

Design patents: An introduction to protecting product designs in China

Due to the difference in regional systems, many European companies do not know how to protect their product designs in China. While in Europe you can seek protection for an original work as either a registered or unregistered community design, in China designs fall under the scope of patent protection, while no protection is offered to unregistered designs.

A design patent provides the right holder to exclusive use of a product design for a period of 10 years. As well as providing a legal basis to fight counterfeiters, a design patent also allows you to generate additional revenue by licensing the design to third parties.

Definition

According to China's Patent Law, a design is defined as "the shape, pattern, or the combination thereof, or the combination of the color with shape and pattern, which are rich in an aesthetic appeal and are fit for industrial application." While most items with a distinctive exterior appearance can be covered by a design patent the following cannot: trade marks, parts of a design which cannot be used or sold separately and items that contravene local law or have a negative effect on public interest.



A Chinese design patent provides exclusive use of the aesthetic features of a product for a period of 10 years; that is, protection of the way a product looks as opposed to how it functions. In addition two products with different functions but which appear the same may be covered by the same design patent. For example, the same design patent could apply to two generations of mobile phone with the same external appearance but different functionality. The only condition is that all products covered by that design patent have to be capable of being sold or used independently. As such, retail spare parts can be protected by design patents in China.

Importantly, the design must be novel. This means that the design must be new and not have been disclosed to the public through sales, advertising or any other means anywhere in the world before the application is filed in China. If the design was disclosed before the design patent application was filed, the patent could be invalidated later. Therefore if you plan to pursue a design patent in China make sure your design is treated as a trade secret and not made public in your home country or elsewhere in the world before the application has been made.

Comparison with the European system

Europe and China differ in several crucial aspects with regards to the legal structures for design protection. The table below, lists some of the key differences to aware of.

	EU Community Design	Chinese design patent
Maximum term of protection	25 years	10 years
Unregistered design right protection	Protected for 3 years	NOT protected
Max. number of designs in one multiple design application	No limit	Maximum of 10
Novelty requirement	12-months grace period	Absolute novelty
Limitation on number of views	Max seven views per design	No statutory limitation
Brief description of design	Optional	Mandatory

Design patent VS Copyright

In China, copyright and design patents serve two distinct functions: copyright protects the physical expression of an idea whereas a design patent protects the aesthetic features of an industrial product. Different aspects of the same product may be covered by these different types of IPR. For example, the external appearance of an electric razor may be protected by a design patent whereas the instruction manual, packaging and marketing materials are covered by copyright.

Some companies may ask when a design patent should be used and when copyright should be used to protect a product. In general, design patent protection should be considered whenever a product with new and distinctive aesthetic features is in development. It is less straightforward if the product has two-dimensional (2D) design features such as patterns, colours or their combinations. Although such products are not excluded absolutely from design patent protection, such 2D design features would be excluded if these are mainly used for identification i.e. being used as trade mark. Therefore, it is advisable to protect products with 2D design features by copyright initially, and where possible apply for design patent protection.

Furthermore, copyright can offer an additional layer of protection as it protects images of the design such as photographs and those found in instruction manuals. When counterfeit items are offered for sale, especially online, they often use copyright protected images. Providing copyright ownership can be proved, this can be a successful IPR protection strategy. This strategy is useful in cases where a design patent cannot qualify for a design patent, for example, if the product has been disclosed in Europe and cannot meet the absolute novelty requirement for a design patent.

Take away messages

- You should register your design patent in China before you disclose your design patent anywhere in the world (or before the end of the 'grace' period, to follow a European registration with a Chinese application), otherwise your design patent could be invalidated.
- Design and copyright in China protect different items. If a product is to be made from design diagrams, then design patent protection should be considered.
- Multiple design application (up to a maximum of ten designs) should be actively considered whenever possible.
- Due to the unique Chinese IP infringement environment and the nature of design patents, design patent infringement litigations are very active, and good litigation results can be obtained by the owners of such rights.



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