



Promoting Intellectual  
Property Rights in the  
ASEAN Region

## Session 5: Novelty, Conflicts with prior rights

Mr. Nguyen Quang Tuan, Deputy Director of ID  
Examination Center, IP Vietnam  
Kuala Lumpur, Malaysia | 29-30 October 2019



Funded by the European Union



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## General considerations

- ❖ An industrial design cannot be validly registered if it is not new. **Absolute worldwide novelty** is required in order that a design may be registered or maintained on the register.
- ❖ Novelty may be examined by an industrial property authority prior to registration, either ex officio or following an opposition filed on grounds of lack of novelty.
- ❖ Novelty may also be examined in revocation, cancellation or invalidation proceedings before an industrial property authority or before a judicial authority (court of law).
- ❖ Regardless of the procedural stage for the examination of novelty, the substantive conditions of the novelty requirement remain essentially the same.

## Definition

- ❖ Novelty of a design is determined by reference to everything that has been made available to the public before a relevant date with respect to that design.
- ❖ To this effect, the novelty requirement will be met if the design is NOT **identical or substantially identical** with any **earlier design** disclosed to the **relevant public** before the **applicable date**.

## Public of reference

- ❖ The public of reference to decide whether an industrial design has been made available:
  - The general public or the average consumers
  - The sector of informed consumers that usually purchase or use the products that embody the design
  - The trade, industry and business circles that ordinarily deal with the production, importation, distribution or marketing of the products that embody the design
- ❖ It is not necessary that the general public be able to access the sources of disclosure of designs to destroy their novelty.
- ❖ The required novelty will not be complied with if the informed consumers or business circles have had, or could have had, access to sources of disclosure before the relevant date.



## Public of reference



## Relevant date for novelty purposes

- ❖ Generally be the date of filing of a regular application to register the industrial design with an industrial property Office. A regular application is one that complies with the requirements prescribed to obtain a filing date.
- ❖ The priority date
  - The applicant invokes a right of priority under the Paris Convention.
  - The period of priority for industrial designs is six months.
  - If the priority of two or more earlier applications is claimed, the date of the earliest of those applications must be taken.

## Grace period

- ❖ The absolute novelty requirement is quite strict.
- ❖ Grace period may be applied (a period of time after a design is disclosed during which the design application can be filed without such disclosure destroying the novelty of that design).
- ❖ Grace period is usually a period of 12 months/6 months that precedes the date of filing of the application of the priority application.
- ❖ The grace period may be limited to particular cases of disclosure:
  - Disclosure took place at an official or officially recognized exhibition.
  - Disclosure resulted from an illegal act or abuse committed against the design owner.

## Possible sources of disclosure

Disclosure of a design in a way that makes the design accessible to the public will require that the design may be seen or retrieved from certain public sources.

The main sources of disclosure through which a design can be made available to the public:

- ❖ Commercial distribution and use in trade
- ❖ General publications
- ❖ Official publications
- ❖ Disclosure on the internet
- ❖ Disclosure at an exhibition

## Possible sources of disclosure - Commercial distribution and use in trade



Disclosure of an industrial design may result from:

- ❖ The introduction into the marketplace of products that embody the design.
- ❖ The distribution of products that embody the design to the public free of charge as samples, as market test runs or for advertising purposes.

## Possible sources of disclosure - General publications

Disclosure of an industrial design may result from the graphic or photographic representation of the product that embodies the design in:

- ❖ Public periodicals, newspapers, magazines or other publications
- ❖ Specialized publications such as professional periodicals and thematic magazines
- ❖ Industrial and commercial catalogues distributed by producers and distributors of products within the relevant trade circles or to the public at large



