Part III Exception to Lack of Novelty

31 Relevant provisions

Design Act

Article 4 (1) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) against the will of the person having the right to obtain a design registration, such a design shall be deemed not to have fallen under item (i) or (ii) of Article 3(1) for the purposes of Article 3(1) and (2) for any design in an application for design registration which has been filed by the said person within one year from the date on which the design first fell under either of those items.

(2) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) as a result of an act of the person having the right to obtain a design registration (excluding those which have fallen under item (i) or (ii) of Article 3(1) by being published in a gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 3(1) and (2) to any design in an application for design registration which has been filed by the said person within one year from the date on which the design first fell under either of those items.

(3) Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration, a document stating thereof and, within thirty days from the date of filing of the application for design registration, a document proving the fact that the design which has otherwise fallen under item (i) or (ii) of Article 3(1) is a design that is subject to application of the provision of the preceding paragraph (referred to as a “certificate” in the following paragraph).

(4) Notwithstanding the preceding paragraph, where, due to reasons beyond the control of a person who submits a certificate, the person is unable to submit the certificate within the time limit as provided in the said paragraph, the person may submit to the Commissioner of the Patent Office the certificate within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the said time limit.

31.1 Provisions of Article 4(1) and (2) of the Design Act

When a created design has fallen under the category of a publicly known design against the will of the person having the right to obtain a design registration at the time of the disclosure or as a result of an act of the person having the right to obtain a design registration (hereinafter referred to a “disclosed design”), and the person having the right to obtain a design registration for said disclosed design files an application for design registration within one year from the date on which the disclosed design was first disclosed and the prescribed requirements are complied with, said disclosed design is deemed not to be a publicly known design only with
regard to said application for design registration in determination of the requirements of novelty (Article 3(1) of the Design Act) and creative difficulty (Article 3(2) of the Design Act).

Since the provisions of Article 4(1) and (2) of the Design Act do not provide for the relationship between the disclosed design and the design in the application for design registration, the provisions apply to the disclosed design regardless of the relationship between the two designs, such as whether or not the two designs are identical, similar or not similar, as long as the disclosed design and the application for design registration comply with the prescribed requirements.

31.1.1 Requirements for application of the provision of Article 4(2) of the Design Act

In order to apply the provision of Article 4(2) of the Design Act to any disclosed design, the design must comply with the following requirements (1) to (3).

(1) The design needs to have fallen under the following design (i) or (ii) as a result of an act of the person having the right to obtain a design registration (the creator of the design or to his successor in title).

   (i) A design that was publicly known in Japan or a foreign country, prior to the filing of the application for design registration.

   (ii) 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, prior to the filing of the application for design registration.

(2) The person having the right to obtain a design registration for the above design (1), has filed the application for design registration.

(3) The application for design registration needs to have been filed within one year from the date on which the above design (1) was disclosed for the first time.

At the time of making a determination on the application of the provision of Article 4(2) of the Design Act, the examiner shall determine whether it is proved that the above requirements are satisfied, based on the "proving document" submitted in accordance with the provision of Article (3) or (4) of the Design Act (hereinafter, simply referred to as "proving document").

31.1.1.1 Person having the right to obtain a design registration for the
disclosed design at the time of the disclosure as stated in the documentary proof

“Person having the right to obtain a design registration” as provided in Article 4(2) of the Design Act shall be referred to as the person having the right to obtain a design registration for the disclosed design at the time of the disclosure.

Generally, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure is the creator of the disclosed design, but where the creator had a third party succeed to the said the right to obtain a design registration, the said person shall be a person who had succeeded the said right at the time of disclosure. As a result, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure and the creator of the design are different, the fact about the succession to the right needs to be clearly indicated and proved.

31.1.2 Fact that the disclosed design was disclosed as a result of an act of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure as stated in the documentary proof

The fact that disclosed design has fallen under the category of a publicly known design as a result of an act of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure as stated in the documentary proof needs to be clearly indicated and proved.

31.1.2 Specific procedures for receiving application of the provision of Article 4(2) of the Design Act

(1) A document stating a request for the application of the provision of Article 4(2) of the Design Act must be submitted to the Commissioner of the Patent Office upon filing the application for design registration (Article 4(3) of the Design Act). However, the submission of the document may be omitted by including a statement to that effect in the application for design registration in lieu of the submission of said document (Article 27-4 of the Ordinance for Enforcement of the Patent Act applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act).

