

NEW CHANGES TO DESIGN AND UTILITY MODEL PATENT APPLICATIONS IN CHINA

EXTENDING DESIGN PATENT PROTECTION TO SOFTWARE GRAPHICAL USER INTERFACE (“GUI”) DESIGNS

On 12 March 2014, the SIPO announced and implemented the Decisions on Revision of the Patent Examination Guidelines by SIPO Order No. 68 (the “No. 68 Decisions”) effective from 1 May 2014. The decision extends design patent protection to software graphical user interface (“GUI”) designs.

CHANGES TO THE GUIDELINES IN RELATION TO GUI DESIGNS

Previously, Section 7.4.11 of Chapter 3 of Part 1 of the Guidelines stipulated that software graphical user interface (“GUI”) designs, such as pattern displayed on a phone screen and software interface, are not patentable subject matter. After the implementation of the No. 68 Decisions, Section 7.4.11 has been amended such that GUI designs are patentable except game interfaces, displays which are not related to functionality or man-machine interfaces.

To accommodate for the change, the No. 68 Decisions made further amendments to various sections of the Guidelines to emphasize the significance of the GUI to the overall visual effect of the design and to provide

expressly for the requirements of figures and specifications to be submitted for product design patent applications which incorporate GUI.

EFFECT OF THE DECISIONS

While design patent protection for GUIs has been available in Japan and the U.S. for more than twenty years and Taiwan began providing such design patent protection also more than one year ago, it is welcoming to see that China is increasing its efforts in providing patent protection for advance innovation in the fast growing information and communications technologies sector. Indeed, as the SIPO identified, the reasons for the change include the pervasiveness and growing importance of GUI’s, as well as increased domestic investment in GUI design.

CHANGES OF PRIOR ART SEARCH PRACTICE IN PRELIMINARY EXAMINATION

On 6th November 2013, the State Intellectual Property Office of China (the “SIPO”) announced the Order No.67 to implement the Decisions on Revision of the Patent Examination Guidelines by SIPO (the “No.67 Decisions”), which was effective from 15th October 2013. The Decisions focused on the current preliminary examination practice of design and utility model (“UM”) applications, and it amended the corresponding sections of the Patent Examination Guidelines (the “Guidelines”) accordingly.

Previously, examiners would not conduct any searches during preliminary examination (this position has been stipulated clearly even in the Guidelines). After the implementation of the Decisions, the SIPO has changed the practice in relation to preliminary examination and raised the threshold for design and UM application accordingly.



CHANGES TO THE GUIDELINES IN RELATION TO UTILITY MODEL APPLICATIONS

Before the changes, Sections 11 and 13 of Chapter 2 of Part 1 of the Guidelines stated that the examiner, during preliminary examination of an UM application, generally would not conduct any searches to determine if the application is obviously lacking novelty, or whether there are more than one applicants filing patent applications for the same invention.

Under the No.67 Decisions, the words “generally would not conduct any searches” of the two articles are now deleted.

CHANGES TO THE GUIDELINES IN RELATION TO DESIGN PATENT APPLICATIONS

Similarly, the position under Sections 8 and 11 of Chapter 3 of Part 1 of the Guidelines that the examiner would examine based on the application document and common sense of a general consumer alone but not conduct searches on prior arts and registration of design has also been changed.

Under the No.67 Decisions, the words “generally would not conduct any searches” and “based on the application document and common sense of a general consumer” are now deleted.

EFFECTS OF THE DECISIONS

Previously, UM and design patent applications would undergo only formality examination before grant, which were welcomed by the applicants as it took a much shorter pending period, around 6 to 9 months. However, this policy resulted in the reputation of UM and design patents for being unstable. The public were skeptical of the value of the UM and design patent without a corresponding positive patent evaluation report conducted by the SIPO.

The revision of Guidelines is expected to improve the quality of UM and design patents as the examiners are now no longer explicitly excused from conducting searches during preliminary examination. Although it is not as sophisticated as the normal substantive examination for invention patent applications, the new preliminary examination practice will likely increase public confidence in the novelty of newly granted UM or design patents.

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