

Design Systems 外观设计保护制度

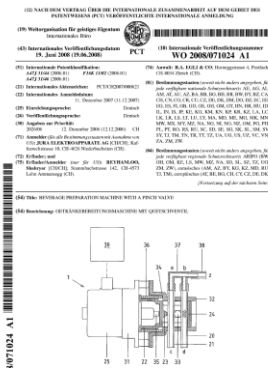
Registered Community Design vs. Chinese Design Patents 注册式共同体外观设计与中国外观设计专利的比较研究

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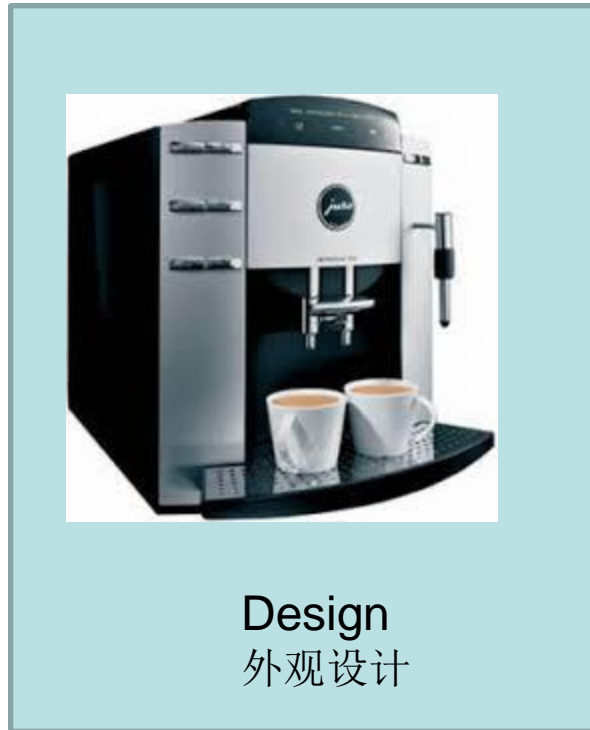
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IP Rights in a product – Strategy

产品涉及的知识产权 – 战略



Patent/Utility Model
专利/实用新型



Design
外观设计



Trademark
商标



Copyright
著作权

General Observations Design Patents – CN

中国外观设计专利的一般性观察

- In China designs are governed by patent law which is a relatively new concept in the country 外观设计在中国是一个相对来说很新的概念，在专利法下进行保护的
- However, IPR protection is considered to be an essential part of developing new innovative industries and sectors in the National IP Strategy 但是，知识产权保护是国家知识产权保护战略中对创新产业的发展必不可少的一部分
- Obtaining a design patent is a low-cost and relatively fast procedure without substantive examination before grant 外观设计专利的申请费用少，且因为无需实质审查，速度相对快
- High Popularity of the newly created systems 申请数量较多
 - Around one third of all patent applications are designs 占有所有专利申请的三分之一
 - By a factor of ten more design patents than any other office 比其他国家的申请数量能多达10倍

1. Laws and by-laws – CN 中国的法律法规

- Patent Law of the People's Republic of China (2008) 《专利法》
- Implementing Regulations of the Patent Law of the People's Republic of China (2010) 《专利法实施条例》
- Decision of SIPO On The Amendments of Guidelines for Patent Examination (2013) 《国家知识产权局关于修改〈专利审查指南〉的决定》
- Decision of SIPO On The Amendments of Guidelines for Patent Examination (2014) 《国家知识产权局关于修改〈专利审查指南〉的决定》
- Beijing Higher People's Court Guidelines for Determination of Patent Infringement (September 2013) 北京市高级人民法院《专利侵权判定指南》

1. Laws and by-laws – CN 中国的法律法规

- Decision of SIPO on the Amendments of Guidelines for Patent Examination (2013) 《国家知识产权局关于修改〈专利审查指南〉的决定》

In the preliminary examination, the examiner **shall examine whether a design application obviously does not comply with Article 23.1**, and may examine whether a design application obviously does not comply with Article 23.1 based on the obtained information of related prior design or conflicting applications. 初步审查中，审查员对于外观设计专利申请是否明显不符合专利法第二十三条第一款的规定进行审查。审查员可以根据其获得的有关现有设计或抵触申请的信息，审查外观设计专利申请是否明显不符合专利法第二十三条第一款的规定。

Where a design application might concern an **abnormal application**, such as an application obviously plagiarizing prior design or with repeatedly-submitted substantially identical content, the examiner **shall examine** whether the design application obviously does not comply with Article 23.1 **based on the prior art document obtained through search** or information obtained through other **approaches**. 外观设计可能涉及非正常申请的，例如明显抄袭现有设计或者重复提交内容明显实质相同的专利申请，审查员应当根据检索获得的对比文件或者其他途径获得的信息，审查外观设计专利申请是否明显不符合专利法第二十三条第一款的规定。

1. Laws and by-laws – CN 中国的法律法规

- **Decision of SIPO on the Amendments of Guidelines for Patent Examination (2014) promulgated March 12, 2104** 《国家知识产权局关于修改〈专利审查指南〉的决定》2014年3月12日发布
 - **Exclusion of electrified screen designs from patentability is now removed** 删除了电子屏幕设计不受专利保护的规定
 - **Dynamic (animated) graphical user interfaces are included** 新增动态图形用户界面保护
 - **Designs which are unrelated to human-machine interaction or product function will however remain unprotected under the revised examination guidelines** 与人机交互无关或者与实现产品功能无关的产品显示装置所显示的图案依然不受保护
 - **Excluded designs include video game interfaces, wallpaper, start-up and shut-down screens or graphic compositions in a web page.** 不受保护的设计包括电子屏幕壁纸、开关机画面和网站网页的图文排版

General Observations Community Design – EU

欧盟共同体外观设计的一般性观察

- One unitary design right covering 28 countries of the European Union (500 million inhabitants or 7.3% of the world population) coexisting with national rights 一个与国内权利共存的，覆盖欧盟28个成员国的统一权利
- Two-tier system of registered and unregistered community design rights 包括注册式与非注册式共同体外观设计的两极制
- Obtaining a registered design patent is a low-cost and extremely fast procedure without substantive examination before grant 注册式共同体外观设计的申请也是花费少，速度快
- Validity issues are rare, leading to high acceptance 有效性的争议较少，因此得到广泛认可

