



**WIPO | HAGUE**

The International  
Design System

# 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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Sachiko Chiba

**Geneva  
November 10, 2016**

# 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

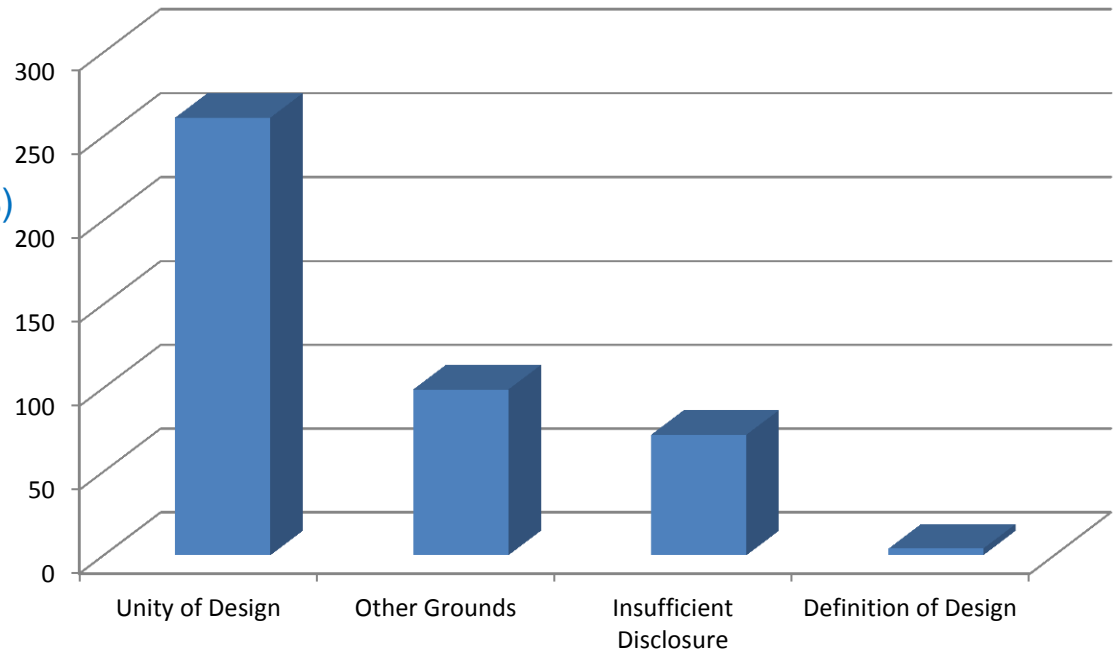
99 designs (30.9%)

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)

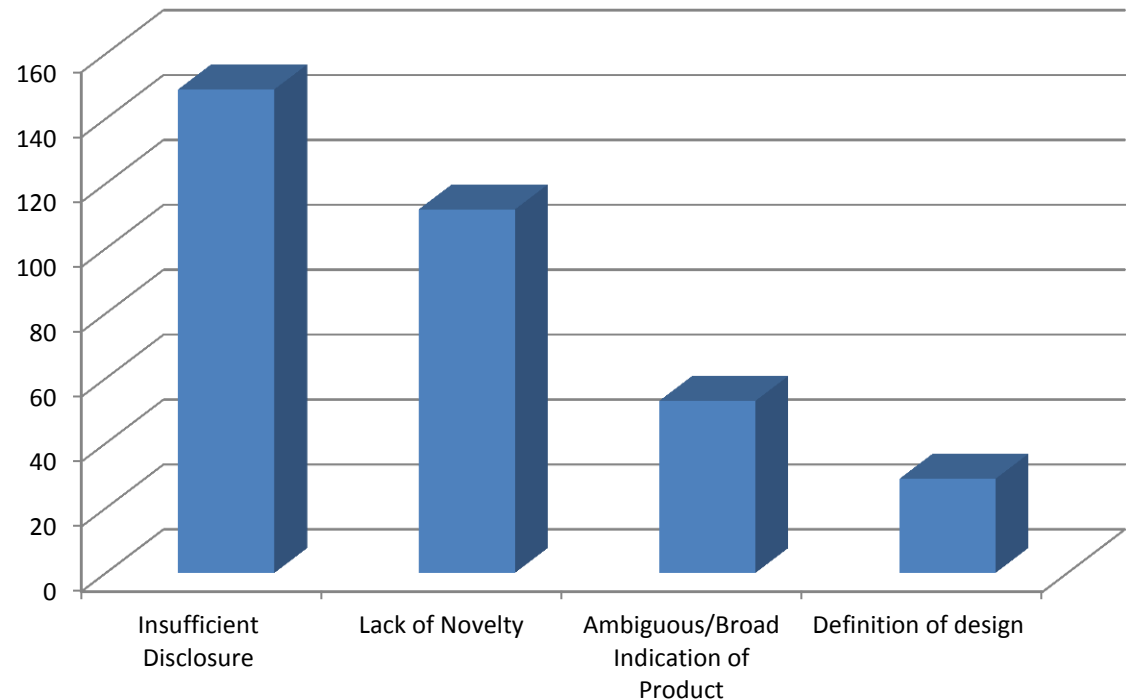
Source: Internal (unofficial) statistics

## 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)

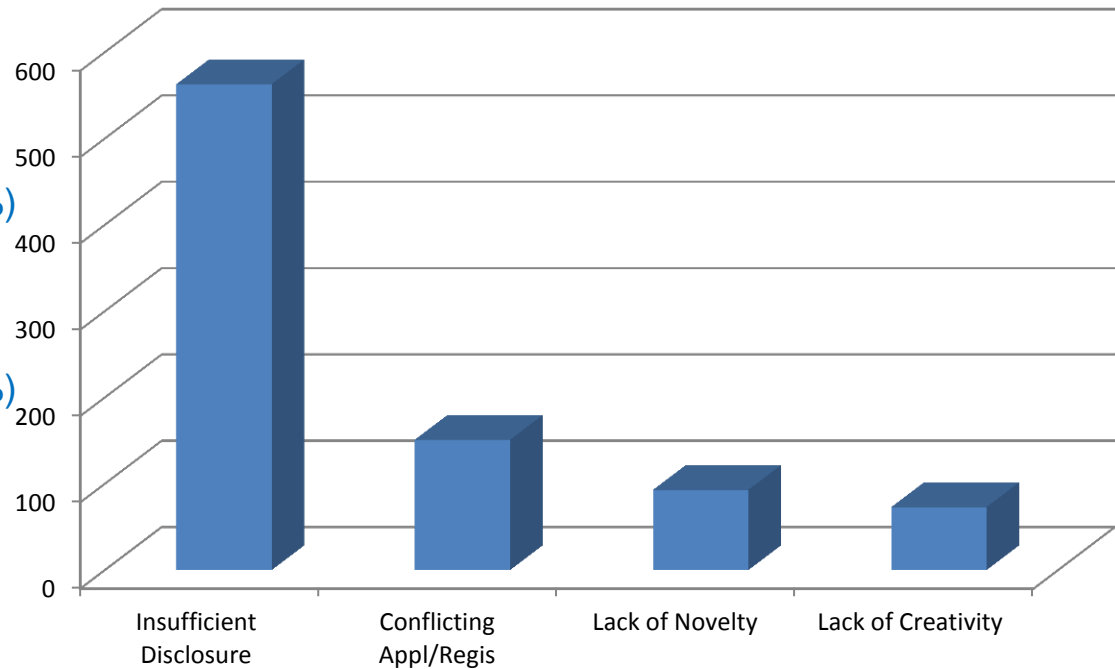
Source: Internal (unofficial) statistics

