Part XI International Application for Design Registration

Chapter I International Application Which Is Deemed to Be an Application for Design Registration

111 Relevant provisions

Design Act: Article 6, Article 16, Article 60-6
Geneva Act: Article 1(vi) to (viii), (xix), Article 5(4), Article 10(2), (3), Article 12 (1), Article 14(1)

111.1 Provisions of Article 60-6 of the Design Act

Article 60-6(1) of the Design Act provides that an international application under Article 1(vii) of the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs (hereinafter referred to as "Geneva Act") (hereinafter referred to as “international application”), designating Japan as a designated Contracting Party under Article 1(xix) of the Geneva Act (hereinafter referred to as “designated Contracting Party”), where publication (hereinafter referred to as “international publication”) has been made under Article 10(3)(a) of the Geneva Act, shall be deemed to be an application for design registration filed with Japan on an international registration date under Article 10(2) of the Geneva Act (hereinafter referred to as "date of the international registration"). Paragraph 2 of this Article provides that an international application for design registration containing two or more designs based on the provision of Article 5(4) of the Geneva Act shall be deemed to be an application for design registration filed for each design that is the subject of an international registration (hereinafter referred to as “international registration”) under Article 1(vi) of the Geneva Act (hereinafter, an international application deemed to be an application for design registration under these provisions shall be referred to as “international application for design registration”).

As Article 14(1) of the Geneva Act provides that the international registration shall, from the date of the international registration, have at least the same effect as a regularly filed application in each designated Contracting Party, Paragraph 3 and Paragraph 4 of this Article provide that as matters necessary for proceeding with the international application for design registration as the Japanese application for design registration, matters recorded on International Register as provided in Article 1(viii) of the Geneva Act (hereinafter referred to as "International Register") shall be deemed to be the matters stated in an application and the matters depicted in drawings as provided in Article 6(1) of the Design Act.
(Note) Examination of the international application for design registration

The Geneva Act provides that the international registration under the same Act shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly filed application for the grant of protection of the industrial design under the law of that Contracting Party (Article 14(1) of the Geneva Act), while provides that the Office of any designated Contracting Party designated under the Geneva Act may, where the industrial designs that are the subject of an international registration do not meet the conditions for the grant of protection under the law of that designated Contracting Party (excluding requirements relating to the form of or matters stated in the application), refuse the effects of the international registration (Article 12(1) of the Geneva Act).

As the Japanese Design Act provides that applications for design registration shall be examined as a premise of the grant of protection by the design right (Article 16 of the Design Act), the international registration designating Japan under the Geneva Act shall be also examined based on the provision of the Design Act that is the Japanese law.
Chapter II Finding of the Design in an International Application for Design Registration

112 Relevant provisions

Design Act: Article 6, Article 60-6  
Ordinance for Enforcement of the Design Act: Article 2, Article 2-2, Article 2-3,  
Article 2-4, Article 3, Article 4,  
Article 5  
Geneva Act: Article 5(1), (2), Article 6  
Common Regulations of the Hague Agreement(Note): Rule 7 to Rule 11  
Administrative Instructions of the Hague Agreement(Note): Section 401 to Section 408

(Note)  
These are abbreviations of the Common Regulations under the 1999 Act and the  
1960 Act of the Hague Agreement and the Administrative Instructions for the  
Application of the Hague Agreement.

112.1 Relationship of the matters recorded on the International Register with the  
matters to be stated in an application or drawings of an application for design registration

With regard to the matters to be stated in an application of the application for design registration under Article 6(1) of the Design Act, prescribed matters recorded in the International Register shall be treated as matters to be stated in an application of the application for design registration pursuant to Article 60-6 (3) of the Design Act (Table 1).

With regard to the matters to be stated in an application other than those as provided in Art 6(1) of the Design Act, as the international application for design registration shall be regarded as the domestic application for design registration, among the matters recorded in the International Register for the international application for design registration, the matters whose specific relationship is not explicitly provided in the Design Act shall be treated as equivalent to the matters stated in an application of the application for design registration (Table 2).

A person requesting a design registration in Japan should attach “drawings depicting the design for which registration is requested” to an application under Article 6(1) of the Design Act. Article 60-6(4) of the Design Act provides that “design recorded in the International Register” for the international application for design registration shall be regarded as “design for which registration is requested” depicted in drawings submitted under Article 6(1) of the Design Act, so in the case of the international application for design registration, the drawings depicting the
design recorded in the International Register namely “a reproduction of the design recorded in the International Register” shall be treated as equivalent to “drawings depicting the design for which registration is requested” (Table 3).

[Table 1] Relationship of matters provided in Article 6(1) of the Design Act

<table>
<thead>
<tr>
<th>Matters recorded on the International Register</th>
<th>Matters stated in an application of the application for design registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>one or more products that constitute a design that is the subject of an international registration, or one or more products that will use a design that is the subject of an international registration; (Article 5(1)(iv) of the Geneva Act)</td>
<td>the article to the design;</td>
</tr>
<tr>
<td>the name, and domicile or residence of the registered person of an international registration; (Article 5(1)(ii) of the Geneva Act, Rule 7(3)(i) and (ii) of the Common Regulations of the Hague Agreement)</td>
<td>the name, and domicile or residence of the applicant for design registration;</td>
</tr>
<tr>
<td>the name and the domicile of a person who has created a design that is the subject of the international registration; (Article 5(2)(b)(i) of the Geneva Act, Rule 7(5)(a) of the Common Regulations of the Hague Agreement)</td>
<td>the name, and the domicile or residence of a person who has created a design;</td>
</tr>
</tbody>
</table>

[Table 2] Relationship of matters other than those provided in Article 6(1) of the Design Act

