

Insights into Refusals

Practice and Experience of the Federal Service for Intellectual Property (ROSPATENT)

*The Hague System: Roundtable on Refusals Issued by
Designated Offices*

Structure

- Legal basis
- Definitions
- Proceedings
- Examples
- Questions & answers

Legal basis

- Geneva act (1999) to the Hague agreement concerning the international registration of industrial designs
- Regulations (Common Regulations , Administrative Instructions)
- Civil Code of the Russian Federation (part IV, Chapter 72 «Patent rights») with the latest amendments entered into force on June 27, 2019 by the Federal Law of December 27, 2018 № 549-FL)
- Requirements for the application documents to grant a patent for an industrial design, approved by the order № 695 of the Ministry of economic development of Russia of September 30, 2015
- Rules for drafting, filing and consideration of documents for an application to grant a patent for an industrial design, approved by the order № 695 of the Ministry of economic development of Russia of September 30, 2015

What is an industrial design? *article 1351(1)*

- A solution of an external appearance of the article manufactured industrially or made by artisans shall be protected as an industrial design
- The essential features of an industrial design shall include features determining the aesthetic characteristics of the external appearance of the article, in particular, the shape, configuration, ornamentation, combination of colors, lines, contours of the article, texture or material of the article

The features, which are solely determined by a technical function of the article, are not the features of the industrial design for which legal protection is granted

Requirement of unity of an industrial design

article 1377(1) of the Civil Code, paragraph 2 of the Requirements for the application documents

- **one industrial design or a group of industrial designs**, associated with each other so closely as to form a **single creative concept**

This requirement is met where there is:

- **one independent and distinct industrial design**
- or **one industrial design and its variants differing from that industrial design by visually non-essential features and/or by color combination**
- or **a group of industrial designs belonging to the same set of articles, as well as one or more industrial designs for separate articles belonging to the same set of articles**

It is required that all industrial designs of the group **shall belong to the same class** of International Classification for Industrial Designs (Locarno classification)

Essential and non-essential features, *clause 72 of the Rules for the drafting, filing and examination of the documents*

- **The essential features** of the external appearance are recognized as essential if they **determine the aesthetic characteristics of the external appearance of an article, being dominant and determine the overall visual impression**
- **The non-essential features** of the external appearance include **such slightly distinguishable and inexpressive features** of the external appearance of an article, **the exclusion of which** from the set of the features of the external appearance **does not lead to a change the overall visual impression**

Patentability, *article 1352*

- **Novelty**

the sum of its essential features reflected on reproductions of the external appearance of the article is not known from the information that has become public worldwide before the priority date of the industrial design