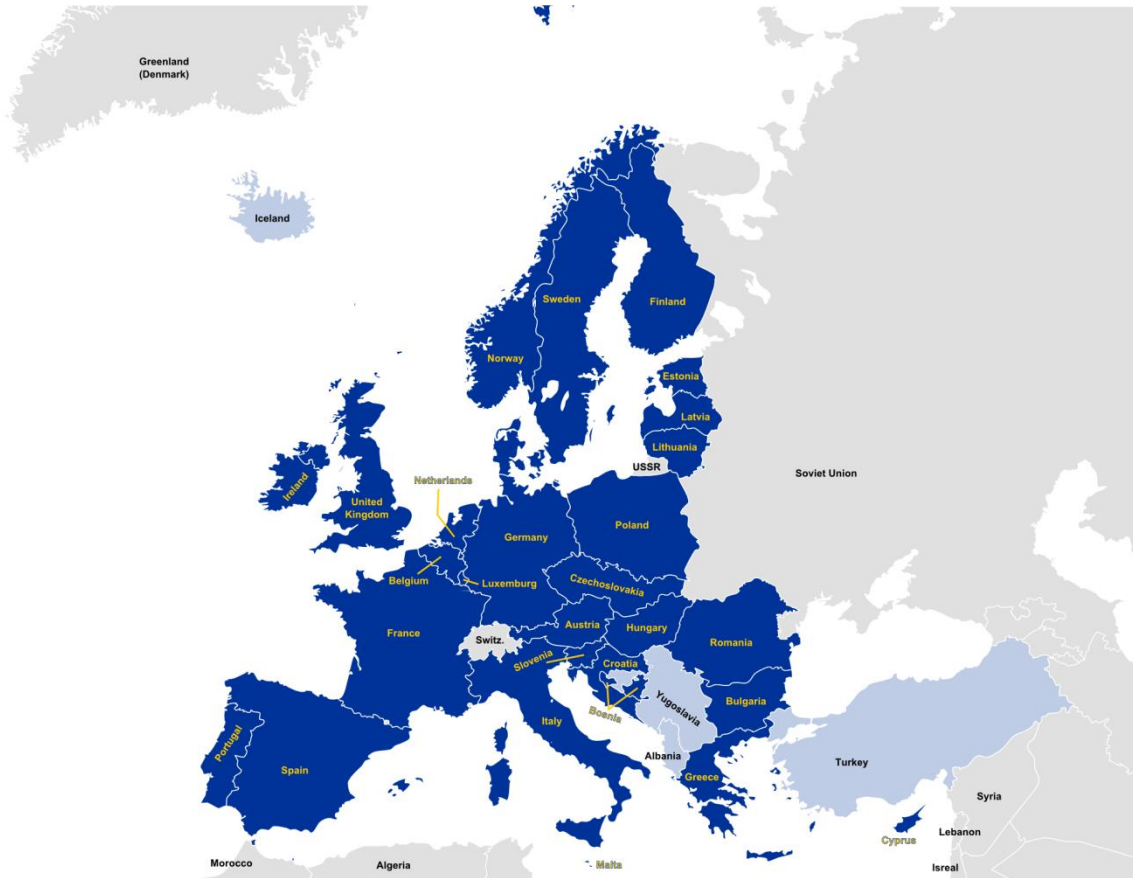
1. Legislative basis - EU 欧盟的法律基础

A Community Design is protected by Council Regulation, where a unitary industrial design right has equal effect across the European Union. 共同体外观设计受到欧盟理事会条例的保护，在整个欧盟范围内有效

- 1998 Directive 98/71/EC 欧盟指令
- 2001 Community Design Regulation (EC) No 6/2002 (“CDR”) 共同体外观设计条例
- 2006 Amended Community Design Regulation (EC) No 6/2002* 共同体外观设计条例修订版
- National laws of the 28 EU member states 28个成员国的国内法**

*It was amended by Council Regulation No1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs

1. Legislative basis - EU 欧盟的法律基础



Automatic addition
of new countries
对新成员国自动适用

2. Administrative Authorities 行政机关

CN 中国

SIPO (State Intellectual Property Office of the P.R.C) 中国国家知识产权局

- Design Examination Department of the Patent Office is for the examination of design patent application 专利局外观设计审查部负责外观设计专利申请的审查
- Patent Reexamination Board is for the examination of **invalidation** and reexamination 专利复审委员会负责无效审查和复审

EU 欧盟

OHIM (Office for Harmonization in the Internal Market) 欧盟内部市场协调局

- Design Examination Department of the Patent Office for the examination of registration and **invalidation** OHIM 外观设计和注册部负责外观设计的注册和无效的审查
- Board of Appeal is for the examination of the appeals 申诉委员会负责申诉案件的审查

Qualification for protection

保护的條件



Definition of a design - CN 中国外观设计的定义

■ Article 2 of Patent Law 专利法第二条

‘Design’ means any new design of the **shape**, the **pattern**, or their combination, or the combination of the **color with the shape or pattern, of a product**, which creates an aesthetic feeling and is fit for industrial application. 本法所称外观设计，是指对产品的形状、图案或者其结合以及色彩与形状、图案的结合所作出的富有美感并适用于工业设计的新设计。



Article 25(6) Patent law: Exclusion of designs of two-dimensional printing goods, made of the pattern, the color or the combination of the two, which serve mainly as marks. 第25（6）条排除了对平面印刷品的图案、色彩或者二者的结合作出的主要起标识作用的外观设计的保护

Definition of a design – EU 欧盟外观设计的定义

Article 3(a) of Council Regulation 第三条 (a) :

‘Design’ means the **appearance** of the whole **or a part** of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/ or materials of the product itself and/or its ornamentation. 外观设计是由线条、轮廓、色彩、形状，产品自身和（或）其装饰物的纹理和（或）材料等特征所产生的整个产品或者其中一部分的外观



lines



colours



shape



texture



contours



materials



ornamentation

Visible 可视性

Designs have to be visible to claim the protection. 具有可视性的外观设计才能受到保护

CN: 中国

'aesthetic feeling' not only implies certain degree of beauty, but also shows the visibility of the design, product must be perceived by visual senses or be determined with the naked eye ‘美感’的要求不仅意味着设计要有一定的美学特征，也反应出外观设计要具有可视性，可以被肉眼观察到

EU: 欧盟

Art 3 CDR 'appearance' implies a design is what we can see and something visible ‘外观’表示设计必须是能看到的

Art 4 CDR excludes protection for non-visible component parts of complex products 排除了对复杂产品不可视的内部零件的保护

Product 产品

- CN: Design is for a product. A design draw on a plain paper may be protected as a copyright work. A design printed on the wallpaper may be a design patent. 外观设计是产品的外观设计。白纸上的设计图可能是著作权保护的客体，印在壁纸上出售的设计可能构成外观设计专利
- CDR Art 3(b) : Any industrial or handicraft items 任何工业或手工业品



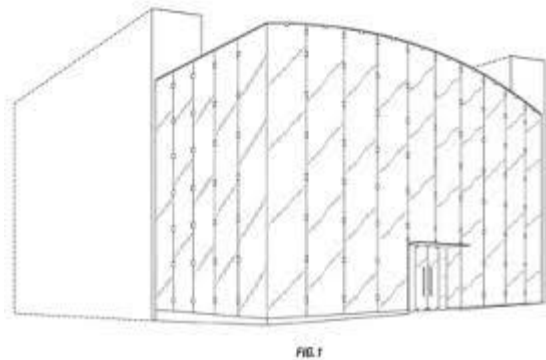
Example Cultural & Creative Industry – Architecture

