

Part VII Advantage of the Priority under the Paris Convention

1. Outline

The priority under the Paris Convention means that, if a person, who has filed an application for design registration in any of the countries of the Union of the Paris Convention (the first country), files an application for design registration in another country of the Union of the Paris Convention (the second country) with respect to the contents described in the application documents of the application in the first country, the application for design registration in the second country shall be treated as if it had been filed on the filing date of the first application in the first country (hereinafter referred to as the “priority date” in this Part) for the purpose of determining novelty, creative difficulty, etc.

In Japan, nationals of a member of the World Trade Organization and nationals of countries designated by the Commissioner of the Patent Office as allowing declarations of priority under the same conditions as in Japan are also allowed to claim priority under the Paris Convention (priority recognized under the Paris Convention).

2. Requirements, etc. of priority claim under the Paris Convention

The requirements of priority claim under the Paris Convention are as follows.

- (1) Person entitled to claim priority under the Paris Convention (→ see 2.1)
The person is the national of a country of the Union of the Paris Convention who has regularly filed an application in a country of the Union of the Paris Convention or who is his/her successor
- (2) Period for filing an application in Japan with a priority claim under the Paris Convention (→ see 2.2)
The application for design registration in Japan has been filed within six months from the filing date of the first application in the first country
- (3) Applications capable of serving as a basis for priority claim under the Paris Convention (→ see 2.3)
 - (i) The application is a regularly filed application in the first country
 - (ii) The application is the first application filed in the first country
 - (iii) The application is an application for design registration, an application for utility model registration, or a patent application

The following procedure must also be followed in claiming priority.

- (4) Procedure for priority claim under the Paris Convention
Declaration of a priority must be made at the same time as filing an application for design registration in Japan, and a priority certificate must be submitted within three months from the filing date of the application (→ see 2.4)

In addition to the above, the following requirement must be complied with in order for the priority claim to be effective.

(5) Approval or disapproval of the effects of priority claim under the Paris Convention (→ see 4. “Identicalness of design in approval or disapproval of the effects of priority claim”)

The design filed in Japan is identical to the design in the application on which the priority claim is based

Furthermore, regarding priority recognized under the Paris Convention as provided in Article 43-3 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act, see 2.5 “Priority recognized under the Paris Convention as provided in Article 43-3 of the Patent Act” in this Part.

2.1 Person entitled to claim priority under the Paris Convention

A person entitled to claim priority under the Paris Convention shall be a national of a country of the Union of the Paris Convention (Note) who regularly filed an application in the first country or who is his/her successor (Article 2 of the Paris Convention, Article 3 of the Paris Convention, Article 4A, paragraph (1) of the Paris Convention).

(Note) Including a person who is deemed to be a national of a country of the Union of the Paris Convention in accordance with Article 3 of the Paris Convention.

2.2 Period for filing an application in Japan with a priority claim under the Paris Convention

The period for filing an application for design registration in Japan with a priority claim under the Paris Convention (the priority period) shall be six months from the initial filing date in the first country. Similarly, in the case of an application for design registration for which the priority claim is based on an application for utility model registration or patent application, the priority period shall be six months (Article 4C, paragraph (1) and Article 4E, paragraph (1) of the Paris Convention).

However, where it has not been possible to file an application for design registration with a priority claim within the priority period (within six months from the initial filing date in the first country), if there are reasonable grounds for having been unable to file the application for design registration, and if the application for design registration is filed within the time limit provided by an Ordinance of Ministry of the Economy, Trade and Industry, a right of priority may be claimed for the application for design registration even after the priority period has lapsed.

2.3 Applications capable of serving as a basis for priority claim under the Paris Convention

The application on which a priority claim under the Paris Convention is based must comply with all of the requirements from 2.3.1 to 2.3.3 below.

2.3.1 The application is a regularly filed application in the first country

The application in the first country that serves as the basis for the right of priority must be an application that was regularly filed in a country of the Union of the Paris Convention (including an international application based on the Geneva Act (Note)) (Article 4A, paragraph (1) through (3), Article 4C, paragraph (4), and Article 4D of the Paris Convention, and Article 6, paragraph (2) of the Geneva Act).

