

## 34.01

### **Specific handling of an amendment made to the statement in the application or the drawings, etc. attached to the application**

#### **I. Specific handling of an amendment made to the “statement in the application”**

#### **1. Handling of an amendment made to the statement in the column “Article Embodying the Design”**

##### **1.1 Principles in handling**

A determination on whether or not an amendment made to the statement in the column “Article Embodying the Design” of the application changes the gist of the statement in the application (Note 1) should be made based on: whether or not the amendment to the statement in the column “Article Embodying the Design ” changes the gist of the design as originally filed (Note 2) beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design by making a comprehensive determination (Note 3) based on the statement in the application and the drawings, photographs, models or specimens attached to the application (Note 4); or whether or not the amendment clarifies the gist of the design which was unclear when originally filed.

In other words, if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, any usage or function of the article, etc. embodying the design (Note 5) cannot be inevitably derived, the amendment for correction to make clearer the usage and function of the article, etc. embodying the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

Meanwhile, if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, the article, etc. embodying the design can be inevitably derived, the amendment to make correction to the article, etc. embodying the design does not fall under an amendment to change the gist of the design.

(Note 1)

The term “statement in the application” refers to the statements in the columns: [i] Article Embodying the Design, [ii] Description of the Article Embodying the Design and [iii] Description of the Design.

(Note 2)

The term “gist of design” refers to the contents of a specific design that can be directly derived from the statement in the application and the drawings, etc. attached to the application based on the ordinary skill in the art of the design.

(Note 3)

The term “comprehensive determination” includes the determination as to whether or not it is reasonable to give a favorable construction to an improper description of an application or drawings, etc. attached to the application, where such improper description exists; the same should apply hereinafter. Also, where it is simply described as “comprehensive determination” hereinafter, the determination is assumed to be made based on the ordinary skill in the art of the design.

(Note 4)

The term “drawings, photographs, models or specimens attached to the application” is hereinafter referred to as the “drawings, etc. attached to the application.”

(Note 5)

The term “article, etc. embodying the design” refers to the article, building, graphic image or interior embodying the design.

## 1.2 Specific handling

### **(1) Amendment made to the statement containing a proper name, e.g., trademark or XX style, to make clearer the usage and function of the article, etc. embodying the design**

If the statement contains a proper name, e.g., trademark or XX style, it does not fall under a general name of the article, etc. embodying the design, and, accordingly, the article, etc. is not found to be an article whose usage and function are clear.

In this case, if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, any article, etc. embodying the design cannot be inevitably derived, the amendment for correction to make clearer the usage and function of the article, etc. embodying the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If such statement contains a proper name, e.g., trademark or XX style, but a section of the statement other than the proper name makes clear the usage and function of the article, etc. embodying the design, then an amendment to remove the trademark or proper name is found to be an amendment to improve the format of the statement within the scope of the articles as originally filed. Accordingly, the amendment does not fall under an amendment to change the gist of the design.

[Case example]

An amendment to correct the statement “Ogino Style Manual Knitting Machine” in the column “Article Embodying the Design” as originally filed into “Manual Knitting Machine”

does not fall under an amendment to change the gist of the design.

**(2) Amendment made to the statement containing a generic name into that containing a name whose usage and function of the article, etc. embodying the design are clear**

In this case, if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, any usage or function of the article, etc. embodying the design cannot be inevitably derived, an amendment for correction to make clearer the usage and function of the article, etc. embodying the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If a statement contains a generic name, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the usage and function of the article, etc. embodying the design can be inevitably derived, the amendment to correct the generic name into the name whose usage and function of the article, etc. embodying the design are clear does not fall under an amendment to change the gist of the design.

**[Case example 1]**

If a “lighting apparatus” is stated in the column “Article Embodying the Design” in the application as originally filed and a sentence to the effect that “this article is a lighting apparatus which not only can be used as an electric desk lamp on a tabletop, but also can be held in the hand outdoors, e.g., at a camping site” is stated in the column “Description of the Article Embodying the Design” in the application and also if a fact that the article embodying the design has the usage and function of a flashlight can be inevitably derived by making a comprehensive determination based on the statement in the drawings, then an amendment to correct the statement in the column “Article Embodying the Design” into a “flashlight” does not fall under an amendment to change the gist of the design.

**[Case example 2]**

If “furniture” is stated in the column “Article Embodying the Design” in the application as originally filed, but if, by making a comprehensive determination based on the statement of the application and the drawings, etc. attached to the application, the name “chairs,” which indicates a clear usage and function of the article, etc. embodying the design, can be inevitably derived, then an amendment to correct the statement in the column “Article Embodying the Design” to “chairs” does not fall under an amendment to change the gist of the design.

