101 Relevant provisions

Design Act: Article 15 (1)
Geneva Act: Article 6(1), (2)

101.1 Effect of a priority claim under the Paris Convention, etc.

With regard to the effect of a priority claim under the Paris Convention, Article 4B of the Paris Convention provides that any subsequent application will not be invalidated by reason of another application or a fact of becoming publicly known within the period from the filing date of the first application in one of the countries of the Union of the Paris Convention until the filing date of a subsequent application containing a priority claim in any of the other countries of the Union of the Paris Convention.

Based on this, in examination of an application for design registration containing a priority claim in relation to novelty (Article 3(1) of the Design Act), creative difficulty (Article 3(2) of the Design Act), exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application (Article 3-2 of the Design Act), prior application (Article 9 of the Design Act) or related design (Article 10 of the Design Act), the filing date of the first application that serves as the basis for the right of priority is treated as the reference date for the determination. In other words, even where another application for design registration is filed for a design identical or similar to the design in an application for design registration containing a priority claim within the period of priority, such application for design registration will be treated as a later application of the application containing a priority claim, and even where a fact that results in lack of novelty of the design occurs within the period of priority, such fact will not be used as the basis for a reason for refusal.

In Japan, not only nationals of a country of the Union of the Paris Convention, but also nationals of a member of the World Trade Organization and nationals of a country that is neither a country of the Union of the Paris Convention nor a member of the World Trade Organization (limited to a country that allows Japanese nationals to declare priority under the same conditions as in Japan, and that is designated by the Commissioner of the Patent Office) may make a priority claim recognized under the Paris Convention, under Article 43-3 of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act, and the effect of such priority claim is the same as that of a priority claim under the Paris Convention.

101.1.1 Procedure for making a priority claim under the Paris Convention, etc.

A person who intends to make a priority claim for an application for design
registration under Article 4D(1) of the Paris Convention must follow the procedure provided in Article 43(1), (2) and (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.

The procedure for a priority claim recognized under the Paris Convention is the same as that for a priority claim under the Paris Convention. (Article 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act)

101.1.2 Period of priority in the case of making a priority claim under the Paris Convention, etc.

The period of priority in the case of filing an application for design registration in Japan by making a priority claim under the Paris Convention based on an application for design registration or an application for utility model registration is six months. (Article 4C(1) and Article 4E(1) of the Paris Convention)

The period of priority recognized under the Paris Convention is the same as the period of priority under the Paris Convention. (Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act)

101.2 Requirements for a priority claim under the Paris Convention, etc. to be effective

In order for a priority claim under the Paris Convention to be effective, it must comply with all of the following requirements that are specified by the Paris Convention.

(1) The first application that serves as the basis for the right of priority is the first application (including an international application based on the Geneva Act\(^{Note}\)) that has been duly filed in one of the countries of the Union of the Paris Convention
(Article 4A(1), Article 4A(2), Article 4A(3) and Article 4C(4) of the Paris Convention, Article 6(2) of the Geneva Act)

(2) The applicant for design registration filing in Japan is the person who has filed the first application that serves as the basis for the right of priority or such person’s successor in title, who is eligible to enjoy the advantages of the Paris Convention (Article 2, Article 3 and Article 4A(1) of the Paris Convention)

(3) The first application that serves as the basis for the right of priority is an application for design registration or an application for utility model registration (Article 4E(1) of the Paris Convention)

(4) The application for design registration has been filed in Japan within six months
from the filing date of the first application
(Article 4C(1) and Article 4E(1) of the Paris Convention)

(5) A right of priority has been declared based on the first application
(Article 4D of the Paris Convention)

(6) The design in the application for design registration filed in Japan is identical to
the design in the first application that serves as the basis for the right of priority
(Article 4A(1) and Article 4B of the Paris Convention)

(Note)
For details of “the Geneva Act” and “an international application”, see Part XI “International Application for Design Registration”. The same applies hereinafter.

