

Study Guidelines

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2021 – Study Question

Industrial designs and the role of prior art

You are invited to submit a Report addressing the questions below.

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

References to a "design" below are to be read as referencing the intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture, irrespective of what it is called in your jurisdiction.

Note: If your answer(s) to Q1) to Q3) below is (are) the same as your answer(s) in reply to the 2016 Designs Study Question, you may simply refer to those answer(s).

- 1) a) Does your Group's current law provide for an intellectual property right (other than copyright, trade marks or trade dress), that specifically protects the outward appearance or ornamentation of an object or article of manufacture or other? Please answer YES or NO.

Yes.

- b) If YES to Q1.a), please identify that law and explain what that right is called. (e.g., registered design, industrial design, design patent, etc.).

Federal Law for the Protection of Industrial Property (FLPIP).
Industrial Design Registration.

- 2) Please identify what features of the outward appearance or ornamentation are taken into consideration for a design, e.g., shape/contour, surface, texture, color, etc.

According to Article 66 of the FLPIP, there are two kinds of industrial designs: industrial drawings (2-D designs) and industrial models (3-D designs).

- The protection of Industrial drawings contemplates the combination of figures, lines or colors that are incorporated into an industrial or artisanal product for ornamentation purposes, and which confer to it a peculiar and self-appearance.

- The protection of industrial models contemplates the three-dimensional shape that serves as a type or pattern for the manufacture of an industrial or artisanal product, which confers to it a special appearance in so far as it does not involve technical effects.

In practice, for industrial models some color features might be accepted.

- 3) a) Is prior art used to assess requirements for protection of a design prior to registration/issuance of a design, i.e., during substantive examination by an Intellectual Property (“IP”) Office? Please answer YES or NO.

Yes.

If you have answered YES to Q3.a), please proceed to answer Q3.b). Otherwise, please proceed to Q4).

- b) Referring to Q3.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely ...

According to FLPIP, the industrial designs that are new and susceptible to industrial application shall be registerable.

In addition, it should be understood as new, a design which is of a) independent creation and, b) which differs by a significant degree, from known designs or from combinations of designs known features.

“Independent creation” is achieved where no other identical industrial design has been made public before the registration application filing date, or before the date of the acknowledged priority. Those industrial designs whose characteristics differ only

in irrelevant details shall be considered identical, (the Mexican group interprets this provision as being related to an originality requirement)

and

“Significant degree” (from known designs or from combinations of designs known features) is understood as the general impression that an industrial design produces to a person skilled in the art and which differs from the general impression produced by any other industrial design, which has been made public before the registration application filing date or before the acknowledged priority date, considering the designer’s degree of freedom for the creation of the industrial design (the Mexican group interprets this provisions as being related to a requirement for individual character).

- c) Referring to Q3.a) to Q3.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

Articles 45, 51 (secret prior art), 65, 67, 76 and of the FLPIP.

- 4) a) Is prior art used to assess requirements for protection of a design when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO.

Yes. If validity is questioned based on novelty and/or significant degree variations.

If you have answered YES to Q4.a), please proceed to answer Q4.b). Otherwise, please proceed to Q5).

- b) Referring to Q4.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely ...

Please see response to 3.b) above for the originality and individual character requirements.

- c) Referring to Q4.a) to Q4.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

Article 156 fraction I, in light of Articles 45, 51 (secret prior art), 65, 67, 76 and of the FLPIP

- 5) a) Is prior art used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q3) and Q4)? Please answer YES or NO.

No. In the practice of infringement and counterclaim, prior art is commonly connected to any of the plaintiff's or the defendant's claims.

If you have answered YES to Q5.a), please proceed to answer Q5.b). Otherwise, please proceed to Q6).

- b) Referring to Q5.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely ...

- c) Referring to Q5.b), please indicate in which context these requirements for protection are taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q3) and Q4).