(Note) With regard to the “Geneva Act” and “international applications,” see Part IX “International Application for Design Registration”; the same applies hereinafter.

2.3.2 The application is the first application filed in the first country

Only the first application in a country of the Union of the Paris Convention can serve as the basis for a priority claim under the Paris Convention (Article 4C, paragraph (2) and (4), and Article 4D, paragraph (1) of the Paris Convention). This is because the priority period would be substantively extended if the effect of the priority claim were recognized again based on subsequent applications (i.e., cumulatively) for the design disclosed in the first application.

2.3.3 The application is an application for design registration, an application for utility model registration, or a patent application filed in the first country

The application for design registration, application for utility model registration, or patent application that was filed in the first country can serve as the basis for a priority claim under the Paris Convention.

Note that, while the Paris Convention provides that an application for design registration may be filed claiming priority based on an application for utility model registration (Article 4E, paragraph (1) of the Paris Convention), it does not include provisions on whether an application for design registration can be filed claiming priority based on a patent application or an application for trademark registration. The effect of such priority claim not provided for in the Paris Convention should be determined as below, based on whether or not it is possible to convert applications between such legal domains in Japan.

- (1) Where the application that serves as the basis for the right of priority is an application for utility model registration

Under Article 4E of the Paris Convention, an application for design registration may be filed claiming priority based on an application for utility model registration.

- (2) Where the application that serves as the basis for the right of priority is a patent application

In Japan, it is possible to convert an application between the legal domains of the Patent Act and the Design Act. Therefore, where an application for design registration has been filed by claiming priority based on a patent application, the effect of priority claim will be recognized as long as a design identical to the design in the application for design registration filed in Japan is indicated in the priority certificate.

- (3) Where the application that serves as the basis for the right of priority is an application for trademark registration

In Japan, conversion of an application from an application for trademark registration into an application for design registration is not allowed. Therefore, where an application for design registration has been filed by claiming priority based on an application for trademark registration, the effect of priority claim will not be recognized. Also, the effect of priority claim will not be recognized even if the application for trademark registration filed in the first country that serves as the basis for the right of priority is a three-dimensional trademark.

2.4 Procedure for priority claim under the Paris Convention

When making a priority claim under the Paris Convention, at the time of filing of the application for design registration, a right of priority must be declared based on the first application in the first country. Furthermore, a priority certificate must be submitted within three months from the filing date (Article 43, paragraph (1) through (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act following the deemed replacement of terms) (With regard to international applications based on the Geneva Act of the Hague Agreement, see 3. “Procedures for claiming right of priority under the Paris Convention” in Part IX, Chapter VIII “Right of Priority under the Paris Convention in International Applications for Design Registration”).

Furthermore, where making a priority claim based on an application for design registration in a country or region where the electronic exchange of priority documents is available utilizing the World Intellectual Property Organization’s Digital Access Service (DAS), instead of submitting a priority certificate, the access code, etc. may be stated on the application, or it may be supplemented using a written amendment of proceedings.

Where a priority certificate is not submitted within the prescribed period, the Japan Patent Office will send notice that the priority certificate has not been submitted. The applicant may submit the priority certificate within a period of 2 months from receipt of this notice. Furthermore, during this period, where the applicant is unable to submit the priority certificate for reasons not attributable to the applicant, the applicant may submit the priority certificate within the following periods according to the reason.

(1) Where the non-submission is due to an administrative delay related to issuance of the priority certificate by the government that should issue it, 1 month from acquisition of the priority certificate (or 2 months in the case of an overseas resident)

(2) For reasons other than (1) above, the sooner of (i) 14 days from the date on which the reason for being unable to submit the priority certificate was no longer valid (or 2 months in the case of an overseas resident) and (ii) 6 months from 2 months after the date on which notice that the priority certificate has not been submitted was received (total 8 months from the date on which the notice was received)

2.5 Priority recognized under the Paris Convention as provided in Article 43-3 of the Patent Act

In Japan, not only nationals of a country of the Union of the Paris Convention, but also nationals of a member of the World Trade Organization and nationals of a country that is neither a country of the Union of the Paris Convention nor a member of the World Trade Organization (limited to a country that allows Japanese nationals to declare priority under the same conditions as in Japan, and that is designated by the Commissioner of the Patent Office) may make a priority claim recognized under the Paris Convention, under Article 43-3 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act, and the effect of such priority claim is the same as that of a priority claim under the Paris Convention.

