

## 44.05

### **Application of the provisions of Article 9 and Article 10, paragraph (1) of the Design Act to two or more applications for design registration filed by the same applicant on the same date**

<Principles in handling>

#### (1) Targets of the discussions

- [i] Applications for design registration which have been filed for identical or similar designs on the same date should be subject to discussions under the provisions of Article 9, paragraph (2) of the Design Act, regardless of whether the applicants are the same person or different persons.
- [ii] In addition, in a case where applications for design registration for similar designs filed on the same date are filed by the same person, if the applications are filed as those having a relationship between the principal design and its related designs or that between the fundamental design (Note 1) and its related design and a further-removed related design which is linked to the related design (the expression “a related design of the fundamental design and a further-removed related design which is linked to the related design” is hereinafter referred to as the “related designs associated with the fundamental design.”), and if the relationship is established (Note 2), these applications should not be subject to such discussions, notwithstanding the provisions of Article 9, paragraph (2) of the Design Act.

(Note 1) The “fundamental design” refers to a design which the applicant has first selected as a principal design. In other words, it is a “principal design” which is not a related design of any other design.

(Note 2) The “related design” must be a design similar to that selected as a principal design.

#### (2) Concerning such applications subject to discussions, if one of the applications is selected at the discussions, a decision of registration should be made for the application. Moreover, if an amendment is made to the applications to supplement the relationship between a principal design and its related designs or that between a fundamental design and the related designs associated with the fundamental design and the relationship is established (Note), a decision of registration should also be made for the applications.

(Note) The “related design” must be a design similar to that selected as a principal design.

#### (3) Failure to reach an agreement at the discussions

- [i] If no notification is made within the specified period, it should be deemed that no

agreement has been reached at the discussions (Design Act 9(5)).

- [ii] If any inconsistencies are found in the details of the notification of the discussions or if the procedures (e.g., for amendment or withdrawal) which correspond to the details of the notification are not completed (Note) even with no inconsistencies found in the details, it should be deemed that the discussions have failed to reach an agreement.

(Note) In such cases where:

- No withdrawal is made of the designs which have not been selected;
- There are multiple designs having a relationship in which one design designates the other as a principal design and vice versa and it is impossible to define a fundamental design; etc.

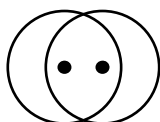
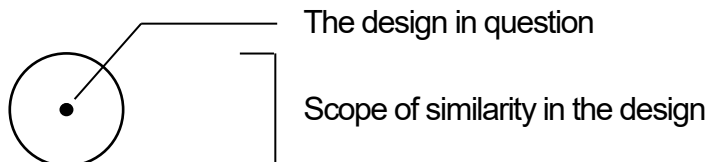
#### (4) Decision

- [i] If a relationship between a principal design and its related designs or that between a fundamental design and the related designs associated with the fundamental design is established and if no other reasons for rejection are found for these designs, a decision of registration is made for the principal design and its related designs or the fundamental design and the related designs associated with the fundamental design at the same time. However, in the case of an international application for design registration, the examiner should wait until the registration of establishment of the design right of the application becomes final and binding and then make a decision of registration for its related designs.
- [ii] If any reason for rejection is found for a principal design, the examiner should wait until the registration of the principle design becomes final and biding and then make a decision of registration of its related designs.

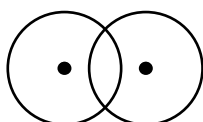
-----

[Explanatory notes]

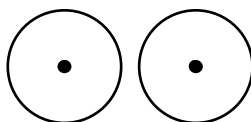
In the following explanations, each drawing is used as that representing the meaning below respectively.



Relationship in which the designs are similar

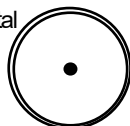


Relationship in which the designs are not similar (with some overlapping found in the scopes)

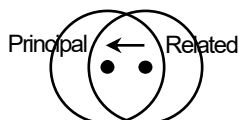


Relationship in which the designs are not similar (with no overlapping found in the scopes)