<table>
<thead>
<tr>
<th>Matters recorded on the International Register</th>
<th>Matters stated in an application of the application for design registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application; (Article 5(2)(b)(ii) of the Geneva Act)</td>
<td>the description of the design or the description of the article to the design;</td>
</tr>
<tr>
<td>* Any of them is stated in a column of [Description of the Design] in</td>
<td></td>
</tr>
</tbody>
</table>
Part XI International Application for Design Registration
Chapter II Finding of the Design in an International Application for Design Registration

<table>
<thead>
<tr>
<th>Act, Rule 7(5)(a) of the Common Regulations of the Hague Agreement</th>
<th>an international application for design registration without identifying them.</th>
</tr>
</thead>
<tbody>
<tr>
<td>the reference to the principal application or registration, or to the principal design; (Article 5(1)(vii) of the Geneva Act, Rule 7(5)(f) of the Common Regulations of the Hague Agreement, Section 407(a) of the Administrative Instructions of the Hague Agreement)</td>
<td>the indication of the principal design;</td>
</tr>
<tr>
<td>declaration concerning exception to lack of novelty; (Article 5(1)(vii) of the Geneva Act, Rule 7(5)(f) of the Common Regulations of the Hague Agreement, Section 408(c)(i) of the Administrative Instructions of the Hague Agreement)</td>
<td>the statement of “an application for design registration seeking the application of the provision of Article 4(2) of the Design Act” in the column of [Special Matter];</td>
</tr>
<tr>
<td>a declaration claiming the priority of an earlier filing; (Article 6(1)(a) of the Geneva Act, Rule 7(5)(c) of the Common Regulations of the Hague Agreement)</td>
<td>the priority claim under the Paris Convention, etc.;</td>
</tr>
</tbody>
</table>

[Table 3] Relationship of reproductions of the design with drawings

| any reproduction of the design recorded on the International Register; (Rule 15(2)(ii) of the Common Regulations of the Hague Agreement) | drawings stating the design for which the design registration is requested; |

Hereinafter, in an international application for design registration, matters which are found to be stated in an application submitted under Article 6(1) of the Design Act shall be referred to as a “statement in an application of an international application for design registration”, and matters which are found to be stated in
drawings submitted under Article 6(1) of the Design Act shall be referred to as a “statement in drawings of an international application for design registration”.

112.2 Finding of the Design in an International Application for Design Registration

The finding of the design in an international application for design registration shall be made taking into consideration the above-described handling of a statement in an application and drawings of an international application for design registration and applying standards for finding of the design in a domestic application for design registration (see Part 1 “Application/Drawings”, Chapter 2 “Finding of the Design in an Application for Design Registration”).

Additionally, a statement in an application of an international application for design registration shall be found based on a statement written in English.
Chapter III Requirements for Design Registration for International Application for Design Registration

In order for the subject matter of an application for design registration filed as an international application for design registration (Note) to be registered, it must comply with all of the following requirements.

(Note)

The subject matter of an application for design registration filed as an international application for design registration refers to the subject matter for which the examiner has yet to make the determination as to whether or not it is categorized as a design as defined in Article 2(1) of the Design Act.

(1) The subject matter is an industrially applicable design (→113.1)
(2) The subject matter is novel (→113.2)
(3) The subject matter involves creative difficulty (→113.3)
(4) The subject matter is not a design in a later application that is identical or similar to part of a design in a prior application (→113.4)

113 Relevant provisions

Design Act: Article 2(1), (2), Article 3, Article 3-2, Article 60-6(1)
Ordinance for Enforcement of the Design Act: Form No. 6 Notes (7) to (10), Notes (12) to (16), Notes (18) to (21), Note (25)
Geneva Act: Article 12(1)
Common Regulations of the Hague Agreement: Rule 7 to Rule 11

113.1 Industrially applicable design

In order for the subject matter of an application for design registration filed as an international application for design registration to be categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act, it must comply with all of the following requirements.

Therefore, the subject matter that does not comply with any of the following requirements is not categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act, and therefore may not be registered.

(1) The subject matter constitutes a design (→113.1.1)
(2) The subject matter is a specific design (→113.1.2)
(3) The subject matter is an industrially applicable design (→113.1.3)
113.1.1 The subject matter constitutes a design

With regard to the requirement that the subject matter constitutes a design, see Part II "Requirements for Design Registration", Chapter I "Industrially Applicable Design", 21.1.1 "The subject matter constitutes a design".

113.1.2 The subject matter is a specific design

The design for which the design registration is requested, which is the object of a design right, must be one for which contents of a specific single design, that is, specific contents concerning (i) and (ii) below, can be directly derived from the statement in an application and drawings of an international application for design registration, based on the ordinary skill in the art of the design.

(i) The usage and function based on the purpose of use, state of use, etc. of the article to the design

(ii) The form of the article to the design

(1) Examples of cases where the subject matter is not found to be a specific design

Requirements for forms and matters to be stated of an application and drawings, etc., which a domestic application for design registration should satisfy are not imposed on an international application for design registration. However, during the examination of an international application for design registration, where the statement in an application or drawings of the international application for design registration is in the state equivalent to the state of improper description in case of the domestic application for design registration ((i) to (xviii) shown in Part II "Requirements for Design Registration", Chapter I "Industrially Applicable Design", 21.1.2 "The subject matter is a specific design" (1) Examples of cases where the subject matter is not found to be a specific design"), and where contents of a specific single design cannot be directly derived consequently upon making comprehensive determination based on the statement in the application and drawings of said international application for design registration, the subject matter is not found to be a specific design.

With regard to any other standards for determining if the subject matter is a specific design, see Part II "Requirements for Design Registration", Chapter I "Industrially Applicable Design", 21.1.2 "The subject matter is a specific design".
113.1.3 The subject matter is an industrially applicable design

With regard to industrial applicability, see Part II “Requirements for Design Registration”, Chapter I “Industrially Applicable Design”, 21.1.3 “The subject matter is an industrially applicable design”.

