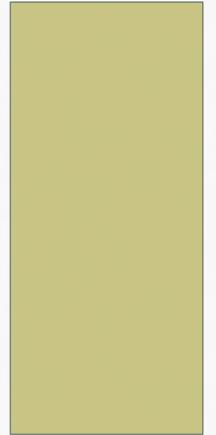


TIMING AND VALIDITY ISSUES FOR DESIGNS

FICPI OPEN FORUM – ROME – 11/11/11



PRESENTERS



- Matthias Bosch
- Bosch Jehle
- Munich
- www.bgsj.com



- Jay Sha
- Liu, Shen & Associates
- Beijing
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- Robert Katz
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- www.bannerwitcoff.com

OVERVIEW

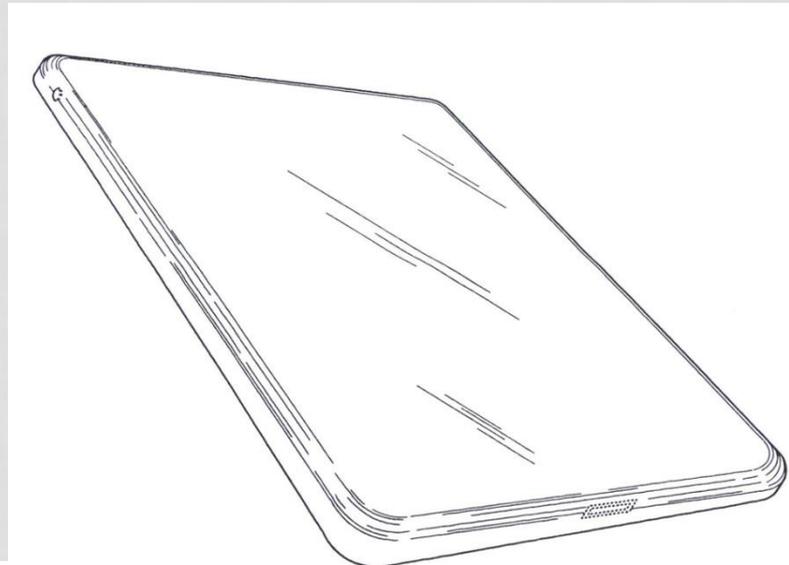
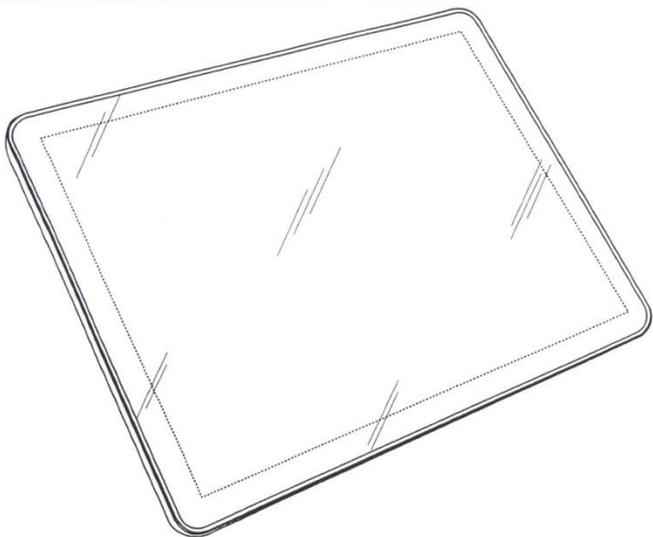
- Timing
 - Absolute novelty (and exceptions)
 - Grace Period (and variations)
 - Unauthorized disclosures
 - Timing Traps
- Effect of the Prior Art on Validity
 - Novelty and Individual character/non-obviousness
 - Different articles
 - Combination of references
 - Examples

TIMING ISSUES

- Do you have time to file?
- If I file post-disclosure, where do I lose rights?
- Not all grace periods work the same
 - Active or passive ?
 - From the actual filing date or the effective filing date?
- Unauthorized disclosures are more common
 - Are they novelty destroying?
 - What can be done?
- Other exceptions – Recognized trade shows
- Timing Traps
- Tips

WHY IS THIS IMPORTANT?

