

Chapter III Design for a Set of Articles

1. Outline

Article 8 of the Design Act provides, “Where two or more articles, buildings or graphic images are used together and are specifically designated by Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as a “Set of Articles”), if the Set of Articles is coordinated as a whole, an application for design registration may be filed as one design, and the applicant may obtain a design registration, for designs for the articles, buildings or graphic images that constitute the Set of Articles.”

An application for design registration shall be filed for each design (Article 7 of the Design Act), and, in principle, the application for a design can only be filed for a single article, etc. However, in the creation of designs, two or more articles, etc. are often created with a sense of unity.

In response, Article 8 of the Design Act provides that, even if a design comprises two or more articles, buildings, or graphic images (hereinafter referred to as “articles, etc.”), if those constituent articles, etc. are used together and are coordinated as a whole, an applicant may file an application for design registration and may obtain a design registration as one design.

Furthermore, Article 2 of the Design Act provides that parts of articles, etc. are also subject to design registration, and since the design for a set of articles is not an exception, even in the case of an application requesting design registration for two or more parts of an article, etc., design registration may be obtained as a design for a set of articles.

This Chapter describes how an examiner should determine whether a design that has been filed as a design for a set of articles complies with the requirements for registration as a design for a set of articles.

2. Basic concept in examining a design for a set of articles

For applications requesting design registration as a design for a set of articles, the examiner should determine whether the filed design complies with each of the following requirements in order to obtain design registration as a design for a set of articles (Note).

(1) The design falls under one for a set of articles as provided by Ordinance of the Ministry of Economy, Trade and Industry

(2) Two or more articles, buildings or graphic images (hereinafter referred to as an “article, etc.”) are used together

(3) The set of articles is coordinated as a whole

Where the filed design for a set of articles complies with each of the above requirements, the examiner should determine whether it complies with other requirements (the main paragraph of Article 3, paragraph (1) of the Design Act (as well as Article 2 of the Design Act); novelty (Article 3, paragraph (1) of the Design Act); creative difficulty (Article 3, paragraph (2) of the Design Act); exclusion from

protection of a design in a later application that is identical or similar to part of a design in a prior application (Article 3-2 of the Design Act); unregistrable designs (Article 5 of the Design Act); prior application (Article 9 of the Design Act); and related designs (Article 10 of the Design Act)) not on the basis of each constituent article, but as a whole set of articles.

(Note) Even if the application does not comply with the requirements of (2) or (3) above, if the specific design is identifiable and there is no substantive deficiency, such non-compliance with the requirements constitutes a mere formal deficiency that applications should have been filed as a single design for each of the multiple articles, etc. Accordingly, where an application for design registration does not comply with the requirements of (2) or (3) above, registering that application as it is does not directly harm the interests of third parties in a substantial way. Therefore, failure to fulfill the requirements of Article 8 of the Design Act does constitute a reason for refusal, but does not constitute a reason for invalidation. Considering these circumstances, the examiner should not make an unnecessarily strict determination on the requirements of (2) or (3) above.

- * This Chapter focuses on particular matters that are applicable only when examining a design for a set of articles. For other matters not described in this Chapter, see the relevant parts of the ordinary determination standards for designs.

3. Specific determinations in examining a design for a set of articles

3.1 The design falls under one for a set of articles as provided by Ordinance of the Ministry of Economy, Trade and Industry

Where a design that has been filed as one for a set of articles does not fall under some of the designs for a set of articles listed in Appended Table, the examiner should give notice of reasons for refusal under Article 8 of the Design Act.

3.2 Two or more articles, etc. are used together

Where the examiner determines that the articles, etc. constituting a design that has been filed as one for a set of articles (hereinafter referred to as “constituent articles, etc.”) do not comprise two or more articles, etc. that are commonly used together, the examiner should give notice of reasons for refusal under Article 8 of the Design Act.

Where each constituent article, etc. of a filed design for a set of articles is used together, the examiner should determine that the design for a set of articles complies with this requirement in cases of two article designs, two building designs and two graphic image designs, as well as in cases of combinations of these, for example, a building design and a graphic image design, a building design and an article design, and an article design and a graphic image design.

It is not necessary for all constituent articles to be actually used at the same time. In determining this requirement, where each constituent article, etc. is used within the scope of a series of uses in accordance with the usage, function and the purpose of use, etc. of the filed design for a set of articles, the examiner should determine that the filed design complies with this requirement.

Furthermore, the examiner should also determine that the filed design complies with this requirement where each constituent article, etc. of a filed design for a set of articles is commonly distributed in an integrated manner.

