Part XII Procedure of Examination

Chapter I Overview

121 Main provisions relating to the examination procedure

Article 16 (Examination by examiner) of the Design Act
Article 17 (Examiner's decision of refusal) of the Design Act
Article 17-2 (Dismissal of amendments) of the Design Act
Article 18 (Examiner's decision to the effect that a design registration is to be granted) of the Design Act
Article 50 (Notice of reasons for refusal) of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act
Article 52 (Formal requirements for decision) of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act
Article 12 of the Geneva Act (Refusal)

121.1 Basic policy of examination

The examiner conducts substantive examination as to whether or not a design right should be granted for an application for design registration. The examiner is required to make a fair determination based on a high level of expert knowledge.

The following points should be particularly taken into consideration in examination.

(1) Consistent examination should be conducted according to examination standards, etc., while taking into consideration the securing of promptness, accuracy, fairness and transparency.

(2) Effort should be made to maintain and further improve the quality of examination with regard to prior design searches and determination on the requirements for registration, etc.

(3) Efficient examination should be conducted, while taking into consideration the securing of communication with the applicants and their agents (hereinafter simply referred to as “applicant(s)”).

121.2 Outline of the examination processes

The examination procedure is outlined below. For details of each process, see “Chapter II Details.” Also, the main flow of the substantive examination is illustrated in a diagram.
(1) Finding of the design in an application for design registration (→ 122.1)

The examination starts from finding the design in an application for design registration (hereinafter referred to as the “design in the application”). In finding the design, comprehensive determination is made based on the statement in the application and drawings, etc. attached to the application. In addition, a review is conducted with regard to the requirements set forth in the main paragraph of Article 3(1), Article 7 and Article 8 of the Design Act.

(2) Prior design search (→ 122.2)

A prior design search is conducted to find (i) prior designs and (ii) shapes, patterns or colors, or any combination thereof, that were publicly known (or widely known) (hereinafter (i) and (ii) are collectively referred to as “prior designs, etc.”) which contribute to the determination on the requirements for registration, such as novelty and creative difficulty, (the items of Article 3(1), Article 3(2) and Article 3-2 of the Design Act), the requirements for a prior application (Article 9 of the Design Act) and the requirements for a related design (Article 10 of the Design Act) with regard to the design in the application.

(3) Review with regard to novelty, creative difficulty, etc. (→ 122.3)

A review is conducted as to whether or not the contents of the prior designs, etc. found in a prior design search constitute a reason for refusal relating to the requirements for registration, such as novelty and creative difficulty (the items of Article 3(1), Article 3(2) and Article 3-2 of the Design Act), the requirements for a prior application (Article 9 of the Design Act) and the requirements for a related design (Article 10 of the Design Act) with regard to the design in the application.

In addition, a review is conducted as to whether or not the application for design registration falls under any of the reasons for refusal provided in the items of Article 17 of the Design Act.

(4) Notice of reasons for refusal (→ 122.4, 122.5)

Where a reason for refusal is found as a result of the review, a notice of reasons for refusal is given (Article 50 of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act). The reason for refusal should be stated in plain language by describing the gist in an easy to understand manner.

In case of an international application for design registration, a notice of reasons for refusal shall be given through the notification of refusal to the International Bureau (Article 12 of the Geneva Act).
(5) Where a written opinion or a written amendment of proceedings has been submitted (→ 122.6)

Where a written opinion or a written amendment of proceedings has been submitted, after carefully reading the written opinion and fully understanding its contents, the respective matters asserted in the written opinion are reviewed, or the contents of the written amendment of proceedings are sufficiently reviewed and determination is made as to whether the reason for refusal that has been indicated previously has been overcome.

Where a written amendment of proceedings has been submitted, the design as originally filed and the amended design are compared, and confirmation is made that the gist of the statement in the application and drawings, etc. attached to the application as originally filed has not been changed.

Where an amendment made to the application or drawings, etc. changes the gist of design, the amendment is dismissed by a ruling.

(6) Examiner's decision (→ 122.7)

Where no reason for refusal is found, a decision of registration is rendered. Where the reason for refusal has been overcome through submission of a written opinion or a written amendment of proceedings, and no other reason for refusal is found, a decision of registration is rendered (Article 18 of the Design Act).

Meanwhile, where the reason for refusal of which notice was given is determined not to have been overcome after reviewing the contents of a written opinion or a written amendment of proceedings, a decision of refusal is rendered (Article 17 of the Design Act). When rendering a decision of refusal, the specific reason for the failure to overcome the reason for refusal of which notice was given is stated in plain language.