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Notes and Comments

The Partial Design and Derivative Design Patent Practices under the R.O.C. (Taiwan) Patent Reform Act^{*}

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Abstract

The two most important changes to design patenting to be introduced by the Patent Reform Act are that partial designs can be protected and that protection by “associated design patent” is replaced by “derivative design patent”. According to Article 123 of the Act, a design patent application can focus on partial design by using solid lines to indicate the claimed portion and using dash/broken lines to indicate the unclaimed portion. The introduction of partial design avoids unnecessary limitations to the scope of the claimed design. According to Article 129 of the Act, for two or more similar designs owned by the same person, a design patent application can be filed to cover one of the designs and derivative design patent application(s) can be filed to cover the rest. Unlike an associated design patent, which

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depends from its original patent, a derivative design patent is independent from its original design patent. That is, a derivative design patent can be independently enforced.

Keywords: Partial Design, Derivative Design Patent, Associated Design Patent, Patent Reform Act

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專利法修正草案對 我國設計專利實務的影響

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摘 要

專利法修正草案對我國設計專利實務兩項最大的影響在於部分設計成爲設計專利之保護標的以及衍生設計專利取代現行聯合新式樣專利。依據專利法草案第 123 條之規定，申請人可以透過實線表示主張權利之部分並透過虛線表示不主張權利的部分，以針對物品的局部請求設計專利保護。部分設計專利引進專利法修正草案後，解決了現行專利法中要求必須針對完整物品請求設計專利保護，因而不必要地限縮權利範圍的問題。依據專利法草案第 129 條之規定，同一人有二個以上近似之設計，得申請設計專利及其衍生設計專利。衍生設計專利與獨立於其原設計專利，與聯合新式樣專利依附於其原設計專利不同。換言之，衍生設計專利權人可獨立行使其專利權。

關鍵詞：部分設計、衍生設計專利、聯合新式樣專利、專利法修正
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1. INTRODUCTION

R.O.C. (Taiwan) became a member of the World Trade Organization (WTO) in 2002. The current patent law¹ was enacted in the same year in light of the WTO's Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement. To address the needs of the local design industry and the Intellectual Property Court (established 2008), the Intellectual Property Office (IPO) has held numerous public hearings in recent years culminating in a draft Patent Reform Act,² which has been reviewed by the Ministry of Economic Affairs (MOEA) and Executive Yuan. The Act will take effect upon passage by the Legislative Yuan and promulgation by the President.

The main changes to design patenting are that: (i) the Chinese name of “design patent” is changed from “新式樣專利” (new design patent) to “設計專利” (design patent) to keep consistency with corresponding names in the patent laws of other countries/jurisdictions; (ii) icons and graphical user interfaces (GUI) become patentable subject matter; (iii) a set of designs that has commonality of design or is generally of the same character can be protected by a single design patent application; (iv) partial designs are protected; and (v) protection by “associated design patent” is replaced by “derivative design patent (衍生設計專利)”.³ This article focuses on the fourth and fifth changes. In particular, comparisons are made between the current complete-article design practice and the partial design practice in

¹ The current Patent Law has been in effect since July 1, 2003 [hereinafter Patent Law].

² The version sent to the Legislative Yuan for examination, *see Articles of Draft Amendment of the Patent Act*, TAIWAN INTELLECTUAL PROPERTY OFFICE, http://www.tipo.gov.tw/ch/AllInOne_Show.aspx?path=2769&guid=45f2e9ed-6a50-488e-8514-47a78e3cc320&lang=zh-tw (last updated Nov. 10, 2010) [hereinafter the Act].

³ 沈淑瑩，「我國專利法修正中設計專利與設計產業現況之調和」，科技法律透析，第 21 卷第 8 期，頁 27-30 (2009)。

the Act in view of U.S. practice under *Zahn*.⁴ Also compared are the current associated design patent in the Patent Law and the derivative design patent in the Act.

Current practice does not allow an applicant to use phantom/broken lines to unclaim the portions that he/she does not intend to claim, and this may unnecessarily limit the scope of a design. For example, a designer designs a fashionable bottle in which the design at the bottom portion is the point of novelty while the rest is conventional, and latter obtains a design patent in Taiwan, the claim of the design patent has to cover the whole bottle. If a potential infringer creates a product which appropriates only the novel design of the bottle's bottom section and intentionally changes the design of the middle and upper portions of the bottle shown in the design patent, he/she may not be infringing the design patent if the overall visual effect of the claimed design and the accused bottle, including the bottom, middle and upper portions thereof, are different such that an ordinary observer would not consider them to be similar. However, if it were allowable to claim only the design embodied in the bottom of the bottle, as under the Act, the result will be totally different.

Under current practice, a single design patent application is not allowed to include multiple embodiments (designs similar to each other); similar designs have to be included in associated design patent applications. However, an associated design patent is dependent from its parent and does not have its own patent scope. Therefore, although a patent owner may have a parent design patent and several associated design patents, he/she only has one patent scope and has to annually maintain a plurality of patents. The advantage of owning associated design patents, as discussed in section IV of this article, is very limited. The derivative design patent system in the Act aims to solve this problem.

⁴ *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980).

2. PARTIAL DESIGN

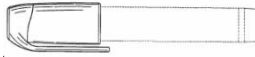
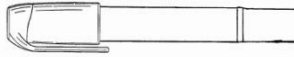

2.1 Current Practice of Partial Design Drawings in Taiwan

Under US practice, phantom/broken lines are frequently used to highlight partial feature(s) of a design or to show environments of a claimed design, while the design itself is presented in solid lines (*see* M.P.E.P. § 1503.02). In contrast, since partial designs are not currently allowable in Taiwan, Page 3-1-6 of the Patent Examination Guidelines (hereinafter referred to as the “Guidelines”) stipulates that the subject matter sought to be patented in a new design patent (hereinafter referred to as the “design patent”) application should be shown in solid lines. Phantom/broken lines should be removed or replaced with solid lines. Examiners often object to even phantom/broken lines showing only detachable environmental parts of a claimed design.