<Priority claims recognized under the Paris Convention in accordance with the provisions of Article 43-3 of the Patent Act>

- (1) Rights of priority based on an application filed by a Japanese national or a national of a country of the Union of the Paris Convention (including nationals deemed to be nationals of a country of the Union in accordance with Article 3 of the Paris Convention) in a member of the World Trade Organization (WTO) (Article 43-3, paragraph (1) of the Patent Act)
- (2) Rights of priority based on an application filed by a national of a member of the WTO in a country of the Union of the Paris Convention or a member of the WTO (Article 43-3, paragraph (1) of the Patent Act)
- (3) Rights of priority based on an application filed in a country that is neither a country of the Union of the Paris Convention nor a member of the WTO, allows Japanese nationals to declare a priority under the same conditions as in Japan, and is designated by the Commissioner of the Patent Office (hereinafter, such a country is referred to as a “specified country” in this Chapter) by a national of the specified country (Article 43-3, paragraph (2) of the Patent Act)
- (4) Rights of priority based on an application filed in a specified country by a Japanese national, a national of a country of the Union of the Paris Convention or a national of a member of the WTO (Article 43-3, paragraph (2) of the Patent Act)

These applications with a claim of priority are treated in the same way as for a Japanese application with a priority claim under the Paris Convention, and their effect is the same as for a priority claim under the Paris Convention.

3. Effects of priority claim under the Paris Convention

With regard to the effect of priority claim under the Paris Convention, Article 4B of the Paris Convention provides that any subsequent application shall not be invalidated by reason of another application being filed or a fact becoming publicly known in the interval between the filing date of the first application in a country of the Union of the Paris Convention and the filing date of a subsequent application with a priority claim in another country of the Union of the Paris Convention.

Therefore, in applying this provision in the substantive examination of (i) to (v) below of the Design Act, where the effect of the priority claim is recognized, the examiner should treat the priority date as the date on which the determination is based (hereinafter referred to as the “reference date” in this Chapter).

- (i) Novelty (Article 3, paragraph (1) of the Design Act)
- (ii) Creative difficulty (Article 3, paragraph (2) of the Design Act)
- (iii) Identical or similar to part of a design in a prior application (Article 3-2 of the Design Act)
- (iv) Prior application (Article 9 of the Design Act)
- (v) Related design (Article 10 of the Design Act)

4. Identicalness of design in approval or disapproval of the effects of priority claim

4.1 Basic concept of “identicalness of design” in approval or disapproval of the effects of priority claim

The examiner should recognize the effect of a claim, such as a right of priority under the Paris Convention, only where the examiner determines that the design in the application for design registration filed in Japan is identical to the design in the first application in the first country (hereinafter referred to as the “application filed in the first country”). The basic concept of “identicalness of design” in determining this is as follows.

- (1) It is sufficient for the design in the application filed in the first country and the design in the application for design registration filed in Japan to be identical designs, regardless of the style of representation of the design.
- (2) Whether or not the design in the application filed in the first country and the design in the application for design registration filed in Japan are identical designs should be determined by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, based on the ordinary skill in the art of the design.
- (3) The finding of the design in the application filed in the first country (the article, etc. to the design, the shapes, patterns and colors of the article, etc., the position, size and scope of the part for which the design registration is requested in the entire design, etc.) should be made by also taking into consideration the laws and regulations, etc. of the first country.

4.2 Statements in the column of “Article to the Design”

In order for the design in an application for design registration filed in Japan to be found to be identical to the design in an application filed in the first country, in principle, the articles, etc. to the design of the two designs must be identical.

