

## Chapter II Novelty & Creative Difficulty

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### Section 1 Novelty

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#### 1. Outline

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Article 3, paragraph (1) of the Design Act provides that designs that were publicly known (item (i)), or designs that were described in a distributed publication or designs that were made publicly available through an electric telecommunication line (item (ii)), in Japan or a foreign country, prior to the filing of the application for design registration (hereinafter collectively referred to as “publicly known designs”), or designs similar to those publicly known designs (item (iii)) may not be obtained design registrations.

Since the purpose of the design system is to encourage the creation of designs thereby contributing to the development of industry, designs eligible for design registration must be new creations. The provisions of this paragraph were established for the purpose of acknowledging this requirement objectively.

This Section describes the determination of novelty for a filed design.

#### 2. Determination of novelty

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##### 2.1 Basic concept in determining novelty

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The examiner determines whether the filed design has novelty by comparing the filed design against publicly known designs (Note). If, as a result, the two designs are found to be identical, the examiner should determine that the filed design lacks novelty. In addition, even where there are points of difference between the two designs, if the two designs are found to be similar, likewise, the examiner should determine that the filed design lacks novelty.

Determining whether two designs are similar or not (hereinafter referred to as “determination of similarity”) is conducted as described in 2.2 “Determination of similarity” below.

Furthermore, for information that serves as the basis for determining novelty, see 2. “Information that serves as the basis for determination” in Section 3 “Points to Note when Examining Novelty & Creative Difficulty” in this Chapter.

(Note) Not only a design for an article, etc. that has become publicly known as a result of being described in a publication, etc., but also a design for an article, etc. that is included in and not similar to the said article, etc. (for example, the design for a component of the said article, etc.) should be treated as information that serves as the basis for determination of novelty if the specific shape, etc. of the design itself can be identified. Furthermore, a design for which the specific shape, etc. of the article, etc. to the design can be identified in “any other part,” other than the “part for which the design registration is requested,” of a design for which the design registration is requested for part of an article, etc., which has been published in a design bulletin, should also be similarly treated as information that serves as the basis for determination of novelty, etc.

## 2.2 Determination of similarity

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The approaches explained below for determining similarity between designs indicate the basic concept concerning the method of extracting and comparing the design characteristics, that is, the elements forming the aesthetic impression of the design, which are necessary for ensuring objective determination of similarity in design examination.

### 2.2.1 Determining entity

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The determining entity in the determination of similarity is consumers (including traders).

There are no provisions in any of the articles of the Design Act regarding the entity that determines similarity in the determination of novelty. However, because Article 24, paragraph (2) of the Design Act, which provides for the scope of a registered design, states “whether a registered design is identical with or similar to another design shall be determined based upon the aesthetic impression that the designs would create through the eye of their consumers,” the entity that determines similarity in the determination of novelty shall also be consumers (including traders). Furthermore, since the term “consumers” as referred to in this provision is a concept that includes traders, they will be referred to as “consumers (including traders)” here, and shall be persons who are appropriate according to the actual status of trade and distribution of the article.

Although determination of similarity largely depends on the human senses, the determination should be made based on the objective impressions of consumers (including traders) as observed by them, while eliminating the subject perspective of the creator.

### 2.2.2 Approaches for determining similarity

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Since the article, etc. and shape, etc. are inseparably integrated in a design, unless the articles, etc. to the design of the two designs being compared are identical or similar, the designs are not similar.

Accordingly, the examiner should determine that the two designs being compared are similar only where the two designs comply with all of the following.

Even between designs of articles, graphic images and buildings, where the two designs being compared comply with all of the following, the examiner should determine that the two designs are similar.

- (1) Where the filed design is one requesting design registration for the entire article, etc.
  - (i) The usage and function of the article, etc. to the design of the filed design and those of a publicly known design are identical or similar
  - (ii) The shape, etc. of the filed design and a publicly known design are identical or similarWhere the designs are identical with regard to both (i) and (ii) above, the examiner should determine that the two designs are identical.
  