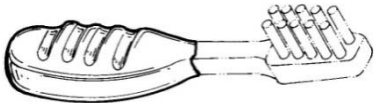
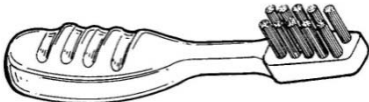
Removal of phantom/broken lines representing non-detachable parts of an article would render the article that embodies such a claimed design incomplete, and so an applicant’s only option is to replace them with solid lines. However, since solid lines represent parts of the features of a claimed design, replacing phantom/broken lines with solid lines adds features to the claimed design, thus narrowing its scope.

The following two examples of detachable and non-detachable components demonstrate the difference between original disclosure as filed in the United States and current acceptable disclosure in Taiwan.

Example 1: Cap of a Pen with Detachable Barrel (see below Figure 1)

Original Disclosure as filed in USA	Acceptable Disclosure 1 Currently in Taiwan	Acceptable Disclosure 2 in Taiwan
		
<p>The above left drawing includes phantom/broken lines to represent an environmental part (barrel) of the claimed cap. When filing currently in Taiwan, the drawings for design patent application should be amended by removing the phantom lines (<i>see</i> the above right drawing) or replacement with solid lines (<i>see</i> the above middle drawing).</p>		

Example 2: Toothbrush with Non-Detachable Handle (see below Figure 2)

Original Disclosure as filed in USA	Acceptable Disclosure Currently in Taiwan
	
<p>Under Taiwan's current practice, a non-detachable article is not eligible for design patent protection. Therefore, the phantom lines in the drawings must be replaced with solid lines to demonstrate the entire article rather than a partial component.</p>	

2.2 The U.S. Design Practice under *Zahn*

The two leading sources regarding the use of broken lines for design drawings are the Manual of Patent Examining Procedure (M.P.E.P.) § 1503.02 and *In re Zahn*. In *Zahn*, instead of claiming the whole drill, the patent applicant used solid lines to indicate the claimed shank portion and used broken lines to indicate the

unclaimed twist-drill portion in the application (*see* below Figure 3). The title of the design application as originally filed is “for the Shank of a Drill Bit” and in the specification, its claim is described as “the ornamental design for a Shank of a Drill Bit as shown and described”.

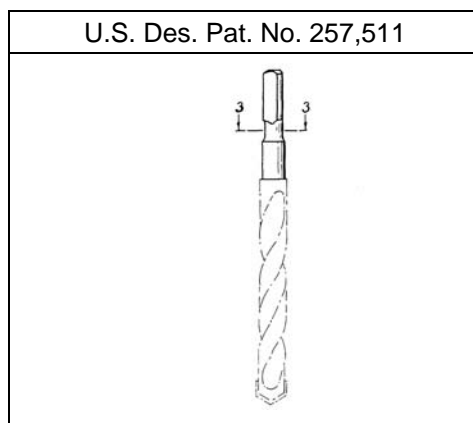


Figure 3

The description in the specification reads: “The phantom representation of the cutting portion of the drill is made in the drawings merely for the purpose of illustrating the type of cutting portion that may be formed integral with the shank portion to form the drill bit”. The examiner of the United State Patent and Trademark Office (USPTO) in the first office action rejected the application on the ground that the scope of the claim is indefinite and violates Paragraph 2, § 112 of the Patent Law⁵ because the portion in the application covered by solid lines is not directed to a complete article of manufacture. In response to the first office action, the applicant without changing his drawings amended the description to read: “the phan-

⁵ The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

tom representation of the cutting portion of the drill bit is made in the drawings merely for the purpose of illustrating the environment in which the shank of this invention is used. The structure shown in broken lines is not part of the design sought to be patented” and cited M.P.E.P. § 1503.02 expressly permitting the use of broken lines to show environmental structure.⁶ The examiner seeming to understand the scope of the claim after the applicant’s amendments of the description and explanations in the response dropped the indefiniteness rejection and in the second office action made a new subject matter rejection under 35 U.S.C. 171.⁷ The examiner reasoned that the claim is not directed to a discrete article of manufacture. Twist drills are one article of manufacture having shank portions, which are not separate elements, separately protectable as articles of manufacture and thus the subject matter of the claim violates 35 U.S.C. 171. Responding to the second office action, still without changing the drawings, the applicant amended the title to read “drill tool” (a complete article) and made corresponding amendments in the descriptions to meet the discrete article of manufacture requirement. However, even though the title and the descriptions were amended, since the drawings, which determine the scope of the claim, were not amended, the claim of the subject application still did not direct to a discrete article of manufacture, the application was finally rejected under 35 U.S.C. 171.

Unsatisfied with the rejection decision, the applicant appealed to the Board of Patent Appeals and Interference (BPAI). The BPAI not only affirmed the examiner’s § 171 rejection but also added a § 112 rejection. The BPAI stated its reasons for sustaining the rejection decision: “[I]n view of our conclusion that only the shank portion, rather than the entire tool, is being claimed, we feel constrained by

⁶ *In re Zahn*, 617 F.2d at 262.

⁷ Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor subject to the conditions and requirements of this title.

*Blum*⁸ to hold that a design patent cannot properly be granted for the ornamental design of a portion only of an article of manufacture.”⁹ With respect to the newly added § 112 rejection, the BPAI reasoned that it is unclear what the scope of the claim is in light of the inconsistency between the subject matter claimed in the drawings (a portion of the drill) and the title (a complete drill).