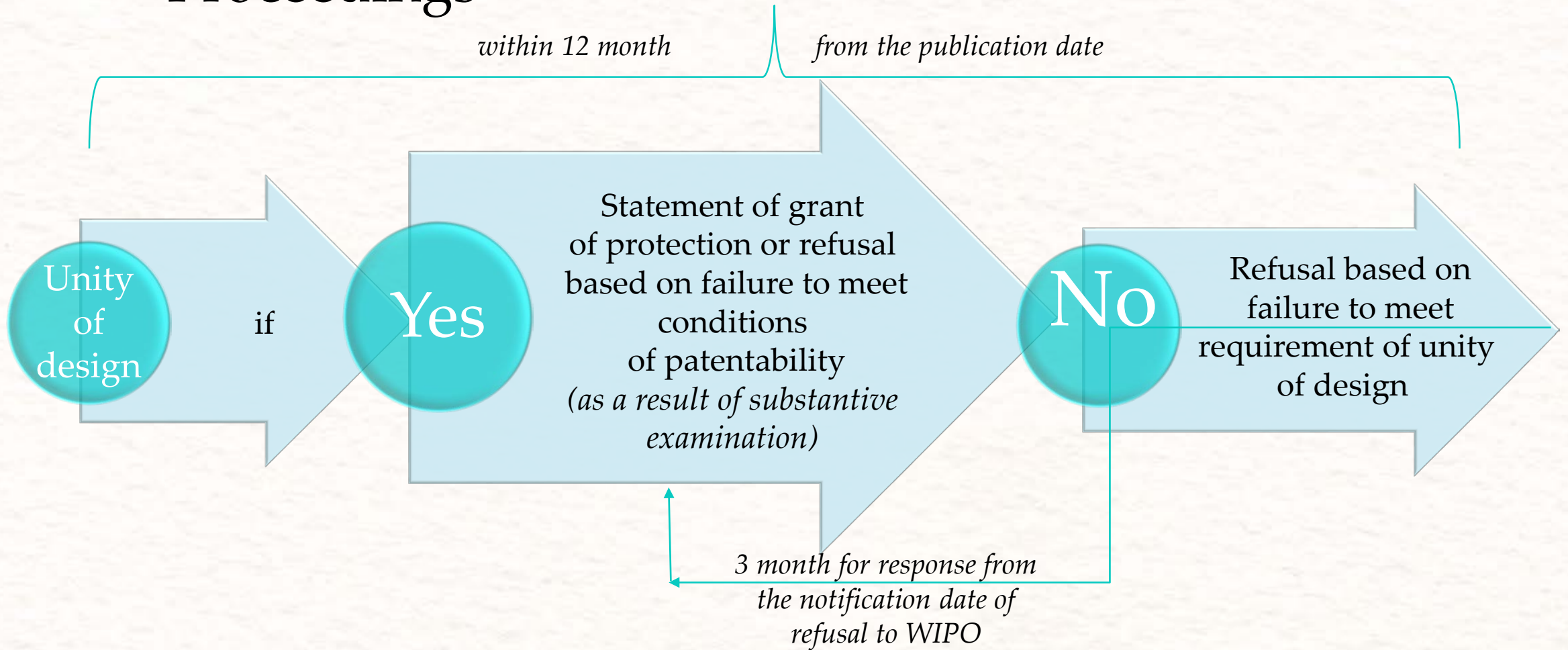
- **Originality**

its essential features are determined by the creative nature of the special features of the article, in particular, if **a solution of an external appearance of the article of similar purpose which produces the same overall impression on the informed consumer as the industrial design pictured on the reproductions of the article external view is unknown from the information that has become public worldwide before the priority date of the industrial design**

Legal protection shall not be granted, *articles 1231.1, 1349(4), 1352(5)*

- if they are contrary to public interest, principles of humanity and morality
- contain, reproduce or imitate the official symbols, names and distinctive marks or their recognizable parts (*may be included in an industrial design as an unprotected element, in case of consent from the relevant competent government authority, the body of an international or intergovernmental organization*)
- solutions that are **solely determined by the technical function** of the article
- solutions that **could mislead the consumer** in a way of recognition of the article manufacturer, or the place of article manufacturing, or goods for which the article is a container, packaging, labeling, particularly **the solutions identical to ones specified in clauses 4-10 of Article 1483 of the Civil Code of the Russian Federation**, or producing the same overall impression, or including the mentioned objects, if the rights for the mentioned objects emerged earlier than the priority date of the industrial design, except in case the legal protection of the industrial design is sought by a person or legal entity who have the sole right for such object
- **Granting of legal protection** for the industrial designs which are identical to the objects specified in clause 4, sub-clauses 1, 2 of clause 9 of Article 1483 of the Civil Code of the Russian Federation, or producing same overall impression, or including the mentioned objects **is allowed with the permission of the owners or persons authorized by the owners or ones who possess the rights for the mentioned objects**

Proceedings



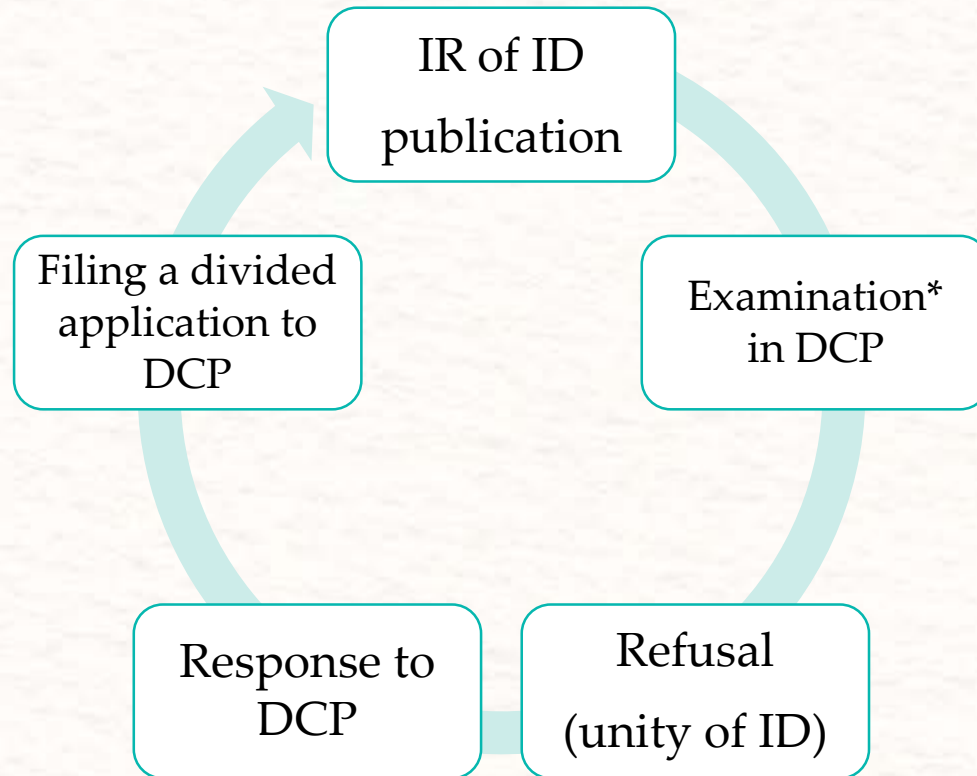
Filing a divided application, *article 1381(4)*