- (2) Where the filed design is one requesting design registration for part of an article, etc.
  - (i) The usage and function of the article, etc. to the design of the filed design and those of a publicly known design are identical or similar

- (ii) The usage and function of the “part for which the design registration is requested” of the filed design and the part in the publicly known design that coincides with the “part for which the design registration is requested” are identical or similar
  - (iii) The position, size, and scope of the “part for which the design registration is requested” of the filed design in the shape, etc. of the entire article, etc. and those of the part in the publicly known design that coincides with the “part for which the design registration is requested” in the shape, etc. of the entire article, etc. are identical or within the scope of ordinary in the art of the design
  - (iv) The shape, etc. of the “part for which the design registration is requested” of the filed design and that of the part in the publicly known design that coincides with the “part for which the design registration is requested” are identical or similar
- (Note) The shape, etc. of “any other parts” alone is not subject to comparison.

Where the designs are identical with regard to all of (i) through (iv) above, the examiner should determine that the two designs are identical.

#### 2.2.2.1 Viewpoints for determining similarity between designs

The examiner should determine similarity according to the viewpoints set forth in (a) through (g) below.

- (a) Finding of the usage and function of the articles, etc. to the design of the two designs being compared, and determination of similarity (→ see 2.2.2.2)
- (b) Finding of common points and different points in the usage and function of a part of an article etc., in the case of a design for which the design registration is requested for that part (→ see 2.2.2.3)
- (c) Finding of common points and different points in the position, size, and scope of a part of an article etc., in the case of a design for which the design registration is requested for that part (→ see 2.2.2.4)
- (d) Finding of the shape, etc. of the two designs being compared (→ see 2.2.2.5)
- (e) Finding of common points and different points in the shape, etc. of the two designs being compared (→ see 2.2.2.5)
- (f) Individual evaluation of common points and different points in the shape, etc. of the two designs being compared (→ see 2.2.2.6)
- (g) Comprehensive determination of similarity (→ see 2.2.2.7)

#### 2.2.2.2 Finding of the usage and function of the articles, etc. to the design of the two designs being compared, and determination of similarity

The examiner should find the usage and function of the articles, etc. to the design based on the purpose of use, state of use, etc. of the articles, etc. to the design of the two designs being compared.

Similarity between designs assumes that the usage and function of the articles, etc. to the design of the two designs being compared are identical or similar.

The same is also true for designs for which the design registration is requested for part of an article, etc. For example, suppose an application for design registration is filed in which the design registration is requested for the grip part of a still camera. Given the article to the design, which is the object of the right, is the “still camera” that includes the grip part, the information that serves as the basis for determination of novelty should be designs for “still cameras” and for articles, etc. similar thereto.

Determining that the “usage and function of the articles, etc. to the design are identical or similar” above does not require judgment of similarity based on a comparison of the detailed usage and function of the articles, etc., and it is sufficient to determine that there is similarity in the usage and function of the articles, etc. if they have commonality in their usage (purpose of use, state of use, etc.) and function within the extent of assessing the value of the shape, etc. represented in the specific articles, etc.

Where there is no commonality in the usage (purpose of use, state of use, etc.) and function of the articles, etc. to the design, the designs are not similar.

#### 2.2.2.3 Finding of common points and different points in the usage and function of a part of an article etc., in the case of a design for which the design registration is requested for that part

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Where the filed design is one for which the design registration is requested for part of an article, etc., the examiner should find common points and different points in the usage and function of the “part for which the design registration is requested” and those of the part in the publicly known design that coincides with the “part for which the design registration is requested.”

#### 2.2.2.4 Finding of common points and different points in the position, size, and scope of a part of an article etc., in the case of a design for which the design registration is requested for that part

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Where the filed design is one for which the design registration is requested for part of an article, etc., the examiner should find common points and different points between the position, size, and scope of the “part for which the design registration is requested” in the shape, etc. of the entire article, etc. and the position, size, and scope of the part in the publicly known design that coincides with the “part for which the design registration is requested” in the shape, etc. of the entire article, etc.

Furthermore, a difference in position, size or scope has hardly any influence if it is within the scope of ordinary in the art of the design.

#### 2.2.2.5 Finding of the shape, etc., and finding of common points and different points in the shape, etc. of the two designs being compared

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##### (1) Observation by the naked eye

Observation is based on visual observation by the naked eye (however, even where the shape, etc. is not recognizable by the naked eye, it should be treated in the same way as a shape, etc. that is recognizable by the naked eye if it is normal to observe the article, etc. under magnification at the time of trading.)