- Design patents are usually enforced against unbranded competitors making knockoffs
- *Apple v. Samsung* Battlegrounds
 - USA, AU, JP, KR, FR, UK, IT, DE, NL, and BR
 - Over design patents/registrations covering tablet and smart phone designs



EU and Other Countries with/without Grace Period

AT 12m	BY no	BENELUX 12m	BA no	BU 12m	HR no
CY no	CZ no	DK 12m	EE no	FI 12m	FR 12m
GE no	DE 12m	HU 12m	IS 12m	IE 12m	IT 12m
LV 12m	LI 12m	LT 12m	RU 6m	RS 12m	SI no
MK no	MD 12m	NO 12m	PL 12m	PT no	RO no
SM no	SK no	ES 12m	SE 12m	CH 12m	TR 12m
UA no	UK 12m	IN no	AU no	OHIM 12m	

EU GRACE PERIOD SUMMARY

- OHIM and all countries part of 1999 Harmonization Directive have a 12 month grace period*
- Norway and Switzerland also have a 12 month grace period
- Many countries added to the Community at 2004 expansion are still absolute novelty for their own national registrations -- but others have a grace period

TIMING ISSUES IN ASIA

- Absolute novelty:
 - China, Singapore, Hong Kong, Taiwan
- Conditioned Grade periods: 6 m.
 - Japan, Korea
- China and Taiwan have conditioned 6 m. exception for selected government-sponsored trade shows, exhibitions, and conferences
 - But has many potential pitfalls and hard to meet requirements



CN EXCEPTION ILLUSTRATED

- Self disclosure anywhere (this country or foreign)

- (1) Public known/use/worked/tested



Filed within 6 m.

Supplements in 3 months

- (2) Exhibition—govern. sponsored, international, etc.

---CN: for (1) above, NOT at all;

for (2) above, need: (a) governmental document;

(b) exhibition organizer document-date

(c) show-both map--location

(d) photos of what shown, etc.

TIMING ISSUES IN NORTH AMERICA

- US, CA, and MX all have 1 year grace periods
- *WRINKLE #1*: US also counts non-public sales and offers for sales
- *WRINKLE #2*: US and MX run to effective filing date while CA runs to actual filing date
- What do these WRINKLES mean?

TIMING WRINKLE #1 (US)