The case was appealed to the Court of Customs and Patent Appeals (C.C.P.A.). Ultimately, the C.C.P.A. court (now replaced by the Court of Appeals for the Federal Circuit (C.A.F.C.)) held that partial design is acceptable for patent design applications. With respect to the BPAI’s § 112 rejection, the court noticed the examiner’s drop of the § 112 rejection during the prosecution of the application and that in the BPAI’s written opinions, the BPAI clearly states and understands that only the shank portion, rather than the entire tool, is claimed and thus reversed the BPAI’s § 112 rejection. Under U.S. practice, the scope of a design patent is determined based on the drawings but not the title and the BPAI seems to have confused the two. With respect to the BPAI’s § 171 rejection, the court found that the BPAI incorrectly relied on *Blum*. In *Blum*, solid lines were used to illustrate the dominant features of the claimed design, “the handrail” of the handrail unit while broken lines were used to illustrate the relatively unimportant portions of the design, i.e., “the handrail support” of the handrail unit, and such use of broken lines rendered the scope of the claim indefinite because there are no portions of a claimed design which are unimportant. In contrast, the broken lines in *Zahn* were used to show the portions unclaimed but not portions relatively unimportant. The courts have searched *Blum* in vain, however, for any statement justifying the BPAI’s statement that an ornamental design cannot be incorporated or embodied

⁸ *In re Blum*, 374 F.2d 904 (C.C.P.A. 1967).

⁹ *In re Zahn*, 617 F.2d at 263.

into something less than an entire article of manufacture.¹⁰

The court noted that the word “therefor” of § 171 in the phrase, “may obtain a patent therefor” refers back to “design”, not to “article of manufacture”.¹¹ Therefore, a design patent is to protect a design that is embodied in an article but not the article itself. 35 U.S.C. 171 authorizes patents on ornamental designs for articles of manufacture. While the design must be embodied in some article, the statute is not limited to designs for complete articles, or “discrete” articles.¹² The court reasoned that “the design is embodied in the shank portion of a drill and a drill is unquestionably an article of manufacture.” In *Zahn*, the USPTO and the Board looked to the M.P.E.P. for guidance on partial design. The pertinent parts in the M.P.E.P. were considered to lack clarity by the C.C.P.A. court and thus were amended. The C.C.P.A. court’s holding reflects this updated M.P.E.P. revision.

In general, M.P.E.P. Chapter 1,500 governs design patent procedures in the U.S. A design patent application by definition includes “subject matter which is claimed as the design embodied in or applied to an article of manufacture and not the article itself” (*see* M.P.E.P. § 1502). Under the amended M.P.E.P. § 1503.02, broken lines are most commonly used to disclose the environment and define the bounds of the claim. Such illustration of environment by broken and phantom lines can be used to show structures that are not part of the claim. Additionally, boundary lines illustrated by straight broken lines can be used to define the bounds of a claimed design when the boundary does not exist in reality. However, in view of *Blum*, broken and phantom lines cannot be used to indicate the relative unimportance of portions of the design, such as hidden planes or surfaces. To avoid confusion, a design patent application should indicate the purpose of broken lines in rela-

¹⁰ *Id.* at 268.

¹¹ *Id.*

¹² *Id.*

tion to the scope of the claim.

2.3 Partial Design under the Act and Its Influence

2.3.1 Partial Design Practice under the Act

According to § 123 of the Act, a design patent application can focus on either an entire or partial design. The legislative reason¹³ for adopting partial design in the Act is as follows: “Under present patent law, a patented design should be configurations, patterns and colors or combinations thereof of a ‘complete’ article (including components and parts). In other words, if the patented design contains multiple points of novelty while a counterfeit only copies some of them, such counterfeit does not fall in the scope of the design patent. To encourage creative design in conventional industries on the one hand while strengthening design patents to meet the needs of developing designs in mature domestic industries, and in view of § 2 of the Japanese Design Act, § 2 of the Korean Design Act, and § 3 of the European Design Act, ‘partial design’ is added to Paragraph 1, § 123 of the amended patent law as a patentable design.” Although, the Enforcement Rules of the Patent Law (the Rules) has not been amended to correspond to the partial design practice in the Act, it is believed that under the new practice, solid lines will be used to illustrated claimed portions of an article and phantom/broken lines will be used to the unclaimed portions of the article just like practice in the U.S., Japanese and European. The term “partial design” in the Act may not be the most appropriate term to truly reflect what is intended and may cause some confusion. In view of similar U.S. practice, the design in *Zahn* was a design that embodied in a portion of an article of manufacture but the design by itself was not a part of another design.

¹³ See *supra* note 2.

2.3.2 The Influence of the Partial Design Practice

2.3.2.1 Influence During the Prosecution Stage

Under current § 33 of current Rules, drawings of a design shall be presented in a perspective view and six views (i.e. the front, rear, left side, right side, top and bottom), or in two or more perspective views. However, since partial design forces on the design of a particular portion of an article, some views of the article would not contain the claimed portion, and it would be unnecessary to show such view(s). Therefore, the Taiwan Intellectual Property Office may need to consider amending the current requirement. In contrast, U.S. practice only requires that the drawings or photographs should contain “a sufficient number of views” to disclose the complete appearance of the design claimed (*see* 37 C.F.R. 1.152). Taking the drill in *Zahn* as an example, the claimed shank portion cannot not be seen from the bottom view and thus in the granted U.S. Des. Pat. No. 257,511 does not contain such bottom view.

2.3.2.2 Influence During the Enforcement Stage

In contrast to the holding of the U.S. case *Egyptian Goddess*¹⁴ that the single ordinary observer test including prior art analysis should apply, Chapter II (for design patents) of the Patent Infringement Assessment Guidelines¹⁵ (hereinafter referred to as the Assessment Guidelines) adopts a procedure similar to the two-prong test in the US case *Litton System*¹⁶ for assessing infringement on a design patent. The two-prong test includes both the “ordinary observer test” and “point of novelty test.” The ordinary observer test is to determine whether the resemblance

¹⁴ *Egyptian Goddess v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

¹⁵ The Patent Infringement Assessment Guidelines was issued by the Taiwan Intellectual Property Office in 2004 for the reference by all levels of courts in conducting a patent infringement analysis.

