

# Notes for the Designation of Japan in an International Design Application under the Geneva Act of the Hague Agreement

October, 2021

## I. International application

### 1. Entry in the application form (DM/1) or on the eHague interface

#### (1) Identity of the creator

As the Japan's Design Act requires information on the creator of an industrial design, always fill in relevant information in the "Creator" section.

#### (2) Products which constitute the industrial design or in relation to which it is to be used

- a. Under the Japan's Design Act, where the product constitute an article, building or graphic image, protection shall be granted. (Under the Japan's Design Act, surface pattern, logo, ornamentation, etc. shall not be granted protection.)
- b. Under the Japan's Design Act, where designs for articles, buildings or graphic images that constitute equipment and decorations inside a store, office and the other facilities create a coordinated aesthetic impression as a whole interior, an application for design registration may be filed as one design, and the applicant may obtain a design right for the design of the interior.
- c. Under the Japan's Design Act, where designs of two or more articles, buildings or graphic images which are used together and belong to any of the prescribed 43 categories of set of articles (See APPENDIX), and such a set of articles, buildings or graphic images is coordinated as a whole, an application for design registration may be filed as for one design, and the applicant may obtain a design right for the design of a set of articles.

#### (3) Priority claim

In order to claim priority under Article 4 of the Paris Convention, never fail to provide information regarding the earlier filing(s) in the "Priority claim" section. An applicant shall submit priority documents with ANNEX V (applicable to International Application on or after October 1, 2021.). Upload priority documents scanned with color data on the eHague in case of attaching them issued in writing. If the earlier filing(s) has the DAS access code, indicate it and priority documents are deemed to be submitted. It is NOT possible to claim priority later with the JPO. (See also II.1.)

#### (4) Indication of the principal design

Under the Japan's Design Act, where a design which is the subject of an application is similar to the design in another application filed on the same date or earlier (principal design), and where both applications are filed by the same applicant, the former design may be registered as a related design in relation to the principal design.

In order to file an application for the registration of a related design, fill in relevant information in the "Related design (Relation with a principal design)" section. Alternatively, the holder of an international registration may submit an amendment for adding the indication of a principal design to the JPO after the publication of the international registration. (See also IV.1.)

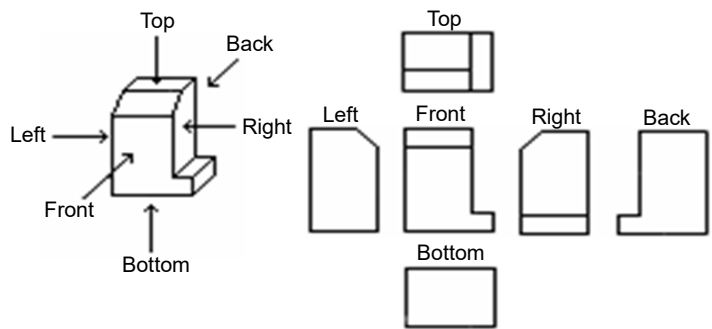
#### (5) Declaration of exception to lack of novelty

In order to make a declaration of exception to lack of novelty, fill in relevant information in the "Exception to lack of novelty" section. Alternatively, the holder of an international registration may make a declaration by submitting a relevant document to the JPO within 30 days from the date of publication of the international registration. (See also II.2. and IV.1.) Disclosure of the industrial design during a period of 1 year preceding the date of the international registration is the only subject of this exception. An applicant shall submit a document proving the fact that the design meets the requirements for exception to lack of novelty with ANNEX II (applicable to International Application on or after October 1, 2021.).

## 2. Reproductions

- (1) Sufficient number of views for clearly showing the design

A reproduction should contain sufficient number of views for clearly showing the design for which the design registration. For example, a front view, a back view, a top view, a bottom view, a left side view and a right side view. (See diagram)



Appropriate legends should also be indicated in the “Description (Legends)” section in the application form (DM/1) or the “Reproduction(s)” section where eHague is used. (Depending on the actual shape, additional view(s) are necessary to fully disclose the industrial design.)

- (2) Where protection is sought for a design of a part of an article, etc.

In order to seek protection for a design of a part of an article, building or graphic image, where the other part of the article, etc. for which protection is not sought is shown in the reproduction in compliance with Section 403 (a)(ii) of the Administrative Instructions, also indicate to that effect in the “Description” section in the application form (DM/1) or on the eHague interface.

## II. National procedures to be done after publication of the international registration

1. Where a priority claim was made in the international application and priority documents were not submitted at the same time, they must be submitted directly to the JPO within three months from the date of publication of the international registration. If the earlier filing(s) has the DAS access code, indicate it and priority documents are deemed to be submitted. (See also IV.1.)
2. Where a declaration of exception to lack of novelty was made in the international application and a document proving the fact that the design meets the requirements for exception to lack of novelty was not submitted at the same time, it must be submitted directly to the JPO within 30 days from the date of publication of the international registration. (See also IV.1.)

