



Q278-SGL-D-2021

Study Guidelines

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2021 – Study Question

National Group: Brazil / ABPI
Title: Industrial designs and the role of prior art
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Questions

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.)*

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.*

The features taken into consideration are the ornamental plastic shape of an object or the arrangement of colours and lines that can be applied to a product.

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.*

No.

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.*

Not applicable.

Novelty

Originality

Individual character

Non-obviousness

Inventive step

Aesthetic

- Ornamental
- Other, namely _____

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.

Not applicable.

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 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 _____

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 96 of Brazilian IP Law and Resolution nº 232/2019 of the Brazilian PTO (“Industrial Design Guidelines”).

II.

- 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.

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.*

Not applicable.

- 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).*

Not applicable.

- 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.

Not applicable.

III.

- 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).*

Not applicable.

Criteria of prior art

5)

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

Any document with a specified date that was made available to the public such as industrial design registrations, patents, catalogues, magazine articles, newspaper articles, electronic publications, scientific publications, websites, videos, etc.

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

No, the document does not have to be printed by applying ink (or a similar material) on a physical medium such as paper. In other words, electronic documents are accepted as prior art as long as the disclosure date can be unequivocally determined.

- c) *Does the prior art have to be “published” and if so, what does it means?*

Yes, the document needs to be made available to the public.

- 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

6)

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

The date when the prior art reference was effectively made available to the public. However, according to Art. 96 § 2 - For the sole purpose of determining novelty, the whole contents of an application for a patent or a registration filed in Brazil, but not yet published, will be considered as included in the state of the art from the date of filing, or from the priority claimed, provided that it is published, even though subsequently.

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

Yes, only after grant. Up to January 2020, the BPTO used to publish design applications after a final rejection. However, the BPTO stopped this practice to preserve the novelty of a rejected/withdrawn design and allow the Applicant to file a new application of such rejected/withdrawn design without the risk of facing an Administrative Nullity Procedure.

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

When the application is granted, the drawing that better characterizes the design is automatically published in the ensuing IP Gazette. In addition, the full document is accessible to anyone through the BPTO database.

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

No, since the application is granted/published without an examination on the merits (novelty and originality), i.e., if all the formal requirements are met, the application is automatically published, independently from previous registered/issued/published designs.

Circumstances of disclosure

7) *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 _____

Grace Period

- 8) 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. According to Article 96 of Brazilian IP Law:

“§ 3 - An industrial design of which disclosure occurred within the 180 (one hundred and eighty) days preceding the date of filing the application or of the priority claimed will not be considered as included in the state of the art, provided such disclosure is made in accordance with the situations provided for in items I to III of article 12.”

For the sake of completeness, Article 12 of Brazilian IP Law states that:

“Article 12 - The disclosure of an invention or utility model which occurs during the twelve months preceding the date of filing or priority of the patent application will not be considered as part of the state of the art, provided such disclosure is made:

I - by the inventor;

II - by the National Institute of Industrial Property - INPI, by means of the official publication of a patent application filed without the consent of the inventor and based on information obtained from him or as a result of his acts; or

III - by third parties, on the basis of information received directly or indirectly from the inventor or as the result of his acts.

Sole Paragraph - INPI may require the inventor to provide a declaration relating to the disclosure, accompanied or not by proof, under the conditions established in the rules.”

Other

- 9) Please indicate any other relevant criteria of prior art.

The images disclosed in the prior art document should have enough quality/resolution and comprise enough views so that the main ornamental features of the prior art design can be assessed and compared with the design being examined.

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

10)

- 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)?*

*Yes, there is no need for them to be absolutely identical to each other. The Brazilian IP Law or Industrial Design Guidelines do not explicitly determine what are minor details, and the BPTO relies on the definition of the “originality” requirement, that is, “An industrial design is considered original when it results in a **distinctive visual configuration** in relation to other prior objects” (Art. 97 of *of Brazilian IP Law*).*

It should be assessed on a case-by-case basis, but non-limiting examples are purely technical/functional elements (such as screws, nails, etc) or lines/curves/color that do not change the overall aesthetics of the design.

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

Yes.

- 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 not a limit to the number of prior art references that can be combined. However, according to the sole paragraph of Art 97 of the Brazilian IP Law: “the original visual result may be the result of the combination of known elements”

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

Depends on their relevance. Assuming that all the prior art references are relevant, then, it is an indication that the general design is very known in the art and its validity should rely on original features not found in any of the prior art references. Nevertheless, our Group believes that the relevance of each prior art (i.e. its proximity with the examined design) is more important than the quantity of prior arts.

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

11) *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.*

There is no specific provision on this in the Brazilian IP Law and in the guidelines, but practitioners would say YES.

Assuming that all the prior art references are relevant, then, it is an indication that the general design is very known/common in the art and, for this reason, it may be difficult to allege infringement unless the registered industrial design comprises an original feature that cannot be found in any of the prior art references but can be found in the potential infringer article.

According to practitioners, the scope of protection of an Industrial Design should be more limited when there are objects in the state of the art similar to the object protected by the Industrial Design. In other words, the greater the novelty of the proposed Design in relation to the prior art, the greater should be the scope of the protection conferred.

