Part V Related Design

1. Outline

The reality in design creation is that many design variations are continually created from a single concept. The related design system deals with designs in a group that have been created this way. The system protects the designs as having equivalent value, and enables rights to be enforced on each design, but only where applications for these designs have been filed by the same applicant.

Since a design right is an exclusive right enabling a person to work the design as a business, if overlapped rights are able to be enforced separately, the rights of others may stop a right holder from being able to work a design as a business. The provisions of prior application (Article 9 of the Design Act) have therefore been established to prevent such a situation from happening.

The related design system as provided in Article 10 of the Design Act permits registration as an exception to these provisions of prior application, while eliminating the detrimental effects caused by overlapped rights, by imposing requirements for registration and restrictions on rights.

2. Basic concept in examining related designs

To obtain a design registration as a related design, the filed design must comply with the prescribed requirements for related designs.

Therefore, for applications requesting design registration as a related design, in addition to the ordinary requirements for design registration, the examiner should determine whether the filed design complies with the prescribed requirements for registration as a related design.

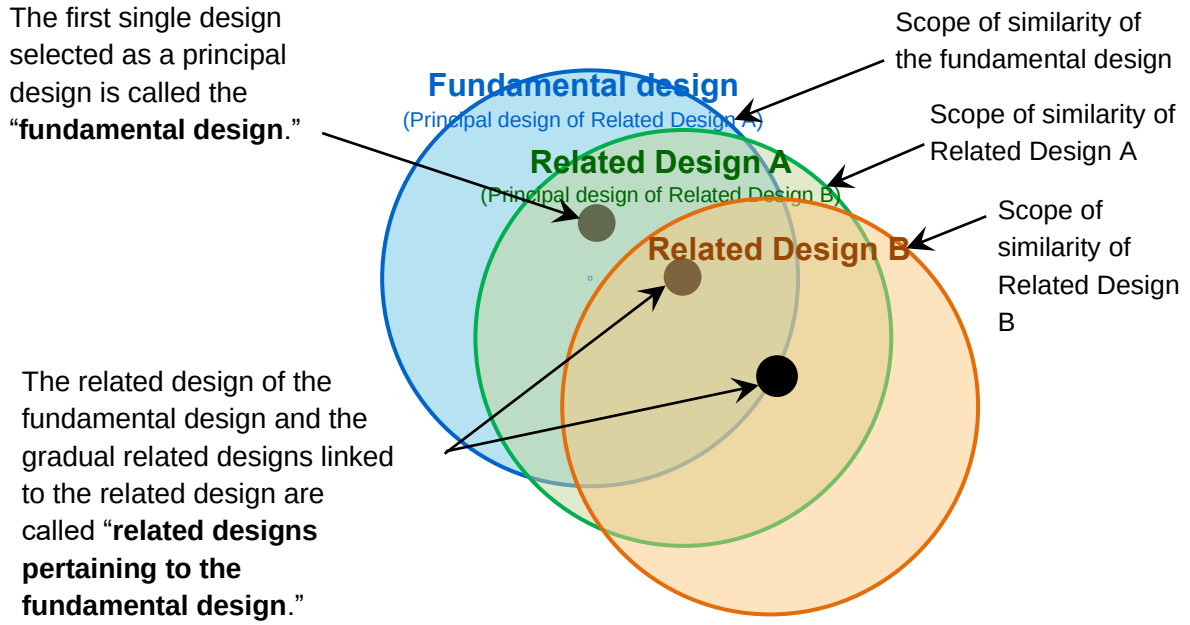
3. Specific determinations in examining related designs

3.1 Description of terms pertaining to related designs

To obtain a design registration as a related design, a single design must be selected from the applicant’s own design for which an application for design registration has been filed or for which design registration has been granted. This selected design is called the “principal design” (Article 10, paragraph (1) of the Design Act).

