Part IX Special Application for Design Registration

Chapter I Division of Applications for Design Registration

91 Relevant provisions

Design Act

Article 10-2 (1) An applicant for design registration may extract one or more new applications for design registration out of a single application for design registration containing two or more designs only while examination, trial or retrial of the application for design registration is pending.

(2) Where an application for design registration is divided under the preceding paragraph, the new application(s) for design registration shall be deemed to have been filed at the time of the filing of the original application; provided, however, that this shall not apply for the purposes of applications of Article 4(3) of this Act and Articles 43(1) and (2) of the Patent Act as applied mutatis mutandis under Article 15(1) of this Act (including the cases where they are applied mutatis mutandis pursuant to Article 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of this Act).

(3) Where a new application for design registration is filed under paragraph (1), any statements or documents which have been submitted in relation to the original application for design registration and are required to be submitted in relation to the new application under Article 4(3) of this Act and Articles 43(1) and (2) of the Patent Act as applied mutatis mutandis under Article 15(1) of this Act (including the cases where they are applied mutatis mutandis pursuant to Article 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of this Act) shall be deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration.

91.1 Provisions of Article 10-2 of the Design Act

Division of applications for design registration refers to extracting one or more new applications for design registration out of a single application for design registration containing two or more designs.

In division of applications for design registration, only where an application for design registration has been filed while erroneously including two or more designs in a single application and where a legitimate procedure has been taken, the new application for design registration is deemed to have been filed at the time of the filing of the original application for design registration.

Here, “a new application for design registration” includes a new application for design registration resulting from division of an international application for design registration.
91.1.1 Requirements for division of applications 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 filing 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 of division can only be taken where the examination, trial or retrial of the application for design registration is pending. In other words, an application for design registration may not be divided after the application for design registration has been waived, withdrawn or dismissed, or where an examiner’s decision or trial decision on the application has become final and binding (excluding the case where retrial of the application 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 applicants are found to be the same.

(3) An application for design registration containing two or more designs is divided

A case where an application for design registration contains two or more designs refers to the case where two or more designs are represented in the application and drawings, etc. attached to the application. It is for example the case where two or more articles are stated in parallel in the column of “Article to the Design” of the application or the case where two or more forms are represented in drawings, etc. attached to the application (see Part V “One Application per Design,” 51.1.2 “Examples of cases that do not comply with the requirements provided in Article 7 of the Design Act”).

(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

91.1.2 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 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 provided in Article 8 of the Design Act is divided by each constituent article

(3) 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 all of the two or more designs contained in the original application for design registration

91.1.3 Handling of a new application for design registration that does not comply with the requirements for division

The new application for design registration is not deemed to have been filed at the time of the filing of the original application for design registration, but is treated as having been filed at the time of the division.

91.1.4 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(3) of the Design Act) or are required to be submitted for filing a priority claim under the Paris Convention, etc. (including a priority claim recognized under the Paris Convention) (documents required to be submitted under Article 43(1) and (2) of the Patent Act Article 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act) are deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration under Article 10-2(3) of the Design Act.