Fundamental

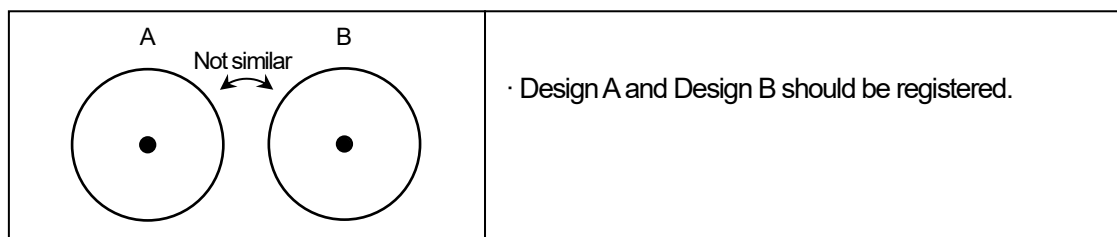


Fundamental design

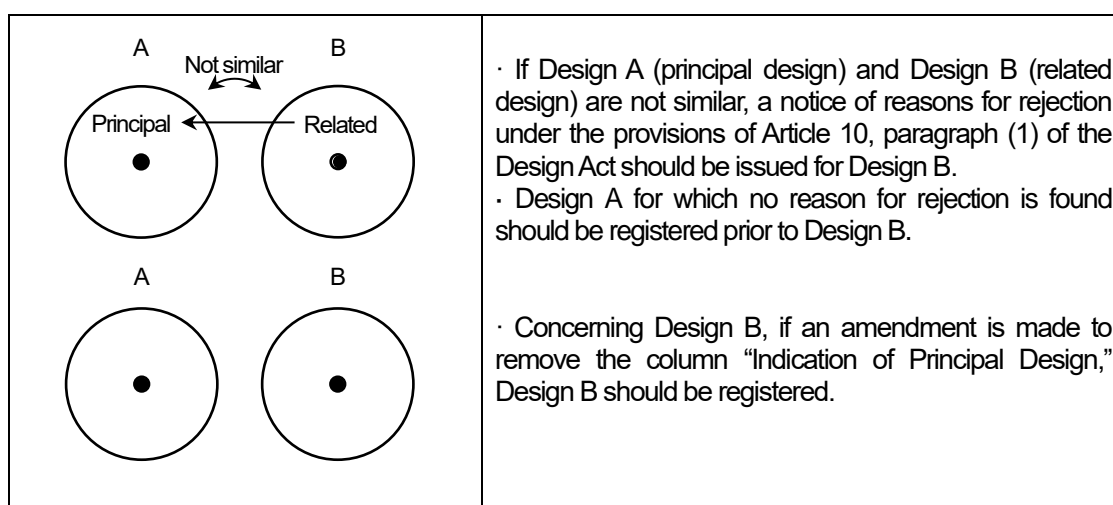


Relationship between the principal design and its related design

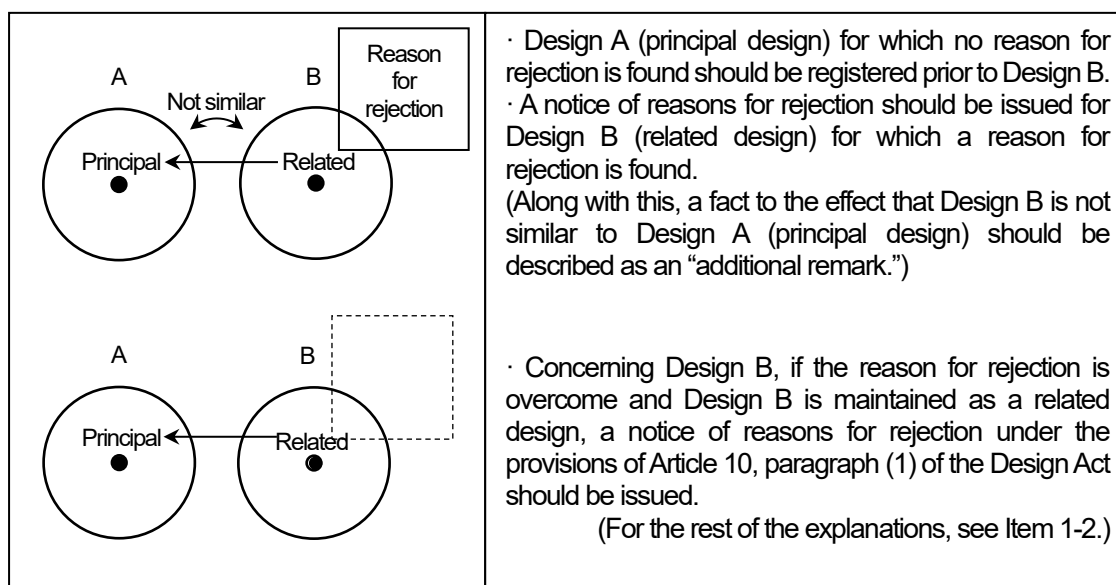
**1-1. Two designs which are not similar and whose applications have been filed on the same date (with no principal design-related design relationship)**



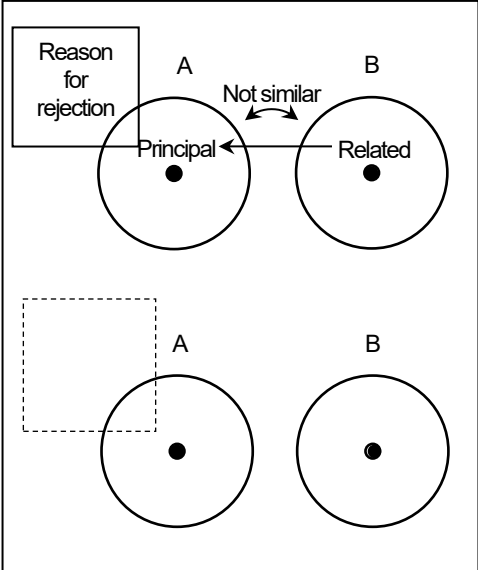
**1-2. Two designs which are not similar and whose applications have been filed on the same date (applications for a principal design and its related design)**



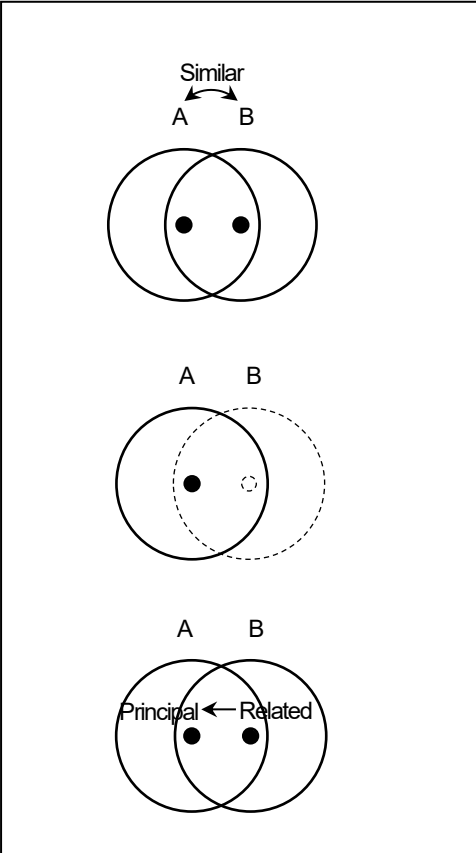
**1-3. Two designs which are not similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the related design)**



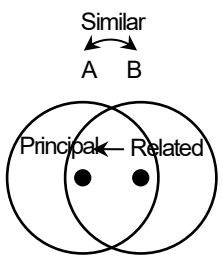
**1-4. Two designs which are not similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the principal design)**

	<ul style="list-style-type: none"> <li>· A notice of reasons for rejection should be issued for Design A (principal design).</li> <li>· A notice of reasons for rejection should be issued for Design B (related design) to the effect that Design B is not similar to Design A (principal design) and that Design B may not be registered as a related design under the provisions of Article 10, paragraph (1) of the Design Act.</li> </ul> <ul style="list-style-type: none"> <li>· Concerning Design A, if the reason for rejection is overcome, Design A should be registered.</li> <li>· Concerning Design B, if an amendment is made to remove the column "Indication of Principal Design," Design B should be registered.</li> </ul>
---	--