创意文化产业方面的事例 – 建筑

- CN: Guidelines for Examination (Part I, Chapter 3 6.4.3) excludes fixed building which depends on its specific geographic condition and cannot be rebuild elsewhere 审查指南（第一部分，第三章 6.4.3）排除对处于特殊地理环境、不能再它处重建的固定建筑物的保护
- EU: A ‘product’ means any industrial or handicraft item etc. ‘产品’指任何工业或手工业品
- EU: Buildings are in class 25 of the Locarno Classification 建筑是洛迦诺分类表第25类
- EU: Blueprints, plans for houses or other architectural plans will be considered ‘products’ and will be accepted only with corresponding indication of ‘*printed matter*’ in Class 19 of the Locarno Classification 蓝图，房屋或其他建筑计划可被视为“产品”，但只有当作为洛迦诺分类表第19类的‘印刷物’才受到保护

Example Cultural & Creative Industry – Architecture

创意文化产业方面的事例 – 建筑



Patent for building?
建筑专利?



Color 颜色

- Mere color cannot be protected as a design. A combination of color and shape/pattern is ok. 单一的色彩不能作为外观设计受到保护。颜色与形状或图案的组合是可以的。



Merely functional 仅具有功能性

- **EU: Article 8 (1) CDR**

A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function. 仅有其技术功能所决定的外观特征是不能注册为共同体外观设计的。

Art 8(2) also excludes “must-match” and “must-fit” designs 排除了 ‘必须匹配’ 设计

- **CN**

No clear requirement. Same may be concluded from “aesthetic feeling” requirement. 尚无明确规定，但从 ‘美感’ 可推测也具有相同的要求

Merely functional - Exclusion of spare parts in EU

仅具有功能性 – 在欧盟备件排除

Directive 98/71/EC

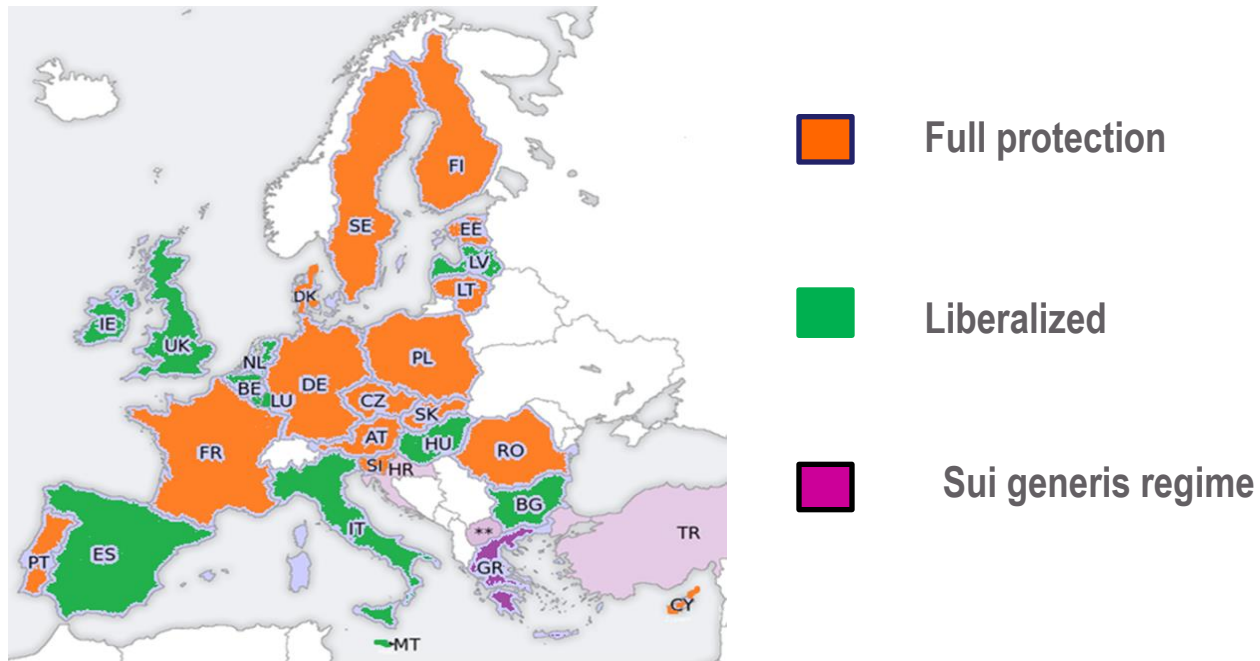
Article 14: Member States **maintain existing legal protection** as to the use of spare parts for repair with the possibility of modification if it leads to the liberalization of the market. 各成员国保留现有法律中对可能导致市场的自由化的具有改造可能性的维修备件的使用进行保护的规定。



Merely functional – spare parts in the countries

仅具有功能性 – 在各成员国备件的保护情况

Spare parts – National situation 备件 – 各国的情况



Merely functional – spare parts 仅具有功能性 – 备件

▪ Spare part? 备件?



000032438-0004



000609458-0006



000304274-0004



000936281-0005

- component of a complex product?
复杂产品的部件?
- dependent upon the appearance of a given complex product? 取决于特定复杂产品的外观?
- same appearance generally used for the purpose of repair? 维修备件的通常形状?
- was the component of the same appearance fitted at the moment when the producer lost control over the complex product? 当生产者不再控制复杂产品时与原部件外形相同的备件?

Requirements – CN 中国的保护要件

Novelty 新颖性

no **prior design**, no **prior application** relating to the identical design

不属于现有设计且不存在抵触申请

Significantly differ from prior design or **combination** of prior design features 与现有设计或者现有技术特征的组合相比具有明显区别

(“inventive step” overcome by “unique visual effect” ‘创造性’ 战胜 ‘独特视觉效果’)

Not in conflict with the **existing legitimate right** 不得与他在取得的合法权利相冲突

Requirements – EU 欧盟的保护要件

1. Novelty (Art 5 CDR)

no prior identical* design; 无相同的外观设计

* Design shall be deemed to be identical if their features differ only in immaterial details. 若外观设计仅在非重要细节上有不同，则其应视为相同

2. Individual character (Art 6 CDR) 特征性

- the **overall impression** it produces on the **informed user** differs from the overall impression produced on such a user by any design which has been made available to the public 知情用户在浏览外观设计时对其他任何现有的公之于众的外观设计有明显不同的整体印象
- the **degree of freedom** of the designer in developing the design 设计者在开发外观设计时的自由程度

