JPO Study-Cum Research Fellowship Program
July 2018-November 2018
Tokyo, Japan

Research theme:

THE IMPLEMENTATION OF A SUBSTANTIVE EXAMINATION IN OAPI's DESIGN REGISTRATION SYSTEM – Lessons from the Japanese Experience

Justin Fabrice MANGA ZAMBO

Trademark Examiner

African Intellectual Property Organization

Under the supervision of
Dr. YORIMASA SUWA,
Senior Researcher
Asia-Pacific Industrial Property Center,
Japan Institution of Promoting Invention and Innovation (APIC-JIPII)

Advisors

Ms. MINAKO MIZUNO
Partner, Patent Attorney
SEIWA PATENT & LAW

Ms. SHOKO TSUTSUI
Partner, Patent Attorney (Qualified IP Litigator)
TSUTSUI & ASSOCIATES

Abstract

In Africa, the effectiveness of Intellectual property rights as a lever for economic development is no longer in dispute. Japan is undoubtedly the country that has been the most successful at exploiting the impressive potential of intellectual property rights to aid economic development.

In the context of strengthening the legal security of the system of protection of industrial property rights in the territory of its member States, the African Intellectual Property Organization is currently considering on the introduction of opposition proceedings in the area of design. The introduction of such a procedure will make it possible to take into account the respect of the substantive criteria, and mainly the criterion of novelty. The examination of these criteria will be carried out before the formal examination, and only in case of opposition procedure (within three months after the publication of the application). The opposition procedure will therefore introduce some tools related to the Substantive Examination Systems.

The Japan Patent Office has been practicing the Design Substantive Examination for many decades, and is a world benchmark for the quality and reliability of his Examination results. For this reason, it seems to us necessary to carry out a study, in order to identify some tools that could prove useful for the development of the OAPI Design Protection System.

Keywords: Design Right, Substantive Examination, Iintellectual Property Protection

Table of Contents

List of Figures

List of Tables

1. INTRODUCTION

1.1. Research rationale: the problem consciousness for the research

The OAPI's system as it actually works has its legal basis in the Bangui Agreement of 2nd March of 1977. This agreement which has been revised several times specifies the legal framework for the protection of designs in its 4th annexure. This Agreement provides that a design, for which an application for registration is filed, has to fulfill some formal and substantive conditions. Actually, OAPI only examines the formal conditions[1]. Thus the substantive conditions, although required by the Bangui Agreement, are not actually taken into account in the examination procedure.

The most recent revision of the Bangui Agreement in 2015 (not yet into force) fortunately introduce a new opposition procedure for designs. This procedure will allow any interested person to challenge the registration of a design, on the basis of non-compliance with the substantive conditions provided for, in Articles 1, 2 and 3 of said annexure, within a period of three months following the publication of the concerned design. The implementation of the said opposition procedure will necessarily require the adoption of a certain number of tools and techniques, which are essential for the examination of the substantive requirements for the protection of designs. Many resources will be required to guarantee the stability of the system during its implementation.

1.2. Research objectives

This research is conducted basically as a comparative study of the Japan system and the OAPI system. The results of this research will help to achieve a better understanding of the substantive examination system of Japan and its main advantages, hence, to propose to OAPI a set of ideas on how to implement the examination of substantive requirements in OAPI.

Our study is organized with the following points.

- Study the industrial design system background in Japan and OAPI;
- Compare the design registration system and examination practices in Japan and OAPI to understand the difference and advantage of each of them.
- Compare the performances of both systems and analyze the gathered information;
- Make some recommendations to OAPI in order to improve the performance of industrial design system.

[1] Agreement Revising the Bangui Agreement of March 2, 1977, on the Creation of an African Intellectual Property Organization (Bangui (Central African Republic), February 24, 1999) (Bangui Agreement) Annex IV. Article 11 (1)
https://www.wipo.int/edocs/lexdocs/treaties/en/oa002/trt_oa002_2.pdf

2. BASIC INFORMATION AND PREVIOUS STUDIES

2.1. Different frameworks of design legal systems

The protection of designs around the world is the subject of different conceptions. The different worldwide design protection's system can be categorized in two types. The first is a patent-oriented type, and the second is copyright oriented. Indeed, although of an ornamental nature, the design is generally intended to apply to objects whose technical character is more or less preponderant. According to the patent-oriented systems, there is a tendency to consider them from a technical point of view. In this type of system, the design is essentially appreciated from the point of view of its technical structure and function. The opposing trend considers the aesthetic aspects much more and perceives the design as an element of ornamentation, even a work of art, the aim of which is not primarily functional but decorative.

In England, it is since the 1880s that the distinction between pure art and applied art has been made. According to the defenders of this distinction, works of pure art must be protected by copyright, and those of applied arts, which have an obvious functional character, by design rights. In practice, this distinction was not easy to apply, "because industrial designs are often based on drawings, which are themselves copyrights works; and making a competing product could mean indirectly copying the drawings. Copy rights has no "functionality exclusion, it does not need one; nor does the subject-matter have to be novel." [Fellner, 1995].

This idea was consolidated by the Copyright Act 1911, making a distinguish between works of art and industrial design, the latter being subject to protection by the Patents and Designs Act 1911.

During the first meeting of the "Joint Study Group" which gathered Twenty-one countries in April 1959 at the UNESCO House, Paris, a proposition was adopted, that it should be left to the discretion of each country whether protection should be allocated under one or both laws, which was eventually adopted at the conclusion. [JPO and APIC, 2003]

We will explore in detail the situation in the JPO's system and the OAPI's system.

2.1.1. The legal framework of Japan design system

The Japanese design protection system is the result of a long history dating back to the Meiji era, which represents the end of the politic of voluntary isolation called "sakoku" and the beginning of a politic of modernization of Japan, and thus, a shift from the feudal system to a Western-style industrial system. The government of that time, to promote the creation of quality works of art, adopted the Design Ordinance of 1889, in the purpose to ensure the protection of the designs, granting exclusive exploitation to the creator of the design and therefore, allowing the possibility to recover the investments associated with the creation of his work. The effect sought by this legislation was also the reduction of imitations, too often of poor quality, and in the short term, to favor the placing on the market of quality designs [JPO and APIC, 2005].

2.1.1.1. Revision of Design Law in 1899

From the late 19th century to the early 20th century, "The revision of the Design Law in 1899 was made together with that of the Patent Law, etc. in order to allow Japan to become member to the Paris Convention. Included in that revision was a provision for the protection of similar designs with the term of their rights set at 10 years". .

2.1.1.2. Revision of Design Law in 1909

Because the 1899 revision was relatively provisional in nature, and due to the expansion of industrial reproduction techniques in the Western world, it became necessary to broaden the spectrum of protection of the Design Act. Hence the need of a new modification of the design Act. The new Design Act involved the following:

a. Incorporated a provision calling for the right of a similar design to be integrated with the right of its principal design;
b. Adopted a secret design system;
c. Limited the effects of design rights to items "commercially working,";
d. Adopted a provision allowing a retrial, and no more, with respect to complaints against an examiner's decision at a retrial with an appeal trial granted;
e. Admitted the continuation of the use of registered designs based on their earlier use.

2.1.1.3. Revision of Design Law in 1921

The 1921 revision of the Design Act took place in the context of a period marked by the tendency to move away from essentially traditional styles towards design creation that responds more rationally to functional and user-friendly requirements.

2.1.1.4. Revision of Design Law in 1959

With the end of the war, Japan had to embark on an intensive production of consumer products, the quality and originality of which would soon give rise to numerous counterfeits both domestically and internationally. Since export was an inevitable option for the development of the country, a number of measures had to be taken at the legal level to strengthen the protection of industrial property rights. In this context, the revision of the Design Act took place in 1959, and was characterized by many innovations, for example:

a. Provisions were modified and made clear concerning requirements for the registration of a design (a provision was added to define the scope of novelty extending to an article known in other parts of the world and a provision added concerning the degree of ease to create a design);
b. A provision was added concerning exceptions to the loss of novelty of a design;

c. It was made clear that designs merely similar to a similar design were not registrable as a similar design;

d. It was stipulated that a design for combined articles was registrable as a single design;

e. The term of a design right was extended from 10 years to 15 years;

f. It was expressly stipulated that a design right took effect upon registration of its establishment

2.1.1.5. Revision of Design Law in 1998

The Design Act underwent a final modification in 1998. This modification would prove indispensable in a context marked by a fierce international competition. This revision is characterized by:

a. The protection for partial designs;

b. The expansion of creative abilities;

c. The exception of protection for applications which are similar or identical to a part of a prior application:

d. The exception of protection for designs based on only functional qualities;

e. The dissolution of the design system for sets of articles

f. The handling of applications for confirming decisions of rejection against subsequent or prior applications, and the end to the system for similar designs as well as the construction of a system for related designs.

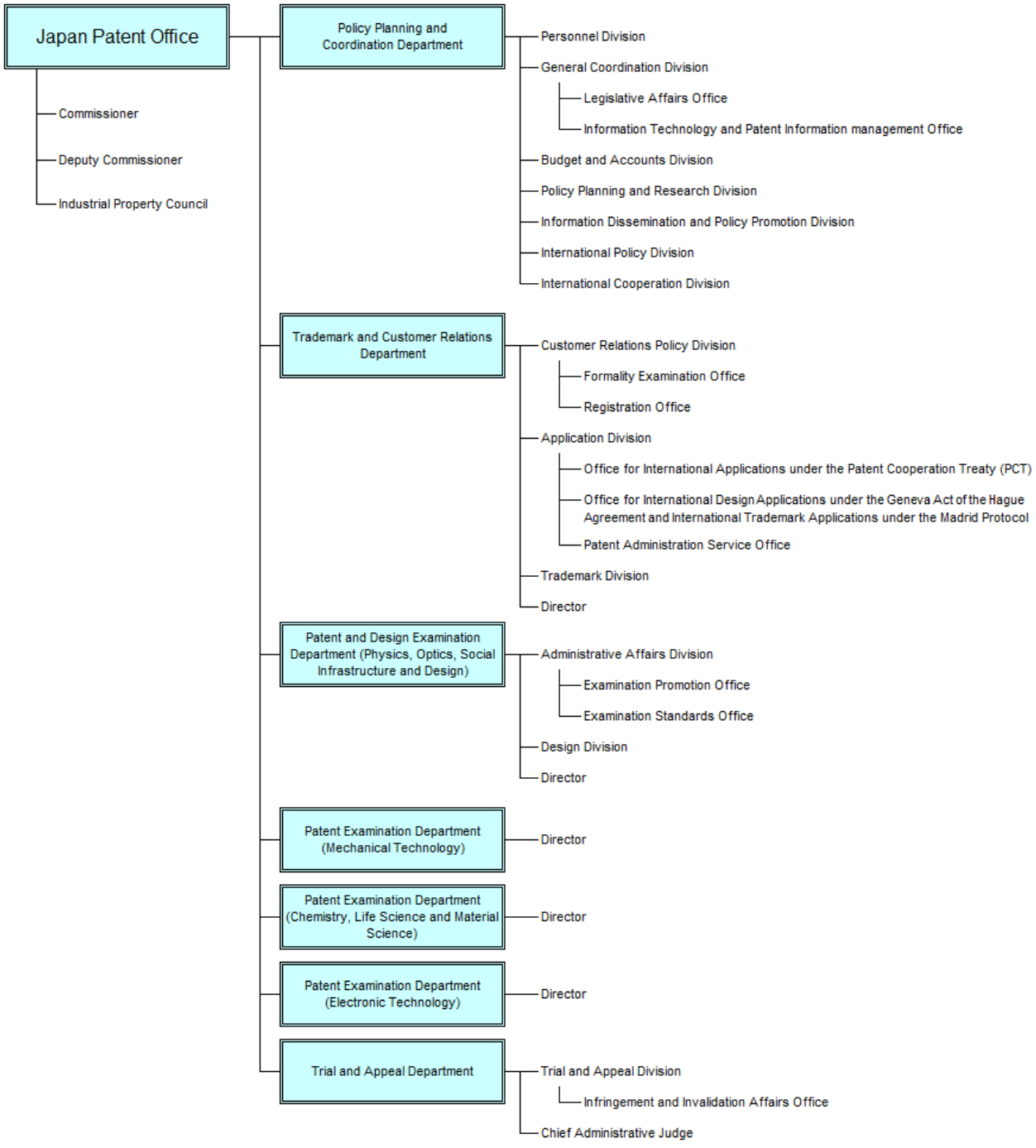


Figure 1: **Organizational chart of Japan Patent Office**

2.1.2. The legal framework of OAPI design system

Presenting the history of the OAPI requires to place oneself consecutively in the period that precedes the independencies in Africa, and then, in the post-colonial period.

