

Chapter II Dismissal of Amendments

1. Outline

Dismissal of an amendment under Article 17-2 of the Design Act refers to dismissal of an amendment by a ruling by the examiner where the case is pending in examination, trial or retrial and an amendment that has been made to the statement in the application or any drawings, etc. attached to the application changes the gist thereof.

2. Basic concept in dismissing amendments

Since an amendment has the effect of the documents, etc. being treated as having been submitted in the amended state when originally filed, if the contents that were described when originally filed could be freely amended, it would run contrary to the purport of the first-to-file system and would give unexpected disadvantage to third parties. It would also make it difficult for the examiner to conduct a prompt examination. For this reason, amendments to a statement in the application or drawings, etc. are limited to the extent that they do not change the gist of design, and any amendment that does change the gist shall be dismissed by a ruling by the examiner.

3. Gist of design

3.1 Gist of design

The statement in the application and drawings, etc. attached to the application represent the contents of the design filed as an aesthetic creation, which serves as the basis for specifying the scope of the registered design. On such grounds, 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 is called the gist of design.

3.2 Finding of the gist of design

The process of directly deriving the gist of design from the statement in the application and drawings, etc. attached to the application based on the ordinary skill in the art of the design is called the finding of the gist of design.

4. Change of the gist of design

4.1 Categories of amendments that change the gist

Where an amendment made to the statement in the application or 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.

4.1.1 Where the amendment is found to make a change exceeding the scope identical to that which can be inevitably derived based on the ordinary skill in the art of the design

If 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, from the statement in the application and drawings, etc. attached to the application as originally filed were allowed, it would run contrary to the purport of the first-to-file system and would give unexpected disadvantage to third parties. On these grounds, the examiner should determine that such amendment changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

Meanwhile, identical scope refers to identical scope with regard to the gist of design, and does not include the concept of similarity.

4.1.2 Where the amendment is found to clarify the gist of design that was unclear when originally filed

If an amendment to make subject matter that is not categorized as an industrially applicable design as provided in the main paragraph of Article 3, paragraph (1) of the Design Act, and whose gist of design cannot be identified even by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application as originally filed, into an industrially applicable design were allowed, that is, if an amendment that clarifies the gist of design that was unclear when originally filed were allowed, it would run contrary to the purport of the first-to-file system and would give unexpected disadvantage to third parties. On these grounds and as above, the examiner should determine that such amendment also changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

4.1.3 Where change is made to the scope for which the design registration is requested

The examiner should determine that an amendment made to change the scope which was not disclosed in the statement in the application and drawings, etc. attached to the application as originally filed, to the scope for which the design registration is requested, that is, an amendment to change the scope for which the design registration is requested, changes the gist of design.

(However, this excludes the case of an amendment to state that views are omitted since they are identical to or mirror images of other views.)

Where it is suggested by the statement in the application and drawings, etc. attached to the application as originally filed that a certain scope is the scope for which the design registration is requested, and the shape is also indicated, the examiner should determine that adding such scope by making an amendment does not change the gist of design.

4.2 Categories of amendments that do not change the gist

In making determination through comparison of the design as originally filed and the design as amended, if the amendment falls under any of the following upon making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application, the examiner should determine

that the amendment does not change the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

4.2.1 Where a correction is made within the scope identical to that which can be inevitably derived based on the ordinary skill in the art of the design

Even where the statement in the application or drawings, etc. attached to the application as originally filed contains an improper description, such as an error or ambiguous statement, if it is clear by making comprehensive determination that the improper description has arisen from an error or mishandling in preparing, or from restrictions in constructing the application or drawings attached to the application, and if a proper description can be inevitably and directly derived based on the ordinary skill in the art of the design, the examiner should determine that an amendment to correct it into a proper description does not change the gist of the statement in the application or drawings, etc. attached to the application as originally filed (see 3.1 “Requirement for the design to be specific” in Part III, Chapter I “Industrially Applicable Design”).

4.2.2 Where correcting an improper description of a part that is minor enough to not affect the finding of the gist of design into a proper description

Even where the statement in the application or drawings, etc. attached to the application as originally filed contains an improper description, such as an error or ambiguous statement, and it is not possible to determine the correct contents by making a comprehensive determination, if the improper description is found to be an improper description of a part that is minor enough to not affect the finding of the gist of design, the examiner should determine that an amendment to correct it into a proper description does not change the gist of the statement in the application or drawings, etc. attached to the application as originally filed (see 3.1 “Requirement for the design to be specific” in Part III, Chapter I “Industrially Applicable Design”).