This is because articles, etc. are normally observed by the naked eye, and the aesthetic impression made by the entire shape, etc. that can be recognized by the naked eye affects the selection and purchase of the article, etc. to the design. Where the shape, etc. of the entire article, etc. to the design can be recognized by the naked eye, but the shape, etc. of a part of the article, etc. is too fine to be recognized by the naked eye, in determining similarity, the examiner should find only the shape, etc. that is recognizable by the naked eye to be the shape, etc. of the design.

##### (2) Observation method

Determination of similarity between designs is made by an observation method that is normally used when observing the article, etc. to the design.

For example, in the case of the design of a writing tool that can be visually observed by actually holding it in the hand both at the time of purchase and at the time of use, the entire design is observed with the same weight, but in the case of the design of a television receiver whose rear surface and bottom surface are not seen in a normally installed state, the examiner should make observation by placing greater emphasis on the front surface, side surface and top surface directions.

(3) Finding of the shape, etc.

The examiner should find the shape, etc. of the entire article, etc. to the design (also referred to as the main structural shape, etc. or the basic constitution when taking a general overview of the design) of the two designs and the shape, etc. of each part.

(4) Finding of common points and different points in the shape, etc.

The examiner should find common points and different points in the shape, etc. of the entire article, etc. to the design of the two designs (basic constitution) and in the shape, etc. of each part.

Where the filed design is one for which the design registration is requested for part of an article, etc., the examiner should find common points and different points in the entire shape, etc. and the shape, etc. of each part of the “part for which the design registration is requested” and those of the part in the publicly known design that coincides with the “part for which the design registration is requested.” However, the examiner should not directly find common points and different points in the shape, etc. of “any other parts.”

#### 2.2.2.6 Individual evaluation of common points and different points in the shape, etc. of the two designs being compared

With regard to the shape, etc. in the common points and different points of the two designs, the examiner should conduct the following: (1) finding of whether or not the shapes, etc. are parts that draw attention when comparatively observed and evaluation of the extent to which they draw attention; and (2) evaluation of the extent to which the shape, etc. draws attention in comparison to prior designs.

By considering the extent to which the shape, etc. in the common points and different points draws attention from the viewpoints of (1) and (2), the examiner should determine the degree of influence that each common point and different point has on the aesthetic impression of the entire design.

(1) Finding and evaluation of whether or not the shapes, etc. are parts that draw attention when comparatively observed

The examiner should find and evaluate whether or not the shape, etc. in each common point and different point of the two designs is a part that draws attention when comparatively observed and the extent to which they draw attention based on: (i) the relative size of the proportion of the part in the entire design; and (ii) whether the part has a large influence on the visual impression considering the characteristics of the article, etc. to the design.

While the specific evaluation method and evaluation results differ for individual designs, in general, they are as follows.

(a) Evaluation of the proportion of the part in the entire design

If a part pertaining to a common point or different point between the filed design and the publicly known design is large in proportion to the entire article, etc. to the design, the extent to which that part draws attention is larger than in the case where the part is small.

The shape, etc. of the entire article, etc. to the design (basic constitution) can be regarded as the main structure of the design, so it normally has the largest influence on the visual impression.

(b) Evaluation of the difference in the size of the articles

Even if the articles, etc. to the design of the two designs differ in size (including the ordinary scope of size that is found where there is no explanation of the size), the difference does not draw strong attention unless it affects the finding of the usage and function of the articles, etc.

(c) Evaluation of whether or not the part is easily observed based on the characteristics of the articles

There are parts of a design that are easily observed and parts that are not easily observed when making visual observation. If the shape, etc. of a common point or different point of the two designs is the shape, etc. of an easily observed part, it is likely to draw attention.

An easily observed part is extracted by finding (1) whether or not the part is easy to see when selecting or purchasing the article, etc. to the design, and (2) whether or not it is a part which consumers (including traders) observe with interest, based on the usage (purpose of use, state of use, etc.) and function, size, etc. of the article, etc. to the design.

However, even where the part is extracted in this way, it is not taken into consideration as a design characteristic if its shape, etc. is solely based on functional necessity.

(d) Evaluation of the internal shape, etc. of the article, etc.

