

Examination Handbook for Designs

Revised in March 2023

Design Examination Standards Office,
Design Division, Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Preface

The Examination Handbook for Designs is a compilation of procedural matters and points to note which are required for examiners in undertaking examination of applications for design registration. Since its full-fledged revision in January 2002, the Examination Handbook for Designs has been partially revised in line with the revision of laws and regulations, the revision of the Examination Guidelines for Design, etc.

In line with the enforcement of the revised Design Act under the Act for Partial Revision of the Patent Act, etc. (Act No. 42 of May 21, 2021) on April 1, 2023, we revised the Examination Guidelines for Design and also reviewed the statement concerning the period of priority under the Paris Convention or in accordance with the Paris Convention of this Examination Handbook for Designs.

We will continue to revise it as needed in accordance with the revision of the design system, changes in the procedures for examination practices, etc.

March 2023

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Explanatory Notes

1. Classification numbers

One-hundred two-digit numbers from 00 to 99 are defined as the basic classification numbers. Each of the basic classification numbers represents a group of information on the same subject.

Two-digit numbers following the basic classification numbers are the sub-classification numbers. If you read these sub-classification numbers in order, which are hierarchically developed under the basic numbers, you can smoothly understand the explanations. One classification number consists of a two-digit basic classification number, one dot (".") and a two-digit sub-classification number in sequence.

2. The note "(→Classification number XX)" in the text of this handbook refers you to other relevant sections. For example, if you find a note "(→Main classification number)..... e.g., (→Main 10.05)," this means that the section referred to by the number is the main section explaining the information concerned.

As well, if you find a note showing a two-digit basic classification number alone in parentheses as described above, this note refers you to the entire section indicated by the basic classification number.

Furthermore, if the Examination Guidelines for Design, the Formality Examination Manual or other documents are/is mentioned as a reference, the title is shown in the section concerned together with a classification number.

3. Abbreviations (Examples)

| | |
|--------------------------------|--|
| Design Act 1(1)(iii) | Article 1, paragraph (1), item (iii) of the Design Act |
| Design Enforcement Act 3 | Article 3 of the Act for Enforcement of the Design Act |
| Design Enforcement Order | Order for Enforcement of the Design Act |
| Design Regulation 2 | Article 2 of the Regulation for Enforcement of the Design Act |
| Design Registration | Design Registration Order |
| Design Registration Regulation | Regulation for Enforcement of the Design Registration Order |
| Patent Act 4 | Article 4 of the Patent Act |
| Patent Enforcement Order | Order for Enforcement of the Patent Act |
| Patent Regulation 5 | Article 5 of the Regulation for Enforcement of the Patent Act |
| Patent Registration | Patent Registration Order |
| Patent Registration Regulation | Regulation for Enforcement of the Patent Registration Order |
| Utility Act 6 | Article 6 of the Utility Model Act |
| Paris Convention | Paris Convention for the Protection of Industrial Property |
| Establishment Act | Act for Establishment of the Ministry of Economy, Trade and Industry |
| Organization Order | Order for Organization of Ministry of Economy, Trade and Industry |
| Civil Code 7 | Article 7 of the Civil Code |
| Civil Procedure 8 | Article 8 of the Code of Civil Procedure |
| [m.m.] | Mutatis mutandis application |

(Example)

| | |
|--|--|
| Patent Act 37 [m.m.] Design Act 15(1): | Article 37 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act |
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If a new application for design registration resulting from division (Design Act 10-2) has a gist that goes beyond the scope of the design stated in the earliest application and drawings attached thereto of the original application for design registration, the examiner should proceed with examination considering the date on which the new application for design registration resulting from division has been filed as the filing date.

In this case, this fact should be notified to the applicant for design registration in the name of the examiner.

14. 03. 01**Filing date of a new application for design registration resulting from conversion and the handling of the filing date in a case where the new application resulting from conversion changes the gist of the original application's design**

If a new application for design registration resulting from conversion (Design Act 13(1) or (2)) is found to change the gist of the design stated in the description and drawings as originally filed in the original patent application or application for utility model registration, the examiner should proceed with the examination considering the date on which the new application for design registration resulting from conversion has been filed as the filing date.

In this case, this fact should be notified to the applicant for design registration in the name of the examiner.

15. 02

Period of priority under the Paris Convention or in accordance with the Paris Convention

1. The period of priority (period during which an applicant is eligible to claim the priority right) is the period from the earliest filing date on which the application has been filed in a regular manner in the first country to the filing date on which the application has been filed in the second country. The period of priority in a case where an applicant files an application for design registration claiming priority based on the application for design registration is six months (Paris Convention 4(C)(1)). Moreover, the period of priority in a case where an applicant files an application for design registration claiming priority based on the application for utility model registration is six months as well (Paris Convention 4(E)(1)).
2. These periods mentioned above start from the filing date of the earliest application, and the filing day is not included in the calculation of the period (Paris Convention 4(C)(2)).
3. If the last day of the period is an official holiday, or a day when the patent office is not open for the filing of applications in the second country, the period is extended until the first following working day (Paris Convention 4(C)(3)) (→Patent Act 3(2) [m.m.] Design Act 68(1), Act on Holidays of Administrative Organs 2).
4. With regard to a person that has been unable to file an application for design registration containing a priority claim within the period of priority provided for in Article 4, paragraph C, item (1) of the Paris Convention, despite seeking a request to claim priority pursuant to Article 4, paragraph D, item (1) of the Paris Convention regarding the application for design registration, where the person files the application for design registration as provided by Order of the Ministry of Economy, Trade and Industry within the time limit provided by Order of the Ministry of Economy, Trade and Industry (within two months from the lapse of the period of priority provided by Article 4, paragraph C, item (1) of the Paris Convention), the person may make a priority claim regarding the application for design registration in accordance with Article 4 of the Paris Convention, even after the lapse of the period of priority (Patent Act 43-2(1) [m.m.] Design Act 15(1), Patent Regulation 27-4-2(2) [m.m.] Design Regulation 19(3), Formality Examination Manual 28.01). However, this does not apply to the case where it is found that the person didn't file the application for design registration deliberately within the period of priority.

15. 03

Procedures for a priority claim under the Paris Convention, etc.

1. A person seeking to claim priority in relation to an application for design registration pursuant to the provisions of Article 4, paragraph D, item (1) of the Paris Convention must submit to the Commissioner of the Japan Patent Office, at the time of filing of the application for design registration, a document with statements of: the fact that the person is seeking the priority claim; the name of a member country of the Paris Convention Union or member state of the World Trade Organization or the name of a specified country with which the person has filed the earliest application or the application deemed to be the earliest application pursuant to the provisions of Article 4, paragraph C, item (4) of the Paris Convention or the application found to be the earliest application pursuant to the provisions of Article 4, paragraph A, item (2) of the Paris Convention (If the earliest application is a regional application or an international application and if there are one or more names of intergovernmental organization offices or agencies or designated countries, it should be sufficient to state one name of the country among the designated countries (Formality Examination Manual 28.01).); and the filing date of the application (Patent Act 43(1), Patent Act 43-2, Patent Act 43-3 [m.m.] Design Act 15(1)). This is called a “declaration of priority” in the Paris Convention. No other procedures may be required for the declaration of priority at the time of filing the application for design registration (Paris Convention 4(D)(4)). Moreover, if the person states this fact and the required information in the application for design registration, the person may omit the submission of the document provided for in Article 43, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act (Patent Regulation 27-4(3) [m.m.] Design Regulation 19(3)).
2. A person that has made a priority claim in accordance with Item 1 above must submit to the Commissioner of the Japan Patent Office, within three months from the date of filing of the application for design registration (within three months from the date of international publication regarding an international application for design registration), a document stating the filing date of the application and bearing the certification of a member country of the Paris Convention Union or member state of the World Trade Organization or a specified country with which the person has filed the earliest application or the application deemed to be the earliest application pursuant to the provisions of Article 4, paragraph C, item (4) of the Paris Convention or the application found to be the earliest application pursuant to the provisions of Article 4, paragraph A, item (2) of the Paris Convention, as well as certified copies of the application and drawings, or any bulletin or certificate giving

the same type of details published by the government of the Union, member state or specified country (certified as correct by the authority which received the earliest application, in which the authority includes intergovernmental authorities) (Patent Act 43(2), Patent Act 43-2(2), Patent Act 43-3(3) [m.m.] Design Act 15(1), Patent Act 43(2) [m.m.] Design Act 60-10(2), Design Regulation 12-2). Such document is commonly called a “priority certificate.” Submission of this certificate should be accompanied by a translation (Paris Convention 4(D)(3), Patent Regulation 2(2) [m.m.] Design Regulation 19(1)). Moreover, the priority certificate is deemed to be submitted in a case where it is permissible for electronic or magnetic means to be used for exchanging the details given in the certificate with the government of a member country of the Paris Convention Union or an international organization involved in industrial property rights (Patent Regulation 27-3-3(2)(i) [m.m.] Design Regulation 19(3)), if the person claiming priority under the provisions of Article 43, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act submits to the Commissioner of the Japan Patent Office a document stating the filing number of the application for design registration and other matters as necessary for exchanging the matters (Patent Regulation 27-3-3(3) [m.m.] Design Regulation 19(3)), within three months from the filing date of the application for design registration (within three months from the date of international publication regarding an international application for design registration) (Patent Act 43(5) [m.m.] Design Act 15(1)).

3. A person that has made a priority claim in accordance with Item 1 above must submit to the Commissioner of the Japan Patent Office a document stating the number of: the earliest application or the application deemed to be the earliest application pursuant to the provisions of Article 4, paragraph C, item (4) of the Paris Convention or the application found to be the earliest application pursuant to the provisions of Article 4, paragraph A, item (2) of the Paris Convention, together with the priority certificate. However, if it is not possible for the person to learn that filing number prior to the submission of the priority certificate, a document specifying the reason therefor must be submitted in lieu of the document specifying the filing number, and the document specifying the filing number must be submitted without delay once the person comes to know that number (Paris Convention 4(D)(5), Patent Act 43(3) [m.m.] Design Act 15(1), 60-10(2)).
4. If a priority certificate or a document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act has not been submitted within the period provided for in Item 2 above, the Commissioner of the Japan Patent Office must notify the person that has made the priority claim to that effect (Patent Act 43(6) [m.m.] Design Act 15(1), 60-10(2)). A person that has received such notice may submit a priority certificate or a document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis

mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act only within two months from the date of the notice (Patent Act 43(7) [m.m.] Design Act 15(1), 60-10(2), Patent Regulation 27-3-3(5) [m.m.] Design Regulation 19(3)).

5. If a person that has received a notice referred to in Article 43, paragraph (6) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act is unable to submit a priority certificate or a document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act within two months from the date when the person received the notice due to reasons beyond the person's control, the person may submit the priority certificate or the document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act within the period below (Patent Act 43(8) [m.m.] Design Act 15(1), 60-10(2)).
 - a. Within one month (in the case of an overseas resident, within two months) from the date on which the person obtained a priority certificate if the person was unable to submit a priority certificate due to an administrative delay in issuance of the document by the government that should issue the document (Patent Regulation 27-3-3(6)(i) [m.m.] Design Regulation 19(3), Formality Examination Manual 28.21).
 - b. In a case other than those mentioned in Item a. above, within 14 days (in the case of an overseas resident, within two months) from the date on which the reason for which the person was unable to submit the priority certificate or the document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act ceases to exist, but not later than six months after the lapse of the period (Patent Regulation 27-3-3(6)(ii) [m.m.] Design Regulation 19(3)).
6. If a person that has made a priority claim fails to submit a priority certificate or a document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act within the period provided for in Item 2 above, the priority claim is forfeited (Paris Convention 4(D)(4), Patent Act 43(4) [m.m.] Design Act 15(1), 60-10(2)). However, if the priority certificate or the document provided for in Article 43, paragraph (5) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act is submitted within the period provided for in Items 4 or 5 above, the provisions of Article 43, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act and Article 60-10, paragraph (2) of the Design Act do not apply (Patent Act 43(9) [m.m.] Design Act 15(1), 60-10(2)).

15. 06

Handling of the period of priority in a case where an application for design registration is a result from conversion of a patent application or an application for utility model registration containing a priority claim under the Paris Convention, etc.

If a new application for design registration is a result from conversion of a patent application or an application for utility model registration which contains a priority claim, the priority claim is found to be effective only when the original patent application or the original application for utility model registration was filed within six months from the filing date of the earliest application in the first country.

(Explanation)

Article 4, paragraph C, item (1) of the Paris Convention stipulates the period of priority for designs as six months, while Article 4, paragraph E, item (1) of the Paris Convention stipulates the period of priority for designs as six months in a case where the application for design registration is filed in the second country by claiming priority based on the application for utility model registration filed in the first country. Meanwhile, Japan prescribes the period of priority for an application for utility model registration as 12 months. In accordance with this provision, in a case where an application for utility model registration has been filed in Japan based on the application for utility model registration filed in the first country after six months from the filing date in the first country and the procedure for a priority claim has been undertaken, if the application is later converted into an application for design registration and the effect of the priority claim is permitted, then the period of priority, i.e., six months, for the application for design registration would be extended. To avoid this, the period of priority should be treated as mentioned above, taking into consideration the consistency with the purposes of Article 4, paragraph C, item (1) and Article 4, paragraph E, item (1) of the Paris Convention.

Court decision for reference: Court decision of the Tokyo High Court, 1996 (Gyo-ke) 34, "Whistle Caramel Candy"; Date of the decision: July 16, 1997

(The preceding sentences are omitted.) Article 4, paragraph C, item (1) of the Paris Convention stipulates the period of priority as 12 months for utility models and as six months for designs. Meanwhile, Article 4, paragraph E, item (1) of the Paris Convention stipulates to the effect that if a design is registered in any member state by claiming priority based on the application for utility model registration, the period of priority should be that stipulated for designs (i.e., six months) and the said provision establishes that such period of priority should start from the filing date of the earliest application (Paris Convention 4(C)2).

Nevertheless, no special provisions are stipulated regarding the period of priority for the case where, as in the present case, an application for utility model registration is filed in the second country claiming priority based on an application for utility model registration filed in the first country and, after that, converted to an application for design registration.

