

Summary of the Revision of the Design Examination Standard for the Examination Procedures (Draft version)

Part 11 Examination Procedures

Chapter 1 Introduction

111 Main Articles of the Design Act related to Examination Procedures

Article 16 (Examination by examiner)

Article 17 (Examiner's decision of refusal)

Article 17-2 (Dismissal of amendments)

Article 18 (Examiner's decision to the effect that a design registration is to be granted)

Article 19 (Notice of reasons for refusal) Mutatis Mutandis Application of Article 50 of the Patent Act

Article 19 (Formal requirements for decision) Mutatis Mutandis Application of Article 52 of the Patent Act

111.1 Examination Principles

Design examiners conduct substantive examinations on whether applications for design registration should be granted or not. Design examiners are required to utilize their high-level of expertise to make a fair judgment.

In an examination, the following points are considered to be especially important.

- (1) Examiners are required to conduct design examination as uniformly as possible in accordance with official examination guidelines, etc., paying due consideration to promptness, accuracy, fairness and transparency.
- (2) Examiners are required to make an effort to ensure and improve the quality of design examination with respect to prior design search and judgment on the requirements for design registration, etc.
- (3) Examiners are required to conduct efficient examinations in which there is sufficient communication with applicants or their legal representatives (hereinafter referred to as "applicants").

111.2 Outline of design examination procedures

The design examination procedures are summarized as follows.

- (1) Finding of a design in an application for design registration

The design examination starts with finding of a design in an application for design registration (hereinafter referred to as "the design in the application"). The finding of the design should be based on a comprehensive judgment on the statement in the application and on the drawings attached to the application. The examiner, furthermore, should consider the conditions for design registration under the main paragraph of Article 3 (1), and the requirements under Article 7 and Article 8 of the Design Act.

(2) Prior design search

Prior design search should be conducted in order to find (1) prior designs and (2) publicly or widely known shapes, patterns or colors, or any combination thereof (hereinafter, the combination of (1) and (2) is referred to as “prior designs, etc.”) which contribute to the judgment on the conditions for design registration in terms of novelty and uneasiness of creativity, etc. (Article 3(1) (i) to (iii), Article 3 (2) and Article 3-2 of the Design Act), the requirements in terms of prior application (Article 9 of the Design Act) and related design (Article 10 of the Design Act), pertain to the design in the application.

(3) Examination of conditions for design registration in terms of novelty and uneasiness of creativity

The examiner should examine whether the prior designs, etc. retrieved through prior design search provide a reason for refusal of the conditions for design registration in terms of novelty and uneasiness of creativity, etc. (Article 3(1) (i) to (iii), Article 3 (2) and Article 3-2 of the Design Act), the requirements in terms of prior application (Article 9 of the Design Act) or related design (Article 10 of the Design Act), pertain to the design in the application.

The examiner, in addition, should examine whether the application for design registration has a reason for refusal under Article 17 (i) to (iv) of the Design Act.

(4) Notice of reasons for refusal

The examiner should send to an applicant a notice of reasons for refusal where reasons for refusal are found during an examination (Article 50 of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act). The reasons for refusal should be stated as clearly as possible so that they may be easily understood by an applicant.

(5) Where a written opinion or a written amendment is submitted

Upon receiving a written opinion or a written amendment, the examiner should first consider the applicant’s assertion in the written opinion by carefully reading the written opinion so that its contents are sufficiently understood, and by fully examining the contents of the written amendment. Thereby, the examiner should determine whether the reasons for refusal stated in the notice of refusal have been overcome.

Upon receiving a written amendment, the examiner should compare the design initially filed and the amended design in order to confirm that the gist of the statement in the initial application and the drawings, etc. attached to the application initially filed have not been changed.

Where the amendment made to any statement in the application or to the drawing(s) has changed the gist of the design, the amendment should be dismissed by ruling.

(6) Final decision

Where no reasons for refusal are found, the decision to grant a design registration should be made. Where the reasons for refusal have been eliminated by means of a written opinion or a written amendment and where there are no more reasons for refusal left, the decision to grant a design registration should be made. (Article 18 of the Design Act)

Where the notified reasons for refusal are deemed not to be eliminated, the decision of the examiner should be refusal of the application for design registration (Article 17 of the Design Act). The examiner should also provide to the applicant a clear explanation of why the notified reasons for refusal have not been eliminated.