- Directly to ROSPATENT
- All requirements apply in accordance with the national legislation
- **The priority of an industrial design for a divided application shall be stated by the filing date of the initial application** filed by the same applicant to the federal executive authority for intellectual property disclosing industrial design, and **in case there is a right to state an earlier priority of the initial application - by the date of this priority**, given that, as of the filing date of the divided application, **the initial application for an industrial design was not withdrawn and is not considered withdrawn and the divided application was filed before the opportunity to file an objection to the decision to refuse to grant a patent on the initial application has been exhausted, or before the date of registration of the industrial design in case a decision to issue a patent was made on the basis of the initial application**

Time limits for a divided application, *article 1387(3)* *and article 1389*

- Within **seven months from the date of the notifications of refusal** the applicant can file the divided applications under Clause 3 of Article 1387 of Part IV of the Civil Code of the Russian Federation
- If an applicant misses the mentioned time limit and presents the proof of good reasons for missing the time limit, this mentioned time limit may be restored by Rospatent under Clause 1 of Article 1389 of Part IV of the Civil Code of the Russian Federation
- **A request for the restoration of a missed time limit may be submitted by an applicant within twelve months following the expiration of an established time limit** under Clause 2 of Article 1389

Process



- IR – international registration
- ID – industrial design
- DCR – designated contracting party
- Examination* - 1st step – check the requirement of unity of design

2nd step – substantive examination (patentability - originality, universal novelty, public order and morality)

Requirement of unity of design is not met

Examples

Accessory for agricultural machines

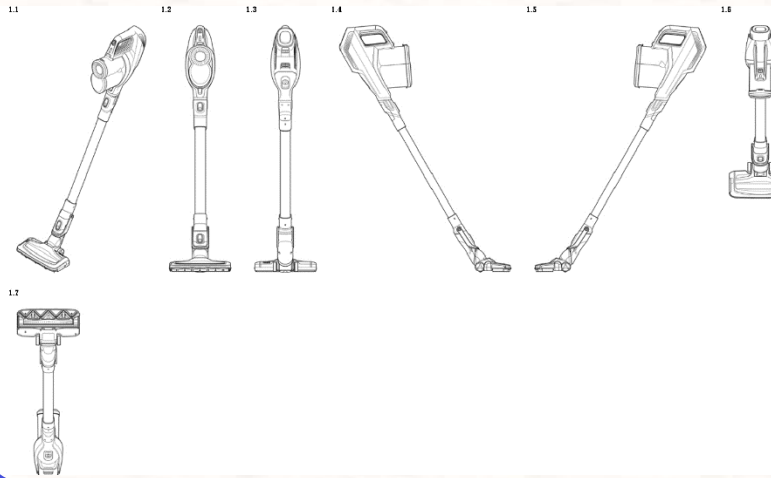
Design №1

Design №2

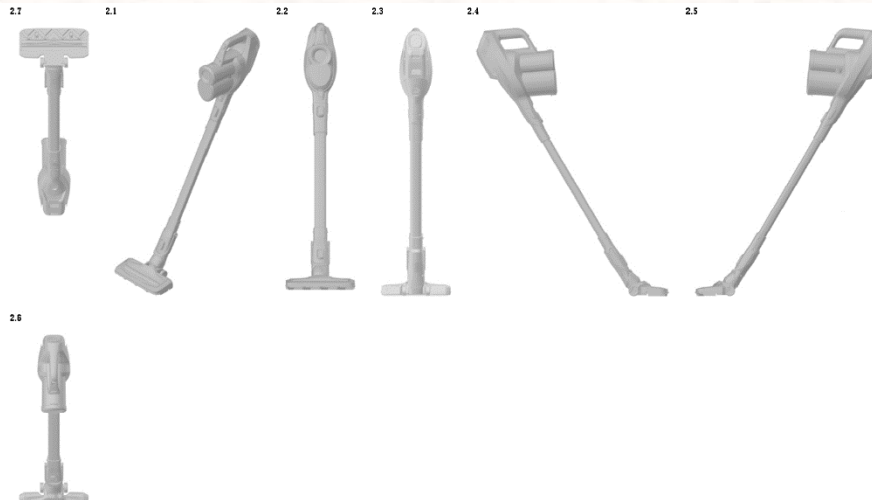


Stick vacuum cleaner [Design No 1, 2] Handheld part of vacuum cleaner [Design No 3]