A offers for
sale
Design X

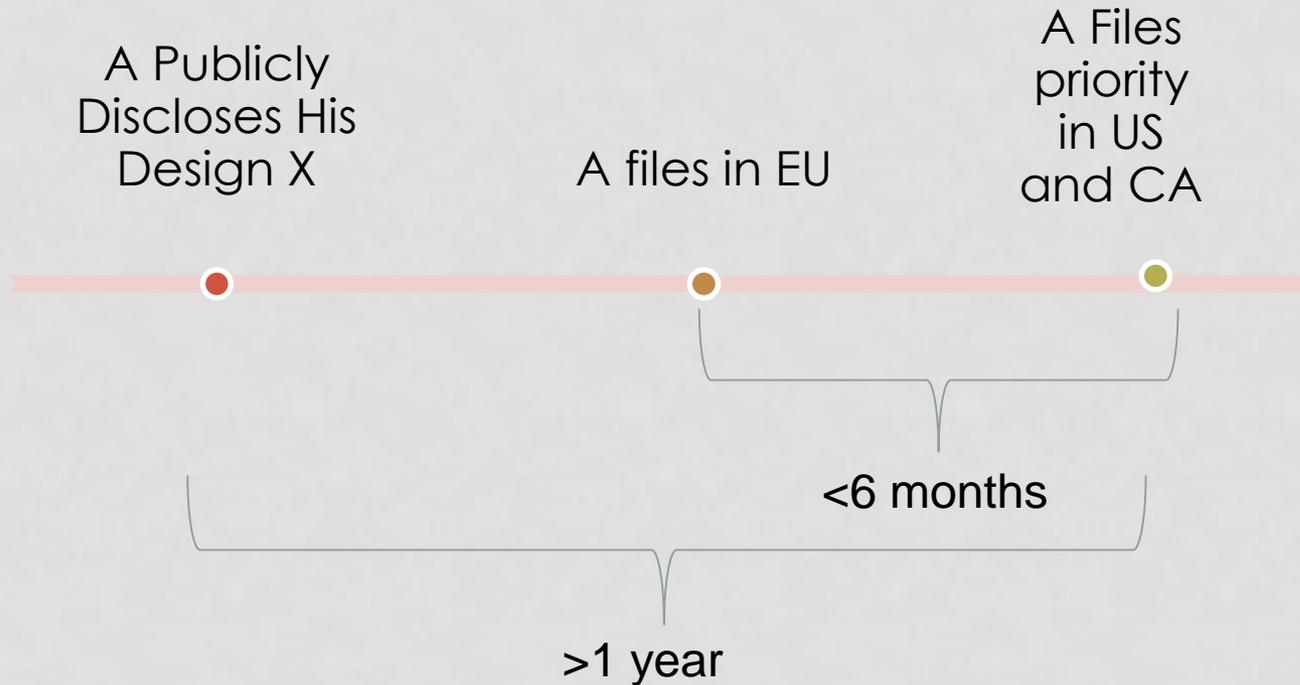
A Files on X in
CA and US

> 1 year



- No other potentially barring event has occurred
- A will get a design patent in CA
- A's offer for sale is a statutory bar for protection

TIMING WRINKLE #2 (CA)



- A's reliance on a grace period is typically fine
- Absolute filing date for Canada is >1 year and would be barred

TIMING ISSUES IN SOUTH AMERICA

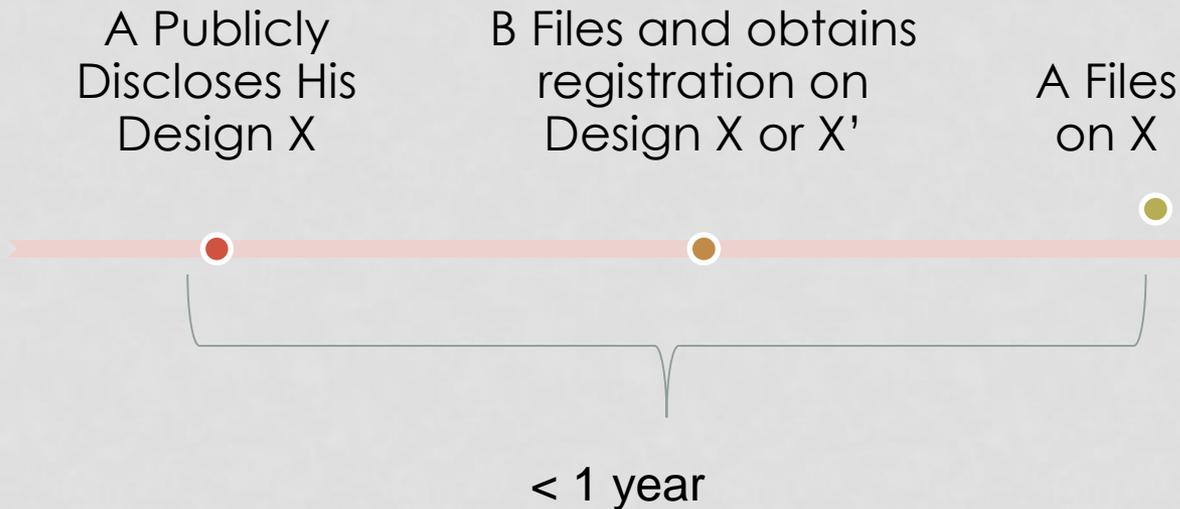
- South America varies widely
 - Know possible filing targets early - many different laws
 - **Grace period countries**
 - Brazil (180 days) and Columbia (12 months)
 - **Absolute novelty but may have possible exceptions**
(authorized trade shows and unauthorized disclosures)
 - Argentina, Bolivia, Chile, Paraguay
 - **Absolute novelty no apparent exceptions**
 - Peru, Uruguay

GRACE PERIOD AND TIMING TRAPS OVERVIEW

- Grace period variations
 - Automatically entitled
 - Statements, declarations, proofs
 - Effect
- Timing Traps



GRACE PERIOD IN EU - TRAP 1



- What can Designer A do?
- If B files on X, then A needs to seek transfer of title in national court **or** cancel in OHIM (tricky)
- If B files on X', then A's relief is severely limited

GRACE PERIOD IN EU - TRAP 2



- What can Designer A do?
- If B publicly discloses X, it is prior art to A's registration unless A can prove copying
- If B publicly discloses X', it is likely prior art to A's registration

GRACE PERIOD IN KR AND JP

- Grace periods to be claimed at filing
- Declarations to be filed within 30 days
 - Stating the “event” and proving the “fact”
 - Disclosure by applicant and request excusing of disclosure;
 - Usually needs to be signed by person of direct knowledge of the disclosure facts (JP)
- Wrinkles and strategies and pitfalls: form of proof of “date” and “right”, formalities
- Add significant costs to obtaining design protection

TIMING TRAP IN CN

- Precaution against third party filing of stolen design in China:
 - 3rd party stole design, and filed, in their own name, for identical or similar (modified) design,
 - Source: (1) leak from your own entity; and (2) from supplier or manufacturer
 - Original designer likely out of luck
 - TIP: Protective measure to keep “Trade Secret”
 - TIP: File earlier!



