Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

24 Relevant provisions

Design Act

Article 3-2 Where a design in an application for design registration is identical with or similar to part of a design described in the statement in the application and drawing, photograph, model or specimen attached to the application of another application for design registration which has been filed prior to the date of filing of the said application and published after the filing of the said application in the design bulletin under Article 20(3) or Article 66(3) (hereinafter referred to in this Article as the "earlier application"), a design registration shall not be granted for such a design, notwithstanding paragraph (1) of the preceding Article; provided, however, that this shall not apply where the applicant of the said application and the applicant of the earlier application are the same person and the said application was filed before the date when the design bulletin in which the earlier application was published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) was issued.

24.1 Provision of Article 3-2 of the Design Act

The provision of Article 3-2 of the Design Act provides that, where the design in a later application is not found to be a creation of a new design, such as where an application for design registration is filed while adopting a part of the design in a prior application almost as it is as the design in the later application, the design in the later application may not be registered. It is provided, however, that the reason for refusal under this provision does not apply where an application for design registration was filed by the same applicant as that for the prior application before the date of publication of the Design Bulletin pertaining to the prior design registration (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published).

24.1.1 Design Bulletin that serves as the basis for application of the provision of the main clause of Article 3-2 of the Design Act

The Design Bulletin that serves as the basis for application of the provision of the main clause of Article 3-2 of the Design Act is any of the following Design Bulletins for a design filed before the filing date of the application for design registration subject to the application of Article 3-2 of the Design Act which was published after the filing of said application for design registration.
(1) Design Bulletin based on the provisions of Article 20(3) of the Design Act (Registered Design Bulletin)

(2) Design Bulletin based on the provisions of Article 66(3) of the Design Act (Bulletin for giving public notice of an application for which refusal has become final and binding in the case where no agreement was reached by consultations or consultations were unable to be held where two or more application have been filed for identical or similar designs on the same date)

24.1.2 Design described in the statement in the application and drawing, photograph, model or specimen attached to the application

A design described in the statement in the application and drawing, photograph, model or specimen attached to the application in the design bulletin as provided in Article 3-2 of the Design Act specifically refers to a design which has been described in a Design Bulletin and which has been created by the applicant for design registration who filed the prior application, in other words, which has been disclosed by the applicant for design registration who filed the prior application as a form of an article that is categorized under the classification of articles stated in the column of “Article to the Design” of the application (hereinafter referred to as “the design disclosed in a prior application”).

Therefore, information other than the design disclosed in the prior application which is described in a view showing the state of use or any other reference view to be added where it is necessary to help in understanding the design cannot be used as information that serves as the basis for application of the provision of Article 3-2 of the Design Act.

Such practice has been adopted for the reason that if, in a view showing the state of use or any other reference view to be added where it is necessary to help in understanding the design, amendment is made to a design other than the design disclosed in the prior application within a scope that does not change the gist of such reference view, the contents of descriptions other than those of the design disclosed in the prior application may change while examination, trial or retrial of the application is pending, and refusing a later application based on such unstable information will be disadvantageous for the applicant for design registration who files the later application, and also for the reason that it runs contrary to the purport of the provision of Article 3-2 of the Design Act to refuse a later application by finding a value of creation in information that has merely been added for an explanatory purpose to help in understanding the design disclosed in the prior application.
24.1.3 Drawings for specifying the design disclosed in a prior application

24.1.3.1 In the case of an application for design registration for a whole design
In the case of a three-dimensional article, the front view, the rear view, the left side view, the right side view, the top view, and the bottom view that have been prepared at the same scale by the orthographic projection method, or drawings that are replaceable therewith (hereinafter referred to as “a set of drawings”) are regarded as drawings for specifying the design disclosed in a prior application.

In the case of a flat and thin article, the surface view and the back side view that have been prepared at the same scale (hereinafter referred to as “a set of drawings” equivalent to the case of a design for a three-dimensional article) are regarded as drawings for specifying the design disclosed in a prior application.

In addition, a development view, sectional view, end elevational view of the sectioned part, enlarged view, perspective view, graphic image view or other necessary drawings (hereinafter referred to as “other necessary drawings”) to be added where a set of drawings alone cannot sufficiently represent the design in an application for design registration are also regarded as drawings for specifying the design disclosed in a prior application.

24.1.3.2 In the case of an application for design registration for a partial design
In the case of an application for design registration for a partial design, a set of drawings representing the form of the entire article to the design of the partial design, including the “part for which design registration is requested” and “any other part,” and other necessary drawings are regarded as drawings for specifying the design disclosed in a prior application.

24.1.3.3 In the case of an application for design registration for a design for a set of articles
In the case of an application for design registration for a design for a set of articles, sets of drawings for the respective designs pertaining to the articles constituting the set of articles (hereinafter referred to as “constituent articles”), sets of drawings for the respective designs pertaining to articles that are used at the same time as constituent articles and that are within the scope incidental to specified
Part II Conditions for Design Registration

Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

constituent articles, or a set of drawings for the state where the constituent articles are combined, and other necessary drawings are also regarded as drawings for specifying the design disclosed in a prior application.

