122.1 Finding of the design in an application for design registration

(1) Finding of a whole design (→ Part I, Chapter II)

As a premise for determining the novelty, creative difficulty, etc. of the design in the application, the contents of the design must be identified. This process is called “finding the design.”

In finding the design in the application, comprehensive determination is made based on the statement in the application and drawings, etc. attached to the application predicated on the ordinary skill in the art of the design (the skill of a person skilled in the art), with regard to the following points.

(i) The article to the design
(ii) The form of the article to the design

With regard to the article to the design, the usage and function of the article to the design are found based on the statements in the columns of “Article to the Design” and “Description of Article to the Design,” etc. of the application and drawings, etc. attached to the application.

With regard to the form of the article to the design, the form of the entire article to the design and the forms of the respective parts are found based on the drawings, etc. attached to the application and the statement in the column of “Description of the Design,” etc. of the application.

(2) Finding of a partial design (→ 71.3)

In finding the design in the application for a partial design, comprehensive determination is made based on the statement in the application and drawings, etc. attached to the application, with regard to the following points, after specifying the “part for which the design registration is requested.”

(i) The article to the design of the 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 the article to the design of the partial design, the usage and function of the article to the design of the partial design are found based on the statements in the columns of “Article to the Design” and “Description of Article to the Design,” etc. of the application and drawings, etc. attached to the application.

With regard to the usage and function of the “part for which the design registration is requested,” the determination is made based on the usage and function of the article to the design of the partial design which has been found as mentioned above.

With regard to the position, size and scope of the “part for which the design registration is requested,” the determination is made based on the drawings, etc. attached to the application and the statement in the application.

With regard to the form of the “part for which the design registration is requested,” the determination is made based on the drawings, etc. attached to the application and the statement in the column of “Description of the Design,” etc. of the application.

(3) Matters to consider in finding a design

In finding the design in the application, if an improper statement or depiction is found in the statement in the application or drawings, etc. attached to the application, determination is made as to whether or not it is reasonable to give a favorable construction to the improper statement or depiction in finding a specific design. (see 21.1.2 “The subject matter is a specific design”)

Note that where the contents of one creation can be identified by perceiving the disclosed area as a partial design, the subject matter is found to be a specific design even if the part that the applicant considers to be outside the scope of creation is not disclosed.

122.2 Prior design search

A prior design search is conducted to find 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.
Where the art of the design in the application cannot be specified, a review is conducted before the prior design search as to whether the design is an industrially applicable design (the main paragraph of Article 3(1) of the Design Act), whether the design does not comprise two or more designs (Article 7 of the Design Act), and in the case of a design for a set of articles, whether the design complies with the requirements to be recognized as a design for a set of articles (Article 8 of the Design Act), and if a reason for refusal is found, a notice of reasons for refusal is given. (See 72.1.1 “Requirements for being found to be a design for a set of articles”)

(1) Reference material

Information for use in examination in which are published prior designs, etc. which contribute to the determination on the novelty, creative difficulty, etc. of the design in the application is called a “reference material.”

After finding prior designs, etc. that are found to have common points with the design in the application in terms of the entire design or the forms of the respective parts, information for use in examination in which such prior designs, etc. are published is recorded as a reference material.

Where there is any information for use in examination in which prior designs, etc. are published that the examiner has consulted in understanding the design in the application and the art of the design, such information may be recorded as a reference material.

(2) Method of a prior design search

(i) In an application for design registration, the applicant is not required to state an explanation on which form of the design the applicant considered to be important or the part of the article to which particular weight is given. Accordingly, in order to set the scope of information for use in examination to be used in the prior design search and to extract reference materials, the examiner himself/herself must first assume the parts that draw attention in the form of the design and the extent to which they draw attention based on the statement in the application and drawings, etc. attached to the application, before conducting the prior design search. In making such assumption, in the case of an application for design registration for a related design, the common points in the forms between the related design and the principal design are also taken into consideration, and in the case where a feature statement has been submitted for the application for design registration, the contents of the
feature statement are also taken into consideration. (See 121.1 “Feature statement”)

(ii) A prior design search is conducted based on information for use in examination, such as applications for design registration, publicly known information (Japanese and foreign books, Japanese and foreign magazines, Japanese and foreign catalogs, Design Bulletins of Japanese and foreign patent offices, Internet websites), publications of unexamined patent applications, and publications of registered utility model applications.

