

# 2021 Study Question - Q278 - Industrial designs and the role of prior art

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## Introduction

- 1) This Study Question concerns the role of prior art with respect to Industrial Designs (“designs”). Around the world, there are varying definitions of novelty in view of applicable prior art and varying applications of such applicable prior art.
- 2) This Study Question aims to investigate those definitions and applications, with a particular focus on the defining quality that identifies art as applicable prior art.

Why AIPPI considers this an important area of study

- 3) AIPPI has previously studied aspects of the subject matter of designs of this Study Question. However, AIPPI has no recent Resolutions on the rules governing the scope of novelty (and other requirements for protection) and specifically on the role of prior art with respect to designs.
- 4) The current differing definition of novelty or other requirements for protection in view of prior art in different jurisdictions brings uncertainty and unpredictable results when strategizing, filing, prosecuting, and later enforcing a design application in multiple jurisdictions.
- 5) During the AIPPI World Congress in October 2020, a Virtual Roundtable entitled “Should there be an option to have applications for European design registrations to be substantively examined” effectively highlighted the large gap between the design patent and registration systems of various countries, and the stark difference of if, rather than what, prior art is used to show an absence of a requirement for patenting or registration.
- 6) AIPPI is also regularly represented in fora where it is desirable for AIPPI to be able to voice a position on the basis of an AIPPI Resolution concerning those issues.

Previous work of AIPPI

- 7) In the Resolution on Q263 – “Partial Designs” (Cancun, 2018), AIPPI resolved for “uniform methods of defining the Claimed Part of Partial Designs graphically, by disclaimer or otherwise” and “addresses the role and relevance of the Unclaimed Part and the Surrounding Context.” The Resolution states that the “validity and scope of protection of the Partial Design is assessed through the eyes of that relevant observer of that Product, considering exclusively the Claimed Part.” The Resolution further addressed that “in the assessment of the overall impression created by a prior design (validity) and an accused product (infringement), the Surrounding Context need not be excluded.”
- 8) In the Resolution on Q250 – “Requirements for Protection of Designs” (Milan, 2016), AIPPI resolved that “design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) (Appearance) of an object or article of manufacture as a whole (Product)” and that in the assessment of the scope of protection of a registered design, “no visual portion of the Appearance of the Product should be excluded from consideration, even if the appearance of any such portion is dictated solely by the functional characteristics or functional attributes of any such portion of the Product” and while “the functional characteristics or functional attributes of any such portion should not be protected, all visual aspects of such portion, including its size, position and spatial relationship relative to the Appearance of the Product, should be taken into account when assessing the scope of protection of the Registered Design.”
- 9) In the Resolution on Q231 – “The Interplay between Design and Copyright Protection for Industrial Products” (Seoul, 2012), AIPPI resolved that “copyright and design right protection of industrial products may be excluded in so far as the shape or appearance of the product is dictated exclusively by functional considerations”.
- 10) In the Resolution on Q148 – “Three-dimensional marks: the borderline between trademarks and industrial designs” (Sorrento, 2000), AIPPI resolved that “3D shapes are protectable both as industrial designs and as trademarks, provided that the usual requirements for each modality of protection are satisfied.” More specifically, AIPPI resolved that “to be protected as an industrial design, the 3D shape must be new, though the standard of novelty is not the same in every country or territory, for instance [ ] some jurisdictions requiring worldwide novelty and others requiring only local novelty.”
- 11) In the Resolution on Q108A – “Protection of Designs and Models in the EC” (Tokyo, 1992), contrary to the EC Commission proposal, AIPPI resolved that the proposed definition that a design shall be protected as a Community Design to the extent that it is new and has an own individual character is not satisfactory and the “characterising feature” ought not to appear as another requirement in addition to novelty. As explained by AIPPI, novelty is the “only criterion” for protection and the concept of “individual character” ought to be a “qualification” of design novelty. Further, contrary to the EC Commission proposal, AIPPI resolved in favor of a system of absolute novelty, in time and space, without taking into account whether or not the earlier object in question is known to certain people. AIPPI

confirmed its agreement for a grace period to allow industry time to test the market, and clarified that the grace period is not a priority right such that an intervening publication by a third party constitutes an anticipation which destroys novelty.

