

2021 AIPPI World Congress – Online
Adopted Resolution
October 22, 2021



Resolution

2021 – Study Question – Designs

Industrial designs and the role of prior art

Background:

- 1) This Resolution concerns the role of prior art with respect to industrial designs when assessing requirements for protection of a design and, in the context of infringement, determining the scope of protection of a design right.
- 2) Since the terminology can differ between the jurisdictions, *e.g.*, design registration vs. design patent, in this Resolution, the term design right 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. Protection by copyright, trade mark, and utility patent is outside the scope of this Resolution.
- 3) 39 Reports were received from AIPPI's National and Regional Groups and Independent Members, providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 4) At the online AIPPI World Congress in October 2021, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

Use of prior art when assessing the requirements for protection/validity of a design right

- 1) Prior art should be used to assess the registrability/patentability of a design right (as prescribed by national legislation, *e.g.*, novelty, individual character or non-obviousness) in those jurisdictions where there is substantive examination by an IP Office.
- 2) Prior art should be used to assess the validity of a design right (as prescribed by national legislation, *e.g.*, novelty, individual character or non-obviousness) when the validity of the design right is contested.
- 3) Prior art should be used to assess the scope of protection of a design right (as prescribed by national legislation) in infringement proceedings.

Criteria of prior art

- 4) Prior art should be any disclosure made available to the public anywhere in the world prior to the relevant date of the design right by any means. A disclosure of a design shall not, however, be deemed to have been made available to the public when it was disclosed to a third person under explicit or implicit conditions of confidentiality.
- 5) The relevant date for determining the relevant prior art should be: (i) for a registered/patented design right, the earlier of the filing date or priority date (if applicable); and, (ii) for an unregistered design right, the date on which the design has been made available to the public.
- 6) With respect to a registered/patented design, a public disclosure made during the 12 months immediately prior to the relevant date of a design right (“grace period”) shall not be deemed prior art to the design right provided that the disclosure is either (i) made by, or through, the designer, applicant or owner, or (ii) made by a third person as a consequence of a wrongful or illegitimate act in relation to the designer, applicant or owner.

Use of prior art when assessing the requirements for protection of a design

- 7) A prior art reference that discloses (i) the subject design, or (ii) a design that differs from the subject design only in immaterial respects, shall prevent the registrability/patentability, or a finding of validity, of the subject design.

- 8) It should be possible to contest the validity of a design right on grounds other than novelty as prescribed by national legislation (e.g., individual character or non-obviousness).
- 9) Lack of novelty of a design right shall not be based on a combination of prior art references.
- 10) It should not be possible to contest other requirements prescribed by national legislation (e.g., individual character or non-obviousness) of a design on the basis of a combination of prior art references disclosing the features of a design, unless (i) such combination is suggested in the prior art, and (ii) the design is assessed as a whole.

Influence of the prior art on the protection and infringement of a design

- 11) The validity and the scope of protection of a design right should depend upon the amount and general visual impression of the applicable prior art references.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Group Reports](#)