2.1.2.1. Before the independence

Before 1962, the French colonial law that applied in most of the African countries occupied by French. Thus, the French law of 1844 was applied for the patents, the law of 1857 for the trademarks and the law of 14th, July 1909 for the designs.

Institutionally, the National Institute of Industrial Property (INPI) was the office of these colonial territories. As a result, a filing in France was also producing its effects on the territory of its former colonies and vice versa.

2.1.2.2. The Libreville agreement.

On September 13, 1962, the Libreville agreement was signed. It was the first treaty addressing the issue of intellectual property in Africa as a common system integrated. At the beginning, the office was known as OAMPI (African and Malagasy Organization of Intellectual Property), because Madagascar was among the signatory states of the Libreville agreement of 1962. But in 1976, the Malagasy State decided to withdraw from OAMPI. The reasons for this withdrawal are related to changes in ideology in Madagascar's national politics, which affected his perception of intellectual property law, especially as it related to patent law. However, the patent system as it emerged from the Libreville Agreement was strongly inspired by the French model and therefore anchored in a liberal economy. It no longer corresponded to Malagasy socialist expectations. Madagascar now aspired to a system offering simple recognition to the inventor and reserving the exploitation of the patent to the State.

The designs were among the subjects covered by the Libreville Agreement, in Annex III.

2.1.2.3. The Bangui agreement on march 2, 1977.

With the signing of the Bangui agreement on March 2, 1977, OAPI was created.

Twelve African states were involved from the start. They made the choice for an integrated common system for the protection of intellectual property. Actually, there are 17 Member States, namely: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Ivory Coast, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal, Togo and finally the Comoros Union recently.

The designs were among the subjects covered by the Libreville Agreement, in Annex IV.

2.1.2.4. The Bangui agreement on February 24th, 1999.

With a view to simplify procedures for the acquisition of industrial property rights, and in order to comply with the provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights, OAPI proceeded on 24 February 1999 to a revision of its fundamental law. This revised version of the Bangui Agreement is currently in force at OAPI.

2.1.2.5. OAPI design system on an international view.

On June 16, 2008, the African Intellectual Property Organization (OAPI) adhered to the Geneva Act of the Hague's Agreement Concerning the International Registration of Industrial Designs. The Geneva Act is one of the three treaties that govern Hague's System for the International Registration of Industrial Designs and constitute for companies of all participating countries a simple, affordable and efficient to obtain and maintain the registration of their industrial designs.

2.1.2.6. The future development of OAPI legal framework

It should be noted that a diplomatic conference for the signing of a new act revising the Bangui Agreement was held in Bamako on 14 December 2015. During the Conference, fifteen plenipotentiaries of the following OAPI member States, being duly authorized for this purpose, signed the new act revising the Bangui Agreement: Burkina Faso, Central African Republic, Congo, Ivory Coast, Gabon, Guinea, Guinea Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Senegal, Chad, Togo, Union of Comoros. The said Act remains open for signature by the other two member States of the Organization. And should enter into force in few months.

2.1.2.7. Presentation of the African Intellectual Property Office.

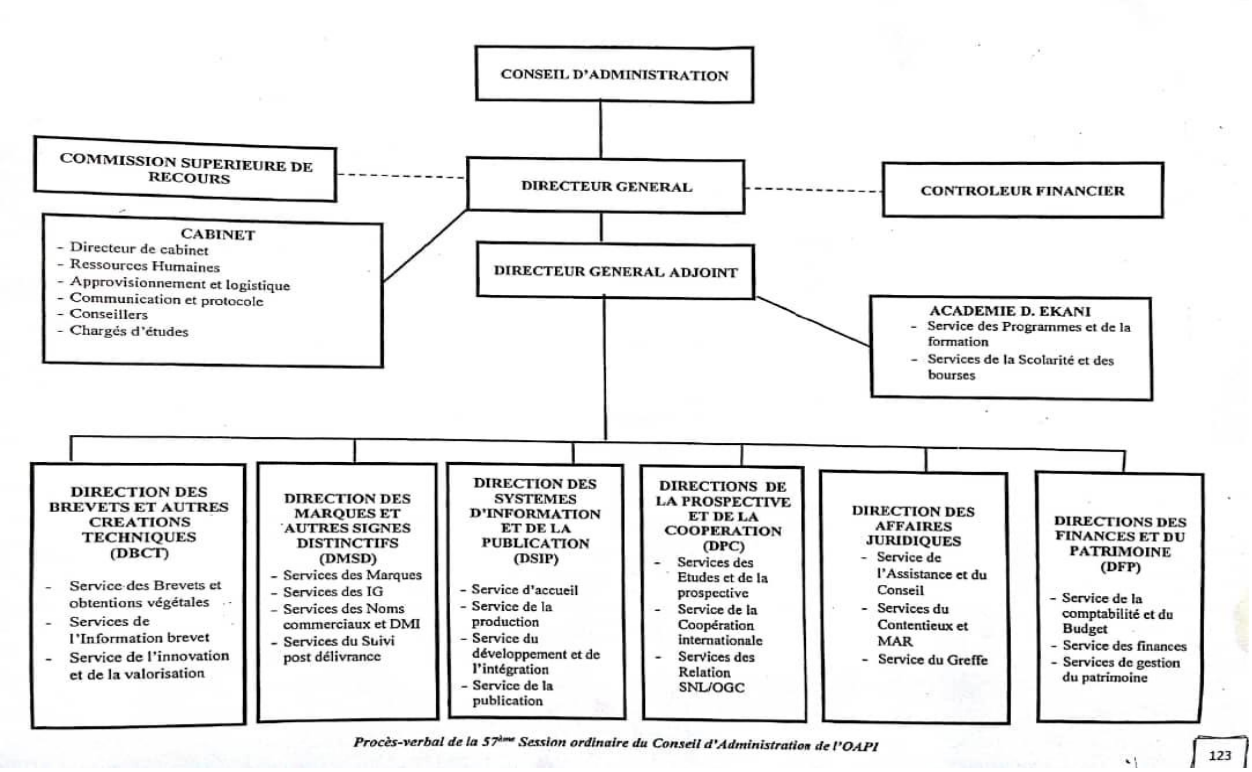


Figure 2: **Organizational chart of OAPI**

2.2. The registration procedures in OAPI and JPO.

2.2.1. Definition of a design

According to the Bangui Agreement, design can be defined as "*any arrangement of lines or colors*", and "*any three-dimensional shape, whether or not associated with lines or colors, (...), provided that the said arrangement or shape gives a special appearance to an industrial or craft product and may serve as a pattern for the manufacture of such a product.*"[2].

The Japanese design law gives a similar definition, protecting shapes, patterns, colors or any combination thereof in whole or a part of an article, which produce an aesthetic impression through the sense of sight[3].

In order to be registered, the design application for registration must comply with the formal and substantial requirements. These requirements shall be complied by the applicant before the filing of the application.

Once the application is filed, the examination procedures starts. They are divided in two steps. The first step is the formal examination. In the OAPI system it is the only examination step before the registration. In Japan there is a substantive examination step after the formal examination. For the purpose of our comparative research, we will examine both.

2.2.2. Filling of an application

The acquisition of a design is subject to compliance with a number of formalities codified both by the OAPI's and JPO's Design laws. The Bangui Agreement provides for this purpose that:

> "*Any person wishing to have an industrial design registered shall file with the Organization or with the Ministry responsible for industrial property, or send it by registered mail with a request for acknowledgement of receipt*
>
> *(a) his **application**, addressed to the Director General of the Organization, in the number of copies prescribed by regulation;*
>
> *(b) a document proving **payment of the prescribed fees** to the Organization;*
>
> *(c) an unstamped private **power of attorney** if the applicant is represented by an agent;*
>
> *(d) a mention of the **type of product** for which the design is to be used;*

[2] Bangui Agreement, Annex IV, Article 1(1)

[3] JPO Design Act http://www.japaneselawtranslation.go.jp/law/detail/?id=44&vm=04&re=02 Law N0 125 of April 13, 1959, as amended, Article 2

(e) on pain of invalidity of the application, ***a sealed package containing two identical copies of a graphic or photographic representation of the design****, in dimensions specified by regulation"*[4].

These requirements are similar to those of the Japanese Design Act which states that:

"A person requesting a design registration shall submit to the Commissioner of the Patent Office an ***application*** *stating the following matters and drawing depicting the design for which registration is requested:*

(i) the ***name, and domicile or residence of the applicant*** *for the design registration;*

(ii) the ***name and domicile or residence of the creator*** *of the design; and*

(iii) the ***article to which the design is applied****"*[5].

There are two differences between the Bangui Agreement and the Design Act:

- The Power of Attorney is not Mandatory in the Japanese Design Act;
- In Japan the fees are paid after completion on the examination.

Both of the two legislations requires the following documents:

- Evidence necessary for claiming Exception to loss of Novelty
- Certified copy of the Original Application for claiming Conventional priority (may be filled after the application);

Actually the e-filling which is used in at the JPO, is not yet possible in OAPI, but the system will be introduced in a near future.

2.2.3. Opposition procedure in OAPI

Opposition is a procedure open to anyone who disputes the registration of an industrial design. This procedure is not provided for either by Japanese law or by that of OAPI in its present state, but the draft revision of the Bangui Agreement in the version of 14 December 2015 provides for the introduction of that procedure. Since this revision is not yet in force, we shall limit ourselves to a simple description of its main lines with the following map.

Opposition is an administrative procedure which consists in verifying on the request of a party (in this case, the one who introduced the action in opposition), that the application for registration of a design fulfills the required substantive conditions, as provided by the articles 1, 2, and 4 of the future OAPI's Design Law (Bangui Agreement revised on December 2015).

[4] Bangui Agreement, Article 8(1).
[5] Design Act, Law No 125 of April 13, 1959, Article 6 (1)

This procedure is administered in the Legal Affairs Department of OAPI, by the Opposition Board. The Opposition Board is an ad hoc committee whose members are usually former examiners who have acquired some experience in the appreciation of the subtleties inherent in the OAPI procedures and a thorough knowledge of the legal nature of the designs.

Opposition can be considered as a part of the registration procedure because the examination of the formal requirements will not be possible until the opposition period is exhausted. That period is 3 months following the publication of the application for the registration of the design.

Opposition procedure is also the only procedural framework for the substantive examination of design. it is therefore important that the examiners involved in such a procedure have expertise in the appreciation of novelty, special appearance, industrial application, and design morality issues submitted to them for re-examination.

