

Section 3 Points to Note when Examining Novelty & Creative Difficulty

1. Application of the provisions on novelty and creative difficulty

In examining the novelty and creative difficulty of a filed design, the examiner should first determine whether it complies with the requirements for novelty. The examiner should make a determination on creative difficulty only where no reason for refusal is found for novelty.

This is because Article 3, paragraph (2) of the Design Act provides that “except for designs prescribed in any of the items of the preceding paragraph” (Note).

(Note) “The items of the preceding paragraph” (the items of Article 3, paragraph (1) of the Design Act) prescribe the requirements for novelty.

2. Information that serves as the basis for determination

Information that serves as the basis for determination of novelty and creative difficulty is information that falls under any of the following 2.1 to 2.3, either in Japan or a foreign country, prior to the filing of the application for design registration.

In determining whether the information has become public prior to the filing of the application for design registration, the hours, minutes, and seconds should be taken into account. Where information has become publicly known in a foreign country, determination should be made based on a comparison of time converted into Japan time. (For international applications for design registration, see 1. “Novelty & Creative Difficulty” in Part IX, Chapter IV “Requirements for Design Registration of International Applications for Design Registration.”)

2.1 “Described in a distributed publication” (Article 3, paragraph (1), item (ii), Article 3, paragraph (2))

“Described in a distributed publication” means described in a publication (Note 1) which is made available for unspecified persons to view (Note 2).

(Note 1) “Publication” refers to a document, drawing or other similar medium for communicating information, which has been reproduced for the purpose of disclosing the contents through distribution to the general public.

(Note 2) The fact that someone has actually viewed the publication is not a requirement.

(1) Design described in a publication, etc.

“Design described in a publication” (including “shape, etc. or graphic image” in the case of determining creative difficulty; hereinafter the same shall apply in this paragraph) means a design that can be ascertained from matters described and matters equivalent to those described in a publication.

The examiner should find designs that can be ascertained from these matters as designs described in a publication.

The expression “matters equivalent to those described in a publication” means matters that a person skilled in the art could derive from matters described in the

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publication based on the ordinary skill in the art of the design at the time of the filing of the application.

The examiner may not regard a design as a “cited design” if it cannot be ascertained by a person skilled in the art from matters described and matters equivalent to those described in a publication. This is because such a design is not a “design described in a publication.”

(2) Handling of the time of distribution

a. Inferring the time of publication distribution

Does the publication include a statement of when it was published?		Inferred distribution time
Yes (Note)	Where only the year of publication is stated	The end of the last day of that year
	Where the month and year of publication are stated	The end of the last day of that month in the year
	Where the day, month and year of publication are stated	The end of that day in the month and year
No	In the case of a foreign publication, where the timing of when it was received in Japan is known	The date backdated from when it was received in Japan by the period of time normally required from the country of publication to Japan
	Where there is another publication that contains a book review, excerpt or catalog, etc. about the publication	The date on which the other publication was distributed, estimated from when it was published
	Where the publication's reprinted or revised edition, it contains when the first edition was published	The date noted when the first edition was published
	Where there is other relevant information	The distribution date that can be inferred or recognized from that information

(Note) Where there is other relevant information besides the publication date stated in the publication, the examiner may assume that the distribution date which can be inferred or recognized from that information is the distribution time of the publication. For example, where there is a known date on which the publication was accepted (the date of acceptance seal) as examination materials by the Japan Patent Office.

b. Handling of cases where the filing date of the application for design registration and the publication date are the same

Where the filing date of an application for design registration and the publication date are the same, the examiner should not treat the distribution date as being prior to the filing of the application for design registration, unless it is clear that the publication was published before the application for design registration was filed.

2.2 “Made publicly available through an electric telecommunication line” (Article 3, paragraph (1), item (ii), Article 3, paragraph (2))

“Made publicly available through an electric telecommunication line” means posted on a webpage, etc. (Note 1) which is made available for unspecified persons to view (Note 2) via electric telecommunication lines (Note 3).

(Note 1) “Webpage, etc.” means those that post information on the Internet, etc.

“Internet, etc.” means the Internet, commercial databases, mailing lists and other means of providing information via electric telecommunication lines.

(Note 2) The fact that someone has actually accessed the webpage, etc. is not a requirement.

Specifically, a webpage, etc. can be described as having been made available to the public (made available for unspecified persons to view) if it satisfies both (i) and (ii) below.

(i) The webpage, etc. can be reached on the Internet through a link from another publicly known webpage, etc. and is registered with a search engine, or its address (URL) is listed in a means of communicating information to the public (for example, a widely-known newspaper or magazine).

(ii) Public access to the webpage, etc. is not restricted.

(Note 3) The term “line” means a transmission channel capable of two-way communication, generally consisting of a round-trip communication path. Broadcasting that can only transmit information one-way is not included under “line.” Cable television, etc. which transmits communication in both directions falls under the category of “line.”

(1) Designs posted on webpages, etc.

“Design posted on a webpage, etc.” (including “shape, etc. or graphic image” in the case of determining creative difficulty; hereinafter the same shall apply in this paragraph) means a design that can be ascertained from matters posted and matters equivalent to those posted on a webpage, etc.

The examiner should make findings on designs posted on webpages, etc. according to the descriptions in 2.1(1). However, in order to cite a design, matters posted on the webpage, etc. need to have been posted on that webpage, etc. with the same contents at the time of posting.

The examiner should determine whether or not a webpage, etc. was publicly available prior to the filing of the application based on the post date indicated on the webpage, etc. (Note 4).

(Note 4) Where the post date is not stated or only the year or month is stated and thus it is unclear whether the post date is prior to or after the filing date, the examiner may cite the posted information if proof regarding the post date can be obtained from an authorized person responsible for the posting, maintenance etc. of such information and the post date is prior to the filing date.

(2) Counterargument by an applicant regarding the date and content of posting (whether matters posted on the webpage, etc. were posted on that webpage, etc. with the same contents at the time of posting)

a. Cases where the applicant counterargues that the indicated date and content of posting are unreliable, saying only that it is not supported by evidence and is simply a disclosure on a webpage, etc.

In this case, because no specific evidence has been presented, the examiner should not accept that counterargument.

- b. Cases where the applicant makes a counterargument while presenting specific evidence, raising doubts about the date or content of posting

The examiner should contact the authorized person responsible for the posting, maintenance etc. of the information, and request that they confirm the date or content of the posting. At this time, the examiner should request the person issue a certificate about the date or content of posting on the webpage, etc.

Upon examining the counterargument etc. by the applicant, where the examiner's conviction about there being doubt remains unchanged, the examiner should not cite the shape, etc. posted on the webpage, etc.

2.3 "Publicly known" (Article 3, paragraph (1), item (i), Article 3, paragraph (2))

"Publicly known" means that the contents were known to unspecified persons as information that is not confidential (Note).

In particular, "publicly known" information that can be recalled just at the mention of its name, without having to produce evidence, is referred to as "widely known."

(Note) Information is "publicly known" if it became known to someone from a person with obligations of confidentiality as information that is not confidential. This is unrelated to whether the creator or applicant intended to keep it confidential.