Part VI Prior Application

61 Relevant provisions

Design Act

Article 9 (1) Where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration on the earliest date shall be entitled to obtain a design registration for the design.

(2) Where two or more applications for design registration have been filed for identical or similar designs on the same date, only one applicant, who was selected by consultations between the applicants who filed the said applications, shall be entitled to obtain a design registration for the design. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a design registration for the design.

(3) Where an application for design registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that an application for design registration is to be refused has become final and binding, the application for design registration shall, for the purpose of the preceding two paragraphs, be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the application for design registration is to be refused has become final and binding on the basis that the latter sentence of the preceding paragraph is applicable to said application for design registration.

(4) The Commissioner of the Patent Office shall, in the case of paragraph (2), order the applicants to hold consultations as specified under paragraph (2) and to report the result thereof, designating an adequate time limit.

(5) Where no report under the preceding paragraph is submitted within the time limit designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) has been reached.

61.1 Provisions of Article 9 of the Design Act

The design registration system grants a right to monopoly for a creation of a new design for a specified period. Therefore, two or more rights should not be granted for a single creation.

For the purpose of eliminating such overlapping rights, Article 9 of the Design Act provides that, where two or more applications for design registration have been filed for identical or similar designs, only one applicant for design registration is entitled to obtain a design registration.
61.1.1 **Applications for design registration that are subject to application of the provision of Article 9(1) or (2) of the Design Act**

Application of the provision of Article 9(1) or (2) of the Design Act is determined with regard to two or more applications for design registration for whole designs or two or more applications for design registration for partial designs, in other words, for two or more applications for design registration for which the method of requesting design registration and the subject matter for which the design registration is requested are the same.

Therefore, for example, where an application for design registration for a partial design is filed first, and an application for design registration for a whole design is filed on a later date, or where such applications for design registration are filed on the same date, even if the classifications of articles stated in the column of “Article to the Design” of the application of the respective applications for design registration are the same, application of the provision of Article 9(1) or (2) of the Design Act will not be determined with regard to the application for design registration for a whole design and the application for design registration for a partial design in either case.

61.1.2 **Categories of applications for design registration that are treated as prior applications**

An application for design registration that falls under either of the following is treated as a prior application for design registration with regard to application of the provision of Article 9(1) of the Design Act.

(1) An application for design registration for which establishment of a design right has been registered
(2) An application for design registration for which the examiner's decision or trial decision to the effect that the application is to be refused has become final and binding on the basis that no agreement was reached by consultations under Article 9(2) of the Design Act or such consultations were unable to be held for identical or similar designs for which applications were filed on the same date

61.1.3 **Categories of applications for design registration that are not treated as prior applications or applications filed on the same date**

An application for design registration that falls under any of the following (1) to (4) is deemed never to have been filed with regard to application of the provisions of Article 9(1) and (2) of the Design Act.

(1) A waived application for design registration
(2) A withdrawn application for design registration
(3) A dismissed application for design registration
(4) An application for design registration for which the examiner’s decision or trial decision to the effect that the application is to be refused has become final and binding

(Note)
This includes an application for design registration which was deemed to have been withdrawn under the provision of Article 60-14(1) of the Design Act, that is, an international application for design registration whose basic international registration extinguished because the international registration was waived under the provision of Article 16(1)(iv) of the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs or limited under the provision of Article (1)(v) of the same Article or the international registration was not renewed under the provision of Article 17(2) of the same Agreement (limited to cases where establishment for a design right for said international application for design registration has not been registered).

61.1.4 Determination of similarity between a whole design and a whole design

With regard to determination of similarity between two or more whole designs under Article 9(1) or (2) of the Design Act, the determination of similarity between a publicly known design and a whole design applies, so see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.3.1 “Determination of similarity between designs.”

When applying the provision of Article 9(1) or (2) of the Design Act to an application for design registration for a whole design, determination will be made as to whether the designs described in the statements in the respective applications and drawings, etc. attached to the applications are identical or similar.

Therefore, even where a certain design can be specifically identified within another design, determination will not be made on whether that design and part of the other design are identical or similar, as in the case of a design described in a publication as set forth in Article 3(1)(ii) of the Design Act (see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.2.6 “Design described in a publication,” (1) “Examples of designs that can be used as information that serves as the basis for determination of novelty,” (ii)).
61.1.5 Applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, only the applicant for design registration who filed the application for design registration on the earliest date is entitled to obtain a design registration for the design under the provision of Article 9(1) of the Design Act, regardless of whether the two or more applications for design registration were filed by the same person or by different persons.

