

# COMMON GUIDELINES FOR THE SUBSTANTIVE EXAMINATION OF INDUSTRIAL DESIGNS



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one identity  
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# **COMMON GUIDELINES FOR THE SUBSTANTIVE EXAMINATION OF INDUSTRIAL DESIGNS**

**The ASEAN Secretariat  
Jakarta**

The Association of Southeast Asian Nations (ASEAN) was established on 8 August 1967. The Member States of the Association are Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Myanmar, Philippines, Singapore, Thailand and Viet Nam.

The ASEAN Secretariat is based in Jakarta, Indonesia.

For inquiries, contact:

The ASEAN Secretariat  
Community Relations Division (CRD)  
70A Jalan Sisingamangaraja  
Jakarta 12110  
Indonesia  
Phone : (62 21) 724-3372, 726-2991  
Fax : (62 21) 739-8234, 724-3504  
E-mail : public@asean.org

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**PART**  
**1**

**GROUNDS FOR REFUSAL OR INVALIDATION  
 OF REGISTRATION**



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## PREAMBLE

### ***Background***

These Common Guidelines for the Substantive Examination of Industrial Designs in the ASEAN Member States (hereinafter called “the Common Guidelines”) have been prepared in the context of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III). That project was approved by the European Union and ASEAN in 2009 to support the objectives of the ASEAN Economic Community Blueprint, and the strategic goals as identified in the ASEAN IPR Action Plan 2011-2015.

The overall objective of ECAP III Phase II is to further integrate ASEAN Member States into the global economy and world trading system to promote economic growth and reduce poverty in the region.

The project’s specific objective is to enhance ASEAN regional integration and further upgrade and harmonise the systems for the creation, protection, administration and enforcement of intellectual property rights in the ASEAN region, in line with international intellectual property standards and best practices, and with the ASEAN Intellectual Property Rights Action Plan 2011-2015.

The EU Office for Harmonization in the Internal Market (OHIM) was entrusted with the implementation of Phase II of ECAP III over the period 2013-2015.

On 12 March 2015, in Bandar Seri Begawan, Brunei Darussalam, the ECAP Project Steering Committee (PSC) approved the project Annual Work Plan (AWP) for 2015. The PSC decided to include within that work plan the organisation of a key activity “aimed at enhancing the quality, consistency and transparency of the work undertaken by the ASEAN IP Offices with regard to the examination and registration of industrial designs”. The work plan specifies that this result will be achieved through the elaboration of “guidelines” that may be applied by interested ASEAN IP Offices.

All ASEAN Member States have enacted or are in the process of adopting legislation – either in the form of dedicated laws or as specific chapters or provisions within a broader law – to allow for the registration of industrial designs. In some of those countries, those laws are supplemented by other norms of lower hierarchy, including implementing regulations and subsidiary administrative decisions.

The following ASEAN Member States have also published or adopted for internal use by their Office examiners, manuals, guidelines or specific practice directives for the examination of industrial design applications:

- Indonesia: Guidelines – Substantive Examination of Industrial Design – 2015
- Lao PDR: Industrial Designs Manual – October 2003
- Decision of the Minister of Science and Technology on the implementation of Law on Intellectual Property concerning Industrial Design, No. 755/MOST, 20 September 2012
- Law on Intellectual Property, No 38/NA dated 15 November 2017
- Malaysia: Module for Industrial Design Examination (2014)
- Philippines: Revised Implementing Rules and Regulations adopted since April 20, 2011 in conjunction with the IPOPHL Memorandum Circular No. 17-013 "Amending The Revised Implementing Rules and Regulations on Patents, Utility models, and Industrial Designs", July 10, 2017
- BOP Memorandum Circular No. 14-004 issued by the Director of Patents on "Deferred Publication of Industrial Design Application", May 20, 2014
- BOP Memorandum Order No. 16-005 regarding the "Implementation of the Kind Codes in the Publication of Patents, Utility Models and Industrial Designs based on WIPO Standard St. 16 and the Revisions of WIPO Standard St. 3, June 21, 2016
- BOP Memorandum Circular No. 17-002 regarding "Implementation of the Revised Patent Quality Review System for Utility Models and Industrial Designs", October 20, 2017
- Singapore: Practice Direction No. 4 of 2018 – Registration of Graphical User Interfaces (GUIs), 20 June 2018
- IP2SG Practice Direction No. 1 of 2018 - Electronic Online System (EOS), 30 Oct 2018

Practice Direction No. 1 of 2017 – Classification of Articles, Non-Physical Products or Sets of Articles and Non-Physical Products for the Purposes of Registration of a Design, 30 October 2017

- Thailand: Inspection Manual for the Application for Design Patents
- Viet Nam: Rules of Examination of Industrial Designs Registration Applications, Promulgated by Decision 2381/QD-SHTT of 8 December 2009 of the NOIP’s Director General

These Common Guidelines have been drafted taking into account the laws, regulations and available jurisprudence of the ASEAN Member States, relevant to the examination of industrial design applications. The aforementioned internal guidelines and manuals used by some of the offices to examine design registration applications have been considered.

The Common Guidelines also take into account EU standards and best practices, in particular the Guidelines for Examination in the European Union Intellectual Property Office (EUIPO) on Registered Community Designs – Examination of Applications for Registered Community Designs 2015, and Examination of Design Invalidation Applications 2015 (hereinafter called, respectively, “the EUIPO Guidelines (Applications)” and “the EUIPO Guidelines (Invalidity)”).

The first draft of these Common Guidelines was presented to the intellectual property authorities of the ASEAN Member States at the “ASEAN Design Consultation Meeting and Elaboration of Common Guidelines for Design Examination”, held in Langkawi, Malaysia, on 2-5 June 2015.

This revised draft takes into account the suggestions made at the Langkawi meeting and the inputs and comments sent after that meeting by the authorities of the ASEAN Member States.

## ***Purpose of the Common Guidelines***

The implementation of common guidelines for the examination of industrial designs in the ASEAN Member States is challenged at present by the fact that some major differences subsist in the systems for the examination and registration of industrial designs in those countries. Some of those differences are anchored in national laws and will require legislative action if any changes are to be made. However, greater convergence at the level of administrative standards and internal directives will tend to enhance consistency in the practice of those national offices as regards the registration and maintenance of industrial design rights.

These Common Guidelines are intended to supplement the abovementioned internal guidelines and manuals, and to support a convergence of the design examination standards and criteria applied by the ASEAN designs offices. The Common Guidelines may also serve as a practical training tool for examiners and as a reference document for professional advisors and industrial property agents.

Attention is drawn to the fact that industrial designs may also receive protection in the ASEAN Member States through the law of copyright, to the extent that industrial designs are recognised as “works” or as “works of applied art”. This may result from compliance with international standards under the Berne Convention for the Protection of Literary and Artistic Works of 1886, as revised in 1971, and from provisions in national copyright laws that protect works of applied art. However, these Common Guidelines do not deal with the protection of unregistered designs or works of applied art under the law of copyright, or the validity of such protection.

**These Guidelines are not binding on the participating ASEAN industrial designs offices and do not purport to reflect the current practice in all those offices. While much of the matter covered in the national laws and practice of the ASEAN Member States is consistent in substance with these Common Guidelines, some divergence may remain in respect of certain specific points. Further development and use as reference material of these Common Guidelines is expected to stimulate gradual convergence of the standards and criteria for the examination of industrial designs in the ASEAN Member States. The registration of industrial designs still depends on the national laws and regulations of the ASEAN Member States.**

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## ABBREVIATIONS USED IN THE COMMON GUIDELINES

### ***ASEAN Member States (Country Codes)***

BN: Brunei Darussalam

ID: Indonesia

KH: Cambodia

LA: Lao PDR

MY: Malaysia

MM: Myanmar

PH: Philippines

SG: Singapore

TH: Thailand

VN: Viet Nam

### ***Other abbreviations***

CDR: Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs (Community Design Regulation)

CDIR: Commission Regulation (EC) No. 2245/2002 of 21 October 2002, implementing Council Regulation (EC) No. 6/2002 on Community Designs (Community Design Implementing Regulation)

DA: Designs Act/Registered Designs Act / Designs Order

DL: Designs Law/Registered Designs Law

DR: Designs Regulation(s)/Designs Rules

ECJ: Court of Justice of the European Union (European Court of Justice)

EU: European Union

**HAGUE AGREEMENT:** The Hague Agreement Concerning the International Registration of Industrial Designs, Geneva Act of July 2, 1999

**IPL:** Intellectual Property Law

**LCL:** The International Classification of Industrial Designs, under the Locarno Agreement Establishing an International Classification for Industrial Designs, Locarno, October 8, 1968, as amended on September 28, 1979

**OHIM:** Office for the Harmonization of the Internal Market (European Community Office for industrial designs and marks)

**PARIS CONVENTION:** Paris Convention for the Protection of Industrial Property, concluded in 1883, last revised in Stockholm, 1967

**Office:** The national Office or national administrative authority responsible for registering industrial designs

**TRIPS:** Agreement on Trade-Related Aspects of Intellectual Property Rights

**WIPO:** World Intellectual Property Organisation

**WTO:** World Trade Organisation

## ***References***

All website references are current as of 30 September 2015.



## **GROUND FOR REFUSAL OR INVALIDATION OF REGISTRATION**

### ***INTRODUCTION***

Under the laws and regulations of the ASEAN Member States relating to industrial designs the registration of an industrial design and the validity of such registration require compliance with a number of conditions. Several such conditions relate to the industrial design itself as an object of protection and to supporting documents that have a direct relation to the scope of protection of the industrial design. These requirements are broadly referred to in these Common Guidelines as “substantive” conditions for registration.

At present the substantive conditions and the related formal requirements to register an industrial design in the ASEAN Member States are not harmonized. These Common Guidelines propose a number of criteria and standards for the examination of industrial design applications, and for the revocation of industrial design registrations.

These Common Guidelines deal, in particular, with the following selected topics relating to industrial designs:

- Definition of industrial designs
- Novelty
- Visibility
- Technical or functional features
- Conflict with prior rights
- Public policy, public order and morality
- Specific statutory prohibitions
- Representation of the design
- Product indication
- Multiple application and unity of design

While the above subjects are not all covered in the laws of the ASEAN Member States, all of those laws have some provisions on most of these topics. It is also noteworthy that these topics and the corresponding grounds for refusal or revocation of registration are not examined at the same procedural stage or by the same type of authority in the ASEAN Member States. Some of those issues may be examined *ex officio* by the industrial property authority while others will be checked only following a third-party opposition filed against the registration.

In several ASEAN Member States, some of the conditions for the validity of an industrial design registration will only be examined in the context of revocation, cancellation or invalidation proceedings. Such proceedings may be heard by an authority within the national IP administration or by a judicial authority.

It can be argued that some of the matters covered by these Guidelines are not issues of substance but of form. However, those topics have been included to the extent that they are substance-related and have a direct bearing on matters such as the definition of an industrial design as an object of protection, the scope of protection, the registrability of an industrial design or the subsequent validity of a design registration.

Issues of entitlement and ownership of an industrial design or of rights in a registered industrial design may, under the applicable national laws, determine the registrability of an industrial design in the name of a particular person, and may be invoked as grounds for invalidation of a registration erroneously granted to a particular person. However, the questions relating to the entitlement and ownership of an industrial design will generally be decided by judicial authorities and will not come under the purview of administrative industrial design authorities. These matters are therefore not covered in these Common Guidelines.

**ANNEX I** of these Guidelines contains excerpts of the provisions of the laws and regulations of the ASEAN Member States that are relevant to the topics discussed herein.

**ANNEX II** of these Guidelines contains the internet links to the websites of the ASEAN Member States' industrial design authorities. These websites provide further information regarding the legislation and registration procedures for industrial designs.

# 1 Definition of 'industrial design'

## 1.1 Definition under national law

The term "industrial design" is defined in each of the industrial designs laws of the ASEAN Member States.<sup>1</sup> The definitions of 'industrial design' found in the ASEAN laws are summarized below:

*Brunei Darussalam:* "Industrial design" means features of shape, configuration, pattern or ornament applied to an article<sup>2</sup> by any industrial process, being features which in the finished article appeal to and are judged by the eye [...].

*Cambodia:* [...] any composition of lines or colours or any three-dimensional form, or any material, whether or not associated with lines or colours, is deemed to be an industrial design, provided that such composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, and appeals to and is judged by the eye.

*Indonesia:* Industrial design shall mean a creation on the shape, configuration, or the composition of lines or colours, or lines and colours, or the combination thereof in a three or two dimensional form which gives aesthetic impression and can be realized in a three or two dimensional pattern and used to produce a product, goods or an industrial commodity and a handicraft.

*Lao PDR:* 'Industrial design' means the form or shape of the product, which is to be created which includes the shape, pattern, line, colour, etc.

*Malaysia:* "Industrial design" means features of shape, configuration, pattern or ornament applied to an article<sup>3</sup> by any industrial process or means, being features which in the finished article appeal to and are judged by the eye [...].

---

<sup>1</sup> See the provisions in BN DA, s. 2; KH DL, art. 89; ID DL art. 1.1; LA IP Law art. 3.8; MY DA, s. 3; MM DL, s. 2(a); PH IP Code, s. 112; SG DA s. 2.1; TH DA s. 3; and VN IPL art. 4.13. Also the EUIPO Guidelines (Applications), paragraph 4.1.

<sup>2</sup> "Article" is defined as any article of manufacture and includes any part of an article if that part is made and sold separately.

<sup>3</sup> "Article" is defined as any article of manufacture and includes any part of an article if that part is made and sold separately.

*Myanmar:* Industrial design means the appearance of the whole or a part of any industrial or handicraft product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the said product itself and/or its ornamentation.

*Philippines:* An industrial design is any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours; provided, that such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft.

*Singapore:* “Design” means features of shape, configuration, colours, pattern or ornament applied to any article<sup>4</sup> or non-physical product that give that article or non-physical product its appearance [...].

*Thailand:* “Design” means any form or composition of lines or colours that gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.

*Viet Nam:* An industrial design means a specific appearance of a product embodied by three-dimensional configurations, lines, colours, or a combination of these elements.

For the purposes of these Guidelines, an ‘industrial design’ can therefore be defined as the *appearance* of a two-dimensional or three-dimensional *product*, or of a part of a product, that results from *features* of shape, contours, lines, colour, materials or other elements that form the design.<sup>5</sup>

Registration of an industrial design is not allowed if the subject matter of the application for registration is not an industrial design as defined in the national law. If the application relates to matter that does not comply with the legal definition of ‘industrial design’, or if it is established that the object of the application is not a design, the examiner shall propose the refusal of the registration. In this case, it will not be necessary to examine the application for other grounds of refusal.

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<sup>4</sup> "Article" is defined as any thing that is manufactured (whether by an industrial process, by hand or otherwise), and includes any part of an article if that part is made and sold separately, and any set of articles.

“Non-physical product” means anything that (i) does not have a physical form; (ii) is produced by the projection of a design on a surface or into a medium (including air); and (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information; and includes any set of non-physical products.

<sup>5</sup> In these Guidelines the expressions “industrial design” and “design” are used interchangeably.

If the subject matter of an application was registered as an industrial design in contravention of the requirement to comply with the statutory definition, the registration may be revoked, cancelled or invalidated.

## **1.2 Elements of the definition**

The legal definitions of ‘industrial design’ mentioned above prescribe or imply the following common elements that the subject matter of an application must comply with in order that it may be admitted as an industrial design:

- (i) it must comprise features of *appearance* or features that ‘appeal to the eye’, that result from one or several factors including shape, lines, colours or combinations thereof;
- (ii) it should be capable of *embodiment in a product* or article;
- (iii) such product or article should be *made in industry* or handicraft.

### **1.2.1 Features of appearance**

An industrial design relates to the appearance or visible aspect of a product, or an article, that appeals to, and may be “judged by, the eye”.

If an application refers to matter that cannot be characterized as the appearance or visible aspect of a product, that matter should not be admitted as an industrial design and the design examining authority should raise an objection to the application.

The following subjects warrant particular consideration to determine whether they can qualify as matter capable of giving an appearance to a particular product for design registration purposes:

#### **1.2.1.1 Words, letters and other characters**

Words, letters and digits presented as abstract concepts, independently from an embodiment in a product, will not constitute the appearance of a product.

This does not preclude the possibility that products may be shaped as letters or digits, or that the surface appearance of a product may consist of patterns of two-dimensional representations of words, numbers or other characters. Moreover, the visible appearance of products may consist of

letters, digits or symbols, and they would be regarded as the appearance of those products for purposes of registration.

For example, the following surface pattern contains letters and words:<sup>6</sup>

such as



### 1.2.1.2 Colours

A colour presented or claimed as an *abstract* notion, independently from an embodiment in any shape or contour, cannot be accepted as the appearance of a product.

However, industrial designs can and often do contain features of colour that, in combination with other features, compose the appearance of a product. A design may be registered with one or several colours that will be regarded as one of the claimed features.<sup>7</sup> This applies to both three-dimensional designs and two-dimensional designs such as surface ornamentation, logos, graphic symbols and similar devices that can be regarded as products.

For example, the following three-dimensional designs of wristwatches comprise both shape and colour:<sup>8</sup>

<sup>6</sup> Image taken from: <http://janefarnhamdesigns.com/portfolio/love-letters/>

<sup>7</sup> Under the laws of some ASEAN Member States colour cannot be claimed as a feature of industrial designs.

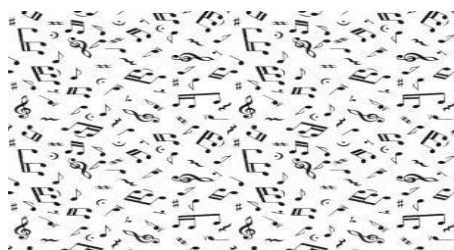
<sup>8</sup> Image taken from [http://articulo.mercadolibre.com.co/MCO-414986807-reloj-swach-coleccion-new-gent-hombre-o-mujer-originales-\\_JM](http://articulo.mercadolibre.com.co/MCO-414986807-reloj-swach-coleccion-new-gent-hombre-o-mujer-originales-_JM)



### 1.2.1.3 *Music and sounds*

Music and sounds are not perceptible by the sense of sight and cannot provide a visible appearance to a physical product. This does not exclude the possibility of giving products the shape of musical notes, or claiming a design for surface decoration of products with, for example, the appearance of written musical notation.

For instance, the following surface pattern design contains musical notes:<sup>9</sup>



### 1.2.1.4 *Photographs*

A photograph may provide a product with a surface appearance that can be regarded as a design for that product. Moreover, a photograph itself may be considered as the appearance of products such postcards, papers, printed matter and similar articles (see Locarno Classification class 19).

### 1.2.1.5 *Architectural plans, blueprints, construction plans*

Architectural plans, blueprints and construction plans for buildings, machines or other devices may be regarded as the appearance of a specific

<sup>9</sup> Image taken from: <http://nevarsoahc.deviantart.com/art/music-pattern-149006824>

products indicated in the application as “printed matter” (see Locarno Classification class 19.08).

Architectural plans, blueprints and construction plans for buildings, machines or other devices cannot be admitted as industrial designs of buildings, machines or other devices because the two-dimensional plans or prints do not render the appearance of the corresponding finished product.

Architectural plans, blueprints and plans of machines, devices and other artefacts may also be protectable under copyright law if they meet the legal requirements for such protection, in particular the condition of originality.

#### *1.2.1.6 Graphs, charts, maps and teaching materials*

Printed teaching materials such as graphs, charts, tables and maps are products and their appearance can be regarded as those products’ industrial design. They can be admitted for registration purposes where the product indication is “teaching materials” (see Locarno Classification LCL, class 19-07).

This is without prejudice that such designs may also be applied to other products as surface patterns or other two-dimensional designs in the form of ornamentation, for example for products such as table linen, beach towels, wall paper, etc.

Maps and graphs and charts may also be protectable under copyright law if they meet the legal requirements for such protection, in particular the condition of originality.

#### *1.2.1.7 Computer screen displays, screen icons*

The design of the displays of screens of computers, portable devices and similar products, and designs of graphical user interfaces (GUIs) could be registered as industrial designs.<sup>10</sup> Likewise, icons, sets of icons and other visually perceptible features of computer programs can be indicated as products that embody designs. (See Locarno Classification LCL, class 14-04).

The following image illustrates the design of a set of icons for a hand-held phone display:<sup>11</sup>

<sup>10</sup> See, for instance Singapore’s Practice Direction No. 4 of 2018 – Registration of Graphical User Interfaces (GUIs).

<sup>11</sup> Image taken from: <http://store.apple.com/us/buy-iphone/iphone6>





Screen displays and icons may also be protectable under copyright law if they meet the legal requirements for such protection, in particular the condition of originality.<sup>12</sup>

## **1.2.2 Embodiment in a product**

An industrial design must be embodied in an industrial product or handicraft article. The essential purpose of an industrial design is to give a unique appearance to a utilitarian or functional object. Matter that cannot be embodied or fixed in an object capable of being produced or manufactured in industry or handicraft, cannot be registered as an industrial design.

The following subjects may warrant particular consideration to determine whether they can qualify as embodiments of products and useful articles of commerce:

### *1.2.2.1 Concepts, principles*

An industrial design may not consist of abstract concepts, mathematical formulae or ideas that cannot *perceptibly* be embodied in a product. Likewise, sets of instructions or games are intangible concepts or ideas that cannot be embodied in a specific article or product. However, the utensils and physical accessories used to play a game or apply the instructions are products that may embody industrial designs.

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<sup>12</sup> Screen displays and icons might not be accepted as industrial designs in certain countries, for example Viet Nam. In Viet Nam an industrial design must be the appearance of a product that can be circulated in the market independently. In this case, the icons themselves cannot be sold independently without the cell phones.

### 1.2.2.2 *Methods, processes*

Methods of construction<sup>13</sup> and processes to obtain products, economic or technical results are essentially ideas and instructions addressed to human beings. They cannot as such give a visible appearance to a product and may therefore not constitute industrial designs.

### 1.2.2.3 *Computer programs and layout-designs*

*Computer programs* are creations that cannot, as such, be visibly embodied in a physical article. This is the case despite the fact that they can be operated on physical devices (computers, telephones, etc.) and can be recorded in physical supports (memory chips, CD disks, etc.). As they cannot be visibly embodied as such in an industrial product they cannot constitute an industrial design.

Computer programs and software may be assimilated to literary works and protected under copyright law.

*Layout designs* of integrated circuits are a *sui generis* intellectual property object of protection. Layout designs may be embodied in physical products, namely integrated circuits or electronic 'chips'. However, a layout design cannot be perceived by the naked eye during normal use of an electronic circuit and therefore would not meet the visibility requirement.

Layout designs of integrated circuits are normally protected under special legal statutes and not under industrial design law.<sup>14</sup>

### 1.2.2.4 *Powders and fluids*

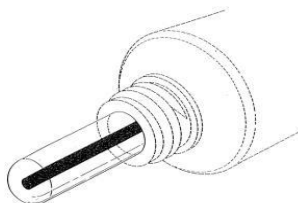
Products that consist of substances in the form of powder or fluid do not have a defined shape or precise contours. The appearance of those products in their usual state for use by final consumers cannot be predetermined. Therefore, their shape cannot be represented in a precise manner. That type of products cannot embody an industrial design.

In some cases, this may also apply to products in the form of paste or pellets if its shape is undefined or unstable. For example, in Viet Nam the following design was found to be inadmissible:<sup>15</sup>

<sup>13</sup> See the definition of 'industrial design' in BN DA s. 2; MY DA s. 3(1); SG DA s. 2(1).

<sup>14</sup> See the Treaty on Intellectual Property in respect of Integrated Circuits, 1989 (IPIC Treaty), and TRIPS Articles 35 to 38.

<sup>15</sup> Example provided by the industrial property authorities of Viet Nam.



Application N°: 3-2005-00960 Title: Toothpaste – LCL: 28-03

The filing design was rejected due to the lack of industrial applicability. The toothpaste in reality does not have a stable shape. Its shape depends on the pressure put by the user on the tube and depends on the position and the angle of the tube compared to the toothbrush. The shape of the toothpaste may not be cylindrical but subject to distortion. Accordingly, the design cannot be applied in mass production of an article embodying it.

Example of the appearance of a product in form of pellets or grains:<sup>16</sup>



#### 1.2.2.5 Parts of products

A design may apply to only a part of a product, as opposed to the whole product. The part that embodies the design may be an integral, inseparable part of a larger article, or a separable piece that may be replaced as a spare part or an accessory of a complex product.

The law may confine the protection for designs of a part of an article to cases where the part may be made and sold *separately*. In these cases, a design would not be recognized if it was embodied in a part or a feature that is inseparable from, or integral with, a larger product.<sup>17</sup>

<sup>16</sup> Example provided by the industrial property authorities of Malaysia. Image taken from <https://www.flickr.com/photos/foto-nn/3695413282>

<sup>17</sup> For instance, see BN DA s. 2(1) “article”; MY DA s. 3(1) “article”; SG DA s. 2(1) “article” (a). This is also the practice in the designs offices of Thailand and Viet Nam, which do not register industrial designs for parts or features that are integral with a product. Industrial design registration is, however, available for spare parts that are *separable*.

As regards the scope of legal protection for parts or features that are *integral* with and *inseparable* from a larger product or article, it is noted that claiming only a specific part or feature of the overall appearance of a larger product would not prejudice the scope of protection of the design for the claimed part or feature. National law may restrict the protection for a part or feature by making such protection dependent on the *overall* appearance of the larger product.

The examining authority (administrative or judicial) may apply a standard of ‘*overall impression* on an informed user’ to decide a case of conflict involving features or parts that are inseparable from a larger product, rather than focus on the claimed part or feature. In this regard, if the products in conflict do not produce the same overall impression on the average informed consumer, the authority may find non-anticipation or non-infringement, notwithstanding the fact that a similar part or feature is included in both products.

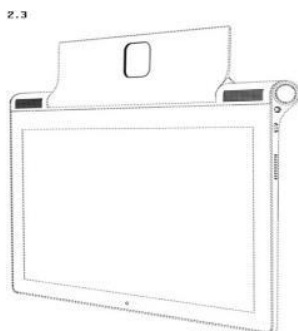
The ‘*overall impression*’ approach would confine within reasonable limits the scope of protection of an industrial design relating to an integral inseparable part of a larger product. This would also recognize that, in the marketplace, products and articles are commercialized as finished, integrated products, not as loose parts or features that cannot be commercialized or sold detached from those products. The examining authority may find that the overall appearance of the products and the overall impression they make on the relevant consumers should be dispositive, rather than the similarity of a single part or feature taken in isolation.

The representation of the design in the application for registration and any description or clarifying notes should make clear what part or feature of the product is being claimed as the design and what is the product to which that part belongs. Regarding the representation of parts of products, see item 8.6, below.

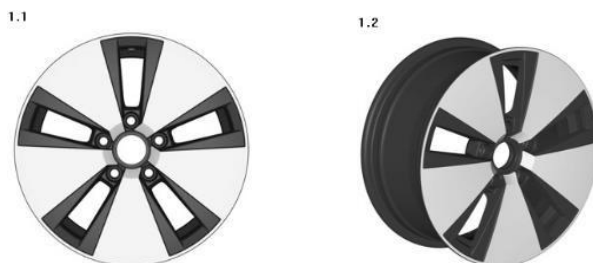
The following is an example of a design for a *part* of a product (‘Tablet computers’) that is integral and inseparable. The part that is claimed appears in *solid* lines and the part that is not claimed is depicted by *dotted* lines:<sup>18</sup>

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<sup>18</sup> Example taken from International Design Registration DM/085175.



The following is an example of a design embodied in a *spare part* ('Wheel rim') for an automobile wheel to be assembled into a larger product with which it normally functions (wheel and car), where such part is not integral with the larger product and may be regarded as a separable product:<sup>19</sup>



## **1.2.3 Products of industry or handicraft**

### *1.2.3.1 Industrial application*

The law may establish as an express requirement for registrability of an industrial design that it comply with the condition of being capable of industrial application.<sup>20</sup> This condition is complied with to the extent that the product or article that embodies the design may be manufactured industrially or produced by handicraft.<sup>21</sup>

<sup>19</sup> Example taken from International Design Registration DM/084901.

<sup>20</sup> For example, BN, DA s. 13.3, r. 5; PH IPC s. 112, r. 1500; SG DA s. 9.3, r. 12; TH DA s. 56; and VN IPL art. 63.3

<sup>21</sup> Several definitions of 'industrial design' contain references to 'products' of 'industry' or 'handicraft'. See items 1.1 and 1.2, above.

Industrial designs are embodied in functional, utilitarian articles. They provide aesthetic value to those products in order to make them more attractive to the potential buyer. The design must be able to serve as a model or pattern for the manufacture of an industrial or handcraft product.

To be registered as a design, the product that embodies the design should be capable of being reproduced in substantial quantities in such a way that each of the individual items produced has an appearance identical to the original model. Products, articles and objects that do not comply with this *repeatability* requirement because they cannot be produced in identical copies, or cannot be manufactured industrially or in the context of handcraft activity, may not be products for design registration purposes.

For example, the following design in Viet Nam was found not to comply with the repeatability requirement:<sup>22</sup>



Application Number: 3-2012-01727 Filing Date: 27/11/2012

Title: Stone panel – LCL: 25-01

The filed design was rejected due to the lack of industrial applicability. The design is created by joining pieces of natural stone in random shapes, sizes, patterns and colours. These pieces of stone are arranged randomly so that they make a roughly square panel. Hence, there are not two panels with the same shape and pattern, and therefore, the same aesthetic impression. Accordingly, the design cannot be applied in mass production of an article embodying it.

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<sup>22</sup> Example provided by the industrial property authorities of Viet Nam.

### 1.2.3.2 *Living and natural products*

Living products and organisms are not regarded as industrial or handcraft products and their shapes cannot be registered as industrial designs for those products. Two issues arise simultaneously: appearance consistency and manner of production.