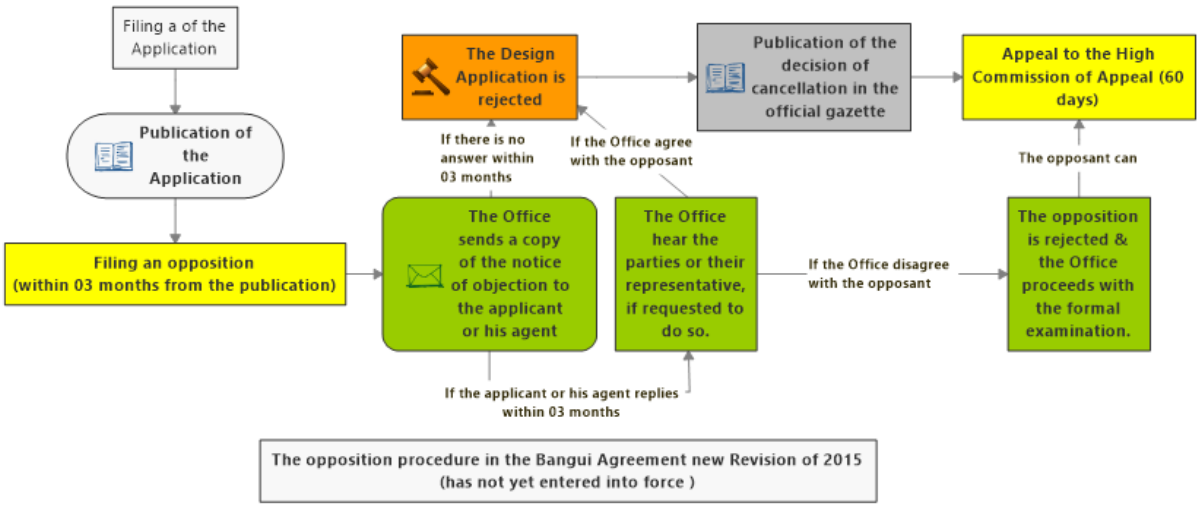


Figure 3: **The opposition procedure according to the future legislation of OAPI**

2.2.4. The formal examination

During the formal examination, only the formal requirements are checked.

In OAPI system, "*for every application for registration of an industrial design, the Organization shall examine whether the* ***conditions of form*** *referred to in Articles 8 and 9 of this Annex have been met, and whether the prescribed fees have been paid*"[6]. There is no substantive examination before the registration. This system is very simple, and the procedure duration is also short. After the completion of this formal examination, if some formal requirements are not complied, a notification of reasons for refusal is sent to the applicant, who can reply with a written argument and an amendment. If there isn't reply after three months,

[6] Bangui Agreement, Annex IV, Article 11(1)

the application will be rejected[7]. On the other hand, if all formal requirements are met, the design is registered and published in the official gazette.

The JPO has a similar formal examination procedure.

2.2.4.1. Representation of a design

In OAPI, an application "*may include **from one to 100 designs, which shall be numbered from first to last**, provided that **they belong to the same class of the International Classification (Locarno Classification) or to the same set or range of articles.** Designs additional to the hundredth shall not be considered validly filed*[8]". In practice, there are two types of applications. A "simple" filing application shall contain **only one article**, but there is a possibility to fill in the second type of application, more than one article, up to one hundred.

In Japan, an application for design registration "*shall be filed **for each design** in accordance with a classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry*"[9].

In the Japanese system's, there are many requirements concerning the representation of the views, because "*the scope of the right to the registered design is defined based on both the description in the request (mainly the name of the article) and the design shown in the drawings attached to the application*"[10]

a. Drawings and photographs

"*The drawings can be said to constitute the substantive scope of the design to be registered. The design for which registration is being sought should be shown in the drawings*" [Asamura and Okano, 2001].

The article shall be represented using the **six view principle** including as a minimum, a front view, a rear view, a plan view, a bottom view, a left side view and a right side view, in the same reduced scale. Each view shall be presented in a maximum vertical 113mm * horizontal 150 mm.

If necessary, "*a development view, a sectional view, an end face view of a fragmented portion, an enlarged view, a perspective view, or any other drawing necessary to give full expression to the design must be added*"[Asamura and Okano, 2001].

- *"In the case of an article including a lid and a main body that can be separated, or a cup and a saucer which constitute a design of a set of articles, six drawings of each component part of the article must be presented"*, "*in addition to the drawings showing the article with its component parts assembled*" [Asamura and Okano, 2001].

[7] Bangui Agreement, Annex IV, Article 11(3)
[8] Bangui Agreement, Article 8(2)
[9] Design Act, law No 125 of April 13, 959, Article 7
[10] Design Act, law No 125 of April 13, 1959, Article 24

- *"In the case of a design of an article that moves or opens and which cannot be fully shown unless drawings showing the change in the article before and after the moving or opening are presented, such drawings shall be prepared to enable one to understand the manner of change that takes place when the article is moved or opened"* [Asamura and Okano, 2001].
- "*When an article is partly or entirely transparent, the design of such an article should be drawn as it is seen, together with an explanation that the article is partly or entirely transparent. However, the thickness of such a transparent article shall not be indicated by placing any line or lines"* [Asamura and Okano, 2001].
- "*A sectional view must be prepared by selecting the portion where a cavity (ies), protrusion (s), aperture (s) or any other suitable portion to be sectioned exists"*
- *"In order to clearly show what part of the article is shown in the sectional view, the portion that has been sectioned should be indicated by a dash and dot line, the direction in which the sectional view has been taken should be indicated by arrow lines, and the plane along which the section has been made should be indicated by hatching"* [Asamura and Okano, 2001].

In case photographs are used in place of drawings:

"*Correct six aspect views of an article to which a design is applied must be photographed using the same scale, against a plain contrasting background without any shadows or other background scenes…photographs may be monochrome or color…photograph must not be folded*" [Asamura and Okano, 2001].

b. The filing of a model or sample

In OAPI a model or a sample can be filled in place of drawings[11]. This possibility is also given by the Japanese system, "*if the model or sample of an article to which the model is applied is not breakable or transformable and it is easily stored*", such model or sample itself can be filled. [Asamura and Okano, 2001]

2.2.4.2. ***Other types of Design Application***

a. Related design

In Japan, "*an applicant for design registration may obtain design registration of a design that is similar to* ***another design selected from the applicant's own designs*** *either for which an application for design registration has been filed or for which design registration has been granted, if the filing date of the application for design registration of the Related Design is on or after the filing date of the application for design registration of the Principal Design and* ***before the date when the design bulletin in which the application for design registration of the Principal Design is published … is issued"[12].***

[11] Bangui Agreement, Annex IV, Article 8(1)(e)
[12] Design Act, law No 125 of April 13, 1959, as amended, Article 10(1)

b. Secret design

Secret designs are protected in Japan since the revision of Design Law in 1909. The Design Act provide that, "*An applicant for design registration may request that the design be kept in secret for a period that shall be designated in the request and shall be* ***no more than three years*** *from the date of the registration establishing the design"*[13].

c. Set of articles

At OAPI the registration of sets of articles is not an issue, considering the possibility of including up to one hundred designs in the same application. In Japan, however, since the registration of set of articles is an exception to the principle of "one application, one design", the legislator has provided for the possibility of recording several designs in the same application, only when these designs correspond to objects that are used together. A list of articles eligible for this exemption is provided by the Ministry of International Trade and Industry[14].

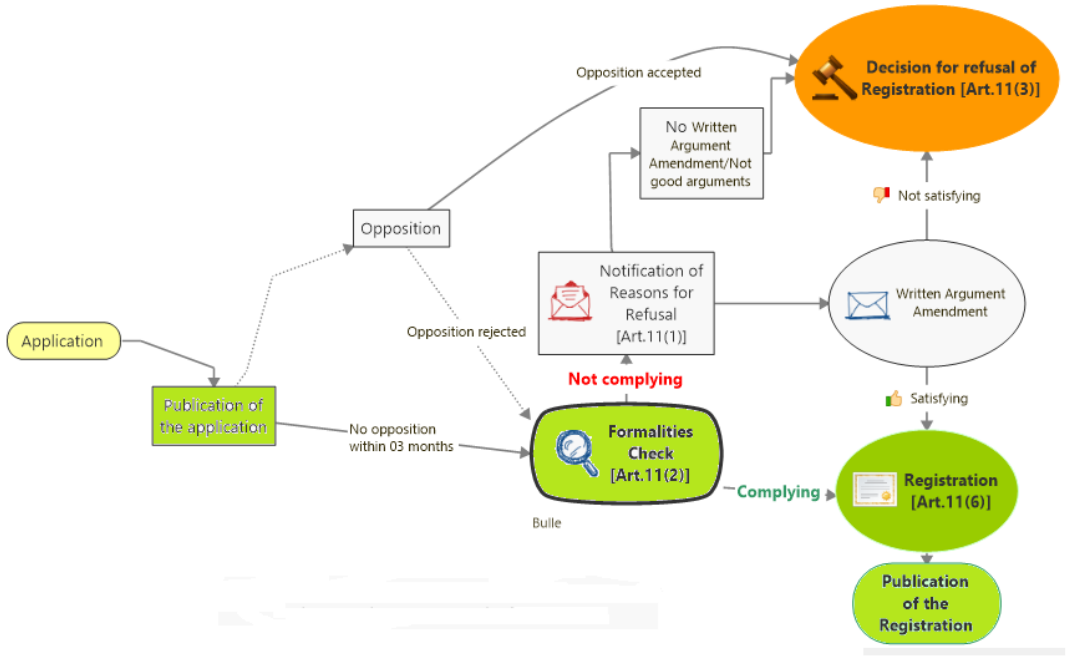


Figure 4: **The Design registration's procedure in OAPI**

2.2.5. The substantive examination in JPO

In Japan, there are two levels of examination of the application before the registration. The first is the formal examination, which doesn't differ from the OAPI's. The second is the

[13] Design Act, law No 125 of April 13, 1959, as amended, Article 14(1)
[14] Design Act, law No 125 of April 13, 1959, as amended, Article 8

substantive examination, which is very specific to the JPO. In the Japan Patent Office, the substantive examination is conducted separately from the formality check.

The substantive examination is a procedure which consist for the Office, in checking the fulfillment of substantive requirements in the design application. The following process chart describe the examination procedure of designs in JPO.

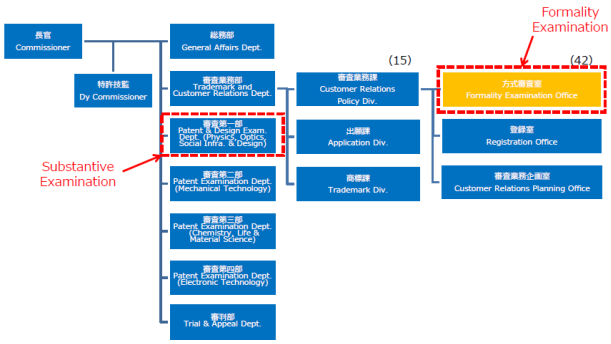


Figure 5: **The Formality check office and the Substantive Examination Department in JPO**