GRACE PERIOD IN NORTH AMERICA

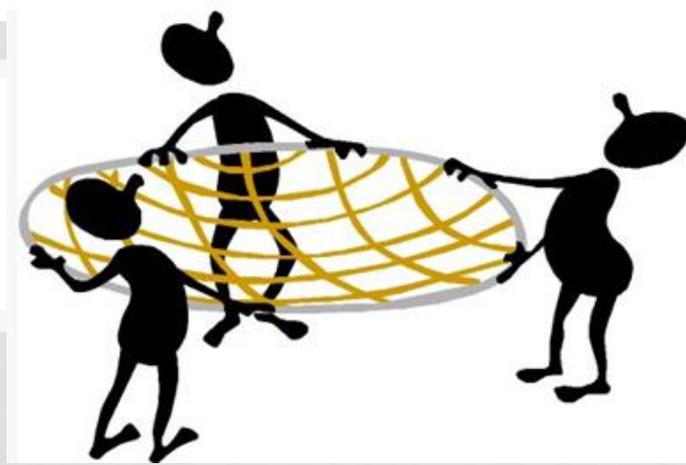
- Automatically occurs in US and CA
 - First to file in CA
 - US in process of change
 - First to Invent → First Inventor to File
- Statement needed in MX – more liberal
- **Timing Trap** in the US
 - 102(d) – own prior filings will kill your application if filed > 6 months prior and published before filing
- **Timing Trap** in CA
 - dual pending designs if too close and on the other is the second is in jeopardy



GRACE PERIOD IN BR AND CO

- Automatically occurs in Brazil
 - No statement needed
 - However, applicant may submit information regarding the disclosure as it may provide procedural benefits in an enforcement proceeding
- Automatically occurs in Columbia
 - No statement needed

PARTING PRACTICE TIP



- Grace periods are good
 - Doesn't provide perfect relief in all situations
 - Still pitfalls and traps
 - Materially increases costs in many countries
- Still many countries with valuable design protection that are absolute novelty
 - China is one of the most desirable
- **CONCLUSION:** Use grace period more like a safety net and not a filing strategy

UNAUTHORIZED LEAKS

- Common problem in today's world
- Outside the company factors
 - Aggressive press/bloggers
 - Thefts and spinoffs from factory
 - NDAs not honored
- Inside the company factors
 - Generating buzz
 - Miscommunications
- How to treat throughout the world?
 - Typically within grace periods



UNAUTHORIZED LEAKS AUSTRALIA

- No Grace period
- Exceptions exist but are complicated
- Example:
 - “leak” **in** Australia consisted of, or included, the sale, letting for hire or exposing for sale of products to which the design had been applied industrially, AND
 - “leak” was by, or with the consent of the owner
- If “leak” is publication **outside** Australia → prior art.
- If “leak” is use **outside** Australia → no prior art.

UNAUTHORIZED LEAKS INDIA AND RUSSIA

- INDIA

- No grace period
- Leak is an excusable event if design was disclosed to third party under NDA, and leak caused by the third party
- Submission of proof required

- RUSSIA

- Has a 6 month grace period
- Unauthorized leaks (direct and indirect) fall within scope of grace period



UNAUTHORIZED LEAKS CHINA AND TAIWAN

- Request at time of filing
- Submit proof of facts in Declaration
- 3 month deadline
- In China
 - Leaks must be by 3rd party
 - Proofs must be detailed*
- In Taiwan
 - More liberal standard: “in a manner without consent of the applicant”



PRIOR ART TESTS FOR VALIDITY

- Vary slightly from country to country
 - Interesting aspects are found in differences
- Novelty
- Individual/Character- Non-obviousness
- Tests relative to infringement/design scope

VALIDITY TEST OVERVIEW - EUROPE

- Cancellation – Art. 25 CDR (Art. 4 to 9 are not met)
 - Requirements for protection – Art. 4 CDR
 - Novelty - Art. 5 CDR
 - Individual Character – Art. 6 CDR
 - Disclosure – Art. 7 CDR
 - Designs dictated by their technical function and designs of interconnections – Art. 8 CDR
 - Designs contrary to public policy or morality – Art. 9 CDR

