

Chapter II Design Examination Process

1. Finding of the design in an application for design registration

(1) Outline

As a prerequisite for determining whether a filed design complies with the requirements for registration, such as novelty and creative difficulty, the examiner needs to identify and understand the contents of the design. This is called “finding of the design.”

(2) Finding of the design

In finding the design in an application, the examiner should make a comprehensive determination based on the statement in the application and drawings, etc. attached to the application based on ordinary skill in the art of the design (the skill of a person skilled in the art).

A certificate and other relevant documents submitted under Article 43, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act (hereinafter referred to as “priority certificate, etc.”) proving documents submitted under Article 4, paragraph (3) of the Design Act, and feature statements are not to be used as information that serves as the basis for finding the design.

Where a statement in the application and drawings, etc. attached to the application have been amended, the examiner should also fully understand the contents of the amendment.

(3) Points to note when finding the design

When finding the design in the application, if the examiner finds any improper description in the statement in the application or drawings, etc. attached to the application, the examiner should determine whether or not it is reasonable for the improper description to be interpreted favorably in finding the specific design.

Note that even if there is no disclosure of parts which the applicant considers to be outside the scope of creation, the examiner should determine that the design is specific if the content of a single creation can be identified by perceiving the disclosed scope as the part for which the design registration is requested.

2. Search of prior designs, etc.

The examiner should conduct a search of prior designs, etc., in order to find prior designs, etc. which contribute to determining the fulfillment of 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).

Note that, where the art of the filed design cannot be specified, the examiner should conduct a review before the search of prior designs, etc. as to whether the design is an industrially applicable design (main paragraph of Article 3, paragraph (1) of the Design Act), whether the design does not comprise two or more designs (Article 7 of the Design Act), and in the case of a design for a set of articles, whether the design

complies with the requirements to be recognized as a design for a set of articles (Article 8 of the Design Act), and whether the design complies with the requirements to be recognized as an interior design (Article 8-2 of the Design Act), and if a reason for refusal is found, the examiner should give notice of reasons for refusal.

2.1 Reference material

Examination materials containing prior designs, etc. which contribute to determining the novelty, creative difficulty, etc. of a filed design are called “reference material.”

The examiner should find prior designs, etc. that are found to have points in common with the filed design, either as an entire design or in terms of the shape, etc. of individual parts, and record the examination materials containing the prior designs, etc. as reference material.

In addition, where there are examination materials containing prior designs, etc. which the examiner consulted to understand the filed design and the art of the design, the examiner should also record such examination materials as reference material.

2.2 Method of a search of prior designs, etc.

- (1) When filing an application for design registration, there are no mandatory items requiring the applicant is required to include such as an explanation about the shape, etc. that the applicant considers to be important in the design or about the part of the article, building or graphic image (hereinafter collectively referred to as the “article, etc.”) to which particular weight is given. Accordingly, in order to set the scope of examination materials used in the search of prior designs, etc. and to extract reference materials, before conducting the search of prior designs, etc., the examiner should first make their own inference as to the parts of the design that draw attention to shape, etc. and the extent to which they draw attention based on the statement in the application and drawings, etc. attached to the application. In making that inference, where a feature statement has been submitted, the examiner should also take the contents of that feature statement into consideration.
- (2) The examiner should conduct a search of prior designs, etc. through the database comprised of examination materials, such as applications for design registration, publicly known information (Japanese and foreign books, Japanese and foreign magazines, Japanese and foreign catalogs, design bulletins of Japanese and foreign patent offices, and Internet webpages), publications of unexamined patent applications, and publications of registered utility model applications.
- (3) Based on the examiner’s knowledge, experience and past determinations in examining applications for design registration in the art of the filed design, the examiner should set the scope of examination materials to be searched, and conduct the search with priority for fields most relevant to the filed design. In addition, the examiner should expand the scope of the search as necessary for each case as in the “Examples of expanded scope of search” below.

<Examples of expanded scope of search>

- (i) Where there is a Japanese design classification or an international design classification established under the Locarno Agreement^(Note) (hereinafter referred to as an “international design classification”) that is likely to cover articles, etc. that have commonality in their usage (purpose of use, state of use, etc.) and function with the article, etc. to the design in the filed design, the examiner should conduct a search on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international

design classification.