113.2 Novelty

113.2.1 Article 3(1)(i) of the Design Act

Designs that were publicly known in Japan or a foreign country prior to the filing of the application for design registration

113.2.1.1 Prior to the filing of the application for design registration

"Prior to the filing of the application for design registration" takes into consideration the exact time of the filing,\(^\text{(Note)}\) unlike the date of the filing of an application for design registration (Articles 9 and 10 of the Design Act, etc.) which is determined on a daily basis.

However, in an international application for design registration, the time of an application shall be defined on a daily basis under Article 14(1) of the Geneva Act and Article 60-6(1) of the Design Act, and the exact time cannot be specified. Therefore, where the filing date of an international application for design registration and the date adopted as the time when a publicly known design was publicly known are the same, the time when said publicly known design was publicly known is not judged to be earlier than the international application for design registration.

(Note)

In the case of a “design that was publicly known in a foreign country,” the exact time at which the design became publicly known in the country or region is converted into Japan time to make the determination.

With regard to any other determination standards for applying Article 3(1)(i) of the Design Act, see Part II “Requirements for Design Registration”, Chapter II “Novelty”, 22.1.1 “Article 3(1)(i) of the Design Act”.

113.2.2 Article 3(1)(ii) of the Design Act

Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration
113.2.2.1 Prior to the filing of the application for design registration

“Prior to the filing of the application for design registration” takes into consideration the exact time of the filing, unlike the date of the filing of an application for design registration (Articles 9 and 10 of the Design Act, etc.) which is determined on a daily basis.

However, in an international application for design registration, the time of an application shall be defined on a daily basis under Article 14(1) of the Geneva Act and Article 60-6(1) of the Design Act, and the exact time cannot be specified. Therefore, where the filing date of the international application for design registration as the date adopted as the time when the publication was distributed or the time when the design was made publicly available through an electric telecommunication line are the same, the time when said publication was distributed or the time when the design was made publicly available through an electric telecommunication line is not judged to be earlier than the filing of the international application for design registration.

(Note)

In the case of a “design that was described in a distributed publication, or a design that was made publicly available through an electric telecommunication line in a foreign country,” the exact time at which the publication in which the design was described was distributed or the exact time at which the design was made publicly available through an electric telecommunication line in the country or region is converted into Japan time to make the determination.

With regard to any other determination standards for applying Article 3(1)(ii) of the Design Act, see Part II “Requirements for Design Registration”, Chapter II “Novelty”, 22.1.2 “Article 3(1)(ii) of the Design Act”.

113.2.3 Article 3(1)(iii) of the Design Act

With regard to Article 3(1)(iii) of the Design Act, see Part II “Requirements for Design Registration”, Chapter 2 “Novelty”, 22.1.3 “Article 3(1)(iii) of the Design Act”.

113.3 Creative difficulty

113.3.1 Prior to the filing of the application for design registration

“Prior to the filing of the application for design registration” takes into consideration the exact time of the filing, as in the case of “prior to the filing of
the application for design registration” as provided in Article 3(1)(i) or (ii) of the Design Act, and differs from the date of the filing of an application for design registration (Articles 9 and 10 of the Design Act, etc.) which is determined on a daily basis.

However, in an international application for design registration, the time of filing shall be defined on a daily basis under Article 14(1) of the Geneva Act and Article 60-6(1) of the Design Act, and the exact time cannot be specified. Therefore, when the filing date of an international application for design registration and the date adopted as the time when publicly known shapes, patterns or colors, or any combination thereof were publicly known are the same, the time when said publicly known shapes, patterns or colors or any combination thereof were publicly known is not judged to be earlier than the international application for design registration.

Also, the reference time for determining whether or not an ordinary person skilled in the art of the design would have been easily able to create the design is prior to the filing of the application for design registration.

With regard to any other determination standards concerning application of creative difficulty, see Part II “Requirements for Design Registration”, Chapter 3 “Creative Difficulty”.

113.4 Exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application

113.4.1 Time requirement concerning application of the provision of Article 3-2 of the Design Act

As the provision of Article 3-2 of the Design Act applies to an application for design registration (excluding an application to which the provision of the proviso applies) that is filed during the period from the filing date of the prior application for design registration to the date of publication (including said date) of the Design Bulletin for said application for design registration (Registered Design Bulletin or Bulletin for giving public notice of an application for which refusal has become final and binding in the case where no agreement was reached by consultations or consultations were unable to be held where two or more applications have been filed for identical or similar designs on the same date), it shall be handled that Article 3-2 of the Design Act shall apply when the filing date of an international application for design registration is the same as the publication date of the Design Bulletin of a prior application.
With regard to any other determination standards for application of exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application, see Part II "Requirements for Design Registration", Chapter IV "Exclusion from Protection of a Design in a Later Application That is Identical or Similar to Part of a Design in a Prior Application".
Chapter IV Exception to Lack of Novelty Concerning International Application for Design Registration

114 Relevant provisions

Design Act: Article 4, Article 60-7
Ordinance for Enforcement of the Design Act: Article 1-2, Article 1-3, Form No. 1, Form No. 1-2
Administrative Instructions of the Hague Agreement: Section 408(c)

114.1 Provision of Article 60-7 of the Design Act

In order that an international application for design registration also may receive application of the Provisions of Article 4(2) of the Design Act, procedures that can be employed in case of an international application for design registration are provided.