## Possible sources of disclosure - Official publications



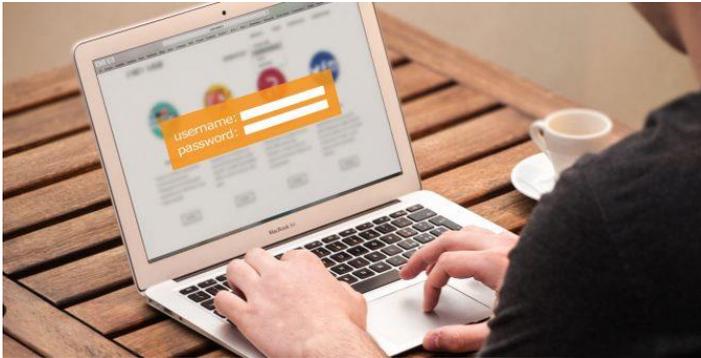
- ❖ Publications issued by the national industrial property authorities (IP Offices) of any country, such as official gazettes and bulletins, are also relevant sources of disclosure.
- ❖ Not only bulletins or gazettes dedicated to industrial designs but also bulletins that announce trademarks, patents and other IP rights.
- ❖ The reproduction of the design may not be included in the publication but available upon request .

## Possible sources of disclosure - Disclosure on the internet

- ❖ Internet sites and databases should be regarded as publicly available sources of information.
- ❖ Disclosure on the internet that allows the public to have clear access to the appearance of the product will destroy the novelty of the design embodied in that product in the same way as the commercial distribution.



## Possible sources of disclosure - Disclosure on the internet



A disclosure on a website should be regarded as a public disclosure

- ❖ even where the website requires a subscription or payment, or is password protected.
- ❖ if access to the website is not restricted by confidentiality clauses and is accessible to the traders and business circles that deal with the products in question.

## Possible sources of disclosure – Date of disclosure

- ❖ It will be necessary to ascertain the precise date of the disclosure of a design on an internet site to be able to compare that date against the filing date or the priority date of the application.
- ❖ The date of an internet disclosure may not always be readily available.



## Possible sources of disclosure – Date of disclosure

<http://www.basenotes.net/ID26136517.html>

DIRECTORY NEWS FEATURES SHOPPING REVIEWS EVENTS FORUMS GROUPS BLOGS SOTD AWARDS

Home » Perfume Directory » Yves Saint Laurent

Perfume Directory

# Manifesto (2012) ♀

by Yves Saint Laurent



-  Wishlist
-  I Own This
-  Testlist
-  Have tried

- Show Reviews
- Show Stockists
- Private Notes
- Upload your photo

## Possible sources of disclosure – Reliable date of disclosure

Indexing dates are given to the web page by search engines (e.g. from the Google cache)







Google Search

I'm Feeling Lucky

## Possible sources of disclosure – Reliable date of disclosure

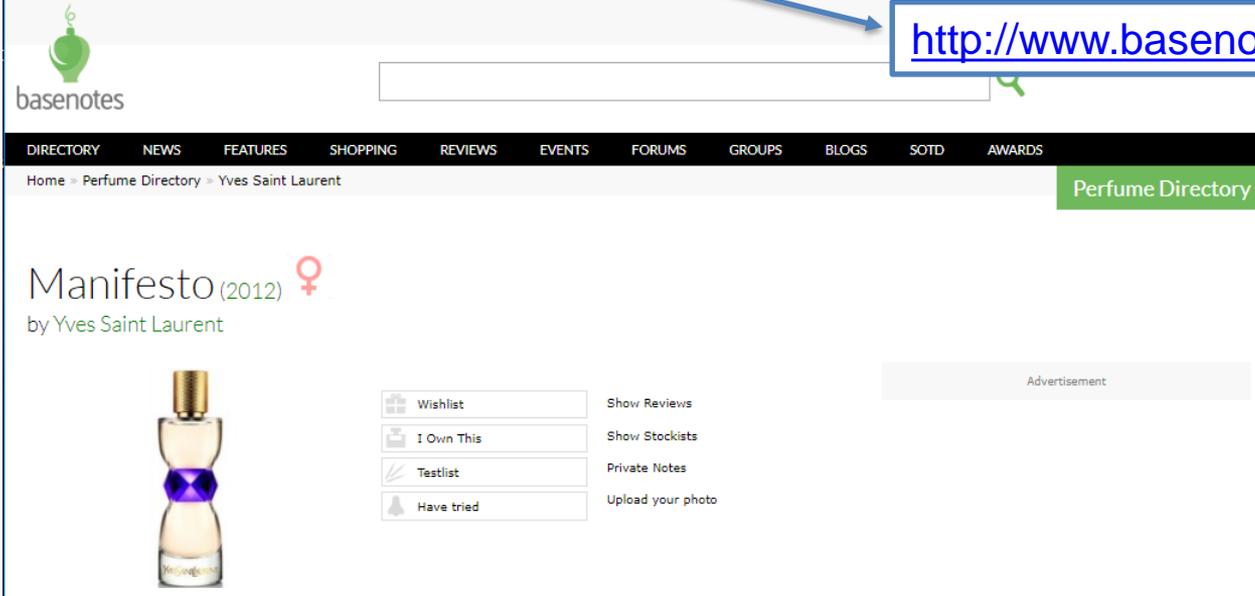
This is Google's cache of <http://www.basenotes.net/ID26136517.html>. It is a snapshot of the page as it appeared on 10 Oct 2019 11:24:33 GMT. The current page could have changed in the meantime. [Learn more.](#)