VALIDITY TEST EUROPE - EXAMPLE

- Cancellation action per Article 25
- Novelty and individual character challenged
- Design cancelled as it leaves the same overall impression on the informed user



Design at Issue



Prior Design

VALIDITY TEST AUSTRALIA

- Prior art
 - Publicly used in AU, published globally
- Designs are identical or substantially similar in overall impression
 - Factors to be considered in assessing substantial similarity in overall impression
 - Consider design as a whole unless statement of newness and distinctiveness that focus on subset of features
 - Consider the freedom of the creator of the design to innovate
 - the standard of the informed user

VALIDITY TEST INDIA

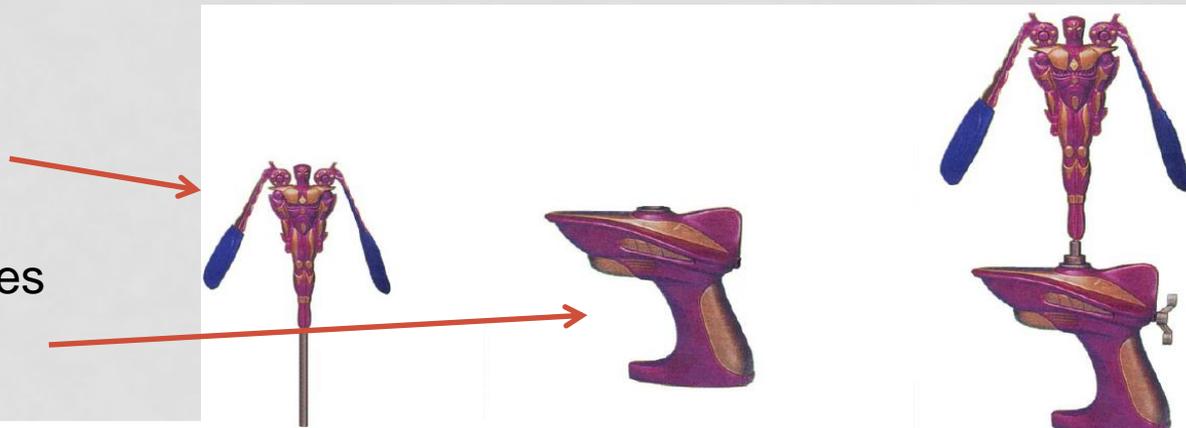
Per Section 4 of the Designs Act, must:

- Be new and original;
- Not been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration;
- Be significantly distinguishable from known designs or combination of known designs; and
- Not have scandalous or obscene matter.

VALIDITY TESTS IN CHINA

- Novelty test - overall appearance substantial similar:
 - same/similar design on same/similar product
 - similarity—overall visual effect of normal consumers
 - easy, directly visible, & distinguishable from prior designs, but for non-functional parts
- Inventive step hurdle too
 - patentable design shall be significantly distinguished from prior art or **any combination of features** in the prior art

