

The veil of secrecy regarding a protected design scope in the light of prior art

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Abstract:

The scope of industrial design protection is often determined in close relation to legal information on prior industrial designs recorded in the prosecution estoppel history and in other sources. Determining the scope of industrial design protection based on that “prior art” aims to clarify the nature of the protected design and determine whether a contested design falls into that scope or is infringing the protected design right in resolving conflicts of rights as well as adjudicating infringements of rights over the protected design. This article delved into the theoretical basis for the scope of industrial design protection in the light of prior art and practical international lessons in determining the nature of the protected design. Although it is not clearly stipulated in current legal provisions on industrial designs in Vietnam, the accessible design prior art, particularly, the public design prosecution estoppel history, should be considered as one of the indispensable grounds to determine the scope of design protection. The principles for analysing scope of design protection that should be applied in Vietnam in accordance with the common standard practice are proposed in this article as well.

Keywords: design, industrial design, prior art, prosecution estoppel, scope of protection.

Classification numbers: 6, 7

1. The “black box” of the scope of design protection

The current Intellectual Property Law stipulates that an industrial design (or design) patent recognises the subject matter, the scope, and the term of protection of the design (Article 92.1). For that purpose, the scope of design protection is determined based on the scope recorded in the National Register of Industrial Property, the International Register of industrial designs, or in design patents, or in decisions on the acceptance of international industrial design protection (Article 34.1 of the Decree No. 65/2023/ND-CP dated August 23, 2023 by the Government). Furthermore, the basis for determining the infringement of industrial design rights is the scope of industrial design protection recorded in those documents (Article 76.2 of the Decree). The unique information on the scope of design protection

recorded in the above mentioned documents only includes a set of photos or drawings of the protected design, the number of the design’s alternatives, the international classification of the design and some other information (Article 37.2.b) (ii) and (iii) of the Circular No. 23/2023/TT-BKHCN dated November 30, 2023 of the Ministry of Science and Technology). Thus, the current laws and regulations on industrial designs do not explicitly stipulate how to determine the scope of design protection with the existence status of known industrial designs for the same products (hereinafter referred as “prior art”). Therefore, the research issue in this context is whether the scope of design protection should be determined in comparison with other known designs of the same products in the eyes of informed users.

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It would be understood that the scope of industrial design protection determines the nature of that design, i.e. the overall visual impression or appearance of the design characterised by the combination of its essential features (Article 23.4. of the Circular No. 23/2023/TT-BKHCHN). In particular, the features of an industrial design are presented in the form of lines, shapes, colours, position or dimension proportions that, when combined with other features, create the individual character of the design. Among those features, “essential features” contribute to the overall appearance of the design, which are easy for informed users to perceive, necessary and sufficient to determine the design’s nature and differentiate the design with other designs used for the same products or articles. The essential feature must meet the criteria that can be used to examine the novelty, non-obviousness and industrial applicability of a design, and to be easily “looked and felt” by the informed users in terms of significant differences of the relevant designs. In other words, the combination of those essential features of overall appearance of a design identifies the scope of that design protection.

In the practical perspective, regarding the process of industrial design prosecution as well as invalidity proceedings, the prior art even anywhere in the world would be taken into account at the time of filing date of the design application for the purpose of examining essential features of that design as well as its nature in the light of the prior art. Thus, design protection is conferred only for the combination of those essential features of overall appearance of the registered design. However, in Vietnam those who try to precisely determine the scope of an industrial design protection may not rely only on the information recorded on the design patent as provided for in the current design laws and regulations due to the lack of both the design’s published prior art and disclosed prior art accessibility limitation. To contribute to a more relevant interpretation of the scope of design protection, the methodological approach used in this article is synthesis and analysis of secondary data including legal regulations and court precedents.