3.3 The set of articles is coordinated as a whole

Where the constituent articles, etc. of a design that has been filed as one for a set of articles are not coordinated as a whole, the examiner should give notice of reasons for refusal under Article 8 of the Design Act.

Where the constituent articles, etc. of a design that has been filed as one for a set of articles include those for which the design registration is requested for a part of the article, etc., the examiner should examine whether all of the constituent articles, etc. have the part for which design registration is requested (including cases where design registration is requested for all of the constituent articles; hereinafter the same shall apply in this paragraph 3.3), and whether the parts for which design registration is requested in all constituent articles, etc. are coordinated as a whole, and where the examiner determines that the filed design complies with neither of these requirements, the examiner should give notice of reasons for refusal under Article 8 of the Design Act.

Where each constituent article, etc. (in cases where the filed design is one for which the design registration is requested for a part of an article, etc., “the part for which the design registration is requested in each constituent article, etc.”; hereinafter the same shall apply in this paragraph and in 3.3.1 through 3.3.3) falls under any of the following, for example, the examiner should determine that the set of articles is coordinated as a whole.

- (1) Where the shape, patterns, or colors, or any combination thereof of each constituent article, etc. is represented through equivalent formative processing
- (2) Where each constituent article, etc. of a set of articles represents one cohesive shape or pattern as a whole
- (3) Where the shape, patterns, or colors, or any combination thereof of each constituent article, etc. gives a conceptually related impression as a whole set of articles, such as narrativity

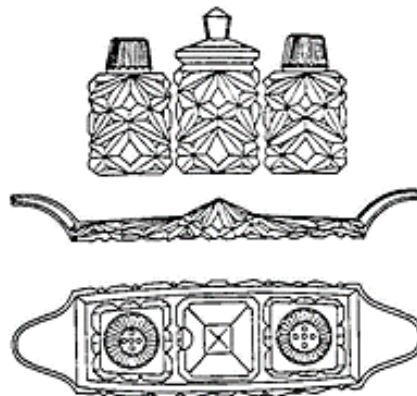
3.3.1 Examples of cases where the shape, patterns, or colors, or any combination thereof of each constituent article, etc. is represented through equivalent formative processing

- (1) Where the constituent articles, etc. are coordinated in shape
 - (a) Where the shapes of all constituent articles, etc. have a constant order or tone

[Case example 1] A set of electric and electronic appliances

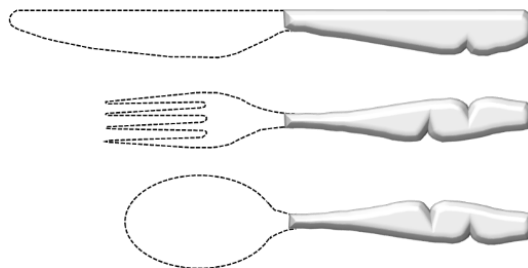


[Case example 2] A set of tableware

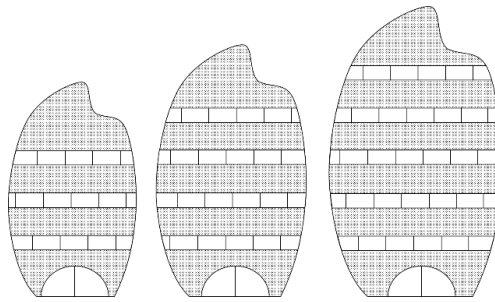


- (b) Where each constituent article, etc. represents a shape with equivalent characteristics

[Case example 1] A set of cutlery



[Case example 2] A set of buildings



[Description of Article to the Design]

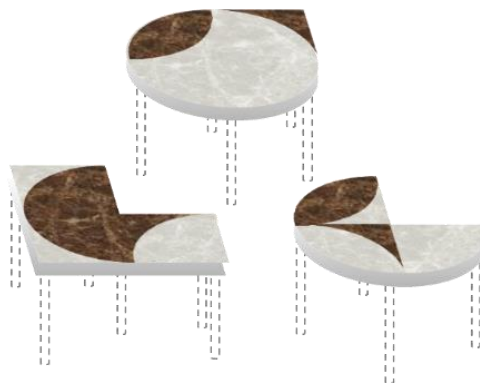
This set of buildings consists of a commercial building, a hotel, and a museum.

- (2) Where the constituent articles, etc. are coordinated in pattern
Where a pattern with the same motif or mode of expression is represented on each constituent article, etc.