61.1.6 Applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, only the applicant for design registration who filed the application for design registration on the earliest date is entitled to obtain a design registration for the design under the provision of Article 9(1) of the Design Act.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, a design registration may be obtained for a design selected from the applicant's own designs for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the "principal design") and its related design, only if the case falls under the provision of Article 10(1) of the Design Act. However, even with regard to a related design whose principal design is the design in the earliest application, where there is a similar registered design pertaining to an earlier application other than the principal design and its related designs, a design registration may not be obtained under Article 9(1) of the Design Act (because not all of the reasons for refusal under Article 9(1) of the Design Act based on these similar designs can be remedied under Article 10(1) of the Design Act simultaneously).
61.1.7 Applications for design registration filed for identical designs on the same date

Where two or more applications for design registration have been filed for identical designs on the same date, the two or more applications for registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and only one applicant for design registration, selected in the consultations, is entitled to obtain a design registration for the design, regardless of whether they are applications for design registration filed by the same person or by different persons.

61.1.8 Applications for design registration filed for similar designs on the same date

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and only one applicant for design registration, selected in the consultations, is entitled to obtain a design registration for the design.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and except for only one applicant for design registration, selected in the consultations, others are not entitled to obtain a design registration for the design; however, where the applications for design registration are filed by the same person, a design registration for the principal design and its related design may be obtained only where the case falls under the provision of Article 10(1) of the Design Act.
61.1.9 Handling of applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, one design in the earliest application is to be registered and designs in later applications are to be refused under Article 9(1) of the Design Act for that reason, regardless of whether they are applications for design registration filed by the same person or by different persons. Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

61.1.10 Handling of applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, the design in the earliest application that has no reason for refusal is to be registered and designs in later applications are to be refused under Article 9(1) of the Design Act for that reason. Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, the design in the earliest application that has no reason for refusal is to be registered. The designs in later applications are to be registered if the applications are filed before the date of publication of the Design Bulletin for the earliest application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the
Part VI Prior Application

application and drawings, etc. attached to the application were published) and they are applications for related designs whose principal design is the design in the earliest application. However, where the design in a later application is similar to two or more registered designs in earlier applications, and if these include registered designs that are not the principal design and its related designs, the later application is refused by giving a notice mentioning these multiple applications for design registration as the reason for refusal under Article 9(1) of the Design Act.

Where a later application is filed before the date of publication of the Design Bulletin for the earliest application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published), but it is not an application for design registration for a related design, a notice mentioning the earliest application as the reason for refusal under Article 9(1) of the Design Act is given; if the design in the later application is amended into a related design whose principal design is the design in the earliest application, the design in the later application is registered.

An application for design registration that is filed on the same day as the date of publication of the Design Bulletin for the earliest application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published) is to be refused under Article 9(1) of the Design Act. (However, if the later application is filed on the same day as the date of publication, but it is obvious that the application for design registration was filed before the publication of the Design Bulletin, the application for design registration is to be refused under Article 3(1) of the Design Act.)

Where the earlier application is an application for design registration for which the examiner’s decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

61.1.11 Handling of applications for design registration filed for identical or similar designs on the same date

(1) Where the applications for design registration are filed by different
persons

(i) An order is given in the name of the Commissioner to the respective applicants for design registration to hold consultations under Article 9(4) of the Design Act.

(ii) Where a report on the results of consultations is submitted within the designated time limit, an examiner’s decision to the effect that a design registration is to be granted is rendered only for the application for design registration filed by one applicant for design registration that was selected in the consultations. However, even where such report is submitted, if the procedure for withdrawal or waiver is not taken for the applications for design registration other than the application for design registration filed by the one applicant for design registration selected in the consultations, or if the contents of reports of the results of consultations held in response to multiple orders for consultations are inconsistent, it is found that no agreement was reached by consultations, and a notice of the reason for refusal under the second sentence of Article 9(2) of the Design Act is given to the respective applicants for design registration.