Natural and agricultural products produced by man as well as natural products found in nature do not have shapes that may be expected to be consistently identical for each individual product. Their appearance could not remain true to a predetermined design.

The second issue is that the manner of production of natural products is not industrial or handcraft. Although certain natural and agricultural products may be mass-produced by processes akin to industrial operations, their production is not regarded as 'industrial' for this purpose. Consequently, natural fruits, flowers or animals cannot be regarded as products of industry to be indicated as products that embody an industrial design.<sup>23</sup>



However, the appearance and shapes of fruits, flowers, animals and other creatures of nature may validly *inspire* designs for other products, including artificial fruits, items of decoration and surface patterns for textile products, printed products and other two or three-dimensional objects.

For example, the following registrable industrial designs embody fruit and animal-shaped objects:<sup>24</sup>

<sup>23</sup> Images taken, respectively, from <http://en.wikipedia.org/wiki/Apple> and <http://pixgood.com/wheat-germ.html>. See also the EUIPO Guidelines (Invalidity), paragraph 5.1.1.

<sup>24</sup> Images taken, respectively, from: [http://www.garrettspecialties.com/trade-show-items-useful-giveaways-c-71\\_160.html](http://www.garrettspecialties.com/trade-show-items-useful-giveaways-c-71_160.html) and <http://www.amazon.ca/Piggy-Shape-Money-box-Storage-Decorated/dp/B008297LQM>



### 1.2.3.3 Works of art

Products that are produced as singular creations or that are cast on substrates such as a canvas, marble, clay or metal, and conceived as individual works of art, will not be regarded as industrial designs. For this purpose, it is irrelevant that the work may be reproduced in multiple copies by lithography, printing or reduced models.

The following examples illustrate works that are works of art and not utilitarian products that embody an industrial design:<sup>25</sup>



However, a work of art can be, and often is, the basis for an industrial design. For example, utilitarian products such as textile goods, paperweights or souvenirs may have as their design a work of art that is printed on the product, or a design that is shaped, moulded or patterned on a work of art.

<sup>25</sup> Images taken, respectively, from [http://www.diytrade.com/china/pd/3832187/stainless\\_steel\\_shinning\\_sculpture\\_wit\\_h\\_artistic\\_design.html](http://www.diytrade.com/china/pd/3832187/stainless_steel_shinning_sculpture_wit_h_artistic_design.html) and <http://www.figurativeartist.org/andrew-benyei-figurative-sculpture/>



The essence of any industrial design is the embellishment of utilitarian objects and products of industry. A designer's contribution will make the appearance of a useful object aesthetically pleasing and should be regarded as an artistic input. Because of their artistic nature, industrial designs are also recognized as works of applied art and are protected under copyright law.<sup>26</sup>

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<sup>26</sup> For example, see the provisions on 'works of applied art' in the copyright laws of BN, s. 2 and 6; KH art. 7(h); ID art. 12(1)(f); LA art. 92.1.1.9; MY, s. 3, 7(1)(c), 7(5); PH, s. 171.10; SG DA s. 2(1); TH s. 4; VN IPL art. 14.g.

## 2 Novelty

An industrial design cannot be validly registered if it is not new. Absolute worldwide novelty is required in order that a design may be registered or maintained on the register.<sup>27</sup>

Depending on the applicable legal provisions, novelty may be examined by an industrial property authority prior to registration, either *ex officio* or following an opposition filed on grounds of lack of novelty. Novelty may also be examined in revocation, cancellation or invalidation proceedings before an industrial property authority or before a judicial authority (court of law). Regardless of the procedural stage for the examination of novelty, the substantive conditions of the novelty requirement remain essentially the same.<sup>28</sup>

### 2.1 Definition of novelty

Novelty of a design is determined by reference to everything that has been made *available to the public* before a relevant date with respect to that design.

To this effect, the novelty requirement will be met if the design is *not identical* or substantially identical with any earlier design disclosed to the relevant public before the applicable date.

#### 2.1.1 Public of reference

The public of reference to decide whether an industrial design has been made available is not only the general public or the average consumers but, more importantly, the *sector of informed consumers* that usually purchase or use the products that embody the industrial design. That sector of informed consumers will usually be more aware of the existence of a design in connection with specific products than members of the general public who do not normally have contact with all products.

<sup>27</sup> See the provisions in BN DA, s. 9; KH DL, art. 91; ID DL art. 2; LA IPL art. 15.1; MY DA, s. 12 (1), (2)(a); PH IP Code, s. 23, 24, 113.1, IP Rules r. 1502; SG DA s. 5; TH DA s. 56, 57; VN IPL art. 63.1, 65.1. Also the EUIPO Guidelines (Invalidity), section 5.5.

<sup>28</sup> The laws of some ASEAN Member States mention certain conditions that a design must meet for purposes of registration, in addition or alternatively to the novelty requirement. Such conditions, which include the “originality” or “creativity” of the design, are not discussed in these Common Guidelines.

The public of reference should also include the trade, industry and *business circles* that ordinarily deal with the production, importation, distribution or marketing of the products that embody the design. Those circles have closer contact with, and easier access to, the sources of information where designs are disclosed. In particular, they are aware of supply sources, catalogues and databases for the different types of products, and have privileged access to suppliers, contacts, trade fairs and other sources that allow them to receive the latest information in the relevant fields.

It is not necessary that the general public be able to access the sources of disclosure of designs to destroy their novelty. The required novelty will not be complied with if the informed consumers or business circles have had, or could have had, access to those sources of disclosure before the relevant date.

A design should not be regarded as disclosed to the public if it has been disclosed to persons that are bound by a confidentiality agreement or by any sort of contractual relationship that would require those persons not to disclose or communicate the design. Likewise, disclosure of a design within a confined circle of persons in such a manner that the information could not normally or reasonably be accessible to the public or to the specialized trade circles, should not be considered as a disclosure that is relevant for novelty purposes.

### **2.1.2 Relevant date for novelty purposes**

The *relevant date* to determine novelty will generally be the date of filing of a *regular* application to register the industrial design with an industrial property Office. A regular application is one that complies with the requirements prescribed to obtain a *filing date*.

#### **2.1.2.1 Priority**

If the applicant invokes a *right of priority* under the Paris Convention, the relevant date will be the date of the earliest priority filing invoked. The period of priority for industrial designs is six months. This means that, for the benefit of priority to operate, the application must be filed with the Office not later than six months after the filing date of the priority application. If the applicant claims the priority of two or more earlier applications, the date of the earliest of those applications must be taken.

Under the principles of the right of priority established by the Paris Convention, a regular filing in a country bound by that Convention should be regarded as the relevant date in order to decide on novelty in case of

intervening applications, disclosures or other actions in respect of an industrial design. The Paris Convention provides the following in Article 4.B:

“B. Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession.”

A right of priority can only be validly invoked in respect of industrial designs that are *identical* in both the priority application(s) and the application filed with the Office. If the designs contained in the application under consideration present perceptible variations or differences, the right of priority will not operate.

Where the designs contained in an application come from several earlier priority filings, the applicant may invoke *multiple* priorities as well as *partial* priorities, as allowed under the Paris Convention.<sup>29</sup>

### 2.1.2.2 Grace period

In cases where the applicable law provides for a *grace period* or a *period of immunity* in favour of a designer, or his successor in right, that discloses a design before filing an application for its registration, such disclosure may be relevant to determine whether the novelty requirement is complied with.<sup>30</sup>

The absolute novelty requirement is quite strict. Therefore, any disclosure of a design before the relevant filing or, where applicable, priority date can destroy the required novelty. Disclosures that can affect a design's novelty will include disclosures resulting from acts of the designer himself or his successor in title, or from acts performed by persons who obtained the design directly or indirectly from the designer, legally or by illegal means.

Laws providing for a grace period in favour of designers aim at preventing loss of rights in case of early or involuntary disclosure of a design. This also

<sup>29</sup> See the Paris Convention, Article 4.F.

<sup>30</sup> See the provisions in BN DA s. 12, 13; KH art. 92; ID DL art. 3; LA IPL art. 30; MY DA, s. 12 (3); PH IP Code, s. 25, IP Rules r. 1503, 1601; SG DA s. 8, 9, 10; TH DA s. 6, 19, 57; and VN IPL art. 65.4. Also the EUIPO Guidelines (Invalidity), paragraph 5.5.1.9.

takes into account that often such disclosure is required in order to test a product's design in the marketplace, to prepare a licensing or distribution agreement or to introduce a design at an official exhibition.

A grace period is provided in the law as a period of time after a design is disclosed during which the designer (or his successor in title) can file an application to register that design, without such disclosure being detrimental to the required novelty. To this effect, a disclosure of the design under the prescribed circumstances would not be taken into account for purposes of establishing the novelty of the design.

The grace period is usually a period of *twelve months* that precedes the date of filing of the application with the Office. Where a priority application is claimed, the grace period will precede the filing date of the priority application. However, the law may establish a grace period of only *six months* (instead of twelve months), or may limit the benefit of the grace period to particular cases of disclosure, for example, where disclosure took place at an official or officially recognized exhibition, or resulted from an illegal act or abuse committed against the designer or his successor in title.

The examiner must take the grace period into account if it is invoked by an applicant or by the holder of an industrial design registration to prevent a refusal of registration or the revocation of the registration for reason of a disclosure occurred during the grace period. The applicant or holder will bear the burden of proving the facts that are relevant for the grace period to operate.

### **2.1.3 Possible sources of disclosure**

Disclosure of a design in a way that makes the design accessible to the public will require that the design may be seen or retrieved from certain public sources. The main *sources of disclosure* through which a design can be made available to the public are discussed below.

#### ***2.1.3.1 Commercial distribution and use in trade***

Disclosure of an industrial design may result from the introduction into the marketplace of products or articles that embody the design. If the articles that embody the design are put on the market, the design becomes immediately accessible to the public at large as the consumers may directly see and purchase the products. The same applies to cases where the products are distributed to the public free of charge as samples, as market test runs or for advertising purposes.

### 2.1.3.2 *General publications*

The graphic or photographic representation of a product that embodies a design, in public periodicals, newspapers, magazines or other publications would disclose and divulge the design to the extent that the design can be clearly distinguished in those representations. Such publications must be taken into account when analysing whether the design is to be regarded as novel under the law.

The same applies to *specialized publications* such as professional periodicals and thematic magazines dealing with, for instance, fashion, wearing apparel, interior decoration, architecture, hobbies, automobiles or technical matters.

Industrial and commercial *catalogues* distributed by producers and distributors of products that embody the design are also valid references to establish prior art and disclosure of the design. This applies to both catalogues distributed within the relevant trade circles and catalogues distributed to the public at large, whether in printed form or on the internet (see below).

### 2.1.3.3 *Official publications*

Publications issued by the national industrial property authorities (IP Offices) of any country, such as official gazettes and bulletins, are also relevant sources of disclosure. Unless the law provides otherwise, the reproduction of an industrial design in an official publication is to be regarded as a disclosure of the design to the public. In fact, that is the intended primary effect of announcements made in such official publications.

The disclosure effect occurs regardless of the specific subject of the official gazette or bulletin. Not only bulletins or gazettes dedicated to industrial designs will be relevant, but also bulletins that announce trademarks, patents and other IP rights.

An official announcement in a periodical that does not include a reproduction of the design but lays open the file of the design application where the reproduction of the design is available upon request by any member of the public, should also be regarded as full disclosure.

#### 2.1.3.4 *Disclosure on the internet*

Internet sites and databases should be regarded as publicly available sources of information.

Disclosure on the internet of a product that embodies an industrial design, in a manner that allows the public to have clear access to the appearance of that product, will destroy the novelty of the design in the same way as the commercial distribution of those articles.

Presentation or offering of products on internet websites should be assimilated to commercialization of those products. This type of disclosure should be recognized even where the website requires a subscription or payment, or is password protected for access to a limited group of persons. If access to a website is not restricted by confidentiality clauses and is accessible to the traders and business circles that deal with the products in question, a disclosure on that site should be regarded as a public disclosure.

It will be necessary to ascertain in each case the precise date of the disclosure of a design on an internet site to be able to compare that date against the filing date or the priority date of the application. The date of an internet disclosure may not always be readily available. The OHIM Guidelines (Invalidity) mention the following indications that a date of disclosure on the internet may be regarded as reliable:<sup>31</sup>

- the web site provides timestamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google cache); or
- a screenshot of a webpage bears a given date; or
- information relating to the updates of a web page is available from an internet archiving service.

#### 2.1.3.5 *Disclosure at an exhibition*

The legal provision for a grace period in case of the disclosure of a design at an exhibition may be established independently or in conjunction with the

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<sup>31</sup> See EUIPO Guidelines (Invalidity), paragraph 5.5.1.4.

implementation of the obligation under the Paris Convention to provide protection for products exhibited in an official or officially recognized international exhibition.<sup>32</sup>

An industrial design may be disclosed for the first time at an exhibition or trade fair, especially where such events are used to launch new products or products of fashion, periodical turnover or seasonal demand. The presentation of a product at an exhibition should be taken into consideration to determine the novelty of a design.

The law may provide for a limited grace period following the disclosure of a product bearing a design (see above item 2.1.2.2). However, the law may specify that such grace period will be applicable only to disclosures at official or officially *recognized international exhibitions*. Consequently, the disclosure of a product in non-recognized exhibitions could effectively destroy the novelty of the designs embodied in those products.

The following example illustrates of a novelty-destroying disclosure at an exhibition that is not officially recognized:<sup>33</sup>

**Filed design:**

Application No: 3-2007-00452 – “Motorbike” LCL: 12-11  
Priority Date: 4 January 2007 – Filing Date: 12 April 2007



<sup>32</sup> The Paris Convention, Article 11(1), provides:

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

<sup>33</sup> Example provided by the authorities of Viet Nam.



**Cited design disclosure:**

The design was rejected for lack of novelty. The motorcycle appearing in the cited document was disclosed at an exhibition held in Jakarta, Indonesia before the priority date. The applicant stated that the design was disclosed at an international exhibition. However, the applicant failed to prove that the exhibition was an *official* international exhibition as required under the law of Viet Nam.

The law of Viet Nam also provides for a grace period of six months following the disclosure of a product bearing a design at *recognized national exhibitions in Viet Nam*.

## **2.2 Assessing novelty**

### **2.2.1 Identity of designs**

Novelty is assessed by comparing the design in question against any other design that has been disclosed before the date of filing or the date of priority of the design being examined.

In principle, the requirement of novelty is met if no *identical* earlier design can be found that anticipates the design under examination. However, *minor, insignificant* or imperceptible differences, and *immaterial* details, should not be taken into account when comparing a design against an earlier disclosure or citation. Such minor differences should not affect the relevance of the earlier disclosure for novelty purposes.

A difference or variation of appearance should be regarded as minor, insignificant, imperceptible or immaterial if it would normally not be noticed by the *average consumer* of the product that embodies the design, or if the relevant feature can only be perceived upon close examination. The

average consumer may exercise different levels of circumspection and attention depending on the type of product. This should also be taken into account to assess novelty in the specific case.

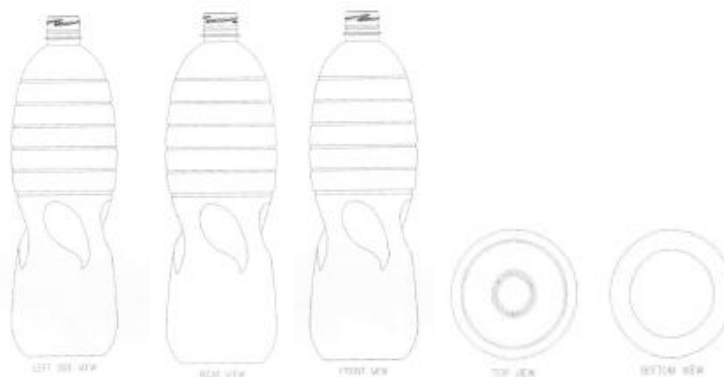
The following example illustrates a case where insignificant differences in the design would not avoid a finding of lack of novelty:<sup>34</sup>

**Filed design:** Application No: 3-2006-01570  
Filing Date: 25 December 2006

"Fish sauce bottle" – LCL: 09-01



**Cited design:** Registration No.: HK 0211665.5M004  
IP Office: Hong Kong  
Publication date: 8 November 2002  
"Plastic bottle" LCL: 09-01



<sup>34</sup> Example provided by the authorities of Viet Nam.

The filed design was rejected due to lack of novelty. The filed design was anticipated by the cited design. The differences in the cap, the bottom, the shoulder and the leaf-shaped pattern on the body were deemed to be insignificant.

Significant variations in the features of a design under examination, as compared to an earlier design disclosed or cited against the examined design, can make the later design perceptibly different, and consequently new with regard to the earlier design.

To determine the degree of variation and novelty of a later design with regard to earlier designs, a standard of *overall impression* should be applied (see item 2.2.2, below).

### **2.2.2 Overall impression**

The assessment of novelty should be undertaken on the basis of the overall impression that is given by the design under examination, as compared to the overall impression given by each individual earlier design.

The test will require determining whether – as a matter of *first impression* – the design under consideration is perceived as being the same or practically the same as a design disclosed earlier or cited against the design under consideration. The examining authority should apply this standard from the perspective of the potential consumer of the product.

The following examples illustrate the test of novelty as applied on the basis of the overall impression of the designs in conflict:

### EXAMPLE 1<sup>35</sup>

**Filed design:** Application No.: 3-2006-00347 – “Lighting Controller”

Filing Date: 27 March 2006 LCL: 13-03



**Cited design:** Application No.: 3-2004-00180 – Patent No.: 8695

“Inverter” – LCL: 13-02



The filed design was rejected for lack of novelty. The filed design is not identical with the cited design (the cited design has buttons and LCD screen which do not appear on the filed design) but its main features are totally disclosed in the cited design.

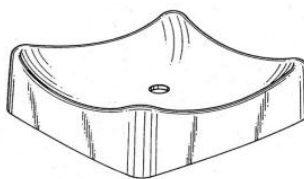
<sup>35</sup> Example provided by the authorities of Viet Nam.

**EXAMPLE 2<sup>36</sup>**

Application for a patent for the design of a “sink”, filed 2 December 2005.



**Filed Design**



**Cited Design**

A search of existing designs found an earlier “sink” in the database of the United States Patent and Trademark Office.

The designs are both squares with significant content in design as the slope in the middle of the sink, while the top edges are curved upwards. The difference is in the dip of the filed design, which is shallower and is taller than the cited design.

The filed design has the same shape of top edges as the cited design, even though they are different in height. The difference in height does not make the shape of the applying design different from the existing design and, therefore, is not considered new.<sup>37</sup>

### **2.2.3 Combinations of earlier designs**

In principle, novelty is determined objectively on the basis of the overall, first impression of identity, similarity or difference between two (or more) designs. They should be compared individually and separately, in their entirety, as they appear to the consumer during the ordinary use of the product.

<sup>36</sup> Example from the Inspection Manual for the Application for Design Patents of Thailand, p. 73.

<sup>37</sup> Based on the explanation provided in the Inspection Manual for the Application for Design Patents of Thailand, p. 73.

Novelty should not be assessed by comparing a design against a combination of features taken from two or more earlier designs. An amalgamation of different features found in earlier designs will generally yield a novel design, unless the *overall first impression* given by this design is not dissimilar from that given by one or more of the earlier disclosures.

If the overall first impression indicates that the designs are different, the examiner should not construct a case of similarity by combining separate features found in earlier disclosures.

However, if a design that combines features taken or inspired from earlier designs remains closely similar to one of the earlier disclosures when its overall appearance is considered, the design could be found lacking the required novelty. Furthermore, in national laws there may be an additional requirement in connection with novelty, such as creativity, inventive step or individual character.<sup>38</sup>

#### **2.2.4 Freedom of design**

For the purposes of establishing the novelty of an industrial design, the *degree of freedom* enjoyed by the designer in shaping the appearance of the product in question should be taken into account. The nature of the object that embodies an industrial design will determine the degree to which the designer will have leeway to add aesthetically-defined features in the design of that object.

Industrial designs are intended for embodiment in utilitarian articles and industrial products. The purpose of a design is – in particular – to make an article or product aesthetically pleasant to the eye and desirable for potential purchasers, without interfering with the technical functionality of the product. If a design was aesthetically valuable but its embodiment hampered or impeded the intended use or operation of the article in which the design is embodied, that design would not fulfil its purpose.

A consequence of the fact that a design is embodied in a product or article that has a predetermined function is that a designer will always face a certain degree of constraint on his freedom to design, as he must take into consideration the features of shape of the product receiving the design that

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<sup>38</sup> In Viet Nam requirement of *creativity* applies. A design may be compared against a combination of features taken from two or more prior designs, and may be refused due to lack of creativity if it is found to be merely a combination of two or more previously disclosed features.

are necessary for that product to perform its intended function and be used in accordance with its purpose.

The nature of the products involved will determine the degree to which a designer's creativity is unfettered or constrained. Some products contain features that are *standardised* to respond to specific functional or technical requirements. Those features will be commonplace in that type of products and the designer will have little or no freedom to alter, move or suppress such features when designing those products.

A designer's freedom to shape, for example, a portable telephone is more restricted than would be the case if he were to design, for example, a pattern for wallpaper or for textile products. A telephone will necessarily have several features that will unavoidably be part of the product's appearance, for example the keypad or the screen on the front of the device. Such features are functionally required and the designer cannot disregard or suppress them. He will have only marginal freedom to design the appearance of that sort of product.

By the same token, all the devices that share common functional features and design constraints, or that have standardised features, will tend to be similar. In these cases, the designer's contribution to the appearance of the product will tend to be subtle and less conspicuous than would be the case with products that are less standardised and allow for greater freedom of design.

## 3 Visibility

### 3.1 Principle

An industrial design provides a particular appearance to a utilitarian product or article. A design should appeal to, and be judged, by the eye. The design should therefore be visible to the consumers to whom the design is addressed and remain visible to the user of the product.<sup>39</sup>

Features of a design that are not visible or perceptible during the normal, intended use of the product that embodies the design cannot be claimed for registration as an industrial design. To this effect, *normal use* refers to use by the *end user* of the product or article, whether a member of the general public or a professional or specialized user, for example a medical doctor, a computer programmer or an auto mechanic.

Normal use of a product does not include interventions to overhaul or provide maintenance to machines, apparatuses or devices that contain internal pieces and components. The end users of such articles do not normally open or disassemble them during ordinary use in accordance with the product's intended function.

The issue of visibility may arise mainly with regard to two groups of products, namely *complex products* that contain component parts, and products that present two or more *positions* in their normal operation or use.

### 3.2 Complex products and different positions of a product

A complex product is a product that comprises or consists of a number of individual parts or pieces that are assembled together to form a device, machine or other larger product. Those parts and pieces may be assembled, disassembled and replaced, but they may or may not be visible during the normal use or operation of the device.

Parts and pieces that are internal in a complex product will not be visible to the potential purchaser or user of the finished device during its normal operation.

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<sup>39</sup> See the provisions in BN DA s. 2(1) "industrial design"; KH DL art. 89; LA IPL art. 15.2; MY DA s. 3(1) "industrial design"; PH IP Code, s. 112, IP Rules r. 1500; TH DA s. 3 "design"; VN IPL art. 64.3, DR r. 35.3.b(iii). Also the EUIPO Guidelines (Invalidity), paragraph 5.5.2.1 "The visibility requirement".



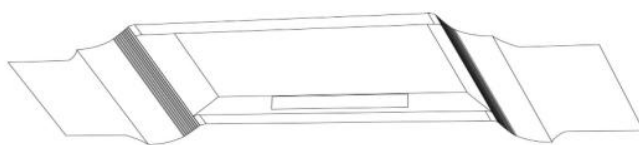
This is the case, for example, with an electronic device such as a computer or a mobile telephone, or a mechanical device such as a pump or a turbine. These are complex products that are formed of several interconnected parts and pieces.

If the design is embodied in an object that is a component part or piece of a complex device, and that part or piece is not visible to the end consumer during the use of that device, an objection to the registration of the design for that component part or piece may be raised. A design right should only cover products and objects that remain *totally or partially* visible during operation and use.<sup>40</sup>

It is not necessary that all parts of a complex object remain visible all the time. It is enough if a part is visible during a particular position, phase or step in the normal use or operation of the complex product in such a way that its essential features can be perceived. If such normal use includes, for instance, the opening and closing of an article, a part or feature of that article that becomes visible during the usual opening step during use should be regarded as a visible feature for purposes of registration and validity of the design.

Examples of the representation of articles that have *different positions* during normal use can be found below, under item 8.4 “Different appearances of a product during use”.

The following examples illustrate parts and pieces that are contained inside complex products and are usually *not visible* during the product’s ordinary use:



Interior linings for vehicles<sup>41</sup>

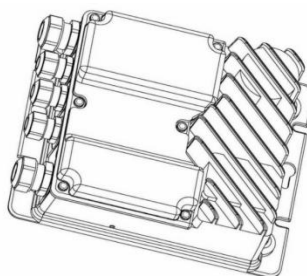
<sup>40</sup> The requirement that component parts and pieces be visible during ordinary use may not be applicable in some of the ASEAN Member States.

<sup>41</sup> Example taken from International Design Registration DM 085065.

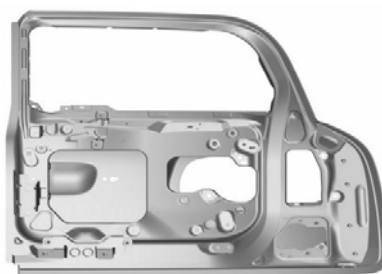
1.4



Joint for sliding roofs for trucks<sup>42</sup>



Frequency converters [electricity]<sup>43</sup>



Interior of door for motor vehicles<sup>44</sup>

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<sup>42</sup> Example taken from International Design Registration DM/084724.

<sup>43</sup> Example taken from International Designs Registration DM 085126.

<sup>44</sup> Example taken from International Design Registration DM/084240.

## 4 Technical or functional features

### 4.1 Rationale for refusal

An industrial design right protects only the aesthetic appearance of a utilitarian product. It does not cover the *functional or technical characteristics* of the features of appearance that compose the design.<sup>45</sup>

Features of shape of a product will not be covered by an industrial design right if they have a technical effect or give the product a functional or economic advantage that is relevant to the product's manufacturing process, its transportation or handling, or its ergonomic performance.

Features of shape that respond to functional considerations or give a technical effect or advantage amount to 'technical solutions' or inventions. Such features may only be claimed in an application for a patent of invention or a utility model patent or registration.

The rationale behind this is that technical solutions should not receive monopoly-like protection if they do not comply with the strict conditions and examination procedures established for inventions and other technical subject matter. Unlike industrial designs, early access to inventions and other technical solutions is regarded as crucial for technological and economic development.

As a matter of public policy, a technically determined shape should only be granted exclusive intellectual property rights through the patent system (including utility model protection), which has the proper set of legal conditions and requirements to assess whether the grant of exclusive rights is warranted. Public policy therefore dictates that inventions should only be shielded from competition in the marketplace (i.e. by patents) when the prescribed conditions are met.

Functional and technically determined features of shape cannot be covered by industrial design protection regardless of whether alternative functional shapes are available. The rationale for the exclusion of functional features from industrial design protection will apply equally to other shapes that are determined by technical considerations.

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<sup>45</sup> See the provisions in BN DA, s. 2(1) "industrial design" (a) and (b); KH art. 90; LA IPL art. 22.1; MY DA, s. 3(1) "industrial design" (a) and (b); PH IP Code, s. 113.2, IP Rules r. 1501(a); SG DA s. 2(1) "industrial design" (a) and (b); VN IPL art. 64.1, r. 33.7.b(i), 35.3.b. Also the EUIPO Guidelines (Invalidity), paragraph 5.3 and 5.5.2.1.

A practical consequence of the exclusion of technical solutions from industrial design coverage is that where the *entire* appearance or shape of a product, or all its essential features of appearance are *dictated solely by technical or functional considerations*, that shape may not be registered as an industrial design. Although most utilitarian products leave some leeway for designers to exercise their artistic freedom and add aesthetic value to the shape of products, examiners should raise an objection to the registration of a design where the appearance of the product responds *only* to function.

For example, the following product shapes could be refused registration as industrial designs, and their registrations could be declared invalid, on grounds that all their essential features of appearance are dictated solely by technical requirements or by functional considerations:



Images taken, respectively, from:

[http://www.centrafasteners.co.uk/acatalog/Online\\_Catalogue\\_Hoses\\_Fittings\\_240.html](http://www.centrafasteners.co.uk/acatalog/Online_Catalogue_Hoses_Fittings_240.html) and [http://www.landwide-screw.com/en/product/HEX-HEAD/Self\\_Drilling\\_Screw\\_Hex\\_Head-001.html](http://www.landwide-screw.com/en/product/HEX-HEAD/Self_Drilling_Screw_Hex_Head-001.html)

2-1



Beams [construction]<sup>46</sup>

<sup>46</sup> Example taken from International Design Registration DM/086395.

## 4.2 Assessment of functionality

To determine whether the functionality ground of refusal (or invalidation) is applicable, the examiner will have to determine what the function or utilitarian purpose of the product is. The indication and classification of the product provided by the applicant or holder of the registration should be taken into consideration. The examiner may also consider other documents disclosed in connection with the product, including parallel filings for patents of invention or of utility model for the same product, in the country or abroad, and advertising material published by the manufacturer or distributor of that product.

The technical nature or functional effect of the features of the design must be assessed objectively from a technical point of view. The perception of an average consumer or user with respect to the technical functionality of features of appearance of a device would not be relevant for this purpose.