(Court decision for reference)

1991 (Gyo-ke) 274, "Protection Plate for Miniature Bearing"; Date of the decision: September 30, 1992

(The preceding sentences are omitted.) The present amendment does not change the drawings depicting the design per se but corrects the statements in the columns "Article Embodying the Design" and "Description of the Article Embodying the Design," restricts the subject matter of design protection to the "protection plates for miniature bearings" which were encompassed by the "protection plates for bearings" in the application as originally filed and defines the size of the plates as those described above. Accordingly, it is obvious that the amendment does not fall under an amendment to change the gist of the design. (The following sentences are omitted.)

(Trial decision for reference)

Trial against examiner's ruling dismissing an amendment No. 1989-50023, "Tool for Road Hazard Sign"; Date of the trial decision: September 28, 1989

(The preceding sentences are omitted.) In the written amendment of procedures, a statement in the Article Embodying the Design was amended from "tool for a road hazard sign" in the application as originally filed to "socket as a tool for a road hazard sign." Concerning this point, the name "socket" was not mentioned in any statement in the application or in the drawings attached to the application as originally filed. However, when the configuration shown in the drawings (including the reference drawings) is comprehensively observed, it is clearly found that the constitution of the design represents that of a "socket." Moreover, it is found from the statement of the article embodying the design, i.e., "road hazard sign," in the application or from the perspective view of the socket in use with the cover attached, which is shown as a reference drawing among the drawings, that the "socket" is used for the purpose of indicating a road hazard sign, and also found that the statement specifically describes the method and state of use of the socket. Therefore, it is reasonable to assume that the aforementioned amendment is proper, while it is not reasonable to assume that there has been a change of the gist merely because of a difference in the statement of the article embodying the design. (The following sentences are omitted.)

### **(3) Amendment to specify one design when two or more articles, etc. embodying designs are stated together in the column "Article Embodying the Design"**

If an application states two or more articles, etc. embodying designs together in the column "Article Embodying the Design," it is not considered as an application filed for a single design.

In this case, if an application for design registration found to contain two or more designs is divided to provide a new application for a single design, the following amendment does not fall under an amendment to change the gist of the design, namely an amendment in which: the design contained in the new application for design registration resulting from the division is removed from the original application and then the statement in the column "Article Embodying the Design" of the original application is corrected to provide an article, etc. embodying the design, which is the article remaining after the removal.

In addition, the following amendment to an application for design registration which is

found to contain two or more designs does not fall under an amendment to change the gist of the design either, namely an amendment in which: by removing some part of the designs in the application for design registration without undertaking division, the statement in the column “Article Embodying the Design” of the application is corrected to provide an article, etc. embodying the design, which is the article remaining after the removal.

If an application states two or more articles, etc. embodying designs together in the column “Article Embodying the Design,” but if, by making a comprehensive determination based on the statement of the application and the drawings, etc. attached to the application, a fact that the application for design registration involves one article, etc. of the two or more articles, etc. can be inevitably derived, then an amendment to correct the statement to specify the article, etc. does not fall under an amendment to change the gist of the design.

[Case example]

If an application as originally filed states “desk, chair, bookshelf” in the column “Article Embodying the Design” of the application, but the drawing attached to the application depicts “desk” alone, an amendment which corrects the statement in the column “Article Embodying the Design” into “desk” does not fall under an amendment to change the gist of the design.

## **2. Handling of an amendment made to the statement in the column “Description of the Article Embodying the Design”**

### **2.1 Principles in handling**

If the purpose of use, state of use, etc. of an article, building, graphic image or interior does not become clear only from the statement in the column “Article Embodying the Design,” an applicant should provide in the column “Description of the Article Embodying the Design” of the application a description which could aid in understanding of the article, building, graphic image or interior, including the purpose of use, state of use, etc. of the article, building, or graphic image pursuant to the provisions of Form No. 2, Notes (39) and (45) of the Regulation for Enforcement of the Design Act.

A determination on whether or not an amendment made to the statement in the column “Description of the Article Embodying the Design” of the application changes the gist of the design should be made based on: whether or not the amendment made to the statement in the column changes the gist of the design as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application; or whether or not the amendment clarifies the gist of the design which was unclear when originally filed.

## 2.2 Specific handling

### **(1) Amendment in which the unclear usage and function of the article, etc. embodying the design is corrected to add a description to aid in understanding of the usage and function**

In a case where: the usage and function of the article, etc. embodying the design stated in the column “Article Embodying the Design” of the application are unclear; no description is provided to aid in understanding of the usage and function; and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design are still unclear, then an amendment to supplement with a description which could aid in understanding of the purpose of use, state of use, etc. of the article, etc. embodying the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

In a case where: the usage and function of the article, etc. embodying the design stated in the column “Article Embodying the Design” of the application are unclear; and no description which could aid in understanding of the usage and function is provided; but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design can be inevitably derived, then if an amendment is made, within the scope of the derivation, to supplement the column “Description of the Article Embodying the Design” of the application with a description which could aid in understanding of the purpose of use, state of use, etc. of the article, etc. embodying the design, the amendment does not fall under an amendment to change the gist of the design.