12) In the Resolution on Q73 – “Legal and Economic Significance of Design Protection” (Moscow, 1982; Paris, 1983; Rio de Janeiro, 1985), AIPPI resolved “the appearance of an industrial object may be protected as an industrial design or model; this appearance may result among other things from an assembly of lines or colors, from the shape of the article itself or from its ornamentation.” AIPPI resolved the novelty is “essential for valid protection” and that it is to be an absolute novelty, “both territorially and timewise.” AIPPI further resolved for instituting a grace period of 6 months for the benefit of “an author” so that the author can apply for registration of the design or model after the author disclosed it. AIPPI further resolved that it “desires that the priority period effective for designs should be modified from six months to one year.”

13) In the Resolution on Q34 – “International Protection of Works of Applied Art, Designs and Models” (London, 1960; Salzburg, 1964; Tokyo, 1966), AIPPI resolved some basic conditions of protection including that protection of a design may be refused if the design corresponds to an earlier design or “involves no creative effort relatively thereto.” Further, AIPPI resolved that the deposit or registration in an examining country “shall give protection not only against exact reproduction but also against any substantial copying and wrongful reproduction by any means.”

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Scope of this Study Question

- 14) This Study Question concerns what is considered prior art and the role that prior art plays in determining requirements for protection, e.g., novelty, individual character, etc. of a design.
- 15) This Study Question also addresses the role of prior art on the determination of infringement and the scope of the protection of a design right.
- 16) The following areas are assessed in order to achieve a base understanding of the role of prior art with respect to designs:
- a) whether there is protection for an unregistered, registered, or patented design right;
  - b) whether prior art is used to assess requirements for protection of a design during prosecution, and if so, on what basis: novelty, originality, individual character, and/or other;
  - c) whether prior art is used to assess requirements for protection such as validity of a design during enforcement, and if so, on what basis;
  - d) the definition of the type(s) of disclosure that renders art as "prior art", including which material can serve as prior art and what disclosure (level, time, place) is necessary so that the material can serve as prior art;
  - e) the exceptions or defenses available that prevent disclosure of art from rendering it as prior art, such as a confidentiality agreement, limited access, experimental use, exhibition, related inventorship, grace period, with respect to a design; and
  - f) the influence of prior art in assessing infringement/scope of protection of a design, for instance, where there is a crowded field, i.e., numerous prior art, vs. an empty field, i.e., very few prior art.
- 17) This Study Question does involve consideration of those jurisdictions in which there is protection for unregistered designs, for the sake of information in understanding the scope of protection and enforcement.
- 18) This Study Question does not include consideration of protection by copyrights, trade marks and trade dress. Earlier Study Questions, mentioned above, concern the interplay between designs and trade marks and designs and copyrights.
- 19) This Study Question does not include a focus on the intricacies of the relationship with "utility" and functional patents.
- 20) This Study Question acknowledges that terminology can differ between the jurisdictions, e.g., design registration vs. design patent. As used herein, the term design includes an unregistered and a registered or patented intellectual property right that protects the outward appearance or ornamentation of an object or article of manufacture. Where a jurisdiction's definition expands on "object" or "article of manufacture" to include, e.g., a graphical user interface ("GUI"), such expansion is useful when applying specific types of prior art and should be identified herein where applicable.

## Discussion

### Paris Convention and TRIPS

- 21) Pursuant to Article 5 of the Paris Convention, designs shall be protected in all countries of the Union.
- 22) Article 25 of the Agreement on Trade-related aspects of Intellectual Property Rights (TRIPs) requires that Member States provide for the protection of independently created industrial designs that are new or original.
- 23) Article 25 further allows Member States to provide that
- "designs are not new or original if they do not significantly differ from known designs or combinations of known design features" and that "such protection shall not extend to designs dictated essentially by technical or functional considerations."

### Requirements

- 24) In the European Union Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs, Article 3(a) defines a design as

“the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation”.

Article 4(a) provides that a design shall be protected by a Registered Community Design to the extent that it is new and has individual character. Article 5.1 provides that a design shall be considered to be new if no identical design has been made available to the public. Article 5.2 provides that:

“Designs shall be deemed to be identical if their features differ only in immaterial details”.

Article 7 of the Regulation further provides:

1. For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.
2. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:
  - a. by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and
  - b. during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.
3. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

25) The Court of Justice of the European Union (“CJEU”) has addressed the notion of prior art in a number of decisions. For instance, in its *Gautzsch/Duna* decision the CJEU states that:

“it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector.” (para. 30)

The CJEU further states that:

“an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.” (para. 44)

Furthermore, disclosure outside the EU can be relevant:

“(…) it should be pointed out (….) that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public.” (para. 33)

26) In *Senz/Impliva*, the General Court considered disclosure outside the EU:

“27. Moreover, the presumption provided for in Article 7(1) of Regulation No 6/2002 applies irrespective of where the events constituting disclosure took place, since it can be seen from the wording of the first sentence of Article 7(1) of Regulation No 6/2002 that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public (judgment of 13 February 2014 in *H. Gautzsch Großhandel*, C-479/12, ECR, EU:C:2014:75, paragraph 33).