[Full version](#) [Text-only version](#) [View source](#)

Tip: To quickly find your search term on this page, press Ctrl+F or ⌘-F (Mac) and use the find bar.

10 Oct 2019 11:24:33 GMT

<http://www.basenotes.net/ID26136517.html>



The screenshot shows the homepage of the basenotes website. The navigation menu includes: DIRECTORY, NEWS, FEATURES, SHOPPING, REVIEWS, EVENTS, FORUMS, GROUPS, BLOGS, SOTD, AWARDS. The breadcrumb trail is: Home > Perfume Directory > Yves Saint Laurent. The main content area features the perfume 'Manifesto (2012)' by Yves Saint Laurent, marked with a female symbol. A product image of the perfume bottle is shown on the left. To the right of the image is a list of user actions: 'Wishlist', 'I Own This', 'Testlist', and 'Have tried', each with a corresponding icon and a button. Further right are links for 'Show Reviews', 'Show Stockists', 'Private Notes', and 'Upload your photo'. An advertisement placeholder is visible at the bottom right of the product section.

Google cache

## Possible sources of disclosure – Reliable date of disclosure

Information relating to the updates of a web page is available from an internet archiving service



Explore more than 384 billion [web pages](#) saved over time

<http://www.basenotes.net/ID26136517.html>

**Calendar**

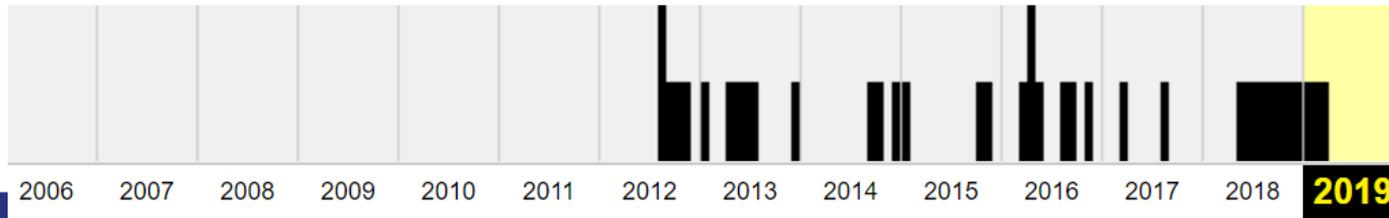
[Collections](#) <sup>beta</sup>

[Changes](#) <sup>beta</sup>

[Summary](#)

[Site Map](#)

Saved **37 times** between [August 7, 2012](#) and [March 29, 2019](#).