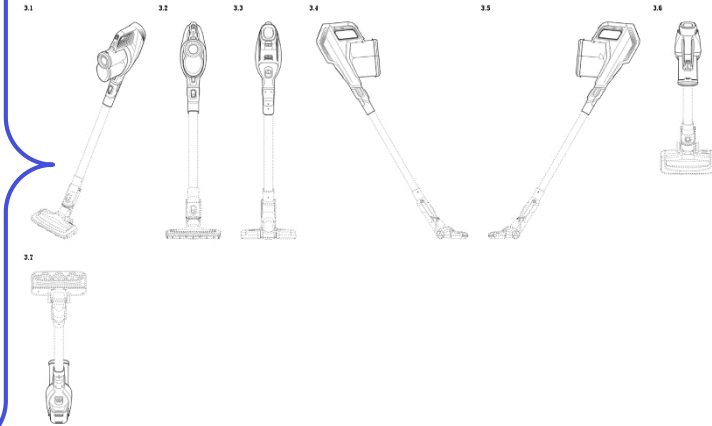
Design No 1



Design No 2

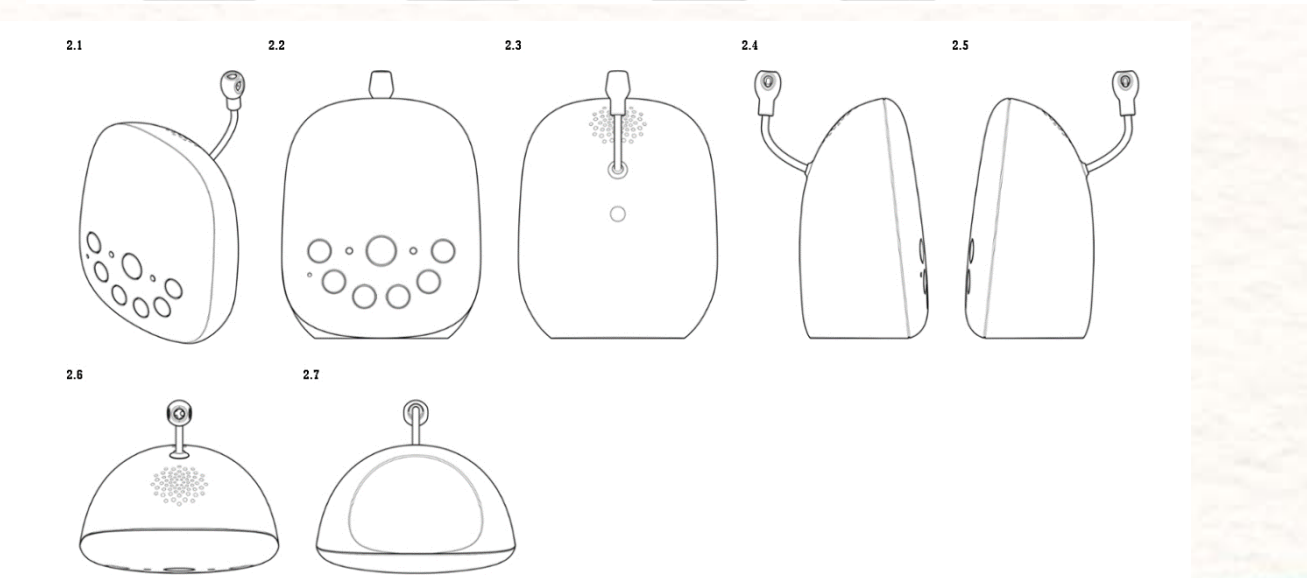
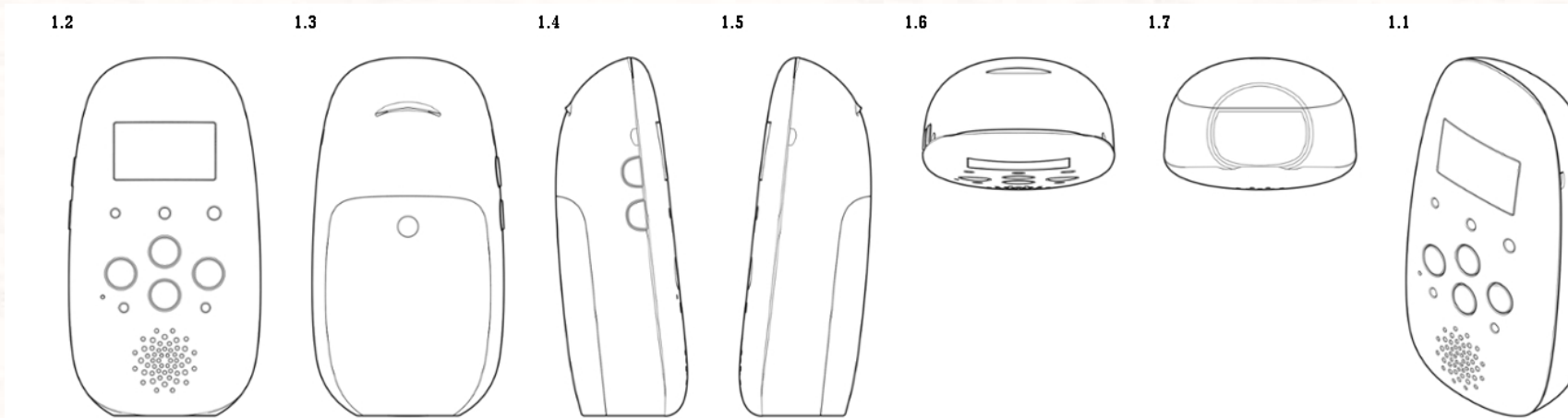