## 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?

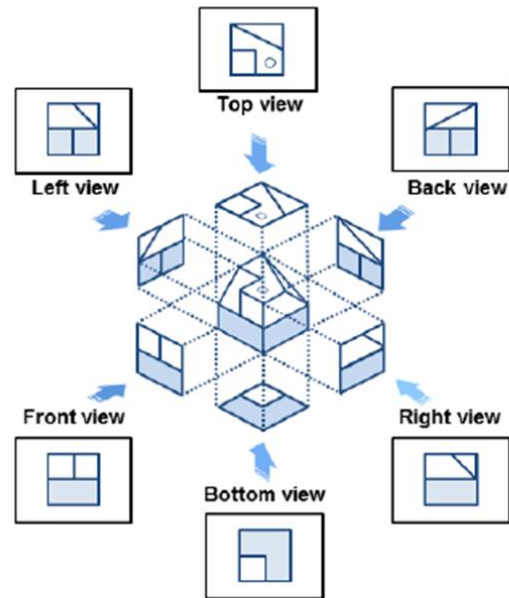
- US: The claimed invention should be described in **such full, clear, concise, and exact terms as to enable any person skilled in the art... to make and use the same...** and.. **particularly point out and distinctly claim the subject matter** which the inventor...regards as the invention.  
(paraphrase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



Six views created by the orthographic projection method

JP: Front, back, top, bottom, left, right view by the orthographic projection method are mandatory (Declaration under Rule 9 (3) )

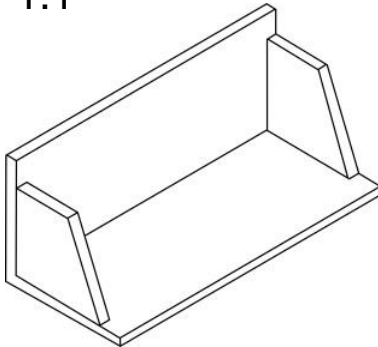
KR, US: Six views are recommended, not mandatory

# 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.

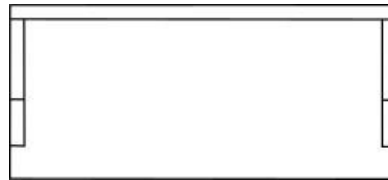
Indication of product: “Bookstand”

1.1



Perspective

1.2



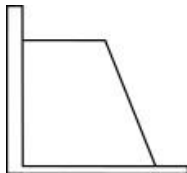
Top

1.6



Back

1.3



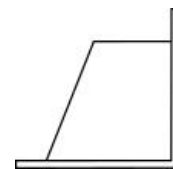
Left

1.4



Front

1.5



Right

1.7



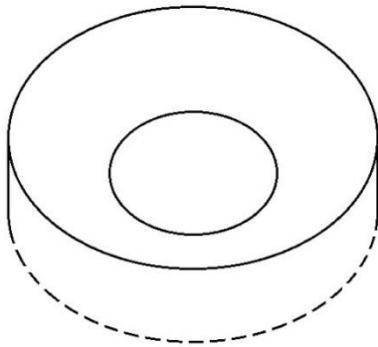
Bottom

# 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

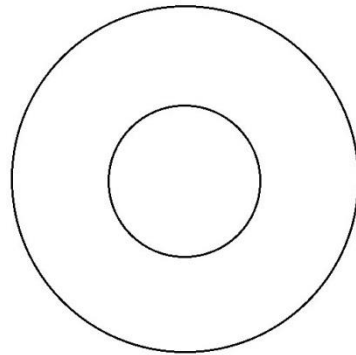
Indication of product: “Pharmaceutical tablet”

1.1



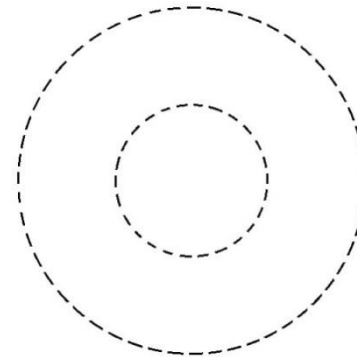
Perspective

1.2



Top

1.3



Bottom

1.4

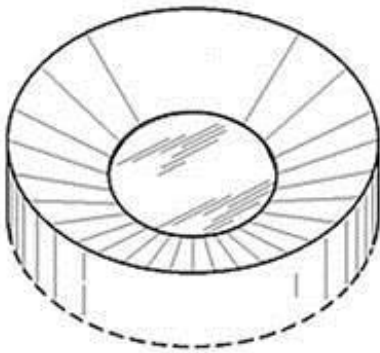


Front

# Lack of / or Inadequate Surface Shading

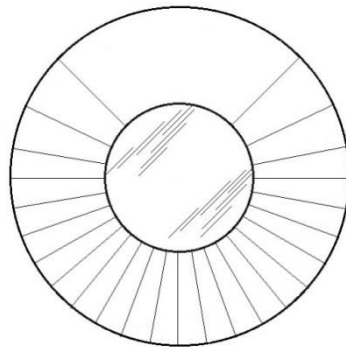
Adequate and proper surface shading clarifies the contours of the design and the scope of protection sought

1.1



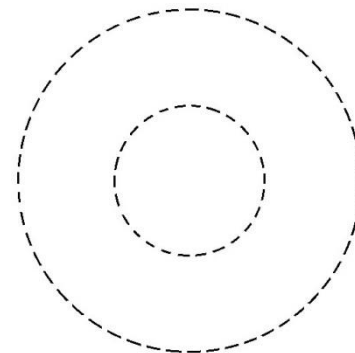
Perspective

1.2



Top

1.3



Bottom

1.4



Front

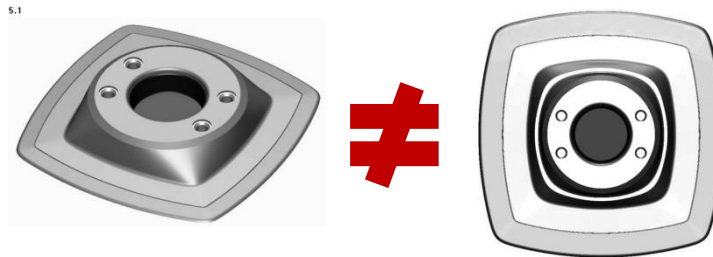
\* JP: submitting sectional views or perspective views to represent relief or contours of surfaces of the product is a more preferable way than providing shading

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

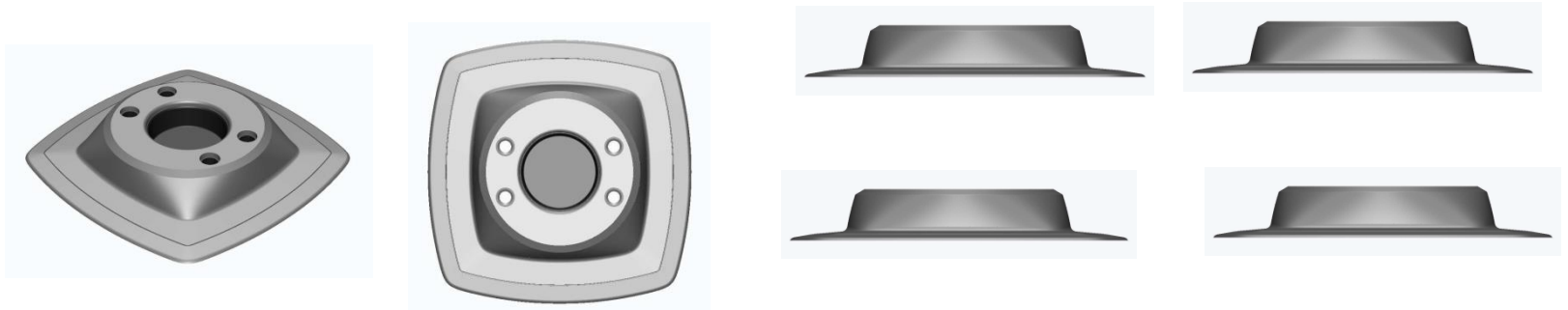
# Lack of Consistency among the Views

- Example (1):