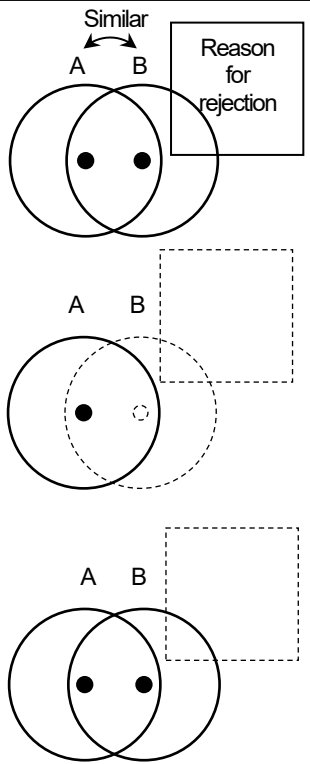
**2-1. Two designs which are similar and whose applications have been filed on the same date (with no principal design-related design relationship)**

	<ul style="list-style-type: none"> <li>· An order for discussion under the provisions of Article 9, paragraph (4) of the Design Act should be issued for both Design A and Design B.</li> <li>· If these applications are filed by the same person, a notice of reasons for rejection under the provisions of Article 9, paragraph (2) of the Design Act should be issued in the name of the examiner, together with the order for discussion in the name of the Commissioner of the Japan Patent Office.</li> </ul> <ul style="list-style-type: none"> <li>· If a notification is filed to the effect that the applicant has selected one of the applications and if the other is withdrawn, the selected one should be registered.</li> <li>· If no such notification is filed but just any one of the applications is withdrawn, the other one, for which discussions are no longer needed, should be registered after the lapse of the predetermined period of time.</li> </ul> <ul style="list-style-type: none"> <li>· If these applications are filed by the same person (including the cases where different applicants become one applicant as a result of, e.g., transfer of the design right) and if, together with filing a notification, an amendment is made to the applications in which the applicant selects one of the applications as that for a principal design while selecting the other as that for its related design, then both designs should be registered.</li> </ul>
---	---

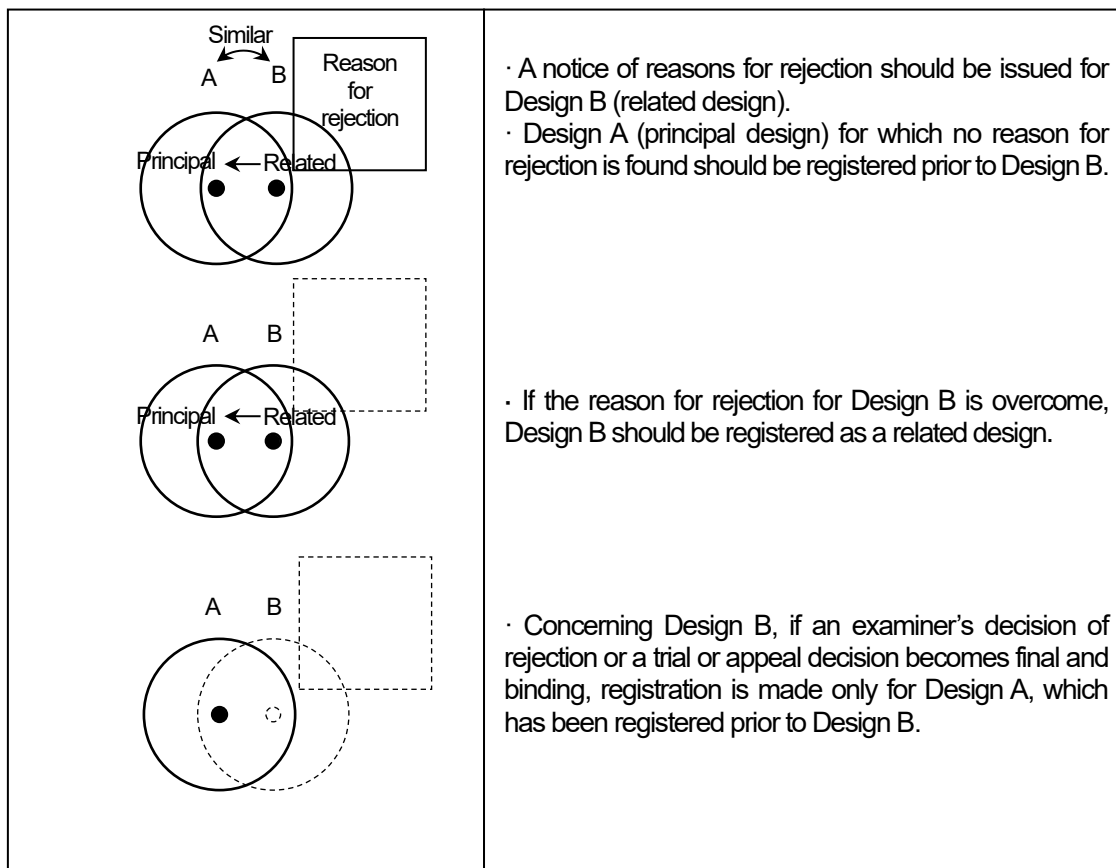
**2-2. Two designs which are similar and whose applications have been filed on the same date (applications for a principal design and its related design)**

	<ul style="list-style-type: none"> <li>· If two applications are filed as that for a principal design and as that for its related design and they are found to be similar, both designs should be registered.</li> </ul>
---	--

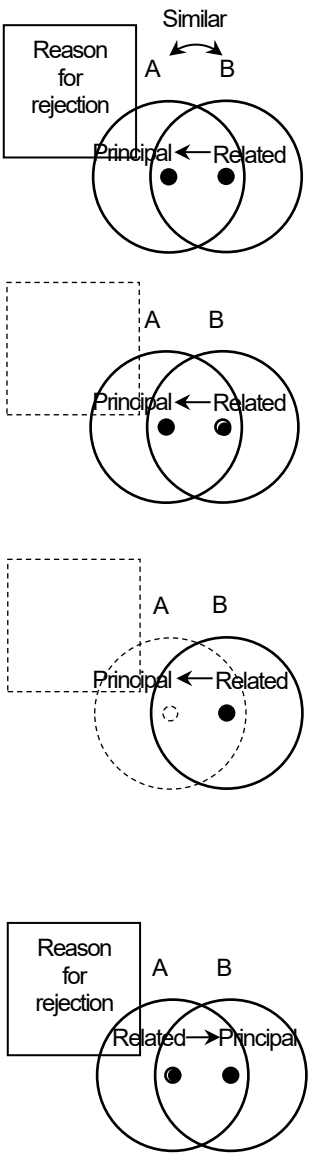
**2-3. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for one of the designs)**