(iii) Based on the examiner’s knowledge, experience and past examination determinations on applications for design registration in the art of the field of the design in the application, a decision is made on the scope of information for use in examination to be searched, and a search is conducted with priority on the field of articles that is highly relevant to the design in the application. Normally, the Japanese Classification for Industrial Designs that covers the article to the design of the design in the application is set as the scope of the search, based on the statement in the application and drawings, etc. attached to the application, and the search is conducted, starting with the applications for design registration and publicly known information that are categorized under that Japanese Classification for Industrial Designs.

(iv) Whether or not the scope of the search should be expanded is decided while taking into consideration the search results for the Japanese design classification that had been set as the scope of the search. In other words, where sufficient prior designs, etc. for reasonably determining the novelty, creative difficulty, etc. could not be found as a result of searching the information for use in examination categorized under the Japanese Classification for Industrial Designs that covers the article to the design of the design in the application, and where there is a search method by which prior designs, etc. for reasonably determining the novelty, creative difficulty, etc. are likely to be found, as in the examples below, a search method by which prior designs are likely to be able to be found most efficiently, considering both the promptness and accuracy of the search, is additionally used.
(Examples of prior design search methods to be used when expanding the scope of the search)

i. Where there is a Japanese design classification or an international design classification established by the Locarno Agreement(Note) (hereinafter referred to as “international design classification”) that is likely to cover articles that have commonality in their usage (purpose of use, state of use, etc.) and function with the article to the design of the design in the application, a search is conducted on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international design classification.

(Note)
Officially, the Locarno Agreement establishing an international classification for industrial designs signed at Locarno on October 8, 1968, as amended on September 28, 1979

ii. Where there is a Japanese design classification or an international design classification that is likely to cover prior designs, etc. in which any of the shapes, patterns or colors, or any combination thereof, which are constituent elements of the design in the application, is represented, a search is conducted on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international design classification.

iii. Where the design in the application is a design of a component or a partial design, and there is a Japanese design classification or the international design classification that covers articles that are likely to include prior designs in which the form of the component or the “part for which the design registration is requested” is disclosed as a part of such prior designs, a search is conducted on applications for design registration and publicly known information that are categorized under that Japanese design classification or that international design classification.

iv. Where the column of “Article to the Design,” “Description of Article to the Design” or “Description of the Design” of the design in the application contains words that are found to represent features of the article, a search
is conducted on applications for design registration that have those words included in their columns of "Article to the Design," "Description of Article to the Design" or "Description of the Design" and publicly known information that has those words included in "Article to the Design."

v. Where there is a technical field of patents that is related to the article to the design of the design in the application, and the form of the article is likely to be represented in publications of unexamined patent applications and publications of registered utility model applications, etc. in that technical field, a search is conducted on publications of unexamined patent applications and publications of registered utility model applications in that technical field.

vi. Where the design in the application is unlikely to comply with the requirement for registration of creative difficulty, a search is conducted, as needed, on information that serves as the basis for determining creative difficulty and information that serves as the basis for the fact that the design uses an ordinary technique for a person skilled in the art, etc.

vii. Where references are recorded for the prior designs that were found, a search is conducted on those reference materials of the prior designs.

viii. Where the applicant of the application for design registration has filed any application for design registration in the past, a search is conducted on that past application for design registration and its reference materials.

(3) Termination of a prior design search

Where sufficient prior designs, etc. for determining the novelty, creative difficulty, etc. have been found for the design in the application, or where it has become hardly likely to be able to find significant prior designs, etc. even by expanding the scope of the search, the prior design search may be terminated.