## Possible sources of disclosure – Reliable date of disclosure

http://www.basenotes.net/ID26136517.html

Go

JUL

**AUG**

SEP



**07**



2011

**2012**

2013

[37 captures](#) [Base Directory](#) [Yves Saint Laurent](#) [Manifesto](#)

7 Aug 2012 - 29 Mar 2019

### MANIFESTO (2012) BY YVES SAINT LAURENT



**Launched:** 2012

**Gender:** Feminine

**Availability:** In Production

**Perfumer:** Anne Flipo / Loc Dong [IFF]

**Bottle Designer:** Unknown - Let us know

## Possible sources of disclosure – Reliable date of disclosure

The web site that provides timestamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs).

### File history

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Click on a date/time to view the file as it appeared at that time.

	Date/Time	Thumbnail	Dimensions	User	Comment
current	<b>16:15, 13 September 2012</b>		2,850 × 4,000 (185 KB)	<b>Mariusba</b> ( <a href="#">talk</a>   <a href="#">contribs</a> )	User created page with UploadWizard

## Possible sources of disclosure – Disclosure at an exhibition

- ❖ Grace period may be applied.
- ❖ However, the law may limit the application of grace period only to disclosures at specific exhibitions, such as official or officially recognized international exhibitions.



## Possible sources of disclosure – Disclosure at an exhibition



Filed design



Cited design

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## Identity of designs

- ❖ In principle, the requirement of novelty is met if no identical earlier design can be found.
- ❖ However, minor, insignificant differences, and immaterial details, should not be taken into account when comparing a design against an earlier disclosure.
- ❖ Such minor differences should not affect the relevance of the earlier disclosure for novelty purposes.
- ❖ A difference or variation of appearance should be regarded as minor, insignificant if it would normally not be noticed by the average consumer, or if the relevant feature can only be perceived upon close examination.

## Insignificant differences

Filed design



Earlier design



## Overall impression

- ❖ The assessment of novelty should be undertaken on the basis of the **overall impression** given by the design under examination, as compared to the overall impression given by each individual earlier design.
- ❖ The examination will require determining whether – as a matter of **first impression**, from the perspective of the potential consumer of the product – the design under consideration is perceived as being the same or practically the same as an earlier design.