	<ul style="list-style-type: none"> <li>· A notice of reasons for rejection should be issued for Design B for which a reason for rejection is found.</li> <li>· A “wait notice” should be issued for Design A which may need a discussion depending on the results concerning Design B.</li> <li>· Concerning Design B, if an examiner's decision of rejection or a trial or appeal decision of rejection becomes final and binding, Design A should be registered.</li> <li>· If the reason for rejection for Design B is overcome, both designs fall under the provisions of Article 9, paragraph (2) of the Design Act and, therefore, an order for discussion under the provisions of Article 9, paragraph (4) of the Design Act should be issued for both designs. (For the rest of the explanations, see Item 2-1.)</li> </ul>
--	---

**2-4. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the related design)**



**2-5. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the principal design)**

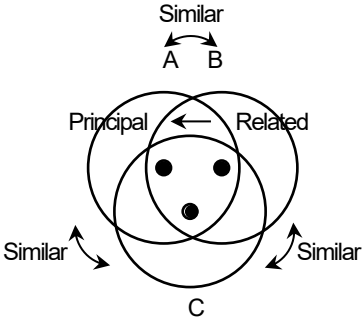
 <p>The diagrams illustrate the following scenarios:</p> <ul style="list-style-type: none"> <li><b>Diagram 1:</b> Two overlapping circles, A (left) and B (right), are labeled 'Similar' with a double-headed arrow. A box labeled 'Reason for rejection' points to circle A. Inside circle A is a solid dot labeled 'Principal'. Inside circle B is a solid dot labeled 'Related'. An arrow points from 'Related' to 'Principal'.</li> <li><b>Diagram 2:</b> Similar to Diagram 1, but the 'Reason for rejection' box is dashed. Both dots are solid. An arrow points from 'Related' to 'Principal'.</li> <li><b>Diagram 3:</b> Similar to Diagram 1, but the 'Reason for rejection' box is dashed. The dot in circle A is dashed (labeled 'Principal'), and the dot in circle B is solid (labeled 'Related'). An arrow points from 'Related' to 'Principal'.</li> <li><b>Diagram 4:</b> Similar to Diagram 1, but the 'Reason for rejection' box is solid. The dot in circle A is solid (labeled 'Related'), and the dot in circle B is solid (labeled 'Principal'). An arrow points from 'Related' to 'Principal'.</li> </ul>	<ul style="list-style-type: none"> <li>· A notice of reasons for rejection should be issued for Design A (principal design).</li> <li>· A “wait notice” should be issued for Design B (related design).</li> </ul> <ul style="list-style-type: none"> <li>· If the reason for rejection for Design A is overcome, both Designs A and B should be registered as a principal design and its related design.</li> </ul> <ul style="list-style-type: none"> <li>· If an examiner’s decision of rejection or a trial or appeal decision for Design A becomes final and binding, a notice of reasons for rejection (Design Act 10 (1)) should be issued for Design B to the effect that there is no principal design and thus Design B may not be registered as a related design.</li> <li>· In contrast, if an amendment is made to remove the indication of the principal design, Design B should be registered.</li> </ul> <ul style="list-style-type: none"> <li>· In addition, if an amendment is made to exchange the principal design and the related design, Design B, for which a reason for rejection is no longer found, is registered prior to Design A. (see Item 2-4 above.)</li> </ul>
--	--



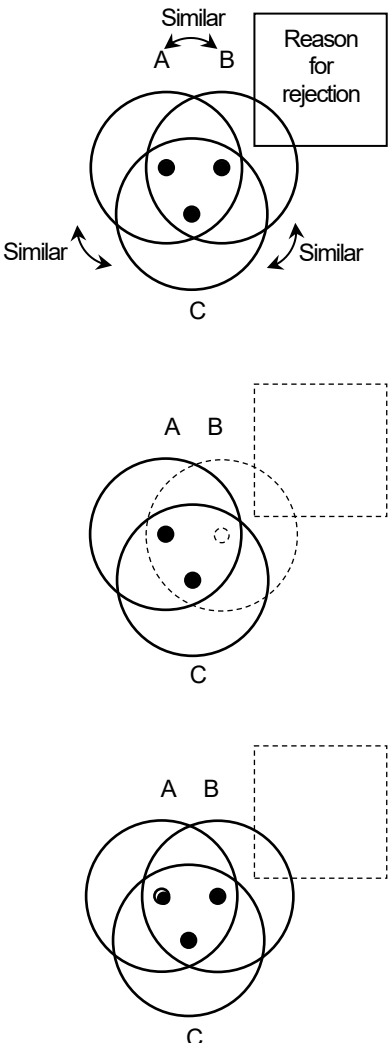
### 3-1. Three designs which are similar to each other and whose applications have been filed on the same date (with no principal design-related design relationship)

	<ul style="list-style-type: none"> <li>· An order for discussion is issued on the relationship between Designs A and B, that between Designs B and C and that between Design C and A, respectively. (An order for discussion is issued as below: Design A requires discussions on its relationships with Designs B and C; Design B requires those on its relationship with Designs A and C; and Design C requires those on its relationships with Designs A and B.)</li> <li>· If a notification is filed to the effect that the applicant has selected only one of Designs A, B and C and if the rest of the designs are withdrawn, the selected one should be registered.</li> <li>· In a case where three designs are filed by the same person, if a notification is filed to the effect that the applicant has selected one of them as a principal design and the rest of them as its related designs and if an amendment is made therefor, then these three designs should be registered.</li> <li>· If a notification is filed to the effect that the applicant has selected one of the designs as a fundamental design, the second one, among the rest of the designs, as a related design in which the fundamental design is selected as a principal design, and the third one as another related design in which the related design above is selected as a principal design and if an amendment is made therefor, then these three designs should be registered.</li> <li>· As seen in the drawing on the left, if a notification that all three designs are selected as related designs and if an amendment is made therefor, a notice of reasons for rejection (Design Act 10(1)) should be issued to the effect that these designs may not be registered as related designs based on the ground that no design is selected as a fundamental design.</li> </ul>
--	--