Meanwhile, the requirements for a priority claim recognized under the Paris
Convention to be effective are the same as those for a priority claim under the Paris
Convention to be effective.
(Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article
15(1) of the Design Act)

101.3 **Basic concept of “identicalness of design” in approval or disapproval of a priority claim under the Paris Convention**

(1) It is sufficient for a design that is substantially identical to the design in the
application for design registration filed in Japan to be indicated in the priority
certificate, regardless of the style of expression of the design
(15.07 of the Design Examination Manual)

(2) Whether or not the design in the application for design registration filed in Japan
is indicated in the priority certificate should be determined by making
comprehensive determination based on the contents of the entire priority
certificate.

(3) The finding of the design described in the priority certificate (the article to the
design, the shapes, patterns and colors of the article, the position, size and scope
of the part for which the design registration is requested in the entire design, etc.)
should be made by also taking into consideration the laws and regulations, etc.
of the first country (the country in which the first application was filed).

101.3.1 **Statement in the column of “Article to the Design”**
In principle, in order for the design described in the priority certificate to be
found to be identical to the design in the application for design registration filed
in Japan, the articles to the designs of the two designs must also be identical.

However, since the name of the article to the design, etc. to be stated in the application differs considerably among countries, even where the name of the article to the design, etc. described in the priority certificate differs from the name of the “Article to the Design” of the design in the application for design registration filed in Japan, if the difference is considered to be inevitable due to differences in the laws and regulations, etc. of the respective countries, the article to the design described in the priority certificate and the article to the design in the application for design registration filed in Japan are found to be identical in determining the approval or disapproval of the right of priority.

101.3.1.1 Where the usage and function of the article to the design of the design described in the priority certificate are clear by making comprehensive determination based on the entire contents of the priority certificate

Where a classification of articles under Appended Table 1 or a classification of articles equivalent in level to such classification, corresponding to the usage and function that are clear by making comprehensive determination based on the entire contents of the priority certificate, is stated in the application for design registration filed in Japan, the articles to the designs of the two designs are found to be identical in determining the approval or disapproval of the right of priority.

[Example of a case where the articles to the designs of the two articles are found to be identical]

<table>
<thead>
<tr>
<th>Example 1</th>
<th>Where a classification of articles corresponding to the usage and function that are clear by making comprehensive determination based on the entire contents of the priority certificate is stated</th>
</tr>
</thead>
</table>

First application: The name of the article to the design, etc. is “Graphical user interfaces” and the drawings contain the front view of a mobile phone in a state where a graphic image is displayed on the display part.

Japanese application: It is an application for a partial design where the article to the design is a “Mobile phone” and the part for which the design registration is requested is the display part of the mobile phone. A graphic image is displayed on the display part. Meanwhile,
the forms of the parts other than the display part are consistent with the form of the mobile phone represented by a broken line in the priority certificate.

(Explanation)
In foreign countries, there are cases where design registration can be obtained for a graphic image on a screen alone without having to specify the article on which the graphic image is to be used. Therefore, even where the name of the article to the design, etc. stated in the priority certificate does not specify an article, if the article to the design in the application for design registration filed in Japan can be derived by making comprehensive determination based on the entire contents of the priority certificate, such as where the priority certificate contains a figure in which the graphic image is displayed on a specific article, the article to the design described in the priority certificate and the article to the design in the application for design registration filed in Japan are found to be identical in determining the approval or disapproval of the right of priority.

101.3.1.2 Where the name of the article to the design, etc. of the design described in the priority certificate is a generic name and there are multiple classifications of articles corresponding to its usage and function
Where the name of the article to the design, etc. of the design described in the priority certificate is a generic name, and one classification of articles, from among the multiple classifications of articles that are derived by making comprehensive determination based on the entire contents of the priority certificate, is stated in the application for design registration filed in Japan, the articles to the designs of the two designs are found to be identical in determining the approval or disapproval of the right of priority.