The first selected principal design, that is, a “principal design” that is not a related design of any other design, is called the “fundamental design” (Article 10, paragraph (7) of the Design Act). Furthermore, the related design of the fundamental design and the gradual related designs linked to the related design are called “related designs pertaining to the fundamental design.”

In this Part, “fundamental design” shall be stated for matters that apply only to the fundamental design, and “principal design” shall be stated for matters that apply, not only to the fundamental design, but also to other principal designs.



3.2 Reference date for determination on the provisions of Article 10, paragraph (1) of the Design Act

With respect to the provisions of Article 10, paragraph (1) of the Design Act, the examiner should determine the filing date for the fundamental design and the filing date for the related design as follows.

(1) Cases where effects of priority claim are recognized

Regarding applications for design registration containing a priority claim under the Paris Convention, etc., if the effects of that claim are recognized (for the approval or disapproval of the effects of priority claim, see Part VII), as for the filing date for the fundamental design and the filing date for the related design under Article 10 of the Design Act, the filing date of the first application should be the reference date for determination.

(2) Cases complying with the requirements for 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 paragraph (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 a retroactive effect of the filing date has been recognized, as

for the filing date for the fundamental design and the filing date for the related design under Article 10 of the Design Act, 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 determination.

(3) Cases of an international application for design registration

Regarding international applications for design registration, unless a priority claim under the Paris Convention is recognized to be effective (see (1)), as for the filing date for the fundamental design and the filing date for the related design under Article 10 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.

3.3 Requirements for obtaining design registration as a related design

When examining whether a filed design is a registrable as a related design, the examiner should determine whether it complies with all of the following requirements.

(1) The application for design registration is filed by the same applicant for design registration as that for the principal design (→ see 3.3.1)
(2) The application for design registration pertains to a design similar to the principal design (→ see 3.3.2)
(3) The application for design registration was filed on or after the filing date of the application for design registration for the fundamental design (or the priority date in cases where effects of priority claim are recognized) and before a lapse of 10 years from the date (→ see 3.3.3)

3.3.1 The application for design registration is filed by the same applicant for design registration as that for the principal design

The applicant for design registration for a related design must be the same as that for the principal design (or the same as the holder of the design right of the principal design in cases where establishment of the design right has been registered for the principal design).

The determination on whether or not the applicants for design registration are the same in the examination is made at the time of rendering the examiner's decision, but the applicants for design registration also need to be the same at the time of the registration establishing the design right.

3.3.2 The application for design registration pertains to a design similar to the principal design

To obtain a design registration as a related design, the design in application must be similar to the principal design.

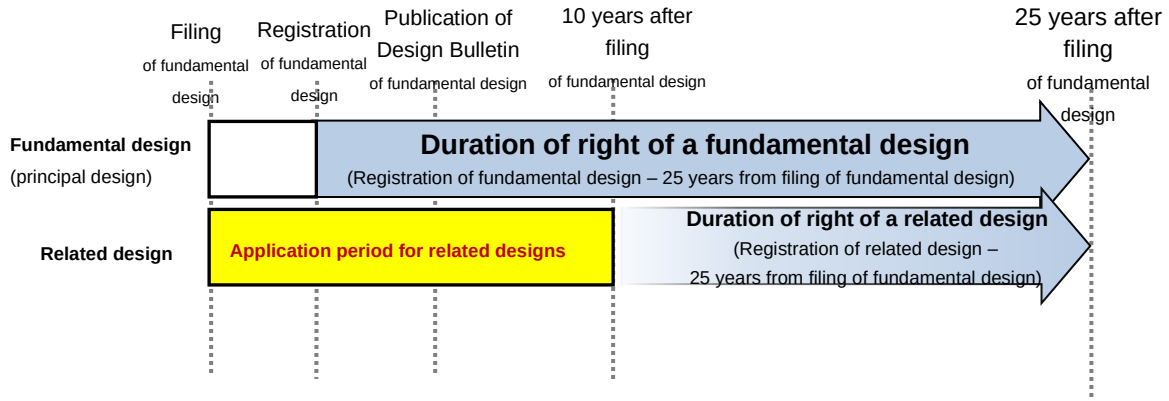
Where the related design is identical to principal design, it cannot be registered as a related design.