Requirements – EU 欧盟的保护要件

- Interaction between “same overall impression” and “degree of freedom of the designer” 相同整体印象与设计自由度的交叉
- (+) Interaction between “degree of freedom of the designer” and finding “different overall impression” 或设计自由度与不同的整体印象的交叉
- (+) “Same overall impression” (+) if designs do not have “significant differences” (in case of high degree) 或相同整体印象或设计没有‘明显区别’（当设计自由度较高时）

Made available to public – CN 中国的‘公开’

Article 23:

The prior design referred to in this law means any design known to the public before the date of filing in **China or abroad**. 本法所称现有设计，是指申请日以前在国内外为公众所知的设计。

(Absolute Novelty绝对新颖性)

Made available to public – EU 欧盟的‘公开’

CDR Art 7 Disclosure 披露

- ‘In the sector concerned’ 在相关行业 -- wide approach
- EU + outside EU 欧盟内外

Case: Green Lane Product v PMS [2008] FSR 1 案例

- the sector that consists of or includes the sector of the alleged prior art, not limited to the sector specified for which the design is applied for 包括但并不限于应用该被指认的现有设计的特定的行业
- i.e., use of spiky balls as massage balls **could be** taken into account when assessing validity of spiky balls as dryer balls 例如，在判定烘干球的设计有效性时有可能考虑到这种球作为按摩球的使用对其的影响

How to compare – CN 在中国怎么比较

Normal consumer 普通消费者

- End user or Purchaser? 最终用户还是购买者?
- Supreme Court decisions in 2010 increased the requirements of the capabilities of general consumer saying the general consumer shall have the common sense understanding of the products in the same class or category and even knows design trends 2010年《专利审查指南》增加了对常用设计手法了解的能力，使得一般消费者的能力有所提高。根据其规定，一般消费者应当具备两方面的能力，即对同类产品的常识性了解的能力和对产品外观设计之间区别的一般识别力
- Move towards “informed user”? 更接近知情用户?

How to compare – CN 在中国怎么比较

Supreme Court Case *Honda 2010* 最高院本田案

Principle: Overall observation and comprehensive judgment

整体观察，综合判断



“freedom to design” known 了解设计自由度

The Supreme Court revoked the first and second instance judgments on the invalidity decision, saying the changes in the sectional design features rather than the design of the vehicles as a whole is what would draw the general user's attention. 最高院认为一般消费者会更加关注汽车的前面、侧面、后面等部位的设计特征的变化而非此类汽车的外形轮廓。

How to compare – EU 在欧盟怎么比较

Informed user 知情用户

- Be aware of existing ‘design corpus’ 对该领域内的相关设计有一定的了解
- Will know where design freedom is limited by functional concerns 知道设计自由度受限于产品功能
- Unlike the relevant consumer for TM law, the informed user does not suffer from imperfect recollection, because he can compare the two designs side-by-side 与商标法中的消费者不同，这里的知情用户因为可以直接把东西放在一起比较，其并不会因对产品来源产生误解而选错产品 (Proctor & Gamble v. Reckitt Benkiser [2008] FSR 8)
- In short, it is normally the people between the average consumer and the experts in the sector concerned 一般介于普通消费者和行业专家之间
 - Consequence 结果
 - : no extensive design expert opinions 并不需要设计专家的意见
 - minimal differences will not suffice to exclude infringement claims 只有设计专家才能观察到的细微差别并不足够摆脱侵权之诉

How to compare – EU 在欧盟怎么比较

Overall impression

▪ ‘... the overall impression of a design is what sticks in the mind after it has been carefully viewed. ... the task of the informed user is to reach an overall impression of each of the two(or more) designs and then to ask whether those overall impression differ ’

...整体印象是消费者在仔细观察事物之后在脑子里留下的对外观设计印象...应该在知情用户看过两个设计并分别有了整体印象之后，再问他们这两个整体印象是否有不同之处。

(Lewinson J. in case P&G v Reckitt Benckiser [2007] EWCA Civ 936)

Case 'Fiat' v 'Great Wall'

菲亚特诉长城案



0001.2

0001.3

0001.4



0001.5

0001.6



Fiat Panda

Great Wall Peri



The Italian Court 意大利法院判决

- Considered the two models and took into account a report by a **technical expert witness** on the comparison of the two car designs 考虑了技术专家证人对两个汽车设计的对比报告
- “Overall impression” refers to how individual parts influence the impression on the final form of the design. Under this **broad test**, the two models need not be identical in design so long as the overall impression is similar ‘整体印象’ 指的是每一个单独部件对外观设计最终整体外形的影响。在这个宽泛的检验标准下，当两个设计的整体印象相似时，只要他们不是完全相同就可以。
- The degree of freedom: standard design does not mean no space or chance for creation. Various combinations may be available and lead to difference. 设计的自由度：标准设计并不意味着没有创造的空间。设计者依然可以通过选择不同的组合达到不同的设计效果。
- *Held:* the GW Peri does not look like a different car but is a Panda with a different front end and granted a preliminary injunction 法院认定GW Peri与Panda仅在前端不同，授予临时禁令

The China Court 中国法院判决

- The significant differences in the front end and the rear part were what the **consumers** were most concerned about and that such remarkable differences would not mislead consumers to confuse the **two models**. 消费者最关注的是前端和后部的显著差异，而这种显著差异不会造成消费者的混淆。
- *Held:* remarkable differences on the front view, and there is no infringement 有显著差别，不侵权
- *Note,* this is the judgment before 2008, while the newer case of *Honda 2010* shows the tendency that the method adopted by China court **is approaching** the method adopted in the EU, but still coming to the same result 注意，这是2008年之前的判决，上述的本田案是10年的案例。从中可以看出中国法院采用的判断方式有向欧盟方式接近的趋势，尽管两个案子的结果还是一样的。

The scope of the Right/Protection 权利保护的范围

- Territory :
China mainland 中国大陆 vs EU 28 member states 欧盟
28个国家
- Duration :
CN: 10 years 十年 vs
EU: 5years, renewable 4 times, up to 25 years 5年-25年
- Same in exclusive rights to use and to prevent unauthorized use , but 'use' is different 授予的都是专有权利，可以阻止未经许可的使用，但对‘使用’的规定有所不同

Exclusive rights – CN 中国的专有权

- Article 11: After the grant of the patent for a design, no entity or individual may, without the authorization of the patentee, exploit the patent, that is, make, offer to sell, sell or import the product incorporating its or his patented design, for production or business purposes.
- 第11条：外观设计专利权被授予后，任何单位或者个人未经专利权人的许可，都不得实施其专利，即不得为生产经营目的制造、销售、许诺销售、进口其外观设计专利产品。

Exclusive rights – EU 欧盟的专有权

- Article 19(1) CDR: A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, **in particular**, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.注册式共同体外观设计赋予权利人排他性使用权，并阻止任何第三方在欧盟境内未经同意使用该外观设计。该使用特别包括对该外观设计或者其应用的产品制造、许诺销售、市场投放、进口、出口或使用该外观设计的产品，或者为了前述目的而存储该产品等。
- Note: Exhaustion in EU 在欧盟权利穷竭