### **(2) Amendment in which the clear usage and function of the article, etc. embodying the design is corrected to add a description which could aid in understanding of the usage and function**

In a case where: the usage and function of the article, etc. embodying the design stated in the column “Article Embodying the Design” of the application are clear; a description which could aid in understanding of the article, etc. embodying the design is also stated in the application; but the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design, which can be inevitably derived from the article, etc. embodying the design stated in the column “Article Embodying the Design” of the application, do not correspond to the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design stated in the column “Description of the Article Embodying the Design” of the application; and thus, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it is difficult to inevitably derive which

statement is correct, then if an amendment is made to specify one article, etc. among those which could be specified in the column “Article Embodying the Design” of the application as originally filed and in the column “Description of the Article Embodying the Design” of the application, the amendment intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

In a case where: the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design, which can be inevitably derived from the article, etc. embodying the design stated in the column “Article Embodying the Design” of the application, do not correspond to the usage and function based on the purpose of use, state of use, etc. of the article, etc. embodying the design stated in the column “Description of the Article Embodying the Design” of the application; but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, the purpose of use, state of use, etc. of the article, etc. embodying the design can be inevitably derived, then if an amendment is made, within the scope of the derivation, to correct or supplement the statement in the column “Article Embodying the Design” or the column “Description of the Article Embodying the Design” of the application, the amendment does not fall under an amendment to change the gist of the design.

[Case example]

In a case where no drawings attached to the application as originally filed show the expansion-contraction state of the article, but a fact that the “article has an expansion-contraction function” can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, if an amendment is made to supplement the column “Description of the Article Embodying the Design” with a statement to the effect that “this XX vertically expands and contracts,” the amendment does not fall under an amendment to change the gist of the design.

(Court decision for reference)

1992 (Gyo-Ke) 227 (Litigation seeking rescission of the trial or appeal decision), “Rotating Warning Light”;  
Date of the decision: July 15, 1993

(The preceding sentences are omitted.) In the application for the present design as originally filed, the column “Description of the Article Embodying the Design” states that “(Some sentences are omitted.) the layered rotating lights in which lights are stacked in a sequential order to form a tower, [each of the lights is] covered by a cube-shaped globe-case and [the tower of the lights is] fixed by a top panel,” and the column “Description of the Design” states that “the globe cases are colored or colorless transparent.” Later, amendments were made to change the column “Description of the Article Embodying the Design” to “(Some sentences are omitted.) the light rotates and issues warning according to the colors of the layers in the tower”

and the column “Description of the Design” to “the globe cases in each layer have transparent colors, respectively.” These amendments change the important elements of the present design and fail to keep the identicalness of the nature in the design before and after the amendments. Therefore, it should be said that the amendments fall under an amendment to change the gist of the design. (The following sentences are omitted.)

### **3. Handling of an amendment made to the statement in the column “Description of the Design”**

#### **3.1 Principles in handling**

A determination on whether or not an amendment made to the statement in the column “Description of the Design” of the application changes the gist of the statement in the application should be made based on: whether or not the amendment made to the statement in the column changes the gist of the design as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application; or whether or not the amendment clarifies the gist of the design which was unclear when originally filed.

#### **3.2 Specific handling**

##### **(1) Amendment made to the statement of the material or size of the article or building embodying the design**

If there is no statement of the material or size of the article or building embodying the design, and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no specific design can be inevitably derived due to the unclear material or size of the article or building embodying the design, then an amendment to supplement with a statement of the material or size to specify the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement of the material or size of the article or building embodying the design, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the material or size of the article or building can be inevitably derived, then an amendment to supplement with a statement of the material or size within the scope of the derivation does not fall under an amendment to change the gist of the design.

##### **(2) Amendment made to the statement to the effect that the shape, etc. of the article, building or graphic image embodying the design changes due to the way the article, etc. functions**



If there is no statement to the effect that the shape, etc. of the article, building or graphic image embodying the design changes due to the way the article, etc. functions, and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no fact that the shape, etc. of the design changes can be inevitably derived, then an amendment to supplement with: a statement to the effect that the applicant seeks to have a design registration made for the shape, etc. of the article, building or graphic image as it appears before, during, and after that change; or a statement to describe the function of the article, building or graphic image changes the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement to the effect that the shape, etc. of the article, building or graphic image embodying the design changes due to the way the article, building or graphic image functions, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a fact that the shape, etc. of the design changes can be inevitably derived, then an amendment, within the scope of the derivation, to supplement with: a statement to the effect that the applicant seeks to have a design registration made for the shape, etc. of the article, building or graphic image as it appears before, during, and after that change; or a statement to describe the function of the article, building or graphic image does not fall under an amendment to change the gist of the design.