However, the purpose of the provisions of Article 4, paragraph E, item (1) of the Paris Convention can be understood that Article 4, paragraph C, item (1) of the Paris Convention stipulates that the period of priority should be basically determined in accordance with whether or not the application filed in the first country involves a patent, a utility model, a design or a trademark; but that if the application filed in the second country, which was filed to enjoy the effect of a priority claim based on the application filed in the first country, is an application seeking the effect of design protection, it is reasonable that the period of priority should be the period of priority for designs as provided for in Article 4, paragraph C, item (1) of the Paris Convention as a principle. For the purpose of this provision, it is reasonable to understand that: even if the application with a priority claim which is filed in the second country is initially an application for utility model registration, –as far as the application is converted to an application for design registration and the effect of design protection is sought– the period of priority which the application can enjoy should be reasonably understood as the period of priority for designs as provided for in Article 4, paragraph C, item (1) of the Paris Convention as a principle.

In view of this, it should be said that: in order for the new application for design registration resulting from conversion in the present case to succeed the effect of the priority claim based on the original application for utility model registration, the original application for utility model registration must have been filed within six months from the filing date of the application for utility model registration in Spain (the first country). In the present case, the period of time between the filing date of the application for utility model registration which the plaintiff filed in Spain and the filing date of the original application for utility model registration exceeded six months. Accordingly, it must be said that the new application for design registration resulting from conversion cannot succeed the effect of the priority claim of the original application for utility model registration. (The following sentences are omitted.)

15. 07**Determination on identicalness of designs in approval or disapproval of the effect of priority claim under the Paris Convention, etc.**

If an application for design registration is filed in Japan within the period of priority based on an application filed in the first country, the priority claim is an advantage which the applicant may enjoy with respect to the application. In order for it to be found that such priority claim is effective, the design in the application for design registration filed in Japan must be identical to the design in the corresponding earliest application filed in the first country on which the application in Japan is based (Paris Convention 4(A)(1), 4(B)). However, since the forms of applications, drawings, etc. are diverse due to the differences in the laws and regulations among countries, it is sufficient for the design in the application filed in the first country and the design in the application for design registration filed in Japan to be stated as identical designs in the priority certificate, regardless of the style of representation of the designs.

17. 02**Handling of the original application for design registration
in a case where the original application is not amended at the time of filing the new
application for design registration resulting from division**

If the original application for design registration is not amended at the time of filing of the new application for design registration resulting from division, the original application for design registration should be rejected as an application containing multiple designs (Design Act 7, Design Act 17(3)).

17. 03

Handling of an amendment required to the original application for design registration in a case where an application for design registration is divided

1. In a case of division of an application for design registration, an amendment to the original application should be made to delete the design involving the division out of the two or more designs contained in the original application.

In undertaking the amendment, if two or more designs remain in the original application for design registration even after the deletion of the design involving the division, the designs which are not necessary among the remaining ones may be excluded from the original application to leave a single design.

2. If an application for design registration is divided, the amendments required to the original application should be made at the time of the division (Patent Regulation 30 [m.m.] Design Regulation 19(3)).

However, if this amendment is not made at the time of the division, it may be made only while an examination, trial, appeal, or retrial of the case is pending.

3. If an application for design registration contains two or more designs and does not meet the requirements provided for in Article 7 of the Design Act, an amendment to the application to leave a single design should be permitted.

(Explanation)

Concerning an application for design registration containing two or more designs, an approach to excluding some of the designs from the application and restricting the application to keep a single design must rely on the amendment of procedures since the Design Act only provides the system for amendment of procedures. Accordingly, such amendment should be treated as an amendment which does not fall under a change of the gist.

17.16

Handling of an application for design registration resulting from division in a case where an application for design registration filed for a single design as provided by Order of the Ministry of Economy, Trade and Industry is divided by each constituent of articles, buildings or graphic images of the design

If an application for design registration filed for a single design is divided by constituent of articles, buildings or graphic images of the design, the new application for design registration resulting from the division is treated as having been filed at the time of the division (→Main 14.03).

The same approach as the one above is adopted in a case where an application for design registration for a design for a set of articles, which satisfies the requirements provided for in Article 8 of the Design Act, is divided pursuant to the provisions of Article 10-2 of the Design Act or where an application for design registration for an interior design, which satisfies the requirements provided for in Article 8-2 of the Design Act, is divided pursuant to the provisions of Article 10-2 of the Design Act.

(Explanation)

An application for design registration should be filed for a single design as prescribed by Order of the Ministry of Economy, Trade and Industry in accordance with the provision of one application per design under Article 7 of the Design Act. However, even if an applicant has erroneously filed an application containing two or more designs, the applicant can enjoy a remedial opportunity in which the applicant is eligible to divide the application into one or more new applications for design registration and file the new application(s); that is, on the premise that such new application for design registration is compliant, the applicant is allowed to enjoy the effect that the new application for design registration is deemed to have been filed at the time of filing the original application for design registration, and this is the purpose of the provisions of Article 10-2 of the Design Act. Accordingly, the division of an application for design registration which satisfies the requirements provided for in Article 7 of the Design Act is not allowed in principle.

18. 01. 03

Application of the provisions on exception to lack of novelty to a new application for design registration resulting from conversion of its original application

1. An applicant may enjoy the application of the provisions under Article 4, paragraph (2) of the Design Act (Exception to Lack of Novelty) to a new application for design registration resulting from conversion of its original application in the following cases:

(1) The applicant has: filed, at the time of filing the new application for design registration, a document stating to the effect that the applicant is seeking to apply the provisions on exception to the lack of novelty for the original patent application or the original application for utility model registration; and also filed a certificate within 30 days from the filing date of the original document. (For a remedy applicable after the lapse of a time limit due to reasons beyond the control of an applicant filing the document, see Item 04.04 of the Formality Examination Manual.)

(2) The applicant has: filed only a document stating to the effect that the applicant is seeking to apply the provisions on exception to the lack of novelty for the original patent application or the original application for utility model registration; and also undertaken the conversion of the original application within 30 days from the filing date of the original application.

In this case, concerning the new application for design registration, the applicant must file a certificate within 30 days from the filing date of the original application. (For a remedy applicable after the lapse of a time limit due to reasons beyond the control of an applicant filing the document, see Item 04.04 of the Formality Examination Manual.)

Moreover, even if the applicant does not take the necessary procedures to apply the exception to the lack of novelty to the original application, the applicant should be treated as eligible to apply the provisions referred to in Article 4, paragraph (2) of the Design Act in the same manner as above when the applicant has: converted the application within one year from the publication date of the design; and filed, at the time of filing the new application for design registration, a document stating to the effect that the applicant is seeking to apply the exception to the lack of novelty; and filed a certificate within 30 days from the filing date of the original application.

Furthermore, this approach is also applied to cases of a divisional application.

18. 01. 04

Application of the provisions on a priority claim under the Paris Convention, etc. to a new application for design registration resulting from conversion of its original application

1. An applicant may enjoy the application of the provisions on a priority claim under the Paris Convention, etc. to a new application for design registration resulting from conversion of its original application in the following cases:

(1) The applicant has: filed, at the time of filing the new application for design registration, a document under the provisions on the procedures for a priority claim for the original patent application or the original application for utility model registration; and also filed a certificate within the predetermined period (→15.03).

The applicant may enjoy the application of this provision only when the applicant has filed the original patent application or the original application for utility model registration within six months from the filing date of the earliest application (the filing date of the application in the first country).

(2) The applicant has: filed only a document through the procedures for a priority claim for the original patent application or the original application for utility model registration; and also undertaken the conversion of the application within three months from the filing date of the original patent application or the original application for utility model registration.

In this case, concerning the new application for design registration, the applicant must file a certificate within the predetermined period from the filing date of the original application (→15.03).

However, this is limited to the case where the applicant has filed the original patent application or the original application for utility model registration within six months from the filing date of the earliest application (the filing date of the application in the first country) (→Main 15.06).

18. 02**Handling of the retroactive effect of the filing date in converting an application**

If an applicant has converted a patent application or an application for utility model registration into an application for design registration pursuant to the provisions of Article 13, paragraph (1) or (2) of the Design Act, the retroactive effect of the filing date should be allowed only if the earliest description and drawings of the original patent application or application for utility model registration contain a concrete statement based on which the design in the new application for design registration resulting from conversion can be clearly recognized.

18. 11**Handling of a case where a patent application or an application for utility model registration is converted into two or more applications for design registration**

A patent application or an application for utility model registration which contains two or more designs may be converted into two or more applications for design registration. In this case, a decision should be made on whether or not the retroactive effect for the filing date is approved for each of these applications for design registration.

(Explanation)

In converting an application, the original application and the new application should be identical in terms of contents. However, due to the difference in the subject matter of protection, a patent application or an application for utility model registration may contain two or more subject matters of design protection in relation to one invention or one device.

Concerning such conversion of an original application which contains two or more designs, all subject matters of protection under the Design Act should be protected. Therefore, if the application contains two or more designs which are subject matters—even if a difference lies in interpretation of the conversion: some may consider that the conversion is possible without having to undergo the procedure for division, while others may recognize that such division is conducted at the same time when conversion is conducted (i.e., the procedure for division is omitted)—; the application may be converted into two or more applications for design registration as a result.

31.02

Determination on a change of the gist in a case where an application for design registration which has been converted from a different legal domain is amended

In a case where an applicant has amended an application for design registration which is a result of conversion from a patent application or an application for utility model registration, a determination on a change of the gist should be made based on the application as originally filed of the application for design registration resulting from the conversion, namely the statements in the columns: Article Embodying the Design, Description of the Article Embodying the Design, and Description of the Design (hereinafter referred to as the “statement in the application”), and the drawings, photographs, models or specimens attached to the application (hereinafter referred to as the “drawings, etc. attached to the application”).

31. 03**Determination on a change of the gist in a case where an application for design registration containing a priority claim under the Paris Convention, etc. is amended**

A determination on a change of the gist in the case where an application for design registration containing a priority claim under the Paris Convention, etc. has been amended should be made based on the statements in the application for design registration filed in Japan and the drawings, etc. attached to the application.

(Explanation)

A priority certificate for the application for design registration filed in the first country is, even if such application contains a priority claim, merely a material for considering the effect of the priority claim. Therefore, the certificate itself does not have any nature or effect equivalent to that of the application for design registration filed in Japan or the drawings attached to the application. In accordance with this, a determination on whether or not the amendment changes the gist of the application should be made based only on the statements in the application for design registration filed in Japan and the drawings, etc. attached to the application.

Court decision for reference: Court decision of the Tokyo High Court, 1969 (Gyo-ke) 128, "Digital Calculation System"; Date of the decision: October 13, 1981

(The preceding sentences are omitted.) A priority certificate does not have any nature or effect equivalent to that of the description or drawings of the patent application filed in Japan. (The following sentences are omitted.)

Court decision for reference: Court decision of the Tokyo High Court, 1977 (Gyo-ke) 46; Date of the decision: June 27, 1978

(The preceding sentences are omitted.) Since the Paris Convention is based on the principle of territoriality and the principle of independence of patents in each country, it goes without saying that even if an application is based on a priority claim under the Paris Convention, the success or failure of a patent application in Japan depends on the application under its domestic law. Moreover, the description of the application filed in the first country is merely a so-called priority certificate which is a material for examining the effect of the priority claim, i.e., the presence of the retroactive effect of the filing date. Accordingly, the certificate itself or a translation thereof does not have a nature or effect equivalent to that of the description of the patent application filed in Japan. (The sentences between the paragraphs are omitted.) In the end, a determination on whether or not the present amendment changes the gist must be made based solely on the description originally attached to the application filed in Japan, examining whether or not the amendment lies within the scope of the statements in the application. (The following sentences are omitted.)

32. 01. 02**Article embodying the design to be stated in the decision to dismiss an amendment**

Concerning a written amendment in which the statements in the column “Article Embodying the Design” of the application are appropriately amended, when making a decision to dismiss the amendment based on the ground, as a reason for the change of the gist, that other matters in the written amendment are amended, the examiner should describe, as the article embodying the design to be indicated in the decision to dismiss the amendment, the article embodying the design before the amendment, rather than the article embodying the design that has appropriately been amended in the written amendment.

(Explanation)

If a decision to dismiss an amendment is made, the procedures for amendment themselves should be dismissed. In accordance with this, even if an amendment which is stated in the written amendment does not change the gist, once a decision is made to dismiss the amendment based on the ground, as a reason for the change of the gist, that other matters in the written amendment are amended, then the former amendment which does not change the gist is also dismissed entirely together with the latter amendment. In line with this, such cases should be treated as described above.

32. 02

Actions taken by an applicant for design registration in response to the decision to dismiss an amendment

In response to the decision to dismiss an amendment, an applicant for design registration may choose one of the following actions.

(1) Request for trial or appeal

If the applicant is not satisfied with the decision to dismiss an amendment, the applicant may file a request for a trial or appeal within three months from the date on which the certified copy of the decision has been served (Design Act 47).

However, If, due to reasons beyond the control of the applicant, i.e., the person that files the request, the applicant is unable to file the request within the period, the applicant may file the request within 14 days (or, if the person is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the lapse of the period (Design Act 46(2) [m.m.] Design Act 47(2)).

(2) New application for an amended design

The applicant may file a new application for design registration for an amended design within three months from the date on which the certified copy of the decision has been served. In this filing, the original application for design registration is deemed to have been withdrawn (Design Act 17-3 (1) and (2)).

(3) Submitting a written amendment again

If an amendment in response to a notice of reasons for rejection or an order to amend procedures has been dismissed, the applicant may file a written amendment to eliminate the reason for rejection or other written amendment in an appropriate form for up to three months from the date on which the certified copy of the decision has been served.

(4) No reply made to the decision to dismiss an amendment

The applicant may not make any reply to the decision to dismiss an amendment and may leave the decision as it is (→Main 32.07).

32. 06

Handling of an amendment in response to the order to amend procedures in a case where the amendment changes the gist of the statement in the application or the drawings, etc. attached to the application as originally filed

If the amendment which an applicant for design registration has made in response to the order to amend procedures under Article 17, paragraph (3) of the Patent Act (Amendment of Proceedings) as applied mutatis mutandis pursuant to Article 68, paragraph (2) of the Design Act is found to have an appropriate form and passes the formality examination and, after that, it is found that the amendment changes the gist, then the amendment must be dismissed.

(Explanation)

Since the determination on whether or not an amendment changes the gist falls under substantive examination, statements in the application or the drawings, etc. attached to the application in which any correction or complement involving the substantive examination is made in the formality examination always require a determination in the substantive examination on whether or not the amendment is appropriate.

In line with this, if an amendment in response to the order to amend procedures is found to change the gist of the statement in the application or the drawings, etc. attached to the application as originally filed after it passes the formality examination, then the amendment must be dismissed.

