

Chapter V Prior Application

1. Outline

The design system grants an exclusive right for creation of a new design for a specified period. Therefore, two or more rights should not be granted for a single creation.

For the purpose of preventing such overlapping rights, Article 9 of the Design Act provides that, where two or more applications for design registration have been filed for identical or similar designs, only the applicant who filed the application for design registration on the earliest date may obtain a design registration.

Under this Article, where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration on the earliest date may obtain a design registration for that design (Article 9, paragraph (1)).

Where two or more applications for design registration have been filed for identical or similar designs on the same date, only one applicant determined through consultation among the applicants may obtain a design registration (first sentence of Article 9, paragraph (2)).

Where no agreement is reached or consultation is not possible, none of the applicants may obtain a design registration for that design (second sentence of Article 9, paragraph (2)).

Where two or more applications for design registration have been filed for identical or similar designs on the same date, the Commissioner of the Patent Office shall order the applicants to consult with each other and to report the results thereof within a designated period of time (Article 9, paragraph (4)).

Where no report on the results of consultation is received, the Commissioner of the Patent Office may deem that no agreement was reached by consultation (Article 9, paragraph (5)).

This Chapter describes the determination of the requirements for a prior application.

2. Determination of the requirements for prior application

2.1 Basic concept in determining the requirements for prior application

Where the application for design registration that is the subject of examination (hereinafter referred to as the "Application" in this Chapter) and another application comply with all of the following, the examiner should apply the provisions of prior application as prescribed in Article 9 of the Design Act.

- (1) The other application falls under both (i) and (ii) below
 - (i) The other application was filed earlier or on the same date as the Application (→ see 5. through 7.)

- (ii) The other application is an application for design registration that is treated as a prior application (→ see 2.3 and 2.4)
- (2) The design in the Application and the design in the other application are identical or similar to each other (→ see 3.)

2.2 Categories of applications for design registration that are treated as prior applications

An application for design registration that falls under either of the following should be treated as a prior application for design registration with regard to applying the provisions of Article 9, paragraph (1) of the Design Act.

- (1) An application for design registration for which establishment of a design right has been registered
- (2) An application for design registration for which the examiner's decision or trial decision to the effect that the application is to be refused has become final and binding on the basis that no agreement was reached by consultations under Article 9, paragraph (2) of the Design Act, or such consultations were unable to be held for identical or similar designs for which applications were filed on the same date

2.3 Categories of applications for design registration that are not treated as prior applications or applications filed on the same date

An application for design registration that falls under any of the following (1) to (4) is deemed never to have been filed with regard to applying the provisions of Article 9, paragraph (1) and paragraph (2) of the Design Act.

- (1) A waived application for design registration
 - (2) A withdrawn application for design registration (Note)
 - (3) A dismissed application for design registration
 - (4) An application for design registration for which the examiner's decision or trial decision to the effect that the application is to be refused has become final and binding
- However, this excludes applications for design registration described in 2.2 (2).

(Note) This includes an application for design registration which was deemed to have been withdrawn under the provisions of Article 60-14, paragraph (1) of the Design Act, that is, an international application for design registration whose basic international registration extinguished because the international registration was waived under the provisions of Article 16(1)(iv) of the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs or limited under the provisions of Article (1)(v) of the same Article or the international registration was not renewed under the provisions of Article 17(2) of the same Agreement (limited to cases where establishment for a design right for the said international application for design registration has not been registered).

2.4 Applications for design registration that are subject to the provisions of Article 9, paragraph (1) or (2) of the Design Act

Determination for applying the provisions of Article 9, paragraph (1) or (2) of the Design Act is made not only with regard to two applications for design registration for whole designs or two applications for design registration for "designs for which the design registration is requested for part of an article, etc.," but also between a whole

design and a “design for which the design registration is requested for part of an article, etc.”

3. Determination of similarity

3.1 Determination of similarity between two whole designs

With regard to determination of similarity between two whole designs under Article 9, paragraph (1) or (2) of the Design Act, since the determination of similarity is made in the same way as that between a publicly known design and a whole design, see 2.2 “Determination of similarity” in Part III, Chapter II, Section 1 “Novelty.”

In addition, when applying the provisions of Article 9, paragraph (1) or (2) of the Design Act to an application for design registration for a whole design, determination is made as to whether the designs represented as the designs for which the design registration is requested (Note) in the respective statements in the applications and drawings, etc. attached to the applications are identical or similar.

(Note) In determining the requirements for novelty, in addition to a design for an article, etc. that has become publicly known as a result of being described in a publication, etc., since it is also considered to have become publicly known, 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; on the other hand, in determining the requirements for a prior application, since the provisions of prior application are not applied to such designs included in other designs, they should not be treated as information that serves as the basis for determination.

Furthermore, in determining the requirements for novelty, a design for which the specific shape, etc. of the article, etc. to the design can be identified in “any other parts,” 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.; on the other hand, in determining the requirements for a prior application, since the provisions of prior application are not applied to such “any other parts,” they should not be treated as information that serves as the basis for determination (see the (Note) in 2.1 “Basic concept in determining novelty” in Part III, Chapter II, Section 1 “Novelty”).

3.2 Determination of similarity between two “designs for which the design registration is requested for part of an article, etc.”

In determining similarity between two “designs for which the design registration is requested for part of an article, etc.” under Article 9, paragraph (1) or (2) of the Design Act, the examiner should determine that the two “designs for which the design registration is requested for part of an article, etc.” are similar if both designs comply with all of the following.

- (i) The usage and function of the article, etc. to the design of the design in the Application and the design in the other application are identical or similar
- (ii) The usage and function of the “part for which the design registration is requested” of the design in the Application and the design in the other application are identical or similar
- (iii) The position, size and scope of the “part for which the design registration is requested” within the shape, etc. of the entire article, etc. of the design in the

Application and the design in the other application 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 design in the Application and the design in the other application 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.

3.2.1 Viewpoints for determining similarity between two “designs for which the design registration is requested for part of an article, etc.”

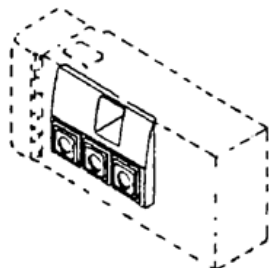
The examiner should determine similarity according to the viewpoints set forth in (a) through (g) below. For matters other than those listed below, the examiner should make a determination in accordance with 2.2.2 “Approaches for determining similarity” in Part III, Chapter II, Section 1 “Novelty.”

- (a) Finding of the usage and function of the articles, etc. to the design of the two designs being compared, and determination of similarity
- (b) Finding of common points and different points in the usage and function of the “part for which the design registration is requested”
- (c) Finding of common points and different points in the position, size, and scope of the “part for which the design registration is requested”
- (d) Finding of the shape, etc. of the “part for which the design registration is requested”
- (e) Finding of common points and different points in the shape, etc. of the “part for which the design registration is requested”
- (f) Individual evaluation of common points and different points in the shape, etc. of the “part for which the design registration is requested”
- (g) Comprehensive determination of similarity between “designs for which the design registration is requested for part of an article, etc.”

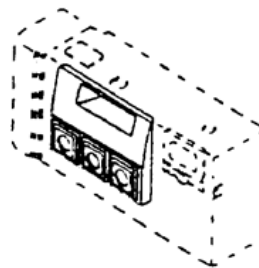
3.2.2 Examples of applications for design registration for “designs for which the design registration is requested for part of an article, etc.” that are found to be similar under Article 9, paragraph (1) of the Design Act

[Case example 1]

Design in a prior application
“Still camera”

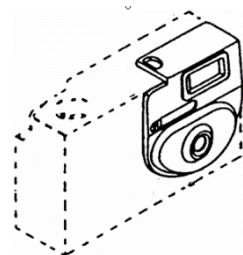


Filed design
“Still camera”

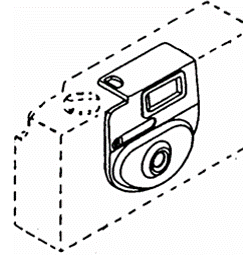


[Case example 2]

Design in a prior application
“Digital camera”



Filed design
“Digital camera”



Where the application for design registration for a partial design shown on the right-hand side in the case example above is filed during the period starting from the filing date of the application for design registration for a partial design in the prior application shown on the left-hand side and ending on the publication date (including the said date) of the design bulletin for the said prior 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), the application also falls under the provisions of Article 3-2 of the Design Act, so the provisions of Article 3-2 of the Design Act are applied in examination practice.

3.3 Determination of similarity between a whole design and “a design for which the design registration is requested for part of an article, etc.”

In determining similarity between a whole design and “a design for which the design registration is requested for part of an article, etc.” under Article 9, paragraph (1) or (2) of the Design Act, the examiner should determine that the two designs are similar if both designs comply with all of the following.

- (i) The usage and function of the articles, etc. to the design of the two designs are identical or similar
 - (ii) The usage and function of the whole design and the usage and function of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.” are identical or similar
 - (iii) Relative to the entire article, etc. of the whole design, the position, size and scope of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.” within the shape, etc. of the entire article, etc. are within the scope of ordinary in the art of the design
 - (iv) The shape, etc. of the whole design and the shape, etc. of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.” 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 substantially identical.

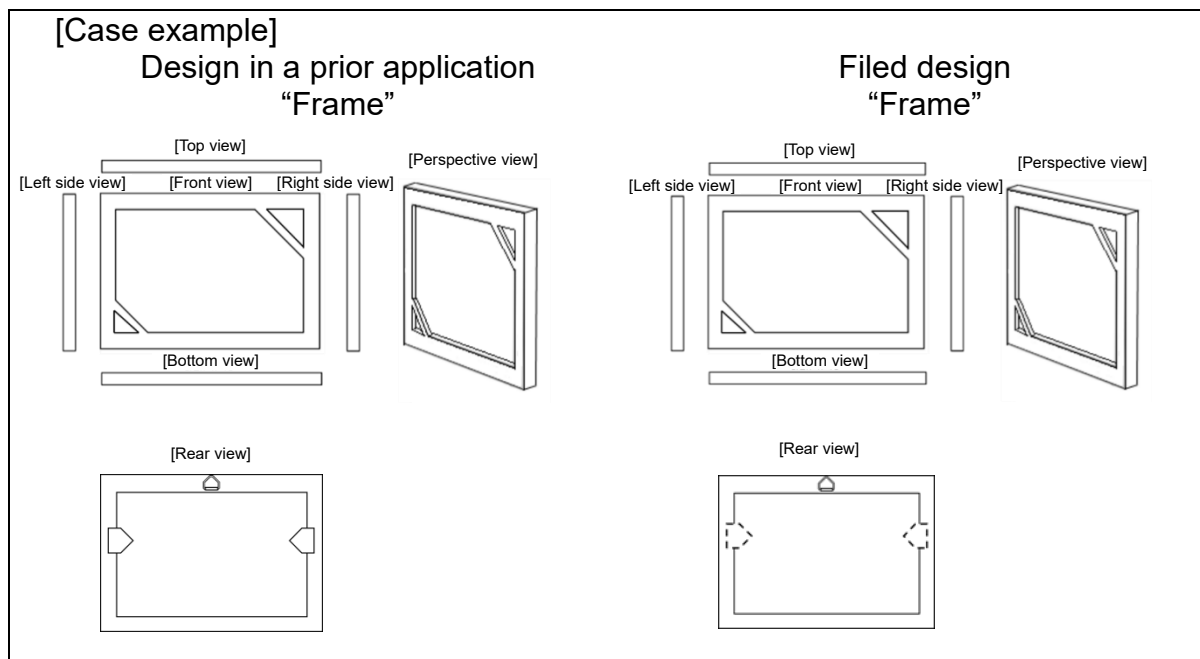
3.3.1 Viewpoints for determining similarity between a “design for which the design registration is requested for part of an article, etc.” and a whole design

The examiner should determine similarity according to the viewpoints set forth in (a) through (g) below. For matters other than those listed below, the examiner should make a determination in accordance with 2.2.2 “Approaches for determining similarity” in Part III, Chapter II, Section 1 “Novelty.”

- (a) Finding of the usage and function of the articles, etc. to the design of the two designs being compared, and determination of similarity
- (b) Finding of common points and different points in the usage and function of the whole design and the usage and function of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.”
- (c) Finding of common points and different points between the position, size, and scope of the whole design and those of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.” within the shape, etc. of the entire article, etc.
- (d) Finding of the shape, etc. of the whole design and that of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.”
- (e) Finding of common points and different points between the shape, etc. of the whole design and that of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.”
- (f) Individual evaluation of common points and different points between the shape, etc. of the whole design and that of the “part for which the design registration is requested” in the “design for which the design registration is requested for part of an article, etc.”

- (g) Comprehensive determination of similarity between the whole design and the “design for which the design registration is requested for part of an article, etc.”

3.3.2 Examples of applications for design registration for whole designs and “designs for which the design registration is requested for part of an article, etc.” that are found to be similar under Article 9, paragraph (1) of the Design Act



Where the application for design registration for a partial design shown on the right-hand side in the case example above is filed during the period starting from the filing date of the application for design registration for a whole design in the prior application shown on the left-hand side and ending on the publication date (including the said date) of the design bulletin for the said prior 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), the application also falls under the provisions of Article 3-2 of the Design Act, so the provisions of Article 3-2 of the Design Act are applied in examination practice.

4. Handling of applicants and filing dates

4.1 Applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, under Article 9, paragraph (1) of the Design Act, regardless of whether the applications for design registration are filed by the same person or by different persons, in either case, only the applicant who filed the application for design registration on the earliest date may obtain a design registration for that design.

4.2 Applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, under Article 9, paragraph (1) of the Design Act, only the applicant who filed the application for design registration on the earliest date may obtain a design registration for that design.

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, the examiner should register the design in the earliest application for design registration for which there are no reasons for refusal, and should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act. Furthermore, where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9, paragraph (2) of the Design Act, the examiner should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, the design may be registered as a related design if the applications for design registration are not subject to any other reasons for refusal and they comply with the requirements for obtaining design registration as a related design as provided for in Article 10 of the Design Act (see Part V "Related Design").

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, the examiner should register the design in the earliest application for design registration for which there are no reasons for refusal. Regarding designs in any subsequent applications for design registration, the design may be registered as a related design if the application for design registration is an application for design registration of a related design, it is not subject to any other reasons for refusal, and it complies with the requirements for obtaining design registration as a related design as provided for in Article 10 of the Design Act (see Part V "Related Design").

Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9, paragraph (2) of the Design Act, the examiner should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

4.3 Applications for design registration filed for identical designs on the same date

Where two or more applications for design registration have been filed for identical designs on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9, paragraph (2) of the Design Act, and become subject to an order for consultation under Article 9, paragraph (4) of the Design Act, regardless of whether they are applications for design registration filed

by the same person or by different persons. As a result, only one applicant for design registration, who was selected by consultations, may obtain a design registration for that design.

4.4 Applications for design registration filed for similar designs on the same date

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9, paragraph (2) of the Design Act, and become subject to an order for consultation under Article 9, paragraph (4) of the Design Act. As a result, only one applicant for design registration, who was selected by consultations, may obtain a design registration for that design.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9, paragraph (2) of the Design Act, and become subject to an order for consultation under Article 9, paragraph (4) of the Design Act. In principle, persons other than the one applicant for design registration who was selected by consultations may not obtain a design registration, but where the applications for design registration are filed by the same person, the design may be registered as a related design if the applications for design registration are not subject to any other reasons for refusal and they comply with the requirements for obtaining design registration as a related design as provided for in Article 10 of the Design Act (see Part V “Related Design”).

4.5 Handling of applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, regardless of whether they are applications for design registration filed by the same person or by different persons, the examiner should register one design in the earliest application, and should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act. Furthermore, where the earlier application is an application for design registration for which the examiner’s decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9, paragraph (2) of the Design Act, the examiner should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

4.6 Handling of applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, the examiner should register the design in the earliest application for design registration for which there are no reasons for refusal, and should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

Furthermore, where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9, paragraph (2) of the Design Act, the examiner should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, the examiner should register the design in the earliest application for design registration for which there are no reasons for refusal. Regarding designs in any subsequent applications for design registration, the design may be registered as a related design if the application for design registration is an application for design registration of a related design, it is not subject to any other reasons for refusal, and it complies with the requirements for obtaining design registration as a related design as provided for in Article 10 of the Design Act (see Part V "Related Design").

Where the subsequent application for design registration is not an application for design registration of a related design, the examiner should provide notice, citing the earliest application as the reason for refusal under Article 9, paragraph (1) of the Design Act. Where the subsequent application for design registration is not subject to any other reasons for refusal, and through amendment, it complies with the requirements for obtaining design registration as a related design, the design may be registered as a related design.

Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9, paragraph (2) of the Design Act, the examiner should refuse any designs in subsequent applications for design registration for this reason under Article 9, paragraph (1) of the Design Act.

4.7 Handling of applications for design registration filed for identical or similar designs on the same date

(1) Where the applications for design registration are filed by different persons

- (i) An order for consultation is to be given in the name of the Commissioner of the Patent Office to the respective applicants for design registration under Article 9, paragraph (4) of the Design Act.
- (ii) Where a report on the results of consultations is submitted within the designated time limit, an examiner's decision to the effect that a design registration is to be granted is rendered only for the application for design registration filed by one applicant for design registration who was selected by consultations. However, even where such a report is submitted, if the procedures for withdrawal or waiver are not taken for the applications for design registration other than the application for design registration filed by the one applicant for design registration selected in the consultations, or if the contents of reports of the results of consultations held in response to multiple orders for consultations are inconsistent (see 4.7.1 "Examples of cases where the contents of reports on multiple orders for consultations are found to be inconsistent" in this Chapter), it is found that no

agreement was reached by consultations, and the respective applicants for design registration are notified of the reasons for refusal under the second sentence of Article 9, paragraph (2) of the Design Act.

- (iii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act, the respective applicants for design registration are notified of the reasons for refusal under the second sentence of Article 9, paragraph (2) of the Design Act.
- (2) Where the applications for design registration are filed by the same person
 - (i) An order for consultation is to be given in the name of the Commissioner of the Patent Office to the applicant for design registration under Article 9, paragraph (4) of the Design Act. However, at the same time as giving the order in the name of the Commissioner of the Patent Office, a notice of the reasons for refusal based on the second sentence of Article 9, paragraph (2) of the Design Act is given. It is handled this way in cases where the applicant is the same person since time for consultations is deemed unnecessary.
 - (ii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act. Where a report on the results of consultations is submitted within the designated time limit, but the applications for design registration other than the application for design registration filed by one applicant for design registration, who was selected by consultations, are not withdrawn or waived, or the contents of reports on multiple orders for consultations are inconsistent (see 4.7.1 “Examples of cases where the contents of reports on multiple orders for consultations are found to be inconsistent” in this Chapter), it is found that no agreement was reached by consultations, and the examiner should render a decision to the effect that each application for design registration should be refused based on the previously notified reason for refusal under the second sentence of Article 9, paragraph (2) of the Design Act.

4.7.1 Examples of cases where the contents of reports on multiple orders for consultations are found to be inconsistent

- (1) Examples of a report selecting one of the applicants of the applications for design registration subject to consultations, for which no agreement is found to have been reached
 - (i) A report whereby both applicants select themselves
 - (ii) A report whereby both applicants select each other
- (2) Examples of a report specifying the design in one of the applications for design registration subject to consultations as a principal design and the designs in the other applications for design registration as its related designs, for which no agreement is found to have been reached
 - (i) A report selecting a design that does not exist as a principal design
 - (ii) A report selecting a dissimilar design or a design in an application for design registration filed by a different applicant for design registration as a principal design
 - (iii) A report selecting multiple designs as a principal design

4.7.2 Handling of cases where no report is submitted in response to an order for consultations, and procedures for withdrawal or waiver, or for amendment, are taken only for one or some of the applications for design registration

With regard to applications for design registration that are filed for identical or similar designs by the same person on the same date, an order for consultations is issued for each such application for design registration, and in principle, a report on the results of consultations is required to be submitted for each application for design registration.

Even if procedures for withdrawal or waiver or for amendment are taken only for one or some of the applications for design registration subject to consultations, the examiner may not as a result immediately deem that agreement has been reached by consultations. Accordingly, until the expiration of the designated time limit, the examiner must assume that the results of consultations have not yet been reported, and must wait for all of the applications for design registration subject to consultations to be processed in accordance with the purport of the order for consultations.

Where no report on the results of consultations is submitted by the designated time limit, it may be deemed that no agreement was reached by consultations under Article 9, paragraph (5) of the Design Act; however, if, within the designated time limit, an amendment has been made to make the design in an application for design registration subject to consultations a principal design or its related design, or if either of the applications for design registration subject to consultations has already been withdrawn or waived, such procedures for amendment or for withdrawal or waiver will result in the reason for consultations being overcome. In this case, the examiner should not deem that no agreement was reached by consultations.

5. Reference date for determination on the provisions of Article 9, paragraph (1) or (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 for applying the provisions of Article 9, paragraph (1) or (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.

6. Reference date for determination on the provisions of Article 9, paragraph (1) or (2) of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.

When applying the provisions of Article 9, paragraph (1) or (2) of the Design Act, if the effects of that claim are recognized, the filing date of the application filed in the first country will be the reference date for determination.

7. Reference date for determination on the provisions of Article 9, paragraph (1) or (2) of the Design Act with regard to an international application for design registration

In applying the provisions of Article 9, paragraph (1) or (2) of the Design Act, 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 will be the reference date for determination (however, this excludes cases where the effect of a priority claim under the Paris Convention, etc. is recognized).