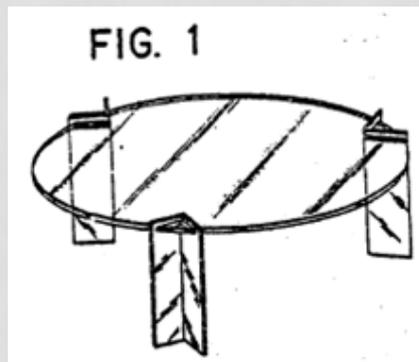
Prior
Design
Examples



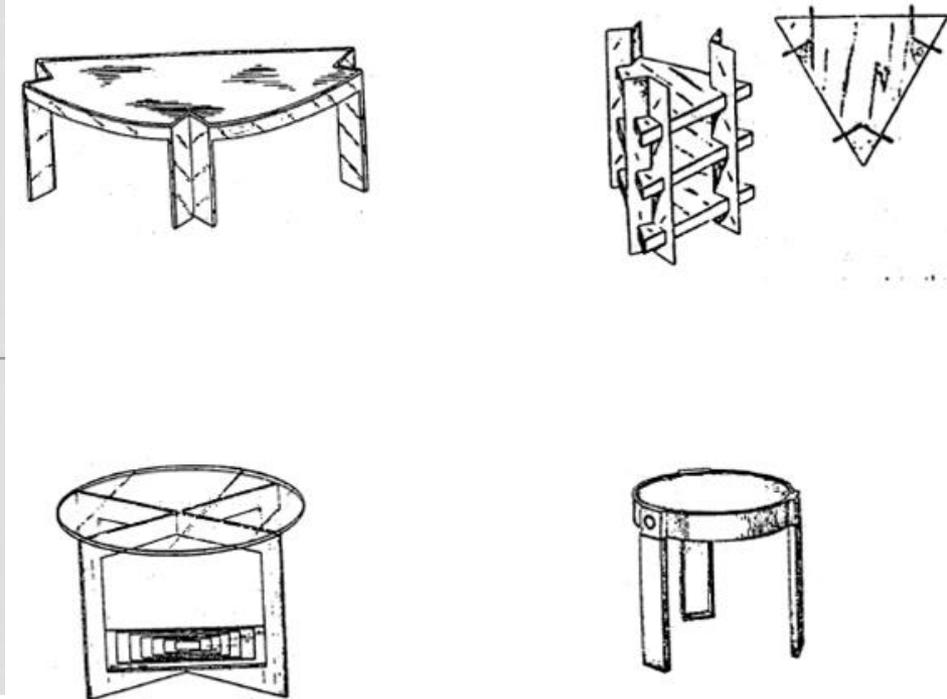
Non-valid
Design

VALIDITY TEST OVERVIEW AND EXAMPLES NORTH AMERICA

- Novelty and Non-Obviousness Tests in US
- Like EU, same design for different article is not novel
- Non-obviousness wrinkles – combining references
 - *In re Rosen* reference (a “primary reference that is basically the same”)
 - More than 2 references?



Design Under Examination



VALIDITY TEST

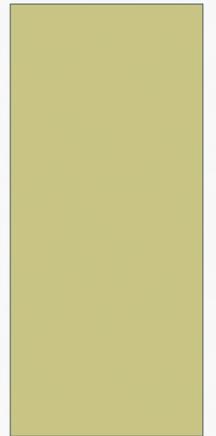
BRAZIL/SOUTH AMERICA

- Validity tests in South America vary country-to-country
- Brazil:
 - Novelty and Originality Tests in Brazil
 - Originality = the design has a distinct visual configuration compared with prior art designs
 - Cannot combine prior art designs to formulate an originality rejection

THANK YOU

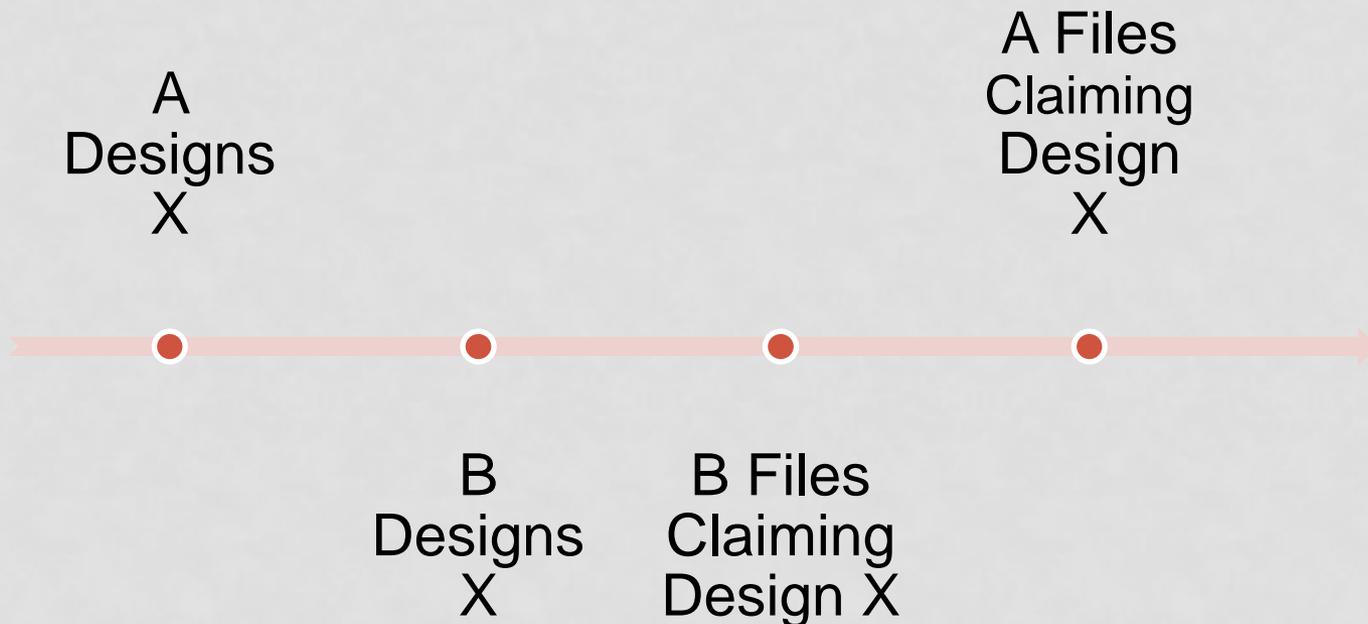
TIMING AND VALIDITY
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FIRST INVENTOR TO FILE (FITF) – EFFECTIVE 16 MAR 2013