Moreover, for approaches to handling a case where an amendment in response to the order to amend procedures is dismissed in the substantive examination based on the grounds that it changes the gist, see “Item 43.20 of the Formality Examination Manual.”

32. 07

Handling of an application for design registration in a case where the applicant for design registration does not reply to the decision to dismiss an amendment

- (1) In a case where a notice of reasons for rejection has already been given, the examiner should wait until the decision to dismiss the amendment in question becomes final and binding and then make a decision to the effect that the application for design registration should be rejected on the grounds for the reasons for rejection.
- (2) In a case where a notice of reasons for rejection has not yet been given, the examiner should wait until the decision to dismiss the amendment in question becomes final and binding and then examine the application for design registration whose written amendment has not yet been filed.
- (3) In a case where an applicant for design registration does not reply to the decision to dismiss an amendment which the applicant has made in response to the order to amend procedures, the application for design registration should be dismissed pursuant to the provisions of Article 18, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 68. paragraph (2) of the Design Act (→Formality Examination Manual 43.20).

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

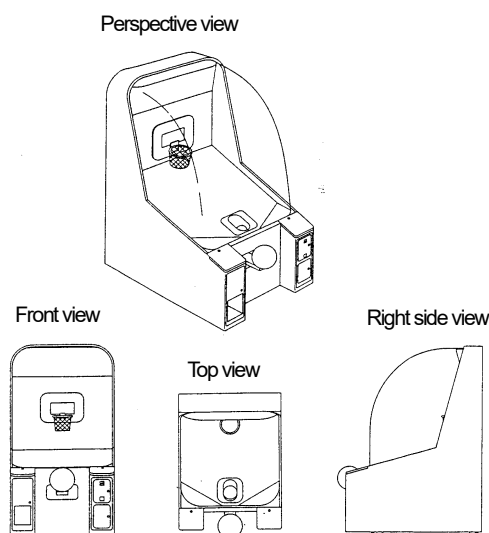
If there is no statement to the effect that the whole or part of the article, building or graphic image embodying the design is transparent and, even by making a comprehensive determination based on the statement in the application and the drawings, etc. attached to the application, no fact that the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

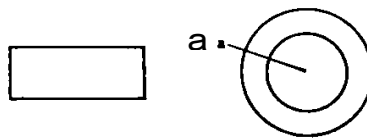
[Case example 1] “Design which changes due to the way the article, etc. functions”(design which has movable elements)

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.

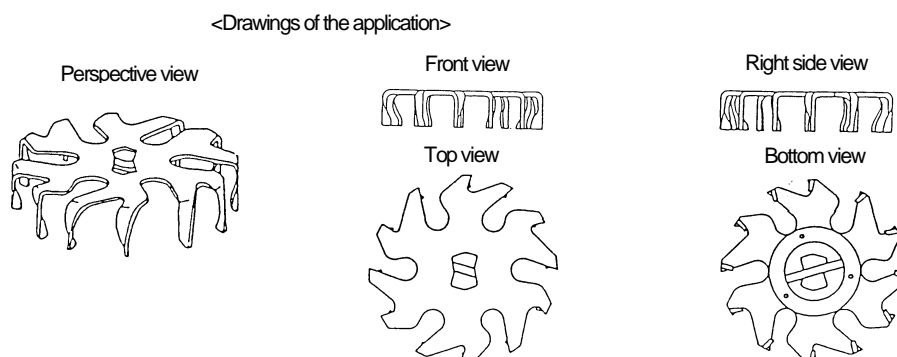


[Case example 3] “Cutter head for electric razor”

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

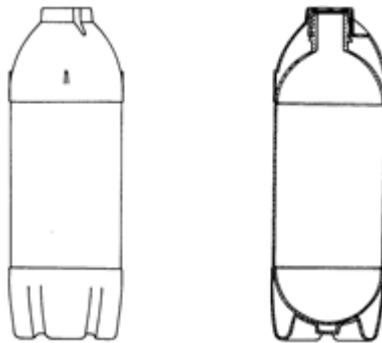
(The preceding sentences are omitted.) The present registered design exhibits inconsistency not only between the Description of the Design and the drawings but also between the drawings. Moreover, as these differences are not those which are found to be apparent errors, the design in the application 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.

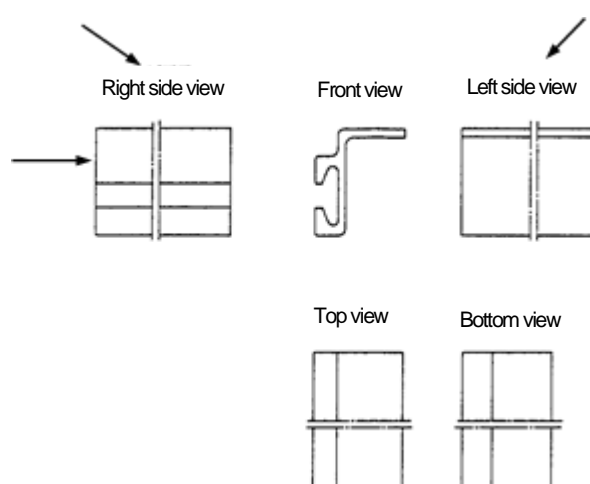
[Case example 2] “Design which changes due to the way the article, etc. functions”
(design which has movable elements)

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.

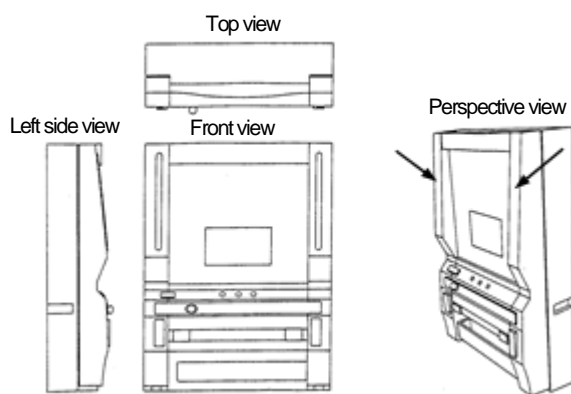
Accordingly, an amendment to correct the improper descriptions to provide the drawings with no such description does not fall under an amendment to change the gist of the design.



[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.

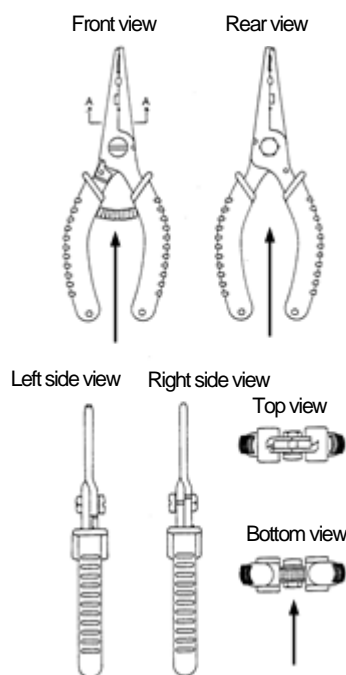
Accordingly, an amendment to correct the improper descriptions to provide the drawings with no such description does not fall under an amendment to change the gist of the design.



[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.

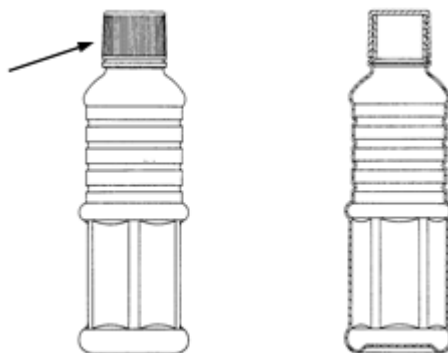
Accordingly, an amendment to correct the improper descriptions to provide the rear view with no such description by putting a spring part to the rear view does not fall under an amendment to change the gist of the design.



[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



42. 01

Handling of a design that was publicly known

Article 3, paragraph (1), item (i) of the Design Act stipulates to the effect that a design that was publicly known in Japan or a foreign country, prior to the filing of the application for design registration, lacks novelty.

1. Design which is not treated as a design that was publicly known

A registered design prior to the issue date of the Registered Design Bulletin is not treated as a design that was publicly known even if it has completed the registration of establishment of a design right, because it is found doubtful that the registered design can be used as information that serves as the basis for the application of the provisions referred to in Article 3, paragraph (1), item (i) of the Design Act as a design publicly known in general.

2. Approach to handling of a design which falls under a design that was publicly known

In a case where a design falls under a design that was publicly known, the examiner should present all of the following information to the applicant in a specific manner:

- (1) Articles, etc. embodying the design that was publicly known, and their shapes, etc.; and
- (2) The fact that the said design was in reality known to unspecified persons as a non-confidential design.

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.

42. 47**Case where the application of the provisions of Article 4, paragraph (2) of the Design Act is sought based on a pattern which has been published prior to the filing of an application for design registration**

As it is prescribed in the provisions of Article 4, paragraph (2) of the Design Act, the content which was published must be a design only ^(Note). Therefore, if a creator of a design discloses only a pattern as a part of the design created by the creator, the pattern does not fall under the design which, contrary to the wish of the person with the right to register the design or due to that person's actions, came to fall under the provisions of Article 3, paragraph (1), item (i) or (ii) of the Design Act.

(Note) As the provisions of the exception to lack of novelty of a design aim to provide a remedy to "a person with the right to register the design," the application of the provisions also to the case where only a pattern, i.e., an unregistrable design, of the design in question is published is not allowable in light of the original purpose sought in the Design Act for protecting created designs.

44.04**Relationship between the conversion of an application for design registration and Article 9 of the Design Act**

If an application for design registration is converted to a patent application pursuant to the provisions of Article 46, paragraph (2) of the Patent Act or an application for design registration is converted to an application for utility model registration pursuant to the provisions of Article 10, paragraph (2) of the Utility Model Act, the original application for design registration is deemed to be withdrawn (Patent Act 46(4), Utility Act 10(5)). Accordingly, the original application is not treated as a prior application or as an application for design registration filed on the same date, and in this case the provisions of Article 9, paragraph (1) or paragraph (2) of the Design Act do not apply.

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:

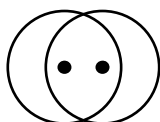
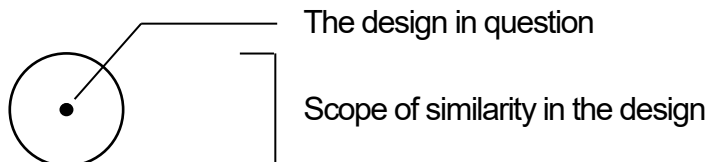
- No withdrawal is made of the designs which have not been selected;
- There are multiple designs having a relationship in which one design designates the other as a principal design and vice versa and it is impossible to define a fundamental design; etc.

(4) Decision

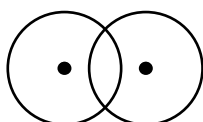
- [i] If a relationship between a principal design and its related designs or that between a fundamental design and the related designs associated with the fundamental design is established and if no other reasons for rejection are found for these designs, a decision of registration is made for the principal 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]

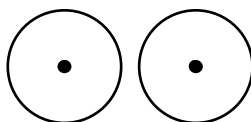
In the following explanations, each drawing is used as that representing the meaning below respectively.



Relationship in which the designs are similar

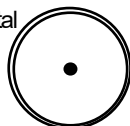


Relationship in which the designs are not similar (with some overlapping found in the scopes)

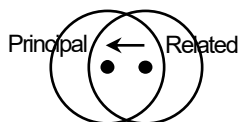


Relationship in which the designs are not similar (with no overlapping found in the scopes)

Fundamental

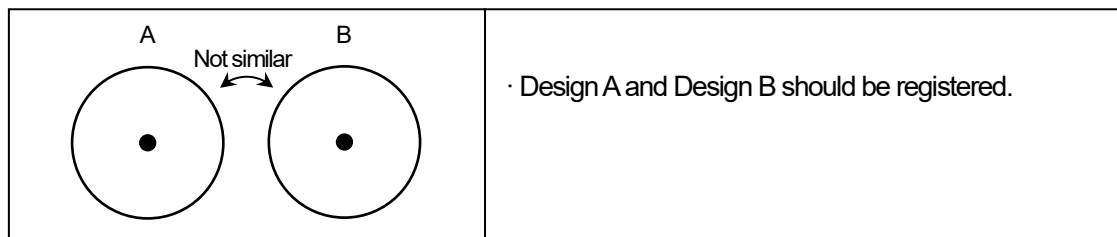


Fundamental design

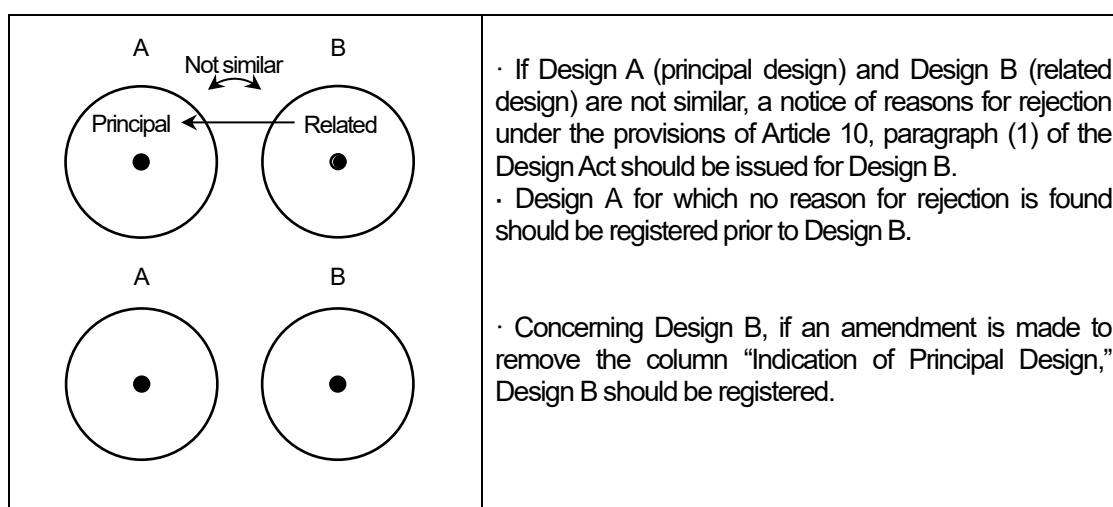


Relationship between the principal design and its related design

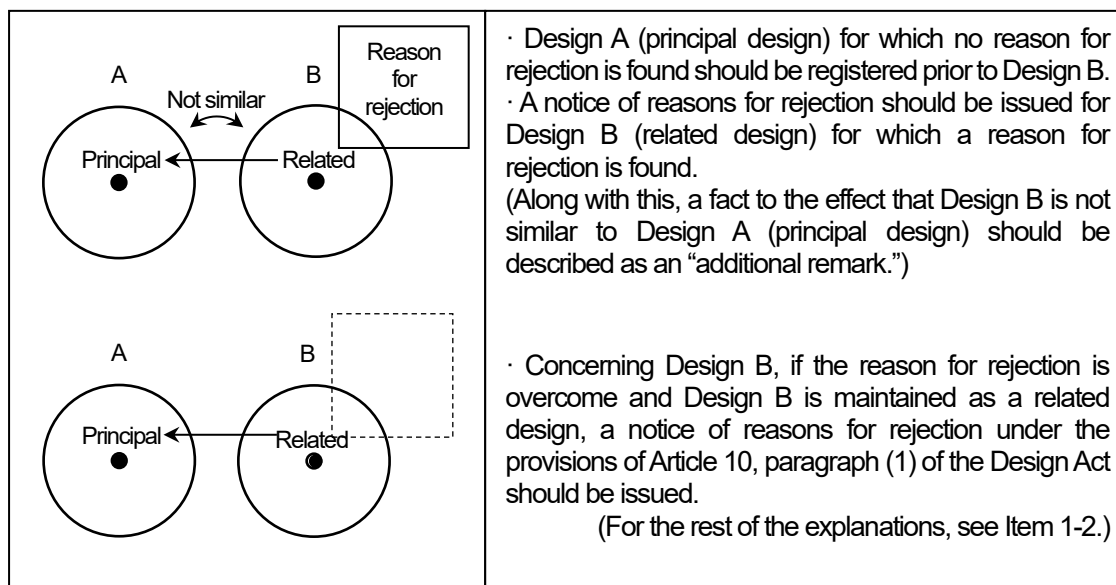
1-1. Two designs which are not similar and whose applications have been filed on the same date (with no principal design-related design relationship)



