

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

1. Outline

Article 3-2 of the Design Act provides that, where no creation of a new design can be found in the design in a later application, such as when part of the design in a prior application is filed as the design in a later application almost as it is, the design in the later application may not be registered.

However, the reason for refusal under this provision does not apply where an application for design registration was filed by the same applicant as that for the prior application before the date of publication of the design bulletin pertaining to the prior design registration (excluding a design bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published) (proviso to Article 3-2 of the Design Act). In addition, this provision shall also not apply to cases where the application for design registration filed by the same person is an application for design registration of a related design (Article 10, paragraph (3) of the Design Act) (see 3.6 “Application of the provisions concerning exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application” in Part V “Related Design”).

This Chapter deals with exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application which pertains to the application for design registration that is under examination (hereinafter referred to as the “Application” in this Chapter).

2. Design bulletins that serve as the basis for application of the provisions of the main clause of Article 3-2 of the Design Act

The design bulletin that serves as the basis for application of the provisions of the main clause of Article 3-2 of the Design Act is either of the following design bulletins for a design filed prior to the filing date of the application for design registration subject to the application of Article 3-2 of the Design Act which was published after the filing of the application for design registration.

- (1) A design bulletin based on the provisions of Article 20, paragraph (3) of the Design Act
(Registered Design Bulletin)
- (2) A design bulletin based on the provisions of Article 66, paragraph (3) of the Design Act
(Bulletin for giving public notice of an application for which refusal has become final and binding in the case where no agreement was reached by consultations or consultations were unable to be held where two or more applications have been filed for identical or similar designs on the same date)

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

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

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

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

4. Drawings for specifying the design disclosed in a prior application

4.1 In the case of an application for design registration for a whole design

In the case of a three-dimensional article, the front view, rear view, left side view, right side view, top view and bottom view that represent the design for which the design registration is requested, or drawings that are replaceable therewith (hereinafter referred to as “a set of drawings”) are regarded as drawings for specifying the design disclosed in a prior application.

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

In addition, a development view, sectional view, end elevational view of the cut part, enlarged view, perspective view, graphic image view or other necessary drawings, but not a reference view, to be added where a set of drawings alone

cannot sufficiently represent the design in an application for design registration (hereinafter referred to as “other necessary drawings”) are also regarded as drawings for specifying the design disclosed in a prior application.

4.2 In the case of an application for design registration for a design for which the design registration is requested for part of an article, etc.

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

4.3 In the case of an application for design registration for a design for a set of articles or for an interior design

In the case of an application for design registration for a design for a set of articles or for an interior design, sets of drawings for the respective designs pertaining to the articles, etc. constituting the design for a set of articles or the interior design (hereinafter referred to as “constituent articles, etc.”), or a set of drawings in the state where the constituent articles, etc. are combined, and other necessary drawings are also regarded as drawings for specifying the design disclosed in a prior application.

5. Part of a design

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

Where the design for which the design registration is requested in the later application represents the shape, etc. of the entire article, etc. to the design of a design for which the design registration is requested for part of an article, etc. in the prior application, including the “part for which the design registration is requested” and “any other parts” of the design for which the design registration is requested for part of an article, etc., the design in the later application should not be treated as being part of the design in the prior application.

6. Determination of similarity between part of a design disclosed in a prior application and a whole design in a later application

In applying the provisions of Article 3-2 of the Design Act, in principle, it is necessary that the entire shape, etc. of the whole design in the later application,

which is subject to the provisions of Article 3-2 of the Design Act, is disclosed in the design disclosed in the prior application (including cases where the entire shape, etc. of the whole design in the later application, which is subject to the provisions of Article 3-2 of the Design Act, is not disclosed in the design disclosed in the prior application, but is sufficiently represented to a comparable level).

Regarding a design disclosed in a prior application and a whole design in a later application, regardless of (i) whether the design disclosed in the prior application is a whole design or a design for which design registration is requested for part of an article, etc., and (ii) whether the article, etc. to the design of the design disclosed in the prior application and that of the whole design in the later application are identical, similar or not similar, where the part of the design disclosed in the prior application that coincides with the whole design in the later application and the article, etc. to the design of the whole design in the later application have an identical or similar usage and function and their respective shapes, etc. are identical or similar, the examiner should determine that the whole design in the later application and the part of the design disclosed in the prior application that coincides with the whole design in the later application are similar.

7. Design in a later application that is identical or similar to part of a design in a prior application

The provisions of Article 3-2 of the Design Act also apply to cases where a design for which the design registration is requested for part of an article, etc. in a later application is not found to be a creation of a new design, such as where an application for design registration is filed while adopting a part of the design in a prior application almost as it is as the “part for which the design registration is requested” of a design for which the design registration is requested for part of an article, etc. in a later application.

7.1 Determination of similarity between part of a design disclosed in a prior application and a design for which the design registration is requested for part of an article, etc. in a later application

In applying the provisions of Article 3-2 of the Design Act, in principle, it is necessary that the entire shape, etc. of the “part for which the design registration is requested” of the design for which the design registration is requested for part of an article, etc. in the later application, which is subject to the provisions of Article 3-2 of the Design Act, is disclosed in the design disclosed in the prior application. However, even where the entire shape, etc. of the “part for which the design registration is requested” of the design for which the design registration is requested for part of an article, etc. in the later application, which is subject to the provisions of Article 3-2 of the Design Act, has not been disclosed in the design disclosed in the prior application, if it is sufficiently represented to a comparable level, the examiner may apply the said provisions.

In determining similarity between the design disclosed in a prior application and the design for which design registration is requested for part of an article, etc. in a later application, it does not matter (i) whether the design disclosed in the prior application is a whole design or a design for which design registration is requested for part of an article, etc., and (ii) whether the article, etc. to the design of the design

disclosed in the prior application and the article, etc. to the design of the design for which design registration is requested for part of an article, etc. in the later application are identical, similar or not similar. Furthermore, where the part of the design disclosed in a prior application that coincides with the “part for which the design registration is requested” of a design for which design registration is requested for part of an article, etc. in a later application and the “part for which the design registration is requested” of the design for which design registration is requested for part of an article, etc. in the later application have an identical or similar usage and function and their respective shapes, etc. are identical or similar, the examiner should determine that the part of the design disclosed in the prior application and the design for which design registration is requested for part of an article, etc. in the later application are similar.

7.2 Examples of applications for design registration for a design for which the design registration is requested for part of an article, etc. that fall under the provisions of Article 3-2 of the Design Act

With regard to case examples of applications for design registration for a design for which the design registration is requested for part of an article, etc. that fall under the provisions of Article 3-2 of the Design Act, see case examples 1 through 6 in 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” in 2.2 “Determination of similarity” in Part III, Chapter II, Section 1 “Novelty,” by replacing the term “publicly known design” with “design disclosed in a prior application.”

8. Determining application of the provisions of the proviso to Article 3-2 of the Design Act

According to the provisions of the proviso to Article 3-2 of the Design Act, an application that is ineligible for design registration under the main clause of Article 3-2 of the Design Act does not fall under a reason for refusal if it complies with all of the following requirements.

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

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

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

8.2 The application for design registration was filed before the publication date of the design bulletin in which the earlier application was published under Article 20, paragraph (3) (except for a design bulletin in which the matters listed in Article 20, paragraph (3), item (iv) was published under Article 20, paragraph (4))

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

In addition, the provisions of this Article shall not apply to cases where the applicant of the prior application for design registration and the applicant for design registration for a related design are the same person (Article 10, paragraph (3) of the Design Act) (see 3.6 “Application of the provisions concerning exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application” in Part V “Related Design”).

* Please note that, although design bulletins here do not include the International Designs Bulletin, an international publication (Note) in the case of international applications for design registration (Note), a design that is listed in the International Designs Bulletin which has been published internationally shall fall under a design as provided in Article 3, paragraph (1), item (ii) of the Design Act (designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country).

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

9. Time requirement concerning application of the provisions of Article 3-2 of the Design Act

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

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

9.1 Reference date for determination on application of the provisions of Article 3-2 of the Design Act with regard to division of an application for design registration, conversion of an application, or filing of a new application for an amended design

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

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

9.2 Reference date for determination on the provisions of Article 3-2 of the Design Act with regard to an application for design registration claiming priority under the Paris Convention, etc.

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

9.3 Time for giving notice of the reasons for refusal under Article 3-2 of the Design Act

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

In the case of a design bulletin pertaining to the design which was requested to be kept secret, the notice of the reasons for refusal will be given after the designated period for which secrecy was requested has elapsed and after the date of publication of the design bulletin in which all matters to be published with regard to the application for design registration are published. With respect to the intervening period, the examiner should issue a wait notice.

9.4 Reference date for determination on the provisions of Article 3-2 of the Design Act with regard to an international application for design registration

In applying the provisions of Article 3-2 of the Design Act to an international application for design registration, the date of the international registration on which an application for design registration was deemed to have been filed under Article 60-6, paragraph (1) of the Design Act (Note) will be the reference date for

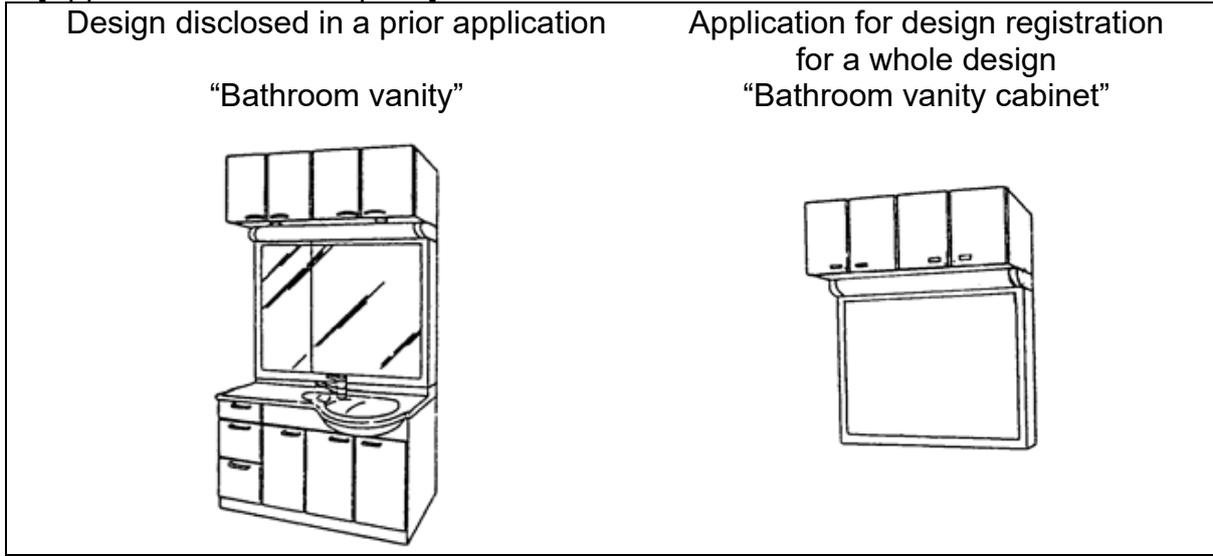
Part III Requirements for Design Registration
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Similar to Part of a Design in a Prior Application
determination (however, this excludes cases where a priority claim under the Paris
Convention, etc. has been legitimately made).

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

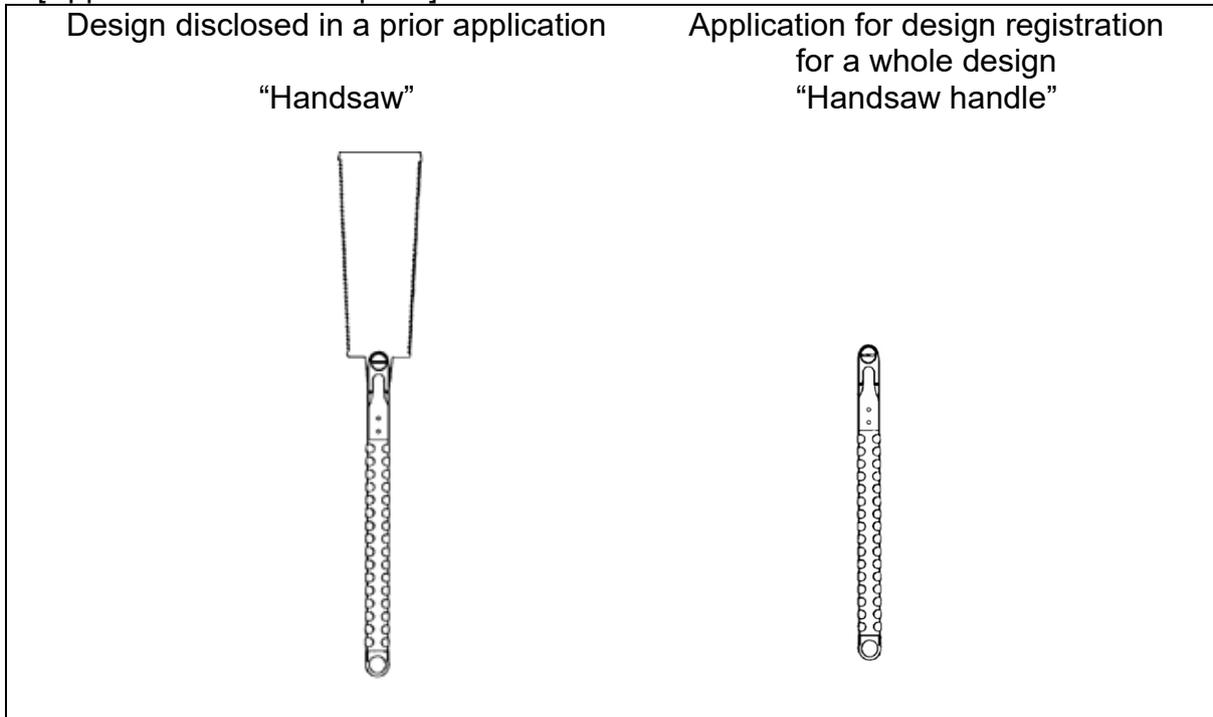
10. Examples of applications for design registration for a whole design that fall under the provisions of Article 3-2 of the Design Act

- (1) Where the prior application is an application for design registration for a whole design, and part of the design disclosed in the prior application and the whole design in the later application are identical or similar

[Applicable case example 1]

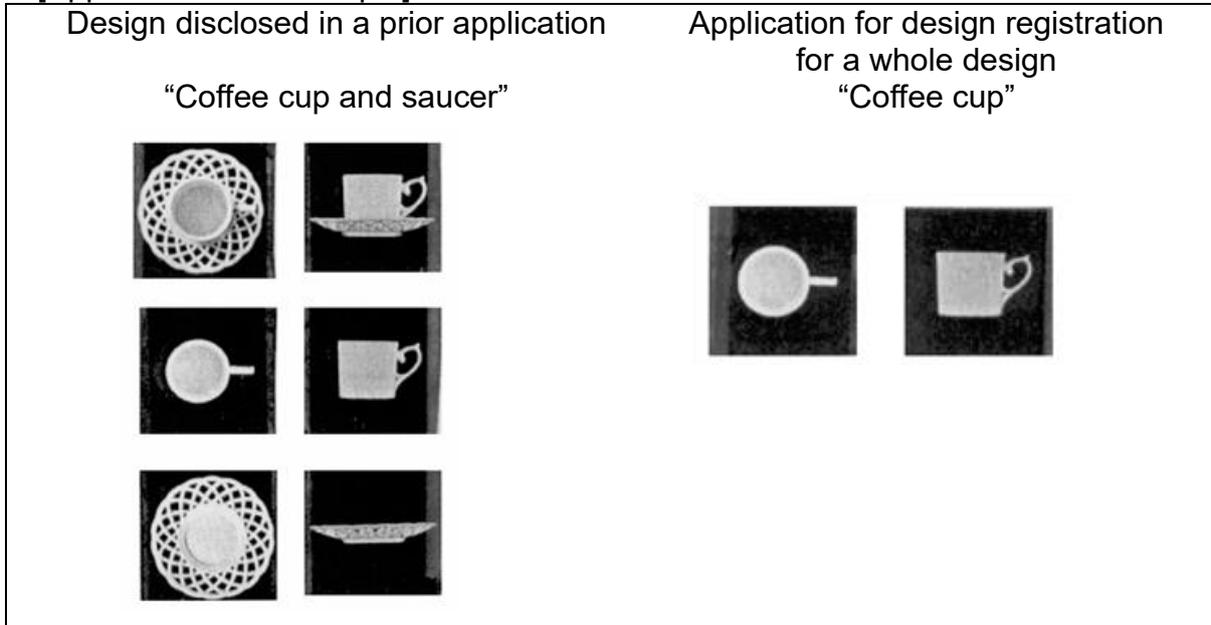


[Applicable case example 2]

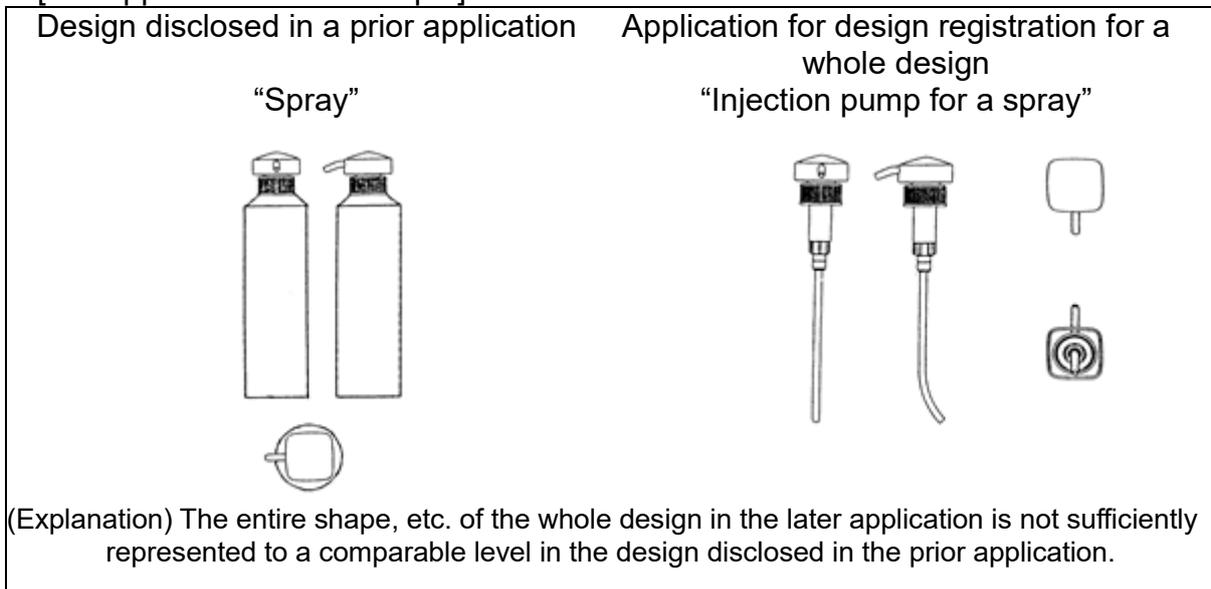


(2) Where the prior application is an application for design registration pertaining to a separable article, etc., and the separated design which is part of the design disclosed in the prior application and the whole design in the later application are identical or similar

[Applicable case example]

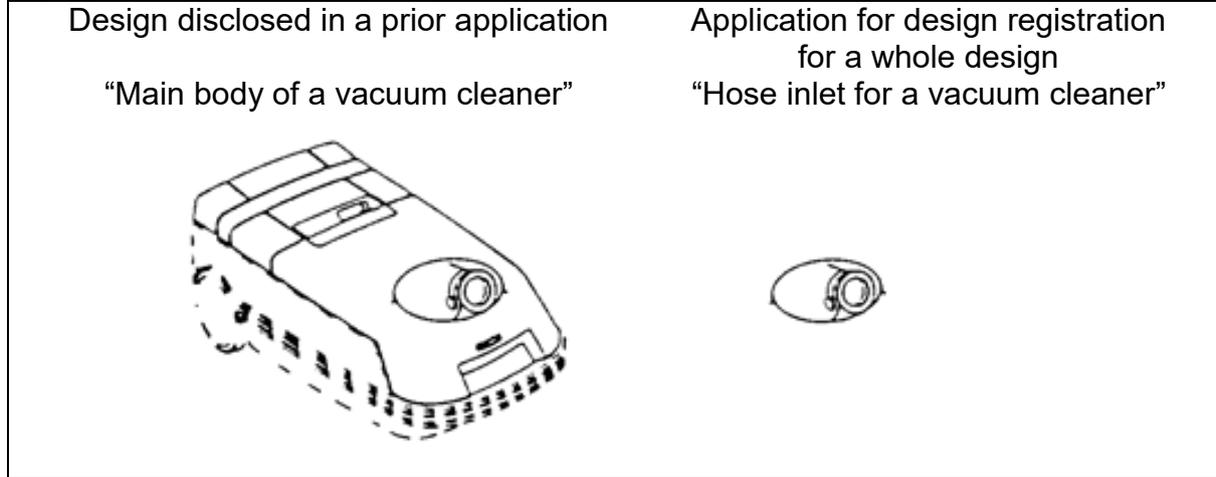


[Not applicable case example]

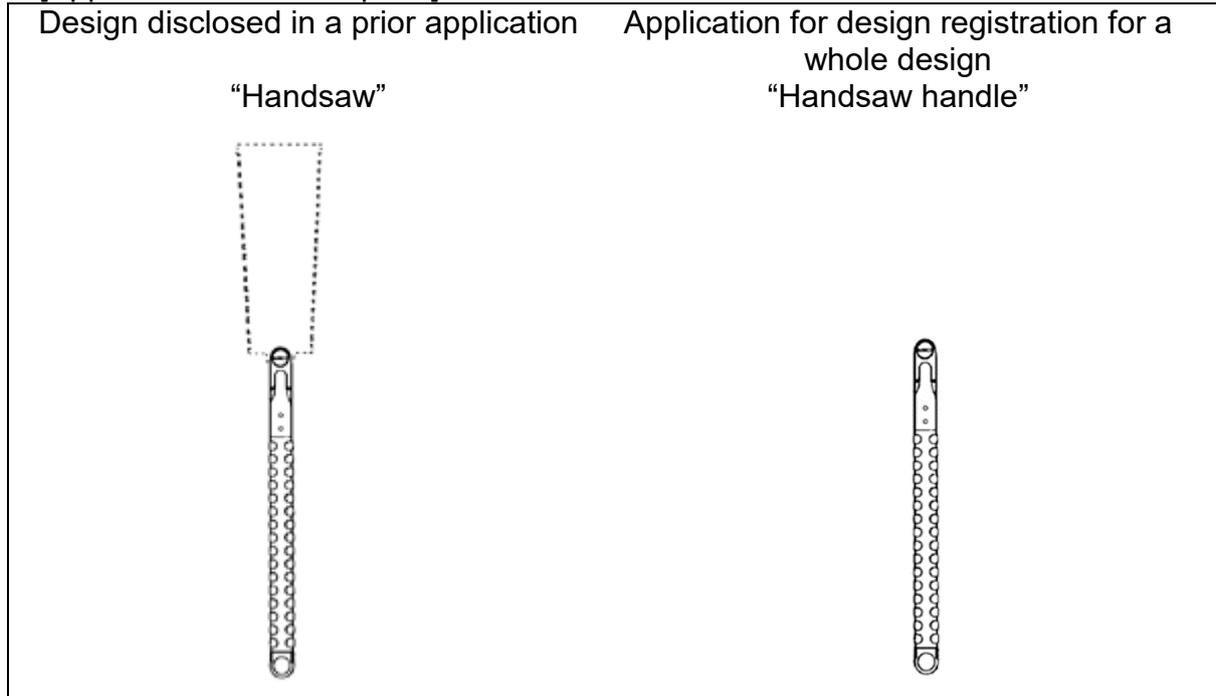


(3) Where the prior application is an application for design registration for a design for which the design registration is requested for part of an article, etc., and part of the design disclosed in the prior application and the whole design in the later application are identical or similar

[Applicable case example 1]



[Applicable case example 2]



- (4) Where the prior application is an application for design registration for a design for a set of articles, and the design pertaining to a constituent article, etc. which is part of the design disclosed in the prior application and the whole design in the later application are identical or similar

[Applicable case example]

