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## How to submit key design points when filing for a design patent

Pursuant to article 59 of the Patent Law, the brief description of a design has an interpretive function in respect of the scope of protection of the design patent. So in what manner should it be written up in the filing process to be of the most benefit to the rights holder? This column will attempt an analysis of this, and give some recommendations.

### Invalidation procedure

Pursuant to the definition in the Patent Examination Guidelines, the term “key design points” means the shape or pattern of a product or a combination thereof, or the combination of colour and shape and/ or pattern, or a part thereof, that distinguishes the patented design from existing designs. Key design points are the difference between a patented design and existing designs and reflect the innovations of the patented design.

Pursuant to article 23 of the Patent Law, to determine whether a patent may be granted for a design, it has to be examined to see whether it is innovative as compared to existing designs and for the degree of such innovativeness. Accordingly, key design points that highlight the innovation of the patented design theoretically should have an impact on the determination of whether a patent satisfies the conditions for approval. If the key design points are overly minor, the granting of a patent will be negatively affected.

However, the Patent Examination Guidelines at the same time specify that “the design indicated by the key design points in the brief description of a design need not necessarily have a marked effect on the overall visual impact of the design and need not necessarily lead to there being a marked difference between the patent in question and existing designs”.

### Reasons for provision

There are two main reasons why such a provision exists: (1) the key design points recorded in the brief description only reflect the opinion of the applicant, and do not necessarily accord with



objective reality; and (2) being innovative is only the minimum requirement for the granting of a design patent, and if a patent is desired, the innovativeness needs to reach a certain level. In an invalidation procedure, the petitioner will generally submit existing designs that are relatively similar to the patented design. Accordingly, the key design points recorded in the brief description have a very limited reference value in the patent invalidation examination.

### **Infringement actions**

The Interpretations of the Supreme People’s Court of Several Issues Concerning the Application of the Law in the Trial of Patent Infringement Disputes (Draft for Comment) issued in 2009 specify that “if the alleged infringing design does not contain the key design points of the patented design, it shall be found that the alleged infringing design will not cause confusion with the patented design among the relevant public in terms of its overall visual impact. For the purposes of the preceding paragraph, the term ‘key design points’ means the design characteristics of the patented design that, in contrast with existing designs, can produce a marked visual impact on the relevant public. A People’s Court may refer to the brief description of the design in determining the key design points.”

Three levels of meaning are contained in this: (1) the key design points do not refer to all of the differences between the patented design and the existing designs, but rather particularly refer to the differences that have a significant degree of innovation; (2) the key design points recorded in the brief description may serve as a basis for an infringement judgment; and (3) if the alleged infringing design contains key design points, it does not necessarily fall within the patent scope, but if it does not contain the key design points, it definitely does not fall within the patent scope.

### **Final version**

However, the above-mentioned provision was not included in the final version, which only states that “the design features that set the patented design apart from existing designs generally have a greater effect on the overall visual impact of a design as compared to the other design features of the patented design”. The final version to some extent weakens the status and effect of the key design points in infringement actions and does not regard the key design points recorded in the brief description as a basis for judgment. Studying the draft for comment in conjunction with the final version helps in accurately understanding the status and effect of the key design points in infringement actions. Notwithstanding the above, broadly writing up the key design points is



clearly of no help when a determination of infringement is being made.

It is currently usually permitted in the course of a patent filing to make revisions to the key design points recorded in the brief description. Although revision of the application documents, including the brief description, is normally not permitted in the course of an invalidation procedure or infringement action, if there is evidence showing that the key design points recorded in the brief description are not in accord with fact, the re-examination board or court will determine anew the contribution made by the patented design to the existing designs based on the evidence at its disposal. However, neither the re-examination board nor the court will take the initiative in conducting a search. Particularly in an infringement action, if a party has not submitted evidence relating to existing designs, it is entirely possible that the court will refer to the brief description to determine the key design points.

### **Filing recommendations**

Based on this analysis, an applicant should deem the effect of the key design points in invalidation procedures and infringement actions as important. We recommend against applicants writing up the key design points in the brief description in a manner that deviates from fact or reality. The author has noticed the phenomenon that in practice some right holders exploited legal and procedural loopholes to deliberately write up the key design points in a relatively broad and sweeping manner at the filing stage, and then narrowed them down in the course of an infringement action through interpretation or the submission of evidence relating to existing designs, thereby reaping advantages in both the invalidation procedure and the infringement action.

However, the legislative and judicial authorities have set out to take measures against such behaviour, and the occurrence of such phenomenon should become more unlikely in future. We also recommend that applicants fully discover the state of existing designs before filing, and collect and keep relevant evidence for submission later in invalidation procedures or infringement actions that may arise.

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