(With regard to determination of similarity between two or more whole designs, see Part III, Chapter V “Prior Application,” 3.1 “Determination of similarity between two or more whole designs”; with regard to determination of similarity between two or more designs for which the design registration is requested for a part of an article, etc., see 3.2 “Determination of similarity between two or more ‘designs for which the design registration is requested for a part of an article, etc.’” in the same Chapter; and with regard to determination of similarity between a whole design and a design for which the design registration is requested for a part of an article, etc., see 3.3 “Determination of similarity between a whole design and ‘a design for which the design registration is requested for a part of an article, etc.’” in the same Chapter.)

3.3.3 The application for design registration should be filed on or after the filing date of the application for design registration for the fundamental design and before a lapse of 10 years from the date

The filing date of an application for design registration of a related design must be on or after the filing date of the application for design registration for the fundamental design and before a lapse of 10 years from that filing date.

Furthermore, in cases where effects of priority claim are recognized with respect to both the filing date of the application for design registration of the fundamental design and the filing date for the related design, application of the provisions of Article 10, paragraph (1) of the Design Act is determined based on the priority date.



3.4 Essential requirements for principal designs, etc.

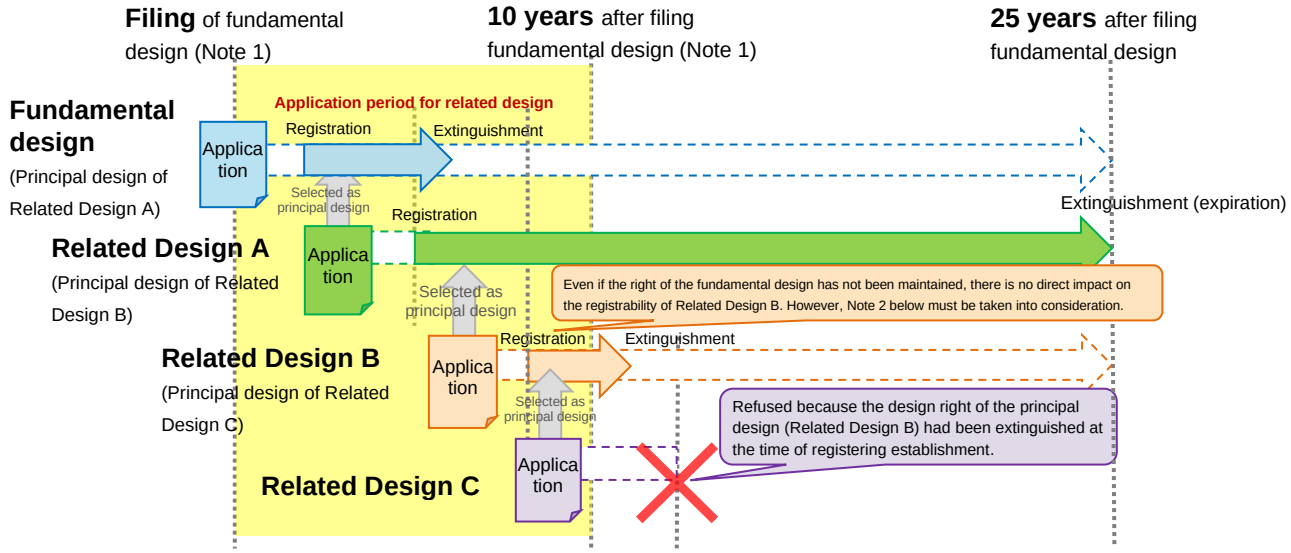
When examining whether a filed design is a registrable as a related design, in addition to the requirements for a related design (see 3.3 above), the examiner should determine whether it complies with all of the following requirements for a principal design, etc.