(Court decision for reference)

1980 (Gyo-ke) 349, "Chair"; Date of the decision: June 17, 1981

(The preceding sentences are omitted.) The plaintiff alleges that it is incorrect to find that these chairs for the two designs in Appendix 1 and Appendix 2 have an embodiment in which the legs of the chairs are vertically adjustable because there is no statement, in either of the applications, to the effect that the legs move vertically in an expanding and contracting manner. Meanwhile, the provisions of Article 6, paragraph (5) of the Design Act (Some sentences are omitted.) do not stipulate so far as to say that: if the shape, etc. of an article embodying a design changes due to the way the article functions and the applicant seeks to have a design registration made for the shape, etc. of the article as it appears before, during, and after that change, then the applicant must state this or give an explanation of that function of the article in the application to the last detail, whatever the degree and details of the change. Rather, it is reasonable to understand the purpose of the provisions as that if the applicant considers such statement unnecessary, for example, if such change is well detailed to the degree that the function or the shape, etc. of the article as it appears before, during, and after such change is clearly recognizable based on the drawings themselves attached to the application, then omitting any statement of such change from the application should not be rejected. (The following sentences are omitted.)

**(3) Amendment made to the statement to the effect that application of color black or white is omitted in a case where colors of the design are applied to the drawing, etc.**

In a case where colors of the design are applied to the drawing, etc., if the application of either color black or white to the drawing, etc. is omitted in the part which affects a determination on the gist of the design and if there is no statement to the effect that the application of one of the colors, black or white, to the drawing, etc. is omitted and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it cannot be inevitably derived whether the part to which no color is applied is painted in white or black, then an amendment to supplement with a statement to the effect that the application of one of the colors is omitted (e.g., “the non-colored part is in white,” etc.) intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

In a case where colors of the design are applied to the drawing, etc., if the application of either color black or white to the drawing, etc. is omitted in a minor part which does not affect a determination on the gist of the design and if there is no statement to the effect that the application of one of the colors to the drawing, etc. is omitted, the color of the part is unknown, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a specific design which the creator of the design intends can be inevitably derived, then, based on this, an amendment to supplement with a statement to the effect that the application of one of the colors is omitted in the minor part does not fall under an amendment to change the gist of the design.

In a case where the drawings to which colors of the design are applied are prepared by copying, if white color is not applied and there is no statement to the effect that the application of either color black or white to the drawing, etc. is omitted, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a fact that the uncolored part is in white can be inevitably derived, then an amendment to supplement with a statement to the effect that the application of white color is omitted does not fall under an amendment to change the gist of the design.

**(4) Amendment made to the statement to the effect that the whole or part of the article, building or graphic image embodying the design is transparent**

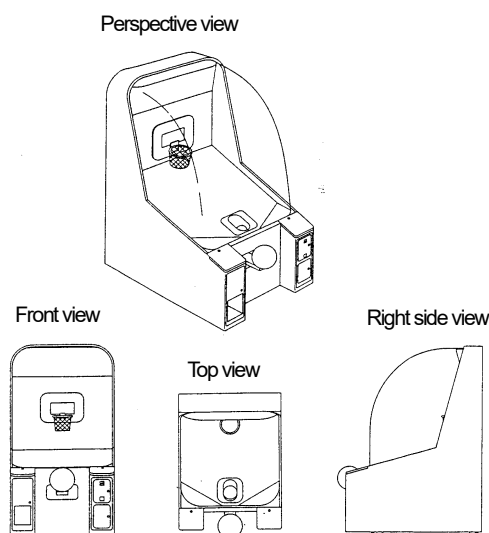
If there is no statement to the effect that the whole or part of the article, building or graphic image embodying the design is transparent and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no fact that the whole or part of the article,

building or graphic image embodying the design is transparent can be inevitably derived, then an amendment to supplement with a statement to the effect that the whole or part of the article, building or graphic image is transparent changes the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement to the effect that the whole or part of the article, building or graphic image embodying the design is transparent, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a fact that the whole or part of the article, building or graphic image is transparent can be inevitably derived, then an amendment, within the scope of the derivation, to supplement with a statement to the effect that it is transparent does not fall under an amendment to change the gist of the design.

[Case example] “Gaming machine”

If there is no statement to the effect that “[I]n the front view, the lid covering the basket at the upper part of the surface is transparent” in the column “Description of the Design” of the application as originally filed, but if, by making a comprehensive determination based on the manner of expression in the drawings, the perspective view, etc., it is found that the part is transparent can be inevitably derived, then an amendment to supplement with a statement to the effect that the lid is transparent does not fall under an amendment to change the gist of the design.



**(5) Amendment made to the statement to the effect that drawings are omitted** (Note 8)

A part of the design which is not disclosed in the application or the drawings, etc. attached to the application as originally filed is treated as a part other than that for which the design registration is sought for the design. Accordingly, concerning the drawings which have not been submitted in the application as originally filed, if, even by making a comprehensive determination based on the statement in the application and other drawings, etc. attached to the application, an amendment to add any statement, such as “the right side view is omitted because it is a symmetrical view to the left side view,” is found to be an amendment to change the scope of the part for which the design registration is sought for the design, the amendment falls under an amendment to change the gist of the design.

