Chapter III Related Design

73 Relevant provisions

Design Act

Article 10 (1) Notwithstanding Article 9(1) or (2), an applicant for design registration may obtain design registration of a design that is similar to another design selected from the applicant's own designs either 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 a design similar to it is referred to as a "Related Design"), if the filing date of the application for design registration of the Related Design (or when the application for design registration of the Related Design contains a priority claim under Article 43(1), 43-3(1) or 43-3(2) of the Patent Act as applied mutatis mutandis under Article 15 of this Act, the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application under 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 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 under Article 4(A)2 of the Paris Convention, hereinafter the same shall apply in this paragraph) is on or after the filing date of the application for design registration of the Principal Design and before the date when the design bulletin in which the application for design registration of the Principal Design is published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) is issued.

(2) Where an exclusive license has been established for the design right of the Principal Design, a design registration shall not be granted to its Related Designs, notwithstanding the preceding paragraph.

(3) A design registration shall not be granted to a design that is similar only to a Related Design to be registered under paragraph (1).

(4) Where applications for design registration are filed for two or more Related Designs pertaining to the Principal Design, Article 9(1) or (2) shall not apply to these Related Designs.

Article 21 (1) The duration of a design right (excluding design right of a Related Design) shall expire after a period of 20 years from the date of registration of its establishment.

(2) The duration of a Related Design shall expire after a period of 20 years from the date when the establishment of the design right of its Principal Design is registered.

Article 22 (1) The design right of a Principal Design and that of its Related Design may
not be transferred independently of each other.

(2) Where the design right of a Principal Design has been extinguished under Article 44(4), a trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, the design right of its Related Design thereof may not be transferred independently.

Article 27 (1) A holder of a design right may grant an exclusive license on the design right; provided, however, an exclusive license on a design right of a Principal Design or exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Principal Design and its Related Designs are granted to the same person at the same time.

(2) An exclusive licensee shall have an exclusive right to work the registered design or designs similar thereto as a business to the extent permitted by the contract granting the license.

(3) Where the design right of a Principal Design has been extinguished under Article 44(4), a trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Related Designs are granted to the same person at the same time.

(4) Articles 77 (iii) to (v) (Transfer, etc.), 97(2) (Waiver) and 98(1)(ii) and (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to exclusive licenses.

73.1 Related design

Although Article 9 of the Design Act provides that two or more rights should not be granted for one creation, based on the purport of eliminating overlapped rights, in design development there is an actual situation that many design variations are created from one design concept.

Only if applications for such design variations are filed by the same applicant as that for the principal design before the publication date of the Design Bulletin for the principal design (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), the design variations are exceptionally protected as related designs as those having equivalent value as the principal design, and a design right can be enforced for each design.

73.1.1 Design that is registrable as a related design

In order for a design in an application for design registration to be registered as a related design under Article 10(1) of the Design Act, it must comply 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

(2) The application for design registration pertains to a design similar to the principal design

(3) The application for design registration is filed on or after the filing date of the application for design registration for the principal design and before the publication date of the Design Bulletin for the principal design (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)

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

Since the application for design registration is an application for which the applicant’s own design similar to the principal design can be registered as a related design, the applicant for design registration for a related design must be the same as that 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. Meanwhile, where the establishment of a design right has been registered for the principal design, the applicant for design registration for a related design must be the same person as the holder of the design right of the principal design.

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

The design in an application for design registration which can be registered as a related design must be similar to the principal design. Therefore, where the design is identical to the principal design, it cannot be registered as a related design. (With regard to determination of similarity between two or more whole designs, see Part VI “Prior Application,” 61.1.4 “Determination of similarity between a whole design and a whole design”; with regard to determination of similarity between a partial design and a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.9.1 “Determination of similarity between a partial design and a partial
design”; with regard to determination of similarity between a whole design and a partial design, see 71.9.2 “Determination of similarity between a whole design and a partial design” in the same chapter.)