(…)

29. In order to carry out the assessment referred to by the Court of Justice, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their

interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.

(...)

39. (...) the conclusion is therefore that the applicant has failed to establish sufficiently that the circumstances of the present case prevented the circles specialised in the sector concerned from learning of the publication of the earlier patent on the USPTO website and thereby learn of the patent. Accordingly, the Board of Appeal did not err in finding that the earlier patent had been made available within the meaning of Article 7(1) of Regulation No 6/2002."

27) In the Easy Sanitary Solutions/Group Nivelles decision, the CJEU discussed further aspects of prior art, in particular regarding the identification of specific designs and the relevance of prior art from other sectors:

"61. (...) it should be added that, by requiring that, in order for a design to be considered to be new, 'no identical design has been made available to the public', that provision implies that the assessment of the novelty of a design must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously (see, by analogy, regarding Article 6 of Regulation No 6/2002, judgment of 19 June 2014, Karen Millen Fashions, C-345/13, EU:C:2014:2013, paragraph 25).

(...)

96. (...) a Community design cannot be regarded as being new, within the meaning of Article 5(1) of that regulation, if an identical design has been made available to the public before the dates specified in that provision, even if that earlier design was intended to be incorporated into a different product or to be applied to a different product. The fact that the protection granted to a design is not limited only to the products in which it is intended to be incorporated or to which it is intended to be applied must therefore mean that the assessment of the novelty of a design must also not be limited to those products alone. (...)

(...)

103. Thus, the General Court was right to hold (...) that the 'sector concerned', within the meaning of Article 7(1) of Regulation No 6/2002, is not limited to that of the product in which the contested design is intended to be incorporated or applied."

28) In the United States of America (US), 35 U.S.C. §171 provides statutory basis for "design patents" reciting that "whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor (...)". 35 U.S.C. §102 provides for the conditions for patentability, including novelty and loss of right to patent, as well as exceptions, reciting:

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person. (...)

29) In the US, 35 U.S.C. §103 provides for the conditions for patentability and non-obvious subject matter, reciting an

“ordinary skill in the art” standard.

30) In a recent US case, *Campbell Soup Company v. Gamon Plus, Inc.*, 939 F.3d 1335 (Fed Cir 2019), the US Federal Circuit Court of Appeals set forth the long-standing §103 obviousness inquiry from *In re Rosen*, 673 F.2d 388 (C.C.P.A. 1982), which asks “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” In applying, the court explains that, for designs, the fact finder first must find a single reference to serve as the primary reference whose design characteristics are “basically the same” as the claimed design. Further, the court recites that “[t]o identify a primary reference, one must: ‘discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression,’” (citing *Durling v. Spectrum Furniture*, 101 F.3d 100, 103 (Fed. Cir. 1996)). If a primary reference exists, then related secondary references can be used to modify it for use as prior art.

31) In *Campbell Soup*, the question arose whether the Linz reference (see below) could be used as a primary reference, even though it did not include the can / cylindrical object as a part of its claimed design.

32) In *Campbell Soup*, the court highlights, *inter alia*, that the parties did not dispute that the Linz reference’s claimed design is for dispensing cans, and that a can would be used in the claimed design. In responding to the further issue that the intended dimensions of a can or cylindrical object differ between the two designs, the court states that “the ever-so-slight differences in design, in light of the overall similarities, do not properly lead to the result that Linz [reference] is not ‘a single reference that creates ‘basically the same’ visual impression as the claims designs.” (emphasis added; internal citations omitted).

33) Accordingly, since the court further found that the parties did not dispute that the Linz reference’s design is made to hold a “cylindrical object in its display area,” the court vacated the U.S. Patent Trial and Appeal Board’s (“PTAB”) finding that the Linz reference could not be held as a primary reference, and remanded the case. The PTAB has since issued its Judgment (Final Written Decision on Remand) on July 29, 2020.

34) It is recognized that various seminal case law, including, e.g., *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) for at least the US analysis, for this Study Question may be critical to the understanding of the role of prior art.