(Note) Officially, the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as amended on September 28, 1979

- (ii) Where there is a Japanese design classification or an international design classification that is likely to represent constituent elements of the filed design, the examiner should conduct a search on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international design classification.
- (iii) Where the filed design is a design of a component or a design for which the design registration is requested for a part of an article, etc., and there is a Japanese design classification or an international design classification that covers articles, etc. that are likely to include prior designs which have a part of the shape, etc. of the component or of the “part for which design registration is requested,” the examiner should conduct a search on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international design classification.
- (iv) Where there is a technical field of patents that is related to the article, etc. to the design of the filed design, and the shape, etc. of the article, etc. is likely to be represented in publications of unexamined patent applications and publications of registered utility model applications, etc. in that technical field, the examiner should conduct a search on publications of unexamined patent applications and publications of registered utility model applications in that technical field.
- (v) Where the filed design is unlikely to comply with the requirement for registration of creative difficulty, the examiner should conduct a search, as needed, on information that serves as the basis for determining creative difficulty.
- (vi) Where reference material is recorded for prior designs, etc. that have been found, the examiner should conduct a search on the reference material of those prior designs, etc.
- (vii) Where the applicant of an application for design registration has filed an application for design registration in the past, the examiner should conduct a search on that past application for design registration and its reference material.

2.3 Completion of a search of prior designs, etc.

Where sufficient prior designs, etc. for determining the novelty, creative difficulty, etc. have been found for the filed design, or where finding useful prior designs, etc. has become highly unlikely even if the scope of the search is expanded, the examiner should complete the search of prior designs, etc.

3. Review of novelty, creative difficulty, etc.

The examiner should review as follows 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.

3.1 Confirmation of bibliographic data of the information

In considering application of the provisions of the items of Article 3, paragraph (1) and Article 3, paragraph (2) of the Design Act, the examiner should confirm the relationship between the date on which the prior design, etc. became publicly known and the reference date for the determination on the requirements for registration, etc. of the filed design. (In considering application of the provisions of the items of Article 3, paragraph (1) and Article 3, paragraph (2) of the Design Act, the examiner should take not only the date but also the exact time into consideration.)

In considering application of the provisions of Article 3-2 and Article 9 of the Design Act, the examiner should confirm the relationship of the reference date for the determination on the requirements for registration, etc. for the filed design with the reference date for the determination on the requirements for registration, etc. and the date of publication of the design bulletin for the prior design (the design in the prior application). The examiner should also confirm the relationship of the applicant of the filed design with the applicant or holder of the design right of the prior design (the design in the prior application).

Here, the “reference date for the determination on the requirements for registration, etc.” refers to any of the following dates.

- (1) The filing date
- (2) The filing date of the first application that serves as the basis for the right of priority under the Paris Convention, etc.
- (3) The filing date of the original application in the case of a divisional application or a converted application
- (4) The date of submission of the written amendment of proceedings in the case of a new application following a ruling dismissing an amendment

Where a found prior design is a disclosed design for which application of the provisions on exception to lack of novelty (Article 4, paragraph (1) or (2) of the Design Act) is requested, the examiner should confirm whether or not the request for application of the provisions on exception to lack of novelty complies with the prescribed requirements.

3.2 Determination of similarity between designs in determining novelty, etc.

In considering reasons for refusal relating to novelty (the items of Article 3, paragraph (1) of the Design Act), prior application (Article 9 of the Design Act) or exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application (Article 3-2 of the Design Act), the examiner should make a determination by comparing the filed design with the prior design while mainly giving consideration to the following points.

- (1) In determining similarity between the filed design and the prior design cited in the notice of reasons for refusal (hereinafter referred to as the “cited design”), consumers (including traders) should be the determining entity.
- (2) The examiner should determine whether or not the usage and function of the article, etc. to the design of the filed design and that of the cited design are identical or similar. This does not require judgment of similarity based on a comparison of the detailed usage and function of the articles, etc. It is sufficient to determine that there is similarity in the usage and function of the articles, etc. if the articles, etc. have commonality in their usage (purpose of use, state of use, etc.) and function.

- (3) After confirming that the cited design is sufficiently represented to a level comparable with the filed design, and finding the common points and different points in the shape, etc. of the entire articles, etc. to the design (basic constitution) and the shape, etc. of each part of the two designs by comparing the filed design and the cited design, the examiner should conduct further individual evaluation of the common points and different points from the viewpoints in (i) and (ii) below.
- (i) Finding of whether or not the shape, etc. is the part that draws attention when observed by comparison, and evaluation of the extent to which it draws attention
 - (ii) Evaluation of the extent to which the shape, etc. draws attention in comparison to prior designs
- With regard to a design for which the design registration is requested for a part of an article, etc., after finding the common points and different points in the usage and function, position, size, scope and shape, etc. of the “part for which the design registration is requested,” the examiner should conduct further individual evaluation of the common points and different points.
- (4) The examiner should determine whether or not the designs create different aesthetic impressions on consumers (including traders) when all common points and different points between the two designs are comprehensively observed as entire designs.