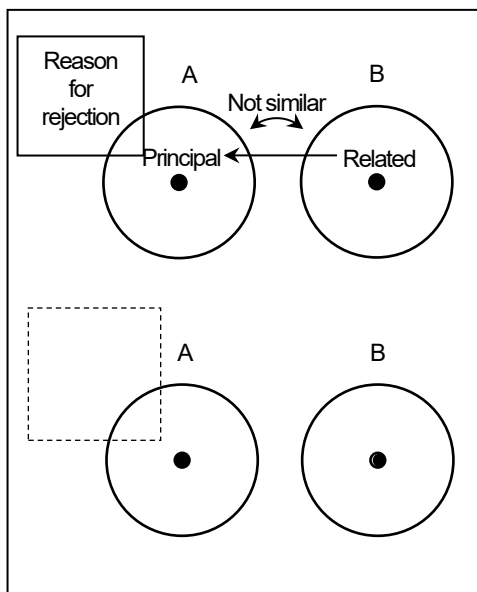
1-2. Two designs which are not similar and whose applications have been filed on the same date (applications for a principal design and its related design)



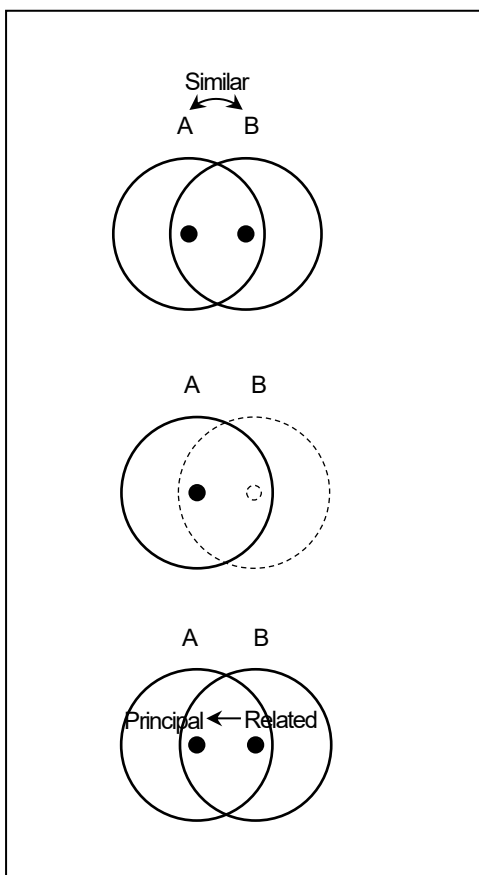
1-3. Two designs which are not similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the related design)



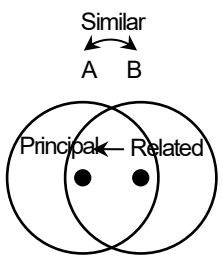
1-4. Two designs which are not similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the principal design)

| | |
|---|--|
|  | <ul style="list-style-type: none"> · A notice of reasons for rejection should be issued for Design A (principal design). · 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. <ul style="list-style-type: none"> · Concerning Design A, if the reason for rejection is overcome, Design A should be registered. · Concerning Design B, if an amendment is made to remove the column "Indication of Principal Design," Design B should be registered. |
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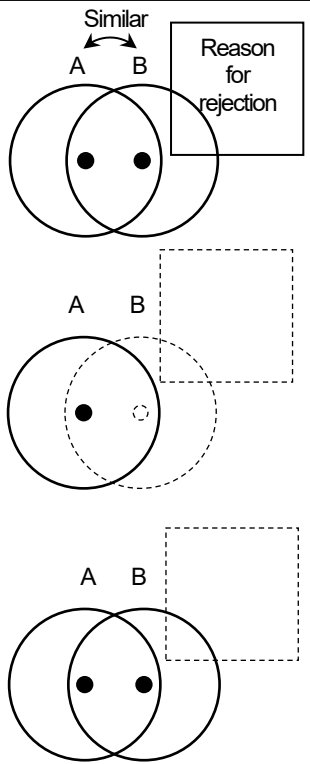
2-1. Two designs which are similar and whose applications have been filed on the same date (with no principal design-related design relationship)

| | |
|---|---|
|  | <ul style="list-style-type: none"> · 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. · 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. <ul style="list-style-type: none"> · 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. · 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. <ul style="list-style-type: none"> · 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. |
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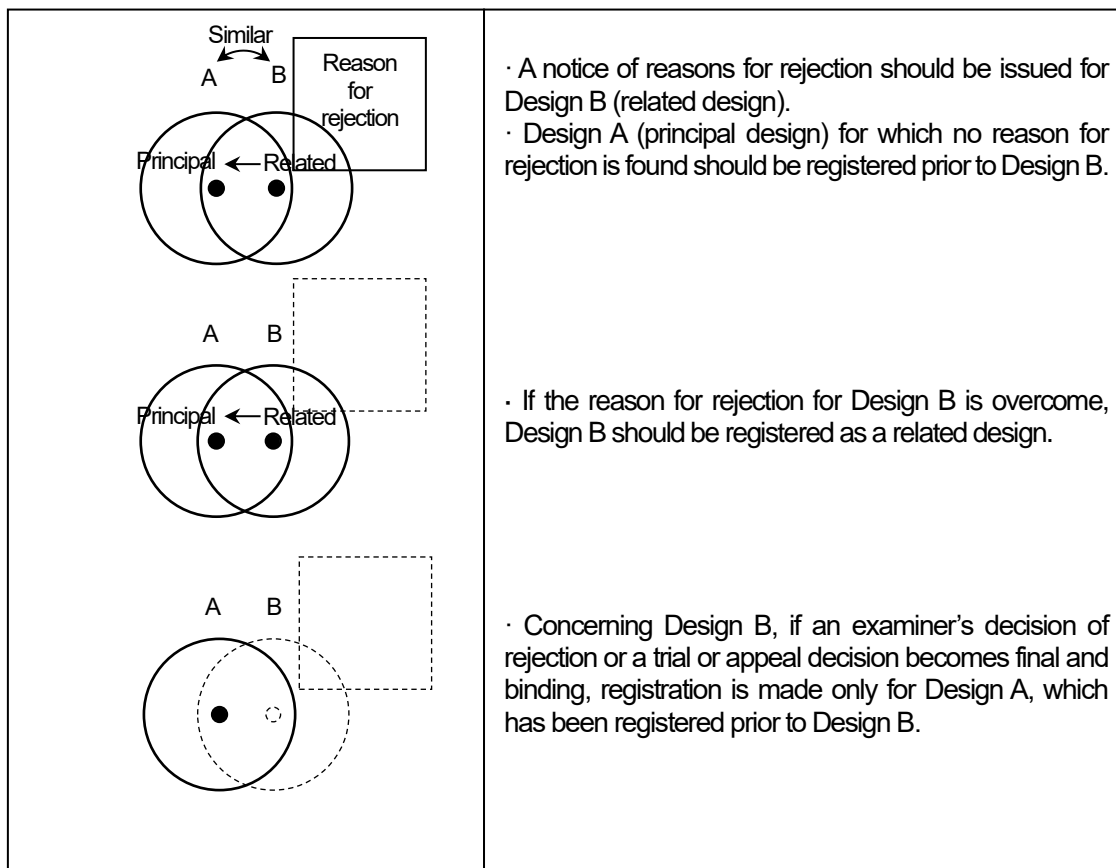
2-2. Two designs which are similar and whose applications have been filed on the same date (applications for a principal design and its related design)

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|  | <ul style="list-style-type: none"> · 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. |
|---|--|

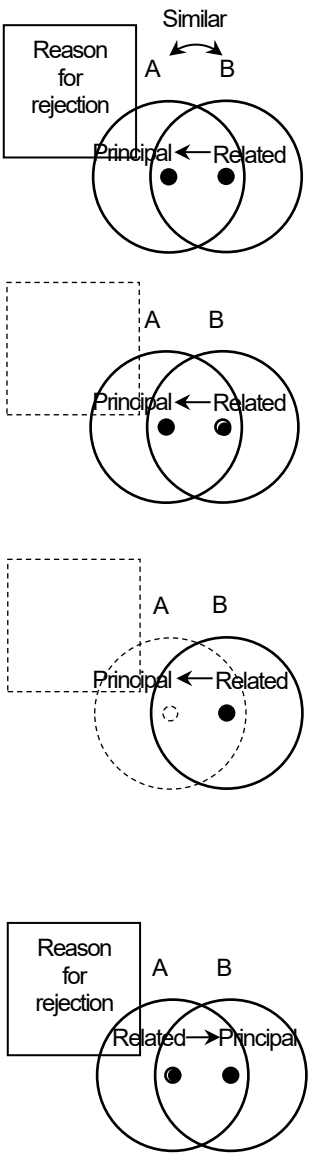
2-3. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for one of the designs)

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|--|---|
|  | <ul style="list-style-type: none"> · A notice of reasons for rejection should be issued for Design B for which a reason for rejection is found. · A “wait notice” should be issued for Design A which may need a discussion depending on the results concerning Design B. · 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. · 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.) |
|--|---|

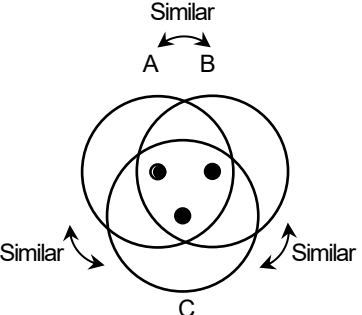
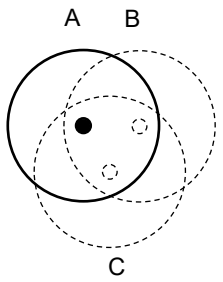
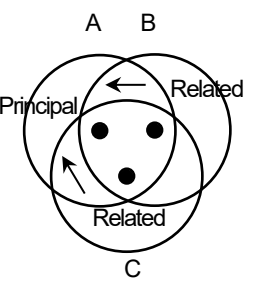
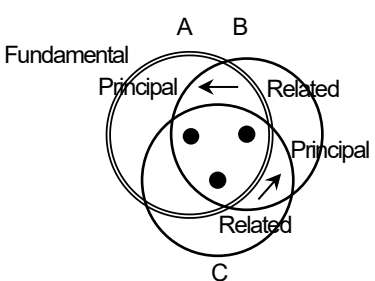
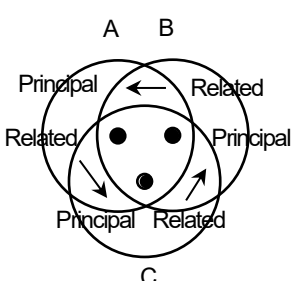
2-4. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the related design)



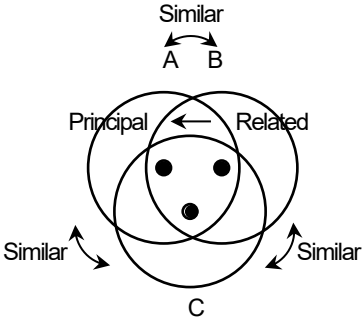
2-5. Two designs which are similar and whose applications have been filed on the same date (in a case where a reason for rejection is found for the principal design)

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|  <p>The diagrams illustrate the following scenarios:</p> <ul style="list-style-type: none"> Diagram 1: Two overlapping circles, A (left) and B (right). A box labeled 'Reason for rejection' points to circle A. An arrow labeled 'Similar' points from A to B. Inside the intersection, an arrow points from 'Principal' (under A) to 'Related' (under B). Diagram 2: Similar to Diagram 1, but the 'Reason for rejection' box is dashed, indicating it has been overcome. Both circles A and B are now solid. Diagram 3: Similar to Diagram 2, but circle A is dashed, indicating its rejection is final and binding. Circle B remains solid. Diagram 4: Similar to Diagram 1, but an arrow labeled 'Related' points from circle B to circle A, and the 'Reason for rejection' box is solid, indicating a new reason for rejection has been found for Design A. | <ul style="list-style-type: none"> · A notice of reasons for rejection should be issued for Design A (principal design). · A “wait notice” should be issued for Design B (related design). <ul style="list-style-type: none"> · 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. <ul style="list-style-type: none"> · 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. · In contrast, if an amendment is made to remove the indication of the principal design, Design B should be registered. <ul style="list-style-type: none"> · 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.) |
|---|--|