## III. Response to the notification of refusal

As a response to the notification of refusal issued by the JPO, the holder of the international registration may submit a written opinion or an amendment to the JPO. It also applies to the case where the holder submits a consultation result in response to the order for consultation stated in the notification of refusal. (See also IV.1.)

Time limits for responding to the notification of refusal are as follows;

- For holders not having residence, domicile or establishment in Japan (“overseas resident”): Three months from the date of dispatch of the notification by the JPO.
- For holders having residence, domicile or establishment in Japan: Sixty (60) days from the date of dispatch of the notification by the JPO.

The time limit for responding can be extended by two months from the initial due date by commissioning an extension of the term to the JPO by the initial due date or within two months after the initial due date. (See also IV.1.)

#### **IV. Others**

##### 1. Basic rules of procedures undertaken to the JPO

Any holder of the international registration designating Japan who does not have residence, domicile or establishment in Japan (“overseas resident”) must undertake procedures to the JPO through a representative who is domiciled or resident in Japan. In this case, the appointed representative must be notified to the JPO.

- (1) With respect to an international registration containing designation of Japan, any documentation addressed to the JPO must be submitted after the publication of the international registration concerned. Please note that the JPO cannot accept those submitted to the JPO before the publication of the international registration.
- (2) Procedures undertaken to the JPO deriving from an international registration must be done by written document. On-line procedures using application software are not applicable except for the procedures of trial against examiner’s decision of refusal and trial against examiner’s ruling dismissing an amendment.
- (3) In accordance with the provision of the Japan’s Design Act, an international registration containing two or more industrial designs is treated as two or more “applications” filed for each industrial design contained in the international registration (there is no need for the holder to divide the international registration). Therefore, any procedure before the JPO must be undertaken not for the international registration as a whole but for each industrial design contained in the international registration.

##### 2. Request for refund of the individual designation fee

In the following cases, the individual designation fee which has already been paid in respect of the designation of Japan may be partially refunded (in Japanese yen) upon request to the JPO within six months from the date of the event (See also IV.1.);

- where the examiner’s decision or trial decision of refusal has become final and binding in Japan, or
- where the application for design registration deriving from an international registration designating Japan has been deemed withdrawn and such an application does not exist any longer (e.g. renunciation and/or limitation of the international registration in respect of Japan, etc.)

##### 3. Duration of protection for industrial designs

The duration of protection for industrial designs in Japan become effective from the date of the registration of the establishment of a design right in Japan and expire after a period of 25 years from the date of international registration (in the case where the international registration date of the international application is on and before March 31, 2020, expire after a period of 20 years from the date of the registration of the establishment of a design right in Japan.)

In the case of related designs, the duration of a design right of a related design expires after a period of 25 years from the date of the application for design registration of its Fundamental design (a primarily selected design as a principal design.) (In the case where the fundamental design is an international application, from the date of the international registration.)

With regard to the industrial design contained in an international registration, upon registration establishing a design right in Japan, the holder may also claim compensation against a person who has worked the industrial design or industrial designs similar thereto as a business after the publication of the international registration and prior to the registration establishing a design right in Japan.

## APPENDIX

Set of Articles			
1	A set of Processed Foods	23	A set of Athletic Implements
2	A set of Tobacco or other similar articles (including related items)	24	A set of Musical Instruments
3	A set of Clothing	25	A set of Instructional Instruments
4	A set of Personal Belongings	26	A set of Office Equipment
5	A set of Instruments for Beauty Treatment	27	A set of Merchandising Equipment (including Packaging Supplies, Advertising Apparatus or Display Racks etc.)
6	A set of Textiles for Interior Decoration	28	A set of Conveying Equipment
7	A set of Interior Ornaments	29	A set of Transportation Equipment
8	A set of Cleaning Appliances	30	A set of Electronic Appliances or Devices
9	A set of Laundry Appliances	31	A set of Information Processing Appliances
10	A set of Health and Hygiene Articles	32	A set of Measuring Equipment
11	A set of Tableware (Not including a set of Cutlery (Cl.13))	33	A set of Optical Equipment
12	A set of Cooking Articles	34	A set of Office Equipment
13	A set of Cutlery	35	A set of Merchandising Machinery
14	A set of Ceremonial Articles	36	A set of Security Equipment
15	A set of Lighting Apparatus	37	A set of Medical Equipment
16	A set of Air Conditioning Equipment	38	A set of Desktop Instruments or Industrial Tools
17	A set of Kitchen Equipment	39	A set of Industrial Machinery
18	A set of Sanitary Equipment	40	A set of Construction Equipment
19	A set of Storage Articles	41	A set of General Purpose Components or Materials
20	A set of Furniture	42	A set of Buildings
21	A set of Pet Articles	43	A set of Graphic Images
22	A set of Amusement and Entertainment Articles		

[End]