Original



Amended



DM/086312  
(design 5)

Mounting platform for installation on  
inflatable products (class 08-08)

# Lack of Consistency among the Views

- Example (2):

Original

2.1



2.2



2.3



2.4



Amended

Repro. 2.1  
(deleted)



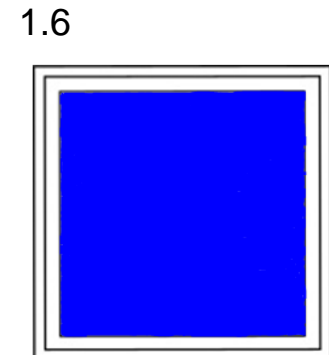
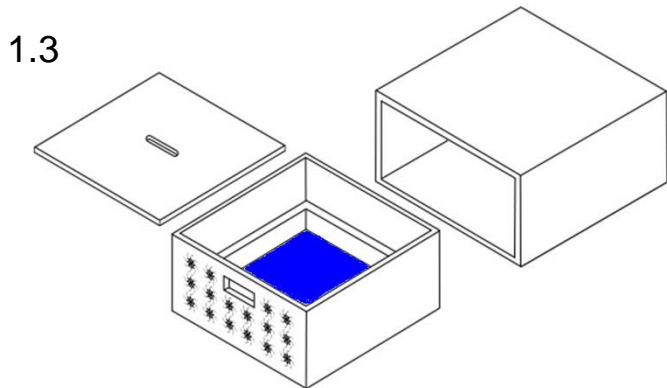
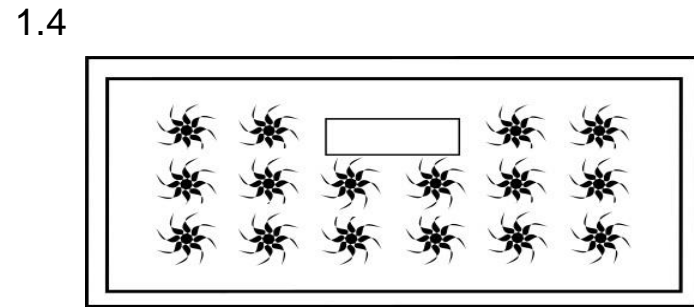
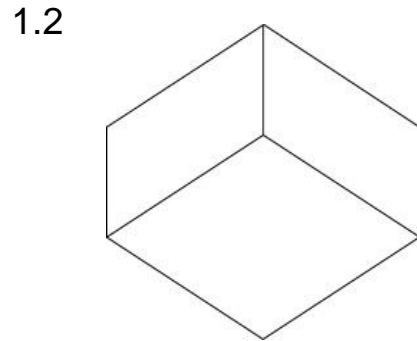
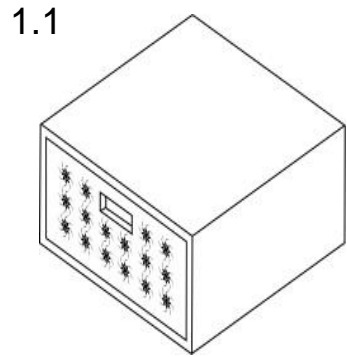
DM/086614 Handbag (class 03-01)  
(design 1)



# 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

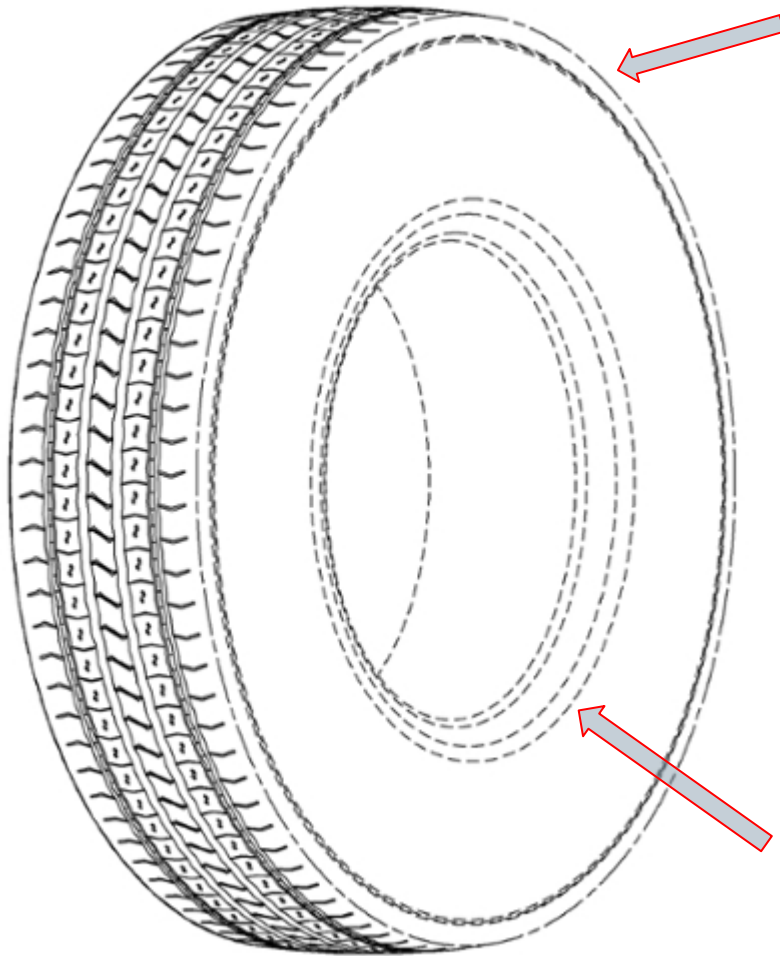
- 1.1) Top, front, perspective view, 1.2) Bottom, rear, perspective view, 1.3) Exploded view, 1.4) Enlarged front view of 1.1, 1.5) Cross-sectional view\*, 1.6) Top view of the inner box
- The blue colored portion of the inner box forms no part of the claimed design.
  - The bottom view of the inner 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



Dot-dashed  
broken lines

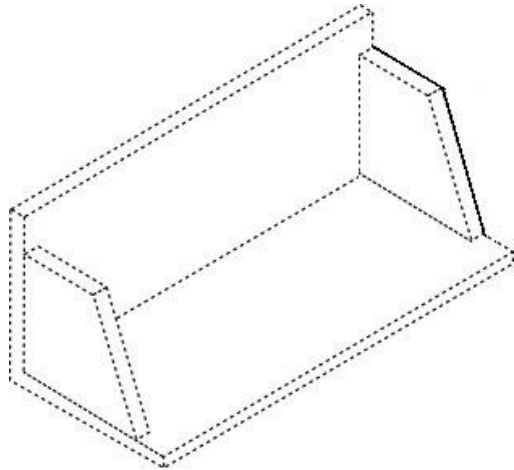
### Descriptions for visually different types of broken lines:

- 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

- Example of descriptions to clarify the design and scope of protection:

1.1

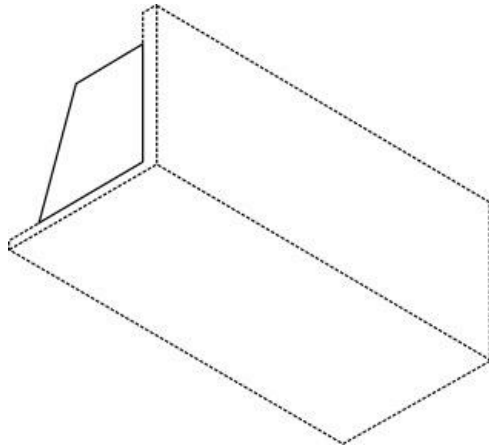


Reproductions \*:

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



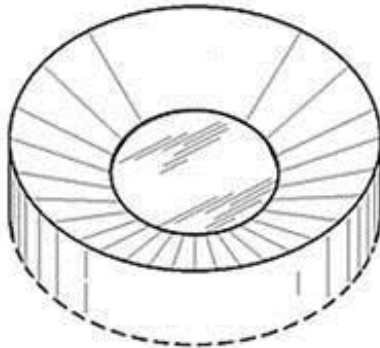
Description \*:

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:

1.1



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

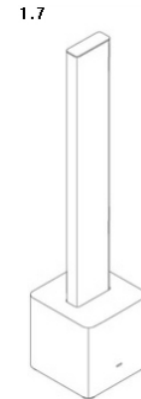
# Ambiguous or Broad Product Indication

- Examples:

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



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



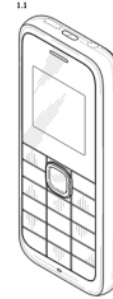
✓ Cycle → **Bicycle, Motorcycle** (class 12-11)



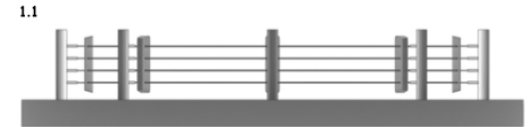
# Ambiguous or Broad Product Indication

- Examples:

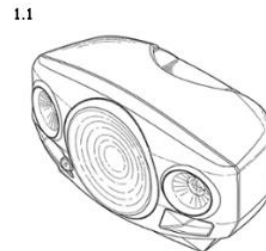
✓ Handset (D088186) → **Mobile phone** (class 14-03)




✓ Sports installation (D089511) → **Boxing ring** (class 25-03)



✓ Portable sound system (D087842) → **Portable speaker** (class 14-01)



# Guidance on Preparing and Providing Reproductions



**WIPO**  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

August 2016

**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**

**(Rule 9(4) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement)**

**GENERAL DISCLAIMER:**

*This Guidance is prepared in consultation with the Examining Offices under the Hague System. The purpose of this guidance is neither to be self-sufficient nor all inclusive; each guidance focuses on a separate issue elaborating ways to help the applicant to avoid a possible refusal. A table at the end of this Guidance indicates whether a specific guidance is recommended by a given Examining Office.*

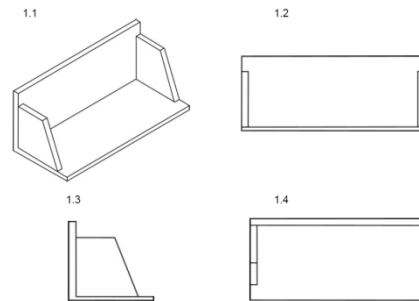
## I. NOT ENOUGH VIEWS

Examining Offices may consider that the design has not been sufficiently disclosed if the whole configuration of the product in which the claimed design is embodied is not fully shown.

### EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The following example involves a bookstand. Only a certain part of the product is shown in the reproductions without any explanation regarding the lack of some views.

Indication of the product: "Bookstand"



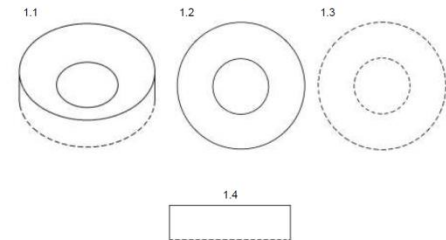
## III. UNCLEAR RELIEF OR CONTOURS OF SURFACES OF A THREE-DIMENSIONAL PRODUCT

It may be considered by Examining Offices that the design has not been sufficiently disclosed if the scope of the claimed design has not been clearly defined with the submitted views in combination with any additional written description.

### EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The contours of a three-dimensional product with curved surfaces have not been clearly shown in the representation since shading is not provided in the drawings.

Indication of the product: "Pharmaceutical tablet"



### Legends

1.1) Perspective (front, top and right); 1.2) Top; 1.3) Bottom; 1.4) Front.

### Description

The parts shown by means of broken lines in the reproductions are not part of the claimed design. The left side view, the right side view and the back view are omitted because they are identical with the front view, respectively.

Available from 10 August 2016 at:

English: [http://www.wipo.int/export/sites/www/hague/en/how\\_to/pdf/guidance.pdf](http://www.wipo.int/export/sites/www/hague/en/how_to/pdf/guidance.pdf)

French: [http://www.wipo.int/export/sites/www/hague/fr/how\\_to/pdf/guidance.pdf](http://www.wipo.int/export/sites/www/hague/fr/how_to/pdf/guidance.pdf)

Spanish: [http://www.wipo.int/export/sites/www/hague/es/how\\_to/pdf/guidance.pdf](http://www.wipo.int/export/sites/www/hague/es/how_to/pdf/guidance.pdf)



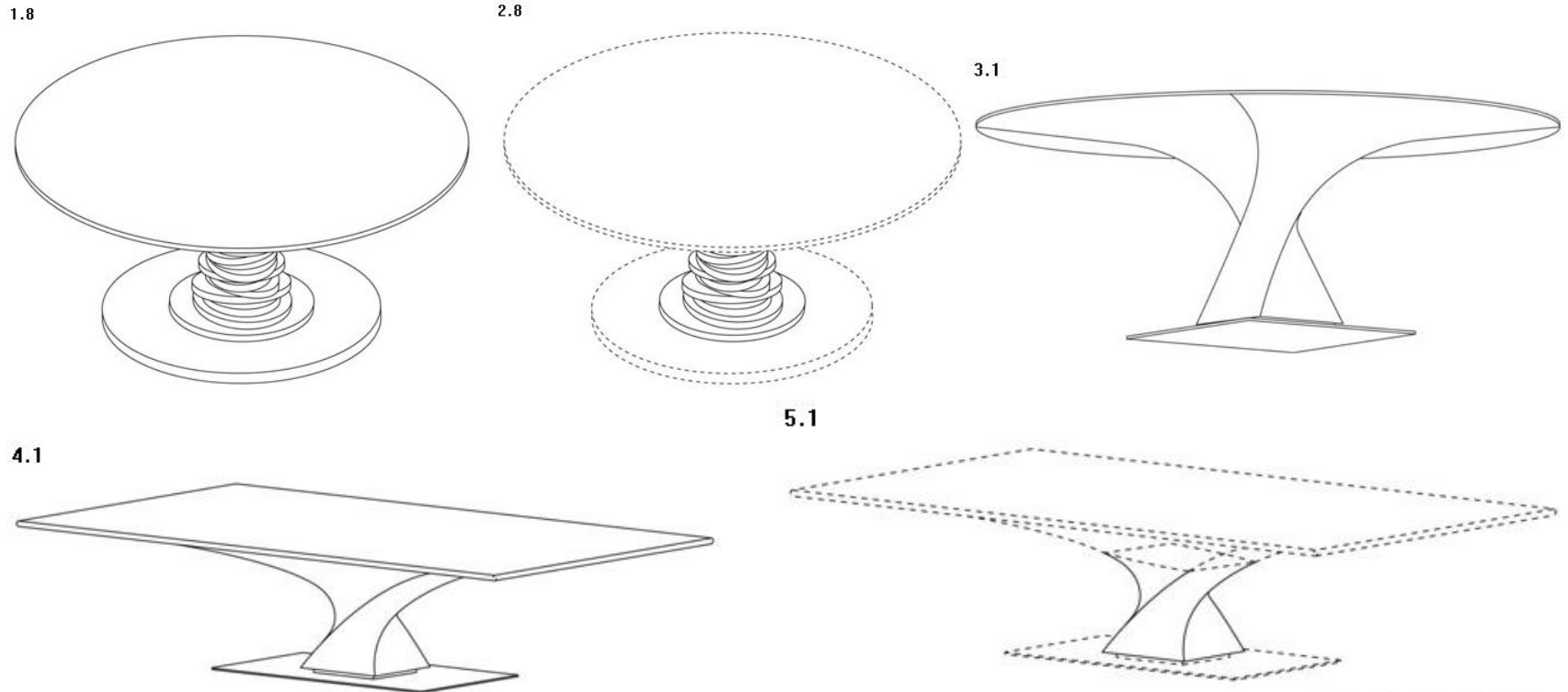
## ■ ISSUES SPECIFIC TO THE USA

# Unity of Design

- Declaration under Article 13(1)