Design No 3



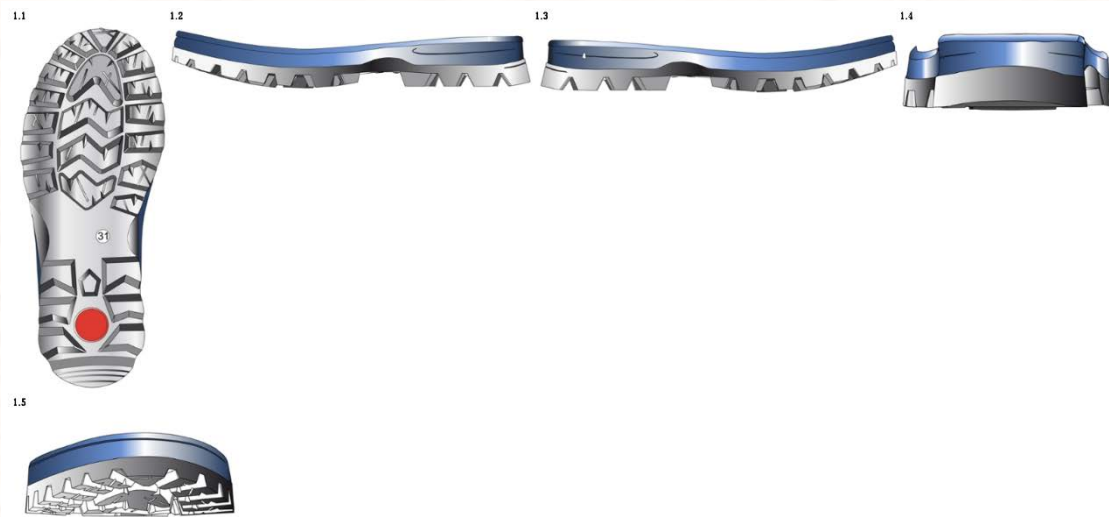
No1 and No2 considered as a group

Parent unit for baby monitor [Design No 1] Baby unit for baby monitor [Design No 2, 3]