122.3 Review with regard to novelty, creative difficulty, etc.

A review is conducted as follows 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.

(1) Confirmation of bibliographic data of the information

In the case of considering application of the provisions of the items of Article 3(1) and Article 3(2) of the Design Act, the relationship between the date on which the prior design, etc. became publicly known and the reference date for the determination on the requirements for registration, etc. of the design in the application is confirmed. (In considering application of the provisions of the items of Article 3(1) and Article 3(2) of the Design Act, not only the date but also the exact time is to be taken into consideration.)

In the case of considering application of the provisions of Article 3-2, Article 9 and Article 10 of the Design Act, the relationships between the reference date for the determination on the requirements for registration, etc., the date of publication of the Design Bulletin and the applicant or the holder of the design right of the prior design (the design in the prior application), and the reference date for the determination on the requirements for registration, etc. and the applicant of the design in the application are confirmed.

(Article 3-2 of the Design Act)
See 24.1.6.1 "The applicant of the application for design registration and the applicant of the earlier application are the same person"
See 24.1.6.2 "The application for design registration was filed before the date when the Design Bulletin in which the earlier application was published (omitted)"
See 24.1.7 "Time requirement concerning application of the provision of Article 3-2 of the Design Act"

(Article 9 of the Design Act)
See 61.1.10 "Handling of applications for design registration filed for similar designs on different dates"
See 61.1.11 "Handling of applications for design registration filed for identical or similar designs on the same date"
See 61.1.12 “Reference date for determination on application of the provision of Article 9(1) or (2) of the Design Act with regard to division of an application for design registration, conversion of an application, or filing of a new application for an amended design”

See 61.1.13 “Reference date for determination on application of the provision of Article 9(1) or (2) of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.”

(Article 10 of the Design Act)

See 73.1.1.1 “The application for design registration is filed by the same applicant for design registration as that for the principal design”

See 73.1.1.3 “The application for design registration is filed on or after the filing date of the application for design registration for the principal design and before the publication date of the Design Bulletin for the principal design (omitted)"

Here, the “reference date for the determination on the requirements for registration, etc.” refers to any of the following dates.

(i) The filing date
(ii) The filing date of the first application that serves as the basis for the right of priority under the Paris Convention, etc.
(iii) The filing date of the original application in the case of a divisional application or a converted application
(iv) The date of submission of the written amendment of proceedings in the case of a new application following a ruling dismissing an amendment

Where the prior design found is a disclosed design for which application of the provisions on exception to lack of novelty (Article 4(1) or (2) of the Design Act) is requested, confirmation is made as to whether or not the request for application of the provisions on exception to lack of novelty complies with the prescribed requirements. (See Part III “Exception to Lack of Novelty”)

(2) Determination of similarity between designs in determining novelty, etc. (→ 22.1.3)

In considering a reason for refusal relating to novelty (the items of Article 3(1) of the Design Act), prior application (Article 9 of the Design Act) or 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), the comparison between the prior design and the design in the application and the determination are to be made while mainly giving consideration to the following points.

(i) In determining similarity between the design in the application and the prior design cited in the notice of reasons for refusal (hereinafter referred to as the “cited design”), consumers (including traders) should be the determining entity.

(ii) Determination should be made as to whether or not the usage and function of the article to the design of the design in the application and that of the cited design are identical or similar. This does not require judgment of similarity based on a comparison of the detailed usage and function of the articles, and it is sufficient to determine that there is similarity in the usage and function of the articles if the articles have commonality in their usage (purpose of use, state of use, etc.) and function.