114.1.1 Specific procedures for receiving application of the provision of Article 4(2) of the Design Act in case of an international application for design registration

(1) Submit a document stating a request for the application for the provision of Article 4(2) of the Design Act to the Commissioner of the Patent Office within 30 days as provided in Article 1-2 of the Ordinance of Enforcement of the Design Act after the date of an international publication (Article 4(3) of the Design Act, Article 60-7 of the Design Act) or a Declaration to that effect in an international application of design registration (Section 408(c) of the Administrative Instructions of the Hague Agreement, Article 27-4 of the Ordinance for Enforcement of the Patent Act as applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act)

(2) Submit a document proving that the design which has fallen under the category of a publicly known design is a design that is subject to application of the provision of Article 4(2) of the Design Act within 30 days as provided in Article 1-2 of the Ordinance of Enforcement of the Design Act after the date of an international publication (Article 4(3) of the Design Act, Article 60-7 of the Design Act)

(3) Submit a document of submission of a certificate for requesting the exception to lack of novelty prepared according to the Form No. 1 as provided in Article 1 of the Ordinance for Enforcement of the Design Act
With regard to any other determination standards for application of the exception to lack of novelty, see Part III "Exception to Lack of Novelty".
Chapter V Provisions of Article 5 Concerning International Application for Design Registration

With regard to determination standards for application of provisions of Article 5 of the Design Act, see Part IV “Unregistrable Designs.”
Chapter VI  One Application per Design Concerning International Application for Design Registration

116 Relevant provisions

Design Act: Article 7, Article 60-6(2), (3)
Ordinance for Enforcement of the Design Act: Article 2-4, Article 7, Form No. 2 Note (39), Appended Table 1, Notes
Geneva Act: Article 13(1)

116.1 Provision of Article 60-6(2) of the Design Act

Article 60-6(2) of the Design Act provides that an international application for design registration containing two or more designs shall be regarded as an application for design registration filed for each design which is the subject of an international registration in Japan. “A design which is the subject of an international registration” shall, however, mean a unit of designs in the international registration based on determination by the International Bureau and does not directly mean a unit of designs according to a classification of articles provided in Appended Table 1 to the Ordinance for Enforcement of the Design Act or a classification equivalent in level to such classifications under Article 7 of the Design Act.

Accordingly, an international application for design registration which does not comply with Article 7 of the Design Act shall be treated as falling under reasons for refusal under Article 7 of the Design Act.

116.1.1 Classification of Articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry

For details of the classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry, see Part V “One Application per Design” and 51.1.1 “Classification of Articles as provided by an Ordinance of the Ministry or Economy, Trade and Industry”.

116.1.2 Examples of cases of International Applications of Design Registration that do not comply with the requirements provided in Article 7 of the Design Act

116.1.2.1 Examples of statements in the column of “Article to the Design” that are not based on classification of articles

The statements in the column of “Article to the Design” shown in Part V “One Application per Design”, 51.1.2.1 “Examples of statements in the
column of "Article to the Design" in the application that are not based on classification of articles" are not according to the classification of articles or a classification equivalent in level to such classifications.

However, as an application of the international application for design registration is written in English, (5) a statement using foreign characters and (6) a statement using foreign language words that are not commonly used in Japanese shall be excluded.

116.1.2.2 Examples of applications that are not filed for each design

Where an international application for design registration falls under either of the following when making comprehensive determination based on the statement in the application and drawings, the application is regarded as containing two or more designs and is not found to be an application for design registration filed for each design.

(1) Where two or more classifications of articles are stated in parallel in the column of "Article to the Design" of the application

However, this excludes the notation of the entire types in a plurality form (for example, “Desks”) or an international application for design registration which can be found to be filed for a design for a set of articles.

(2) Where drawings of two or more articles are indicated (including the case where multiple articles are arranged in the drawings)

However, this excludes cases where an international application for design registration can be found to be filed for a design for a set of articles.

116.1.2.3 Handling in the case of partial design

With regard to handling in the case of partial design, see Part XI "International Application for Design Registration", Chapter 8 "International Application for Design Registration for a Partial Design", 118.1.6 "One Application per Design concerning an International Application for Design Registration for a Partial Design".
Chapter VII Provisions of Article 9 of the Design Act Concerning International Application for Design Registration

With regard to the determination standards concerning application of Article 9 of the Design Act, see Part VI “Prior Application”.
Chapter VIII International Application for Design Registration for a Partial Design

118 Relevant provisions

Design Act: Article 2(1), (2), Article 60-6(1)
Ordinance for Enforcement of the Design Act: Form No. 6 Note (11), Note (14), Form No. 8 Note (3)
Common Regulations of the Hague Agreement: Rule 9(2)(b)
Administrative Instructions of the Hague Agreement: Section 403

118.1 Handling of a partial design in an international application for design registration

In an international application, indicating "the matter" which is shown in drawings but “for which protection is not sought” is allowed to be indicated in the description or by means of dotted or broken lines or coloring (Rule 9(2)(b) of the Common Regulations of the Hague Agreement, Section 403 of the Administrative Instructions of the Hague Agreement). This expression of “the matter for which protection is not sought” is not explicitly scheduled in the Japanese Design Act but on the premise of the purport of the international registration system based on the Geneva Act, among an international application for design registration which represents “the matter for which protection is not sought”, said “matter for which protection is not sought” corresponds to “the parts other than the part for which the design registration is requested” (hereinafter referred to as “any other part”) of article to the design, as a result of which the subject matter which can clearly find the part for which “the part for which the design registration is requested” namely shapes, patterns or colors, or any combination thereof of a part of an article which is reasonably found as an application seeking design registration shall be treated as a Japanese application for a partial design.

118.1.1 Statement in the application and drawings of an international application for design registration for a partial design

118.1.1.1 Statement in the application of an international application for design registration for a partial design

(1) Statement in the column of [Article to the Design]

With regard to the statement in the column of [Article to the Design], see Part VII “Individual Applications for Design Registration”, Chapter 1 “Partial Design”, 71.2.1 “Matters to be stated in the application of an application for design registration for a partial design”, (2) “Statement
in the column of “Article to the Design” and Part XI “International Application for Design Registration”, Chapter VI “One Application per Design Concerning International Application for Design Registration”.

