

Examination Guidelines for Design

(Provisional translation)

Japan Patent Office

Examination Guidelines for Design

The Examination Guidelines for Design aims to ensure consistent interpretation and implementation of the Design Act in design examination. It already existed around 1930 as a document titled “Design Examination Arrangements.” In June 1968, the “Examination Guidelines for Design” was published to respond to the Design Act as revised in 1959, and has been used for over 30 years while undergoing slight additions and modifications from time to time.

Subsequently, a drastic revision was made to the Design Act in 1998 and, further, some provisions were revised in 1999. With regard to interpretation and implementation of the revised provisions, efforts were made to ensure consistent implementation through publication of the “Implementation Standards for Design Examination under the Design Act as Revised in 1998” and the “Implementation Standards for Design Examination under the Design Act as Revised in 1999,” but in examination practice, it was necessary to additionally read the existing “Examination Guidelines for Design.”

In light of such circumstances, the Design Examination Standards Office re-edited the “Examination Guidelines for Design” into those for the respective provisions concerning design examination practice, based on the existing “Examination Guidelines for Design,” “Implementation Standards for Design Examination under the Design Act as Revised in 1998” and the “Implementation Standards for Design Examination under the Design Act as Revised in 1999,” and hereby publishes it.

January 2002
Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Examination Guidelines for Design (for the Design Act as revised in 2006)

The “Act for Partial Revision of the Design Act, etc.” (Act No. 55 of 2006) was promulgated on June 7, 2006, and major provisions revising the Design Act were decided to come into effect on April 1, 2007. In line with this development, we revised the following parts of the Examination Guidelines for Design that had been published to date. We also amended the relevant provisions cited in each Chapter accordingly.

This Examination Guidelines for Design is applied to applications for design registration that are filed on or after April 1, 2007. (Meanwhile, Part III “Exception to Lack of Novelty” is applied to applications for design registration that are filed on or after September 1, 2006.)

- Part II, Chapter II “Determination of Similarity between Designs”
- Part II, 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”
- Part III “Exception to Lack of Novelty”
- Part VI “Prior Application”
- Part VII, Chapter I “Partial Design”
- Part VII, Chapter III “Related Design”
- Part VII, Chapter IV “Design Including a Graphic Image on a Screen as Provided in Article 2(2) of the Design Act”

April 2007

Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

Of the existing “Examination Guidelines for Design,” we revised Part VII, Chapter IV “Design Including a Graphic Image on a Screen as Provided in Article 2(2) of the Design Act” and Part X “Procedures for Priority Claim under the Paris Convention, etc.” The revisions were deliberated at the first meeting of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (hereinafter referred to as the “Design System Subcommittee”) that was held in July 2008. Then, after hearing opinions in and outside the Japan Patent Office from September to October, 2008, and making necessary amendments based on those opinions, the revisions were approved at the second meeting of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee that was held in October 2008.

Part VII, Chapter IV and Part X of these Examination Guidelines for Design apply to applications that are examined on or after October 31, 2008.

- Part VII, Chapter IV “Design Including a Graphic Image on a Screen as Provided in Article 2(2) of the Design Act”
- Part X “Procedures for Priority Claim under the Paris Convention, etc.”

October 2008
Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

In line with the revision of the Design Act by the “Act for Partial Revision of the Patent Act, etc.” (Act No. 16 of April 18, 2008), we amended “30 days” to “three months” in the following items of the Examination Guidelines for Design.

The revisions in “Part VIII, Chapter II Dismissal of Amendments” and “Part IX, Chapter IV New Application for Amended Design” are applied to applications for which a certified copy of a ruling dismissing an amendment is served on or after April 1, 2009. The revisions in “Part IX, Chapter II Conversion of Application” are applied to applications for which a certified copy of the examiner’s initial decision to the effect that the original patent application is to be refused is served on or after April 1, 2009.

- Part VIII, Chapter II “Dismissal of Amendments”
- Part IX, Chapter II “Conversion of Application”
- Part IX, Chapter IV “New Application for Amended Design”

July 2009

Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We newly added Part XI “Procedure of Examination” to the Examination Guidelines for Design. The “Procedure of Examination” outlines how substantive examination of designs should be conducted, and its contents were deliberated at the third meeting (November 2009) and the fourth meeting (January 2010) of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (hereinafter referred to as the “Design System Subcommittee”) that were held during FY2009. Then, after hearing opinions in and outside the Japan Patent Office in February 2010 and making necessary amendments based on those opinions, the contents were approved by the Working Group on the Examination Guidelines for Design of the Design System Subcommittee.

In addition, as a result of adding “Procedure of Examination” as Part XI, we moved former Part XI “Others” down to Part XII “Others.”

This Examination Guidelines for Design is applied to applications for design registration that are examined on or after April 1, 2010.

- Part XI “Procedure of Examination”
- Part XII “Others”

April 2010
Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

Of the existing “Examination Guidelines for Design,” we revised Part II, Chapter I “Industrially Applicable Design,” Part VII, Chapter I “Partial Design,” and Part VII, Chapter IV “Design Including a Graphic Image on a Screen.” The revisions were deliberated at the fifth meeting (March 2011) and the sixth meeting (May 2013) of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (hereinafter referred to as the “Design System Subcommittee”). Then, after hearing opinions in and outside the Japan Patent Office from May to June of 2011 and making necessary amendments based on those opinions, the revisions were approved by the Working Group on the Examination Guidelines for Design of the Design System Subcommittee.

Part II, Chapter I, Part VII, Chapter I, and Part VII, Chapter IV of this Examination Guidelines for Design apply to applications for design registration that are filed on or after August 1, 2011.

July 2011

Design Examination Standards Office,
Design Division,
Trademark, Design and Administrative Affairs Department,
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We newly added Part XI “International Application for Design Registration” and amended Part II, 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,” Part VI “Prior Application,” Part VII, Chapter III “Related Design,” Part IX, Chapter I “Division of Applications for Design Registration,” Part X “Procedure for Priority Claim under the Paris Convention, etc.,” and Part XII “Procedure of Examination” at the same time. These revisions respond to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs and were deliberated at the first meeting of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Committee of the Industrial Structure Council (October 2014) and the second meeting of the Working Group on the Examination Guidelines for Design (October 2014). Then, after hearing opinions in and outside the Japan Patent Office from October to November, 2014, and making necessary amendments based on those opinions, the revisions were approved at the third meeting of the Working Group on the Examination Guidelines for Design (December 2014).

In addition, as a result of adding “International Application for Design Registration” as Part XI, we moved former Part XI “Procedure of Examination” and Part XII “Others” down to Part XII “Procedure of Examination” and Part XIII “Others,” respectively.

This Examination Guidelines for Design is applied to applications for design registration that are examined on or after May 13, 2015.

- Part II, 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”
- Part VI “Prior Application”
- Part VII Chapter III “Related Design”
- Part IX, Chapter I “Division of Applications for Design Registration”
- Part X “Procedure for Priority Claim under the Paris Convention, etc.”
- Part XI “International Application for Design Registration”
- Part XII “Procedure of Examination”
- Part XIII “Others”

April 2015

Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We revised Part VII, Chapter IV “Design Including a Graphic Image on a Screen”. This revision was deliberated at the meeting of the Working Group on the Examination Guidelines for Design of the Design System Subcommittee (from March to November 2015) in response to the report of “Global business promotion support to Japanese companies by the protection of the rights of creative designs” submitted in January 2014 by the Design System Subcommittee of the Intellectual Property Committee of the Industrial Structure Council (hereinafter referred to as the “Design System Subcommittee”). Then, after the Design System Subcommittee's confirmation followed by the opinion hearing procedure (from December 2015 to January 2016), the revision was approved.

Part VII, Chapter 4 of the Revised Examination Guidelines for Design will be applied, with regard to “74.4.3 Creative difficulty,” to applications for design registration to be examined on April 1, 2016 and after and, with regard to the parts other than “74.4.3 Creative difficulty,” to applications for design registration on April 1, 2016 and after.

○ Part VII Chapter IV “Design Including a Graphic Image on a Screen”

March 2016
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We revised Part I, Chapter II “Finding of the Design in an Application for Design Registration”, Part II, Chapter I “Industrially Applicable Design”, and Part III, “Exception to Lack of Novelty”. The revisions were deliberated at the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (from December of 2016 to February of 2017). Then, after hearing opinions (from February to March of 2017), the revisions were amended based on those opinions.

The Revised Examination Guidelines for Design will be applied to applications for design registration to be examined on April 1, 2017 and after.

- Part I Chapter II “Finding of the Design in an Application for Design Registration”
- Part II Chapter I “Industrially Applicable Design”
- Part III “Exception to Lack of Novelty”

March 2017
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We revised “Part II, Chapter I, Industrially Applicable Design”, “Part VII, Chapter I Partial Design”, and “Part XI, Chapter VIII International Application for Design Registration for a Partial Design” of the Examination Guidelines for Design. The revisions were deliberated at the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (February of 2018). Then, after hearing opinions (from March to April of 2017), the revisions were amended based on those opinions.

The Revised Examination Guidelines for Design will be applied to applications for design registration to be examined on May 1, 2018 and after.

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| ○ Part II | Chapter I | “Industrially Applicable Design” |
| ○ Part VII | Chapter I | “Partial Design” |
| ○ Part XI | Chapter VIII | “International Application for Design Registration for a Partial Design” |

April 2018
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

In line with the revision of the Design Act by the “Act of Partial Revision of the Unfair Competition Prevention Act, etc.” (Act No. 33 of May 23, 2018), we amended “six months” to “one year” in the Part III “Exception to Lack of Novelty” of the Examination Guidelines for Design.

The revised examination guidelines is applied to the designs being published on or after December 9, 2017 and filed on or after June 9, 2018.

○ Part III “Exception to Lack of Novelty”

June 2018
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We revised “Part V, One Application per Design”, “Part VII, Chapter II Design for a set of articles”, and “Part XIII, Appendix “Table of Constituent Articles of Sets of Articles” of the Examination Guidelines for Design. The revisions were deliberated at the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (from September to October of 2018). Then, after hearing opinions (from November to December of 2018), the revisions were amended based on those opinions.

The Revised Examination Guidelines for Design will be applied to applications for design registration to be examined on January 10, 2019 and after.

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|-------------|-----------|--|
| ○ Part II | | “One Application per Design” |
| ○ Part VII | Chapter I | “Partial Design” |
| ○ Part XIII | Appendix | “Examples of Constituent Articles of Sets of Articles” |

January 2019
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Partial Revision of the Examination Guidelines for Design

We revised “Part I, Application/Drawings”, “Part II, Chapter I Industrially Applicable Design”, “Part VI, Prior Application”, “Part VII, Chapter I Partial Design”, “Part VII, Chapter 3 Related Design”, “Part VII, Chapter IV Design Including a Graphic Image on a Screen”, “Part VIII, Chapter II Dismissal of Amendments”, “Part X, Procedure for Priority Claim under the Paris Convention, etc.”, “Part XI, Chapter VIII International Application for Design Registration for a Partial Design”, and “Part XII, Chapter II Details” of the Examination Guidelines for Design.

The revisions were deliberated at the Working Group on the Examination Guidelines for Design of the Design System Subcommittee under the Intellectual Property Policy Committee of the Industrial Structure Council (from September to October of 2018). Then, after hearing opinions (from November to December of 2018), and the revisions of the Ordinance for Enforcement of the Design Act promulgated on April 26, 2019, the revisions were amended.

This revised Examination Guidelines for Design applies to applications for design registration that are filed on or after May 1, 2019.

○ Part I	Application/Drawings
○ Part II	Chapter I Industrially Applicable Design
○ Part VI	Prior Application”
○ Part VII Chapter I	Partial Design
○ Part VII Chapter III	Related Design
○ Part VII Chapter IV	Design Including a Graphic Image on a Screen
○ Part VIII Chapter II	Dismissal of Amendments
○ Part X	Procedure for Priority Claim under the Paris Convention, etc.
○ Part XI Chapter VIII	International Application for Design Registration for a Partial Design
○ Part XII Chapter II	Details

April 2019
Design Examination Standards Office,
Design Division,
Patent and Design Examination Department
(Physics, Optics, Social Infrastructure and Design),
Japan Patent Office

Examination Guidelines for Design

History of Revisions

June 12, 1968

Partial addition on June 27, 1985

Partial amendment on June 27, 1985

Partial amendment on December 11, 1985

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Partial addition on March 23, 1989

Partial amendment on April 23, 1993

Partial amendment on November 8, 1993

Partial amendment on June 16, 1994

Partial addition on January 31, 2002

Partial amendment on January 31, 2002

Partial addition on April 1, 2007

Partial amendment on April 1, 2007

Partial amendment on October 31, 2008

Partial amendment on July 1, 2009

Partial addition on April 1, 2010

Partial amendment on August 1, 2011

Partial addition on April 10, 2015

Partial amendment on April 10, 2015

Partial amendment on March 11, 2016

Partial amendment on March 31, 2017

Partial amendment on April 27, 2018

Partial amendment on June 6, 2018

Partial amendment on January 9, 2019

Partial amendment on April 26 9, 2019

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Explanatory Notes

1. Abbreviations used throughout the Examination Guidelines for Design

“Drawings, etc. attached to the application”:	drawings, photographs, models or specimens attached to the application
“Publicly known design”:	the design set forth in Article 3(1)(i) or (ii) of the Design Act
“Disclosed design”:	a design that has become a publicly known design
“Electronic design information”:	design information made available to the public through the Internet
“Person skilled in the art”:	a person ordinarily skilled in the art of the design
“Design disclosed in a prior application”:	a design disclosed by the applicant of a prior application for design registration as a form of an article that falls under the classification of articles described in the column of “Article to the Design” in the application
“A set of drawings”:	in the case of a three-dimensional article, the front view, the rear view, the left side view, the right side view, the top view and the bottom view that have been prepared at the same scale by the orthographic projection method, or drawings that are replaceable therewith; in the case of a flat and thin article, the surface view and the back side view that have been prepared at the same scale
“Other necessary drawings”:	a development view, sectional view, end elevational view of the cut part, enlarged view, perspective view or other necessary drawings to be added when a set of drawings cannot sufficiently represent the design in an application for design registration
“Appended Table 1”:	Appended Table 1 of the Ordinance for Enforcement of the Design Act
“Appended Table 2”:	Appended Table 2 of the Ordinance for Enforcement of the Design Act
“Principal design”:	a design selected from the applicant's own designs for which an application for design registration has been filed
“Constituent article”:	an article constituting a set of articles
“Specified constituent article”:	a constituent article that is specified in the “Table of Constituent Articles”
“Geneva Act”:	the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs
“Designated Contracting Party”:	a designated Contracting Party under Article 1(xix) of the Geneva Act of the Hague Agreement
“International application”:	an international application under Article 1(vii) of the Geneva Act

“International publication”:	publication under Article 10(3)(a) of the Geneva Act
“Date of the international registration”:	an international registration date under Article 10(2) of the Geneva Act
“International registration”:	an international registration under Article 1(vi) of the Geneva Act
“International application for design registration”:	an international application deemed to be an application for design registration under Article 60-6(1) of the Design Act and paragraph (2) of said Article
“International Register”:	International Register under Article 1(viii) of the Geneva Act
“Statement in an application of an international application for design registration”:	matters which are found to be stated in an application of an international application for design registration which was submitted under Article 6(1) of the Design Act
“Statement in drawings of an international application for design registration”:	matters which are found to be stated in drawings of an international application for design registration which was submitted under Article 6(1) of the Design Act
“International design classification”:	an international classification for industrial designs established by the Locarno Agreement establishing an international classification for industrial designs signed at Locarno on October 8, 1968, as amended on September 28, 1979

2. Abbreviations used in part of the Examination Guidelines for Design

“Form”:	<p>the shape, patterns or colors, or any combination thereof</p> <p>However, the term “form” is not used in relation to “creative difficulty.” The purpose is to clearly distinguish between the “shape, patterns or colors, or any combination thereof” prescribed in Article 2(1) of the Design Act, which is entirely combined with the article as a constituent feature of the design, and the “shape, patterns or colors, or any combination thereof” prescribed in Article 3(2) of the Design Act, which also means an independent element, such as the shape alone or the pattern alone detached from an article, or a combination of such independent elements.</p> <p>Specifically, the term “form” is not used in Part II “Requirements for Design Registration,” Chapter III “Creative Difficulty” and Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.4.3 “Creative Difficulty.”</p> <p>Also, the term “form” is not used in Part VII “Individual Applications for Design Registration,” Chapter II “Design for a</p>
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Set of Articles,” 72.1.1.3 “The set of articles is coordinated as a whole” and 72.1.1.3.1 “Categories of constituent articles that are found to be coordinated as a whole,” because the determination as to whether or not a set of articles is coordinated as a whole is also made based on an independent element, such as the shape alone or the pattern alone detached from an article, or a combination of such independent elements.

Part I Application/Drawings

Chapter I Application for Design Registration

11 Relevant provisions

Design Act

Article 6 (1) A person requesting a design registration shall submit to the Commissioner of the Patent Office an application stating the following matters and drawing depicting the design for which registration is requested:

- (i) the name, and domicile or residence of the applicant for the design registration;
- (ii) the name and domicile or residence of the creator of the design; and
- (iii) the article to the design.

(2) Where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, the applicant may submit photograph, model or specimen representing the design for which the registration is requested, in lieu of the drawing in the preceding paragraph. In such case, the applicant shall indicate in the application which among photograph, model and specimen is submitted.

(3) When neither the statement of the article to the design required under item (iii) of paragraph (1), nor the drawing, photograph or model attached to the application would enable a person ordinarily skilled in the art to which the design pertains to understand the material or size of the article, and by this reason such a person would not be able to recognize the design, the material or size of the article to the design shall be specified in the application.

(4) Where the shape, patterns or colors of the article to the design is changeable based on the function possessed by the article, if the applicant intends to request a design registration of the shapes, patterns or colors, or a combination thereof as it appears before, during and after the said change, he/she shall state such an intention and include an explanation of said function of the article in the application.

(5) Where colors of the design are applied to the drawing, photograph or model to be submitted under paragraph (1) or (2), the applicant may omit to apply either black or white to them.

(6) When the applicant omits to apply black or white under the preceding paragraph, the applicant shall state thereof in the application.

(7) Where the applicant submits the drawing depicting the design under paragraph (1) or the photograph or model representing the design under paragraph (2), if the whole or part of the article to the design is transparent, the applicant shall state thereof in the application.

Ordinance for Enforcement of the Design Act

Article 4 (1) The case where an applicant may submit photographs in lieu of the drawings in Article 6(1) of the Design Act under paragraph (2) of said Article shall be the case where the design is clearly represented by photographs.

(2) Where submitting photographs, they shall be submitted according to the Form No. 7.

Article 5 (1) The case where an applicant may submit a model or specimen in lieu of the drawings in Article 6(1) of the Design Act under paragraph (2) of said Article shall be the case where the model or specimen falls under all of the following items:

- (i) difficult to break or does not easily change in shape or quality;
- (ii) not inconvenient for handling or preserving;
- (iii) where inserted into a bag under the following paragraph, its thickness is not more than 7 mm; and
- (iv) its size is not more than length 26 cm × width 19 cm; provided, however that this shall not preclude the size being not more than length 1 m × width 1 m when using a thin cloth or paper.

(2) Where submitting a model or specimen, it shall be inserted into a durable bag, and a written form prepared according to the Form No. 8 shall be affixed to the bag. In this case, where submitting a model or specimen under the proviso to item (iv) of the preceding paragraph, the cloth or paper shall be inserted into the bag by folding it to a thickness of not more than 7 mm.

Form No. 2 [Notes]

(39) Where filing an application for design registration for an article which does not belong to any items of the classification of articles listed in the right-hand column of the Appended Table 1, an explanation which can help in understanding the article, such as the purpose of use or the state of use of the article, shall be stated in the column of “[Description of Article to the Design].”

11.1 Provisions of Article 6 of the Design Act

Article 6 of the Design Act provides for documents to be submitted when filing an application for design registration and the matters to be stated in those documents.

Paragraph (1) specifies an application and drawings as the documents to be submitted to the Commissioner of the Patent Office when filing an application for design registration and provides for the matters that must be stated therein. With regard to an article to the design, see Part V “One Application per Design.”

Paragraph (2) provides for items that can be submitted in lieu of drawings, in order to improve the convenience for the applicant in preparing drawings.

Paragraphs (3) through (7) assume a case where a design cannot be sufficiently represented by drawings, and provide that the design should be sufficiently represented by supplementarily including an explanation in the application in such a case.

However, since the inclusion of matters in the application or the drawings, photographs, models or specimens attached to the application (hereinafter referred to as the “drawings, etc. attached to the application”) under these provisions should be carried out under the responsibility of the applicant, the examiner does not make such determination as “this matter is not needed” or “an additional matter is needed” with regard to the matters which the applicant has included as being necessary and sufficient.

11.2 Significance of an application and drawings

An application and drawings, etc. attached to the application which a person requesting a design registration submits to the Commissioner of the Patent Office represent the contents of the design created by the creator, that is, the design for which the design registration is requested.

Therefore, it is provided that the scope of a registered design must be determined based upon the statement in the application^(Note) and the design represented in the drawings, etc. attached to the application. (Article 24 of the Design Act)

Accordingly, an application and drawings, etc. attached to the application not only have the function to identify the creator and the applicant for design registration, but also have the function as a document of title specifying the scope of the registered design.

(Note)

The statement in the application refers to the statement in the columns of (i) “Partial Design,” (ii) “Article to the Design,” (iii) “Description of Article to the Design” and (iv) “Description of the Design.”

Chapter II Finding of the Design in an Application for Design Registration

The finding of the design in an application for design registration should be made by making comprehensive determination 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, with regard to what kind of form^(Note) was created for an article with what kind of function and usage.

This is because the Design Act provides that, when a person requesting a design registration files an application for design registration, the applicant must state necessary matters in the application, represent the design for which the design registration is requested in drawings, etc. attached to the application, and submit them to the Commissioner of the Patent Office (Article 6 of the Design Act) and that the scope of a registered design must be determined based upon the statement in the application and the design represented in the drawings, etc. attached to the application (Article 24 of the Design Act).

Consequently, the design for which the design registration is requested is determined based on the content of the statement in the application and what is represented in the drawings, etc. attached to the application, and therefore, the form of the part that is not disclosed (excluding forms for which indication of views are omitted by including a description stating that the views are identical to or mirror images of other views) shall not be handled as the form of the part for which design registration is requested. In a case where a shape, a pattern, or a color shown in the “reference views” in drawings, etc. attached to the application is different from those shown in a set of drawings and the other required drawings, such shape, pattern, or color shall not be taken into consideration in finding the form of the design in the application (for design registration).

Also, documents that are not categorized as an application or drawings, etc. attached to the application, such as a feature statement, a priority certificate or a certificate for receiving application of the provision of Article 4(2) of the Design Act, are not to be used as information that serves as the basis for finding the design in an application for design registration.

(Note)

Hereinafter referred to as the “form,” except in the following: Part II “Requirements for Design Registration,” Chapter III “Creative Difficulty”; Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.4.3 “Creative Difficulty”; and Part VII, Chapter II “Design for a Set of Articles,” 72.1.1.3 “The set of articles is coordinated as a whole” and 72.1.1.3.1 “Categories of constituent articles that are found to be coordinated as a whole.”

Part II Requirements for Design Registration

In order for the subject matter of an 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 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 (→ Part II, Chapter I)
- (2) The subject matter is novel (→ Part II, Chapter II)
- (3) The subject matter involves creative difficulty (→ Part II, Chapter III)
- (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. (→ Part II, Chapter IV)

(Note)

Even if a design complies with the requirements above, it may not be registered if the application for design registration falls under any of the following.

- (1) Where the design in the application for design registration is not registrable under any of the following provisions
 - (i) Article 5 (Unregistrable designs) of the Design Act
 - (ii) Article 8 (Design for a set of articles) of the Design Act
 - (iii) Article 9(1) or (2) (Prior application) of the Design Act
 - (iv) Article 10(1) to (3) (Related designs) of the Design Act
 - (v) Article 38 (Joint applications) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act
 - (vi) Article 25 (Enjoyment of rights by foreign nationals) of the Patent Act as applied mutatis mutandis pursuant to Article 68(3) of the Design Act
- (2) Where the design in the application for design registration is not registrable under the provisions of any relevant treaty
- (3) Where the application for design registration does not comply with the requirements under Article 7 of the Design Act
- (4) Where the applicant for design registration is not the creator of the design, and has not succeeded to the right to obtain a design registration for the design

Chapter I Industrially Applicable Design

21 Relevant provisions

Design Act

Article 2 (1) “Design” in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(2) The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner.

(Paragraphs (3) and (4) omitted)

Article 3 (1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the said design, except for the following:

- (i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;
- (ii) 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; or
- (iii) Designs similar to those prescribed in the preceding two items.

(Paragraph (2) omitted)

Ordinance for Enforcement of the Design Act

Form No. 6 [Notes]

(7) A figure (excluding a figure in the reference view) must not contain a centerline, baseline, horizontal line, fine line or shading to express shadows, indication line, code or character to explain the contents, nor any other line, code or character which does not constitute the design; provided, however, that it may contain a line, dot or any other mark for specifying the shape of the design for which the design registration is requested. In this case, a statement to that effect and a statement as to which mark specifies the shape shall be included in the column of “[Description of the Design]” of the application.

(8) A drawing showing a three-dimensional shape is to be indicated by a sufficient number of views for clearly showing the design for which the design registration is requested. If a view is identical to or is a mirror image of another view contained in the drawing, the latter view may be indicated in lieu of the former view by including a

statement specifying the latter view which is identical to or is a mirror image of the former view in the column of “[Description of the Design]” of the application.

- (9) Views prepared by the isometric projection method or views prepared by the oblique projection method (limited to cabinet drawings (at a width-height-depth ratio of 1:1:1/2) or cavalier drawings (at a width-height-depth ratio of 1:1:1)) which are set forth in the left-hand column of the following table may be indicated in lieu of all or part of the views set forth in the right-hand column. In this case, if the views are prepared by the oblique projection method, the distinction of cabinet drawings or cavalier drawings and the inclination angle are to be stated in the column of “Description of the Design” of the application for each view.

Views showing the front, top and right side	Front view, top view or right side view
Views showing the rear, bottom and left side	Rear view, bottom view or left side view
Views showing the front, left side and top	Front view, left side view or top view
Views showing the rear, right side and bottom	Rear view, right side view or bottom view
Views showing the front, right side and bottom	Front view, right side view or bottom view
Views showing the rear, left side and top	Rear view, left side view or top view
Views showing the front, bottom and left side	Front view, bottom view or left side view
Views showing the rear, top and right side	Rear view, top view or right side view

- (10) A drawing representing a flat and thin article is to be indicated by a sufficient number of views for clearly showing the design for which the design registration is requested from among the surface view and the back side view prepared at the same scale; provided, however, that if the surface view and the back side view are identical or mirror images or if the back side is without any pattern, the surface view may be indicated in lieu of the back side view by including a statement to that effect in the column of “[Description of the Design]” of the application.
- (12) Drawings of a rod, a wire rod, a plate, a pipe or the like with a continuous shape or of a textile in which a pattern repeats continuously may be prepared only for the part that clearly shows the state of continuing or repeating continuously, and for a textile in which a pattern repeats continuously in a single direction, a statement to that effect shall be included in the column of “[Description of the Design]” of the application.
- (13) As in the case of a middle part of a cord of a radio receiver, if the design can be

clearly shown even by omitting depiction of a part of the article, and it is unavoidable in constructing drawings, depiction of that part may be omitted. In this case, the omitted part will be clarified by, for example, indicating that part as if cut by two parallel dash-dotted lines, and if the design cannot be clearly shown merely by indicating the drawing, a statement to the effect that depiction of a part of the article has been omitted or a statement of the size of the omitted part in the drawing is to be included in the column of "[Description of the Design]" of the application.

- (14) Where the drawings in (8) through (10) alone cannot sufficiently represent the design, a development view, sectional view, end elevational view of the cut part, enlarged view, perspective view, graphic image view, or any other necessary views will be added, and where it is necessary to help in understanding the design, a view showing the state of use or any other reference views will be added.
- (15) In the cross section of a sectional view or an end elevational view of the cut part, oblique parallel lines will be drawn, and the cut part will be indicated by a chain line in another view. The chain line must not be drawn within a figure. At both ends of the chain line, codes will be attached and the direction of depicting the cross section will be indicated by arrows.
- (16) Where drawing an enlarged view of a part, the enlarged part will be indicated by a chain line in the original view of said enlarged view of a part. The chain line must not be drawn within a figure. At both ends of the chain line, codes will be attached and the direction of depicting the enlarged view of a part will be indicated by arrows.
- (18) When the article is separable, such as a cover and a main body or a plate and a bowl, and the state of these constituent parts combined cannot sufficiently represent the design, the drawings from (8) through (10) and the views in (14) for each constituent part of the article will be added, besides the views representing the state of the constituent parts combined.
- (19) Where drawings of each constituent piece of the article cannot sufficiently represent the state of use, such as in the case of building blocks, a perspective view representing the state of use or being stored will be added, and where the article is to be assembled and disassembled, such as in the case of a wooden toy, and drawings of the assembled state cannot sufficiently represent the disassembled state, a perspective view of each constituent piece of the article.
- (20) Where the article is transformable or openable, etc., and the drawings representing the state before and after the change of the design, such as the transforming or opening, are required in order to sufficiently represent the design, drawings that show the state before and after the change of the design, such the transforming or opening, will be prepared.
- (21) If a design relates to clothes or personal ornaments, etc. and the design must be depicted in the state where it is put on an subject matter other than the design for which the design registration is requested in order to sufficiently represent the design,

and if the design for which the design registration is requested can be specified by at least either of the following methods, the subject matter other than the design for which the design registration is requested may be depicted.

- (a) Stating the way of specifying the design for which the design registration is requested in the column of “[Description of the Design]” of the application.
 - (b) Drawing the design for which the design registration is requested with solid lines and any other parts with broken lines, etc. in the drawing attached to the application.
- (25) Drawings of a design for which the whole or part of the article is transparent will be prepared according to the following.
- (a) Where the outside is colorless and without any patterns, the see-through part will be depicted as it is.
 - (b) Where any one of the outer surface, inner surface or thickness of the outside has a pattern or color, the pattern or color on the rear surface and the bottom surface will not be depicted, and only the pattern or color on the front surface or the top surface will be depicted.
 - (c) Where any two or more of the outer surface, inner surface or thickness of the outside or the inner part surrounded by the outside have a shape, pattern or color, the shape, pattern or color of each such part will be depicted.

21.1 Provision of the main paragraph of Article 3(1) of the Design Act

The main paragraph of Article 3(1) of the Design Act provides that the subject matter of an application for design registration may not be registered unless it is categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act.

In order for the subject matter of an 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. Any 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 (→ 21.1.1)
- (2) The subject matter is a specific design (→ 21.1.2)
- (3) The subject matter is an industrially applicable design (→ 21.1.3)

21.1.1 The subject matter constitutes a design

The Design Act is a law to protect creation of designs, and “design” shall mean the form of an article which creates an aesthetic impression through the eye.

Accordingly, in order for the subject matter of an application for design registration to constitute a design, it must comply with all of the following

requirements.