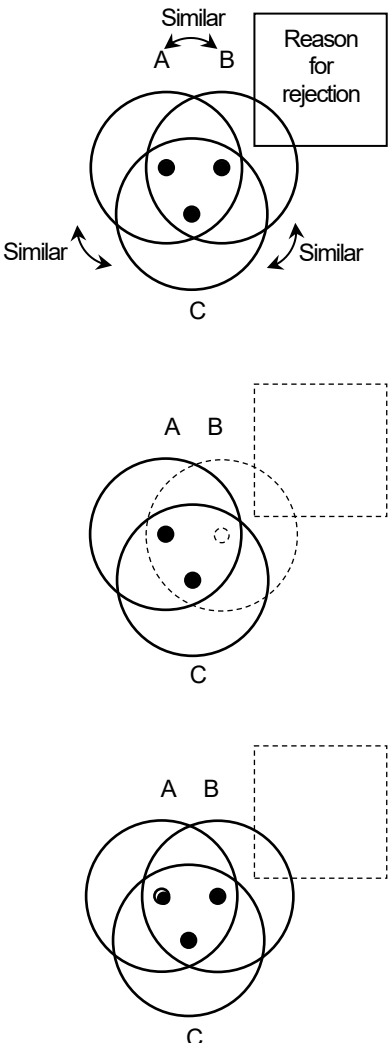
3-1. Three designs which are similar to each other and whose applications have been filed on the same date (with no principal design-related design relationship)

| | |
|--|--|
|      | <ul style="list-style-type: none"> · 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.) · 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. · 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. · 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. · 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. |
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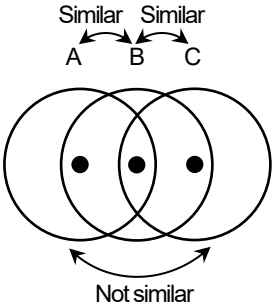
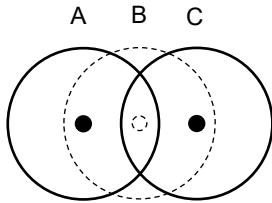
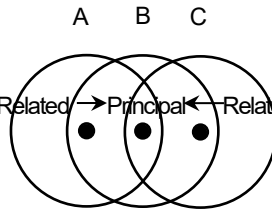
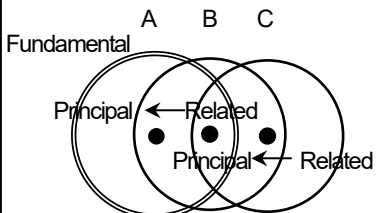
3-2. Three designs which are similar to each other and whose applications have been filed on the same date (applications in which two of the designs have a relationship between a principal design and its related design)

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|---|--|
|  | <ul style="list-style-type: none"> 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.) |
|---|--|

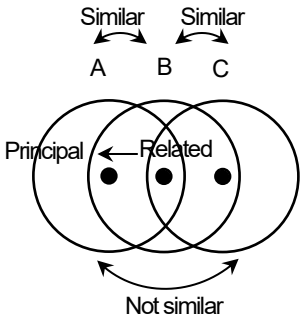
3-3. Three designs which are similar to each other and whose applications have been filed on the same date (in a case where a reason for rejection is found for one of the designs)

| | |
|---|---|
|  | <ul style="list-style-type: none"> A notice of reasons for rejection should be issued for Design B for which a reason for rejection is found. 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. 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.) 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.) |
|---|---|

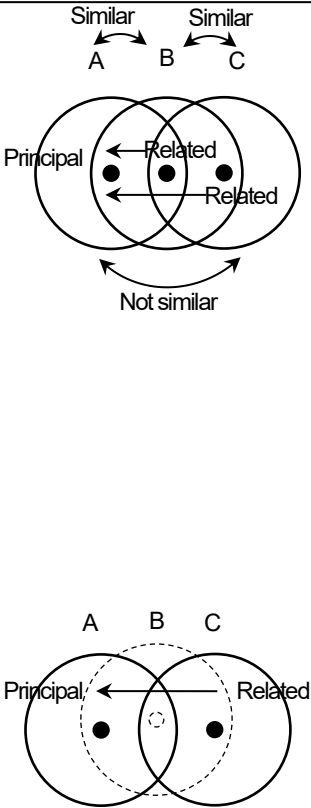
4-1. Three designs which are similar or not similar and whose applications have been filed on the same date (with no principal design-related design relationship)

| | |
|--|--|
|  <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</p> <p>Principal ← Related</p> | <ul style="list-style-type: none"> · An order for discussion is issued on the relationship between Designs A and B and that between Designs B and C, respectively. · 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. · 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. · 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. |
|--|--|

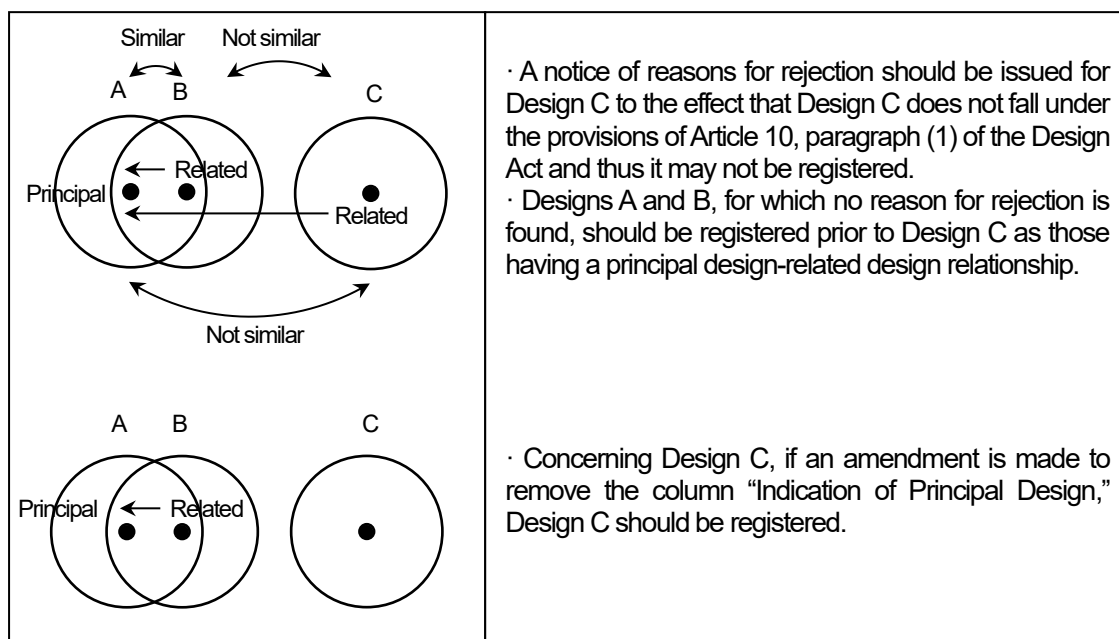
4-2. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (1))

| | |
|---|--|
|  | <ul style="list-style-type: none"> · 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.) A “wait notice” should be issued for Design A. <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"> · Design C which is not similar to Principal Design A requires a discussion on its relationship with Design B. · 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.) · A “wait notice” should be issued for Design A. <ul style="list-style-type: none"> · 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. <p>(For the rest of the explanations, see Item 4-1.)</p> |
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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))

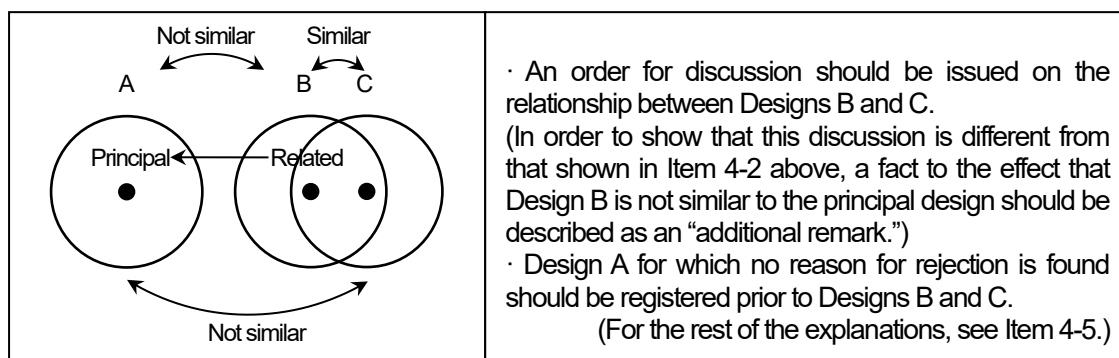


4-5. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (4))

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|--|---|
| | <ul style="list-style-type: none"> · Designs B and C which are not similar to the principal design may not be registered as a related design. · 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.”) · Design A for which no reason for rejection is found should be registered prior to Designs B and C. |
| | <ul style="list-style-type: none"> · 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. |
| | <ul style="list-style-type: none"> · 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. |
| | <ul style="list-style-type: none"> · 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. |

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

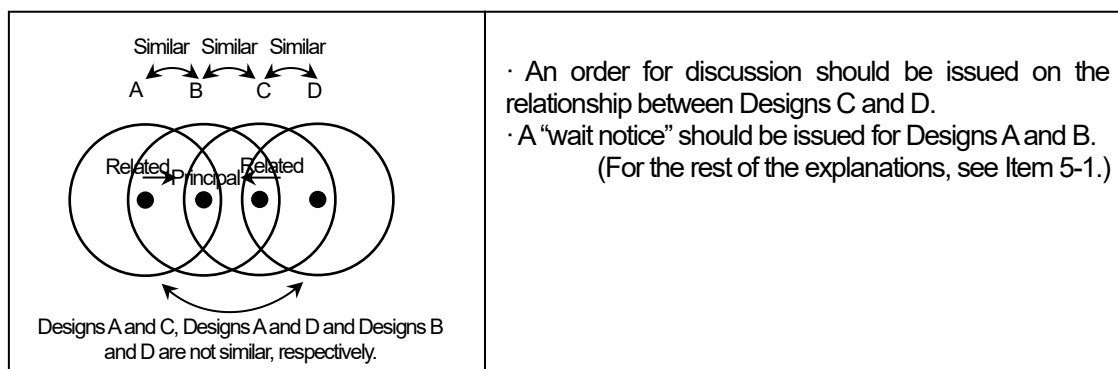
4-6. Three designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (5))



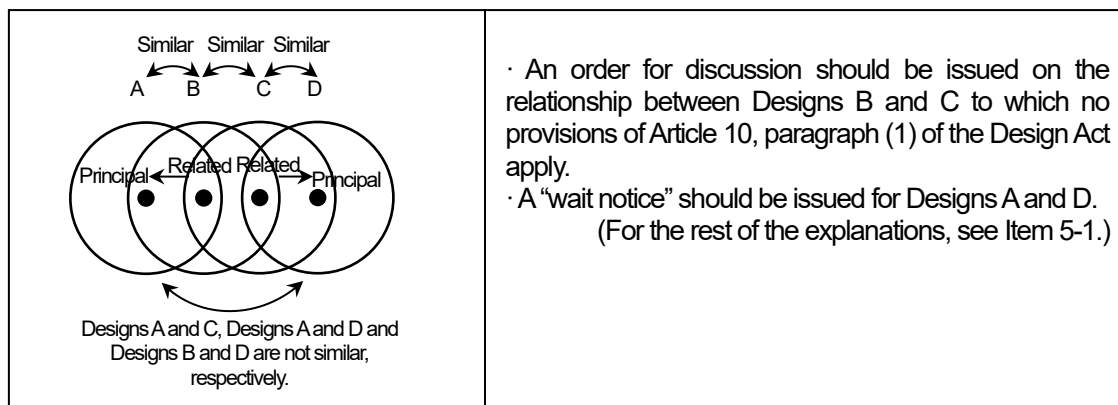
5-1. Four designs which are similar or not similar and whose applications have been filed on the same date (with no principal design-related design relationship)

| | |
|--|---|
| <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> <p>A B C D</p> <p>Fundamental</p> <p>Principal Principal Related</p> <p>Principal Principal Related</p> <p>Fundamental</p> <p>A B C D</p> <p>Related Principal Related</p> <p>Principal Principal Related</p> | <ul style="list-style-type: none"> · 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. · 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. · 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. · 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. |
|--|---|

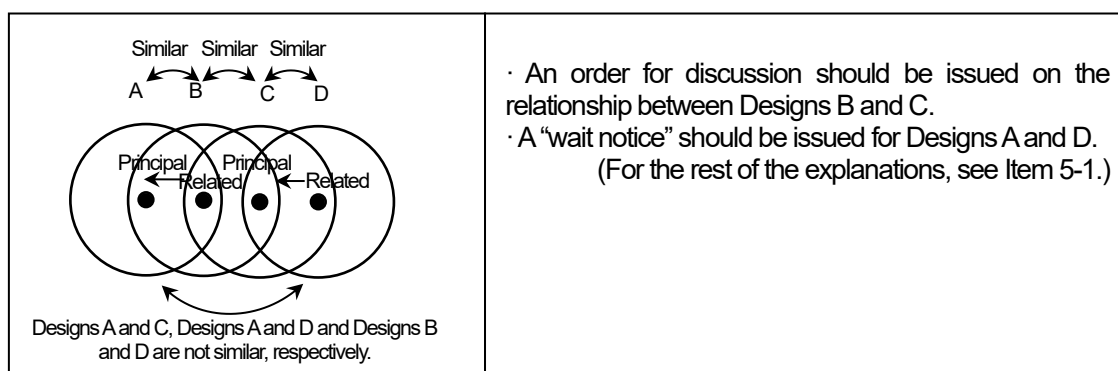
5-2. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (1))