[Example of a case where the articles to the designs of the two articles are found to be identical]

<table>
<thead>
<tr>
<th>Example 2</th>
<th>Where the name of the article to the design, etc. in the priority certificate is a generic name and the statement in the column of “Article to the Design” of the application for design registration filed in Japan is a classification of articles equivalent in level to a classification of articles under Appended Table 1 that is included in such generic name</th>
</tr>
</thead>
<tbody>
<tr>
<td>First application: The name of the article to the design, etc. is “bottle”</td>
<td></td>
</tr>
</tbody>
</table>
and the drawings contain the form of a general PET bottle for beverages.

Japanese application: The article to the design is stated as a "Packaging container."

101.3.2 Number of designs included in one application

In foreign countries, the procedural provisions on the number of designs that can be included in one application and how they should be represented are varied, but even where the number of designs included in one application were to differ in the case of filing an application for each design that can be found based on the priority certificate under the Japanese design system, the designs are found to be identical in determining the approval or disapproval of the right of priority.

101.3.2.1 Where multiple designs are described in the priority certificate and one of such designs is specified as the design in the application for design registration filed in Japan, the designs are found to be identical in determining the approval or disapproval of the right of priority.

101.3.2.2 Where multiple designs are described in the priority certificate and all or part of their constituent articles are specified as the design in the application for design registration filed in Japan as a design for a set of articles (a set of articles listed in Appended Table 2 as designated by the Ordinance of the Ministry of Economy, Trade and Industry provided in Article 8 of the Design Act), the designs are found to be identical in determining the approval or disapproval of the right of priority.

101.3.2.3 Where the design described in the priority certificate and a design that is not described in the priority certificate are specified as the design in the application for design registration filed in Japan as a design for a set of articles, the designs are not found to be identical.

101.3.2.4 Where a design combining designs based on multiple priority certificates is specified as the design in the application for design registration filed in Japan, the designs are not found to be identical.

Where the designs in the multiple priority certificates and the design
in the application filed in Japan are compared, the design in the application for design registration filed in Japan cannot be derived from any one of the priority certificates, and it is possible to file individual applications for design registration in Japan for the designs in the multiple first applications. Therefore, where a design combining the designs described in such multiple priority certificates is specified as the design in the application for design registration filed in Japan, the designs are not found to be identical.

[Example of a case where the two designs are not found to be identical]

First application A: A design of the cap of a ball point pen
First application B: A design of the main body of a ball point pen
Japanese application: A design of a ball point pen (the cap + the main body) combining first application A and first application B

101.3.3 Where the form of the entire article to the design for which the design registration is requested is not represented in the drawings attached to the priority certificate

There are some foreign countries where it is not necessary to disclose the entire article to the design for which the design registration is requested in the drawings attached to the application.

Accordingly, where the form of the entire article to the design for which the design registration is requested is not represented in the drawings attached to the priority certificate, if the part(s) for which the design registration is requested in the first country is(are) consistent with the design for which the design registration is requested in Japan, by considering the disclosed portion(s) indicated by solid lines and broken lines in reproductions and other matters stated in the application, the two designs are found to be identical in determining the approval or disapproval of the right of priority.

101.3.3.1 Where a design in which the form of the entire article is represented is specified as the design in the application for design registration filed in Japan

Where the part(s) other than the part(s) for which the design registration is requested in the first country is(are) specified as the part(s) for which the design registration is requested in Japan, even
by making comprehensive determination based on the contents of the entire priority certificate, the two designs are not found to be identical.

101.3.3.2 Where the design in the application for design registration filed in Japan is a partial design, adopting the part whose specific form was represented in the design described in the priority certificate as the part for which the design registration is requested, and adopting the part whose specific form was not represented therein as any other part

(i) Where the position, size and scope of the part of which the specific form was represented, in the entire article, cannot be derived by making comprehensive determination based on the contents of the priority certificate, the two designs are not found to be identical.

(ii) Where, with regard to the design described in the priority certificate, it is possible to derive the position, size and scope of the part of which the specific form was represented, in the entire article, by making comprehensive determination based on the contents of the priority certificate, other than drawings, or based on the characteristics of the article, etc., the two designs are found to be identical in determining the approval or disapproval of the right of priority.