(2) Statement in the column of [Description of Design]

In an international application for design registration for a partial design, “the matter” which is shown in a drawing but “for which protection is not sought” may be stated in the column [Description of Design] (Section 403 of the Administrative Instructions of the Hague Agreement).

118.1.1.2 Statement in drawings of an international application for design registration for a partial design

In an international application for design registration for a partial design, the “matter” which is shown in drawings but “for which protection is not sought” may be indicated by means of dotted or broken lines or coloring (Section 403 of the Administrative Instructions of the Hague Agreement).

118.1.2 Finding of a design in an international application for design registration for a partial design

A design in an international application for design registration for a partial design shall be found with respect to the following points by making comprehensive determination based on the statement in an application and drawings of an international application for design registration.

(i) The article to the design of a partial design
(ii) The usage and function of the “part for which the design registration is requested”
(iii) The position, size and scope of the “part for which the design registration is requested”
(iv) The form of the “part for which the design registration is requested”

With regard to finding of the above-described (i) to (iv), see Part VII “Individual Applications for Design Registration”, Chapter 1 “Partial Design”, 71.3 “Finding of a design in an application for design registration for a partial design” and Part XI “International Application for Design Registration”, Chapter II “Finding of the Design in an International Application for Design Registration”, 112.2 “Finding of the Design in an International Application for Design Registration”.

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118.1.3 Requirements for design registration concerning a partial design

In order for the subject matter of an international application for design registration for a partial design(Note) to be registered, it must comply with all of the following requirements, equivalent to the case of an international application for design registration for a whole design.

(Note)
The subject matter of an international application for design registration for a partial design refers to the subject matter for which the examiner has not yet to make the determination as to whether or not it is categorized as a design as defined in Article 2(1) of the Design Act.

(1) The subject matter is an industrially applicable design (→118.1.3.1)
(2) The subject matter is novel (→118.1.3.2)
(3) The subject matter involves creative difficulty (→118.1.3.3)
(4) The subject matter is not a design in a later application that is identical or similar to part of a design in a prior application (→118.1.3.4)

118.1.3.1 Industrially applicable design

In order for the subject matter of an international application for design registration for a partial design to be categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act, it must comply with all of the following requirements.

Therefore, the subject matter that does not comply with any of the following requirements is not categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act, and therefore may not be registered.

(1) The subject matter constitutes a design (→118.1.3.1.1)
(2) The subject matter is a specific design (→118.1.3.1.2)
(3) The subject matter is industrially applicable (→118.1.3.1.3)

118.1.3.1.1 The subject matter constitutes a design

With regard to the subject matters constituting a design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.4.1.1 “The subject matter constitutes a design”.
118.1.3.1.2 The subject matter is a specific design

First, it must be possible to inevitably derive that a design for an international application for design registration corresponds to a partial design under the Japanese Design Act by making a comprehensive determination based on the statements in the columns of "Article to the Design" and "Description of Article to the Design" of the application and drawings of said international application for design registration.

Next, equivalent to the case of a whole design, contents of a specific single design, that is, specific contents concerning (i) through (iv) below should be directly derived from the statement in the application and drawings of an international application for design registration based on the ordinary skill in the art of the design.

(i) The article to the design of a partial design
(ii) The usage and function of the "part for which the design registration is requested"
(iii) The position, size and scope of the "part for which the design registration is requested"
(iv) The form of the "part for which the design registration is requested"

In addition, the form of the entire article to the design of the partial design, including the "part for which design registration is requested" and "any other part," must at least clearly represent the minimum constituent elements necessary for recognizing articles that belong to the classification of articles that is stated in the column of "Article to the Design" of the application.

With regard to the accuracy of the statement in the application and drawings of an international application for design registration for a partial design, the practice for a whole design applies, so see Part XI “International Application for Design Registration”, Chapter III “Requirements for Design Registration”, 113.1.2 “The subject matter is a specific design”.

(1) Examples of cases where subject matter is found to be a specific design

   see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design”, 71.4.1.2 “The subject matter is a specific design,” (1) “Examples of cases where subject matter is found to be a specific design” ii)
(2) Examples of cases where subject matter is not found to be a specific design

Where an application or drawings of the international application for design registration is in the following state, and where contents of a specific single design cannot be directly derived upon making comprehensive determination based on the statement in the application and drawings attached to the application, the subject matter is not found to be a specific design.

(i) Where it is unclear whether the international application for design registration is one for a partial design or one for a whole design, even by making comprehensive determination based on the statement in drawings of the international application for design registration, because there is no statement made on the way of specifying the "matter for which protection is not sought" in the column of "Description of the Design" of the application of the international application for design registration

(ii) Where it is unclear whether the international application for design registration is one for a partial design or one for a whole design or the form of "the part for which the design registration is requested" or "any other part" is unclear because the matter which is unclear whether it corresponds to shapes, patterns or colors, or any combination thereof of the article to the design is contained in the statement in drawings of the international application for design registration.

(iii) Where the specific usage and function of the article to the design of a partial design or the "part for which the design registration is requested" are unclear.

(iv) Where the entire form of the "part for which the design registration is requested" is not represented

(v) Where the position, size and scope of the part for which the design registration is requested occupying the entire design cannot be identified because the entire form of "any other part" is not represented or the views are inconsistent

(vi) Where the form of the entire article to the design of the partial design, including the "part for which design registration is requested" and "any other part," does not clearly represent the minimum constituent elements necessary for recognizing articles that belong to the classification of articles that is
stated in the column of “Article to the Design”
(vii) Where the form of the “part for which the design registration is requested” is unclear
i. Where the form of the “part for which the design registration is requested” is inconsistent in the respective views
ii. Where as the “part for which the design registration is requested” is not a closed area

118.1.3.1.3 The subject matter is industrially applicable
With regard to the subject matter being industrially applicable, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.4.1.3 “The subject matter is industrially applicable”.