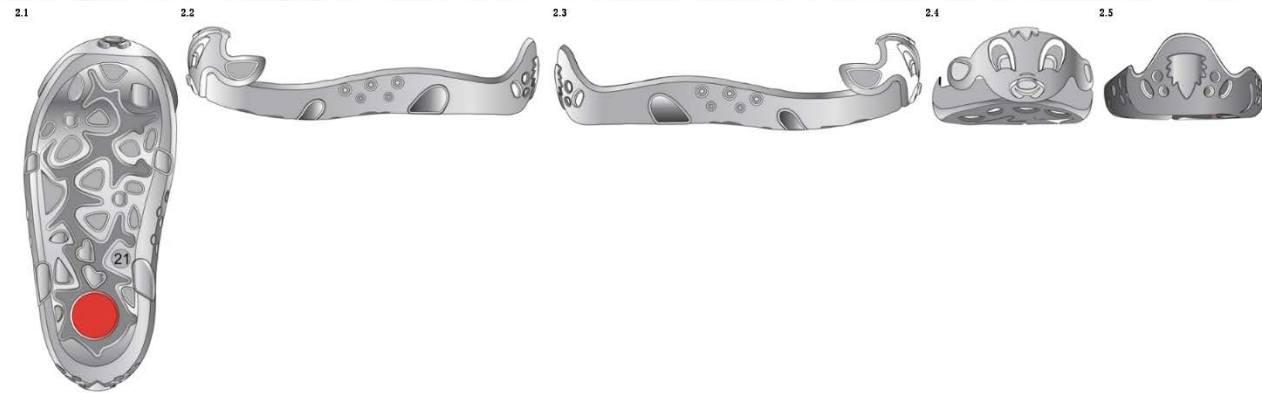


Footwear sole

Design No1



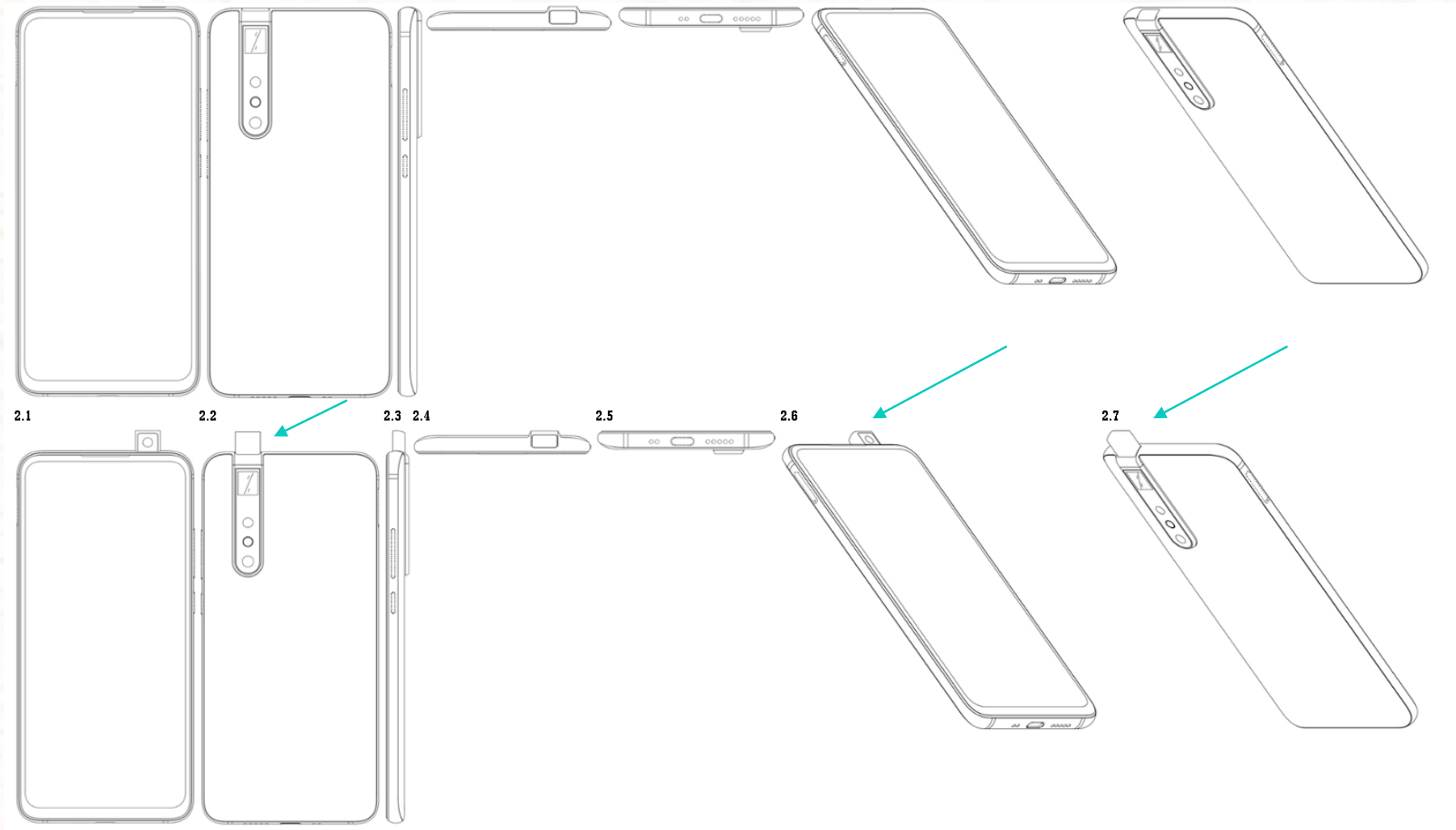
Design No2



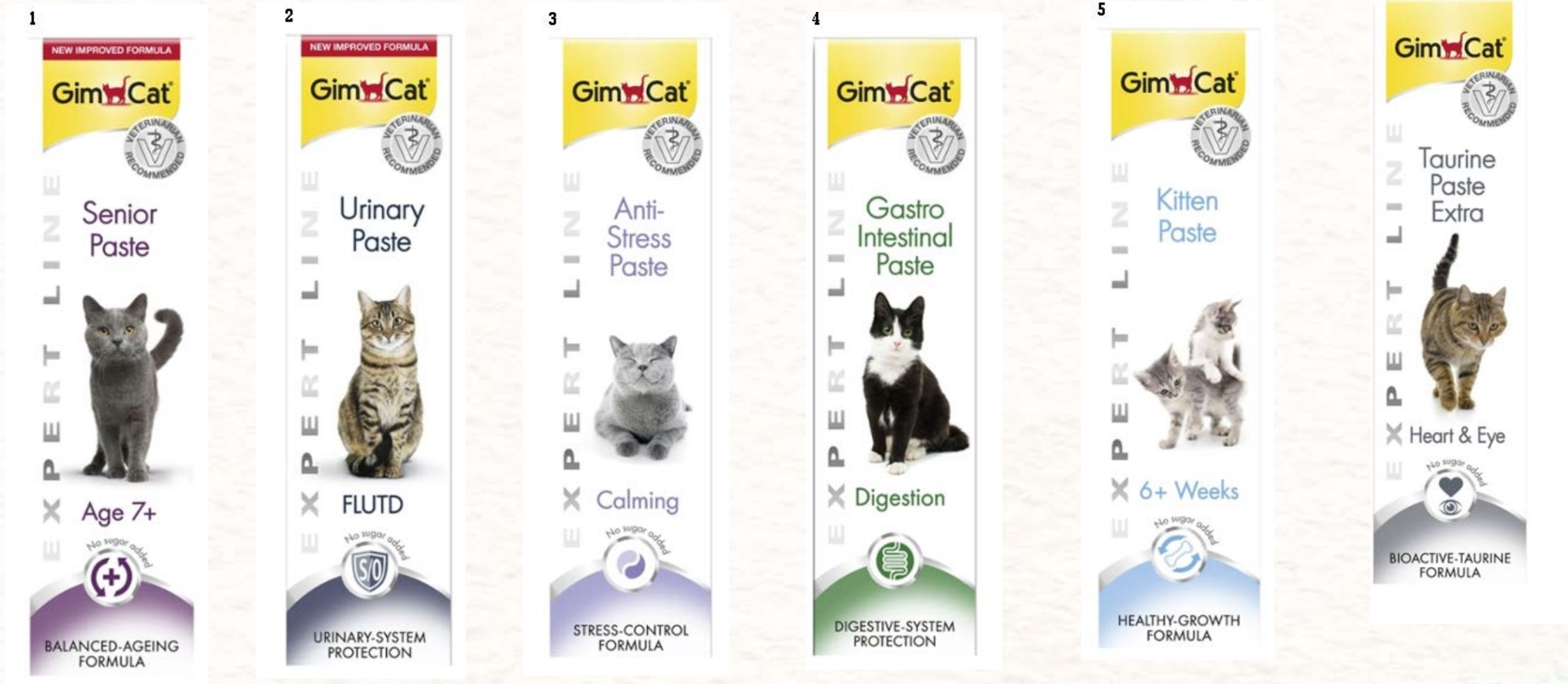
Design No3



Mobile phone



Packaging for the transport and sale of goods

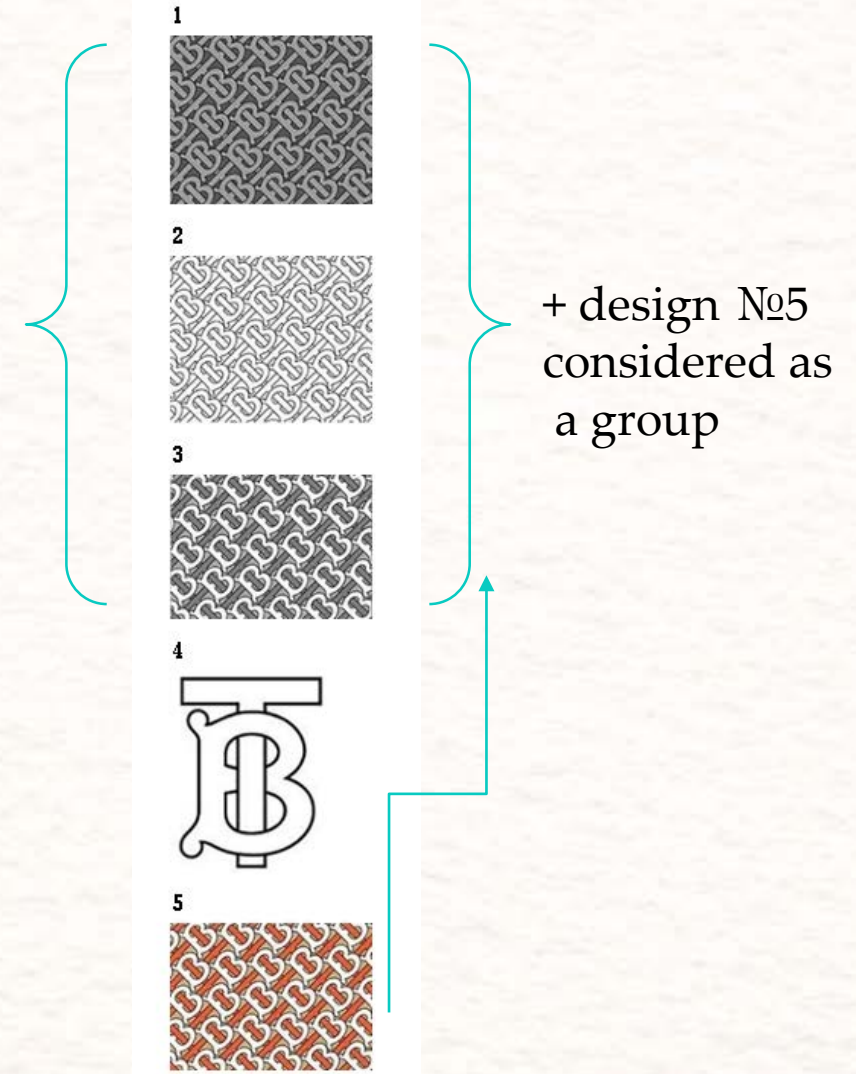


Surface pattern [Design No 1-3, 5] Logo [Design No 4]

Under clause 32 of the Requirements for the application documents to grant a patent for an industrial design, any article manufactured industrially or made by artisans, particularly packaging, label, composite article, set (kit) of articles, font, as well as an independent part of an article is understood to be an article, and a separate part, which is visible during the normal use, namely, images, graphical symbols, logotypes, applied to the surface of the article is understood to be the independent part

Accordingly, **if a pattern or an ornament is claimed as an industrial design**, in order to classify it as an independent part of an article, **an indication of an article for which it is intended is necessary**