¹⁶ *Litton System, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

between the “accused product” and the “claimed design” is such as to deceive an ordinary observer, given such attention as a purchaser usually gives, inducing him to purchase the accused product in the belief that it is the product covered by the claimed design.¹⁷ The point of novelty test is applied to determine whether the accused product appropriates the point of novelty of the claimed design. Point of novelty refers to the features that can distinguish the claimed design from the prior art in regard to novelty or inventive step.¹⁸ The Assessment Guidelines do not mention whether the design of the an accused product in pertinent part has to be identical to the point of novelty of the design patent in order to be deemed an appropriation of the point of novelty, or such design when is substantially similar to the patented design’s points of novelty is sufficient to constitute appropriation, while under U.S. practice, a potentially infringing design needed only to incorporate points of novelty that were substantially similar to the patented design’s points of novelty, not the identical points of novelty.¹⁹ The Assessment Guidelines also do not clearly indicate whether the accused product needs to appropriate only one or all points of novelty in order to be deemed an infringement, or whether the features of a design as a whole can be considered as a point of novelty; neither do the courts offer a clear conclusion in this regard. However, it appears that the IPO believes that all points of novelty of the claimed design have to be appropriated by the accused product to be found infringing in view of the above-mentioned legislative reason for adopting partial design.

Please note that the ordinary observer test in the Assessment Guidelines

¹⁷ TAIWAN INTELLECTUAL PROPERTY OFFICE, PATENT INFRINGEMENT ASSESSMENT GUIDELINES 56 (2004).

¹⁸ *Id.* at 53.

¹⁹ Aaron Cook, *Points of Novelty, Lawman Armor, and the Destruction of Design Patents*, 12 J. TECH. L. & POL’Y 103, 114 (2007).

seems to be slightly different from that under U.S. practice, which was established in *Gorham*.²⁰ The *Gorham* Court set forth the test: “[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” In the Assessment Guidelines, it is “the accused product” (the design embodied in a complete product) and “the claimed design” to be compared while under *Gorham*, it is “the design that embodied in the accused product” and “the claimed design” to be compared. Since under the Act, the claimed design can be embodied in only a portion of the product, the pertinent part of the Assessment Guidelines may need to be amended to be consistent with *Gorham*.

The partial design practice compared to the current practice is advantageous to the patentee in the regards of the “point of novelty test” as well as the “ordinary observer test”. As mentioned above, the Patent Infringement Guidelines are silent about whether an infringer needs to appropriate all or any of the points of novelty of a claimed design to be deemed as infringing. The Patent Infringement Guidelines should be amended to specifically indicate that the accused product needs to appropriate all points of novelty in order to constitute an infringement. Otherwise, the partial design practice in the Act would not meet the above-mentioned legislative purpose. Accordingly, if an applicant considers that the design of its complete product contains a plurality of points of novelty, separate design patent applications can be filed to cover each of the points of novelty by using the phantom/broken lines to indicate the unclaimed portions. In that case, as long as an accused product appropriates any one of the points of novelty, it may infringe at least one of the design patents. For example, it is our understanding that the U.S. Hoover Company

²⁰ *Gorham Co. v. White*, 81 U.S. 511 (1871).

considers that the design of its product, “floor cleaner handle potion”, contains a plurality of points of novelty, and filed separate design applications to cover them (shown in solid lines). The applications are entitled “floor cleaner upper handle potion” and “floor cleaner lower handle potion” and are later issued U.S. Des. Pat. Nos. D469,227 and D469,590 (*see* below Figure 4). If Hoover intends to seek design patent protection for the same product in Taiwan, under current practice, it has to claim the design of the whole product, and an accused product must appropriate both points of novelty to be deemed an infringement. In contrast, under the Act, the accused product, if appropriating any one of the two points of novelty, may infringe one of the two design patents.

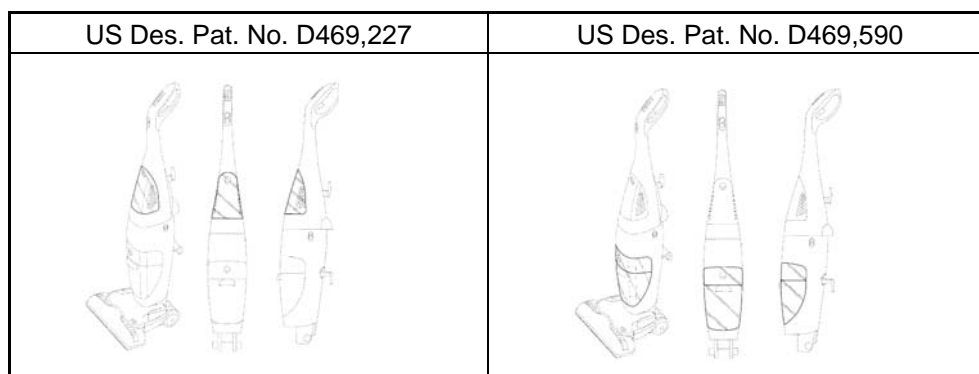


Figure 4

In regard to the “ordinary observer test”, even if the design of the entire product contains only a single point of novelty, the partial design practice has its advantages. A patent applicant may limit the impact of prior art on the ordinary observer test by using broken or phantom lines in the design patent. The applicant should draw distinctive portions of the article’s design using solid lines, and represent portions of the article that are not considered part of the claimed design with broken

lines.²¹ Using broken lines can effectively broaden the design patent by excluding unnecessary or extraneous features from the claimed design. For example, it is our understanding that Procter & Gamble Co. obtained a Des. Pat. No. 400,443 (*see* below Figure 5 at the left) covering a design of an entire bottle and later found that the design resided in the bottom of the bottle should be the point of novelty and thus later filed continuation of applications and obtained Des. Pat. No. 414,419 and Des. Pat. No. 435,216 (*see* below Figure 5 at the middle and right).²² Under the “ordinary observer test”, Des. Pat. No. 435,216 would be the easiest to infringe since only the bottom of the bottle (shown in solid lines) needs to be compared to the corresponding design of an accused product, while for Des. Pat. No. 414,419, the neck oration must be additionally considered in the comparison to determine whether their visual appearances as a whole are the same or similar to the corresponding portions of the accused product. As for Des. Pat. No. 400,443, the neck and the cap both need to be additionally considered and thus would be the most difficult to infringe. If the applicant seeks design patent protection for the same product in Taiwan, under current practice, the applicant can only obtain a design patent similar to Des. Pat. No. 400,443, while under the Act, the applicant may obtain a design patent similar to either of the three design patents.