118.1.3.2 Novelty
With regard to novelty, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.4.2 “Novelty”, Part XI “International Application for Design Registration”, Chapter III “Requirements for Design Registration for International Application for Design Registration”, 113.2.1 “Article 3(1)(i) of the Design Act” and 113.2.2 “Article 3(1)(ii) of the Design Act”.

118.1.3.3 Creative Difficulty
With regard to creative difficulty, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.4.3 “Creative Difficulty”, Part XI “International Application for Design Registration”, “Chapter III “Requirements for Design Registration for International Application for Design Registration”, 113.3 “Creative Difficulty”.

118.1.3.4 Design in a later application that is identical or similar to part of a design in a prior application
With regard to a design in a later application that is identical or similar to part of a design in a prior application, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.4.4 “Design in a later application that is identical or similar to part of a design in a prior application”, and Part XI “International Application for Design Registration”, Chapter III “Requirements for Design Registration for International Application for Design Registration”, 113.4 “Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to
Part of a Design in a Prior Application”.

118.1.4 Exception to lack of novelty concerning an international application for design registration for a partial design

With regard to exception to lack of novelty concerning an international application for design registration for a partial design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.5 “Exception to lack of novelty concerning an application for design registration for a partial design”, and Part XI “International Application for Design Registration”, Chapter IV “Exception to Lack of Novelty concerning International Application for Design Registration”.

118.1.5 Provisions of Article 5 of the Design Act concerning an international application for design registration for a partial design

With regard to determination standards for application of Article 5 of the Design Act concerning an international application for design registration for a partial design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.6 “Provisions of Article 5 of the Design Act concerning an application for design registration for a partial design”.

118.1.6 One application per design concerning an international application for design registration for a partial design

With regard to one application per design concerning an international application for design registration for a partial design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.7 “One application per design concerning an application for design registration for a partial design” and Part XI “International Application for Design Registration”, Chapter VI “One Application per Design Concerning International Application for Design Registration” (excluding 116.1.2.3 “Handling in the case of partial design).

118.1.7 Partial design pertaining to a design for a set of articles

With regard to a partial design pertaining to a design for a set of articles, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.8 “Partial design pertaining to a design for a set of articles”, Part XI “International Application for Design Registration”, Chapter IX “Design for a Set of Articles in International Application for Design Registration”.

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118.1.8 Provisions of Articles 9 and 10 of the Design Act concerning an international application for design registration for a partial design

With regard to the provisions of Articles 9 and 10 of the Design Act concerning an international application for design registration for a partial design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.9 “Provisions of Articles 9 and 10 of the Design Act concerning an application for design registration for a partial design” and Part XI “International Application for Design Registration”, Chapter VII “Provisions of Article 9 of the Design Act concerning International Application for Design Registration”.

118.1.9 Change of the gist concerning an international application for design registration for a partial design

118.1.9.1 Gist of design of a partial design

With regard to the gist of design of a partial design, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.10.1 “Gist of design of a partial design”.

118.1.9.2 Categories of amendments that change the gist

With regard to the categories of amendments that change the gist, see Part VII “Individual Applications for Design Registration”, Chapter I “Partial Design”, 71.10.2 “Categories of amendments that change the gist” and Part XI “International Application for Design Registration”, Chapter XII “Amendment of Statement in the Application/Drawing of International Application for Design Registration”, 1112.2.1.2.1 “Categories of amendments that change the gist”.

118.1.9.3 Specific handling of an amendment made to the statement in an application of an international application for design registration

(1) Amendment to supplement a statement concerning the way of specifying the “part for which the design registration is requested”

Where there was no statement concerning the way of specifying the “part for which the design registration is requested” in the column of “Description of the Design” as originally filed, and the “part for which the design registration is requested” is unclear and no specific design cannot be inevitably derived even by comprehensive determination based on the statement in the application and drawings, an amendment
to supplement a statement concerning the way of specifying the “part for which the design registration is requested” in the column of “Description of the Design” changes the gist.

Where there was no statement concerning the way of specifying the “part for which the design registration is requested” in the column of “Description of the Design” as originally filed, but it is clear that the international application for design registration is an international application for design registration for a partial design and the “part for which the design registration is requested” can be inevitably derived by making comprehensive determination based on the statement in the application and drawings, an amendment to supplement a statement concerning the way of specifying the “part for which the design registration is requested” in the column of “Description of the Design” of the application does not change the gist.

(2) Amendment to delete a statement concerning the way of specifying the “part for which the design registration is requested” with regard to an international application for design registration for a partial design

Where it can be inevitably derived that the international application for design registration is an international application for design registration for a partial design by making comprehensive determination based on the statement in the application and drawings as originally filed, an amendment to delete a statement concerning the way of specifying the “part for which the design registration is requested” from the column of “Description of the Design,” making it unclear whether the international application for design registration is one for a partial design or one for a whole design or making it unclear which part is the “part for which the design registration is requested” in the international application for design registration, changes the gist.

Where it can be inevitably derived that the international application for design registration is an international application for design registration for a whole design by making comprehensive determination based on the statement in the application and drawings as originally filed, an amendment to delete a statement concerning the way of specifying the “part for which the design registration is requested” from the column of “Description of the Design” of the application does not change the gist.
118.1.9.4 Specific handling of an amendment made to the drawing of an international application for design registration

(1) Amendment to make an international application for design registration for a partial design that includes two or more physically separate “parts for which the design registration is requested” into an international application for design registration for a partial design that includes one “part for which the design registration is requested”

An amendment, made when dividing an international application for design registration for a partial design that cannot be treated as one design because it includes two or more physically separate “parts for which the design registration is requested,” to correct a “part for which the design registration is requested” represented in the drawing of the international application of the original application for design registration for a partial design that coincides with a “part for which the design registration is requested” in the new divided application for design registration for a partial design into “any other part” does not change the gist.