## A single independent and distinct design:

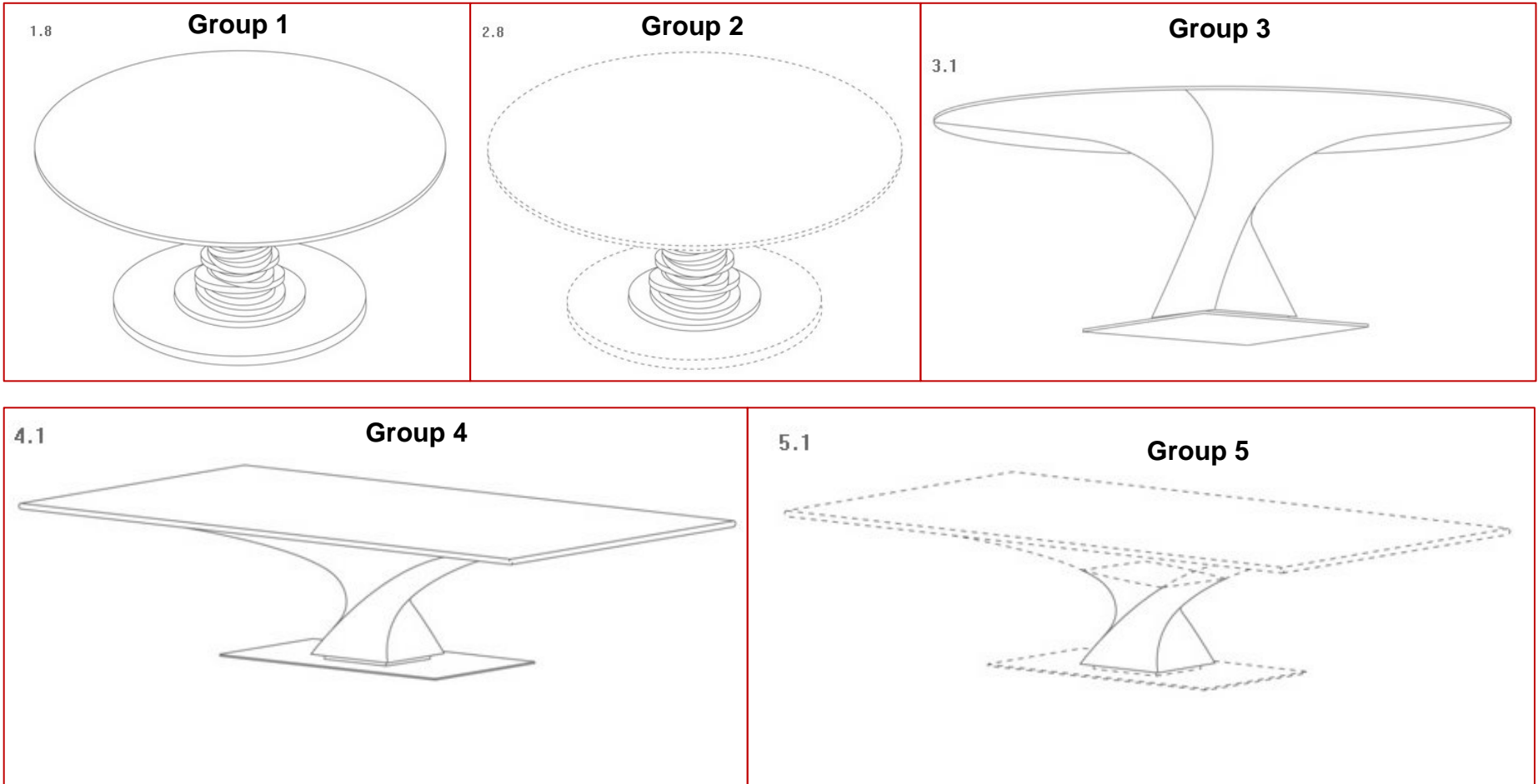
Up to 100 designs may be filed in an application, though patentably distinct designs will be divided out by the United States Patent & Trademark Office (USPTO)



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

# Unity of Design

- Distinct designs and Distinct scope of protection



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

# Unity of Design

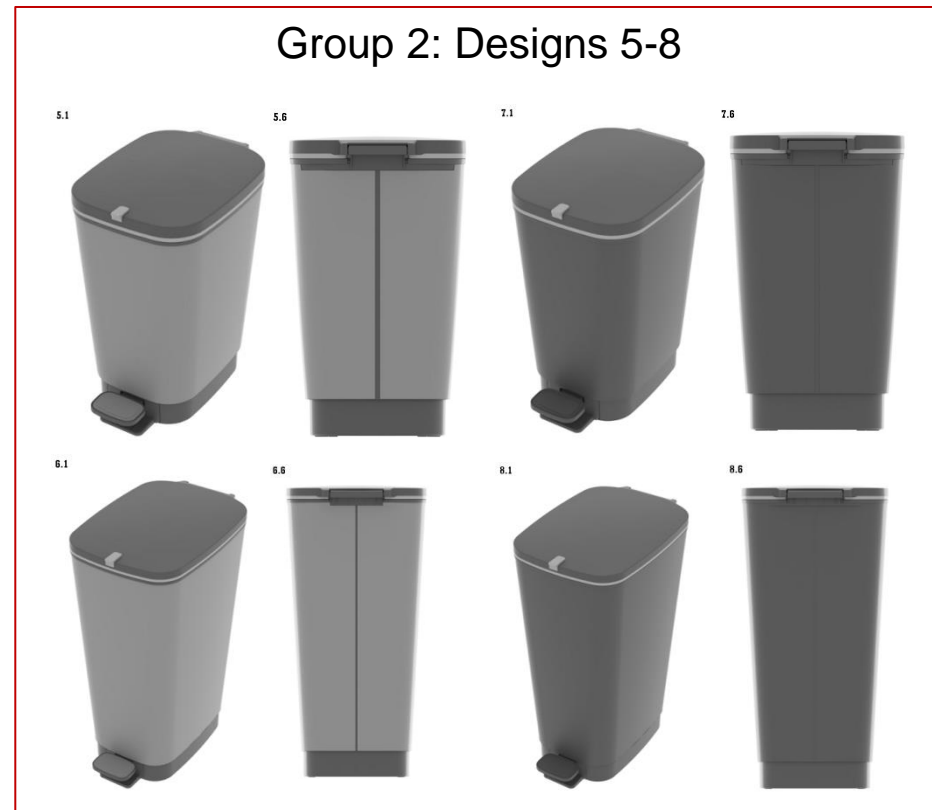
- Indistinct designs or obvious variations:

**DM/087960: Designs 1-8 “Storage Boxes”**



# Unity of Design

- Indistinct designs or obvious variations:

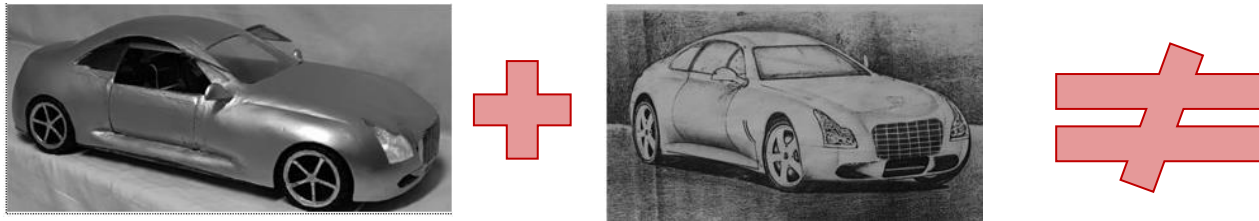


Designs grouped together have the same basic design characteristics:

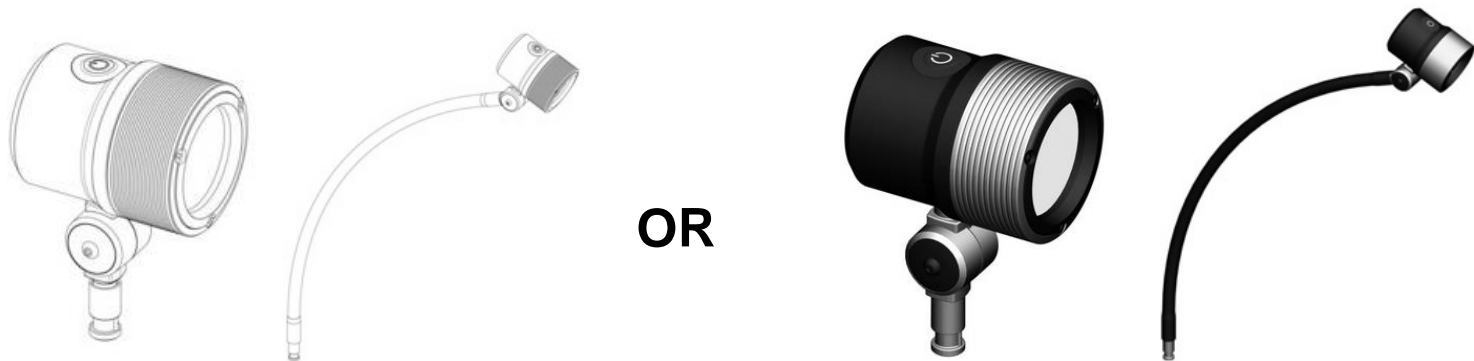
- similar in overall appearance
- similar in visual impression
- similar in shape/ configuration

# Representations of the Design

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

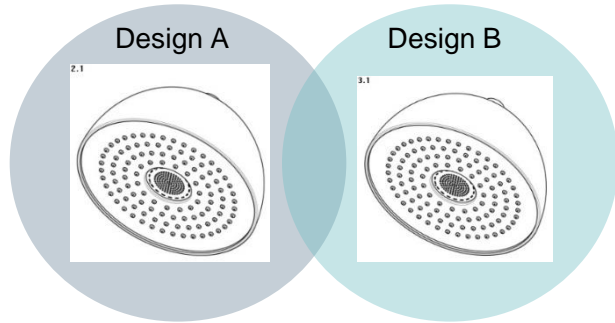


**Photographs and ink drawings are not permitted to be combined as formal drawings in one application.** US: 37 CFR 1.152



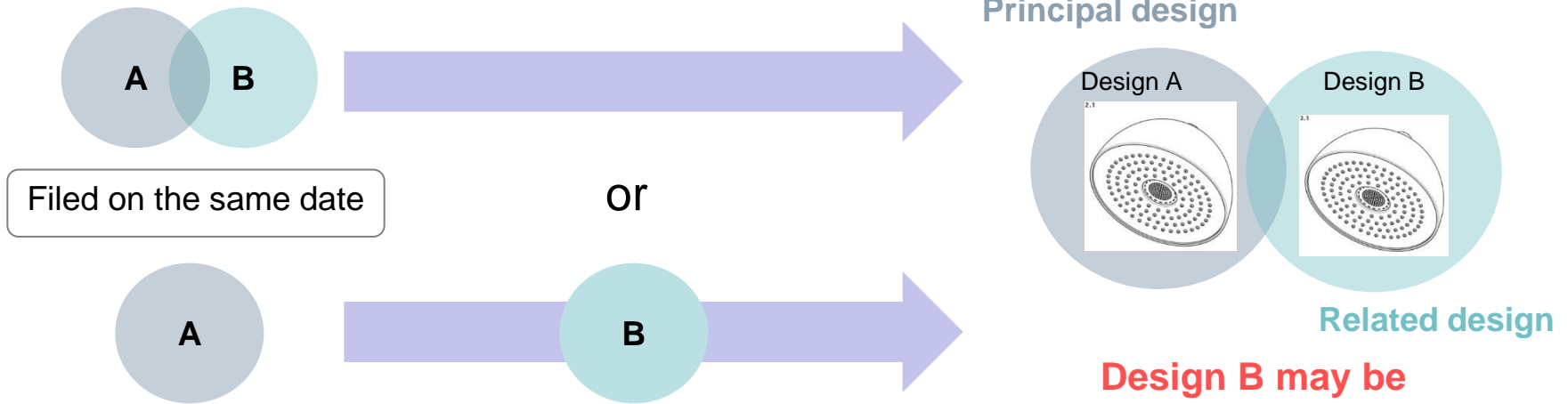
# ■ ISSUES SPECIFIC TO JAPAN AND THE REPUBLIC OF KOREA

# What is related design?



DM/084369

- Similar
- Filed by the same applicant
- Filed in appropriate duration



Principal design

Design A

Design B

Related design

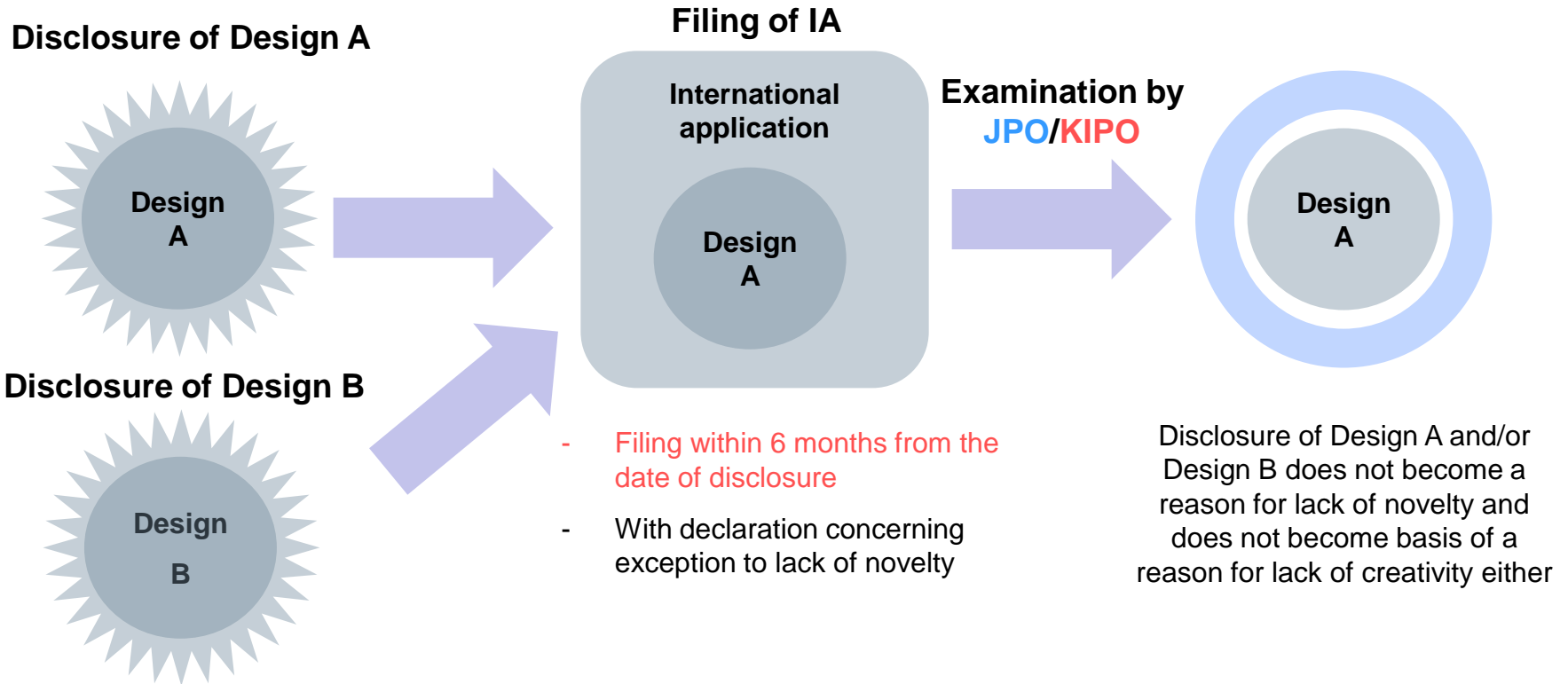
**Design B may be registered as a related design of Design A**