(iii) After confirming that the cited design is sufficiently represented to a level comparable with the design in the application, comparing the design in the application and the cited design and finding the common points and different points in the forms of the entire articles to the design (basic constitution) and the forms of each part of the two designs, individual evaluation of the common points and different points is further conducted from the viewpoints in (i) and (ii) below.

i. Finding of whether or not the forms are parts that draw attention when comparatively observed and evaluation of the extent to which they draw attention

ii. Evaluation of the extent to which the forms draw attention in comparison to prior designs

With regard to a partial design, after finding the common points and different points in the usage and function, position, size, scope and form of the “part for which the design registration is requested,” individual evaluation of the common points and different points is further conducted. (See 71.4.2.2.1 "Determination of similarity between a publicly known design and a partial
(iv) Determination is made on whether or not the designs create different aesthetic impressions on consumers (including traders) when all common points and different points between the two designs are comprehensively observed as entire designs.

(3) Determination of creative difficulty (→ Part II, Chapter III)

The determination of creative difficulty (Article 3(2) of the Design Act) is made by reviewing whether or not the design in the application would have been easily created based on the prior designs, etc.

The determination of creative difficulty is to be made while mainly giving consideration to the following points.

(i) A person ordinarily skilled in the art of the design (a person skilled in the art) should be the determining entity for creative difficulty.

(ii) Confirmation is made that the information that serves as the basis for determination of creative difficulty is information that was publicly known or widely known. If it is information that was publicly known, evidence of such fact is confirmed.

(iii) Evidence of a specific fact showing that the design was created by an ordinary technique for a person skilled in the art is confirmed.

(4) Determination on whether or not the application for design registration falls under any of the items of Article 17 of the Design Act

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. For example, a review is conducted as to whether the design has grounds of unregistrability (the items of Article 5 of the Design Act), and whether the application for design registration is under a classification of articles as designated by the Ordinance of the Ministry of Economy, Trade and Industry or a classification of articles equivalent in level to such classification (Article 7 of the Design Act). (See Part IV “Unregistrable Designs”; see Part V “One Application per Design”)
122.4 Notice of reasons for refusal

Where a reason for refusal has been found, a notice of reasons for refusal is given to the applicant, and an opportunity to submit a written opinion is given to the applicant, designating an adequate time limit (Article 50 of the Patent Act as applied mutatis mutandis pursuant to Article 19 of the Design Act).

122.4.1 Matters to consider in giving a notice of reasons for refusal

In giving a notice of reasons for refusal, the reason for refusal should be specifically indicated so that the applicant can clearly understand the purport of the reasons for refusal, while mainly giving consideration to the following points.

(1) The reason for refusal should be stated in plain language insofar as possible by describing the key points in an easy to understand manner so as to make it easy for the applicant to understand.

(2) With regard to a design which is not specific and which is clearly not an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act, the improper part in the statement in the application and drawings, etc. attached to the application and the reason therefor should be specifically indicated. (See 21.1.2 “The subject matter is a specific design”)

(3) Where the design in the application falls under the items of Article 3(1), Article 3-2 or Article 9(1) of the Design Act and does not comply with such requirements as novelty, prior application, etc., the reason for the determination in the examination should be specifically indicated in the notification of reasons for refusal. Also, in specifying a cited design, information identifying the source of the cited design (document name, date of publication, issue number, volume, the relevant page, the relevant position on the page, etc.) should be stated. In doing so, if the design in the application is a design of a component or a partial design, the part cited for making the comparison and determination should be clearly indicated as needed.

Meanwhile, where the design in the application falls under both the provision of Article 3-2 of the Design Act and the provision of Article 9(1) of
the Design Act (where the design in the application and the design in the prior application are identical or similar partial designs, and their applicants are not the same), the provision of Article 3-2 of the Design Act should be applied in examination practice. (See 71.9.1.1 “Examples of applications for design registration for partial designs that are found to be similar under Article 9(1) of the Design Act”)

(4) Where the design in the application falls under the provision of Article 3(2) of the Design Act and does not comply with the requirement for registration of creative difficulty, the reason for the determination in the examination should be specifically indicated in the notification of reasons for refusal. In doing so, the information that serves as the basis for determination of creative difficulty and a specific fact showing that the design was created by an ordinary technique for a person skilled in the art should be presented, unless they are so obvious that such presentation is not required. (See 23.6 “Presentation of information that serves as the basis for determination of creative difficulty”; see 23.7 “Presentation of the fact that the design uses an ordinary technique for a person skilled in the art”)

In presenting information that serves as the basis for determination of creative difficulty, information identifying the source (document name, date of publication, issue number, volume, the relevant page, the relevant position on the page, etc.) should be stated.