Therefore, the doctrine recommends the simultaneous realization of three comparisons:

I. a first comparison between the Industrial Design and the state-of-the-art documents closest to the Design and the object of analysis;

II. a second comparison involving the object being analyzed and the same prior techniques of the first comparison;

III. a third comparison between Industrial Design and object of analysis

If the result of the three comparisons is that the infringed and infringing designs are those with more similarity between themselves, there is infringement; otherwise there is no infringement.

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

12) *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*

No.

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

Yes. The Law is very broad/generic and does not establish clear rules on how exactly the prior art can be used when assessing the requirements for protection of a design. Our Group believes that these rules need to be defined in a specific Normative and/or Examination Guidelines. For instance, there should be rules establishing criteria to determine how to correctly analyse a prior art and compare with the design; the degree of similarity that is necessary to destroy the originality requirement; and the possibility of combining prior art references.

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

Yes. The Law is silent in this regard. Our Group believes that there should be provided rules establishing that there is infringement when an infringer article is identical or very similar to the registered design to the point that causes confusion to the consumer AND also when the registered design cannot be confused with its prior art references.

13) *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?*

No.

V. Proposals for harmonisation

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

14) *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.

15)

- 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.*

No.

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.*

Not applicable.

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

16)

- 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 _____*

17)

- 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.

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.*

Not applicable.

- 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).*

Not applicable.

Criteria of prior art

18)

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

Any disclosure (a document or any other means) with a specified date that was made available to the public such as industrial design registrations, patents, catalogues, magazine articles, newspaper articles, electronic publications, scientific publications, websites, videos, etc.

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

No, the disclosure does not have to be “printed” by applying ink (or a similar material) on a physical medium such as paper. In other words, electronic documents are accepted as prior art as long as the disclosure date can be unequivocally determined.

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

Yes, the disclosure needs to be made available to / accessible by the public.

Time of disclosure

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

The publication date. However, according to Art. 96 § 2 - For the sole purpose of determining novelty, the whole contents of an application for a patent or a registration filed in Brazil, but not yet published, will be considered as included in the state of the art from the date of filing, or from the priority claimed, provided that it is published, even though subsequently.

Circumstances of disclosure

- 20) *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 _____

Grace Period

21)

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).*

This Group understands that the period established by our Law is adequate, i.e., 180 days preceding the filing date or the claimed priority, if any. However, a term of 6 months would be easier and more adequate for Applicants to account the deadline.

The applicant should benefit from the grace period at any time during the period in which the design is in force, considering that it is possible to show the evidences (proofs) of the early disclosure as established by the Law.

This Group believes that a voluntary formal request to the Patent Office is not necessary.

Other

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

No

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

No

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

24)

- 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 would consist of features that does not impact the distinctiveness of the object, such as purely technical/functional features or lines/curves/color that do not change the overall aesthetics of the design

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

Yes.

- 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?*

No. This Group believes that only one document can be used to contest the validity of a design, with basis on the sole paragraph of Art 97 of the Brazilian IP Law: “the original visual result may be the result of the combination of known elements”.

If it is necessary to combine two or more prior art references, then the design should meet the originality requirement.

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

Depends on their relevance. Assuming that all the prior art references are relevant, then, it is an indication that the general design is very known in the art and its validity should rely on original features not found in any of the prior art documents. Nevertheless, our Group believes that the relevance of each prior art (i.e. its proximity with the examined design) is more important than the quantity of prior arts.

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

This Group believes that the assessment of validity should be different for bidimensional ornamental patterns.

The current understanding of the Brazilian PTO is that any prior ornamental pattern can be considered a relevant prior art for an 2D Industrial Design, even in the scenario when the 2D patterns are applied to completely different products. We cannot agree with this understanding, since an ornamental arrangement of lines and colors can be known in one segment of the industry, but completely new and original when applied to products in a different segment of the industry.

Therefore, for bidimensional ornamental patterns, this Group believes that the Locarno Classification should also be taken into account when evaluation the relevance of prior art an validity.

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

25) *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.*

This Group believes that YES, the assessment of infringement/scope of protection should take into account the number of relevant prior art.

Assuming that all the prior art references are relevant, then, it is an indication that the general design is very known/common in the art and, for this reason, it may be difficult to allege infringement unless the registered industrial design comprises an original feature that cannot be found in any of the prior art references but can be found in the potential infringer article.

This Group believes that the scope of protection of an Industrial Design should be more limited when there are objects in the state of the art similar to the object protected by the Industrial Design. In other words, the greater the novelty of the proposed Design in relation to the prior art, the greater should be the scope of the protection conferred.

Therefore, the doctrine recommends the simultaneous realization of three comparisons:

- I. a first comparison between the Industrial Design and the state-of-the-art documents closest to the Design and the object of analysis;*
- II. a second comparison involving the object being analyzed and the same prior techniques of the first comparison;*
- III. a third comparison between Industrial Design and object of analysis*

If the result of the three comparisons is that the infringed and infringing designs are those with more similarity between themselves, there is infringement; otherwise there is no infringement.

- 26) 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.

(...)

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

(...)