[Case example 1] A set of furniture



[Case example 2] A set of furniture



[Case example 3] A set of tableware

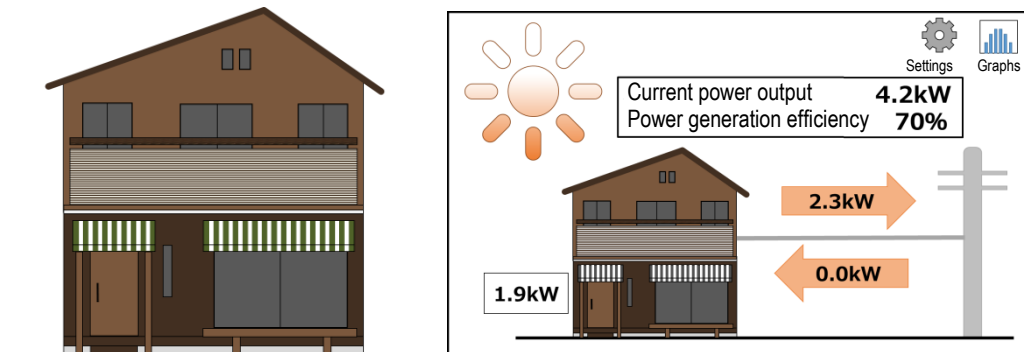


- (3) Where the constituent articles, etc. are coordinated in shape and pattern
Where a shape and pattern with the same motif or mode of expression is represented on each constituent article, etc.

[Case example 1] A set of buildings

House with solar panels

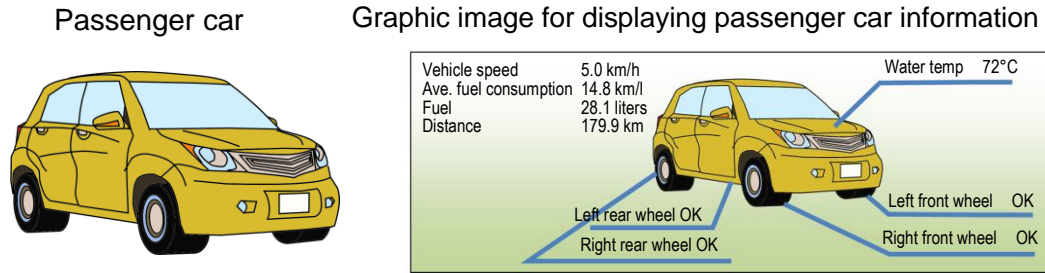
Graphic image for indicating power generation



[Description of Article to the Design]

This design comprises a house with solar panels and a graphic image for indicating power generation. The graphic image shown in the graphic image view indicates the amount of power generated, power generation efficiency, the amount of consumption, and the state of power sold to the grid.

[Case example 2] A set of transportation equipment



[Description of Article to the Design]

This design comprises a passenger car and a graphic image for displaying passenger car information. The graphic image shown in the graphic image view indicates passenger car information such as water temperature and tire pressure.

(4) Where the constituent articles, etc. are coordinated in color

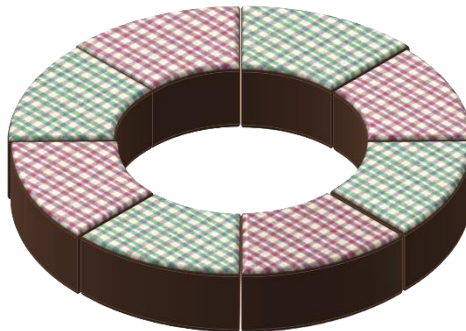
Where the constituent articles, etc. are coordinated as a whole by a specific color combined with a shape or pattern

3.3.2 Examples of cases where each constituent article, etc. of a set of articles represents one cohesive shape or pattern as a whole

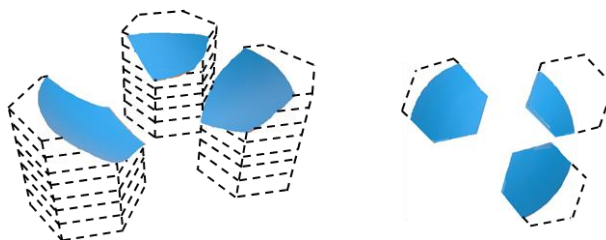
(1) Where the constituent articles, etc. are coordinated in shape

Where the constituent articles constitute one cohesive shape in an integrated manner

[Case example 1] A set of furniture



[Case example 2] A set of buildings

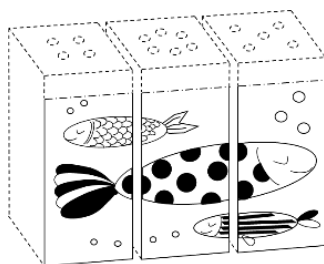


[Description of Article to the Design]

This set of buildings consists of a commercial building, a hotel, and a museum.