Meanwhile, the provision of Article 3(2) of the Design Act is applied only where the design in the application is not any of the designs provided in the items of Article 3(1) of the Design Act. (See 23.8 “Application of the items of Article 3(1) of the Design Act”)

(5) Where the application for design registration does not comply with the requirement of one application per design provided in Article 7 of the Design Act, the reason that the application is not found to be filed for each design in accordance with a classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry or a classification of articles equivalent in level to such classification should be specifically indicated in the notification of reasons for refusal. (See Part V “One Application per Design”)

360
122.4.2 Securing of communication with the applicant

(1) Where it is found to contribute to prompt and accurate examination, the examiner should utilize telephone, facsimile, interviews, etc. as supplementary means for securing communication with the applicant, and make effort to deal with the applicant in a careful and easy-to-understand manner. Interviews, etc. are held based on “Interview Guidelines [Design Examination],” and an interview record or a response record is prepared in order to secure the transparency of the procedure. Where there is an agent for the application for design registration, the interview, etc. is held with the agent, in principle.

Note that where the form of the entire article to the design is not disclosed, but there is no specific reason for refusal, such as in the case where the contents of one creation can be identified when the disclosed area is perceived as a partial design for which the design registration is requested, the examiner will not confirm the intention of the applicant or encourage him/her to make amendments with regard to the parts that are not disclosed.

(2) Such practice should be ensured to maintain or secure the continuity of examination even if the examiner in charge is changed. In the case of making a determination that differs from that of the prior examiner in charge, consideration should particularly be given to the communication with the applicant.

122.5 Notification of refusal in case of an international application for design registration

In case where an international application for design registration does not satisfy conditions for grant of protection under the Japanese laws and regulations, a notification of refusal shall be given (Article 12(1) and (2) of the Geneva Act).

122.5.1 Notification of refusal

When giving a notification of refusal, the following points should be considered.

(1) Cases where an international application for design registration does not comply with conditions for granting protection under the Japanese
laws and regulations include the following cases:

(i) A case where said international application for design registration falls under reasons for refusal (the items of Article 17 of the Design Act) (A notice of reasons for refusal in case of an international application for design registration shall be given through the notification of refusal)

(ii) A case where waiting until procedures or dispositions for said international application for design registration has become final and binding is necessary

(iii) A case where waiting until dispositions for an application other than said international application for design registration have become final and binding is necessary (a wait notice)

Where a notification of refusal is given once, during the subsequent procedures, a notice of reasons for refusal, etc. shall be given not through a notification of refusal but through a normal notice of reasons for refusal, etc.

(2) Where an international application for design registration falls under any of the above-described (1)(i) to (iii), a notification of refusal shall be given to the International Bureau within 12 months after an international publication (Article 12(2)(a) of the Geneva Act, Regulation 18(1)(b) of the Common Regulations of the Hague Agreement).

(3) All reasons(Note) as a basis shall be stated in a notification of refusal (Article 12(2)(b) of the Geneva Act), and further a notification of refusal shall refer to main provisions of corresponding laws and regulations to said reasons (Rule 18(2)(iii) of the Common Regulations of the Hague Agreement).

(Note)

“All reasons” to be stated in a notification of refusal shall be reasons that can be presented when giving a notification of refusal and fall within the reasonable range to be noticed at the same time.