(Note 8)

Form No. 6, Notes (8) to (10) of the Regulation for Enforcement of the Design Act

**(6) Amendment made to the statement required in a case where drawings show articles, etc. with a continuous shape or a textile in which a pattern repeats continuously and only the allowable part of such articles, etc. is prepared**

In a case where the drawings show articles, etc. with a continuous shape or a textile in which a pattern repeats continuously, if there is no statement to the effect that the articles, etc. provide a continuous shape, and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no fact that there is a continuous shape or a textile in which a pattern repeats continuously can be inevitably derived, then an amendment to supplement with a statement to the effect of the continuous shape changes the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design. Accordingly, the amendment falls under an amendment to change the gist of the design.

In a case where the drawings show articles, etc. with a continuous shape or a textile in which a pattern repeats continuously, if there is no statement to the effect that the articles, etc. provide a continuous shape, but if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a fact that there is a continuous shape or a textile in which a pattern repeats continuously can be inevitably derived, then an amendment to supplement with a statement to the effect that the articles, etc. provide a continuous shape does not fall under an amendment to change the gist of the design.

**(7) Amendment made to the statement to the effect that some part of the article, building or graphic image is omitted or to the statement of the dimensions in the drawings as for the omitted part**

If there is no statement to the effect that some part of the article, building or graphic image is omitted or no statement of the dimensions in the drawings as for the omitted part, and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the dimensions in the drawings as for the omitted part cannot be inevitably derived, then an amendment to supplement with a statement of the dimensions in the drawings as for the omitted part intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement to the effect that some part of the article, building or graphic image is omitted or no statement of the dimensions in the drawings as for the omitted part, but if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the dimensions in the drawings as for the omitted part can be inevitably derived, then an amendment to supplement with a statement to the effect that some part of the article, building or graphic image is omitted or a statement of the dimensions in the drawings as for the omitted part does not fall under an amendment to change the gist of the design.

**(8) Amendment made to the statement of the way of specifying the shape of the design in a case where a line, dot or any other mark for specifying the shape of the design is indicated in the drawings**

If there is no statement to the effect that a line, dot or any other mark in the drawings specifies the shape of the design and this causes inconsistency between the drawings, and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no specific design can be inevitably derived, then an amendment to supplement with a statement to the effect that a line, dot or any other mark in the drawings aims to specify the shape of the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement for describing the way of specifying the shape of the design and this causes inconsistency between the drawings, but if a shape or pattern of the design with no inconsistency can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached

to the application or if the part indicating the line, dot, etc. is a minor part which does not affect a determination on a gist of the design, then an amendment to supplement with a statement of the way of specifying the shape of the design does not fall under an amendment to change the gist of the design.

**(9) Amendment made to the statement of the distinction of a cabinet drawing or cavalier drawing or the inclination angle thereof**

If there is no statement of the distinction of a cabinet drawing or cavalier drawing or the inclination angle thereof and this causes inconsistency between the drawings as a result of being treated as those prepared by the isometric projection method, and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no specific design can be inevitably derived, then an amendment to supplement with a statement of the distinction of the cabinet drawing or cavalier drawing or the inclination angle thereof to specify the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If there is no statement of the distinction of a cabinet drawing or cavalier drawing or the inclination angle thereof, but if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the distinction of the cabinet drawing or cavalier drawing or the inclination angle thereof can be inevitably derived, then an amendment to supplement with a statement of the distinction of the cabinet drawing or cavalier drawing or the inclination angle thereof does not fall under an amendment to change the gist of the design.

## **II. Specific handling of an amendment made to the “drawings, etc. attached to the application”**

### **1. Principles in handling**

A determination on whether or not an amendment made to the drawings, etc. attached to the application changes the gist of the drawings, etc. attached to the application should be made based on: whether or not the amendment changes the gist of the design as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application; whether or not the amendment clarifies the gist of the design which was unclear when originally filed; or whether or not the amendment intends to change the scope of the part for which the design registration is sought between the design after the amendment and that originally filed.

### **2. Specific handling**

#### **(1) Amendment to change the drawing method showing a three-dimensional shape (orthographic projection method, isometric projection method and oblique projection method)**

If an amendment is made to change the drawing method showing a three-dimensional shape in the application as originally filed to that showing another three-dimensional shape and this causes changes in the specific shapes, etc., and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it is found that the amendment changes the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design, then the amendment falls under an amendment to change the gist of the design.

If an amendment is made to change the drawing method showing a three-dimensional shape in the application as originally filed to that showing another three-dimensional shape, but if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it is found that the specific shape, etc. falls within the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design, then the amendment does not fall under an amendment to change the gist of the design.

Moreover, the same approach to determination is applied to any case where an amendment is made from one to the other among the drawing methods mentioned above.