3.3 Determination of creative difficulty

The examiner should determine creative difficulty (Article 3, paragraph (2) of the Design Act) by reviewing whether or not the filed design could have been easily created based on prior publicly known shapes, etc.

In determining creative difficulty, the examiner should mainly give consideration to the following points.

- (1) A person ordinarily skilled in the art of the design (a person skilled in the art) should be the determining entity for creative difficulty.
- (2) The examiner should confirm that the information that serves as the basis for determining creative difficulty is a shape, etc., graphic image or design that is publicly known, or is a shape, etc., graphic image or design that is described in a distributed publication or was made publicly available through an electric telecommunication line.
- (3) Where determining that the design was created by an ordinary technique for a person skilled in the art, the examiner should confirm evidence of a specific fact showing this.

3.4 Determination on whether or not the application for design registration falls under any of the items of Article 17 of the Design Act

The examiner should 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. For example, the examiner should review whether the filed design has any grounds of unregistrability (the items of Article 5 of the Design Act), whether applications for design registration have been filed for each design as provided by an Ordinance of the Ministry of Economy, Trade and Industry (Article 7 of the Design Act), and in the case of an application filed as a related design, whether it complies with the requirements for obtaining design registration as a related design (Article 10 of the Design Act).

4. Notice of reasons for refusal (excluding international applications for design registration)

Where a reason for refusal is found, the examiner should give notice of reasons for refusal to the applicant and should give the applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose (Article 50 of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act).

Furthermore, an extension of the time limit may be requested even after the expiration of the said time limit, but only within the time limit specified by an Ordinance of the Ministry of Economy, Trade and Industry (Article 5, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (1) of the Design Act).

4.1 Points to note when giving notice of reasons for refusal

When giving notice of reasons for refusal, taking the following points in particular into consideration, the examiner should indicate the reasons specifically so that the applicant can clearly understand the purport of the reasons for refusal.

- (1) The reasons for refusal should be stated in plain language insofar as possible by describing the key points in an easy to understand manner so as to make it easy for the applicant to understand.
- (2) With regard to a design which is not specific and which is clearly not an industrially applicable design as provided in the main paragraph of Article 3, paragraph (1) of the Design Act, the examiner should specifically indicate the improper part in the statement in the application and drawings, etc. attached to the application and the reason therefor.
- (3) Where the filed design falls under the provisions of the items in Article 3, paragraph (1), Article 3-2 or Article 9, paragraph (1) of the Design Act and does not comply with the requirements of novelty, prior application, etc., the examiner should specifically indicate the reason for the examination determination in the notification of reasons for refusal. Also, in specifying a cited design, the examiner should state information identifying the source of the cited design (document name, date of publication, issue number, volume, the relevant page, the relevant position on the page, etc.). In doing so, if the filed design is a design of a component or a design for which the design registration is requested for a part of an article, etc., the examiner should clearly indicate the part cited for making the comparison and determination as needed.

In addition, where the filed design falls under both the provision of Article 3-2 of the Design Act and the provision of Article 9, paragraph (1) of the Design Act (where the filed design and the design in the prior application are identical or similar designs for which the design registration is requested for a part of an article, etc., and their applicants are not the same), the examiner should apply the provision of Article 3-2 of the Design Act in examination practice.

However, where the prior application is an application involving a request for the design to be kept secret, and where it is necessary to wait for publication of the design bulletin after the period for which secrecy was requested has lapsed before giving notice of reasons for refusal under Article 3-2 of the Design Act, in the

interests of expediting the examination, the examiner should give notice of reasons for refusal under Article 9, paragraph (1) of the Design Act without waiting for publication of the design bulletin after the period for which secrecy was requested has lapsed.

- (4) Where the filed design falls under the provision of Article 3, paragraph (2) of the Design Act and does not comply with the requirement for registration of creative difficulty, the examiner should specifically indicate the reason for the examination determination in the notification of reasons for refusal. In doing so, the examiner should present the information that serves as the basis for determining creative difficulty and a specific fact showing that the design was created by an ordinary technique for a person skilled in the art, unless they are so obvious that such presentation is not required.

In presenting information that serves as the basis for determining creative difficulty, the examiner should state information identifying the source (document name, date of publication, issue number, volume, the relevant page, the relevant position on the page, etc.).