24.1.4 Part of a design

Part of a design refers to a closed area that is included in the appearance of the design disclosed in a prior application, and a shape, pattern or color which is a constituent element of a design and which has been conceptually separated from the design is not treated as being part of a design. For example, where the design disclosed in a prior application is a design constituted by a combination of a shape and pattern of an article, part of a design refers to part of the entire design in the combined state, and merely the shape of the article without the pattern is not treated as being part of a design.

Where the whole design in a later application represents the form of the entire article to the design of a partial design in a prior application, including the “part for which design registration is requested” and “any other part” of the partial design, the design in the later application is not treated as being part of the design in the prior application.

24.1.5 Determination of similarity between part of the design disclosed in a prior application and the whole design in a later application

In order to apply the provision of Article 3-2 of the Design Act, in principle, it is necessary that the entire form of the whole design in the later application, which is subject to the provision of Article 3-2 of the Design Act, is disclosed in the design disclosed in the prior application (including the case where such form is not disclosed, but is sufficiently represented to a comparable level, in the design disclosed in the prior application; see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.2.6 “Design described in a publication”).

Regardless of (i) whether the design disclosed in a prior application is a whole design or a partial design, and (ii) whether the article to the design of the design disclosed in a prior application and that of the whole design in a later application are identical, similar or not similar, where the part of the design disclosed in a prior application that coincides with the whole design in a later application and the article to the design of the whole design in the later application have an identical or similar usage and function and their respective forms are identical or similar, the whole design in the later application and the part of the design disclosed in the prior application that
coincides with the whole design in the later application are similar.

24.1.6 Determination on application of the provision of the proviso to Article 3-2 of the Design Act

An application for which design registration is not granted, as provided under the main clause of Article 3-2 of the Design Act, does not fall under a reason for refusal if it complies with all of the following requirements, according to the provision of the proviso to said Article.

24.1.6.1 The applicant of the application for design registration and the applicant of the earlier application are the same person

The determination as to whether the applicant of the application for design registration and the applicant of the earlier application are the same person is made based on the statement of the applicant for design registration in the respective applications at the time of making determination on application of the provision, that is, the time when a certified copy of the examiner’s decision or a written notice of reasons for refusal is served. Therefore, even if the applicants are different at a time other than the time of making determination on application of the provision or the applicant of the application for design registration and the holder of the design right pertaining to the earlier application are different, that is not taken into consideration in the determination on application of the provision.

In the case of a joint application, the "same person" means that all applicants are the same.

24.1.6.2 The application for design registration was filed before the publication date of the Design Bulletin in which the earlier application was published under Article 20(3) (except for a Design Bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4))

The application for design registration needs to have been filed before the date of publication of the Design Bulletin pertaining to design registration of the earlier application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published).

* Please take note that although this Design Bulletin does not include an International Designs Bulletin of an international publication(Note) in
case of an international application for design registration, a design that was placed in the International Designs Bulletin that was internationally published shall fall under a design provided in Article 3(1)(ii) of the Design Act (a design that was described in a distributed publication or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country).

(Note)
With regard to the “international application for design registration” and “international publication”, see Part XI “International Application for Design Registration”; the same shall apply hereinafter.

24.1.7 Time requirement concerning application of the provision of Article 3-2 of the Design Act
The provision of Article 3-2 of the Design Act applies to an application for design registration (excluding an application to which the provision of the proviso apply) that is filed during the period from the filing date of the prior application for design registration to the date of publication (including said date) of the Design Bulletin for said application for design registration (a Registered Design Bulletin or Bulletin for giving public notice of an application for which refusal has become final and binding in the case where no agreement was reached by consultations or consultations were unable to be held where two or more application have been filed for identical or similar designs on the same date).

Meanwhile, Article 3(1)(ii) or (iii) of the Design Act applies to an application for design registration that was obviously filed after the time of publication of the Design Bulletin for the prior application for design registration.

24.1.7.1 Reference date for determination on application of the provision of Article 3-2 of the Design Act with regard to division of an application for design registration, conversion of an application, or filing of a new application for an amended design
In the case of division of an application for design registration under Article 10-2(1) of the Design Act, conversion of a patent application or an application for utility model registration into an application for design registration under Article 13(1) or (2) of the Design Act, or filing of a new application for design registration for an amended design for which a ruling dismissing an amendment has
been made under Article 17-3 of the Design Act, if the procedures are conducted legitimately, such application for design registration is deemed to have been filed at the time of filing the original application or at the time of submitting the written amendment of proceedings.

However, since determination on application of the provision of Article 3-2 of the Design Act is made on the basis of the day of the filing the application for design registration, with regard to a new application for design registration resulting from division, a new application for design registration resulting from conversion, or a new application for design registration for an amended design for which a ruling dismissing an amendment has been made, the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized will be the reference date for the determination.

24.1.7.2 Reference date for determination on application of the provision of Article 3-2 of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.