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



# Exception to Lack of Novelty: JP, KR

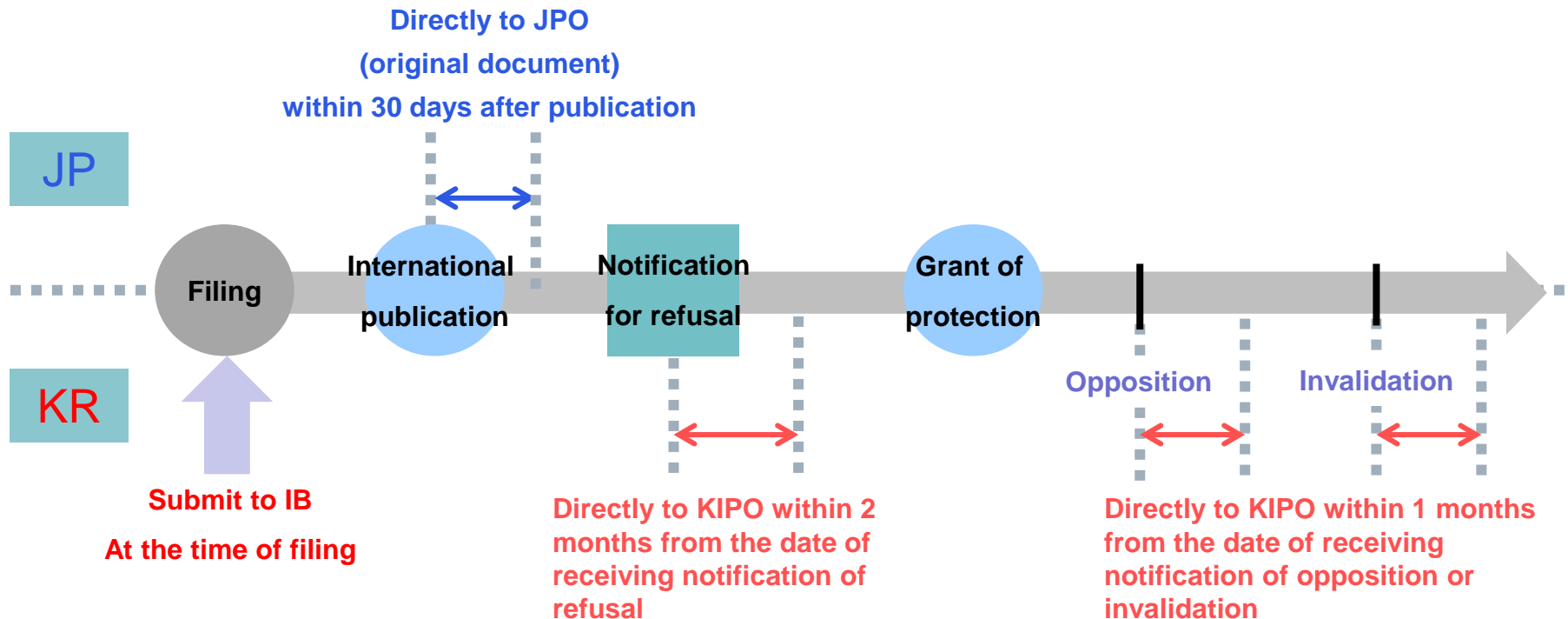


In an exhibition, published materials such as a magazine, catalog, or through the internet media, etc.

- 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



(Only in KR) After filing, directly to KIPO

- Upon submitting written opinion against notification of refusal
- Upon submitting written refutation against opposition or invalidation

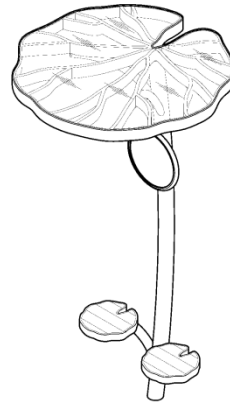
# Declaration under Rule 9(3) by KR

- 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)



< Perspective A >  
(table + chair)



< Perspective B >  
(table)



< Perspective C >  
(chair)

- 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)

A B C D E F G  
H I J K L M N  
O P Q R S T U  
V W X Y Z  
a b c d e f g h i j  
k l m n o p q r  
s t u v w x y z

(52 given characters)

The quick  
brown fox  
jumped  
over the  
lazy dog

The quick brown fox jumped over  
the lazy dog

(sample sentence as  
with above)

H a  
R e  
S g

(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)

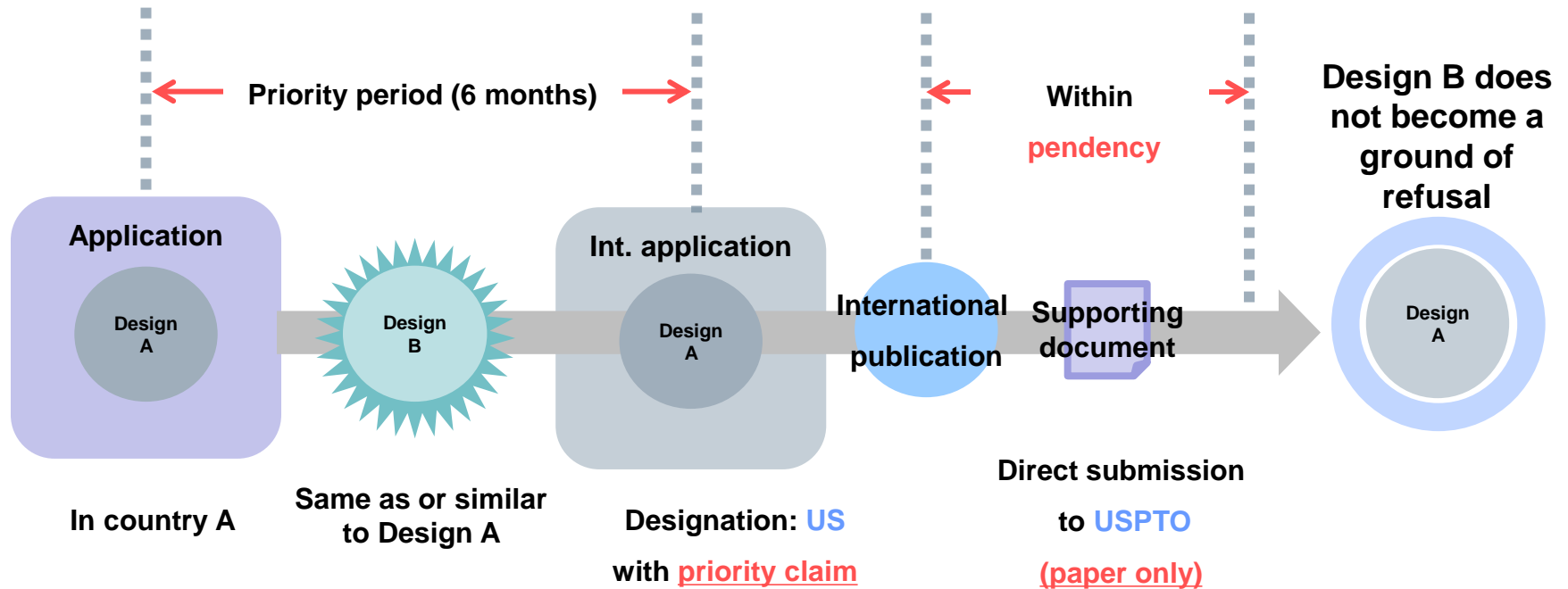
### < **Partially substantive examination** >

