

Chapter III Exception to Lack of Novelty

1. Outline

Article 4 of the Design Act provides for an exception to lack of novelty, namely, where a created design has become 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 as a “disclosed design”), and where the person having the right to obtain a design registration for the 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, only with regard to the said application for design registration, the said disclosed design shall be deemed not to be a publicly known design in determining the requirements of novelty (the items of Article 3, paragraph (1) of the Design Act) and creative difficulty (Article 3, paragraph (2) of the Design Act).

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

Furthermore, an application for design registration for a design for which the design registration is requested for part of an article, etc. may also be subject to application of the provisions of Article 4, paragraph (1) or (2) of the Design Act.

2. Requirements for applying the provisions of Article 4, paragraph (2)

The examiner should admit application of the provisions of Article 4, paragraph (2) of the Design Act to a disclosed design only where it is determined that the design complies with all of the following requirements (1) to (3).

- (1) The design has fallen under (i) or (ii) below as a result of an act of the person having the right to obtain a design registration (the creator of the design or their successor).
 - (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.

However, this excludes the design that has fallen under (i) or (ii) above as a result of information being published in a gazette relating to an invention, utility model, design or trademark (Article 4, paragraph (2) of the Design Act).

- (2) The person having the right to obtain a design registration for the design in (1) above has filed the application for design registration.
- (3) The application for design registration has been filed within one year from the date on which the design in (1) above was disclosed for the first time.

In making a determination on the application of the provisions of Article 4, paragraph (2) of the Design Act, the examiner should determine whether or not the above requirements have been proven to have been met, based on the “proving document” submitted pursuant to the provisions of Article 4, paragraph (3) or (4) of the Design Act (hereinafter simply referred to as the “proving document”).

2.1 Person having the right to obtain a design registration

A “person having the right to obtain a design registration” as provided in Article 4, paragraph (2) of the Design Act means 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 a third party had succeeded to the creator’s right to obtain a design registration prior to disclosure, it shall be the person who had the said right at the time of disclosure as a result of the succession. If the person having the right to obtain a design registration for the disclosed design at the time of disclosure is different from the creator, the fact of succession must be clearly indicated and proved.

2.2 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

The fact that the 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 needs to be clearly indicated and proved in the proving document.

3. Specific procedures for seeking application of the provisions of Article 4, paragraph (2) of the Design Act

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

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

(2) A document proving that the disclosed design is a design that is subject to application of the provisions of Article 4, paragraph (2) of the Design Act must be submitted to the Commissioner of the Patent Office within 30 days from the filing date of the application for design registration (Article 4, paragraph (3) of the Design Act). However, in cases where there have been two or more acts of a person having the right to obtain a design registration which have resulted in it falling under items (i) or (ii) of Article 3, paragraph (1) of the Design Act in respect of the identical or similar design, it would be sufficient to submit the “proving document” with respect to one of the two or more acts conducted on the earliest date (Article 4, paragraph (3) of the Design Act).

In addition, with regard to submission of the proving document, according to the provisions 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 document of submission of a certificate for requesting the exception to lack of novelty.

4. Procedures for determining application of the provisions of Article 4, paragraph (2) of the Design Act based on a “proving document”

4.1 Cases where a “proving document” prepared according to the following format is submitted

In principle, the examiner should determine that the disclosed design has been proved to comply with the requirements stated in 2. “Requirements for applying the provisions of Article 4, paragraph (2)” in this Chapter, and should admit application of the provisions of Article 4, paragraph (2) of the Design Act.

However, if the examiner finds evidence which casts doubt on the fact that the “disclosed design” is a design that is subject to application of the provisions of Article 4, paragraph (2) of the Design Act, the examiner should not admit application of the provisions of Article 4, paragraph (2) of the Design Act.