[Example of a case where the two designs are found to be identical]

[Example 4] Where parts that were not represented in the first application are specified as “parts other than the part for which the design registration is requested”

First application: A design of a foldable mobile phone for which only drawings representing the form of the folded state are described, and the form of the inside in the unfolded state is not described. There is no statement as to whether or not it is an application for a partial design.

Japanese application: An application for a partial design for which the inside in the unfolded state is represented by broken lines and which specifies the part that is visible in the folded state as the “part for which the design registration is requested”

(Explanation)

By making comprehensive determination based on the contents of the priority certificate, the first application is found to correspond to an
application for a partial design under the Japanese system, requesting design registration for only the part of the mobile phone that is visible in the folded state, and the position, size and scope of the part that is visible in the folded state in the entire mobile phone is clear. Therefore, the design described in the priority certificate and the design in the application for design registration filed in Japan are found to be identical in determining the approval or disapproval of the right of priority.

[Example of a case where the two designs are found to be identical]

<table>
<thead>
<tr>
<th>Example 5</th>
<th>Where the position, size and scope of the part for which the design registration is requested can be derived by making comprehensive determination based on the contents of the priority certificate (graphic image on a screen)</th>
</tr>
</thead>
<tbody>
<tr>
<td>First application: The name of the article to the design, etc. is “Graphical user interfaces” and the drawings contain the front view of a mobile phone (A) in a state where a graphic image (a) is displayed on the display part (the parts other than the display part are represented by broken lines) and multiple views that only represent plural graphic images (b, c and d).</td>
<td></td>
</tr>
<tr>
<td>Japanese application: It is an application for a partial design where the article to the design is a “Mobile phone” and the part for which the design registration is requested is the display part of the mobile phone. The shape of the entire mobile phone is consistent with mobile phone (A) represented by broken lines in the priority certificate, and graphic image (c) is displayed on the display part.</td>
<td></td>
</tr>
</tbody>
</table>

(Explanation)

While the first application requests design registration for a graphic image on a screen for operation, by making comprehensive determination based on the fact that it also contains views showing the state where graphic image (a) is displayed on the display part of mobile phone (A), it is found to be requesting design registration also for graphic image (c) as a graphic image that is displayed on mobile phone (A).

In foreign countries, there are cases where design registration can be obtained for a graphic image on a screen alone, but in the design in an application for design registration filed in Japan, design registration cannot be obtained for a graphic image alone. Therefore, where a classification of articles that can be derived by making comprehensive determination based on the entire contents of the priority certificate is
specified as the article to the design (see Example 2), and only the
display part displaying graphic image (c) on mobile phone (A) is
specified as the part for which the design registration is requested, the
specific position, size and scope of the display part in the entire article
to the design can be derived by making comprehensive determination
based on the entire contents of the priority certificate, so a design
identical to the design in the application for design registration filed in
Japan is found to be indicated in the priority certificate.

[Example of a case where the two designs are not found to be
identical]

[Example 6] Where the position, size and scope of the part for which
the design registration is requested cannot be derived by making
comprehensive determination based on the contents of the priority
certificate

First application: The name of the article to the design, etc. is "Package"
and the drawings only depict a pattern.
Japanese application: It is an application for a partial design for which
the article to the design is a "Packaging box" and the pattern part
represented on a part of the packaging box is specified as the part
for which the design registration is requested.

(Explanation)
Where the drawings attached to the priority certificate only depict a
pattern, even if the name of the article to which the pattern is to be
applied has been described, the position, size and scope of the pattern
in the entire article cannot be derived from the contents of the priority
certificate, so the designs are not found to be identical.

101.3.4 Combination or separation of parts constituting a design

Where the design described in the priority certificate is found to be one
design in light of the provision of Article 7 of the Japanese Design Act, only if
an application for design registration is filed in Japan for the same unit of design
as said design, the two designs are found to be identical in determining the
approval or disapproval of the right of priority.