A shape should be regarded as functional in the following cases, in particular:

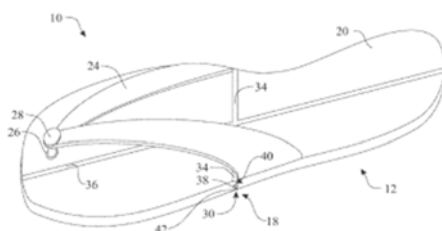
- the shape is necessary to allow the product to be used for its intended purpose, or is an ergonomic shape for the product,
- the shape allows for a more efficient or more economical manufacture or assembly of the goods (e.g. by saving material or energy),
- the shape facilitates the transportation or storage of the goods,
- the shape gives the product more strength or better performance or durability,
- the shape allows the product to fit or be connected with another product.

An objection based on a finding of functionality should be maintained regardless of whether the functional features can be replaced by alternative functional features. The objection cannot be overcome even if other shapes are available that would afford equivalent functionality or provide the same effect or advantage.

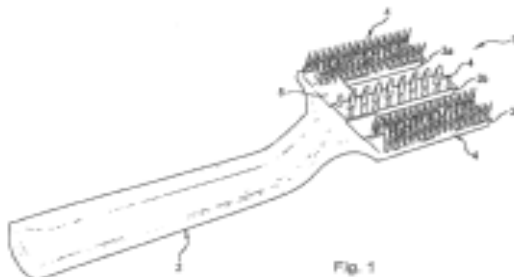
The functionality exclusion is based on the fact that *none* of the features of the product were freely created by a designer with the purpose of adding aesthetic value, but were all dictated by the functional purpose of the product, and this was the only factor taken into consideration. It is irrelevant in this regard that a functional effect may also be achieved using other technical features disclosed in the state of the art.

A shape that is disclosed and claimed in a patent of invention document or in technical literature in connection with the type of product for which the design is to be registered, should be regarded as functional since matter claimed in a utility patent document should be presumed to be a technical solution.

For example, the following shapes could be regarded as functional in respect of the products indicated:



“Sandal with formed hinge and method of use”<sup>47</sup>



“Hair applicator brush for generating streaks and method of using the same”<sup>48</sup>

A type of functional shapes that may be improper for registration as industrial designs are surface designs that have the function of providing grip, traction or other physical or technical effect. The fact that such surface

<sup>47</sup> Example taken from US patent document US09089184 accessible at [patentscope.wipo.int/search/en](https://patentscope.wipo.int/search/en)

<sup>48</sup> Example taken from patent document PCT/EP2014/056817 accessible at [patentscope.wipo.int/search/en](https://patentscope.wipo.int/search/en)

designs may incidentally also be aesthetically pleasing or decorative should not avoid an objection on grounds of functionality, where applicable (see item 4.3, below).

For example, the following surface patterns could not be claimed as industrial designs for tyres if their shape and appearance were determined *solely* by function:



[Image taken from <http://www.cdtextbook.com/steersusp/wheelsTires/construct/treaddesign.html>]

### **4.3 *Functionality ban prevails over aesthetic quality***

The fact that a functional feature of shape that is dictated solely by technical requirements or considerations also happens to be aesthetically attractive will not avoid the exclusion on grounds of functionality.

If the entire shape of the product claimed in an application is functionally necessary or is dictated solely by its technical function, the examiner should raise an objection regardless of any aesthetic value of the product's appearance. If that shape has been registered as an industrial design, the registration should be revoked, cancelled or invalidated on grounds of functionality.

For example, the shape of a turbine fan may be found to be aesthetically pleasing (see below). However, to the extent that every element and detail of the shape of each feature of that device has been dictated by mechanical and aerodynamic functional and technical considerations, the appearance of the product cannot be claimed as an industrial design. In this case, the designer had no freedom to make a personal aesthetic contribution to the shape of the product. Such a shape could be claimed as an invention under patent law if it complies with the conditions for patentability.

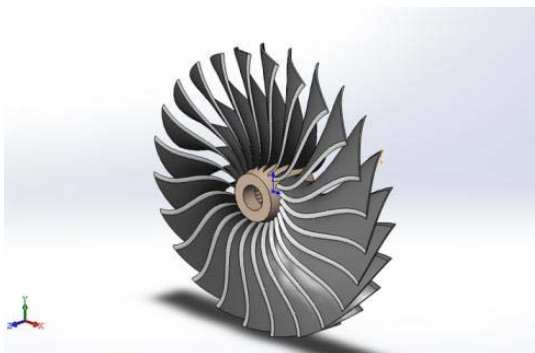


Image taken from: <https://grabcad.com/library/fan-for-turbofan-engine>

#### 4.4 Spare parts and interconnections

A design right will not cover a feature of a design that must necessarily be replicated in order that the product that embodies that design may be mounted on, connected with or assembled in another product of which it is a part, in order that they may both perform their intended function.<sup>49</sup> Such feature should be regarded as *functional* and would not be covered by the registration of the design. The functionality standards would apply (see item 4.5, below).

The following example illustrates a part (screw thread) of a product (sparkplug) that cannot be claimed because it is functional as it allows the product to be fixed into position so it may operate according to its purpose.<sup>50</sup>



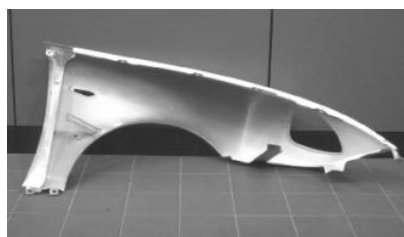
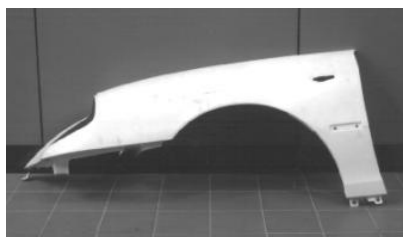
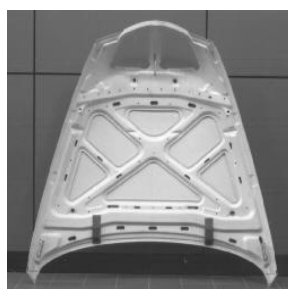
<sup>49</sup> See the provisions in BN DA, s. 2 and 10; KH Law, art. 90; LA IPL art. 22.1; MY DA, s. 3; PH IP Code, s. 113.2, IP Rules r. 1501(a); SG DA s. 2(1); VN IPL art. 64.1. Also the EUIPO Guidelines (Invalidity), section 5.4.

<sup>50</sup> Example provided by the Malaysian IP authorities.



Likewise, any shape of an object such as a spare part that must necessarily be reproduced in its entirety in *identical* shape and appearance in order that such part may fit or match a complex product to which it belongs, may be regarded as entirely *functional* and consequently excluded from protection as an industrial design.<sup>51</sup> This case can apply to spare parts and pieces, in particular to so-called ‘crash parts’ of motor vehicles and other devices that need to be reproduced identically to fit or match the rest of the body of the complex product.

The following examples illustrate designs of spare parts that could be acceptable for registration but could be subject to the ‘must fit’ or ‘must match’ limitation, where such limitation is applicable.<sup>52</sup>



#### **4.5 Combination of functional and aesthetic features**

To the extent that an industrial design is, by definition, embodied in an object that has a functional and utilitarian nature, the overall combination of features of the design will maintain the functionality and usefulness of the object that embodies the design. A good industrial design will add aesthetic value to the appearance of a useful article without impeding, hampering or interfering with its functionality.

<sup>51</sup> The ‘must-match’ standard might not apply in some of the ASEAN Member States.

<sup>52</sup> Examples taken from International Design Registration DM/053625.

However, it is only when the *totality* of the appearance of a product is dictated by function, and none of its features is imbued with an aesthetic purpose, that an objection should be raised against registration of the design (see item 4.1, above).

In most cases an industrial design, i.e. the appearance of a useful product, will *combine* both functional and aesthetic features. In fact, the same feature may be functional and aesthetic simultaneously where the designer has designed the feature to realise both purposes.

Consequently, industrial design protection will not extend to those features of appearance of an object that are functional because they are needed in order that the object may perform its function, or because they provide some other technical or economic advantage. By contrast, features of appearance and shape that respond *at least in part* to the designer's intention to make the product's aspect more pleasing to the eye should not be objectionable under the functionality standard.

In practice, this means that the fact that one or several features of a product's design would not be claimable under design law would not invalidate the entire design for purposes of registration or continued validity. It is only if *all the essential features* of the appearance of a product were found to be dictated solely by function and were totally lacking in non-functional features that an objection must be raised and registration denied or invalidated.

The following examples of running shoes illustrate designs that combine functional features required to provide grip, stability and ergonomic advantage with aesthetic features incorporated to make the product pleasing to the eye:



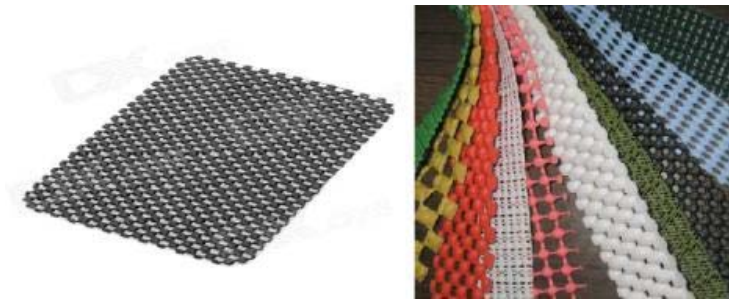


[Images taken, respectively, from <http://strengthrunning.com/2013/04/newton-gravity-running-shoe-review/>, <http://runblogger.com/2012/09/saucony-grid-type-a5-running-shoe.html>, and <http://runblogger.com/2012/04/womens-running-shoe-reviews-merrell.html>]

An industrial design consisting of a *combination* of functional and aesthetic features, or containing one or more features that have deliberately been shaped by its designer to respond to an aesthetic purpose, should be accepted for registration. However, in accordance with the applicable law, the registration of the industrial design embodying such combination will only cover the aesthetic features in the design, not the functional features. Features and elements of the design that are functional or technically necessary will not be covered by that registration, even if they are integrated in the overall design of the product.

As a further consequence of this principle, features of a design that are functionally necessary or dictated by technical considerations should not be taken into account when comparing the design with other (earlier or later) designs. Functional and technical features should be disregarded for purposes of establishing novelty of a design, or similarity between two or more designs, as such features fall outside the scope of the industrial design.

The following examples further illustrate designs consisting of *combinations* of functional and aesthetic features in useful products.<sup>53</sup>



<sup>53</sup> Examples provided by the industrial property authorities of Malaysia.

## 5 Conflict with prior rights

To the extent that national law so provides, an industrial design may not be validly registered if the registration of the design or its commercial use would conflict with an earlier intellectual property right.

Such conflict may occur, in particular, in respect of prior registered industrial designs, earlier registered or well-known trademarks, earlier copyright in protected works, or existing rights in personal names, portraits or images.<sup>54</sup>

### 5.1 *Prior rights in registered designs*

If an industrial design that is submitted for registration is identical with an earlier registered industrial design, or is different from an earlier registered design only in features or details that do not produce a *different overall impression* on an informed user or average consumer of those products, the registration should be objected by the examining authority (administrative or judicial). If the design is registered, the registration could be revoked, cancelled or invalidated.

The examining authority should apply the same standards that are applied to establish novelty of an industrial design in respect of other earlier disclosed designs, whether registered or unregistered (see above item 2).

The examining authority should presume that an earlier registered industrial design is valid. However, the applicant or holder of the later design may challenge the validity of the registration that is the basis for opposition or invalidation proceedings.

### 5.2 *Prior rights in distinctive signs*

If an industrial design that is submitted for registration is identical with an earlier registered or well-known trademark, or is different from such trademark only in features or details that would not produce a *different overall impression* on an informed user or average consumer of those products, the registration should be objected by the examining authority (administrative or judicial). If the design is registered in spite of the earlier

<sup>54</sup> See the provisions in BN DA, s. 9(2)(a), DR, 13, 14; MY DA, s. 12(2)(b); SG DA s. 5(2)(a), 27(2)(a), DR r. 11. Also the EUIPO Guidelines (Invalidity), items 5.6, 5.7 and 5.8.

conflicting mark, the registration could be revoked, cancelled or invalidated by the IP Office or by the court.

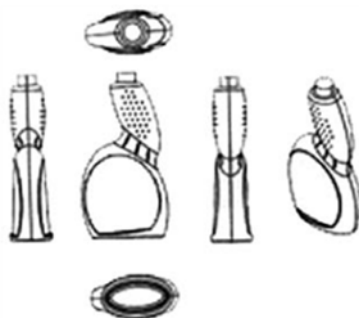
This situation may occur where the earlier registered or well-known trademark is a three-dimensional mark or a figurative mark. The shape of a product, a product container or product packaging, may constitute a trademark and be registered for specific products, if the applicable requirements under trademark law are complied with – in particular the requirements of distinctiveness and non-functionality.

If an application for the registration of an industrial design takes up, reproduces or includes, without due authorization, a registered or well-known mark that belongs to a third person, this person may oppose the registration or request the registration to be revoked, cancelled or invalidated. However, the examining authority should not raise such objection if the applicant is also the holder of the earlier mark or submits proof of consent by the holder of the trademark to the effect that the mark may be included in the industrial design registration.

The following three-dimensional marks and figurative surface pattern marks are examples of product shapes and appearances that have been submitted as trademarks but could also be registered as industrial designs for the products that embody them:



Example taken from the Guidelines for Trademark Examination of the Philippines, p. 126.



Example taken from international trademark application N° 1061835 under the Madrid Protocol.



Images taken respectively, from: <http://knitcrochetpat.com/burberry-pattern-background/> and <http://www.dailymail.co.uk/femail/article-2515445/Is-Burberry-losing-rights-infamous-checked-design-Fashion-house-threat.html>



Images taken respectively, from: <http://vector-magz.com/search/louis-vuitton-pattern/> and <http://www.mycolorfashion.com/201108/louis-vuitton-romance-pump-in-monogram-idylle.html>

### 5.3 *Prior rights in copyrighted works*

An industrial design may be characterized as a blend of functionality and aesthetics. Every industrial design is based on an artistic concept that is applied to a utilitarian product or article of industry or handicraft. That is why industrial designs are also recognized under copyright law as 'works of applied art'.<sup>55</sup>

The artistic work that underlies every industrial design may have been created purposely for embodiment in an industrial product, or may have been created for purely artistic purposes and was subsequently taken up to be embodied in a utilitarian article. In either case, the creator of the work enjoys *ab initio* copyright and can control any subsequent use of the work.

If the economic rights in the underlying work have not been sufficiently assigned to the applicant of the industrial design registration or to his predecessor in title, the registration could be opposed or invalidated by the copyright holder.

Likewise, if an industrial design submitted for registration reproduces or embodies a work of sculptural or pictorial art, or a work of applied art, without authorization from the artist or designer of the work, the registration may be objected by the examining authority (administrative or judicial) on opposition from the holder of the copyright in the work. If the industrial design is registered, the registration could be revoked, cancelled or invalidated upon request by that holder.

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<sup>55</sup> See the provisions on 'works of applied art' in the *copyright laws* of BN, s. 2 and 6; KH art. 7(h); ID art. 12(1)(f); LA art. 92.1.1.9; MY, s. 3, 7(1)(c), 7(5) and 7(6); PH, s. 171.10; SG DA s. 2(1); TH s. 4; and VN IPL art. 14.g.



## 6 Public policy, public order and morality

### 6.1 General considerations

A distinction should be made between the concepts of ‘public policy’ and ‘public order’, on the one hand, and ‘morality’ on the other.

‘*Public policy*’ and ‘*public order*’ refer to the general legal framework of a particular State, and to the rationale and purpose underlying that legal framework. The legal framework includes, in addition to positive legislation and executive provisions in force in a country, international treaties and other international commitments adopted by a State, as well as established case law. These legal sources reflect and express the policy, basic principles and values of that State.

‘*Morality*’ is a set of socially recognised principles that determine practices and rules of conduct within a particular society or community. These principles and rules are not cast in positive legislation or executive norms, and may vary over time. They may be quite different in different countries or within different regions and communities inside the same country. Moral principles and rules reflect values that a national society or community wants to uphold. They are applied alongside positive legal norms that generally will not deal with the type of issues or details that are the subject matter of ‘morality’.

Since the definition of ‘public policy’, ‘public order’ and ‘morality’ is a strictly domestic matter, it can only be judged and decided by the competent national authorities on a case-by-case basis in each country. The determination of what is contrary to public order or to prevailing standards of morality will necessarily depend on the political, cultural and religious context prevailing in the country concerned.<sup>56</sup>

In addition, factors such as the degree of outrage calculated to be caused by the use of the offensive sign and the size and section of the identified community potentially affected by the sign are factors to be considered in each case.

The examiner should raise an objection to the registration of a design when those standards are offended, as determined by reference to the local

<sup>56</sup> See the provisions in BN DA, s. 11; KH DL art.93; ID DL art. 4, DR, r. 25(1); LA IPL art. 22.2; MY DA, s. 13; PH IP Rules r. 1501(c); SG DA s. 6; TH DA 58(1); VN IPL art. 8.1. Also the EUIPO Guidelines (Applications), item 4.2.

perceptions and the context of the country where the application is examined.

## 6.2 Particular issues

### 6.2.1 Nature of the design itself

To the extent that national law so provides, registration of a design should raise an objection from the examiner if commercial exploitation of the design would be contrary to public policy or public order, or contrary to accepted principles of morality, in the country concerned.

When this ground for refusal is invoked, it should refer to the design itself. Refusal should be based on the fact that the shape or pattern to be registered as a design is, in itself, contrary to public policy, public order or accepted principles of morality. This ground for refusal or invalidation will also apply where the commercial exploitation of the product embodying the design would be contrary to public policy, public order or morality.

For example, the following designs are unregistrable in Thailand on account of their being contrary to morality and prevailing standards of decency:<sup>57</sup>



An objection on grounds of public policy, public order or morality may also be raised in cases where the problem does not lie with the design itself but with the use to which the article that embodies the design would be put. This is the case of certain symbols or images that are *highly respected* or of *restricted use* in a particular country. The use of such symbols (for example, a symbol of royalty) or images (for example, an image of religious significance) embodied in products traded on the market would be regarded as offensive and contrary to public policy, public order or accepted morality.

<sup>57</sup> Examples taken from the Inspection Manual for the Application for Design Patents of Thailand, page 65.

For example, the following design would be found unregistrable on account of its being contrary to public order or morality:<sup>58</sup>



The following designs would be unregistrable in Thailand on account of their being contrary to public order and public policy:<sup>59</sup>

“Designs with shapes that indicate disrespect to religion, the monarch, or the royal family, which are revered by the public, such as using images of Buddha as decoration or on utility items such as candle holder or table base, or designs of good luck charms or amulets.”



### **6.2.2 Nature of the product on which the design is applied**

The nature of the product that embodies an industrial design may in some cases affect the registrability of the design. Distinction may be made between cases where the product is itself inherently illegal or immoral and cases where the product is subject to regulatory control, prior marketing

<sup>58</sup> Example provided by the industrial property authorities of Malaysia.

<sup>59</sup> Examples taken from the Inspection Manual for the Application for Design Patents of Thailand, page 64.

approval or regulatory prohibition for importation, production or distribution in the country.

Where some or all the products in which the design is embodied cannot be produced, imported, distributed or otherwise commercialised in the country where the application is filed because of a legal or administrative procedural constraint, the registration of the design could be allowed to proceed. For instance, it is usual that national laws will require – in particular for reasons of safety, health and environmental security – that certain products be subjected to regulatory approval or prior marketing authorization before they can be manufactured, imported, distributed or otherwise commercialized in the country.

It may also happen that, in a particular country, the importation and distribution of particular goods, or the offering of certain services, is totally restricted or banned by law.

In case of doubt, the examiner may raise an objection to hear the applicant's views or to clarify the scope of the application.

### **6.2.3 Aesthetic considerations**

Industrial designs are applied to useful products with a view to making them more attractive to potential consumers. The value a design adds to a utilitarian article is that of increasing its desirability and hence the price that such product could command in a particular market or in respect of a particular segment of the public.

However, aesthetic standards and criteria should not be taken into account for purposes of registering an industrial design. The examiner should not apply personal, local or foreign standards of good or bad taste, fashion or aesthetic acceptability to determine compliance with public policy or morality standards.

## 7 Specific statutory prohibitions

### 7.1 Prohibitions provided by statute

If the applicable national law or regulations provide for the exclusion of specified devices, images, representations or other objects from registration as industrial designs, the examiner should apply the exclusion *ex officio* and raise an objection to any application that contains the excluded matter.

This ground for refusal is additional to any exclusion based on grounds of public order or public policy. Exclusions based on statutory prohibitions are established and published beforehand, unlike exclusions based on public order or public policy, which need to be interpreted and applied on a case-by-case basis.<sup>60</sup>

For example, in the following countries the specified subject matter is excluded from registration as whole or part of an industrial design:

#### Brunei Darussalam

- (a) works of sculpture (other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process);
- (b) wall plaques, medals and medallions;
- (c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greeting cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.<sup>61</sup>

#### Philippines

Mere schemes of surface ornamentations existing separately from the industrial product or handicraft.<sup>62</sup>

<sup>60</sup> See the provisions in BN DR, r. 4; PH IP Rules r. 1501(b); SG DA s. 7(1) and (3), DR r. 9; TH DA s. 58(2); VN IPL art. 64.2.

<sup>61</sup> BN DR r. 4.

<sup>62</sup> PH IP Regulations r. 1501(b).

### Singapore

- (a) works of sculpture (other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process);
- (b) wall plaques, medals and medallions;
- (c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greeting cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.<sup>63</sup>

### Viet Nam

The appearance of a civil or industrial construction work.<sup>64</sup>

## **7.2 State emblems and official signs**

The law may provide that an industrial design cannot be registered if it consists of or contains emblems, armorial bearings, insignia, orders of chivalry, decorations, flags or devices of any country, state, city, government body, statutory board, or other official institution.

In these cases, the examiner must *ex officio* require the applicant to furnish proof of consent to the registration and use of the emblem or sign in question. The examiner must assess the reasonable likeliness that the document of consent is valid and the person giving consent is entitled to do so.<sup>65</sup>

For example, in Brunei Darussalam the following signs cannot be registered as part of an industrial design:<sup>66</sup>

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<sup>63</sup> SG DA s. 7(3) and DR r. 9.

<sup>64</sup> VN IPL art. 64.2.

<sup>65</sup> See, for example, BN DR r. 12 and Chap. 94 s.3(c), Schedule; MY DR r.16; SG DA s. 7(3) and DR r. 10.

<sup>66</sup> Chapter 94 -- Emblems and Names (Prevention of Improper Use) 20 of 1967, 3 of 1974 - Amended by: S 128/80 S 163/81.

1. The standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri.
2. The State Seal of Brunei Darussalam.
3. The Brunei Coat-of-Arms.
4. The emblem or official seal of the United Nations Organisation.
5. The Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty.
6. The Emblem or official seal of the International Criminal Police Organisation (Interpol).
7. The emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam [...]

Designs that contain a national or state emblem without due authorization should raise an objection *ex officio*. For example, an application for an industrial design that includes emblems such as any of the following belonging to the ASEAN Member States and the ASEAN organisation, should not be allowed to proceed without proper consent from the competent authority:





### 7.3 Representations of persons and dignitaries

The law may expressly exclude from registration an industrial design that reproduces or represents a living or recently dead *person* unless the use of the representation is duly authorized by the person concerned or their legal representatives. In these cases the examining authority should – either *ex officio* or at the request of an interested party in opposition proceedings –



raise an objection to such registration and require that the applicant furnish evidence of the consent of the person or his legal representatives.<sup>67</sup>

Likewise, the law may provide that the image or representation of certain public *dignitaries* may not be included in an industrial design. In this case the examining authority should *ex officio* require that the applicant furnish evidence of proper authorization from the competent authorities.

For example, in Thailand the following representations of an official dignitary are not registrable in as an industrial design:

A picture of His Majesty the King or a sculpture of His Majesty the King or members of the royal family to be made into statue of worship or decorations such as King Rama the V, etc.<sup>68</sup>



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<sup>67</sup> See, for example, SG DA s. 7(3) and DR r. 11.

<sup>68</sup> Example taken from the Inspection Manual for the Application for Design Patents of Thailand, p. 65.

## 8 Representation of the design

### 8.1 General requirements

The representation of the design is an essential part of the application for registration of an industrial design. Although it is a formal requirement that must be filed with the application, it directly concerns the substantive requirements of compliance with the definition of design, industrial applicability of the design and visibility of the design.<sup>69</sup>

An adequate, sufficient and clear representation of each industrial design included in an application will be critical to obtaining the registration and will subsequently determine the scope of protection of the design.

The representation submitted by the applicant should be sufficient to represent accurately and faithfully the real product so that no samples or specimens should be necessary. Therefore, the Office should not normally request samples or specimens of the products that embody the industrial design.

The date of filing of the application should be contingent on the adequate compliance with the requirements regarding the representation of the design. If the representations are *deficient* in any respect the Office should raise an objection.

The applicant may be allowed to remedy the deficiency by submitting improved representations, as required. However, no additional designs or different design features should be accepted on occasion of correcting the deficiencies of the original representations.

### 8.2 Form of representation

The representation may consist of drawings, photographs or computer-generated images of the design. If the representation is filed in electronic format, the electronic document should comply with the same requirements when opened on screen or printed.

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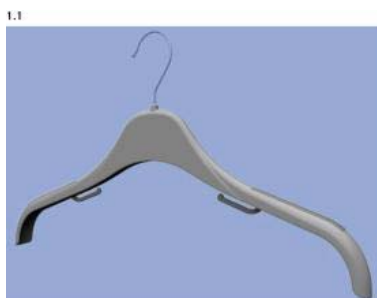
<sup>69</sup> See the provisions in BN DA, s. 15(2)(b), DR r. 6(2)(b), 7; KH DL art. 95; ID DL art. 11(4)(a), DR r. 1; LA IPL art. 32.3; MY DA, s. 14(1)(b), DR 10, 15; PH IP Code, s. 114.1(d), DR r. 1510(c); SG DA s. 11(2)(c), DR r. 14; TH DA s. 59(1), DR r. 17, 19; VN IPL art. 103, DR r. 33.5.d, 33.6. Also the EUIPO Guidelines (Applications), item 3.3.

### **8.2.1 Background of the representation**

The representation should be presented on a *neutral background*. In particular, when the representation is by means of a photograph, the background should be neutral enough to allow the contours of the product or part of the product that embodies the design to be clearly contrasted with the background environment.

The background should not interfere with or hamper the clarity of the claimed design, which should distinctly stand out from the background.

The following are examples of different neutral backgrounds that allow for the design to stand out in clear contrast:<sup>70</sup>



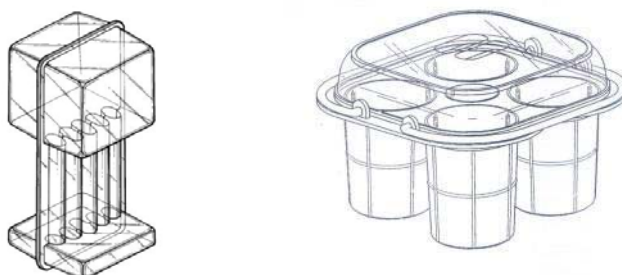
### **8.2.2 Transparency in the design representation**

The representation should clearly show what parts of the product, if any, are transparent. In the case of photographs, the quality should suffice to show the parts that are transparent.

<sup>70</sup> Examples taken, respectively, from International Design Registrations DM/087075, DM/086317 and DM/087323.

In the case of a representation of the design by drawings, the effect of transparency should be indicated by light parallel lines at the place of the transparent surface or part. The appearance of the product behind the transparent surface should be visible.

The following drawings illustrate the effect of transparency in industrial design representations by drawings:<sup>71</sup>



### **8.2.3 Quality of the representations**

The representation should be of a quality that is sufficiently high to allow for reproduction and digitization (scanning) without significant loss of quality.

The quality should remain high for representation for publication, including any printing of the design.

## **8.3 Number and consistency of views**

The representation of a design should fully disclose all the relevant features and details of the appearance of the product. The features that are not clearly shown on the representation will not be covered by the industrial design registration.

The applicant is free to choose the *number of views* provided that they are sufficient to disclose all the features that he intends to claim for his design in the registration. Typically, a full disclosure of a three-dimensional object could be achieved by *six directional views* (from the front, back, sides, bottom and top) and *one perspective view*, i.e. a total of seven views.

<sup>71</sup> Examples from the Inspection Manual for the Application for Design Patents of Thailand, p. 31 and 68, respectively.

The applicant may also submit *cross-sectional views* of the design, in addition to the standard seven views, if they are required to represent fully the design's features.

The following is an example of the standard seven views:<sup>72</sup>

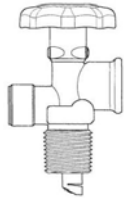


Image 1

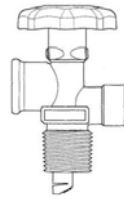


Image 2

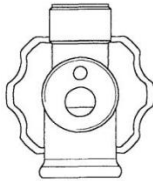


Image 3

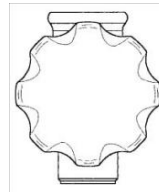


Image 4

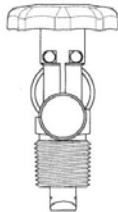


Image 5



Image 6



Image 7

<sup>72</sup> Example from the Inspection Manual for the Application for Design Patents of Thailand, p. 27.

The applicant may choose to file less views if the full complement of seven views is deemed unnecessary in respect of a particular design. That could be the case, for instance, because of the overall symmetry of the object that embodies the design makes additional views superfluous, or because the application only relates to a part of a product that can be clearly visualized with a reduced number of views.

If the examiner finds that the representations submitted by the applicant do not represent the design with sufficient clarity, he should raise an objection and request clearer representations. However, no additional or different design features may be accepted in respect of a filed design after the application has received its filing date.

Each design contained in the application should bear a distinct number, and the different views of each design should be numbered as a sub-number of the design's number, as a series.