Application for a RCD or Design Patent

申请



Where to apply 去哪里申请

- CN:

One choice, SIPO (Art.3) 唯一选择

- EU:

Three choices - OHIM ; national office; Benelux Design Office, convenient and **no** significant delays as the offices shall forward the application to the OHIM within 2 weeks (Art. 35)

三种选择

Materials – CN 中国申请材料

Must (Art. 27):

- Request 请求书
- **Drawings or photographs** of the design 该外观设计的图片或者照片
- Brief explanation 对该外观设计的简要说明
 - Potentially allows to better protect design features that are incorporated as parts of products (amended 2008) 可能对产品部件的设计特征的有更好的保护
 - Potentially causes problems when interpreting the scope (limitation?) 解释保护范围时可能会有问题

May:

- Sample or model 模型

The extent of protection – CN 中国权利的范围

Art 59(2) of Patent Law:

- The extent of protection of the patent right for design **shall be determined by** the design of the product as shown in the **drawings or photographs**. The brief explanation may be used to interpret the design of the product as shown in the drawings or photographs.
- 专利法第59条第2款：外观设计专利权的保护范围以表示在图片或者照片中的该产品的外观设计为准，简要说明可以用于解释图片或者照片所表示的该产品的外观设计。

Materials – EU 欧盟申请材料

Must (Art 36):

- a) Request for registration 注册请求
- b) Information identifying the applicant 申请人的身份信息
- c) **Representation** of the design suitable for reproduction or the specimen 外观设计适合复制再现的**表述**
- d) Indication of the products 进一步的说明

May:

- a) A description explaining the representation or the specimen 对表述或样本的描述
- b) The classification of the products 产品的分类
- c) ...

The extent of protection – EU 欧盟权利的范围

Art. 36(6) CDR

- The information contained in the elements mentioned in paragraph 2 and in paragraph 3(a) and (b) shall not affect the scope of protection of the design as such. 第2款、第3款(a) (b) 项所提到的要件的信息在字面上不得影响外观设计受保护的範圍
- I.e., the representation is what limits the scope of the protection to a design 表述 限定着外观设计的保护範圍

Applications – CN 中国的申请方式

- a) one design 一项外观设计
- b) **similar** designs for the **same** product 同一产品两项以上的相似外观设计
- c) designs for **set** products in the same class 用于同一类别且成套出售或使用的产品的两项以上的外观设计



Applications – EU 欧盟的申请方式

- a) Registered Community design 注册式共同体外观设计
- b) Several designs may be combined in one multiple application; except **ornamentation only** for the same class products 多项申请可以包含多个外观设计，作为装饰物时有例外

Note: multiple application leads to different fees and can be dealt with separately. (Article 37 (4)) 多项申请会产生不同的费用，其中的每一项外观设计应被分别对待

The submission approaches 材料的提交方式

CN:

- a) Personally hand in to the counter or via an agency 窗口递交
- b) By Mailing 邮寄

EU:

- a) Personally hand in to the counter of the offices 窗口递交
- b) By Mailing 邮寄
- c) By fax and then hand in the originals within one month 先传真，后在一个月內补交材料

Fee structure 费用

China

- RMB 500, combined application is regarded as one piece of application 500元，合并申请视为一件申请

EU:

- Registration € 230, additional registration 2 to 10 = € 115, > 11 = €50
注册费230欧；在多项申请时，增加一项115欧（第2-10项）或50欧（第11项之后）
- Publication € 120, additional publication 2 to 10 = € 60, > 11 = €30
公布费120欧；在多项申请时，增加一项60欧（第2-10项）或30欧（第11项之后）
- Deferment of Publication € 40, additional publication 2 to 10 = € 20, > 11 = €10
延迟公布费 40欧；在多项申请时，增加一项20欧（第2-10项）或10欧（第11项之后）

Grace period 宽限期

- **CN: 6 month, but only if** 申请专利的发明创造在申请日以前六个月内，有下列情形之一的，不丧失新颖性：
 - a) **at an international exhibition;**在中国政府主办或者承认的国际展览会上首次展出的；
 - b) **at a prescribed academic or technological meeting;**在规定的学术会议或者技术会议上首次发表的；
 - c) **was disclosed without consent (vindication)** 他人未经申请人同意而泄露其内容的

- **EU: 12 months 12个月**
(own commercial use or vindication) (Article 7(2)) 自己商业使用或) 他人未经申请人同意而泄露其内容的

Priority 优先权

- CN:
 - Convention priority of 6 months for prior foreign filings 根据公约规定的对6个月内的国外申请
- EU:
 - Convention priority of 6 months for earlier design or utility model filing根据公约规定的对6个月内的国外外观设计或实用新型申请
 - Additionally: exhibition priority (Art. 44 CDR) 展览优先权

Case: Bundesgerichtshof (Pastry Press) (I ZR 126/06): 糕点工坊案

Plaintiff : Chinese manufacturer 原告是中国公司

- being granted design patent in 2002, China for its pastry presses 2002年在中国获得外观设计专利
- supplying pastry presses to a UK-based company between June and October 2002 2002年6到10月向某英国公司提供商品

Defendant: German company 被告是德国公司

- marketing identical pastry press 制造相同的产品

Case: Bundesgerichtshof (Pastry Press) (I ZR 126/06): 糕点工坊案

- **The Federal Supreme Court** : the wording of the provision does not exclude the possibility of the disclosure taking place outside the Community, provided the design can become known to the relevant specialist circles in the Community. 联邦最高法院：从条款的用词来看，其并未排除在欧盟之外的公开构成“披露”的可能性，因为欧盟内相关专家仍有可能知晓该设计。
- **Regulation amended in 2004** 04年修改了条例
- **Art.110a(5) ... Pursuant to Article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design.** 根据第11条，在共同体境内为公开的外观设计不得作为非注册式外观设计受到保护。

Practical Advice 建议

Register the design in OHIM within one year when it is disclosed publicly outside EC, as first disclosure outside EC does not lead to UCD protection, but ruin the novelty and the RCD protection.