However, since the items described in an application and the method of description differ among countries, even if, for example, the statement in the column of “Article to the Design” in the application for design registration filed in Japan differs from the name of the article, etc. to the design of the design in the application filed in the first country, rather than determining whether the two designs are identical based on these statements alone, the examiner should determine whether the articles, etc. to the design of the two designs are identical by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application for design registration filed in Japan and the statement in the application and drawings, etc. attached to the application in the application filed in the first country.

In making this determination, the examiner should also take into consideration differences in the laws and regulations, etc. of the respective countries.

[Example where two designs are found to be similar or identical]

[Case example] Where the name of the article to the design of the design in the application filed in the first country is a generic name, and a statement is included in the column of "Article to the Design" in the application for design registration filed in Japan clarifying the specific usage and function

Application filed in the first country: The name of the article to the design, etc. is "bottle" and the drawings contain the shape, etc. of a general PET bottle for beverages.

Application filed in Japan: The article to the design is stated as a "packaging container." The shape, etc. of the design represented in the drawings is identical to that in the application filed in the first country.

(Explanation) Where the name of the article to the design of the design in the application filed in the first country is a generic name, and one article from among the multiple articles that are derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, is stated in the application for design registration filed in Japan, the two designs should be found to be similar or identical in the approval or disapproval of priority.

[Example where two designs are found to be similar or identical]

[Case example] Where the design in the application filed in the first country is a design including a graphic image and the name of the article to the design, etc. is filed as “screen panel,” and the design in the application for design registration filed in Japan was filed as graphic image design

Application filed in the first country: The name of the article to the design, etc. is “screen panel,” and the drawings do not show the specific article, etc. for displaying graphic images, only the graphic image for displaying the time.

Application filed in Japan: “Graphic image for displaying the time” is stated in the column of “Article to the Design,” and the graphic image represented in the drawings is identical to that in the application filed in the first country.

(Explanation) The method of protecting designs including a graphic image differ in each country. Even if the design in the application filed in the first country relates to “screen panels” and the design in the application for design registration filed in Japan is a “graphic image design,” since the “screen panel” itself has no other conceivable specific usages and functions other than for realizing graphic images, if the overall shape, etc. of the two designs shown in the drawings is identical, the two designs should be found to be similar or identical in the approval or disapproval of priority.

4.3 Number of designs included in one application

In foreign countries, there are various rules of procedure on the number of designs that can be included in one application and how they should be represented, but as in the examples below for instance, where an application is deemed to have been filed for each design that can be found from the statement in the application and drawings, etc. attached to the application in the application filed in the first country based on the design system in Japan, even if the number of designs included in one application is different, the examiner should determine that the two designs are identical in the approval or disapproval of priority.

<Examples where designs are determined to identical in approval or disapproval of priority>

- (1) Where multiple designs are described in the statement in the application and drawings, etc. attached to the application in the application filed in the first country, and one of these designs is specified as the design in the application for design registration filed in Japan
- (2) Where multiple designs are described in the statement in the application and drawings, etc. attached to the application in the application filed in the first country, and all or part of their constituent articles are specified as the design in the application for design registration filed in Japan as a design for a set of articles (a set of articles listed in Appended Table as designated by the Ordinance of the

Ministry of Economy, Trade and Industry as provided in Article 8 of the Design Act)

- (3) Where, despite the shape, etc. of the article, etc. or the graphic image being changeable based on the function possessed by that article, etc., laws and regulations, etc. in the first country mean that the shape, etc. of the article, etc. or the graphic image as it appears before, during, and after the change cannot be included in a single application, and consequently multiple separate applications must be filed for the shape, etc. or graphic image of the same design as it appears before, during, and after the change, and where priority is claimed on the basis of these multiple applications, and the shape, etc. or graphic image as it appears before, during, and after the change is included in a single application for design registration filed in Japan

[Example where two designs are found to be similar or identical]

[Case example] Where a shape, etc. or graphic image as it appears before, during, and after the change is included in a single application for design registration filed in Japan, based on multiple separate applications having been filed in the first country due to laws and regulations, etc. there not permitting the shape, etc. or graphic image as it appears before, during, and after the change to be included in a single application

Application A filed in the first country: Design of a radio receiver showing only the shape, etc. when the antenna is retracted