73.1.1.3 The application for design registration is filed on or after the filing date of the application for design registration for the principal design and before the publication date of the Design Bulletin for the principal design (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)

Where the filing date of an application for design registration for a related design is on or after the filing date of the application for design registration for the principal design, and before the publication date of the Design Bulletin for the principal design (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), the related design may be registered notwithstanding the provisions of Article 9(1) and (2) of the Design Act. Since this Design Bulletin includes 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 not published (the first Design Bulletin pertaining to a secret design), even where the principal design is a design which was requested to be kept secret, an application for design registration for a related design is required to be filed before the publication date of the first Design Bulletin, just as in the case of an ordinary design.

* Please take note that although this Design Bulletin does not include an International Designs Bulletin of an international publication in case of an international application for design registration, a design that was placed in the International Designs Bulletin that was internationally published shall fall under a design provided in Article 3(1)(ii) of the Design Act (a design that was described in a distributed publication or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country).

73.1.1.3.1 Reference date for determination on application of the provision of Article 10(1) 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 10(1) of the Design Act is made on the basis of the day of 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 as to whether or not an application for design registration is found to be an application for a related design filed on or after the filing date of the principal design and before the publication date of the Design Bulletin for the principal design.

Reference date for determination on application of the provision of Article 10(1) of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.

Whether or not an application for design registration containing a priority claim under the Paris Convention, etc. is found to be an application for design registration for a related design filed on or after the filing date for the principal design and before the publication date of the Design Bulletin for the principal design is determined based on the filing date of the first application instead of the filing date in Japan.

Therefore, with regard to an application containing a priority...
claim, etc. seeking design registration for a related design under Article 10(1) of the Design Act, if the claim is legitimate, whether or not it is an application for design registration for a related design filed on or after the filing date for the principal design and before the publication date of the Design Bulletin for the principal design is determined based on the filing date of the first application.

73.1.3.3 Reference date for determination on application of the provision of Article 10(1) of the Design Act with regard to an international application for design registration

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 as to whether or not an international application for design registration is found to be an application for design registration for a related design filed on or after the filing date of the principal design and before the publication date of the Design Bulletin for the principal design (this excludes cases where a priority claim under the Paris Convention, etc. was legitimately made.).

73.1.2 Handling in the case where an exclusive license has been established on the design right of the principal design

A related design whose principal design is a design pertaining to a design right on which an exclusive right has been established may not be registered according to the provision of Article 10(2) of the Design Act.

When establishing exclusive licenses on the design rights of the principal design and its related designs, they must be established for all of the designs to the same person and at the same time under Article 27(1) of the Design Act.

73.1.3 Handling of a design that is similar only to a related design

A design that is similar only to the applicant’s own related design to be registered may not be registered, according to Article 10(3) of the Design Act.

A “design that is similar only to a related design” refers to a design that is similar to the applicant’s own related design to be registered but is not similar to the principal design pertaining to said related design.
73.1.4 Handling of the case where two or more related designs pertaining to the principal design are similar to each other

Since the design rights of related designs are subject to restrictions on duration, transfer and establishment of an exclusive license, along with the design right of the principal design, and their overlapping parts are adjusted, the provisions of Article 9(1) and (2) of the Design Act do not apply even if the related designs pertaining to the design are similar to each other, according to Article 10(4) of the Design Act.

The same applies to related designs that continue to exist after the principal design has been extinguished.

Where the principal design is 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, or where the application for design registration for the principal design was filed prior to the date on which the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006; hereinafter referred to as the “Revising Act”) came into effect and its duration has expired under Article 21(1) of the Design Act prior to the revision (Article 125 of 1959; hereinafter referred to as the “Old Design Act”) which was to remain applicable under Article 2(1) of the Supplementary Provisions of the Revising Act, the design rights of the related designs continue to exist; similar related designs that continue to exist in such a case will continue to exist while maintaining the restrictions that have been imposed centering on the principal design, considering that the respective designs have equivalent creative values and that the stability of relations of rights need to be secured, and they do not become subject to the provisions of Article 9(1) and (2) of the Design Act even if the related designs are similar to each other.

