

Chapter I Division of Applications for Design Registration

1. Outline

Article 10-2 of the Design Act provides that an applicant may extract one or more new applications for design registration from part of a single application for design registration containing two or more designs. Article 10-2 also provides that, if an application for design registration is legitimately divided, the new application for design registration is deemed to have been filed at the same time as the original application for design registration.

The system for dividing applications for design registration is intended to provide redress to applicants in cases where an application for design registration has been filed while erroneously including two or more designs in a single application contrary to the principle of one application per design as provided in Article 7 of the Design Act (see Part II, Chapter II “Filing an Application for Each Design”).

The term “new application for design registration” here includes new applications for design registration resulting from division of an international application for design registration.

2. Requirements for division of an application for design registration

In order for a new application for design registration resulting from division to be deemed to have been filed at the time of the original application for design registration, it must comply with all of the following requirements.

- (1) Examination, trial or retrial of the application for design registration is pending
The procedure for division can only be taken where the examination, trial or retrial of the application for design registration is pending.
- (2) The applicants for design registration are the same
The applicant of the new application for design registration resulting from division must be the same as the applicant of the original application for design registration. However, where the new applicant for design registration has legitimately succeeded to the right to obtain a design registration from the original applicant for design registration, the examiner should determine that the applicants are the same.
- (3) An application for design registration containing two or more designs is divided
An application for design registration containing two or more designs refers to the case where two or more designs are represented in the statement in the application and drawings, etc. attached to the application. It is for example the case where two or more articles are stated together in the column of “Article to the Design” of the application, or where two or more shapes, etc. are represented in drawings, etc. attached to the application (see Part II, Chapter II “Filing Applications for Each Design”), or the case where the article to the design for which the design registration is requested for part of a single article, etc. contains two or more “parts for which the design registration is requested” that are

physically separate and for which no unity in shape, etc. or unity in function is recognized.

- (4) The design in a new application for design registration resulting from division is a design identical to any of the two or more designs contained in the original application for design registration

3. Examples of cases that are not found to be a legitimate procedure for division of an application for design registration

- (1) Where an application for design registration that has been filed for each design and that complies with the requirements as provided in Article 7 of the Design Act is divided by each component constituting the article
- (2) Where an application for design registration for a design for a set of articles that complies with the requirements as provided in Article 8 of the Design Act is divided by each constituent article, etc.
- (3) Where an application for design registration for an interior design that complies with the requirements as provided in Article 8-2 of the Design Act is divided by each constituent article, etc.
- (4) Where a new application for design registration resulting from division has a gist that is outside the scope of the design represented by the statement in the initial application and drawings, etc. attached to the application of the original application for design registration, that is, where the design represented in the new application for design registration changes the gist from the viewpoint of each of the two or more designs contained in the original application for design registration
- (5) Where an application for design registration for a whole design that is found to be one design, or for a design for which the design registration is requested for part of an article, etc. that is treated as one design, is divided into one or more new applications for design registration for designs for which the design registration is requested for part of an article, etc.

4. Handling of new applications for design registration that do not comply with the requirements for division

The examiner should not regard a new application for design registration as having been filed at the time of the original application for design registration, but should treat it as having been filed at the time of the division.

5. Documents to be submitted when requesting application of the provisions on exception to lack of novelty of design or filing a priority claim under the Paris Convention, etc. for a new application for design registration resulting from division

Where a new application for design registration resulting from division is filed, any statements or documents which have been submitted in relation to the original application for design registration and are required to be submitted for the procedure to request application of the provisions on exception to lack of novelty of design (the documents required to be submitted under Article 4, paragraph (3) of the Design Act) or are required to be submitted for filing a priority claim under the Paris Convention, (including a priority claim recognized under the Paris Convention) (documents required to be submitted under Article 43, paragraphs (1) and (2) of the Patent Act or Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design Act) should be deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration under Article 10-2, paragraph (3) of the Design Act.