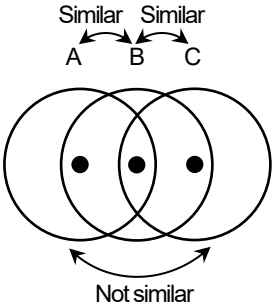
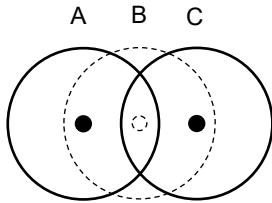
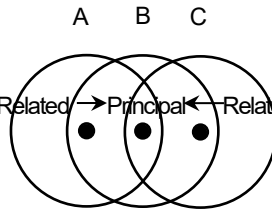
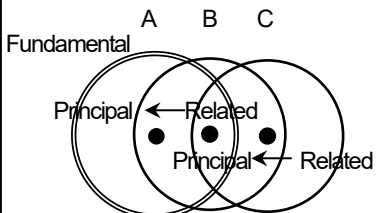
**3-2. Three designs which are similar to each other and whose applications have been filed on the same date (applications in which two of the designs have a relationship between a principal design and its related design)**

	<ul style="list-style-type: none"> <li>An order for discussion should be issued on the relationship between Designs A and C and that between Designs B and C. (For the rest of the explanations, see Item 3-1.)</li> </ul>
---	--

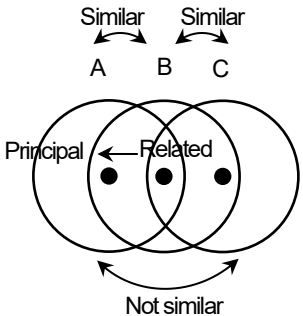
**3-3. Three designs which are similar to each other and whose applications have been filed on the same date (in a case where a reason for rejection is found for one of the designs)**

	<ul style="list-style-type: none"> <li>A notice of reasons for rejection should be issued for Design B for which a reason for rejection is found.</li> <li>A “wait notice” should be issued for Designs A and B, the relationship on which a discussion may need depending on the results concerning the application for Design B.</li> <li>Concerning Design B, if an examiner’s decision of rejection or a trial or appeal decision becomes final and binding, an order for discussion on the relationship between Designs A and C should be issued. (For the rest of the explanations, see Item 2-1.)</li> <li>If the reason for rejection for Design B is overcome, an order for discussion should be issued on the relationship between Designs A and B, that between Designs B and C and that between Designs C and A. (For the rest of the explanations, see Item 3-1.)</li> </ul>
---	---

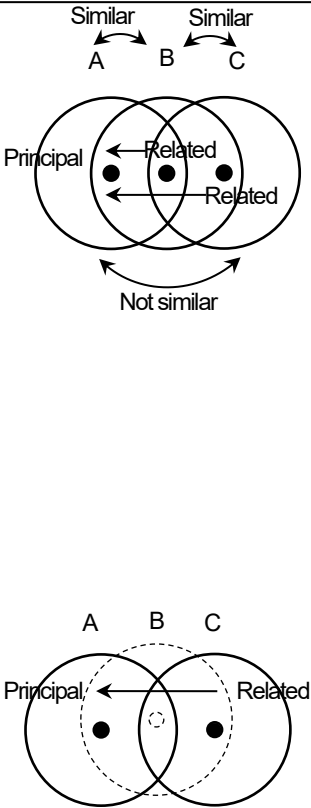
**4-1. Three designs which are similar or not similar and whose applications have been filed on the same date (with no principal design-related design relationship)**

 <p>Similar   Similar</p> <p>A   B   C</p> <p>Not similar</p>  <p>A   B   C</p>  <p>A   B   C</p> <p>Related   Principal   Related</p>  <p>Fundamental   A   B   C</p> <p>Principal   Related   Principal   Related</p>	<ul style="list-style-type: none"> <li>· An order for discussion is issued on the relationship between Designs A and B and that between Designs B and C, respectively.</li> <li>· If a notification is filed to the effect that the applicant has selected Design A concerning the relationship between Designs A and B and another notification is filed to the effect that the applicant has selected Design C concerning the relationship between Designs B and C, and if Design B is withdrawn, then Designs A and C should be registered.</li> <li>· If a notification is filed to the effect that the applicant has selected Design B as a principal design and Designs A and C as its related designs and if an amendment is made therefor, then these three designs should be registered.</li> <li>· If a notification is filed to the effect that the applicant has selected Design A as a fundamental design, Design B as a related design in which Design A is selected as a principal design, and Design C as another related design in which Design B is selected as a principal design and if an amendment is made therefor, then these three designs should be registered.</li> </ul>
---	--

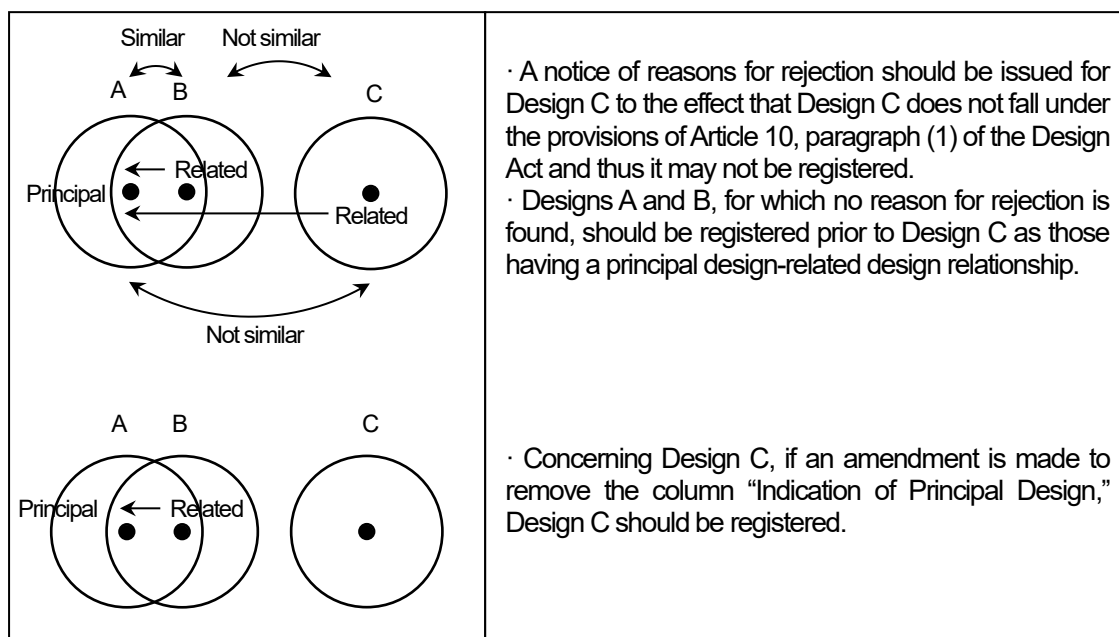
**4-2. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (1))**

