



Preparation of a design application, prepared for multiple jurisdictions and national particularities in their prosecution:

13.10.2022

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The Community Design

A design means the appearance of the whole or a part of a product resulting from the features of, in particular:

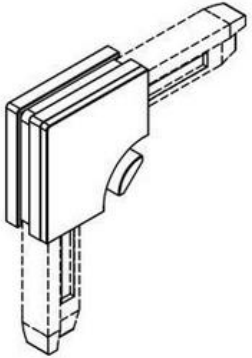
- the lines,
- contours,
- colours,
- shape,
- texture, and/or
- materials

of the product itself and/or its ornamentation

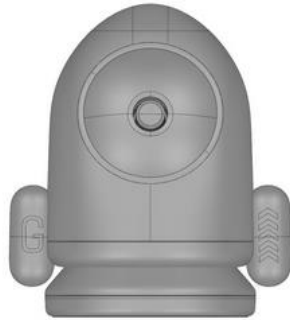
(Art. 3(a) CD Regulation)



The Community Design



EM - 009201106 (three views)



EM - 009201569 (seven views)



EM - 009195928 (four views)



EM - 009188287 (one view)



EM - 009185168 (seven views)



EM - 009190986 (two views)



EM - 009190093 (seven views)



EM - 009081375 (seven views)

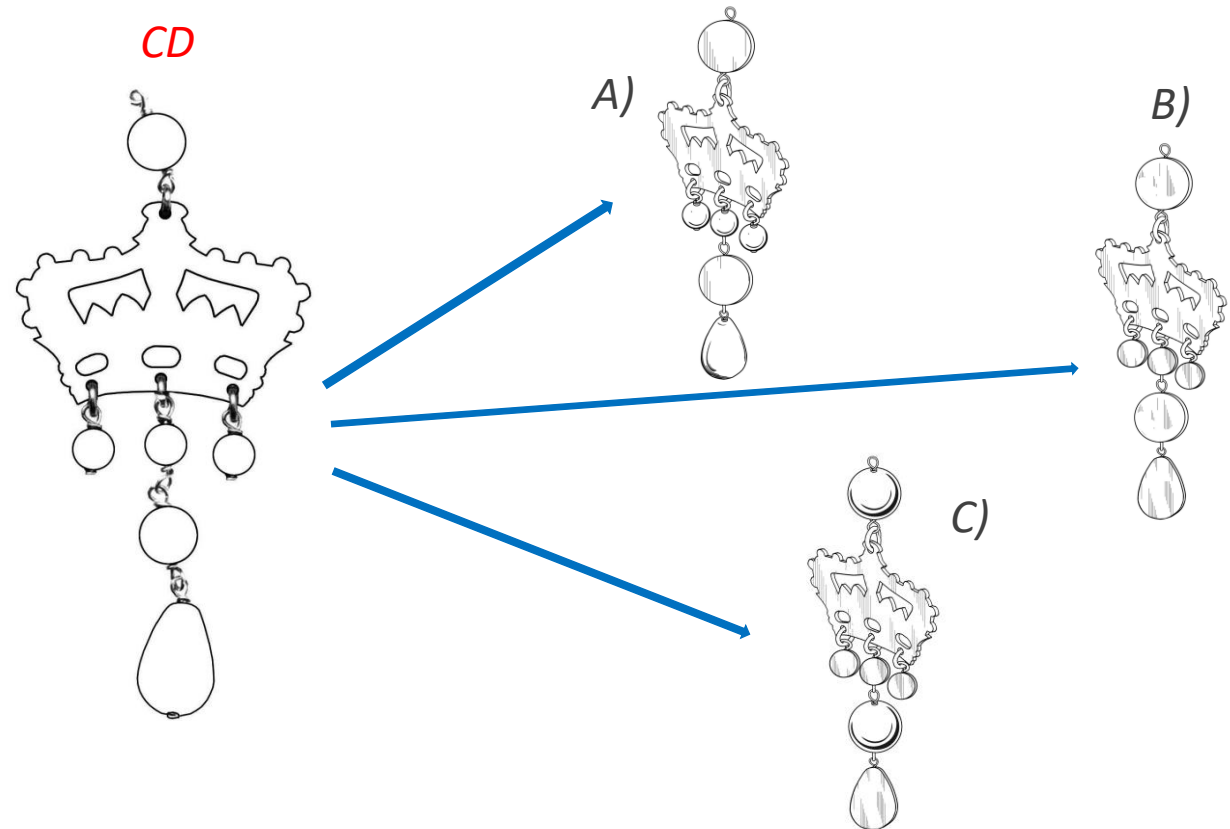


EM - 009189392 (seven views)