企业应该在外观设计在中国公开使用的12个月内向OHIM申请注册式共同体外观设计，因为在欧盟之外的披露不仅不会得到非注册式共同体外观设计的保护，反而会影响新颖性和注册式共同体外观设计的保护。

Side note on UCD 非注册式共同体外观设计值得注意的点

- **Unregistered Design** 非注册式共同体外观设计
- **Important for a few industries with short design life cycles** 对设计寿命较短的产业很重要
(e.g. creative fashion industry 例如时装产业)
- **Has serious limitations over registration** 对其稍后注册有很大的限制:
 - 3 year term only 必须在3年内
 - protects only against direct copy 只保护直接抄袭
 - difficulty in providing evidence of first use 很难提供初次使用的证据

Examination 检查

- CN: Preliminary examination 初步审查

Duration: approx. 8 months 8个月

- EU: Examination as to formal requirements for filing (Article 45) 只审查是否符合申请要件

Requirements for representation before the office 代理人要求

Required for foreign applicants 对国外申请者的要求 (except filing in EU 欧盟境内的申请有例外情形)

- CN: Properly approved patent agencies 被批准的代理
- EU: Art. 78 CDR
 - Lawyers of the member states 成员国的律师
 - Professionals listed as professional representatives for community design or trademark matters 列表内的具有从事外观设计和商标事宜资格的专业人员

Example: UK lawyer 英国律师 (yes)

German Patent Attorney 列表上的德国专利代理人 (yes, if listed)

European Patent Attorney 欧盟专利代理人 (no)

Invalidation 无效

■ Relevant Authority 相关机构

– CN:

- Patent Reexamination Board of SIPO 专利复审委员会
- Administrative litigation in the Beijing Courts 北京法院，如果是行政诉讼
- Supreme Court 最高院

– EU: Two Ways

- | | |
|--|--|
| • OHIM*
欧盟内部市场协调局 | 1st inst. Design court (DE: Landgericht)
德国第一外观设计法院 |
| • Board of Appeals**
申诉委员会 | 2nd inst. Design Court (DE: Oberlandesg.)
德国第二外观设计法院 |
| • General Court of EU
欧盟普通法院 | DE: Federal Supreme Court
德国联邦最高法院 |
| • Court of Justice
欧盟法院 | (all can refer to Court of Justice)
所有都可以移交到欧盟法院 |

*Invalidation rate 无效判决率: 60 %

**Confirmation rate 确认率: 50 %

Invalidation – CN 中国的无效

- Main ground for invalidation: Identity or similarity compared with a prior right (Art. 23) 主要无效原因是与现有设计相比无明显区别
- Supreme People's Court (Midea vs GREE) 最高院美的诉格力案
- Attention should be given to the overall visual similarities rather than to the partial effects generated by the distinguishing features 关注点应该是整体视觉的相似之处而不是突出特征产生的部分效果

Enforcement China 中国的执法现状（救济手段）

- Litigation in the courts 诉讼
 - Injunction 禁令
 - Damage award 损害赔偿
 - Loss of patentee 专利权人的损失
 - Infringer's gains 侵权所得
 - Royalty based 许可费
 - Statutory (RMB 1,000,000) + plus attorney cost 法定（1百万）+代理费用
- Administrative complaint 行政投诉
 - No damage award, but fines possible 没有损害赔偿，可能有罚款
 - Seizure of goods 扣押商品

Enforcement China 中国的执法现状（救济手段）

- Pre-action rights 预行动
 - Preliminary injunction (within 48 h, if request is complete) 临时禁令
 - Evidence preservation order 证据保全
- Complexity 复杂点
 - Evidence preservation 证据保全

Enforcement China 中国的执法现状

- **Beijing Higher People's Court Guidelines for Determination of Patent Infringement (September 2013), Section 70. to 86.**北京市高级人民法院《专利侵权判定指南》（2013），第70-86条
 - **Infringing design must be in same or similar class to be determined by its use**应当根据外观设计产品的用途（使用目的、使用状态），认定产品种类是否相同或者相近。
 - **Normal consumer with defined knowledge and cognitive capability**一般消费者的知识水平和认知能力为判断标准
 - **Whole observation and comprehensive judgment** 整体观察、综合判断为原则
“clearer standard ” 更为清楚的标准
 - **Overall visual effects determined by**对外观设计的整体视觉效果更具有影响的是：
(1) the part which can be easily viewed directly in the normal use of the product compared with other parts产品正常使用时容易被直接观察到的部位相对于其他部位; or(2) design features of a design which are distinct from those of the existing designs外观设计区别于现有设计的设计特征相对于外观设计的其他设计特征

Enforcement China - The Neoplan case 尼奥普兰案

Neoplan Starliner



Zhongda A9 coach



- Notarized Purchase of 1 mio RMB 1百万元的公证购买
- High damage award (Beijing No. 1 court, 2009) 高额的损害赔偿:
 - RMB 20 million plus RMB 1.16 million for Neoplan's legal costs
2000万元经济损失赔偿及116万元诉讼合理支出

but, novelty issue which let to invalidation (2012) 12年的无效审理解决了新颖性问题

Enforcement Registered Community Design

注册式共同体外观设计的实施

- **Litigation in the community design courts (A. 82, 83 CDR) 在共同体外观设计法院的诉讼**
 - At the state of domicile 住所地
 - Defendent's domicile (if in member state) 原告所在地（如果是欧盟成员国）
 - Plaintiff's domicile (if in member state) 被告所在地（如果是欧盟成员国）
 - OHIM's location (if none is in member state) 原告所在地（如果都不是欧盟成员国）
 - At the place of actual or threatened infringement 实际或可能侵权发生地
 - No community wide decision; “no spider in the net” 决定并不在欧盟全境有效
- **Sanctions (A. 89 CDR, national laws) 制裁**
 - Injunctions 禁止令
 - Seizure of goods and specific manufacturing equipment 扣押侵权产品及其制造机器
 - Damages according to national laws 成员国法律规定的其他制裁

Enforcement Registered Community Design

注册式共同体外观设计的实施

- **National laws become applicable** 国内法的适用
 - Cost 诉讼费用
 - Quality 质量
 - Predictability 可预测性
- **Locally experienced counsel needed** 需要有经验的当地法律顾问
- **Decision on cost** 费用分配的判决

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- The registered design 注册号
No. 000181607



0001.2



0001.3



0001.4



0001.5



0001.6



0001.7



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- The accused infringing product 被控侵权产品



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

■ Disputed points 争议点

- Jurisdiction of the court for all of Europe? 法院是否具有全欧盟的管辖权?
- Urgency for the Preliminary Injunction? 临时禁令的紧迫性?
- Validity? 有效性?
 - Inconsistent drawings 不一致的绘图
 - Merely technical features 仅仅具有功能性的特征
 - Prior art 现有设计
- Infringement? 侵权?