- (2) Where the constituent articles, etc. are coordinated in pattern
Where the patterns represented on the constituent articles form one cohesive pattern in an integrated manner

[Case example 1] A set of tableware



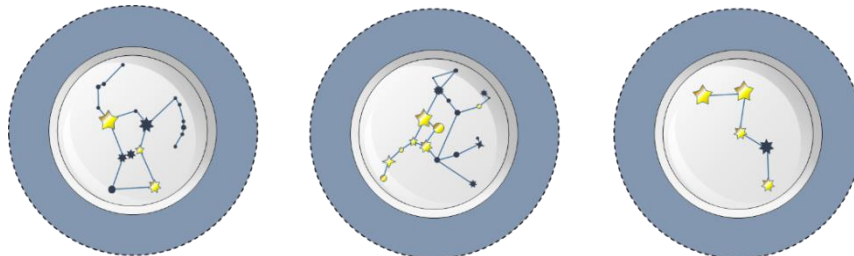
[Case example 2] A set of kitchen equipment



- (3) Where the constituent articles, etc. are coordinated in color
Where the constituent articles, etc. are coordinated as a whole by a specific color combined with a shape or pattern

3.3.3 Examples of cases where the shape, patterns, or colors, or any combination thereof of each constituent article, etc. gives a conceptually related impression as a whole set of articles, such as narrativity

[Case example] A set of tableware



4. Determination on the requirements for design registration, etc. concerning a design for a set of articles

Where an application for design registration for a design for a set of articles complies with the requirements provided in Article 8 of the Design Act, the examiner should determine whether or not the whole set of articles falls under each of the provisions including the following: the main paragraph of Article 3, paragraph (1) of the Design Act (as well as Article 2 of the Design Act); novelty (Article 3, paragraph (1) of the Design Act); creative difficulty (Article 3, paragraph (2) of the Design Act); exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application (Article 3-2 of the Design Act); unregistrable designs (Article 5 of the Design Act); prior application (Article 9 of the Design Act); and related designs (Article 10 of the Design Act).

5. Exception to lack of novelty concerning an application for design registration for a design for a set of articles

An application for design registration for a design for a set of articles is also subject to application of the provisions of Article 4, paragraph (1) or (2) of the Design Act.

With regard to the requirements, etc. and any other determination standards for application of the provisions of Article 4, paragraph (1) or paragraph (2) of the Design Act, see Part III, Chapter III “Exception to Lack of Novelty.”

6. Amendment of a design for a set of articles

A person undertaking a procedure with regard to an application for design registration, a request or any other procedures relating to design registration, may make amendments only while the case is pending in examination, appeal and trial or retrial (Article 60-24 of the Design Act).

Below describes the points that examiners should note regarding the amendment of designs for sets of articles. For other information on the basic handling of amendments, see Part VI, Chapter I “Amendment” and Chapter II “Dismissal of Amendments.”

6.1 Categories of amendments that change the gist

Where an amendment made to the statement in the application or any drawings, etc. attached to the application falls under any of the following, the examiner should determine that it changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

- (1) An amendment that makes a change exceeding the scope identical to that which can be inevitably derived based on the ordinary skill in the art of the design
- (2) An amendment that clarifies the gist of design (Note) that was unclear when originally filed

(Note) “Gist of design” refers to the contents of a specific design that can be directly derived from the statement in the application and drawings, etc. attached to the application based on the ordinary skill in the art of the design.

6.2 Specific handling of an amendment made to the statement in an application

- (1) Amendment to change a statement to a set of articles listed in Appended Table

Where a set of articles listed in Appended Table is not stated in the column of “Article to the Design” in the application as originally filed, and it can be recognized as a single design from statements such as those in the application and drawings, etc. attached to the application, if an amendment has been made to change a statement in the column of “Article to the Design” in the application to a set of articles listed in Appended Table, the examiner should determine that such an amendment changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

However, where the statement in the column of “Article to the Design” in the application as originally filed was, for example, “a set (pair) of xxx set (unit),” “a set (pair) of xxx” or “xxx set (unit),” and is unregistrable under Article 8 of the Design Act, but a set of articles listed in Appended Table can be inevitably derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application, if an amendment has been made to change a statement in the column of “Article to the Design” to such set of articles that could be inevitably derived, the examiner should determine that such an amendment does not change the gist.