All these random examples were published on 11/10/2022

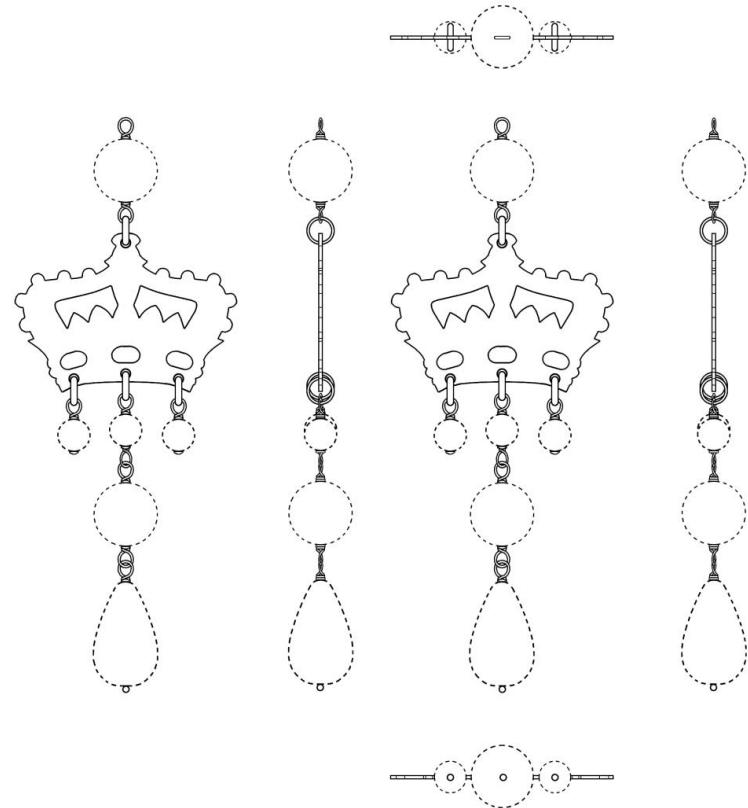
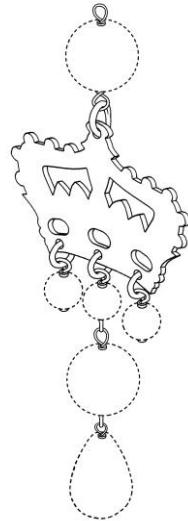
The Community Design – Extending the Scope of Protection

- Limit the Views



The Community Design – Extending the Scope of Protection

- Use Disclaimers (e.g. dashed lines)

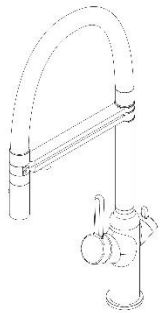




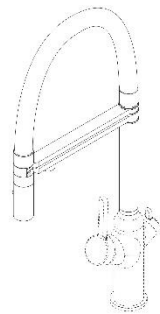
The Community Design – Multiple Design Applications

- Multiple Design Applications allow to reduce the official fees for the design applications

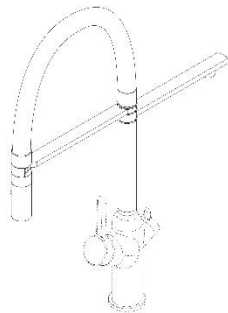
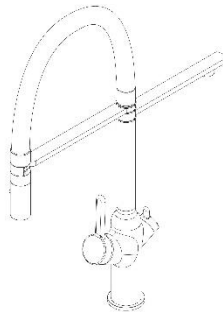
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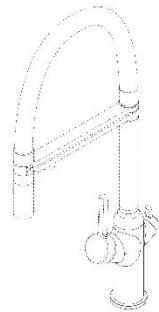
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007535240 - 3

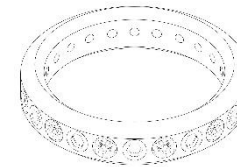


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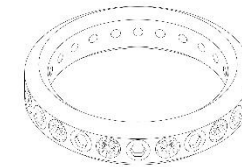