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- **Jurisdiction of the court for all of Europe?** 法院是否具有全欧盟的管辖权？
- Respondents are Korean company and branch office 被告是韩国企业和其在德国的分支
- **Is the branch office an “establishment” under Article 82(1) CDR?** 德国分支是否构成CDR第82（1）条意义上的‘机构’？
 - Joint management structures 联合管理
 - Joint use of Samsung brand on internet & trade fairs 在网络和商会上共同使用三星品牌
 - **BUT, branch as legal entity entered into agreements and issued invoices in its own name** 但是，该分支是作为独立法人与他人订立合同的，并以自己的名义出具发票的

Therefore: No international jurisdiction outside Germany of the adjudicating court.
因此，德国法院在德国之外无管辖权

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Urgency for the PI? 临时禁令的紧迫性?
 - Uncertainty to what German design would look like 不能确定德国的设计会是什么样
 - Introduction in the US is no indication of what German product would look like 并不能从美国的公开介绍中得知德国销售的产品会是什么样
 - Country modifications exists 在不同国家销售的产品在设计上会有不同
 - Earliest publication is in consumer magazine 之前是在消费者杂志上的公开
 - This publication is less than 4 weeks before filing of the PI (even though 8 weeks may be allowed by the court) 必须是在申请临时禁令4个星期内的公开（尽管法院仍有可能允许8个星期内的申请）

Therefore: A finding of urgency cannot be denied

因此认定：确实具有紧迫性

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

Article 6 (1) CDR

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public (...) before the date of filing the application for registration or, if a priority is claimed, the date of priority. 知情用户在浏览外观设计时对其他任何现有的公之于众（... 在提交注册申请的日期之前，如果要求优先权，则在优先权日期之前）的外观设计有明显不同的整体印象

Article 6 (2) CDR

In assessing individual character, **the degree of freedom of the designer in developing the design** shall be taken into consideration. 在评价特征性时，应当考虑设计者在开发外观设计时的自由程度

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

“(…) the greater the designer’s freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer’s freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user.” 设计者的自由度越高，设计之间的微小差别就越不容易给知情用户留下不同的整体印象。相反，设计自由的制度越大，设计之间的微小差别就越可能给知情用户留下不同的整体印象。

General Court 普通法院

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Inconsistency of the drawings 不一致的绘图

One design? What was intended to protect? 一项外观设计？要保护的是什么？

Abb. 0001.6



Abb. 0001.7



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Merely technical feature? 仅仅具有功能性的特征?

Conclusion: 结论

Minimalistic design can be a novel design

简单化的设计可以是新的设计



0001.2



0001.3



0001.4



0001.5



0001.6



0001.7



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Prior Art 现有设计



HP Compaq
惠普的Compaq



Knight Ridder

Science fiction movie 科幻电影



Jonathan Ive, Apple's British designer-in-chief, could well have been inspired by John's fondness. Born in 1967, he was aged between six and 12 when The Tomorrow People was shown.

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Infringement ? 侵权?

Article 10 (1) CDR

The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression. 共同体外观设计的受保护范围应包括任何外观设计，该等外观设计不会对知情用户造成不同的整体印象。

Article 10 (2) CDR

In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration. 在评估受保护的范范围时，应当考虑设计者在开发外观设计时的自由程度。

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Infringement ? 侵权?

“**A great concentration of designs** and, thus, only little freedom of the designer **will lead to a narrow scope of protection of the design** so that minor differences in appearance may produce a different overall impression on the informed user. In contrast, **a low concentration of designs** and, therefore, a great freedom of the designer **will lead to a broad scope of protection** of the design so that even major differences in appearance may not produce a different overall impression on the informed user.” 设计很集中时，设计师自由度很小，就会导致设计的保护范围很小，以至于产品外观的微小差别足够给知情用户造成不同的整体印象。相反，设计不集中，设计师有很大的设计自由时，外观设计的保护范围就会很大。那么即使产品外观的差别很大也不能够给知情用户造成不同的整体印象。

German Federal Supreme Court 德国联邦最高法院

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Infringement 侵权 “large degree of freedom for design” 很大的设计自由度



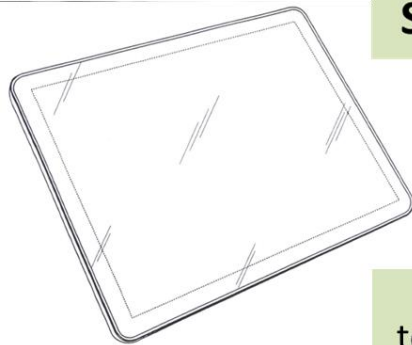
Direct comparison

直接对比



**Infringement:
Same overall impression?**

侵权？
相同的整体印象



Particularly decisive:
top view and oblique view

部分比较：
俯视图斜视图



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- Infringement侵权 “large degree of freedom for design” 很大的设计自由度



**Infringement:
Same overall impression?**



Direct comparison

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

■ The decision 判决

On penalty of an administrative fine of up to EUR 250,000.00 to be imposed by the Court for each instance of non-compliance—or confinement for contempt of court if the fine cannot be collected—

or, 25万欧元的行政罚款或未交罚款时的蔑视法庭的监禁

alternatively, confinement for contempt of court for up six months or蔑视法庭的6个月监禁

confinement for up to two years for repeated non-compliance 多次不履行时的两年监禁 (the latter to be enforced against the Respondents' legal representatives 对被告法人代表的处理),

- the Respondents, are prohibited from using any computer products, in particular, from manufacturing, offering for sale (including advertising), bringing to market, importing, exporting and/or possessing same for any of the above purposes, where such products have the following characteristics: {...} as illustrated below

被告被禁止在未来使用该电脑产品, 尤其是, 不可以制造、许诺销售(包括广告)放入市场、进出口和(或)为上述目的的存储,如果该产品有如下特征: ...



- The amount in dispute is € 2,000,000, of which € 1,000,000 is attributable to each Respondent, and the amount attributable to the Federal Republic of Germany included therein, was assessed at € 200,000 in the decision on costs. 总费用为2百万, 两被告均摊, 其中二十万归德国联邦政府

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later – New prior art in second instance 二审中出现的现有设计

Still new 依然是新的

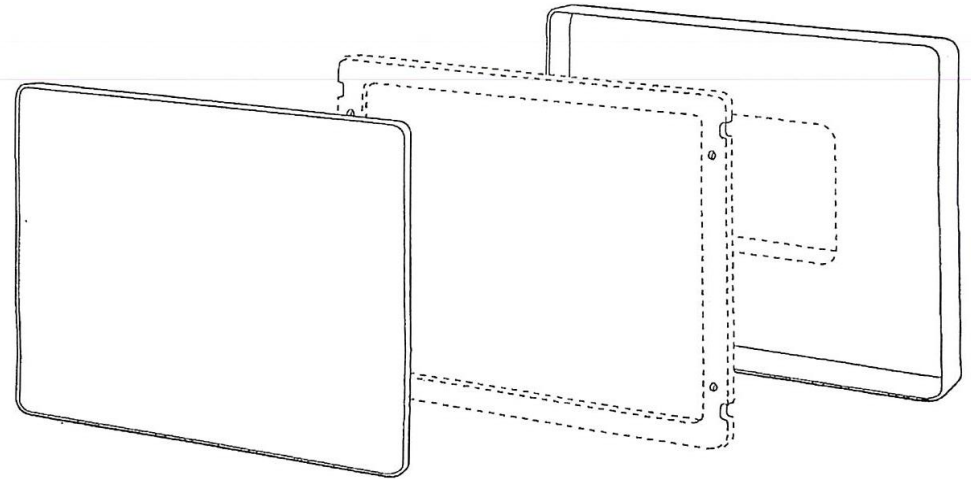
But lower scope of protection 但保护范围变窄

Result: 结果

No infringement! 不侵权!