	<ul style="list-style-type: none"> <li>· An order for discussion should be issued on the relationship between Designs B and C. (The relationship between Designs A and B, which establishes a principal design-related design relationship, is not subject to an order for discussion since the provisions of Article 9, paragraph (2) of the Design Act do not apply due to the provisions of Article 10, paragraph (1) of the Design Act.)</li> <li>A “wait notice” should be issued for Design A.</li> </ul> <p>(For the rest of the explanations, see Item 4-1.)</p>
---	--

**4-3. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (2))**

	<ul style="list-style-type: none"> <li>· Design C which is not similar to Principal Design A requires a discussion on its relationship with Design B.</li> <li>· An order for discussion should be issued on the relationship between Designs B and C. (In order to show that Designs A, B and C do not stand in a relationship of similarity (the relationship mentioned in 3-1 above) to each other, the order for discussion should also describe to the effect that Design C has no similarity to Design A. The relationship between Designs A and B, which establishes a principal design-related design relationship, is not subject to an order for discussion since the provisions of Article 9, paragraph (2) of the Design Act do not apply due to the provisions of Article 10, paragraph (1) of the Design Act.)</li> <li>· A “wait notice” should be issued for Design A.</li> </ul> <ul style="list-style-type: none"> <li>· Concerning the relationship between Designs B and C, if a notification is filed to the effect that the applicant has selected Design C and maintained Design A as a principal design, a notice of reasons for rejection under the provisions of Article 10, paragraph (1) of the Design Act should be issued for Design C.</li> </ul> <p>(For the rest of the explanations, see Item 4-1.)</p>
--	--

**4-4 Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (3))**

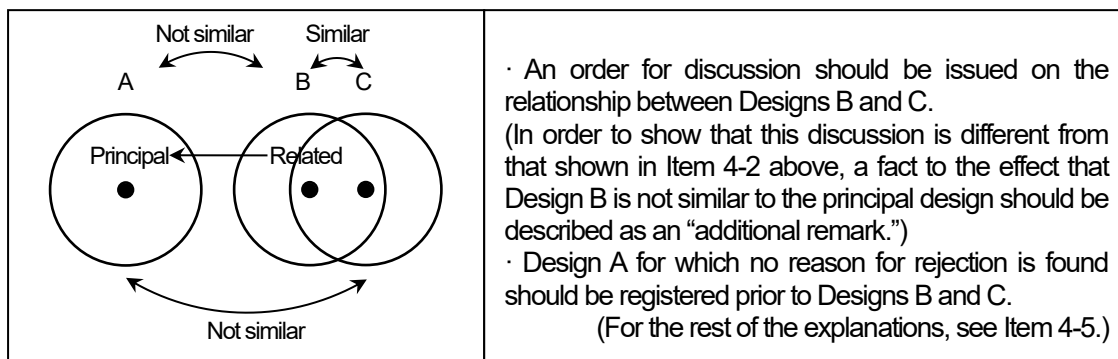


**4-5. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (4))**

	<ul style="list-style-type: none"> <li>· Designs B and C which are not similar to the principal design may not be registered as a related design.</li> <li>· An order for discussion should be issued on the relationship between Designs B and C. (In order to show that this discussion is different from that shown in Item 4-3 above, a fact to the effect that neither Design B nor Design C is similar to the principal design should be described as an “additional remark.”)</li> <li>· Design A for which no reason for rejection is found should be registered prior to Designs B and C.</li> </ul>
	<ul style="list-style-type: none"> <li>· Concerning the relationship between Designs B and C, if a notification is filed to the effect that the applicant has decided the relationship as a principal design-related design relationship and if an amendment is made therefor, Designs B and C should be registered.</li> </ul>
	<ul style="list-style-type: none"> <li>· If a notification is filed to the effect that the applicant has selected one of Designs B and C and if the other one is withdrawn, the selected one should be registered.</li> </ul>
	<ul style="list-style-type: none"> <li>· In a case where the applicant has selected one of Designs B and C and withdrawn the other one, if a notification is filed to the effect that the applicant has maintained Design A as a principal design, a notice of reasons for rejection under the provisions of Article 10, paragraph (1) of the Design Act should be issued for the selected design, i.e., Design B or C.</li> </ul>

(For the rest of the explanations, see Item 1-2.)

**4-6. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (5))**

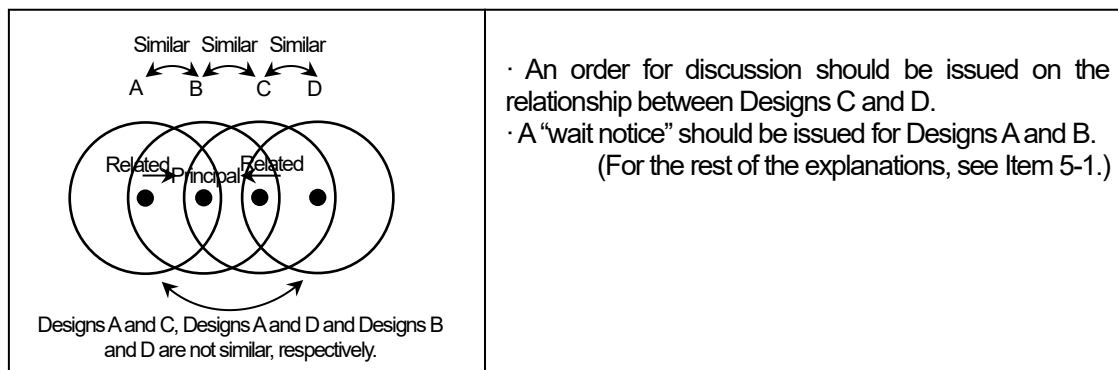


**5-1. Four designs which are similar or not similar and whose applications have been filed on the same date (with no principal design-related design relationship)**