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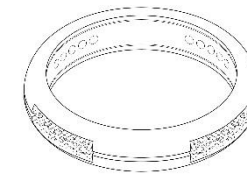
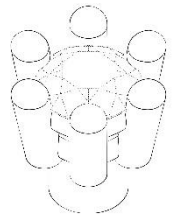
008432413 - 1



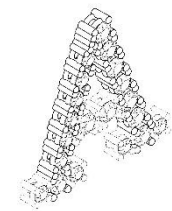
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008432413 - 13



The Community Design – Grace Period

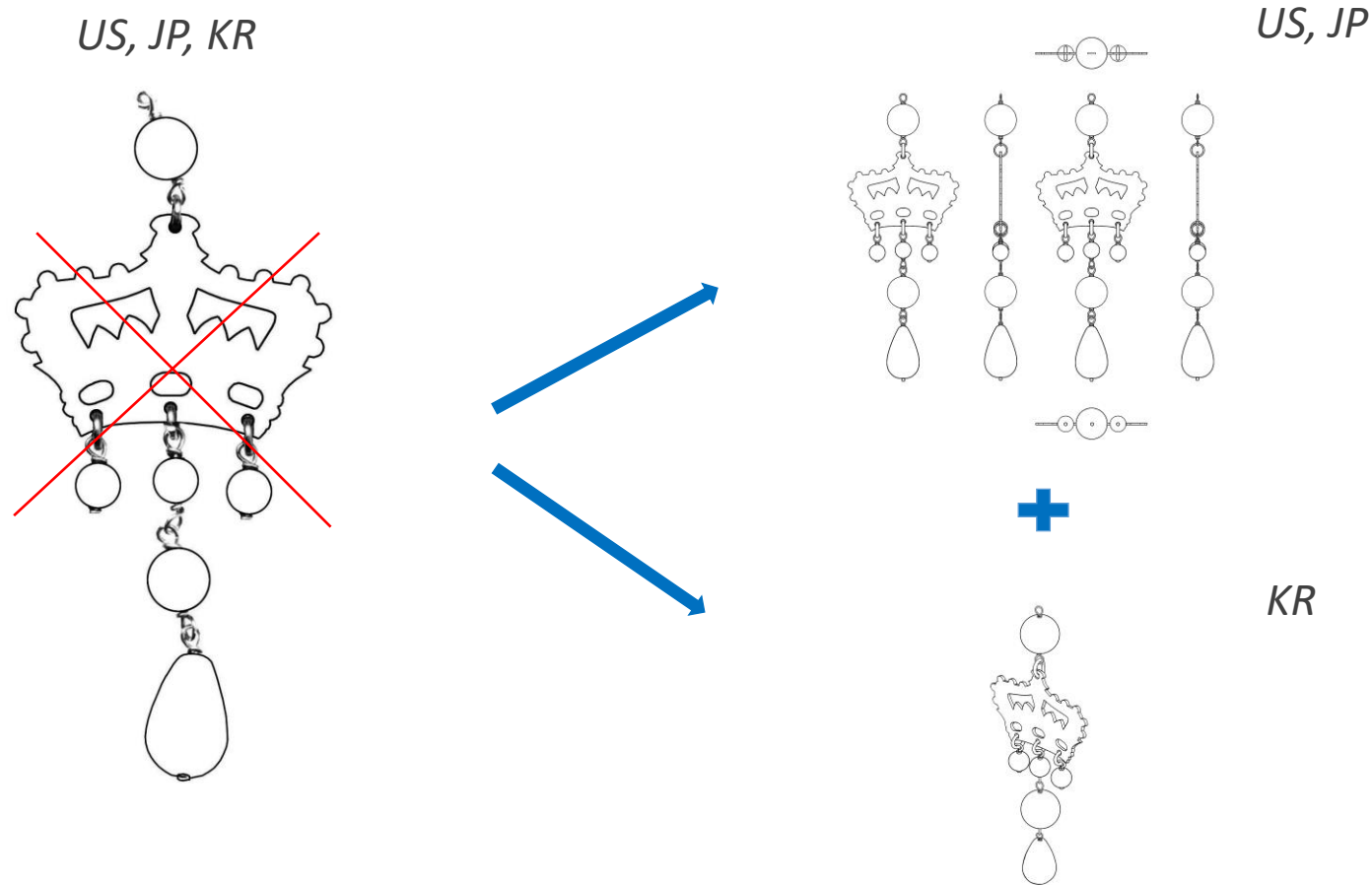
- The law provides that a disclosure of the design is not taken into consideration if it has been disclosed:
- by the designer (or his successor in title) during a 12 month period prior the filing/priority date
- by means of an abuse (for instance industrial espionage) during 12 month period prior the filing/priority date.