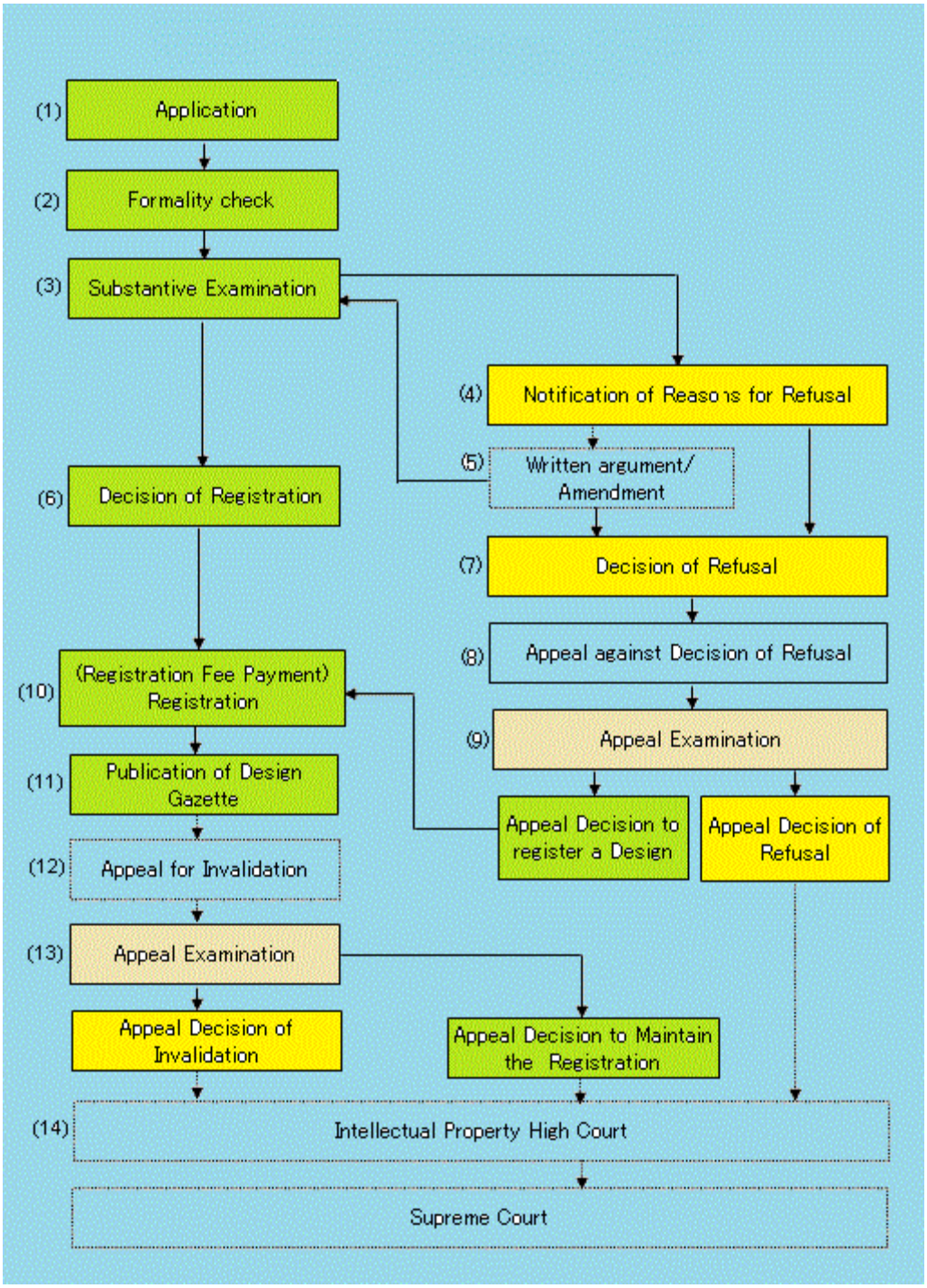


Figure 6: **The Design registration's procedure in JPO**

During the substantive examination, the main examined requirements are the novelty, the creative difficulty, the morality of the design. The examiners also make sure that the design doesn't fall into the category of un-registrable designs.

2.2.5.1. Novelty

Many systems currently require global novelty, so as not to enable re-monopolization of existing designs.

https://www.jpo.go.jp/seido_e/quality_mgt/quality_mgt.htm

Novelty is different from originality => Cass. Civ., 1re., 7 November 2006.

"Form bearing the seal of the personality of its author" =>TGI Paris, 9 mars 1970.

or the imprint of this personality => Paris, 21 November 1994.

by an intellectual contribution specific to its author

The rule

It is commonly admitted that "**An industrial design may be registered if it is new**"[15]

The Bangui Agreement states that : "*An industrial design is new **if it has not been disclosed anywhere in the world** by publication in tangible form, by use or by any other means before the filing date or, where applicable, before the priority date of the application for registration.*"[16]

The Bangui Agreement does not distinguish between the hypothesis of a perfect identity and that of a simple similarity between the design that aspires to protection, and the prior designs. In the hypothesis of implementation of the procedure of opposition it may be useful to clarify this legal provision, to prevent possible discrepancies.

The formulation made by Japanese law seems more precise on this point. It evokes two hypotheses. The first concerns the **identical designs**, and the second, the **similar design**:

a. In the first hypothesis, the law excludes from protection, the designs which are identical to:

- *"Designs that were **publicly known** in Japan or a foreign country, prior to the filing of the application for design registration"*[17]*;*
- *"Designs that were **described in a distributed publication**, or designs that were **made publicly available** through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration*[18]*;*

[15] Bangui Agreement, Annex IV, Article 2(1)
[16] Bangui Agreement, Annex IV, Article 2(2)
[17] Design Act, law No 125 of April 13, 1959, as amended, Article 3(i)
[18] Design Act, law No 125 of April 13, 1959, as amended, Article 3(ii)

b. The second hypothesis concerns the "*Designs similar to those prescribed in the preceding two items*[19] ".

Acording to the JPO, the concept of *"Prior to the filing of the application for deign registration takes into consideration the exact time of the filing, unlike the date of the filing of an application for design registration (Articles 9 and 10 of the Design Act, etc.) which is determined on a daily basis*[20].

Th term "designs that were publicly known" refers to **a design whose contents became known in reality to unspecified persons** as a design that is not kept secret[21].

A registered design prior to the date of publication of the Registered Design Bulletin thereof is generally not treated as a design that was publicly known even if establishment of the design right has been registered[22].

Regarding the designs described in a publication, the novelty is lost when "*the publication is made available for **unspecified persons** to see, and it **does not require a fact that someone has seen the publication in reality***[23]. Moreover, evidence should be provided that A design described in a publication can be used as information that the design that serves as the basis for determination of novelty "*has been sufficiently **represented to a comparable level**"*[24].

Exceptions

There are cases in which, although previously published, a design that aspires to protection through registration will not be rejected for lack of novelty. For example, if, during the 12 months preceding the date of the application, the industrial design was the subject of disclosure resulting from:

a. An obvious violation in relation to the applicant or his predecessor in title;
b. The fact that the applicant or his predecessor in title has displayed it at an official or officially recognized international exhibition[25].

In the above hypothesis, the novelty will not be lost. The Design Act contains a similar provision and specifies that:

"*In the case of a design which has fallen under item (i) or (ii) of Article 3(1) **against the will of the person having the right to obtain a design registration**, such a design shall be deemed not to have fallen under item (i) or (ii) of Article 3(1) for the purposes of Article 3(1) and (2) for any design in an application for design registration which has*

[19] Design Act, law No 125 of April 13, 1959, as amended, Article 3(iii)
[20] JPO Examination Guidelines for Design https://www.jpo.go.jp/e/system/laws/rule/guideline/design/shinsa_kijun/index.html No 22.1.1.1
[21] Examination Guidelines for Design No 22.1.1.2
[22] Examination Guidelines for Design No 22.1.1.3(1)
[23] Examination Guidelines for Design No 22.1.2.2
[24] Examination Guidelines for Design No 22.1.2.6
[25] Bangui Agreement, Article 2(3)

*been filed by the said person within **six months**[26] from the date on which the design first fell under either of those items*"[27].

"*In the case of a design which has fallen under item (i) or (ii) of Article 3(1) as a result of an act of the person having the right to obtain a design registration (excluding those which have fallen under item (i) or (ii) of Article 3(1) by being published in a gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 3(1) and (2) to any design in an application for design registration which has been filed by the said person within **six months**[28] from the date on which the design first fell under either of those items*[29]".

In order to apply the previous provision, The JPO's Examination Guidelines describes some requirements shall be complied by the design[30]:

*a. The design needs to have fallen under the following design (i) or (ii) as a result of **an act of the person having the right to obtain a design registration** (the creator of the design or to his successor in title).*

- *A **design that was publicly known** in Japan or a foreign country, prior to the filing of the application for design registration.*
- *(ii) A **design that was described** in a distributed publication, or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration.*

*b. **The person having the right to obtain a design registration** for the above design*

- *(1), has filed the application for design registration.*

*c. **The application for design registration needs to have been filed within one year** from the date on which the above design (1) was disclosed for the first time.*

Principles for determining the similarity between designs

a. The reference person for the appreciation.

The Bangui Agreement makes no explicit reference to the question of likeness, and merely excludes any design that does not meet the novelty test from the subject matter of protection.

[26] This duration was changed to 12 months under the Act Amending the Patent Act that came into effect on June 9, 2018, and apply to design publications issued on or after December 9, 2017

[27] Design Act, law No 125 of April 13, 1959 Article 4(1)

[28] This duration was changed to 12 months under the Act Amending the Patent Act that came into effect on June 9, 2018, and apply to design publications issued on or after December 9, 2017.

[29] Design Act, law No 125 of April 13, 1959 Article 4(2)

[30] Examination Guidelines for Design No 31.1.1

In French Law, "*A design or model shall only be protected if it is **new** and has **individual character***"[31]. "*A design or model has individual character if the **overall visual impression** it produces on the informed observer differs from that produced by **any design or model disclosed before the date of the filing** of the application for registration*

or before the date of priority claimed"[32]. The Japan's Design Act seems to be more precise as it states that "*Whether a registered design is identical with or **similar** to another design shall be determined based upon the **aesthetic impression** that the designs would create through the **eye of their consumers**[33]"*. It emerges from the previous article, that the reference person for the appreciation of similarity is **the consumers**[34]**,** who are "*appropriate persons according to the actual status of transactions and distribution of the article*"[35].

b. JPO's approaches of determination of similarity between designs[36].

The following steps are used for comparing designs

- Finding of the articles to the design of the two designs, to be compared and determination of similarity;
- Finding of the forms of the two designs to be compared;
- Finding of common points and different points in the forms;
- Individual evaluation of common points and different points in the forms.
- Definition of similarity of entire designs.
-

2.2.5.2. The Creative difficulty

In Japanese system, "*Where, prior to the filing of the application for design registration, **a person ordinarily skilled in the art of the design** would have been **able to easily create** the design based on **shape, patterns or colors**, or **any combination thereof** that were **publicly known in Japan or a foreign country**, a design registration shall not be granted for such a design*[37]*".* From the preceding the Japan's system seems to be looking in the created designs, the same effort that would be required from a patent inventor. Therefore, designs are considered from a patent approach, different with the ornamental approach of western countries and OAPI.

Three types of designs cannot be accepted for the registration.

Designs based on ordinary shapes or patterns

[31] Intellectual Property code, Article L511-1
https://www.wipo.int/edocs/lexdocs/laws/en/fr/fr467en.pdf
[32] Intellectual Property Code, Article L511-4
[33] Design Act, law No 125 of April 13, 1959 Article 24(2), Examination Guidelines for Design No 22.1.3.1
[34] Examination Guidelines for Design No 22.1.3.1
[35] Examination Guidelines for Design No 22.1.3.1.1
[36] Examination Guidelines for Design No 22.1.3.1.2
[37] Design Act, law No 125 of April 13, 1959 Article 3(2)

This category includes the following:

a. Shapes, patterns or colors, or any combination thereof, that were publicly known[38]

- Shapes, patterns or colors, or any combinations thereof, that were publicly known in Japan or a foreign country;

- Shapes, patterns or colors, or any combinations thereof, that were described in a distributed publication in Japan or a foreign country However, the publication must not only have been distributed, but must also have been in a state where it was publicly known.

b. Shapes, patterns or colors, or any combination thereof, that were widely known[39].
c. Designs that were publicly known or widely known[40]

Designs imitating natural objects as well as famous works and buildings

"Designs that merely represent, in whole or in part, the shapes or patterns of natural objects and famous works or buildings, almost as they are in an article cannot be protected."[41]

Designs converted as a business practice

"In the case where a design is converted to a dissimilar article as a business practice, a design that merely represent the shapes patterns, colors or any combination thereof of a dissimilar article which has been deformed to an extent that is normally made as a business practice, in an article"[42].

2.2.5.3. Industrial utilization

In OAPI system, a design to be registrable should be able to serve as a pattern for the manufacture of such a product[43]. This requirement is not apparent in the Japan Design Act, but it constitute the criterion for distinguish between fine arts (protected in Japan only by copyrights) and applied arts (which can be protected by Design Law).

In Japan , it is commonly accepted that the design "*must be capable of being industrially utilized*"[44].

2.2.5.4. Un-registrable Designs

In Japan as in OAPI, the following cannot be protected

[38] Examination Guidelines for Design No 23.4.1
[39] Examination Guidelines for Design No 23.4.2
[40] Examination Guidelines for Design No 23.4.3
[41] Former Japanese Examination Guidelines for design 3-5200
[42] Former Japanese Examination Guidelines for design 3-5300
[43] Bangui Agreement, Annex IV, Article 1(1)
[44] Design Act, law No 125 of April 13, 1959 Article 3(1)

a. Designs which are perceived to be prejudicial to public order or morality;[45]
b. Designs which are liable to be confused with articles relevant to another person's business[46];
c. Designs which are composed only of shapes that are indispensable in securing the functions of an article.
"*If the object can at the same time be considered a new design and a patentable invention and if the elements constituting the novelty of the design are inseparable from those of the invention, the said object may only be protected under the provisions of Annex I on Patents or Annex II on Utility Models*"[47].