Format of “proving document”

<p>Certificate for requesting application of the provisions on exception to lack of novelty of design</p>	<p>Photograph, etc. presenting disclosed design (separate sheet allowed)</p>
<p>1. Facts of disclosure</p> <ul style="list-style-type: none">(i) Disclosure date(ii) Disclosure site(iii) Discloser(iv) Contents of disclosed design (attach photographs, etc. of the design)	
<p>2. Facts concerning succession to the right to obtain design registration, etc.</p> <ul style="list-style-type: none">(i) Creator of disclosed design(ii) Person having the right to obtain a design registration at the time of the act leading to disclosure of design (the right holder at the time of the action)(iii) Applicant for design registration (the person stated in the application form)(iv) Discloser(v) About succession to the right to obtain a design registration (transfer of the right from the person in (i) through the person in (ii) to the person in (iii))(vi) Relationship, etc. between the right holder at the time of the action and the discloser (e.g., state that the person in (iv) disclosed the design as a result of an act of the person in (ii))	
<p>I hereby certify that the above statements are true.</p>	<p>YYYY/MM/DD Applicant name</p>

In this Chapter, the facts equivalent to the contents of “1. Facts of disclosure” and “2. Facts concerning succession to the right to obtain design registration, etc.” above are hereinafter referred to as “facts of disclosure” and “facts concerning succession to the right to obtain design registration, etc.,” respectively.

4.2 Cases where the “proving document” is submitted in a format different from that indicated in 4.1 above

If the content of the submitted “proving document” is equivalent to the format indicated in 4.1 above, in principle, the examiner should determine that the disclosed design has been proved to comply with the requirements stated in 2., and should admit application of the provisions of Article 4, paragraph (2) of the Design Act.

However, even if a “proving document” is submitted with content equivalent to the format indicated in 4.1, if the examiner finds evidence which casts doubt on the fact that the “disclosed design” is a design that is subject to application of the provisions of Article 4, paragraph (2) of the Design Act, the examiner should not admit application of the provisions of Article 4, paragraph (2) of the Design Act.

4.3 Specific determination in regard to the contents stated in the “proving document”

The examiner shall make a determination in regard to the contents stated in the “proving document” as follows.

4.3.1 “Disclosure date” of disclosed design

The date on which the disclosed design was publicly known, that is the date on which the contents were known to unspecified persons as not being secret, and the

date on which the design was described in a distributed publication or the date on which the design was made publicly available through an electric telecommunication line in Japan or a foreign country, shall be the disclosure date of the said design.

In cases where the design has been publicly known in a foreign country, it shall be determined with the date converted to Japan time. For example, if the design is disclosed in Japan at 10am on January 1st and simultaneously disclosed in the eastern United States (9pm on December 31st local time), January 1st Japan time shall be the earliest date.

4.3.2 “The earliest date” (the proviso to Article 4, paragraph (3) of the Design Act)

In cases where there are multiple identical or similar disclosed designs which have fallen under a publicly known design as a result of the acts of a person having the right to obtain a design registration, it would be sufficient to state in the “proving document” any one act conducted on the earliest date, without having to prove each of the “facts of disclosure.”

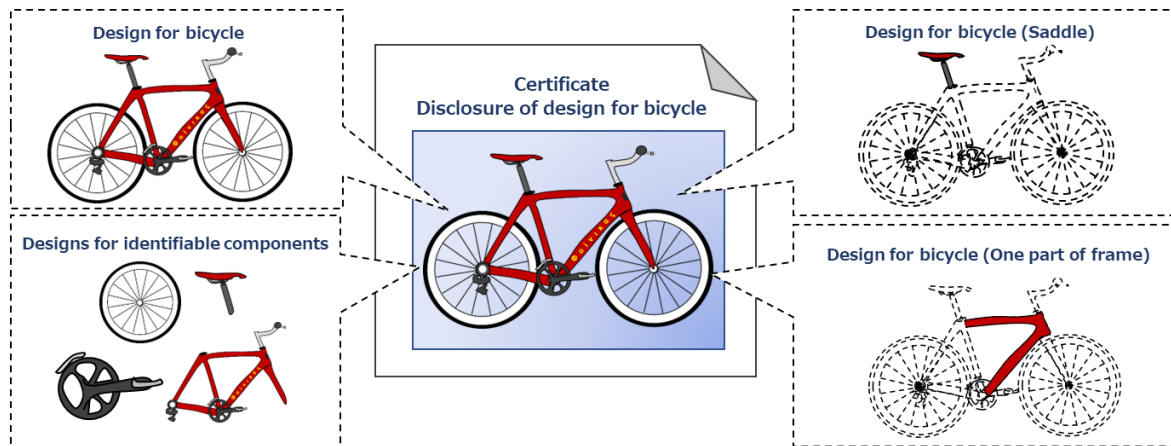
In addition, in cases where there are multiple acts disclosing the identical or similar design conducted on the earliest disclosure date, it is irrelevant whether the disclosure time on the date is earlier or later.