The Community Design – An International Perspective

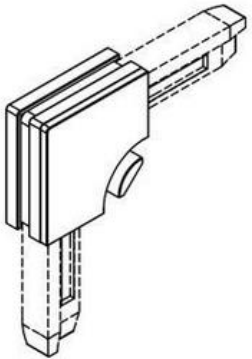
- The legal basis underlying the Community Design is a liberal one
 - Possibilities of enlarging the scope of protection
 - Choice of representation (b&w; colors; rendering; photographs, ...)
 - Number of views
 - Multiple design applications
- How is the situation in other jurisdictions?
- What do we need to consider?

Defining a Filing Strategy – Points to Consider

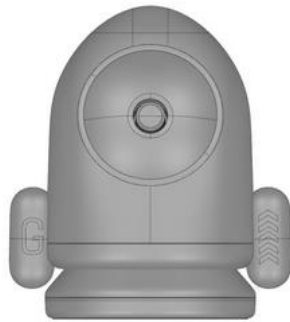


It is advisable to consider from the very beginning the possible desire and/or need to obtain protection in other jurisdictions than the one by means of a Community Design

The Community Design



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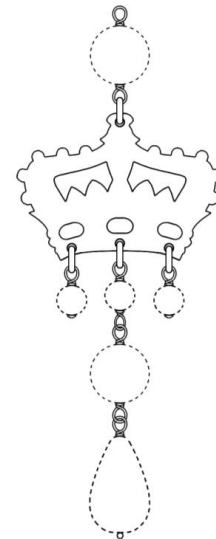


EM - 009189392 (seven views)



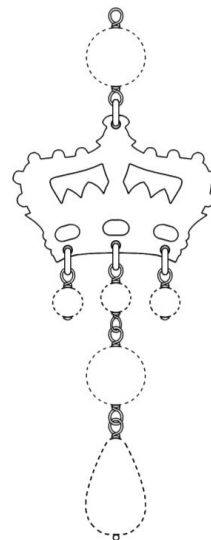
Case Study 1

- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other country



Case Study 1

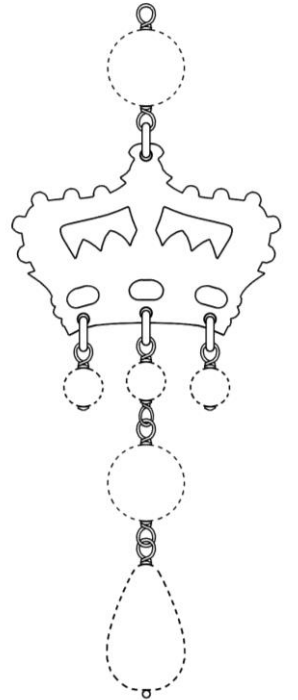
- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other country
- Company A discloses the product on its webpage and at a trade fair immediately after the filing of the design application





Case Study 1

- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other country
- 5 months later, Company A mentions that they have decided to commercialize the product also in the US and accordingly they want to obtain protection also in the USA
- Problem: In the USA the views must be sufficient to completely disclose and describe the design; accordingly, we need to provide for further views
- The priority claim will most likely not be valid
- Problem: Is the commercialized product novelty destroying for a putative US design application?