[Transitional measures]

Act for Partial Revision of the Design Act (Act No. 55 of 2006)
Supplementary Provisions
(Transitional Measure upon Revision of the Design Act)
Article 2 The provisions of Article 2(2), Article 3-2, Article 10, Article 14, Article 17, Article 21, Article 42 and Article 48 of the Design Act as revised by the provisions of Article 1 (hereinafter referred to as the “New Design Act”) shall apply to applications for design registration filed after the date on which this Act comes into effect, and with regard to applications for design registration filed prior to the date on which this Act comes into effect, the provisions then in force shall remain effective.
Article 14 In addition to what is provided for in Articles 2 through 11 of the Supplementary Provisions and the preceding Article, any necessary transitional measures for the enforcement of this Act shall be specified by a Cabinet Order.

Cabinet Order Specifying Transitional Measures for Enforcement of the Act for Partial Revision of the Design Act, etc. (Cabinet Order No. 341 of October 27, 2006)

(Transitional Measures Concerning Design Rights of Related Designs)

Article 1 Where the filing date of an application for design registration for a Principal Design (meaning the principal design provided in Article 10(1) of the Design Act as revised (Act No. 125 of 1959; hereinafter referred to as the “New Design Act”) by the provisions of Article 1 of the Act for Partial Revision of the Design Act, etc. (hereinafter referred to as the “Revising Act”); the same shall apply hereinafter) pertaining to the related design provided in said paragraph is prior to the date on which the Revising Act comes into effect, with regard to application of the provision of Article 22(2) of the Design Act to transfer of the design right of said related design, the term “or the design right of a Principal Design has been waived” in said paragraph shall be deemed to be replaced with “the design right of a Principal Design has been waived, or the duration has expired under the provision of Article 21(1) prior to the revision which were to remain applicable under Article 2(1) of the Supplementary Provisions of the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006).”

Article 2 Where the filing date of an application for design registration for a Principal Design pertaining to the related design provided in Article 10(1) of the New Design Act is prior to the date on which the Revising Act comes into effect, with regard to application of the provision of Article 27(3) of the Design Act to an exclusive license on the design right of said related design, the term “or the design right of a Principal Design has been waived” in said paragraph shall be deemed to be replaced with “the design right of a Principal Design has been waived, or the duration has expired under the provision of Article 21(1) prior to the revision which were to remain applicable under Article 2(1) of the Supplementary Provisions of the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006).”

○ Application of the Revising Act to an application for design registration for a related design filed after the date on which the Revising Act comes into effect
whose principal design is a design in an application for design registration filed prior to the date on which the Revising Act comes into effect.

The provision of Article 10(1) of the Revising Act applies to an application for design registration for a related design filed after the date on which the Revising Act comes into effect whose principal design is a design in an application for design registration filed prior to the date on which the Revising Act comes into effect, based on the provisions of Article 2 of the Supplementary Provisions of the Revising Act, and the design may be registered as a related design. In this case, the duration of the right of the related design will be 20 years from the date of registration of its principal design, based on the provision of Article 21(2) of said Act. However, the duration of the design right of said principal design will be 15 years from the date of registration of the principal design, based on the provision of Article 21(1) of the Old Design Act, so the design right of the principal design will be extinguished through expiration of the duration, even without waiver of the design right, a failure to pay registration fees or a trial decision of invalidation becoming final and binding. In such a case as well, transfer of the design right and establishment of an exclusive license will be restricted based on the provision of Article 1 or 2 of the Cabinet Order Specifying Transitional Measures for Enforcement of the Act for Partial Revision of the Design Act, etc.

○ Application of the Revising Act to an application pertaining to division of an application for design registration, conversion of an application or filing of a new application for an amended design

The Revising Act applies to an application pertaining to division of an application for design registration, conversion of an application or filing of a new application for an amended design where 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 under Article 10-2(2) of the Design Act (including the cases where applied mutatis mutandis pursuant to Article 13(5) of said Act) or Article 17-3(1) of said Act is after the date on which the Revising Act comes into effect.

○ Application of the Revising Act to an application for design registration containing a priority claim under the Paris Convention, etc.

The Revising Act applies to an application for design registration containing a priority claim under the Paris Convention, etc. where the filing date in Japan is after the date on which the Revising Act comes into effect, based on the provision of Article 4B of the Paris Convention.