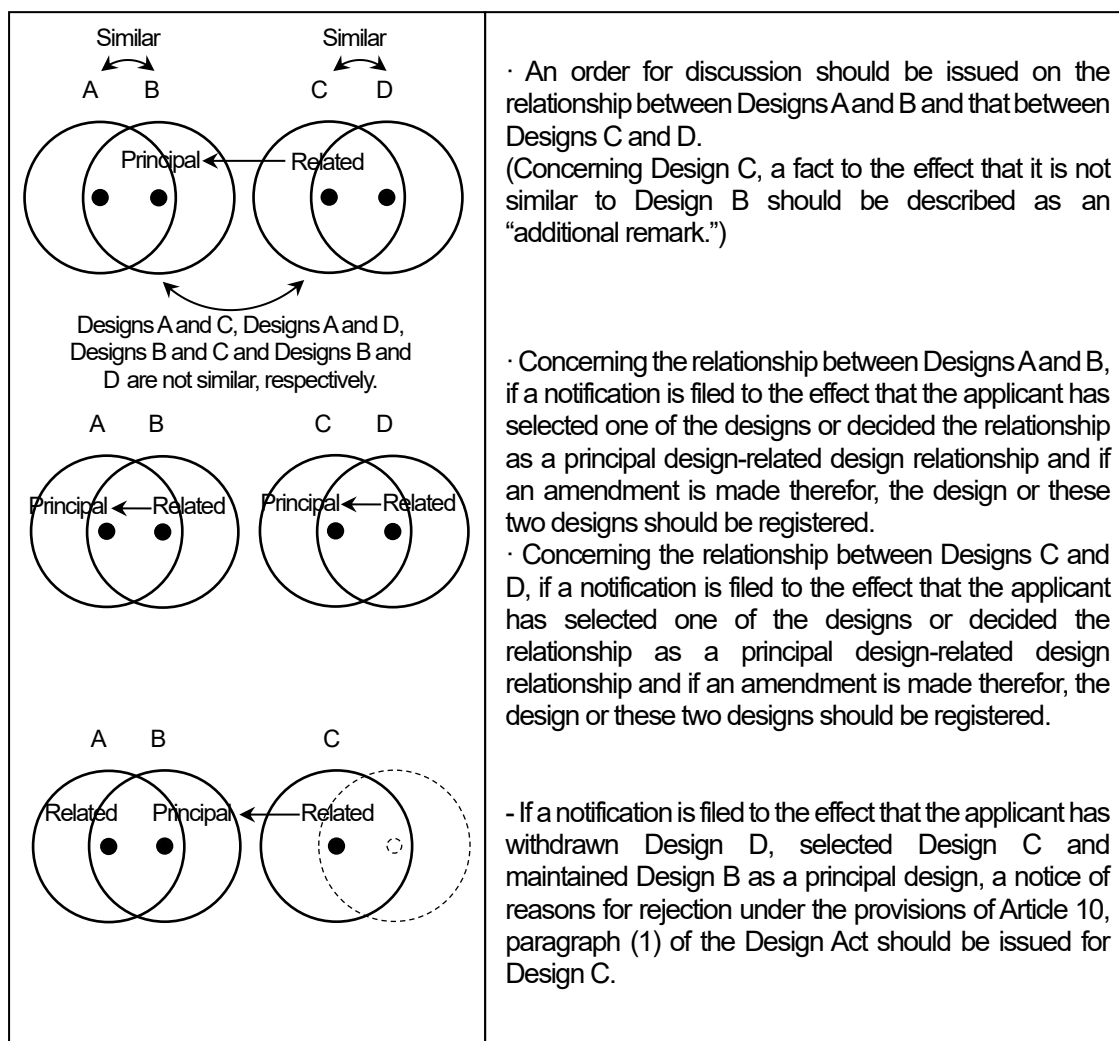
5-3. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (2))



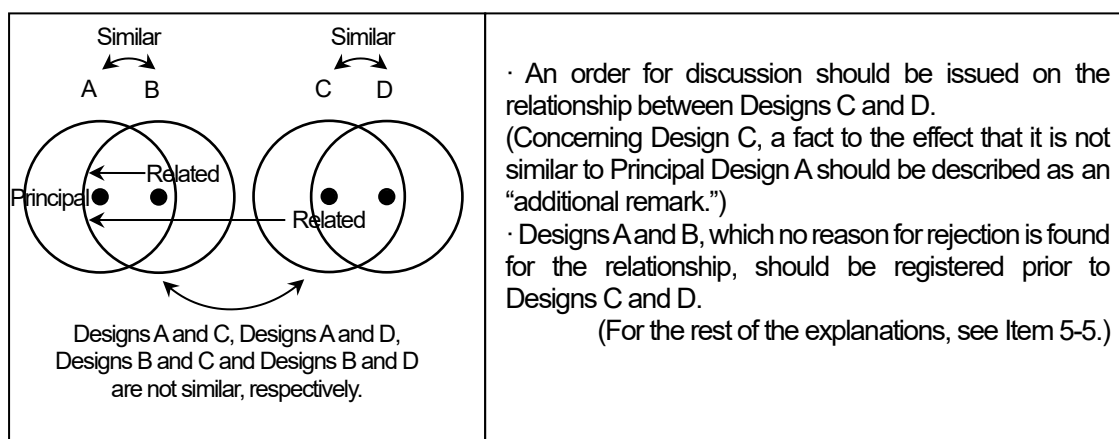
5-4. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design-related design relationship (3))



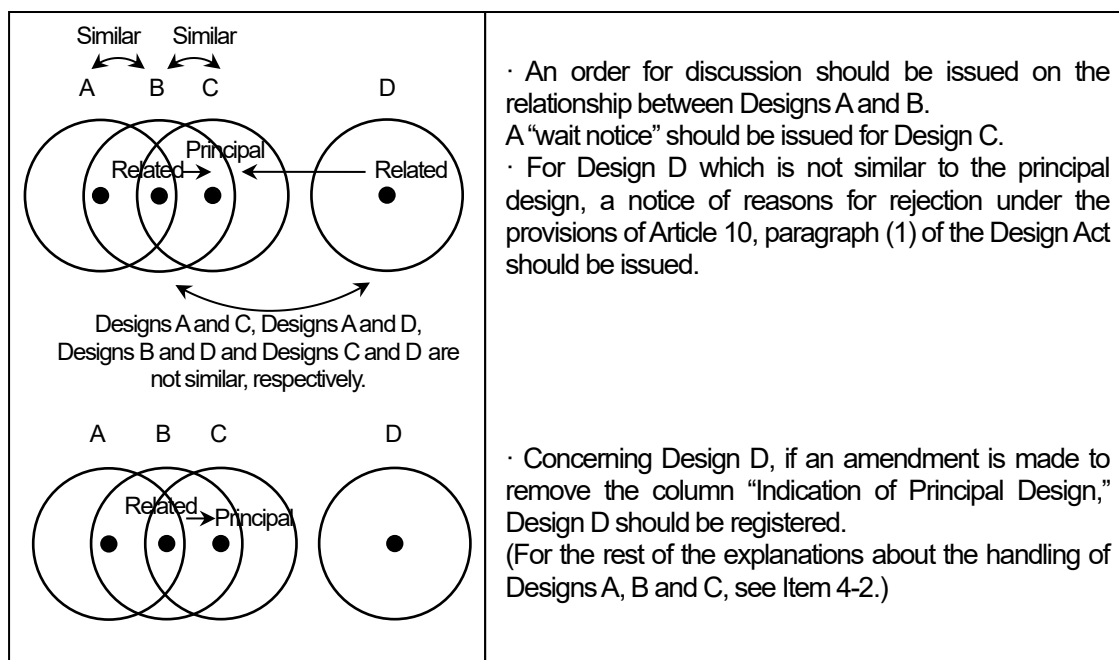
5-5. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (4))



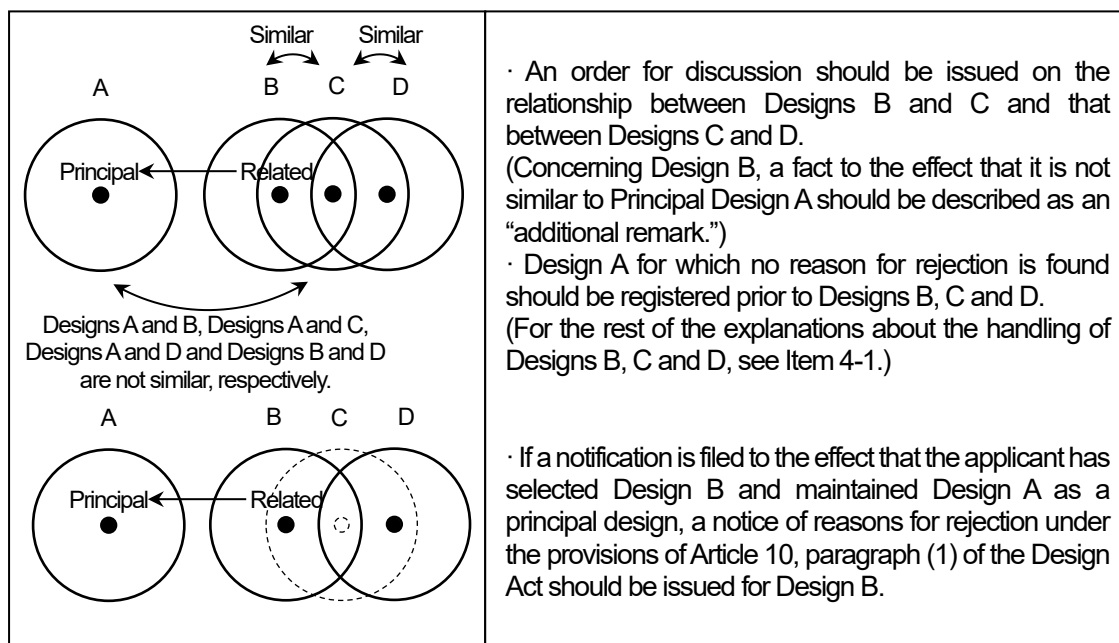
5-6. Four designs which are similar or not similar and whose applications have been filed on the same date (with a principal design–related design relationship (5))



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))



44.06

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 different dates

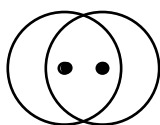
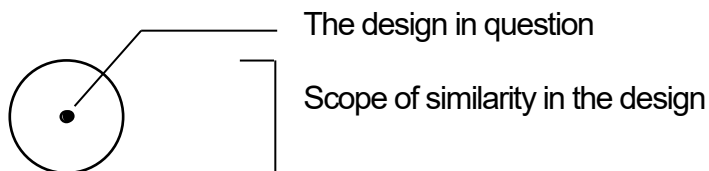
<Principles in handling>

- (1) If two or more applications for design registration for similar designs are filed by the same person on different dates, the design involving the application for design registration for which no reason for rejection is found and which has been filed on the earliest date should be registered.
- (2) Concerning the later application for design registration, if: the application is filed on the date before the lapse of 10 years from the filing date of the application for design registration for its fundamental design (as for the application for which the effect of priority claim is permitted, 10 years from its priority date); the application is filed as an application having a relationship between a principal design and its related design or a relationship between a fundamental design (Note 1) and its related designs associated with the fundamental design; and such relationship is established (Note 2), then the later application should not be subject to discussion, notwithstanding the provisions of Article 9, paragraph (2) of the Design Act.

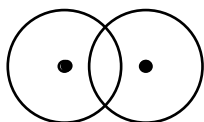
(Note 1) The “fundamental design” refers to a design which the applicant has first selected as a principal design. In other words, it is a “principal design” which is not a related design of any other design.

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

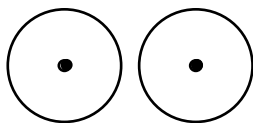
[Explanatory notes] In the following explanations, each drawing is used as that representing the meaning below respectively.



Relationship in which the designs are similar

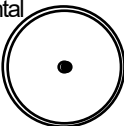


Relationship in which the designs are not similar (with some overlapping found in the scopes)



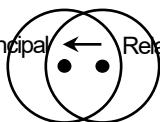
Relationship in which the designs are not similar (with no overlapping found in the scopes)

Fundamental



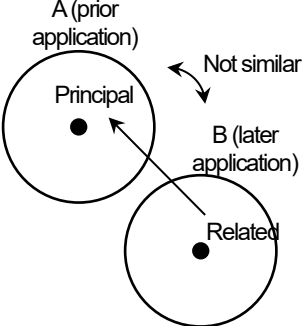
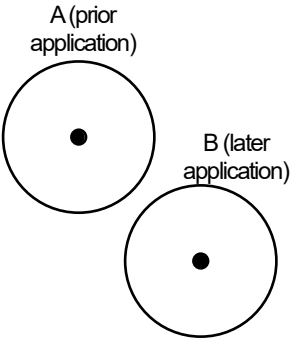
Fundamental design

Principal ← Related

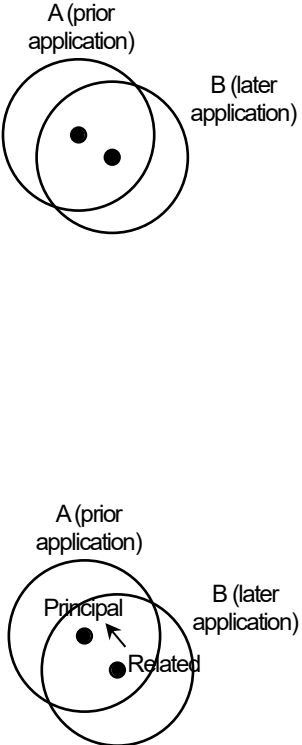


Relationship between the principal design and its related design

1. Two designs which are not similar and whose applications have been filed on different dates (with a principal design--related design relationship)

| | |
|--|--|
|  <p>A (prior application)</p> <p>Principal</p> <p>Not similar</p> <p>B (later application)</p> <p>Related</p>  <p>A (prior application)</p> <p>B (later application)</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · If Design B in the later application as a related design is not similar to the 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 B in the later application. <ul style="list-style-type: none"> · Concerning Design B in the later application, if an amendment is made to remove the column "Indication of Principal Design," Design B in the later application should be registered. |
|--|--|

2. Two designs which are similar and whose applications have been filed on different dates (with no principal design--related design relationship)

| | |
|---|---|
|  <p>The diagram consists of two overlapping circles. The upper circle is labeled 'A (prior application)' and the lower circle is labeled 'B (later application)'. Within the overlapping region, there are two dots. The upper dot is labeled 'Principal' and the lower dot is labeled 'Related'.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · If no establishment of a design right is registered for Design A in the prior application, a “wait notice” should be issued for Design B in the later application. · If the establishment of a design right is registered for Design A in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design A in the prior application) above as its principal design, the reasons for rejection will be overcome.”) · Concerning Design B in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, Design B in the later application should be registered. |
|---|---|