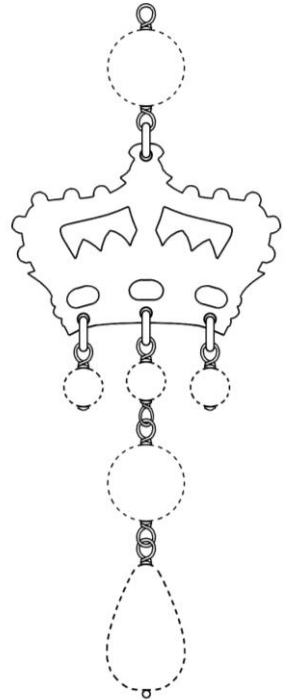




Case Study 1

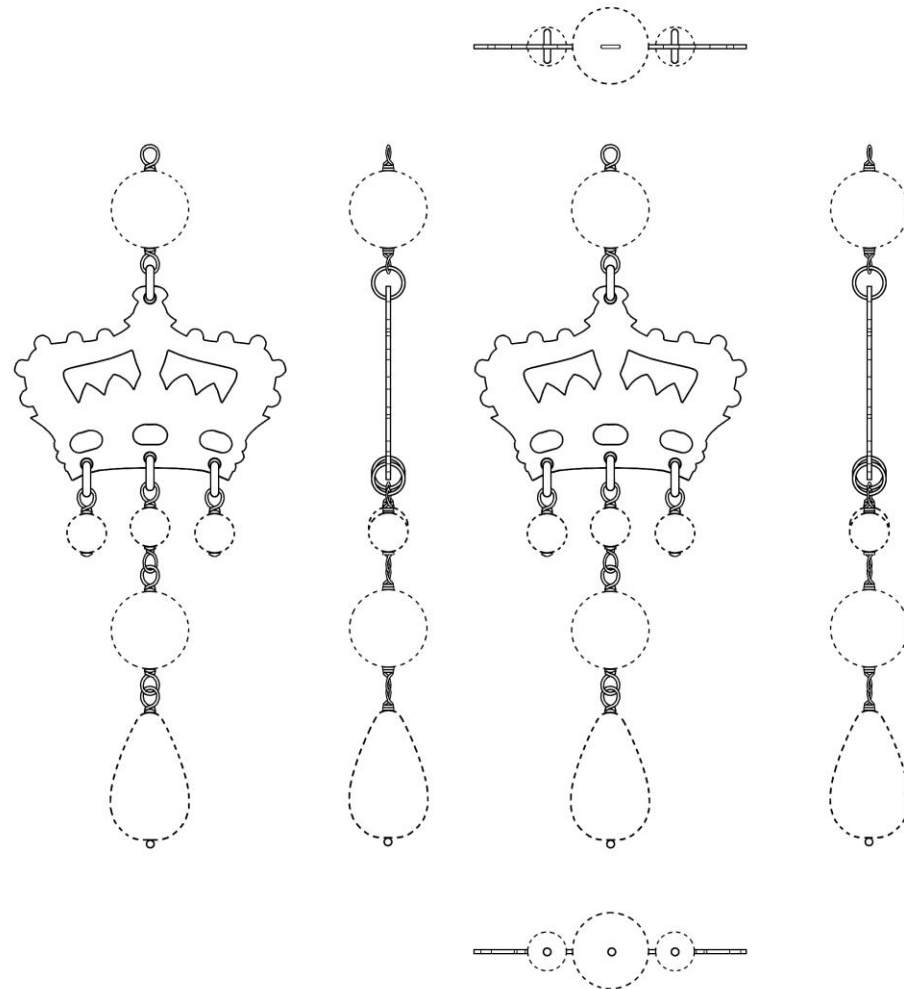
- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other countries
- 5 months later, Company A mentions that they want to commercialize the product also in the US and accordingly they want to file a design application also in the USA
- Problem: In the USA the inventor is required to completely disclose and describe the design; accordingly, we need to provide other views
- The priority claim is likely not be valid
- Problem: Is the commercialized product novelty destroying for a putative US design application?

