

APPEARANCE OVERRIDES FUNCTION IN DESIGN PATENT APPLICATIONS

by Titikaan Ungbhakorn

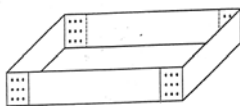


Titikaan Ungbhakorn, Attorney
Intellectual Property Department

In a case as recent as 2007, the Board of Patents again rendered a decision affirming that only the shape or appearance of a product design shall be taken into consideration when determining patentability. It is not necessary for a product design to have an improved or developed function as this does not reflect the patentability of the product design.

The affirmative statement is found in the Board of Patents' Decision No. 19/2550 for a design patent application entitled "A Tray for Bottles" which was filed on May 4, 2000.

Thai Design Patent
Application No. 0002000770



On June 15, 2007, the Director-General dismissed this design patent application because the product design is in the shape of a rectangular box which resembles prior art. Also, the submitted product design has portions of the side edges that are formed by the vertical coupling of sheets which are similar to an existing design. Therefore, the design for "A Tray for Bottles" is not new since it is similar to an already existing design according to Section 57 (4) of the Thai Patent Act B.E. 2522 (A.D. 1979) as amended by the Thai Patent Act (No. 3) B.E. 2542 (A.D. 1999). The pertinent section is provided below:

Section 57: The following designs are not new and will be rejected by the Thai Patent Office:

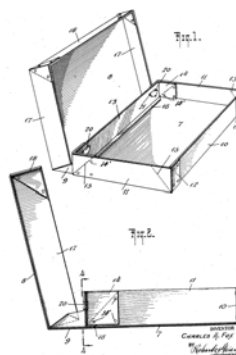
- (1) A design widely known or used by others in this country before the filing of the application for a patent;
- (2) A design which was disclosed or described in this or a foreign country before the filing of the application for a patent;
- (3) A design which was published before the filing of the application for a patent;

(4) Any design so nearly resembling any of the designs prescribed in (1), (2), or (3) as to be an imitation.

On August 16, 2007, the applicant filed an appeal petition to the Board of Patents against the Director-General's rejection. The applicant argued that the various shapes of most product designs are generally geometric, including squares, triangles, and circles. The applicant's product design can also be produced in a square or triangular shape. As for the portions of the side edges that are formed by the vertical coupling of sheets, in the assembled state of the product design of the known art, the top and bottom edge portions must be folded toward each other to form a box. For the application under consideration, the applicant argued that the folding is applied to only the four side edges and once connected to one another, a tray is formed. Moreover, the side edges can be disassembled or assembled as required.

The Board of Patents examined the present product design and compared it to the known design, US Patent No. 1,559,241 for "Collapsible Box" which was filed on October 27, 1925.

US Patent No. 1,559,241



The Board found that the applicant's product design is rectangular in shape and is characterized in that the side edges of both sides, that is, the area of the side edges, are formed by the vertical coupling of the sheets connected to the corners of the box, which is similar to the US design. Even though the areas where the sheets are vertically coupled together in the applicant's design have 9 dots lined up,

which is different from the known design with areas having only 4 dots, this difference does not make the shape of these two designs distinctively different from each other. When the overall product design of the applicant is considered, it can be seen that it resembles a known product design, and thus lacks novelty.

According to the Board of Patents' point of view, in the examination of a product design, emphasis should be placed on the determination of only the shape or outer configuration, and not the function of the product design. Furthermore, the geometric shapes that the applicant mentioned are shapes that have existed for a long time. Therefore, the issues raised by the applicant cannot prove that the product design is patentable. The Board of Patents agreed with the Director-General's decision and dismissed the appeal petition accordingly.

To summarize this case, the applicant wished to receive a design patent for a product design for "A Tray for Bottles," but he was denied the patent because of the cited US Patent for a "Collapsible Box." The application was rejected because the differences in uses and functions between these two designs were not recognized by the Board of Patents. Instead, the Board of Patents focused solely on the outer appearance of the product designs when rendering its judgment.

Therefore, a product design similar in appearance to a known product would not qualify for a design patent in Thailand, even though the two may have been designed to be used for different purposes. Moreover, the novelty of the design can be destroyed not only by the existing product design, but also by existing inventions which are similar to the design. ♦