## Overall impression

Filed design



Earlier design



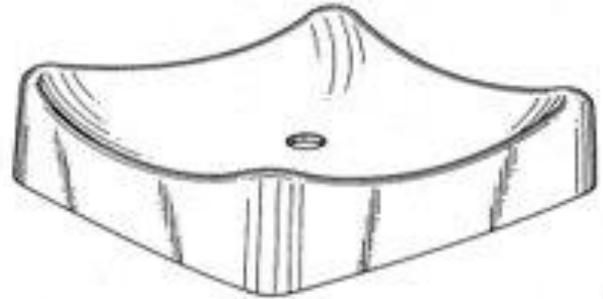


## Overall impression

Filed design



Earlier design



## Overall impression

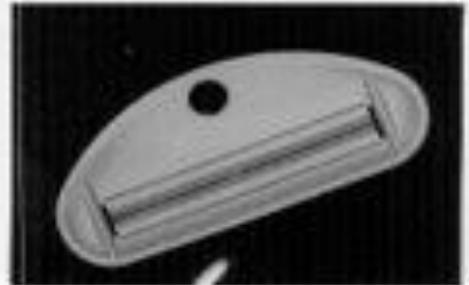
Filed design



Earlier design



Top view



Bottom view

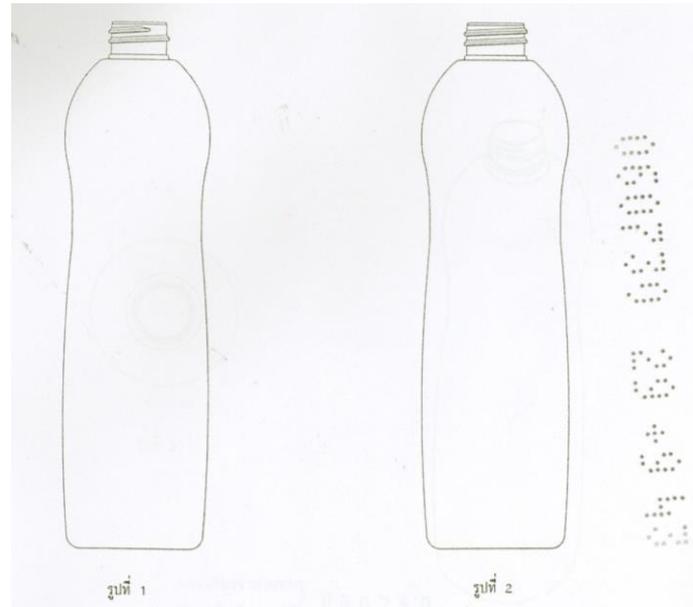
The design of the earlier design is not a new design.

## Overall impression

Filed design



Earlier design

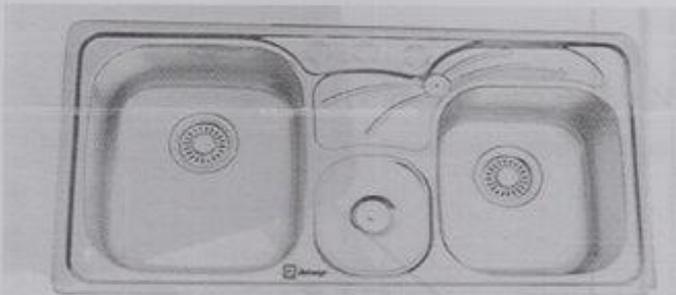


## Overall impression

Filed design



Earlier design



**CHẬU RỬA CHÉN DATKEYS**  
Được sản xuất bởi Huaqian Group theo công nghệ tiên tiến nhất của Thụy Sĩ tạo ra bề mặt nhám, mịn, sang trọng. Sản phẩm được chế tạo từ thép không gỉ, có độ dày 0.9mm, bề mặt sau được bao phủ hợp chất chống ồn, ngăn sự ngưng tụ nước. Có bộ phận xả nước bằng nút nhấn, lỗ thoát với bộ phận chặn rác chống bốc mùi, tiện lợi hơn khi sử dụng. Giá bán 1.500.000đ/cái tại các đại lý của công ty Đất Quảng trên toàn quốc.

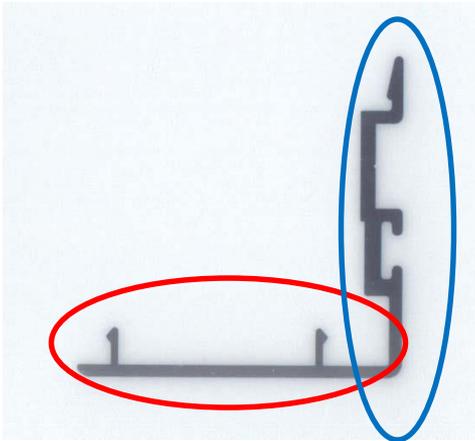
Tạp chí Tư vấn Tiêu dùng xuất bản 20/03/2004

## Combinations of earlier designs

- ❖ For assessing novelty, designs should be compared individually and separately.
- ❖ Novelty should not be assessed by comparing a design against a combination of features taken from two or more earlier designs.
- ❖ A combination of different prior features will generally form a novel design, unless the overall first impression given by this combination remains closely similar to that given by one or more earlier designs.
- ❖ In national laws there may be an additional requirement, such as creativity, inventive step or individual character that is assessed by comparing a design against a combination of features taken from two or more prior designs.