The claimed group of industrial designs “Surface pattern” does not have an indication of an article of which it is an independent part



Information relating to subsequent procedures

NOTIFICATION OF REFUSAL

- **Within three months from the date of notification of refusal indicated under item VII, the applicant can report which industrial design(s) filed in the application should be considered. Please note that the extension of the time limit established for response is NOT permitted**
- **In case of non-receipt of communication from applicant by Rospatent within the established time limit, the examination will be conducted in accordance with clause 4 of Article 1384, clause 3 of Article 1391 of Part IV of the Civil Code of the Russian Federation in respect to the object that was specified first or a group of industrial designs meeting the requirement of unity of an industrial design with the first industrial design specified in the application**
- **Other industrial designs claimed in the application can be processed as divided applications meeting the requirement under clause 4 of Article 1381 of Part IV of the Civil Code of the Russian Federation.**
- **The applicant must submit his response to this notification directly to Rospatent and through a patent attorney registered in the territory of the Russian Federation (clause 2 of Article 1247 of Part IV of the Civil Code of the Russian Federation) without forwarding it to the International Bureau of WIPO**
- **The list of patent attorneys is provided on Rospatent website under the section **Activities - Patent Attorneys** at: http://www.rupto.ru/en/activities/patent_attorneys**
- **Additional materials which amend the application for an industrial design in substance are not accepted for consideration (clause 3 of Article 1378 of Part IV of the Civil Code of the Russian Federation)**

Contact information

Larisa Boroday

Head

International registration systems
department

Madrid system & Hague system

[FIPS](#) / [ROSPATENT](#)

+7 (495) 531-65-97

e-mail: larisa.boroday@rupto.ru