²¹ James Juo, *Rebooting Design Patents and Resurrecting Whitman Saddle*, 18 FED. CIR. B.J. 429, 448 (2009).

²² 葉雪美，「導致美國開放部份設計專利的 Zahn 案例及其影響」，智慧財產權月刊，第 85 期，頁 81（2006）。

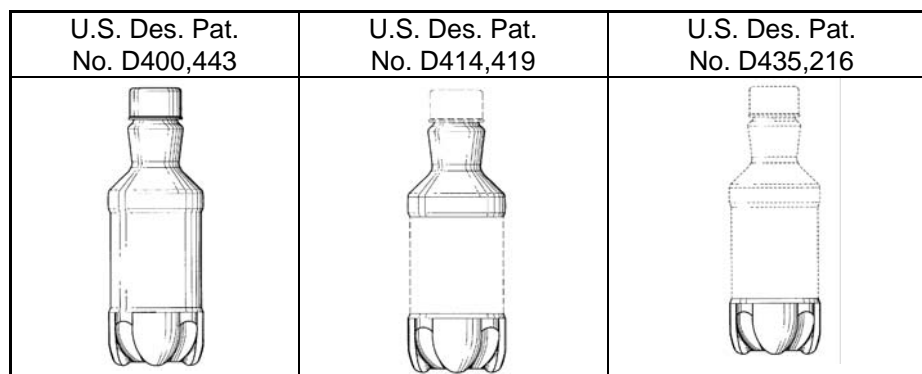


Figure 5

Despite the advantages mentioned above, applicants should be aware that since the portions covered by phantom/broken lines are not claimed and are not considered visual features of the design, they cannot contribute to patentability of the claimed design over prior art references. In other words, a partial design is basically easier to be found invalid than a design that is embodied in a complete article of manufacture.

3. DESIGN PATENT UNITY REQUIREMENT

3.1 Current One-Embodiment Practice in Taiwan

Paragraph 1, § 119 stipulates that “when applying for a design patent, an application shall be filed for each separate new design.” A general design idea may cover several similar embodiments (specific designs) which can thus theoretically be placed in a single design patent application. However, paragraph 5, § 110 further requires that where a person applies for a patent for a new design similar to another new design already filed by the applicant, an associated design patent application shall be filed with respect to the said similar new design. Accordingly, since the embodiments covered by a general design idea should be similar to each other, they

cannot be placed in a single design patent application. The applicant should designate one embodiment as the parent and file associated design patent applications covering the other embodiments. Therefore, under local practice, a single design patent application can only cover one embodiment of a design.

3.2 Patent Reform Act for Unity of Application Requirements

In the Act, the one-embodiment practice remains unchanged. However, the Act adopts an approach similar to the Japanese Design Act, in which other similar embodiments should be filed in derivative design patent application(s), in contrast to the current practice of associated design applications. The legal protection of the associated design patent is different from that of a derivative design patent.

3.3 United States Practice Regarding Unity of Application Requirements

The two leading sources for the unity of application requirements are M.P.E.P. § 1504.05 and *In re Rubinfeld*, 270 F.2d 390 (C.C.P.A. 1959). In *Rubinfeld*, the applicant disclosed two similar but different embodiments of floor waxers. The main issue in *Rubinfeld* was whether two different embodiments can be properly illustrated in the same application. The C.C.P.A. court reversed the examiner's rejection based on the multiplicity of designs being claimed and held that multiple embodiments of a single inventive concept can be included within the same design application since 35 U.S.C. 171 does preclude multiple embodiments within a design invention.²³

According to M.P.E.P. § 1504.05, multiple embodiments are permissible in a single application if they involve a single inventive concept. However, two or more

²³ 葉雪美，同前註。

distinctively patentable designs may not be included in the same patent application. The obviousness standard under 35 U.S.C. 103(a) is applied by examiners to determine admissibility of multiple embodiments within one application. The embodiments are allowable if they are similar in appearance with minor differences or are obvious to a person of ordinary skill in the art. For example, U.S. Des. Pat. No. 346,722 entitled “flatware” involves three embodiments in which the three embodiments share the same design (with a knob) that embodies in the handle portions (*see* below Figure 6).²⁴ The head portions of the three embodiments are obvious to a person of ordinary skill in the art because they are commonly seen knife, fork and spoon heads.



Figure 6

In practice, in a U.S. design application that contains a plurality of embodiments, each of the embodiments can be individually enforced and has its own scope of similarity.²⁵ If multiple embodiments are included within a single appli-

²⁴ 葉雪美，「淺談美國設計（新式樣）專利」，智慧財產權月刊，第 73 期，頁 47-48（2005）。

²⁵ 葉雪美，同前註，頁 41。

cation, they should be described and differentiated within the specification. Lack of description may hinder the allowance of multiple embodiments.