35) In China’s Patent Law, Article 23 provides that

“Any design for which a patent is granted shall not be attributed to the existing design (...) [d]esigns for which the patent right is granted shall be distinctly different from the existing designs or the combination of such designs (...) For the purposes of this Law, existing designs shall mean designs that are known to the public both domestically and abroad before the date of application.”

In China, design patent applications are not substantively examined prior to registration; thus, in order to understand the role and scope of prior art, one must look into the invalidation proceedings where novelty and distinctiveness over the challenging prior art is determined, or through the patentability evaluation report that is produced by the patent office per the request of the patentee or any interested party. Certain exceptions regarding prior art are available, including public disclosures made up to 6 months before the application filing, if the invention was: exhibited by the applicant for the first time at an international exhibition sponsored or recognized by the Chinese government, made public for the first time at a prescribed academic or technology-related meeting, or divulged by others without the consent of the applicant. The Chinese patent law concerning design patents is changing in 2021, with changes that can affect the application of prior art, e.g., recognition of domestic priority and partial designs.

## Current law practice

Please answer the below questions with regard to your Group's current law and practice.

References to a "design" below are to be read as referencing the intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture, irrespective of what it is called in your jurisdiction.

Note: If your answer(s) to Q1) to Q3) below is (are) the same as your answer(s) in reply to the 2016 Designs Study Question, you may simply refer to those answer(s).

1) a) Does your Group's current law provide for an intellectual property right (other than copyright, trade marks or trade dress), that specifically protects the outward appearance or ornamentation of an object or article of manufacture or other? \*

YES

NO

b) If YES to Q1. a), please identify that law and explain what that right is called. (e.g., registered design, industrial design, design patent, etc.). \*

The Design Protection Act (1970:485)

The right is called design. Protection is obtained by registration.

Unregistered designs enjoy protection in Sweden under the EU Community Design Regulation

2) Please identify what features of the outward appearance or ornamentation are taken into consideration for a design, e.g., shape/contour, surface, texture, color, etc. \*

"Design" = the appearance of the whole, or a part of, a product, resulting from the features of the product itself or of the features of the ornamentation of the product, relating especially to the lines, contours, colours, shapes, textures or materials.

3) a) Is prior art used to assess requirements for protection of a design prior to registration/issuance of a design, i.e., during substantive examination by an Intellectual Property ("IP") Office? Please answer YES or NO. \*

YES

NO



If you have answered YES to Q3.a), please proceed to answer Q3.b). Otherwise, please proceed to Q4) b) Referring to Q3.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply. \*

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other: None

c) Referring to Q3.a) to Q3.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context. \*

Not applicable

4) a) Is prior art used to assess requirements for protection of a design when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO. \*

- YES
- NO

If you have answered YES to Q4.a), please proceed to answer Q4.b). Otherwise, please proceed to Q5). b) Referring to Q4.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply. \*

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other: .....

c) Referring to Q4.a) to Q4.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context. \*

The Design Protection Act (1970:485), preparatory works to the Design Protection Act, and case-law from Swedish courts. The Act does not define prior art as such, but indirectly through the definition of novelty and individual character.  
.....

5) a) Is prior art used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q3) and Q4)? Please answer YES or NO. \*

- YES
- NO

If you have answered YES to Q5.a), please proceed to answer Q5.b). Otherwise, please proceed to Q6). b) Referring to Q5.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply. \*

- Novelty
- Originality
- Individual character
- Non- obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other: .....

c) Referring to Q5.b), please indicate in which context these requirements for protection are taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q3) and Q4). \*

Third party (e.g. an infringement defendant) questions the validity of the registration (the registered design).  
.....

d) Referring to Q5.a) to Q5.c), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context. \*

The Design Protection Act (1970:485), preparatory works to the Act, and case-law from Swedish courts. The Act does not define prior art as such, but indirectly through the definition of novelty and individual character.  
.....

6) a) Do your national/regional laws or guidelines provide different definitions of prior art or indications of what qualifies as prior art for registration/issuance, validity, infringement, or other? Please answer YES or NO. \*

YES

NO

b) If YES to Q6.a), please briefly identify the differences, if not readily apparent from your responses to Q3) to Q5). \*

Not applicable

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### Criteria of prior art

7) a) What are recognized means of disclosure, i.e., which materials /documents etc., can constitute prior art? \*

The Design Protection Act:  
Pictures of the prior art, models

CP10:  
Internet; webpages, social media, app from internet, mobile phone etc

The most important is to recognize what (the clear image of the object/design is required) and when and where the object has been made public. Any means could be relevant e.g. websites, brochures, advertisements, or newspaper articles but even exhibitions (documentation from an exhibition).