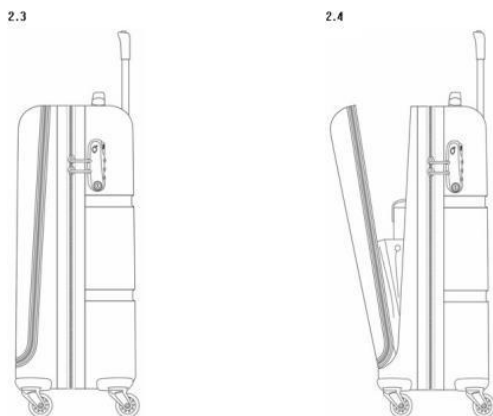
The views submitted in respect of each representation of the design should be *consistent*. The examiner should verify that the views correspond to the representation of a particular design in the application, and that the numbering of the designs and of each view can be clearly understood. If the views of a particular design are inconsistent or correspond to different designs, the request may need to be treated as a multiple application.

#### **8.4 Different appearances of a product during use**

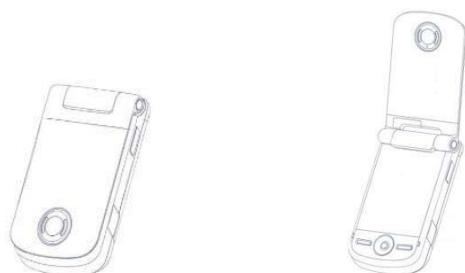
A product or device may present two or more alternative positions during its normal use. Such is the case, in particular, with articles that require an opening and closing action to be used, or devices that require folding or unfolding to operate. The device's alternative positions will correspondingly produce different visible appearances of the product, all of which should be represented in the application.

In this regard, each design should be represented and claimed in all the positions or phases that would be visible by the end user during the product's normal operation. This would need to be reflected clearly in the representation or drawings submitted for registration, and can be supplemented by an explanatory description.

The following examples show representations of the different positions (open and closed) of a product during its normal use:



Suitcases<sup>73</sup>



[Image 8]

[Image 7]

Portable Phone<sup>74</sup>

## 8.5 Complex products, sets of articles and variations

### 8.5.1 Complex products

A *complex product* is a product, article or device that consists of several individual component parts that can be assembled and disassembled, and replaced or alternated among two or more positions in the ensemble.

Each individual part of a complex product could, in certain cases, constitute a separate industrial design in itself. Therefore, where the design of a

<sup>73</sup> Example taken from International Design Registration DM/086304.

<sup>74</sup> Example taken from the Inspection Manual for the Application for Design Patents of Thailand, p. 32.

complex product is allowed to be registered as a single industrial design, the representation of the design should include separate representations for each of the individual parts (or individual features) plus a representation of the *ensemble* viewed as a whole, with all the individual parts connected. Full representations of all the designs may also be required.<sup>75</sup>

The view of the ensemble is required in order that the application may be treated as an application for a single design and not as a multiple application. If the individual parts are not clearly presented in a single representation that shows all of the parts connected as a complex product, the examiner should treat the application as a multiple application, or require division of the application if the standard of unity of design is not complied with (see chapter 10, below).

The *ensemble* representation of a complex product need not be the only possible assembly of the product that embodies the design if the elements allow for more than one assembly.<sup>76</sup>

For example, design No 1 is an assembly that includes two or more elements of designs Nos. 3 and 4:<sup>77</sup>

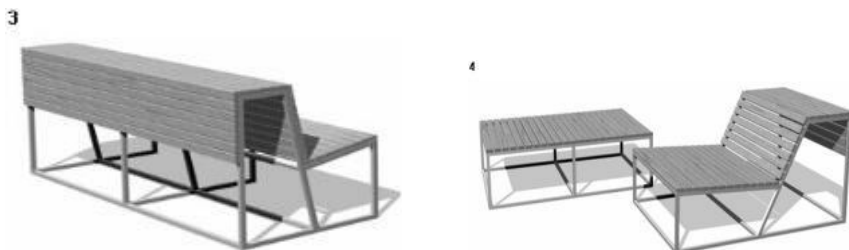


<sup>75</sup> In Viet Nam, the representation of the design must include full representations (perspective view and directional views) of the ensemble with all the individual parts connected. Separate representations for each of the individual parts may be submitted for reference. The applicant will have rights for the whole ensemble and no rights for each individual parts. Full representations (perspective view and directional views) of the ensemble are required.

<sup>76</sup> In Viet Nam, each ensemble is considered as an individual design. If they are significant different from each other, they must be filed in different applications.

<sup>77</sup> Example taken from International Design Registration No DM/086204.





### **8.5.2 Sets of articles**

A set of articles is a group or ensemble of articles that share an identical or similar appearance or design. The articles that compose the set are normally commercialized as a collection and intended for use together.<sup>78</sup> With regard to the general question of unity of design, see item 10.1, below.

Unlike a complex product, the individual articles that compose a set are not physically connected or attached to each other and do not require any mechanical joining or mounting to be able to function.

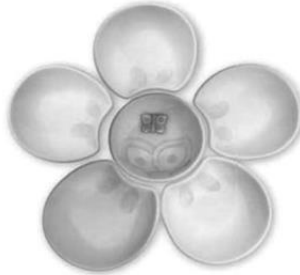
An application for registration of an industrial design that refers to a set of products should be treated as a *single* design application if the individual articles in fact share features of appearance and are functionally complementary in their use. Typical designs for sets relate to products such as tableware, cutlery, kitchenware, table textile products, furniture.

The representations filed in the application for registration of a design for a set of products should therefore include separate representations for each of the individual articles and a representation of all the articles in the *set* viewed as an *ensemble*. The view of the set ensemble is required in order that the application may be treated as an application for a single design and not as a multiple application. If the individual articles that compose the set are not clearly presented in a representation that shows all of them as an ensemble, the examiner should raise an objection with a view to treating the application as a multiple application.

However, an application for registration of a design for a set of products is not treated as a single design application in Viet Nam, because each individual design in the set is protected independently with its own separate scope of protection.

<sup>78</sup> See the provisions in BN DA, s. 2 “set of articles”, 15(6), DR r. 7(2); ID DL art. 13(b); LA IPL art. 32; MY DA, s. 3(1) “set of articles”, s. 3(2); PH IP Code, s. 115, DR r. 1515; SG DA s. 2(1) “article” (b), “set of articles”, DR r. 22(b); VN IPL art. 101.3.a, IPR r. 33.2.b. Also the EUIPO Guidelines (Applications), item 3.2.3.

The following are examples of designs for sets of products:



Dish<sup>79</sup>



Handles for cutlery sets<sup>80</sup>

### **8.5.3 Variations of an industrial design**

An industrial design is a particular, visually-distinct appearance of a product or article. Every distinct appearance of a product constitutes a different industrial design. However, two exceptions to this rule have been considered. One refers to the case of designs of *complex* products (see item 8.5.1, above), and the other refers to designs of *sets* of products (see item 8.5.2), which can be treated as single designs as a matter of practical fiction to facilitate the registration of that type of products.

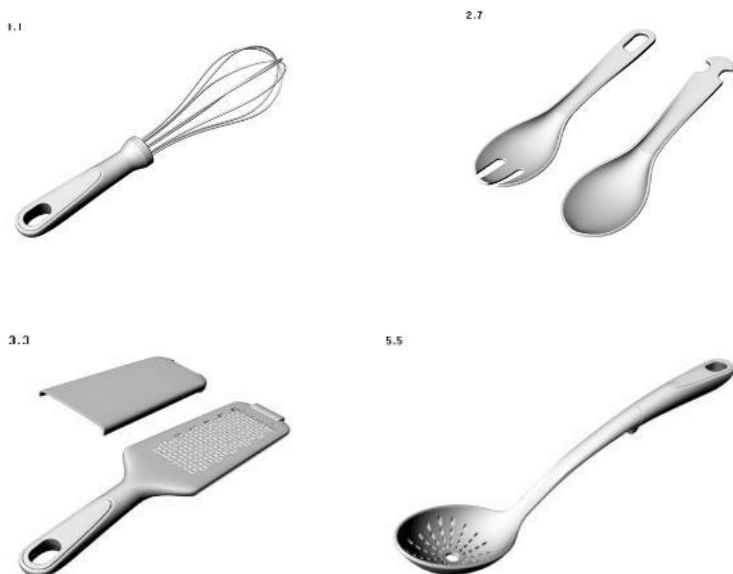
Where several designs consist of different *variations* of the appearance of products they are neither a complex product nor a set of articles. Such distinct designs cannot be regarded as a single design but could be filed

<sup>79</sup> Example taken from International Design Registration No DM/087020.

<sup>80</sup> Example taken from International Design Registration No DM/083026.

together in a multiple application if they meet the applicable requirement of unity of design (see chapter 10, below).<sup>81</sup>

The following is an example of a multiple application/registration containing several different product designs that fall under the same class of the international classification (LCL Cl. 07-03, 04, 06), and could be filed together if they meet the applicable requirement of unity of design:<sup>82</sup>



## **8.6 Representation of a design for a part of a product**

### **8.6.1 Representation of a claimed part**

Where the law allows, an application for the registration of an industrial design may refer to only a *part* or a feature of a larger product. See above, item 1.2.2.5.

Where the application claims only a part of a larger product, the representation of the claimed part should clearly identify that part. The

<sup>81</sup> In Viet Nam, the standard of unity of design is not based on the classes of the International Classification of the Locarno Agreement. In fact, a multiple application will comply with the standard of unity of design if all the designs in the application are embodied in the same product and they are not significantly different from each other.

<sup>82</sup> Example taken from International Design Registration N° DM/084120.

identification of the claimed part or feature is important because the scope of protection of the design of that part or feature will be defined by the representation of the design included in the registration.

Viet Nam provides design registration for spare parts that are separable. Even though, the representation must display the spare part itself as an independent article, being extracted from the larger product. Viet Nam does not accept the representation that displays the larger product with specific claimed part on it.

### **8.6.2 Means of identification of a claimed part**

In order to define clearly and distinctly the part of a product to which the *claimed* design applies, and *disclaim* the other parts of a larger product that will not be covered by the registration, the applicant may identify the relevant part by using the following means:

- Dotted lines and solid lines
- Perimetric boundaries
- Shading and blurring
- Separations and cuts

#### *8.6.2.1 Dotted lines and solid lines*

In the representation of the design, the part or feature of the larger article that is specifically claimed may be delineated using *solid lines* while the rest of the larger article is represented in the representation using *dotted* or *broken* lines.

This representation of the parts or features of a design allows the public to understand that only the part represented with solid lines is being *claimed* while the dotted or broken lines represent the part of the design that is *not claimed*.

The following representation of a design provides an illustration of both types of lines:<sup>83</sup>

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<sup>83</sup> Example taken from International Design Registration N° DM/084120.

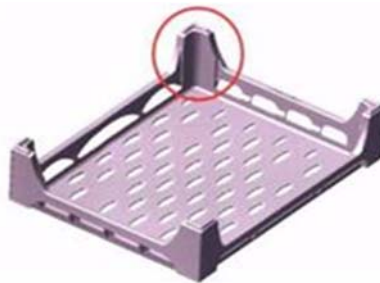
1.1



### 8.6.2.2 *Perimetric boundaries*

Perimetric boundaries are clear solid lines, drawn a particular contrasting colour, that surround and identify the part of the larger product that is claimed in the application and to which the industrial design relates.

The perimetric boundary lines should clearly separate the claimed and disclaimed parts of the product whose representation is filed. The parts of the representation that fall outside the boundary lines are to be regarded as having only an illustrative purpose of the context where the claimed part is embodied and should be disregarded by the examiner when evaluating the design. For example:<sup>84</sup>

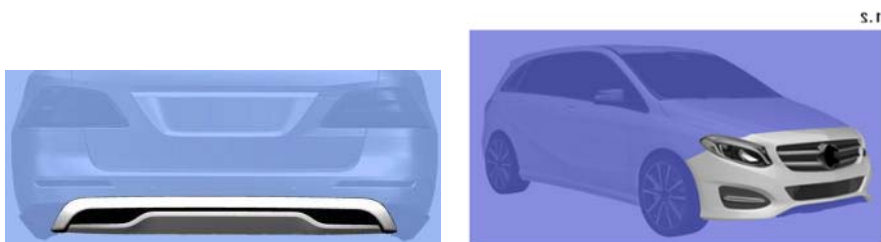


### 8.6.2.3 *Shading and blurring*

Where the application refers only to a part of a larger product, the applicant may choose to identify a design of that part by shading or blurring the parts that are not claimed. The representation would present a clear image of the claimed part and leave the disclaimed parts of the product covered by a shade or blurred so that they may be disregarded.

<sup>84</sup> Example taken from European Registered Community design (RCD) N° 164611-0004.

For example:<sup>85</sup>



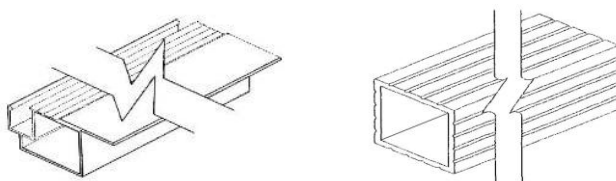
#### 8.6.2.4 Separations and cuts

A design may relate to parts of a larger product that are located only at one side or one end of that product. The design may also apply to a product of indeterminate length, such that the design applies to one or more features that occur along the full length of that product.

In these cases, the representation need not reproduce the entire length of the larger product. Instead, a separation or a cut may be drawn in the representation to indicate the omission of a part of the length of the product. This should be understood to mean that the omitted part does not add or detract to the design shown in the visible parts.

The length omitted in the representation should be assumed by the examiner to be a continuation of the visible part the design of which is claimed as shown in the representation, or a part of the product that is irrelevant to the part that embodies the claimed design.

For example:<sup>86</sup>



<sup>85</sup> Examples taken, respectively, from International Design Registrations DM/072764 and DM/083403.

<sup>86</sup> Examples taken from the Inspection Manual for the Application for Design Patents of Thailand, p. 30.

## 8.7 Description of views and explanatory text

The applicant may submit, together with the representation of the design in an application for registration, a *description* or *explanatory notes* in respect of one, some or all views of the representation of the design. The description or notes may serve to clarify the purpose or nature of some of the features where this would facilitate the examination of the application and dispel doubts about the representation submitted by the applicant.

The representation of each design should be *self-contained* and sufficient to represent faithfully the appearance of the design that will be registered. A description or explanatory notes to the representations may be required by some offices for the registration of an industrial design.<sup>87</sup>

A description must refer only to features of appearance that may be seen on the representations of the design. It should not refer to other possible or optional features that are not represented, nor discuss the novelty, functional or aesthetic value of the design.

A written description or explanatory notes cannot replace the representation of a design in an application for registration, and cannot remedy any deficiencies or insufficient clarity in the representation of the design.

## 8.8 Representation of repeating surface pattern designs

Where the design is a *repeating pattern* of surface appearance the representation should contain the full extent of the repeating elements of the pattern so as to disclose all the features that are repeated. For example:<sup>88</sup>



<sup>87</sup> Such as in Viet Nam.

<sup>88</sup> Example taken from International Design Registration No DM/086803.

Only the elements visible in the portion of the design that is reproduced in the application will be covered by the design registration.

The applicant may submit additional views of the pattern applied to a particular product, for illustration purposes. If it is not intended to claim the shape of the product bearing the pattern, this should be made clear by using one of the methods of disclaiming matter in the representation of the design, as mentioned in item 8.6.2 above.

## **8.9 Representation of designs with colours**

Where colour is an essential feature of the design, the design representation should be in colour.<sup>89</sup>

The representations of a design and the various views must be in either black and white or in colour. The application may not contain a combination of views where some are in black and white and some in colour. If such combination were submitted, the representation would be ambiguous and unclear, and the examiner should raise an objection.

Where a design is to be registered with a particular colour or set of colours, all the views of the design should have the same colour or colours in a consistent manner. If the colours change in the different views of the design, the examiner should object the representations for lack of consistency. In this case the application could be regarded as containing more than one design and treated as a multiple application.

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<sup>89</sup> However, under the laws of some ASEAN Member States (e.g. Malaysia) color cannot be claimed as a feature of industrial designs. See item 1.2.1.2, above.



## 9 Product indication

### 9.1 General matters

An indication of the product to which the design will be applied, namely the product that embodies the design, is an essential element of the registration of an industrial design.<sup>90</sup>

The product indication and its classification do not affect the scope of protection of a registered industrial design, unless the law provides otherwise.<sup>91</sup> The classification of industrial designs serves administrative purposes, mainly to structure the schedule of fees to be paid for industrial design registrations and to facilitate the search and retrieval of registered designs in search databases.

The application must indicate the product or products to which each design will be applied. The application can indicate one or more products to embody the designs in a multiple application, but the requirement of *unity of class* should be complied with (see item 10, below).

### 9.2 Classification of products that embody industrial designs

#### 9.2.1 Use of the International Classification

The indication of products must be sufficiently clear to allow the Office to classify the products that embody each design, or to validate the classification proposed by the applicant.

The classification of a product that embodies an industrial design should be done using the international classification of the Locarno Agreement establishing an International Classification for Industrial Designs (LCL).<sup>92</sup>

<sup>90</sup> See the provisions in BN DR r. 6(3)(a); KH DL art. 95; ID DL art. 11(4)(a), DR r. 1; LA IPL art. 32.4; MY ID Form 1 items 4 and 5; PH IP Code, s. 114.1(c), DR r. 1510(a); SG Form D3 part 4; TH DA s. 59(2), DR r. 18(2); VN IPR r. 33.5.a. Also the EUIPO Guidelines (Applications), item 6.1.4.

<sup>91</sup> For instance, in Viet Nam the scope of protection may be confined to the product indication.

<sup>92</sup> The list of classes and subclasses under the Locarno International classification with explanatory notes is available at [http://www.wipo.int/classifications/nivilo/pdf/eng/locarno/LOC\\_10e.pdf](http://www.wipo.int/classifications/nivilo/pdf/eng/locarno/LOC_10e.pdf)

The applicant should indicate the products that embody each design designating them by their usual specific name. The Office should encourage that – where possible – the indication be made using the terms of the *alphabetical list of products* drawn up under the Locarno International Classification (LCL).<sup>93</sup>

The use of the product names in the LCL alphabetical list of products will facilitate classifying the products indicated in an application as well as validating the classification proposed by the applicant. The use of broad terms such as those contained in the LCL class headings should not be encouraged as they could give rise to an objection for an insufficient or deficient product indication.

The examiner should validate or *provide a full classification* – i.e. the LCL class and subclass – for each product indicated in the application. If the product indication provided by the applicant is insufficient to classify the design, the examiner should classify the design by reference to the representations of the design in the application.

### **9.2.2 Correction of product indication**

If the products shown in the application are designated with names that are not included in the *alphabetical list of products* of the LCL, the examiner may propose *ex officio* to change or amend those indications and replace a term taken from the alphabetical list of products or from the relevant class or subclass heading that is of *equivalent* scope or *more general* (broader) scope. The examiner should not propose an indication that would appear to be narrower in scope than the term used in the application.

The product indications will appear on the registration of the industrial design and their use will provide the industrial design register with coherent product indication data. This in turn will facilitate future search and retrieval of registered design information.

If the design refers to a *part of a product*, the product indication should reflect that fact using the expression “(Part of –)” after the indication of the product to which that part belongs. For example, if the design is for the bezel (rim) of a wrist watch, the indication should be “Wrist watch (Part of –)” classified in class 10-02.<sup>94</sup>

<sup>93</sup> The alphabetical list of products under the Locarno International Classification is available at [http://www.wipo.int/classifications/nivilo/pdf/eng/locarno/LOC\\_10e.pdf](http://www.wipo.int/classifications/nivilo/pdf/eng/locarno/LOC_10e.pdf)

<sup>94</sup> In Viet Nam, the product indication should be the name of the part rather than the name of the overall product with the expression “(Part of –)”. The name of the part is more specific although it may not be in the LCL list of goods. For example, the

Likewise, if the design is for a set of products, the product indication for should include the word “Set”. For example, a design for a set of table linen should be indicated as “Table linen (Set of –)”. The examiner should amend or require the applicant to amend the indication to this effect, if necessary.

The same rule applies with regard to designs for an *ornamentation* product that is for use with another product. For instance, if the design is intended for ornamentation of “Carpets” the product indication should be “Carpets (Ornamentation for –)”, and the product classified in LCL class 32-00. However, if the application contains also a design for the carpets as they appear with the embodiment of the ornamentation, both products should be indicated and the examiner should assign a double classification for “Carpets” (LCL class 06-11) and ornamentation (LCL class 32-00).<sup>95</sup>

### **9.2.3 Objection to product indication**

If the examiner finds that the product indication given by the applicant or the representation of the design are insufficient to allow a proper product indication and classification of the design in a single class (saving the exception cases allowed for dual uses and ornamentation products), he should raise an objection and request the applicant to submit information about the nature and intended purpose of the design.

The examiner should raise an objection in cases where the product indication is *vague*, unclear or *ambiguous* and does not allow the product to be classified within a single LCL *subclass*.

If *no product indication* is provided and the information cannot be found in the description or explanatory notes to the representation or the views of the design, or in the relevant priority document, if any, the examiner should raise an objection and request the missing indication.

An obvious *discrepancy* or mismatch between the product indication and the representation of the design in the application should be treated as a case of omission of the product indication.

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product indication of a bottle cap should be “bottle **cap**” rather than “Bottle (Part of –)”.

<sup>95</sup> In Viet Nam, ornamentation is not accepted as industrial design. Therefore, in this example, the application must contain only design of the carpet, not the ornamentation for the carpet.

## 10 Multiple application and unity of design

### 10.1 General aspects

Applications for the registration of industrial designs may contain more than one design, and may be referred to as ‘*multiple applications*’.<sup>96</sup> Unless the law prescribes otherwise, the number of different designs in a multiple application is not limited. However, the number of designs will have a direct effect on the amount of fees to be paid for the application.

Applications may also refer to ‘*sets*’ of products.<sup>97</sup> Sets are defined as an ensemble of individual articles that are intended to be used together and that have common features that give them the same overall appearance. Regarding the representation of sets of products, see item 8.5.2, above.

In a multiple application each design should be examined individually for compliance with the applicable substantive grounds for refusal. If one or several designs do not comply with the applicable conditions for registration, the examiner should raise an objection in respect of those designs only. Likewise, if revocation, cancellation or invalidation is requested for one or several designs in a registration, the designs not affected by the petition should remain valid.

The Office should resolve the entire application, in respect of all the designs it contains, in the same decision, prescribing what designs are acceptable and which cannot be validly registered.

### 10.2 Standard of unity of design

A multiple application requires a standard of unity of design in order to avoid situations where the different designs contained in the application are totally

<sup>96</sup> See the provisions in BN DA, s. 15(6)(a), DR r. 16; KH DL art. 97; ID DL art. 13(b); LA IPL art. 32; MY DA, s. 15, DR r. 5(4); PH IP Code, s. 115, IP Rules r. 1515; SG DA s. 2(1) “article” (b), “set of articles”, DR r. 22; VN IPL art. 101.3, IPR r. 33.2. Also the EUIPO Guidelines (Applications), chapter 7.

<sup>97</sup> See the provisions in BN DA, s. 2(1) “set of articles”, 15(6)(a), DR r. 7(2), 16; KH DL art. 97; LA IPL art. 32; MY DA, s. 3(1) “set of articles”, 3(2)(a), 15; PH IP Code, s. 115, IP Rules r. 1515; SG DA s. 2(1) “article” (b) “set of articles” (c) non-physical product (d) set of non-physical products, DR r. 22; VN IPL art. 101.3.a, IPR r. 33.2.b and 33.5.e(v). Also the EUIPO Guidelines (Applications), items 5.2.3 and 6.1.4.4.

unrelated to each other. Such dissimilarity can make examination of the application particularly complicated.

As a matter of policy and administrative simplicity, the diversity of designs contained in a single design registration needs to be confined under specified criteria. Also, a standard of unity of design will allow a better structuring of fees by attaching fee payment to the design's belonging to a particular category. Designs that do not fall within that category may not be included in the same application.

The standard of unity of design is based on the classes of the International Classification of the *Locarno Agreement* establishing an International Classification for Industrial Designs.<sup>98</sup> The International Classification contains a list of 32 classes of all products that may embody industrial designs. The classes of products of the Locarno classification are fairly broad but each class is further divided into several *subclasses*, with the exception of the final classes 31 and 32.<sup>99</sup>

Under the standard of 'unity of class'<sup>100</sup>, an application containing several designs will comply with the requirement of unity of design if all the designs are embodied in products or articles that fall within the *same class* of the Locarno classification (LCL).

Where the law requires the applicant to specify the classification of the products that embody the designs contained in the application, the examiner should verify that the classification proposed is correct. Otherwise, the examiner himself should classify each of the designs in the application. In case of disagreement between the applicant and the Office, the Office's view should prevail.

The full classification should comprise one class and one subclass according to the LCL. In case of an article that has a *dual nature or use*, the design of the product should indicate the classifications for both uses of the article.

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<sup>98</sup> See the provisions in BN DA s. 15(6)(a), DR r. 6(3)(b) KH DL art. 97; ID DL art. 13(b), DR art. 3(1)(b), 12(5); LA IPL art. 32; MY DA, s. 15, DR r. 7; PH IP Code, s. 115, IP Rules r. 1515; SG DR r. 22 and 26; TH DR r.18(2). Also the EUIPO Guidelines (Applications), paragraphs 6.2.3 and 7.2.3.

<sup>99</sup> In Viet Nam, the standard of unity of design is not based on the classes of the International Classification of the Locarno Agreement. In fact, a multiple application will comply with the standard of unity of design if all the designs are embodied in the same product and they are not significantly different from each other. These designs are called variations.

<sup>100</sup> Viet Nam does not adopt the standard of "unity of class".

For example, the following article is both a clothes hanger and a floor lamp:



Clothes hanger and lamp<sup>101</sup>

The classification of each design should be made on the basis of the product indication and the representation of the corresponding design. If there is an inconsistency between the representation of the design and the indication of the product, the classification will not be possible. The examiner should raise an objection and require the applicant to clarify the product indication or delete the representation altogether.

A special case of possible double classification is allowed with respect to the products 'ornamentation', graphic symbols', logos' and surface patterns' that are classified in class 32 of the LCL. Those products can be produced and commercialized as independent products. However, 'ornamentation', graphic symbols', logos' and surface patterns' may be applied on other products and articles to give them a particular appearance by means of surface decoration, which in turn will be the design of those products. In this case, a multiple application may be accepted for both products with the corresponding double classification: one for the ornamentation or surface pattern (LCL class 32) and one for the product that embodies that ornamentation or pattern.

The products 'ornamentation', graphic symbols', logos' and surface patterns' may be combined in a multiple application with any other products. The examiner should disregard the indication for 'ornamentation', graphic symbols', logos' and surface patterns' for purposes of determining if there is unity of classification. The products in LCL class 32 should be taken as

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<sup>101</sup> Example taken from the Inspection Manual for the Application for Design Patents of Thailand, p. 75

neutral. The examination should determine whether the remaining products in the multiple application comply with the unity of class requirement.

For example, a multiple application could contain ten industrial designs that are applied to the following products:

Product indication	LCL class and subclass
Writing paper, cards for correspondence and announcements	19 - 01
Calendars	19 - 03
Books and other objects of similar outward appearance	19 - 04
Teaching materials	19 - 07
Surface patterns, ornamentation	32 - 00
Teaching materials (ornamentation for)	32 - 00
Writing paper (surface patterns for)	32 - 00

The first four products indicated belong to a single class of the LCL, class 19, so they comply with the requirement of unity of class. The other three products belong to LCL class 32 and are not taken into consideration to determine compliance with the unity-of-class requirement. In this example, the unity of class standard has been met.

If the application in the above example also included the following additional products, the unity of class would be broken and an objection should be raised:

Textile fabrics – class 5 – 05

Curtains – class 6 – 10

Textile fabrics (surface patterns for) – class 32

In this case, the products ‘Textile fabrics (*surface patterns for*)’ classified in LCL class 32 could be indicated together with the product ‘Textile fabrics’.

However, the products ‘Textile fabrics’ and ‘Curtains’ are classified in classes that are different from class 19. Consequently, the application would have products falling under three different classes and would not comply with the single class requirement.<sup>102</sup>

[ANNEX I follows]

<sup>102</sup> Classification in more than one class with respect to ornamentation, graphic symbols, logos and surface patterns is not the case in Viet Nam because these subject matters are not accepted as industrial designs.





**ANNEX**

**EXCERPTS OF LEGAL PROVISIONS OF THE ASEAN  
COUNTRIES RELEVANT TO THE EXAMINATION  
AND REGISTRATION OF INDUSTRIAL DESIGNS**



# ANNEX I

## EXCERPTS OF LEGAL PROVISIONS OF THE ASEAN COUNTRIES RELEVANT TO THE EXAMINATION AND REGISTRATION OF INDUSTRIAL DESIGNS

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## BRUNEI DARUSSALAM

### ***Emergency [Industrial Designs] Order, 1999***

2. (1) In this Order, unless the context otherwise requires—  
[...]

"article" means any article of manufacture and includes any part of an article if that part is made and sold separately;

"artistic work" shall be construed in accordance with section 6 of the Emergency (Copyright) Order, 1999, but does not include a layout design or an integrated circuit as respectively defined in section 2 of the Emergency [Layout Designs) Order, 1999;  
[...]

"corresponding industrial design", in relation to an artistic work, means an industrial design which if applied to an article would produce something which would be treated for the purposes of Part I of the Emergency (Copyright) Order, 1999 as a copy of that work;  
[...]

"designer", in relation to an industrial design, means the person who creates it or, if there are two or more such persons, each of those persons;  
[...]

"industrial design" means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include—

- (a) a method or principle of construction; or
  - (b) features of shape or configuration of an article which—
    - (i) are dictated solely by the function which the article has to perform; or
    - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part;
- [...]