Since designs should be compared mainly with regard to the shape, etc. of parts that are eye-catching when observing the articles, etc. to the design, during determination of similarity, their internal shape, etc. which is not visible under normal conditions of use is not taken into consideration as a design characteristic. On the other hand, if the internal shape, etc. can be observed under normal conditions of use, the shape, etc. that is eye-catching during use is the part that is likely to draw attention.

For example, in the case of the design of a refrigerator, the state of the door open is one of the shapes, etc. during use, but since the usage and function of a refrigerator are to cool and store food and other items inside with the door closed, it is normally visually observed with the door closed. Therefore, in such a case, the outer appearance with the door closed draws more attention than the internal shape, etc. On the other hand, in the case of the design of a bathroom, etc. which people go inside to use, the internal shape, etc. is the part that draws attention.

(e) Evaluation of a shape, etc. that is visually observed only during distribution

In the case of an article, etc., a part of which is no longer visible when used or installed (such as a fence a part of which is buried in the ground, or a lighting apparatus a part of which is hidden in a wall or ceiling), in principle, the part that

is visually observed only during distribution draws less attention than the other parts.

However, where the shape, etc. of such other parts have little influence on the aesthetic impression of the entire design, such as being ordinary shapes, etc., the part that is visually observed only during distribution may become relatively more important in the entire design, and may affect similarity when making the final determination of similarity of the entire designs.

(2) Evaluation based on comparison with prior designs

Evaluation is made on whether or not the shape, etc. of each common point or different point between the filed design and the publicly known design is likely to draw attention when compared with prior designs. Whether or not the shape, etc. is likely to draw attention depends on the number of publicly known designs having the same shape, etc., the extent to which the shape, etc. differs from other commonly seen shapes, etc., or the level of the creative value of the shape, etc.

(a) Evaluation of common points based on prior design searches

Where the shape, etc. of each common point between the filed design and the publicly known design is an ordinary mode that is regularly seen in other prior designs, the shape, etc. cannot be regarded as a distinctive shape, etc. Therefore, such shape, etc. draws less attention than a shape, etc. that is also seen in other prior designs but which is not an ordinary mode that is regularly seen.

In either case, an ordinary shape, etc. or a publicly known shape, etc. is not simply excluded from the basis of determination.

(b) Evaluation of different points based on prior design searches

Where the shape, etc. of each different point that is found through comparison between the filed design and the publicly known design is a novel shape, etc. that is not seen in other prior designs and is found to have a high creative value, that shape, etc. gives a strong impression of being different from conventional shapes, etc. and draws strong attention. Where the shape, etc. of each different point is an ordinary mode that is regularly seen in other prior designs, that shape, etc. cannot draw strong attention. However, in some cases, the mode of the combination of an ordinary shape, etc. and a publicly known shape, etc. could draw attention depending on the combination.

(3) Handling of shapes, etc. that have functional meaning and shapes, etc. derived from materials

Shapes, etc. that have functional meaning and shapes, etc. derived from materials are generally handled as follows.

(a) Evaluation of functional shape

Where there is formative freedom in meeting the functional demands and the shape is not inevitable, the formative characteristics of that shape should be taken into consideration. However, a design consisting solely of shapes that are indispensable for securing the functions of the article, etc. is not protected, because it would mean granting an exclusive right for the creation of a technical idea, which is not intended to be protected under the Design Act (Article 5, item (iii) of the Design Act).

Also, slight differences in shape that do not significantly influence the visual impression are not regarded as particularly important, even if the differences have a significant bearing upon function.

- (b) Evaluation of patterns that incorporate a consideration to meet the functional demands of the article, etc.

In addition to patterns simply for the purpose of decoration (such as the pattern applied to the surface of a table plate), it has become relatively common in recent years for the mode of the input/operating part to be configured as a flat figure, etc. that is not accompanied by a bumpy three-dimensional shape, such as sheet key and touch panel. The design characteristics of a pattern that has a certain function in relation to such an article, etc. to the design is evaluated after understanding the meaning of the pattern, that is, what is intended by the pattern and what kind of function the pattern plays in relation to the usage and function of the article, etc., and the pattern is evaluated in the same way as in the case of a shape.