4. ASSOCIATED DESIGN PATENT V. DERIVATIVE DESIGN PATENT

The associated design patent system of the current Patent Law is to be repealed by the Act, which adopts the derivative design patent system in its place. The pending derivative design patent is similar to the related design patent under Japanese patent law. We compare current and pending design patent systems as follows:

4.1 Associated Design Patent under the Patent Law

4.1.1 The Nature of an Associated Design

The term “associated new design” as used herein refers to a creation made by a person, which is originated from and similar to an original design of the same person (*see* Paragraph 2, § 109 of the Patent Law). According to page 57 of the Assessment Guidelines, the scope of a design patent covers any design that is the same or similar to the design shown in the design patent.²⁶ Therefore, if two designs are similar, their patent rights overlap.²⁷ On the basis of the above, the associated design patent system seems to solve the double patenting problem in design

²⁶ The same design means that both the visual features of the two designs and the articles that embody the designs are the same, and similar design means that (i) the visual features of the two designs are similar and the articles that embody the designs are similar; (ii) the visual features of the two designs are the same and the articles that embody the designs are similar; or (iii) the visual features of the two designs are similar and the articles that embody the designs are the same; 葉雪美，同前註。

²⁷ 黃文儀，「新式樣近似判斷之相關理論」，2001 全國科技法律研討會論文集，頁 14-23 (2001)。

patents. It is well understood that double patenting is prohibited to prevent the same applicant from prolonging the term of the same exclusive patent right from of an earlier filed patent application. Under U.S. practice, there are two types of double patenting: same-invention type double patenting under § 171 of the U.S. patent law, and non-statutory type double patenting,²⁸ also known as obvious-type double patenting. For non-statutory type double patenting, the applicant can file a terminal disclaimer to relinquish the right for the second patent upon conclusion of the term of the first patent so that the same exclusive right will not be inappropriately prolonged.²⁹ As to same-invention type double patenting, the applicant can only cancel the application for the second patent to overcome the rejection. The term of an associated design patent, however, expires when its original design patent expires (see below Figure 7, and Paragraph 3, § 113). Accordingly, the associated design patent system seems to resolve a problem similar to the above U.S. non-statutory type double patenting problem.

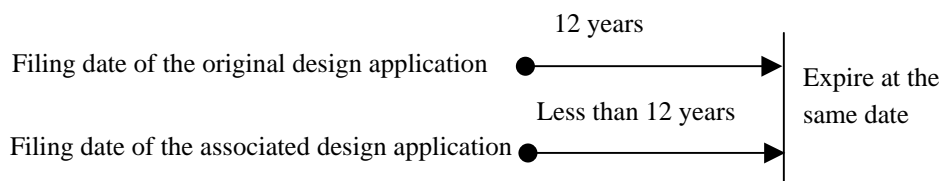


Figure 7

Paragraph 5, § 110 of the Patent Law stipulates: “where a person applies for a patent for a new design similar to another new design already filed by him/her, an associated design patent application shall be filed with respect to the said similar

²⁸ UNITED STATES PATENT AND TRADEMARK OFFICE, THE US MANUAL OF PATENT EXAMINING PROCEDURE 2001 § 1504.06 (2001).

²⁹ *Id.*

new design without being subject to the restrictions set out in Paragraph 1 (novelty requirement) and in Paragraph 4 (creativity requirement) of this Article.” Thus, a “similar” design, but not a “same” design should be filed as an associated design patent application. If the designs in two applications owned by the same person are exactly the same (“same design” filing results from accidentally filed duplicate filings), the later-filed application will be rejected by the IPO or must be cancelled by the applicant. Moreover, the later-filed application cannot be saved by filing an associated design patent application. If two same design patent applications are filed on the same date, the applicant will be required to choose one; otherwise, both will be rejected. This situation is similar to the same-invention type double patenting rejection under U.S. practice in which filing of a terminal disclaimer cannot save the later application.

4.1.2 Under Current Patent Law, How to Do Deal with a Taiwan Design Patent Filed with Priority Documents Containing Multiple Embodiments

If a priority document (such as a U.S. priority document) contains multiple embodiments, to meet the one-embodiment requirement under the Patent Law, the applicant for the corresponding R.O.C. (Taiwan) patent applications needs to decide whether (i) to file one embodiment as the parent application and the rest as the parent’s associated design patent applications,³⁰ or (ii) to file separate independent design patent applications for each embodiment. In the former case, the scope of patent right is restricted because the associated design patents do not have their own independent scopes; while in the latter case the collective scope of patent right

³⁰ Since the applicant includes the multiple embodiments in the priority document, they should be similar designs. However, the similarity of embodiments in the priority document may vary by case, and so it is still possible that they are considered as patentably distinctive from each other in Taiwan.

is broader because each design patent has its own scope of similarity (近似範圍). However, in the latter case, if the embodiments are considered similar, the examiner will require them to be arranged as in the former case, and additional cost will be incurred. Alternatively, the applicant may choose to initially submit the multiple embodiments within a single design patent application and wait until receiving an office action to respond (i.e. (i) designate one embodiment as the parent and file divisional applications covering the rest or (ii) choose one as the parent and convert the rest to associated design patent applications of the parent). There have even been cases in which the examiner first asked the applicant to file divisional applications for each embodiment, but in the next office action asked the applicant to arrange them as one parent and multiple associated design patent applications, incurring even greater cost. Applicants are therefore advised to file separate design patent applications at the outset, thereby covering a broader scope of inclusive rights, if allowed; and if rejected, they can still be arranged as parent and associated design patent(s) at a later stage.

4.1.3 Definition of the Term “Similar” in Paragraph 2, Article 109 of the Patent Law

The term “similar” is repeatedly mentioned in the Patent Law, the Enforcement Rules of the Patent Law and the Guidelines. It is understood that the meaning of “similar” is different in novelty analysis than in analysis of creativeness/non-obviousness. A design is devoid of novelty if the design is the same or similar to the prior art reference such that an “ordinary observer” will confuse the two and mistake one for the other,³¹ while a design is devoid of creativeness if a “person skilled in the art” can easily conceive the claimed design in view of a single prior

³¹ See p.3-3-7 of the Guidelines.

art reference or a combination of prior art references.³² Since the associated design patent system functions to avoid the double patenting problem, the design in the original design patent should be “patentably” indistinguishable from that in the associated design patent(s). A design is not patentable if it is devoid of novelty or devoid of creativeness. The standards for determining novelty of a design are different from those for creativeness, and the degree of similarity in novelty analysis is stricter than that in creativeness analysis. Accordingly, when defining associated design patent as in Paragraph 2, § 109 of the Patent Law, the term “similar” should be understood as adopting the standard applied to creativeness analysis.