(4) A notification of refusal shall be given in English (Rule 6(3)(i) of the
122.6 Where a written opinion or a written amendment of proceedings has been submitted

(1) Review of the contents of the written opinion or the written amendment of proceedings

Where a written opinion or a written amendment of proceedings has been submitted after giving a notice of reasons for refusal, 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 earlier has been overcome.

(2) Handling of a written amendment of proceedings

Where an amendment made to the application or drawings, etc. is found to change the gist of the statement in the application and drawings, etc. attached to the application as originally filed (the cases indicated in (i) and (ii) below), the amendment is dismissed by a ruling (Article 17-2 of the Design Act). A ruling dismissing an amendment is made by indicating the reason therefor (where there are multiple reasons, all of such reasons). (See 82.1 “Dismissal of an amendment”)

(i) An amendment 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

(ii) An amendment to clarify the gist of design that was unclear when originally filed

Where the amendment does not change the gist of the statement in the application and drawings, etc. attached to the application as originally filed, the examination is continued based on the amended statement in the application and amended drawings, etc. attached to the application.

An amendment may only be made while the application for design registration is pending in examination, trial or retrial (Article 60-24 of the Design Act). (See
81.1.2 “Limitation on the period for amendment”

(3) Notice of reasons for refusal after submission of a written opinion or a written amendment of proceedings

Where the reason for refusal of which notice has been given earlier has been overcome through submission of a written opinion or a written amendment of proceedings, but another reason for refusal has been found, a notice of reasons for refusal is given once again.

122.7 Examiner's decision

122.7.1 Decision of registration

Where no reason for refusal is found for an application for design registration, the examiner renders a decision of registration. 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).

In rendering a decision of registration, if there is a design that is categorized as any of the prior designs, etc. shown below, which does not constitute a reason for refusal but was particularly referred to in examination with regard to the design in the application, the information for use in examination in which the prior design, etc. is published is to be published in the Design Bulletin as a reference material.

(1) A prior design that is found to have common points with the design in the application in terms of the entire design

(2) A prior design that is found to have common points with the design in the application in terms of a part of the form

122.7.2 Decision of refusal

Where the reason for refusal is not overcome by a written opinion or a written amendment of proceedings submitted in response to a notice of reasons for refusal, a reason for refusal is to be rendered promptly (Article 17 of the Design Act).

The following points should be particularly taken into consideration in
rendering a decision of refusal.

(1) The specific reason for the failure of overcoming the reason for refusal should be stated in plain language.

(2) With regard to the matters asserted in the written opinion, the determination made by the examiner should be clearly stated in accordance with the purport of the reason for refusal.

(3) An unreasonable decision of refusal must not be rendered by being bound by the reason for refusal of which notice was given and citing a new prior design, etc. However, a new prior design, etc. can be presented for reinforcing the fact that an ordinary mode is used or an ordinary technique for a person skilled in the art is used.
[Figure] Main flow of examination

Finding of the design

Prior design search

Is there a reason for refusal?

NO

Decision of registration

YES

Notice of reason for refusal

Is a written opinion or a written amendment of proceedings submitted?

NO

Decision of refusal

YES

Is a written amendment of proceedings submitted, and does it change the gist of the design?

NO

Ruling dismissing an amendment

Is the reason for refusal overcome?

NO

122.7 Examiner’s decision

YES

Decision of refusal

122.7.2 Decision of refusal

Is there any other reason for refusal?

NO

122.7 Decision of registration

YES

Decision of registration

122.7.1 Decision of registration

Relevant part in “Chapter II Details”

122.1 Finding of the design in an application for design registration

122.2 Prior design search

122.3 Review with regard to novelty, creative difficulty, etc.

122.4 Notice of reasons for refusal

122.4.1 Matters to consider in giving a notice of reasons for refusal

122.4.2 Securing of communication with the applicant

122.5.1 Notification of refusal (in case of an international application for design registration)

122.6 Where a written opinion or a written amendment of proceedings has been submitted

122.7 Decision of refusal