# "The Industrial Property Rights System in Japan"

## Chapter 1. The Role of the Industrial Property Rights System

Tanikei Manufacturing, Ltd. is a small company in Tokyo with just six employees. However, a technology it developed is now being used all over the world. What is it?

It's the "double safety can end". In order to avoid injuries, Tanikei Manufacturing developed a technology that prevents the fingers from touching the sharp edge of the opening of a pull-top can.

Around 25% of the world's cans today have this type of pull top.

This brilliant invention for such familiar everyday items as canned goods has brought big profits to the company.

What is the important key that can turn an invention into company growth? It's the patent.

Tanikei Manufacturing has acquired patents in 17 countries, including the United States and European countries, as well as in Japan.

The company's technology drew the eye of an American canned foods and beverages manufacturer. At the end of the negotiations, Tanikei Manufacturing transferred the rights to its invention, and the American company commercialized products using it.

This is one example from Japan's small and medium-sized enterprises. The development of unique new technologies and high-value-added products can stimulate industrial growth and activate the national economy.

This graph shows the relationship between economic activities and the creation of intellectual works.

You can see that the increase and decrease in the number of patent and trademark applications is closely linked to economic growth.

Establishing an intellectual property rights system is, in fact, essential for economic growth.

If the national government highly encourages the development of new products and technologies, but does not carry out proper examinations, the rights granted are unstable and lack a clear scope of use. Even if you acquire those rights, you may have difficulty using them. However, if a proper examination has been carried out and a stable right is granted, the company can then actively use it. The profits gained by the use of the right can then finance more research and development projects, and the company's operations are likely to expand. This in turn activates the market and the whole industry. It also promotes trade and investment from overseas countries, leading to the nation's economic growth.

This is why it's so important to carry out proper examinations on technologies for which applications are filed and stabilize the rights system.

We hope you now understand the role of an intellectual property rights system.

Now, we'll introduce the Intellectual Property Rights System in Japan.

As shown here, there are many types of intellectual property rights.

The four rights strongly connected with industrial activities are called "industrial property rights". They are patent rights, utility model rights, trademark rights, and design rights.

Let's take this mobile phone as an example.

High-technology inventions such as its compact, long-life, and lightweight lithium-ion battery are protected under "Patent Rights".

And the device consisting of an antenna structure that won't suffer from reduced reception sensitivity when stored inside the body is protected under "Utility Model Rights".

Here, we can see the manufacturer's trademark. This kind of trademark that differentiates the product from those of other companies is protected under "Trademark Rights".

Moreover, the shape of the body, which is slimmer than current products, the pattern, the color, and other details are protected under "Design Rights".

So far, we've looked at industrial property rights in Japan. This "Intellectual Creation Cycle" clearly indicates the workings of the Industrial Property Rights System.

If we consider the workings of the Industrial Property Rights System in Japan together with it, we can gain an understanding of the Intellectual Creation Cycle's concrete flow.

At the stage of "Creation", companies carry out creative R&D activities related to inventions, devices, designs, and trademarks.

If the created product for which an application is filed satisfies the registration terms of the examination, it obtains industrial property rights. This is the stage of "Protection", at which the rights are now protected.

When a right is granted based on a proper examination under the established Industrial Property Rights System, the applicant acquires stable patent rights which clearly explain the scope of use and the owner of the rights.

Using the patent rights or design rights to commercialize company products, or to enter into a licensee agreement, makes it possible to recoup the money spent on R&D. In addition, by utilizing the trademark rights for a company emblem to add extra value to company products or the corporate image, it's possible to differentiate the product from those of other companies. This is the stage of "Utilization".

The profits gained by using this intellectual creation can be reinvested in further R&D, so this links back to the "Creation" stage.

This cycle generates company vitality, which leads to the development of the national economy and society in general.

Next, we'd like to explain aspects of the Intellectual Property Rights System other than industrial property rights.

First, the Unfair Competition Prevention Law.

The purpose of this Law is to ensure fair competition among entrepreneurs and the full implementation of international agreements.

Promoting fair competition between entrepreneurs is designed to protect private interests in the form of entrepreneurial business interests, and public interest, through the maintenance of fair competition.

Laws such as the Patent Law and the Trademark Law protect intellectual properties by giving certain rights to objects. By contrast, the Unfair Competition Prevention Law functions in a restrictive manner to protect intellectual properties by prohibiting certain acts as "unfair competition".