In addition, the examiner should apply the provision of Article 3, paragraph (2) of the Design Act only where the filed design does not fall under any of the designs provided in the items of Article 3, paragraph (1) of the Design Act.

- (5) Where the application for design registration does not comply with the requirement of one application per design provided in Article 7 of the Design Act, the examiner should specifically indicate in the notification of reasons for refusal the reason why the application is not found to be filed for each design as provided by an Ordinance of the Ministry of Economy, Trade and Industry or classifications of articles equivalent in level to such classification.
- (6) Where the application for design registration falls under another reason for refusal, the examiner should specifically state that reason.

4.2 Ensuring communication with the applicant

- (1) Where it is found to contribute to prompt and accurate examination, the examiner should utilize telephone, facsimile, interviews, etc. as supplementary means for ensuring communication with the applicant, and make effort to deal with the applicant in a careful and easy-to-understand manner. Interviews, etc. are held based on "Interview Guidelines [Design Examination]," and an interview record or a response record is prepared in order to secure the transparency of the procedure. Where there is an agent for the application for design registration, the interview, etc. is held with the agent, in principle.

Note that where the shape, etc. of the entire article, etc. to the design is not disclosed, but there is no specific reason for refusal, such as in the case where the contents of a single creation can be identified by perceiving the disclosed scope as the part for which the design registration is requested, the examiner should not confirm the intention of the applicant or encourage the applicant to make amendments with regard to the parts that are not disclosed.

- (2) The examiner should ensure that practices are carried out in such a way as to maintain or secure the continuity of examination even if the examiner in charge is changed. Where the examiner makes a different determination from that of the

previous examiner in charge, the examiner should pay particular attention to communicating with the applicant.

5. Orders for consultation (excluding international applications for design registration)

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 become subject to an order for consultation under Article 9, paragraph (4) of the Design Act, regardless of whether they are applications for design registration filed by the same person or by different persons.

5.1 Points to note when issuing orders for consultation

When giving an order for consultation, the examiner should take the following points into consideration.

- (1) Handling of applications for design registration filed by different persons for identical or similar designs on the same date
 - (i) An order for consultation is issued in the name of the Commissioner of the Patent Office to the respective applicants for design registration under Article 9, paragraph (4) of the Design Act.
 - (ii) Where a report on the results of consultations is submitted within the designated time limit, an examiner's decision to the effect that a design registration is to be granted is rendered only for the application for design registration filed by one applicant for design registration that was selected in the consultations.
 - (iii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act, and the respective applicants for design registration are given notice of reasons for refusal under the second sentence of Article 9, paragraph (2) of the Design Act.
- (2) Handling of applications for design registration filed by the same person for identical or similar designs on the same date
 - (i) An order for consultation is issued in the name of the Commissioner of the Patent Office to the applicant for design registration under Article 9, paragraph (4) of the Design Act. However, where the applicant is the same person, since time for consultations is not deemed necessary, at the same time as issuing an order for consultation in the name of the Commissioner of the Patent Office, the applicant is given notice of reasons for refusal based on the provisions of the second sentence of Article 9, paragraph (2) of the Design Act.
 - (ii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act, and an examiner's decision is rendered to the effect that each application for design registration should be refused based on the previously given notice of reason for refusal under the second sentence of Article 9, paragraph (2) of the Design Act.

- (3) Handling of the case where procedures for withdrawal or waiver or for amendment are taken only for one or some of the applications for design registration subject to consultations, and where no report on the results of consultations is submitted

Even if procedures for withdrawal or waiver or for amendment are taken only for one or some of the applications for design registration subject to consultations, the examiner may not as a result immediately deem that agreement has been reached by consultations, and must wait for the report on the results of consultations until the expiration of the designated time limit.

In principle, a report on the results of consultations is required for each application for design registration that is subject to consultations. Where no report on the results of consultations is submitted by the designated time limit, it may be deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act; however, if, within the designated time limit, an amendment has been made to make the design in an application for design registration subject to consultations a principal design or its related design, or if either of the applications for design registration subject to consultations has already been withdrawn or waived, such procedures for amendment or for withdrawal or waiver will result in the reason for consultations being overcome. Consequently, the examiner should not deem that no agreement was reached by consultations.

6. Notification of refusal in case of an international application for design registration

In cases where an international application for design registration does not satisfy conditions for grant of protection under the Japan's laws and regulations, the examiner should give a notification of refusal (Article 12(1) and (2) of the Geneva Act).

6.1 Notification of refusal

When giving a notification of refusal, the examiner should take the following points into consideration.

