, there is no clear standard regarding who is in the best position to determine whether the omitted view is one not likely to be noticed by consumers during purchase or use. Currently, in some cases, the patent office accepts the omission of a certain view(s) (for example, the bottom view of a refrigerator). Yet in some other cases, the patent office objected to the omission of certain view(s) (for example, the interior (rear view) of an automobile bumper which only contains features relevant to assembly).

Omission and Explanation

A further question is where the design features applied to an article are only visible in one or two views and the other views do not have design features that the applicant has created or wants to claim in the application. Under these circumstances, can the applicant omit these views and state in the specification why these views are omitted? The answer, interestingly, is no. Current practice still requires that an applicant submit "a perspective view and six directional views" or at least two perspective views that show all the features visible from each direction. The required drawings (views) must at least clearly show the "boundary contour" or "profile" of the article to which the design is applied. A contour or profile that the applicant has no intention to claim must be illustrated with dotted lines and those to be claimed in the application must be illustrated by solid lines.

Comment

Given the above, although the new guidelines seem to allow applicants to omit some unimportant views or views without design features with an appropriate statement in the specification, the patent office still requires that the applicant submit "sufficient drawings (views)" to clearly disclose at least the outer contour/profile and the claimed features regardless of whether each of the submitted views contains design features to be claimed.

To ensure a design application meets formality requirements, it is recommended that the applicant submit drawings which sufficiently disclose all the claimed features and the outer contours/profile visible from six orthogonal views; supplementing the drawings at a later stage could be considered introducing new matters (new design features) and thus be objected to by patent office action, potentially resulting in rejection of the application for insufficient disclosure of the design.