(1) The design right of the principal design has not been extinguished, etc. (→ see 3.4.1)
(2) An exclusive license has not been established on the design right of the principal design (→ see 3.4.2)

3.4.1 The design right of the principal design has not been extinguished, etc.

Where, at the time of registering establishment of the design right of a related design, the design right of the principal design has been extinguished under the provisions of Article 44, paragraph (4) or Article 60-14, paragraph (2), a trial decision to the effect that it is to be invalidated has become final and binding, or it has been waived, the related design may not be registered in accordance with the provisions of Article 10, paragraph (1) of the Design Act.

Therefore, if the examiner intends to render an examiner's decision to the effect that a related design is to be registered, the examiner should confirm that the design right of the principal design has not been extinguished under the provisions of Article 44, paragraph (4) or Article 60-14, paragraph (2), that a trial decision to the effect that it is to be invalidated has not become final and binding, and that it has not been waived.



(Note 1) In cases where effects of priority claim are recognized, requirements for obtaining a design registration as a related design and prior and later applications are determined based on the priority date.

(Note 2) In this case example, it must be noted that, after the design right of the fundamental design is extinguished, the applicant's own publicly known design that are identical or similar to the fundamental design are not excluded in determination of the novelty and creative difficulty of Related Design B. (For details, see 3.7.3 "Application of the provisions of Article 10, paragraph (8) of the Design Act with respect to applicant's own design that are identical or similar to a related design that has been extinguished, etc." in this Part.)

3.4.2 An exclusive license has not been established on the design right of the principal design

Pursuant to the provisions of Article 10, paragraph (6) of the Design Act, a related design whose principal design is one pertaining to a design right on which an exclusive license has been established may not be registered.

Therefore, if the examiner intends to render an examiner's decision to the effect that a related design is to be registered, the examiner should confirm that an exclusive license has not been established on its principal design.

Furthermore, even if an exclusive license has been established on the principal design, if cancellations (Note) of that exclusive license has been registered, a related design could be registered with respect to that principal design.

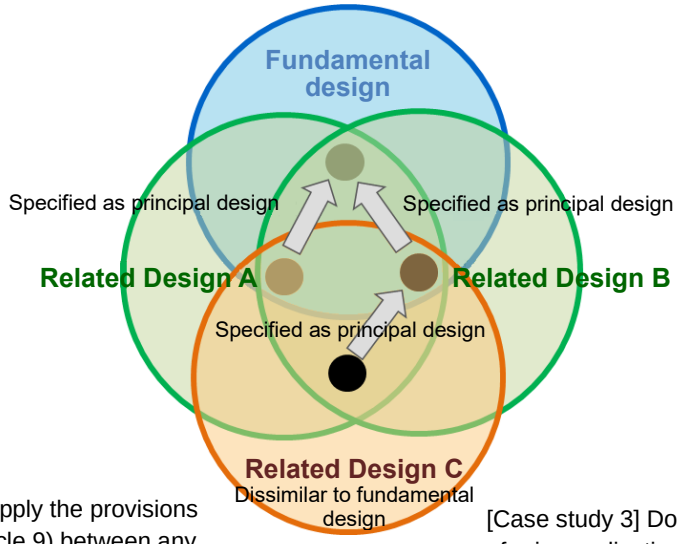
(Note) Pursuant to the provisions of Article 27, paragraph (1) of the Design Act, registering the cancellations of an exclusive license pertaining to the design right of the fundamental design and that of related design pertaining to the fundamental design must be established for all designs at the same time.