Meanwhile, in the case of following the procedure by using an electronic data processing system, a request for the application with a
statement to that effect must be recorded in lieu of submitting the said
document (Article 12 of the Ordinance for Enforcement of the Act on
Special Provisions for Procedures, etc. concerning Industrial Property
Rights).

(2) A document proving that the disclosed design is a design that is subject to
application of the provision of Article 4(2) of the Design Act must be
submitted to the Commissioner of the Patent Office within 30 days from the
date of the application for design registration (Article 4(3) of the Design Act).

Meanwhile, with regard to the proving document, according to the
provision of Article (1) of the Ordinance for Enforcement of the Design Act
and Form No. 1 of the same Ordinance for Enforcement, the said document
must be submitted together with a certificate for requesting the exception
to lack of novelty.

31.1.3 Determination Procedures on application of the provision of Article 4(2)
of the Design Act based on a “proving document”

31.1.3.1 The case where a “proving document” made according to the
format as shown below is submitted

In principle, the examiner shall determine that it is proved that the
disclosed design complies with the requirements stated in 31.1.1, and
shall admit application of the provision of Article 4(2) of the Design Act.

However, if the examiner found a proof that have him/her doubt that
the “disclosed design” is a design to which the provision of Article 4(2)
of the Design Act is applicable, the examiner shall not admit application
of the provision of Article 4(2) of the Design Act.
### Form of "Proving Document"

**Proving Document for seeking Application of Exceptions to Lack of Novelty of Design**

1. **Facts of Disclosure**
   1) Disclosure date
   2) Disclosure site
   3) Discloser
   4) Contents of disclosed design (the photographs, etc. of the design needs to be attached)

2. **Facts of Succession to Right to Obtain Design Registration, etc.**
   1) Creator of disclosed design
   2) Person having right to obtain design registration as of action leading to disclosure of design (the right holder as of the action)
   3) Design registration applicant (the person stated in the application form)
   4) Discloser
   5) About succession to right to obtain design registration (succession to the right from the person in 1) to the person in 3) through the person in 2))
   6) About relation, etc. between right holder as of action and discloser (for example, the fact that the person in 4) disclosed the design resulting from the action of the person in 2) needs to be stated)

I hereby certify that the above statements are true. YYYY/MM/DD

Applicant Name (Signature)

In this section, the facts corresponding to the contents of "1. Facts of Disclosure" and "2. Facts of Succession to Right to Obtain Design Registration, etc." are hereinafter referred to as "facts of disclosure" and "facts of succession to right to obtain design registration, etc.," respectively.

#### 31.1.3.2 The case where the "proving document" made in a form that is different from the form mentioned in 31.1.3.1 has been submitted

If contents equivalent to the form mentioned in 31.1.3.1 is stated in the submitted "proving document", in principle, the examiner shall determine that it is proved that the disclosed design complies with requirements stated in 31.1.3.1, and shall admit the application of the provision of Article 4(2) of the Design Act.
However, even if the "proving document" in which the contents equivalent to the form mentioned in 31.1.3.1 has been submitted, in the case where the examiner finds evidence which casts any doubt on the fact that the "disclosed design" is an design to which the provision of Article 4(2) of the Design Act is applicable, the examiner shall not admit the application of the provision of Article 4(2) of the Design Act.

31.1.3.3 Determination procedures after a notice of reasons for refusal is issued without admission of the application of the provision of Article 4(2) of the Design Act

With regard to an "disclosed design" for which "facts of disclosure" are explicitly stated in the "proving document", after the examiner issues a notice of reasons for refusal without admitting the application of the provision of Article 4(2) of the Design Act, the applicant may assert that the application of the provision of Article 4(2) of the Design Act should be admitted through a written opinion, a written statement, or other such documents. In this case, the examiner shall determine again whether it is proved that the design complies with the requirements stated in 31.1.3.1, in consideration of the assertion of the applicant together with the matters stated in the "proving document".

31.1.4 Points to Note Regarding Determination on Application of Provision of Article 4(2) of the Design Act

31.1.4.1 Handling of disclosure action conducted between the earlier "date on which a design first fell under the provision" of Article 4(2) of the Design Act and the date on which application for design registration was filed, in the case where the same design were disclosed for multiple times

(1) In the case where the number of designs disclosed resulting from an action of a person having the right to obtain design registration is more than one, in order to seek the application of the provision of Article 4(2) of the Design Act, in principle, the "proving document" for each "disclosed design" must be submitted.