4.3.3 Finding the disclosed design stated in the “proving document”

With regard to a “disclosed design” for which the “facts of disclosure” are explicitly stated in the “proving document,” in principle, the examiner should admit the application of the provisions of Article 4, paragraph (2) of the Design Act.

If the article, etc. to the disclosed design stated in the “proving document” contains separately identifiable components or accessories, etc. and those components or accessories are the disclosed design, those components or accessories should also be treated as being proved (if some parts are hidden inside the article or building, only the parts that appear externally should be treated as a publicly known design), also each part of the article, etc. to the disclosed design stated in the “proving document,” i.e. the position, size, and scope indicated within the article, etc., should also be treated as being proved.

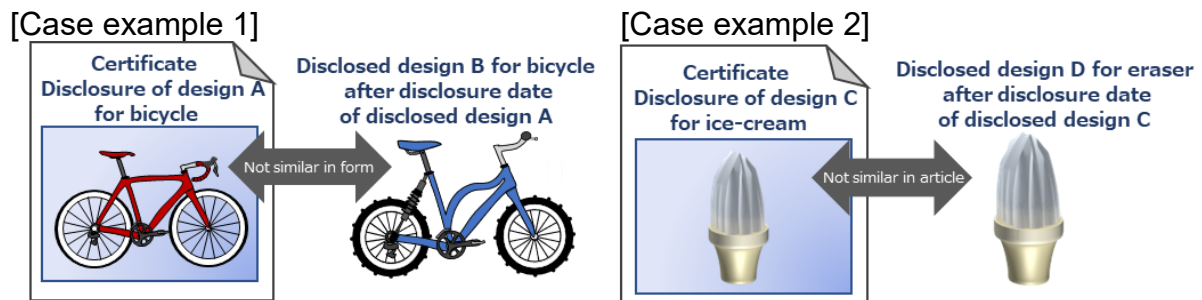
For example, if the disclosed design stated in the “proving document” is a bicycle assembled from components such as a frame, tires, and saddle, as in the case below, the design to which the provisions of Article 4, paragraph (2) of the Design Act apply includes not only the design for the bicycle, but also designs for components such as a frame, tires, and saddle which are identifiable as components of the bicycle, or designs for parts constituting the saddle part of the bicycle or a part of the bicycle frame, which are considered to be a design for which design registration is requested.



4.4 “Identical or similar design” to the disclosed design stated in the “proving document”

An identical or similar disclosed design that has been disclosed after the disclosure date of the disclosed design stated in the “proving document,” shall be deemed not to have fallen under a publicly known design, in determining the registration requirements of novelty (the items of Article 3, paragraph (1) of the Design Act) and creative difficulty (Article 3, paragraph (2) of the Design Act). On the other hand, for a disclosed design which is not similar to the disclosed design stated in the “proving document,” the application of the provisions of Article 4, paragraph (2) of the Design Act based on the said “proving document” shall not be admitted. For standards for determining the similarity between the disclosed design stated in the “proving document” and other disclosed designs, see Part III, Chapter II, Section 1 “Novelty,” 2.2 “Determination of similarity,” etc.

