

Chapter II Conversion of Application

1. Outline

Article 13 of the Design Act provides that an applicant may convert a patent application or an application for utility model registration into an application for design registration. Article 13 also provides that, if an application for design registration is legitimately converted, the new application for design registration is deemed to have been filed at the same time as the original application.

The system for converting applications for design registration is intended to provide a remedy to applicants such as in cases where an applicant has selected an incorrect form of application (application for design registration, a patent application or an application for utility model registration), or, for example, where a patent application was filed for invention of a new shape which was considered technically effective but the application was refused so the applicant is requesting design registration for the aesthetic aspect of the shape.

2. Requirements for conversion into an application for design registration

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

- (1) In the case of conversion from a patent application into an application for design registration, that it is within three months from the date on which the certified copy of the examiner's initial decision to the effect that the original patent application is to be refused was served
- (2) In the case of conversion from an application for utility model registration into an application for design registration, that the original application for utility model registration is pending before the Japan Patent Office
- (3) The applicant of the new application for design registration resulting from conversion and the original applicant for the patent or utility model registration are the same
However, where the new applicant for design registration has legitimately succeeded to the right to obtain a design registration from the original applicant for the patent or utility model registration, the examiner should determine that the applicants are the same.
- (4) The initial description and drawings of the original patent application or application for utility model registration contain a concrete description based on which the design in the new application for design registration resulting from conversion can be clearly recognized
- (5) The design in the new application for design registration resulting from conversion is identical to the design represented in the initial description and drawings of the original patent application or application for utility model registration

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

- (1) Where the initial description and drawings of the original patent application or application for utility model registration do not contain a concrete description based on which the design in the new application for design registration resulting from conversion can be clearly recognized
- (2) Where the design in the new application for design registration resulting from conversion is not found to be identical to the design that is represented in the initial description and drawings of the original patent application or application for utility model registration by a concrete description based on which the design can be clearly recognized
- (3) Where the design in the new application for design registration resulting from conversion has added anything other than the contents of the initial description and drawings of the original patent application or application for utility model registration

4. Conversion of a patent application or an application for utility model registration into an application requesting design registration for part of an article, etc.

Where the initial description and drawings of the patent application or application for utility model registration contain a concrete description based on which the new design for which the design registration is requested for part of an article, etc. resulting from conversion can be clearly recognized, and the contents before and after the conversion of the application are found to be identical, the examiner should deem that the new application for design registration resulting from conversion was filed at the time of the original patent application or application for utility model registration.

5. Handling of new applications for design registration that do not comply with the requirements for conversion

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

6. 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 conversion

Where a new application for design registration resulting from conversion is filed, any statements or documents which have been submitted in relation to the original patent application or application for utility model registration (including any of those which were provided by an electronic or magnetic means) 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) (which are required to be submitted under Article 43, paragraphs (1) and (2) of the Patent Act (including the cases where these provisions are applied mutatis mutandis in Article 43-2, paragraph (2) of the Patent Act and Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of the Design 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 (Article 10-2, paragraph (3) of the Design Act as applied mutatis mutandis pursuant to Article 13, paragraph (6) of the Design Act).