Practical Guidance to Users Designating Japan, the Republic of Korea and the United States of America

Seminar on the Hague System for the International Registration of Industrial Designs

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Topics Addressed

- Specific issues to the United States of America
- Specific issues to Japan and the Republic of Korea
- Priority documents
- Reproductions and other common issues

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<td>110</td>
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<tr>
<td>JPO</td>
<td>253</td>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td>USPTO</td>
<td>386</td>
<td>1</td>
<td>0</td>
</tr>
</tbody>
</table>

Source: Internal (unofficial) Statistics
Specific Issues to the USA
USA: Indirect filing and security clearance

The filing date shall be the date on which the Office received the international application, provided that it is received by the International Bureau within one month from that date and the application is governed exclusively by the 1999 Act (Rule 13(3)).

The USA whose law requires security clearance made a declaration to extend the above period to six months (Rule 13(4)).
USA: A single design system

Declaration under Article 13(1):
Only one independent and distinct design may be accepted.
- no examination by IB
- possibility of refusal by USPTO based on this condition
- any patentably distinct design should be eliminated.

Claim: A single claim

Fee (Individual designation fee):
A single fee, although different amounts apply according to the economic status of the applicant

For international registrations, JPO accepts multiple designs and divides them into each application, *ex officio.*
USA: Claim

Through declaration under Article 5(2)

Date of international registration affected

A claim must be provided in a specific wording, that is:

The ornamental design for «product indication» as shown and described.

Point: provide only one claim in item 12 of DM/1 or «claim» item in E-Filing Interface, even for multiple designs.
USA: Provisional rights

- After the date of international publication
  The holder may send a «cease and desist letter» to an infringer, notifying the design claimed in the published international registration; and

- After the grant of design patent
  The holder may sue the infringer for design patent infringement and claim damages dating back to the cease and desist letter.
USA: Individual designation fee

- Article 7(2) for individual designation fee
  - a single fee for a single design
  - but three different amounts
    - for standard, small, or micro entity (with certification)

- Rule 12(3) for designation fee to be paid in two parts
  - first part: at the time of international application
  - second part: upon notice of allowance by USPTO
    - payment for the second part: to IB or USPTO
    - this second part covers the full period of 15 years (no renewal fee)
USA: Payment of the 2\textsuperscript{nd} part of designation fee

(1) Copy of the notice of allowance
(4) Notification for payment, if paid to WIPO
(5) Statement of grant of protection

(1) Original notice of allowance
(2) Notification for payment within 3 months from the mailing date of the notice

(3) PAYMENT

USPTO

WIPO

Holder
USA: Payment of the 2\textsuperscript{nd} part of designation fee

1. Copy of the notice of allowance
2. Notification for payment within 3 months from the mailing date of the notice
3. Non-payment
4. Notification of non-payment
5. Request for cancelation of US designation
6. Notification of cancelation
6. Publication of cancelation

**USPTO**

**WIPO**

**Holder**

(2) Notification for payment within 3 months from the mailing date of the notice
USA: Reduction of the designation fee

- Default: 733 CHF (1st) + 540 CHF (2nd)
- Small entity: 367 CHF (1st) + 270 CHF (2nd)
- Micro entity: 183 CHF (1st) + 135 CHF (2nd)

To claim a micro entity status, certification required by a hard copy (with Annex IV) or PDF (E-Filing))

USPTO Certification forms: (PTO/SB/15A or PTO/SB/15B), available at: [http://www.uspto.gov/forms/aia_forms.jsp](http://www.uspto.gov/forms/aia_forms.jsp).
“Information Disclosure Statement”
- May be submitted to IB (at the time of application only, by a hard copy (with Annex III) or PDF (E-Filing)),
- Or otherwise, must be submitted to USPTO (later)
Form (USPTO): [http://www.uspto.gov/forms/aia_forms.jsp](http://www.uspto.gov/forms/aia_forms.jsp).
USA: Oath or Declaration of the creator

“Declaration of inventorship”

*Required from each of the creators*

- Standard WIPO form (DM/1/I)
  (in English, French and Spanish)

- Electronic WIPO form on E-Filing Interface

- Standard USPTO form
  (in 11 languages)
USA: Oath or Declaration of the creator

“Substitute Statement”
May be used where it is not possible to obtain the signature of the inventor.