Examples where the application of the provisions of Article 4, paragraph (2) of the Design Act is not admitted, as the disclosed design is not similar to the disclosed design stated in the “proving document”

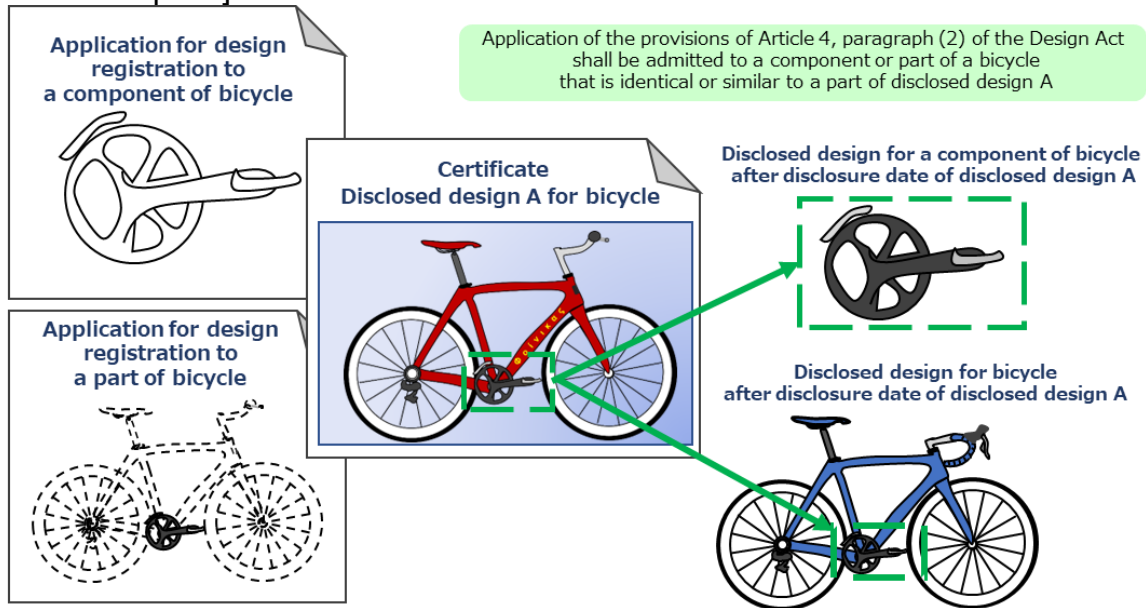


4.5 Determining application of the provisions of Article 4, paragraph (2) of the Design Act for a disclosed design after the disclosure date of the disclosed design stated in the “proving document”

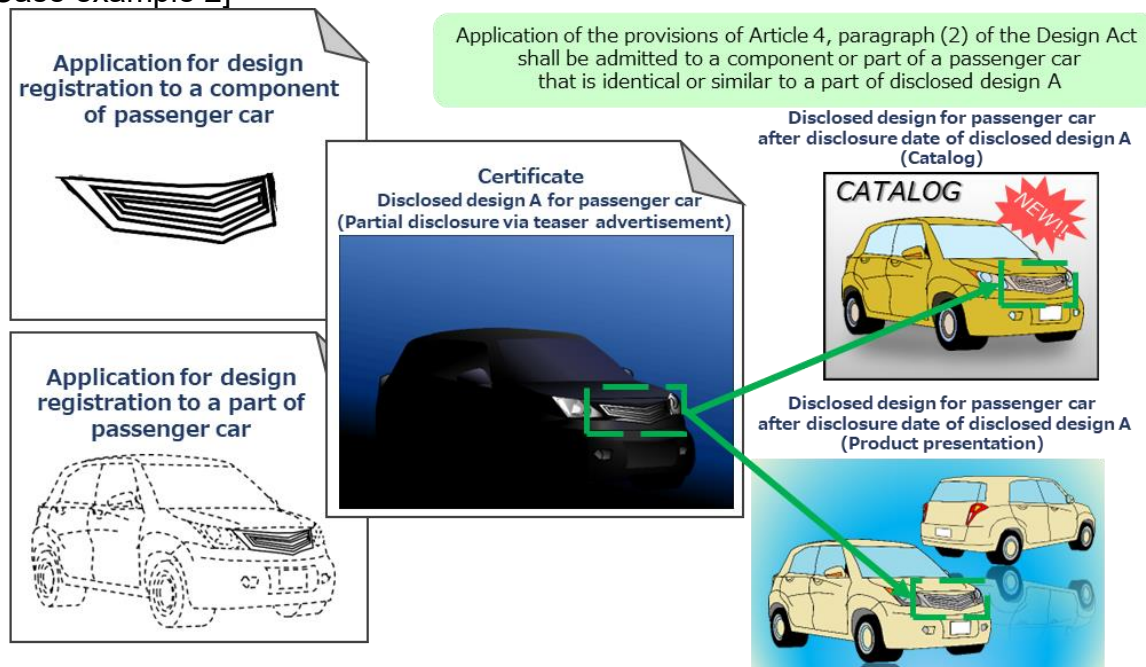
A determination on the application of the provisions of Article 4, paragraph (2) of the Design Act to a disclosed design after the disclosure date of the disclosed design stated in the “proving document” shall be made based on the parts of the disclosed design stated in the “proving document” that are subject to comparison with the design in the application for design registration.