Application B filed in the first country: Design of a radio receiver showing only the shape, etc. when the antenna is extended

Application filed in Japan: Design filed as a single application for design registration that includes the shape, etc. before the change as represented in Application A filed in the first country and the shape, etc. after the change as represented in Application B filed in the first country

(Explanation) Where the shape, etc. represented in the drawings, etc. of Application A filed in the first country and the shape, etc. represented in the drawings, etc. of Application B filed in the first country are both clearly the shape, etc. or graphic image of the same design as it appears before, during, and after the change, the designs in the applications filed in the first country and the design filed in Japan should be found to be similar or identical.

On the other hand, in the following cases for example, the examiner should determine that the two designs are not identical in the approval or disapproval of priority.

<Examples where designs are determined not to be identical in approval or disapproval of priority>

- (1) Where a design filed in the first country and a design not filed in the first country are, together, specified as the design in the application for design registration filed in Japan as a design for a set of articles

- (2) Where a design that combines designs based on multiple priority claims is specified as the design in an application for design registration filed in Japan

[Example where two designs are not found to be similar or identical]

[Case example] Where a design that combines designs based on multiple priority claims is specified as the design in an application for design registration filed in Japan

Application A filed in the first country: Design of the cap of a ballpoint pen

Application B filed in the first country: Design of the main body of a ballpoint pen

Application filed in Japan: Design of a ballpoint pen (cap +main body), combining Application A filed in the first country and Application B filed in the first country

(Explanation) The design in the application for design registration filed in Japan cannot be derived directly from the designs in the applications filed in the first country. Furthermore, given it is possible to file individual applications for design registration in Japan for each of the designs in the applications filed in the first country, where a design combining these designs in the multiple applications filed in the first country is specified as the design in the application for design registration filed in Japan, the examiner should not determine them to be identical.

4.4 Combination or separation of parts constituting a design

Where the design in an application filed in the first country is found to be one design in light of the provision of Article 7 of the Japanese Design Act, if an application for design registration is filed in Japan for the same unit of design as the said design, only then should the two designs be found to be similar or identical in the approval or disapproval of priority.

- (1) Where the design in an application for design registration filed in Japan is the design of a finished product combining the design of a component in an application filed in the first country and the design of another component that is not described in statement in the application and drawings, etc. attached to the application in the application filed in the first country, the two designs should not be found to be similar or identical designs.
- (2) Where the design in an application filed in the first country is the design of a finished product, and one of the components constituting that finished product is specified as the design in an application for design registration filed in Japan, the two designs should not be found to be similar or identical designs.

[Example where two designs are not found to be similar or identical]

[Case example] Where one of the components constituting a finished product is specified as the design in an application for design registration filed in Japan

Application filed in the first country: Design of a bicycle

Application filed in Japan: Design of a bicycle saddle

(Explanation) Since the application filed in the first country is one for which the design registration is requested for an entire bicycle, which is found to be one design under Article 7 of the Japanese Design Act, and is not found to be one for which the design registration is requested independently for a bicycle saddle constituting the bicycle, the two designs should not be found to be similar or identical.

- (3) Where the design in the application filed in the first country is a finished product combining multiple interchangeable components, and a combination that is not disclosed in the statement in the application and drawings, etc. attached to the application in the application filed in the first country is specified as the design in an application for design registration filed in Japan
- (i) Even after making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, where it is unclear whether design registration is being requested in the first country for a combination specified as the design in the application for design registration filed in Japan, the two designs are not found to be identical.
 - (ii) After making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, where it is found that design registration being requested in the first country includes a mode of combination specified as the design in the application for design registration filed in Japan, the two designs are found to be identical in the approval or disapproval of priority.