101.3.4.1 Where the design in the application for design registration filed
in Japan is the design of a finished product combining the
design of a component described in the priority certificate and
the design of another component that is not described in the
priority certificate
The two designs are not found to be identical.

101.3.4.2 Where the design described in the priority certificate is the design of a finished product, and one of the components constituting said finished product is specified as the design in the application for design registration filed in Japan

The two designs are not found to be identical.

[Example of a case where the two designs are not found to be identical]

[Example 7] Where one of the components constituting a finished product is specified as the design in the application for design registration filed in Japan

First application: A design of a bicycle
Japanese application: A design of a bicycle saddle

(Explanation)

The first application is requesting design registration for an entire bicycle, which is found to be one design under Article 7 of the Japanese Design Act, and is not found to be requesting design registration independently for the bicycle saddle constituting the bicycle, so the two designs are not found to be identical.

101.3.4.3 Where the design described in the priority certificate is a finished product combining multiple interchangeable components, and a combination that is not disclosed in the priority certificate is specified as the design in the application for design registration filed in Japan

(i) Where it is found that design registration is being requested in the first country for subject matter including the mode of combination specified as the design in the application for design registration filed in Japan, by making comprehensive determination based on the entire contents of the priority certificate, the two designs are found to be identical in determining the approval or disapproval of the right of priority.

(ii) Where it is unclear whether design registration is being requested in the first country for the combination specified as the design in the application for design registration filed in Japan, by making comprehensive determination based on the entire contents of the priority certificate, the two designs are not found to be identical.
[Example of a case where the two designs are found to be identical]

[Example 8] Where the design described in the priority certificate is a finished product combining multiple interchangeable components, and a combination that is not disclosed in the priority certificate is specified as the design in the application for design registration filed in Japan.

First application: Three designs of the main body of a ball point pen (A, B and C), three designs of the cap of a ball point pen (a, b and c), and one design of a ball point pen with a cap (A + a) are described. In addition, the application contains a statement to the effect that the subject matter is not limited to one design of a ball point pen with a cap (A + a), but that the combinations of the main body of a ball point pen and the cap of a ball point pen can be changed.*

Japanese application: A design of a ball point pen with a cap (A + b)

(Explanation)

A total of seven designs are illustrated in the first application: three designs of the main body of a ball point pen (A, B and C), three designs of the cap of a ball point pen (a, b and c), and one design of a ball point pen with a cap (A + a).

However, by making comprehensive determination based on the contents of the application, the design of a ball point pen with a cap (A + a) has been shown as an example, and the first application is found to be an application requesting registration for nine designs with regard to designs of a ball point pen with a cap, including a design of a combination that has not been illustrated (A + b).

* Where it is unclear whether the first application is requesting design registration in the first country for the combination specified as the design in the application for design registration filed in Japan, by making comprehensive determination based on the entire contents of the priority certificate, such as where the design of a ball point pen with a cap (A + a) is not described in the first application, or where it is not clear whether the combinations of the main body of a ball point pen and the cap of a ball point pen can be changed, the two designs are not found to be identical.

101.3.5 Where the constituent elements (shapes, patterns and colors) of the designs differ

In order for the two designs to be found to be identical, the shapes, patterns,
and colors (hereinafter referred to as the “constituent elements of the design”) of the articles to the design of the two designs must be identical.

If the constituent elements of the designs differ, the designs are regarded as different, and this will have an influence on the similarity, so in principle, the effect a priority claim cannot be extended to the case where any constituent element of the design has been changed.

However, even where the constituent elements differ but it is found, based on the contents of the priority certificate, that design registration is not requested for the constituent elements that are not included in the design in the application for design registration filed in Japan, or where the methods of expression, such as the drawing methods, of the designs differ but a design identical to the design described in the application for design registration filed in Japan can be inevitably derived by making comprehensive determination based on the drawings, etc. described in the priority certificate, the two designs are found to be identical in determining the approval or disapproval of the right of priority.