(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)

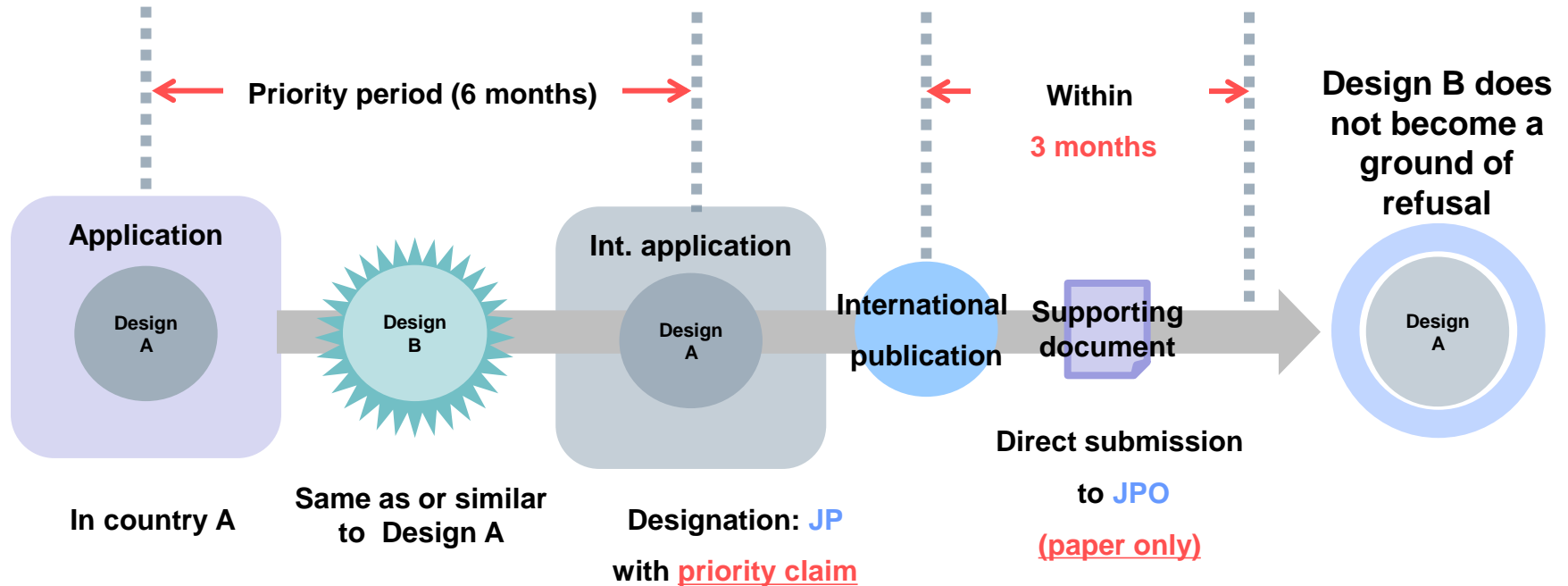
# ■ PRIORITY DOCUMENTS

# Priority Documents for US



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)).

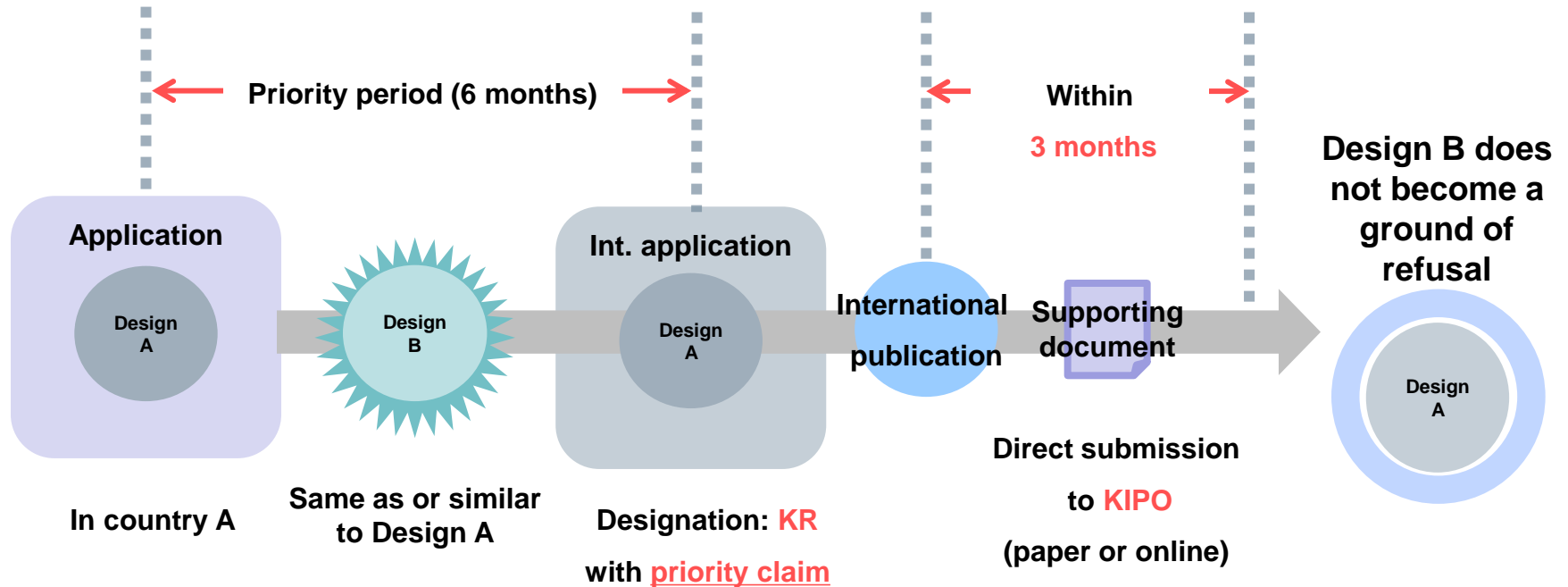
# Priority Documents for JP



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



< **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:

Japan: <http://www.wipo.int/hague/en/members/profiles/jp.html?part=general>

Republic of Korea: <http://www.wipo.int/hague/en/members/profiles/kr.html?part=general>

USA: <http://www.wipo.int/hague/en/members/profiles/us.html?part=general>