[Example where two designs are found to be similar or identical]

[Case example] Where the design in the application filed in the first country is a finished product combining multiple interchangeable components, and a combination that is not disclosed in the statement in the application and drawings, etc. attached to the application in the application filed in the first country is specified as the design in an application for design registration filed in Japan

Application filed in the first country: Three designs of the main body of a ballpoint pen (A, B and C), three designs of the cap of a ballpoint pen (a, b and c), and one design of a ballpoint pen with a cap (A + a) are described. In addition, the application contains a statement to the effect that the subject matter is not limited to one design of a ballpoint pen with a cap (A + a), but that the combinations of the main body of a ballpoint pen and the cap of a ballpoint pen can be changed.*

Application filed in Japan: Design of a ballpoint pen with a cap (A + b)

(Explanation) A total of seven designs are illustrated in the application filed in the first country: three designs of the main body of a ballpoint pen (A, B and C), three designs of the cap of a ballpoint pen (a, b and c), and one design of a ballpoint pen with a cap (A + a).

However, by making comprehensive determination based on the statement in the application, the design of a ballpoint pen with a cap (A + a) has been shown as an example, and the application filed in the first country is found to be an application requesting registration for nine designs with regard to designs of a ballpoint pen with a cap, including a design of a combination that has not been illustrated (A + b).

* Even after making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, where it is unclear whether design registration is being requested in the first country for the combination specified as the design in the application for design registration filed in Japan—such as where the design of a ballpoint pen with a cap (A + a) is not described in the first application, or where it is not clear whether the combinations of the main body of a ballpoint pen and the cap of a ballpoint pen can be changed—the two designs should not be found to be similar or identical.

4.5 Where the shape, etc. of the entire article, etc. is not represented in the drawings, etc. of the application filed in the first country

Where the shape, etc. of the entire article, etc. is not represented in the drawings, etc. in the application filed in the first country, the examiner should treat each case as follows.

- (1) Where only the shape, etc. of a part of an article, etc. is represented in the statement in the application and drawings, etc. attached to the application in the application filed in the first country, whereas the design in the application for design registration filed in Japan is one requesting design registration for the

shape, etc. of the entire article, etc., the examiner should not determine the two designs to be identical designs.

(2) Where only the shape, etc. of a part of an article, etc. is represented in the drawings of the application filed in the first country, whereas the application filed in Japan specifies the said part is the part for which the design registration is requested and includes “other parts” in addition:

(i) Regarding the design represented in the statement in the application and drawings, etc. attached to the application in the application filed in the first country, where it is not possible to derive the position, size, and scope of the part whose shape, etc. is represented, in the entire article, etc., even after making a comprehensive determination based on other statements in the application filed in the first country and on the characteristics of the article, etc., the examiner should not determine that this design is identical to the design in the application for design registration filed in Japan.

[Example where two designs are not found to be similar or identical]

[Case example] Where the position, size, and scope of the part for which the design registration is requested cannot be derived even by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country

Application filed in the first country: The name of the article to the design, etc. is “Package” and the drawings only depict a pattern.

Application filed in Japan: The article to the design is a “Packaging box” and the design for which the design registration is requested is for the pattern part represented on a part of the packaging box.

(Explanation) Where the drawings of the application filed in the first country only depict a pattern, even if the name of the article to which the pattern is to be applied has been described, since the position, size, and scope of the pattern in the entire article cannot be derived from statements such as those in the application and drawings, etc. attached to the application in the application filed in the first country, the examiner should not determine the two designs to be identical designs.

(ii) Regarding the design in the application filed in the first country, where it is possible to derive the position, size, and scope of the part whose shape, etc. is represented, in the entire article, etc., by making a comprehensive determination based on other statements in the application filed in the first country and on the characteristics of the article, etc., and where this is consistent with the position, size, and scope of the part for which the design registration is requested in the application for design registration filed in Japan, the examiner should determine that the two designs are identical.

[Example where two designs are found to be similar or identical]

[Case example] Where parts that were not represented in the application filed in the first country are specified as “parts other than the part for which the design registration is requested”

Application filed in the first country: Design of a foldable mobile phone for which only drawings representing the shape, etc. of the folded state are described, and the shape, etc. hidden in the unfolded state is not described.

Application filed in Japan: An application for which the inside in the unfolded state is represented by broken lines and which specifies the part that is visible in the folded state as the “part for which the design registration is requested”

(Explanation) By making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, given the application filed in the first country is one for which the design registration is requested for only the part of the mobile phone that is visible in the folded state, and that the position, size, and scope of the part that is visible in the folded state in the entire mobile phone is clear, the examiner should determine that the design described in the priority certificate and the design in the application for design registration filed in Japan are identical.

