Chapter II Dismissal of Amendments

82 Relevant provisions

Design Act

Article 17-2 (1) Where an amendment made to any statement in the application, or to the drawing, photograph, model or specimen attached to the application has changed the gist thereof, the examiner shall dismiss the amendment by a ruling.

(2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state the reasons therefor.

(3) Where the ruling dismissing an amendment under the preceding paragraph (1) has been rendered, the examiner shall not render a decision on the application for design registration before the expiration of three months from the date on which a certified copy of the ruling has been served.

(4) Where an applicant for design registration files a request for a trial against an examiner's ruling dismissing an amendment under paragraph 1, examination of the application for design registration shall be suspended until the trial decision becomes final and binding.

82.1 Dismissal of an amendment

Dismissal of an amendment under Article 17-2 of the Design Act refers to dismissal of an amendment by a ruling 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.

82.1.1 Gist of design and the finding of the 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 basis, the content 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, and 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.
82.1.2 Change of the gist

82.1.2.1 Categories of amendments that change the gist
Where an amendment made to the application or drawing, etc. attached to the application falls under any of the following, it changes the gist of the application or drawing, etc. attached to the application as originally filed.

82.1.2.1.1 Where the amendment is found to make a change exceeding the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design
From the viewpoint that allowing an amendment that makes a change exceeding the scope of identity of a design that can be inevitably derived based on the ordinary skill in the art of the design from the application and drawing, etc. attached to the application as originally filed would run contrary to the purport of the first-to-file system, and would give unexpected disadvantage to third parties, such amendment is to be found to change the gist of the application or drawing, etc. attached to the application as originally filed.

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

82.1.2.1.2 Where the amendment is found to clarify the gist of design that was unclear when originally filed
From the viewpoint that an amendment to make subject matter that is not categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act and whose gist of design cannot be identified even by making comprehensive determination based on the application and drawing, etc. attached to the application as originally filed, into an industrially applicable design, that is, allowing an amendment that clarifies the gist of design that was unclear when originally filed, would run contrary to the purport of the first-to-file system, and would give unexpected disadvantage to third parties, equivalent to the above, such amendment is also to be found to change the gist of the application or drawing, etc. attached to the application as
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originally filed.

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

An amendment made to change the scope that was not disclosed in the application or drawing, 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, is found to change the gist of the design.

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

Where it is suggested by the application or drawing, 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, adding such scope by making an amendment is not found to change the gist of the design.

82.1.2.2 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 comprehensive determination on the application and drawing, etc. attached to the application, the amendment does not change the gist of the application or drawing, etc. attached to the application as originally filed.

82.1.2.2.1 Where a correction is made within the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design

Even where the application or drawing, 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 the application or drawing attached to the application or from restrictions in constructing drawings, and if a proper description can be inevitably and directly derived based on the ordinary
skill in the art of the design, an amendment to correct it into a proper description does not change the gist of the application or drawing, etc. attached to the application as originally filed. (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design”)

82.1.2.2.2 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 application or drawing, 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, an amendment to correct it into a proper description does not change the gist of the application or drawing, etc. attached to the application as originally filed. (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design”)

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