- Standard WIPO form (DM/1/I)
  http://www.wipo.int/export/sites/www/hague/en/forms/docs/form_dm_1_annex_I.pdf (in English, French and Spanish)

- Electronic WIPO form on E-Filing Interface

- Standard USPTO form
  http://www.uspto.gov/sites/default/files/forms/aia0002.pdf (in 11 languages)
Specific Issues to Japan and the Republic of Korea
Grounds of refusals by KIPO
(from July 1, 2014 to September 30, 2015)

Number of refusals by KIPO
312 designs
(87 international registrations)

Main grounds of refusals

1. Insufficient disclosure
   163 designs
2. No indication of a creator
   160 designs
3. Similar designs on the same date by the same holder
   (No indication of the related design)
   98 designs
4. Broad indication of a product
   22 designs

Source: Internal (unofficial) statistics
**Grounds of refusals by KIPO**
(from July 1, 2014 to September 30, 2015)

**Insufficient disclosure:** 163 designs (45 international registrations)

- Lack of some views: 133 designs
  - Lack of some of six orthographic views
  - Lack of certain view for a set of an article showing the design comprehensively
- Inconsistency among views: 20 designs
  - Color difference among the views
  - A certain part shown in one view is not shown in other views
  - A certain part shown by solid lines is shown by broken lines in other views
- Ambiguity of certain elements in the representation: 17 designs
  - The broken lines (disclaimed part or stitch)
  - The shading (disclaimed part or pattern)

Source: Internal (unofficial) statistics
### Grounds of refusals by KIPO
**(from July 1, 2014 to September 30, 2015)**

<table>
<thead>
<tr>
<th>Ambiguous/broad product indication</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>X</strong></td>
</tr>
<tr>
<td>Lamp</td>
</tr>
<tr>
<td><strong>✓</strong></td>
</tr>
<tr>
<td>Lamp for table</td>
</tr>
<tr>
<td>Lighting device</td>
</tr>
<tr>
<td>Lamp for table</td>
</tr>
<tr>
<td>Footwear</td>
</tr>
<tr>
<td>Men’s shoes/high-heeled shoes/ slipper/ Sandals, etc.</td>
</tr>
<tr>
<td>Single or multicomponent discharge device</td>
</tr>
<tr>
<td>Device for silicone discharge/Nail discharge device, etc.</td>
</tr>
</tbody>
</table>
What is related design?

DM/086182
What is related design?

- Similar
- Filed by the same applicant
- Filed in appropriate duration

**Design B may be registered as a related design of Design A**

- Filed on the same date
- Filed by the same applicant
- Filed in appropriate duration

**Principal design**

**Related design**

**Design A**

**Design B**

**WIPO | HAGUE**

The International Design System

**KR:** filed within 1 year from the filing date of Design A

**JP:** after the filing date and before the date of publication for design registration of Design A in JP
Exception to lack of novelty: KR, JP

Disclosure of Design A

In an exhibition, published materials such as a magazine, catalog, or through the internet media, etc.

Filing of an IA

- Filing within 6 months from the date of disclosure
- With declaration concerning exception to lack of novelty

Examination by JPO/KIPO

Disclosure of Design A does not become a reason for lack of novelty
Exception to lack of novelty: KR, JP

Supporting document

(Only in KR) After filing, directly to KIPO

• Upon submitting written opinion against notification of refusal
• Upon submitting written refutation against opposition or invalidation
Refusal period for KR

- International classification 2, 5, or 19 → 6 months from the date of publication
  * Class 2 (clothing, footwear), 5 (textile, sheet materials), 19 (stationary)

- Others except for International classification 2, 5, or 19 → 12 months from the date of publication

< Substantive examination >
(Except for class 2, 5, and 19)

- Industrial Applicability
- Definition of design
- Insufficient disclosure
- Novelty
- Creativity
- Not to be any of the unregistrable Design Categories (ex. public order)

< Partially substantive examination >
(Class 2, 5, and 19)

- Industrial Applicability
- Definition of design
- Insufficient disclosure
- Novelty (X)
- Creativity (X)
- Not to be any of the unregistrable Design Categories(ex. public order)
Priority Documents
Original priority documents must be submitted directly to the JPO with in 3 months from the date of publication of the international registration.
Priority documents for KR

- Priority documents can be attached to international application.
- by using Section for declaration claiming the exception to lack of novelty in E-filing interface, under tab “More optional contents or by using Annex II
Priority documents for US

Original priority documents must be submitted **directly to the USPTO**, at the latest before *“the date the issue fee is paid”* (according to Title 37 – Code of Federal Regulations Patents, Trademarks, and Copyrights (37 CFR) §1.55, paragraphs (g)(1) and (m)).
Reproductions and Other Common Issues
Definition of design; Reproductions: Refusal grounds

- **Formal grounds**: certain types of «views» required through a declaration under Rule 9(3)(a)

- **Substantive grounds**: definition of an industrial design in accordance with Article 12(1) under the 1999 Act
  - Type of design not protected (ex. “logo”)
  - Disclosure insufficient to figure out the design, justified by Rule 9(4)
Specific views: Declaration under Rule 9(3)(a)

No requirement as to the types of views. A single reproduction is enough.