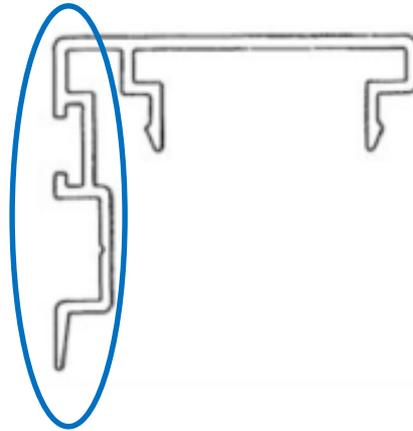
## Combinations of earlier designs

Filed design

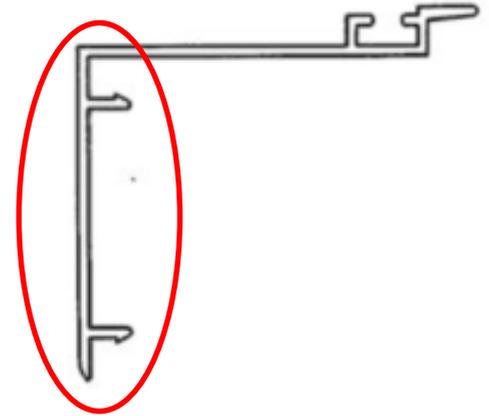


VN 3-2013-00323  
Filing date: 12/03/2013  
Title: Profile  
Locarno class: 25-01

Earlier designs



CN 3419331  
Publication date: 12/01/2005  
Title: Profile  
Locarno class: 25-01



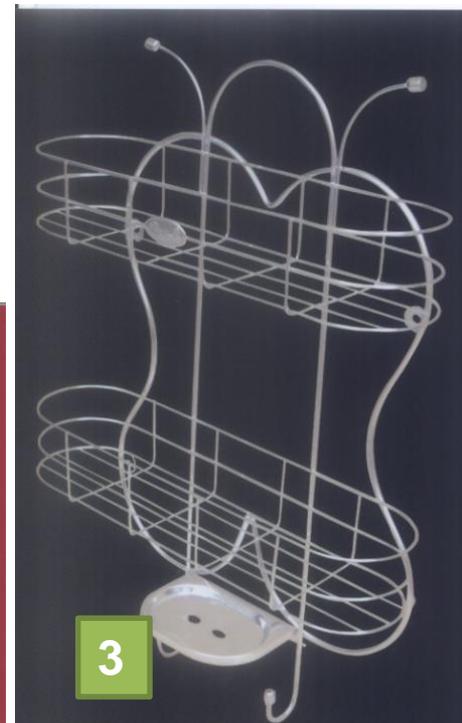
CN 301145935  
Publication date: 24/02/2010  
Title: Profile  
Locarno class: 25-01

## Combinations of earlier designs



Filed design

Earlier designs



## Freedom of design

- ❖ The purpose of a design is to make a product aesthetically pleasant without interfering with the technical functionality.
- ❖ Some products contain standardised features due to specific functional requirements.
- ❖ Those features are commonplace, and the designer will have little or no freedom to alter such features.



ASUS Zenfone 5



iPhone X



Ulefone T2 Pro



Leagoo S9

## Freedom of design



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## Conflict with prior rights

- ❖ To the extent that national law so provides, an industrial design may not be validly registered if the registration of the design or its commercial use would conflict with an earlier intellectual property right.
- ❖ Such conflict may occur in respect of prior registered industrial designs, earlier registered or well-known trademarks, earlier copyright in protected works, or existing rights in personal names, portraits or images.

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## Conflicts with prior rights in registered designs

- ❖ If an industrial design under examination is identical with or not substantially different from an earlier registered industrial design, the registration should be objected. If the design is registered, the registration could be revoked, cancelled or invalidated.
- ❖ The examining authority should apply the same standards that are applied to establish novelty of an industrial design in respect of other earlier disclosed designs.
- ❖ The earlier registered design is presumed to be valid. However, the applicant of the later design may challenge the validity of the earlier registration with invalidation proceedings.