Next, let's take a look at the Copyright Law.

The Industrial Property Rights System, including the Patent Law, the Trademark Law, and the

Design Law, mainly aims at "industrial development". However, the purpose of the Copyright Law is to contribute to "the development of culture".

The main feature of the Copyright Law is that, unlike in the case of Industrial Property Rights, it does not require the procedures of "application" and "registration". A work automatically has copyright protection the moment it is created.

Let's look at works that are protected by the Copyright Law.

The term "work" means "a production in which thoughts or sentiments are expressed in a creative way" and "which falls within the literary, scientific, artistic, or musical domain".

As the work must fall "within the literary, scientific, artistic, or musical domain", industrial products are basically *not* protected under Copyright Law.

Works that *are* protected under Copyright Law include novels, comics, paintings, cinematographic works, animation, musical works, and computer programs.

This has been a general explanation of the role of the Intellectual Property Rights System. From Chapter 2, we'll introduce each of the industrial property rights.

# End of Chapter 1

#### Chapter 2. The Patent System and Utility Model System

In this chapter we'll introduce the Japanese Patent System.

Article 1 stipulates that the purpose of the Patent Law is to encourage inventions, and thereby to contribute to the development of industry through promoting the protection and utilization of inventions.

The Patent System aims to contribute to industrial development by, on the one hand, protecting inventions by granting the inventor the exclusive right of a patent for a certain period of time, and, on the other, by disclosing the invention, preventing others from conducting research and development of the same invention and encouraging improvements to be developed.

Under the Patent Law, inventions are broadly divided into the two categories of "Products" and "Methods". They have to meet certain conditions.

Utilization of the laws of nature

Technical ideas

Creation

Highly advanced

Even if an application is filed for an invention that is a highly advanced creation of technical ideas utilizing the laws of nature, it may not necessarily obtain a patent right.

The granting of a patent right to a technology that is already publicly known or an invention that is not industrially applicable is not regarded as useful for industrial development.

In addition, there is concern that the granting of a patent right to a similar invention will not maintain the stability of an exclusive right and may lead to frequent dispute.

Therefore, before a patent right can be granted, an examination is required to check whether the application fully satisfies the patent requirements.

This is called a "substantive examination".

Now, let's look at the major patent requirements.

## First-to-file system

There are two international systems: "first-to-file" and "first-to-invent". In many countries, including Japan, the "first-to-file system" is adopted because it ensures more stable rights than "first-to-invent". The application filed first to the Patent Office is granted priority.

## Industrial applicability

Being "industrially applicable" means that the invention, even if not directly connected to industry, is regarded as capable of contributing to the development of industry through its manufacture or sales.

As this table indicates, patent rights for medical practices, such as surgery and treatment, as well as diagnostic methods, differ in each country.

In Japan, new medical devices and medical products are not regarded as "medical practices". They are considered as "inventions of products" which are "industrially applicable", which means they can be patented.

#### Novelty

Inventions must be new. Patent rights are not granted to technologies that people are already familiar with. Inventions that are "publicly known" and "publicly used", as stipulated in Article 29 Clause 1, are considered to lack "novelty".

Regarding an invention that has already been published in a thesis, for example, an exception to the "lack of novelty" restriction can be made if it was published under specific conditions and the designated application procedures are carried out within six months from the publication date.

## Inventive Step

An invention that can easily be conceived by a person with ordinary knowledge in the same technical field is not considered to represent an "inventive step".

For example, inventions that are simply an aggregation of other publicly known inventions, feature just slight structural modifications with no advantageous effect, or that could easily be created by anyone, are regarded as lacking an inventive step and will not be granted patent rights. The "Inventive step" is an important examination requirement.

Now let's consider some test cases.

A yacht and a motorboat are publicly known products. Can a "motor yacht" that combines those two technologies be regarded as an "inventive step"?

In this case, it's regarded as *not* having an "inventive step" because it's just an aggregation of publicly known technologies.

Well then, what about the invention of a motor yacht which has a digital anemometer installed that automatically changes between use of the sail and the motor according to the wind speed?

If the same technical idea cannot be found in existing technologies, then this can be considered to involve an "inventive step".

How about the case in which switching between use of the sail and the motor of a motor yacht is not controlled *automatically* but *manually* by a person observing a digital anemometer?