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b) Does the prior art have to be “printed” and if so, what does that mean? \*

Not necessary, you can also send in a model och recording if there are technical solutions to support that (CP10).

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c) Does the prior art have to be “published” and if so, what does that mean? \*

The prior art has to be known before the application date. (see question 7a) The law mentions (3 § Design Protection Act) publication or otherwise displayed or used in business or any other way that made the design known.

d) Have there been any recent updates or clarifications of prior art in your jurisdiction focused on intangible or other non-“printed” materials? Please provide those updates \*

Convergence Program 10 (EUIPO) [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/News/cp10/CP10\\_sv.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/News/cp10/CP10_sv.pdf)

### Time of disclosure

8) a) What is the relevant date of a prior art reference? \*

Before the application date

b) Are design applications published, and if so, when? \*

All applications are published, except those that are kept confidential (if requested by the applicant).

c) When and how are issued design patents or registered designs published? \*

The registered designs are published and announced immediately after the decision on registration.

d) Does the publication of an issued design patent or registered design effect a publication of the underlying design application if not previously published? \*

We are not sure exactly how to read the question, but design applications are publicly available from the day they are submitted unless the applicants in the application requests that the application should be kept confidential. If a previous design application was confidential and the application was denied or the applicant revokes the application, the application was never made available to the public. If the application was not confidential, but never published it, may be considered that it was made available to the public and therefore prior art.

### Circumstances of disclosure

9) Are the circumstances of disclosure relevant, e.g. (please tick all boxes that apply): \*

- geographic location
- sector / type of productis
- the person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc)
- the recipient of the disclosed prior art
- Other: misuse (3 a§ Design Protection Act)

### Grace period

10) Does your jurisdiction provide a grace period after a first public disclosure of a design for later filing for protection of such design? Please answer YES or NO. If answering YES, please explain the conditions (e.g., formal request, same applicant) and identify the length of time for the grace period (e.g., 6 or 12 months). For explanation use Other... \*

Yes

No

Other: .....

### Other criteria of prior art

11) Please indicate other criteria prior to art. \*

Not applicable  
.....

### The use of prior art when assessing the requirements for protection of a design

12) a) Does one single prior art reference have to disclose all features of a design in order to prevent its validity? \*

It is important that it is possible to evaluate the overall impression of the designs, this is in most cases done by assessing all features of the design. But there might be some exceptions (part of design?).  
.....

b) Can a prior art reference that differs only in minor details from a design prevent finding validity? If YES, please indicate what does only in minor details mean (is it, e.g., in a non-substantive way)? \*

In 2 § Design Protection Act it is stipulated that a design is considered new if no identical design was made available before the filing date. A design is considered identical even when they differ, if their features differ only in immaterial details. What is considered to "differ in minor details" is determined in case law.  
.....

c) Can a prior art reference that discloses the entire design with additional features prevent finding validity? \*

Yes, however as above - the overall impression of the designs is compared.

d) Can a combination of prior art references be used to disclose the features of a design in order to prevent its validity? If YES, is there a limit to the number of prior art references that can be combined? \*

Yes, however several previous designs can create the new value as a whole.

Several references can be used to show that a design is not new, but you cannot use several references to show that different features in various references and then argue that design is not new. All features of the design have to be shown in one prior art reference.

e) Does the assessment of validity differ where there is numerous prior art or very few prior art available? \*

The relevant sector of products can make a difference. It could affect the scope of protection, since the informed user shall consider the degree of freedom the designer has in developing the design. There could be more or less space for new designs depending on which industry sector is concerned

f) Does the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)? \*

Yes, see the answer to 12.e) above.

**The influence of prior art on the infringement/scope of protection of a design**

13) Does the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable. \*

See answer to question 12.e.



## II. Policy considerations and proposals for improvements of your Group's current law

14) Could any of the following aspects of your Group's current law relating to prior art be improved? If YES, please explain. a) defining criteria of prior art \*

Representatives from the industry would like to see a substantive examination of novelty and individual character at the application stage, in order to give both the applicant and third parties more clarity as to the scope of protection

b) the use of prior art when assessing the requirements for protection of a design \*

Not applicable

c) the influence of prior art on the infringement/scope of protection of a design \*

Yes, see above.

15) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question? \*

The law needs to modernize and decide if motion designs should be registerable. Today motion design can be register if the motion is presented in several pictures. However it is unclear what the scope of protection is. Further, the borderline of protection between designs on one hand and trademarks or copyrights on the other hand should be more precise.