- (1) The subject matter is found to be an article (→ 21.1.1.1)
- (2) The subject matter is the form of an article itself (→ 21.1.1.2)
- (3) The subject matter appeals to the eye (→ 21.1.1.3)
- (4) The subject matter creates an aesthetic impression through the eye (→ 21.1.1.4)

21.1.1.1 The subject matter is found to be an article

In order for the subject matter of an application for design registration to constitute a design, it must be a creation of the form of an article, and because the article and the form are inseparably integrated, creation of the form alone detached from the article, such as creation of the pattern alone or the color alone, is not found to be a design.

(1) Article subject to the Design Act

Articles subject to the Design Act are tangible objects which are movables distributed on markets.

(2) Examples of subject matter not found to be articles

(i) Subject matter that is not movables, in principle

Land and any fixtures thereto, what is called real estate, is not found to be an article. However, subject matter that becomes real estate when used, but is industrially mass-produced and treated as movables when sold, such as a gate or a prefabricated bungalow, is found to be an article.

(ii) Subject matter that is not solid

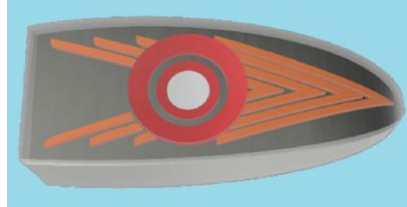
An intangible object, such as electricity, light or heat, is not found to be an article. Also, a tangible object that does not have a form of its own, such as gas or liquid, is not found to be an article.

When an article has a lighting part^(Note), and a pattern or color appears on the article itself with the turning on of the lighting part of said article, such pattern and color shall also be treated as elements constituting the form of the design in the application.

(Note) For example, articles to illuminate the surroundings, such as indoor or outdoor lighting fixtures and vehicular lamps, etc., and articles that have a lamp section for warning displays or power indicators as part of the article.

[Case example] Vehicular tail lamp

[Front view]



[Front view showing unlit state]



* For convenience, other drawings were omitted.

(In this case example, the “front view showing the unlit state” is also illustrated for the purpose of clarification, but the form of the lighting part is found to be identifiable even without the indication of this drawing.)

(iii) Subject matter which is a collection of powder or granules

Powder and granules are not found to be articles, because although the individual constituent objects are solid and have a certain form, a collection of them does not have a specific form. However, where the individual constituent objects are powder or granules, but a collection of them has a solid form, such as in the case of a sugar cube, the subject matter is found to be an article.

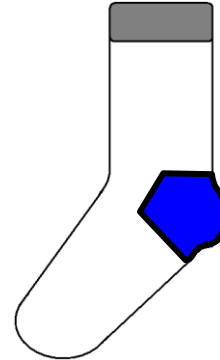
(iv) Subject matter which is a part of an article

Subject matter which cannot be isolated without destroying the article, such as the “heel of a sock” which is a part of a “Sock,” is not found to be an article because it is not traded as an independent product by itself in a normal trading state. However, a component constituting a part of a finished product (a component product) is found to be an article if it is interchangeable and is traded as an independent product in a normal trading state.

[Case example]
“Heel of a sock”



“Sock”



21.1.1.2 The subject matter is the form of an article itself

Since a design is the form of an article, subject matter that is not found to be the form of an article itself is not found to be a design.

(1) Form of an article itself

The form of an article itself refers to the form that arises from the characteristics or the nature of the article itself.

(2) Example of subject matter that is not found to be the form of an article itself

(i) Subject matter for achieving an effect of sales display

For example, where the article is a handkerchief, the form of a flower made by tying knots in the handkerchief for achieving an effect of sales display is not found to be the form of the article, i.e. the handkerchief, itself. However, where a folded handkerchief is made into an ornament imitating the shape of another article, it is found to be the form of the article, i.e. the ornament, itself.

21.1.1.3 The subject matter appeals to the eye

Since Article 2 of the Design Act defines that a design creates an aesthetic impression through the eye, subject matter that does not appeal to the eye is not found to be a design.

(1) Subject matter that appeals to the eye

Subject matter that appeals to the eye refers to the subject matter of an application for design registration of which the entire form can be recognized by the naked eye.

(2) Example of subject matter that is not found to appeal to the eye

(i) One unit of powder or granules

Where the form of one unit of subject matter is too fine to recognize by the naked eye, the subject matter is not found to appeal to the eye.

21.1.1.4 The subject matter creates an aesthetic impression through the eye

Since Article 2 of the Design Act defines that a design creates an aesthetic impression through the eye, subject matter that does not create an aesthetic impression is not found to be a design.

While an aesthetic impression can also be created through the ear, such as in the case of music, it is limited to an aesthetic impression that is created through the eye in the case of a design.

(1) Aesthetic impression

An aesthetic impression as provided in Article 2(1) of the Design Act does not need to be refined beauty as in a work of art; it is sufficient for the subject matter to create some kind of aesthetic impression.

(2) Examples of subject matter that is not found to create an aesthetic impression through the eye

(i) Subject matter mainly for achieving a function or a working effect which hardly creates an aesthetic impression

(ii) Subject matter which is not coordinated as a design, and which only creates a complicated impression and hardly creates an aesthetic impression

21.1.2 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 the application and drawings, etc. attached to the application as originally filed, predicated 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 design

Since the subject matter that is protected as a design is an aesthetic creation concerning an article, which is an intangible property that can be identified through the statement in the application and drawings, etc. attached to the application, it is sufficient to be able to derive a specific single design with regard to it is sufficient as long as the contents of the design filed as an aesthetic creation can be specifically derived from the statement in the application and drawings, etc. attached to the application; thus, the drawings, etc. attached to the application only need to contain elements that are required to identify the contents of the creation of the design, and do not necessarily need to be indicated with equally high accuracy for the entire design, such as in the case of an engineering drawing for a product.

Where the form of the entire article to the design is not illustrated in the drawings, the form of the area that is not disclosed in the drawings (excluding cases where the drawings regarding such area are omitted in accordance with the Ordinance) shall not be treated as a part for which the design registration is requested, and the part that is illustrated in the drawings shall be treated as a partial design (with regard to specific treatments, see Part VII, Chapter I). Also, even where the application or drawings, etc. attached to the application contains any improper description, such as an erroneous or ambiguous statement, if the improper description falls under any of the following, the subject matter is found to be a specific design.

- (i) Where it is reasonable to give a favorable construction upon making comprehensive determination^(Note) predicated on the ordinary skill in the art of the design
- (ii) Where it is an improper description of a part that is minor enough to not affect the finding of the gist of the design (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”) even if the question as to which description is correct is left undecided

(Note)

“Comprehensive determination” includes the determination as to whether or not it is reasonable to give a favorable construction to an improper statement of an application or improper depiction of drawings, etc. attached to the application, where such improper statement and depiction exist; the same shall apply hereinafter.

Also, where it is simply described as “comprehensive determination” hereinafter, the determination is assumed to be made predicated on the ordinary skill in the art of the design.

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

Where contents of a specific single design cannot be directly derived upon making comprehensive determination based on the statement in the application and drawings, etc. attached to the application such as in the following examples, the subject matter is not found to be a specific design.

- (i) Where the purpose of use, the state of use, etc. of the article to the design is unclear
- (ii) Where views are inconsistent and the contents of the design cannot be identified
- (iii) Where drawings or photographs, etc. are unclear
 - i. Where drawings or photographs are unclear, etc. so that the contents of the design cannot be identified accurately
 - ii. Where it is not possible to determine whether the background, highlights or shadows are shown, and the contents of the design cannot be identified accurately

For example, the design is not recognized as being clearly specified in a case where it is unclear whether the whole drawing shows a form of an article to the design in the application or the drawing contains a background color.

An example requiring a description of the background color

Article to the design “Decorative Sticker”

[Surface view]



It is unclear, whether the “Decorative Sticker” is only the sunflower part or the whole drawing including pale blue part.

* For the sake of convenience, other drawings were omitted.

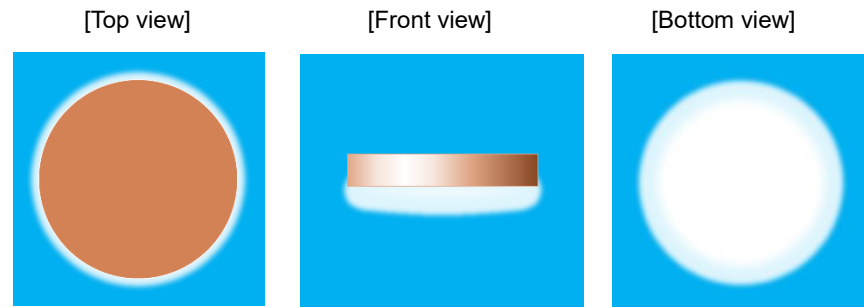
- iii. Where the design has a lighting part, and drawings represent the lit state such that the form of the design becomes unclear.

However, the subject matter is found to be a specific design if the form of the design can be identified even when the drawings show only the lit state, or where a drawing showing the unlit state or a sectional view,

etc. has been provided and the form of the design can be identified.

An example representing only the lit state such that the form cannot be identified

Article to the design “A lighting fixture directly attached to a ceiling”



* For the sake of convenience, other drawings were omitted.

(iv) Where the design is explained in an abstract manner

Where the shape, pattern and color are explained in an abstract manner in the application or drawings by using characters or codes, etc.

(v) Where the material or size of the article needs to be explained, but there is no such statement

(Article 6(3) of the Design Act)

(vi) Where drawings showing the states of change in the form are needed, but there are no such drawings or explanation

Where the article to the design is transformable or openable, and the drawings representing the states of the change of the design, such as the transforming or opening, are required in order to sufficiently represent the design, but such drawings and explanation are not included in the column of “Description of the Design” of the application.

(Article 6(4) of the Design Act)

(Form No. 6 Note (20) of the Ordinance for Enforcement of the Design Act)

(vii) Where colored drawings have a part that is not colored

However, this excludes the case where an explanation to the effect that the uncolored part is black or white is stated in the column of “Description of the Design” of the application.

(Article 6(6) of the Design Act)

(viii) Where the whole or part of the article is found to be transparent based on the drawings, but there is no explanation to that effect in the column

of “Description of the Design” of the application

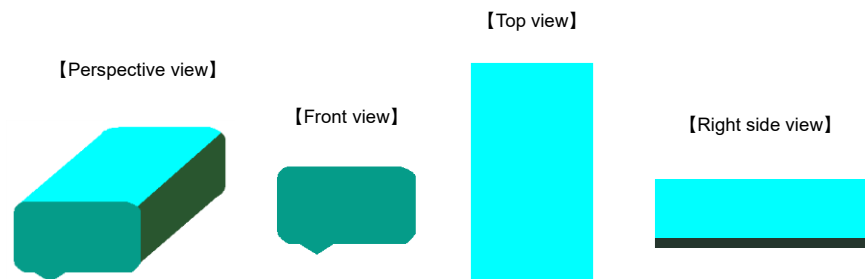
(Article 6(7) of the Design Act)

(Form No. 6 Note (25) of the Ordinance for Enforcement of the Design Act)

- (ix) Where elements such as a centerline, baseline, horizontal line, fine line or shading to express shadows, indication line, code or character to explain the contents, or any other line, code or character which does not constitute the design are included in such a way that the design cannot be identified.

An example where the design cannot be identified

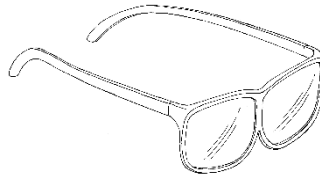
Article to the design “Eraser”



- * Without an explanation, it is unclear whether the creation has different colors for each view, or whether it is a single-color creation and the different colors show the tone of the shaded areas depending on the way the light falls onto the article.

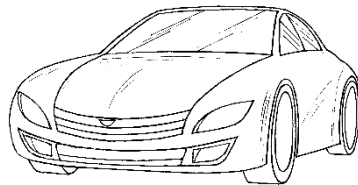
However, cases where a line, dot or any other mark for specifying the shape of the design is indicated, and a statement to that effect and a statement as to which mark specifies the shape are included in the column of “[Description of the Design]” of the application (Form No. 6 Note (7) of the Ordinance for Enforcement of the Design Act), and cases where it is obvious that the line, dot, etc. are depicted for the purpose of specifying the shape even without such explanation, in the light of nature and use/function of each part of the article to the design shall be excluded.

Examples where it is obvious that the line, dot, etc. are for specifying the shape of the design even without an explanation



Article to the design “Glasses”

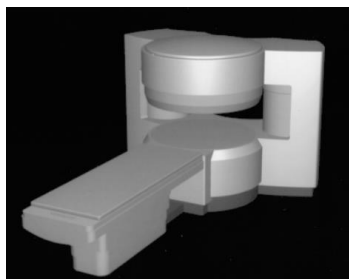
When considering the nature of the article “Glasses,” it is not general to place a line pattern, etc. on a center of a lens thereof.



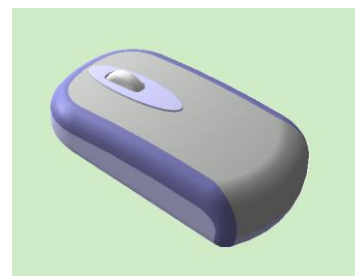
Article to the design “Passenger Vehicle”

When considering the nature of the article “Passenger Vehicle,” it is not general to place a line pattern, etc. on a body or windows thereof.

Examples where it is obvious that brightness change is “shades”
even without a description of explanation



Article to the design
“Medical Image Photographing
Apparatus”



Article to the design
“Mouse for Electronic Computer”

Characters and signs indicated on an article will be treated as elements constituting a design, except for those used only for conveying information.

Examples of characters, etc. used only for conveying information

a The text part of a newspaper or book

b Characters indicating ingredients or explaining the use, in a normal manner

(x) Where drawings showing a three-dimensional shape fall under any of the following

i. Where drawings are not clearly prepared by methods such as the orthographic projection method, the oblique projection method (limited to cabinet drawings (at a width-height-depth ratio of 1:1:1/2) or cavalier drawings (at a width-height-depth ratio of 1:1:1)), and the contents of the design for which the design registration is requested cannot be identified even when comprehensive determination is made based on the statement in the application and drawings, etc. attached to the application.

* Where the form of the entire article to the design is not represented in the drawings, etc. attached to the application, nor is there a statement on omission of views, such design shall be treated as a partial design. (The requirement concerning a partial design that "The subject matter is a specific design" shall be determined in accordance with 71.4.1.2.)

Where a view is identical to or a mirror image of another view, such view can be omitted by stating which view is identical or a mirror image in the column of "Description of the Design" of the application. Also, where views are prepared by the isometric projection method or prepared by the oblique projection method (limited to cabinet drawings (at a width-height-depth ratio of 1:1:1/2) or cavalier drawings (at a width-height-depth ratio of 1:1:1)), the views set forth in the left-hand column of the following table may be replaced by the views set forth in the right-hand column.

In this case, if the views are prepared by the oblique projection method, the distinction of cabinet drawings or cavalier drawings and the inclination angle shall be stated in the column of "Description of the Design" of the application for each view.

Views showing the front, top and right side	Front view, top view or right side view
Views showing the rear, bottom and left side	Rear view, bottom view or left side view
Views showing the front, left side and top	Front view, left side view or top view
Views showing the rear, right side and bottom	Rear view, right side view or bottom view
Views showing the front, right side and bottom	Front view, right side view or bottom view
Views showing the rear surface, left side surface and top surface	Rear view, left side view or top view
Views showing the front, bottom and left side	Front view, bottom view or left side view
Views showing the rear, top and right side	Rear view, top view or right side view

- ii. Where each view is prepared at different scales and a single design cannot be identified

This excludes cases where a specific single design can be derived even though each view is prepared at different scale.

- iii. Where drawings are prepared by the oblique projection method, but a specific single design cannot be identified because the distinction of a cabinet drawing or a cavalier drawing and the inclination angle are not stated in the column of "Description of the Design" of the application (Form No. 6 Note (9) of the Ordinance for Enforcement of the Design Act)

- (xi) Where the drawings representing a flat and thin article fall under any of the following
 - i. Where drawings are not prepared clearly using a surface view and a back side view, and a single design cannot be identified even when comprehensive determination is made based on the statement in the application and drawings, etc. attached to the application.
 - * Where the form of the entire article to the design is not represented in the drawings, etc. attached to the application, nor is there a statement on omission of views, such design shall be treated as a partial design (and the requirement concerning a partial design that "The subject matter is a specific design" shall be determined in accordance with 71.4.1.2).
 - Where the surface view and the back side view are identical or mirror images or the back side has no pattern, the back side view may be omitted. In this case, a statement to that effect shall be included in the column of "[Description of the Design]" of the application.
 - ii. Where each view is prepared at different scales and a single design cannot be identified. However, this excludes cases where each view is prepared at different scales, but a specific single design can be derived.

(Note)

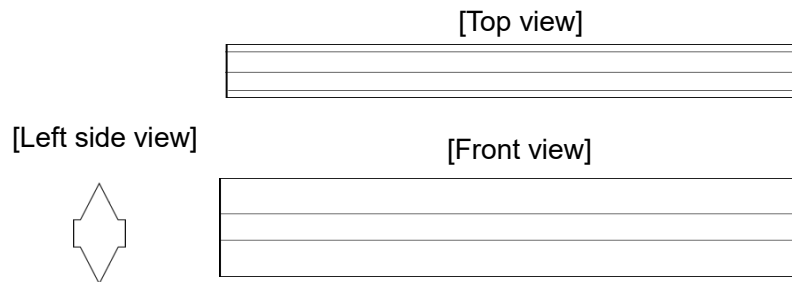
A flat and thin article refers to a thin article such as wrapping paper, a vinyl sheet or woven cloth fabric. However, an article that has an overlapping part and is three-dimensional when used, such as a packaging bag, or a thick article, such as a flocked vinyl sheet, is treated as a three-dimensional article.

- (xii) Where drawings of an article in which a shape or a pattern continues or repeats continuously do not clearly show the continuous state (Form No. 6 Note (12) of the Ordinance for Enforcement of the Design

Act)

The following examples shall be deemed that the continuous state is obvious.

Example of a case where the continuous state is obvious (1)



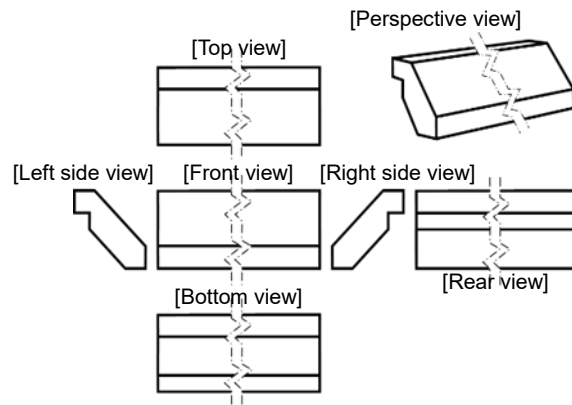
Article to the design: "Wire"

Description of Article to the Design: n/a

Description of the Design: The rear view, right side view and bottom view are omitted as they are identical with the front view, left side view and top view, respectively. This design is continuous only to the left and right in the front view.

Example of a case where the continuous state is obvious (2)

[Perspective view]



Article to the design:

"Window frame material"

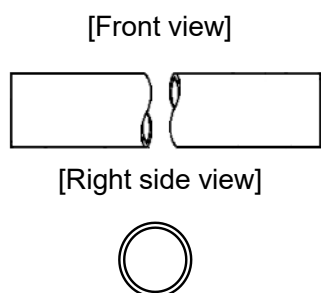
Description of Article to the Design: n/a

Description of the Design: n/a

When considering the illustration of the drawings and the nature of the article "Window frame material," the continuous state is obvious even without a statement in the column of Description of the Design.

Where the statement in the column of Description of Article to the Design is described as "XX material," and the drawings are represented in a way that the same shape or pattern appears to continue or repeat continuously in one direction only (hereinafter referred to as a "long shaped object"), and no particular statement on the length is found in the column of Description of Design, it shall be found as a long shaped object.

Example of a case where the continuous state is obvious (3)



Article to the design: "Exhaust duct material"

Description of Article to the Design: n/a

Description of the Design: The left side view is omitted as it is identical with the right side view; the rear view, top view and bottom view are omitted as they are identical with the front view.

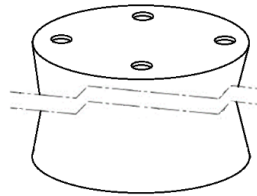
When considering the illustration of the drawings and the nature of the article "Exhaust duct material," the continuous state is obvious even without a statement in the column of Description of the Design.

Where the statement in the column of Description of Article to the Design is described as "XX material," and the drawings are represented as a long shaped object, and no particular statement on the length is found in the column of Description of Design, it shall be found as a long shaped object.

(xiii) Where drawings in which the middle part of an article such as a cord is omitted and which are prepared according to the Form No. 6 Note (13) of the Ordinance for Enforcement of the Design Act fall under the following

- i. Where it is unclear as to which part is omitted
- ii. Where the component ratio of the entire design for which the design registration is requested cannot be identified and the position, size and scope cannot be identified because the omitted part is inappropriate or there is no explanation as to how many centimeters the omitted part on the drawings are, etc.

An example of a case where the component ratio of the entire design cannot be identified and the position, size and scope are unclear



Article to the design: "Revetment block"

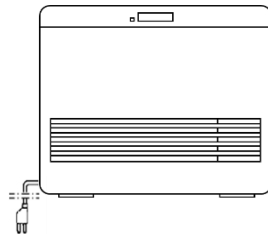
Description of Article to the Design: n/a

Description of the Design: n/a

* For the sake of convenience, other drawings were omitted.

However, even if there is no explanation of the omitted part, in the case where the length of the omitted part can be identified from the nature of the article, or in the case where the omitted part, such as the middle section of a power supply cord, varies in length and such length does not constitute a design characteristic, the contents of the design of the disclosed part shall be determined to be identifiable even without such explanation of the omitted part.

An example of a case where the contents of the design can be identified without an explanation of the omitted part



Article to the design: "Warm air heater"

Description of Article to the Design: n/a

Description of the Design: n/a

* For the sake convenience, other drawings were omitted.

(xiv) Where six views or two views alone cannot sufficiently represent the design, and the following drawings are missing

- i. A development view, sectional view, enlarged view, etc. as provided in the Form No. 6 Note (14) of the Ordinance for Enforcement of the Design Act
- ii. In the case of a building block or a structuring block, a perspective view as provided in the Form No. 6 Note (19) of the Ordinance for Enforcement of the Design Act

(xv) Where indication of the cross section or the cut part, such as a sectional view, falls under the following

- i. Where the oblique parallel lines at the cross section are incomplete or

missing

- ii. Where the cut part is not clearly shown by indications (a cutting-plane chain line, codes and arrows)

However, this excludes the case where the cut part is clearly indicated by stating that the view is the central longitudinal section of a certain view or the central traverse section of a certain view.

(Form No. 6 Note (15) of the Ordinance for Enforcement of the Design Act)

- (xvi) Where an enlarged view of a part does not have indications (a cutting-plane chain line, codes and arrows) of the enlarged part

(Form No. 6 Note (16) of the Ordinance for Enforcement of the Design Act)

- (xvii) Where a separable article falls under the following

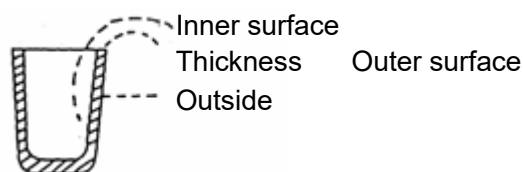
Where the article is separable, such as a cover and a main body, and the state of these constituent parts combined cannot sufficiently represent the design, but the views of combined constituent parts and drawings for each constituent part are not prepared in full

(Form No. 6 Note (18) of the Ordinance for Enforcement of the Design Act)

- (xviii) Where drawings of a transparent design are not prepared according to the provision of the Form No. 6 Note (25) of the Ordinance for Enforcement of the Design Act

(Note) Concerning the "outside" as provided in Note (25)

Example of a longitudinal sectional view of a cup



- i. Where the see-through part needs to be depicted as it is in order to sufficiently represent the design, such as in the case of a light bulb, the article will be depicted according to Note (25) (a). However, the thickness will not be depicted.
- ii. In any other cases, the article will be depicted like an opaque object, and where the shape or pattern overlaps, it will be depicted according to Note (25) (b) or (c).

The same also applies to the case where the rear part can be

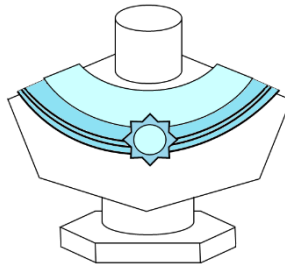
seen through and the shape or pattern overlaps, such as in the case of a bird cage. (Article 6(7) of the Design Act) (See (viii) above)

(xix) Where articles other than the design for which the design registration is requested are represented in the drawings (excluding reference views)

The drawings (excluding reference views) should contain only the representation of the design for which the design registration is requested. However, this excludes the case where an explanation on such articles other than the design for which the design registration is requested is included in the Description of the Design, or where the design for which the design registration is requested and the subject matter other than the design are described in a distinguished manner in the drawings, etc. and can be clearly recognized.

An example where the design for which the design registration is requested and the subject matter other than the design can be clearly identified.

[Case example] “Necklace”



[Description of the Design]

The torso represented in white is an article other than the design for which the design registration is requested.

* For the sake of convenience, other drawings were omitted.

An example where the design for which the design registration is requested and the subject matter other than the design can be identified, but the form of the design for which the design registration is requested is unclear, and the subject matter is not a specific design.

[Case example] “Scarf”



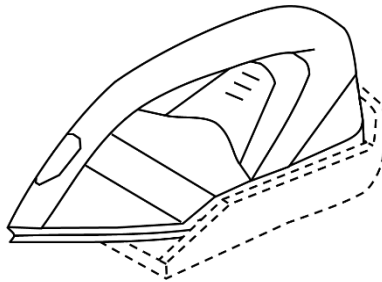
[Description of the Design]

In the photograph, the display tool formed by black wire and the tablecloth are articles other than the design for which the design registration is requested.

* For the sake of convenience, other drawings were omitted.

(xx) Where the article to the design in the application for design registration is unclear

[Case example] “Part of steam iron”



[Description of the Design]

n/a

* For the sake of convenience, other drawings were omitted.

Where the statement in the column of Article to the Design is inappropriate and there is no statement in the column of Description of the Design, and it is unclear from the drawings whether the article to the design includes both the main body of the steam iron and the charging base, and design registration is requested for the main body of the steam iron as a partial design, or whether the article to the design is only the main body part of the steam iron which does not include the charging base, and the charging base is represented only for the purpose of

showing that it is an article to be used together with the steam iron main body part. The subject matter is not found to be a specific design.

21.1.3 The subject matter is an industrially applicable design

Designs protected under the Design Act are limited to those that can be mass-produced by an industrial method, unlike industrially applicable inventions or devices under the Patent Act or the Utility Model Act. For example, farm tools are used for farming, but since farm tools themselves are mass-produced by an industrial method, their design is categorized as an industrially applicable design.

(1) Industrially applicable

Industrially applicable means that the same article can be produced in large volumes repeatedly by using industrial technology. The article does not need to be industrially applied in reality, but having a potential for industrial applicability will be sufficient.

(2) Examples of subject matter that is not found to be industrially applicable

Subject matter that falls under the following is not found to be an industrially applicable design, and therefore may not be registered under the main paragraph of Article 3(1) of the Design Act.

(i) Subject matter that uses a natural object as the main element of the design, and cannot be mass-produced

Such subject matter is not categorized as an industrially applicable design, because, as in the case of an ornament that uses a natural stone as it is, it is subject matter that uses a natural object that is hardly processed in the shape as it is, or in other words, it is subject matter that uses formative art created by nature as the main element of the design and the same article cannot be produced in large volumes repeatedly by using industrial technology.

(ii) Real estate such as land and buildings

Such subject matter is not categorized as an industrially applicable design, because the same article cannot be produced in large volumes repeatedly by using industrial technology. (See 21.1.1.1(2) "Examples of subject matter not found to be articles" above)

(iii) Copyright works that belong to the field of fine art

Such copyright works are not categorized as industrially applicable designs, because they are not created for the purpose of producing the same article in large volumes repeatedly by using industrial technology.

Chapter II Novelty

22 Relevant provisions

Design Act

Article 3 (1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the said design, except for the following:

- (i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;
- (ii) 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; or
- (iii) Designs similar to those prescribed in the preceding two items.

(Paragraph (2) omitted)

22.1 Provisions of the items of Article 3(1) of the Design Act

Even where subject matter for which an application for design registration is filed is an industrially applicable design, subject matter that is categorized as the design set forth in Article 3(1)(i) or (ii) of the Design Act (hereinafter referred to as a “publicly known design”) or as a design similar to a publicly known design lacks novelty, and therefore may not be registered.

In other words, a design that was publicly known in Japan or a foreign country, prior to the filing of the application for design registration, or a design that was described in a distributed publication, or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration, will be regarded as lacking novelty even if it was originally created and published by the creator, and the creator may not obtain a design registration by filing an application for design registration with regard to subject matter that is identical or similar to that design.

22.1.1 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

22.1.1.1 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,^(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.

Therefore, for example, if a design becomes publicly known in Japan or a foreign country in the morning, and an application for design

registration is filed for that design in the afternoon of the same day, the design in the application for design registration is categorized as a design that was publicly known prior to the filing of the 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.

22.1.1.2 Designs that were publicly known

A design that was publicly known refers to a design whose contents became known in reality to unspecified persons as a design that is not kept secret.

22.1.1.3 Design that is not treated as a design that was publicly known

(1) Registered design prior to the date of publication of the Registered Design Bulletin

A registered design prior to the date of publication of the Registered Design Bulletin thereof is generally not treated as a design that was publicly known even if establishment of the design right has been registered, because there is doubt that it can be used as information that serves as the basis for application of Article 3(1)(i) of the Design Act as a design that is publicly known.

22.1.1.4 Handling of the case where a design is categorized as a design that was publicly known

Where a design is categorized as a design that was publicly known, all of the following must be presented to the applicant in a concrete manner.

(1) The article to the design that was publicly known and its form

(2) The fact that the above design became known in reality to unspecified persons as a design that is not kept secret

22.1.2 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

22.1.2.1 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,^(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.

Therefore, for example, if a design was described in a distributed publication, or was made publicly available through an electric telecommunication line in Japan or a foreign country in the morning, and an application for design registration is filed for that design in the afternoon of the same day, the design in the application for design registration is categorized as a design that was described in a distributed publication, or was made publicly available through an electric telecommunication line prior to the filing of the 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.

22.1.2.2 Distribution

Distribution refers to the situation where a publication is made available for unspecified persons to see, and it does not require a fact that someone has seen the publication in reality.

22.1.2.3 Publication

A publication refers to a document, drawing or other similar medium for communicating information (such as a CD-ROM Design Bulletin, book, magazine, newspaper, catalog or pamphlet), which has been reproduced for the purpose of disclosing the contents through distribution to the general public.

22.1.2.4 Handling of the time of distribution of a publication

(1) Where a publication has a statement of the time of publication or an acceptance seal^(Note)

(i) Where there is no acceptance seal, but the date of publication is indicated, that date is adopted.

If the date of publication indicates only the year of publication or the month and year of publication, the time of publication is presumed to be as follows.

i. Only the year of publication: the last day of that year

ii. Only the month and year of publication: the last day of that month of the year

(ii) If there are both the date of publication and the acceptance seal, the earlier date will be adopted.

(iii) If there is no statement of the date of publication, but there is an acceptance seal, that date will be adopted.