"registered industrial design" means an industrial design registered under section 26;

"registered owner", in relation to a registered industrial – design, means the person whose name is entered in the Register as the owner of the industrial design or, if there are two or more such persons, each of those persons;  
[...]

"set of articles" means two or more articles of the same general character that are ordinarily on sale together or intended to be used together, to each of which the same industrial design, or the same industrial design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied;  
[...]

(2) Unless the context otherwise requires, any reference in this Order–  
[...]

(b) to an article in respect of which an industrial design is registered shall, in the case of an industrial design registered in respect of a set of articles, be construed as a reference to any article of that set:  
[...]

3. (1) This Order does not apply to computer programs and layout designs.

(2) Provision may be made by rules under section 77 for excluding from registration under this Order industrial designs for such articles of a primarily literary or artistic character as may be specified therein.

(3) In subsection (1)–

"computer program" means an expression, in any language, code or notation, of a set of instructions (whether with or without related information) intended, either directly or after either or both of the following–

- (a) the conversion to another language, code or notation;
- (b) the reproduction in a different material form, to cause a device having information-processing capabilities to perform a particular function;

"layout design" means the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections, of an integrated circuit [as defined in section 2 of the Emergency (Layout Designs Order, 1999)]; and includes such a three-dimensional disposition prepared for an integrated circuit intended for manufacture.

9. (1) Subject to this Order, an industrial design which is new may, upon application by the person claiming to be the owner, be registered in respect of any article or set of articles specified in the application.

(2) An industrial design for which an application for registration is made shall not be regarded as new if it is the same as–

- (a) an industrial design that has been registered in pursuance of a prior application filed or having effect in Brunei Darussalam, whether or not that industrial design has been registered in respect of the same article for which the application is made or in respect of any other article; or
- (b) an industrial design that has been disclosed in Brunei Darussalam or elsewhere before the filing date, whether or not it has been published in respect of the same article for which the application is made or in respect of any other article,

or if it differs from such an industrial design only in immaterial details or in features which are variants commonly used in the trade.

(3) The Registrar may, in such cases as may be prescribed, direct that for the purpose of deciding whether an industrial design is new an application for registration shall be treated as made on a date earlier or later than that on which it was in fact made.

10. An industrial design is not registrable in respect of an article if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the industrial design were to be applied to the article.

11. (1) Subject to subsection (2), an industrial design the publication or use of which would be contrary to public order or morality is not registrable.

(2) The publication or use of an industrial design shall not be considered to be contrary to public order merely because it is prohibited by any law in force in Brunei Darussalam.

12. (1) An application for the registration of an industrial design shall not be refused, and the registration of an industrial design shall not be invalidated by reason only of–

- (a) the disclosure of the industrial design by the owner within twelve months to any other person in such circumstances as would make



it contrary to good faith for that other person to use or publish the industrial design;

- (b) the disclosure of the industrial design in breach of good faith within twelve months by any person other than the owner of the industrial design;
  - (c) in the case of a new or original textile industrial design intended for registration, the acceptance of a first and confidential order for goods bearing the industrial design; or
  - (d) the communication of the industrial design by the owner within twelve months to a government department or to any person authorised by a government department to consider the merits of the industrial design, or of anything done in consequence of such a communication.
- (2) An application for the registration of an industrial design shall not be refused, and the registration of an industrial design shall not be invalidated by reason only—
- (a) that a representation of the industrial design, or any article to which the industrial design has been applied, has been displayed, with the consent of the owner of the industrial design at an official international exhibition;
  - (b) that after any such display as is mentioned in paragraph (a), and during the period of the exhibition, a representation of the industrial design, or any article to which the industrial design has been applied, has been displayed by any person without the consent of the owner; or
  - (c) that a representation of the industrial design has been published in consequence of any such display as is mentioned in paragraph (a),

if the application for registration of the industrial design is made not later than six months after the opening of the exhibition.

(3) In this section, "official international exhibition" means an official, or officially recognised, international exhibition falling within the terms of the Convention on International Exhibitions of 22nd. November, 1928 and any protocols to that Convention, or falling within the terms of any treaty replacing that Convention, as respectively revised or amended.

13. (1) Subject to subsection (2), where an application is made by or with the consent of the owner of copyright in an artistic work for the registration

of a corresponding industrial design, the industrial design shall not be treated for the purposes of this Order as being other than new by reason only of any use previously made of the artistic work.

(2) Subsection (1) does not apply if the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire, of articles to which had been applied industrially—

- (a) the industrial design in question; or
- (b) an industrial design differing from it only in immaterial details or in features which are variants commonly used in the trade, and that previous use was made by or with the consent of the copyright owner.

(3) Provision may be made by rules as to the circumstances in which an industrial design is to be regarded for the purpose of this section as applied industrially to articles or any description of articles.

14. (1) Where the registered owner of a design registered in respect of any article makes an application—

- (a) for registration in respect of one or more other articles, of the registered design; or
- (b) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially affect the identity thereof,

the application shall not be refused, and the registration made on the application shall not be invalidated, by reason only of the previous registration or publication of the registered design:

Provided that the right in a design registered by virtue of this section shall not extend beyond the end of the period and any extended period for which the right subsists in the original registered design.

(2) Where any person makes an application for the registration of a design in respect of any article and either—

- (a) the design has been previously registered by another person in respect of some other article; or
- (b) the design to which the application relates consists of a design previously registered by another person in respect of the same or

some other article with modifications or variations not sufficient to alter the character or substantially affect the identity thereof,

then, if at any time while the application is pending the applicant becomes the registered owner of the design previously registered, subsection (1) shall apply as if at the time of making the application the applicant had been the registered owner of that design.

15. (1) An application for registration of an industrial design shall be filed with the Registrar in the prescribed manner.

(2) The application shall include—

- (a) a request for registration of the industrial design;
- (b) a representation of the industrial design suitable for reproduction;
- (c) a statement that the industrial design is new;  
[...]

(6) Two or more industrial designs may be the subject of the same application for registration if the industrial designs—

- (a) relate to the same prescribed class of industrial designs or to the same set of articles; and
- (b) comply with any prescribed conditions.

25. (1) If an application for registration of an industrial design has been accorded a filing date under section 16 and has not been withdrawn, the Registrar shall examine the application to determine whether it complies with the requirements of this Order and with the formal requirements.

[...]

26. (1) If on an examination by the Registrar under section 25 an application for registration of an industrial design is found to have satisfied the formal requirements, then as soon as practicable after such examination but subject to section 27, the Registrar shall on payment of the prescribed fee—

- (a) register the industrial design by entering the prescribed particulars in the Register;
- (b) enter the name of the applicant, or the successor in title to the application, in the Register as the owner of the industrial design;

- (c) issue a certificate of registration to the person who is the registered owner of the industrial design at the time the industrial design is registered; and
- (d) advertise the fact of such registration and publish a representation of the industrial design by notice in the *Gazette*.

(2) Notwithstanding paragraph (d) of subsection (1), advertisement of the registration and publication of the industrial design shall, upon request by the applicant at the time of filing of the application or at any time before the date on which preparations for publication have been completed, be deferred for a period not exceeding twelve months from the date of filing or, if priority is claimed, from the date of priority of the application.

(3) Where a request has been made under subsection (2) for deferment of publication, upon registration of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection. In this case, the Registrar shall publish a mention of the deferment and information identifying the registered owner, indicating the filing date of the application, the length of the period for which deferment has been requested and any other prescribed particulars.

(4) At the expiry of the period of deferment, the Registrar shall publish the registered industrial design.  
[...]

27. (1) The Registrar may by notice in the prescribed manner, stating the reason for his refusal, refuse an application for registration of an industrial design if, after an examination by him under section 25 and after giving the applicant the opportunity to correct any deficiencies as provided for in that section, he determines—

- (a) that the application does not satisfy the formal requirements;
- (b) that, on the face of the application, the industrial design is not new or is not registrable for any other reason; or
- (c) the prescribed fee for the registration of the industrial design has not been paid.

(2) Where the Registrar refuses an application for registration of an industrial design under this section—

- (a) the applicant shall continue to enjoy the right of priority under section 18 which he enjoyed immediately before such refusal; and

- (b) no other right may be claimed under this Order in relation to the application.

28. Except as expressly provided to the contrary, nothing in this Order shall be construed as imposing any obligation upon the Registrar to consider or have regard to, for the purpose of determining whether to accept an application for registration of an industrial design, any question as to—

- (a) the registrability of the industrial design;
- (b) whether the applicant is entitled to any priority claimed in the application; or
- (c) whether the industrial design is properly represented in the application.

44. (1) Any person may at any time after an industrial design has been registered under this Order refer to the court for determination the question of whether, having regard to section 11, the industrial design is a registrable industrial design.

[...]

- (3) If the court determines that the industrial design is not a registrable industrial design under section 11, it shall order the registration of the industrial design to be revoked.

[...]

45. The court may, on application by any person, order the registration of an industrial design to be revoked on the ground that, at the time of its registration, the industrial design was not new or was not registrable for any other reason.

46. (1) Subject to subsections (2) and (3), the court may, on application by any person, order the registration of an industrial design to be revoked on the ground that the person whose name is entered in the Register as the owner of the industrial design is not entitled to be registered as the owner.

(2) An application under subsection (1) may be made only by a person found by the court on a reference under section 41 to be entitled to be registered as the owner of the industrial design.

(3) Where the reference under section 41 was commenced after the end of the period of two years beginning with the date of registration of the

industrial design, the court may not order the revocation of the registration of the industrial design under this section unless the applicant shows that the person whose name is entered in the Register as the owner of the industrial design knew at the time of its registration or of the registration of the transfer of the industrial design to him that he was not entitled to be registered as the owner.

### ***Industrial Designs Rules, 2000***

2. (1) In these Rules—

"Locarno Agreement" means the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on the 8th. October, 1968, as amended;

"statement of novelty" means a statement in accordance with rule 8;

"textile article" means textile and plastics piece goods, handkerchiefs, shawls and such other classes of articles of a similar character as the Registrar may decide, for which the protection under the Order is limited to features of pattern and ornament only.

[...]

4. There shall be excluded from registration under the Order industrial designs intended to be applied to any of the following articles—

- (a) works of sculpture (other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process);
- (b) wall plaques, medals and medallions;
- (c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greeting cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.

5. An industrial design is to be regarded for the purposes of section 13 as "applied industrially" if it has been applied—

- (a) to more than fifty articles which do not all together constitute a single set of articles; or

- (b) to articles manufactured in lengths or pieces, not being hand-made articles.

6. (1) An application for registration of an industrial design shall be made on the prescribed form.

(2) The application shall include the information and documents referred to in subsection (2) of section 14, that is—

- (a) a request for registration of the industrial design;
- (b) a representation of the industrial design suitable for reproduction, in accordance with rules 7 and 8;
- (c) the name and address of the applicant;
- (d) where the applicant is not the industrial designer, a statement explaining the applicant's rights in relation to the industrial design; and
- (e) an address in Brunei Darussalam for the service of documents.

(3) In addition, the application shall include—

- (a) a statement identifying the article or articles to which the industrial design is intended to be applied;
  - (b) a statement identifying the classification of the article or articles to which the industrial design is intended to be applied, according to the class and sub-class of the classifications established by the Locarno Agreement;
  - (c) six additional representations of the industrial design, in accordance with sub-rule (3) of rule 7;
  - (d) any statements or evidence required by rules 9, 10, 11, 12, 13 and 14, whichever are applicable;
- [...]

7. (1) The representation of the industrial design included with the application may be either a drawing or a photograph and shall be of a size of not more than 160 millimetres by 160 millimetres, and one side of the representation shall be not less than 30 millimetres.

(2) Where the application is made for the registration of an industrial design intended to be applied to a set of articles, the representation shall show the industrial design as applied to each different article included in the set.

(3) The application shall be accompanied by six additional representations of the industrial design corresponding exactly to the original.

8. (1) A statement describing the features of the industrial design which the applicant considers to be new shall appear on each representation of the industrial design filed under rules 6 and 7.

(2) The statement shall appear on the front of each representation except where the Registrar is satisfied that its appearance on the front is impracticable, in which case it shall appear in a place approved by the Registrar.

(3) The statement shall appear separately from any other statement appearing on the representation.

9. (1) Where an applicant wishes to claim that section 12 applies in relation to the application, the application shall include a statement to that effect in accordance with this rule.

(2) Except in the case referred to in sub-rule (3), the statement shall—

- (a) identify the provisions of section 12 on which the applicant relies; and
- (b) describe the circumstances of the disclosure of the industrial design, including any relevant dates.

(3) Where the disclosure of the industrial design relates to an official international exhibition, as defined in subsection (3) of section 12, the statement shall specify—

- (a) the name of the exhibition and the place where it was held;
  - (b) the opening date of the exhibition; and
  - (c) if the first disclosure of the industrial design did not take place on the opening date of the exhibition, the date of such first disclosure.
- [...]

12. Where a reproduction of the armorial bearings, insignia, orders of chivalry, decorations, emblems or flags of any country, city, town, place, society, body corporate, institution or person appears on an industrial



design, the application shall include evidence satisfactory to the Registrar that such official or other person as is entitled to give consent to the registration of the industrial design and to the use of the reproduction has given such consent.

13. Where the name or portrait of a living person appears on an industrial design, the application shall include evidence satisfactory to the Registrar that such person has consented to the registration of the industrial design and to the use of his name or portrait.

14. Where the name or portrait of a person who has recently died appears on an industrial design, the application shall include evidence satisfactory to the Registrar that the personal representative of such person has consented to the registration of the industrial design and to the use of the name or portrait.

15. Except where the Registrar requires, no specimens shall be filed.

16. Two or more industrial designs may be the subject of the same application for registration if the industrial designs relate to the same class of articles as classified in accordance with the classifications established by the Locarno Agreement or to the same set of articles.

24. For the purpose of the registration of industrial designs, articles shall be classified in accordance with the classifications established by the Locarno Agreement.

### ***Chapter 94 – Emblems and Names (Prevention of Improper Use) 20 of 1967, 3 of 1974 - Amended by S 128/80 S 163/81***

2. In this Act unless the context otherwise requires–  
[...]

“specified emblem” means any emblems, seal, flag, pennant, insignia, formation sign, ensign or coat of arms specified in Part I of the Schedule; “specified name” means any name specified in Part II of the Schedule and includes any abbreviation of any such name.

3. (1) Notwithstanding anything contained in any law for the time being in force, no person shall, except with the written permission of His Majesty the Sultan and Yang Di-Pertuan—

[...]

(c) use or continue to use any specified name or specified emblem, or any colourable imitation thereof, in the title of any patent, or in any trade mark or design;

[...]

4. Notwithstanding anything contained in any law for the time being in force, no competent authority shall—

(a) register any company, firm or other body or persons under any name; or

(b) register a trade mark or design which bears any emblem, name, photograph, drawing or other pictorial representation;

[...]

if the use of such name, emblem, photograph, drawing or pictorial representation would be in contravention of section 3.

## **SCHEDULE**

### **Part I – Emblems**

1. The standards, coats-of-arms and official seals of His Majesty the Sultan and Yang Di-Pertuan and Her Majesty the Raja Isteri.

2. The State Seal of Brunei Darussalam.

3. The Brunei Coat-of-Arms.

4. The emblem or official seal of the United Nations Organisation.

5. The Orders, Insignias, Medals, Badges and Decorations instituted by Statutes of His Majesty.

6. The Emblem or official seal of the International Criminal Police Organisation (Interpol).

7. The emblem, formation sign or ensign of the Administrative Service of Brunei Darussalam [...]

## Part II – Names

1. The name of His Majesty the Sultan and Yang Di-Pertuan.
2. The name of Her Majesty the Raja Isteri.
3. The name ICPO - Interpol or International Criminal Police Organisation (Interpol).

### ***Emergency [Copyright] Order, 1999***

2. (1) In this Order, unless the context otherwise requires–  
[...]

"architectural work of art", in paragraph (a) of the definition in this subsection of "artistic work", means any building or structure having an artistic character or design, in respect of such character or design, or any model for such building or structure, provided that any protection afforded by any law relating to copyright in force immediately before commencement was confined to such artistic character or design and did not extend to the process or methods of construction;

"article", in the context of an article in a periodical, includes an item of any description;

"artistic work"–

(a) in the First Schedule, includes works of painting, drawing, sculpture (including casts and models) and artistic craftsmanship, and architectural works of art, and engravings and photographs;

(b) elsewhere in this Order, shall be construed in accordance with section 6,

but does not include a layout design or an integrated circuit as respectively defined in section 2 of the Emergency (Layout Designs) Order, 1999;  
[...]

"sculpture" shall be construed in accordance with section 6;  
[...]

"typeface" includes an ornamental motif used in printing;  
[...]

3. (1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–

- (a) original literary, dramatic, musical or artistic works;  
[...]

6. In this Order–

"artistic work" means–

- (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality;
- (b) a work of architecture, being a building or a model for a building; or
- (c) a work of artistic craftsmanship; "building" includes any fixed structure, and a part of a building or fixed structure;

"graphic work" includes–

- (a) any painting, drawing, diagram, map, chart or plan; and
- (b) any engraving, etching, lithograph, woodcut or similar work;  
[...]

"sculpture" includes a cast or model made for purposes of sculpture.

55. (1) It is not an infringement of any copyright–

- (a) in a design document or model recording or embodying a design for anything other than an artistic work or a typeface, to make an article to the design or to copy an article made to the design;
- (b) to issue to the public, or include in a film, broadcast or cable programme service, anything the making of which was, under subsection (1), not an infringement of that copyright.

(2) In this section–

"design" means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration;

"design document" means any record of a design, whether in the form of a drawing, written description, photograph, data stored in a computer or otherwise.

## First Schedule

5. (1) Copyright shall not subsist under this Order in an artistic work made before such date as the Attorney General may by order determine, which at the time when it was made constituted a design capable of registration under any law relating to the registration of designs, and was used, or intended to be used, as a model or pattern to be multiplied by an industrial process.

(2) For this purpose, a design shall be deemed to be used as a model or pattern to be multiplied by an industrial process—

- (a) when it is reproduced or is intended to be reproduced on more than fifty single articles, unless all the articles in which the design is reproduced or is intended to be reproduced together form only a single set of articles; or
- (b) when it is to be applied to—
  - (i) printed paper hangings;
  - (ii) carpets, floor cloths or oil cloths, manufactured or sold in lengths or pieces;
  - (iii) textile piece goods, or textile goods manufactured or sold in lengths or pieces; or
  - (iv) lace, not made by hand.

(3) In sub-paragraph (2), "set of articles" means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

## CAMBODIA

### ***Law on Patents, Utility Model Certificates and Industrial Designs, January 22, 2003***

#### Article 89.

For the purposes of this Law, any composition of lines or colours or any three- dimensional form, or any material, whether or not associated with lines or colors, is deemed to be an industrial design, provided that such composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, and appeals to and is judged by the eye.

#### Article 90.

The protection under this Law does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

#### Article 91.

An industrial design is registrable if it is new.

#### Article 92.

An industrial design shall be considered as new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

For the purpose of the 1<sup>st</sup> paragraph of this Article, disclosure to the public of the industrial design shall not be taken into consideration:

- (i) if it occurred within twelve (12) months preceding the filling date or, where applicable, the priority date of the application;
- (ii) if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

Article 93.

Industrial designs that are contrary to public order or morality shall not be registrable.

Article 95.

The application for registration of an industrial design shall be filed with the Ministry in charge of industry and shall contain a request, drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used. It may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional. The application shall be subject to the payment of the prescribed application fee, as referred to in Article 130 of this Law.

Article 97.

Two or more industrial designs may be the subject of the same application, provided they relate to the same class of the International Classification or to the same set or composition of articles.

Article 102.

After according a filing date, the Registrar shall examine whether:  
[...]

- (iii) the industrial design complies with the requirements of Articles 89 to 90, Article 93 of this Law and the Regulations pertaining thereto.

Article 103.

Where the Registrar finds that the conditions referred to in Article 102 of this Law are fulfilled, he shall register the industrial design, publish a reference to the registration and shall proceed to issue to the applicant a certificate of registration of the industrial design; otherwise, he shall refuse the application.

Article 110.

Any interested person may request the competent Court to invalidate the registration of an industrial design.

Article 111.

The competent Court shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Section 1 and Section 2 of this Chapter is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title.

***Prakas (Declaration) on the Procedure for the Registration of Industrial Designs; Ministry of Industry, Mines and Energy N° 707 MIME.DIP.PRK***

**Rule 4. Classification of Industrial Designs**

The Registrar shall apply the International Classification of Industrial Design as adopted under the Locarno Agreement of October 08, 1968, and updated in its subsequent editions, for all purposes relating to the registration and publication of Industrial Design, as well as for the maintenance of classified search files.

**Rule 5. Application for Registration of Industrial Designs**

The application for registration of industrial design shall be accompanied as following:

1. Application for registration of industrial design contained a request, drawing, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used, as referred in Article 95 of the Law, shall be filed with the Registration Department and shall be subject to the payment of the prescribed application fee.

[...]

**Rule 6. Number, Size of Representation and Specimen**

Number and size of graphic and real representation shall be filed as following:

1. The application shall be accompanied by the following:
  - a. if the industrial design is two-dimensional, by four graphic representations or four drawings or tracings; or



- b. if the industrial design is three-dimensional, by four graphic representations or four drawings or tracings of each of the different sides of the industrial design; and
  - c. a printing block or printing blocks of such dimensions of which shall not exceed 17 centimeters x 26,2 centimeters.
2. A specimen shall be of a size not exceeding 20 centimeters x 20 centimeters x 20 centimeters. No graphic representation, drawing or tracing of the industrial design shall exceed 10 centimeters x 20 centimeters. Such representations, drawings or tracings, shall be affixed on four sheets of cardboard of A4 size. Drawings and tracings shall be in black ink.

#### **Rule 14. Examination as to Form**

[...]

1. The Registrar shall examine whether the application fulfills the requirements of Article 95 of the Law.

[...]

4. Where the Registrar finds that the conditions set out in Article 89, Article 90, Article 93, Article 95 and Article 96 and the Regulations pertaining thereto are not fulfilled, he shall invite the applicant, in writing, to file the required correction within two (2) months from the date of the invitation, together with the payment of the prescribed fee; if the applicant does not comply with the invitation to correct a deficiency, or where, despite corrections submitted by the applicant, the Registrar is of the opinion that the said conditions are not fulfilled, he shall reject the application and notify the applicant, in writing, stating the reasons.

[...]

#### ***Law on Copyrights and Related Rights, adopted by the National Assembly on January 21, 2003 and ratified by the Senate on February 13, 2003***

##### **Article 2**

In this law, the principal terms shall have the following meaning:

a. "Work" means a product in which thoughts or sentiment are expressed in a creative way, and which falls within the literary, scientific, artistic or musical domain;

[...]

Article 7

The following subject matters, in accordance with the contents of Article 3, are being protected under this law:

[...]

h. Works of painting, engraving, sculpture or other works of collages, or applied arts.

[...]

m. Products of collage work in handicraft, hand-made textile products or other clothing fashions.

## INDONESIA

### ***Law N° 31, regarding Industrial Designs, December 20, 2000***

#### Article 1

In this Law:

Industrial Design shall mean a creation on the shape, configuration, or the composition of lines or colours, or lines and colours, or the combination thereof in a three or two dimensional form which gives aesthetic impression and can be realized in a three or two dimensional pattern and used to produce a product, goods or an industrial commodity and a handy craft.  
[...]

#### Article 2

- (1) The right to Industrial Design shall be granted for an Industrial Design that is new.
- (2) An Industrial Design shall be deemed new if on the filing date such Industrial Design is not the same as any previous disclosures.
- (3) The previous disclosure as referred to in paragraph (2) shall be one which before:
  - the filing date; or
  - the priority date, if the application is filed with priority right

has been announced or used in Indonesia or outside Indonesia.

#### Article 3

An Industrial Design shall not be deemed to have been announced if within the period of 6 (six) months at the latest before the filing date, such Industrial Design

- a. has been displayed in a national or international exhibition in Indonesia or overseas that is official or deemed to be official; or
- b. has been used in Indonesia by the designer in an experiment for the purposes of education, research or development.

#### Article 4

The right to Industrial Design shall not be granted if an Industrial Design is contrary to the prevailing laws and regulation, public order, religion, or morality.

#### Article 11

[...]

The Application as referred to in paragraph (3) shall be furnished with:

a physical sample or drawing or photograph and the description of the Industrial Design being applied for registration;

[...]

#### Article 13

An Application can only be filed for:

- one Industrial Design, or
- several Industrial Designs that constitute a unity of an Industrial Design, or that have the same class.

#### Article 24

(1) The Directorate General shall conduct an examination on an application according to the provisions as provided for in the prevailing laws and regulation.

(2) The Directorate General shall notify the Applicant regarding the refusal of an application if the Industrial Design falls within the criteria in Article 4 or notify the assumption that the Application is deemed withdrawn for not complying with Article 20.

[...]

(4) Where the Applicant does not file any objection as referred to in paragraph (3), the decision on the refusal or the withdrawal by the Directorate General as referred to in paragraph (2) shall be permanent.

(5) Upon the decision on the refusal or withdrawal by the Directorate General, the applicant or his proxy can bring a lawsuit at the Commercial Court with the procedure as regulated in this Law.

## Article 26

- (1) Starting from the commencement of the announcement as referred to in Article 25 paragraph (1), any party may file an objection that include substantive matters in writing at the Directorate General with the payment of fee as regulated in this Law.  
[...]
- (5) Where there is an objection against an application as referred to in paragraph (1), the examiner shall conduct a substantive examination.
- (6) The Directorate General shall use the objection and the counter that had been submitted as material for consideration in examining whether to register or to refuse the application.  
[...]
- (8) The decision of the Directorate General as referred to in paragraph (7) shall be notified in writing to the applicant or his proxy at the latest 30 (thirty) days from the date of issue of the decision.

## Article 29

- (1) Where there is no objection against an Application until the termination of the announcement period as referred to in Article 26 paragraph (2), the Directorate General shall issue and grant a Certificate of Industrial Design at the latest 30 (thirty) days from the date of termination of the announcement period.  
[...]

## Article 38

- (1) A lawsuit on the cancellation of registration of an Industrial Design may be filed by any interested party on the grounds as referred to in Article 2 or Article 4 to the Commercial Court.  
[...]

## ***Regulation N° 1, 2005, regarding the Implementation of Law N° 31 of 2000 on Industrial Design***

### Article 1

In this Government Regulation the meaning of:

1. Industrial Design is a creation of shape, configuration, or composition of lines or colors, or lines and colors, or a combination thereof in the form of three-dimensional or two-dimensional provide aesthetic impression and can be realized in a pattern of three-dimensional or two-dimensional and can be used to produce a product, goods, industrial commodity or handicraft.

The description of Industrial Design is an explanation of the industrial design itself which includes a statement of the goods or products industrial designs and information matters or protection is sought in the form of information novelty.

Industrial Design is presenting the image in the form of two-dimensional images or three-dimensional appearance as complete as possible showing of all the parts that want to be protected.

## Article 2

- (1) Industrial Design rights granted for the new design.
- (2) Industrial design is considered new if on the filing date Industrial Design Application is not the same as the previous disclosures.
- (3) Previous disclosure, as referred to in paragraph (2) is the disclosure of which before:
  - a. Date of receipt of application; or
  - b. Priority date when the application is filed with the priority rights has been announced or used in Indonesia or outside Indonesia.

## Article 3

- (1) Applications may only be submitted for:
  - a. an Industrial Design; or
  - b. several industrial designs that constitute a unity, or that have the same class.
- (2) Industrial Design as referred to in paragraph (1) is an industrial design that meets the criteria referred to in Article 1 paragraph 1.

## Article 5

(1) Each application referred to in Article 4 shall be accompanied by:

- a. physical sample or drawing or photograph and description of the industrial design that can explain the industrial design being applied for registration for three copies;  
[...]

## Article 6

(1) Drawings or photographs referred to in Article 5 paragraph (1) letter a is as follows:

[...]

- b. any image or photograph contained in the A4 paper must be reproduced by photocopy or reproduction equipment *scanner* without reducing quality;

- c. each image must be accompanied by a caption [...] by including an image sequence number and explain the appearance of any image that is made in accordance with the position and angle of view images made to explain the disclosure of the industrial design which protection is sought;  
[...]

- f. drawings or photographs must be in accordance with the original sample;

- g. Industrial Design drawings can be created with a dotted line, if the part that made the dotted line is not requested protection, [...]; and

- h. Industrial Design drawings submitted in the application may be accompanied by a diskette containing the image data to simplify the process of announcement.

## Article 11

(1) Directorate General administrative checks referred to in Article 4 to Article 9 of the application that includes a physical examination, formality and clarity of disclosure requirements Industrial Design within a maximum period of 30 (thirty) days from the filing date of the Application.

[...]

(5) When the provisions referred to in paragraph (3) and paragraph (2) are not met, the Directorate General shall notify in writing to the applicant or his

proxy that his application is considered withdrawn within a maximum period of 14 (fourteen) days from the expiry of the time limit provisions of paragraphs (3) and (4).

[...]

## Article 12

(1) In the administrative inspection as referred to in Article 11 (1), the Directorate General shall notify the applicant or his proxy when there is lack of clarity in the description of the disclosure of the industrial design, photo or caption including those relating to union application within a period of thirty (30) days from the application filing date.

[...]

(5) At the time of examination of clarity, Examiner also perform classification for each application in accordance with applicable regulations.

## Article 13

(1) When the administrative checks referred to in Article 11 paragraph (1) there is more than one application, [...] the Directorate General shall notify in writing to the applicant or his proxy to break the application.

[...]

## Article 24

(1) In the event of objections to the application as referred to in Article 23, examiner checks matters relating to the clarity of disclosure of Industrial Design.