In this case, the examiners could make two possible decisions regarding its validity as an "inventive step".

Some examiners might determine that it *does* involve an "inventive step" because no existing technology has included the installation of a digital anemometer.

Other examiners might determine that it does *not* involve an "inventive step" because anyone could come up with the idea of switching between use of a motor yacht's sail and motor manually by observing a digital anemometer.

We've included these examples to help you understand the concept of an "inventive step". As you have seen, the presence of an inventive step cannot be determined unconditionally. The point is that the examination should be carried out by comparing the scope of claims of an invention with the existing technologies.

For that purpose, examiners need to possess a wide range of expertise, including the ability to fully comprehend the substance of the invention under examination and the ability to compare it with existing technologies.

It's important to foster such expertise in order to carry out examinations appropriately.

A "formality examination" checks whether or not an application document fulfills the necessary procedural and formal requirements. A "substantive examination" checks the specific technical

content of the application as well as whether it fulfills the patentability requirements, and determines whether there are any reasons for refusal.

If an examiner finds reasons for refusal, a notification of this result is sent to the applicant.

An applicant can subsequently submit a written opinion describing how the invention does in fact differ from existing technologies, referred to as "prior art", issue an amendment providing further description, or amend, for example, the scope of the claims. If the reasons for the initial refusal are deemed to have been eliminated, then the examiner may make the decision to grant a patent.

The duration of a patent right generally expires 20 years after the filing date of the application.

If the examiner determines that the reasons for refusal have not been eliminated through the amendments, another decision of refusal will be made. If dissatisfied with the decision, the applicant has the right to appeal against it.

For a variety of reasons, some applications require the speedy granting of a patent. In order to respond to such needs, the Japan Patent Office will carry out expedited examinations that are faster than usual if the applications satisfy certain requirements.

As of 2012, the period of first action in the case of normal applications for examination is about 20 months from the date of request. Expedited examinations, however, take only two months on average.

A comparison of the invention with "prior art" is essential for patent examinations.

To avoid the "unwanted results" of free text searches, patent classification search is possible using the "International Patent Classification" (IPC), or Japan's unique "FI" (File Index) or "F-term". This makes it possible to systematically search features of technologies that are difficult to express in words, such as shapes and structures.

Text searches using keywords enable searches with fewer failures.

Since the examination of "prior art" requires efficient searches with fewer "unwanted results" and less search failure, it is carried out by combining a patent classification search and a text search.

Regarding the search for Japanese patent documents, use of the FI or F-term searches is more efficient than using an IPC search.

Here we can see the relationship between IPC, FI and F-term.

The Official Gazette of the Japan Patent Office containing information on patents, utility models, designs and trademarks has been issued since the Meiji era which started in 1868. In addition, there is the Industrial Property Digital Library, or IPDL, which offers the public Internet access to information such as the progress of examinations included in the IP Gazettes of the Japan Patent Office.

PAJ (Patent Abstracts of Japan) and FI or F-term searches are possible in English, so overseas examiners can use these for reference regarding patent applications and registrations from Japan.

Let's take the example of "an umbrella with LED lights installed at the end of the ribs to improve safety at night". Now we'll try an FI search.

The FI for this invention is somewhere in the Main Group of "A45B Umbrellas". Using the Patent Map Guidance System, or PMGS, we make an inquiry in the Main Group of target A45B.

Searching for related FI from the viewpoints of "lighting device" and "the end of umbrella ribs", we find A45B3/04@C and A45B25/10.

Using FI search, we now search for the theme of 3B104 with A45B3/04@C and A45B25/10 (A45B3/04@C\*A45B25/10).

A similar official report can be found in the Gazette.

Advanced Industrial Property Network (AIPN)

The Advanced Industrial Property Network, or AIPN, is the system whereby examiners in IP Offices overseas can obtain patent examination information from the JPO.

The purpose of the AIPN is to reduce the workload in IP offices overseas, thereby enabling Japanese applicants to obtain patents in other countries more quickly.

Via the Internet, it's possible to obtain patent applications, their legal status, cited documents, examination information for granted claims, and the patent family of a patent application filed with the JPO.

The JPO registers the global IP addresses of the computers used in each IP office overseas, which makes it possible to use the AIPN without having to input an ID or a password.