(Note)

An acceptance seal is a seal affixed by an organization that has accepted the publication (Design Division of the JPO, former Document Section of the Design Division of the JPO, National Center for Industrial Property Information and Training, former independent administrative institution National Center for Industrial Property Information, former National Center for Industrial Property Information, former Industrial Property Library) on the cover page, etc. of the publication with a clear indication of the accepting organization and the date of acceptance in order to specify the fact of acceptance.

(2) Where a publication neither has a statement of the time of publication nor an acceptance seal

(i) If there is another publication containing a review, extract or catalog of said publication, the time of distribution of said publication is assumed from the time of publication of such other publication.

(ii) If said publication has a second edition or a reprint edition which contains a statement of the time of publication of the first edition, the date is presumed to be the time of distribution of said publication.

(iii) If there is any other appropriate clue, the time of distribution of said publication is presumed or found based on such clue.

22.1.2.5 Determination of the relationship between the time of filing of the application for design registration and the time of distribution of the publication

- (1) Where the date of filing of the application for design registration and the date adopted as the time of distribution of the publication are different

It is sufficient to determine which is earlier based on their dates, and there is no need to make the determination by further finding or presuming their exact times.

- (2) Where the date of filing of the application for design registration and the date adopted as the time of distribution of the publication are the same

Unless it is clear that the time of the filing of the application for design registration is later than the time of distribution of the publication, the time of distribution of the publication is not judged to be earlier than the filing of the application for design registration.

22.1.2.6 Design described in a publication

A design described in a publication can be used as information that serves as the basis for determination of novelty if it has been sufficiently represented to a comparable level when determining whether or not the design in an application for design registration is identical or similar to the design described in a publication.

- (1) Examples of designs that can be used as information that serves as the basis for determination of novelty

- (i) A design described in a publication which is represented by a perspective view and therefore the forms of its rear surface, bottom surface, etc. are not represented, or a design described in a publication a part of which is not represented, but where the specific form of the non-disclosed part can be presumed due to such reason as that the entire form of the design is more or less fixed by the characteristics of the article
- (ii) Not only a design for an article described in a publication, but also a design for an article included in and not similar to said article (for example, the design for a component of said article) where the specific form of the design itself can be identified
- (iii) A design for which the specific form of the article to the design

can be identified in “any other part,” other than the “part for which the design registration is requested,” of a partial design published in a Design Bulletin

22.1.2.7 Design that is made publicly available through an electric telecommunication line

(1) Line

A line generally means a transmission channel that allows for two-way communication, consisting of a round trip communication path. Broadcasting that can only transmit information one-way (excluding cable television, etc. which transmit communication in two directions) is not included in a line.

(2) Public

Public refers to unspecified persons in general society.

(3) Made publicly available

Made publicly available refers to the situation where a design is made available for unspecified persons in general society to see, and it does not require a fact that someone has accessed the design in reality. For example, a design is made publicly available if links to the design are provided on the Internet, the design is registered with a search engine,^(Note 1) or its address^(Note 2) is provided by means for communicating information to the general public (for example, a newspaper, magazine, etc. that is widely known to the public), and if no restriction is imposed on public access to the design.

(Note 1)

A search engine refers to a site that plays the role similar to a database for searching for a desired site on the Internet.

(Note 2)

An address refers to the location of an Internet service that is indicated by notation called a uniform resource locator (URL). It is generally indicated in such a manner as <http://xxx.or.jp>.

(4) Time at which a design is made publicly available

Finding of the fact that the design was made publicly available through an electric telecommunication line prior to the filing of the

application for design registration will be sufficient.

22.1.2.8 Handling of design information made available to the public through the Internet in examination

In order to cite design information made available to the public through the Internet (hereinafter referred to as “electronic design information”) as a design that was made publicly available through an electric telecommunication line, the information must satisfy all of the following requirements.

- (1) The electronic design information to be cited was publicly available information prior to the filing of the application for design registration
(→ 22.1.2.8.1)
- (2) The electronic design information to be cited was published with the same contents prior to the filing of the application for design registration
(→ 22.1.2.8.2)

22.1.2.8.1 The electronic design information to be cited was publicly available information prior to the filing of the application for design registration

Information published on the Internet is normally information that is made publicly available, since it can be accessed by unspecified persons, and has the equivalent power to disseminate information as information described in a distributed publication.

Even where a password is needed or a fee is charged for accessing the website, as long as the information is published on the Internet, its existence and location are disclosed to the general public, and it is accessible by unspecified persons, it can be regarded as information that is made publicly available.

- (1) Examples of electronic design information that is found to be information that is made publicly available
 - (i) Searchable information that is registered with a search engine or information whose existence and location are disclosed to the general public (for example, where a link to the information is provided on a website of a related academic society or in an online news article, etc. or the existence and location of the information are provided by means for communicating information to the general

public such as a newspaper, magazine, etc.)

- (ii) Information that requires a password but can be accessed by unspecified persons by merely entering the password (in this case, whether or not a fee is charged for acquiring the password is irrelevant; if any person can acquire the password and access the information without discrimination by following some kind of procedure, it is information that is made publicly available)
- (iii) Information that is published on a charged website but can be accessed by unspecified persons by merely paying a fee (in this case, if any person can access the website without discrimination by paying a fee, it is information that is made publicly available)

(2) Examples of electronic design information that is not found to be information that is made publicly available

Information published on the Internet is not regarded as being made publicly available if it falls under any of the following.

- (i) Information that is published on the Internet, but since its address is not disclosed, cannot be accessed except accidentally
- (ii) Information that can only be accessed by members, etc. of a specific organization or company, and that is treated as confidential information (for example, an intra-company system that can only be used by employees)
- (iii) Information of which contents are coded in a manner that normally cannot be deciphered (except for the case where any person can acquire a tool for deciphering the code by some kind of means, whether or not a fee is charged therefor)
- (iv) Information that has not been published for a period sufficient for the general public to see the information (for example, information that was published on the Internet for only a short time)

22.1.2.8.2 The electronic design information to be cited was published with the same contents prior to the filing of the application for design registration

- (1) Matter of the date and time of publication^(Note) of the electronic design information to be cited and alteration of the contents thereof

Since information published on the Internet is easy to alter, there is always the question of whether the electronic design information to be cited was published with the same contents at the indicated date and time of publication.

Even if the indicated date and time of publication of the electronic design information to be cited was prior to the filing of the application for design registration when the examiner discovered the electronic design information, the possibility that such indication itself has been altered cannot be fully eliminated.

(Note)

With regard to the indication of the date and time of publication, the time in the country or region where the information on the Internet was published on the website is converted into Japan time to make the determination.

- (2) Response to the matter of the date and time of publication of the electronic design information to be cited and alteration of the contents thereof

With regard to a website for which there is considered to be very little doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication, the information is cited by presuming that the contents that were published at the time when the examiner accessed the information are those that were published at the date and time of publication indicated on the website.

Where there is doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication, whether or not the information can be cited will be investigated.

Information will not be cited if it is published on a website that is unlikely to clear the doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication.

- (3) Examples of websites for which there is considered to be very little doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication

Such doubt is considered to be very little for electronic design information published on the following websites, because the contact information for inquiring about the information is normally clear.

- (i) Website of a publishing company that has published printed publications, etc. for many years (website publishing electronic information of a newspaper, magazine, etc.)
- (ii) Website of an academic institution (website of an academic society, university, etc.)
- (iii) Website of an international institution (website of such bodies as a standards organization)
- (iv) Website of a public institution (website of a ministry or agency)

Information on these websites will not be cited, in principle, where there is no indication of the date and time of publication, but it may be cited if proof of the date and time of publication of the information on the website and of the contents of the information can be obtained from the person who has authority and responsibility over publication, preservation, etc. of the published electronic design information.

- (4) Response to the case where there is doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication

Where the examiner determines that there is such doubt with regard to the electronic design information to be cited, the examiner will inquire with the contact point indicated in the contact information, etc. about whether or not the

information has been altered, and examine such doubt.

If the doubt is not cleared as a result of examination, the information will not be cited.

- (5) Handling of a website that is unlikely to clear the doubt that the electronic design information to be cited was published with the same contents at the indicated date and time of publication

Information published on a website for which contact information is unknown and which does not indicate the date and time of publication of the information will not be cited because the doubt is unlikely to be cleared.

22.1.2.9 Design published on the Internet as electronic design information

Equivalent to a design described in a publication, a design published on the Internet as electronic design information can be used as information that serves as the basis for determination of novelty if it has been sufficiently represented to a comparable level when determining whether or not the design in an application for design registration is identical or similar to the design published on the Internet. (See 22.1.2.6 “Design described in a publication” above)

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

Designs similar to those prescribed in the preceding two items

22.1.3.1 Determination of similarity between designs

Determination of similarity between designs refers to determination as to whether designs are similar or not in terms of aesthetic impression as viewed from the standpoint of consumers (including traders) (with regard to the determining entity, see 22.1.3.1.1).

The approaches for determining similarity explained below indicate the basic concept concerning the method of extracting and comparing the design characteristics, that is, the elements forming the aesthetic impression of the design, which are necessary for ensuring objective determination of similarity in design examination.

22.1.3.1.1 Determining entity

In determination of similarity between designs, the determining entity will be consumers (including traders) (Article

24(2) of the Design Act; since “consumers” as referred to in this provision is a concept that includes traders, they will be referred to as “consumers (including traders)” here) who are appropriate persons according to the actual status of transactions and distribution of the article.

While the entity determining similarity between designs upon determination of novelty is not clearly provided in the Design Act, because Article 24(2) of the Design Act, which provides for the scope of a registered design, states “whether a registered design is identical or similar to another design shall be determined based upon the aesthetic impression that the designs would create through the eyes of their consumers,” the entity determining similarity between designs upon determination of novelty will also be consumers (including traders).

Although determination of similarity between designs largely depends on human senses, the determination will be made based on the objective impression that consumers (including traders) will have when the designs are observed, while eliminating the subject perspective of the creator in creating the design.

22.1.3.1.2 Approaches of determination of similarity between designs

(1) Viewpoints of determination of similarity between designs

In design examination, the determination of similarity is made from the viewpoints set forth in (a) through (e) below.

- (a) Finding of the articles to the design of the two designs to be compared and determination of similarity
- (b) Finding of the forms of the two designs to be compared
- (c) Finding of common points and different points in the forms
- (d) Individual evaluation of common points and different points in the forms
- (e) Determination of similarity of entire designs

(2) Finding of the article to the design of the two designs to be compared and determination of similarity

The usage and function of the articles to the design of the two articles are found based on the purpose of use, state of use, etc. of the articles.

Since a design is the form of an article, similarity between designs assumes that the usage and function of the articles to the design of the two designs to be compared are identical or similar. Here, “the usage and function of the articles to the design of the two designs to be compared are identical or similar” 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 within the extent of assessing the value of the forms represented in the specific articles.

Where there is no commonality in the usage (purpose of use, state of use, etc.) and function of the articles to the design, the designs are not similar.

The “Classification of Articles” shown in the right-hand column of Appended Table 1 of the Ordinance for Enforcement of the Design Act as specified by the Ordinance of the Ministry of Economy, Trade and Industry merely indicates specific examples of the classification of articles to be described in the application, and does not directly provide the similarity or non-similarity of articles.

(3) Finding of the forms of the two designs to be compared and finding of common points and different points in the forms

i. Observation by the naked eye

Observation is basically made through visual observation by the naked eye (however, even where the form cannot be recognized by the naked eye, if it is an ordinary practice to make magnified observation upon trading, it is treated equivalent to a form that can be recognized by the naked eye). This is because an article is normally observed by the naked eye, and the

aesthetic impression made by the entire form that can be recognized by the naked eye affects the selection and purchase of the article to the design. Where the form of the entire article to the design can be recognized by the naked eye, but the form of a part of the article is too fine to be recognized by the naked eye, only the form that can be recognized by the naked eye is found to be the form of the design in determining similarity.

ii. Observation method

Determination of similarity between designs is made by an observation method that is normally used when observing the article to the design.

For example, in the case of the design of a writing tool that can be visually observed by actually holding it in the hand both at the time of purchase and at the time of use, the entire design is observed with the same weight, but in the case of the design of a television receiver whose rear surface and bottom surface are not seen in a normally installed state, observation is made by placing weight mainly on the front surface, side surface and top surface directions.

iii. Finding of the forms

The form of the entire article to the design (also referred to as the fundamental form or the basic constitution upon taking a general overview of the design) and the form of each part are found.

iv. Finding of common points and different points in the forms

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 are found.

(4) Individual evaluation of common points and different points in the forms

With regard to the forms of the common points and

different points, the following are conducted: 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; and ii. evaluation of the extent to which the forms draw attention in comparison to prior designs.

By considering the extent to which the forms of the common points and different points draw attention from the viewpoints of i. and ii., the degree of influence that each common point and different point has on the aesthetic impression of the entire design will be determined.

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

Whether or not the form of each common point and different point draws attention when comparatively observed and the extent to which they draw attention are found and evaluated based on the following:

- the largeness/smallness of the proportion of the part in the entire design; and
- whether the part has a large influence on the visual impression considering the characteristics of the article to the design.

While the specific evaluation method and evaluation results differ for individual designs, the following can be said in general.

(a) Evaluation of the proportion of the part in the entire design

If a part pertaining to a common point or different point between the filed design and the cited design takes up a large proportion in the entire article to the design, the extent to which that part draws attention is large, compared to the case where such proportion is small.

The form of the entire article to the design (basic constitution) can be regarded as the fundamental form of the design, so it normally has the largest

influence on the visual impression.

(b) Evaluation of the difference in the sizes of the articles

Even if the sizes of the articles to the design (including the scope of the normal size that is found where there is no explanation of the size) of the two designs are different, the difference does not draw strong attention unless it affects the finding of the usage and function of the articles.

(c) Evaluation of whether or not the part is easily observed based on the characteristics of the articles

A design has a part that is easily observed and a part that is not easily observed when making visual observation. If the form of a common point or different point is the form of an easily observed part, it is likely to draw attention.

An easily observed part is extracted by finding (1) whether or not the part is easy to see when selecting or purchasing the article to the design, and (2) whether or not it is a part which consumers (including traders) observe with interest, based on the use (purpose of use, state of use, etc.) and function, size, etc. of the article to the design.

However, even where the form is a part thus extracted, it is not taken into consideration as a design characteristic if the form is solely based on functional necessity.

(d) Evaluation of the internal forms of the article

Since designs should be compared mainly with regard to the forms of parts that are eye-catching when observing the articles to the design, determination of similarity is made based on the outer appearance of the articles to the design, and their internal forms which are not seen upon use are not taken into consideration as a design characteristic.

If the internal forms can be observed, the forms that are eye-catching upon use are the parts that are likely to draw attention.

For example, in the case of the design of a refrigerator, the state of the door open is one of the forms upon use, but since the usage and function of a refrigerator are to cool and store food, etc. inside with the door closed, it is normally visually observed with the door closed. Therefore, in such a case, the outer appearance with the door closed draws more attention than the internal form. On the other hand, in the case of the design of a bathroom, etc. which a human enters inside to use, the internal form will be the part that draws attention.

(e) Evaluation of the form that is visually observed only upon distribution of the article

In the case of an article a part of which is no longer in sight when used or installed (such as a fence a part of which is buried in soil, or a lighting apparatus a part of which is hidden in the wall or the ceiling), the part that is visually observed only upon distribution of the article draws less attention than the other parts, in principle.

However, where the forms of such other parts have little influence on the aesthetic impression of the entire design, such as being ordinary forms, the part that is visually observed only upon distribution of the article may become relatively more important in the entire design, and may affect the similarity upon making the final determination of similarity of the entire designs.

ii. Evaluation in comparison with prior designs

Evaluation is made on whether or not the form of each common point or different point between the filed design and the cited design is likely to draw attention when

compared with prior designs. Whether or not the form is likely to draw attention depends on the number of publicly known designs having the same form, how much different the form depends on other generally seen forms, or the level of the creative value of the form.

(a) Evaluation of common points based on prior design searches

Where the form of each common point between the filed design and the cited design is an ordinary mode that is regularly seen in other prior designs, the form cannot be regarded as a characteristic form. Therefore, such form draws less attention than a form that is also seen in other prior designs but which is not an ordinary mode that is regularly seen.

In either case, an ordinary form or a publicly known form is not simply excluded from the basis of determination.

(b) Evaluation of different points based on prior design searches

Where the form of each different point that is found through comparison between the filed design and the cited design is a novel form that is not seen in other prior designs and is found to have a high creative value, that form gives a strong impression of being different from conventional forms, and draws strong attention. Where the form of each different point is an ordinary mode that is regularly seen in other prior designs, that form cannot draw strong attention. However, in some cases, the form of a combination of an ordinary mode and a publicly known form could draw attention.

iii. Handling of a form that has a functional meaning and a form resulting from the material of the article

A form that has a functional meaning and a form resulting from the material of the article are generally handled as follows.

(a) Evaluation of a functional shape

Where there is formative freedom in meeting the functional demands and the shape is not inevitable, the formative characteristics of that shape will be taken into consideration. However, a design consisting solely of shapes that are indispensable for securing the functions of the article is not protected, because it would mean granting an exclusive right for a creation of a technical idea, which is not intended to be protected under the Design Act (Article 5(iii) of the Design Act).

Also, even if a slight difference in shape which does not have a large influence on the visual impression was substantially involved with functions, such difference is not regarded as particularly important.

(b) Evaluation of a pattern that incorporates a consideration to meet the functional demands of the article

In addition to patterns simply for the purpose of decoration (such as the pattern applied to the surface of a table plate), it has become relatively common in recent years for the mode of the input/operating part on the surface of an article to be a flat figure, etc. that does not accompany a bumpy three-dimensional shape. The design characteristics of a pattern that has a certain function in relation to the article to such design is evaluated after understanding the meaning of the pattern, that is, what is intended by the pattern and what kind of function the pattern plays in relation to the usage and function of the article, and the pattern is evaluated as equivalent to the case of a shape.

(c) Evaluation of a pattern or color arising from the material of the article

The pattern or color to be truly taken into consideration as a constituent element of a design is the pattern or color that is represented based on a

creative act of the creator of the design. However, where the design represented by the drawings, etc. attached to the application is found to be represented by the natural pattern or color of the material that is normally used for manufacturing the article to the design, that pattern or color is ordinary in the field of the article and has very little influence on the aesthetic impression of the entire design.

(5) Determination of similarity of entire designs

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, based on the individual evaluation of each common point and different point in the forms of the two designs.

Since elements of an entire design are combined with organic linkage between them, similarity cannot be determined by merely individually evaluating each common point and different point. Evaluation must be made on what kind of influence the common points and different points have on the similarity of the aesthetic impressions of the entire designs, when comprehensively examining the common points and different points while also paying attention to the combination of the respective forms.

The basic concept is as follows.

i. Comprehensive determination on the common points and different points

Whether or not a certain common point or different point becomes the most important element in determining similarity is decided by its relative relationship with the other common points and different points. When considering the degree of influence that a certain common point or different point has on the determination of similarity, if the other common points and different points have little influence on the aesthetic impressions of the entire designs, said common point or different point will have a relatively large influence on the

determination of similarity. On the other hand, if there is another common point or different point that has the same degree of or a larger influence on the aesthetic impressions of the entire designs, said common point or different point will have a relatively small influence on the determination of similarity.

ii. Form of the entire article to the design (basic constitution)

The form of the entire article to the design (basic constitution) can be regarded as the fundamental form of the design, and it has the largest influence on the aesthetic impression created through the eye. Therefore, in order for designs to be similar, there must be commonalities in the forms of the entire articles to the designs (basic constitutions).

However, even if there are different points in the forms of the entire articles to the designs (basic constitutions) between the filed design and the cited design, if both forms are ordinary and the common points in the form of each part are conspicuous, the two designs may be regarded as similar, in spite of the difference in the forms of the entire articles to the designs (basic constitutions).

For example, where there are two designs of patterned rectangular parallelepiped packaging boxes with different length-width-height ratios, if they are both found to be ordinary as ratios of packaging boxes and do not draw attention, and their common patterns are found to be characteristic and draw strong attention, the two designs may be regarded as similar, surpassing the differences in the forms of the entire articles to the designs (basic constitutions) (the length-width-height ratios of the entire boxes).

Also, where different points in the form of each part have little influence on determination of similarity, the common form of the entire articles to the designs (basic constitutions) will have the largest influence on the determination of similarity within the designs, even if

they were ordinary, and the two designs could be determined to be similar in some cases.

In addition, even if a design is an aggregation of publicly known or well-known forms, if the mode of the combination is novel and the form of the entire article to the design (basic constitution) is novel, the form of the entire article to the design (basic constitution) employing such combination is evaluated as a novel form.

iii. Publicly known form used within the design in the application

A publicly known form used within the filed design generally has smaller influence on determination of similarity than a novel form, but since a design is composed of elements that are organically combined as a whole, even if the form of a common point or a different point were a publicly known form, a determination will not be made only with regard to the other common points and different points by simply excluding such common point or different point.

Where a combination of publicly known forms is novel, the mode of such combination will be evaluated.

iv. Relationship between constituent elements of the design

It cannot be said sweepingly which of the constituent elements of a design (shape, pattern and color) has a large influence on the determination of similarity, and an element that has the most notable characteristic and draws attention in relation to prior publicly known designs is regarded to have a large influence on the determination of similarity.

However, while the shape and pattern often require creation based on human knowledge, a color is more appropriately described as a selection rather than a creation, unless it constitutes a pattern, and a large product variation is normally provided with only a change in color, so color is less likely to draw attention than the shape and pattern. Therefore, generally, color has a smaller influence on the determination of similarity

than the shape and pattern.

v. Relationship with existing cases of determination of similarity in the same field of articles

In general, where evaluation on the degree of influence which common points and different points between two designs to be compared have on the aesthetic impressions of the entire designs is similar to such evaluation made in existing cases of determination, the result will be equivalent to that in the existing cases of determination of similarity.

However, since determination of similarity between designs is made for the entire designs including the other parts, even if the two designs to be compared have equivalent common points or different points to those in existing cases of determination, the finding of whether or not they are common points or different points in a part that draws attention in the entire designs and evaluation of the extent to which the part draws attention will not always be the same. Furthermore, prior publicly known designs are accumulated day by day, so the evaluation in comparison to prior publicly known designs will not always be the same.

In this manner, even if the designs have equivalent common points or different points, evaluation on the degree of influence they have on the determination of similarity will not always be the same, so the results of determinations made in existing cases of determination of similarity in the same field of articles will not be simply applied to another case.

Chapter III Creative Difficulty

23 Relevant provisions

Design Act

Article 3

(Paragraph (1) omitted)

(2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

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

23.2 Person ordinarily skilled in the art of the design

A person ordinarily skilled in the art of the design (hereinafter referred to as a “person skilled in the art”) is the entity that determines the creative difficulty. A person skilled in the art refers to a person who had ordinary skills concerning designs in the industry in which the article to the design is to be manufactured or sold as of the time of the filing of the application for design registration.

23.3 That were publicly known

That were publicly known has the same meaning as that were publicly known as provided in Article 3(1)(i) of the Design Act. In other words, it is a situation where contents of subject matter became known in reality to unspecified persons as subject matter that is not kept secret.

Of that were publicly known, a situation where presenting the name of the subject matter is enough to call the subject matter to mind, without having to show the actual subject matter, is specifically referred to as that were widely known.

That were widely known in a foreign country requires that the subject matter was widely known in said country, but it does not necessarily require that it was widely

known in several countries. Also, as long as the subject matter was widely known in said country, it does not necessarily require that it was widely known in Japan.

23.4 Information that serves as the basis for determination of creative difficulty

The following can be used as information that serves as the basis for determination of creative difficulty.

- (1) Shapes, patterns or colors, or any combination thereof, that were publicly known
(→ 23.4.1)
- (2) Shapes, patterns or colors, or any combination thereof, that were widely known
(→ 23.4.2)
- (3) Designs that were publicly known or widely known
(→ 23.4.3)

23.4.1 Shapes, patterns or colors, or any combination thereof, that were publicly known

The following are categorized as shapes, patterns or colors, or any combinations thereof, that were publicly known.

- (1) Shapes, patterns or colors, or any combinations thereof, that were publicly known in Japan or a foreign country
- (2) Shapes, patterns or colors, or any combinations thereof, that were described in a distributed publication in Japan or a foreign country
However, the publication must not only have been distributed, but must also have been in a state where it was publicly known.

Shapes, patterns or colors, or any combination thereof are rarely publicly known independently by themselves, when described in a publication; in most cases, they are represented as being inseparably integrated with the article to the design that was publicly known, which was described in the publication. In such case as well, if the shapes, patterns or colors, or any combination thereof, of said article show a specific mode that can be distinguished by themselves, they can be used as information that serves as the basis for determination of creative difficulty.

In the case mentioned above, the similarity between the article to the design that was publicly known, which was described in a publication, and the article to the design for which an application for design registration was filed is irrelevant.

23.4.2 Shapes, patterns or colors, or any combination thereof, that were widely known

Not only shapes, patterns or colors, or any combination thereof, that were widely known in Japan or a foreign country and that were widely known independently by themselves, but also shapes, patterns or colors, or any combination thereof represented in a widely known design can be used as information that serves as the basis for determination of creative difficulty, as shapes, patterns or colors, or any combination thereof, that were widely known.

23.4.3 Designs that were publicly known or widely known

Designs that were publicly known or designs that were widely known can also be used as information that serves as the basis for determination of creative difficulty.

23.5 Examples of designs that are found to be designs that would have been easily created

23.5.1 Design of replacement

Replacement refers to replacing a part of the constituent elements of a design with those of other designs.

A design that is constituted merely by replacing specific constituent elements of a design that was publicly known (the same shall apply in a case based on a design that widely known; the same shall apply hereinafter) to those of other designs that were publicly known by an ordinary technique for a person skilled in the art

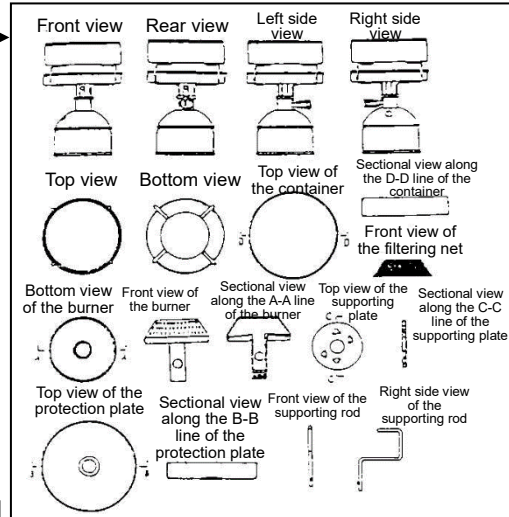
Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combination thereof, that were publicly known.

[Case example 1]

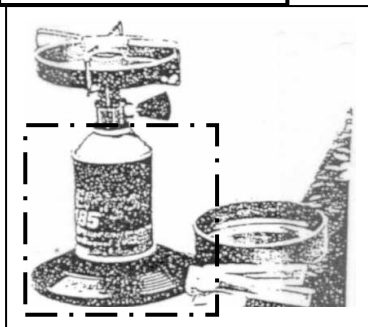
In the art of the design, using a different gas cylinder is an ordinary technique for a person skilled in the art, considering that it is a general practice to make available multiple types of gas cylinders for a single model according to the duration of fuel use.

Filed design

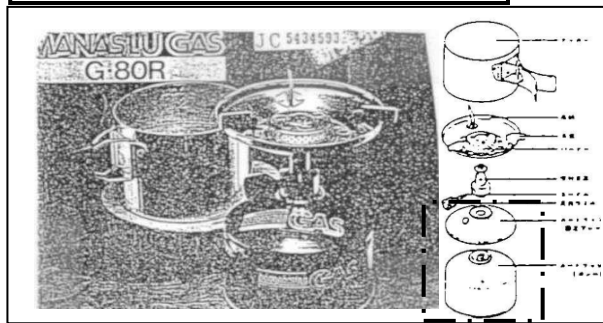
“Cooking stove that also serves as a gas space heater”



Design that was publicly known 1



Design that was publicly known 2



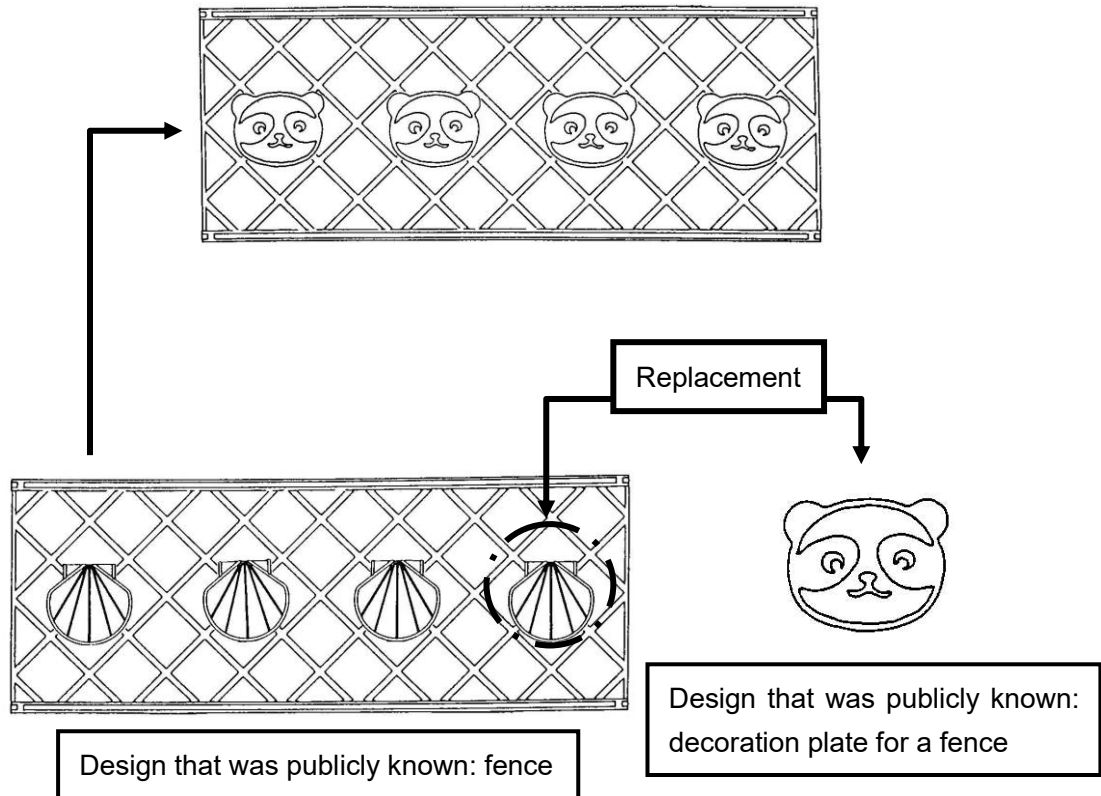
Replacement

[Case example 2]

In the art of the design, constituting a design by merely replacing the decoration plate of a design that was publicly known with other decoration plates is an ordinary technique for a person skilled in the art.