GRACE PERIOD





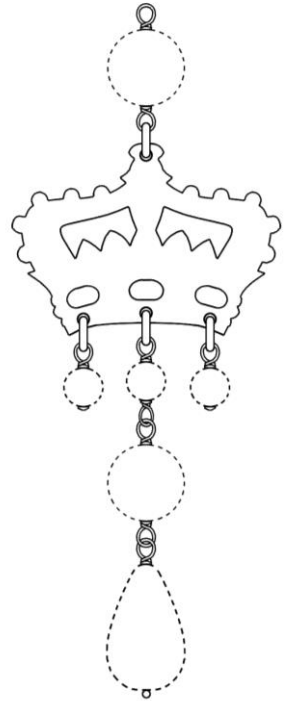
Case Study 1





Case Study 1

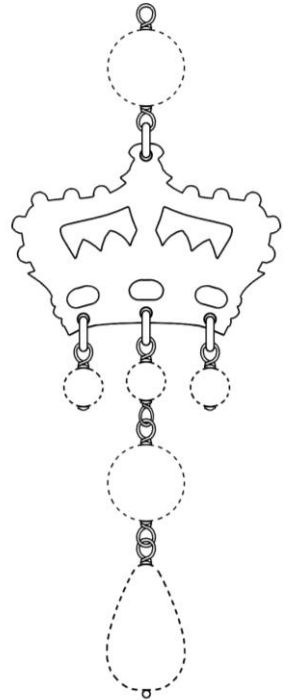
- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other country
- 5 months later, Company A mentions that they have decided to commercialize the product also in China and accordingly they want to obtain protection also in China
- Problem: The views are not sufficient
- The priority claim would most likely not be valid
- Problem: Is the commercialized product novelty destroying for a putative Chinese design application?
- Does the grace period save us?





Case Study 1

- Company A aims to protect the design of its product in Europe to obtain the broadest scope of protection with the lowest possible investment
- Company A mentions to have no interest in any other country
- 5 months later, Company A mentions that they have decided to commercialize the product also in China and accordingly they want to obtain protection also in China
- Problem: The views are not sufficient to identify the design
- The priority claim would be refused
- Problem: Is the commercialization of the product novelty destroying for a putative Chinese design application?
- Does the grace period save us?