4.1.4 An Associated Design Patent Depends from Its Original Design Patent

An associated new design patent right shall not be claimed separately, nor shall its effect be extended to the scope of similarity (*see* Paragraph 1, § 124). The patent right of an associated new design shall be revoked or extinguished concurrently with the revocation or extinguishment of the patent right of the original new design (*see* Paragraph 2, § 124). An associated new design shall not be independently subject to assignment, trust, licensing or pledge creation (*see* § 126). Accordingly, an associated design patent depends from an original design patent, and does not have its own scope of similarity³³ (*see* below Figure 8). Under local practice, an associated design patent is often cited to substantiate or answer a challenge to the scope of its original design patent.³⁴ That is, if, *prima facie*, it is unclear whether an accused design is similar to the original design patent but it is clear that

³² See para 4, § 110 of the Patent Law.

³³ 顏吉承，「聯合新式樣制度與新式樣之近似概念（上）」，智慧財產權月刊，第 86 期，頁 99-128（2006）；顏吉承，「聯合新式樣制度與新式樣之近似概念（下）」，智慧財產權月刊，第 87 期，頁 68-84（2006）。

³⁴ See *supra* note 2.

the accused design is similar to an associated design patent of the original design patent, it will be concluded that the accused design is also similar to the original design patent.

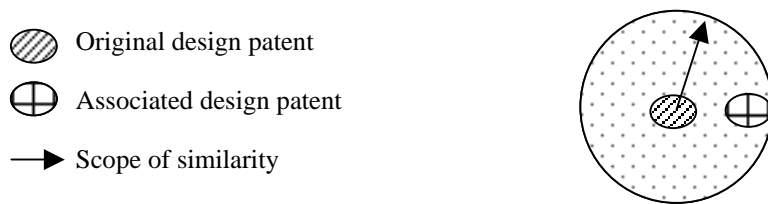


Figure 8

The patent right of an associated new design patent is subordinate to the patent right of the original design patent (Paragraph 1, § 124). In other words, the patent right of an associated design patent cannot be independently enforced; it must be enforced simultaneously with the original design patent. According to Paragraph 5, § 110 of the Patent Law, if, prior to the filing of the original design patent application, another new design identical with or similar to such associated new design has been published, or put to public use, or has become known to the public, no associated design patent may be applied for or granted. Accordingly, it is possible that a prior art reference published prior to the filing of the original design patent application is similar to the original design but not similar to the associated design, and such a prior art reference would not directly bar an associate design patent application from being granted a patent right (*see* below Figure 9). However, such prior art reference can be used to negate the patentability of the original design patent application; since the associated design application depends from the original design patent application, once the original design patent application is rejected, the associated design patent application still cannot be granted a patent right.

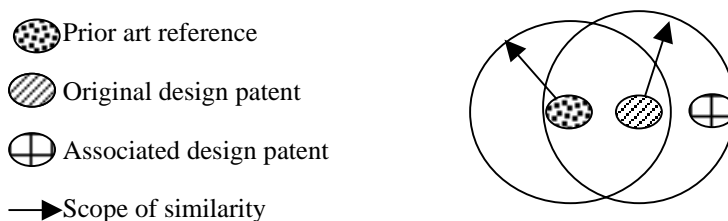


Figure 9

Where a design is similar to one disclosed in an associated design patent application filed by the same applicant, the applicant shall not file an associated new design for the said new design (*see* Paragraph 6, § 110). The rationale of the aforementioned provision may be that since an associated design patent may be cited to substantiate its original design patent, if the original design patent is an associated design patent, there will be no scope of similarity to substantiate. Another possible rationale is to avoid unreasonable extension of the original design patent's scope of similarity. For example, it is possible that design B is similar to designs A and C, but designs A and C are not similar to each other. If design B is an associated design of design A, then allowing design C to be filed as an associated design of design B would be unreasonable because it would incorrectly imply that design C is also similar to design A.

4.2 Derivative Design Patent under the Act

4.2.1 The Nature of a Derivative Design Patent

According to § 129 of the Act, for two or more similar designs owned by the same person, a design patent application can be filed to cover one of the designs and derivative design patent application(s) can be filed to cover the rest. Although the associated design patent system is eliminated in the Act, the one-embodiment requirement remains in light of the aforementioned provision. The added derivative

design patent system is similar to the related design patent system of the Japanese Design Act.³⁵ Since the original design is similar to the derivative design, the exclusive patent rights overlap. Similar to the relevant requirement for associated design patents in the Patent Law, to avoid prolongation of the earlier filed original design patent right, the patent right of the derivative design patent expires when the original design patent expires.³⁶

The filing date of a derivative design patent application cannot be earlier than that of the original design patent application. A derivative design patent application cannot be filed after issuance of the original patent application.³⁷ In other words, a derivative design patent application shall be filed while the original patent application is pending. A design patent application can be converted into a derivative design patent application and vice versa. The filing date of the converted patent application is the same as that of the design application before the conversion.³⁸

4.2.2 A Derivative Design Patent Is Independent from Its Original Design Patent

According to § 139 of the Act, the patent right of a derivative design patent can be enforced independent from other related design patents, and the derivative design patent has its own scope of similarity (*see* below Figure 10). Where the scopes of similarity of the parent design patent and the derivative design patent

³⁵ *See* § 10 of the Japanese Design Act: “Notwithstanding § 9(1) or (2), an applicant for design registration may obtain design registration of a design that is similar to another design selected from the applicant’s own designs either for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the “Principal Design” and a design similar to it is referred to as a “Related Design”) ...”.

³⁶ *Id.* § 137.