As economic globalization advances, many growing companies are applying for patents in other countries.

Here are the ways to apply for a patent overseas.

#### The Paris Convention Route

Within 12 months from the date of filing of the first patent application in the first member country of the Paris Convention, it's possible to apply for a patent in each of the other member countries. Under the Paris Convention, a person who has filed a patent application in one of the member countries will receive priority when filing in other member countries.

## The PCT Route

Under the Patent Cooperation Treaty, or PCT, you can gain the same effect as applying simultaneously to all PCT member countries by submitting a single international patent application to the Patent Office of your own PCT member country.

Today, along with the increase in the number of international patent applications, applications are increasingly being made to more than one country. As it's inefficient, both in terms of the labor and time involved, to carry out an examination for the same patent in each country, efforts are now being made for international work sharing of patent examinations.

One of these is the Patent Prosecution Highway, or PPH.

The PPH tracks work sharing to enable international patent applications to undergo an accelerated examination.

Based on bilateral office agreements, the PPH makes it possible for an application whose claims have been determined to be patentable in the Office of First Filing, or OFF, to undergo an accelerated examination in the Office of Second Filing, or OSF. There is just a simple procedure upon request from the applicant. This considerably reduces the examination waiting period.

In addition, introducing work sharing for "prior art" examinations and their results enables the OSFs to avoid duplicated examinations and reduces the burden on the examiners.

As of March 2013, Japan is carrying out the PPH with 29 IP Offices.

We would now like to explain about the Utility Model System.

The purpose of the Utility Model Law is to contribute to the development of industry in the same way as the Patent Law by promoting the protection and utilization of devices relating to the shape or structure of items or a combination of items.

To facilitate an applicant's prompt acquisition of a patent, there is no system of request for examination regarding applications for utility model registration. There is only a conventional formality check.

Because the right is granted without examination and abuse of that right could hinder industrial development, stricter responsibility and care is required in the exercise of the right.

The Report of Utility Model Technical Opinion evaluates the validity of the application.

Japan Patent Office examiners carry out an assessment of the novelty, inventive step, and so on, of a utility model application and report the results to the applicant.

A holder of a utility model right may not exercise that right unless he or she has given warning regarding the Report of Utility Model Technical Opinion.

## End of Chapter 2

#### Chapter 3. The Trademark System in Japan

In this chapter we'll introduce the Japanese Trademark System.

Article 1 of the Trademark Law stipulates that its purpose is as follows: "through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks, and thereby to contribute to the development of the industry and to protect the interests of consumers".

The term "trademark" in the Law is defined as "any character or characters, figure or figures, sign or signs, or three-dimensional shape or shapes, or any combination thereof, or any combination thereof with colors, that is: used in connection with the goods of a person who produces, certifies or assigns the goods as a business; or used in connection with the services of a person who provides or certifies the services as a business".

In the Trademark Law, the term "services" includes retail and wholesale services; namely, the provision of benefits for customers conducted in the course of retail and wholesale business.

Trademarks include:

"Character trademarks" that consist solely of characters;

"Figure trademarks" that consist of figures making a design of something realistic, or figures such as geometrical patterns;

"Symbol trademarks" that combine the designs of certain symbols and characters; "Three-dimensional trademarks" that consist of three-dimensional shapes;

and "Composite trademarks" that are a combination of characters of different meanings, or trademarks that combine characters, figures, signs, and three-dimensional shapes.

There are also plans to protect things such as movement, holograms, colors, position and sound as new types of trademarks.

The distinctive feature of a trademark right is that it combines a mark with the products or services that use the mark. Along with the trademark for which registration is being sought, an application for trademark registration must designate the goods or services in connection with which the trademark is to be used.

The class of the goods and services must be stated in the application for trademark registration. There are 45 classes in alignment with the International Classification based on the Nice Agreement. This classification facilitates the search and management of prior trademarks to be examined. And because the classification consists of combinations of marks of the trademark right, and the products and services that use those marks, the same mark can be registered for the same product as long as the service is different.

Here, you can see the various ways that trademarks are used. Carrying out these kinds of actions using a mark is called "use of a registered trademark".

In order to obtain a trademark right, the applicant must fill out the prescribed forms and submit them to the Japan Patent Office. A "first-to-file" system has been adopted in Japan, so if applications are submitted for an identical or similar trademark, priority will be granted to the one whose application was filed with the Patent Office first.