- (c) Evaluation of patterns and colors arising from materials

The patterns and colors to be truly taken into consideration as constituent elements of a design are the patterns and colors that are represented based on the creative act of the creator. However, where the design represented by the drawings, etc. attached to the application is found to be represented by the natural patterns and colors of the materials that are normally used for manufacturing the article, etc. to the design, those patterns and colors are ordinary in the art of the design and have very little influence on the aesthetic impression of the entire design.

#### 2.2.2.7 Comprehensive determination of similarity

Determination is made on 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, based on the individual evaluation of each common point and different point in the shape, etc. of the two designs.

Since elements of an entire design are combined with organic linkage between them, similarity cannot be determined by merely individually evaluating each common point and different point. Evaluation must be made on what kind of influence the common points and different points have on the similarity of the aesthetic impressions of the entire designs, when comprehensively examining the common points and different points while also paying attention to the combination of the respective shapes, etc.

The basic concept is as follows.

- (1) Comprehensive determination on the common points and different points

Whether or not a certain common point or different point becomes the most important element in determining similarity is decided by its relative relationship with the other common points and different points. When considering the degree of influence that a certain common point or different point has on the determination of similarity, if the other common points and different points have little influence on the aesthetic impressions of the entire designs, the said common point or different point will have a relatively large influence on the determination of similarity. On the other

hand, if there is another common point or different point that has the same or larger degree of influence on the aesthetic impressions of the entire designs, the said common point or different point will have a relatively small influence on the determination of similarity.

(2) Shape, etc. of the entire article, etc. to the design (basic constitution)

The shape, etc. of the entire article, etc. to the design (basic constitution) can be regarded as the main structure of the design, and it has the largest influence on the aesthetic impression created through the eye. Therefore, in order for designs to be similar, in principle, there must be commonalities in the shapes, etc. of the entire articles, etc. to the designs (basic constitutions).

However, even if there are different points in the shapes, etc. of the entire articles, etc. to the designs (basic constitutions) between the filed design and the publicly known design, if both shapes, etc. are ordinary and the common points in the shape, etc. of each part are conspicuous, the two designs may be regarded as similar, in spite of the difference in the shapes, etc. of the entire articles, etc. to the designs (basic constitutions).

For example, where there are two designs of patterned rectangular parallelepiped packaging boxes with different length-width-height ratios, if they are both found to be ordinary as ratios of packaging boxes and do not draw attention, and their common patterns are found to be distinctive and draw strong attention, the two designs may be regarded as similar, surpassing the differences in the shapes, etc. of the entire articles, etc. to the designs (basic constitutions) (the length-width-height ratios of the entire boxes).

Also, where different points in the shape, etc. of each part have little influence on determination of similarity, the common shape, etc. of the entire articles, etc. to the designs (basic constitutions) will have the largest influence on the determination of similarity between the designs, even if it is ordinary, and the two designs could be determined to be similar in some cases.

In addition, even if a design is an aggregation of publicly known or well-known shapes, etc., if the mode of the combination is novel and the shape, etc. of the entire article, etc. to the design (basic constitution) is novel, the shape, etc. of the entire article, etc. to the design (basic constitution) employing such combination is evaluated as a novel shape, etc.

(3) Publicly known shape, etc. used within the design in the application

A publicly known shape, etc. used within the filed design generally has smaller influence on determination of similarity than a novel shape, etc., but since a design is composed of elements that are organically combined as a whole, even if the shape, etc. of a common point or a different point were a publicly known shape, etc., a determination will not be made only with regard to the other common points and different points by simply excluding such common point or different point.

Where a combination of publicly known shapes, etc. is novel, the mode of such combination will be evaluated.

(4) Relationship between constituent elements of the design

While it is not possible to generalize which of the constituent elements of a design (shape, pattern and color) has a large influence on the determination of similarity, it can be said that the element that has the most notable characteristic and most draws

attention in relation to prior publicly known designs has a large influence on the determination of similarity.

However, while the shape and pattern often require creation based on human knowledge, a color is more appropriately described as a selection rather than a creation, unless it constitutes a pattern, and a large product variation is normally provided with only a change in color, so color is less likely to draw attention than the shape and pattern. Therefore, generally, color has a smaller influence on the determination of similarity than the shape and pattern.