4.6 Where the constituent elements of the designs differ

In order for a design filed in Japan to be found to be identical to the design in an application filed in the first country, the shape, patterns, and colors (hereinafter referred to as the “constituent elements of the design”) of the articles, etc. to the design of these two designs must be identical. If the constituent elements of the designs differ, the designs are regarded as different, and in principle, the effect of a priority claim cannot be found valid.

However, even where the constituent elements of the design represented in the drawings, etc. differ, if it is found, based on other statements in the application filed in the first country, etc., that design registration is not requested for constituent elements that are not included in the design in the application for design registration filed in Japan (for example, a color is appended in the drawings of the application filed in the first country, but it is stated in the description that no rights over the color are being claimed), or, even where the methods of expression, such as the drawing methods, of the designs differ, by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country, if it is found that it can be inevitably derived that protection is being sought for a design that is identical to the design described in the application for design registration filed in Japan, the two designs should be found to be similar or identical in the approval or disapproval of priority.

<Examples where the methods of expression differ between designs>

- (i) Where the design in the application filed in the first country and the design in the application for design registration filed in Japan are represented by different drawing methods
- (ii) Where the design in the application filed in the first country is represented by drawings (including computer graphics) and the design in the application for design registration filed in Japan is represented by photographs (monochrome or color), a specimen or a sample
- (iii) Where the design in the application filed in the first country is represented by photographs (monochrome or color), a specimen or a sample and the design in the application for design registration filed in Japan is represented by drawings (including computer graphics)

[Example where two designs are found to be similar or identical]

[Case example] Where the methods of expression differ but a design identical to the design described in the application for design registration filed in Japan can be inevitably derived by making a comprehensive determination based on the statement in the application and on drawings, etc. attached to the application in the application filed in the first country

Application filed in the first country: Design of a nail. It is represented by uncolored drawings, but the application contains a statement that it is made of iron.

Application filed in Japan: Design of a nail. It is represented by photographs, and it has the metallic luster and metallic color that would appear on a general nail made of iron.

(Explanation) Although the design described in the application filed in the first country has no pattern or color, by making comprehensive determination based on the statement in the application that it is made of iron, since it is possible to inevitably derive a design identical to the design of a nail having a metallic luster and metallic pattern which is represented by photographs attached to the application for design registration filed in Japan, the two designs should be found to be similar or identical in the approval or disapproval of priority.

[Example where two designs are found to be similar or identical]

[Case example] Where the design in the application filed in the first country is represented by two perspective views and the design in an application for design registration filed in Japan is represented by six views prepared by the orthographic projection method

Application filed in the first country: The design is represented by a perspective view showing the front, top and right side, and a perspective view showing the rear, bottom and left side.

Application filed in Japan: The design is represented by six views (a front view, rear view, left side view, right side view, top view and bottom view) prepared by the orthographic projection method. The shape, etc. represented by these six views is consistent with the contents that can be inevitably derived from the perspective views in the drawings of the application filed in the first country.

(Explanation) The drawings of the application filed in the first country are two perspective views showing the six sides, and since the contents that can be inevitably derived by making comprehensive determination based on these views and the design in the application filed in Japan are consistent, the mere difference is in the drawing method, so the two designs should be found to be similar or identical in the approval or disapproval of priority.

[Example where two designs are found to be similar or identical]

[Case example] Where the design in the application filed in the first country is represented by photographs and the design in an application for design registration filed in Japan is represented by drawings (colored drawings)

Application filed in the first country: The design is represented by photographs in color.

Application filed in Japan: The design is represented by drawings and they are colored using the same colors as those represented in the application filed in the first country.

(Explanation) Whereas the application filed in the first country uses photographs, since the application for design registration filed in Japan uses drawings, the methods of expression used in the designs are different. However, because the designs shown in each application are consistent, the two designs should be found to be similar or identical in the approval or disapproval of priority.