When an application is made for a trademark registration, the unexamined application is published in the Official Gazette, so that unauthorized third party use of a trademark for which an application for trademark registration has been made can be restrained even before the application is registered.

After a "formality examination", examiners carry out a "substantive examination" to determine whether or not there are any reasons for refusal.

Now, let's look at some "unregistrable trademarks".

First, trademarks likely to cause confusion in connection with the goods or services pertaining to another person's business because they are indistinguishable will not be registered.

Common names of goods or services

For example, a common name or term such as "PC" cannot be registered as a trademark for a personal computer.

#### Trademarks customarily used

Trademarks that could originally be distinguished from someone else's goods or services, but that are now customarily used in the same trade, cannot be accepted.

Indication of quality, place of origin, etc.

"Deluxe", for example, is merely an indication of quality, so it cannot be approved as the name of a car model.

In principle, the place of origin cannot be accepted as a trademark, either. However, in order to support the enhancement of industrial competition and regional revitalization, any association such as a business cooperative is entitled to obtain a "regional collective trademark registration", provided that the trademark combines the name of the region and the name of the goods or services, and that the trademark is well known in the region.

Trademarks including a common surname or name

Trademarks consisting solely of a mark indicating a common surname or the name of a legal entity, or a very simple and common mark, cannot be accepted.

Trademarks by which consumers are unable to recognize the goods or services as those pertaining to the business of a particular person will not be approved, either.

If it can be proved that a trademark that has basically been determined as difficult to distinguish has become well-known as the result of its use, it may be registered as being distinguishable.

Any trademark that is identical with, or similar to, the Japanese national flag, Imperial chrysanthemum crest, a decoration, a medal, a foreign national flag, a mark indicating an international organization, a famous mark indicating the State or a local public entity, or a trademark that works against the public interest, such as an indication which could be confused with the trademark of a public organization, will not be registered.

Any trademark that is confusingly similar to another person's registered trademark, or to trademarks that are famous or widely known, will not be registered, either.

In order to exclude applications that aim to obtain unfair profit, and to avoid unnecessary problems after the granting of rights, examinations in Japan are carried out regarding similarity with widely known overseas trademarks.

Although meat grilled on a skewer called "satay" is widely known in Southeast Asia, for example, it is not so well-known in Japan. If an application for the name "Satay" is made in Japan in the same class concerning food or food services, it will not be registered because it is a familiar term in other countries.

The grounds for refusal to register a trademark following the substantive examination can be roughly divided into two types: absolute and relative. "Absolute grounds" include the lack of distinguishability mentioned earlier, and being identical or similar to public trademarks. "Relative grounds" include possible confusion with someone else's prior trademark.

In most countries, absolute grounds for registration refusal are determined during the examination ex-officio. In some countries, however, an examination for relative grounds for refusal is not carried out. Registration of a later application of a similar trademark may be accepted as long as no opposition to the registration is filed by the holder of a prior registered trademark before the trademark right is granted.

It takes longer to acquire the right when an examination for relative grounds for refusal is included than when there is only an examination for absolute grounds.

However, the right granted in such cases is superior in terms of stability because there is less confusion with other rights holders regarding its source after registration.

Taking the stability of the right into account, examiners in Japan carry out examinations for both absolute and relative grounds for refusal ex officio.

Here are two examples of cases that will not be registered because they are similar to prior registered trademarks:

"HCNDA", because it looks similar to the prior application "HONDA";

and "Bahhalo", because it sounds similar to the prior application "Buffalo".

Any trademark that is likely to mislead those who see or hear it will not be registered.

For example, "tora" is the Japanese word for "tiger". If an application is made for "TIGER", but there is already a prior "TORA" trademark, "TIGER" may be determined to be a similar trademark, even though the two words differ in appearance and pronunciation. Since they both have the same meaning, it will therefore not be eligible for registration.

When an application is refused, a notification is made of the grounds for refusal. The applicant may then submit a written opinion or amendment that includes any amendment or amendments made to the designated goods or designated services or trademark for which the registration is sought.

A decision of refusal is made when there is no response from the applicant for a notification for grounds of refusal, or when the written opinion or amendment may not eliminate the grounds for refusal.

An applicant who is dissatisfied with the examiner's decision may file a request for a trial against the examiner's decision of refusal.