3.5 Application of the provisions concerning prior application

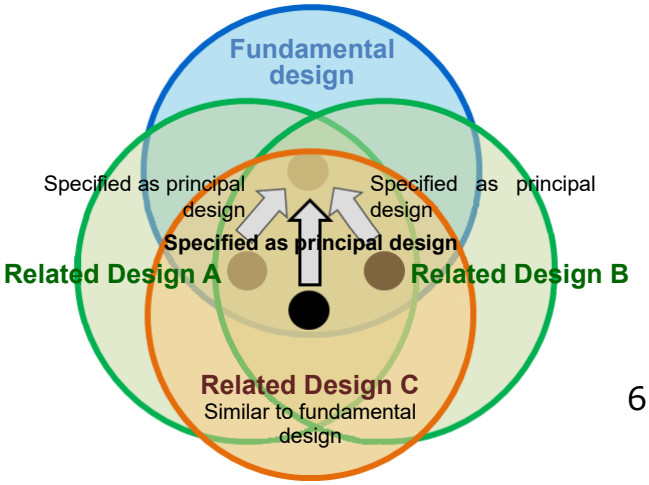
In cases where the fundamental design and a related design pertaining to the fundamental design are similar to each other, the examiner should not apply the provisions of Article 9, paragraph (1) and paragraph (2) of the Design Act to their relationship (Article 10, paragraph (1), paragraph (4) and paragraph (7) of the Design Act).

In addition, the same applies to related designs that continue to exist after their fundamental design has been extinguished as a result of waiver of the design right, a failure to pay registration fees, or a trial decision of invalidation becoming final and binding. Even if two or more related designs pertaining to a single fundamental design are similar to each other, the provisions of Article 9, paragraph (1) and paragraph (2) of the Design Act will not apply.

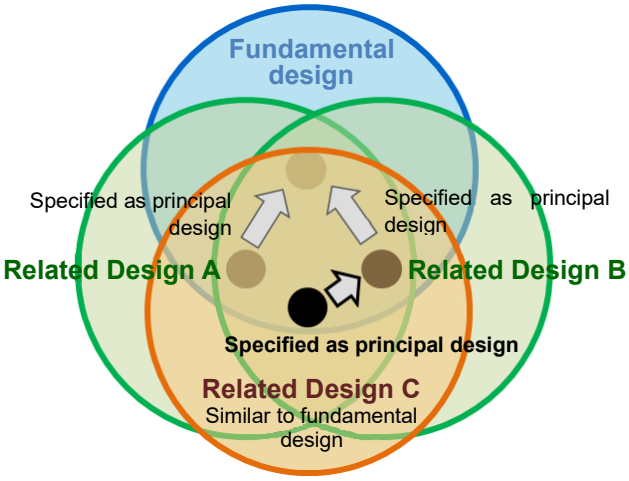
[Case study 1] Do not apply the provisions of prior application (Article 9) between any of the designs below



[Case study 2] Do not apply the provisions of prior application (Article 9) between any of the designs below



[Case study 3] Do not apply the provisions of prior application (Article 9) between any of the designs below



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 cases where the applicant of an application for design registration for a related design and the applicant of the earlier application are the same person, the examiner should not apply the provisions prescribed in Article 3-2 of the Design Act 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 (Article 10, paragraph (3) of the Design Act).

3.7 Application of the provisions concerning novelty and creative difficulty

Of the designs of an applicant filing an application for design registration for a related design (hereinafter referred to as the “applicant’s own design”), which are publicly known, the examiner should exclude from information that serves as the basis for determination of novelty and creative difficulty of the related design, those designs that are identical or similar to the fundamental design of the design for which the design registration is requested as a related design and to related designs pertaining to that fundamental design (Article 10, paragraph (2) and paragraph (8) of the Design Act).

3.7.1 Meaning of “applicant’s own design” under Article 10, paragraph (2) and paragraph (8) of the Design Act

The term “applicant’s own design” means those designs for which the applicant for design registration for a related design holds the design rights or holds the right to obtain a design registration. It does not include designs for which others hold the design rights or hold the right to obtain a design registration.

3.7.2 Timing, etc. of the disclosure of publicly known designs to which the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act apply

The examiner should apply the provisions of Article 10, paragraph (2) or paragraph (8) of the Design Act only to the applicant’s own design which are publicly known, and which fall under any of the following (1) through (3).