In this case, an amendment to correct all “parts for which the design registration is requested” other than one “part for which the design registration is requested” represented in the drawing, etc. attached to the application into “any other part” without dividing the international application for design registration also does not change the gist.

(2) Amendment to change the form, etc. of the “part for which the design registration is requested”

An amendment to change the form of the “part for which the design registration is requested” exceeding the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design or an amendment that does not change the form itself of said part but an amendment to change the position, size or scope of the “part for which the design registration is requested” exceeding the scope of identity in the form of the entire article to the design of the partial design changes the gist.

In addition, where the form of the “part for which the design registration is requested” or the position, size or scope of the “part for which the design registration is requested” in the form of the entire article to the design of the partial design is unclear even by making comprehensive determination based on the statement in the application and drawings attached to the application as originally filed,
an amendment to make it clear changes the gist.

(3) Amendment to change the form of “any other part”

An amendment to change the form of the “part for which the design registration is requested” exceeding the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design by correcting a part of “any other part” to be depicted by a solid line or an amendment to change the position, size or scope of the “part for which the design registration is requested” in the form of the entire article to the design of the partial design exceeding the scope of identity that can be inevitably derived based on the ordinary skill in the art of the design by changing the outline shape of “any other part” changes the gist.

Where it can be inevitably derived that the international application for design registration is an international application for design registration for a partial design by making comprehensive determination based on the statement in the application and drawings as originally filed, an amendment to change the international application for design registration for the partial design into an application for design registration for a whole design by correcting “any other part” to be depicted solely by solid lines and also making necessary corrections to the statement of the application changes the gist.

(4) Amendment to delete broken lines etc. depicting “the matter for which protection is not sought”

Where broken lines etc. are depicted in the drawing as originally filed and it cannot be inevitably derived that broken lines etc. represent only additional elements relative to the entire form of the article to the design of the partial design as “the matter for which protection is not sought” by making comprehensive determination based on the statement in the application and drawings, an amendment to delete the broken lines etc. changes the gist.

Where broken lines etc. are depicted in the drawing as originally filed but it cannot be inevitably derived that broken lines etc. represent only additional elements relative to the entire form of the article to the design of the partial design as “the matter for which protection is not sought” by making comprehensive determination based on the statement in the application and drawings, an amendment to delete the broken lines etc. does not change the gist.
118.1.10 A new application for design registration resulting from division in the case of an international application for design registration for a partial design

With regard to a new application for design registration resulting from division in the case of an international application for design registration for a partial design, see Part VII "Individual Applications for Design Registration", Chapter 1 “Partial Design”, 71.11 “Division concerning an application for design registration for a partial design”.

118.1.11 International application for design registration for a partial design containing a priority claim under the Paris Convention, etc.

With regard to an international application for design registration for a partial design containing a priority claim under the Paris Convention, etc., see Part VII “Individual Applications for Design Registration”, Chapter 1 “Partial Design”, 71.13 “Application for design registration for a partial design containing a priority claim under the Paris Convention, etc.”, Chapter XIV “Procedure for Priority Claim under the Paris Convention, etc. concerning International Application for Design Registration”.

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Chapter IX Design for a Set of Articles in International Application for Design Registration

119 Relevant provisions

Design Act: Article 2(1), Article 8
Ordinance for Enforcement of the Design Act: Article 2-4, Article 8, Appended Table 2
Geneva Act: Article 5(1)(iv)
Common Regulations of the Hague Agreement: Rule 7(3)(iv)

119.1 Design for a set of articles
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”.

119.1.1 Requirements to be found as a design for a set of articles
In order for an international application for design registration to be registered as a design for a set of articles, it must comply with all of the following requirements.

(1) The subject matter stated in the column of “Article to the Design” is designated by an Ordinance of the Ministry of Economy, Trade and Industry
(→118.2.1.1.1)
(2) The constituent articles are appropriate
(→118.2.1.1.2)
(3) The set of articles is coordinated as a whole
(→118.2.1.1.3)

119.1.1.1 The subject matter stated in the column of “Article to the Design” are designated by an Ordinance of the Ministry of Economy, Trade and Industry
The subject matter stated in the column of “Article to the Design” must be designated by an Ordinance of the Ministry of Economy, Trade and Industry, that is, they must fall under any of the categories of a set of articles listed in Appended Table 2.

However, the language of an international application for design registration shall be English, so the subject matter that coincides with any of sets of designs listed in Appended Table 2 of the Ordinance of Enforcement of the Design Act may be stated as “a set of …” in the column of “Article to the Design”.

Where the subject matter stated in the column of “Article to the Design” are not designated by an Ordinance of the Ministry of Economy, Trade and Industry, they are not found to be a set of articles, and a notice
of the reason for refusal under Article 8 of the Design Act shall be given.

With regard to other determination standards for application of a design for a set of articles, see Part VII “Individual Applications for Design Registration”, Chapter II “Design for a Set of Articles”.

Chapter X Provisions of Article 10 of the Design Act Concerning International Application for Design Registration

With regard to determination standards for application of Article 10 of the Design Act, see Part VII “Individual Applications for Design Registration”, Chapter III “Related Design”.
Chapter XI Design Including a Graphic Image on a Screen in International Application for Design

1111 Relevant provisions

Design Act: Article 2(1), (2)
Ordinance for Enforcement of the Design Act: Article 2; Article 3; Form No. 2 Note (40), Form No. 6 Notes (8) to (11), Note (14), Note (21)

1111.1 Statement in the application and drawings of an international application for design registration including a graphic image on a screen

1111.1.1 Matters to be stated in the application of an international application for design registration including a graphic image on a screen

(1) Statement in the column of “Article to the Design”

When filing an international application for design registration for a design including a graphic image on a screen, the article that serves as the basis of the creation must be found to be an article subject to the Design Act. (“Graphical user interface for xx” is not categorized as an article to the design.)