Where no reasons for refusal are found in connection with an application for trademark registration, the examiner will render a decision to the effect that the trademark can be registered. The application is registered in the Trademark Registry by carrying out the subsequent procedures, and a trademark right will go into effect upon registration of the establishment of that right.

A trademark right expires ten years after the date of its registration of establishment. However, because the aim of trademark protection is to ensure the maintenance of business confidence among those who use trademarks, it may be renewed any number of times.

Trademarks play a major role in global business development today, For that reason, an international rule-based system is required for their use.

Applications for trademark registration must include the class of goods or services that conforms to the International Classification of Goods and Services based on the Nice Agreement.

Concluded in the French city of Nice in 1957, the Nice Agreement is an international classification of goods and services that went into effect in 1961 for the purpose of registering trademarks and service marks.

While 84 States are currently party to the Nice Agreement, more than 150 States adopt an international classification based on it.

Under this international classification, Classes 1 to 34 list "goods", while Classes 35 to 45 list "services".

Although this classification standardizes the basic concept of classification, the indications of goods and services acceptable for examinations differ from country to country.

Cooperative efforts are now being made for this indication to be standardized.

Let's now look at the procedures for acquiring a trademark directly in other countries.

One way to do this is to submit an application in the language of each country through the intermediary of a local agent. Another method is to make an application based on the Madrid Protocol.

Let's take a look at the Madrid Protocol.

While the Madrid Protocol requires a basic application or basic registration in one's own country, it's possible to submit a single application to multiple countries.

Instead of having to file separately in different languages, the procedures can be carried out in one of the three prescribed languages: English, French or Spanish.

In the case of Japan, the procedures are carried out in English.

Negotiation with an agent in each country is required when submitting individual applications to different countries. But under the Madrid Protocol, the application documents submitted to the Office of Origin are sent via the International Bureau of the World Intellectual Property Organization (WIPO) to the Office of the Contracting Party in the country for which registration is requested. They are then treated in the same way as if the application had been made individually.

Because the selection of representatives in each country is not required, merits include simplifying application document preparation and procedures, as well as the possibility of cost reduction.

In addition, because the time limit for making notifications regarding any provisional refusal is specified at 12 months, or 18 months from the date notified by the International Bureau, acquisition of the right is facilitated at an early stage.

The simplification of rights management is also an advantage, owing to the centralized management of the International Register recorded and administered by the International Bureau.

The amendment of domestic trademark laws is required for accession to the Madrid Protocol.

For example, international registration will no longer be protected when the basic application or registration ceases to have effect within a five-year period from the date of international registration.

This is known as "central attack". For this reason, Japan has prescribed "Special Provisions under the Protocol relating to the Madrid Agreement" as remedial provisions to deal with accession.

The "Office of Origin" carries out formality examinations for international applications as made on the application form MM2 to present to the International Bureau.

The formality examination checks whether the entries in the basic application and the registration trademark submitted to the Patent Office of Origin are identical, whether the applicant is appropriate, etc. The international application is then sent to the International Bureau.

If an international application is found to have deficiencies, the International Bureau reports this to the applicant and the Office of Origin.

The Designated Office of the Contracting Party carries out a substantive examination on the notification from the International Bureau in alignment with domestic trademark laws.

If registration is not approved, a provisional refusal must be notified to the International Bureau within 12 months, or 18 months from the date of notification by the International Bureau. In Japan the period is within 18 months.

If there are grounds for refusal as the result of an examination, a notification of provisional refusal is made to the applicant via the International Bureau.

Where no reason for refusing registration is found, the office notifies the International Bureau that it has issued a grant of protection. It then sends the decision of registration to the holder of the international registration, and issues a trademark registration certificate on completion of the designated procedures.

## End of Chapter 3

## Chapter 4. The Design System in Japan

In this chapter we'll introduce the Japanese Design System.

The purpose of the Design Law is stipulated in Article 1: "Through promoting the protection and the utilization of designs, to encourage creation of designs, and thereby to contribute to the development of industry".

The Design Law protects those design aspects of an article, including the shapes, patterns or colors, that create an aesthetic impression via the sense of sight, so certain elements must be satisfied.

Regarded as "an article"

The subject matter of protection of the Design Right under the Design Law are "articles", which are defined as "corporeal things and movable properties".

