

Chapter I Principles of Examination and Flow of Examination

1. Principles of examination

The examiner should conduct a substantive examination as to whether or not a design right ought to be granted for an application for design registration. The examiner is required to make a fair determination based on a high level of expert knowledge.

In conducting an examination, the examiner should take the following points in particular into consideration.

- (1) Consistent examination should be conducted according to the examination guidelines, etc., while taking into consideration the ensuring of promptness, accuracy, and fairness.
- (2) Effort should be made to maintain and further improve the quality of examination with regard to search of prior designs, etc. and determination on the requirements for registration, etc.
- (3) Efficient examination should be conducted, while taking into consideration the ensuring of communication with the applicants and their agents (hereinafter referred to as the “applicant(s)”).

2. Flow of examination

When examining an application for design registration, the examiner should follow the process below. For details of each process, see Chapter II “Design Examination Process.” Also, the main flow of the substantive examination is illustrated in Figure 1.

(1) Finding of the design in an application for design registration

First, the examiner should find the design in the application for design registration (hereinafter referred to as the “filed design” in some case). In finding the design, the examiner should make a comprehensive determination based on the statement in the application and drawings, etc. attached to the application. While finding the design in an application, the examiner should also consider whether the design falls under an industrially applicable design (main paragraph of Article 3, paragraph (1) of the Design Act), and whether it is an application for design registration that has been filed for each design (Article 7 of the Design Act). Furthermore, the examiner should also consider whether subject matter of an application for a design for a set of articles complies with the requirements set forth in Article 8 of the Design Act, and whether subject matter of an application for interior design complies with the requirements set forth in Article 8-2 of the Design Act.

(2) Search of prior designs, etc.

The examiner should conduct a search of prior designs, etc. to find (i) prior designs and (ii) shapes, patterns, or colors, or any combination thereof (shapes, etc.), or

graphic images that were publicly known, described in a distributed publication or made publicly available through an electric telecommunication line in Japan or a foreign country (hereinafter (i) and (ii) are collectively referred to as “prior designs, etc.”) which contribute to determining the requirements for registration, such as novelty and creative difficulty of the filed design (the items of Article 3, paragraph (1), Article 3, paragraph (2), and Article 3-2 of the Design Act), the requirements for a prior application (Article 9 of the Design Act), and the requirements for a related design (Article 10 of the Design Act) with regard to the design in the application.

(3) Review of novelty, creative difficulty, etc.

The examiner should review whether or not the contents of the prior designs, etc. found in a search of prior designs, etc. constitute a reason for refusal relating to the requirements for registration, such as novelty and creative difficulty of the filed design (the items of Article 3, paragraph (1), Article 3, paragraph (2), and Article 3-2 of the Design Act), or the requirements for a prior application (Article 9 of the Design Act).

In addition, the examiner should also review whether or not the application for design registration falls under any of the reasons for refusal provided in the items of Article 17 of the Design Act.

(4) Notice of reasons for refusal and orders for consultation

Where a reason for refusal is found as a result of the review, the examiner should give notice of reasons for refusal (Article 50 of the Patent Act as applied *mutatis mutandis* pursuant to Article 19 of the Design Act). The reasons for refusal should be stated in plain language insofar as possible by describing the key points in an easy to understand manner.

Where two or more applications for design registration have been filed for identical or similar designs on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9, paragraph (2) of the Design Act, and an order for consultation is issued in the name of the Commissioner of the Patent Office under Article 9, paragraph (4) of the Design Act.

In case of an international application for design registration, a notice of reasons for refusal or an order for consultation is given through a notification of refusal to the International Bureau (Article 12 of the Geneva Act).

(5) Review of written opinions and written amendments of proceedings, etc.

Where a written opinion or a written amendment of proceedings has been submitted, the examiner should carefully read the written opinion and fully understanding its contents before reviewing the respective matters asserted in the written opinion, or should sufficiently review the contents of the written amendment of proceedings, and should determine whether the reason for refusal that had been indicated previously has been overcome.

Where a written amendment of proceedings has been submitted, the examiner should compare the design as originally filed and the design as amended, and should confirm that the gist of the statement in the application and drawings, etc. attached to the application as originally filed has not been changed.

Where an amendment made to the application or drawings, etc. changes the gist of design, the examiner should dismiss the amendment by a ruling.

(6) Examiner's decision

Where no reason for refusal is found, the examiner should render a decision of registration. Where the reason for refusal has been overcome through submission of a written opinion or a written amendment of proceedings, and no other reason for refusal is found, the examiner should render a decision of registration (Article 18 of the Design Act).

Furthermore, upon reviewing the contents of a written opinion or a written amendment of proceedings, where the examiner determines that a notified reason for refusal has still not been overcome, the examiner should render a decision of refusal (Article 17 of the Design Act). When rendering a decision of refusal, the examiner should state in plain language the specific reasons why the notified reason for refusal has not been overcome.

Figure 1 Main flow of examination

