

CHAPTER 6**NOVELTY STATEMENT****INDEX**

- 6.1 Introduction
- 6.2 Definition
- 6.3 Purpose
- 6.4 Not mandatory
- 6.5 Application requirements
- 6.6 Circumstances for making a request
- 6.7 Form
- 6.8 Statements of novelty which duplicate the statement of monopoly
- 6.9 Statements in the absence of a monopoly statement
- 6.11 When the features claimed are not new or original
- 6.12 Amendment
- 6.13 Application form.

INTRODUCTION

- 6.1 Novelty statements are used to delineate those features of a design which the owner of the design considers to be new or original. They are not common. The statement is not mandatory but may be requested by the Registrar. The form of the statement is not as strictly enforced as that of the monopoly statement and, like the monopoly statement, cannot refer to features that are not shown in the representations and cannot refer to a method or principle of construction.

DEFINITION

- 6.2 Section 4(1) defines a statement of novelty as:

"..in relation to a design, means a statement relating to the representations of an article to which the design is applied that indicates those features of the representations in respect of which novelty or originality is claimed."

PURPOSE

- 6.3 The statement of novelty is used to highlight those portions of the design that the applicant believes are new or original, and thus distinguish it from any prior art. This may be for the applicant's own purposes or, if requested by the examiner, to distinguish it from any close prior art (see below).

It is not clear what effect a statement of novelty has on the protection of a design. Certainly, it would not effect the scope of the monopoly being claimed.

It seems that its function is simply to point out to any interested party those features that distinguish a design from what has gone before and so, perhaps, to avoid, as far as possible, any contest as to the novelty or originality of the design. In a related vein, the D.L.R.C. (at para 100) considered that a statement of novelty would be particularly useful in infringement proceedings.

Whatever their purpose, statements of novelty are not common. It could be that, in most cases, an applicant does not want to define the novel features, preferring instead to leave it to the courts to decide in the event of any contest. Some applicants may also feel that a novelty claim is superfluous, since registration implies that the office considers the design to be new or original.

NOT MANDATORY

- 6.4 A statement of novelty is not mandatory. An applicant may furnish such a statement voluntarily. If the voluntary statement fulfils all the requirements for a statement of novelty, then it may be allowed to remain on the application.

However, according to s.20(5)(a), the examiner can insist, on behalf of the Registrar, that a statement of novelty be made and can do so without giving a reason. In practice though, the examiner should only insist on such a statement if he/she considers it appropriate and should explain the reason(s) for the demand, and supply any evidence that may be relevant eg. a number of illustrations of the same article showing very similar features.

APPLICATION REQUIREMENTS

6.5 Novelty statements should fulfil the following requirements:

- 1) They should refer to parts of the article that are shown in the representations. If they aren't then the statement of novelty should be amended.
- 2) The wording should clearly and unambiguously describe which features of the design are being claimed as new or original. This may mean amendment of the representations to clearly identify the area being referred to. For example, it may be useful to indicate the area(s) being referred to with arrows and an appropriate reference letter and refer to this area in the statement eg. "the feature marked "A" in the representations."
- 3) They should not claim a method or principle of construction.
- 4) They should not claim features that are not already within the scope of the monopoly claimed. For example, a statement of novelty cannot claim features of pattern and ornamentation if the scope of the monopoly statement has been restricted to shape and configuration.

CIRCUMSTANCES FOR MAKING A REQUEST

6.6 In most, if not all, cases a request for statement of novelty will be the result of a contested objection to the novelty or originality of the design.

In this light, a statement of novelty should be requested where:

- 1) there is close prior art which the examiner has or would otherwise use as an objection to the novelty or originality of the design,

and/or
- 2) the applicant wishes to rely on a surprisingly small or ordinary feature(s) to distinguish their design from that prior art.

FORM

6.7 The form of the definition of the statement of novelty in s.4(1) implies that the statement of novelty should be in much the same form as a monopoly statement. In practice though the Registrar has not strictly enforced the form of such statements. Although a statement of novelty that follows the same form as the monopoly statement is acceptable, statements that differ from this form may also be accepted.

Such statements as the following, which follow the form of the monopoly statement, are acceptable:

"Novelty is claimed in the shape and/or configuration of the back and head-rest portion of the bath as shown in the representations."

and

"The novelty of the design resides in the shape and configuration of the ribs of the castor shroud as shown in the representations."

The following statements which do not follow the form of the monopoly statement are also acceptable so long as they lie within the scope of the monopoly claimed and are clearly indicated in the representations:

"Novelty is claimed in the back and head-rest portion of the bath."

and

"The novelty of the design resides in the ribs of the castor shroud."

The Designs Office believes that the above two statements are acceptable since the statement of novelty takes its colour from the statement of monopoly, and should be interpreted from that viewpoint. The statement of novelty would not therefore need to refer to the representations since this has already been implied by the statement of monopoly. Similarly, the statement of novelty would not need to refer to the features of shape, configuration, pattern or ornamentation, since the scope of the features claimed has already been defined in the statement of monopoly

STATEMENTS OF NOVELTY WHICH DUPLICATE THE STATEMENT OF MONOPOLY

- 6.8 An applicant may claim the same features in their statement of novelty and statement of monopoly. Doing so implies that the applicant wishes to restrict their monopoly to those features which he/she believes are new or original.

STATEMENTS IN THE ABSENCE OF A MONOPOLY STATEMENT

- 6.9 Since the Designs Office views the absence of a statement of monopoly as implying that the applicant is claiming all four features of shape, configuration, pattern and ornamentation, (see Chapter 5), then any statement of novelty made in the absence of a statement of monopoly (so long as it fulfils all the other standard requirements) would be acceptable since it could not fall outside the scope of the monopoly claim.
- 6.10 While there is nothing that prevents an applicant from making a statement of novelty in the absence of a monopoly statement, it is unusual. If the applicant can gain the scope of protection they require by the use of a statement of monopoly, then a statement of novelty may not be required, since registration of the design implies that the Designs Office considers it to be new or original in any case.

WHEN THE FEATURES CLAIMED ARE NOT NEW OR ORIGINAL

- 6.11 If the examiner can provide evidence that the claimed features are not new or original with regard to the article in question, then a suitable objection to the statement of novelty may be made, otherwise the statement must be allowed to stand.

AMENDMENT

- 6.12 The statement of novelty may be amended at any time before the registration of the design. See s.22(B), especially sub-section (3). Amended statements should be re-assessed according to the criteria given above.

APPLICATION FORM

- 6.13 The current application form part 1 does not have a separate space for writing a statement of novelty. Consequently it may be written in the space allocated to the monopoly statement so long as the two statements are distinct. It may also be included on a separate sheet included with the application. Some latitude can be allowed as to how the statement is presented.

If a statement of novelty is made after the first examination or is requested as an amendment to the application before examination, then a note on part 1 of the application form is sufficient to indicate that one has been added to the application. The text of the statement will be apparent from the correspondence file.