"*Notwithstanding Article 3, the following designs, a design solely consisting of a shape that is indispensable for securing functions of the article shall not be registered*"[48]

When the form is distinguished from the function, the judge retains the originality since the form is gratuitous [Paris, March 17, 1972.].

On the other hand, when the form and the function are inseparable, the protection of the work by the copyright is refused since the form is dictated by the function of the object. [Cass. Civ. 1st, March 28, 1995, Thermopac v. Seprosy.]

In JPO the examination duration is nearly 01 Month. In case of irregularities, the office notifies the applicant who can correct the application within 30 days.

2.2.6. Ownership of the design

2.2.6.1. The "First to file" system

In Japan's and OAPI'S systems, the design right is owned by the person who filed first[49]. In case there are two or more applications made on the same day for registration of designs identical with or similar to each other, only one applicant, decided upon by mutual agreement of all of the applicants may obtain a design registration; if there is no agreement, none of them may obtain a registration[50]. In the OAPI system, the design law provides that "*The ownership of a design shall vest in the person who created it or in his successors in title, but in the absence of proof to the contrary the first applicant shall be presumed to be the creator of the design*"[51].

2.2.6.2. Design right

[45] Design Act, law No 125 of April 13, 1959 Article 5(i)
[46] Design Act, law No 125 of April 13, 1959 Article 5(ii)
[47] Bangui Agreement, Annex IV, Article 1(2)
[48] Design Act, law No 125 of April 13, 1959 Article 5(iii)
[49] Design Act, law No 125 of April 13, 1959 Article 9(1)
[50] Design Act, law No 125 of April 13, 1959 Article 9(2)
[51] Bangui Agreement, Annex IV, Article 4(2)

a. Payment of the registration fees

In OAPI, the payment of registration fees is done at the same moment with the filing of the application. Without the payment, the application cannot be examined. In Japan however, the registration fees (the annuity for the first year of registration) are paid within the prescribed period of 30 days from the mailing date of the notice of decision of registration, i.e. after the examination and only if the design is registered. In case the applicant doesn't pay within the said period, the registration will be nullified[52].

b. Duration of a design Right

In OAPI, "*the term of the protection conferred by a certificate of registration of an industrial design shall expire at the end of the fifth year following the filing date of the application for registration. The registration of a design may be renewed for a further two consecutive periods of five years on payment of a renewal fee the amount of which shall be fixed by regulation"*[53].

This duration is shorter than the duration provided by the JPO's Design Act, which states that, "*the duration of a design right (excluding design right of a Related Design) shall expire after a period of* ***20 years*** *from the date of registration of its establishment"*[54].

c. Renewal of the design right

In OAPI as said before the renewal fees are paid every five years, and the renewal cannot be done more than two times. The JPO's has a different approach of the importance of design. The design is similar to patent, and they have a similar renewal procedure. "*A person obtaining the registration establishing a design right, or a holder of a design right, shall pay as registration fees the amounts specified in the following items, for each design registration and for each year to the expiration of the duration as provided in Article 21"*[55]. However, he registrant can pay in advance the annuities for several years or for all the remaining years [Asamura and Okano, 2005].

2.2.7. Invalidation procedure in Japan

In Japan, after the Examiners issued his/her decision (3) to (9) in Figure 5, if an applicant wishes to demand for an appeal against the Examiner's rejection, he/she can demand for appeal to the JPO, Department of Appeal. Then three appeal examiners in the Department of Appeal reviews the Examiner's decision. The registered and published design may be challenged if someone found that it has been granted in violation of some requirements[56].

Regarding invalidation procedure, the Examiner in the Design Examination Department issues allowance to register design then the applicant pays the issue fee and the registration of

[52] Design Act, law No 125 of April 13, 1959 Article 43(1).
[53] Bangui Agreement, Annex IV, Article 12(1)(2)
[54] Design Act, law No 125 of April 13, 1959 Article 21(1)
[55] Design Act, law No 125 of April 13, 1959 Article 42(1)
[56] Design Act, law No 125 of April 13, 1959 Article 48

design is established. After establishment the registered design is published. The third party or person can watch the registered design in a publication and he/she can demand an invalidation to the Department of Appeal in the JPO. Three appeal examiners will conduct trial examination.

For example, if the design is characterized by a lack of novelty, or if it belongs to the category of designs that cannot be registered, or if the design is identical or similar to a design in a prior application, or if the design is in contravention of the required conditions. The invalidation procedure take place in the Trial and Appeal Department. In case of non-satisfaction, the parties may appeal to the High Court and then to the Supreme Court.

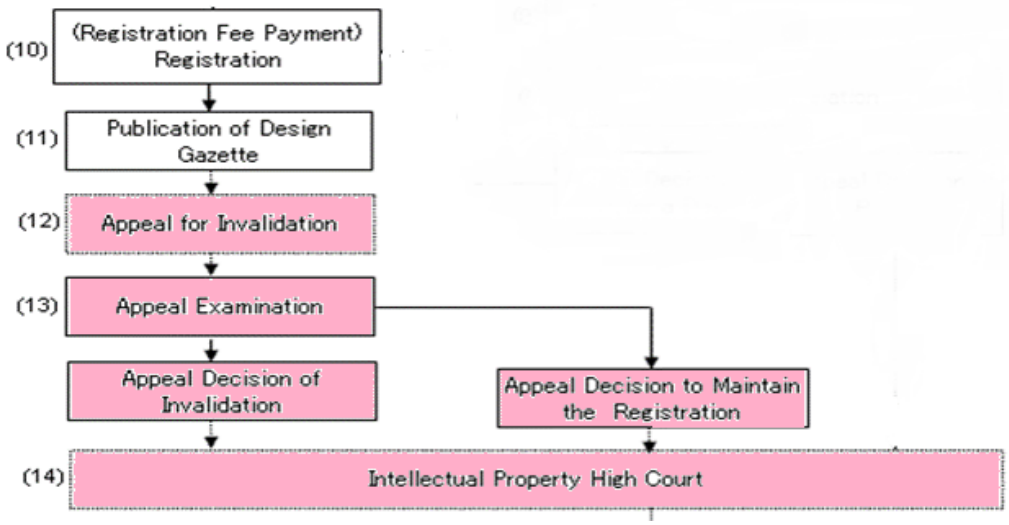


Figure 7: **The design's invalidation procedures in JPO**

3. METHODOLOGY OF THE STUDY

3.1. Survey of previous information

The desk research consisted of a review of the legal developments at the OAPI and JPO's. We also used the results from the former researchers on the Design Substantive Examination System of Japan, and tried to compare with OAPI trends and statistics.

3.2. Short training courses

3.2.1. On the Japanese strategies for promoting public awareness on IP

During five days, (August 6- 10, 2018) we participated in a series of presentations on the development strategies of the awareness on intellectual property. This training session helped us to get a better understanding on how Japan politic strategies rely on the promotion of innovation to ensure the economic and social technological development of the country. This training is very useful in that it could serve as an example in the African context, where the awareness of many creators seems to be very low on IP issues.

3.2.2. On the JPO's design system

One month later, (September 3- 14, 2018) we assisted to a training on Japan design system, during which we were able to gain a better understanding of how the design protection system works in Japan. This course has allowed us to know the history of the system of protection of designs in Japan. We also took part in practical examinations of form requirements (representation of designs on demand) as well as substantive requirements (novelty, inventive step).

3.3. Stakeholder interviews

We have been received for interviews, by some examiners of the JPO's Design Division, some members of the Japan Patent Attorneys Association and also, by a user of the Japan design system.

3.3.1. JPO's Design examiners

We have also been received by some examiners of the JPO's design division on the 29th October. They shared with us their experience with the Guideline of Examination, the Quality Management Manual and the database creation, for design examination.

3.3.2. Patent Attorneys

We had many meetings with different patent Attorney. They shared with us their experience on design system in Japan, and some information on their association's structure and activity. These opinion exchange helped us to understand the importance of the activities of patent attorneys in the process of increasing the awareness of the population on Intellectual Property issues in Japan.

3.3.3. User of the JPO design system.

We had an interview with the General Manager of HONDA, Motorcycle and Power Product Intellectual Property Division, and Standardization Supervisory Unit.

This interview helped us to understand the relationship between the JPO and the companies in Japan. In particular, we have discovered that the JPO frequently receives the opinions of users of its protection system, through surveys and other questionnaires.

4. RESULTS AND ANALYSIS

4.1. The awareness on importance of Design Rights in JPO and OAPI.

Given the crucial role of the protection of industrial property rights in the economic growth of African countries, it is important to question the statistical results in the OAPI member states, comparing them to those of Japan, whose economic success is essentially based on a policy of promoting intellectual property.

4.1.1. The Number of Design Applications and registrations in JPO and OAPI.

For more than 8 years, the Japanese Patent Office has been receiving an average of over 30,000 design registration applications, and is therefore ranked as the 7th design applications receiving Office in the world, according to the World Ranking published by WIPO in 2017.

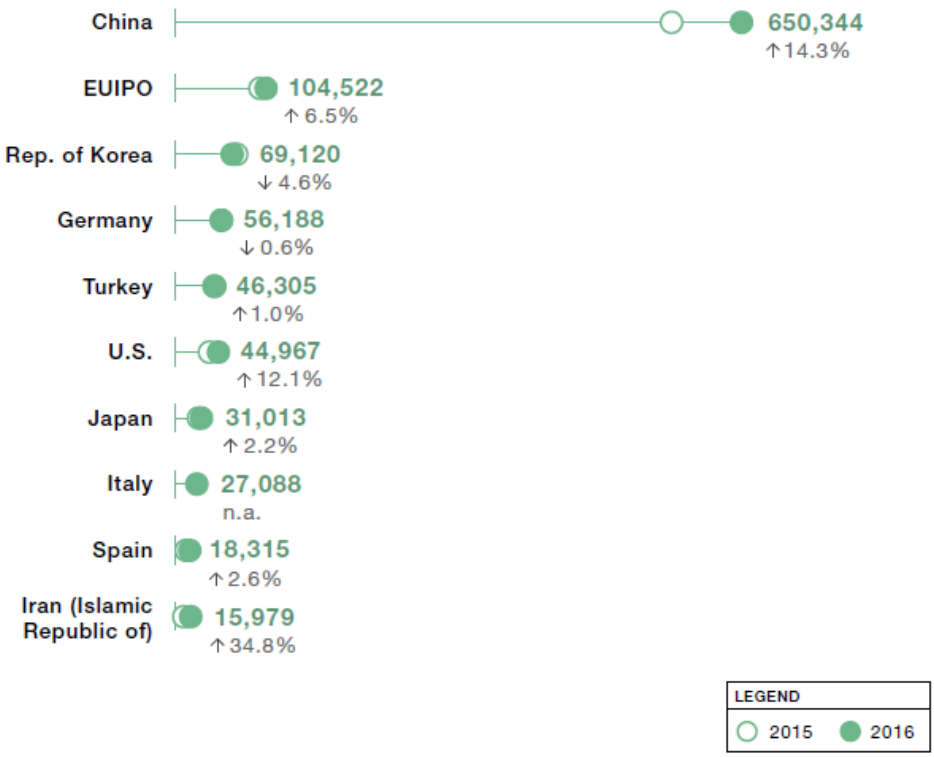


Figure 8: **Application design counts for the top 10 offices** [57]

The following table represents the number of designs applications received since 2008. The number of applications appears to be almost constant and more than six times higher than that of OAPI.