(1) Designs that are identical or similar to the fundamental design of the design for which the design registration is requested as a related design, and which became publicly known on or after the filing date of the fundamental design (or, if effects of priority claim are recognized, the filing date of the first application that serves as the basis for the priority claim; hereinafter the same shall apply in 3.7.2)

(2) Designs that are identical or similar to related designs pertaining to the fundamental design of the design for which the design registration is requested as a related design, and which became publicly known on or after the filing date of the respective corresponding related design

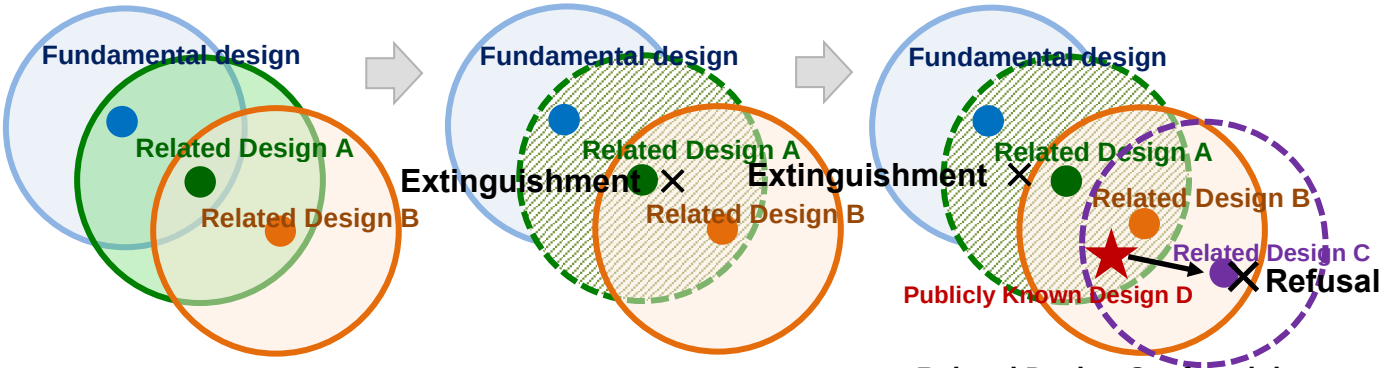
(3) Designs that are identical or similar to the fundamental design of the design for which the design registration is requested as a related design and to related designs pertaining to that fundamental design, and where exceptions to lack of novelty have been applied to that fundamental design or to the related designs pertaining to the fundamental design

(Note) For designs that became publicly known in a foreign country, etc., the examiner should also take any time difference into account when determining (1) or (2) above.

3.7.3 Application of the provisions of Article 10, paragraph (8) of the Design Act with respect to applicant's own design that are identical or similar to a related design that has been extinguished, etc.

If applicant's own design which is publicly known (for example, Publicly Known Design D in the figure below) is identical or similar to a related design (for example, Related Design A or B in the figure below) pertaining to the fundamental design of the design for which the design registration is requested as a related design (for example, Related Design C in the figure below), which falls under any of the following (1) through (7), the examiner should not apply the provisions of Article 10, paragraph (8) of the Design Act, and should treat that applicant's own design as information that serves as the basis for determination of novelty and creative difficulty for the filed related design.

(1) Where the application for design registration for the related design has been waived
(2) Where the application for design registration for the related design has been withdrawn
(3) Where the application for design registration for the related design has been dismissed
(4) Where an examiner's decision or trial decision to the effect that the application for design registration for the related design is to be refused has become final and binding
(5) Where the design right of the related design has been extinguished pursuant to the provisions of Article 44, paragraph (4) or Article 60-14, paragraph (2) of the Design Act
(6) Where a trial decision to the effect that the design right of the related design is to be invalidated has become final and binding
(7) Where the design right of the related design has been waived



Extinguishment of the design right of Related Design A

→ Applicant's own publicly known design, which is identical or similar to Related Design A (green area) should not be excluded from the information that serves as the basis for determination of novelty and creative difficulty.