For example, in cases where the design in the application for design registration is a design for which the design registration is requested for a component or part of an article, etc., even if the disclosed design stated in the “proving document” is to the entire article, etc., the similarity between the disclosed design stated in the “proving document” and the subsequent designs should be determined based on the component corresponding to the said design in the application for design registration or the part for which the design registration is requested.

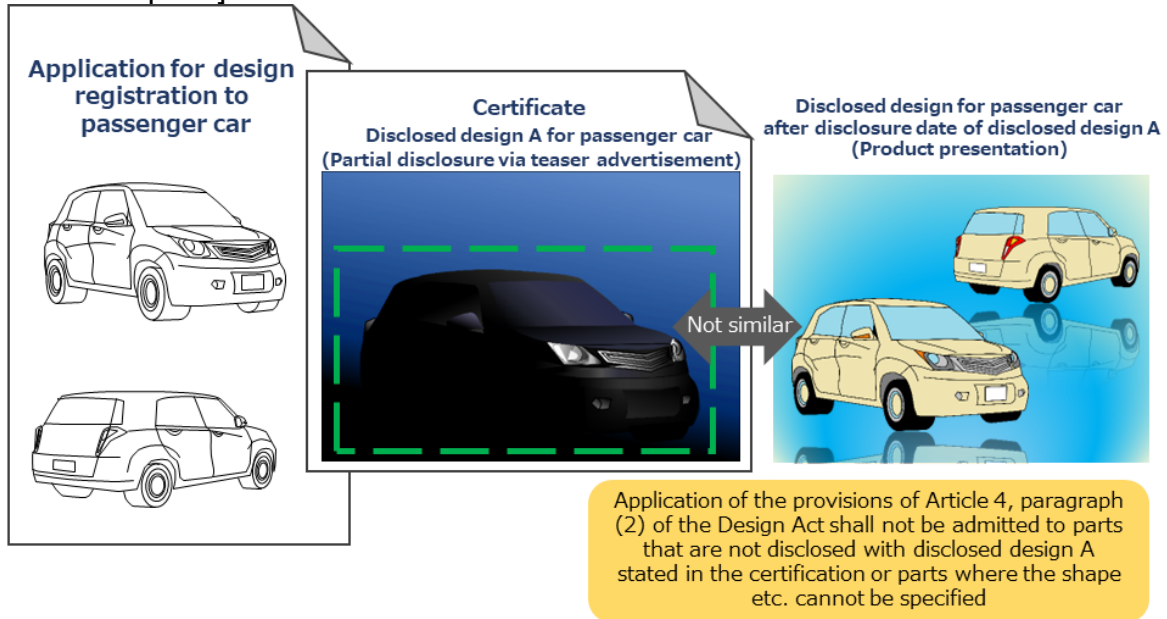
[Case example 1]



[Case example 2]



[Case example 3]



4.6 Determination procedures of cases where a notice of reasons for refusal is given without admission of the application of the provisions of Article 4, paragraph (2) of the Design Act

With regard to a disclosed design, after the examiner has given a notice of reason for refusal without admitting the application of the provisions of Article 4, paragraph (2) of the Design Act, the applicant may assert in a written opinion, a written statement, or other such documents that the application of the provisions of Article 4, paragraph (2) of the Design Act should be admitted. In this case, the examiner shall determine again whether it has been proved that the design complies with the requirements stated in 2., in consideration of the assertion of the applicant together with the matters stated in the "proving document."

5. Points to note in relation to determining application of the provisions of Article 4, paragraph (2) of the Design Act

5.1 Handling of cases where an identical or similar design to the disclosed design stated in the "proving document" has been disclosed by a third party, between the "date on which a design fell under the provisions" of Article 4, paragraph (2) of the Design Act and the date on which the application for design registration was filed.

In cases where a third party has disclosed a design that is identical or similar to the "design which has fallen under Article 4, paragraph (2) of the Design Act" between "the date on which the design fell under that paragraph" and the date on which the application for design registration was filed, in principle, the design shall be deemed to fall under a publicly known design as a result of disclosure by the third party.

However, if it is clear that the disclosure by the third party was based on the disclosure of "the design which has fallen under Article 4, paragraph (2) of the

Design Act” (note), the design shall be deemed not to have fallen under a publicly known design in spite of that disclosure.

(Note) “If it is clear that the disclosure by the third party was based on the disclosure of ‘the design which has fallen under Article 4, paragraph (2) of the Design Act’” means, for example, the following.

Example 1: A design disclosed as the result of a product being sold by the person having the right to obtain a design registration, and the design disclosed as the result of the product being published on a website by the third party who purchased it

Example 2: A design disclosed as the result of a person having the right to obtain a design registration exhibiting in a trade fair, and the design disclosed as a result of information on that exhibition being published in a newspaper

Example 3: A design disclosed as the result of a product being delivered to a distributor by a person having the right to obtain a design registration, and the design disclosed as the result of the product being sold by a retailer via the distributor

Example 4: A design disclosed as the result of a product being published on a website by a person having the right to obtain a design registration, and the design disclosed as the result of the product being posted on SNS by the third party who viewed it

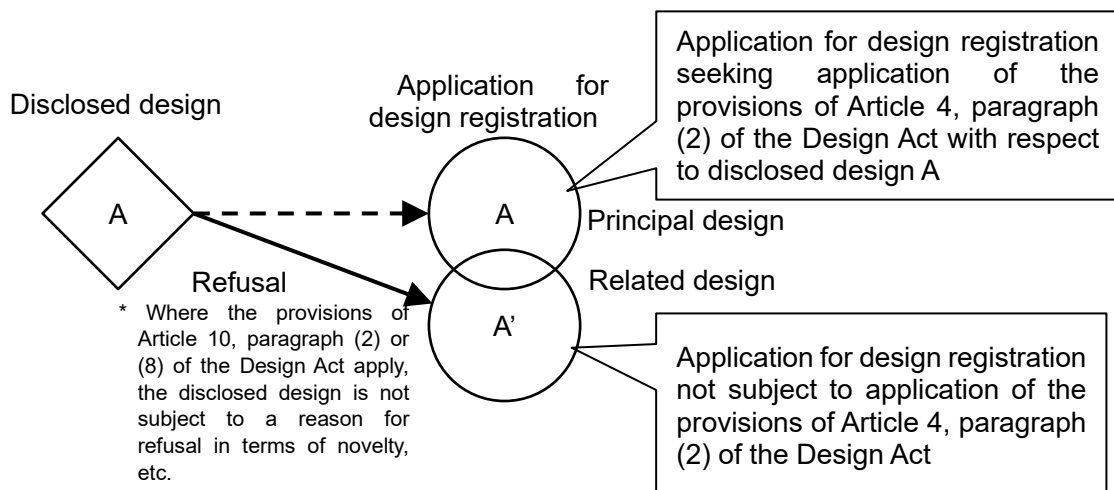
5.2 Handling of disclosed design A with respect to application A' for design registration in cases where, in order to seek application of the provisions of Article 4, paragraph (2) of the Design Act with respect to application A for design registration of a principal design, disclosed design A, which was disclosed prior to the filing of the application for 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 provisions of Article 4, paragraph (2) of the Design Act were not conducted

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

Thus, a design in application A' for design registration that is similar to disclosed design A, which has fallen under a publicly known design prior to the filing of the application thereof, falls under Article 3, paragraph (1), item (iii) of the Design Act and may not be registered as a design.

On the other hand, in cases where procedures for seeking application of the provisions of Article 4, paragraph (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 the prescribed requirements, the provisions of Article 4, paragraph (2) of the Design Act apply and disclosed design A shall be deemed not to have fallen under a publicly known design.

In addition, in cases where the provisions of Article 10, paragraph (2) or paragraph (8) of the Design Act apply to disclosed design A, it is excluded from information that serves as the basis for determination of novelty and creative difficulty with respect to application A' for design registration (see 3.7 “Application of the provisions concerning novelty and creative difficulty” in Part V “Related Design”).



6. Requirements for applying the provisions of Article 4, paragraph (1) of the Design Act

The examiner should admit application of the provisions of Article 4, paragraph (1) of the Design Act to a disclosed design only where it is determined that the design complies with all of the following requirements (1) to (3).

- (1) The design has fallen under (i) or (ii) below against the will of the person having the right to obtain a design registration (the creator of the design or their successor).
 - (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 design in (1) above has filed the application for design registration.
- (3) The application for design registration has been filed within one year from the date on which the design in (1) above was disclosed for the first time.

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

A “person having the right to obtain a design registration” as provided in Article 4, paragraph (1) of the Design Act means 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 a third party had succeeded to the creator’s right to obtain a design registration prior to disclosure, it shall be the person who had the right at the time of disclosure as a result of the succession. If the person having the right to obtain a design registration for the disclosed design at the time of disclosure is different from the creator, the fact of succession must be clearly indicated and proved.

6.2 Fact that the disclosure was against the will of the person having the right to obtain a design registration

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

The fact of the developments 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 need to be clearly indicated and proved.

6.3 Procedures for seeking application of the provisions of Article 4, paragraph (1) of the Design Act

The procedures for seeking application of the provisions of Article 4, paragraph (1) of the Design Act (time limitations, etc. with respect to submission of a document stating a request for the application of the provisions of Article 4, paragraph (1) of the

Design Act, making of a statement in the filed application requesting application of the said provisions, or submission of a document proving the fact that the disclosure was against the will of the person having the right to obtain a design registration) are not provided in Article 4, paragraph (3) of the Design Act.

Therefore, it is sufficient for an applicant for design registration to clearly indicate and prove in a written opinion, a written statement, or other such documents the fact that the design complies with the requirements set forth in 6. above, at the time when the fact becomes clear that the disclosure was against the will of the person having the right to obtain a design registration, for example, when the reason for refusal regarding the said application for design registration was notified pursuant to the provisions of the items in Article 3, paragraph (1) or Article 3, paragraph (2) of the Design Act.

In addition, 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 6. above exists, the applicant for design registration may submit a document proving such fact at the time of filing the application for design registration.

6.4 Determining application of the provisions of Article 4, paragraph (1) of the Design Act

The examiner should determine whether or not it has been reasonably explained that the disclosed design complies with the requirements set forth in 6 above, based on any written opinion, written statement or other such documents submitted by the applicant indicating that the disclosed design may be subject to application of the provisions of Article 4, paragraph (1) of the Design Act.