Filed design

“Road fence”

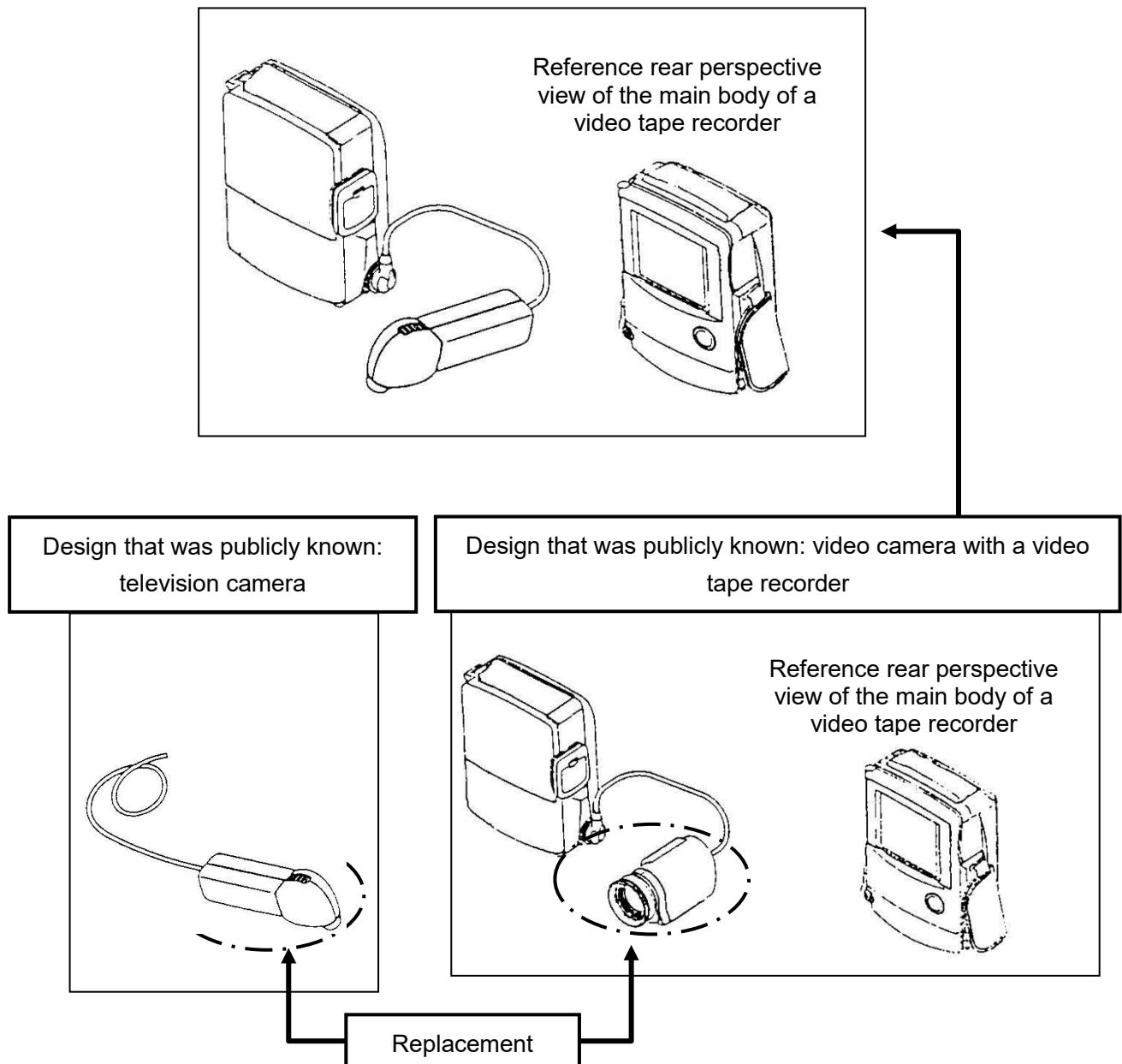


[Case example 3]

In the art of the design, replacing the shape, etc. of a separable component (television camera) with the shape, etc. of other components (television camera) is an ordinary technique for a person skilled in the art.

Filed design

“Video camera with a video tape recorder”

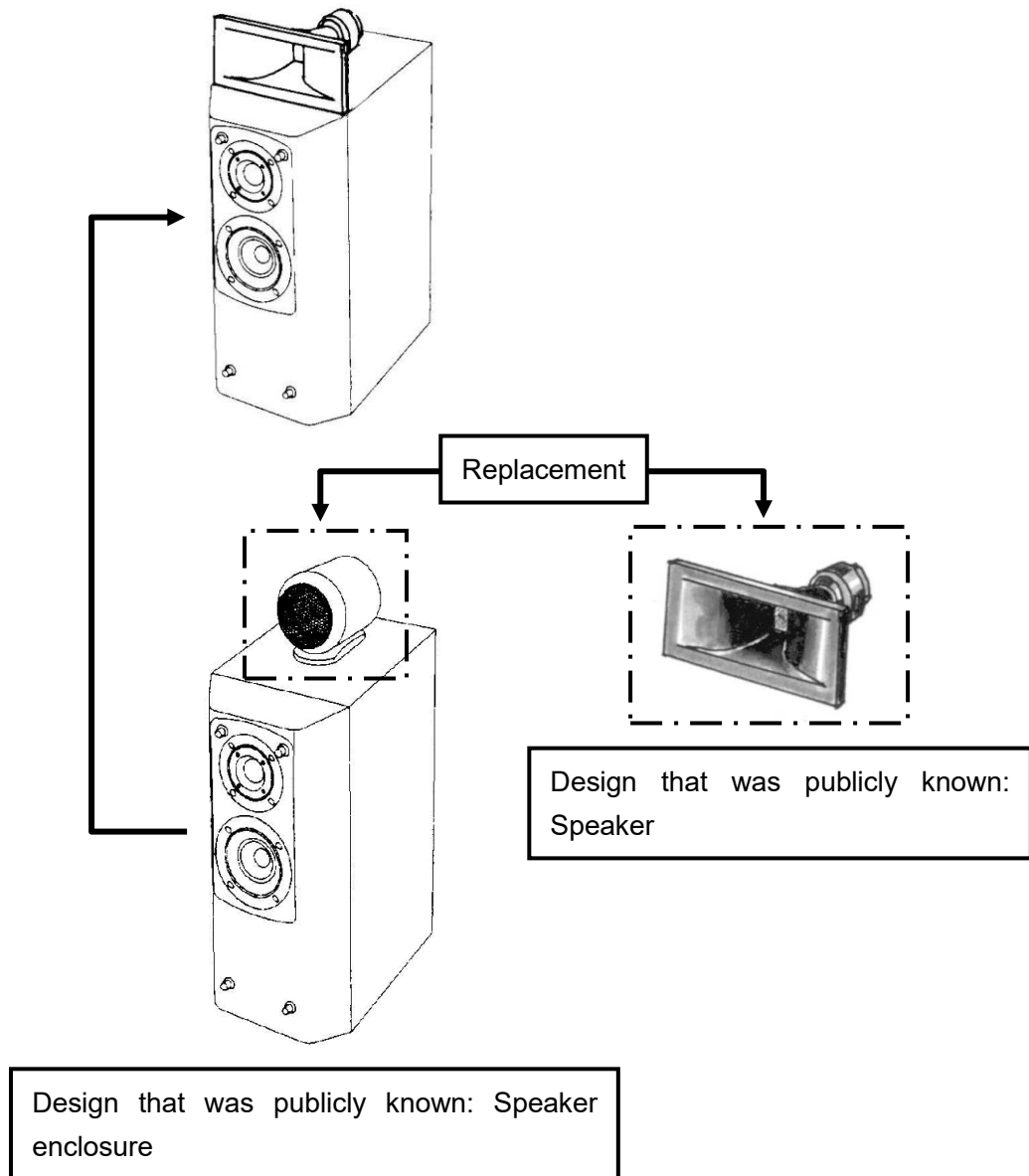


[Case example 4]

In the art of the design, making a single speaker enclosure by stacking various types of speakers for the respective frequency ranges is an ordinary technique for a person skilled in the art.

Filed design

“Speaker enclosure”

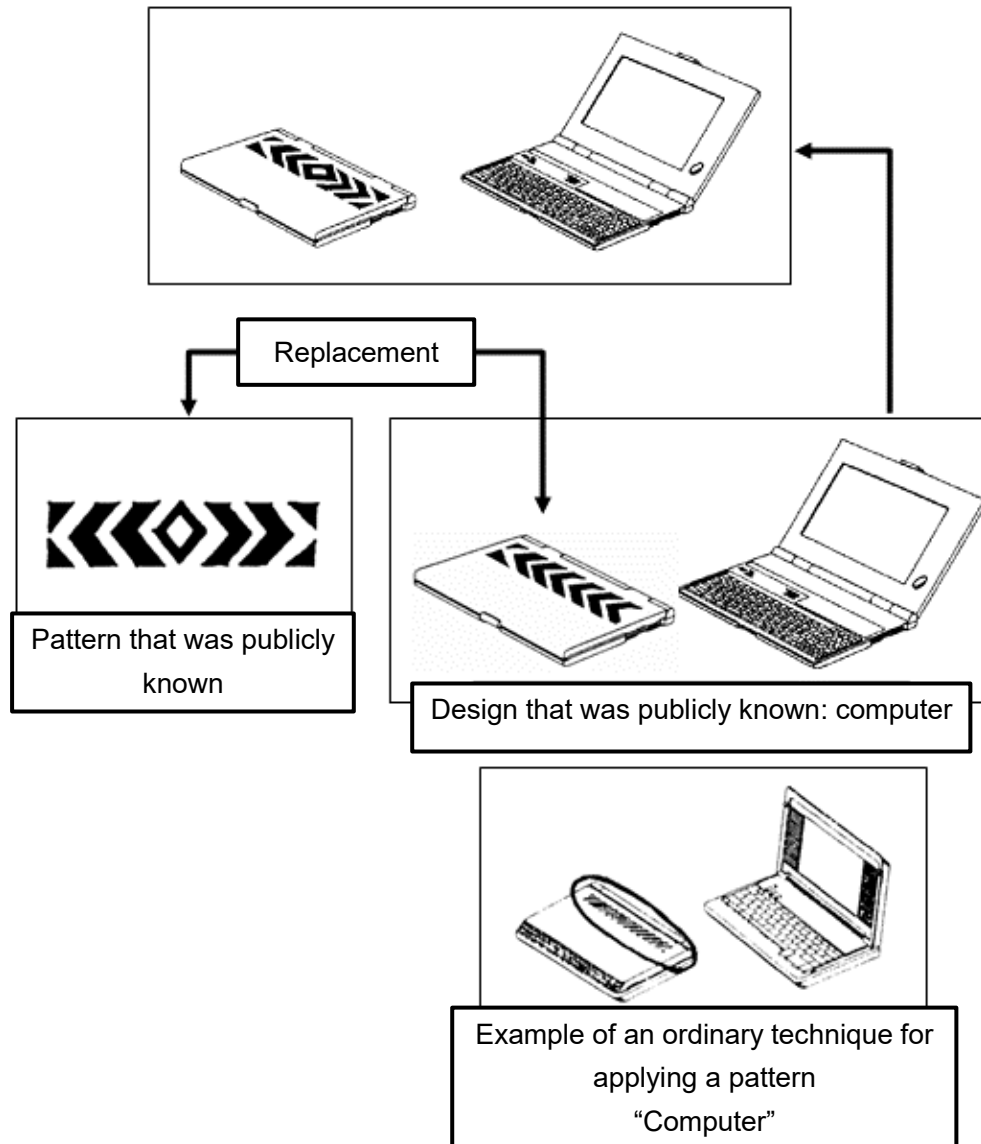


[Case example 5]

In the art of the design, applying a pattern onto the top of the lid part of a computer is an ordinary technique for a person skilled in the art.

Filed design

“Computer”



23.5.2 Design of aggregation

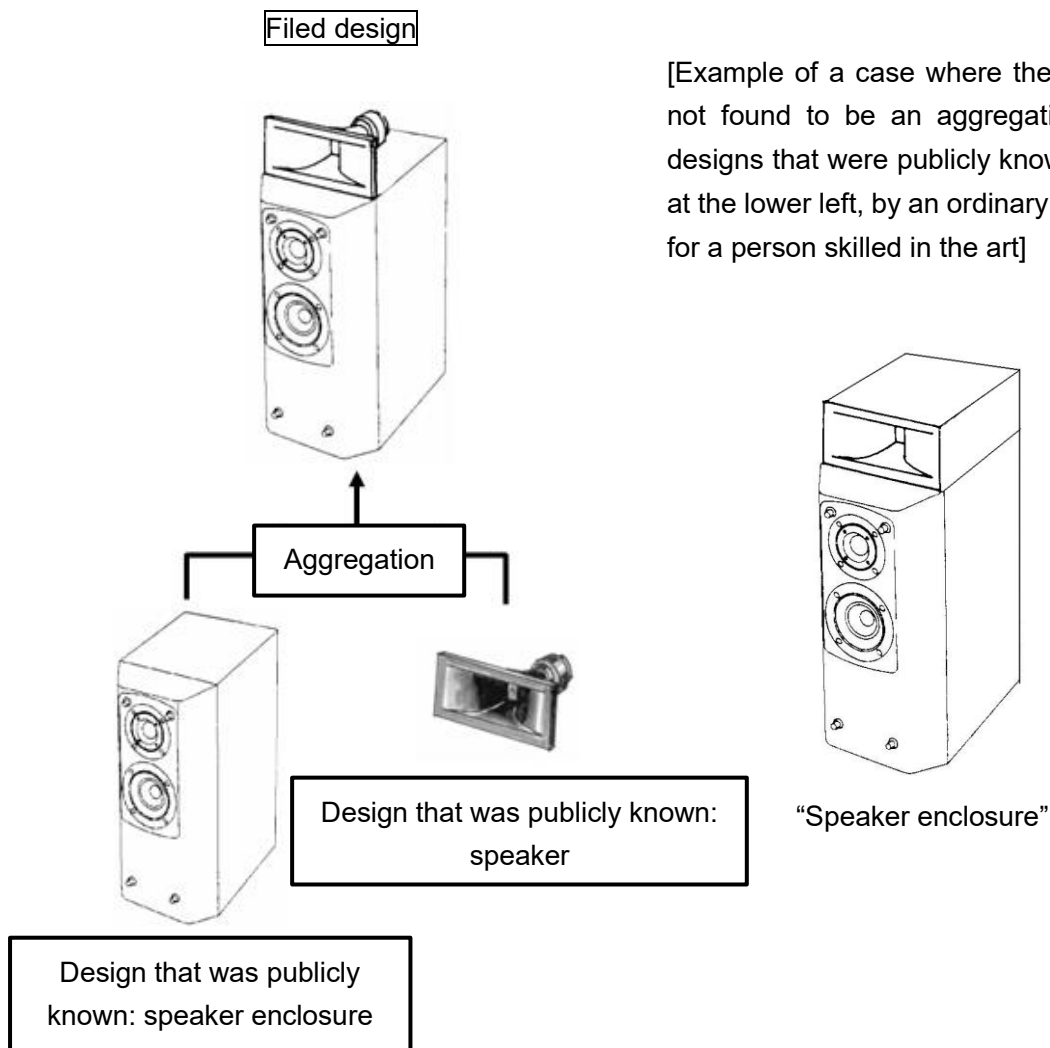
Aggregation refers to constituting a single design by combining multiple designs.

A design that has merely aggregated multiple designs that were publicly known by an ordinary technique for a person skilled in the art

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example 1]

In the art of the design, making a single speaker enclosure by stacking various types of speakers for the respective frequency ranges is an ordinary technique for a person skilled in the art.



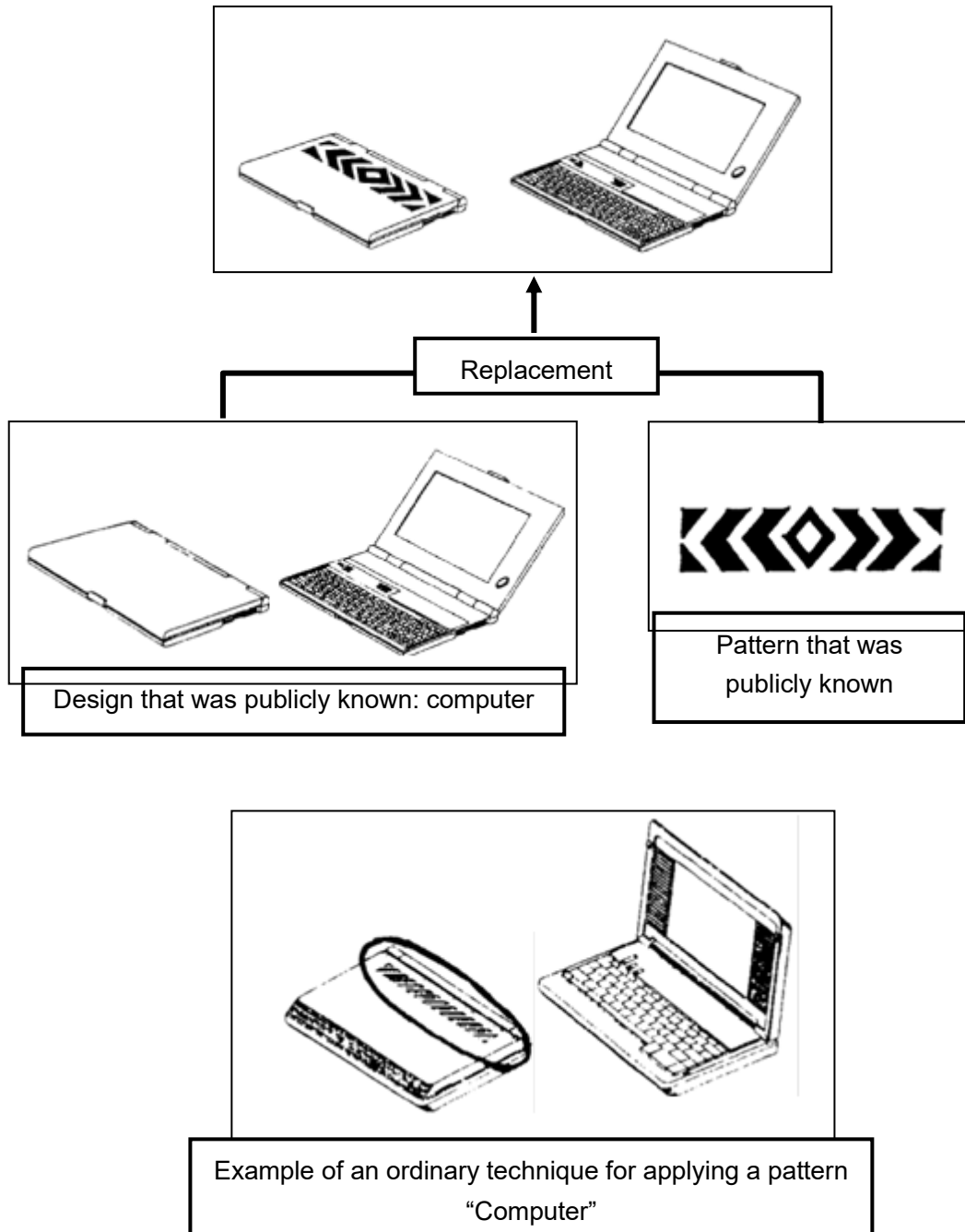
[Example of a case where the design is not found to be an aggregation of the designs that were publicly known, shown at the lower left, by an ordinary technique for a person skilled in the art]

[Case example 2]

In the art of the design, applying a pattern onto the top of the lid part of a computer is an ordinary technique for a person skilled in the art.

Filed design

“Computer”

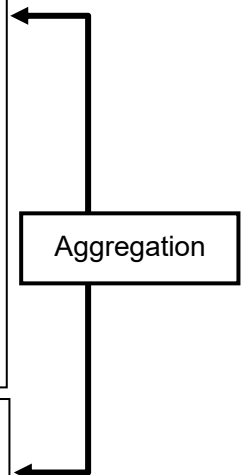
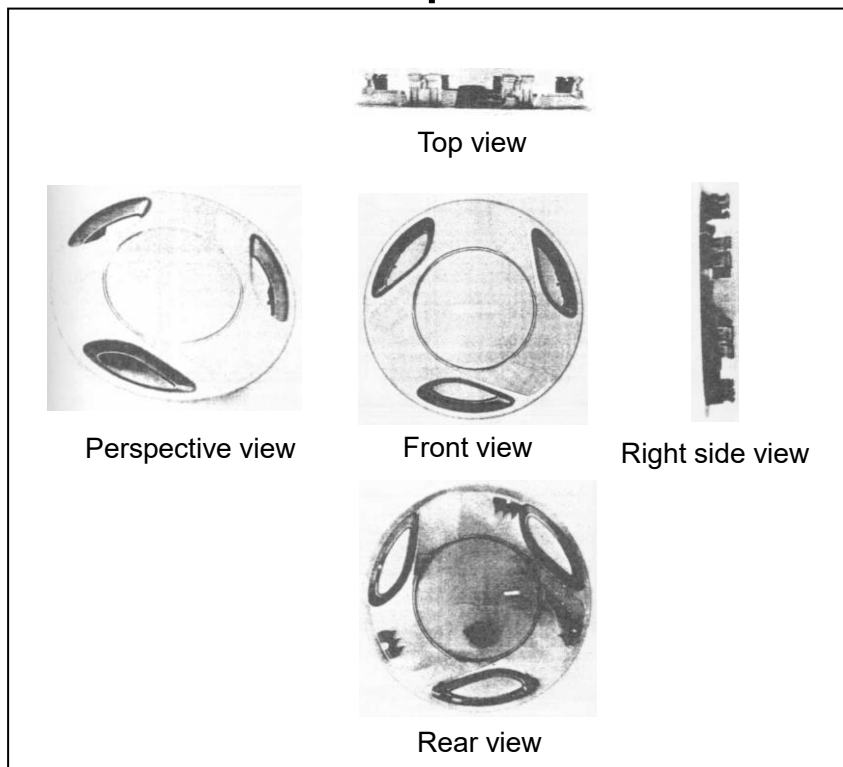
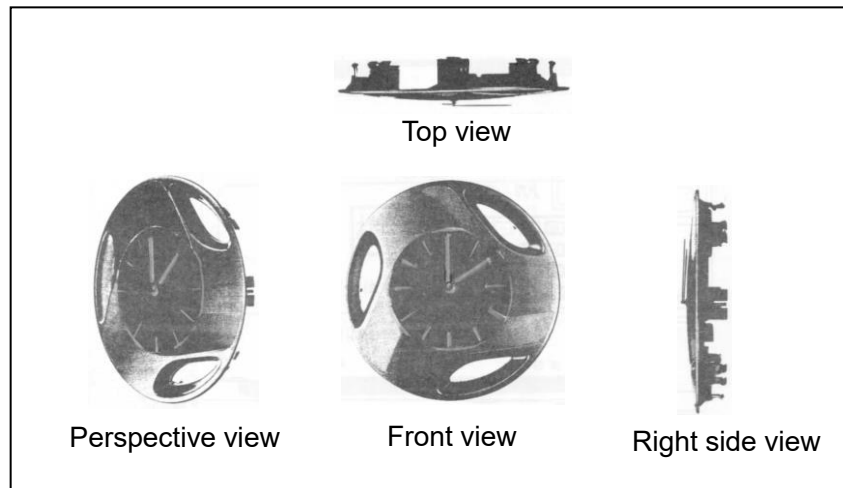


[Case example 3]

In the art of the design, inserting a clock in a part of a base consisting of various concrete objects, etc. and inserting a clock at the center of an almost disc-shaped base are ordinary techniques for a person skilled in the art.

Filed design

“Clock”



The clock inserted at the center is a design that was widely known.

23.5.3 Design constituted by changing the layout

A design that has merely changed the layout of constituent elements of a design that was publicly known by an ordinary technique for a person skilled in the art

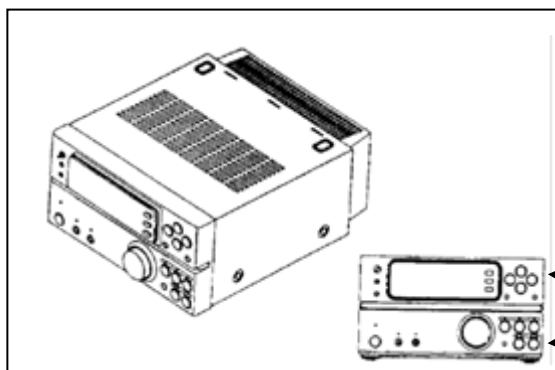
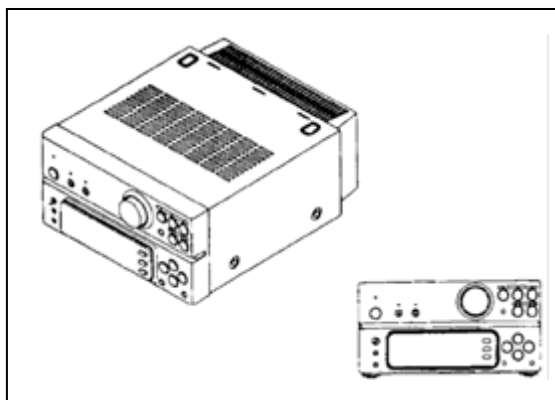
Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example]

In the art of the design, changing the layout of the display part for an equalizer and the operating part for an amplifier in the state of normal use of a design that was publicly known is an ordinary technique for a person skilled in the art.

Filed design

“Amplifier with an equalizer”



Change of layout

Design that was publicly known: amplifier with an equalizer

23.5.4 Design constituted by changing the component ratio or by increasing or decreasing the number of units of a continuous constituent element

A design that has merely changed all or part of the component ratio of a design that was publicly known or changed the number of units of a constituent element of a design that was publicly known, which repeats continuously, by an ordinary technique for a person skilled in the art

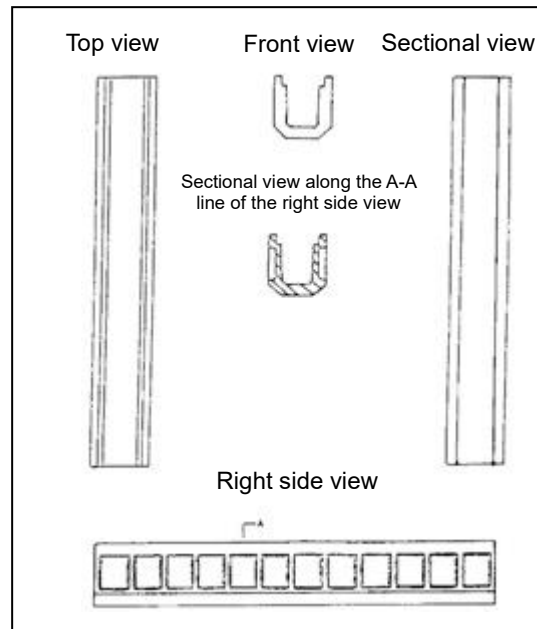
Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example 1]

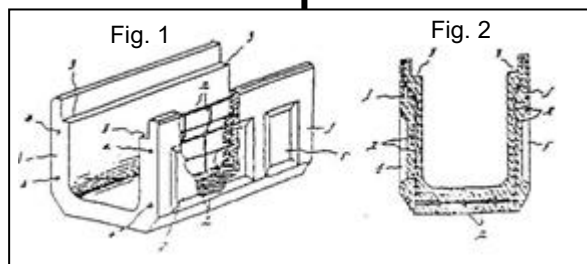
In the art of designs including an extrusion molding member having the same cross-section shape and a side-ditch block having a side shape that repeats continuously, increasing or decreasing the number of units of a constituent element of a design that was publicly known, which repeats continuously, as needed is an ordinary technique for a person skilled in the art.

Filed design

“Side-ditch block”



Increasing the number of units of a constituent element which repeats continuously



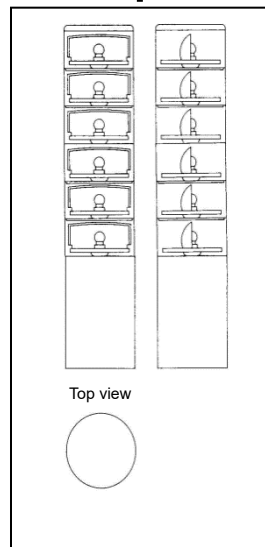
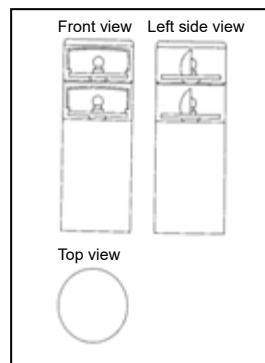
Design that was publicly known: concrete drainage side-ditch

[Case example 2]

In the art of the design, increasing or decreasing the number of warning light units stacked as needed is an ordinary technique for a person skilled in the art.

Filed design

In the “Revolving warning light,” warning light units are stacked in two layers.



Decreasing the number of units of a constituent element which repeats continuously

Design that was publicly known: revolving warning light

Warning light units are stacked in six layers.

23.5.5 Design that merely represents shapes, patterns or colors, or any combinations thereof, that were publicly known almost as they are

A design created by an ordinary technique for a person skilled in the art, which is to represent shapes, patterns or colors, or any combinations thereof by shapes, patterns or colors, or any combinations thereof that were publicly known (the same applies to shapes, patterns or colors, or any combinations thereof, that were widely known; the same shall apply hereinafter) almost as they are

Such design is found to be a design which a person skilled in the art would have been able to easily create based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

23.5.5.1 Design based on shapes or patterns that were publicly known

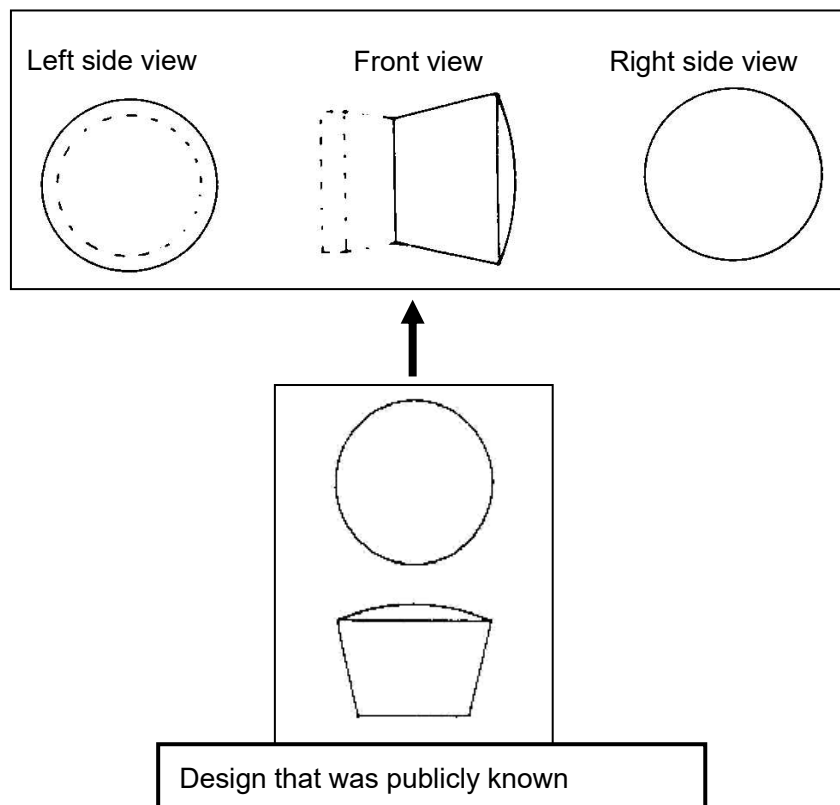
A design that merely represents shapes or patterns that were publicly known almost as they are in the article

[Case example]

In the art of the design, making the tip into various geometric shapes is an ordinary technique.

