Follow-up after the Accession of 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:

- Statistics
- Main Grounds of Refusals
- Issues Specific to the USA
- Issues Specific to Japan and the Republic of Korea
- Priority Documents
STATISTICS
Grounds of refusals by USPTO
(from January 1st, 2016 to July 31st, 2016)

Source: Internal (unofficial) statistics

Number of refusals by USPTO

320 designs (100.0%)
(112 international registrations)

Main grounds of refusals

1. Unity of design issue
   261 designs (81.6%)
2. Other Grounds
   99 designs (30.9%)
3. Insufficient disclosure
   72 designs (22.5%)
4. Definition of design
   4 designs (1.3%)
Grounds of refusals by JPO
(from January 1st, 2016 to July 31st, 2016)

Number of refusals by JPO

303 designs (100.0%)
(134 international registrations)

Main grounds of refusals

1. Insufficient Disclosure
   149 designs (49.2%)
2. Lack of Novelty
   112 designs (37.0%)
3. Ambiguous/broad indication of product
   53 designs (17.5%)
4. Definition of Design
   29 design (9.6%)
Grounds of refusals by KIPO
(from January 1st, 2016 to July 31st, 2016)

Number of refusals by KIPO

832 designs (100.0%)
(252 international registrations)

Main grounds of refusals

1. Insufficient disclosure
   563 designs (67.7%)

2. Conflicting Application/Registration
   151 designs (18.1%)

3. Lack of Novelty
   93 designs (11.2%)

4. Lack of creativity
   73 designs (8.8%)
MAIN GROUNDS OF REFUSALS
Definition of the industrial design

- **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

  35 U.S.C. 171 (Patents for designs)

- **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**

  Article 2 (1), Japanese Design Act

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

  Article 2, Korean Design Protection Act

- **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.)
What is a sufficient disclosure of the design?

US: The claimed invention should be described in such full, clear, concise, and exact terms as to enable any person skilled in the art... to make and use the same... and particularly point out and distinctly claim the subject matter which the inventor... regards as the invention. (paraphrase of 35 US Code 112 (a) and (b))

JP: The design for which the design registration is requested ... must be one for which contents of a specific single design, ...(i) and (ii) below, can be directly derived from the statement in the application and drawings..., predicated on the ordinary skill in the art of the design.

(i) The usage and function based on the purpose of use, state of use, etc.
(ii) The form of the article to the design (21.1.2, Design Examination Standards)

KR: Industrial design should be fully disclosed at the level that an ordinary skilled person in the art can make almost same product through reproductions submitted. (Design Examination Guidelines, p83)
What causes the disclosure of the design to be insufficient and the representation of the design to be unclear?

- Lack of a sufficient number of views
- Lack of /or inadequate surface shading
- Lack of consistency among the views
- Lack of a description to clarify the scope of protection
Lack of a Sufficient Number of Views

- Six views:

  JP: Front, back, top, bottom, left, right view by the orthographic projection method are mandatory *(Declaration under Rule 9 (3))*
  KR, US: Six views are recommended, not mandatory
Lack of a Sufficient Number of Views

The appearance of the right, back and bottom side are unclear from the views 1.1 to 1.4. With the addition of views 1.5 to 1.7, the appearance is fully disclosed.

Indication of product: “Bookstand”

Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices
Lack of / or Inadequate Surface Shading

The exact contours of the product and the specific portions of the product for which protection is sought are unclear without surface shading.

Indication of product: “Pharmaceutical tablet”
Lack of / or Inadequate Surface Shading

Adequate and proper surface shading clarifies the contours of the design and the scope of protection sought.

1.1 Perspective

1.2 Top

1.3 Bottom

1.4 Front

* JP: submitting sectional views or perspective views to represent relief or contours of surfaces of the product is a more preferable way than providing shading.
Lack of Consistency among the Views

- Example (1):

Original

![Original View](image)

Amended

![Amended View](image)

DM/086312 (design 5) Mounting platform for installation on inflatable products (class 08-08)
Lack of Consistency among the Views

- Example (2):

Original

Amended

Repro. 2.1 (deleted)

DM/086614 Handbag (class 03-01)
Lack of a Description to Clarify the Scope of Protection

- Legend OR Description of each view is highly recommended

- Special Description (when necessary):
  - To describe omitted views
  - To describe broken lines (unclaimed portions, boundary lines, stitching, fold lines, etc.)
  - To describe color (unclaimed portions of the design)
  - To describe enlarged, sectional or cross-sectional views
  - To describe surface shading
Example of descriptions to clarify the design and scope of protection:

Legends/Descriptions
1.1) Top, front, perspective view, 1.2) Bottom, rear, perspective view, 1.3) Exploded view, 1.4) Enlarged front view of 1.1, 1.5) Cross-sectional view*, 1.6) Top view of the inner box

- The blue colored portion of the inner box forms no part of the claimed design.
- The bottom view of the inner box is omitted since it is flat and unornamented*.

* US, JP, KR: it is recommended to identify the location of the cross-section (ex. “cross-sectional view taken through front to back center”)

* JP: even if a view only shows a flat and non-ornamental surface, it is not allowed to omit said view
- Example of descriptions to clarify the design and scope of protection:

1.1

**Descriptions for visually different types of broken lines:**

- The evenly spaced broken lines illustrate the portions of the vehicle tire that form no part of the claimed design;
- The dot-dashed broken lines indicate the boundaries of the claimed design and form no part of the claimed design.

