Part IV Unregistrable Designs

41 Relevant provisions

Design Act

Article 5 Notwithstanding Article 3, the following designs shall not be registered.

(i) a design which is liable to injure public order or morality;
(ii) a design which is liable to create confusion with an article pertaining to another person's business; or
(iii) a design solely consisting of a shape that is indispensable for securing functions of the article.

41.1 Provisions of Article 5 of the Design Act

Maintaining public order and morality and eliminating factors detrimental to the development of industry are important in terms of public interest, and subject matter whose nature is contrary to this principle should not be protected by law. Hence, even where a design complies with the requirements for design registration, such as being novel, involving creative difficulty, and being industrially applicable, if it falls under any of the following at the time of the grant of an examiner’s decision on design registration, the design may not be registered.

(1) A design which is liable to injure public order or morality \(\rightarrow 41.1.1\) and \(41.1.2\)
(2) A design which is liable to create confusion with an article pertaining to another person’s business \(\rightarrow 41.1.3\)
(3) A design solely consisting of a shape that is indispensable for securing functions of the article \(\rightarrow 41.1.4\)

41.1.1 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 very likely to injure the dignity of the country or the imperial or royal family and is found to be liable to injure public order, so such design may not be registered.

However, this does not include the case where the design is found not to be liable to injure public order, such as in the case of a patterned design made up of the flags of all nations for a sporting event decoration.

41.1.2 Design which is liable to injure morality

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 found to be liable to injure morality, so such design may not be registered.

41.1.3 Design which is liable to create confusion with an article pertaining to another person’s business

A design representing another person’s famous mark or a mark that can be mixed up therewith is very likely to lead to confusion that the article to the design is produced or sold in relation to the business of that person or organization, and the design is found to create confusion with an article pertaining to another person’s business, so such design may not be registered.

41.1.4 Design solely consisting of a shape that is indispensable for securing functions of the article

A shape that is indispensable for securing functions of an article constitutes a creation of a technical idea, which should normally be protected by the Patent Act or the Utility Model Act. If such shape is to be given protection under the Design Act, this would lead to the same consequence as granting an exclusive right for the creation of a technical idea, which is not intended to be protected by the Design Act. For this reason, a design solely consisting of a shape that is indispensable for securing functions of the article may not be registered.

41.1.4.1 Categories of designs that are found to be a design solely consisting of a shape that is indispensable for securing functions of the article

A design that falls under any of the following is found to be a design solely consisting of a shape that is indispensable for securing functions of the article.

(1) Design consisting of a shape that is inevitably decided for securing the technical functions of the article (inevitable shape)

Whether or not the design in an application for design registration is categorized as an inevitable shape will be determined by merely focusing on the shape that embodies the technical function of the article, regardless of the pattern and color, which are the constituent elements of the design, and in this process, the following points will be taken into consideration in particular.

(i) Whether or not there exists any other alternative shape that can secure the function

(ii) Whether or not the design includes a shape that should be taken into consideration in evaluating the design, other than the
inevitable shape

(2) Design consisting of a shape that is decided by a standardized specification for securing the compatibility of the article (quasi-inevitable shape)

A design where the elements of the article such as its shape, size, etc. are specified or standardized for securing the compatibility of the article (including securing the technical function), and which consists of a shape that needs to be accurately reproduced based on the specified or standardized shape, size, etc. is also handled in the same manner as the design of an inevitable shape as set forth in (1) above.

However, the provision of Article 5(iii) of the Design Act will only be applied to an article whose main purpose of use is to exhibit the function based on the shape.

Therefore, for example, office paper (Sizes of paper JIS P 0202), paper for daily use (Envelopes JIS S 5502) and recording media (Compact disc digital audio system JIS S 8605) have a shape that is decided by a public standard specification or a de facto standard specification, but they are not subject to application of the provision of Article 5(iii) of the Design Act.

41.1.4.1.1 Examples of specifications that are categorized as standardized specifications

Specifications that fall under the following are categorized as standardized specifications for securing the compatibility of the article, etc.

(1) Public standards

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

(2) De facto standards

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