2. The scope of design protection in the light of prior art

Determining the scope of industrial design protection, which analyses and examines the combination of essential features based on the “prosecution estoppel history” and the prior art of the design, is a complicated issue and has long been discussed in the practical context of dispute resolution and infringement adjudication regarding industrial design rights in the world [1]. The prosecution estoppel history is the proceedings between the applicant and the Intellectual Property Office from application filing to patent issuance, which usually comes into play in the context of claim construction (for example, before a court, or in a post-grant proceeding, or in analysing the patent for freedom to operate reasons), and also of an assessment of infringement under the doctrine of equivalents. In general, the scope of industrial design protection is interpreted quite consistently in the United States, the EU, Japan, China... and is often considered during the process of the design prosecution, or invalidity proceedings and particularly in infringement litigation.

In the practice of industrial design litigation, since the late 19th century, to solve the problem of determining the scope of industrial design protection, the US courts have applied a number of legal doctrines relating the design prior art [2, 3], e.g. the “point of novelty test”, the “non-trivial advanced test”, and the “ordinary observer test”. The courts in Japan also apply this important principle [4]. In the EU perspective, the extent of the prior art is also considered as a key determinant for individual character of a protected design [5, 6]. Recently, the EUIPO’s Guidelines for Examination of design invalidity applications (31 March 2024, para 5.7.2) stated that: “...when the contested RCD (Registered Community Design)

*Quotation from the study of Miku & Chikako (2023): “With regard to the enforcement of designs, the test for infringement is fairly similar to the US test... Further, and similar to US law in some cases, the presence of the novelty of the design as compared with the prior art may be considered”.

shows more features than the earlier design (prior art), all of its features will be taken into account for the assessment of novelty and individual character. This can happen, for instance, where the contested RCD includes colours, visible effects produced by textures or any other aspects of appearance that are not visible in the earlier design" [7]. The interpretation and application of these doctrines themselves are modified over time [8, 9]. In this context, this article would like to take US viewpoints as a typical example to further illustrate the determination of the scope of industrial design protection in the light of prior art. Until recently, the courts have almost not applied the non-trivial advanced test as an independent rule, but rather integrated it into two rules on the point of novelty test and the ordinary observer test. Some courts even combine the point of novelty test and the ordinary observer test as if there is only the ordinary observer test. It seems that the litigation in practice of many countries and regions around the world considers the scope of industrial design protection as same as the invention's nature and hence the design protection titles are also called the "design patents".

The purpose of the point of novelty test and the non-trivial advanced test for industrial designs is to determine the scope of industrial design protection [2, 10]. The design owner has the right and obligation to indicate which features of the design are new and inventive. To do this, it is necessary to present a list of the known designs or the earlier published designs (prior art) that are the basis for the improvement or creation of the new designs, and to clarify the essential features that should enjoy the design right protection [11]. On the contrary, the alleged infringer defends against the infringement allegation by providing the prior art information to prove that the essential features claimed by the design owner are not new and/or inventive and therefore do not fall within the scope of design protection. The court may also issue prior art information on its own. Thus, the scope of industrial design protection depends closely on the

relevant prior art information presented to the court or other competent dispute resolution authorities, especially the information recorded in the prosecution estoppel history [12]. In the context of industrial design dispute resolution and infringement adjudication, the scope of design protection may be narrowed, even considered as "zero" (i.e. the design patent is judged as invalid). This circumstance can be clarified by the *Lawman Armor Corp. v. Winner Int'l, LLC.* case in the US. In this case, the industrial design owner indicated eight essential features of the steering wheel lock that are considered as the points of new in his design patent compared to the only one known design of the prior art. The alleged infringer (defendant) argued that all eight features as indicated were not new by presenting a number of known designs of the various prior art information, in which each prior art document had several features, but not all eight, recorded in the design patent. The court accepted this defendant's argument and revoked the design patent validity in its entire scope of protection, i.e. invalidated the granted design patent [10]. What is noteworthy is that the court accepted the use of each individual design in the prior art to reject each essential feature recorded in the design patent and thus this design patent became cannot be infringed.

