

Contributing firm
Tsai Lee & Chen



Authors

Candy KY Chen and James HC Su

Since Apple used its design patents to trump its competitor Samsung, it seems that the weapon of choice used on the commercial battlefield has switched from hi-tech patents to visual designs. As designs have become so crucial, companies should take a closer look at design patents in Taiwan.

Legal framework

In Taiwan, designs are protected under the patent law framework. Under Article 2 of the Patent Act, the term 'patent' is classified into three categories: invention patents, utility model patents and design patents. A design must meet the patentability criteria of novelty, creativeness and industrial applicability in order to be eligible for patent protection. According to the Patent Act, a 'design' is a visual creation emphasising the ornamental features of a whole article or part of an article. Designs are different from invention patents and utility model patents, which involve technological innovations. Unlike the technical features and functional means disclosed in

invention or utility model patents, designs cover only visual creations made in respect of the shape, pattern or colour of an article, or combinations thereof. In other words, a design patent emphasises the creativeness of the article's appearance, rather than the design's functionality.

The Patent Act was revised thoroughly in January 2013 and the design patent system underwent a dramatic change. Several new types of design creation are now eligible for design patents, such as:

- designs in part;
- computer-generated icons applied to an article; and
- a graphic user interface (GUI) applied to an article.

Exceptionally, the revised act allows two or more articles which belong to the same classification and can customarily be sold or used together to be claimed in a single design application. In addition, the associated design category is no longer available; it has been replaced by a derivative design, which extends the protection to cover a design similar to an original design filed by the same applicant.

Unregistered designs

Since designs are protected as patents in Taiwan, if a design creation is not filed or registered as a patent right, the unregistered design creation may be vested in copyright as a type of artistic or graphical work. Other than copyright protection, an unregistered design may be regarded as trade dress. In Taiwan, prior use does not help to obtain the rights in a design, but conversely may destroy the novelty of a design creation.

Registered designs

The creator or designer of a design inherently owns the right to apply for a design patent for his or her creation. More specifically, according to the Patent Act, the owner of the right to apply for a design patent shall be the designer or his or her assignee or successor. However, in situations where a design is created by an employee in the performance of his or her duties, the right to apply for a design shall be vested in the employer, unless there is an agreement to the contrary. If a design is created by an outsourcing designer engaged by a fund provider to conduct research and development, the possession of the right to apply for a design patent shall be governed by the agreement between the parties or, in the absence of such agreement, will be vested in the designer.

In addition to the right to apply for a patent, Taiwan has adopted the first-to-file principle for patent applications. Thus, if two or more design patent applications are filed for the same or similar design(s), only the first-filed application can be granted a design patent, unless the priority date claimed for the later-filed application is earlier than the filing date of the first-filed application.

Provided that a creation made in respect of the shape, pattern or colour of a whole article or part of an article, or combinations thereof, has visual appeal, it can be protected as a design patent. The design patent system allows the following subject matter to be filed in a design application:

- a design applied to a single article;
- a design with several composition elements united as a single article group (eg, a chess set or a dominos set). The entire set of the composition elements is regarded as a single design creation;
- a design-in-part applied to an article, which pertains to a specific part of an article that carries design features;
- computer-generated icons and the GUI

applied to an article, as well as the specific animation sequence of the icon or GUI.

However, these types of design should be designated to an article (eg, the screen plate of a tablet, a smartphone display or a control panel of a washing machine). Otherwise, the icon or the GUI is just a two-dimensional (2D) image and cannot be claimed as a patent;

- a design of a set of articles which belong to the same international classification for industrial designs and are customarily sold or used together (eg, a set of tableware including glasses, pans and dishes under Class 7 ("Household goods, not elsewhere specified")); and
- a derivative design which is provided for the same applicant that owns two or more similar designs to file several derivative designs originated from or similar to the original design, to obtain a more complete scope of patent protection.

On the other hand, according to the Patent Act, non-statutory subject matter for a design patent application includes the shape of an article dictated solely by its function, an artistic work, the layout of an integrated circuit and electronic circuits, and an article that is contrary to public order or morality, even though such a creation may correspond to the definition of a 'design.'