Related Design C refused due to Publicly Known Design D

After the extinguishment of Related Design A, Publicly Known Design D, which is similar to Related Design A, should not be excluded from the information that serves as the basis for determination of novelty and creative difficulty.

* However, it should be excluded if subject to the exceptions to lack of novelty.

(Note 1) Regarding (1) to (4) above, limited to cases where, at the time leading up to the relevant event, the fundamental design or a related design pertaining to the fundamental design had been stated as the principal design in the column of "Indication of Principal Design" of the application, and notice of the determination at the examination, trial or retrial had been given that the related design is one whose principal design is the fundamental design or a related design pertaining to the fundamental design.

(Note 2) The same treatment shall also apply if the applicant's own publicly known design is identical or similar to the fundamental design of the design for which the design registration is requested as a related design, and if the design right of the fundamental design is extinguished, etc. in the same manner as (5) to (7) above, the examiner should not apply the provisions of Article 10, paragraph (8) of the Design Act, and should treat the applicant's own design as information that serves as the basis for determination of novelty and creative difficulty for the filed related design.

3.7.4 Matters to be considered in applying the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act

(1) Regarding publicly known designs, often the manufacturer or seller of an article, etc. to the design is not clearly stated, or the manufacture is engaged in manufacturing under license to work the design right. For this reason, the examiner should determine whether a publicly known design corresponds to "applicant's own design" under Article 10, paragraph (2) and paragraph (8) of the Design Act, while taking each of the following points (a) through (d) into consideration.

Furthermore, when applying Article 10, paragraph (2) and paragraph (8) of the Design Act, the examiner should determine whether a publicly known design is anyone's design based on the time that the publicly known design became publicly known.

(a) Where, based on the general knowledge of a person skilled in the art, it is clear that a mark, etc. indicated on a publicly known design is the mark, etc. of the applicant, the examiner should treat the publicly known design as the "applicant's own design."
(b) In cases of a joint application by multiple applicants for design registration for a related design, where the licensee of a publicly known design is one of those applicants, the examiner should treat the publicly known design as the "applicant's own design." However, where a person other than those joint applicants holds a right to obtain design registration for that publicly known design, the examiner should not treat the publicly known design as the "applicant's own design."
(c)Where it can be inferred that a publicly known design is being used under license to work the design right from the applicant of an application for design registration for a related design, the examiner should treat the publicly known design as the "applicant's own design."
(d) Where a design right has been transferred, and the holder of the design right prior to the transfer is the same person as the discloser of the publicly known design, the examiner should treat the publicly known design as the "applicant's own design."

(2) Regarding publicly known designs presented by the examiner as a basis for determining novelty or creative difficulty, in cases where a counterargument is made by the applicant to the effect that the publicly known design corresponds to the "applicant's own design" under Article 10, paragraph (2) and paragraph (8) of the Design Act:

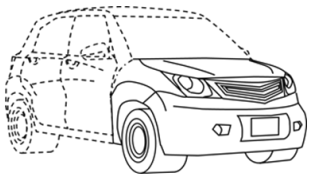
(a) If the applicant has only brought forward a counterargument merely stating that the publicly known design is the applicant's own design, with no evidence or other substantiation:
In this case, because no specific evidence has been presented, the examiner should not accept that counterargument.
(b) If the applicant has brought forward a counterargument detailing how the publicly known design is the applicant's own design while presenting specific evidence:
In this case, the examiner should consider the applicants' counterargument in light of the specific evidence, etc., and if the examiner forms the belief that the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act ought to be applied to the publicly known design, the examiner should exclude that publicly known design from the information that serves as the basis for determination of novelty or creative difficulty.
On the other hand, if the examiner finds evidence which casts doubt on the details of the applicants' counterargument or specific evidence, the examiner should not accept that counterargument.

