

## 42. 02

### **Handling of a design that was contained in a distributed publication or design that was made publicly available through a telecommunications line**

Article 3, paragraph (1), item (ii) of the Design Act stipulates to the effect that a design that was contained in a distributed publication or a design that was made publicly available through a telecommunications line in Japan or a foreign country, prior to the filing of the application for design registration, lacks novelty.

#### 1. Design that was contained in a publication

The examiner may use a design that was contained in a publication as information that serves as the basis for determining the novelty of a design in an application for design registration —provided that the design that was contained in a publication is sufficiently represented to a comparable level— when the examiner determines whether or not the design in an application for design registration corresponds to the design that was contained in a publication or whether or not it corresponds to any design similar to the design that was contained in a publication.

#### (1) Examples of designs allowable as information that serves as the basis for determination of novelty

- [i] Even if a design that was contained in a publication does not show the back, bottom or other parts of its shape, etc. because of the indication by a so-called perspective view or even if any part of the design contained in a publication is not shown, if the design in a publication helps the examiner presume the specific shape of the unseen part, etc. of the design, the design in a publication should be treated as information that serves as the basis for determination on novelty, based on the ground that the entire shape, etc. of the design in a publication is largely defined by the characteristics, etc. of an article, etc.
- [ii] Not only a design for the article, etc. that was contained in a publication, but also another design for an article, etc. which is contained in the article, etc. described in a publication but is not similar to the article (e.g., a design for a component of the article, etc. described in a publication) should be treated as information that serves as the basis for determination of novelty if the specific shape, etc. of the design itself can be identified.

[iii] A design for which registration is sought for a part of an article, etc., published in a Registered Design Bulletin should be treated as information that serves as the basis for determination of novelty if the specific shape, etc. of the article, etc. embodying the design can be identified in “any other part” of the design other than the “part for which the design registration is sought” of the design.

## 2. Design posted on the internet as electronic design information

As is the case with the design that was contained in a publication, the examiner may also use a design posted on the internet as electronic design information as information that serves as the basis for determining novelty of a design in an application for design registration — provided that the design posted on the internet is sufficiently represented to a comparable level— when the examiner determines whether or not the design in an application for design registration corresponds to the design posted on the internet or whether or not it corresponds to any design similar to the posted design (see Item 1 “Design that was contained in a publication” above).

## 3. Examples of approaches to determining whether or not a design posted on webpages, etc. was made available to the public

### (1) Examples of designs that were made available to the public

[i] A design which is registered in a search engine and is searchable or a design in which the existence and location of the information thereon are available to the public (e.g., a linked design by a relevant academic organization, news, etc., or a design whose address is posted in newspapers, magazines or other means for public information distribution);

[ii] A design posted on a webpage, etc. whose existence and location are made available to the public in which a password is required to view the design but the design can be accessed by unspecified persons just by inputting the password (in this case, regardless of whether there is a charge for obtaining the password, the design can be said to be available to the public if anyone can obtain the password and access the design posted on a webpage, etc. without exception just by taking certain procedures); and

[iii] A design posted on a webpage, etc. whose existence and location are made available to the public in which a charge is required to view the webpage, etc. but the design can be accessed by unspecified persons just by paying the charge (in this case, the design can be said to be available to the public if anyone can access the design posted on a webpage, etc. without exception just by paying the charge).

### (2) Examples of designs that are difficult to say that they were made available to the public

Designs falling under the following cases cannot be said to be those available to the public even if they are posted on a webpage, etc.

[i] A design posted on the internet, etc. which the public cannot access except by chance

because of no disclosure of its address;

- [ii] A design in which access to the information thereon is restricted to the members, etc. of a specific organization or company and the information is treated as confidential (e.g., an internal system, etc. available only to employees);
- [iii] A design in which the content of the information thereon is encrypted in such a way that it cannot normally be decrypted (except in the cases where any tool for decryption of the encryption is available to anyone by any means, regardless of a charged or free-of-charge tool); and
- [iv] A design which has not been published for long enough for the public to see the information thereon (e.g., a design which has been published on the internet just for a short period of time).

4. Handling of a case where there is only slight doubt that a design posted on a webpage, etc. might have been modified and a case where there is doubt that such design might have been modified

Since a design posted on a webpage, etc. can be easily modified, the examiner would doubt whether or not the design posted on a webpage, etc., which the examiner intends to cite, is the same as the one which was posted on the post date indicated on the webpage, etc. The examiner should treat such cases according to the following approaches: Approach (1) in a case where there is only slight doubt that such modification might have occurred or Approach (2) in a case where there is doubt that such modification might have occurred.

(1) Case where there is only slight doubt that the design posted on a webpage, etc., which the examiner intends to cite, is the same as that which was posted on the post date indicated on the webpage, etc.

There is normally only slight doubt about the webpages, etc. shown in [i] to [vi] below being modified. Regarding these webpages, etc., the examiner should infer that the content which was posted at the time when the examiner accessed the webpage, etc. is the same as that which was posted on the post date indicated on the webpage, etc.

- [i] Webpages run by publishers issuing publications, etc. for a long period of time
- [ii] Webpages run by academic institutes (e.g., academic societies, universities)
- [iii] Webpages run by international organizations (e.g., standardization organizations)
- [iv] Webpages run by public organizations (e.g., ministries and agencies)

(2) Case where there is doubt that the design posted on a webpage, etc., which the examiner intends to cite, is the same as that which was posted on the post date indicated on the webpage, etc.

For example, a case where an invention which the examiner intends cite is posted on a personal webpage, etc. and the webpage, etc. contains a list of information which is obviously

different from the facts falls under this Item (2). In this case, the examiner should contact the contact counter, etc. indicated on the webpage, etc. to confirm the modification of the webpage, etc. and should consider the doubtfulness. If the examiner clears the doubt as a result of the consideration, he/she may cite the design posted on the webpage, etc. If the examiner does not clear it, he/she should not cite the design. Moreover, if the examiner does not make sure of such contact counter, he/she should not cite the design.