[57] WIPO Statistics Database, September 2017.
https://www.wipo.int/edocs/infogdocs/en/ipfactsandfigures2018/

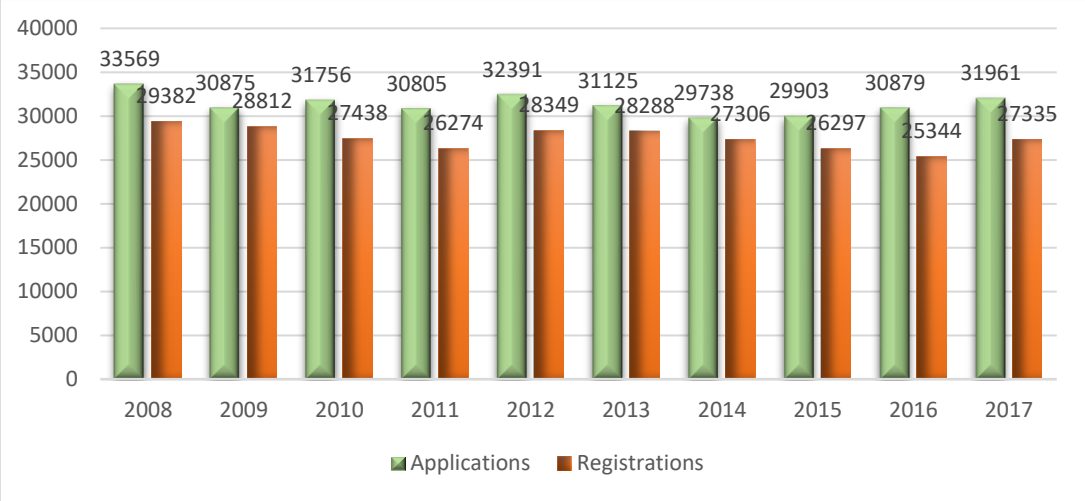


Figure 9: **Number of Design Applications/Registrations in JPO Since 2008 [JPO, 2018]**

In comparison, the statistics of applications and registrations in OAPI are significantly lower than those of the JPO.

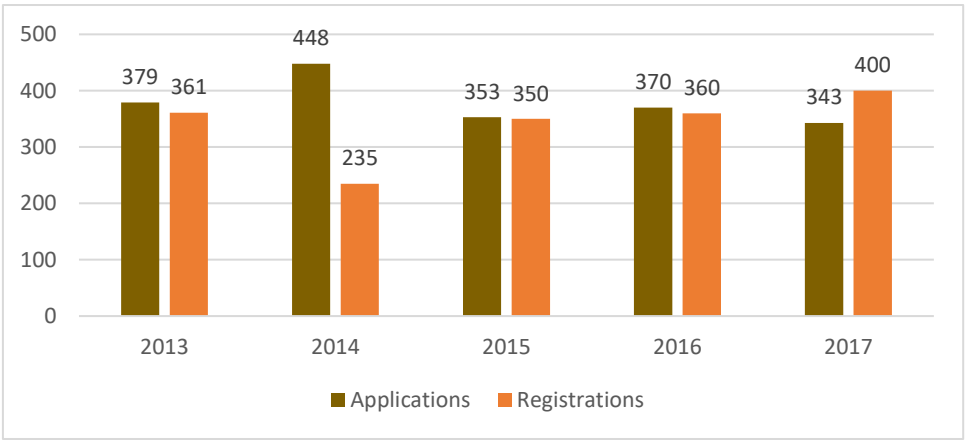


Figure 10: **Number of Design Applications/Registrations in OAPI Since 2013.**

4.1.2. Correlation between the population and the number of design applications.

The difference is even more remarkable when one considers the demographic data of the populations of the OAPI area and of Japan.

Table 1: **Population of OAPI on the 1st July of 2017.**

Country	Date of accession	Population (July 2017)
Benin	Since the creation	11,175,692
Burkina Faso	Since the creation	19,193,382
Cameroun	2-Aug-82	24,053,727
Centrafrican Republic	2-Aug-82	4,659,080
Comoro's	25-May-13	813,912
Congo	2-Aug-82	5,260,750
Cote d'Ivoire	2-Aug-82	24,294,750
Gabon	2-Aug-82	2,025,137
Guinee	13/01/1990	12,717,176
Equatorial Guinee	23/11/2000	1,,267,689
Guinee Bissau	7-Aug-98	1,861,283
Mali	30/09/1984	18,541,980
Mauritania	2-Aug-82	4,420,184
Niger	2-Aug-82	21,477,348
Senegal	2-Aug-82	15,850,567
Chad	Since the creation	14,899,994
Togo	2-Aug-82	7,797,694
	TOTAL	190,310,345

The population of Japan on the 1st July 2017 was estimated at **127 484 450 inhabitants.**[58] In order to objectively compare the importance of awareness of design creators in Japan and in the OAPI space (which is reflected in the desire to obtain the registration of their designs), it seemed useful to evaluate the correlation between the number of inhabitants of these two spaces, and the number of requests for designs received by the Offices, the result is presented in the following graph:

Table 2: **Correlation between the population and the number of design applications in JPO and OAPI.**

Year	2011	2012	2013	2014	2015	2016	2017	Total (7 years)	Population (July 2017)	Ratio/ 100.000 h
OAPI	287	427	470	543	490	534	343	2,751	190,310,345	**1.45**
JPO	30,805	32,391	31,125	29,738	29,451	28,796	29,745	182,306	127,484,450	**143**

Thus, while in Japan, there is an average of **143** design registration applications per 100,000 inhabitants, in the OAPI space, for the same number of inhabitants, the office will receive less than **2** applications for registration.

[58] UNITED NATIONS DESA / POPULATION DIVISION
https://population.un.org/wpp/99

4.1.3. Correlation between the population and the number of Intellectual Property Attorneys.

Table 3: **Correlation between the population and the number of Industrial Property Attorneys**

Country	Date of accession	Population (July 2017)	Number of IP Attorneys
Benin	Since the creation	11,175,692	1
Burkina Faso	Since the creation	19,193,382	2
Cameroun	2-Aug-82	24,053,727	38
Centrafrican Republic	2-Aug-82	4,659,080	0
Comoro's	25-May-13	813,912	0
Congo	2-Aug-82	5,260,750	3
Cote d'Ivoire	2-Aug-82	24,294,750	3
Gabon	2-Aug-82	2,025,137	2
Guinee	13/01/1990	12,717,176	2
Equatorial Guinee	23/11/2000	1,267,689	0
Guinee Bissau	7-Aug-98	1,861,283	0
Mali	30/09/1984	18,541,980	2
Mauritania	2-Aug-82	4,420,184	2
Niger	2-Aug-82	21,477,348	1
Senegal	2-Aug-82	15,850,567	4
Chad	Since the creation	14,899,994	0
Togo	2-Aug-82	7,797,694	1
	TOTAL	190,310,345	61

While in Japan, for a population of 127,484,450 habitants, there are 12.000 Patent Attorneys, In the OAPI territory they are only 61.

4.2. The importance of legal certainty in a Design System.

"Legal certainty" is an issue that seems to be of high importance in any strategy to increase the awareness on Intellectual Property Rights protection. This question seems to be of concern to both lawyers and economists [Kerhuel and Raynouard, 2010]. For the later, the need for subjective rights whose implementation is guaranteed, is an essential element of any economic development: if the property is not insured, no contractor will undertake, if the contracts do not receive execution, nobody will not commit and then, what would encourage the registration of industrial property assets ?

Three criteria traditionally allow to evaluate the level of legal security of a given legal system: **Predictability**, **stability** and **guarantee**. Predictability is the most important, and from it stems from stability and guarantee.

4.2.1. The legal certainty aspects in the OAPI Design System.

Several sources indicate, among other things, that the low number of design registration applications at OAPI is indicative of the lack of information on the mecanism of protection in OAPI (how to acquire the Right and how to defend it in case of infringement ?).

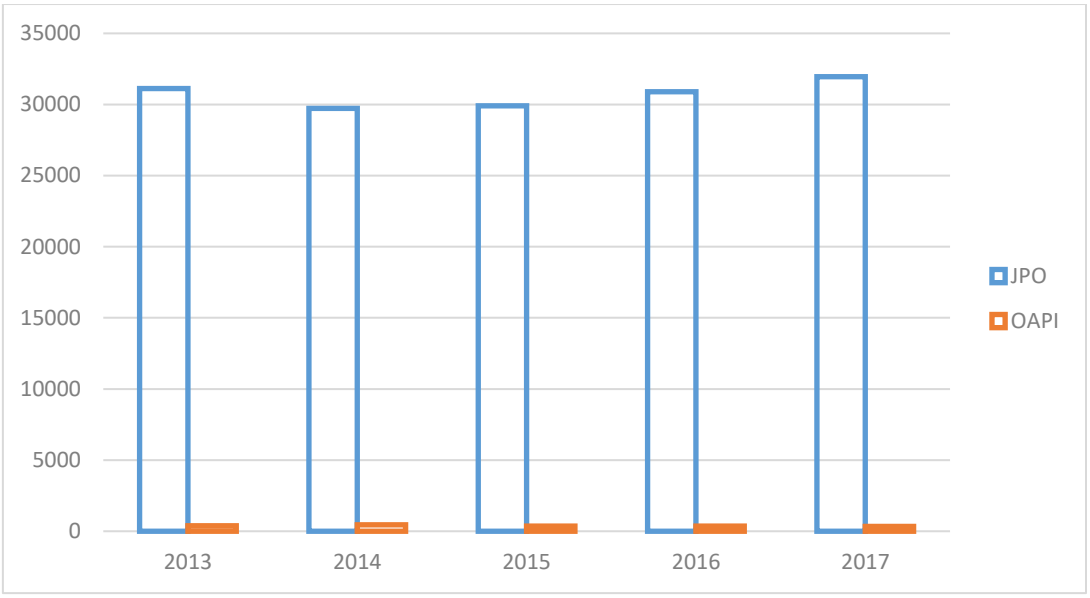


Figure 11: **Comparison between OAPI Design Application for registration and JPO's**

Some economic actors with whom we had the opportunity to exchange during an exhibition in 2017 in Yaounde (Cameroon) clearly told us that they were not sure that the registration of their designs at OAPI would give them more visibility in the market. They were particularly dubious with regard to the protective nature of the registration.

In the same way, during an exchange of information with some Patent Attorneys of the JPAA (Japan Patent Attorneys Association) that we met in September 2018, we had the opportunity to investigate the reasons for the low interest of Japanese companies for the African market. Most of the responses received pointed to the lack of awareness of the laws governing the protection of industrial property rights, as well as the issue of legal certainty in this area.

Legal certainty requires that the law be clear, intelligible accessible and allow the "right of an individual to be fixed on the content of the provisions applicable to him" [Kerhuel and Raynouard, 2010]. Legal certainty is an imperative for the protection of citizens against legal uncertainty, ie risks resulting from difficulties of access to the law, lack of clarity and legibility of the law, its inconsistencies and complexities, its changes too frequent.

The law currently in force in OAPI dates from 1999, that is to say that it will have a **20 years** old in 2019. In order to increase the legal certainty of its system, OAPI's Directors decided in 2004 to organise every year, many training seminars, short and long term, for actors from all economic sectors. Theses training are actually encouraged by the JPO fiduciary fund, and produces perceptible results, as thousands of people are now realizing the importance of protecting their intellectual property assets. However, it is necessary to have a tool to assess the impact of these efforts, and to improve the exchanges with users. The Organization holds an annual information exchange meeting with the representatives. We do not currently have a tool to evaluate the satisfaction of the users of our system.

OAPI's legislation provides a relatively secure framework for protection. However, as we have shown above, many points remain to be specified, particularly those relating to the

representation of designs on a registration application. It is essential to provide the users with additional documentation to the Bangui Agreement. (Examination guidelines, Manual of the Applicant, Database for prior search). The Japanese system has many tools that can be usefully tested by OAPI, although the two systems are fundamentally different.

4.2.2. The legal certainty in the Japanese System

Although OAPI design system is not a substantive Examination System, there are many tools that can be implemented from JPO's design system to make it more efficient. The Japanese system appears likely to be an excellent model for OAPI because of the following factors.

4.2.2.1. The Quality Management System in Japan design System

Since 2014, the JPO has been equipped with a Quality Management System whose functioning is described in the Quality Management Manual. Before 2014, like the OAPI, the JPO had some tools (meetings, polls, etc...) to gather the opinion of the users of its protection system, in order to improve its quality.