3.7.5 Application of the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act in cases where the fundamental design of the design for which the design registration is requested as a related design or a related design pertaining to the fundamental design is the design for which the design registration is requested for a part of an article, etc.

Where the fundamental design of the design for which the design registration is requested as a related design or a related design pertaining to the fundamental design is the design for which the design registration is requested for a part of an article, etc., in applying the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act, the examiner should exclude from information that serves as the basis for determination of novelty and creative difficulty, that part in the applicant's own publicly known design which corresponds to the part in the fundamental design or a related design pertaining to the fundamental design for which the design registration is requested.

[Case example] Example of a design for which the design registration is requested for a part of an article, etc.

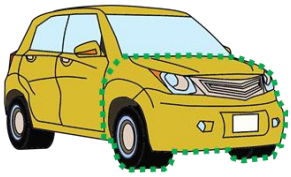
Fundamental design of the related design for which the design registration is requested



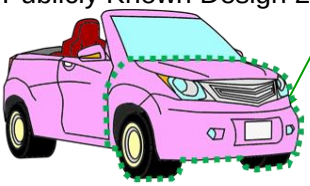
[Article to the Design] Passenger car

[Description of the Design] The part drawn with solid lines is the part for which the design registration is requested. The dashed-dotted lines indicate the boundary between the part for which the design registration is requested and any other parts.

Publicly Known Design 1



Publicly Known Design 2



Design to which the provisions of Article 10, paragraph (2) or paragraph (8) apply

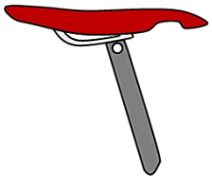
Examiner applies the provisions of Article 10, paragraph (2) or paragraph (8) of the Design Act for the design of the part enclosed by the green dotted line.

3.7.6 Application of the provisions of Article 10, paragraph (2) and paragraph (8) of the Design Act in cases where other articles created by the applicant (hereinafter referred to as the "applicant's other articles") or articles created by others have been added to the applicant's own publicly known design

Even if one of the applicant's other articles or an article created by others has been added to the applicant's own publicly known design, if the applicant's own design can be distinctively recognized, the examiner should exclude from information that serves as the basis for determination of novelty and creative difficulty, the applicant's own design that is identical or similar to the fundamental design of the design for which the design registration is requested as a related design or a related design pertaining to the fundamental design, exclusive of the applicant's other article or the article created by others which was added.

[Case example 1] Example of a whole design of a component

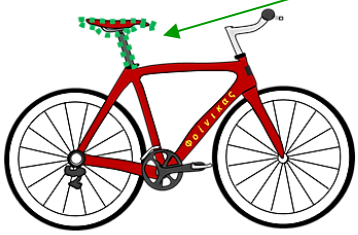
Fundamental design of the related design for which the design registration is requested



[Article to the Design]
A bicycle saddle

Publicly Known Design 2

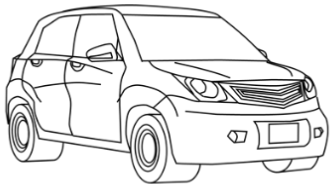
Design to which the provisions of Article 10, paragraph (2) or paragraph (8) apply



Examiner applies the provisions of Article 10, paragraph (2) or paragraph (8) of the Design Act for the design of the part (component) enclosed by the green dotted line.

[Case example 2] Example of a whole design of a finished product

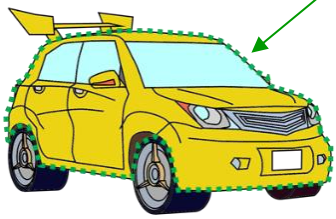
Fundamental design of the related design for which the design registration is requested



[Article to the Design]
Passenger car

Publicly Known Design

Design to which the provisions of Article 10, paragraph (2) or paragraph (8) apply



Examiner applies the provisions of Article 10, paragraph (2) or paragraph (8) of the Design Act for the design of the part enclosed by the green dotted line.