- (1) Cases where an international application for design registration does not comply with conditions for granting protection under the Japan's laws and regulations include the following cases:
- (i) Case where the said international application for design registration has reasons for refusal (the items of Article 17 of the Design Act)
 - (ii) Case where the said international application for design registration is subject to an order for consultation (Article 9, paragraph (4) of the Design Act)
 - (iii) Case where waiting until procedures or dispositions for the said international application for design registration has become final and binding is necessary
 - (iv) Case where waiting until dispositions for an application other than the said international application for design registration have become final and binding is necessary (wait notice)

Where a notification of refusal has been given, during subsequent procedures, a notice of reasons for refusal, etc. shall be given not through a notification of refusal but through a normal notice of reasons for refusal, etc.

- (2) A notification of refusal shall be given to the International Bureau within 12 months

after an international publication (Article 12(2)(a) of the Geneva Act, Regulation 18(1)(b) of the Common Regulations of the Hague Agreement).

- (3) All reasons^(Note) for the refusal shall be stated in a notification of refusal (Article 12(2)(b) of the Geneva Act). Reference shall also be made to the main provisions of laws and regulations corresponding to those reasons (Rule 18(2)(iii) of the Common Regulations of the Hague Agreement).

(Note) "All reasons" to be stated in a notification of refusal shall be reasons that can be presented when giving a notification of refusal, and shall be to the extent that is reasonable to notify at the same time.

- (4) A notification of refusal shall be given in English (Rule 6(3)(i) of the Common Regulations of the Hague Agreement).

7. Where a written opinion or a written amendment of proceedings has been submitted

- (1) Review of the contents of a written opinion or a written amendment of proceedings
Where a written opinion or a written amendment of proceedings has been submitted after giving notice of reasons for refusal, the examiner should carefully read the written opinion and fully understand 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 make a determination as to whether the reason for refusal that had been indicated previously has been overcome.

- (2) Handling of a written amendment of proceedings

Where an amendment made to the application or drawings, etc. is found to change the gist of the statement in the application or drawings, etc. attached to the application as originally filed (the cases indicated in (i) and (ii) below), the examiner should dismiss the amendment by a ruling (Article 17-2 of the Design Act). A ruling dismissing an amendment is made by indicating the reason therefor (or all such reasons if there are multiple).

(i) An amendment that makes a change exceeding the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design

(ii) An amendment to clarify the gist of design that was unclear when originally filed

Where the amendment does not change the gist of the statement in the application or drawings, etc. attached to the application as originally filed, the examiner should continue the examination based on the amended statement in the application and amended drawings, etc. attached to the application.

An amendment may only be made while the application for design registration is pending in examination, trial or retrial (Article 60-24 of the Design Act).

- (3) Notice of reasons for refusal after submission of a written opinion or a written amendment of proceedings

Where a previously given notice of reasons for refusal has been overcome through submission of a written opinion or a written amendment of proceedings, but another

reason for refusal has been found, the examiner should give notice of reasons for refusal once again.

8. Examiner's decision

8.1 Decision of registration

Where no reason for refusal is found for an application for design registration, the examiner should render a decision of registration. In addition, 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).

In rendering a decision of registration, if there is a design that is categorized as any of the prior designs, etc. shown below, which does not constitute a reason for refusal but was particularly referred to in examination of the filed design, the examiner should publish the examination materials containing those prior designs, etc. as reference material in a design bulletin.

- (1) A prior design that is found to have common points with the filed design in terms of the entire design
- (2) A prior design, etc. that is found to have common points with the filed design in terms of a part of the shape, etc.
- (3) A prior design, etc. that is found to have common points in the shape, etc. described as a feature in the feature statement

8.2 Decision of refusal

Where a reason for refusal is not overcome by a written opinion or a written amendment of proceedings submitted in response to notice of reasons for refusal, the examiner should promptly render a decision of refusal (Article 17 of the Design Act).

When rendering a decision of refusal, the examiner should take the following points into consideration.

- (1) The specific reasons why the reason for refusal has not been overcome should be stated in plain language.
- (2) With regard to the matters asserted in a written opinion, the determination made by the examiner should be clearly stated in accordance with the purport of the reason for refusal.
- (3) In cases bound by a notified reason for refusal, where a decision of refusal cannot be rendered without citing a new prior design, etc., the examiner must cite that new prior design, etc., give notice of reason for refusal once again, and ensure that the applicant has an opportunity to state their opinion. However, a new prior design, etc. may be presented for reinforcing the fact that a shape, etc. that is ordinary in the art of the filed design is used or an ordinary technique for a person skilled in the art is used.