However In the case where a person having the right to obtain design registration disclosed a design, which has fallen under a publicly known design, subsequently multiple times based on the earlier disclosure prior to application for design registration, if the earlier disclosed design is a design that is subject to application of the provision of Article 4(2)
Part III Exception to Lack of Novelty

of the Design Act, in spite of the second and subsequent disclosures based on the earlier disclosure, the design shall be deemed not to have fallen under a publicly known design.

For example, in the following examples, if a disclosed design is a design that is subject to application of the provision of Article 4(2) of the Design Act with respect to earlier disclosure, in spite of the subsequent disclosure based on the earlier disclosure, the design shall be deemed not to have fallen under a publicly known design.

Example 1: In the case where a person having the right to obtain design registration delivered a same good to a same customer multiple times, a design disclosed by the first delivery and designs disclosed by the second and subsequent deliveries.

Example 2: A design that has been disclosed first by a person having the right to obtain design registration by delivering a product catalogue on which the design was published to the customer, and secondly and subsequently disclosed by delivering products in accordance with an order from a customer.

(2) In the case where a third party disclosed the same design as the “design which has first fallen under item (i) or (ii) of Article 3(1) of the Design Act” between “the date on which the design first fell under either of those items” and the date on which application for design registration was filed, in principle, the design shall be deemed to fall under a publicly known design through the disclosure by the third party.

However, in the case where it was clear that the disclosure by the third party was based on the disclosure of “the design which has first fallen under item (i) or (ii) of Article 3(1) of the Design Act” (note), in spite of the disclosure, the design shall not fall under a publicly known design.

(Note) “The case where it was clear that the disclosure by the third party was based on the disclosure of “the design which has fallen under item (i) or (ii) of Article 3(1) of the Design Act”” is referred to as the following designs, for example.

Example 1: The design disclosed by selling a good by the right holder to obtain design registration, and the design disclosed by publishing the good on a website by a third party who purchased the good.

Example 2: The design disclosed by exhibiting in a trade fair by the right holder to obtain design registration, and the design disclosed whose
31.1.4.2 Handling of application of the provision of Article 4(2) of the Design Act in the case where a design differing from the filed design is disclosed, etc.

According to the provision of Article 4(2) of the Design Act, regardless of the relationship between the disclosed design prior to application for design registration and the said design in application for design registration, such as whether or not the two designs are identical, similar or not similar, in determination of registration requirements of novelty (Article 3(1) of the Design Act) and creative difficulty (Article 3(2) of the Design Act), if the disclosed design stated in the "proving document" complies with the prescribed requirements, only the said disclosed design shall be deemed as a design not to have fallen under a publicly known design. Thus, application of the provision of Article 4(2) of the Design Act shall not be admitted for a disclosed design not stated in the "proving document", and the design shall be handled as a publicly known design.

The case where multiple designs being similar to each other are disclosed prior to application for design registration, etc. shall be handled as follows.

31.1.4.2.1 Handling of the case where design A and design A’ which are similar to each other are disclosed prior to application for design registration, and only design A is stated in the "proving document" of application A for design registration seeking for application of the provision of Article 4(2) of the Design Act.

In this case, only design A may be subject to application of the provision of Article 4(2) and shall be deemed not to have fallen under a publicly known design.

Thus, a design in application A for design registration that is similar to design A’ having fallen under a publicly known design prior to filing application thereof, shall fall under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where design A and design A’ are stated in the "proving document" of application A for design registration and prescribed requirements are complied with, design A and design A’ shall be subject to application of the provision of Article 4(2) of the Design Act and shall be deemed not to have fallen under a publicly known design.
31.1.4.2.2 Handling of disclosed design A with respect to application A’ for design registration in the case where in order to seek application of the provision of Article 4(2) of the Design Act with respect to application A for design registration of a principal design, design A disclosed prior to the design registration is stated in the “proving document”, but with respect to application A’ for design registration of a design subsequently filed as a related design, required procedures for seeking application of the provision of Article 4(2) of the Design Act are not conducted.

With respect to application A’ for design registration of a related design, since required procedures for seeking application of the provision of Article 4(2) of the Design Act are not conducted, disclosed design A may not be deemed as a design not to have fallen under a publicly known design.

Thus, a design of application A’ for design registration that is similar to disclosed design A having fallen under a publicly known design prior to filing application thereof, falls under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where procedures for seeking application of the provision of Article 4(2) of the Design Act are conducted with
respect to application A' for design registration of a related design and disclosed design A is stated in the “proving document” so as to comply with prescribed requirements, disclosed design A is subject to application of the provision of Article 4(2) of the Design Act and shall be deemed as a design not to have fallen under a publicly known design.