(5) Relationship with existing cases of determination of similarity in the same field of articles, etc.

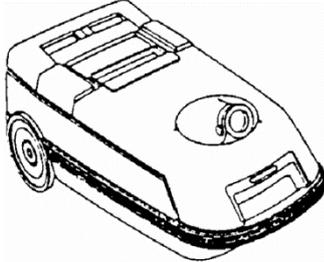
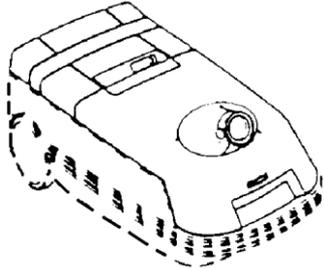
In general, where evaluation on the degree to which common points and different points between two designs being compared influence the aesthetic impressions of the entire designs is similar to such evaluation made in existing cases of determination in the same field of articles, etc., the result will be equivalent to that in the existing cases of determination of similarity.

However, since determination of similarity between designs is made for the entire designs including the other parts, even if the two designs being compared have equivalent common points or different points to those in existing cases of determination, considering the characteristics of the articles, etc., the finding of whether or not they are common points or different points in a part that draws attention in the entire designs and the evaluation of the extent to which the part draws attention will not always be the same. Furthermore, prior publicly known designs are accumulated day by day, so the evaluation based on comparison to prior publicly known designs will not always be the same.

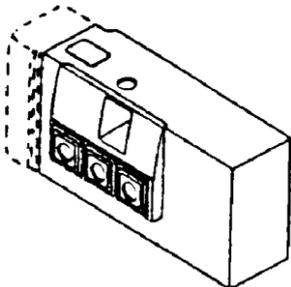
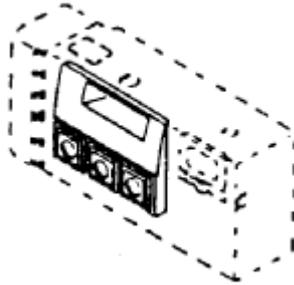
Thus, even if the designs have equivalent common points or different points, evaluation on the degree to which they influence the determination of similarity will not always be the same, so the conclusion made in an existing case of determination of similarity in the same field of articles, etc. is not simply applied to another case.

2.2.2.8 Examples of designs for which the design registration is requested for part of an article, etc. that is similar to a publicly known design

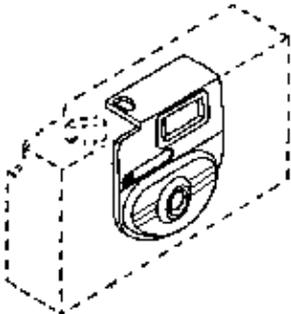
[Case example 1]

Publicly known design “Main body of a vacuum cleaner”	Filed design “Main body of a vacuum cleaner”
	

[Case example 2]

Publicly known design “Still camera” (Design (part) published in a design bulletin)	Filed design “Still camera”
	

[Case example 3]

Publicly known design “Still camera” (Design (part) published in a design bulletin)	Filed design “Camera lens with a view finder”
	

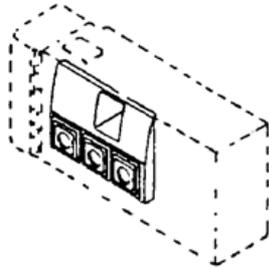
[Case example 4]  
Publicly known design  
“Packaging bottle”  
(Design (part) published in a  
design bulletin)



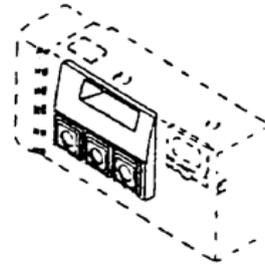
Filed design  
“Packaging bottle”



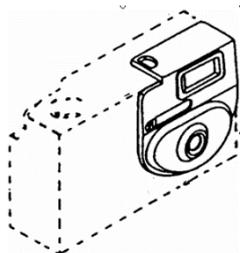
[Case example 5]  
Publicly known design  
“Still camera”  
(Design (part) published in a  
design bulletin)



Filed design  
“Still camera”



[Case example 6]  
Publicly known design  
“Digital camera”  
(Design (part) published in a  
design bulletin)



Filed design  
“Digital camera”