- Replaces first-to-invent (FTI) scheme with FITF scheme

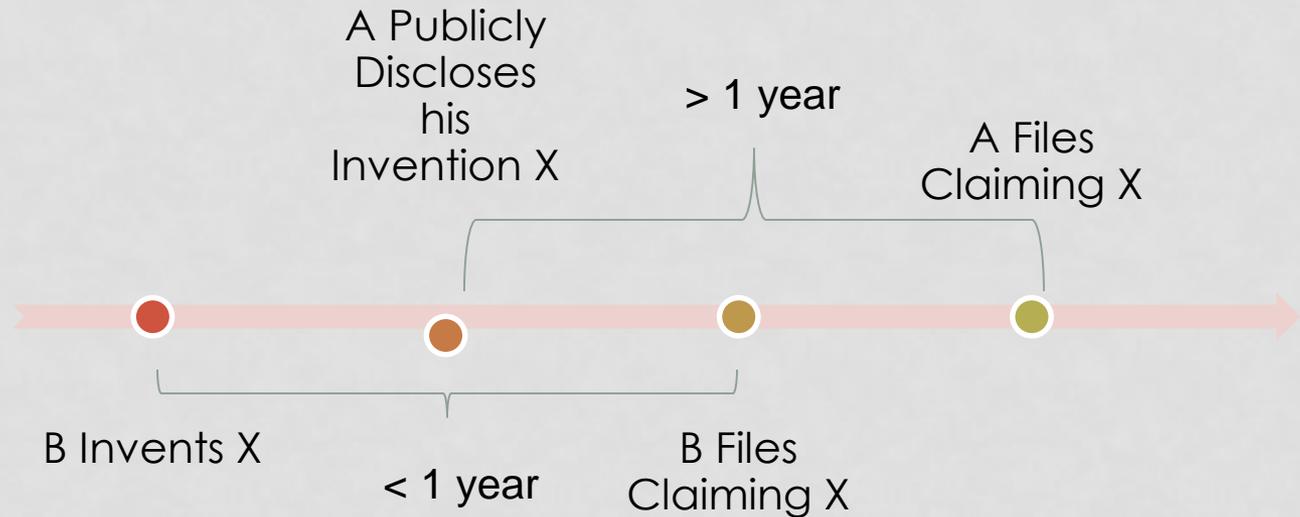


Under FITF, despite A inventing before B, B's earlier filed application is prior art to A, and B can receive a patent for X over A; A can no longer antedate B's application.

1 YEAR GRACE PERIOD CREATED BY PRIOR ART EXCEPTIONS

- Potentially applicable
 - Inventor was first to disclose
 - Inventor's "disclosure" was within one year of filing date
- After inventor's disclosure, later 3rd party disclosure/filing of same subject matter is not prior art
- NOTE: Disclosure of variations of disclosed/filed subject matter may be applied as prior art for obviousness
- Competing views: whether public use or on sale activities are "disclosures"
- USPTO likely to require applicants to provide/identify inventors' disclosures prior to examination

SECTION 102 EXAMPLE 1



Outcome?

- A's public disclosure is prior art to both B's application and A's application (102(a)(1))
- Neither A nor B can receive a patent on X