[...]

(3) Examination referred to in paragraph (2) conducted by Coroner:

a. researching and comparing the application by doing a search on the disclosure of an industrial design that has been there before for related classes.

b. examine and compare the application against the objections raised by the parties filed an objection; and

c. reported the results of the Directorate General.



- (4) Examination report referred to in paragraph (2) (c) includes:
- a. the novelty of the industrial design;
  - b. clarity of disclosure of Industrial Design.  
[...]

#### Article 26

(1) The Directorate General may refuse the application contrary to Article 2 of the Law, and disclose in writing to the applicant and attorney.

(2) The rejection of the application referred to in paragraph (1), the applicant may make improvements do not extend the scope of the industrial design [...].

#### Article 43

Industrial designs registered in the Directorate General may be canceled:  
[...]

b. based lawsuit registration of Industrial Designs by interested parties and has obtained court decision that has had permanent legal force that states the lawsuit is accepted.

### ***Law N° 19, 2002, Regarding Copyright***

#### Article 1

[...]

Work shall mean any result of works of an author, which shows originality in the field of science, arts and literature.

#### Article 12

In this Law, a work that is protected shall be the work in the field of science, arts and literature which includes:

[...]

f. all forms of art, such as paintings, drawings, engravings, calligraphy, carvings, sculptures, collage, and applied arts;

i. batik art;

[...]

## ***Guidelines – Substantive Examination of Industrial Design – 2015***

Available from the IP authorities of Indonesia.

## LAO PDR

### ***Law on Intellectual Property (Amended) N° 38/NA, 15 November 2017***

#### Article 3 (revised). Definitions

The terms as used in this law have the following meanings:

[...]

8. Industrial design means the form or shape of the product, which is to be created which includes the shape, pattern, line, color, etc;

[...]

14. Applied art means adaptations of art to be used for other purposes;

#### Article 15 (revised). Requirements for Obtaining an Industrial Design Certificate

Design eligible to obtain an industrial design certificate, shall meet all the following requirements:

1. shall be new: that it has not been disclosed to the public by publication or by use or displayed, or in any other means in the Lao PDR or any place in the world prior to the date of filing the application for registration or prior to the priority date of the application for registration;

2. shall be ornamental: that it gives a special appearance to the object to which the design is applied or in which it is embodied.

#### Article 22. Designs Ineligible for Industrial Designs Registration

Designs ineligible for industrial designs registration shall be as follows:

1. a design the appearance of which is dictated by technical features of the object to which the design is applied or in which it is embodied;

2. a designs that is contrary to social order and the fine traditions of the nation.

Article 32 (revised). Applications for Registration of Industrial Designs

Applications for registration of industrial designs shall include the following documents:

[...]

3. one or more drawings or photographs that clearly disclose the industrial design as needed to illustrate its appearance;

4. a brief statement of the type of goods to which the industrial design relates;

[...]

Each application for industrial design registration shall apply to a single industrial design or a series of related designs for a single class as per the international classifications.

[...]

Article 40 (revised). Substantive Examination of Industrial Property Applications

After completion of the formality examination of the application, the Ministry of Science and Technology will examine as to substance the invention, utility invention, industrial design, trademark and geographical indication applications for registration.

[...]

Article 41 (revised). Substantive Examination of Industrial Property Applications

[...]

The registration applications for industrial design, integrated circuit layout-design, trademark and geographical indication are not examined as to substance.

Article 42 (new). Amendment and division of the application

At any time an application is pending before the Ministry of Science and Technology but before it is in order for grant an applicant may amend or divide the application based on the following conditions:

[...]

2. upon payment of the application fees, divide the application into two or more divisional applications or re-file the application with or without amendments;  
[...]

An amendment as provided in item 1 of paragraph 1 of this Article shall not:  
[...]

2. change the essential appearance of an industrial design or the essential nature of a mark or geographical indication.  
[...]

#### Article 44 (revised). Registrations

After consideration and examination of the industrial property registration applications which are considered to fulfill the requirements provided for in this law, the Ministry of Science and Technology will issue a patent, petty patent or industrial property registration certificate, enter the registration in the registrar and publish the registration on the official industrial property gazette.

Where the registration has been done, the third party may request an objection or a cancellation or revocation of such registration within period of five years from the date of publication on the official industrial property gazette.

#### Article 45 (revised). Termination of Industrial Property Rights

Patents, petty patents, and industrial property registrations shall terminate as follows:  
[...]

3. the patent, petty patent, or registration is invalidated based on a finding that one or more requirements for protection have not been satisfied; where such finding applies to only a portion of the industrial property, the termination shall apply only to such portion as is invalidated. In such case, the invalidation shall be effective as from the grant of the patent, petty patent, or registration;  
[...]

### ***Industrial Designs Manual – October 2003***

Available from the IP authorities of Laos.

***Decision of the Minister of Science and Technology on the implementation of Law on Intellectual Property concerning Industrial Design, No. 755/MOST, 20 September 2012***

Available from the IP authorities of Laos.

## MALAYSIA

### ***Industrial Designs Act 1996, Act 552, Incorporated changes up to 1<sup>st</sup> July 2013***

3. (1) In this Act, unless the context otherwise requires —  
[...]

“article” means any article of manufacture or handicraft, and includes any part of such article or handicraft if that part is made and sold separately but does not include an integrated circuit or part of an integrated circuit within the meaning of the Layout-Designs of Integrated Circuits Act 2000 [Act 601], or a mask used to make such an integrated circuit;  
[...]

“industrial design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but does not include—

(a) a method or principle of construction; or

(b) features of shape or configuration of an article which—

(i) are dictated solely by the function which the article has to perform; or

(ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part;  
[...]

“set of articles” means a number of articles that are of the same general character and ordinarily on sale together, or intended to be used together, being articles to each of which there is applied an industrial design that is the same as, or which differs only in immaterial details or in features commonly used in the relevant trade from, the industrial design applied to the other articles or to any of them;  
[...]

(2) A reference in this Act to an article shall be read as including a reference to—

(a) a set of articles;

(b) each article in a set of articles; and

(c) both a set of articles and each article in that set, as the case requires.

12. (1) Subject to this Act, an industrial design shall not be registered unless it is new.

(2) An industrial design for which an application for registration is made shall not be considered to be new if, before the priority date of that application, it or an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade—

(a) was disclosed to the public anywhere in Malaysia or elsewhere; or

(b) was the subject matter of another application for registration of an industrial design filed in Malaysia but having an earlier priority date made by a different applicant in so far as that subject matter was included in a registration granted on the basis of that other application.

(3) For the purposes of paragraph (2)(a), an industrial design shall not be deemed to have been disclosed to the public solely by reason of the fact that, within the period of six months preceding the filing date of an application for registration—

(a) it appeared in an official or officially recognized exhibition; or

(b) it has been disclosed by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person or another person.

13. Industrial designs that are contrary to public order or morality shall not be registrable.

14. (1) An application for the registration of an industrial design—

(a) shall be made in the prescribed form and shall be filed at the Industrial Designs Registration Office;

(b) shall be accompanied by the prescribed number of representations of the article to which the industrial design is applied;

(c) shall contain a statement of novelty in respect of the industrial design to which the application relates; and  
[...]



15. Two or more industrial designs may be the subject of the same application, provided they relate to the same class of the International Classification for Industrial Designs or to the same set or composition of articles.

20. (1) Where a request for amendment under Section 19 has been granted, and the amendment has the effect of excluding one or more industrial designs from the initial application, the applicant may at any time during the pendency of the initial application make a further application, referred to in this section as a “divisional application”, for registration of the industrial design or designs so excluded.

(2) A divisional application shall be entitled to the priority date of the initial application

21. (1) Where an application for the registration of an industrial design has been accorded a filing date and the application is not withdrawn, the Registrar shall cause the application to be examined to determine whether it complies with the formal requirements.

[...]

22. (1) Where the Registrar is satisfied that an application for the registration of an industrial design complies with the requirements of section 21, he shall—

(a) register the industrial design by recording the prescribed particulars in the Register; and

(b) issue to the applicant a certificate of registration of the industrial design in the prescribed form.

[...]

(3) The certificate of registration shall be *prima facie* evidence of the facts stated therein and of the validity of the registration.

23. (1) Where an industrial design has been registered in respect of any article and the owner thereof makes an application—

(a) for registration, in respect of one or more other articles, of the registered industrial design; or

(b) for registration, in respect of the same or one or more other articles, of an industrial design consisting of the registered industrial design with

modifications or variations not sufficient to alter the character or substantially to affect the identify thereof,

the application shall not be refused, and the registration made on that application shall not be invalidated by reason only of the previous registration, or of any disclosure or use after the priority date in respect of the application for the previous registration, of the industrial design registered on that application.

[...]

24. (1) Subject to the provisions of this Act—

(a) the Court may, on the application in the prescribed manner, of any person aggrieved by or interested in the non-inclusion in or omission from the Register of any entry, or by or in any entry made in the Register without sufficient cause, or any entry wrongfully remaining in the Register, or any error or defect in any entry in the Register, make such order for including, making, expunging or varying any such entry or for the correcting of any such error or defect as it deems fit;

[...]

(c) in case of fraud in the registration, assignment or transmission of a registered industrial design or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;

[...]

27. (1) At any time after the registration of an industrial design, any person may apply to the Court—

(a) for the revocation of the registration of the industrial design on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design;

(b) for the cancellation of the registration of the industrial design on the ground that the registration of the industrial design has been procured by unlawful means; or

(c) for the grant of a compulsory licence in respect of the industrial design on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case, and the Court may make such order on the application as it considers just.

(2) Paragraphs (1)(a) and (1)(b) shall be without prejudice to the right of the owner of an industrial design to request the Registrar for the revocation of a registered industrial design of which he is owner, or to the power of the Registrar to order the revocation of the registration of an industrial design on any other ground as he thinks fit.

### ***Industrial Designs Regulations 1999, P.U.(A) 182, with changes up to 1 July 2013***

Regulation 5. Application for registration of an industrial design.

[...]

(4) Where pursuant to section 15, two or more industrial designs are the subject of the same application, the applicant shall specify the number of designs and pay the prescribed additional fees.

Regulation 7. Classification.

The application shall indicate a class and subclass in accordance with the International Classification for Industrial Designs.

Regulation 10. Size, etc. of documents.

[...]

(2) Representations shall be filed in one copy.

(3) Where representations consist of specimens, the specimens shall be of a size not exceeding 20cm x 20cm x 20cm.

(4) The Registrar may require the specimens to be replaced by representations comprising of drawings, or photographs.

(5) The photographs and drawings shall be of a size of 12.5 cm x 9 cm.

(6) In an application where words, letters or numerals appear in an industrial design, the Registrar may require that a disclaimer of any right to their exclusive use shall appear on each representation.

Regulation 11. Numbering of industrial designs.

- (1) Each industrial design contained in an application shall be given a number.
- (2) The numbering shall appear in the margin next to each representation.
- (3) When the same article is represented on the representation from different angles, the numbering shall consist of two separate figures separated by a dot.
- (4) Each industrial design included in a multiple application shall be shown by a different number.

Regulation 15. Representation which consists of a repeating surface pattern.

Each representation of an industrial design which consists of a repeating surface pattern shall show a complete pattern and a sufficient portion of the repeat in length and width, and shall be of a size not less than 18cm x 13cm.

Regulation 16. Consent to registration

- (1) Where a portrait of Seri Paduka Baginda Yang di-Pertuan Agong or, Ruler of a State, or the reproduction of the armorial bearings, insignia, orders of chivalry. Decorations of flags of any country, state, city, town, society, body corporate, institution or persons appears on an industrial design, the Registrar shall consider whether to refuse to accept an application for the registration of the industrial design unless a consent to the registration and use of such portrait or reproduction from such official or other person as appears to the Registrar to be entitled to give consent is filed.  
[...]

Regulation 19. Formal requirements and examination.

- (1) For the purposes of subsection 21(5) the requirements of regulations 3 to 14 shall be designated as formal requirements.
- (2) Where the Registrar determines that the application does not satisfy any of the formal requirements, the Registrar shall notify the applicant in writing and give him an opportunity to make observations on such finding and amend the application within three months from the date of the notification.

(3) If within the specified period, the applicant fails to satisfy the Registrar that the formal requirements have been complied with, or to amend the application so as to comply with the requirements the Registrar may refuse the application or, in the case of a multiple application, exclude from the registration any industrial design in respect of which the requirements have not been complied with.

[...]

Regulation 27. Application for rectification or request for revocation.

(1) An application to the Registrar for rectification of the Register pursuant to subsection 24(3) or a request for revocation of registration of the industrial design under subsection 27(2) shall be made on ID Form 6 accompanied by the prescribed fee and a statement setting out fully the applicant's interest and the facts upon which he relies.

[...]

Regulation 28. Application to Court.

(1) An application to the Court under paragraph 24(1)(a), subsection 24(3) or paragraph 27(1) (a), (b) or (c) may be made by notice of motion.

[...]

### ***Copyright Act 1987, Act 332, A1420, incorporated changes up to 1 March 2012***

Section 3. Interpretation.

In this Act, unless the context otherwise requires—

[...]

"artistic work" means (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality; (b) a work of architecture being a building or a model for a building; or (c) a work of artistic craftsmanship, but does not include a layout-design within the meaning of the Layout-Designs of Integrated Circuits Act 2000 [Act 601];

[...]

"graphic work" includes—

(a) any painting, drawing, diagram, map, chart or plan; and

(b) any engraving, etching, lithograph, woodcut or similar work;

[...]

Section 7. Works eligible for copyright.

(1) Subject to this section, the following works shall be eligible for copyright:  
[...]

(c) artistic works;  
[...]

(2A) Copyright protection shall not extend to any idea, procedure, method of operation or mathematical concept as such.

(3) A literary, musical or artistic work shall not be eligible for copyright unless—

(a) sufficient effort has been expended to make the work original in character; and

(b) the work has been written down, recorded or otherwise reduced to material form.  
[...]

(5) Copyright shall not subsist under this Act in any design which is registered under any written law relating to industrial design.  
[...]

(7) For the purpose of this section, "any written law relating to industrial design" includes:

(a) the United Kingdom Designs (Protection) Act 1949 [*Act 214*];

(b) the United Kingdom Designs (Protection) Ordinance of Sabah [*Sabah Cap. 152*]; and

(c) the Designs (United Kingdom) Ordinance of Sarawak [*Swk. Cap 59*].

Section 13A. Design documents and models.

(1) It shall not be an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface—

(a) to make an article to the design, or to copy or to reproduce an article made to the design; or

(b) to issue to the public, or include in a film, broadcast or cable programme service, anything the making of which was, by virtue of paragraph (a), not an infringement of that copyright.

(2) In this section –

"design" means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration; and

"design document" means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise.

## MYANMAR

NOTE: The trademark legislation of Myanmar is in the process of adoption by the competent authorities and was pending enactment at the time of conclusion of these Guidelines.



## PHILIPPINES

***REPUBLIC ACT N<sup>o</sup>. 8293 – an Act prescribing the Intellectual Property Code and establishing the Intellectual Property Office, providing for its powers and functions, and for other purposes, 1997, as amended by REPUBLIC ACT N<sup>o</sup>. 9150, an Act Providing for the Protection of Layout-Designs (Topographies) of Integrated Circuits***

### SEC. 112. Definition of Industrial Design

112.1. An *Industrial Design* is any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors: *Provided*, that such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft;

112.2. *Integrated Circuit* means a product, in its final form, or an intermediate form, in which the elements, at least one of which is an active element and some or all of the interconnections are integrally formed in and/or on a piece of material, and which is intended to perform an electronic function; and

112.3. *Layout-Design* is synonymous with 'Topography' and means the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture."

### SEC. 113. Substantive Conditions for Protection

113.1. Only industrial designs that are new or original shall benefit from protection under this Act.

113.2. Industrial designs dictated essentially by technical or functional considerations to obtain a technical result or those that are contrary to public order, health or morals shall not be protected.

113.3. Only layout -designs of integrated circuits that are original shall benefit from protection under this Act. A layout-design shall be considered original if it is the result of its creator's own intellectual effort and is not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation.

113.4. A layout-design consisting of a combination of elements and interconnections that are commonplace shall be protected only if the combination, taken as a whole, is original.

#### SEC. 114. Contents of the Application

114.1. Every application for registration of an industrial design shall contain:  
[...]

(c) An indication of the kind of article of manufacture or handicraft to which the industrial design or layout-design shall be applied;

(d) A representation of the article of manufacture or handicraft by way of drawings, photographs or adequate graphic representation of the industrial design or of the layout-design as applied to the article of manufacture or handicraft which clearly and fully discloses those features for which protection is claimed; and

(e) The name and address of the creator, or where the applicant is not the creator, a statement indicating the origin of the right to the industrial design or layout-design registration.

114.2. The application may be accompanied by a specimen of the article embodying the industrial design or layout-design and shall be subject to the payment of the prescribed fee."

#### SEC. 115. Several Industrial Designs in One Application

Two (2) or more industrial designs may be the subject of the same application: Provided, that they relate to the same sub-class of the International Classification or to the same set or composition of articles.

#### SEC. 116. Examination

116.1. The Office shall accord as the filing date the date of receipt of the application containing indications allowing the identity of the applicant to be established and a representation of the article embodying the industrial design or the layout -design or a pictorial representation thereof.

116.2. If the application does not meet these requirements, the filing date should be that date when all the elements specified in Sec. 114

are filed or the mistakes corrected. Otherwise, if the requirements are not complied within the prescribed period, the application shall be considered withdrawn.

116.3. After the application has been accorded a filing date and the required fees paid on time, the applicant shall comply with the requirements of Sec. 114 within the prescribed period, otherwise the application shall be considered withdrawn.

116.4. The Office shall examine whether the industrial design or layout-design complies with requirements of Sec. 112 (Definitions) and Sec. 113 (Substantive Conditions for Protection)."

#### SEC. 117. Registration

117.1. Where the Office finds that the conditions referred to in Sec. 113 are fulfilled, it shall order that registration be effected in the industrial design or layout-design register and cause the issuance of an industrial design or layout-design certificate of registration; otherwise, it shall refuse the application.

117.2. The form and contents of an industrial design or layout-design certificate shall be established by the Registrations: *Provided*, That the name and address of the creator shall be mentioned in every case.

117.3. Registration shall be published in the form and within the period fixed by the Regulations.

117.4. The Office shall record in the register any change in the identity of the proprietor of the industrial design or layout design or his representative, if proof thereof is furnished to it. A fee shall be paid, with the request to record the change in the identity of the proprietor, if the fee is not paid, the request shall be deemed not to have been filed. In such case, the former proprietor and the former representative shall remain subject to the rights and obligations as provided in this Act.

117.5. Anyone may inspect the Register and the files of registered industrial designs or layout-designs including files of cancellation proceedings."

**SEC. 118. *The Term of Industrial Design or Layout-Design Registration.***

118.1. The registration of an industrial design shall be for a period of five (5) years from the filing date of the application.

118.2. The registration of an industrial design may be renewed for not more than two (2) consecutive periods of five (5) years each, by paying the renewal fee.

118.3. The renewal fee shall be paid within twelve (12) months preceding the expiration of the period of registration. However, a grace period of six (6) months shall be granted for payment of the fees after such expiration, upon payment of a surcharge.

118.4. The Regulations shall fix the amount of renewal fee, the surcharge and other requirements regarding the recording of renewals of registration.

118.5. Registration of a layout-design shall be valid for a period often (10) years, without renewal, and such validity to be counted from the date of commencement of the protection accorded to the layout-design. The protection of a layout-design under this Act shall commence:

a) on the date of the first commercial exploitation, anywhere in the world, of the layout-design by or with the consent of the right holder: *Provided*, that an application for registration is filed with the Intellectual Property Office within two (2) years from such date of first commercial exploitation; or

b) on the filing date accorded to the application for the registration of the layout-design if the layout-design has not been previously exploited commercially anywhere in the world."

**SEC. 119. *Application of Other Sections and Chapters.***

119.1. The following provisions relating to patents shall apply *mutatis mutandis* to an industrial design registration.

Section 23 – Novelty;

An invention shall not be considered new if it forms part of a prior art.

Section 24 – Prior art; Provided, That the disclosure is contained in printed documents or in any tangible form;

Prior art shall consist of:

24.1. Everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the application claiming the invention; and

24.2. The whole contents of an application for a patent, utility model, or industrial design registration, published in accordance with this Act, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application:

Provided, That the application which has validly claimed the filing date of an earlier application under Section 31 of this Act, shall be prior art with effect as of the filing date of such earlier application:

Provided further, that the applicant or the inventor identified in both applications are not one and the same. (Sec. 9, R.A. No. 165a)

Section 25 – Non-prejudicial Disclosure;

25.1. The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

- (a) The inventor;
- (b) A patent office and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the office, or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor; or
- (c) A third party which obtained the information directly or indirectly from the inventor.

119.2. If the essential elements of an industrial design which is the subject of an application have been obtained from the creation of another person without his consent, protection under this Chapter cannot be invoked against the injured party.

119.3. The following provisions relating to patents shall apply *mutatis mutandis* to a layout-design of integrated circuits registration:

Section 28 – Right to a Patent;

Section 29 – First to File Rule;

Section 30 – Inventions Created Pursuant to a Commission;

Section 33 – Appointment of Agent or Representative;

Section 56 – Surrender of Patent;

Section 57 – Correction of Mistakes of the Office;

Section 58 – Correction of Mistakes in the Application;

Section 59 – Changes in Patents;

Section 60 – Form and Publication of Amendment;

CHAPTER VII – Remedies of a Person with a Right to Patent;

CHAPTER VIII – Rights of Patentees and Infringement of Patents: *Provided*, that the layout-design rights and limitation of layout-design rights provided hereunder shall govern:

CHAPTER X – Compulsory Licensing;

CHAPTER XI – Assignment and Transmission of Rights

119.4. *Rights Conferred to the Owner of a Layout-Design Registration.* The owner of a layout-design registration shall enjoy the following rights:

1) to reproduce, whether by incorporation in an integrated circuit or otherwise, the registered layout-design in its entirety or any part thereof,

except the act of reproducing any part that does not comply with the requirement of originality; and

2) to sell or otherwise distribute for commercial purposes the registered layout design, an article or an integrated circuit in which the registered layout-design is incorporated.

119.5. *Limitations of Layout Rights.* The owner of a layout design has no right to prevent third parties from reproducing, selling or otherwise distributing for commercial purposes the registered layout-design in the following circumstances:

1) Reproduction of the registered layout-design for private purposes or for the sole purpose of evaluation, analysis, research or teaching;

2) Where the act is performed in respect of a layout-design created on the basis of such analysis or evaluation and which is itself original in the meaning as provided herein;

3) Where the act is performed in respect of a registered lay-out-design, or in respect of an integrated circuit in which such a layout-design is incorporated, that has been put on the market by or with the consent of the right holder;

4) In respect of an integrated circuit where the person performing or ordering such an act did not know and had no reasonable ground to know when acquiring the integrated circuit or the article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout-design: *Provided, however,* that after the time that such person has received sufficient notice that the layout-design was unlawfully reproduced, that person may perform any of the said acts only with respect to the stock on hand or ordered before such time and shall be liable to pay to the right holder a sum equivalent to at least 5% of net sales or such other reasonable royalty as would be payable under a freely negotiated license in respect of such layout-design; or

5) Where the act is performed in respect of an identical layout-design which is original and has been created independently by a third party."

## SEC. 120. Cancellation of Design Registration

120.1. At any time during the term of the industrial design registration, any person upon payment of the required fee, may petition the Director of Legal Affairs to cancel the industrial design on any of the following grounds:

- a) If the subject matter of the industrial design is not registerable within the terms of Sections 112 and 113;
- b) If the subject matter is not new; or
- c) If the subject matter of the industrial design extends beyond the content of the application as originally filed.

120.2. Where the grounds for cancellation relate to a part of the industrial design, cancellation may be effected to such extent only. The restriction may be effected in the form of an alteration of the effected features of the design.

120.3. *Grounds for Cancellation of Layout-Design of Integrated Circuits.* Any interested person may petition that the registration of a layout-design be cancelled on the ground that:

- (i) the layout-design is not protectable under this Act;
- (ii) the right holder is not entitled to protection under this Act; or
- (iii) where the application for registration of the layout-design, was not filed within two (2) years from its first commercial exploitation anywhere in the world.

Where the grounds for cancellation are established with respect only to a part of the layout-design, only the corresponding part of the registration shall be cancelled.

Any cancelled layout-design registration or part thereof, shall be regarded as null and void from the beginning and may be expunged from the records of the Intellectual Property Office. Reference to all cancelled layout-design registration shall be published in the IPO Gazette.

## SEC. 171. Definitions

For the purpose of this Act, the following terms have the following meaning:

171.10. A "work of applied art" is an artistic creation with utilitarian functions or incorporated in a useful article, whether made by hand or produced on an industrial scale;

[...]



## SEC. 172. Literary and Artistic Works

172.1. Literary and artistic works, hereinafter referred to as "works", are original intellectual creations in the literary and artistic domain protected from the moment of their creation and shall include in particular:

[...]

Original ornamental designs or models for articles of manufacture, whether or not registrable as an industrial design, and other works of applied art;

[...]

172.2. Works are protected by the sole fact of their creation, irrespective of their mode or form of expression, as well as of their content, quality and purpose. (Sec. 2, P.D. No. 49a)

***The Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs, 20 April 2011***

**Rule 1500. *Industrial Design.*** An industrial design is any composition of shape, lines, colors, or a combination thereof, or any three-dimensional form, whether or not associated with shape, lines, or colors, which produce an aesthetic and ornamental effect in their *tout ensemble* or when taken as a whole; Provided, that such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft.

Industrial products include articles of manufacture that belong to the useful or practical art, or any part including thereof, which can be made and sold separately.

**Rule 1501. *Non-registrable Industrial Design.*** The following industrial designs shall not be registrable:

- (a) Industrial designs that are dictated essentially by technical or functional considerations to obtain a technical result;
- (b) Industrial designs which are mere schemes of surface ornamentations existing separately from the industrial product or handicraft; and
- (c) Industrial designs which are contrary to public order, health, or morals.

**Rule 1502. *Requisites for Registrability of Industrial Design.*** In order to be registrable, an industrial design must be a new or original creation.

**Rule 1503. *Degree of Novelty Required.*** The standard of novelty established by Section 23 (Novelty) and Section 25 (Non-prejudicial Disclosure) of the IP Code applies to industrial designs; Provided, that the period of twelve (12) months specified in Section 25 regarding non-prejudicial disclosure shall be six (6) months in the case of designs.

An industrial design shall not be considered new if it differs from prior designs only in minor respects that can be mistaken as such prior designs by an ordinary observer.

**Rule 1505. *Registration of Industrial Design.*** The Office shall adopt an expeditious registration process for industrial design. All applications for industrial design shall be registered without substantive examination provided all required fees, including fees for publication are paid and all formal requirements set forth in these Regulations are complied with. However, applicants may wish to request for a registrability report in accordance with Rules 1901-1903 before enforcing their rights to benefit from the determination on the novelty or originality of the design by the Office.

**Rule 1506. *Formality Examination of Industrial Design Application.*** The Office shall conduct a formality examination of the application and a report thereon shall be transmitted to the applicant.

The application shall be evaluated taking into consideration the formality requirements stated in these Regulations, such as:

(a) It is one of those falling under the non-registrable industrial designs;  
[...]

**Rule 1510. *The Industrial Design Application.***

[...]

The application shall contain the following:  
[...]

(b) A description containing the following:

- (1) Title;
- (2) Brief description of the different views of the drawings;

- (3) Characteristic-feature description of the design; and
- (4) Claim.

(c) Drawings of the different views of the design showing the complete appearance thereof including the signature of the applicant or representative. The Bureau may also accept photographs or other adequate graphic representation of the design provided the same comply with the requirements of these Regulations regarding drawings of industrial designs.

**Rule 1513.** *Special Form of Description for Application for Registration of Industrial Design.* The application for registration of an industrial design shall include a description containing the following matters, arranged in the order hereunder shown:

[...]

- (b) Detailed description of the several views or figures of the formal drawings;
  - (c) Statement of the characteristic features of the design, if required; and
  - (d) Claim.
- [...]

**Rule 1513.2.** *Brief Description of the Several Views of the Drawings.* Every view of the drawing should be briefly described, i.e. perspective, front, side, top, bottom, or back, and given corresponding figure numbers.

**Rule 1513.3.** *Characteristic Feature.* A characteristic feature statement describing the particular novel and ornamental features of the claimed design which are considered to be dominant, if required.

**Rule 1513.4.** *Claim.* The claim shall be in formal terms of the ornamental design for the article (specifying name) substantially as shown and described. More than one claim is neither required nor permitted.

**Rule 1514.** *Special Requirements for the Drawing of an Industrial Design.* In addition to the drawings being made in conformity with the common rules stipulated in these Regulations for drawings of utility models and industrial designs, the drawings for an industrial design must comprise a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shadings must be used to show character or contour of the surfaces represented.

The applicant may submit photographs of the design in lieu of the required format of the drawings as specified by these Regulations; Provided, that the

photographs are printed on the paper prescribed by these Regulations, with figure numbers shown in black ink on the paper proximate the corresponding photograph.

Where color is a material feature of the industrial design as used or intended to be used, the color or colors employed may be actually reproduced in the drawings. Otherwise, a statement must be made giving the name or names of the color or colors claimed indicating the principal part or parts of the article which is in such color or colors.

**Rule 1514.1.** *Requirements for Graphic Representation of Industrial Designs.* Graphic representation of industrial designs such as computer-aided drawings (CAD) in lieu of the India ink drawings may be accepted; [...]