**(2) Amendment in which two or more designs contained in an application are sorted into one specific design**

If an application for design registration which is found to show two or more articles, buildings or graphic images in the drawings, etc. and to contain two or more designs is divided to provide a new application for a single design, an amendment in which the drawing showing the design contained in the new application for design registration resulting from the division is removed from the original application does not fall under an amendment to change the gist of the design.

**(3) Amendment to state or remove a line, dot or any other mark for specifying the shape of the design**

**[i] Amendment to state a line, dot or any other mark for specifying the shape of the design**

In a case where there is a drawing from which no specific shape of the design can be inevitably derived even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, if an amendment is made to state a line, dot or any other mark for specifying the shape of the design and thereby to specify the shape of the design, it intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

If any specific shape of the design can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, an amendment made to state a line, dot or any other mark for specifying the shape of the design within the scope of the derivation does not fall under an amendment to change the gist of the design.

**[ii] Amendment to remove a line, dot or any other mark for specifying the shape of the design**

In a case where: there is a drawing stating a line, dot or other mark for specifying the shape of the design; and, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, any specific shape of the design can be inevitably derived from the drawing, if an amendment to remove the line, dot or other mark for specifying the shape disallows inevitably deriving the specific shape of the design even by making a comprehensive



determination based on the statement in the application and the drawings, etc. attached to the application, then the amendment to remove it intends to change the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design. Accordingly, the amendment falls under an amendment to change the gist of the design.

In a case where: there is a drawing stating a line, dot or other mark for specifying the shape of the design; and, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, any specific shape of the design can be inevitably derived from the drawing, if, even after removing a line, dot or any other mark for specifying the shape of the design, the shape of the design lying within the scope identical to the scope of the derivation can be inevitably derived, the amendment does not fall under an amendment to change the gist of the design.

**(4) Amendment to change “the drawing attached to the application” as originally filed to a photograph, model or specimen**

If an amendment is made to change the drawing attached to the application as originally filed to, for example, a photograph, and this causes changes in the specific shapes, etc., and if, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it is found that the amendment changes the gist of the design in the application as originally filed beyond the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design, then the amendment falls under an amendment to change the gist of the design.

If an amendment is made to change the drawing attached to the application as originally filed to, for example, a photograph, but if, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application as originally filed, it is found that the shape, etc. represented by the photograph falls within the scope which is identical to the scope which can be inevitably derived from the ordinary skill in the art of the design, then the amendment does not fall under an amendment to change the gist of the design.

Moreover, the same approach to determination is applied to any case where an amendment is made from one to the other among drawings, photographs, models or specimens, not limited to the photograph mentioned above.

**(5) Amendment made to the drawing, etc. having an improper description in a part that is minor enough to not affect the finding of the gist of the design**

If there is an improper description in a part that is minor enough to not affect the finding of the gist of the design, even if no amendment is made to the description as it is, the specific contents of the design filed as an aesthetic creation can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application. Accordingly, an amendment made to correct such error or other ambiguous description does not fall under an amendment to change the gist of the design.

**(6) Amendment made to the drawing, etc. having an improper description in a part that affects the finding of the gist of the design**

An amendment made to the drawing, etc. having an improper description, e.g., an error or an ambiguous description, in a “part that affects the finding of the gist of the design” is treated as below depending on whether or not the shape, etc. with no improper description can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application.

**[i] Concerning the “part that affects the finding of the gist of the design,” if a shape, etc. with no improper description cannot be inevitably derived even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, an amendment to correct the drawing, etc. to that with no improper description about the part intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.**

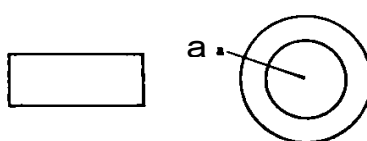
[Case example 1] “Design which changes due to the way the article, etc. functions”(design which has movable elements)

If there is a design which changes the shape, etc. of the article and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, the specific shape, etc. of the article as it appears before, during, and after that change cannot be inevitably derived, then an amendment to supplement with a drawing, etc. which represents

the state before, during, and after the change of the design intends to clarify the gist of the design which was unclear when originally filed. Accordingly, the amendment falls under an amendment to change the gist of the design.

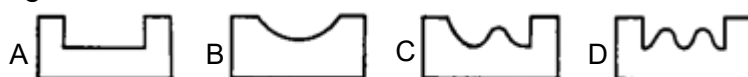
[Case example 2] “Ashtray”

Case where the attached drawings of an ashtray, which are six drawings filed, provide no sectional view and a statement “the ash-receiving pit (a) at the center is recessed” is described in the column “Description of the Design” of the application



The recessed part of the article “ashtray” is a part that affects the finding of the gist of the design. Moreover, even by making a comprehensive determination based on the drawings above and the statement in the column “Description of the Design” of the application, the ash-receiving pit may take any shape from A to D of the following drawings, no specific shape can be inevitably derived, and thus the gist of the design is unclear.

