Chapter III Creative Difficulty

23 Relevant provisions
Design Act
Article 3
(Paragraph (1) omitted)
(2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

23.1 Prior to the filing of the application for design registration
“Prior to the filing of the application for design registration” takes into consideration the exact time of the filing, similarly to “prior to the filing of the application for design registration” as provided in Article 3(1)(i) or (ii) of the Design Act, and differs from the date of the filing of an application for design registration (Articles 9 and 10 of the Design Act, etc.) which is determined on a daily basis. Also, the reference time for determining whether or not a person ordinarily skilled in the art of the design would have been able to easily create the design is prior to the filing of the application for design registration.

23.2 Person ordinarily skilled in the art of the design
A person ordinarily skilled in the art of the design (hereinafter referred to as a "person skilled in the art") is the entity that determines the creative difficulty. A person skilled in the art refers to a person who had ordinary skills concerning designs in the industry in which the article to the design is to be manufactured or sold as of the time of the filing of the application for design registration.

23.3 That were publicly known
That were publicly known has the same meaning as that were publicly known as provided in Article 3(1)(i) of the Design Act. In other words, it is a situation where contents of subject matter became known in reality to unspecified persons as subject matter that is not kept secret.

Of that were publicly known, a situation where presenting the name of the subject matter is enough to call the subject matter to mind, without having to show the actual subject matter, is specifically referred to as that were widely known.

That were widely known in a foreign country requires that the subject matter was widely known in said country, but it does not necessarily require that it was widely

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known in several countries. Also, as long as the subject matter was widely known in said country, it does not necessarily require that it was widely known in Japan.

23.4 Information that serves as the basis for determination of creative difficulty

The following can be used as information that serves as the basis for determination of creative difficulty.

(1) Shapes, patterns or colors, or any combination thereof, that were publicly known

(2) Shapes, patterns or colors, or any combination thereof, that were widely known

(3) Designs that were publicly known or widely known

23.4.1 Shapes, patterns or colors, or any combination thereof, that were publicly known

The following are categorized as shapes, patterns or colors, or any combinations thereof, that were publicly known.

(1) Shapes, patterns or colors, or any combinations thereof, that were publicly known in Japan or a foreign country

(2) Shapes, patterns or colors, or any combinations thereof, that were described in a distributed publication in Japan or a foreign country

However, the publication must not only have been distributed, but must also have been in a state where it was publicly known.

Shapes, patterns or colors, or any combination thereof are rarely publicly known independently by themselves, when described in a publication; in most cases, they are represented as being inseparably integrated with the article to the design that was publicly known, which was described in the publication. In such case as well, if the shapes, patterns or colors, or any combination thereof, of said article show a specific mode that can be distinguished by themselves, they can be used as information that serves as the basis for determination of creative difficulty.

In the case mentioned above, the similarity between the article to the design that was publicly known, which was described in a publication, and the article to the design for which an application for design registration was filed is irrelevant.
23.4.2 Shapes, patterns or colors, or any combination thereof, that were widely known

Not only shapes, patterns or colors, or any combination thereof, that were widely known in Japan or a foreign country and that were widely known independently by themselves, but also shapes, patterns or colors, or any combination thereof represented in a widely known design can be used as information that serves as the basis for determination of creative difficulty, as shapes, patterns or colors, or any combination thereof, that were widely known.

23.4.3 Designs that were publicly known or widely known

Designs that were publicly known or designs that were widely known can also be used as information that serves as the basis for determination of creative difficulty.

23.5 Examples of designs that are found to be designs that would have been easily created

23.5.1 Design of replacement

Replacement refers to replacing a part of the constituent elements of a design with those of other designs.

A design that is constituted merely by replacing specific constituent elements of a design that was publicly known (the same shall apply in a case based on a design that widely known; the same shall apply hereinafter) to those of other designs that were publicly known by an ordinary technique for a person skilled in the art

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combination thereof, that were publicly known.