## Conflicts with prior rights in registered designs



VN 3-2007-00924



Filing date  
19/7/2007

Rejected



Priority date  
19/3/2007  
JP

Filing date  
09/9/2007

Registration 11819  
22/5/2008

VN 3-2007-01261

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## Conflicts with prior rights in distinctive signs

- ❖ If an industrial design that is submitted for registration is identical with an earlier registered or well-known trademark or is different from such trademark only in features or details that would not produce a different overall impression on an informed user or average consumer of those products, the registration should be objected.
- ❖ If the design is registered in spite of the earlier conflicting mark, the registration could be revoked, cancelled or invalidated by the IP Office or by the court.
- ❖ If an application for the registration of an industrial design takes up, reproduces or includes, without due authorization, a registered or well-known mark that belongs to a third person, this person may oppose the registration or request the registration to be revoked, cancelled or invalidated.

## Conflicts with prior rights in distinctive signs



EUTM 002083327

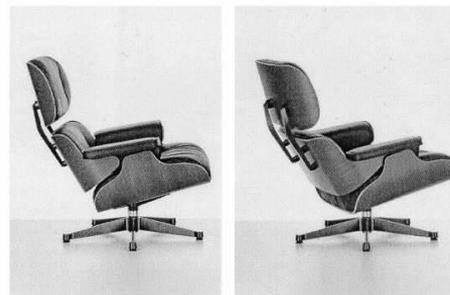


EUTM 004467247

## Conflicts with prior rights in distinctive signs



EUTM 000031203



EUTM 000182451

## Conflicts with prior rights in distinctive signs



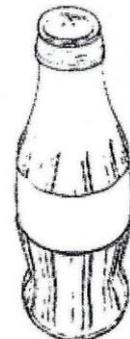
BN 40222



PLAN VIEW



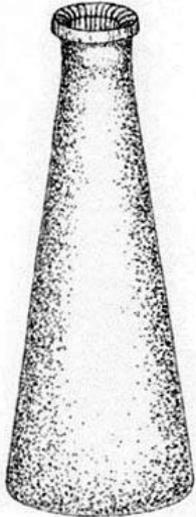
TYPICAL ELEVATION



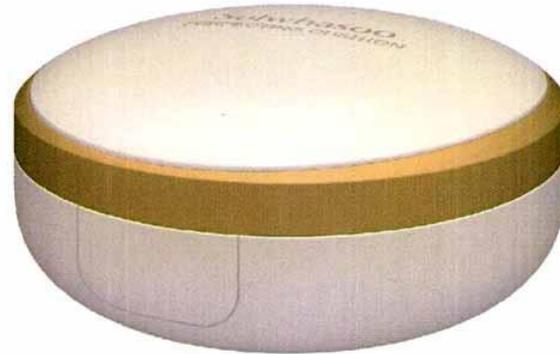
PERSPECTIVE VIEW

BN 37604

## Conflicts with prior rights in distinctive signs



PH-4-2014-5923



PH 4-2014-2479

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### **CONFLICTS WITH PRIOR RIGHTS**

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## Conflicts with prior rights in copyrighted works

An industrial design may be characterized as a blend of functionality and aesthetics.



## Conflicts with prior rights in copyrighted works

Every industrial design is based on an artistic concept that is applied to a utilitarian product.

‘Works of applied art’



## Conflicts with prior rights in copyrighted works

The artistic work that underlies every industrial design may have been created purposely for embodiment in an industrial product



In either case, the creator of the work enjoys copyright.



or may have been created for purely artistic purposes and was subsequently taken up to be embodied in a utilitarian article

## Conflicts with prior rights in copyrighted works

- ❖ If the economic rights in the underlying work have not been sufficiently assigned to the applicant of the industrial design registration or to his predecessor in title, the registration could be opposed or invalidated by the copyright holder.
- ❖ Likewise, if an industrial design submitted for registration reproduces or embodies a work of sculptural or pictorial art, or a work of applied art, without authorization from the artist or designer of the work, the registration may be objected by the examining authority (administrative or judicial) on opposition from the holder of the copyright in the work. If the industrial design is registered, the registration could be revoked, cancelled or invalidated upon request by that holder.

## Conflicts with prior rights in copyrighted works





## Promoting Intellectual Property Rights in the ASEAN Region

# Q & A



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THANK YOU



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