(Examples of cases where the methods of expression of the designs differ)
(i) Where the design described in the priority certificate and the design in the application for design registration filed in Japan are represented by different drawing methods
(ii) Where the design described in the priority certificate is represented by drawings (including computer graphics) and the design in the application for design registration filed in Japan is represented by photographs (monochrome or color), a specimen or a sample
(iii) Where the design described in the priority certificate is represented by photographs (monochrome or color), a specimen or a sample and the design in the application for design registration filed in Japan is represented by drawings (including computer graphics)

[Example of a case where the two designs are found to be identical]

[Example 9] Where the methods of expression differ but a design identical to the design described in the application for design registration filed in Japan can be inevitably derived by making comprehensive determination based on the contents of the priority certificate

First application: A design of a nail. It is represented by uncolored drawings, but the application contains a statement that it is made of iron.
Japanese application: A design of a nail. It is represented by photographs, and it has the metallic luster and metallic color that would appear on a general nail made of iron.

(Explanation)
Although the design described in the priority certificate has no pattern or color, by making comprehensive determination based on the statement in the application that it is made of iron, it is possible to inevitably derive a design identical to the design of a nail having a metallic luster and metallic pattern which is represented by photographs attached to the application for design registration filed in Japan, the two designs are found to be identical in determining the approval or disapproval of the right of priority.

[Example of a case where the two designs are found to be identical]

[Example 10] Where the design described in the priority certificate is represented by two perspective views and the design in the application for design registration filed in Japan is represented by six views prepared by the orthographic projection method.

First application: The design is represented by a perspective view showing the front, top and right side, and a perspective view showing the rear, bottom and left side.
Japanese application: The design is represented by six views (a front view, rear view, left side view, right side view, top view and bottom view) prepared by the orthographic projection method. The form represented by these six views is consistent with the contents that can be inevitably derived from the perspective views described in the priority certificate.

(Explanation)
The drawings described in the priority certificate are two perspective views showing the six sides, and the contents that can be inevitably derived by making comprehensive determination based on these views and the design in the application filed in Japan are consistent, so the mere difference is in the drawing method, and the two designs are found to be identical in determining the approval or disapproval of the right of priority.
Part X Procedure for Priority Claim under the Paris Convention, etc.

[Example of a case where the two designs are found to be identical]

[Example 11] Where the design described in the priority certificate is represented by photographs and the design in the application for design registration filed in Japan is represented by drawings (colored drawings)

First application: The design is represented by photographs in color.
Japanese application: The design is represented by drawings and they are colored using the same colors as those represented in the first application.

101.3.6 Where the application that serves as the basis for the right of priority is not an application for design registration or an application for utility model registration

Filing of an application for design registration by making a priority claim based on a patent application or an application for trademark registration is not provided under the Paris Convention. The effect of such priority claim that is not provided under the Paris Convention should be determined based on whether or not it is possible to convert applications between such legal domains in Japan.

101.3.6.1 Where the application that serves as the basis for the right of priority is a patent application

In Japan, it is possible to convert an application between the legal domains of the Patent Act and the Design Act.

Therefore, where an application for design registration has been filed by making a priority claim based on a patent application, the priority claim will be effective as long as a design identical to the design in the application for design registration filed in Japan is indicated in the priority certificate.

101.3.6.2 Where the application that serves as the basis for the right of priority is an application for trademark registration

In Japan, conversion of application from an application for trademark registration into an application for design registration is not allowed.

Therefore, where an application for design registration has been filed by making a priority claim based on an application for trademark registration, the priority claim will not be effective.

Also, where the application for design registration filed in the first country that serves as the basis for the right of priority was a three-
101.3.7 Concept of identicalness of design of individual applications for design registration containing a priority claim under the Paris Convention, etc.

(i) With regard to a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.13 “Application for design registration for a partial design containing a priority claim under the Paris Convention, etc.”

(ii) With regard to a design for a set of articles, see Part VII “Individual Applications for Design Registration,” Chapter II “Design for a Set of Articles,” 72.1.7 “Application for design registration for a design for a set of articles containing a priority claim under the Paris Convention, etc.”