Filed design

“Tip part for a laser irradiator” (partial design)



23.5.5.2 Design based on a natural object or a copyright work or building, etc. that was publicly known

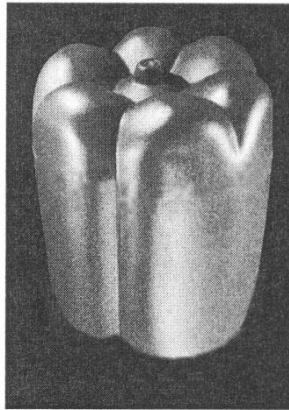
A design that merely represents all or part of the shapes, patterns, etc. of a natural object (animal, plant or mineral) or a copyright work or building that was publicly known almost as they are in the article

[Case example]

In the art of the design, making the shape of a paperweight, etc. resemble the shape of a plant, etc. is an ordinary technique.

Filed design

“Paperweight”

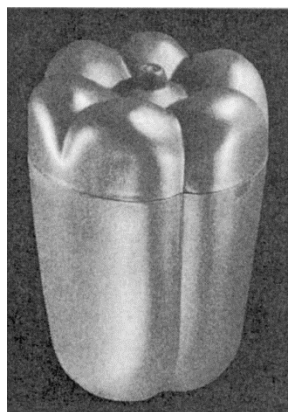


[Case example of subject matter that would not have been easily created]

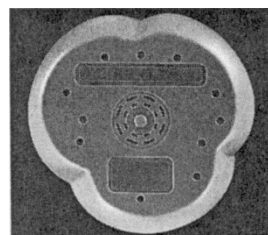
The design of the “culture soil container” shown below does not represent the shape of a green pepper almost as it is, and a person skilled in the art would not have easily created it.

Filed design

“Culture soil container”



Perspective view



Bottom view

23.5.6 Design converted as a business practice

A design that has been converted in the case where there is an ordinary technique for a person skilled in the art to convert a design to a dissimilar article as a business practice

Such design is found to be a design which a person skilled in the art would have been able to easily create based on the shapes, patterns or colors, or any combinations thereof, that were publicly known, which served as the basis for the conversion.

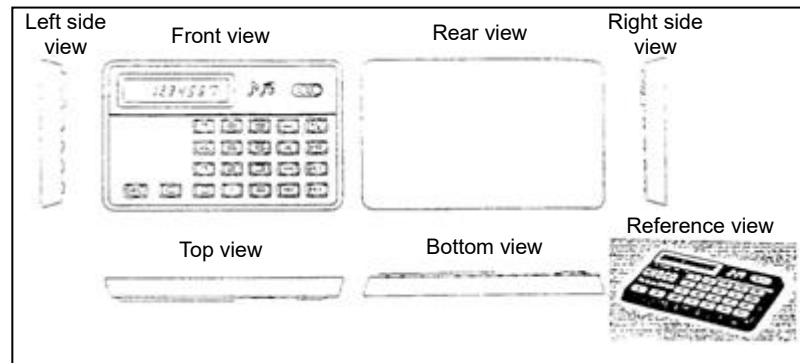
Conversion does not only mean representing shapes, patterns or colors, or any combination thereof, of a certain article as shapes, patterns or colors, or any combination thereof, of a dissimilar article, but it also includes making a technically or economically inevitable change to shapes, patterns or colors, or any combination thereof, which is deformation to the extent any person skilled in the art would make or deformation that is commonly made in the art of the design, in the process of creating a design based on shapes, patterns or colors, or any combinations thereof, that were publicly known.

[Case example 1]

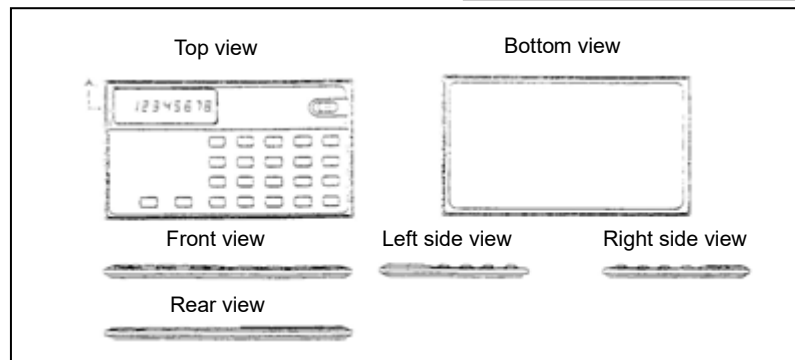
In the art of the design, making the shape of manufactured food resemble the shape of an animal, plant, etc. is an act conducted as a business practice for a person skilled in the art.

Filed design

“Chocolate”



Conversion



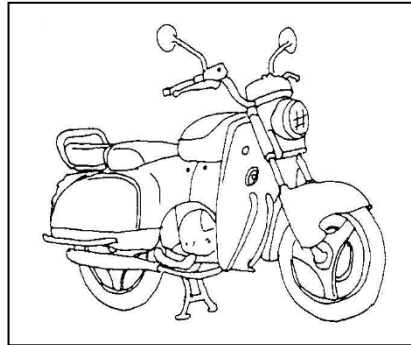
Design that was publicly known: electronic desktop calculator

[Case example 2]

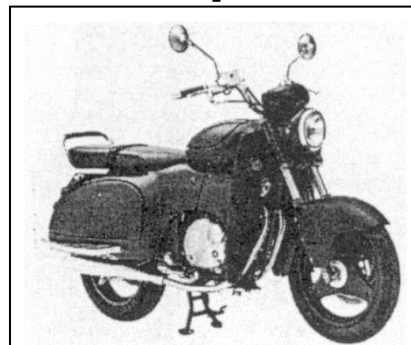
In the art of the design, making the shape of a toy resemble the shape of a vehicle is an act conducted as a business practice for a person skilled in the art.

Filed design

“Toy motorbike



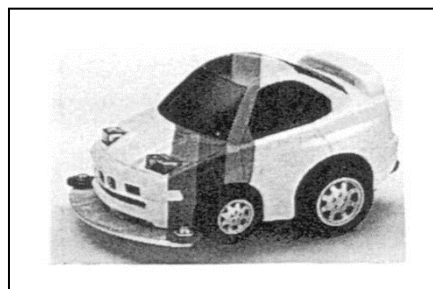
Conversion



Design that were publicly known: motorbike

[Case example of subject matter that would not have been easily created]

The design of a “Toy car” shown below has been deformed to an extent beyond deformation that is normally made as a business practice for a person skilled in the art, so a person skilled in the art would not have easily created it.



23.6 Presentation of information that serves as the basis for determination of creative difficulty

Where using shapes, patterns or colors, or any combinations thereof, that were publicly known or designs that were publicly known as information that serves as the basis for determination of creative difficulty, for example, when using a design that was publicly known, which was described in a distributed publication, as information that serves as the basis for determination of creative difficulty, the examiner must present the design that was publicly known to the applicant for design registration by stating matters including the bibliographic matters concerning the publication in which the design that was publicly known is described and the page number of the page on which the design that was publicly known is described in the notification of reasons for refusal.

However, when using shapes, patterns or colors, or any combinations thereof, that were widely known or designs that were widely known as information that serves as the basis for determination of creative difficulty, the examiner does not need to present proof of their existence.

23.7 Presentation of the fact that the design uses an ordinary technique for a person skilled in the art

A determination that a design could have been created easily must be supported by a fact that the design was created by using an ordinary technique for a person skilled in the art.

Therefore, when giving a notice of reasons for refusal under Article 3(2) of the Design Act, it is necessary to present to the applicant a specific fact showing that the technique used is ordinary for a person skilled in the art, in principle.

However, where the examiner finds it to be evident that the technique used is ordinary for a person skilled in the art, such as where the technique is to convert the design of a real car as it is to a toy car in the toy industry, it is not necessarily required to present said specific fact.

23.8 Application of the items of Article 3(1) of the Design Act

Since Article 3(2) provides “(except for designs prescribed in any of the items of the preceding paragraph),” the provision of Article 3(2) of the Design Act only apply to the case where the design in an application for design registration does not fall under any of the items of Article 3(1) of the Design Act in relation to a design that was publicly known.

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

24 Relevant provisions

Design Act

Article 3-2 Where a design in an application for design registration is identical with or similar to part of a design described in the statement in the application and drawing, photograph, model or specimen attached to the application of another application for design registration which has been filed prior to the date of filing of the said application and published after the filing of the said application in the design bulletin under Article 20(3) or Article 66(3) (hereinafter referred to in this Article as the "earlier application"), a design registration shall not be granted for such a design, notwithstanding paragraph (1) of the preceding Article; provided, however, that this shall not apply where the applicant of the said application and the applicant of the earlier application are the same person and the said application was filed before the date when the design bulletin in which the earlier application was published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) was issued.

24.1 Provision of Article 3-2 of the Design Act

The provision of Article 3-2 of the Design Act provides that, where the design in a later application is not found to be a creation of a new design, such as where an application for design registration is filed while adopting a part of the design in a prior application almost as it is as the design in the later application, the design in the later application may not be registered. It is provided, however, that the reason for refusal under this provision does not apply where an application for design registration was filed by the same applicant as that for the prior application before the date of publication of the Design Bulletin pertaining to the prior design registration (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published).

24.1.1 Design Bulletin that serves as the basis for application of the provision of the main clause of Article 3-2 of the Design Act

The Design Bulletin that serves as the basis for application of the provision of the main clause of Article 3-2 of the Design Act is any of the following Design Bulletins for a design filed before the filing date of the application for design registration subject to the application of Article 3-2 of the Design Act which was published after the filing of said application for design registration.

- (1) Design Bulletin based on the provisions of Article 20(3) of the Design Act (Registered Design Bulletin)
- (2) Design Bulletin based on the provisions of Article 66(3) of the Design Act (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 application have been filed for identical or similar designs on the same date)

24.1.2 Design described in the statement in the application and drawing, photograph, model or specimen attached to the application

A design described in the statement in the application and drawing, photograph, model or specimen attached to the application in the design bulletin as provided in Article 3-2 of the Design Act specifically refers to a design which has been described in a Design Bulletin and which has been created by the applicant for design registration who filed the prior application, in other words, which has been disclosed by the applicant for design registration who filed the prior application as a form of an article that is categorized under the classification of articles stated in the column of “Article to the Design” of the application (hereinafter referred to as “the design disclosed in a prior application”).

Therefore, information other than the design disclosed in the prior application which is described in a view showing the state of use or any other reference view to be added where it is necessary to help in understanding the design cannot be used as information that serves as the basis for application of the provision of Article 3-2 of the Design Act.

Such practice has been adopted for the reason that if, in a view showing the state of use or any other reference view to be added where it is necessary to help in understanding the design, amendment is made to a design other than the design disclosed in the prior application within a scope that does not change the gist of such reference view, the contents of descriptions other than those of the design disclosed in the prior application may change while examination, trial or retrial of the application is pending, and refusing a later application based on such unstable information will be disadvantageous for the applicant for design registration who files the later application, and also for the reason that it runs contrary to the purport of the provision of Article 3-2 of the Design Act to refuse a later application by finding a value of creation in information that has merely been added for an explanatory purpose to help in understanding the design disclosed in the prior application.

24.1.3 Drawings for specifying the design disclosed in a prior application

24.1.3.1 In the case of an application for design registration for a whole design

In the case of a three-dimensional article, the front view, the rear view, the left side view, the right side view, the top view, and the bottom view that have been prepared at the same scale by the orthographic projection method, or drawings that are replaceable therewith (hereinafter referred to as “a set of drawings”) are regarded as drawings for specifying the design disclosed in a prior application.

In the case of a flat and thin article, the surface view and the back side view that have been prepared at the same scale (hereinafter referred to as “a set of drawings” equivalent to the case of a design for a three-dimensional article) are regarded as drawings for specifying the design disclosed in a prior application.

In addition, a development view, sectional view, end elevational view of the sectioned part, enlarged view, perspective view, graphic image view or other necessary drawings (hereinafter referred to as “other necessary drawings”) to be added where a set of drawings alone cannot sufficiently represent the design in an application for design registration are also regarded as drawings for specifying the design disclosed in a prior application.

24.1.3.2 In the case of an application for design registration for a partial design

In the case of an application for design registration for a partial design, a set of drawings representing 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,” and other necessary drawings are regarded as drawings for specifying the design disclosed in a prior application.

24.1.3.3 In the case of an application for design registration for a design for a set of articles

In the case of an application for design registration for a design for a set of articles, sets of drawings for the respective designs pertaining to the articles constituting the set of articles (hereinafter referred to as “constituent articles”), sets of drawings for the respective designs pertaining to articles that are used at the same time as constituent articles and that are within the scope incidental to specified constituent

articles, or a set of drawings for the state where the constituent articles are combined, and other necessary drawings are also regarded as drawings for specifying the design disclosed in a prior application.

24.1.4 Part of a design

Part of a design refers to a closed area that is included in the appearance of the design disclosed in a prior application, and a shape, pattern or color which is a constituent element of a design and which has been conceptually separated from the design is not treated as being part of a design. For example, where the design disclosed in a prior application is a design constituted by a combination of a shape and pattern of an article, part of a design refers to part of the entire design in the combined state, and merely the shape of the article without the pattern is not treated as being part of a design.

Where the whole design in a later application represents the form of the entire article to the design of a partial design in a prior application, including the “part for which design registration is requested” and “any other part” of the partial design, the design in the later application is not treated as being part of the design in the prior application.

24.1.5 Determination of similarity between part of the design disclosed in a prior application and the whole design in a later application

In order to apply the provision of Article 3-2 of the Design Act, in principle, it is necessary that the entire form of the whole design in the later application, which is subject to the provision of Article 3-2 of the Design Act, is disclosed in the design disclosed in the prior application (including the case where such form is not disclosed, but is sufficiently represented to a comparable level, in the design disclosed in the prior application; see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.2.6 “Design described in a publication”).

Regardless of (i) whether the design disclosed in a prior application is a whole design or a partial design, and (ii) whether the article to the design of the design disclosed in a prior application and that of the whole design in a later application are identical, similar or not similar, where the part of the design disclosed in a prior application that coincides with the whole design in a later application and the article to the design of the whole design in the later application have an identical or similar usage and function and their respective forms are identical or similar, the whole design in the later application and the part of the design disclosed in the prior application that coincides with the whole design in the later application are similar.

24.1.6 Determination on application of the provision of the proviso to Article 3-2 of the Design Act

An application for which design registration is not granted, as provided under the main clause of Article 3-2 of the Design Act, does not fall under a reason for refusal if it complies with all of the following requirements, according to the provision of the proviso to said Article.

24.1.6.1 The applicant of the application for design registration and the applicant of the earlier application are the same person

The determination as to whether the applicant of the application for design registration and the applicant of the earlier application are the same person is made based on the statement of the applicant for design registration in the respective applications at the time of making determination on application of the provision, that is, the time when a certified copy of the examiner's decision or a written notice of reasons for refusal is served. Therefore, even if the applicants are different at a time other than the time of making determination on application of the provision or the applicant of the application for design registration and the holder of the design right pertaining to the earlier application are different, that is not taken into consideration in the determination on application of the provision.

In the case of a joint application, the "same person" means that all applicants are the same.

24.1.6.2 The application for design registration was filed before the publication date of the Design Bulletin in which the earlier application was published under Article 20(3) (except for a Design Bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4))

The application for design registration needs to have been filed before the date of publication of the Design Bulletin pertaining to design registration of the earlier application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published).

* Please take note that although this Design Bulletin does not include an International Designs Bulletin of an international publication^(Note) in case of an international application for design registration, a design that was placed in the International Designs Bulletin that was internationally

published shall fall under a design provided in Article 3(1)(ii) of the Design Act (a design that was described in a distributed publication or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country).

(Note)

With regard to the “international application for design registration” and “international publication”, see Part XI “International Application for Design Registration”; the same shall apply hereinafter.

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

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 apply) 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 (a 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 application have been filed for identical or similar designs on the same date).

Meanwhile, Article 3(1)(ii) or (iii) of the Design Act applies to an application for design registration that was obviously filed after the time of publication of the Design Bulletin for the prior application for design registration.

24.1.7.1 Reference date for determination on application of the provision of Article 3-2 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

In the case of division of an application for design registration under Article 10-2(1) of the Design Act, conversion of a patent application or an application for utility model registration into an application for design registration under Article 13(1) or (2) of the Design Act, or filing of a new application for design registration for an amended design for which a ruling dismissing an amendment has been made under Article 17-3 of the Design Act, if the procedures are conducted legitimately, such application for design registration is deemed to have been filed at the time of filing the original application or at the time of submitting the written amendment of proceedings.

However, since determination on application of the provision of Article 3-2 of the Design Act is made on the basis of the day of the filing the application for design registration, with regard to a new application for design registration resulting from division, a new application for design registration resulting from conversion, or a new application for design registration for an amended design for which a ruling dismissing an amendment has been made, the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized will be the reference date for the determination.

24.1.7.2 Reference date for determination on application of the provision of Article 3-2 of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.

When applying the provision of Article 3-2 of the Design Act, if the claim is legitimate, the filing date of the first application will be the reference date for the determination.

24.1.7.3 Time for giving notice of the reason for refusal under Article 3-2 of the Design Act

A notice of the reason for refusal under Article 3-2 of the Design Act is given after the date of publication of the Design Bulletin for the design in the prior application (a 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 application have been filed for identical or similar designs on the same date).

In the case of a Design Bulletin pertaining to a design which was requested to be kept secret, the notice of the reason for refusal will be given after the designated period for which the design was requested to be kept secret has elapsed and after the date of publication of the Design Bulletin in which all matters to be published with regard to the application for design registration are published, and before then, a wait notice will be given.

24.1.7.4 Reference date for determination on application of the provision of Article 3-2 of the Design Act with regard to an

international application for design registration

When applying the provision of Article 3 (2) of the Design Act to an international application for design registration, the date of the international registration on which an application for design registration was deemed to have been filed under Article 60-6(1) of the Design Act^(Note) will be the reference date for the determination (this excludes cases where a priority claim under the Paris Convention, etc. was legitimately made).

(Note)

With regard to the “international registration” and “date of the international registration”, see Part XI “International Application for Design Registration”; the same shall apply hereinafter.

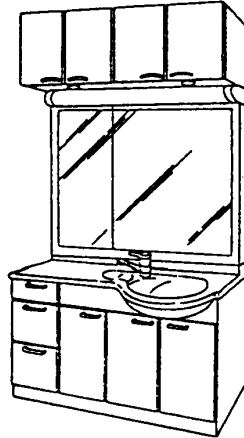
24.2 Examples of applications for design registration for a whole design that fall under the provision of Article 3-2 of the Design Act

- (i) Where the prior application is an application for design registration for a whole design, and part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function

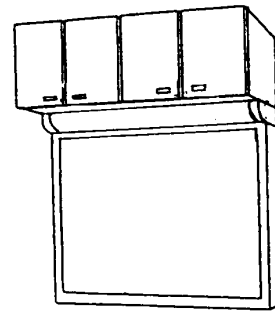
Part II Conditions for Design Registration
Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or
Similar to Part of a Design in a Prior Application

[Applicable case example 1]

Design disclosed in the prior
application
“Bathroom vanity”

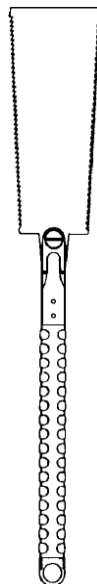


Application for design
registration for a whole design
“Bathroom vanity cabinet”

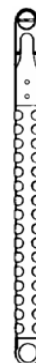


[Applicable case example 2]

Design disclosed in the prior
application
“Handsaw”



Application for design registration
for a whole design
“Handsaw handle”

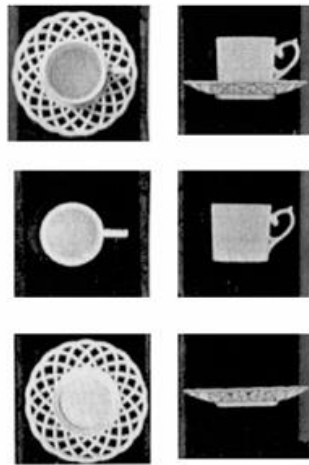


- (ii) Where the prior application is an application for design registration pertaining to a separable article, and the separated design which is part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function

[Applicable case example]

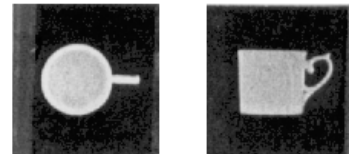
Design disclosed in the prior application

“Coffee cup and saucer”



Application for design registration for a whole design

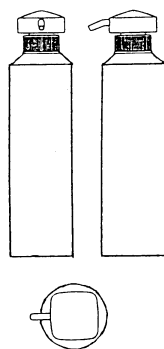
“Coffee cup”



[Not applicable case example]

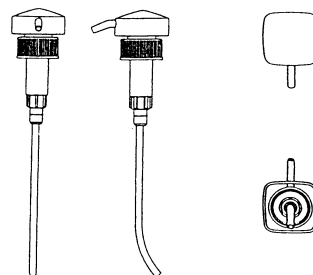
Design disclosed in the prior application

“Spray”



Application for design registration for a whole design

“Injection pump for a spray”



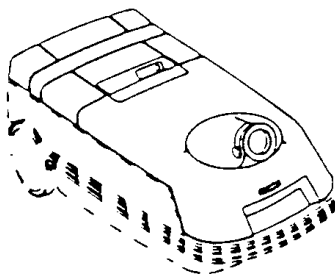
(Supplementary explanation)

The entire form of the whole design in the later application is not sufficiently represented to a comparable level in the design disclosed in the prior application.

- (iii) Where the prior application is an application for design registration for a partial design, and part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function

[Applicable case example 1]

Design disclosed in the prior
application
“Main body of a vacuum cleaner”

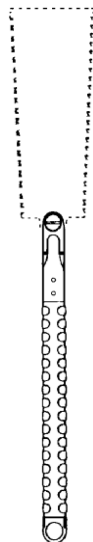


Application for design registration
for a whole design
“Hose inlet for a vacuum cleaner”

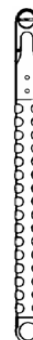


[Applicable case example 2]

Design disclosed in the prior
application
“Handsaw”



Application for design
registration for a whole design
“Handsaw handle”



Part II Conditions for Design Registration

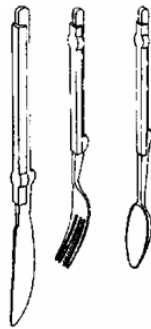
Chapter IV Exclusion from Protection of a Design in a Later Application That Is Identical or Similar to Part of a Design in a Prior Application

- (iv) Where the prior application is an application for design registration for a design for a set of articles, and the design pertaining to a constituent article which is part of the design disclosed in the prior application and the whole design in the later application have identical or similar forms and an identical or similar usage and function

[Applicable case example]

Design disclosed in the prior
application

“Set of dining knives, forks and spoons”



Application for design
registration for a whole design

“Dining spoon”



[Transitional measures]

Supplementary Provisions of the Revising Act

Article 2 The provisions of Article 2(2), Article 3-2, Article 10, Article 14, Article 17, Article 21, Article 42 and Article 48 of the Design Act as revised under Article 1 (hereinafter referred to as the “New Design Act”) apply to an application for design registration filed after the date on which this Act comes into effect, and with regard to an application for design registration filed prior to the date on which this Act comes into effect, the provisions then in force remain applicable.

- Application of the Revising Act to an application for design registration filed after the date on which the Revising Act comes into effect with regard to a design that is identical or similar to part of the design pertaining to an application for design registration filed prior to the date on which the Revising Act comes into effect

The Revising Act applies to an application for design registration filed after the date on which the Revising Act comes into effect with regard to a design that is identical or similar to part of the design pertaining to an application for design registration filed prior to the date on which the Revising Act comes into effect.

- Application of the Revising Act to an application pertaining to division of an application for design registration, conversion of an application, or filing of a new application for an amended design

The Revising Act applies to an application pertaining to division of an application for design registration, conversion of an application, or filing of a new application for an amended design where the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized under Article 10-2(2) of the Design Act (including the cases where applied *mutatis mutandis* pursuant to Article 13(5) of said Act) or Article 17-3(1) of said Act is after the date on which the Revising Act comes into effect.

- Application of the Revising Act to an application for design registration containing a priority claim under the Paris Convention, etc.

The Revising Act applies to an application for design registration containing a priority claim under the Paris Convention, etc. where the filing date in Japan is after the date on which the Revising Act comes into effect, based on the provision of Article 4B of the Paris Convention.

Part III Exception to Lack of Novelty

31 Relevant provisions

Design Act

Article 4 (1) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) against the will of the person having the right to obtain a design registration, such a design shall be deemed not to have fallen under item (i) or (ii) of Article 3(1) for the purposes of Article 3(1) and (2) for any design in an application for design registration which has been filed by the said person within one year from the date on which the design first fell under either of those items.

(2) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) as a result of an act of the person having the right to obtain a design registration (excluding those which have fallen under item (i) or (ii) of Article 3(1) by being published in a gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 3(1) and (2) to any design in an application for design registration which has been filed by the said person within one year from the date on which the design first fell under either of those items.

(3) Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration, a document stating thereof and, within thirty days from the date of filing of the application for design registration, a document proving the fact that the design which has otherwise fallen under item (i) or (ii) of Article 3(1) is a design that is subject to application of the provision of the preceding paragraph (referred to as a "certificate" in the following paragraph).

(4) Notwithstanding the preceding paragraph, where, due to reasons beyond the control of a person who submits a certificate, the person is unable to submit the certificate within the time limit as provided in the said paragraph, the person may submit to the Commissioner of the Patent Office the certificate within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the said time limit.

31.1 Provisions of Article 4(1) and (2) of the Design Act

When a created design has fallen under the category of a publicly known design against the will of the person having the right to obtain a design registration at the time of the disclosure or as a result of an act of the person having the right to obtain a design registration (hereinafter referred to a "disclosed design"), and the person having the right to obtain a design registration for said disclosed design files an application for design registration within one year from the date on which the disclosed design was first disclosed and the prescribed requirements are complied with, said disclosed design is deemed not to be a publicly known design only with

regard to said application for design registration in determination of the requirements of novelty (Article 3(1) of the Design Act) and creative difficulty (Article 3(2) of the Design Act).

Since the provisions of Article 4(1) and (2) of the Design Act do not provide for the relationship between the disclosed design and the design in the application for design registration, the provisions apply to the disclosed design regardless of the relationship between the two designs, such as whether or not the two designs are identical, similar or not similar, as long as the disclosed design and the application for design registration comply with the prescribed requirements.

31.1.1 Requirements for application of the provision of Article 4(2) of the Design Act

In order to apply the provision of Article 4(2) of the Design Act to any disclosed design, the design must comply with the following requirements (1) to (3).

- (1) The design needs to have fallen under the following design (i) or (ii) as a result of an act of the person having the right to obtain a design registration (the creator of the design or to his successor in title).
 - (i) A design that was publicly known in Japan or a foreign country, prior to the filing of the application for design registration.
 - (ii) A design that was described in a distributed publication, or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration.
- (2) The person having the right to obtain a design registration for the above design (1), has filed the application for design registration.
- (3) The application for design registration needs to have been filed within one year from the date on which the above design (1) was disclosed for the first time.

At the time of making a determination on the application of the provision of Article 4(2) of the Design Act, the examiner shall determine whether it is proved that the above requirements are satisfied, based on the "proving document" submitted in accordance with the provision of Article (3) or (4) of the Design Act (hereinafter, simply referred to as "proving document").

31.1.1.1 Person having the right to obtain a design registration for the

disclosed design at the time of the disclosure as stated in the documentary proof

“Person having the right to obtain a design registration” as provided in Article 4(2) of the Design Act shall be referred to as the person having the right to obtain a design registration for the disclosed design at the time of the disclosure.

Generally, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure is the creator of the disclosed design, but where the creator had a third party succeed to the said the right to obtain a design registration, the said person shall be a person who had succeeded the said right at the time of disclosure. As a result, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure and the creator of the design are different, the fact about the succetion to the right needs to be clearly indicated and proved.

31.1.1.2 Fact that the disclosed design was disclosed as a result of an act of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure as stated in the documentary proof

The fact that disclosed design has fallen under the category of a publicly known design as a result of an act of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure as stated in the documentary proof needs to be clearly indicated and proved.

31.1.2 Specific procedures for receiving application of the provision of Article 4(2) of the Design Act

- (1) A document stating a request for the application of the provision of Article 4(2) of the Design Act must be submitted to the Commissioner of the Patent Office upon filing the application for design registration (Article 4(3) of the Design Act). However, the submission of the document may be omitted by including a statement to that effect in the application for design registration in lieu of the submission of said document (Article 27-4 of the Ordinance for Enforcement of the Patent Act applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act).

Meanwhile, in the case of following the procedure by using an electronic data processing system, a request for the application with a

statement to that effect must be recorded in lieu of submitting the said document (Article 12 of the Ordinance for Enforcement of the Act on Special Provisions for Procedures, etc. concerning Industrial Property Rights).

- (2) A document proving that the disclosed design is a design that is subject to application of the provision of Article 4(2) of the Design Act must be submitted to the Commissioner of the Patent Office within 30 days from the date of the application for design registration (Article 4(3) of the Design Act).

Meanwhile, with regard to the proving document, according to the provision of Article (1) of the Ordinance for Enforcement of the Design Act and Form No. 1 of the same Ordinance for Enforcement, the said document must be submitted together with a certificate for requesting the exception to lack of novelty.

31.1.3 Determination Procedures on application of the provision of Article 4(2) of the Design Act based on a “proving document”

31.1.3.1 The case where a “proving document” made according to the format as shown below is submitted

In principle, the examiner shall determine that it is proved that the disclosed design complies with the requirements stated in 31.1.1, and shall admit application of the provision of Article 4(2) of the Design Act.

However, if the examiner found a proof that have him/her doubt that the “disclosed design” is a design to which the provision of Article 4(2) of the Design Act is applicable, the examiner shall not admit application of the provision of Article 4(2) of the Design Act.

Form of "Proving Document"

Proving Document for seeking Application of Exceptions to Lack of Novelty of Design

1. Facts of Disclosure
 - 1) Disclosure date
 - 2) Disclosure site
 - 3) Discloser
 - 4) Contents of disclosed design (the photographs, etc. of the design needs to be attached)
2. Facts of Succession to Right to Obtain Design Registration, etc.
 - 1) Creator of disclosed design
 - 2) Person having right to obtain design registration as of action leading to disclosure of design (the right holder as of the action)
 - 3) Design registration applicant (the person stated in the application form)
 - 4) Discloser
 - 5) About succession to right to obtain design registration (succession to the right from the person in 1) to the person in 3) through the person in 2))
 - 6) About relation, etc. between right holder as of action and discloser (for example, the fact that the person in 4) disclosed the design resulting from the action of the person in 2) needs to be stated)

I hereby certify that the above statements are true.

YYYY/MM/DD

Applicant Name (Signature)

In this section, the facts corresponding to the contents of "1. Facts of Disclosure" and "2. Facts of Succession to Right to Obtain Design Registration, etc." are hereinafter referred to as "facts of disclosure" and "facts of succession to right to obtain design registration, etc.", respectively.