- (2) Amendment to change from a design for a set of articles listed in Appended Table to a single article, etc. to the design

Where a set of articles listed in Appended Table is stated in the column of “Article to the Design” in the application, but the drawings, etc. attached to the application show only single design, an amendment to change the statement in the column of “Article to the Design” in the application to such a single article, etc. to the design does not change the gist.

6.3 Specific handling of an amendment made to the drawings, etc. attached to an application

(1) Amendment to delete an article that is found to be inappropriate as a constituent article of a set of articles

Where a set of articles listed in Appended Table is stated in the column of “Article to the Design” in the application as originally filed, but the drawings, etc. attached to the application show a design with inappropriate constituent articles, etc., the examiner should determine that there are multiple designs. In contrast, when an applicant divides the application for design registration into one application for design registration for a design for a set of articles and one or more other applications for design registration, the examiner should not determine that an amendment to the original application for design registration to delete the design with inappropriate constituent articles, etc. from drawings, etc. attached to the application changes the gist.

(2) Amendment to supplement or delete an article that is found to be appropriate as a constituent article

The examiner should determine that an amendment to add or delete a design that is found to have appropriate constituent articles, etc. exceeds the scope of identity that can be inevitably derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application as originally filed, and it changes the gist.

(3) Amendment to add drawings of the respective constituent articles, etc. with regard to an application for design registration that only has a drawing of the articles in a combined state

Where drawings represent the shape, etc. of respective constituent articles, etc. that cannot be inevitably derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application as originally filed, the examiner should determine that an amendment to add such drawings to drawings, etc. attached to the application changes the gist.

Where the shape, etc. of the constituent articles, etc. can be inevitably derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application as originally filed, the examiner should not determine that an amendment to add drawings representing the shape, etc. of the respective constituent articles, etc. to drawings, etc. attached to the application changes the gist.

6.4 Amendment to building design

Where the subject matter of an application for a design for a set of articles does not contain multiple articles, buildings or graphic images and is not recognized as a design for a set of articles, and if it is recognized that, in essence, it should be filed as a building design, the examiner should determine that an amendment which changes this application to one for design registration for a building design does not change the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

On the other hand, if the subject matter of an application for a design for a set of articles complies with the requirements for categorization as a design for a set of articles, the examiner should determine that an amendment which changes the application to one for a building design does change the gist of the design. (For the

design applicability requirements for designs for a set of articles, see 3. “Specific determinations in examining a design for a set of articles” in this Chapter.)

Furthermore, when determining whether two designs are identical, in addition to the shape, etc. of both designs, the examiner should also compare usage and function, and in the case of designs for which the design registration is requested for a part of an article, etc., the examiner should also determine whether their position, size, and scope are the same.

6.5 Amendment to interior design

Where the subject matter of an application for a design for a set of articles complies with the requirements for categorization as a design for a set of articles, the examiner should determine that an amendment which changes the application for a design for a set of articles to one for an interior design does change the gist of the design. (For the design applicability requirements for designs for a set of articles, see 3. “Specific determinations in examining a design for a set of articles” in this Chapter.)

Furthermore, when determining whether two designs are identical, in addition to the shape, etc. of both designs, the examiner should also compare usage or function and the layout of furniture and fixtures, etc., and in the case of designs for which the design registration is requested for a part of an article, etc., the examiner should also determine whether their position, size, and scope are the same.

7. Division concerning an application for design registration for a design for a set of articles

7.1 Division of an application for design registration where the design of which is found to be a design for a set of articles

Where a design constituted by multiple articles, etc. complies with the requirements provided in Article 8 of the Design Act, such design is found to be one design as a whole, so if one or more new applications for design registration are filed for respective constituent articles, etc., it is not found to be legitimate division based on the provisions of Article 10-2 of the Design Act and the new application for design registration is treated as having been filed at the time of the division.

7.2 Division of an application for design registration where the design of which is not found to be a design for a set of articles

Where an application for design registration for a design for a set of articles does not comply with the requirements provided in Article 8 of the Design Act, such design is not found to be one design as a whole, so division based on the provisions of Article 10-2 of the Design Act is allowed, and the new application for design registration is deemed to have been filed at the time of filing the original application for design registration.

With regard to any other determination standards, see Part VIII, Chapter I “Division of Applications for Design Registration.”

8. Application for design registration for a design for a set of articles containing a priority claim under the Paris Convention, etc.

A priority claim under the Paris Convention, etc. is effective with regard to an application for design registration for a design for a set of articles only where the constituent articles, etc. are filed as one design in the first country equivalent to the case of a set of articles in Japan.

With regard to any other determination standards, see Part VII “Advantage of Priority under the Paris Convention.”