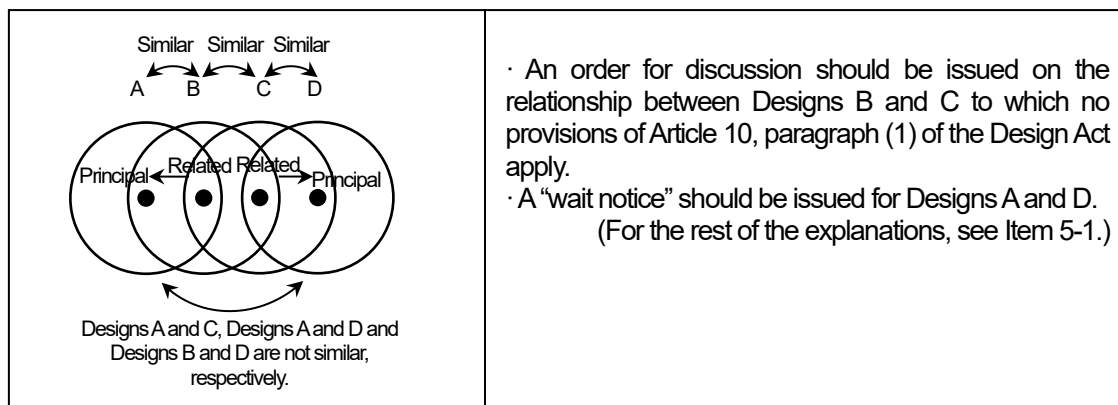
<p>Similar   Similar   Similar</p> <p>A   B   C   D</p> <p>Designs A and C, Designs A and D and Designs B and D are not similar, respectively.</p>	<ul style="list-style-type: none"> <li>· An order for discussion should be issued on the relationship between Designs A and B, that between Designs B and C and that between Designs C and D.</li> </ul>
<p>A   B   C   D</p>	<ul style="list-style-type: none"> <li>· If a notification is filed to the effect that the applicant has selected one of the designs subject to discussion and if the other one is withdrawn, which results in selecting one design or two designs which are not similar to each other (i.e., "A and C," "B and D" or "A and D"), the design or these two designs should be registered, respectively.</li> </ul>
<p>A   B   C   D</p> <p>Fundamental</p> <p>Principal   Principal   Related</p> <p>Principal   Related</p>	<ul style="list-style-type: none"> <li>· If a notification is filed to the effect that the applicant has selected Design A as a fundamental design, Design B as a related design in which Design A is selected as a principal design, Design C as a related design in which Design B is selected as a principal design and Design D as a related design in which Design C is selected as a principal design and if an amendment is made therefor, then these four designs should be registered, respectively.</li> </ul>
<p>A   B   C   D</p> <p>Fundamental</p> <p>Related   Principal   Related</p> <p>Principal   Related</p>	<ul style="list-style-type: none"> <li>· If a notification is filed to the effect that the applicant has selected Design B as a fundamental design, Designs A and C as related designs in which Design B is selected as a principal design and Design D as a related design in which Design C is selected as a principal design and if an amendment is made therefor, then these designs should be registered, respectively.</li> </ul>



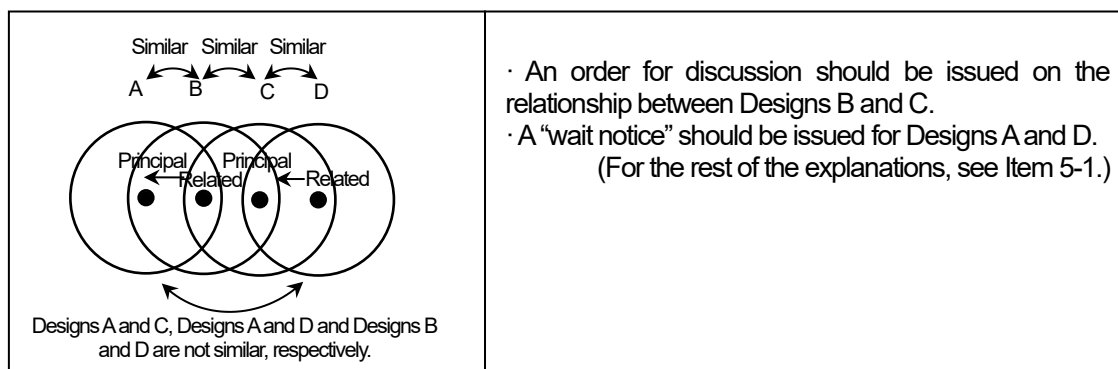
**5-2. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (1))**