31.1.3.2 The case where the "proving document" made in a form that is different from the form mentioned in 31.1.3.1 has been submitted

If contents equivalent to the form mentioned in 31.1.3.1 is stated in the submitted "proving document", in principle, the examiner shall determine that it is proved that the disclosed design complies with requirements stated in 31.1.3.1, and shall admit the application of the provision of Article 4(2) of the Design Act.

However, even if the "proving document" in which the contents equivalent to the form mentioned in 31.1.3.1 has been submitted, in the case where the examiner finds evidence which casts any doubt on the fact that the "disclosed design" is an design to which the provision of Article 4(2) of the Design Act is applicable, the examiner shall not admit the application of the provision of Article 4(2) of the Design Act.

31.1.3.3 Determination procedures after a notice of reasons for refusal is issued without admission of the application of the provision of Article 4(2) of the Design Act

With regard to an "disclosed design" for which "facts of disclosure" are explicitly stated in the "proving document", after the examiner issues a notice of reasons for refusal without admitting the application of the provision of Article 4(2) of the Design Act, the applicant may assert that the application of the provision of Article 4(2) of the Design Act should be admitted through a written opinion, a written statement, or other such documents. In this case, the examiner shall determine again whether it is proved that the design complies with the requirements stated in 31.1.3.1, in consideration of the assertion of the applicant together with the matters stated in the "proving document".

31.1.4 Points to Note Regarding Determination on Application of Provision of Article 4(2) of the Design Act

31.1.4.1 Handling of disclosure action conducted between the earlier "date on which a design first fell under the provision" of Article 4(2) of the Design Act and the date on which application for design registration was filed, in the case where the same design were disclosed for multiple times

- (1) In the case where the number of designs disclosed resulting from an action of a person having the right to obtain design registration is more than one, in order to seek the application of the provision of Article 4(2) of the Design Act, in principle, the "proving document" for each "disclosed design" must be submitted.

However In the case where a person having the right to obtain design registration disclosed a design, which has fallen under a publicly known design, subsequently multiple times based on the earlier disclosure prior to application for design registration, if the earlier disclosed design is a design that is subject to application of the provision of Article 4(2)

of the Design Act, in spite of the second and subsequent disclosures based on the earlier disclosure, the design shall be deemed not to have fallen under a publicly known design.

For example, in the following examples, if a disclosed design is a design that is subject to application of the provision of Article 4(2) of the Design Act with respect to earlier disclosure, in spite of the subsequent disclosure based on the earlier disclosure, the design shall be deemed not to have fallen under a publicly known design.

Example 1: In the case where a person having the right to obtain design registration delivered a same good to a same customer multiple times, a design disclosed by the first delivery and designs disclosed by the second and subsequent deliveries.

Example 2: A design that has been disclosed first by a person having the right to obtain design registration by delivering a product catalogue on which the design was published to the customer, and secondly and subsequently disclosed by delivering products in accordance with an order from a customer.

(2) In the case where a third party disclosed the same design as the “design which has first fallen under item (i) or (ii) of Article 3(1) of the Design Act” between “the date on which the design first fell under either of those items” and the date on which application for design registration was filed, in principle, the design shall be deemed to fall under a publicly known design through the disclosure by the third party.

However, in the case where it was clear that the disclosure by the third party was based on the disclosure of “the design which has first fallen under item (i) or (ii) of Article 3(1) of the Design Act” (note), in spite of the disclosure, the design shall not fall under a publicly known design.

(Note) “The case where it was clear that the disclosure by the third party was based on the disclosure of “the design which has fallen under item (i) or (ii) of Article 3(1) of the Design Act”” is referred to as the following designs, for example.

Example 1: The design disclosed by selling a good by the right holder to obtain design registration, and the design disclosed by publishing the good on a website by a third party who purchased the good.

Example 2: The design disclosed by exhibiting in a trade fair by the right holder to obtain design registration, and the design disclosed whose

exhibition information was published in a paper.

31.1.4.2 Handling of application of the provision of Article 4(2) of the Design Act in the case where a design differing from the filed design is disclosed, etc.

According to the provision of Article 4(2) of the Design Act, regardless of the relationship between the disclosed design prior to application for design registration and the said design in application for design registration, such as whether or not the two designs are identical, similar or not similar, in determination of registration requirements of novelty (Article 3(1) of the Design Act) and creative difficulty (Article 3(2) of the Design Act), if the disclosed design stated in the “proving document” complies with the prescribed requirements, only the said disclosed design shall be deemed as a design not to have fallen under a publicly known design. Thus, application of the provision of Article 4(2) of the Design Act shall not be admitted for a disclosed design not stated in the “proving document”, and the design shall be handled as a publicly known design.

The case where multiple designs being similar to each other are disclosed prior to application for design registration, etc. shall be handled as follows.

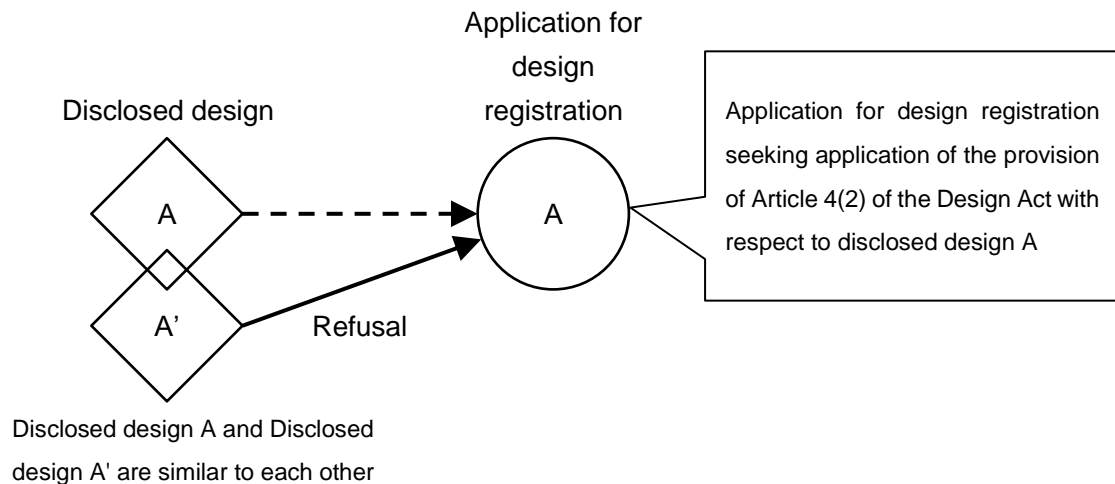
31.1.4.2.1 Handling of the case where design A and design A' which are similar to each other are disclosed prior to application for design registration, and only design A is stated in the “proving document” of application A for design registration seeking for application of the provision of Article 4(2) of the Design Act.

In this case, only design A may be subject to application of the provision of Article 4(2) and shall be deemed not to have fallen under a publicly known design.

Thus, a design in application A for design registration that is similar to design A' having fallen under a publicly known design prior to filing application thereof, shall fall under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where design A and design A' are stated in the “proving document” of application A for design registration and prescribed requirements are complied with, design A and design A' shall be subject to application of the provision of Article 4(2) of the Design Act and shall be deemed not to have fallen under a publicly

known design.



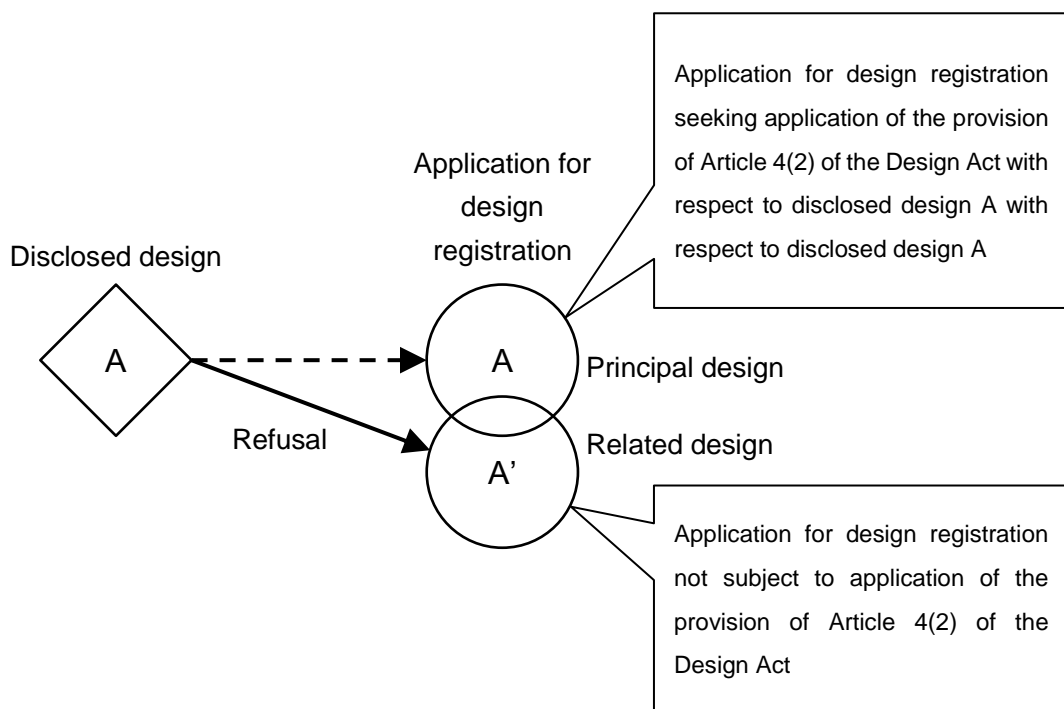
31.1.4.2.2 Handling of disclosed design A with respect to application A' for design registration in the case where in order to seek application of the provision of Article 4(2) of the Design Act with respect to application A for design registration of a principal design, design A disclosed prior to the design registration is stated in the “proving document”, but with respect to application A' for design registration of a design subsequently filed as a related design, required procedures for seeking application of the provision of Article 4(2) of the Design Act are not conducted

With respect to application A' for design registration of a related design, since required procedures for seeking application of the provision of Article 4(2) of the Design Act are not conducted, disclosed design A may not be deemed as a design not to have fallen under a publicly known design.

Thus, a design of application A' for design registration that is similar to disclosed design A having fallen under a publicly known design prior to filing application thereof, falls under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where procedures for seeking application of the provision of Article 4(2) of the Design Act are conducted with

respect to application A' for design registration of a related design and disclosed design A is stated in the "proving document" so as to comply with prescribed requirements, disclosed design A is subject to application of the provision of Article 4(2) of the Design Act and shall be deemed as a design not to have fallen under a publicly known design.



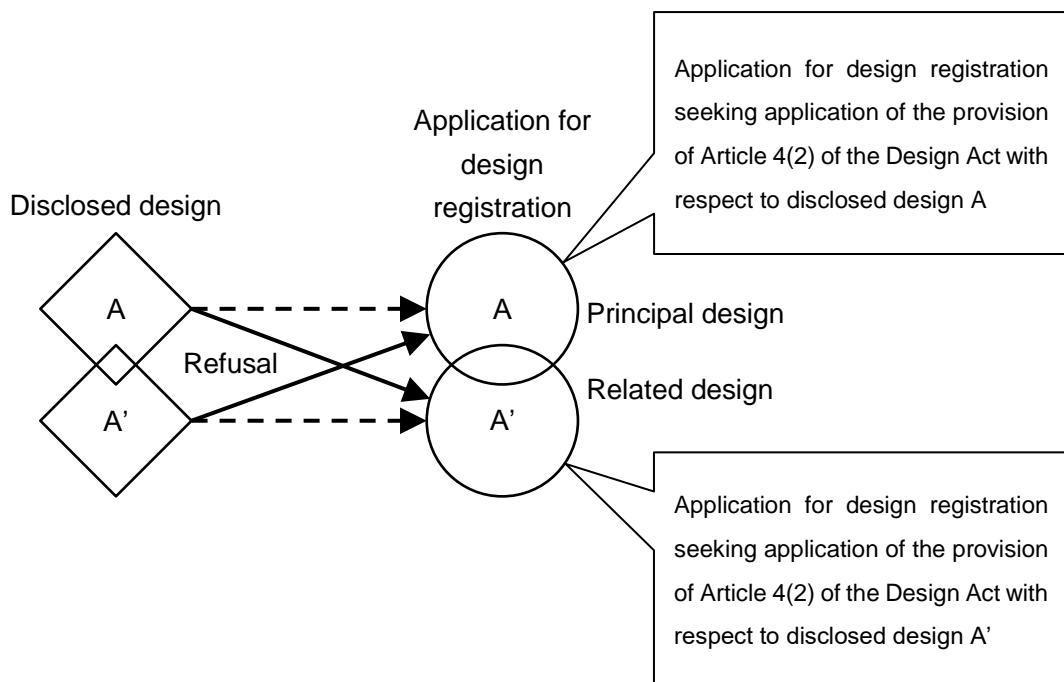
31.1.4.2.3 Handling of the case where design A and design A', which are similar to each other, are disclosed prior to filing application for design registration, and application A for design registration and application A' for design registration seeking application of the provision of Article 4(2) of the Design Act are filed, but only the disclosed design that is identical to the design in application is stated in the "proving document" of each application

Regardless of whether the relationship between the both designs is a relationship between a principal design and a related design, with respect to application A for design registration, only design A stated in the "proving document" may be deemed as a design not to have fallen under a publicly known design according to the application of

the provision of Article 4(2) of the Design Act, similarly, with respect to application A' for design registration, only design A' stated in the "proving document" may be deemed as a design not to have fallen under a publicly known design according to application of the provision of Article 4(2) of the Design Act.

Thus, both of a design of application A for design registration, which is similar to disclosed design A' having fallen under a publicly known design prior to filing application thereof, and a design of application A' for design registration, which is similar to the disclosed design A having fallen under a publicly known design prior to filing application thereof, fall under Article 3(1)(iii) of the Design Act and may not receive a design registration.

Meanwhile, in the case where in application A for design registration and application A' for design registration, disclosed design A' in the "proving document", respectively, and the prescribed requirements are complied with, in both applications, disclosed design A and disclosed design A' shall be subject to application of the provision of Article 4(2) of the Design Act and shall be deemed as a design not to have fallen under a publicly known design.



31.1.5 Requirements for application of the provision of Article 4(1) of the Design Act

In order to apply the provision of Article 4(1) of the Design Act to any disclosed design, the design needs to satisfy the following requirements (1) to (3).

- (1) A design has fallen under the following design (i) or (ii) against the will of the person having the right to obtain a design registration (the creator of the design or to his successor in title).
 - (i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration.
 - (ii) Designs that were stated 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.
- (2) The person having the right to obtain a design registration of the above design (1) has filed the application for design registration.
- (3) The application for design registration of the above design (1) has been filed within one year from the date on which the above design (1) was disclosed first.

31.1.5.1 Person having the right to obtain a design registration for the disclosed design

“Person having the right to obtain a design registration” as provided in Article 4(1) of the Design Act shall be referred to as a person having the right to obtain a design registration for the disclosed design at the time of the disclosure.

Generally, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure is the creator of the disclosed design, but where the creator had a third party succeed to the said the right to obtain a design registration, the said person shall be a person who had succeeded the said right at the time of disclosure. As a result, the person having the right to obtain a design registration for the disclosed design at the time of the disclosure and the creator of the design are different, the fact about the fact about the succession to the right needs to be clearly indicated and proved.

31.1.5.2 Fact that the disclosure was against the will of the person having the right to obtain a design registration for the disclosed

design

A case where a design is disclosed against the will of the person having the right to obtain a design registration for the disclosed design falls under such a case as where a design created by a creator is disclosed by a third party through theft or misappropriation, for example.

The fact about the background that led to the disclosure against the will of the person having the right to obtain a design registration for the disclosed design at the time of the disclosure needs to be clearly indicated and proved.

31.1.6 Procedures for receiving application of the provision of Article 4(1) of the Design Act

The procedures for receiving application of the provision of Article 4(1) of the Design Act (the time limitation on submission of a document stating a request for the application of the provision of Article 4(1) of the Design Act, making of a statement requesting application of said provision in the application document or submission of a document proving the fact that the design was disclosed against the will of the person having the right to obtain a design registration, etc.) are not provided in Article 4(3) of the Design Act.

Therefore, it is sufficient for an applicant for design registration of the application for design registration to clearly indicate and prove the fact that the requirements set forth in 31.1.5 mentioned above are complied with in a written opinion, a written statement, or other such documents, at the time when the fact that the disclosed design was disclosed against the will of the person having the right to obtain a design registration became clear, which is, for example, at the time when upon receiving a notice of the reasons for refusal under the provision of Article 3(1)(iii) of the Design Act for the application for design registration.

Meanwhile, where it becomes clear prior to the filing of the application for design registration that a disclosed design complying with the requirements set forth in 31.1.5 exists, the applicant for design registration may submit a document proving such fact upon filing the application for design registration.

31.1.7 Determination on application of the provision of Article 4(1) of the Design Act

The examiner shall determine whether reasonable clarification that the said disclosed design comply with the requirement of 31.1.5 mentioned above is made by a written opinion, a written statement, or other such document submitted by an applicant for indicating that a disclosed design may be subject to application of the provision of Article 4(1) of the Design Act.

Part IV Unregistrable Designs

41 Relevant provisions

Design Act

Article 5 Notwithstanding Article 3, the following designs shall not be registered.

- (i) a design which is liable to injure public order or morality;
- (ii) a design which is liable to create confusion with an article pertaining to another person's business; or
- (iii) a design solely consisting of a shape that is indispensable for securing functions of the article.

41.1 Provisions of Article 5 of the Design Act

Maintaining public order and morality and eliminating factors detrimental to the development of industry are important in terms of public interest, and subject matter whose nature is contrary to this principle should not be protected by law. Hence, even where a design complies with the requirements for design registration, such as being novel, involving creative difficulty, and being industrially applicable, if it falls under any of the following at the time of the grant of an examiner's decision on design registration, the design may not be registered.

- (1) A design which is liable to injure public order or morality (→ 41.1.1 and 41.1.2)
- (2) A design which is liable to create confusion with an article pertaining to another person's business (→ 41.1.3)
- (3) A design solely consisting of a shape that is indispensable for securing functions of the article (→ 41.1.4)

41.1.1 Design which is liable to injure public order

A design that represents the image of the head of state or the national flag of Japan or a foreign country or a design representing the imperial chrysanthemum crest of Japan or a royal crest of a foreign country (including a design similar thereto) is very likely to injure the dignity of the country or the imperial or royal family and is found to be liable to injure public order, so such design may not be registered.

However, this does not include the case where the design is found not to be liable to injure public order, such as in the case of a patterned design made up of the flags of all nations for a sporting event decoration.

41.1.2 Design which is liable to injure morality

A design that unjustly offends the moral sense of or arouses a sense of shame or disgust in a mentally and physically sound person, such as a design

representing obscene material, is found to be liable to injure morality, so such design may not be registered.

41.1.3 Design which is liable to create confusion with an article pertaining to another person's business

A design representing another person's famous mark or a mark that can be mixed up therewith is very likely to lead to confusion that the article to the design is produced or sold in relation to the business of that person or organization, and the design is found to create confusion with an article pertaining to another person's business, so such design may not be registered.

41.1.4 Design solely consisting of a shape that is indispensable for securing functions of the article

A shape that is indispensable for securing functions of an article constitutes a creation of a technical idea, which should normally be protected by the Patent Act or the Utility Model Act. If such shape is to be given protection under the Design Act, this would lead to the same consequence as granting an exclusive right for the creation of a technical idea, which is not intended to be protected by the Design Act. For this reason, a design solely consisting of a shape that is indispensable for securing functions of the article may not be registered.

41.1.4.1 Categories of designs that are found to be a design solely consisting of a shape that is indispensable for securing functions of the article

A design that falls under any of the following is found to be a design solely consisting of a shape that is indispensable for securing functions of the article.

(1) Design consisting of a shape that is inevitably decided for securing the technical functions of the article (inevitable shape)

Whether or not the design in an application for design registration is categorized as an inevitable shape will be determined by merely focusing on the shape that embodies the technical function of the article, regardless of the pattern and color, which are the constituent elements of the design, and in this process, the following points will be taken into consideration in particular.

- (i) Whether or not there exists any other alternative shape that can secure the function
- (ii) Whether or not the design includes a shape that should be taken into consideration in evaluating the design, other than the

inevitable shape

- (2) Design consisting of a shape that is decided by a standardized specification for securing the compatibility of the article (quasi-inevitable shape)

A design where the elements of the article such as its shape, size, etc. are specified or standardized for securing the compatibility of the article (including securing the technical function), and which consists of a shape that needs to be accurately reproduced based on the specified or standardized shape, size, etc. is also handled in the same manner as the design of an inevitable shape as set forth in (1) above.

However, the provision of Article 5(iii) of the Design Act will only be applied to an article whose main purpose of use is to exhibit the function based on the shape.

Therefore, for example, office paper (Sizes of paper JIS P 0202), paper for daily use (Envelopes JIS S 5502) and recording media (Compact disc digital audio system JIS S 8605) have a shape that is decided by a public standard specification or a de facto standard specification, but they are not subject to application of the provision of Article 5(iii) of the Design Act.

41.1.4.1.1 Examples of specifications that are categorized as standardized specifications

Specifications that fall under the following are categorized as standardized specifications for securing the compatibility of the article, etc.

- (1) Public standards

Standard specifications formulated by public standards organizations, such as JIS (Japanese Industrial Standards) formulated by the General Incorporated Foundation Japanese Standards Association, and ISO International Standards formulated by the International Organization for Standardization (ISO)

- (2) De facto standards

Specifications that are not public specifications, but are recognized as industry standards in the field of the article, where products based on said standard specifications

practically dominate the market of the article and where it is possible to specify the details of the standard shape, size, etc. based on the name, number, etc. of the specification

Part V One Application per Design

51 Relevant provisions

Design Act

Article 7 An application for design registration shall 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.

Ordinance for Enforcement of the Design Act

Article 7 The classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry referred to in Article 7 of the Design Act shall be that set forth in the column of “Classification of Articles” in Appended Table 1.

Appended Table 1 Notes

1. When filing an application for design registration with regard to an article that belongs to a classification of articles listed in the right-hand column of this table, the classification of articles to which the article belongs must be stated in the column of “Article to the Design” of the application.
2. When filing an application for design registration with regard to an article that does not fall under any items of the classification of articles listed in the right-hand column of this table, a classification of articles equivalent in level to the classification of articles listed in the right-hand column must be stated in the column of “Article to the Design” of the application.

Form No. 2 [Notes]

(39) When filing an application for design registration with regard to an article which does not belong to any items of the classification of articles listed in the right-hand column of Appended Table 1, an explanation which can help in understanding the article, such as the purpose of use or the state of use of the article, is to be stated in the column of “[Description of Article to the Design].”

51.1 Provision of Article 7 of the Design Act

Article 7 of the Design Act provides that an application for design registration must be filed for each design.

Article 7 of the Design Act was stipulated from the viewpoint of clarifying the contents of the right to be established; by establishing one design right, which is an exclusive right, for one design, the provision aims to secure the stability of the right and prevent unnecessary disputes, with consideration to the procedural convenience and convenience in the event of an infringement dispute, etc. after the establishment of the right.

Meanwhile, if an applicant for design registration could freely make a statement in the column of “Article to the Design” which is to be stated in the application under Article 6 of the Design Act, such as allowing such a statement as “Pottery,” it would have the same result as allowing the filing of an application for design registration for a design with a very broad usage and function, compared to the case of stating “Flower vase” in the column. Therefore, it was decided that the classification of articles should be separately provided by an Ordinance of the Ministry of Economy, Trade and Industry.

51.1.1 Classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry

The classification of articles as provided by an Ordinance of the Ministry of Economy, Trade and Industry refers to the classification of articles indicated in Appended Table 1 as provided in Article 7 of the Ordinance for Enforcement of the Design Act.

Appended Table 1 exemplifies the classification of articles in response to Article 7 of the Design Act which provides that an application for design registration must 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. However, since it would not be easy to search for an appropriate classification if the over-2,400 classifications of articles were merely listed in Japanese alphabetical order, the table largely divides the classifications into 65 groups, and further subdivides similar classifications into sub-groups as appropriate. The indications in the left-hand and middle columns of Appended Table 1 are merely positioned as headings for the classification of articles listed in the right-hand column.

The classification of articles listed in the right-hand column indicates the classification level of the name of the article required to be used for recognizing a design, which is found to be the name that is normally used for the article and that enables people to clearly understand the usage of the article.

51.1.2 Examples of cases that do not comply with the requirements provided in Article 7 of the Design Act

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

A statement in the column of “Article to the Design” in the application which falls under any of the following is not based on a classification of articles listed in Appended Table 1 or a classification of articles equivalent in level to such classification.

- (1) A statement that is not used as a general name in the art
- (2) A statement with a proper name, such as a trademark name or “so-and-so type”
- (3) A statement using a generic name
(e.g., stating “Building supplies” for “Window shutter”)
- (4) A statement using foreign characters
- (5) An abbreviated classification of articles which is not used as a common name
- (6) A statement using the term “set” although the articles are not those under Appended Table 2 of the Regulation for Enforcement of the Design Act (hereinafter referred to as “Appended Table 2”)

51.1.2.2 Examples of applications that are not filed for each design

Where an application falls under either of the following when making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, 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
- (2) Where two or more articles are indicated in the drawings, etc. (including the case where multiple articles are arranged in the drawings, etc.)

However, this excludes cases where an application for design registration is filed for a design for a set of articles.

51.1.2.2.1 Determination as to whether two or more articles are indicated

If multiple constituent objects constituting the article to the design are indicated in the drawings, etc., whether or not the design in the application for design registration pertains to two or more articles is determined as follows.

- (1) Even where multiple constituent objects are indicated in the drawings, etc., if all of the constituent objects are essential for performing a specific single usage and function from a common sense perspective, they are determined to constitute a single article.

On the other hand, if the multiple constituent objects are found to have no connection with each other for performing a specific single usage and function, they are determined to constitute two or more articles.

However, even where their connection is not strong, if the following apply, whether or not they constitute a single article is determined by also complementarily considering such aspects.

- (i) Where all of the constituent objects physically constitute a single bundle, or where they are cohesive as a single form such as the case where they have been created in an integrated manner with close relevance in form
- (ii) Where all of the constituent objects are worked in an integrated manner from a common sense perspective

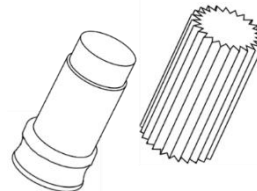
(2) Examples of constituent objects that are determined to constitute a single article

[Case example 1] Solid glue with a container

[Perspective View]



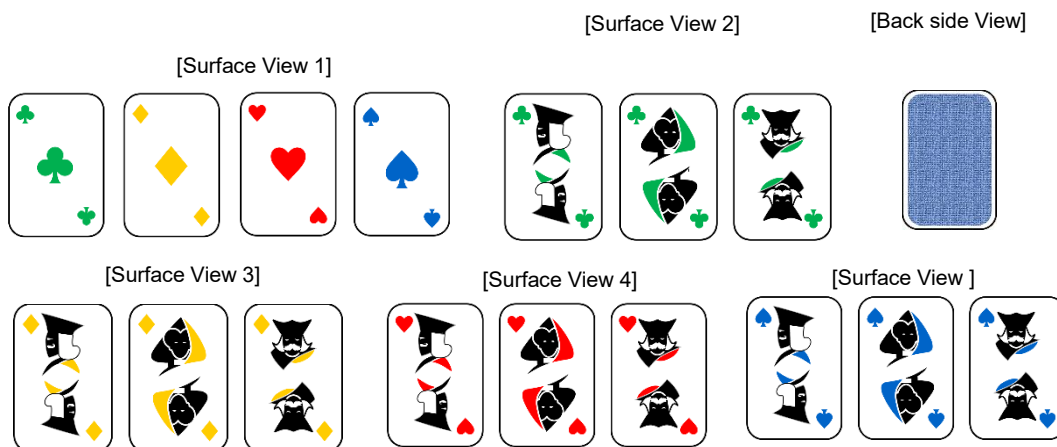
[Perspective View with the Lid Off]



* The matters to be stated in the application and any other views are omitted.

* It is generally necessary to put a solid glue in a container in order to apply the glue and prevent the glue from drying or otherwise deteriorating in quality, so the solid glue and the container with a lid are found to be essential for performing the usage and function of the solid glue from a common sense perspective, and are determined to constitute a single article.

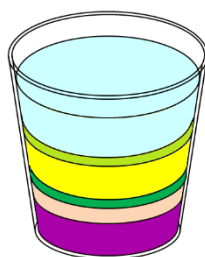
[Case example 2] Playing cards



* The matters to be stated in the application and any other views are omitted.

* Playing cards are widely known as a card game consisting of 13 cards (consisting of number cards from 1 to 10 and picture cards jack, queen, and king) for each of the four suits—heart, diamond, club, and spade—plus a joker card. From a common sense perspective, all of these cards are essential for performing the usage and function of the playing cards, so they are determined to constitute a single article.

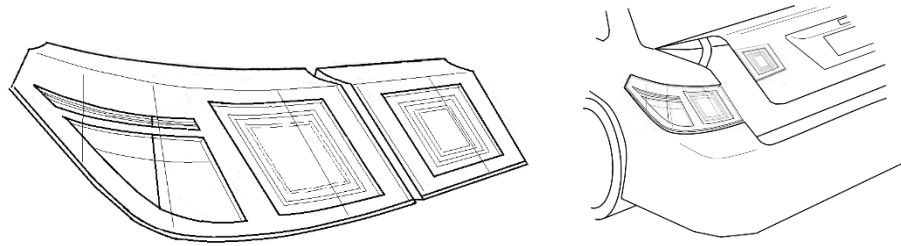
[Case example 3] Jelly with a container



* The matters to be stated in the application and any other views are omitted.

* In the case of a jelly with a container, the jelly can be taken out of the container and be put in a bowl, etc., so their connection cannot be regarded as essential for performing a specific single usage and function, but complementarily considering that they are, they have been created cohesively in terms of their forms in totality, from a common sense perspective, manufactured in an integrated manner, distributed on the market in an integrated manner, and exist in an integrated manner when the jelly is eaten, they are determined to constitute a single article.

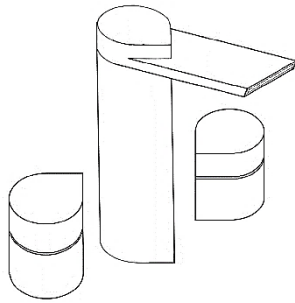
[Case example 4] Tail lamp of a passenger vehicle



* The matters to be stated in the application and any other views are omitted.

* This tail lamp for a passenger vehicle is physically separated into a component to be attached to the trunk and a component to be attached to the vehicle body. However, from a common sense perspective, these two components are recognized as a tail lamp of a vehicle as a bundle, and both components are essential for performing the usage and function of a tail lamp for a vehicle, so they are determined to constitute a single article.

[Case example 5] Hot and cold water mixing faucet

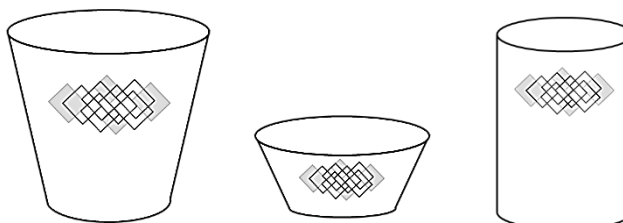


* The matters to be stated in the application and any other views are omitted.