The decision to group these tools into an inclusive, coherent and consistent framework reflects the government's desire "*to build the most advanced intellectual property system in the world"*[59].

Taking the Plan Do Check Act (PDCA) concept, the system includes the following steps:

a. Plan:

In this step, basic legal framework, including the Design Act, the Examination Guide is created.

b. Do:

During this stage, the examiners perform the tasks assigned to them and strive to respect the examination rules. During the examination, examiners prepare a document that motivates their decision:

If the examiner wishes to approve an application, he or she establishes a registration document. said document will be submitted to the appreciation of its superior hierarchical. If the hierarchical superior considers that the reason for acceptance is in accordance with the laws, he will validate the decision of the Examiner and the Design will be registered.

In the event that the examiner wishes to reject an application, he draws up a notice of refusal which he will also submit to the appreciation of his superior. If the latter validates

[59] JPO Quality Management Manual for Design Examination
https://www.jpo.go.jp/e/introduction/hinshitu/shinsa/isho/isho_manual.html, P.3

the notice of refusal, a notification is sent to the applicant who can respond by transmitting his arguments in response to the notification. The examiner then examines the applicant's arguments and decides to modify his decision and thus to establish a registration document, or to maintain his decision to refuse. In each case, he transmits a document containing his decision to his superior, verifying that the examiner has in fact taken into account the arguments of the applicant, and will decide what action to take in the proceedings.

c. Check:

While conducting examinations, the examiners collect as much relevant information as possible to improve examination procedures. For this, the JPO has put in place various means of collecting information. This document allows the hierarchy to control and validate the examiner's decision.

- Approvers check;
- Quality audit
- User Satisfaction surveys;

The information collected by these means, helps to decide whether or not it is necessary to modify the law, and what should be modified.

d. Act:

The information collected in the previous step are used to improve the legal system.

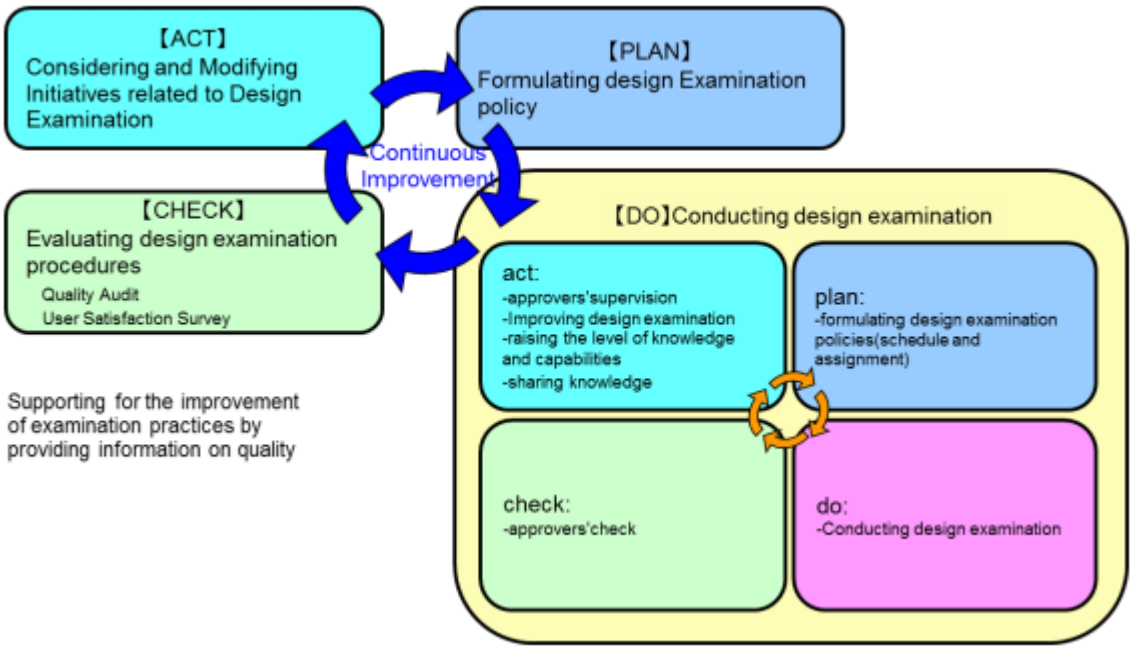


Figure 12: **Conceptual Diagram of the PDCA Cycle for Maintaining and Improving the Quality of Design Examination [60].**

4.2.2.2. The Stability of the Japanese Substantive Examination System.

A questionnaire survey targeting 37 Japanese companies including the some of the most registering industrial designs in the JPO annual report from 2005 to 2013, was conducted in 2004[61] . The questionnaires were sent to 51 IP Attorneys, and 10 answer were returned, which yielded the results presented in the following graph:

[60] JPO's Quality Management Manual for Design Examination, P.15

[61] Latdaphone Sirisombath, Substantive/Non-Substantive Examination System In Design Registration System, Final report of WIPO Long-Term Research-Cum Fellowship Program 2014

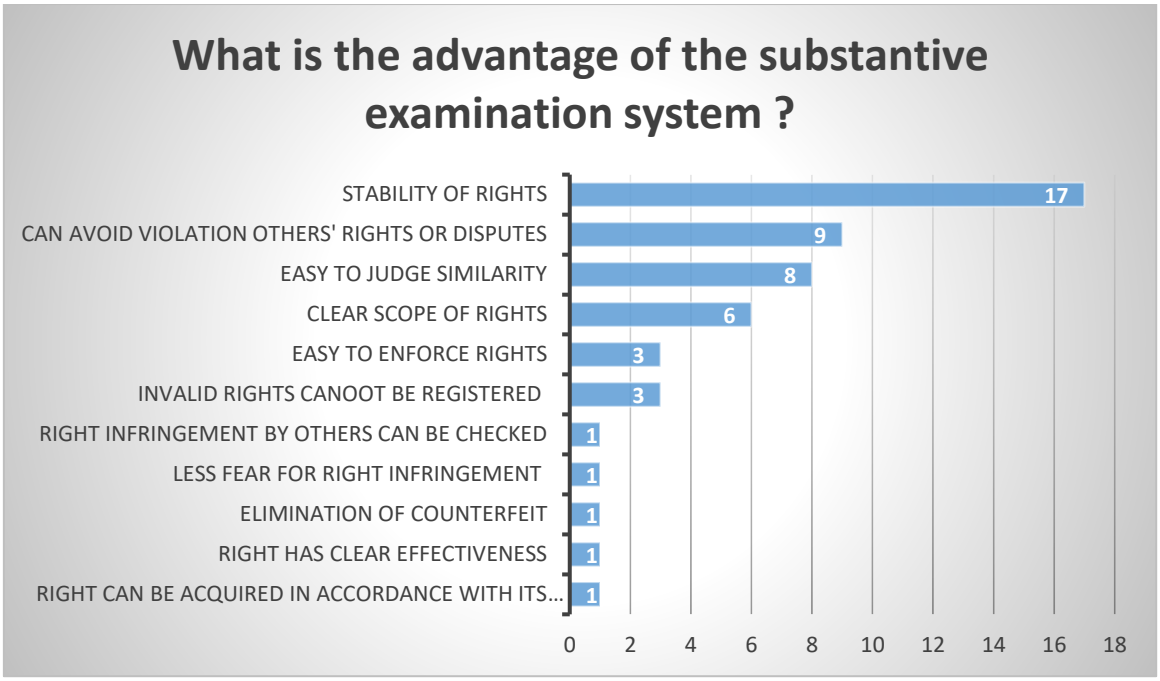


Figure 13: **Statistics on the main advantages of the substantive examination system?**

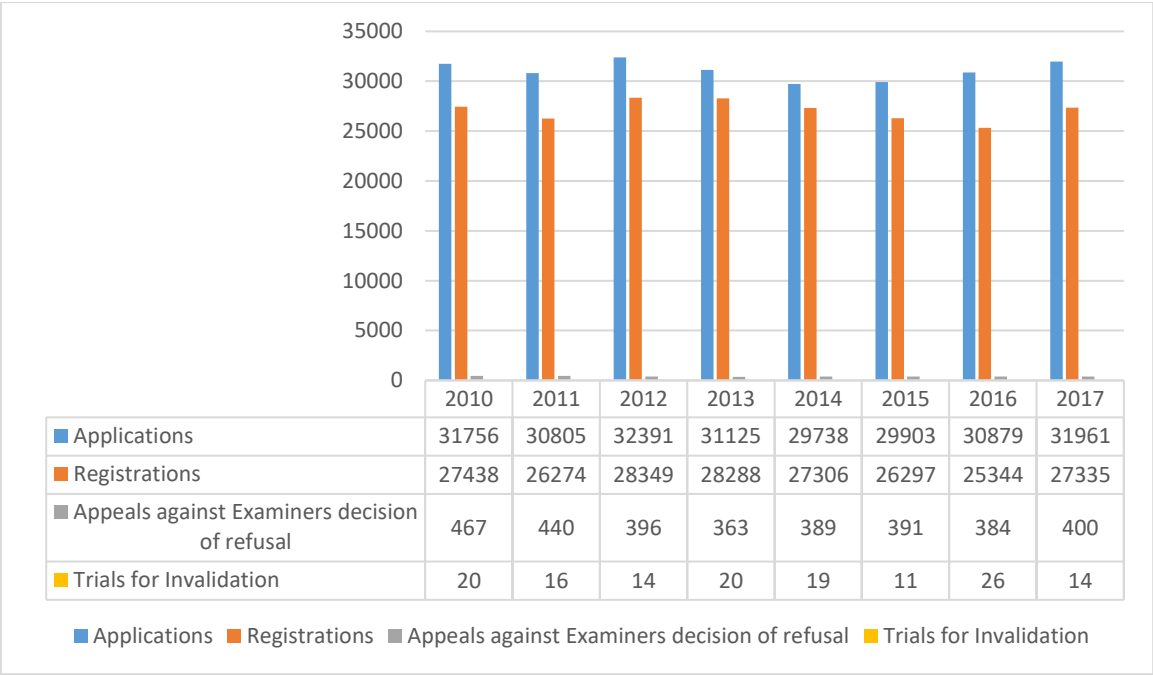
From the precedent results, it appears that the most important advantage of the substantive examination system is the Stability of the rights, which is as we previously said, one of the most important criteria of the legal certainty.

4.2.2.3. The low number of disputes in the Japanese system.

One of the main advantages of the Substantive examination system is that it decreases unnecessary disputes, because the examination is accurate and makes the judgment of similarity easier.

During the Substantive Examination, the examiner verifies that the design subject of application complies with the criteria of novelty, creative effort and that they are not excluded from the design's field of protection. This in-depth examination of the designs provides a strong guarantee to the registered design owners, and the registration certificate can therefore be considered as a certification of compliance with legal requirements. On the other hand, in a non-substantive examination such as that of OAPI, the registration seems less reassuring and is likely to be challenged in particular by the mechanism of the opposition, which would force the Office to examine the recorded design, to check its conformity to the requirement of novelty.

The following table represents the rate of subsequent trials to registration decisions or refusal of registration of designs in JPO.



	2010	2011	2012	2013	2014	2015	2016	2017
Applications	31756	30805	32391	31125	29738	29903	30879	31961
Registrations	27438	26274	28349	28288	27306	26297	25344	27335
Appeals against Examiners decision of refusal	467	440	396	363	389	391	384	400
Trials for Invalidation	20	16	14	20	19	11	26	14

Figure 14: **Comparison between Applications, Registrations and Trial against JPO's Design Examination Decisions [JPO, 2018].**

5. CONCLUSIONS AND RECOMMENDATIONS TO OAPI

5.1. Conclusions

Design law is an important branch of industrial property. Indeed, the design "**contributes to the aesthetic appearance or exterior of a product"** [62]. It is the appearance of the design which attracts the customer, and visual attraction is one of the fundamental elements that influence the consumer's decision to choose one product over another. By helping companies to differentiate their products from competitors, industrial designs reinforce the image of these products.