[Case example 1]

In the art of the design, using a different gas cylinder is an ordinary technique for a person skilled in the art, considering that it is a general practice to make available multiple types of gas cylinders for a single model according to the duration of fuel use.
Filed design

“Cooking stove that also serves as a gas space heater”
[Case example 2]

In the art of the design, constituting a design by merely replacing the decoration plate of a design that was publicly known with other decoration plates is an ordinary technique for a person skilled in the art.

*Filed design*

"Road fence"

Design that was publicly known: fence

Replacement

Design that was publicly known: decoration plate for a fence
[Case example 3]

In the art of the design, replacing the shape, etc. of a separable component (television camera) with the shape, etc. of other components (television camera) is an ordinary technique for a person skilled in the art.

**Filed design**

“Video camera with a video tape recorder”
[Case example 4]

In the art of the design, making a single speaker enclosure by stacking various types of speakers for the respective frequency ranges is an ordinary technique for a person skilled in the art.

Filed design
"Speaker enclosure"

Design that was publicly known: Speaker enclosure

Design that was publicly known: Speaker

Replacement
[Case example 5]

In the art of the design, applying a pattern onto the top of the lid part of a computer is an ordinary technique for a person skilled in the art.

Filed design
“Computer”

Pattern that was publicly known

Replacement

Design that was publicly known: computer

Example of an ordinary technique for applying a pattern
“Computer”
23.5.2 Design of aggregation

Aggregation refers to constituting a single design by combining multiple designs.

A design that has merely aggregated multiple designs that were publicly known by an ordinary technique for a person skilled in the art

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example 1]

In the art of the design, making a single speaker enclosure by stacking various types of speakers for the respective frequency ranges is an ordinary technique for a person skilled in the art.
[Case example 2]
In the art of the design, applying a pattern onto the top of the lid part of a computer is an ordinary technique for a person skilled in the art.

Filed design
“Computer”

Replacement

Design that was publicly known: computer

Pattern that was publicly known

Example of an ordinary technique for applying a pattern
“Computer”
[Case example 3]
In the art of the design, inserting a clock in a part of a base consisting of various concrete objects, etc. and inserting a clock at the center of an almost disc-shaped base are ordinary techniques for a person skilled in the art.

Filed design
"Clock"

The clock inserted at the center is a design that was widely known.
23.5.3 **Design constituted by changing the layout**

A design that has merely changed the layout of constituent elements of a design that was publicly known by an ordinary technique for a person skilled in the art

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example]
In the art of the design, changing the layout of the display part for an equalizer and the operating part for an amplifier in the state of normal use of a design that was publicly known is an ordinary technique for a person skilled in the art.

**Filed design**
“Amplifier with an equalizer”
23.5.4 Design constituted by changing the component ratio or by increasing or decreasing the number of units of a continuous constituent element

A design that has merely changed all or part of the component ratio of a design that was publicly known or changed the number of units of a constituent element of a design that was publicly known, which repeats continuously, by an ordinary technique for a person skilled in the art.

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example 1]

In the art of designs including an extrusion molding member having the same cross-section shape and a side-ditch block having a side shape that repeats continuously, increasing or decreasing the number of units of a constituent element of a design that was publicly known, which repeats continuously, as needed is an ordinary technique for a person skilled in the art.
Filed design
“Side-ditch block”

Increasing the number of units of a constituent element which repeats continuously

Design that was publicly known: concrete drainage side-ditch

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[Case example 2]

In the art of the design, increasing or decreasing the number of warning light units stacked as needed is an ordinary technique for a person skilled in the art.

Filed design

In the “Revolving warning light,” warning light units are stacked in two layers.

Warning light units are stacked in six layers.
23.5.5 Design that merely represents shapes, patterns or colors, or any combinations thereof, that were publicly known almost as they are

A design created by an ordinary technique for a person skilled in the art, which is to represent shapes, patterns or colors, or any combinations thereof by shapes, patterns or colors, or any combinations thereof that were publicly known (the same applies to shapes, patterns or colors, or any combinations thereof, that were widely known; the same shall apply hereinafter) almost as they are

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

23.5.5.1 Design based on shapes or patterns that were publicly known

A design that merely represents shapes or patterns that were publicly known almost as they are in the article

[Case example]

In the art of the design, making the tip into various geometric shapes is an ordinary technique.