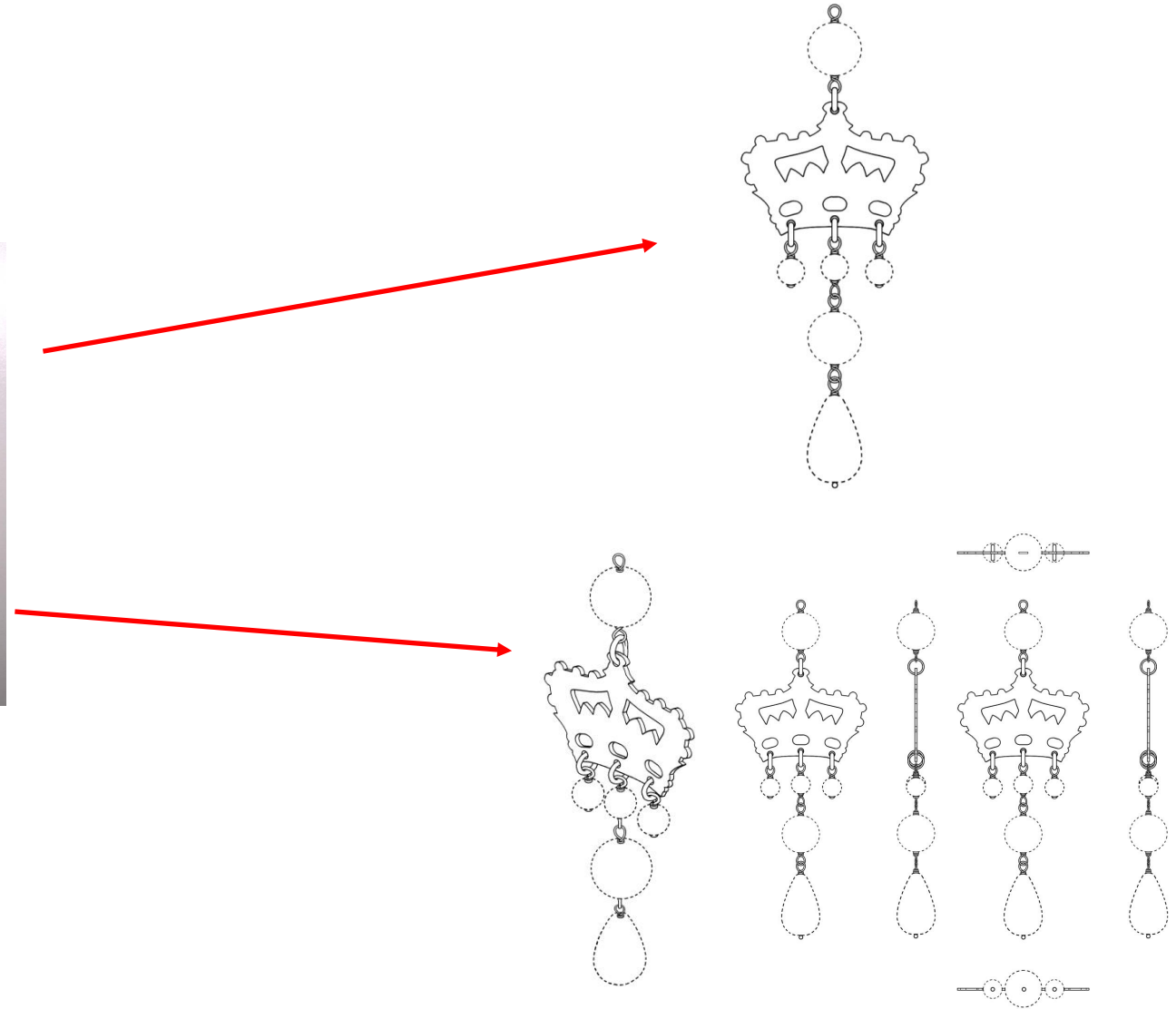


Case Study 1

- In China the grace period is only 6 months and only applies to specific conditions:
 - it is exhibited for the first time at an international exhibition sponsored or recognised by the Chinese government;
 - it is published for the first time at a specified academic or technological conference; and
 - its contents are divulged by others without the consent of the applicant.
- In Australia the grace period entered into force only on March 10, 2022
- In India there is no grace period

Case Study 2

- Company A aims to protect the design of its product in Europe
- Company A cannot exclude interest in any other country
- Company A aims on optimizing the possible scope of protection in Europe





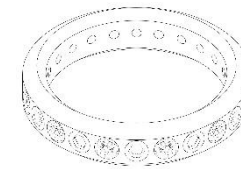
Case Study 2

- There are jurisdictions such as India and Brazil, in which it is not possible to rely on disclaiming parts by dashing.
- Typically, dashed lines must be removed or changed into solid lines
- Recently China has given the possibility to rely on dashed lines

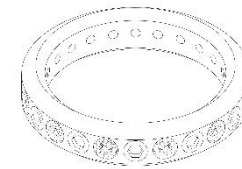
Case Study 3

- Company C has developed a new jewellery collection containing different variations
- Company C aims to obtain protection in several countries including Mexico, USA, China, Russia, India, Brazil and Japan
- International Design Application: Mexico, USA, China (recently), Russia and Japan – multiple design application
- Brazil will join the Hague agreement, but at the moment it is still necessary to directly extend design applications in Brazil
- India: only single design applications

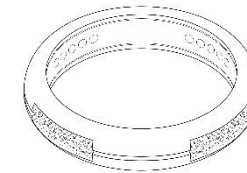
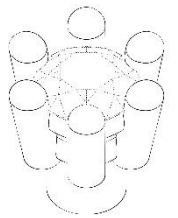
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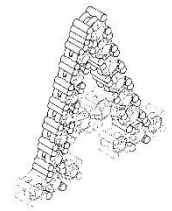
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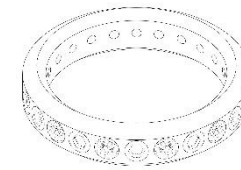


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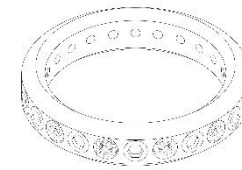
Case Study 3 – What can we expect to happen

- USA – the examiner will identify a series of groups of inventions and a group must be elected; the other groups must be prosecuted in divisional applications
- Mexico – we will presumably receive a non-unity objection and we need to choose a design with eventually also a related design; eventually one needs to file divisional applications
- Russia – unity objection
- Japan – the multiple design application will be split into single design applications

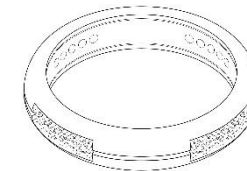
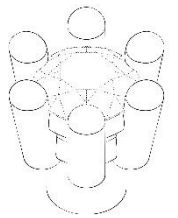
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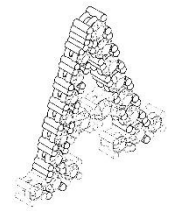
008432413 - 2



008432413 - 3



008432413 - 4



008432413 - 13



Case Study 3 – Some considerations with regard to Japan

The design in the application for design registration is found to be identical with or similar to design(s) in the application(s), as noted below, which was(/were) filed by the same applicant on the same day and then it falls under the provision of the first sentence of Article 9(2) of the Japan's Design Act.