- One perspective view
- Front view + top view + right side view
- Front view + one perspective view
- etc.

The law of the CP

If the law provides for certain types of views that must be submitted, the CP may specify, in the declaration, the views required and the circumstances in which they are required.

- Six orthographic views
  (Front view + Top view + Right side view + Left side view + Rear view + Bottom view)
- Two perspective views showing a whole appearance of the product
- etc.
A CP may not issue a refusal on the ground that requirements relating to the form of the reproduction that are additional to, or different from, those specified in the declaration under Rule 9(3)(a) have not been satisfied.

However, it may issue a refusal, on an individual case basis, on the ground that the reproductions contained in the international registration do not sufficiently disclose the industrial design.
Declaration under Rule 9(3) by JP

- Six views
  - front view, back view, top view, bottom view, left view and right view
  - by the orthographic projection, are required
A design of a set of articles
one view of the coordinated whole and/or corresponding views of each of its components

KR 30-0728275 (Set of table with chair for outdoor use)

- Six views with perspective views were included for A, B, and C, respectively)
Declaration under Rule 9(3) by KR

Typefaces
views of the given characters, a sample sentence and typical characters

KR 30-0576060 (English typeface)

A B C D E F G
H I J K L M N
O P Q R S T U
V W X Y Z

a b c d e f g h i j
k l m n o p q r
s t u v w x y z

The quick brown fox jumped over the lazy dog
The quick brown fox jumped over the lazy dog

(52 given characters)  (sample sentence as with above)  (typical characters as with above)
Definition of the industrial design

KR: …the shape, pattern, or color, or a combination of these of an article ...(including part of an article...and font..), which produces an aesthetic impression in the sense of sight

JP: …the shape, patterns or colors, or any combination thereof, of an article (including a part of an article…), which creates an aesthetic impression through the eye

US: …new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

- Movable property which can be independently transacted
- In relation to the appearance of a product
- immovable property, such as real estate, etc.
- Class 32 (graphic symbols, logos, surface patterns, get-up, etc.)
Reproductions - three dimensional designs

JP: six views (front, back, top, bottom, left, right) are mandatory
KR, US: six views are recommended, not mandatory

Depending on the actual shape, additional view(s) are necessary to fully disclose the designs.

DM/086182

Perspective

- Cross-sectional
- Exploded
- Enlarged

etc.
Reproductions – additional view(s)

Perspective

Exploded

Cross-sectional

Enlarged

Illustrations from: PROPOSAL FOR RECOMMENDATIONS RELATING TO THE DISCLOSURE OF AN INDUSTRIAL DESIGN IN AN INTERNATIONAL APPLICATION (H/LD/WG/5/4)
Reproductions – shading and description

Shading can be shown on the reproductions, but should be explained in the description.

Description:
The thin lines which are shown on the perspective view are shading for specifying its shape and illustrative purposes only.

Description:
The shading shown on the all reproductions is for specifying its shape and illustrative purposes only.

«Description for the above purpose»
JP: required
KR: recommended
US: may not be necessary
Reproductions - partial designs

All appearance of a product should be shown in reproductions, even if it is a partial design.

Reproductions:
Show disclaimed part(s) in dotted or broken lines or coloring.

Descriptions:
The parts which are shown in the dotted lines form no part of the claimed design.

JP: required
KR: recommended
US: may not be necessary
Reproductions - two dimensional designs

JP, KR: front view + back view (or description)

Handkerchief

Front

Back

Description:
“back view has same pattern”
or
“back view has no pattern”

cf) KIPO considers that back view has no pattern if front view is only submitted (Oct. 1, 2015)

*Product(s) which has an overlapping part Will be considered as three-dimensional design (six views needed)

Ex) Envelop

Illustration from “Guide for the way to make documents and drawings for design applications”, Japan Patent Office
1 design or 2 designs?

If one of the reproductions are black and white drawings and the others are in color, it could be considered as 2 different designs.
Thank You

www.wipo.int/hague/en