When applying the provision of Article 3-2 of the Design Act, if the claim is legitimate, the filing date of the first application will be the reference date for the determination.

24.1.7.3 Time for giving notice of the reason for refusal under Article 3-2 of the Design Act

A notice of the reason for refusal under Article 3-2 of the Design Act is given after the date of publication of the Design Bulletin for the design in the prior application (a Registered Design Bulletin or Bulletin for giving public notice of an application for which refusal has become final and binding in the case where no agreement was reached by consultations or consultations were unable to be held where two or more application have been filed for identical or similar designs on the same date).

In the case of a Design Bulletin pertaining to a design which was requested to be kept secret, the notice of the reason for refusal will be given after the designated period for which the design was requested to be kept secret has elapsed and after the date of publication of the Design Bulletin in which all matters to be published with regard to the application for design registration are published, and before then, a wait notice will be given.
24.1.7.4 Reference date for determination on application of the provision of Article 3-2 of the Design Act with regard to an international application for design registration

When applying the provision of Article 3 (2) of the Design Act to an international application for design registration, the date of the international registration on which an application for design registration was deemed to have been filed under Article 60-6(1) of the Design Act(Note) will be the reference date for the determination (this excludes cases where a priority claim under the Paris Convention, etc. was legitimately made).

(Note)
With regard to the "international registration" and "date of the international registration", see Part XI "International Application for Design Registration"; the same shall apply hereinafter.

24.2 Examples of applications for design registration for a whole design that fall under the provision of Article 3-2 of the Design Act

(i) Where the prior application is an application for design registration for a whole design, and part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function
Part II Conditions for Design Registration
Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

[Applicable case example 1]
Design disclosed in the prior application
"Bathroom vanity"
Application for design registration for a whole design
"Bathroom vanity cabinet"

[Applicable case example 2]
Design disclosed in the prior application
"Handsaw"
Application for design registration for a whole design
"Handsaw handle"
Part II Conditions for Design Registration
Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

(ii) Where the prior application is an application for design registration pertaining to a separable article, and the separated design which is part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function

[Applicable case example]
Design disclosed in the prior application
“Coffee cup and saucer”

Application for design registration for a whole design
“Coffee cup”

[Not applicable case example]
Design disclosed in the prior application
“Spray”

Application for design registration for a whole design
“Injection pump for a spray”

(Supplementary explanation)
The entire form of the whole design in the later application is not sufficiently represented to a comparable level in the design disclosed in the prior application.
(iii) Where the prior application is an application for design registration for a partial design, and part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function.

[Applicable case example 1]
Design disclosed in the prior application
“Main body of a vacuum cleaner”
Application for design registration for a whole design
“Hose inlet for a vacuum cleaner”

[Applicable case example 2]
Design disclosed in the prior application
“Handsaw”
Application for design registration for a whole design
“Handsaw handle”
(iv) Where the prior application is an application for design registration for a design for a set of articles, and the design pertaining to a constituent article which is part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function.

[Applicable case example]

<table>
<thead>
<tr>
<th>Design disclosed in the prior application</th>
<th>Application for design registration for a whole design</th>
</tr>
</thead>
<tbody>
<tr>
<td>&quot;Set of dining knives, forks and spoons&quot;</td>
<td>&quot;Dining spoon&quot;</td>
</tr>
</tbody>
</table>
Part II Conditions for Design Registration
Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

[Transitional measures]

Supplementary Provisions of the Revising Act
Article 2 The provisions of Article 2(2), Article 3-2, Article 10, Article 14, Article 17, Article 21, Article 42 and Article 48 of the Design Act as revised under Article 1 (hereinafter referred to as the “New Design Act”) apply to an application for design registration filed after the date on which this Act comes into effect, and with regard to an application for design registration filed prior to the date on which this Act comes into effect, the provisions then in force remain applicable.

○ Application of the Revising Act to an application for design registration filed after the date on which the Revising Act comes into effect with regard to a design that is identical or similar to part of the design pertaining to an application for design registration filed prior to the date on which the Revising Act comes into effect

The Revising Act applies to an application for design registration filed after the date on which the Revising Act comes into effect with regard to a design that is identical or similar to part of the design pertaining to an application for design registration filed prior to the date on which the Revising Act comes into effect.

○ Application of the Revising Act to an application pertaining to division of an application for design registration, conversion of an application, or filing of a new application for an amended design

The Revising Act applies to an application pertaining to division of an application for design registration, conversion of an application, or filing of a new application for an amended design where the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized under Article 10-2(2) of the Design Act (including the cases where applied mutatis mutandis pursuant to Article 13(5) of said Act) or Article 17-3(1) of said Act is after the date on which the Revising Act comes into effect.

○ Application of the Revising Act to an application for design registration containing a priority claim under the Paris Convention, etc.

The Revising Act applies to an application for design registration containing a priority claim under the Paris Convention, etc. where the filing date in Japan is after the date on which the Revising Act comes into effect, based on the provision of Article 4B of the Paris Convention.

85