- d) Referring to Q5.a) to Q5.c), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

- 6) a) Do your national/regional laws or guidelines provide different definitions of prior art or indications of what qualifies as prior art for registration/issuance, validity, infringement, or other? Please answer YES or NO.

No.

- b) If YES to Q6.a), please briefly identify the differences, if not readily apparent from your responses to Q3) to Q5).

Criteria of prior art

- 7) a) What are recognized means of disclosure, i.e., which materials/documents,

etc., can constitute prior art?

Oral or written disclosures, exploitation, or any dissemination or information media in Mexico or abroad.

b) Does the prior art have to be “printed” and if so, what does that mean?

No, the prior art can be disclosed by any means, provided it is considered made available to the public.

c) Does the prior art have to be “published” and if so, what does that mean?

No. Secret prior art, that is, applications filed earlier and published later than the filing date or recognized priority date of a given application, as the case may be, do not need to be published to be included in the prior art applicable to said given application.

d) Have there been any recent updates or clarifications of prior art in your jurisdiction focused on intangible or other non-“printed” materials? Please provide those updates.

No.

Time of disclosure

8) a) What is the relevant date of a prior art reference?

General prior art – the date it has been made available to the public referred to the filing date of an application and/or the recognized priority.

Secret prior art – filing date and/or the recognized priority.

b) Are design applications published, and if so, when?

Industrial designs applications are published by the Mexican Institute of the Industrial Property as soon as possible after the positive conclusion of the formal examination.

c) When and how are issued design patents or registered designs published?

Industrial designs registrations are published by the Mexican Institute of the Industrial Property as soon as possible after paying the granting fees.

d) Does the publication of an issued design patent or registered design effect a publication of the underlying design application if not previously published?

Yes.

Circumstances of disclosure

9) Are the circumstances of disclosure relevant, e.g. (please tick all boxes that apply):

- geographic location
- type of location (e.g., during an exhibition)
- sector/type of products
- the person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc.)
- the recipient of the disclosed prior art
- other, namely *period of time before filing*.

Grace period

10) Does your jurisdiction provide a grace period after a first public disclosure of a design for later filing for protection of such design? Please answer YES or NO. If answering YES, please explain the conditions (e.g., formal request, same applicant) and identify the length of time for the grace period (e.g., 6 or 12 months).

Yes. The disclosure of the design directly or indirectly made by the designer, his successor in title (applicant), or as the case may be, a third party who has obtained the information from any of them, directly or indirectly, and within twelve months prior to the application filing date or, where applicable, the recognized priority, shall not be considered as part of the prior art for an industrial design application.

The publication in an application, patent or registration made by the Mexican Institute of Industrial Property or other industrial property foreign office shall not be included in the cases referred to in the aforementioned paragraph, unless it has been made by error attributable to those authorities or that the application has been filed by a third party without authorization, who directly or indirectly obtained the information from the designer.

A declaration should be made in the application at the time of filing.

Other

11) Please indicate any other relevant criteria of prior art.

N/A

The use of prior art when assessing the requirements for protection of a design

12) a) Does one single prior art reference have to disclose *all features* of a design in order to prevent its validity?

No.

b) Can a prior art reference that *differs only in minor details* from a design prevent finding validity? If YES, please indicate what does *only in minor details*

mean (is it, e.g., in a non-substantive way)?

This response considers that “minor details” has the same meaning than “immaterial details” or “irrelevant details”.

Yes. According to Article 67, fraction II of the FLPIP, industrial designs differing only in irrelevant details are considered identical.

c) Can a prior art reference that discloses the entire design *with additional features* prevent finding validity?

Yes. As long as those additional features do not change the overall impression in such a degree that an “accidental anticipation” can be established.

d) Can a *combination* of prior art references be used to disclose the features of a design in order to prevent its validity? If YES, is there a limit to the number of prior art references that can be combined?

Yes. There is no statutory limit to the number of prior art references that can be combined if the references contain the different design features. However, the combination of two prior art references has more chances to prevent validity than a combination of three or more prior art references.

e) Does the assessment of validity differ where there is numerous prior art or very few prior art available?