The ordinary observer test is also a very important rule to determine whether a particular object falls within the scope of design protection [2, 13]. As early as 1893, in the *Smith v. Whitman Saddle Co.* (148 US 674, 1893) case regarding the industrial design of the saddle, the US Supreme Court clearly expressed its stance on the scope of design protection when it decided that there was no infringement in the alleged product because the protected design has a unique new feature, a drop shape, while the accused product does not have this shape even though the other essential features are the same as the protected design. In this case, the Court stated that "...if, therefore, this drop was material to the design, and rendered it patentable as a complete and integrated whole, there was no

infringement". It means that if the drop shape is the essential feature of the protected design because of its important contribution to the design as a whole, the accused saddle is not infringing only because it does not have this feature. The *Smith v. Whitman Saddle* case became the rule of case law and applied to subsequent industrial design infringement lawsuits. For example, in the case of *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.* (67 F.2d 428, 1933) regarding the design of an ashtray combined with an electric lighter, a district court in the US initially determined that there was infringement because in the eyes of the ordinary observer, there is not a significant difference between the accused product and the protected design. However, the Federal Court overturned the district court's decision on the grounds that "... *ordinary observer was not one who has never seen an ashtray or a cigar lighter, but one who, though not an expert, has reasonable familiarity with such objects and is capable of assessing the similarity of the patented and accused designs in light of similar objects in the prior art*". The latest version of the ordinary observer test established by the US District Court in *Egyptian Goddess, Inc. v. Swisa, Inc.* (543 F.3d 665, Fed. Cir. 2008) case, and is now applied in many countries and regions around the world. In particular, the Federal Court requested to apply the precedent of the *Litton* case [10]. The Court's statement is as follows: "*Litton and predecessor cases on which it relies are more properly read as applying a version of the ordinary test in which the ordinary observer is considered to view the differences between the patented design and the accused product in the context of the prior art. When the differences between the claimed and the accused design are viewed in the light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is so close to the prior art designs, small differences between the accused device and the claimed design are likely to be important to the eye of the hypothetical observer*" (recited by E.E. Vasallo, et al. (2009) [10]).

Thus, the literature review of theoretical and practical studies in international case laws have demonstrated that determining the scope of industrial design protection should be made in view of the relevant design prior art, at least as recorded in the prosecution estoppel history, rather than being taken to consider a particular protected design in isolation [14]. Accordingly, the scope of design protection determination based on the prosecution estoppel history is the important principle known as "three-way visual comparison". This principle firstly determines whether a particular feature of the patented design is considered as essential by comparison with the relevant prior art and secondly, evaluates whether a contested design has that essential feature or not by comparison of the contested design with both the protected design and the prior art. The comparison of two specific designs to determine the protection scope should be taken through the eyes of an "ordinary observer" who is knowledgeable about the product's sector and is aware of known similar designs in the sector, and even being informed about the new features of registered designs [15]. Therefore, to determine the scope of industrial design protection, it is prerequisite to perform a prior art search to identify the essential and non-essential design features. When determining that a feature is "similar", it is necessary to indicate a prior design in the art that contains that feature and not to make an arbitrary judgement. In specific circumstances, a known design with the overall appearance must be included in the prior art; if found, compare that design with the protected one to evaluate which feature is new, thereby determining which new feature is essential, and only then should the contested design be considered; if not found, the general features are essential characteristics without taking details into account. To prevail on a claim for design patent infringement, the patentee must establish that an ordinary observer who is familiar with the prior art designs would be deceived into believing that the accused product is the same as the patented design.