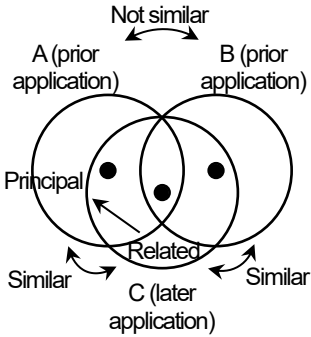
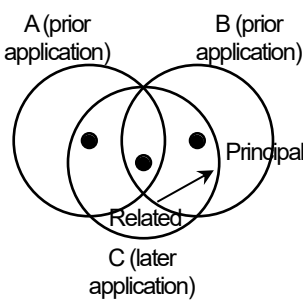
3. Three designs which are similar to each other and whose applications have been filed on different dates (with a principal design–related design relationship)

| | |
|---|---|
| <p>The top diagram shows three overlapping circles labeled A (prior application), B (prior application), and C (later application). Arrows labeled 'Similar' point from A to B, A to C, and B to C. The middle diagram shows A as the 'Principal' design, B as 'Related' to A, and C as 'Related' to both A and B. The bottom diagram shows A as the 'Fundamental' and 'Principal' design, B as 'Related' to A, and C as 'Related' to both A and B.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that both Designs A and B in the prior applications are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design A in the prior application) or the design in Design Registration No. YYYYYYYY (Design B in the prior application) above as its principal design, the reasons for rejection will be overcome.”) · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, Design C in the later application should be registered. · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, Design C in the later application should be registered. · In addition, if Design C in the later application as originally filed specifies Design A in the prior application or Design B in the prior application as a principal design as shown in the left column, Design C in the later application should be registered, without issuing a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act, which would be issued if the other design in the prior application is found to be a cited design. |
|---|---|

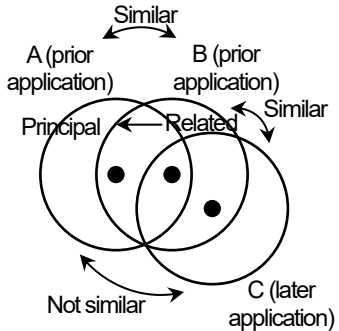
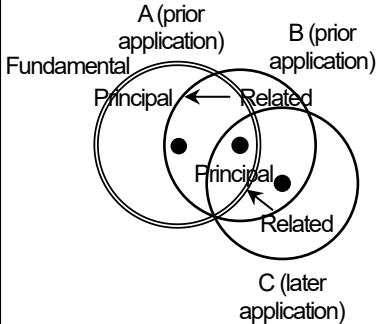
4-1. Three designs which are similar or not similar and whose applications have been filed on different dates (with no principal design–related design relationship (1))

| | |
|--|--|
| | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that both Designs A and B in the prior applications are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, even if an amendment is made to this application for design registration to correct it to an application for a related design in which any one of the registered designs above is selected as a principal design, the other registered design may not be subject to application of the provisions of Article 10, paragraph (1) of the Design Act. Accordingly, the application for design registration may not be registered.”) · If an amendment is made to Design C in the later application to correct it to an application for a related design in which either Design A in the prior application or Design B in the prior application is selected as a principal design, Design C in the later application should be rejected based on the ground that the other design in the prior application exists. |
|--|--|

4-2. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (1))

| | |
|--|---|
|   | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, both Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, Design C in the later application may not be registered since it falls under the provisions of Article 9, paragraph (1) of the Design Act for its similarity to Design B in the prior application and thus it may not be registered. Accordingly, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that Design B in the prior application is found to be a cited design. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, even if an amendment is made to this application for design registration to correct it to an application for a related design in which the design in Design Registration No. XXXXXXXX (Design B in the prior application) above is selected as a principal design, the design of this present application is also similar to the design in Design Registration No. YYYYYYYY (Design A in the prior application) and it is not allowable for Design A in the prior application and Design B in the prior application to be subject to application of the provisions of Article 10, paragraph (1) of the Design Act at the same time. Accordingly, the application for design registration may not be registered.”) · If an amendment is made to Design C in the later application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be newly issued based on that ground that Design A in the prior application is found to be a cited design. |
|--|---|

4-3. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (2))

| | |
|--|--|
|   | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, both Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that both Designs A and B in the prior applications are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design B in the prior application) above as its principal design, the reasons for rejection will be overcome.”) · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, Design C in the later application should be registered. |
|--|--|

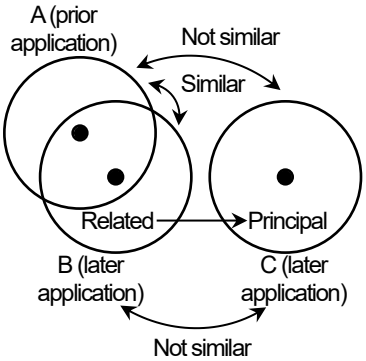
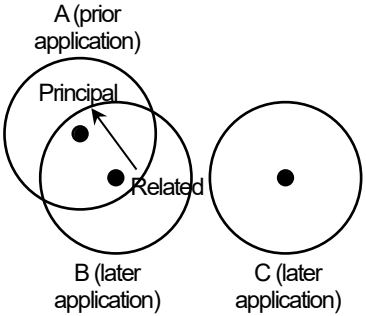
4-4. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (3))

| | |
|--|---|
| <p>The top diagram shows three overlapping circles: A (prior application), B (prior application), and C (later application). A is labeled 'Principal' and B is labeled 'Related'. A and B are connected by a double-headed arrow labeled 'Similar'. B and C are connected by a double-headed arrow labeled 'Similar'. A and C are connected by a double-headed arrow labeled 'Not similar'.</p> <p>The bottom diagram shows three overlapping circles: A (prior application), B (prior application), and C (later application). A is labeled 'Fundamental' and B is labeled 'Principal'. A and B are connected by a double-headed arrow labeled 'Related'. B and C are connected by a double-headed arrow labeled 'Related'. A and C are connected by a double-headed arrow labeled 'Principal'.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, both Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that Design B is found to be a cited design. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is found to be not similar to the design in Design Registration No. XXXXXXXX (Design A in the prior application) filed as its principal design. Moreover, if an amendment is made to this application for design registration to specify the design in Design Registration No. YYYYYYYY (Design B in the prior application) above as its principal design, the reasons for rejection will be overcome.”) · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, Design C in the later application should be registered. |
|--|---|

4-5. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (4))

| | |
|--|--|
| <p>The diagram illustrates design relationships between three applications: A (prior-prior application), B (prior application), and C (later application). The top part shows three overlapping circles. Circle A is labeled 'A (prior-prior application)' and contains a dot labeled 'Principal'. Circle B is labeled 'B (prior application)' and contains a dot labeled 'Related'. Circle C is labeled 'C (later application)' and contains a dot labeled 'Principal'. Arrows indicate 'Similar' relationships between A and B, and between B and C. An arrow labeled 'Not similar' points from circle A to circle C. Below this, a second diagram shows a 'Fundamental' circle containing circle A, which contains circle B, which contains circle C. All dots are labeled 'Principal'.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior-prior application or Design B in the prior application, both Design A in the prior-prior application and Design B in the prior application should be registered. · A “wait notice” should be issued for Design C in the later application. · If the establishment of a design right is registered for Design A in the prior-prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that Design B in the prior applications is found to be a cited design. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design B in the prior application) above as a principal design, the reasons for rejection will be overcome.”) · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, Design C in the later application should be registered. |
|--|--|

4-6. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (5))

| | |
|---|---|
|  <p>A (prior application)</p> <p>Not similar</p> <p>Similar</p> <p>Related</p> <p>Principal</p> <p>B (later application)</p> <p>C (later application)</p> <p>Not similar</p>  <p>A (prior application)</p> <p>Principal</p> <p>Related</p> <p>B (later application)</p> <p>C (later application)</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design C in the later application, both Design A in the prior application and Design C in the later application should be registered. · A “wait notice” should be issued for Design B in the later application. · If the establishment of a design right is registered for Design A in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application based on the ground that Design A in the prior application is found to be a cited design. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is found to be not similar to the design in Design Application No. XXXX-XXXXXX (Design B in the later application) filed as a principal design” and that “[I]f an amendment is made to this application for design registration to specify the design in Design Registration No. YYYYYYY (Design A in the prior application) above as a principal design, the reasons for rejection will be overcome.”) · Concerning Design B in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, Design B in the later application should be registered. |
|---|---|

4-7. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (6))

| | |
|--|--|
| | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · An order for discussion should be issued on the relationship between Design B in the later application and Design C in the later application. (In this order, concerning Design B in the later application, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is found to be similar to the design in Design Application No. XXXX-XXXXXX (Design Registration No. XXXXXXXX) (Design A in the prior application) filed as a principal design. Accordingly, it should be noted that if an amendment is made to the present application for design registration (Design B in the later application) to correct it to an application for a related design in which the design in Design Application No. YYYY-YYYYYY (Design C in the later application) is selected as a principal design, this falls under a reason for rejection under the provisions of Article 9, paragraph (1) of the Design Act based on the ground that Design Application No. XXXX-XXXXXX (Design Registration No. XXXXXXXX) (Design A in the prior application) is found to be a cited design.”) |
| | <ul style="list-style-type: none"> · Concerning Design C in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design B in the prior application is selected as a principal design, Design C in the later application should be registered. |
| | <ul style="list-style-type: none"> · If Design C in the later application is withdrawn, Design B should be registered. |
| | <ul style="list-style-type: none"> · If Design B in the later application is withdrawn, Design C should be registered. |

4-8. Three designs which are similar or not similar and whose applications have been filed on different dates (with no principal design–related design relationship (2))

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| <p>A (prior application)</p> <p>Not similar</p> <p>Similar</p> <p>B (later application)</p> <p>C (later application)</p> <p>Similar</p> <p>A (prior application)</p> <p>Principal</p> <p>Related</p> <p>B (later application)</p> <p>C (later application)</p> <p>A (prior application)</p> <p>B (later application)</p> <p>C (later application)</p> <p>A (prior application)</p> <p>Principal</p> <p>Related</p> <p>B (later application)</p> <p>C (later application)</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · A “wait notice” should be issued for Design B in the later application and Design C in the later application. · If the establishment of a design right is registered for Design A in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application based on the ground that Design A in the prior application exists. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is also found to be similar to the design in the applicant’s own application for design registration (i.e., that in Design Application No. XXXX-XXXXXX (Design C in the later application)) filed on the same date as the filing date of this application for design registration, and this falls under the provisions of Article 9, paragraph (2) of the Design Act as well.”) · A “wait notice” should be issued for Design C in the later application to the effect that Design C in the later application is similar only to Design B filed on the same date. · If Design C in the later application is withdrawn and an amendment is made to Design B in the later application to correct it to an application for a related design in which Design A is selected as a principal design, Design B in the later application should be registered. · If Design B in the later application is withdrawn, Design C in the later application should be registered. · Concerning Design B in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design A is selected as a principal design, an order for discussion should be issued on the relationship between Design B in the later application and Design C in the later application. (In this order, concerning Design B in the later application, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is found to be similar to the design in Design Application No. XXXX-XXXXXX (Design Registration No. XXXXXXXX) (Design A in the prior application) filed as a principal design.”) <p>(For the rest of the explanations, see Item 4-7.)</p> |
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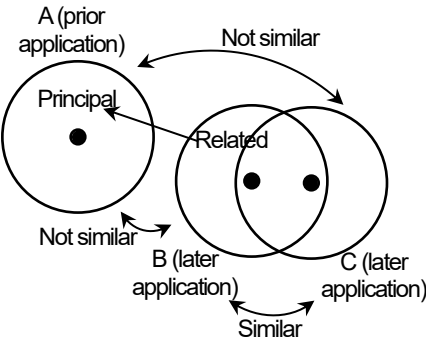
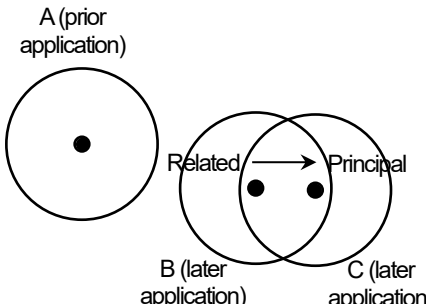
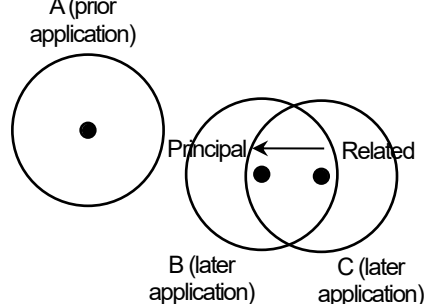
4-9. Three designs which are similar or not similar and whose applications have been filed on different dates (in a case where a reason for rejection is found for one of the designs (1))

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| <p>Diagram 1: A (prior application) overlaps with B (later application) and C (later application). B and C overlap. A is labeled "Not similar" to B and C. B and C are labeled "Similar". A box labeled "Reason for rejection" points to A.</p> <p>Diagram 2: A (prior application) overlaps with B (later application). B overlaps with C (later application). A is labeled "Principal" and B is labeled "Related".</p> <p>Diagram 3: A (prior application) overlaps with B (later application). B overlaps with C (later application). A is labeled "Principal" and B is labeled "Related".</p> <p>Diagram 4: A (prior application) overlaps with B (later application). B overlaps with C (later application). A is labeled "Principal" and B is labeled "Related".</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · A "wait notice" should be issued for Design B in the later application. · A notice of reasons for rejection should be issued for Design C in the later application. <p>· If the establishment of a design right is registered for Design A in the prior application and a decision of rejection becomes final and binding for Design C in the later application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application based on the ground that Design A in the prior application exists.</p> <p>· Concerning Design B in the later application, if an amendment is made to the application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, Design B in the later application should be registered.</p> <p>· If the establishment of a design right is registered for Design A in the prior application and a reason for rejection for Design C in the later application is overcome, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application based on the ground that Design A is found to be a cited design. (In this notice, concerning Design B in the later application, an "additional remark" should be described to the effect that "[T]he design in this application for design registration is found to be similar to the design in the applicant's own application for design registration (i.e., that in Design Application No. XXXX-XXXXXX (Design C in the later application)) filed on the same date as the filing date of this application for design registration, and this falls under the provisions of Article 9, paragraph (2) of the Design Act as well.")</p> <p>· A "wait notice" should be issued for Design C in the later application to the effect that Design C in the later application is similar to Design B in the later application filed on the same date.</p> <p>· If an amendment is made to Design B in the later application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, an order for discussion should be issued on the relationship between Design B in the later application and Design C in the later application.</p> <p>(For the rest of the explanations, see Item 4-7.)</p> |
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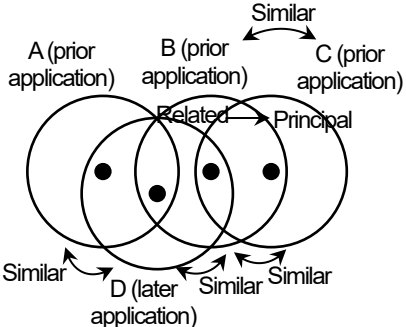
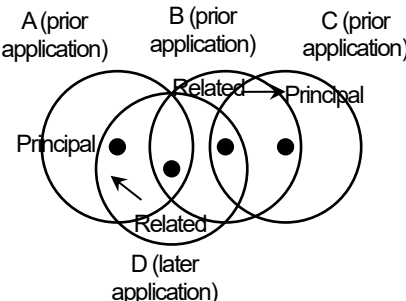
4-10. Three designs which are similar or not similar and whose applications have been filed on different dates (in a case where a reason for rejection is found for one of the designs (2))