(iii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by the consultations under Article 9(5) of the Design Act, and a notice of the reason for refusal under the second sentence of Article 9(2) of the Design Act is given to the respective applicants for design registration.

(2) Where the applications for design registration are filed by the same person

(i) An order is given in the name of the Commissioner to the applicant for design registration to hold consultations under Article 9(4) of the Design Act. However, at the same time as giving such order in the name of the Commissioner, a notice of the reason for refusal based on the second sentence of Article 9(2) of the Design Act is given. The reason for such practice is that it is found that only a short time for consultations is needed where the applicant is the same person.

(ii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by the consultations under Article 9(5) of the Design Act, or where a report on the results of consultations is submitted within the designated time limit but the applications for design registration other than the application for design registration filed by one applicant for design registration selected in the consultations are not withdrawn or...
waived or if the contents of reports of the results of consultations held in response to multiple orders for consultations are inconsistent, it is found that no agreement was reached by consultations, and an examiner’s decision is given to the effect that the applications for design registration are to be refused based on the reason for refusal under the second sentence of Article 9(2) of the Design Act of which notice had been given in advance.

61.1.11.1 Examples of cases where the contents of reports of the results of consultations held in response to multiple orders for consultations are found to be inconsistent

(1) Case of a report selecting one of the applicants for design registration subject to consultations, for which no agreement is found to have been reached
   (i) A report whereby both applicants select themselves
   (ii) A report whereby both applicants select each other

(2) Case of a report specifying the design in one of the applications for design registration subject to consultations as a principal design and the designs in the other applications for design registration as its related designs, for which no agreement is found to have been reached
   (i) A report selecting a design that does not exist as a principal design
   (ii) A report selecting a not similar design, a design in an application for design registration filed on a different date, or a design in an application for design registration filed by a different applicant for design registration as a principal design
   (iii) A report selecting a design in an application for design registration for a related design as a principal design
   (iv) A report selecting multiple designs as a principal design

61.1.11.2 Handling of the case where no report is submitted in response to an order for consultations and procedures for withdrawal or waiver are taken only for one or some of the applications for design registration

With regard to applications for design registration that are filed for identical or similar designs by the same person on the same date, an order for consultations is issued for each such application for design
registration, and a report on the results of consultations are required to be submitted for each application for design registration, in principle.

Even if procedures for withdrawal, waiver or amendment are taken only for one or some of the applications for design registration subject to consultations, it cannot be immediately deemed that an agreement has been reached by consultations, but it is necessary to wait for the procedures compliant with the gist of the order for consultations to be taken for all of the applications for design registration subject to consultations, until the expiration of the designated time limit, while treating them as applications for which a report on the results of consultations has yet to be submitted.

Where no report on the results of consultations is submitted by the designated time limit, it can be deemed that no agreement was reached by consultations under Article 9(5) of the Design Act; however, if an amendment has been made to make the design in an application for design registration subject to consultations a principal design or its related design within the designated time limit or if either of the applications for design registration subject to consultations has already been withdrawn or waived, the reason for consultations has been resolved by the amendment or the procedure of withdrawal or waiver, so it is not deemed that no agreement was reached by consultations.

61.1.12 Reference date for determination on application of the provision of Article 9(1) or (2) of the Design Act with regard to 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(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(1) or (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 the procedures are conducted legitimately, such application for design registration is deemed to have been filed at the time of filing the original application or at the time of submitting the written amendment of proceedings.

However, since determination on application of the provision of Article 9(1) or (2) of the Design Act is made on the basis of the day of the filing the
application for design registration, with regard to the new application for
design registration resulting from division, that resulting from conversion, or
that for an amended design for which a ruling dismissing an amendment has
been made, 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 the determination.

61.1.13 Reference date for determination on application of the provision of
Article 9(1) or (2) of the Design Act with regard to an application for
design registration containing a priority claim under the Paris
Convention, etc.

When applying the provision of Article 9(1) or (2) of the Design Act, where
the claim is legitimate, the filing date of the first application will be the
reference date for the determination.

61.1.14 Reference date for determination on application of the provision of
Article 9(1) or (2) of the Design Act with regard to an international
application for design registration

Where applying the provision of Article 9(1) or (2) 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(1) of the
Design Act will be the reference date for the determination (this excludes
cases where a priority claim under the Paris Convention, etc. is legitimate).