Consisting solely of a shape that is inseparable from the article

Creates a visually aesthetic impression

The article must be visually recognizable. The term "aesthetic impression" means that it does not require a high level of aesthetic appeal, such as that found in a work of art.

However, not all applications submitted to the Patent Office are necessarily registered as a design right, even if they are suitable subject matters of protection under the Design Law. A set of prescribed requirements must be fulfilled in order to obtain a design registration.

#### Industrially applicable

First, it must be possible for the design to be utilized industrially and mass-produced.

#### Novelty

The design must not be identical with or similar to part of a design described in the statement of another application filed prior to the filing of the application for design registration, nor publicly known in Japan or abroad.

Similarly, prior to filing, there should have been no publications containing the design or digital

information about the design on the Internet.

If the created design has been publicly announced before applying for design registration, through publication in a catalog, for example, the design is basically regarded as lacking "novelty".

"Similarity of design" is determined by comparing the article's shape, utilization, function, and so on, with those of others.

### Creativity

Granting a right to a design that can be easily created may not contribute to the development of industry, even if it has novelty. For this reason, an ornamental motif on a substantial structure such as Tokyo Skytree, for example, does not satisfy the requirements since it's considered that anyone could easily think of creating such a design.

#### Does not contravene public order or morality

In addition, designs that contravene public order or morality, or that include the Japanese national flag or Imperial chrysanthemum crest, will not obtain design registration.

## Prior application

Where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration first will be entitled to obtain registration of a design.

## One application per design

It is necessary to file an application for each design; you cannot apply for the registration of more than one design in one application. Moreover, a design registration is made for each article, so separate applications are required for different articles.

In the same way as for patent and trademark rights, a design right can only be granted after an application document has been submitted to the Patent Office and a substantive examination has been carried out by an examiner.

With a view to accelerating the acquisition of design rights, some States implement the policy of not carrying out a substantive examination. A policy of examination has, however, been adopted to stabilize design rights in Japan, where frequent conflicts after registration hinder the development of industry.

The duration of a design right is 20 years from the date of its establishment registration.

To meet social needs and help promote the reinforcement and good use of design protection rights in society, the Japan Patent Office provides various types of registration applications.

Partial design system

As these examples show, part of an article can be protected as a "partial design". When a design refers to a particular part of an article which could not be properly assessed if the article were registered as a "whole design", it's more effective to file for protection as a "partial design".

If part of the article can be physically separated and become an individual product in the market, it's protected as a "part" or an "accessory".

Recently, there have been many skillful imitations of only parts of articles rather than the articles in their entirety. The claim is made that they are not imitations since the whole shape of the articles are dissimilar. It's possible to acquire a "partial design right" to counter this kind of infringement.

For example, Chorittai Mask, three-dimensional nonwoven fabric masks, shown here, are health-related products produced under thorough quality control. Efforts are being made to counter low-quality imitations that could cause health damage to consumers by registering the masks for design registration, including partial design rights.

Detailed parts of the masks, such as the sections over the nose and around the ears, are protected by partial design rights.

Other types of special design registration

Besides partial design registration, there are several types of special design registration.

Under the Design Law, for example, a graphic image on a screen that is provided for use in the operation of an article to enable it to perform its functions is subject to protection as "a constituent part of the design".

When a design is created, more than one design with many variations may be produced from one concept. The design rights for these similar designs can be granted as "related designs", but only if the application is filed by the same person.

There are also cases of "secret designs" where the applicant may request that details of the design,

such as drawings, be kept secret for a certain period if their corporate strategy so requires.

The Hague Agreement Concerning the International Registration of Industrial Designs (The Hague Agreement)

The Hague Agreement Concerning the International Deposit of Industrial Designs provides a mechanism for applying for and registering an industrial design. This has benefits such as simplifying the application procedure and reducing costs, since the procedure for designated contracting member countries can be carried out by means of a single application to WIPO, rather than having to apply to each country individually.

Under the Hague Agreement, more than one design can be included in a single application. This is a major difference from Japan's Design Law, in which each design requires a separate application.

Along with the recent globalization of corporate activities, however, there is an increasing need in society for accession to the international application system.

Discussions are now taking place in Japan regarding whether or not to join the Hague Agreement and the Locarno Agreement, which establishes an international classification for industrial designs.

## End of Chapter 4