Yes. In order to assess novelty, the issue whether the industrial design differs in a significant degree from a prior art reference should be addressed. In evaluating the difference, the designer’s degree of freedom to create the design is to be taken into account. Degree of freedom depends, among other aspects, on the saturation of the state of the art. Accordingly, the volume of prior art will define the standard to evaluate the relevant differences between the design and the prior art.

f) Does the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)?

No.

The influence of prior art on the infringement/scope of protection of a design

13) Does the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

Yes. In order to assess infringement / scope of protection, the issue whether an industrial design differs in a significant degree from a product should be addressed. Accordingly, the volume of prior art will define the standard to evaluate whether there is infringement or not.

II. Policy considerations and proposals for improvements of your Group's current law

14) Could any of the following aspects of your Group's current law relating to prior art be improved? If YES, please explain.

a) defining criteria of prior art

Yes. It could be advisable to specify that solely oral disclosures should not apply as a prior art for industrial design applications.

It could be advisable to define what should be understood by “been available to the public”, as stated in the definition of state of the art in article 45 of the FLPIP.

b) the use of prior art when assessing the requirements for protection of a design

It could be advisable to define what should be understood by “general impression (of the skilled in the art)”, “irrelevant details” and the “designer’s degree of freedom (for the creation of the industrial design)” to assess the registrability requirement.

The concept of the “skilled in the art” applied in the general impression assessment for designs could be clarified since it could be misunderstood as the “skilled in the art” for the evaluation of inventive step for patent matters.

According to the FLPIP, the industrial designs that are new and susceptible to industrial application shall be registerable.

A design is new if it is of a) independent creation and, b) differs by a significant degree, from known designs or from combinations of designs known features.

“Independent creation” is achieved where no other identical industrial design has been made public before the registration application filing date, or before the date of the acknowledged priority. Those industrial designs whose characteristics differ only in irrelevant details shall be considered identical, (the Mexican group interprets this provision as being related to an originality requirement),

and

“Significant degree” (from known designs or from combinations of designs known features) is understood as the general impression that an industrial design produces to a person skilled in the art and which differs from the general impression produced by any other industrial design, which has been made public before the registration application filing date or before the acknowledged priority date, considering the designer’s degree of freedom for the creation of the industrial design (the Mexican group interprets this provisions as being related to a requirement for individual character).

While the FLPIP seems to contemplate both the originality and the individual character in the definition of novelty, it would be desirable that said requirements were defined as separate requirements.

c) the influence of prior art on the infringement/scope of protection of a design

The scope of protection is defined in articles 80 and 81. In article 81 it is defined that the title holder may avoid the exploitation of a product containing the protected design and “a

substantial copy thereof". It is advisable to define the term "substantial" to determine the scope of protection and consequently the possible infringement.

Article 386 of the FLPIP establishes the different infringement activities, under which protected industrial designs would be infringed if a used design does not differ in a significant degree. Therefore, the clarification required in the numeral b, for the definition of "general impression (of the skilled in the art)" in relation to the assessment of "significant degree" would also apply in this point c.

Further, we consider that it would be necessary to clarify the relevance of the prior art to address these definitions.

- 15) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

N/A

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

- 16) Do you believe that there should be harmonisation in relation to the definition of prior art and/or the use of prior art when assessing the requirements for protection?

Yes.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

- 17) a) Should prior art be used to assess requirements for protection of a design prior to registration/issuance, *i.e.*, during substantive examination by an IP Office? Please answer YES or NO.

Yes.

*If you have answered YES to Q17.a), please proceed to answer Q17.b).
Otherwise, please proceed to Q18).*

- b) Referring to Q17.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character

- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely ...

- 18) a) Should prior art be used to assess requirements for protection of a design during determination of validity when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO.

Yes.

*If you have answered YES to Q18.a), please proceed to answer Q18.b).
Otherwise, please proceed to Q19).*

- b) Referring to Q18.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely ...