* This hot and cold water mixing faucet is physically separated into a spout and handles. However, from a common sense perspective, these three components are recognized as a hot and cold water mixing faucet as a bundle, and all components are essential for performing the usage and function of a hot and cold water mixing faucet. In addition, they are cohesive as a single form, so they are determined to constitute a single article.

(3) Examples of constituent objects that are determined to constitute two or more articles

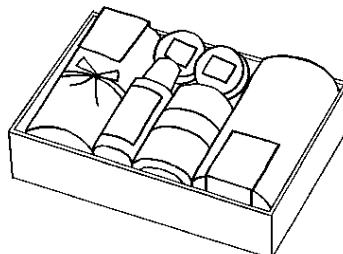
[Case example 1] Cups



* The matters to be stated in the application and any other views are omitted.

* These multiple cups are not found to be essential for performing a specific single usage and function from a common sense perspective. Also, although these cups bear common patterns, it cannot be said that they have been created cohesively in terms of their forms in totality. In addition, it cannot be said that these multiple cups are sold as a set in general. Due to these reasons, they cannot be determined to constitute a single article, and are determined to constitute two or more articles.

[Case example 2] Gift set



* The matters to be stated in the application and any other views are omitted.

* Most gift sets pack multiple articles into a single container in order to sell them as gifts. The combinations of articles are varied, a single gift set contains many articles, and it cannot be found that all of these are intended to perform a specific single usage and function, so they cannot be determined to constitute a single article.

51.1.2.3 Handling in the case of partial design

For examples of cases that do not comply with the requirements provided in Article 7 of the Design Act with regard to partial designs, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.7.1 “Examples of cases that do not comply with the requirements provided in Article 7 of the Design Act.”

Part VI Prior Application

61 Relevant provisions

Design Act

Article 9 (1) Where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration on the earliest date shall be entitled to obtain a design registration for the design.

(2) Where two or more applications for design registration have been filed for identical or similar designs on the same date, only one applicant, who was selected by consultations between the applicants who filed the said applications, shall be entitled to obtain a design registration for the design. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a design registration for the design.

(3) Where an application for design registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that an application for design registration is to be refused has become final and binding, the application for design registration shall, for the purpose of the preceding two paragraphs, be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the application for design registration is to be refused has become final and binding on the basis that the latter sentence of the preceding paragraph is applicable to said application for design registration.

(4) The Commissioner of the Patent Office shall, in the case of paragraph (2), order the applicants to hold consultations as specified under paragraph (2) and to report the result thereof, designating an adequate time limit.

(5) Where no report under the preceding paragraph is submitted within the time limit designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) has been reached.

61.1 Provisions of Article 9 of the Design Act

The design registration system grants a right to monopoly for a creation of a new design for a specified period. Therefore, two or more rights should not be granted for a single creation.

For the purpose of eliminating such overlapping rights, Article 9 of the Design Act provides that, where two or more applications for design registration have been filed for identical or similar designs, only one applicant for design registration is entitled to obtain a design registration.

61.1.1 Applications for design registration that are subject to application of the provision of Article 9(1) or (2) of the Design Act

Application of the provision of Article 9(1) or (2) of the Design Act is determined with regard to two or more applications for design registration for whole designs or two or more applications for design registration for partial designs, and also with regard to whole designs and partial designs.

Therefore, for example, where an application for design registration for a partial design is filed first, and an application for design registration for a whole design to an article which is identical with or similar to the article in the prior application is filed on a later date, the provision of Article 9(1) of the Design Act shall apply to the whole design in the later application if the partial design in the prior application has been registered and the whole design in the later application is similar to the partial design in the prior application. Where an application for design registration for a whole design and an application for design registration for a partial design with regard to articles that are identical with or similar to each other are filed on the same date, if both designs are similar to each other, the provision of Article 9(2) of the Design Act shall be applied.

61.1.2 Categories of applications for design registration that are treated as prior applications

An application for design registration that falls under either of the following is treated as a prior application for design registration with regard to application of the provision of Article 9(1) of the Design Act.

- (1) An application for design registration for which establishment of a design right has been registered
- (2) An application for design registration for which the examiner's decision or trial decision to the effect that the application is to be refused has become final and binding on the basis that no agreement was reached by consultations under Article 9(2) of the Design Act or such consultations were unable to be held for identical or similar designs for which applications were filed on the same date

61.1.3 Categories of applications for design registration that are not treated as prior applications or applications filed on the same date

An application for design registration that falls under any of the following (1) to (4) is deemed never to have been filed with regard to application of the provisions of Article 9(1) and (2) of the Design Act.

- (1) A waived application for design registration
- (2) A withdrawn application for design registration^(Note)
- (3) A dismissed application for design registration
- (4) An application for design registration for which the examiner's decision or trial decision to the effect that the application is to be refused has become final and binding

(Note)

This includes an application for design registration which was deemed to have been withdrawn under the provision of Article 60-14(1) of the Design Act, that is, an international application for design registration whose basic international registration extinguished because the international registration was waived under the provision of Article 16(1)(iv) of the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs or limited under the provision of Article (1)(v) of the same Article or the international registration was not renewed under the provision of Article 17(2) of the same Agreement (limited to cases where establishment for a design right for said international application for design registration has not been registered).

61.1.4 Determination of similarity between a whole design and a whole design

With regard to determination of similarity between two or more whole designs under Article 9(1) or (2) of the Design Act, the determination of similarity between a publicly known design and a whole design applies, so see Part II "Requirements for Design Registration," Chapter II "Novelty," 22.1.3.1 "Determination of similarity between designs."

When applying the provision of Article 9(1) or (2) of the Design Act to an application for design registration for a whole design, determination will be made as to whether the designs described in the statements in the respective applications and drawings, etc. attached to the applications are identical or similar.

Therefore, even where a certain design can be specifically identified within another design, determination will not be made on whether that design and part of the other design are identical or similar, as in the case of a design described in a publication as set forth in Article 3(1)(ii) of the Design Act (see Part II "Requirements for Design Registration," Chapter II "Novelty," 22.1.2.6 "Design described in a publication," (1) "Examples of designs that can be used as information that serves as the basis for determination of novelty," (ii)).

61.1.5 Determination of similarity between a partial design and a partial design

With regard to determination of similarity between two or more partial designs, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.9.1 “Determination of similarity between a partial design and a partial design.”

61.1.6 Determination of similarity between a whole design and a partial design

With regard to determination of similarity between a whole design and a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.9.2 “Determination of similarity between a whole design and a partial design.”

61.1.7 Applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, only the applicant for design registration who filed the application for design registration on the earliest date is entitled to obtain a design registration for the design under the provision of Article 9(1) of the Design Act, regardless of whether the two or more applications for design registration were filed by the same person or by different persons.

61.1.8 Applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, only the applicant for design registration who filed the application for design registration on the earliest date is entitled to obtain a design registration for the design under the provision of Article 9(1) of the Design Act.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, a design registration may be obtained for a design selected from the applicant's own designs for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the “principal design”) and its related design, only if the case falls under the provision of Article 10(1) of the Design Act. However,

even with regard to a related design whose principal design is the design in the earliest application, where there is a similar registered design pertaining to an earlier application other than the principal design and its related designs, a design registration may not be obtained under Article 9(1) of the Design Act (because not all of the reasons for refusal under Article 9(1) of the Design Act based on these similar designs can be remedied under Article 10(1) of the Design Act simultaneously).

61.1.9 Applications for design registration filed for identical designs on the same date

Where two or more applications for design registration have been filed for identical designs on the same date, the two or more applications for registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and only one applicant for design registration, selected in the consultations, is entitled to obtain a design registration for the design, regardless of whether they are applications for design registration filed by the same person or by different persons.

61.1.10 Applications for design registration filed for similar designs on the same date

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and only one applicant for design registration, selected in the consultations, is entitled to obtain a design registration for the design.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on the same date, the two or more applications for design registration fall under the provision of the first sentence of Article 9(2) of the Design Act and become subject to the order to hold consultations under Article 9(4) of the Design Act, and except for only one applicant for design registration, selected in the consultations, others are not entitled to obtain a design registration for the design; however, where the applications for design registration are filed by the same person,

a design registration for the principal design and its related design may be obtained only where the case falls under the provision of Article 10(1) of the Design Act.

61.1.11 Handling of applications for design registration filed for identical designs on different dates

Where two or more applications for design registration have been filed for identical designs on different dates, one design in the earliest application is to be registered and designs in later applications are to be refused under Article 9(1) of the Design Act for that reason, regardless of whether they are applications for design registration filed by the same person or by different persons. Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

61.1.12 Handling of applications for design registration filed for similar designs on different dates

(1) Where the applications for design registration are filed by different persons

Where two or more applications for design registration have been filed for similar designs by different persons on different dates, the design in the earliest application that has no reason for refusal is to be registered and designs in later applications are to be refused under Article 9(1) of the Design Act for that reason. Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

(2) Where the applications for design registration are filed by the same person

Where two or more applications for design registration have been filed for similar designs by the same person on different dates, the design in the earliest application that has no reason for refusal is to be registered. The designs in later applications are to be registered if the applications are filed before the date of publication of the Design Bulletin for the earliest

application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published) and they are applications for related designs whose principal design is the design in the earliest application. However, where the design in a later application is similar to two or more registered designs in earlier applications, and if these include registered designs that are not the principal design and its related designs, the later application is refused by giving a notice mentioning these multiple applications for design registration as the reason for refusal under Article 9(1) of the Design Act.

Where a later application is filed before the date of publication of the Design Bulletin for the earliest application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published), but it is not an application for design registration for a related design, a notice mentioning the earliest application as the reason for refusal under Article 9(1) of the Design Act is given; if the design in the later application is amended into a related design whose principal design is the design in the earliest application, the design in the later application is registered.

An application for design registration that is filed on the same day as the date of publication of the Design Bulletin for the earliest application (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published) is to be refused under Article 9(1) of the Design Act. (However, if the later application is filed on the same day as the date of publication, but it is obvious that the application for design registration was filed before the publication of the Design Bulletin, the application for design registration is to be refused under Article 3(1) of the Design Act.)

Where the earlier application is an application for design registration for which the examiner's decision or trial decision to the effect that an application is to be refused has become final and binding as a result that no agreement was reached by consultations or consultations were unable to be held based on Article 9(2) of the Design Act, designs in later applications are to be refused under Article 9(1) of the Design Act for that reason.

61.1.13 Handling of applications for design registration filed for identical or similar designs on the same date

- (1) Where the applications for design registration are filed by different persons
 - (i) An order is given in the name of the Commissioner to the respective applicants for design registration to hold consultations under Article 9(4) of the Design Act.
 - (ii) Where a report on the results of consultations is submitted within the designated time limit, an examiner's decision to the effect that a design registration is to be granted is rendered only for the application for design registration filed by one applicant for design registration that was selected in the consultations. However, even where such report is submitted, if the procedure for withdrawal or waiver is not taken for the applications for design registration other than the application for design registration filed by the one applicant for design registration selected in the consultations, or if the contents of reports of the results of consultations held in response to multiple orders for consultations are inconsistent, it is found that no agreement was reached by consultations, and a notice of the reason for refusal under the second sentence of Article 9(2) of the Design Act is given to the respective applicants for design registration.
 - (iii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by the consultations under Article 9(5) of the Design Act, and a notice of the reason for refusal under the second sentence of Article 9(2) of the Design Act is given to the respective applicants for design registration.
- (2) Where the applications for design registration are filed by the same person
 - (i) An order is given in the name of the Commissioner to the applicant for design registration to hold consultations under Article 9(4) of the Design Act. However, at the same time as giving such order in the name of the Commissioner, a notice of the reason for refusal based on the second sentence of Article 9(2) of the Design Act is given. The reason for such practice is that it is found that only a short time for consultations is needed where the applicant is the same person.
 - (ii) Where no report on the results of consultations is submitted within the designated time limit, it is deemed that no agreement was reached by the consultations under Article 9(5) of the Design Act, or where a report on the results of consultations is submitted within the designated time limit but the applications for design registration other than the application

for design registration filed by one applicant for design registration selected in the consultations are not withdrawn or waived or if the contents of reports of the results of consultations held in response to multiple orders for consultations are inconsistent, it is found that no agreement was reached by consultations, and an examiner's decision is given to the effect that the applications for design registration are to be refused based on the reason for refusal under the second sentence of Article 9(2) of the Design Act of which notice had been given in advance.

61.1.13.1 Examples of cases where the contents of reports of the results of consultations held in response to multiple orders for consultations are found to be inconsistent

- (1) Case of a report selecting one of the applicants for design registration subject to consultations, for which no agreement is found to have been reached
 - (i) A report whereby both applicants select themselves
 - (ii) A report whereby both applicants select each other
- (2) Case of a report specifying the design in one of the applications for design registration subject to consultations as a principal design and the designs in the other applications for design registration as its related designs, for which no agreement is found to have been reached
 - (i) A report selecting a design that does not exist as a principal design
 - (ii) A report selecting a not similar design, a design in an application for design registration filed on a different date, or a design in an application for design registration filed by a different applicant for design registration as a principal design
 - (iii) A report selecting a design in an application for design registration for a related design as a principal design
 - (iv) A report selecting multiple designs as a principal design

61.1.13.2 Handling of the case where no report is submitted in response to an order for consultations and procedures for withdrawal or waiver are taken only for one or some of the applications for design registration

With regard to applications for design registration that are filed for identical or similar designs by the same person on the same date, an

order for consultations is issued for each such application for design registration, and a report on the results of consultations are required to be submitted for each application for design registration, in principle.

Even if procedures for withdrawal, waiver or amendment are taken only for one or some of the applications for design registration subject to consultations, it cannot be immediately deemed that an agreement has been reached by consultations, but it is necessary to wait for the procedures compliant with the gist of the order for consultations to be taken for all of the applications for design registration subject to consultations, until the expiration of the designated time limit, while treating them as applications for which a report on the results of consultations has yet to be submitted.

Where no report on the results of consultations is submitted by the designated time limit, it can be deemed that no agreement was reached by consultations under Article 9(5) of the Design Act; however, if an amendment has been made to make the design in an application for design registration subject to consultations a principal design or its related design within the designated time limit or if either of the applications for design registration subject to consultations has already been withdrawn or waived, the reason for consultations has been resolved by the amendment or the procedure of withdrawal or waiver, so it is not deemed that no agreement was reached by consultations.

61.1.14 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

In the case of division of an application for design registration under Article 10-2(1) of the Design Act, conversion of a patent application or an application for utility model registration into an application for design registration under Article 13(1) or (2) of the Design Act, or filing of a new application for design registration for an amended design for which a ruling dismissing an amendment has been made under Article 17-3 of the Design Act, if the procedures are conducted legitimately, such application for design registration is deemed to have been filed at the time of filing the original application or at the time of submitting the written amendment of proceedings.

However, since determination on application of the provision of Article 9(1) or (2) of the Design Act is made on the basis of the day of the filing the application for design registration, with regard to the new application for design registration resulting from division, that resulting from conversion, or that for an

amended design for which a ruling dismissing an amendment has been made, the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized will be the reference date for the determination.

61.1.15 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.

When applying the provision of Article 9(1) or (2) of the Design Act, where the claim is legitimate, the filing date of the first application will be the reference date for the determination.

61.1.16 Reference date for determination on application of the provision of Article 9(1) or (2) of the Design Act with regard to an international application for design registration

Where applying the provision of Article 9(1) or (2) of the Design Act, the date of the international registration on which an application for design registration was deemed to have been filed under Article 60-6(1) of the Design Act will be the reference date for the determination (this excludes cases where a priority claim under the Paris Convention, etc. is legitimate).

Part VII Individual Applications for Design Registration

Chapter I Partial Design

71 Relevant provisions

Design Act

Article 2 (1) "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(2) The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner.

(Paragraphs (3) and (4) omitted)

Ordinance for Enforcement of the Design Act

Form No. 2 [Notes]

(39) (See Part I "Application/Drawings," Chapter I "Application for Design Registration," 11 "Relevant provisions")

Form No. 6 [Notes]

(8) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(9) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(10) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(11) If requesting a design registration for a part of an article, and the graphic image view (meaning the view representing the graphic image displayed on an article that is used with the article in an integrated manner as provided in Article 2, paragraph (2) of the Design Act; the same applies hereinafter) prescribed in (8) through (10) and (14) includes both the part for which the design registration is requested and any other parts, the part for which the design registration is requested is to be specified by drawing the part for which the design registration is requested with solid lines and any other parts with broken lines, etc. If the part for which the design registration is requested cannot be specified merely by indicating the drawing, the way of specifying the part for which the design registration is requested is to be stated in the column of

“[Description of the Design]” of the application.

Form No. 7 [Notes]

(4) For other matters, the practice equivalent to the Form No. 6 Notes (2), (3), (6), (8) through (12), (14) and (18) through (24) shall apply.

Form No. 8 [Notes]

(3) Where requesting a design registration for a part of an article, the part of the article to the design for which the design registration is requested shall be specified by painting over in black the parts other than the part for which the design registration is requested, etc., and the way of specifying the part for which the design registration is requested shall be stated in the column of “[Description of the Design]” of the application.

71.1 Partial design

A partial design is defined as the shape, patterns or colors, or any combination thereof, of a part of an article under the provision of Article 2(1) of the Design Act. Specifically, the following applies.

- (1) The article to the design of a partial design must be found to be an article subject to the Design Act. (See Part II, “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.1.1 “The subject matter is found to be an article”)
- (2) The partial design constitutes a part that occupies a certain scope of the form of the entire article.
- (3) The partial design constitutes a part of the article that can become subject to comparison when comparing with another design.

71.2 Application/drawings of an application for design registration for a partial design

71.2.1 Matters to be stated in the application of an application for design registration for a partial design

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

When filing an application for design registration for a partial 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 the column of “Article to the Design” of the application under Article 7 of the Design Act. (See Part V “One Application per Design”)

For example, in the case of a creation of a design of a still camera, even where the “part for which the design registration is requested” is the grip part of the still camera, “Still camera” must be stated in the column of “Article to the Design” of the application because the article to the design which is the object of the right is a “Still camera” including the grip part.

(2) Statement in the column of “Description of the Design”

The Form No. 6 Note (11) of the Ordinance for Enforcement of the Design Act provides that, where the drawings include both the “part for which the design registration is requested” and “any other parts,” the part of the article to the design for which the design registration is requested is to be specified by drawing the “the part for which the design registration is requested” with solid lines and “any other parts” with broken lines, etc., and the way of specifying the part for which the design registration is requested is to be stated in the column of “Description of the Design” of the application.

Therefore, the way in which the “part for which design registration is requested” has been specified in the set of drawings must be stated in the column of “Description of the Design” of the application. However, where the “part for which the design registration is requested” and “any other parts” can be specified from the contents of the drawings alone, it is not necessary to state the way in which the “part for which the design registration is requested” has been specified.

Note that specifying the part for which the design registration is requested only by a statement in the column of “Description of the Design” in the application is not acceptable.

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

The provision of the Form No. 2 Note (39) of the Ordinance for Enforcement of the Design Act also applies to an application for design registration for a partial design.

Therefore, where the article to the design of a partial design does not belong to any of the items of the classification of articles specified by Ordinance of the Ministry of Economy, Trade and Industry, and the purpose of use or the state of use of the article cannot be easily understood based on the general knowledge of a person skilled in the art, an explanation which can help in understanding the article, such as the purpose of use or the state of use of the article, must be stated in the column of “Description of Article to the Design” of the application.

71.2.2 Statement in drawings, etc. of an application for design registration for a partial design

Where filing an application for design registration for a partial design, drawings, etc. are to be prepared under the Form No. 6 Note (11) of the Ordinance for Enforcement of the Design Act. Where the form of the entire article to the design is not indicated in the drawings attached to the application, the application for design registration shall be treated as a partial design.

(1) Drawings

Where drawings include both the “part for which the design registration is requested” and “any other parts,” the part for which the design registration is requested is to be specified by drawing the “part for which the design registration is requested” with solid lines and “any other parts” with broken lines, etc.

(2) Omission of views

Views can be omitted in the following cases.

- (i) Omission of views that are identical or mirror images as prescribed in the Form No. 6 Note (8) of the Ordinance for Enforcement of the Design Act
- (ii) Omission of views that is permitted under the Form No. 6 Note (9) of the Ordinance for Enforcement of the Design Act
- (iii) Omission of the back side view where the surface view and the back side view are identical or mirror images or the back side view is without patterns under the Form No. 6 Note (10) of the Ordinance for Enforcement of the Design Act
- (iv) In the case of an application for a partial design requesting design registration only for a graphic image that is displayed on another article that is used with the article in an integrated manner as provided in Article 2(2) of the Design Act, omission of a set of drawings or a part of views representing the article to the design, other than the graphic image view
- (v) Where the position, size and scope of the part for which the design registration is requested can be specified, omission of a view indicating only a part other than the part for which the design registration is requested

(3) Specification of the “part for which the design registration is requested”

Where the drawings show “any other parts” in addition to the “part for which the design registration is requested,” the “part for which the design registration is requested” must be specified by drawing the “part for which the design registration is requested” with solid lines and “any other parts”

with broken lines, etc.

Therefore, specifying the “part for which the design registration is requested” only by description and without any depiction, or only by reference views, etc. showing the state of use is not acceptable.

However, because there are cases where the “part for which the design registration is requested” cannot be specified in terms of constructing drawings unless a sectional view is added, specifying such part by adding a sectional view to the set of drawings is allowed in that case.

In such case, the sectional drawing may be found to be a normal sectional drawing to be added where the drawings are not enough to represent the design, instead of a drawing for specifying the “part for which the design registration is requested,” and it may be determined as a result that the “part for which the design registration is requested” has not been specified; thus, the applicant for design registration is encouraged to state, for example, that “the ‘part for which the design registration is requested’ is specified by the drawings including the sectional drawing” in the column of “Description of the Design” of the application upon filing.

(4) Extent of disclosure of the partial design

With regard to an application for design registration for a partial design, the form of the “part for which the design registration is requested,” the position, size and scope of the “part for which the design registration is requested” which occupies in the entire article, and the boundary between the “part for which the design registration is requested” and “any other parts” must be clear, and 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 and the function and usage of the part for which the design registration is requested must at least be clearly represented (See 71.4.1.2 “The subject matter is a specific design,” (2) “Examples of cases where subject matter is not found to be a specific design,” (v) below).

71.3 Finding of a design in an application for design registration for a partial design

The finding of a design in an application for design registration for a partial design should be made by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application with regard to the following points.

Note that documents that are not categorized as an application or drawings, etc. attached to the application, such as a feature statement, a priority certificate, and a

certificate for receiving application of the provision of Article 4(2) of the Design Act, are not used as the basis for finding a design in an application for design registration for a partial design. (See Part I “Application/Drawings,” Chapter II “Finding of the Design in an Application for Design Registration”)

(1) Article to the design of the partial design

The usage and function of the article to the design of the partial design should be found based on the purpose of use, state of use, etc. of the article.

(2) Usage and function of the “part for which the design registration is requested”

The usage and function of the “part for which the design registration is requested” should be found based on the usage and function of the article to the design of the partial design that has been found as mentioned above.

(3) Position, size and scope of the “part for which the design registration is requested”

Position refers to the relative position of the “part for which the design registration is requested” in the form of the entire article to the design of the partial design.

With regard to the size, instead of finding one absolute size (dimension) mainly of the “part for which the design registration is requested,” a common-sense range of size in the art of the design should be found. (See Part I “Application/Drawings,” Chapter I “Application for Design Registration,” 11.1 “Provisions of Article 6 of the Design Act.”)

In addition, scope mainly refers to the relative size (area ratio) of the “part for which the design registration is requested” in the form of the entire article to the design of the partial design.

(4) Form of the “part for which the design registration is requested”

(i) Finding of the “part for which the design registration is requested”

The finding of the “part for which the design registration is requested” is carried out, in principle, based on the scope which the applicant for design registration has disclosed in the drawings, and where the drawings include both the “part for which the design registration is requested” and “any other parts,” it shall be found based on the way of specifying such part which the applicant for design registration has stated in the column of “Description of the Design” of the application.

Meanwhile, if it is stated, for example, that “the ‘part for which the design registration is requested’ is specified by the drawings including the sectional drawing” in the column of “Description of the Design” of the application, the “part for which the design registration is requested” is found based on the

drawings including the sectional drawing.

(ii) Finding of the form of the “part for which the design registration is requested”

The form of the “part for which the design registration is requested” is to be found based on drawings including a sectional view or perspective view and other necessary drawings, and other reference views such as a view showing the state of use, equivalent to the case of a whole design.

71.4 Requirements for design registration concerning a partial design

In order for the subject matter of an 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 application for design registration for a whole design.

(Note)

The subject matter of an application for design registration for a partial design 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 (→71.4.1)
- (2) The subject matter is novel (→71.4.2)
- (3) The subject matter involves creative difficulty (→71.4.3)
- (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 (→71.4.4)

71.4.1 Industrially applicable design

In order for the subject matter of an 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, 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 (→71.4.1.1)
- (2) The subject matter is a specific design (→71.4.1.2)
- (3) The subject matter is industrially applicable (→71.4.1.3)

71.4.1.1 The subject matter constitutes a design

In order for the subject matter of an application for design registration

for a partial design to constitute a design as defined in Article 2(1) of the Design Act, it must comply with all of the following requirements.

- (1) The subject matter is found to be an article (→71.4.1.1.1)
- (2) The subject matter is the form of an article itself (→71.4.1.1.2)
- (3) The subject matter appeals to the eye (→71.4.1.1.3)
- (4) The subject matter creates an aesthetic impression through the eye (→71.4.1.1.4)
- (5) The subject matter constitutes a part that occupies a certain scope (→71.4.1.1.5)
- (6) The subject matter constitutes a part that becomes subject to comparison when comparing with another design (→71.4.1.1.6)

71.4.1.1.1 The subject matter is found to be an article

The article to the design of a partial design must be found to be an article subject to the Design Act.

- (1) Examples of subject matter that is found to be an article
 - (i) Subject matter where the article to the design of a partial design is a “Sock,” which is found to be an article subject to the Design Act, and the “part for which the design registration is requested” is the “heel of a sock,” which is not found to be an article subject to the Design Act
 - (ii) Subject matter where the article to the design of a partial design is a “Packaging container,” which is found to be an article subject to the Design Act, and the “part for which the design registration is requested” is the part of the “cap for a packaging container,” which is found to be an article subject to the Design Act
- (2) Example of subject matter that is not found to be an article
 - (i) Subject matter where only a pattern is represented in the drawing as the “part for which the design registration is requested,” and the article to the design of a partial design is a “pattern to be represented on textile products”

71.4.1.1.2 The subject matter is the form of an article itself

The form of the entire article to the design of a partial design must be the form of an article itself.

- (1) Example of subject matter that is not found to be the form of an article itself
 - (i) Subject matter where a part of the form of a flower made by tying knots in a handkerchief for achieving an effect of sales display is the “part for which the design registration is requested”

71.4.1.1.3 The subject matter appeals to the eye

The entire form of the “part for which the design registration is requested” must appeal to the eye.

- (1) Examples of subject matter that is not found to appeal to the eye
 - (i) Subject matter where the entire form of the “part for which the design registration is requested” cannot be visually recognized from outside in the normal trading state of the article to the design of the partial design
 - (ii) Subject matter where the entire form of the “part for which the design registration is requested” is too fine to recognize by the naked eye

71.4.1.1.4 The subject matter creates an aesthetic impression through the eye

The “part for which the design registration is requested” must create an aesthetic impression through the eye.

71.4.1.1.5 The subject matter constitutes a part that occupies a certain scope

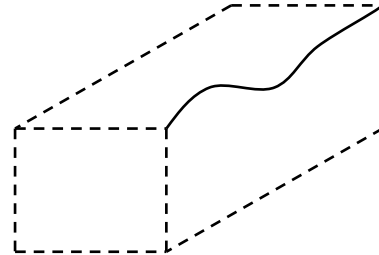
The “part for which the design registration is requested” must be a part that occupies a certain scope of the form of the entire article to the design of the partial design, that is, a closed area that is included in the appearance of the design.

Furthermore, the boundary between the part for which the design registration is requested and any other parts must be clear.

- (1) Examples of subject matter that is not found to constitute a part that occupies a certain scope
 - (i) Subject matter where the “part for which the design registration is requested” is only a ridge line

Since a ridge line does not have an area, it does not constitute a part that occupies a certain scope.

[Case example] “Building concrete block”



- (ii) Subject matter that represents only the silhouette of the form of the entire article to the design of a partial design

Since it is not found to be a closed area that is included in the appearance of the design, it does not constitute a part that occupies a certain scope.

[Case example]

Subject matter representing only a projected silhouette of the side view of a passenger car

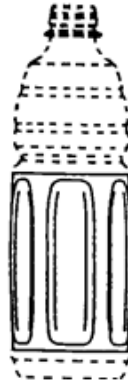
71.4.1.1.6 The subject matter constitutes a part that can become subject to comparison when comparing with another design

The “part for which the design registration is requested” not only needs to constitute a part that occupies a certain scope of the form of the entire article, but it also needs to represent a unit of creation of a design that can become subject to comparison when comparing with another design.

- (1) Examples of subject matter that is found to constitute a part that can become subject to comparison when comparing with another design

In both of the following case examples, the “part for which the design registration is requested” constitutes a part that occupies a certain scope of the form of the entire article of a packaging container, and they both represent the unit of creation of a design that can become subject to comparison when comparing with another design.

[Case example 1]
“Packaging container”



[Case example 2]
“Packaging container”



- (2) Example of subject matter where the “part for which the design registration is requested” does not include any unit of creation of a design

In the following case example, the “part for which the design registration is requested” constitutes a part that occupies a certain scope of the form of the entire article of a packaging container, but it does not represent the unit of creation of a design that can become subject to comparison when comparing with another design.

[Case example] “Packaging container”



71.4.1.2 The subject matter is a specific design

First, it must be possible to directly derive from the statement in the application and drawings, etc. attached to the application as originally filed, that it is an application for design registration for a partial design, based on the ordinary skill in the art of the design.

Next, in order for the design in an application for design registration for a partial design to be found to be a specific design, equivalent to the case of a whole design, the design must be one for which contents of a specific single design, that is, specific contents concerning (i) through (v) below, can be directly derived from the statement in the application and drawings, etc. attached to the application as originally filed, 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 design registration is requested”
- (iii) The position, size and scope of the “part for which design registration is requested”

However, where the position, size and scope of the part for which the design registration is requested can be derived in light of the nature of the article, the subject matter is found to be a specific design even if the entirety of “any other parts” is not indicated.

- (iv) The form of the “part for which design registration is requested”
- (v) The boundary of the “part for which the design registration is requested” and “any other parts”

In addition, the drawings including the “part for which the design registration is requested” 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, etc. attached to the application, the practice for a whole design applies, so see 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 subject matter is found to be a specific design

Where the contents of a specific single design can be directly derived upon making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, the subject matter is found to be a specific design.

- (i) Where it is clear that the application for design registration relates to a partial design from the statement in the column of “Description of the Design” in the application and details

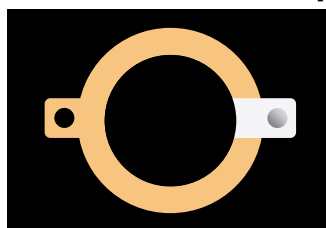
provided in the drawings, etc. attached to the application

[Case example] "Flange"

[Top view]



[Front view]



[Right side view]

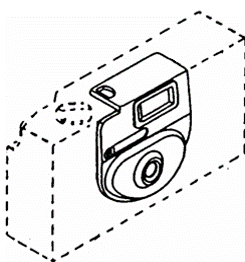


[Description of the Design]

The part other than the parts colored in orange is the part for which the design registration is requested.