A classification of articles listed in the right-hand column of Appended Table 1 or a classification of articles equivalent in level to such classification must be stated in English in the column of “Article to the Design” under Article 7 of the Design Act.

For example, in the case of a creation of a design of a video disc player, even where the graphic image on a screen which is the part for which the design registration is requested is displayed on a television receiver that is used with the article in an integrated manner, “it must be stated in the column of “Article to the Design” such as “Video disc player” because the article to the design which is the object of the right is a video disc player including the graphic image.

With regard to other determination standards for matters to be stated in the application of an international application for design registration including a graphic image on a screen, see Part XI “International Application for Design Registration”, Chapter II “Finding of the Design in an International Application for Design Registration”, 112.1 “Relationship of the matters recorded on the international register with the matters to be stated in an application or drawings of an application for design registration”.

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With regard to other requirements for design including a graphic image on a screen, see Part VII “Individual Applications for Design Registration”, Chapter IV “Design Including a Graphic Image on a Screen”; with regard to a whole design, see Part XI “International Application for Design Registration”, Chapter III “Requirements for Design Registration”; and with regard to a partial design, see Part XI “International Application for Design Registration for a Partial Design”.
Chapter XII Amendment of Statement in the Application/Drawing of International Application for Design Registration

1112 Relevant provisions

Design Act: Article 60-24, Article 68(2)
Ordinance for Enforcement of the Design Act: Article 15, Form No. 14
Patent Act: Article 17(3), (4); Article 17-2

1112.1 Amendment

With regard to the amendment, see Part VIII “Amendment of Statement in the Application/Drawings, etc.”, Chapter 1 “Amendment”.

1112.2 Dismissal of an amendment

1112.2.1 Dismissal of an amendment

1112.2.1.1 Gist of design and the finding of the gist of design

With regard to the gist of design and the finding of the gist of design, see Part VIII “Amendment of Statement in the Application/Drawings, etc.”, Chapter II “Dismissal of Amendments”, 82.1.1 “Gist of design and the finding of the gist of design”.

1112.2.1.2 Change of the gist

1112.2.1.2.1 Categories of amendments that change the gist

Where an amendment made to the statement in an application or drawings of an international application for design registration falls under any of Part VIII “Amendment of Statement in the Application/Drawings, etc.”, Chapter II “Dismissal of Amendments”, 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” or 82.1.2.1.2 “Where the amendment is found to clarify the gist of design that was unclear when originally filed”, it changes the gist of the statement in the application or drawings of the international application for design registration as originally filed.

1112.2.1.2.2 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 Part VIII “Amendment of Statement in the Application/Drawings, etc.,” Chapter II “Dismissal of Amendments”, 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” or 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” upon making comprehensive determination based on the application and drawings, the amendment does not change the gist of the statement in an application of an international application for design registration or drawings attached to the application as originally filed.

With regard to the amendment made to the statement in the application of an international application for design registration, it is determined based on comparison of the statement in English whether the amendment changes the gist or not in principle. If, however, explanation of an international application for design registration using languages other than English (French or Spanish) as the language of an international application was given based on statement in the language of the international application as originally filed, this shall be taken into consideration in determining if the gist is changed or not.
Chapter XIII Special Application for Design Registration Concerning International Application for Design Registration

With regard to a new application for design registration resulting from division in the case of an international application for design registration, see Part IX “Special Application for Design Registration,” Chapter I “Division of Applications for Design Registration” and Part XI “International Application for Design Registration”, Chapter VI “One Application per Design Concerning International Application for Design Registration”, 116.1.2 “Examples of International Applications of Design Registration not satisfying Requirements provided in Article 7 of the Design Act”; with regard to a new application for design registration for an amended design, see Part IX “Special Application for Design Registration,” Chapter IV “New Application for Amended Design”.
Chapter XIV Procedure for Priority Claim under the Paris Convention, etc.
concerning International Application for Design Registration

1114 Relevant provisions

Design Act: Article 15(1), Article 60-10
Ordinance for Enforcement of the Design Act: Article 12-2
Geneva Act: Article 6
Common Regulations of the Hague Agreement: Rule 7(5)(c)

1114.1 Provisions of Article 60-10 of the Design Act

The procedure for the priority claim concerning an international application for design registration is unified to the procedure through the International Bureau under Article 6(1) of the Geneva Act, so the procedure for priority claim to the Japan Patent Office shall not apply to an international application for design registration under Paragraph 1 of this Article.

As the procedure for submitting a priority certificate shall not be accompanied by an international application under the Geneva Act, the provisions of the procedure for submitting a priority certificate under the Patent Act shall also apply mutatis mutandis to “a person who claimed a priority under Article 6(1)(a) of the Geneva Act”.

A priority claim to "a specified country" provided in Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act shall not be permitted under Article 6(1)(a) of the Geneva Act, and shall not thus apply to an international application for design registration pursuant to Paragraph 1 of this Article.

1114.1.1 Effect of a priority claim under the Paris Convention, etc.

Pursuant to Article 60-10(1) of the Patent Act, a priority claim recognized under the Paris Convention for a citizen of “a specified country” provided in Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act shall not be permitted for an international application for design registration.

1114.1.1.1 Procedure for making a priority claim under the Paris Convention, etc.

A person who intends to make a priority claim for an international application for design registration under Article 4D(1) of the Paris Convention must follow the procedure provided in Article 6(1)(a) of the
Geneva Act and Article 43(2) and (3) of the Patent Act as applied mutatis
mutandis pursuant to Article 60-10(2) of the Design Act.

1114.1.2 Requirements for a priority claim under the Paris Convention, etc. to
be effective

A priority claim to an international application for design registration with a
priority claim based on the domestic application for design registration shall
not be effective.

With regard to any other determination standards concerning the procedure for
a priority claim under the Paris Convention etc., see Part X “Procedure for Priority
Claim under the Paris Convention, etc.”