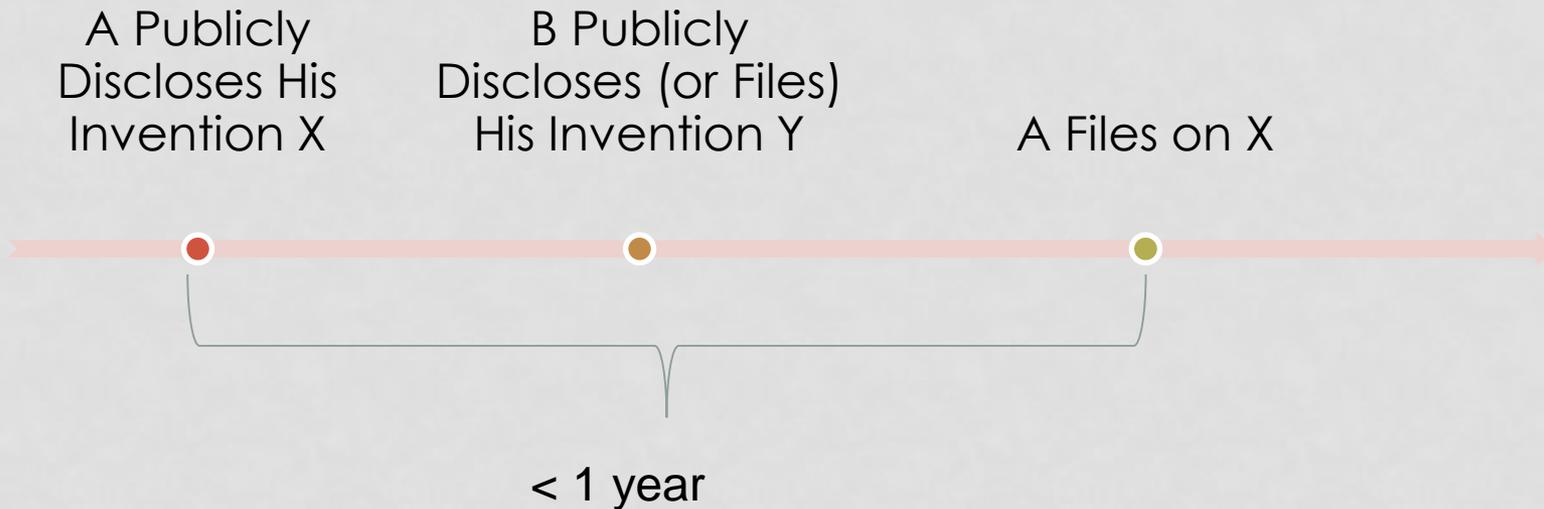
SECTION 102 EXAMPLE 2



Outcome?

- A's disclosure is not prior art to A's application (102(b)(1)(A))
- A's disclosure is prior art to B's application (102(a)(1))
- B's disclosure is not prior art to A's application (102(b)(1)(B))
- B's application is not prior art to A's application (102(b)(2)(B))
- A's application entitled to patent on X over B's application

SECTION 102 EXAMPLE 3



Outcome?

- A's disclosure is not prior art to A's application (102(b)(1)(A))
- B's disclosure of Y is prior art to A's claims to X (102(a))
- If X is obvious in light of Y, then A does not get a patent on X
- If X is not obvious in light of Y, then A gets a patent on X
- A's public disclosure of X is NOT EQUAL to EFD

SECTION 102 EXAMPLE 4



Outcome?

- A's disclosure of X is not prior art to A's claims X and X+Y (102(b)(1)(A))
- B's disclosure of X is not prior art to A's claim X (102(b)(1)(B))
- B's disclosure of Y is prior art to A's claims X and X+Y (102(a)(1))
- B's disclosure of X+Y is prior art to A's claim X+Y (102(a)(1))
- Result: A gets no claim X+Y, possible claim X (if nonobvious over Y)

Factors to be considered for assessing overall impression (Sec. 19) Australian Design Law

- (1) If a person is required by this Act to decide whether a design is substantially similar in overall impression to another design, the person making the decision is to give more weight to similarities between the designs than to differences between them.
- (2) The person must also:
 - (a) have regard to the state of development of the prior art base for the design; and
 - (b) if the design application in which the design was disclosed included a statement (a statement of newness and distinctiveness) identifying particular visual features of the design as new and distinctive:
 - (i) have particular regard to those features; and
 - (ii) if those features relate to only part of the design-have particular regard to that part of the design, but in the context of the design as a whole; and
 - (c) if only part of the design is substantially similar to another design, have regard to the amount, quality and importance of that part in the context of the design as a whole; and
 - (d) have regard to the freedom of the creator of the design to innovate.
- (3) If the design application in which the design was disclosed did not include a statement of newness and distinctiveness in respect of particular visual features of the design, the person must have regard to the appearance of the design as a whole.
- (4) In applying subsections (1), (2) and (3), the person must apply the standard of a person who is familiar with the product to which the design relates, or products similar to the product to which the design relates (the standard of the informed user).