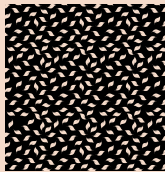
Upon filing a design patent application, the applicant must pay the application fee. Once the design patent has been granted by the Taiwan IP Office (TIPO), the patent issue fee and the first-year patent annuity must be paid in order for the design patent to be issued. In addition, design patents are subject to the payment of follow-up patent annuities as maintenance fees for the whole patent term.

Procedures

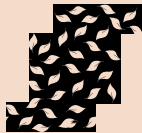
When filing a design patent application, an applicant shall submit the application form, specification and drawings to TIPO. In general, the drawings should include six-directional views (ie, front, rear, left side, right side, top plane and bottom plane views), and a perspective view of the claimed design if the patent application claims a design for a three-dimensional (3D) article, unless certain views are symmetrical or identical to others. If two or more perspective views are to be submitted together, these should

illustrate all six directions of the claimed design.

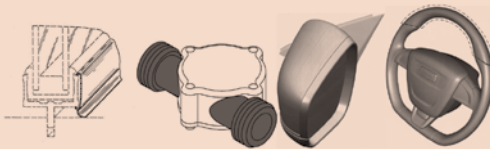
For designs claiming a colour, that colour must be illustrated or identified by the industrial standard colour code. For designs claiming a pattern applied to a 2D article (eg, packaging paper or tissue), a 2D view illustrating the overall design and a unitary drawing showing a repetitive of the claimed pattern must be submitted (as shown below).



TW D151554



For a design-in-part applied to an article, the part to be claimed and that not claimed must be illustrated by distinguishable manners (ie, broken lines versus solid lines, shaded portion versus non-shaded portion, or different greyscales). If none of these can be adopted easily, the part that is claimed or not claimed may be highlighted by broken lines and then identified in the description of the drawings (as shown below).



Referencing

TW D252044

TW D153036

TW D153035

TW D153035

Although the non-claimed parts do not serve to interpret the scope of the claimed design, they serve to illustrate the relative position, size and arrangement of the claimed part with respect to the non-claimed parts.

For icon and GUI designs, since the hardware is generally not claimed, it is usually illustrated by broken lines (as shown below).

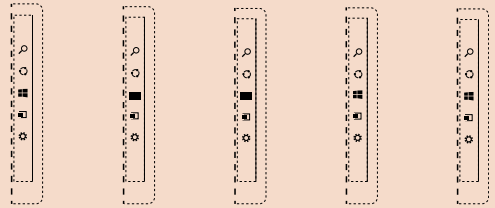


USPN D587720



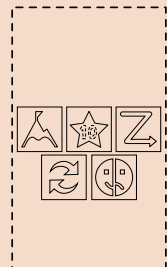
USPN D587075

For GUI designs that consist of a series of images that constitutes an animation, the overall number of images and the sequence of the series of images must be identified and will also serve to interpret the scope of protection. For example, when interpreting the scope of the GUI animation design below, if the removal of an image, addition of other images or alteration of the image sequence will result in a substantially different visual impression, the result of such removal, addition or alteration will constitute a different design.



USPN D679725

For GUI consisting of a set of plural icons, if the relative positions of the plural icons are not claimed, they must be illustrated in a manner that does not require the icons to be in a designated arrangement with respect to each another (ie, separated by broken lines enclosing the individual icons and clearly explained in the description). For example, the two designs below, although consisting of the same set of icon elements, will be interpreted to have different scopes – the relative positions of the plural icons for the design on the left do not constitute the scope of protection, while those for the design on the right do.



USPN D682877

After a design patent application is received by TIPO, it must undergo an examination

process to determine whether a design patent can be granted. In Taiwan, the examination process for a design patent involves both formal and substantive examinations.

Regarding the formality requirements, a design patent application must satisfy the definition of a 'design' and fall under the statutory subject matter, and the disclosed content should be definite. As for the substantive requirements, a search of the prior art is conducted and a decision is issued based on whether the claimed design is patentable in terms of industrial applicability, novelty and creativeness according to the Patent Act. According to current TIPO practice, it takes six to 18 months to obtain a design patent from the date of filing a design patent application.