Filed design

“Tip part for a laser irradiator” (partial design)
23.5.5.2 Design based on a natural object or a copyright work or building, etc. that was publicly known

A design that merely represents all or part of the shapes, patterns, etc. of a natural object (animal, plant or mineral) or a copyright work or building that was publicly known almost as they are in the article

[Case example]
In the art of the design, making the shape of a paperweight, etc. resemble the shape of a plant, etc. is an ordinary technique.

Filed design
"Paperweight"

[Case example of subject matter that would not have been easily created]
The design of the "culture soil container" shown below does not represent the shape of a green pepper almost as it is, and a person skilled in the art would not have easily created it.

Filed design
“Culture soil container”
23.5.6 Design converted as a business practice

A design that has been converted in the case where there is an ordinary technique for a person skilled in the art to convert a design to a dissimilar article as a business practice

Such design is found to be a design which a person skilled in the art would have been able to easily create based on the shapes, patterns or colors, or any combinations thereof, that were publicly known, which served as the basis for the conversion.

Conversion does not only mean representing shapes, patterns or colors, or any combination thereof, of a certain article as shapes, patterns or colors, or any combination thereof, of a dissimilar article, but it also includes making a technically or economically inevitable change to shapes, patterns or colors, or any combination thereof, which is deformation to the extent any person skilled in the art would make or deformation that is commonly made in the art of the design, in the process of creating a design based on shapes, patterns or colors, or any combinations thereof, that were publicly known.
[Case example 1]

In the art of the design, making the shape of manufactured food resemble the shape of an animal, plant, etc. is an act conducted as a business practice for a person skilled in the art.

Filed design

“Chocolate”

Conversion

Design that was publicly known: electronic desktop calculator
[Case example 2]  
In the art of the design, making the shape of a toy resemble the shape of a vehicle is an act conducted as a business practice for a person skilled in the art.

Filed design  
“Toy motorbike

[Case example of subject matter that would not have been easily created]  
The design of a “Toy car” shown below has been deformed to an extent beyond deformation that is normally made as a business practice for a person skilled in the art, so a person skilled in the art would not have easily created it.

Design that were publicly known: motorbike

Conversion
23.6 **Presentation of information that serves as the basis for determination of creative difficulty**

Where using shapes, patterns or colors, or any combinations thereof, that were publicly known or designs that were publicly known as information that serves as the basis for determination of creative difficulty, for example, when using a design that was publicly known, which was described in a distributed publication, as information that serves as the basis for determination of creative difficulty, the examiner must present the design that was publicly known to the applicant for design registration by stating matters including the bibliographic matters concerning the publication in which the design that was publicly known is described and the page number of the page on which the design that was publicly known is described in the notification of reasons for refusal.

However, when using shapes, patterns or colors, or any combinations thereof, that were widely known or designs that were widely known as information that serves as the basis for determination of creative difficulty, the examiner does not need to present proof of their existence.

23.7 **Presentation of the fact that the design uses an ordinary technique for a person skilled in the art**

A determination that a design could have been created easily must be supported by a fact that the design was created by using an ordinary technique for a person skilled in the art.

Therefore, when giving a notice of reasons for refusal under Article 3(2) of the Design Act, it is necessary to present to the applicant a specific fact showing that the technique used is ordinary for a person skilled in the art, in principle.

However, where the examiner finds it to be evident that the technique used is ordinary for a person skilled in the art, such as where the technique is to convert the design of a real car as it is to a toy car in the toy industry, it is not necessarily required to present said specific fact.

23.8 **Application of the items of Article 3(1) of the Design Act**

Since Article 3(2) provides “(except for designs prescribed in any of the items of the preceding paragraph),” the provision of Article 3(2) of the Design Act only apply to the case where the design in an application for design registration does not fall under any of the items of Article 3(1) of the Design Act in relation to a design that was publicly known.