**Rule 1514.2.** *Use of Broken Lines in the Design Drawings.* Unclaimed environmental structure in the drawing disclosure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be indicated adequately by a reasonable concise title or statement in the description. Such showing by broken lines should not be executed in a manner as to obscure or confuse the appearance of the claimed design. In general, when such broken lines are used, they should not intrude upon or cross the showing of the claimed design and should not be of heavier weight than the lines used in depicting the claimed design. Where a broken line showing the environmental structure must necessarily cross or intrude upon the representation of the claimed design, such an illustration should be included as a separate figure in addition to the other figures which disclose fully the subject matter for which the design protection is sought.

**Rule 1515.** *Several Industrial Designs in One Application.* More than one embodiment of an industrial design in one application may be permissible in a proper case. A number of articles presented should not be patently distinct from each other, and they should be of substantially similar dominant design features that are embodied in a single design concept. They must relate to the same subclass of the International Classification or to the same set or composition of articles. A “set of articles” which is customarily sold or used together as a set may be made a proper subject matter in one application for design registration, provided that each article is of, or has, the same design or a substantially similar design.

Where two or more articles are used together as a set of articles, the design of the set of articles may acquire design registration, provided that the set of articles constitutes a coordinated whole.

**Rule 1516. Restriction; Division.** A restriction or division of multiple design embodiments may be deemed proper if two or more independent or distinct designs are presented in one design application for registration.  
[...]

**Rule 1600. Novelty; Prior Art.** The provisions on “Novelty” and “Prior Art” as provided for in Part 2, Rules 203, 204 and 204.1 of the Regulations for Patents shall apply, *mutatis mutandis*, to utility models or industrial designs.

**Rule 203. Novelty.** An invention shall not be considered new if it forms part of a prior art (Sec. 23, IP Code).

**Rule 204. Prior Art.** Prior art shall consist of:

(a) Everything made available to the public anywhere in the world by means of a written or oral disclosure, by use, or in any other way, before the filing date or the priority date of the application claiming the invention. Information is deemed available to the public when it is not confidential or restricted to the use by a selective group. Prior use and oral disclosure, whether within or outside the Philippines, must be proven with substantial evidence.

(b) The whole contents of an earlier application for a patent, utility model, or industrial design registration, published by the Intellectual Property Office of the Philippines, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application; Provided, that the application which has validly claimed the filing date of an earlier application under Section 31 of the IP Code, shall be prior art with effect as of the filing date of such earlier application; Provided further, that the applicant or the inventor of the invention identified in both applications are not one and the same (Sec. 24, IP Code).

(c) The whole contents of corresponding foreign applications disclosing substantially the same invention, or a description thereof, published before the filing date of the application. Inventions are considered substantially the same if the composition of all important particulars, excluding mere formal, unimportant or obvious variations, define the invention.

(d) Where two or more applications are independently filed with respect to the same invention, and the later applications are filed before the first application or earlier application is published, the whole contents of the first or earliest filed application published in accordance with Section 44 of the IP Code on or after the filing date or priority date of the later filed application shall be novelty destroying with respect to the later application filed.

**Rule 1601. *Non-prejudicial Disclosure.*** The disclosure of information contained in the industrial design application during the six (6) months preceding the filing date or the priority date of the application or during the twelve (12) months preceding the filing date or priority date in the case of utility model applications shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

(a) The maker, designer or any person who, at the time of the date of filing, has the right to the registration;

(b) A foreign patent office, the Bureau, or the Office, and such information was contained in:

(i) another application filed by the maker or designer and should have not been disclosed by the Office; or

(ii) an application filed without the knowledge or consent of the maker or the designer by a third party which obtained the information directly or indirectly from the maker or designer; or

(c) A third party which obtained the information directly or indirectly from the maker or designer, provided further that all foreign patent offices that publish pending patent applications, as well as the WIPO which publishes patent applications filed through the PCT are excluded therefrom.

**Rule 1700. *Community Review of the Utility Model and Industrial Design Applications.*** In the interest of transparency in registering utility models or industrial designs and quality of utility models or industrial designs registered, the concerned community shall be notified by the Office upon publication of the utility model or industrial design applications.

**Rule 1701. *Adverse Information.*** Within thirty (30) days from the date of publication of the utility model or industrial design application, any person may present written adverse information concerning the registrability of the utility model or industrial design including matters pertaining to novelty and industrial applicability while citing relevant prior art.

**Rule 1702. *Decision of the Director.*** The Director shall decide whether or not to register the utility model or industrial design. The Director may also direct the applicant to amend the application to conform with the requirements of registrability. For this purpose, the Director may issue a registrability report *motu proprio*. Amended applications shall be re-published prior to registration in accordance with these Regulations.

In case the Director refuses or denies the registration of the utility model or industrial design, the applicant may appeal such decision to the Director General pursuant to Section 7.1 (b) of the IP Code, and in accordance with Part 13 of these Regulations. No motion for reconsideration of the decision or order of the Director shall be allowed.

In case the Director allows the registration of the utility model or industrial design, any interested party may file a petition for cancellation with the Bureau of Legal Affairs in accordance with [...] Section 120 for industrial design of the IP Code [...]

***Memorandum Circular No. 14-004 issued by the Director of Patents regarding "Deferred Publication of Industrial Design Application", 20 May 2014.***

To enable designers and companies applying for the registration of industrial designs to keep them secret from competitors until such time that these are placed in the market, applicants may opt to file a request for the deferred publication of their industrial design application. The request may be filed simultaneous with the filing of the application, or at any time prior to its publication in accordance with Part 17 of the Revised Implementing Rules and Regulations (IRR).

The maximum period allowed for the deferred publication of an industrial design application shall be thirty (30) months from the filing date or priority date of the application. In case the request for the deferred publication is made after the filing of the application, the allowable period for the deferred publication shall be the remaining time from the allowed thirty (30) months deferred publication period. The applicant/s may request for a specific time for this Office to publish the application, provided it does not go beyond the allowed deferment period of thirty (30) months.

Furthermore, as industrial design applications which satisfy the formal requirements provided under Rule 1517 of the revised IRR are immediately published by the Office within five (5) days from the date of filing thereof, applicants are encouraged and strongly advised to file their request for deferred publication upon the filing of their applications. This is to prevent the inadvertent publication of the design applications with subsequent requests for deferred publications.

## SINGAPORE

### ***Registered Designs Act (Chapter 266) (Original Enactment: Act 25 of 2000, 13th November 2000, Revised Edition 31st July 2005)***

2. (1) In this Act, unless the context otherwise requires —  
[...]

“article” means any thing that is manufactured (whether by an industrial process, by hand or otherwise), and includes —

- (a) any part of an article, if that part is made and sold separately; and
- (b) any set of articles;

“artistic work” has the meaning assigned to it in section 7(1) of the Copyright Act (Cap. 63);  
[...]

“corresponding design”, in relation to an artistic work, means a design which, when applied to an article or a non-physical product, results in a reproduction of that work;  
[...]

“design” means features of shape, configuration, colours, pattern or ornament applied to any article or non-physical product that give that article or non-physical product its appearance, but does not include —

- (a) a method or principle of construction;
- (b) features of shape, configuration or colours of an article of a non-physical product that —
  - (i) are dictated solely by the function that the article or non-physical product has to perform;
  - (ii) are dependent upon the appearance of another article or non-physical product of which the article or non-physical product is intended by the designer to form an integral part; or
  - (iii) enable the article or non-physical product to be connected to, or placed in, around or against, another article or non-physical product, so that either article or non-physical product may perform its function;or



- (c) features consisting only of one or more colours that —
- (i) are not used with any feature of shape or configuration; and
  - (ii) do not give rise to any feature of pattern or ornament;

“formal requirements” means —

- (a) the requirements of section 11(2)(c) and (4)(a); and
- (b) any other requirements of section 11, or of the rules made for the purposes of that section, that are prescribed as formal requirements;

“non-physical product” —

- (a) means any thing that —
  - (i) does not have a physical form;
  - (ii) is produced by the projection of a design on a surface or into a medium (including air); and
  - (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information; and
- (b) includes any set of non-physical products

“set of articles” means 2 or more articles of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

“set of articles and non-physical products” means one or more articles and one or more non-physical products —

- (a) all of which are of the same general character and are ordinarily on sale together or intended to be used together; and
- (b) to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied;

“set of non-physical products” means 2 or more non-physical products of the same general character that are ordinarily on sale together or intended to be used together, and to each of which the same design, or the same

design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the design, is applied.

5. (1) Subject to the provisions of this Part, a design which is new may, upon application by the person claiming to be the owner, be registered in respect of an article, a non-physical product, or a set of articles and non-physical products, specified in the application.

(2) A design for which an application for registration is made shall not be regarded as new if it is the same as a design —

(a) registered in respect of the same or any other article, non-physical product or set of articles and non-physical products in pursuance of a prior application; or

(b) published in Singapore or elsewhere in respect of the same or any other article, non-physical product or set of articles and non-physical products before the date of the first-mentioned application,

or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

(3) The Registrar may, in such cases as may be prescribed, direct that, for the purpose of deciding whether a design is new, an application for registration of the design shall be treated as filed on a date earlier or later than that on which it was in fact filed.

6. A design is not registrable if the publication or use of it would be contrary to public order or morality.

7. (1) No computer program or layout-design may be registered under this Act.  
[...]

8. (1) Subject to subsection (2A), an application for registration of a design shall not be refused, and the registration of a design shall not be revoked, by reason only of —

(a) the disclosure of the design by the owner to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;

(b) the disclosure of the design in breach of good faith by any person other than the owner of the design;

(c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design; or

(d) the communication of the design by the owner to a Government department or the Office or to any person authorised by a Government department or the Office to consider the merits of the design, or of anything done in consequence of such a communication.

(2) Subject to subsection (2A), an application for registration of a design shall not be refused, and the registration of a design shall not be revoked, by reason only —

(a) that a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the owner of the design, at an official international exhibition;

(b) that after any such display as is mentioned in paragraph (a), and during the period of the exhibition, a representation of the design, or any article to which the design has been applied, has been displayed by any person without the consent of the owner; or

(c) that a representation of the design has been published in consequence of any such display as is mentioned in paragraph (a),

if the application for registration of the design is made no later than 6 months after the opening of the exhibition.

(2A) This section only applies to —

(a) a disclosure mentioned in subsection (1)(a) or (b);

(b) an acceptance mentioned in subsection (1)(c);

(d) a communication mentioned in subsection (1)(d), or anything done in consequence of such a communication;

(d) a display mentioned in subsection (2)(a) or (b); or

(e) a publication mentioned in subsection (2)(c),

that occurs before the date of commencement of section 6 of the Registered Designs (Amendment) Act 2017.

[...]

8A. (1) An application for registration of a design must not be refused, and the registration of a design must not be revoked, by reason only of any of the following:

(a) a disclosure of the design made to a person other than the designer, or any successor in title of the designer, under conditions of confidentiality (whether express or implied);

(b) a disclosure of the design made by the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design;

(c) a disclosure of the design made by a person other than the designer, or any successor in title of the designer, during the period of 12 months immediately before the date of filing of the application for registration of the design, in consequence of information provided, or any other action taken, by the designer or any successor in title of the designer;

(d) a disclosure of the design made during the period of 12 months immediately before the date of filing of the application for registration of the design, as a consequence of an abuse in relation to the designer or any successor in title of the designer.

(2) This section only applies to a disclosure mentioned in subsection (1)(a), (b), (c) or (d) that is made on or after the date of commencement of section 7 of the Registered Designs (Amendment) Act 2017.

8B. An application for registration of a design in respect of a non-physical product must not be refused, and the registration pursuant to that application of the design in respect of the non-physical product must not be revoked, by reason only of a disclosure of the design made before the date of filing of that application, if that application is filed during the period of 12 months immediately after the date of commencement of section 7 of the Registered Designs (Amendment) Act 2017.

9. (1) Subject to subsection (2), where an application is filed by or with the consent of the owner of copyright in an artistic work for the registration of a corresponding design, the design shall not be treated for the purposes of this Act as being other than new by reason only of any use previously made of the artistic work.

(2) Subsection (1) shall not apply if —

(a) the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire of —

(i) articles or non-physical products to which had been applied —  
(A) the design in question; or

(B) a design differing from the design in question only in immaterial details or in features which are variants commonly used in the trade (called in this subsection an immaterial variant); or

(ii) devices for projecting any non-physical products mentioned in sub-paragraph (i);

(b) the design in question or an immaterial variant had been applied industrially in relation to those articles, non-physical products or devices; and

(c) the previous use was made by or with the consent of the copyright owner.

(3) The Minister may make rules to provide for the circumstances in which a design is to be regarded as having been applied industrially, in relation to articles, non-physical products or devices for projecting non-physical products, for the purposes of this section.

10. (1) Where the registered owner of a design registered in respect of an article or a non-physical product files —

(a) an application for registration of the registered design in respect of one or more other articles or non-physical products; or

(b) an application for registration of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity of the registered design, in respect of the same or one or more other articles or non-physical products,

the application shall not be refused, and the registration made on the application shall not be revoked, by reason only of the previous registration or publication of the registered design.

[...]

11. [...]

(2) The application shall —

[...]

(c) contain a clear representation of the design.

[...]

(4) An application may be filed under subsection (1) for the registration of 2 or more designs, if —

(a) the articles, non-physical products, or sets of articles and non-physical products, to which any of those designs is intended to be applied, as specified in the application, fall within the same class, or (if they fall within more than one class) all of the same classes, under the classification mentioned in section 75(1)(c), as the articles, non-physical products, or sets of articles and non-physical products, to which each of the other designs is intended to be applied, as specified in the application; and

(b) the application complies with such other requirements as may be prescribed.

(5) Every application filed under subsection (1) for the registration of 2 or more designs is to be treated as if a separate application had been filed under that subsection for the registration of each of those designs.

16. (1) The Registrar shall examine an application for registration of a design, being an application which has not been withdrawn, to determine whether it satisfies the formal requirements.

[...]

17. (1) The Registrar may refuse an application for registration of a design if —

(a) after an examination by him under section 16; and

(b) after giving the applicant the opportunity to correct any non-compliance with the formal requirements,

the Registrar determines that the application does not satisfy the formal requirements.

(2) The Registrar may refuse an application for registration of a design if, on the face of the application, the design is not new or is not registrable for any other reason.

[...]

19. The Registrar, in determining whether to accept an application for registration of a design, shall not be required to consider or have regard to —

(a) the registrability of the design;  
[...]

(c) whether the design is properly represented in the application.

27. (1) At any time after a design has been registered, any interested person may apply to the Registrar or the Court for the revocation of the registration of the design on the ground that the design was not, at the date of its registration, new, or on any other ground on which the Registrar could have refused to register the design; and the Registrar may make such order on the application as he thinks fit.

(2) At any time after a design has been registered, any interested person may apply to the Registrar or the Court for the revocation of the registration on the ground that —

(a) the design was at the time it was registered a corresponding design in relation to an artistic work in which copyright subsisted; and

(b) the right in the registered design has expired in accordance with section 22(1),

and the Registrar may make such order on the application as he thinks fit.  
[...]

***Registered Designs Rules, R1 G.N. No. S 504/2000, 13th November 2000, Revised Edition 2002, 31st January 2002***

2. (1) In these Rules, unless the context otherwise requires —  
[...]

“textile article” means textile or plastics piece goods, handkerchiefs, shawls or such other class of articles of a similar character as the Registrar may, from time to time, decide, for which the protection required is limited to features of pattern and ornament only.

9. The Registrar shall refuse to register a design intended to be applied to any of the following articles:

(a) works of sculpture (other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process);

(b) wall plaques, medals and medallions;

(c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greeting cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles.

10. (1) Where a representation of the name, initials, armorial bearings, insignia, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate, government body, statutory board, institution or person appears on a design which is the subject of an application for registration, the Registrar may, before proceeding to register the design, require the applicant to furnish the Registrar with the consent to the registration and use of the matter in question of such official or other person as appears to the Registrar to be entitled to give consent.

(2) The Registrar shall refuse to register the design if no such consent is furnished within the time specified by the Registrar.

11. (1) Where the name or representation of any person appears on a design which is the subject of an application for registration, the Registrar may, before proceeding to register the design, require the applicant to furnish the Registrar with the consent of the person or, in the case of a person recently dead, of his legal representatives.

(2) Where such consent is not furnished within the time specified by the Registrar and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstances of the case to obtain the consent, the Registrar shall refuse to register the design.

12. (1) For the purposes of section 9 of the Act, on or after 30 October 2017 but before 30 October 2018, a design is to be regarded as having been applied industrially in relation to articles, if —

(a) the design is applied to one or more articles (not being hand-made articles) that are manufactured in lengths; or

(b) the design is applied to more than 50 articles, no 2 or more of which are part of the same set of articles.

(2) For the purposes of section 9 of the Act, on or after 30 October 2018, a design is to be regarded as having been applied industrially in relation to articles, if —



(a) the design is applied to one or more articles (not being hand-made articles) that are manufactured in lengths or in pieces;

(b) the design is applied to more than 50 articles, no 2 or more of which are part of the same set of articles; or

(c) all of the following apply:

- (i) the design is applied to articles and non-physical products;
- (ii) the total of the number of those articles, and the number of those non-physical products that can be projected simultaneously by one or more activated devices for projecting non-physical products, is more than 50;
- (iii) no 2 or more of those articles and non-physical products are part of any of the following:
  - (A) the same set of articles;
  - (B) the same set of non-physical products;
  - (C) the same set of articles and non-physical products.

(3) For the purposes of section 9 of the Act, on or after 30 October 2018, a design is to be regarded as having been applied industrially in relation to non-physical products or devices for projecting non-physical products, if —

(a) all of the following apply:

- (i) the design is applied to non-physical products;
- (ii) more than 50 of those non-physical products can be projected simultaneously by one or more activated devices for projecting non-physical products;
- (iii) no 2 or more of those non-physical products are part of the same set of non-physical products; or

(b) all of the following apply:

- (i) the design is applied to articles and non-physical products;
- (ii) the total of the number of those articles, and the number of those non-physical products that can be projected

simultaneously by one or more activated devices for projecting non-physical products, is more than 50;

(iii) no 2 or more of those articles and non-physical products are part of any of the following:

(A) the same set of articles;

(B) the same set of non-physical products;

(C) the same set of articles and non-physical products.

(4) For the purposes of paragraphs (1), (2) and (3), the date on which the design is applied to an article or a non-physical product is irrelevant.

14. [...]

(2) The representation of a design or, where there is more than one view filed as representation of a design, the representation of each view of the design shall be in the form of a drawing or photograph that is suitable for reproduction.

(3) Where the application is made for the registration of a design intended to be applied to a set of articles, the representation shall show the design as applied to each different article in the set.

(4) Where the application is made for the registration of a design intended to be applied to a set of non-physical products, the representation must show the design as applied to each different non-physical product in the set.

(5) Where the application is made for the registration of a design intended to be applied to a set of articles and non-physical products, the representation must show the design as applied to each different article and each different non-physical product in the set.

20. (1) An application for registration of a 2-dimensional design intended to be applied to a textile article may be accompanied by a sample of the article.

(2) The sample of the article shall not exceed such size or weight as the Registrar may specify.

(3) The Registrar may, in his discretion, refuse the acceptance of any sample of article.

21. Unless the Registrar otherwise requires, no specimen shall be filed.

22. For the purposes of section 11(4)(b) of the Act, the other requirements that an application for the registration of 2 or more designs must comply with are as follows:

(a) the registration of all of those designs must be applied for at the time of filing the application form;

(b) the application is for the registration of not more than 50 designs.

27. (1) For the purposes of paragraph (b) of the definition of “formal requirements” in section 2(1) of the Act, the requirements of rules 10, 11, 13, 14, 15, 17, 18 and 19 (being rules made for the purposes of section 11 of the Act) are formal requirements.

(1A) For the purposes of section 16 of the Act and this rule, the Registrar need not take into account any document filed by an applicant after the Registrar has started examining the applicant’s application for registration of a design.

(2) If, in the course of an examination of an application for registration, it appears to the Registrar that the formal requirements for registration are not met, the Registrar shall give a written notice of this to the applicant.  
[...]

40. (1) An application under section 27 of the Act to the Registrar for revocation of the registration of a design shall be made in Form D13.

(2) The application shall be accompanied by a statement of the grounds on which the application is made.  
[...]

Practice Direction No. 1 of 2017 – Classification of Articles, Non-Physical Products or Sets of Articles and Non-Physical Products for the Purposes of the Registration of a Design

***Copyright Act (Chapter 63), Act 2 Of 1987, Revised Edition  
2006, 31st January 2006***

7. (1) In this Act, unless the context otherwise requires —  
[...]

“artistic work” means —

- (a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;
- (b) a building or model of a building, whether the building or model is of artistic quality or not; or
- (c) a work of artistic craftsmanship to which neither paragraph (a) nor (b) applies,

but does not include a layout-design or an integrated circuit within the meaning of section 2(1) of the Layout-Designs of Integrated Circuits Act (Cap. 159A);

### ***Practice Direction No. 4 of 2018 – Registration of Graphical User Interfaces (GUIs) – 20 June 2018***

#### **Registration of Graphical User Interfaces (GUIs) as designs**

(1) Applicants can file with the Registry of Designs at the Intellectual Property Office of Singapore to seek the registration of Graphical User Interfaces (GUIs) as designs under the Registered Designs Act (RDA).

(2) This practice direction supplements and is to be read in accordance with the Registered Designs Act and Rules, other relevant provisions in other Acts and Rules, as well as other practice directions and circulars issued by the Registry.

#### **1. Applicant must indicate, in Form D3, the article or non-physical product that the GUI is applied to**

(1) Where a GUI contains features of shape, configuration, colours, pattern or ornament and such GUI is applied to an article or non-physical product so as to give that article or non-physical product its appearance, an applicant may seek registration of the GUI as a design under the RDA. All GUIs sought to be registered as designs under the RDA must meet the definition of “design” in Section 2(1) of the RDA.

(2) If the applicant is seeking to register the GUI as a design in relation to an article, the applicant must indicate, in the field provided for the “Article Name”, the name of the article that the GUI is applied to. An article is any thing that is manufactured (whether by an industrial process, by hand or otherwise), and it includes any part of an article, if that part is made and sold separately. An article has a physical form (in contrast to non-physical

products). The name of the article indicated by the applicant must meet the definition of “article” in Section 2(1) of the RDA.

(3) If the applicant is seeking to register the GUI as a design in relation to a non-physical product, the applicant must indicate, in the field provided for the “Non-physical Product Name”, the name of the non-physical product that the GUI is applied to. A non-physical product is anything that (a) does not have a physical form; (b) is produced by the projection of a design on a surface or into a medium (including air); and (c) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information. The name of the non-physical product indicated by the applicant must meet the definition of non-physical product in Section 2(1) RDA.

(4) If the applicant is seeking to register the GUI as a design in relation to both articles and non-physical products, the applicant must comply with both paragraph (2) and paragraph (3) above.

(5) In Form D3, under the part on “Statement of Novelty”, the applicant must provide a statement describing the features of the design that the applicant considers to be new. This statement of novelty may be in the following form “Novelty resides in the \_\_\_\_\_ as shown in the representation(s)”.

(6) For further details on filing Form D3 via the electronic online system (EOS), please refer to the special IP2SG Practice Direction No. 1 of 2017 which specifies the practice to be adopted when using the EOS provided by the Registry of Designs.

## **2. Applicants must file a dynamic GUI as a series of static representations of the design**

(1) GUIs may be either static (e.g. non-animated) or dynamic (e.g. animated).

(2) A dynamic GUI is to be filed in an application as a series of static representations, where each representation (in the form of a drawing or photograph) shows a freeze-frame of the GUI in action.

(3) The parts for which protection is sought are to be identified in solid lines. The parts for which protection is not claimed are to be indicated by means of broken or stippled lines, or shaded portions, and these disclaimed portions are to be indicated in Form D3 accordingly.

(4) The applicant may provide, in a cover letter or separate document accompanying Form D3, an explanatory statement for each representation to clearly describe the elements in the GUI (e.g. how they are activated,

how they interact, whether the GUI only appears in an “on” state, whether certain GUI elements subsequently arise from user interaction, etc.). As far as possible, the representations must be filed in consecutive order.

### **3. Number of views allowed for GUIs**

- (1) Each application should contain a sufficient number of different views to completely disclose the appearance of the claimed design.
- (2) A total of up to 40 different views of the same GUI may be filed as representations of the design which protection is being sought for.
- (3) At least 2 views should be filed for a single dynamic GUI.
- (4) The Registry may, on written request, allow for more than 40 views to be filed.

## ***IP2SG Practice Direction No. 1 of 2018 - Electronic Online System (EOS), 30 Oct 2018***

### **1. The Electronic Online System**

- (1) The representation of the submitted design (or, where there is more than one view filed as the representation of the submitted design, the representation of each view of the design) shall be either in the form of photographs or drawings which should be visually clear, of good quality and be suitable for reproduction. Because the application shall contain a clear representation of the design, the submitted views of the design shall be either in the form of photographs, or in the form of drawings, and shall not be in the form of both photographs and drawings.

[...]

### **6A. [Specific to the Registry of Designs] Size and Mode of Representations in Electronic Form**

#### *Mode of Representations*

- (1) The representations of the submitted design shall be either in the form of photographs or drawings which should be visually clear, of good quality and be suitable for reproduction.

- (2) If the representations of the submitted design consist of photographs, the photographs shall be clear original prints. If the application is filed via the Service Bureau, the photographs submitted shall be mounted on good quality A4 size paper.
- (3) All photographs shall be of matte finish and shall show the article against a plain contrasting background. Any extraneous articles that are not intended to form part of the design shall be excluded.
- (4) If the representations submitted consist of drawings, these drawings must be accurately drawn on good quality A4 sized white paper and the drawings must be of well-defined, even, black lines. Rough-hand sketches are not acceptable.
- (5) For applications filed via the EOS, the image files must be in JPEG format only. The image file name should not contain any spaces or special characters.

#### *Views of Representations*

- (6) The drawings or photographs should contain a sufficient number of views to completely disclose the appearance of the claimed design, for example, front, rear, right and left sides, top and bottom views.
- (7) Cross section views of the design should not be submitted unless it is to clearly show the appearance and shape of three-dimensional designs.

#### *Number of Views*

- (8) Each application shall, as far as possible, contain up to 10 different views of the design. Where more than 10 views are provided, the Registry may disregard the additional views lodged.
- (9) Each view shall be presented on individual sheets of A4 sized paper. Similarly, for applications filed via the EOS, each view is to be submitted as one image file. The Registry will accept the views in the consecutive order that they are provided by the applicant.
- (10) If the application is for a design which is to be applied to a set of articles, a set of non-physical products or a set of articles and non-physical products, the view selected for publication shall show the design as applied to all the items (articles and/or non-physical products) that are in the set. For example, if the application is for a set of jewellery consisting of a pendant, a ring and a bangle, these three items must be shown within the view selected for publication.

### *Dimensions of Views*

- (11) The dimensions for each of the views of the design should not exceed 13 cm x 15 cm, and should not be smaller than 3 cm x 3 cm.
- (12) In the case of a set of articles, a set of non-physical products, or a set of articles and non-physical products, where the view selected for publication shows all the items that are in the set (articles and/or non-physical products), the dimension of this view selected for publication should also not exceed 13 cm x 15 cm.
- (13) For applications filed via the EOS, the total file size of all the images and the attachments submitted should not exceed 100 MB.

### *Labelling the Views*

- (14) The views may be labelled numerically such as “Fig. 1”, “Fig. 2” or include terms such as “Perspective view” or “View of one side”.
- (15) The labels should not include dimensions, wordings that describe all or parts of the design, or elements of any trade mark.
- (16) To protect a design which only applies to a part or parts of an article, clearly identify the part or parts of the article in solid lines. The parts for which protection is not claimed may be indicated by means of broken or stippled lines, or shaded portions. Broken or stippled lines and/or shaded portions are for illustrative purposes only.
- (17) Images labelled as “Reference View” are also for illustrative purposes only. Reference views may, for example, show the design in use. Where an applicant indicates that a view is a “Reference View”, the applicant is indicating that that view is not to be taken into consideration in determining the design for which protection is claimed.

[...]



## THAILAND

### ***Patent Act B.E. 2522 (1979), as amended by the Patent Act (No. 2) B.E 2535 (1992) and the Patent Act (No. 3) B.E. 2542 (1999)***

3. In this Act:

[...]

“design” means any form or composition of lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft;

[...]

56. A patent may be granted under this Act for a new design for industry, including handicrafts.

57. The following designs are not new: —

(1) a design which was widely known or used by others in this country before the filing of the application for a patent;

(2) a design which was disclosed or described in a document or a printed publication in this or a foreign country before the filing of the application for a patent;

(3) a design which was published under Section 65 and Section 28 before the filing of the application for a patent;

(4) any design so nearly resembling any of the designs prescribed in (1), (2) or (3) as to be an imitation.

58. The following are unpatentable: —

(1) designs that are contrary to public order or morality;

(2) designs prescribed by a Royal Decree.

59. The application for a patent shall comply with the requirements and procedures as prescribed by the Ministerial Regulations. Every application for a patent shall contain: —

- (1) a representation of the design;
- (2) an indication of the product for which the design is to be used;
- (3) a clear and concise claim;
- [...]

60. An application for a patent shall relate to a design to be used with only one product.  
[...]

61. When an application is published under Sections 65 and 28, but before the registration of and grant of a patent for the design, if it appears that the application does not comply with the provisions of Section 56, 57 or Sections 65 and 10, 11 and 14, the Director-General shall reject the application. The competent officer shall notify the applicant and the opposing party under Sections 65 and 31 of that decision, and a copy of the decision shall be displayed at the place where the application is filed.  
[...]

64. Any patent granted which is not in compliance with the provisions of Section 56, 58 or 65 and Sections 10, 11 and 14 shall be invalid.

The validity of a patent may be challenged by any person. A petition to cancel an invalid patent may be submitted to the Court by any person who has an interest in the patent or by the public prosecutor.