Japan, whose model of economic development rests mainly on the promotion of intellectual property, represents for African countries in general, and for those of OAPI in particular, a model.

In this report, we have highlighted some facts which emphasizes the interest of the Substantive Examination System. Although OAPI has a different system, it seems necessary to draw inspiration from certain elements of the Japanese Design System. The main points we have emphasized in the Japanese's Substantive Examination System are as follows:

- The importance of the portfolio of designs registered every year by JPO is rich. It's the sign of the great experience on JPO on the Design protection field;

- The number of trials for invalidation or appeals against decision of refusal of registration is low. It's the proof of the reliability of Japan's registered design rights.

- The legal certainty of the Japan Substantive Examination System is high;

5.2. Recommendations

5.2.1. Creation of Examination Guidelines for Industrial Design

It would be desirable to hasten the creation of an Examination Guidelines for Designs in OAPI, to strengthen the legal certainty of the design protection system. Indeed, when the rules are standardized, the examination is carried out with greater precision, which develops the confidence of the applicants, and encourages the creators. Also the creation of an Examination Guidelines will serve as a basis for evaluation of the quality of the examination, and consequently, the performance of examiners, whose performance will be improved. The importance of a Guideline is contained in the following points:

- The law cannot contain in the detail, all the practices that are conducted by the examiners.

[62] Kamil Idris, WIPO publication 2004

- The guideline allows the users of the design system, and specifically the applicants, to know the specific points on which they have to give information, to make the understanding of their application easier for the examiner.
- The Guideline is a guarantee of equity for claimants who better understand why some of their applications for registration cannot be registered

The Opposition procedure being the only step where the substantive examination will be performed, it is important to consolidate the legal framework in which comparisons will take place. The main criteria of comparison being novelty, special appearance, it is necessary to specify in a succinct manner, the principles which will make it possible to evaluate the risk of confusion between the different designs object of the dispute. The Examination Guidelines should therefore focus on the steps and principles relating to the opposition proceedings. On this question, it seems obvious to us that the Japanese Examination Guidelines can serve as a model on the issues relating to the examination of the novelty.

The representation of the design on the application is also important. It would be interesting to take inspiration from the JPO's six views principle, to reduce examination difficulties related to the poor quality of images provided by applicants. It would also be interesting to include specific criteria for analyzing public order, morality, and compliance with the requirement of special appearance.

As part of our exchange with the JPO examiners, the following method was suggested by one of the JPO's representant:

- Choose The Important Articles of the Design Law (in this case, Annex IV of the Bangui Agreement);

- Recall the statement of the Article;

- Indicate the purpose of the article;

- Describe the practical elements (with examples in support, where appropriate) of the implementation of this article.

5.2.2. Create a Quality Management Manual for Design Examination

The creation of a Quality Management Manual for the design system is also of great interest. It is indeed desirable to ensure continually that the system chosen to be implemented corresponds to the socio-economic context of the OAPI member States. To this end, a coherent, precise, and practical framework for Quality Management will need to be created. This framework should allow an exchange of points of view between the different actors of the System of Design, and the users of this system.

Actually, OAPI is very open to the development of exchange mechanisms between Industrial Property Attorneys and OAPI, through written communications or meetings.

However, it would be effective to include these different tools in a much more constructed and coherent framework. Our research in this area reveals that it is more efficient to include such actions in an encompassing framework. The JPO's System of Quality Management of the Design System seems to be interesting enough on this point.

This quality management framework not only helps the JPO to collect the opinions of the different users, but also to integrate these opinions, when they are constructive, within the legal framework. It therefore appears useful to transform the OAPI approach in this area, which for the moment is limited to tools without synchronicity, to integrate them into a more coherent framework.

5.2.3. The creation of a Design database

The establishment of an opposition procedure based on non-compliance with a design, substantive criteria, necessarily includes the creation of a set of tools that would make it possible to examine the criteria of novelty, special appearance and industrial application. The most suitable solutions to achieve this goal are the computer tools. The main axis of resolution of this question should be the creation of a database, grouping all the designs registered at OAPI. The use of online image databases also seems unavoidable, to search for designs that would not have been registered in OAPI but whose novelty cannot be admitted because at the moment of the filing of the design registration application, the said design was already public.

It is also useful to develop an interconnectivity with different offices of the world, which already have a database of Designs. This is the case, for example, of the following Offices.

Table 4: **Example of Design Databases from different Offices in the world**

Office	Database Link
JPO	https://www.j-platpat.inpit.go.jp/web/all/top/BTmTopEnglishPage
WIPO	http://www.wipo.int/designdb/en/index.jsp
EUIPO	https://euipo.europa.eu/eSearch/
ARIPO	https://eservice.aripo.org/pdl/pah/advancedSearchScreen.do
Asian	http://www.asean-designview.org/designview/welcome

For the design that have not been registered, it will be useful to use Google image, whose link is: https://images.google.com

5.2.4. Training of the human resources

With a view to amending the legal framework for the protection of designs at OAPI, it will be essential to provide for the retraining of the various actors in the system, in particular design examiners, design creators, applicants, and industrial property attorneys.

5.2.4.1. Training of design examiners

As the introduction of the opposition procedure in the Design Protection System of OAPI realizes the will of OAPI to take into account henceforth, the respect of the

substantive requirements as provided by the Bangui Agreement. It will therefore be necessary for examiners to be trained in novelty examination and special appearance procedures. It will also be useful to train them on the use of databases of some industrial property offices in the field of design registration.

One of the most important aspects, however, being the creation of Examination guidelines, it will be essential for examiners to fully understand the principles and technics of comparison of the designs. It will also be necessary to create a framework for the evaluation of the quality of the examination, and the examiners will be involved in that process, hence the importance of training in quality management.

5.2.4.2. Training the design creators: How to increase the awareness on IP issues

Intellectual property being a relatively recent matter in the OAPI Member States, the low level of interest of creators towards the systematic recording of their creations finds its sources in two mentalities strongly rooted in the minds of creators:

- Creations are perceived as a community heritage, and creators are sometime happy to see their creations freely exploited by third parties, associating this with a form of recognition of their creative genius.

- Creators who may wish to obtain recognition of an exclusive right on their works believe that the cost of registration fees is relatively high.

Both of these arguments reflect the need to adapt the design protection system in particular, and the Intellectual Property System as a whole, to regional socio-cultural-economic realities.

On the other hand, they also reflect the low level of awareness of the population, on issues of intellectual property. As one of OAPI's objectives is making intellectual property a lever of development for African states, it is important to draw inspiration from the Japanese government's strategies to increase people's awareness of intellectual property issues.

5.2.4.3. Redefining the role and structure of Patent Attorneys Association

In Japan, The Regulations on Patent Attorney Registration entered into force in 1898 and one hundred and thirty-eight (138) patent agents were registered[63]. In 1909, the Order on Patent Attorneys was promulgated, and a patent attorney badge was created and adopted for wearing in 1934. In 1938 the Patent Attorney Law was partly amended to require all practicing patent attorneys to become a member of the Patent Attorneys Association. In 1960 The Patent Attorney Law was amended to transfer the patent attorney registration service from the Japan Patent Office to the Patent Attorneys Association.

[63] Japan Patent Attorneys Association, History of the Japan Patent Attorneys Association https://www.jpaa.or.jp/old/?cat=673

Since then, the JPAA as accomplished the following steps:

- Creation of the Osaka Gazette inspection room in 1971**.** It later evolved into the Osaka Branch Office.
- Creation of the Nagoya Branch Office in 1982;
- Creation of the Fukuoka counseling room in 1987;
- In 1978, the Education Institute was established by the Patent Attorneys Association as an affiliated organization.
- In 1981, a sisterhood-based alliance was formed between the Korea Patent Attorney Association and the Patent Attorneys Association;
- In 1996, the Central Research Institute of Intellectual Property was established;
- In 1998, the Industrial Property Arbitration Center, now the Japan Intellectual Property Arbitration Center, was co-founded by the Patent Attorneys Association and the Japan Federation of Bar Associations:
- In 2001 The name of the Patent Attorneys Association was changed to the Japan Patent Attorneys Association.

From the above realizations, it appears that the activity of Patent Attorneys is not limited to the traditional duty to advise and assist the clients, but there is also a remarkable and volunteer involvement in the spreading of information on intellectual property, through seminars and conferences for different audiences (schools, Universities, Research Centers, Companies). The network of Patents Attorneys whose total number is 12.000 is fairly well structured.

- The Japan Patent Attorneys Association comprises nine (9) regional branch offices: Hokkaido Branch Office, Tohoku Branch Office, Hokuriku Branch Office, Kanto Branch Office, Tokai Branch Office, Kinki Branch Office, Chugoku Branch Office, Shikoku Branch Office, and Kyushu Branch Office.
- There are 40 Committees in JPAA, Patent Attorneys can voluntary join them. The total number of committee members is 1000.

- There are also 8 Private Groups in Japan (Osaka, Tokyo, Nagoya). Their meetings consist mainly on Exchanging of information, sharing experience. These groups help selecting persons to be council members of the JPAA.

- There is one committee dedicated to collect information on Europe and African activities relating to IP. But they have no or less information on Africa.

OAPI Intellectual Property Attorneys should play a very important role in the construction of the OAPI system, if they create a more dynamic structure and actively contribute in the spreading of information regarding intellectual Property.

Acknowledgements

I would like to express my sincere gratitude to:

- The World Intellectual Property Organization (WIPO);
- The Japan Patent Office (JPO);
- The African Intellectual Property Organization;
- The Asia Pacific Industrial Property Center (APIC-JIII);

For sponsoring and organizing this program, for the friendly environment and for the availability of resources available for us throughout our training.

I would like to thank my research supervisor, Dr. YORIMASA SUWA, for its availability, whenever I needed advice and guidance, but also every time I had to go to an appointment. He was quick to help me whenever I ran into a trouble spot or had a question about my research or writing. He consistently allowed this paper to be my own work, but steered me in the right direction whenever he thought I needed it.

My special gratitude to: Ms. MINAKO MIZUNO, my advisor for taking the time to explain to me the Japanese system of protection of designs, and especially for the moments shared with her and with other Attorneys of the Cabinet SEIWA Patents and elsewhere. Her energy, her great experience, her sense of humor helped me more than once, to better understand Japanese culture.

My sincere gratitude to Ms. SHOKO TSUTSUI my advisor, for the time she took to help with my presentation outlines, and for introducing me to many Patents Attorneys. You have been a wonderful advisor and friend for me during my stay.

I thank the JPO officers from International Cooperation Division for their conviviality and their kind welcome, their countless invitations, and the excellent relations they contribute to develop with OAPI.

My warmest thanks to the entire APIC team, who was for me, an adoptive family during my stay in Japan. I have been impressed by their professionalism and friendliness, and I think that my personal culture will be different from now, thanks to this experience.

My deepest appreciation to co-researchers Ms. MONICA ISABEL, Ms. DHIYA DURANI and M. VAGNER LUIS LATSCH for their advices and help on my research work.

My gratitude to Ms. YOKO OKAZAKI, whose advices and experience sharing helped me to better understand the Japanese culture in its diversity and richness.

References

Asamura K and Okano K, Japanese design law : a summary for practitioners of the protection system under the design law in Japan, Industrial Design Rights, an International Perspective, Kluwer Law International and International Bar Association, 2001 edited by Brian W. Gray and Effie BOUZALAS

Fellner C, Industrial Design Law (Intellectual Property in Practice), Sweet & Maxwell, 1995

JPO and APIC (collaborated with Riichi Ushiki), Treaties and Conventions for the Protection of Industrial Designs and the Protection System in Major Countries, 2003

JPO and APIC (collaborated with Kenichi Kumagai), History of Japanese Industrial Property System, 2005

JPO, Status Report 2018
https://www.jpo.go.jp/e/resources/report/statusreport/2018/index.html

Kerhuel A-J and Raynouard A, Measuring the Law: Legal Certainty as a Watermark, Georgetown Law and Economics Research Paper No. 10-12, 2010