- 19) a) Should prior art be used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q17 and Q18)? Please answer YES or NO.

No. The assessment of requirements for protection should not be a matter of discussion during an infringement proceeding. However, considerations with respect to prior art applicable during the assessment of the requirements of protection should be taken into account, as suitable, in infringement proceedings when comparing the alleged infringing product with the protected design. For example, in determining whether there are differences, whether such differences constitute *minor or irrelevant details*, and whether the overall impression caused by the compared designs is the same.

*If you have answered YES to Q19.a), please proceed to answer Q19.b).
Otherwise, please proceed to Q20).*

- b) Referring to Q19.a), for which requirements for protection of a design should

prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

- c) Referring to Q19.b), please indicate in which context these requirements for protection should be taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q17) and Q18).

Criteria of prior art

- 20) a) What should recognized means of disclosure be, i.e., which materials/documents, etc., can constitute prior art?

Any means enabling the public to have access to information should be recognized as means of disclosure, including, printed materials, audiovisual means, exhibitions, electronic files, etc. Excluding solely oral means.

- b) Should the prior art have to be “printed” and if so, what should that mean?

No. However, solely oral means should not be allowed as prior art for designs.

- c) Should the prior art have to be “published” and if so, what should that mean?

No. Secret prior art does not need to be published, it only needs to be formally considered filed at the corresponding IP Office. On the other hand, published prior art should mean “accessible to the public”.

Time of disclosure

- 21) What should the relevant date of a prior art reference be?

General prior art – the date it has been made available to the public referred to the filing date of an application and/or the recognized priority.

Secret prior art – filing date and/or recognized priority date.

Circumstances of disclosure

- 22) What, if any, circumstances of disclosure should be relevant? Please tick all

boxes that apply.

geographic location

type of location (e.g., during an exhibition)

sector/type of products

the person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc.)

the recipient of the disclosed prior art

other, namely **period of time before filing**.

Grace period

23 a) Should there be a grace period after a public disclosure of a design for later filing for protection of such design? Please answer YES or NO.

Yes.

b) If the answer to Q23.a) is YES, please identify what the length of time for the grace period should be. Also, please explain what the conditions allowing for the benefit of the grace period should be (e.g., formal request, same applicant).

Length of time: twelve months before filing.

Conditions: that the previous disclosure was made by the designer, its assignee or any third party who obtained the disclosed information directly or indirectly from the designer or the assignee.

Other

24) Should there be any other relevant criteria of prior art?

N/A

25) Should the assessment of prior art differ for the different requirements for protection mentioned in Q17)b), Q18)b) and Q19)b)?

Yes.

The use of prior art when assessing the requirements for protection of a design

26) a) Should one single prior art reference have to disclose *all features* of a design in order to prevent its validity?

No.

b) Should a prior art reference that *differs only in minor details* from a design prevent finding validity? If YES, please indicate what should *only in minor details* mean (is it, e.g., in a non-substantive way)?

Yes. Minor details should mean details that i) do not change the overall impression of the analyzed design and ii) do not form part of the special aesthetical features of the design.

- c) Should a prior art reference that discloses the entire design *with additional features* prevent finding validity?

Yes, if the design is applied to the same or similar products to those of the prior art.

- d) Should it be possible to contest the validity of a design on the ground of a *combination* of prior art references disclosing the features of a design? If YES, should there be a limit to the number of prior art references that can be combined?

Yes. There should not be statutory limit to the number of prior art references that can be combined. However, it could be limited to the same kind of products in which the design will be applied or the related Locarno classification.

- e) Should the assessment of validity differ where there is numerous prior art or very few prior art available?

Yes.

- f) Should the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)?

No.

The influence of prior art on the infringement/scope of protection of a design

- 27) Should the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

Yes.

- 28) Please comment on any additional issues concerning any aspect of industrial designs and the role of prior art you consider relevant to this Study Question.

The Mexican group considers that the role of secret prior art should be specifically addressed in this study question.

- 29) Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

None, as of April 30, 2021.