***Patent Regulations – Ministerial Regulations No. 19, No. 21, No. 22, No. 23, No. 24, No. 25, No. 26, No. 27, of September 24, 1999***

Clause 7

The drawings shall be clear, consistent with the description and in compliance with the principles on drawings. For the purpose of this Clause, drawings shall also mean plans and charts.

#### Clause 17

An application for a design patent shall be filed together with a representation of the design and a claim.

#### Clause 18

Applications shall be on the forms prescribed by the Director-General and shall:

- (1) state the number of design representations, and
- (2) designate the product for which the industrial design is to be used and its class under the classification published by the Minister.

#### Clause 19

The representation may consist of photographs or drawings which shall show all the features of the product for which protection is sought. The representation shall be in black and white or if the design is in color, the representation shall also be in color.

#### Clause 20

A description of the design, not exceeding one hundred words, may be included with the application.

#### Clause 21

Only one claim shall be made in each application.

### ***Copyright Act B.E. 2537 (1994), 9th December B.E. 2537 (1994)***

Section 4 In this Act:  
[...]

"artistic work" means a work of any one or more of the following characters:  
[...]

(7) work of applied art which means a work which takes each or a composition of the works mentioned in (1) to (6) for utility apart from the appreciation in the merit of the work such as for practical use of such work, decorating materials or appliances or using for commercial benefit. Provided that, whether or not the work in (1) to (7) has an artistic merit and it shall include photographs and plans of such work.

***Manual for the Application for Design Patent - 2011***

Available from the IP authorities of Thailand.

## VIET NAM

### ***Law on Intellectual Property, No. 50/2005/Qh11, 29 November 2005***

**Article 4.** Interpretation of terms in this Law, the following terms shall be construed as follows:

[...]

13. *An industrial design* means a specific appearance of a product embodied by three-dimensional configurations, lines, colors, or a combination of these elements.

[...]

**Article 6.** Bases for the emergence and establishment of intellectual property rights

[...]

3. Industrial property rights are established as follows:

a/ Industrial property rights to an invention, industrial design, layout-design, mark or geographical indication shall be established on the basis of a decision of the competent state agency on the grant of a protection title according to the registration procedures stipulated in this Law or the recognition of international registration under treaties to which the Socialist Republic of Vietnam is a contracting party;

[...]

**Article 14.** Types of works covered by copyright

1. Literary, artistic and scientific works covered by copyright include:

[...]

g/ Plastic-art works and works of applied art;

[...]

**Article 63.** General conditions for industrial designs eligible for protection

An industrial design shall be protected when it satisfies the following conditions:

1. Being new;
2. Being creative;
3. Being susceptible of industrial application.

**Article 64.** Subject matters not protected as industrial designs

The following subject matters shall not be protected as industrial designs:

1. Appearance of a product, which is dictated by the technical features of the product;
2. Appearance of a civil or an industrial construction work;
3. Shape of a product, which is invisible during the use of the product.

**Article 65.** Novelty of industrial designs

1. An industrial design shall be considered new if it significantly differs from other industrial designs that are already publicly disclosed through use or by means of written descriptions or in any other form, inside or outside the country, prior to the filing date or the priority date, as applicable, of the industrial design registration application.
2. Two industrial designs shall not be considered significantly different from each other if they are only different in appearance features which are not easily noticeable and memorable and which cannot be used to distinguish these industrial designs as whole.
3. An industrial design shall be considered having not yet been publicly disclosed if it is known to only a limited number of persons who are obliged to keep it secret.
4. An industrial design shall not be considered having lost its novelty if it is published in the following cases, provided that the industrial design registration application is filed within 6 months from the date of publication:
  - a/ It is published by another person without permission of the person having the right to register it defined in Article 86 of this Law;
  - b/ It is published in the form of a scientific presentation by the person having the right to register it defined in Article 86 of this Law;

c/ It is displayed at a national exhibition of Vietnam or at an official or officially recognized international exhibition by the person having the right to register it defined in Article 86 of this Law.

**Article 66.** Creativity of industrial designs

An industrial design shall be considered creative if, based on industrial designs already publicly disclosed through use or by means of written descriptions or in any other form, inside or outside the country, before the filing date or the priority date, as applicable, of the industrial design registration application, it cannot be easily created by a person with average knowledge in the art.

**Article 67.** Susceptibility of industrial application of industrial designs

An industrial design shall be considered susceptible of industrial application if it can be used as a model for mass manufacture of products with appearance embodying such industrial design by industrial or handicraft methods.

**Article 96.** Invalidation of protection titles

1. A protection title shall be entirely invalidated in the following cases:  
[...]

b/ The subject matter of industrial property fails to satisfy the protection conditions at the time the protection title is granted.

2. A protection title shall be partly invalidated when that part fails to satisfy the protection conditions.

3. Organizations and individuals may request the state management agency in charge of industrial property rights to invalidate protection titles in the cases specified in Clauses 1 and 2 of this Article, provided that they pay fees and charges.

**Article 101.** The requirement on the uniformity of industrial property registration applications

1. Each industrial property registration application shall request the grant of only one protection title for a single industrial property subject matter, except for the cases specified in Clauses 2, 3 and 4 of this Article.  
[...]

3. Each registration application may request the grant of one industrial design patent for several industrial designs in the following cases:

a/ Industrial designs of a set of products consist of numerous items expressing a single common inventive idea and used together or for a common purpose;

b/ An industrial design is accompanied by one or more variants, i.e., variations of such industrial design that express a single common inventive idea and that are not significantly different from such industrial design.

**Article 103.** Requirements on industrial design registration applications

1. Documents identifying an industrial design registered for protection in an industrial design registration application include a description and a set of photos or drawings of such industrial design. The industrial design description consists of a section of description and a scope of protection of such industrial design.

2. The section of description of an industrial design must satisfy the following conditions:

a/ Fully disclosing all features expressing the nature of the industrial design and clearly identifying features which are new, different from the least different known industrial design, and consistent with the set of photos or drawings;

b/ Where the industrial design registration application consists of variants, the section of description must fully show these variants and clearly identify distinctions between the principal variant and other variants;

c/ Where the industrial design stated in the registration application is that of a set of products, the section of description must fully show features of each product of the set.

3. The scope of protection of industrial designs must clearly define features which need to be protected, including features which are new and different from similar known industrial designs.

4. The set of photos and drawings must fully define features of the industrial design.



**Article 109.** Formal examination of industrial property registration applications

1. Industrial property registration applications shall be subject to formal examination for evaluating their validity.

2. An industrial property registration application shall be considered invalid in the following cases:

a/ It does not fulfill the formal requirements;

b/ The subject matter stated in the application is ineligible for protection; [...]

**Article 114.** Substantive examination of industrial property registration applications

1. The following industrial property registration applications shall be substantively examined for evaluation of the eligibility for grant of protection titles for subject matters stated in such applications under protection conditions and for determination of the respective scope of protection:

[...]

b/ Industrial design registration applications [...] which have been accepted as being valid.

[...]

**Article 117.** Refusal to grant protection titles

1. The grant of a protection title for an [...] industrial design [...] application shall be refused in the following cases:

a/ There are grounds to affirm that the subject matter stated in the application does not fully satisfy the protection conditions;

[...]

***Decree No. 103/2006/ND-CP of September 22, 2006, detailing and guiding the implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property***

Article 6. Bases and procedures for the establishment of industrial property rights

1. Industrial property rights to inventions, layout designs, industrial designs, marks and geographical indications are established on the basis of decisions of the state management agency in charge of industrial property which grants protection titles to applicants for registration of those objects according to the provisions of Chapters VII, VIII and IX of the Law on Intellectual Property. Industrial property rights to marks internationally registered under the Madrid Agreement and the Madrid Protocol are established on the basis of recognition of such international registration by the state management agency.

[...]

***Circular No. 01/2007/TT-BKHCN of February 14, 2007, Guiding the Implementation of the Government's Decree No. 103/2006/ND-CP of September 22, 2006, Detailing and Guiding the Implementation of a number of articles of the Law on Intellectual Property regarding Industrial Property***

1. Grounds for establishment of industrial property rights

[...]

1.2 Industrial property rights to [...] industrial designs [...] shall be established under decisions of the National Office of Intellectual Property (NOIP) on the grant of protection titles to persons that register those objects.

[...]

15. Substantive examination of applications

[...]

15.1. Purpose and coverage of substantive examination

a/ The purpose of substantive examination of applications is to assess the protectability of objects stated in those applications under the protection conditions and corresponding protection coverage (volume).

[...]

15.6. Examination contents

a/ Substantive examination of an application covers the following contents:

(i) Assessment of compatibility of the object stated in the application with the type of protection title applied for;

(ii) Assessment of the object based on each protection condition;

(iii) Inspection of observance of the first-to-file rule.

b/ The assessment of the object based on the protection conditions shall be conducted for objects one after another (if the application contains many and still ensures the uniformity). For each object, the assessment shall be conducted based on each specific protection condition:

[...]

(ii) For an industrial design registration application, the assessment shall be conducted for the design of each product (if the application is for a set of products); in case the application shows many variations of an industrial design, those variations shall be assessed one after another, starting from the basic variation (the first variation shown in the application);

[...]

c/ The substantive examination with regard to each object specified at Point 15.6.b (i), (ii) and (iii) above shall be completed when that object has been assessed based on all protection conditions and there are enough grounds to conclude whether or not the object satisfies the protection conditions, specifically:

(i) Any reason is found to conclude that the object fails to satisfy one/several/all protection conditions; or

(ii) No reason is found to conclude that the object fails to satisfy at least one protection condition.

[...]

## 16. Re-examination of applications

16.1. Re-examination of an application challenged by an opposition after the issuance of a notice on intended grant/intended refusal to grant a protection title.

a/ The re-examination of an application according to the provisions of Clause 4, Article 117 of the Intellectual Property Law shall be conducted in the following cases:

(i) A written opinion is sent by the applicant to the NOIP during the period from the date of issuance of a notice on intended grant/intended refusal to grant a protection title to the date prior to the issuance of a decision on grant/an official notice on refusal to grant the relevant protection title; or a report is made by a third party, stating justifiable

reason(s) for the absence of a reasonable condition or opportunity to express his/her/its opinions;

(ii) Opinions mentioned at Point 16.1.a (i) above are well-grounded and supported by proofs or references to reliable information sources;

(iii) Arguments or evidence to prove that opinions mentioned at Point 16.1.a (i) above are different from those previously furnished (if any), or though they are not different from the previously furnished ones but the NOIP has not yet replied according to the provisions of Point 6.2 of this Circular.

[...]

17. Amendment /supplementation / division / conversion / transfer of applications

[...]

17.2. Division of applications

a/ The applicant may divide, on his/her own initiative or upon the request of the NOIP, his/her application (division and transfer of [...] one or several industrial designs in an industrial design registration application, [...]).  
[...]

18. Refusal to grant, grant or re-grant of protection titles, grant of protection title duplicates

18.1. Refusal to grant protection titles

Applications for protection titles may be rejected if they fall into one of the cases specified in Clauses 1 and 2, Article 117 of the Intellectual Property Law.

[...]

33. Requirements for industrial design registration applications

[...]

33.2. Industrial design registration applications must ensure uniformity according to the provisions of Clauses 1 and 3, Article 101 of the Intellectual Property Law and the following provisions.

An industrial design registration application is considered uniform if:

- a/ It requests protection of an industrial design of a product; or
- b/ It requests protection of industrial designs of more than one products in a set of products, of which each product has its own industrial design; or
- c/ It requests protection of an industrial design of a product accompanied with one or several variations of that industrial design.

### 33.5. Requirements for industrial design descriptions

An applicant shall submit one copy of the industrial design description that contains the following contents:

- a/ Name of the industrial design, which is the name of the product imbued with the industrial design, expressed in common words and phrases, not of the advertising nature, does not contain symbols, annotations and trade indications;
- b/ Field in which the industrial design is used, which is a specific field in which the product imbued with the industrial design is used, clearly stating the use purpose of the product;
- c/ The most similar industrial design: To clearly state an industrial design which is least different from the industrial design of the same product stated in the application and widely known before the filing date or the date of priority (if the application contains a claim for priority), indicating the information source publicly disclosing the most similar industrial design;
- d/ List of photos or drawings, which enumerates photos, three-dimensional drawings, shadows, cross-sections, etc., of the industrial design one after another according to the ordinal numbers of those photos or drawings;
- e/ The section of description of the industrial design must satisfy the following provisions:
  - (i) It fully discloses the nature of the industrial design sought to be protected, adequately showing design features presenting the nature of the industrial design as well as new design features that are distinguishable from the most similar industrial design defined at Point 33.5.c above and consistent with those shown in the set of photos or drawings;
  - (ii) Design features of the industrial design sought to be protected must be presented one after another in the following order: Configuration and

line features, correlation between configuration and/or line features, color features (if any);

(iii) For a product that have different usages (for example: a product with cover or foldable), its industrial design must be described in different states;

(iv) If an industrial design consists of many variations, distinctive characteristics of the basic variation (the first variation stated in the application) in comparison with those of remaining variations must be clearly indicated;

(v) If an industrial design is the design of a set of products, the design of each product in the set must be described.

f/ Coverage of protection (or claim for protection) of the industrial design must fully enumerate prerequisite and sufficient design features to identify the nature of the industrial design sought to be protected and the scope of industrial property rights to the industrial design, shown on photos or drawings stated in the application, and including new and distinctive design features as compared with known similar industrial designs.

### 33.6. Requirements for sets of photos or drawings of industrial designs

An applicant shall submit five sets of photos or five sets of drawings of an industrial design, sets of photos or drawings must fully present design features of the industrial design sought to be protected, based on which any person with average knowledge in the art can identify that industrial design, and follow the following guidance:

a/ Photos or drawings must be clear and well defined; drawings must be presented with unbroken lines; the background of a photo or drawing must be monochrome and contrast with the industrial design; a photo or drawing must show only the product imbued with the industrial design sought to be protected (not accompanied with another product).

b/ Photos or drawings must show the industrial design on the same scale. The size of the industrial design shown in photos or drawings must neither be smaller than 90 mm x 120 mm nor larger than 190 mm x 277 mm.

c/ Photos and drawings must show the industrial design viewed in the same direction and in the following order: three-dimensional picture of the industrial design, front, rear, right-side- left-side, top-down and down-top shadows of the industrial design; shown shadows must be frontispieces.

d/ For an industrial design with symmetrical shadows, its photos or drawings are not required to show more symmetrical shadows, provided that such is clearly stated in the list of photos and drawings in the description.

e/ For the industrial design of an expandable product (for instance: box, package), shadows of the industrial design may be replaced with photos or drawings of the industrial design in an expanded state.

f/ Depending on the complexity of an industrial design, more photos or three-dimensional drawings from other angles, cross-sections or magnified pictures of parts, pictures of knocked down components of the product, etc., may be required to clearly show new and distinctive design features of the industrial design sought to be protected.

g/ For a product that have different usages (for example: a product with cover or foldable), there must be photos or drawings of its industrial design in different states.

h/ For the industrial design of a part of a complete product, there must be more photos or drawings illustrating the position for fitting or use of such part on the complete product.

i/ For each variation of the industrial design, there must be a set of photos or drawings fully presenting it according to the provisions of this Point.

j/ For a set of products, there must be three-dimensional pictures of the whole set and a set of photos or drawings of each product in the set according to the provisions of this Point.

### 33.7. Design features of industrial designs

a/ Design features of an industrial design are elements presented in the form of lines, configurations, colors, position or size correlation, which constitute, in combination with other features (signs), a gathering necessary and sufficient for the formation of that industrial design.

b/ The following elements are not regarded as design features of an industrial design:

(i) Configurations and lines dictated by the technical functions of the product (for example: the flat shape of data-recording disks is dictated by the relative motion between disks and reading heads);

(ii) Elements whose presence in the combination of signs gives no aesthetic impression (impression of the shape of the product remains

unchanged with or without those elements; for example: if a change in a familiar configuration or line is not impressive enough to be noticed, the changed configuration or line will therefore be taken as old one);

(iii) Materials used for manufacture of the product;

(iv) Signs affixed or stuck on the product merely for the purpose of informing or guiding the origin, features, composition, utility and usage of the product, for example: words in a goods label;

(v) Size of the product, except for change of size of patterns of a fabric sample or similar materials.

#### c/ Substantial and insubstantial design features

Substantial design features are design features that are easily noticeable/memorable, necessary and sufficient to identify an industrial design and distinguish it from another one used for the same type of product.

Any design features that fail to satisfy the above condition are referred to as insubstantial design features.

### 34. Formality examination and publication of industrial design registration applications

Procedures for formality examination and publication of industrial design registration applications shall comply with the general procedures specified at Points 13 and 14 of this Circular.

### 35. Substantive examination of industrial design registration applications

#### 35.1. Assessment of similarity of industrial designs:

a/ Two industrial designs are considered identical when they are used for the same type of product and have the same gathering of substantial and insubstantial design features;

b/ Two industrial designs are considered similar when they are used for the same type of product and have several identical substantial design features;

c/ Two industrial designs are considered most similar when the number of their identical substantial design features is larger than that of all other similar industrial designs.



### 35.2. Order for carrying out procedures for substantive examination of industrial design registration applications

The substantive examination of industrial design registration applications (applications) shall be conducted according to the general order specified at Point 15 of this Circular and specific provisions of this Point.

### 35.3. Assessment of compatibility of objects stated in applications with the type of industrial design protection title

An object stated in an application shall be considered incompatible with the type of industrial design protection title when:

- a/ The object is not the appearance of a product;
- b/ The object stated in the application is:
  - (i) A product's appearance dictated by its technical characteristics;
  - (ii) A civil or industrial construction work's appearance;
  - (iii) Interior design (invisible part) of a product in use (exploitation of a product's utility by ordinary methods and by any consumer, excluding its maintenance, preservation or repair).

### 35.4. Information search

#### a/ Purpose of information search

The purpose of information search is to find in the mandatory minimum information source industrial designs identical or similar to the industrial design stated in the application.

b/ The mandatory minimum information source used in the substantive examination of an application consists of the following documents:

- (i) Industrial design registration applications already received by the NOIP and having dates of publications earlier than the filing date or date of priority of the examined application (if it enjoys priority);
- (ii) Industrial design registration applications and industrial design protection titles published by other organizations or countries within 25 years before the filing date or date of priority of the examined application (if it enjoys priority), which are archived in the NOIP's database on existing industrial designs;

(iii) Other information related to industrial designs collected and archived by the NOIP;

(iv) Industrial design registration applications received by the NOIP and having filing dates or dates of priority (if they enjoy priority) earlier than the filing date or date of priority of the examined application (used to inspect the observance of the first-to-file rule specified at Point 35.9 of this Circular).

c/ When necessary and possible, the search may be expanded beyond the mandatory minimum information source.

### 35.5. Search reports

Search results shall be presented in a search report that clearly states the searched field, search scope, search results within that scope (statistics on and clear indication of control industrial designs found, information sources and date of publication of information) and the full name of the report maker (search person).

At this point, a control industrial design means an industrial design identical or similar to the industrial design stated in the application and compared with the latter upon assessment of novelty and creativity.

### 35.6. Assessment of susceptibility of industrial application of industrial designs according to Article 67 of the Intellectual Property Law

a/ The industrial design stated in the application shall be considered susceptible of industrial application if any person with average knowledge in the art can, based on information on the industrial design supplied in the application, use that industrial design as a model to manufacture by an industrial or manual method a product with an appearance identical to that industrial design.

The concept “any person with average knowledge in the art” is understood according to the relevant provisions of Point 23.6.a of this Circular.

b/ In the following cases, the object stated in the application shall be considered insusceptible of industrial application:

(i) It is the shape of a product with an unfixed state of existence (products in gaseous or liquid form);

(ii) A product whose shape identical to the object stated in the application can only be created with special skills or it is impossible to repeatedly manufacture a product whose shape identical to the object stated in the application;

(iii) Cases where there exist other justifiable reasons.

35.7. Assessment of novelty of industrial designs according to the provisions of Article 65 of the Intellectual Property Law

a/ Method of assessment of novelty of industrial designs

To assess the novelty of an industrial design stated in an application, it is necessary to compare the gathering of substantial design features of that industrial design with that of an identical/the most similar industrial design used as a control industrial design found through the information search.

b/ Conclusion on novelty of industrial designs

The industrial design stated in an application shall be considered novel if:

(i) No control industrial design is found in the mandatory minimum information source; or

(ii) Though a control industrial design is found in the mandatory minimum information source but the industrial design stated in the application has at least one substantial design feature not found in (not belonging to) the gathering of substantial design features of the control industrial design; or

(iii) The control industrial design is the very industrial design stated in the application published/disclosed in the cases specified in Clauses 3 and 4, Article 65 of the Intellectual Property Law.

35.8. Assessment of creativity of industrial designs according to the provisions of Article 66 of the Intellectual Property Law

a/ Method of assessment of creativity of industrial designs

To assess the creativity of an industrial design stated in an application, it is necessary to compare the gathering of substantial design features of that industrial design with that of each identical or similar control industrial design found through the information search.

b/ Conclusion on creativity of industrial designs

In the following cases, the industrial design stated in an application shall be considered non-creative:

(i) It is a simple combination of known design features (publicly disclosed design features are put together or assembled in such a simple way as

replacement, interchange of positions, increase or decrease of quantity).

(ii) It is a reproduction/imitation of part of or the whole inherent natural shape of a tree, fruit or animal, shapes of geometric figures (round, ellipse, triangle, square, rectangular, regular polygons and prisms, cross-sections of which are foregoing figures), which are widely known.

(iii) It is a simple reproduction of the shape of a product or work well known or publicly known in Vietnam or worldwide.

(iv) It is an imitation of an industrial design in another field, if such an imitation is widely known in reality (for example: toys imitating cars, motorcycles, etc.).

If not falling into the above cases, an industrial design is considered creative.

### 35.9. Inspection of the first-to-file rule according to the provisions of Article 90 of the Intellectual Property Law

a/ To inspect the first-to-file rule, it is necessary to search information from the mandatory source defined at Point 35.4.b (iv) of this Circular.

b/ The industrial design stated in the application shall be considered satisfying the first-to-file rule if no identical or substantially indistinguishable industrial design is found in applications that have satisfied the conditions for grant of industrial design patents found through information search.

c/ The industrial design of a component of a product stated in the application shall also be considered satisfying the first-to-file rule if no identical or substantially indistinguishable industrial design of a component of a product and/or a product is found in applications that have satisfied the conditions for grant of industrial design patents found through information search.

d/ When different applications for registration of identical or substantially indistinguishable industrial designs satisfy the conditions for grant of industrial design patents and have the same date of priority or the earliest filing date, the industrial design stated in the application is still considered satisfying the first-to-file rule defined in Clause 2, Article 90 of the Intellectual Property Law if all applicants reach an agreement on designation of the applicant in only one application among those applications to be granted an industrial design patent.

[ANNEX II follows]

**ANNEX**



**WEBSITES FOR INFORMATION ON INDUSTRIAL  
DESIGNS IN THE ASEAN COUNTRIES**



## **ANNEX II**

### **WEBSITES FOR INFORMATION ON INDUSTRIAL DESIGNS IN THE ASEAN COUNTRIES**

#### **BRUNEI DARUSSALAM**

<http://www.bruipo.com.bn>

<http://www.bruipo.com.bn/index.php/information/lagislation/industrial-designs>

<http://www.bruipo.com.bn/index.php/information/forms-and-fees/industrial-designs>

<http://www.ecap3.org/ip-offices>

#### **CAMBODIA**

<http://www.ecap3.org/resources/cambodia>

<http://www.ecap3.org/ip-offices>

#### **INDONESIA**

<http://www.dgip.go.id>

<http://www.ecap3.org/ip-offices>

#### **LAO PDR**

<http://www.stea.la.wipo.net/index.html>

<http://www.stea.la.wipo.net/law/index.html>

<http://www.ecap3.org/ip-offices>

## **MALAYSIA**

<http://www.myipo.gov.my/web/guest/reka-bentuk-perindustrian>

<http://www.myipo.gov.my/web/guest/fullSite>

<http://www.ecap3.org/ip-offices>

## **MYANMAR**

<http://www.most.gov.mm/most2eng/ASEAN.do>

<http://www.ecap3.org/ip-offices>

## **PHILIPPINES**

<http://www.ipophil.gov.ph/index.php/services/design/about-industrial-design>

<http://www.ecap3.org/ip-offices>

## **SINGAPORE**

<http://www.ipos.gov.sg/AboutIP/TypesofIPWhatIsIntellectualProperty/WhatIsaregistereddesign.aspx>

<http://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>

<http://www.ipos.gov.sg>

<http://www.ecap3.org/ip-offices>

## **THAILAND**

[http://www.ipthailand.go.th/en/index.php?option=com\\_content&view=article&id=53&Itemid=169](http://www.ipthailand.go.th/en/index.php?option=com_content&view=article&id=53&Itemid=169)

[http://www.ipthailand.go.th/en/index.php?option=com\\_docman&task=category&view&gid=114&Itemid=169](http://www.ipthailand.go.th/en/index.php?option=com_docman&task=category&view&gid=114&Itemid=169)

<http://www.ipthailand.go.th/en/>



<http://www.ecap3.org/ip-offices>

## **VIET NAM**

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agentDisplayContent\)?OpenAgent&UNID=E2536468B308697D472576A1002F4DB1](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agentDisplayContent)?OpenAgent&UNID=E2536468B308697D472576A1002F4DB1)

Industrial designs overview

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agentDisplayContent\)?OpenAgent&UNID=DD54FE67CD78ECE4472576C500396CA3](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agentDisplayContent)?OpenAgent&UNID=DD54FE67CD78ECE4472576C500396CA3)

Industrial design examination procedure

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agentDisplayContent\)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agentDisplayContent)?OpenAgent&UNID=A3257F48CA99547A4725773100292BFB)

IP Legislation

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agentDisplayContent\)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agentDisplayContent)?OpenAgent&UNID=3B7C678BFD43BB3C4725767200218627)

Governmental Decrees

[http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms\\_en.nsf/\(agentDisplayContent\)?OpenAgent&UNID=D2945788E58A233F4725767200221575](http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agentDisplayContent)?OpenAgent&UNID=D2945788E58A233F4725767200221575)

Ministerial Circulars

<http://www.noip.gov.vn/web/noip/home/en>

<http://www.ecap3.org/ip-offices>

[ANNEX III follows]



**ANNEX**



**CONTACT DETAILS OF IP OFFICES OF ASEAN  
MEMBER STATES**



## ANNEX III

### CONTACT DETAILS OF IP OFFICES OF ASEAN MEMBER STATES

#### BRUNEI DARUSSALAM

Brunei Intellectual Property Office (BruIPO)  
Ministry of Energy, Manpower and Industry

Address:

Level 2 East Wing,  
Design & Technology Building,  
Simpang 32-37, Anggerek Desa, Jalan Berakas,  
Bandar Seri Begawan BB3713  
Brunei Darussalam

Phone: (673) 223 0111 or 238 0964

Website:

<http://www.bruipo.gov.bn>

#### CAMBODIA

Intellectual Property Department (IPD)  
Ministry of Commerce

Address:

Russian Federation Blvd, Toeuk Thla Village  
Sangkat Sen Sok, Khan Sen Sok  
Phnom Penh, Cambodia

Phone: (855 23) 211141 or 222504

Website:

<http://www.cambodiaip.gov.kh/default.aspx?lang=en>

## INDONESIA

Directorate General of Intellectual Property  
Ministry of Law and Human Rights

Address:  
Jalan H.R. Rasuna Said Kav. 8-9  
Jakarta 12940, Indonesia

Phone: (62 21) 57905517

Website:  
<http://www.dgip.go.id/>  
<http://laman.dgip.go.id/>

## LAO PDR

Department of Intellectual Property  
Ministry of Science and Technology

Address:  
P.O. Box: 2279, Nahaidiew Road,  
Vientiane Capital, Lao PDR

Phone: [\(856\) 21 253111](tel:+85621253111)

Website:  
<http://www.most.gov.la/index.php?lang=en>

## MALAYSIA

Intellectual Property Corporation of Malaysia (MyIPO)

Address:  
Unit 1-7, Ground Floor Tower B, Menara UOA Bangsar  
No. 5 Jalan Bangsar Utama 1  
59200 Kuala Lumpur, Malaysia

Phone: (603) 2299 8400

Website:  
<http://www.myipo.gov.my/en/myipo/>

## MYANMAR

Intellectual property Department  
Department of Research and Innovation  
Ministry of education

Address:  
Building No. 21  
Ministry of Education  
Nay Pyi Taw, Myanmar

Phone: (95 67) 404507

Website:  
<http://www.moe-st.gov.mm>

## PHILIPPINES

Intellectual Property Office of the Philippines (IPOP HL)

Address:  
Intellectual Property Center, 28 Upper McKinley Road,  
McKinley Hill Town Center, Fort Bonifacio  
Taguig City 1634, Philippines

Phone: (63 2) 2386300

Website:  
<http://www.ipophil.gov.ph/>

## SINGAPORE

Intellectual Property Office of Singapore (IPOS)

Address:  
51 Bras Basah Road, #01-01 Manulife Centre  
Singapore 189554

Phone: (65) 63398616

Website:  
<https://www.ipos.gov.sg/>

## THAILAND

Department of Intellectual Property  
Ministry of Commerce

Address:  
563 Nonthaburi Rd., Bang Krasor,  
Muang, Nonthaburi 11000,  
Thailand

Phone: (66 2) 547 4621 to 5

Website:  
<https://www.ipthailand.go.th/en/home-eng.html>

## VIET NAM

National Office of Intellectual Property of Viet Nam (NOIP)  
Ministry of Science and Technology

Address:  
386 Nguyen Trai St., Thanh Xuan Dist.  
Ha Noi, Viet Nam

Phone: (844) 3558 8217 or 3858 3069

Website:  
<http://www.noip.gov.vn/web/noip/home/en>





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