JPO Application Number:

Design Number: 002)

JPO Application Number:

Design Number: 003)

Ground for refusal based on the provision of the second sentence of Article 9(2) of the Design Act

Case Study 3 – Some considerations with regard to Japan

10

Hague

[JP, 1587377, S](#)

Motor vehicles
AUTOMOBILI LAM
BORGHINI S. P.

[G2-2100](#)

-

Fundamental design

-



9

Hague

[JP, 1590960, S](#)

Motor vehicles
AUTOMOBILI LAM
BORGHINI S. P.

[G2-2100](#)

-

Related designs

-





An International Perspective

	EU	US	JP	KR	IN
GRACE PERIOD	12 months	12 months	12 months	12 months	NO
SECRECY	30 months from filing date	No	3 years from filing date	3 years from registration date	(PUBLICATUION ONLY AFTER REGISTRATION)
VIEWS	No upper limit of 7 views through ID route – at least one view	Sufficient to disclose and describe completely the design	Sufficient to disclose the design in a detailed way	6 views + perspective view (recommended)	6 views + perspective view (recommended)
COLOURS PHOTOGRAPHS	Yes Yes	No, only on specific demand No	Yes Yes	Yes Yes	YES
DISCLAIMER/ PARTIAL DESIGN	Dotted lines, broken lines, color shading and blurring, boundaries and separations admitted	Dotted lines to exclude protection of parts of the design	Thin lines or shadows to be duly explained in the description, broken lines or colors	No shaded parts, hatching, lettering and numbering or the like	broken lines, shading and blurring portion, not allowed. Disclaiming part/ portion is allowed.
MULTIPLE DESIGN	Yes	No (except variants within the same aesthetic concept)	No A multiple ID is automatically divided into a plurality of single designs	Yes, up to 100	Not allowed



An International Perspective

	EU	US	JP	KR	IN
DESIGNATION OF THE AUTHOR OF THE DESIGN	Not necessary	Mandatory	Mandatory	Mandatory	Not necessary
SUBSTANTIAL EXAMINATION	No	Yes	Yes	Yes	Yes
DESCRIPTION/ CLAIMS	Not necessary	Recommended if necessary to explain particular features /one single claim mandatory	Description required if necessary to explain particular features	Description required if necessary to explain particular features	Title and Novelty statement is required. Description required if necessary to explain particular feature during prosecution.
FILING OF PRIORITY DOCUMENT	Not necessary	Mandatory (before USPTO)	Mandatory (before JPTO)	Mandatory (before WIPO or KIPO)	Mandatory (before IPO)
DURATION	25 years from filing date	15 years from registration date	20 years from registration date (Next Revision – April 1, 2020 – 25 years from filing date)	20 years from filing date	10 years + 5 years (extendable, optional) From registration date



Protection of Graphical User Interfaces

- USA - The most important aspect is that the GUI is to be depicted within **a dashed box which symbolically represents the display screen** on which the GUI appears. The reason is that US law protects articles of manufacture, and a GUI by itself is not protectable, but a display screen (not claimed) with a Graphical User Interface is protectable.
- India – Examiners when assessing GUIs in India often raise objections on Graphical User Interface (GUI) designs on the grounds that “the GUIs are not an article and a design within the meaning of the Indian Designs Act” as per Section 2(a) and 2 (d) of the Act. So far there have been only a few cases where the Indian Design office has allowed registration of GUIs comprising the product to which the GUI is applied.
- Russia - it is not required to show the screen on the representation of the user interface, but the borders of the graphical interface should be shown either with solid lines or dashed (dotted) lines.



Summary

- The Community Design gives us a lot of freedom
- However, the representations, which are fine to obtain protection by means of a Community Design, may not be suited for extending protection to other jurisdictions
- Thus, the countries of putative interest need to be considered already during the definition of the filing strategy taking account of the particularities of the countries of interest
- A filing strategy can take account of the possibilities of relying on multiple Community design application optimizing protection by means of the possibilities of the Community Design and to get ready for extension to other jurisdictions
- One should consider to ask advise from local agents during the definition of the filing strategy

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