31.1.4.2.3 Handling of the case where design A and design A', which are similar to each other, are disclosed prior to filing application for design registration, and application A for design registration and application A' for design registration seeking application of the provision of Article 4(2) of the Design Act are filed, but only the disclosed design that is identical to the design in application is stated in the “proving document” of each application.

Regardless of whether the relationship between the both designs is a relationship between a principal design and a related design, with respect to application A for design registration, only design A stated in the “proving document” may be deemed as a design not to have fallen under a publicly known design according to the application of
the provision of Article 4(2) of the Design Act, similarly, with respect to application A’ for design registration, only design A’ stated in the “proving document” may be deemed as a design not to have fallen under a publicly known design according to application of the provision of Article 4(2) of the Design Act.

Thus, both of a design of application A for design registration, which is similar to disclosed design A’ having fallen under a publicly known design prior to filing application thereof, and a design of application A’ for design registration, which is similar to the disclosed design A having fallen under a publicly known design prior to filing application thereof, fall under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where in application A for design registration and application A’ for design registration, disclosed design A’ in the “proving document”, respectively, and the prescribed requirements are complied with, in both applications, disclosed design A and disclosed design A’ shall be subject to application of the provision of Article 4(2) of the Design Act and shall be deemed as a design not to have fallen under a publicly known design.
31.1.5 Requirements for application of the provision of Article 4(1) of the Design Act

In order to apply the provision of Article 4(1) of the Design Act to any disclosed design, the design needs to satisfy the following requirements (1) to (3).

(1) A design has fallen under the following design (i) or (ii) against the will of the person having the right to obtain a design registration (the creator of the design or to his successor in title).

(i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration.

(ii) Designs that were stated in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration.

(2) The person having the right to obtain a design registration of the above design (1) has filed the application for design registration.

(3) The application for design registration of the above design (1) has been filed within one year from the date on which the above design (1) was disclosed first.

31.1.5.1 Person having the right to obtain a design registration for the disclosed design

“Person having the right to obtain a design registration” as provided in Article 4(1) of the Design Act shall be referred to as a person having the right to obtain a design registration for the disclosed design at the time of the disclosure.

Generally, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure is the creator of the disclosed design, but where the creator had a third party succeed to the said right to obtain a design registration, the said person shall be a person who had succeeded the said right at the time of disclosure. As a result, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure and the creator of the design are different, the fact about the fact about the succession to the right needs to be clearly indicated and proved.

31.1.5.2 Fact that the disclosure was against the will of the person having the right to obtain a design registration for the disclosed design
Part III Exception to Lack of Novelty

design

A case where a design is disclosed against the will of the person having the right to obtain a design registration for the disclosed design falls under such a case as where a design created by a creator is disclosed by a third party through theft or misappropriation, for example.

The fact about the background that led to the disclosure against the will of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure needs to be clearly indicated and proved.

31.1.6 Procedures for receiving application of the provision of Article 4(1) of the Design Act

The procedures for receiving application of the provision of Article 4(1) of the Design Act (the time limitation on submission of a document stating a request for the application of the provision of Article 4(1) of the Design Act, making of a statement requesting application of said provision in the application document or submission of a document proving the fact that the design was disclosed against the will of the person having the right to obtain a design registration, etc.) are not provided in Article 4(3) of the Design Act.

Therefore, it is sufficient for an applicant for design registration of the application for design registration to clearly indicate and prove the fact that the requirements set forth in 31.1.5 mentioned above are complied with in a written opinion, a written statement, or other such documents, at the time when the fact that the disclosed design was disclosed against the will of the person having the right to obtain a design registration became clear, which is, for example, at the time when upon receiving a notice of the reasons for refusal under the provision of Article 3(1)(iii) of the Design Act for the application for design registration.

Meanwhile, where it becomes clear prior to the filing of the application for design registration that a disclosed design complying with the requirements set forth in 31.1.5 exists, the applicant for design registration may submit a document proving such fact upon filing the application for design registration.

31.1.7 Determination on application of the provision of Article 4(1) of the Design Act

The examiner shall determine whether reasonable clarification that the said disclosed design comply with the requirement of 31.1.5 mentioned above is made by a written opinion, a written statement, or other such document submitted by an applicant for indicating that a disclosed design may be subject to application of the provision of Article 4(1) of the Design Act.