**Evenly spaced broken lines**

**Dot-dashed broken lines**

**DM/088295: Vehicle tire**
Example of descriptions to clarify the design and scope of protection:

1.1

Reproductions *:
Full appearance of a product should be shown in reproductions, even though protection is sought only for a certain part of it

* JP, KR: required; US: may not be necessary

1.2

Description *:
The parts shown by means of broken lines in the reproductions are not part of the claimed design

* JP, US: required; KR: recommended
Example of descriptions to clarify the design and scope of protection:

Reproductions with shading, hatching, dots or lines to represent relief or contours of surfaces of a three-dimensional product

Description *: The parallel thin lines and the radial thin lines in the representation represent contours only and do not illustrate an ornamentation or decoration on the surface of the product.

* JP: required; KR: recommended; US: may not be necessary
Ambiguous or Broad Product Indication

- Examples:

- ✓ Writing instrument (D088877) → **Ball-point pen** (class 19-06)

- ✓ Lighting device (D084385) → **Standard lamp** (class 26-05)

- ✓ Cycle → **Bicycle, Motorcycle** (class 12-11)
Ambiguous or Broad Product Indication

- **Examples:**
  - Handset (D088186) → **Mobile phone** (class 14-03)
  - Sports installation (D089511) → **Boxing ring** (class 25-03)
  - Portable sound system (D087842) → **Portable speaker** (class 14-01)
Guidance on Preparing and Providing Reproductions

Available from 10 August 2016 at:

ISSUES SPECIFIC TO THE USA
Unity of Design

- Declaration under Article 13(1)

**A single independent and distinct design:**
Up to 100 designs may be filed in an application, though patentably distinct designs will be divided out by the United States Patent & Trademark Office (USPTO)

**DM/087136:** Designs 1,3,4: “Table”; Designs 2,5: “Part of a table”
Unity of Design

- Distinct designs and Distinct scope of protection

Group 1

Group 2

Group 3

Group 4

Group 5

DM/087136: Designs 1,3,4: “Table”; Designs 2,5: “Part of a table”
Unity of Design

- Indistinct designs or obvious variations:

DM/087960: Designs 1-8 “Storage Boxes”
Unity of Design

- Indistinct designs or obvious variations:

<table>
<thead>
<tr>
<th>Group 1: Designs 1-4</th>
<th>Group 2: Designs 5-8</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.png" alt="Group 1 Designs" /></td>
<td><img src="image2.png" alt="Group 2 Designs" /></td>
</tr>
</tbody>
</table>

Designs grouped together have the same basic design characteristics:

- similar in overall appearance
- similar in visual impression
- similar in shape/configuration
Representations of the Design

- Ink/Line Drawings OR
- Photographs OR
- Computer graphic representations

Photographs and ink drawings are not permitted to be combined as formal drawings in one application. US: 37 CFR 1.152

Images: DM/087530: “Motor Car”; DM/087324 “Parts of lamps”
ISSUES SPECIFIC TO JAPAN AND THE REPUBLIC OF KOREA
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
- or

KR: filed within 1 year from the filing date of Design A
JP: after the filing date and before the date of publication of the application for design registration of Design A in the design bulletin in JP

DM/084369
Exception to Lack of Novelty: JP, KR

Disclosure of Design A

- Design A

Disclosure of Design B

- Design B

Filing of IA

International application

- Design A

Examination by JPO/KIPO

- Design A

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

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

- Same/similar/any
- Disclosed by the creator or applicant (the person who had the right to obtain a design registration when disclosure was made)
Exception to Lack of Novelty: JP, KR

Supporting document

Directly to JPO (original document) within 30 days after publication

JP

International publication Notification for refusal Grant of protection

KR

Submit to IB At the time of filing

Directly to KIPO within 2 months from the date of receiving notification of refusal

Opposition

Invalidation

Directly to KIPO within 1 months from the date of receiving notification of opposition or invalidation

(Only in KR) After filing, directly to KIPO

• Upon submitting written opinion against notification of refusal
• Upon submitting written refutation against opposition or invalidation
A design of a set of articles
one view of the coordinated whole and 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)

(52 given characters)  The quick brown fox jumped over the lazy dog
(sample sentence as with above)

(typical characters as with above)
Declaration under Rule 18(1)(b) by KR

- **Extension to 12 months of refusal period**
  - Class 2, 5, or 19 → **6 months** from the date of publication
    *Class 2 (clothing, footwear), 5 (textile, sheet materials), 19 (stationary)*
  - Others except for class 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)
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)).
Original priority documents must be submitted directly to the JPO within 3 months from the date of publication of the international registration.
Priority Documents for KR

- In country A: Design A
  - Same as or similar to Design A

- International application: Design A with priority claim
  - Designation: KR
  - Within 3 months

- International publication
  - Direct submission to KIPO (paper or online)
  - Design B does not become a ground of refusal

< Interim measure agreed with KIPO >

- Priority documents can be attached to international application
  - by using E-filing interface, under “Priority” tab or by using Annex II.
Thank You

For more information, visit http://www.wipo.int/hague/en/faqs.html

For country specific, general information, visit: