

Chapter VI Unregistrable Design

1. Outline

Article 5 of the Design Act provides that, even if a design complies with the requirements for registration, etc., such as industrial applicability, novelty, and creative difficulty, it may not be registered for reasons of public interest if it is liable to injure public order or morality (hereinafter referred to as “public order or morality, etc.” in this Chapter) or if it is likely to impede the development of industry.

This Chapter describes how an examiner should determine whether a filed design falls under the grounds of unregistrability outlined above (hereinafter referred to as “grounds of unregistrability” in this Chapter).

2. Basic concept in determining whether a design falls under grounds of unregistrability

Even if the filed design complies with the requirements for registration, etc., such as industrial applicability, novelty, and creative difficulty, if, at the time of the grant of an examiner’s decision on design registration, the filed design falls under any of the following, the examiner should determine that the design falls under the grounds of unregistrability.

- (1) A design which is liable to injure public order or morality (Article 5, item (i))
- (2) A design which is liable to create confusion with an article, building, or graphic image pertaining to another person’s business (Article 5, item (ii))
- (3) A design solely consisting of a shape that is indispensable for securing functions of the article or a shape that is indispensable for the usage of the building, or a design solely consisting of a display that is indispensable for the usage of the graphic image (Article 5, item (iii))

Furthermore, in cases of an application requesting design registration for part of an article, etc., regarding application of the provisions of (1) above (Article 5, item (i)) and (2) above (Article 5, item (ii)), the examiner should make the shape, etc. of the entire article to the design, including the “part for which the design registration is requested” and “any other parts,” the subject of determination. On the other hand, regarding application of the provisions of (3) above (Article 5, item (iii)), the examiner should make only the shape of the “part for which the design registration is requested” the subject of determination.

3. Specific determination of whether a design falls under grounds of unregistrability

3.1 Design which is liable to injure public order

A design that represents the image of the head of state or the national flag of Japan or a foreign country or a design representing the imperial chrysanthemum crest of Japan or a royal crest of a foreign country (including a design similar thereto) is likely to injure the dignity of the country or the imperial or royal family. Given this, the examiner should determine that such a design is one which is liable to injure public order as provided in Article 5, item (i) of the Design Act.

Furthermore, the examiner should treat in the same manner a design that represents the portrait or personal information, etc. of a specific person who is completely unrelated to the applicant.

However, where the design is not likely to injure the dignity of a specific country or the imperial or royal family—like a design where the flags of all nations are represented as part of the scene of a sporting event—the examiner should not determine that such a design is liable to injure public order.

3.2 Design which is liable to injure morality

The examiner should determine that a design that unjustly offends the moral sense of or arouses a sense of shame or disgust in a mentally and physically sound person—such as a design representing obscene material—is one which is liable to injure morality as provided in Article 5, item (i) of the Design Act.

3.3 Design which is liable to create confusion with an article, building, or graphic image pertaining to another person's business

A design representing another person's well-known or famous trademark or a mark that can be mixed up therewith is likely to lead to confusion that the article, etc. to the design is produced or sold in relation to the business of that person or organization. Given this, the examiner should determine that such a design is one which is liable to create confusion with an article, etc. pertaining to another person's business as provided in Article 5, item (ii) of the Design Act.

3.4 Design solely consisting of a shape that is indispensable for securing functions of the article or a shape that is indispensable for the usage of the building, or a design solely consisting of a display that is indispensable for the usage of the graphic image

A design solely consisting of a shape that is indispensable for securing functions of the article or a shape that is indispensable for the usage of the building, or a design solely consisting of a display that is indispensable for the usage of the graphic image, constitutes creation of a technical idea, which, by nature, should be protected by the Patent Act or the Utility Model Act, but for which granting an exclusive right as a design right is not appropriate.

If the filed design falls under any of the following categories, for example, the examiner should determine that it is a design solely consisting of a shape that is indispensable for securing functions of the article or a shape that is indispensable for the usage of the building, or a design solely consisting of a display that is

indispensable for the usage of the graphic image as provided in Article 5, item (iii) of the Design Act.

(1) Design solely consisting of a shape that is inevitably decided for securing the functions of the article or by the usage of the building

If the filed design is one solely consisting of a shape that is inevitably decided for securing the functions of the article or by the usage of the building (inevitable shape), the examiner should determine that it falls under a design solely consisting of a shape that is indispensable for securing functions of the article or a shape that is indispensable for the usage of the building as provided in Article 5, item (iii) of the Design Act.

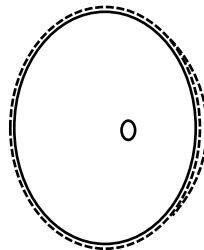
When determining whether or not the filed design falls under a design solely consisting of an inevitable shape, the examiner should focus only on the shape that embodies the technical function of the article or the usage of the building, regardless of the pattern and color, which are the constituent elements of the design. In doing so, the examiner should take the following points in particular into consideration.

(a) Whether or not there exists any other alternative shape that can secure the function of the article or the usage of the building

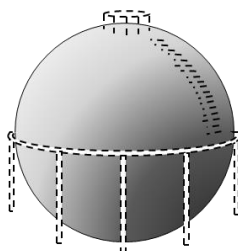
(b) Whether or not the design includes a shape, other than the inevitable shape, etc., which should be taken into consideration in evaluating the design

<Examples where the design for which the design registration is requested falls under a design solely consisting of an inevitable shape>

[Case example 1] A design for which the design registration is requested only for the inner surface part of a “parabolic antenna,” which consists solely of a shape that is inevitably decided for securing the functions of the article



[Case example 2] A design for which the design registration is requested only for the main body of a “gas tank,” which consists solely of a shape that is inevitably decided by the usage of the building



- (2) Design consisting of a shape that is decided by a specification standardized for securing the compatibility of the article, etc. or according to the usage of the building, etc. (quasi-inevitable shape)

Regarding a design where the elements of the article, etc., such as its shape, size, etc. are specified or standardized for securing the compatibility of the article, etc. (including securing the technical function) or according to the usage of the building, etc., and which consists of a shape that must be accurately reproduced based on a specified or standardized shape, size, etc., the examiner should treat such a design in the same manner as a design solely consisting of an inevitable shape as set forth in (1) above.

Regarding specifications that fall under the following (a) or (b), for example, the examiner should determine that they are categorized as specifications standardized for securing the compatibility of the article, etc.

(a) Public standards

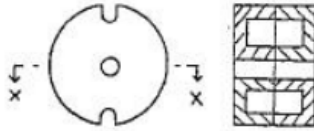
Standard specifications formulated by public standards organizations, such as JIS (Japanese Industrial Standards) formulated by the Japanese Standards Association, and ISO standards formulated by the International Organization for Standardization (ISO)

(b) De facto standards

Specifications that are not public specifications, but are recognized as industry standards in the field of the article, etc., where products based on said standard specifications practically dominate the market of the article, etc. and where it is possible to specify the details of the standard shape, size, etc. based on the name, number, etc. of the specification

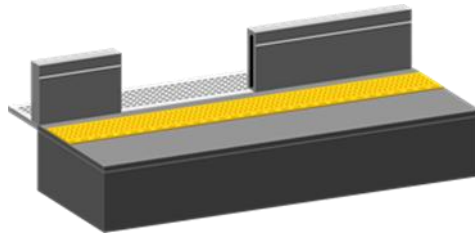
<Examples where the design for which the design registration is requested falls under a design consisting of a quasi-inevitable shape>

[Case example 1] Design of a “magnetic core,” the entire shape of which has been specified by a public standards organization



(Example: A magnetic core specified by JIS C2516 4.4)

[Case example 2] Design of a “platform” where only the tactile paving part, which is specified by a public standards organization, is the part for which the design registration is requested



However, the provisions of Article 5, item (iii) of the Design Act will only be applied to an article, etc. whose main purpose of use is to perform the function based on the shape, etc. Therefore, even though office paper (Sizes of paper JIS P 0202) and paper for daily use (Envelopes JIS S 5502), for example, have a shape that is decided by a public standard specification or a de facto standard specification, they are not subject to application of the provisions of Article 5, item (iii) of the Design Act.

(3) Design solely consisting of a display that is indispensable for the usage of the graphic image

Regarding a design solely consisting of a display that is inevitably decided according to the usage of the graphic image, etc., or a design solely consisting of a display that must be accurately produced based on a specified or standardized display, the examiner should determine that such a design falls under a design solely consisting of a display that is indispensable for the usage of the graphic image as provided in Article 5, item (iii) of the Design Act.

<Examples where the design falls under a design solely consisting of a display that is indispensable for the usage of the graphic image>

[Case example 1] Design of a “graphic image used for road signs,” where design registration is requested for the road sign display part



[Case example 2] Design of a “graphic image indicating a condition in a car” where only the indication, which is specified by a public standards organization, is the part for which the design registration is requested



(Example: Graphic symbols for use on equipment, specified in ISO 7000)

4. Examination procedure for determining whether a design falls under grounds of unregistrability

If the examiner is convinced that a filed design falls under grounds of unregistrability, the examiner should send a notice of reasons for refusal to the effect that the filed design may not be registered under the provisions of Article 5.

In response, the applicant may amend the design by submitting a written amendment of proceedings, or may make a counterargument or an explanation by means of a written opinion. As a result of the amendment, counterargument or explanation, if the examiner is no longer convinced that the filed design clearly falls under grounds of unregistrability, the reasons for refusal should be resolved.

If the examiner's conviction remains unchanged, the examiner should render a decision of refusal based on a reason for refusal to the effect that the design may not be registered under the provisions of Article 5.