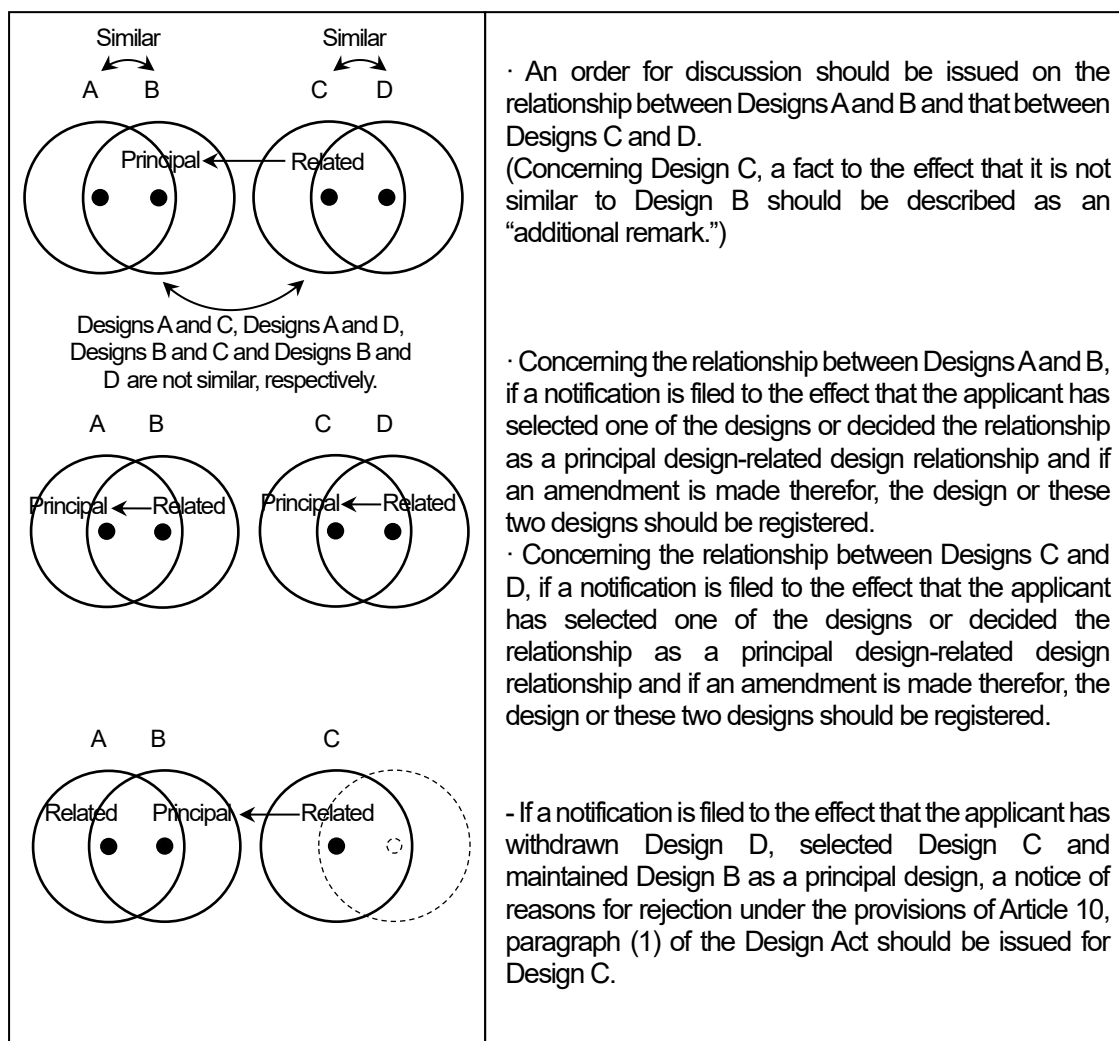
**5-3. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (2))**



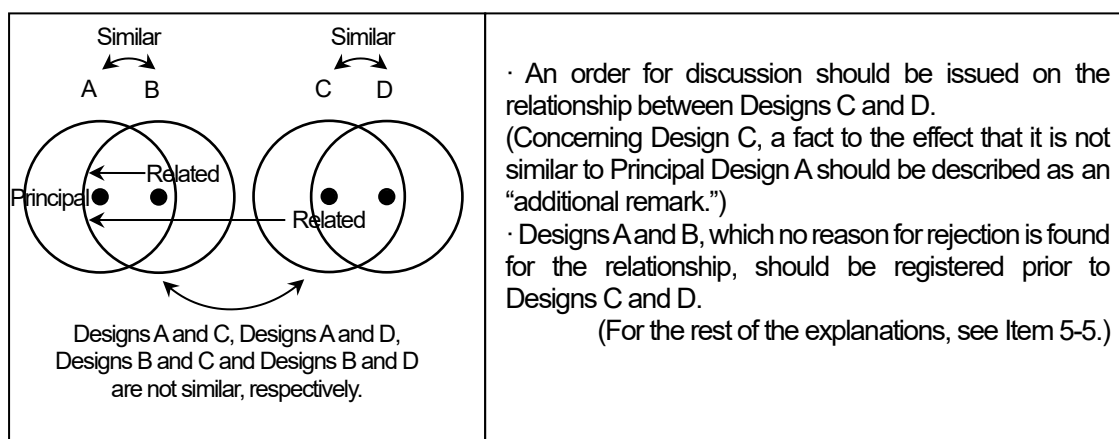
**5-4. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (3))**



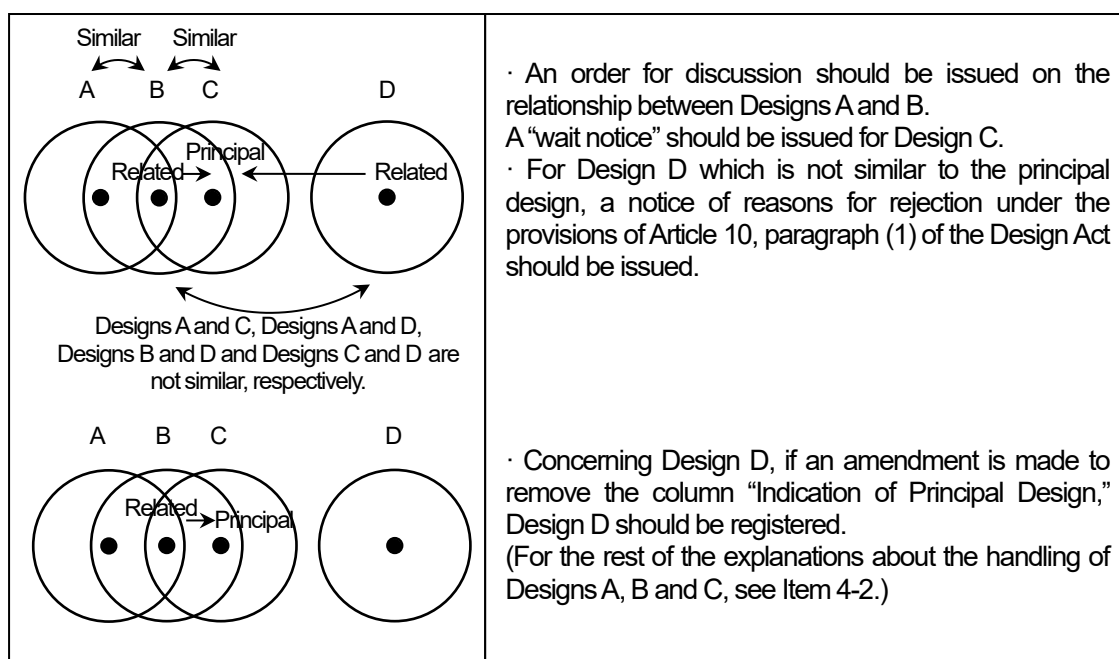
**5-5. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (4))**



**5-6. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (5))**



**5-7. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (6))**



**5-8. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (7))**