The END? 未完待续...

FIG. 3a



40301867

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later – Injunction still maintained 之后，德国法院依照德国不正当竞争法维持了禁令的效力

However,

the injunction was granted under Section 8 (1) in conjunction with Sections 3, 4 (9) (b) of the German Unfair Competition Act.



iPad



iPad 2



Galaxy Tab 10.1

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later – Design changed 改变了设计



European law of infringements – Apple vs. Samsung (DE)

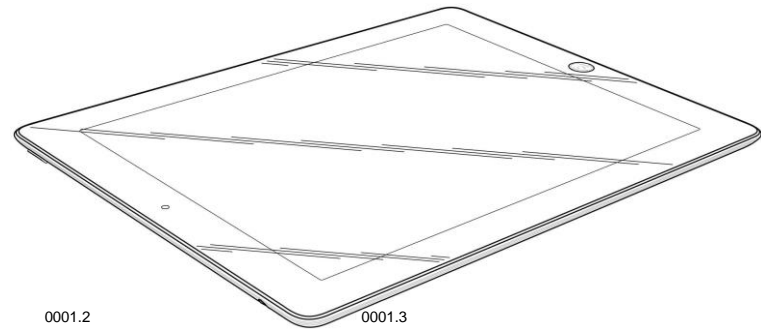
欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later – New request for Preliminary Injunction by Apple 苹果公司重新申请了临时禁令

0013.1



0001.1



0001.2

0001.3

0013.2



0013.3



0013.4



0013.5



0013.6



0013.7



0001.4



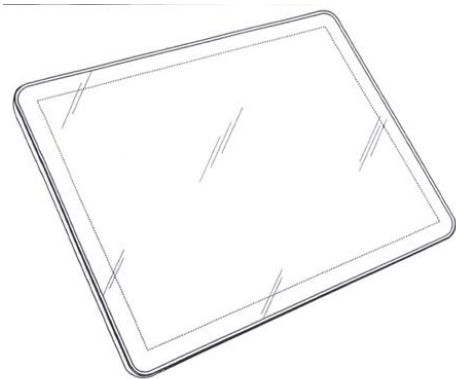
0001.5



European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later – Invalidity in the view of Prior Art? 因现有设计而无效?



Design number : 000181607-0001

外观设计号：00018107-0001

European law of infringements – Apple vs. Samsung (DE)

欧盟法律关于侵权的规定 – 苹果诉三星案（德）

- What came later
 - Article 91 Proceedings can be stayed 诉讼中止
 - If invalidation is pending at another Community design court 若外观设计的有效性正在另一共同体外观设计法院审理
 - If declaration of invalidity has been filed at OHIM 若外观设计无效宣告申请已提交到OHIM
 - Invalidity request was pending at OHIM OHIM 正在审理无效宣告申请
- => German court stayed without injunction 德国法院中止了诉讼，未授予禁令

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

■ Efficient strategic enforcement routes available at early stages

在前期可以采取的相当有效的救济措施

- Warning letter警告函/
cease & desist declaration 停止声明 Patent Attorney 外观设计代理人
- Customs seizure 海关扣押 Customs/ Patent Attorney 海关/专利代理人
- Criminal cases 刑事案件 Customs/ State prosecutor 海关/公诉人
- Preliminary Injunction临时禁令 Court of first instan/Patent Attorney一审法院/代理人
Sequestration查封/
Inspection rights检察权 Sequester/ appointed Expert 查封人员专家
- Tradefair enforcement交易会执法 Tradefair Panel交易会小组/ Patent Attorney专利代理人

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Warning letter 警告函

- No court litigation (less cost burden), but may delay preliminary injunction 不用诉讼（花费较少），但是可能延迟临时禁令
- Elements 内容
 - Cease and desist undertaking with agreed penalty 达成罚金约定的停止
 - Information request on source, sales & manufacturing figures, client lists 关于来源、销售和制造数量、客户名单等信息要求
 - Cost reimbursement request 费用承担请求
- Legal relevance 法律相关性
 - Avoid cost reimbursement (exception product piracy) in litigation, if defendant admits infringement 如果被告承认侵权，则（除产品抄袭）避免诉讼和费用承担
 - Should be followed by litigation, if not answered 未得到回复再去诉讼

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Customs seizure (Community Directive EG/1383/2003) 海关扣押

■Content 内容

- Information on original, infringing product and special features for recognition 关于原产品，侵权产品的信息和其他特定功能的识别信息
- Relevant Community Design 相关共同体外观设计
- If possible, information on infringer and location of the goods 可能的话，侵权者的信息和侵权产品的位置

■Limitation 局限

- Online and in written form with one year validity 网上和书面的一年有效期

■Form 形式

- Only for imports from outside the EU 只可以针对从欧盟境外的进口

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Customs seizure 海关扣押

■ Procedure 程序

- 10 days response limitation for importer 进口商要在10内回复
- Destruction of goods, if admitted infringement or no response 如果承认侵权或者没有回复，则销毁货物
- Release of goods, if opposed by importer -> litigation 如果进口商反对，则释放货物 -- 诉讼

■ Strategic use 战略性的使用

- Low cost, little risk 花费小，风险低
- Prevention of trade fair infringements 阻止交易会侵权

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Criminal action 刑事诉讼

■ Procedure 程序

- Low cost request with little formalities 申请形式简单，花费少
- Evidence preservation and potential seizure by federal customs officer 证据保全且海关人员可能扣押

■ Limitation 局限性

- Only willful acts 只限故意侵权
- Must be taken up by customs officer/state prosecutor 必须靠海关人员或政府查封人员
- Protection letters are usually effective 保护信通常很有效

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Preliminary Injunction 临时禁令

■ Requirements 要求

- Community design patent 共同体外观设计
- Urgency is usually assumed, if within 4 weeks of known infringement 在已知侵权的4个星期内，通常可达到紧迫性要求
- Request at court of first instance 向一审法院请求

■ Effect 效果

- Seizure of goods and assets for cost reimbursement 扣押货物和财产以偿付费用
- Decision within 1-2 days 1-2天就有结果
- Enforced by court sequester 有法院强制执行

Enforcement in a Member State, example: Germany

在成员国的实施，以德国为例

Trade fair enforcement 交易会执法

■ Before the fair 在交易会之前

- Seizure of catalogues, brochures 扣押产品目录和宣传手册
- Customs seizures 海关扣押

■ On the fair 在交易会上

- Preliminary injunction enforced by court sequester 由法院强制执行临时禁令



Questions ?

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