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| | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A in the prior application should be registered. · A notice of reasons for rejection should be issued for Design B in the later application. · A “wait notice” should be issued for Design C in the later application. <ul style="list-style-type: none"> · If the establishment of a design right is registered for Design A in the prior application and a decision of rejection becomes final and binding for Design B in the later application, Design C in the later application should be registered. <ul style="list-style-type: none"> · If the establishment of a design right is registered for Design A in the prior application and a reason for rejection for Design B in the later application is overcome, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design B in the later application based on the ground that Design A in the prior application is found to be a cited design. (In this notice, concerning Design B in the later application, an “additional remark” should be described to the effect that “[T]he design in this application for design registration is found to be similar to the design in the applicant’s own application for design registration (i.e., that in Design Application No. XXXX-XXXXXX (Design C in the prior application)) filed on the same date as the filing date of this application for design registration, and this falls under the provisions of Article 9, paragraph (2) of the Design Act as well.”) · A “wait notice” should be issued for Design C in the later application to the effect that Design C in the later application is similar to Design B in the later application filed on the same date. <ul style="list-style-type: none"> · If an amendment is made to Design B in the later application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, an order for discussion should be issued on the relationship between Design B in the later application and Design C in the later application. <p>(For the rest of the explanations, see Item 4-7.)</p> |
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4-11. Three designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (7))

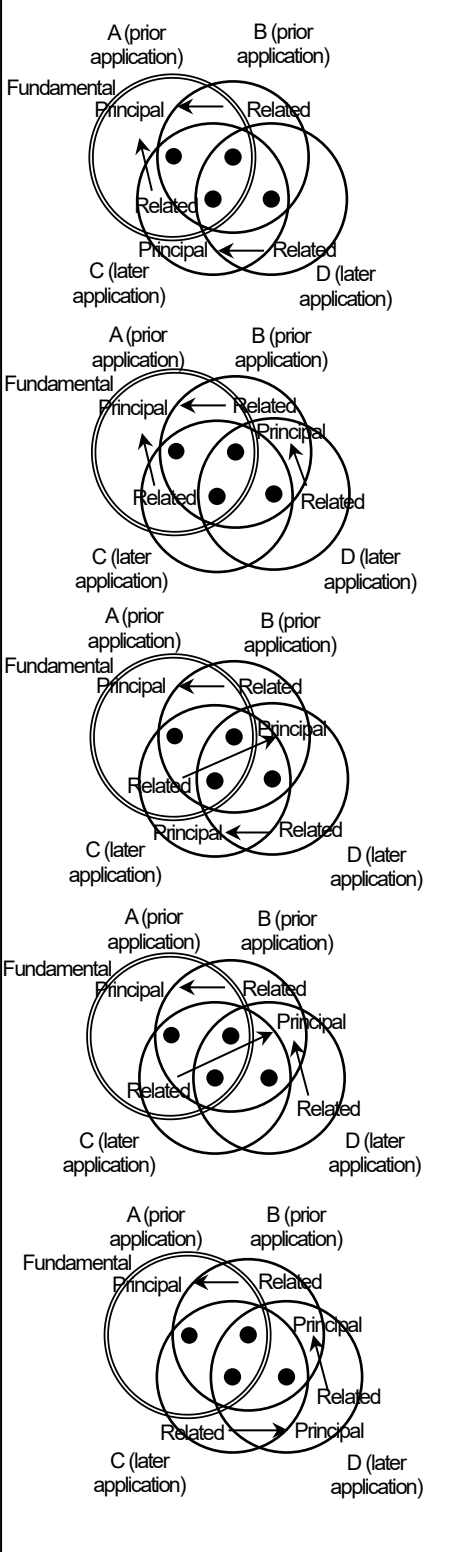
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|  <p>A (prior application)</p> <p>Principal</p> <p>Not similar</p> <p>Related</p> <p>Not similar</p> <p>B (later application)</p> <p>C (later application)</p> <p>Similar</p>  <p>A (prior application)</p> <p>Related</p> <p>Principal</p> <p>B (later application)</p> <p>C (later application)</p>  <p>A (prior application)</p> <p>Principal</p> <p>Related</p> <p>B (later application)</p> <p>C (later application)</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design A should be registered. · An order for discussion should be issued on the relationship between Design B in the later application and Design C in the later application. (In this order, concerning Design B in the later application, an “additional remark” should be described to the effect that “[I]n addition, the design of this application for design registration is found to be not similar to the design in Design Application No. XXXX-XXXXXX (Design Registration No. XXXXXXXX) (Design A in the prior application) filed as a principal design.”) · If an amendment is made to Design B in the later application to correct it to an application for a related design in which Design C is selected as a principal design or if an amendment is made to remove the column “Indication of Principal Design” of Design B in the later application and to correct Design C in the later application to an application for a related design in which Design B in the later application is selected as a principal design, then Design B in the later application and Design C in the later application should be registered. |
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5-1. Four designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (1))

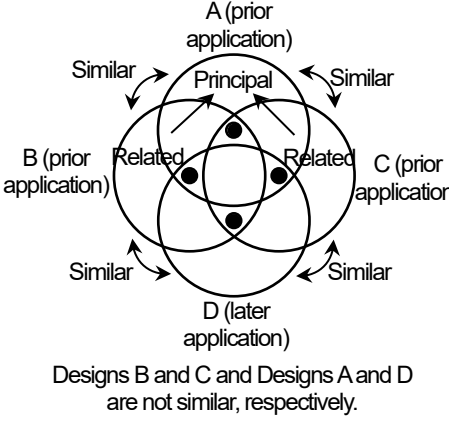
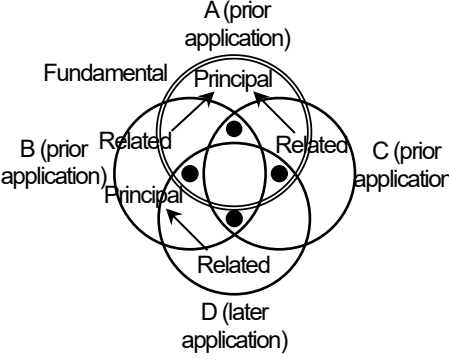
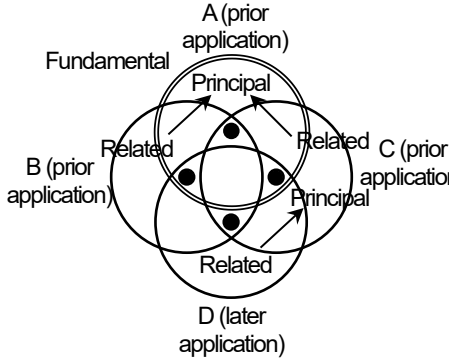
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|  <p>Designs A and B, Designs A and C and Designs D and C are not similar, respectively.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design B in the prior application or Design C in the prior application, all these designs should be registered. · A “wait notice” should be issued for Design D in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design D in the later application based on the ground that both Designs A and B are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, even if an amendment is made to this application for design registration to correct it to an application for a related design in which the design in Design Registration No. XXXXXXXX (Design A in the prior application) above is selected as a principal design, the design of this present application is also similar to the design in Design Registration No. YYYYYYYY (Design B in the prior application) above and thus a reason for rejection under Article 9, paragraph 1 of the Design Act would not be overcome. Accordingly, this application for design registration may not be registered.”) · If an amendment is made to Design D in the later application to correct it to an application for a related design in which Design A in the prior application is selected as a principal design, Design D in the later application should be rejected for a reason for rejection under the provisions of Article 9, paragraph (1) of the Design Act based on the ground that Design B is found to be a cited design. |
|  <p>Designs A and B, Designs A and C and Designs D and C are not similar, respectively.</p> | |

5-2. Four designs which are similar or not similar and whose applications have been filed on the different dates (with a principal–related design relationship (2))

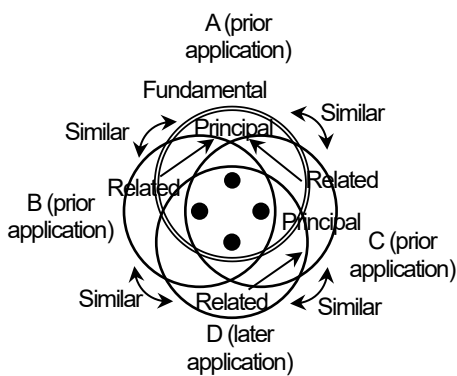
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| <p>Designs B and C are similar, while Designs A and D are not similar.</p> | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application or Design B in the prior application, both Designs A and B in the prior applications should be registered. · A “wait notice” should be issued for Design C in the later application and for Design D in the later application. · If the establishment of a design right is registered for Design A in the prior application and for Design B in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design C in the later application based on the ground that Design A in the prior application and Design B in the prior application are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design A in the prior application) or the design in Design Registration No. YYYYYYYY (Design B in the prior application) above as a principal design, the reasons for rejection will be overcome.”) · For Design D in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued based on the ground that Design B is found to be a cited design. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design B in the prior application) above as a principal design, the reasons for rejection will be overcome.”) |
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|  <p>The five diagrams illustrate the following relationships:</p> <ul style="list-style-type: none"> Diagram 1: A is Fundamental Principal; B is Fundamental Principal; C is Fundamental Principal; D is Fundamental Principal. Diagram 2: A is Fundamental Principal; B is Fundamental Principal; C is Fundamental Principal; D is Fundamental Principal. Diagram 3: A is Fundamental Principal; B is Fundamental Principal; C is Fundamental Principal; D is Fundamental Principal. Diagram 4: A is Fundamental Principal; B is Fundamental Principal; C is Fundamental Principal; D is Fundamental Principal. Diagram 5: A is Fundamental Principal; B is Fundamental Principal; C is Fundamental Principal; D is Fundamental Principal. | <p>Design C in the later application and Design D in the later application should be registered in each of the following five cases where:</p> <ul style="list-style-type: none"> ➤ An amendment is made to: correct Design C in the later application to an application for a related design in which Design A in the prior application is selected as a principal design; and correct Design D in the later application to an application for a related design in which Design C in the later application is selected as a principal design; ➤ An amendment is made to: correct Design C in the later application to an application for a related design in which Design A in the prior application is selected as a principal design; and correct Design D in the later application to an application for a related design in which Design B in the prior application is selected as a principal design; ➤ An amendment is made to: correct Design C in the later application to an application for a related design in which Design B in the prior application is selected as a principal design; and correct Design D in the later application to an application for a related design in which Design C in the later application is selected as a principal design; ➤ An amendment is made to: correct Design C in the later application to an application for a related design in which Design B in the prior application is selected as a principal design; and correct Design D in the later application to an application for a related design in which Design B in the prior application is selected as a principal design; and ➤ An amendment is made to: correct Design C in the later application to an application for a related design in which Design D in the later application is selected as a principal design; and correct Design D in the later application to an application for a related design in which Design B in the prior application is selected as a principal design. <p>In addition, if Design C in the later application as originally filed and Design D in the later application as originally filed designate a principal design as shown in the left column, Design C in the later application and Design D in the later application should be registered without issuing a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act, for either Design C in the later application or Design D in the later application, which would be issued if a prior application is found to be a cited design, or without issuing an order for discussion on the relationship between Design C in the later application and Design D in the later application.</p> |
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5-3. Four designs which are similar or not similar and whose applications have been filed on different dates (with a principal design–related design relationship (3))

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|  <p>Designs B and C and Designs A and D are not similar, respectively.</p>   | <ul style="list-style-type: none"> · If no reason for rejection is found for Design A in the prior application, Design B in the prior application or Design C in the prior application, all these designs should be registered. · A “wait notice” should be issued for Design D in the later application. · If the establishment of a design right is registered for Design B in the prior application and for Design C in the prior application, a notice of reasons for rejection under the provisions of Article 9, paragraph (1) of the Design Act should be issued for Design D in the later application based on the ground that Design B in the prior application and Design C in the prior application are found to be cited designs. (In this notice, an “additional remark” should be described to the effect that “[I]n addition, if an amendment is made to this application for design registration to specify the design in Design Registration No. XXXXXXXX (Design B in the prior application) or the design in Design Registration No. YYYYYYYY (Design C in the prior application) above as a principal design, the reasons for rejection will be overcome.”) · Not only if an amendment is made to correct Design D in the later application to an application for a related design in which Design B in the prior application is selected as a principal design, but also if an amendment is made to correct Design D in the later application to an application for a related design in which Design C in the prior application is selected as a principal design, Design D in the later application should be registered. <p>(Even in a case where the designs in the prior applications, which are found to be similar to the design in the present application, are not similar to each other, if these designs in the prior applications fall under a group of related designs associated with one single fundamental design, the design in the present application may be registered.)</p> |
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6. Four designs which are similar and whose applications have been filed on different dates (with a principal design–related design relationship)

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|  <p>The diagram shows four overlapping circles representing designs A, B, C, and D. Design A is at the top, B at the left, C at the right, and D at the bottom. Arrows indicate relationships: 'Fundamental' from A to B, 'Principal' from A to C, 'Related' from B to C, 'Similar' from B to D, 'Principal' from C to D, and 'Related' from D to A. A central dot is labeled 'Principal'. Below the diagram, it states: 'Designs A, B, C and D are similar to each other.'</p> | <ul style="list-style-type: none"> · Design A in the prior application, Design B in the prior application, Design C in the prior application and Design D in the later application should be registered. <p>(Design D in the later application, i.e., an application for a related design in which Design C in the prior application is selected as a principal design, is similar not only to Design A in the prior application which is a fundamental design but also to Designs B and C in the prior applications which are other related designs.)</p> <p>However, regardless of such cases, if Design D in the later application is similar to Design C in the prior application which is designated as a principal design, Design D in the later application should be registered as a related design in which Design C in the prior application is selected as a principal design, without making any determination on its similarity to Design A in the prior application or Design B in the prior application.)</p> |
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<Reference> Two or more designs which are similar or not similar and whose applications have been filed on different dates (with the extinguishment of design rights)