Accordingly, an amendment to specify the shape of the recessed part is found to be an amendment to clarify the gist of the design which was unclear when originally filed, and therefore the amendment falls under an amendment to change the gist of the design.

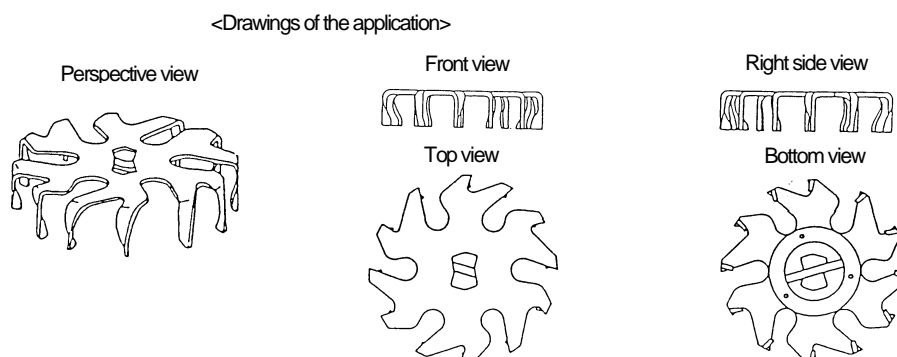


[Case example 3] “Cutter head for electric razor”

The cutter head part of this type of article is a part that affects the finding of the gist of the design. Moreover, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no specific shape of the cutter head part can be inevitably derived, and thus the gist of the design in the application as originally filed is unclear.

Accordingly, an amendment to specify the shape of the cutter head part is found to be an amendment to clarify the gist of the design which was unclear when

originally filed, and therefore the amendment falls under an amendment to change the gist of the design.



Description of the Design: The rear view and the front view, and the left side view and the right side view are symmetrically represented, respectively.

(Court decision for reference)

1981 (Gyo-ke) 279 (Court decision); Date of the decision: May 28, 1987

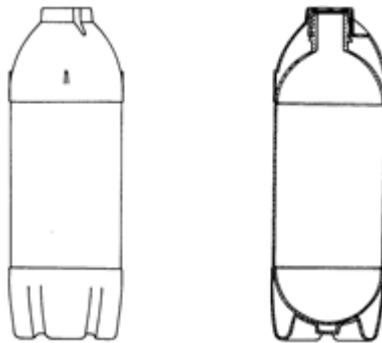
(The preceding sentences are omitted.) The present registered design exhibits inconsistency not only between the Description of the Design and the drawings but also between the drawings. Moreover, as these differences are not those which are found to be apparent errors, the design in the application cannot be said to be a design which is completely specified only by the drawings (Some sentences are omitted). Furthermore, even by taking into full consideration the reference perspective view, the design in the application cannot be specified. (Some sentences are omitted.) Also, the shape of the end of the two-branch arm can be said to be an important part which is an element composing the present registered design, and consequently, the design which fails to show specificity of the part (Some sentences are omitted.) cannot be said to be that falling under a design that is industrially applicable, which is referred to in the main sentence of Article 3, paragraph (1) of the Design Act. (The following sentences are omitted.)

[Case example 4] “Container for packing” (no sectional view provided at the time of filing)

The shape of the extraction opening provided inside the lid at the top of the container, which is a shape affecting the finding of the gist of the design, is not clear only from the drawings in the application as originally filed, and, even by making a comprehensive

determination based on the statement in the application and the drawings, etc. attached to the application, no specific shape of the extraction opening can be inevitably derived, and thus the gist of the design in the application as originally filed is unclear.

Accordingly, an amendment to supplement, etc. with a sectional view to clarify the shape of the extraction opening provided inside the lid at the top of the container is found to be an amendment to clarify the gist of the design which was unclear when originally filed, and therefore the amendment falls under an amendment to change the gist of the design.



**[ii] Concerning the “part that affects the finding of the gist of the Design,” if a shape, etc. with no improper description can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, an amendment to correct the drawing, etc. into that with no improper description about the part does not fall under an amendment to change the gist of the design.**

[Case example 1] Case where an amendment is made by supplement with a drawing

In a case where a set of drawings has not been submitted in full, if there is no statement to the effect that the missing drawing is omitted, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a figure represented by the missing drawing can be inevitably derived, an amendment to supplement with the missing drawing does not fall under an amendment to change the gist of the design.

