

Relevant Provisions

Design Act

Article 10 (1) Notwithstanding the provisions of Article 9, paragraph (1) or (2), an applicant for design registration may have a registration made for a design that is similar to a single design which the applicant has selected either from among the applicant's own designs for which an application for design registration has been filed or from among the applicant's own registered designs (hereinafter the selected design is referred to as the "principal design" and a design similar to it is referred to as a "related design"), but only if the filing date of the application to register the related design (or, if the application to register the related design contains a priority claim under Article 43, paragraph (1), Article 43-2, paragraph (1), Article 43-3, paragraph (1) or Article 43-3, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1), the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application pursuant to Article 4C.(4) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, or the filing date of an application that is recognized as the earliest application pursuant to Article 4A.(2) of the Paris Convention; hereinafter the same applies in this paragraph) falls on or after the filing date of the application to register the principal design, and also falls prior to the last day before the lapse of 10 years' time after the filing date of the application to register the principal design; provided, however, that this does not apply if, as of the time of the registration establishing the rights to the related design, the rights to the principal design have ceased to exist pursuant to Article 44, paragraph (4), a trial or appeal decision to invalidate them has become final and binding, or they have been abandoned.

- (2) In applying the provisions of Article 3, paragraphs (1) and (2) to any of the applicant's own designs that have come to fall under Article 3, paragraph (1), item (i) or (ii) and that are identical or similar to the principal design selected for the design that the applicant seeks to have a design registration made pursuant to the preceding paragraph, those designs are deemed not to have come to fall under Article 3, paragraph (1), item (i) or (ii) with regard to the design that the applicant seeks to have a design registration made.
- (3) In applying the proviso to Article 3-2 to a design that an applicant seeks to have a design registration made pursuant to paragraph (1), the phrase "except for a design gazette in which the matters set forth in Article 20, paragraph (3), item (iv) were published pursuant to Article 20, paragraph (4)" in the proviso to Article 3-2 is deemed to be replaced with "if the secrecy is requested for the earlier application for design registration under Article 14, paragraph (1), limited to a design gazette in which the matters set forth in Article 20, paragraph (3), item (iv) were published pursuant to the provisions of Article 20, paragraph (4)".
- (4) A design that is similar only to the related design for which a design registration is granted pursuant to paragraph (1) may be granted a design registration pursuant

to that paragraph by deeming the related design to be the principal design. This also applies for a design that is similar only to the related design for which it is provided that the design registration may be granted, and for a design that is similar only to a further-removed related design which is linked to a related design for which it is provided that a design registration may be granted.

- (5) In a case as referred to the preceding paragraph, to apply the provisions of paragraph (1), the term "the principal design" in that paragraph is deemed to be replaced with "the single design that was first selected in connection with the related design".
- (6) If an exclusive license has been established on the design rights to the principal design, a design registration may not be granted for related designs associated with the principal design, notwithstanding the provisions of paragraphs (1) and (4).
- (7) If applications to register related designs have been filed for two or more designs, each of which constitutes a related design associated with a fundamental design ("fundamental design" means the single design that was first selected in connection with a related design; the same applies hereinafter) ("related designs associated with a fundamental design" means a related design for which a fundamental design has been selected and any further-removed related design that is linked to the related design; the same applies hereinafter), Article 9, paragraph (1) or (2) does not apply to those designs.
- (8) In a case as provided in the preceding paragraph, in applying the provisions of Article 3, paragraphs (1) and (2) to any of the applicant's own designs that have come to fall under Article 3, paragraph (1), item (i) or (ii) and that are identical or similar to a related design associated with the fundamental design in question (excluding the cases in which an application to register the related design has been abandoned, withdrawn, or dismissed, the examiner's decision or trial or appeal decision rejecting the application for design registration associated with the related design has become final and binding, the rights to the related design have ceased to exist pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision to invalidate the rights to the related design has become final and binding, or the rights to the related design have been abandoned), those designs are deemed not to have come to fall under Article 3, paragraph (1), item (i) or (ii) with regard to the design that the applicant seeks to have a design registration made pursuant to the provisions of paragraph (1).

Article 21 (1) The duration of design rights (excluding rights to a related design) ends 25 years after the filing date of the application for design registration.

- (2) The duration of design rights for a related design ends 25 years after the filing date of the application to register the fundamental design selected for it.

Article 22 (1) The rights to a fundamental design and to its related designs may not be transferred independently of each other.

- (2) If the rights to a fundamental design have been extinguished pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision invalidating the rights to a fundamental design has become final and binding, or the rights to a fundamental design have been abandoned, the rights to the related designs associated with the fundamental design may not be transferred independently.

- Article 27 (1) A holder of design rights may grant an exclusive license on their design rights; provided, however, that an exclusive license on the rights to a fundamental design or exclusive licenses on the rights to its related designs may be granted only if all the exclusive licenses on the rights to the fundamental design and its related designs are granted to the same person at the same time.
- (2) An exclusive licensee has an exclusive right to work the registered design or designs similar to it in the course of trade to the extent permitted by the act establishing the license.
- (3) If the rights to a fundamental design cease to exist pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision to invalidate the rights to a fundamental design becomes final and binding, or the rights to a fundamental design have been abandoned, exclusive licenses on the rights to related designs associated with the fundamental design may be granted only if all the exclusive licenses on the rights to related designs are granted to the same person at the same time.
- (4) The provisions of Articles 77, paragraphs (3) through (5) (Transfer), Article 97, paragraph (2) (Waiver), and Article 98, paragraph (1), item (ii), and paragraph (2) (Effect of Registration) of the Patent Act apply *mutatis mutandis* to exclusive licenses.