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Taiwan - Intellectual Property

Determining claim scope of Taiwan design patents

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In Taiwan, a design patent can be obtained rather quickly (generally speaking, the patent office takes three to 12 months to substantively examine a design patent application) and almost all kinds of designs applied to articles are acceptable subject matter of design patents (such as a partial or whole appearance of an electronic component, icons or graphical user interfaces (GUIs) displayed on a screen, decoration of a store, etc.).

When a design patent is enforced (for example, the patentee initiates a civil suit accusing a suspected infringer of patent infringement), the claim scope of the asserted design patent must be discussed in the court proceedings. This is because it is required that the claim scope of the design patent be determined before a comparison of the design patent and the accused product is conducted for judging whether the accused product infringes the patent.

'CLAIMED APPEARANCE' AND 'ARTICLE'

The claim scope of a design patent is interpreted mainly on the basis of the claimed design features (i.e. the claimed appearance) shown in the drawings and the article to which the design is applied. Although the Taiwan Patent Act provides that the claim scope of a design patent must be determined based on the drawings of the patent, and that the specification of the patent serves as a reference when the claim scope is interpreted, the title and/or the usage indicated in the specification in fact serves to determine what kind of article the design is applied to; if the article to which a design is applied is an actual car, the claim scope cannot extend to a toy car with the same or similar appearance. However, a design for a component of a truck can extend its claim scope to a component of a car with the same or similar appearance because a truck and a car are under similar usage.

Colours in the drawings of a design patent will also be limitations of the claim scope if no disclaimer is made in the specification. In practice, if colours are clearly disclaimed in the specification initially filed with the patent office, the applicant will need to amend the drawings by changing the colours to greyscale.

BROKEN LINES IN DRAWINGS

Drawings of a partial design contain broken lines, which include "dashed lines" and "dot-dashed lines". In principle, broken lines form no part of a claimed design; dot-dashed lines are generally used to represent the boundary of a claimed portion and unclaimed portion to help clarify the claimed scope.

Nevertheless, broken lines are sometimes used to interpret the article to which the design is applied, or the relation between the design and the environment in which the design is shown. For example, if several icons appear in one display, does their relative location on the screen have to be a limitation?

The answer is "not necessarily". If a number of icons is individually surrounded by broken lines, their relative location on the screen is not a limitation. However, if icons are fixed and together surrounded by broken lines, the relative location is a limitation. Therefore, by taking advantage of broken lines, the claimed features illustrated in solid lines, colors or greyscale may have different claim scopes.

VARIABLE SHAPES OR PATTERNS

If necessary, the “variable shapes and/or patterns” of an article can be included as limitations of the claim scope. For example, if the design of a robot figure would like to not only stress the whole appearance of the figure but also emphasize the variable postures or changeable shapes, two sets of drawings are necessary, one which shows the whole appearance in one posture/state and the other showing the whole appearance in another posture/state. In practice, six-directional views of the two states are required to clearly show detailed design features.

Some designs, such as GUIs, may need to claim the sequence of pattern(s) appearing to one’s view. The design applicant has to submit sufficient drawings and/or present explanations in the specification to clearly specify the desired sequence.

REFERENCE VIEW

Reference views in drawings filed with the patent office serve no basis for interpreting claim scope. However, it is suggested to submit a reference view(s) if the state in use or the application of the design is hard to be understood.

CONCLUSION

Because determining the claim scope of a design is critically important in court cases or in assessment of patent infringement, and also because the drawings and the specification serve to interpret claim scope, most examiners require that a design patent application include sufficient drawings (such as six-directional views) and necessary statements in order to make the claim scope easier to be interpreted.

In principle, intrinsic and extrinsic evidence can be referenced when interpreting a claim scope; however, if the scope still cannot be specified after all measures are taken, the “narrower” scope should be taken according to the latest version of the Patent Infringement Guidelines.

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