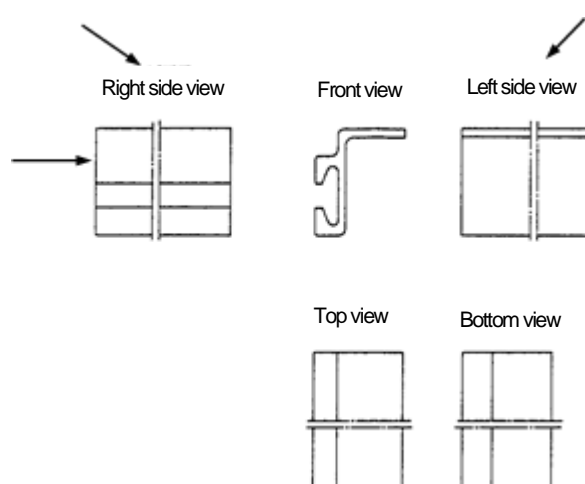
[Case example 2] “Design which changes due to the way the article, etc. functions”  
(design which has movable elements)

If there is a statement in the column “Description of the Design” of the application to the effect that the design changes due to the way the article functions and if there is no specific embodiment of the change in the drawings, etc. but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a specific embodiment of the change in the shape, etc. of the article can be inevitably derived, then an amendment, within the scope of the derivation, to supplement with a drawing, etc. which could aid in understanding of the state of the design as it appears before, during, and after that change does not fall under an amendment to change the gist of the design.

[Case example 3] “Structural component for passenger vehicle”

There are some improper descriptions in the indications shown by the drawings of the right side view and left side view and in the parts to which arrows point about these side views, but it is found that a specific shape with no improper description can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application.

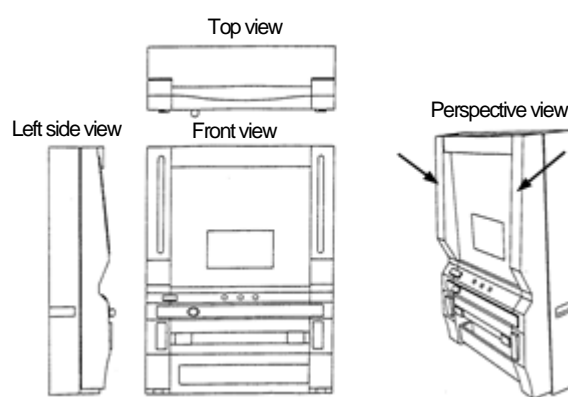
Accordingly, an amendment to correct the improper descriptions to provide the drawings with no such description does not fall under an amendment to change the gist of the design.



[Case example 4] “Electronic gaming machine”

There are some inconsistencies or mismatches recognized in the parts to which arrows point, but it is found that a specific shape with no improper description can be inevitably derived by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application.

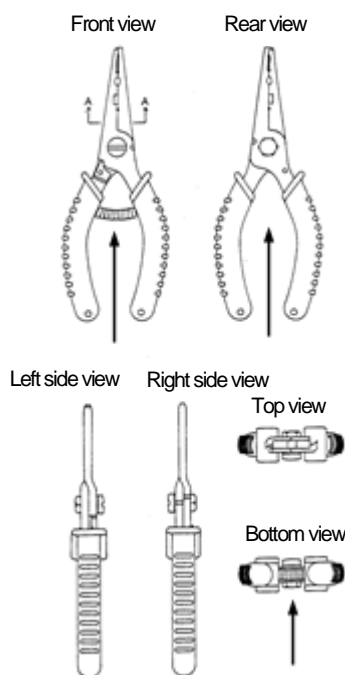
Accordingly, an amendment to correct the improper descriptions to provide the drawings with no such description does not fall under an amendment to change the gist of the design.



[Case example 5] “Fishing pliers”

A spring part is shown in the front view and bottom view, while no such spring is shown in the rear view, which leads to a finding of mismatches in the shapes between the drawings. However, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, it is found that these mismatches are errors that occurred during the preparation of the drawings and, therefore, that a specific shape with no improper description can be inevitably derived.

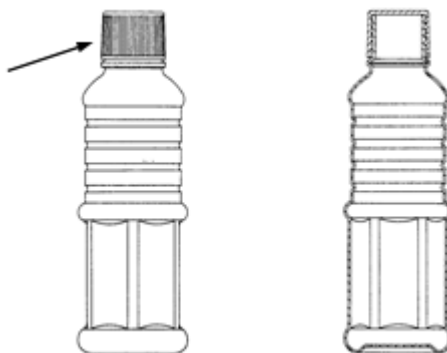
Accordingly, an amendment to correct the improper descriptions to provide the rear view with no such description by putting a spring part to the rear view does not fall under an amendment to change the gist of the design.



[Case example 6] “Bottle for packing” (no sectional view provided at the time of filing)

Concerning the present bottle for packing, the shape of the extraction opening, which is recognized to be a part that affects the finding of the gist of the design, is not clear from the drawings in the application as originally filed, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a fact that the shape is that shown in the sectional view filed at a later date can be inevitably derived.

Accordingly, an amendment to supplement with a sectional view to specify the shape of the extraction opening does not fall under an amendment to change the gist of the design.





[Case example 7] “Tissue box holder”

There are some differences in scale between the drawings, but, by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, a specific shape with no improper description can be inevitably derived.

Accordingly, an amendment to correct the differences to provide the drawings in the same scale does not fall under an amendment to change the gist of the design.

Top view



Front view



Bottom view