3. Some implications on determination of the scope of design protection in Vietnam

In Vietnam, studies on determining the scope of industrial design protection in view of the relevant prior art have almost not been conducted. Due to the lack of clear and complete concept of the protection scope in legal documents and in the implementation of laws and regulations on industrial designs, there have not been practical mechanisms to interpret or clarify that concept in a consistent manner. In recent years, the design right registration and enforcement practice has shown that there is an inconsistency, even contradiction, in the interpretation of the same concept regarding the scope of design protection by competent authorities and practitioners, thereby leading to situations in which the same legal provisions on the protection scope are applied in the different principles. In the context of unofficial case law application and only a few cases have been considered as “sources for developing case law” in the people’s courts’ database, and any authority adjudicating infringement of industrial design right can interpret that legal concept at its own discretion, so that in case of conflict in interpretation, the existence of a guiding agency to determine which interpretation is reasonable to apply consistently in other similar circumstances is really crucial. While the issue of intellectual property in general as well as industrial design rights is still relatively new to the court system, the contradiction in understanding, interpreting and applying the above legal provisions causes difficulties not only for the judges in adjudicating the case but also for other authorities to make satisfactory and predictable decisions. More seriously, it will disrupt industrial design protection activities and make it impossible to fulfil the goal of the intellectual property law system. For that reason, the unification of permissible standards on the scope of industrial design protection is firstly reasonable expectation and urgent practical requirement in the long term, not just in specific cases.

Secondly, in the invalidity proceedings as well as the process of resolving disputes and/or adjudicating industrial design right infringements, the issue of determining the protection scope plays a decisive role in evaluating acts of infringement. In many cases, when an accused design is only different from the protected design in one or a few features, determining the protection scope and assessing whether or not the accused design is within the protection scope in the light of prior art is a complicated task. In other words, within hypothetical scenarios, the following question should be reasonably answered in detail: if the design B is protected on the ground that B has a new feature “y” compared to the feature “x” of the known design A while B has the all remaining features that are similar to those of A, then should the design C be considered different (and not within the protection scope) compared to B if it has the feature “z” that is different from “y” even though C has the all remaining features the same as B? To answer this practical question, the scope of design protection should be interpreted as the combination of each and every essential features of the protected industrial design. The correct answer is “Yes” because if a product has all essential features of the protected design, regardless of whether there are any other essential features on that product, then the product is considered to fall within the scope of design protection, and the production or sale of such products is considered an infringement of the patented design right. Even if the added features are considered to meet the conditions of novelty and inventiveness and their combination with known essential features is eligible for design protection, the right of the person granted the design patent still depends on the right of the original design owner. In this interpretation, the above mentioned essential feature must be considered as the new and different characteristic compared to the relevant prior art and be used to distinguish this design as an overall visual impression from other known designs. Due to the above mentioned “black box”, the relevant prior art which is any disclosure, written or oral, made available to the public anywhere before the filing date of the design application for registration should be publicly accessed in the most comfortable

manner and considered as an indispensable factor affecting the determination of the protection scope. This is because the prior art provides real-time grounds for determining which design features are essential as well as its combination building the nature of the industrial design.

In conclusion, although it is not clearly stipulated in current legal provisions on industrial designs in Vietnam, the accessible design prior art and in particular, the public design prosecution estoppel history, should be considered as one of the indispensable grounds to determine the scope of design protection. As mentioned above, there are a lot of countries or regions having developed modern intellectual property systems such as the US, the EU or Japan apply this important standard when evaluating the scope of design protection. More specifically, the scope of design protection would rather be determined by the combination of all essential features and the construction of which feature is “essential” should be applied consistently based on publicly known designs in the light of prior art. This principle provides an intuitive and effective tool for evaluating design similarities. It helps avoid the common mistake of comparing only two designs in isolation without reference to prior art. This principle has been applied for many years internationally yet, demonstrates its compatibility with the industrial design protection mechanism and therefore should be applied consistently during the process of the design prosecution, or invalidity proceedings and particularly in infringement litigation in Vietnam for the time being. Nevertheless, based on the US and the EU systems, more studies are needed to determine whether the patented design should be conceptualised as the design as applied to a specific type of product, not as a design *per se*, and therefore, may have implications for the broader policy debate over how designs should be protected by intellectual property laws.

COMPETING INTERESTS

The author declares that there is no conflict of interest regarding the publication of this article.

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