After a design patent has been issued, any party can file an invalidation request with TIPO if the design patent fails to meet the patentability criteria or the amendment submitted thereto exceeds the scope of the originally filed documents. The invalidation procedure can be initiated regardless of whether a design patent has expired; if an interested party has recoverable legal interests due to the invalidation of a design patent, such party may request invalidation after that design patent has expired.

Enforcement

According to the Patent Act, a design patent gives the owner the exclusive right to prevent others from making, offering for sale, selling, using or importing that product for such purposes.

It is advisable to mark the patent number(s) on the patented products. By doing so, it is clear that a patent right is attached to the products and this may effectively stop competitors or potential infringers from copying the design directly. Patent marking may also serve as direct evidence to prove an infringer's bad faith, as punitive damages are available for wilful infringement under the Patent Act.

Ownership changes and rights transfer

Design patents can be transferred to others by assignment. Other parties may exploit a design patent through a licence granted by the rights holder. Assignment is the permanent transfer or sale of the patent right by written agreement; the assignee may thus become the owner of the patent and enjoy the same rights as the original patentee.

On the other hand, licensing a design patent grants another party the right to exploit the patent. The licensing contract can be exclusive or non-exclusive, depending on the patentee's strategies. A licensing agreement can be limited to a set period or can be terminated for failure to perform the obligations.

The main concern when licensing or assigning a design patent is the royalties received on licensing or the lump-sum consideration for an assignment. Both assignments and licensing agreements must be recorded with TIPO; otherwise, they cannot be enforced against a third party.

Related rights

There are some overlaps in the protective scope of a trademark right and a design patent right. Each provides different protection and brings commercial advantages to the products bearing such rights. While a trademark identifies the source of the goods or services and can last forever, a design patent protects the ornamental features of a whole article or part of an article for a period of 12 years. An expired design may be eligible for 2D or 3D trademark protection in Taiwan if it acquires the distinctiveness to identify the origin of a product.

As discussed above, a patented design right may also be subject to copyright protection or may be deemed to be trade dress, which is protected under the Fair Trade Act.

In the new era of the design patent, the Taiwanese patent system opens the door for several types of design creation that could not previously be patented. Therefore, when a designer is about to conceptualise the creative idea of a design – whether an ornamental design for a whole article, a unique modification of a certain part of an article or a novel and creative icon or GUI – it is wise to file a design application strategically at the right time in order to obtain a patent right in Taiwan, to create a barrier of protection against competitors. [WTR](#)

Contributor profiles

Tsai, Lee & Chen



Tsai, Lee & Chen

11th Floor, 148 Songjiang Road

Taipei 104, Taiwan

Tel +886 2 2564 2565

Fax +886 2 2562 7650

Web www.tsailee.com

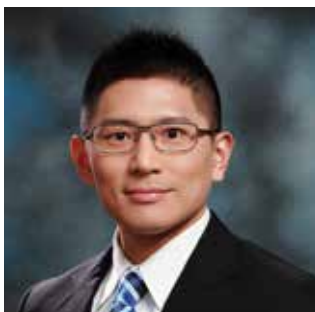


Candy KY Chen

Managing partner

ckchen@tsailee.com.tw

Candy KY Chen is a managing partner and head of the international patent department at Tsai Lee & Chen. She was first admitted as a Taiwan patent agent in 2000 and later registered as a Taiwan patent attorney. Ms Chen is also a registered US patent agent. Ms Chen specialises in technology-related intellectual property, in particular patent prosecution and invalidation for mechanical, automation and software-related inventions, as well as industrial designs. She is particularly proficient in patent prosecution and administrative litigation proceedings. Ms Chen has assisted many Fortune 500 corporations in filing and managing their large patent portfolios, as well as providing opinions on the validity of patent rights.



James HC Su

Patent attorney

info@tsailee.com.tw

James HC Su is a Taiwan patent attorney at Tsai, Lee & Chen. Mr Su has more than 10 years' experience in patent searches, preparation and prosecution of patent applications in the field of mechanical engineering, computer software and hardware, as well as other related areas. He is also proficient in providing opinions on patent invalidation and infringement assessment, and counselling clients on patenting strategy in the related technical fields. Mr Su holds BS and MS degrees in civil engineering from National Taiwan University. Mr Su is currently a member of the Taiwan Patent Attorneys Association.