## III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

16) Do you believe that there should be harmonisation in relation to the definition of prior art and/or the use of prior art when assessing the requirements for protection? If YES, please respond to the following questions without regard to your Group's current law or practice. Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved. \*

See answer to question 14 above.

17) a) Should prior art be used to assess requirements for protection of a design prior to registration/issuance, i.e., during substantive examination by an IP Office? Please answer YES or NO. \*

YES

NO

If you have answered YES to Q17.a), please proceed to answer Q17.b). Otherwise, please proceed to Q18). b) Referring to Q17.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply. \*

Novelty

Originality

Individual character

Non-obviousness

Inventive step

Aesthetic

Ornamental

Other: .....

18) a) Should prior art be used to assess requirements for protection of a design during determination of validity when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO. \*

YES

NO

If you have answered YES to Q18.a), please proceed to answer Q18.b). Otherwise, please proceed to Q19). b) Referring to Q18.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply. \*

Novelty

Originality

Individual character

Non-obviousness

Inventive step

Aesthetic

Ornamental

Other: .....

19) a) Should prior art be used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q17 and Q18)? Please answer YES or NO. \*

YES

NO

If you have answered YES to Q19.a), please proceed to answer Q19.b). Otherwise, please proceed to Q20). b) Referring to Q19.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply. \*

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other: .....

c) Referring to Q19.b), please indicate in which context these requirements for protection should be taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q17) and Q18). \*

Not applicable .....

### Criteria of prior art

20) a) What should recognized means of disclosure be, i.e., which materials/documents, etc., can constitute prior art? \*

See answer to question 7 above. The Group consider the current rules sufficient in this respect. ....

b) Should the prior art have to be “printed” and if so, what should that mean? \*

See answer to question 7 above. The Group consider the current rules sufficient in this respect. ....

c) Should the prior art have to be “published” and if so, what should that mean? \*

See answer to question 7 above. The Group consider the current rules sufficient in this respect.

### Time of disclosure

21) What should the relevant date of a prior art reference be? \*

See answer to question 8 above. The Group consider the current rules sufficient in this respect.

### Circumstances of disclosure

22) What, if any, circumstances of disclosure should be relevant? Please tick all boxes that apply. \*

- geographic location
- type of location (e.g., during an exhibition)
- sector/type of products
- the person disclosing the prior art (e.g., the applicatn of a design, a person bound by confidential agreement, etc.)
- the recipient of the disclosed prior art
- Other: misuse

### Grace period

23 a) Should there be a grace period after a public disclosure of a design for later filing for protection of such design? Please answer YES or NO. \*

YES

NO

b) If the answer to Q23.a) is YES, please identify what the length of time for the grace period should be. Also, please explain what the conditions allowing for the benefit of the grace period should be (e.g., formal request, same applicant). \*

See answer to question 10 above. The Group consider the current rules sufficient in this respect.

Other

24) Should there be any other relevant criteria of prior art? \*

No

25) Should the assessment of prior art differ for the different requirements for protection mentioned in Q17)b), Q18)b) and Q19)b)? \*

No

The use of prior art when assessing the requirements for protection of a design

26) a) Should one single prior art reference have to disclose all features of a design in order to prevent its validity? \*

Yes

b) Should a prior art reference that differs only in minor details from a design prevent finding validity? If YES, please indicate what should only in minor details mean (is it, e.g., in a non-substantive way)? \*

Yes

c) Should a prior art reference that discloses the entire design with additional features prevent finding validity? \*

Yes, in some cases.

d) Should it be possible to contest the validity of a design on the ground of a combination of prior art references disclosing the features of a design? If YES, should there be a limit to the number of prior art references that can be combined? \*

NO, it is important that there is one reference that displays the design "in full view". It will make it very difficult and unpredictable for users if a combination of features from different references are used to invalidate their design, complicate examination and might minimize the scope of design that can be considered novel.

e) Should the assessment of validity differ where there is numerous prior art or very few prior art available? \*

No, the focus should not be on the number of references, but on how the design was disclosed and to whom.

f) Should the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)? \*

See answer to question 10 above. The Group consider the current rules sufficient in this respect

**The influence of prior art on the infringement/scope of protection of a design**

27) Should the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

See answer to question 12.e) above. The Group consider the current rules sufficient in this respect.

28) Please comment on any additional issues concerning any aspect of industrial designs and the role of prior art you consider relevant to this Study Question.

Not applicable.

29) Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

Fashion/clothing

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