³⁷ An associated design patent is not so required.

³⁸ *See supra* note 35, § 133.

overlap should be the core design concept that they share. Accordingly, a derivative design patent is independent from, yet expires on the same date as, its original design patent. The same person cannot file a derivative design patent application in which the design is similar to that in another related design patent application but dissimilar to that in the original design patent application (Paragraph 4, § 129 of the Act). The rationale of the aforementioned provision is similar to that for an associated design patent: to avoid unreasonably extending the original design patent's scope of similarity.

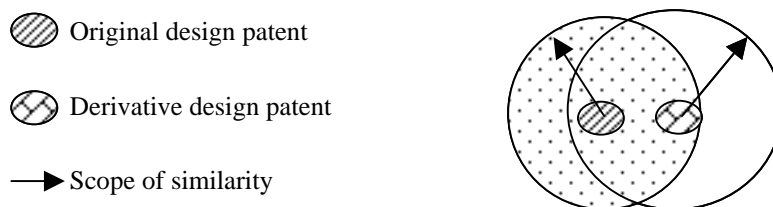


Figure 10

4.2.3 Under the Act, How to Deal with a Taiwan Design Patent Filing with Priority Documents Containing Multiple Embodiments

Under the Act, to meet the one-embodiment requirement, if a priority document such as a U.S. priority document, contains multiple embodiments, the applicant for the corresponding R.O.C. (Taiwan) patent applications needs to decide whether to file one embodiment as the parent and the rest as derivative design patent applications of the parent, or to file separate independent design patent applications for each embodiment at the beginning. Alternatively, the applicant can wait until receiving an office action to respond (i.e. to designate one embodiment as the parent and file divisional applications covering the rest or to choose one as the parent and convert the rest to derivative design patent applications of the parent). Al-

though such decisions should be made on a case-by-case base, it is generally advisable to first file a parent and derivative design patent application(s) unless meeting the six-month priority claim requirement is important and there is insufficient time to arrange such derivative design patent applications. Since a derivative design, like a regular design, has its own scope of similarity, there is no advantage in initially filing separate regular design patent applications for each embodiment. The terms of the separately filed design patent applications will be the same as those of the parent and the derivative design applications. Furthermore, if the applicant chooses to file separate regular design patent applications, the examiner may issue an office action, responding to which would create another cost, requiring one design patent application to be designated as the parent and the rest converted to derivative design patent applications if the examiner considers the designs not patentably distinctive.

4.2.4 The Influence of the Derivative Design Practice

The monetary benefits of a patent portfolio include a market monopoly position for the portfolio holder and revenue from licensing the intellectual property. Non monetary benefits include strategic advantages like first-mover advantages and defense against rival portfolio holders. It is well-known that divisional applications for invention patents can be used to build up a patent portfolio surrounding a core technology. For a core design concept covered in a design application, under current practice, it would be difficult to build a patent portfolio surrounding the core design concept because similar designs should be filed as associate design applications, which is dependent from the parent application and cannot be enforced independently. However, under the Act, similar designs can be filed in derivative design applications, which, when issued, the derivative design patents have their own independent scopes. That is, an applicant can take advantage of the de-

derivative design patent system under the Act to build up a patent portfolio surrounding a core design concept (where the scopes of similarity of these designs overlap). In that case, an accused product may infringe a set of design patents (a parent design patent and/or several derivative design patents) at the same time and it would be a substantial time and momentary burden for the accused infringer to defend infringement accusations based on a plurality of design patents.

5. COMPARISON OF ASSOCIATED AND DERIVATIVE DESIGN PATENTS

The following Table 1 offers a summary comparison of the requirements of, and the rights conferred by, an associated design patent in the Patent Law and a derivative design patent in the Act:

Table 1

	Associated design patent in the Patent Law	Derivative design patent in the Act
Has to be similar to the parent	YES	YES
Has its own scope of similarity	NO	YES
Expires when the parent expires	YES	YES
Must be enforced together with the parent	YES	NO
Has its own patent certificate	NO	YES
Must be filed when the parent is pending	NO	YES
Can be converted into a regular design patent application	YES	YES
Extinguished when the parent is extinguished (e.g. abandoned, invalidated), other than by expiration	YES	NO

6. CONCLUSION

The adoption of the partial design and derivative design systems in the Act would provide many advantages to design patent owners compared to the current system under the currently enforced Patent Law. Applicants should understand and avail themselves of the new mechanisms to best protect their design patent rights in Taiwan. The newly introduced partial design system allows applicants to claim the design of only a portion of a product. Thus, an accused product may infringe a design patent simply because the accused product appropriates the partial/regional design shown in the drawings of the design patent. In contrast, under the current complete-product design patent practice, an infringer needs to appropriate the entire design of the product to be found to be infringing. It is expected that the partial design system will entice foreign applicants to file design patent applications in Taiwan. In addition, unlike the U.S. or Chinese design patent system,³⁹ under the Act, it is unallowable to include a plurality of similar designs in a single design patent application. Instead, similar designs should be included in a parent design patent application and several derivative design patent applications. A derivative design patent has an independent patent scope and can be independently enforced, which is more advantageous than its predecessor, an associated design patent. In particular, a company can utilize the derivative design patent system to establish a design patent portfolio to encompass a core design concept. Furthermore, as explained above, once the derivative design patent system is adopted, if an applicant plans to file Taiwan design patent application(s) with priority document(s) contain-

³⁹ See para. 1 of Rule 35 of the Implementing Regulations of the Chinese Patent Law: “Where two or more similar designs of the same product are filed in one application in accordance with the provisions of § 31, paragraph two of the Patent Law, the other designs of the product shall be similar to the main design indicated in the brief explanation. The number of similar designs contained in an application for patent for design shall not exceed 10”.

ing multiple embodiments, it is generally advisable to arrange a parent and derivative design patent application filings, instead of including all the embodiments in a single design application as in the priority document(s).

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