- (ii) Where there is no statement made on how to specify the part for which the design registration is requested in the column of "Description of the Design" in the application as originally filed, but the fact that the application is an application for design registration for a partial design and the "part for which the design registration is requested" are clear from the details provided in the drawings, etc. attached to the application

[Case example] "Digital camera"



The respective views in the drawings attached to the application are described in a manner that clearly distinguishes a certain part by using solid lines and broken lines, and it can be inevitably derived that the application is an application for design registration for a partial design requesting design registration for the part described in solid lines, even if there is no column of "Partial Design" and there is no statement made on how to specify the part for which the design registration is requested in the column of "Description of the Design."

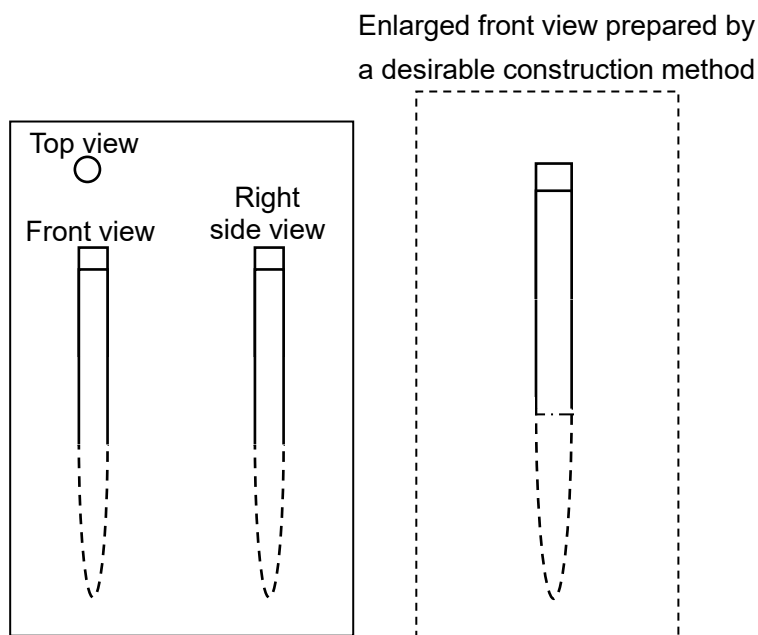
- (iii) Where a lack of indication of a boundary line is found to be an error in constructing drawings, and by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, the boundary of the "part for which the design registration is requested" can inevitably be derived

The "part for which the design registration is requested" must be a part that occupies a certain scope of the form of the entire

article to the design of the partial design, that is, a closed area that is included in the appearance of the design. (See 71.4.1.1.5 “The subject matter constitutes a part that occupies a certain scope” above)

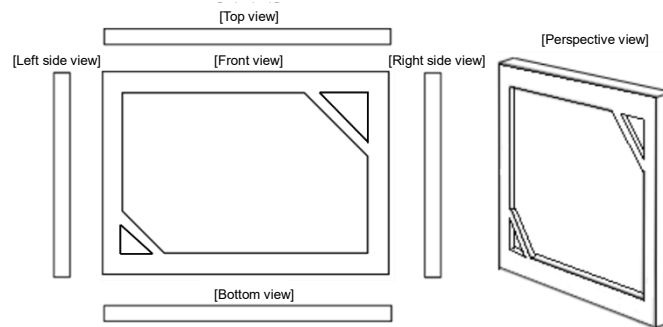
However, for example, where the subject matter is a wire rod or a rod, such as the “fence post” below, and by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, no problem is found in deeming that the position where the two ends of a solid line representing the outline of the “part for which the design registration is requested” are linked together by a straight line is the boundary, the “part for which the design registration is requested” is treated as occupying a certain scope.

[Case example] “Fence post”



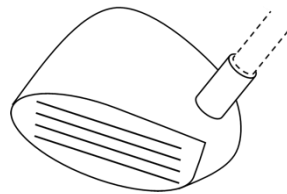
- (iv) Where only a part of the article for which the design registration is requested is represented in the drawings, etc. attached to the application and there is no statement that views are omitted due to them being identical or mirror images of other views, the usage and function of the “part for which the design registration is requested,” the form of the part for which the design registration is requested, the position, size and scope of the part for which the design registration is requested which occupies the entire article, and the boundary between the “part for which the design registration is requested” and “any other parts” are clear

[Case example] "Frame"



- (v) Where the position, size and scope of the part for which the design registration is requested can be derived in light of the nature of the article, even if only a part of the entirety of "any other parts" is indicated

[Case example] "Golf club"



* For the sake of convenience, other drawings were omitted.

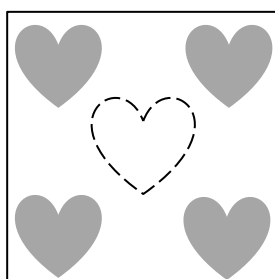
(2) Examples of cases where subject matter is not found to be a specific design

Where the contents of a specific single design cannot be directly derived upon making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, the subject matter is not found to be a specific design.

- (i) Where it is unclear whether the application for design registration is one for a partial design or one for a whole design, or it is unclear which of the parts described in a distinguishing manner in the drawings is the "part for which the design registration is requested," even by making comprehensive determination based on the statement in the application and drawings, etc.

attached to the application, because there is no statement made on the way of specifying the “part for which the design registration is requested” in the column of “Description of the Design” in the application as originally filed

[Case example 1] "Handkerchief"



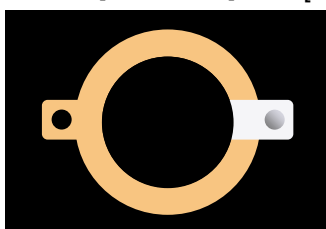
Because there is no statement made on the way of specifying the "part for which the design registration is requested" in the column of "Description of the Design," it is unclear whether the application for design registration is one for a partial design that has been described in a distinguished manner by using solid lines and broken lines, etc. or one for a whole design with a mark stitched at the center.

[Case example 2] "Flange"

[Top view]



[Front view]



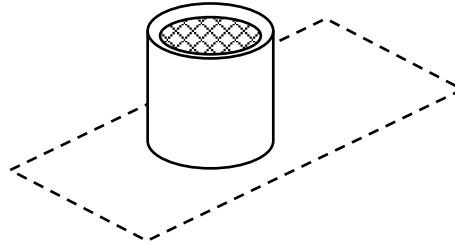
[Right side view]



If there is no statement on the way of specifying the "part for which the design registration is requested" in the column of "Description of the Design," it is unclear whether the "part for which the design registration is requested" is the part colored in orange or the part colored in white.

- (ii) 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
- (iii) Where the entire form of the “part for which the design registration is requested” is not represented
- (iv) Where the position, size and scope of the “part for which the design registration is requested” cannot be specified
- i. Where “any other parts” is not disclosed, and the position, size and scope of the part for which the design registration is requested cannot be derived even in light of the nature of the article

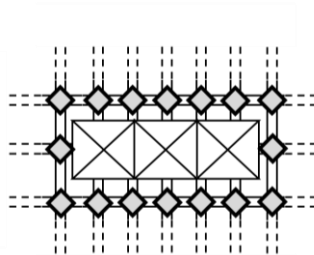
[Case example 1] “Humidifier”



* In this example, only the area adjacent to the steam outlet is indicated, but the position, size or scope of said part cannot be specified

* For the sake of convenience, other drawings were omitted.

[Case example 2] “Garden fence”



* In this example, the position, size or scope of said part cannot be specified

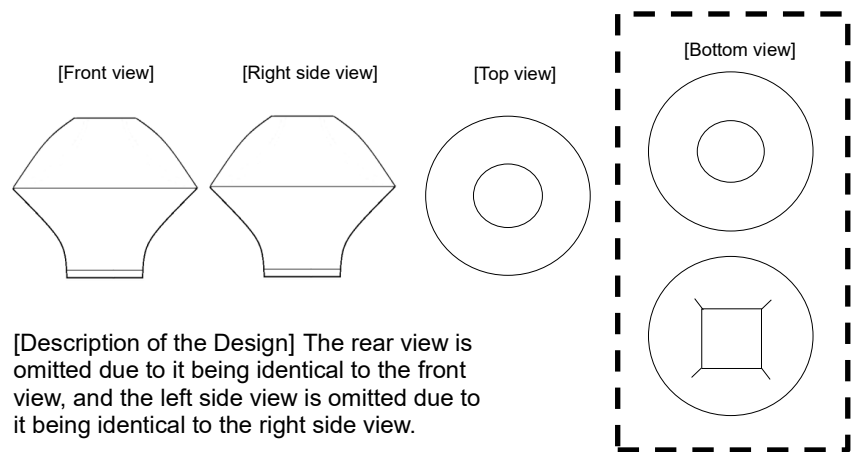
* For the sake of convenience, other drawings were omitted.

- ii. Where the form of “any other parts” represented by a broken line, etc. is not specific due to inconsistency between the views, and as a result, the position, size and scope of the “part for which the design registration is requested” in the form of the entire article are not made specific
- (v) 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 the “part for which the design registration is requested” is not a closed area
 - iii. Where the “part for which the design registration is requested” is specified only by reference views
 - iv. Where the “part for which the design registration is requested” is specified only by text in the column of “Description of the Design” in the application, and the “part for which the design registration is requested” and “any other parts” are not described in a distinguishing manner as required in the

drawings

- v. Where multiple forms could be assumed for the part for which the design registration is requested, so that a single form cannot be derived

[Case example 1] “Flower vase”



* In this example, a specific design cannot be derived because various forms could be assumed as shown in the dot frame on the right.

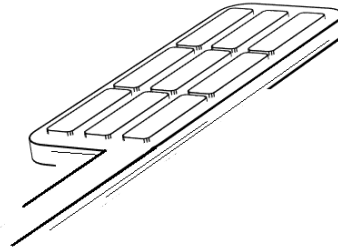
[Case example 2] “Coffee cup”



* In this example, a specific design cannot be derived because, even by examining only the disclosed parts, the form of the handle and the form near the bottom of the cup body are unclear just from this single view as shown above.

- (vi) Where the boundary between the “part for which the design registration is requested” and “any other parts” is unclear

[Case example] “Brake pedal”



71.4.1.3 The subject matter is industrially applicable

The article to the design of a partial design must be industrially applicable.

Meanwhile, the industrial applicability of the “part for which the design registration is requested” is not to be determined.

71.4.2 Novelty

Application of the provisions of the items of Article 3(1) of the Design Act is to be determined by making determination as to whether or not the partial design is categorized as any publicly known design or categorized as any design similar to a publicly known design.

71.4.2.1 Article 3(1)(i) and (ii) of the Design Act

In order to be able to determine whether or not a partial design is categorized as a publicly known design, the entire form of the “part for which the design registration is requested” of the application for design registration for the partial design must be disclosed in the publicly known design, in principle.

With regard to any other determination standards, the determination standards for a whole design apply, so see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.1 “Article 3(1)(i) of the Design Act” and 22.1.2 “Article 3(1)(ii) of the Design Act.”

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

71.4.2.2.1 Determination of similarity between a publicly known design and a partial design

Since the article and the form are inseparably integrated in a design, unless the article to the design of a partial design and

the article to the design of a publicly known design are identical or similar, the designs are not similar.

For example, in the case of a creation of a design of a still camera, if an application for design registration for a partial design is filed for the grip part of the camera, the article to the design which is the object of the right is a “Still camera” including the grip part, so information that serves as the basis for determination of novelty will be designs for “still cameras” and articles similar thereto.

Under such requirement, if a partial design and a publicly known design comply with all of the following, the two designs are similar.

- (i) The article to the design of a partial design and the article to the design of a publicly known design are identical or similar
- (ii) The usage and function of the “part for which the design registration is requested” of an application for design registration for a partial design and those of the part of a publicly known design that coincides with the “part for which the design registration is requested” are identical or similar
- (iii) The form of the “part for which the design registration is requested” of an application for design registration for a partial design and that of the part of a publicly known design that coincides with the “part for which the design registration is requested” are identical or similar
- (iv) The position, size and scope of the “part for which the design registration is requested” of an application for design registration for a partial design in the form of the entire article and those of the part of a publicly known design that coincides with the “part for which the design registration is requested” in the form of the entire article are identical or commonplace in the art of the design

If the designs are identical with regard to all of (i) through (iv) above, the two designs are identical.

- (1) Finding of common points and different points in the articles to the designs

The common points and different points in the usage and function of the article to the design of a partial design and those of the article to the design of a publicly known design are found.

(2) Finding of common points and different points in the usage and function of the relevant parts

The common points and different points in the usage and function of the “part for which the design registration is requested” and those of the part of a publicly known design that coincides with the “part for which the design registration is requested” are found.

(3) Finding of common points and different points in the forms of the relevant parts

The common points and different points in the entire form and the form of each part of the “part for which the design registration is requested” and those of the part of a publicly known design that coincides with the “part for which the design registration is requested” are found.

However, the common points and different points in the form of “any other parts” are not to be found directly.

(4) Finding of the common points and different points in the position, size and scope of the relevant parts

The common points and different points in the position, size and scope of the “part for which the design registration is requested” in the form of the entire article and those of the part of a publicly known design that coincides with the “part for which the design registration is requested” in the form of the entire article are found.

(5) Determination of similarity between a publicly known design and a partial design

Determination of similarity between a publicly known design and a partial design refers to determination as to whether designs are similar or not in terms of aesthetic impression. Specifically, the determination is made by comprehensively observing the common points and different points with regard to (1) through (4) above for the entire design, and evaluating the influence that these points have on the determination of similarity between the two designs. Meanwhile, the influence that the common points and different points have on the determination of similarity between the designs varies by individual designs, but the

following generally apply:

- (i) An easily visible part has a relatively large influence.
- (ii) A part of an ordinary form has a relatively small influence.
- (iii) A difference in size hardly has any influence if it is within a common-sense range in the art of the design.
- (iv) A difference in material hardly has any influence if it does not appear as a characteristic of the outer appearance.
- (v) A difference only in color hardly has any influence as compared to a difference in shape or pattern.
- (vi) A difference in position, size or scope hardly has any influence if it is commonplace in the art of the design.

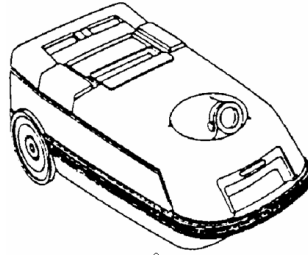
The form of “any other parts” alone is not made subject to comparison.

71.4.2.2.2 Examples of applications for design registration for a partial design that fall under the provision of Article 3(1)(iii) of the Design Act

[Case example 1]

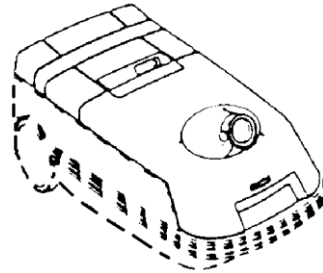
Publicly known design

“Main body of a vacuum cleaner”



Application for design registration for a partial design

“Main body of a vacuum cleaner”

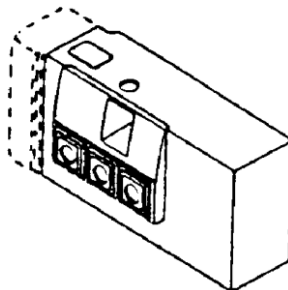


[Case example 2]

Publicly known design

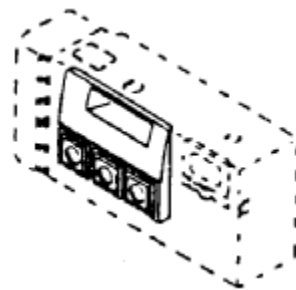
“Still camera”

(Partial design published in a Design Bulletin)



Application for design registration for a partial design

“Still camera”

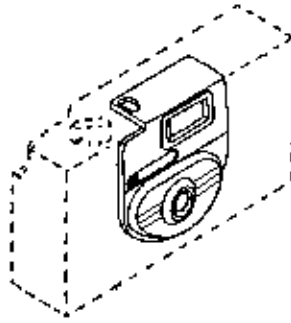


[Case example 3]

Publicly known design

“Still camera”

(Partial design published in a
Design Bulletin)



Application for design

registration for a partial design

“Camera lens with a view finder”



(Note)

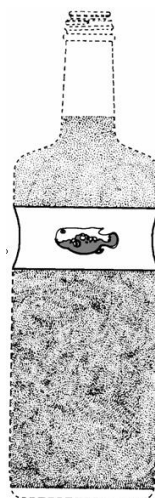
Note that the classification of articles “Camera lens with a view finder” is mentioned here for explaining the case example, and it does not indicate a case example of a specific classification of articles that is found to be equivalent in level to the classification of articles listed in Appended Table 1.

[Case example 4]

Publicly known design

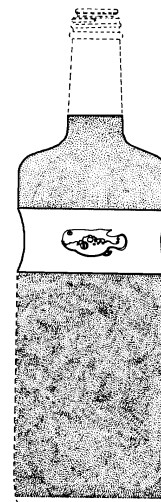
“Packaging bottle”

(Partial design published in a
Design Bulletin)



Application for design
registration for a partial design

“Packaging bottle”

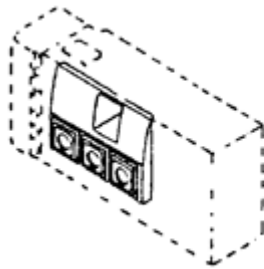


[Case example 5]

Publicly known design

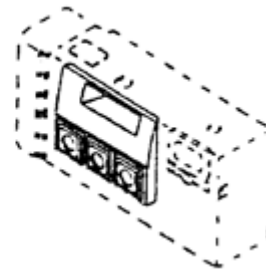
“Still camera”

(Partial design published in a
Design Bulletin)



Application for design
registration for a partial design

“Still camera”

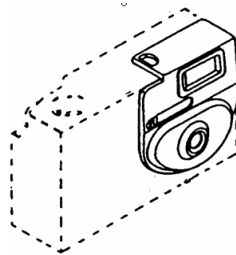


[Case example 6]

Publicly known design

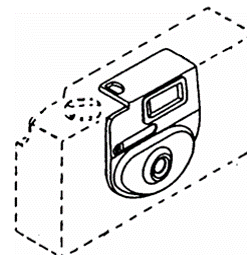
“Digital camera”

(Partial design published in a
Design Bulletin)



Application for design
registration for a partial design

“Digital camera”



71.4.3 Creative difficulty

Application of the provision of Article 3(2) of the Design Act is to be determined by making determination as to whether or not the entire form of the “part for which the design registration is requested” could have been easily created by a person skilled in the art based on shapes, patterns or colors, or any combination thereof that were publicly known prior to the filing of the application for design registration, and whether or not it is an ordinary technique for a person skilled in the art to make the “part for which the design registration is requested” such position, such size or such scope in the form of the entire article, considering the usage and function of such part.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part II “Requirements

for Design Registration,” Chapter III “Creative Difficulty.”

71.4.4 Design in a later application that is identical or similar to part of a design in a prior application

The provision of Article 3-2 of the Design Act also applies to the case where a partial design in a later application is not found to be a creation of a new design, such as where an application for design registration is filed while adopting a part of the design in a prior application almost as it is as the “part for which the design registration is requested” of a partial design in a later application.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so 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.”

71.4.4.1 Determination of similarity between part of a design disclosed in a prior application and a partial design in a later application

In order to apply the provision of Article 3-2 of the Design Act, it is necessary that the entire form of the “part for which the design registration is requested” of the partial design in the later application, which is subject to the provision of Article 3-2 of the Design Act, is disclosed in the design disclosed in the prior application, in principle (including the case where the entire form of the “part for which the design registration is requested” of the partial design in the later application, which is subject to the provision of Article 3-2 of the Design Act, is not disclosed, but is sufficiently represented to a comparable level, in the design disclosed in the prior application; see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.2.6 “Design described in a publication”).

Regardless of (i) whether the design disclosed in a prior application is a whole design or a partial design, and (ii) whether the article to the design of the design disclosed in a prior application and that of the whole design in a later application are identical, similar or not similar, where the part of the design disclosed in a prior application that coincides with the “part for which the design registration is requested” of a partial design in a later application and the “part for which the design registration is requested” of the partial design in the later application have an identical or similar usage and function and their respective forms are identical or similar, the part of the design disclosed

in the prior application that coincides with the “part for which the design registration is requested” of the partial design in the later application and the partial design in the later application are similar.

71.4.4.2 Examples of applications for design registration for a partial design that fall under the provision of Article 3-2 of the Design Act

With regard to case examples of applications for design registration for a partial design that fall under the provision of Article 3-2 of the Design Act, see case examples 1 through 6 in 71.4.2.2.2 “Examples of applications for design registration for a partial design that fall under the provision of Article 3(1)(iii) of the Design Act” above by replacing the term publicly known design with design disclosed in a prior application.

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

An application for design registration for a partial design is also subject to application of the provision of Article 4(1) or (2) of the Design Act.

Meanwhile, with regard to the requirements, etc. for receiving application of the provision of Article 4(1) or (2) of the Design Act and any other determination standards, the determination standards for a whole design apply, so see Part III “Exception to Lack of Novelty.”

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

With regard to application of the provisions of Article 5(i) and (ii) of the Design Act, the form of the entire article to the design of a partial design, including the “part for which the design registration is requested” and “any other parts,” is to be subject to determination. However, with regard to application of the provision of Article 5(iii) of the Design Act, only the shape of the “part for which the design registration is requested” is to be subject to determination.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part IV “Unregistrable Designs.”

71.7 One application per design concerning an application for design registration for a partial design

An application for design registration for a partial design must also comply with the requirements provided in Article 7 of the Design Act.

Meanwhile, with regard to any other determination standards, the determination

standards for a whole design apply, so see Part V “One Application per Design.”

71.7.1 Examples of cases that do not comply with the requirements provided in Article 7 of the Design Act

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

Where, in an application for design registration for a partial design, there is a statement that has added such words as “... part of” or “partial design of” after a classification of articles in the column of “Article to the Design” of the application (for example, the “heel part of a sock” or a “partial design of the heel of a sock”), such statement is not found to be a classification of articles listed in Appended Table 1 or a classification of articles equivalent in level to such classification.

71.7.1.2 Examples of cases where an application is not filed for each design

Where two or more physically separate “parts for which the design registration is requested” are included in the article to the design of one partial design, the application for design registration is not found to be filed for each design.

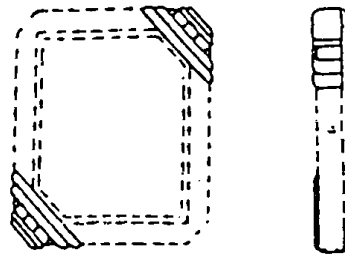
71.7.1.2.1 Categories of subject matter that is treated as one design even if it includes two or more physically separate “parts for which the design registration is requested”

Where subject matter falls under any of the following, it is treated as one design even if it includes two or more physically separate “parts for which the design registration is requested.”

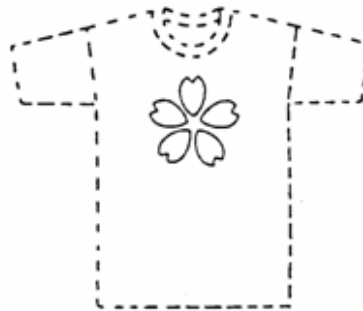
(1) Where unity in form is found

Unity in form is found for two or more physically separate “parts for which the design registration is requested” if they have been created with relevance to each other, such as forms in mirror images or forms that constitute a set.

[Case example 1] "Casing for a wrist watch"



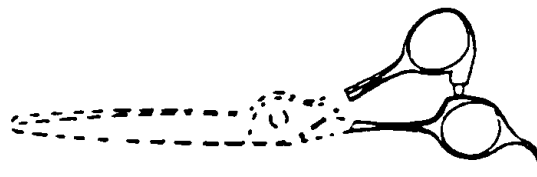
[Case example 2] "T-shirt"



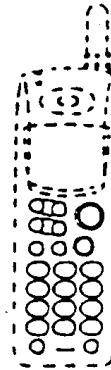
(2) Where unity in function is found

Even where two or more "parts for which the design registration is requested" are physically separate, if they have been created in an integrated manner because they perform one function as a whole, unity in function is found.

[Case example 1] "Barber scissors"



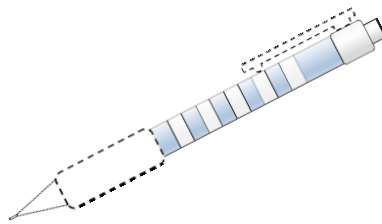
[Case example 2] “Mobile phone”



(3) Where a part that performs a certain usage and function, or a part that is coordinated in form is “any other parts”

An example of subject matter for which a design can be registered as one design

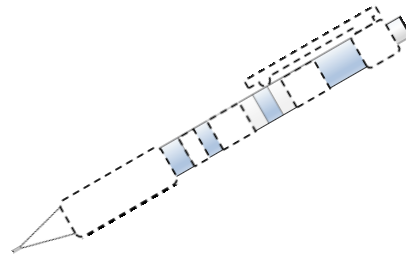
[Case example] “Mechanical pencil”



However, where the part for which a design registration is requested is physically separated into many parts, and is not cohesive as a single design that can become subject to comparison when comparing with another design, it shall not be treated as one design.

An example of subject matter for which a design can be registered as one design

[Case example] "Mechanical pencil"

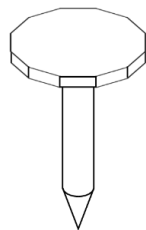


(4) Where the part for which the design registration is requested is divided by an undisclosed part and represented in a physically separated state in the drawing

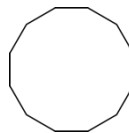
An example of subject matter for which a design can be registered as one design

[Case example] "Nail"

[Perspective view]



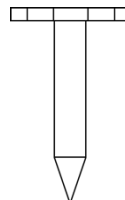
[Top view]



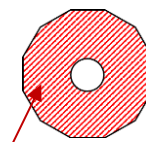
Description of Article to the Design: n/a

Description of the Design: Rear view, right side view and left side view are omitted due to them being identical to the front view.

[Front view]



[Bottom view]



This area is not disclosed in the drawing

A bottom view is not provided, and the red shaded area is not disclosed, therefore it is a "part other than the part for which the design registration is requested." Consequently, the head and the body of the nail are represented in the drawing as two or more physically separate "parts for which the design registration is requested," but in such case they are determined to constitute one design.

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

A partial design pertaining to a design for a set of articles cannot be registered.
(See Part VII “Individual Applications for Design Registration,” Chapter II “Design for a Set of Articles,” 72.1.2 “Partial design pertaining to a design for a set of articles”)

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

Application of the provisions of Articles 9 and 10 of the Design Act is determined with regard to two or more applications for design registration for partial designs and applications for design registration for a partial design and a whole design.

Meanwhile, with regard to any other determination standards, see Part VI “Prior Application” and Part VII “Individual Applications for Design Registration,” Chapter III “Related Design.”

71.9.1 Determination of similarity between a partial design and a partial design

If two partial designs comply with all of the following, the two designs are similar.

- (i) The usage and function of the articles to the design of the partial designs are identical or similar
- (ii) The usage and function of the “parts for which the design registration is requested” are identical or similar
- (iii) The forms of the “parts for which the design registration is requested” are identical or similar
- (iv) The position, size and scope of the “parts for which the design registration is requested” in the forms of the entire articles are identical or commonplace in the art of the design

If the designs are identical with regard to all of (i) through (iv) above, the two designs are identical.

- (1) Finding of common points and different points in the articles to the designs
The common points and different points in the usage and function of the articles to the design of the partial designs are found.

- (2) Finding of common points and different points in the usage and function of the relevant parts
The common points and different points in the usage and function of the “parts for which the design registration is requested” are found.

- (3) Finding of common points and different points in the forms of the relevant

parts

The common points and different points in the entire form and the form of each part of the “parts for which the design registration is requested” are found.

- (4) Finding of the common points and different points in the position, size and scope of the relevant parts

The common points and different points in the position, size and scope of the “parts for which the design registration is requested” in the forms of the entire articles are found.

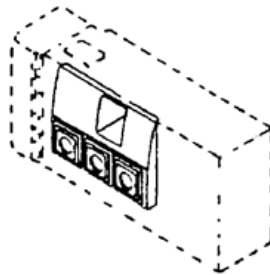
- (5) Determination of similarity between a partial design and a partial design

Determination of similarity between a partial design and a partial design is made according to 71.4.2.2.1 “Determination of similarity between a publicly known design and a partial design,” (5) “Determination of similarity between a publicly known design and a partial design” above.

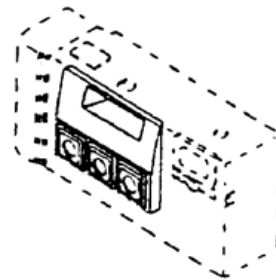
71.9.1.1 Examples of applications for design registration for partial designs that are found to be similar under Article 9(1) of the Design Act

[Case example 1]

Application for design
registration for a partial design
in a prior application
“Still camera”

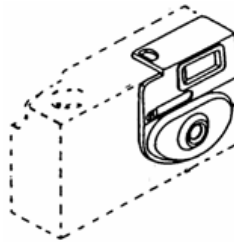


Application for design
registration for a partial design
“Still camera”

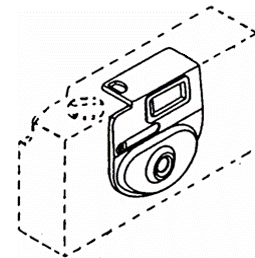


[Case example 2]

Application for design
registration for a partial design
in a prior application
“Digital camera”



Application for design
registration for a partial design
“Digital camera”



Where the application for design registration for a partial design shown on the right-hand side in the case example above is filed during the period from the filing date of the application for design registration for a partial design in the prior application shown on the left-hand side to the publication date (including said date) of the Design Bulletin for said prior application for design registration (a 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 application have been filed for identical or similar

designs on the same date), the application also falls under the provision of Article 3-2 of the Design Act, so the provision of Article 3-2 of the Design Act is applied in examination practice.

71.9.1.2 Examples of applications for design registration for partial designs that are found to be similar under Article 9(2) or Article 10 of the Design Act

With regard to the case examples, see case examples 1 and 2 in 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” above by replacing the term “the prior application for design registration for a partial design shown on the left-hand side” with “the application for design registration for a partial design filed on the same date.”

71.9.2 Determination of similarity between a whole design and a partial design

Since the article and the form are inseparably integrated in a design, similarity can never arise between a whole design and a partial design unless the article to the design of a whole design and the article to the design of a partial design are identical or similar.

For example, in an application for design registration for a partial design of a camera, the article to the design which is the object of the right is a “still camera,” so information that serves as the basis for determination of a prior application will be the prior applications for “still cameras” and articles similar thereto.

If a whole design and a partial design fall under all of the following, the two designs are similar:

- (i) The article to the design of a whole design and the article to the design of a partial design are identical or similar;
- (ii) The usage and function of a whole design and the usage and function of the “part for which design registration is requested” as a partial design are identical or similar;
- (iii) The form of the design in an application for design registration for a whole design and the form of the “part for which the design registration is requested” of a partial design are identical or similar; and
- (iv) The differences of the position, size and scope of the “part for which the design registration is requested” of an application for design registration for a partial design within the form of the entire article are commonplace in the art of the design when compared to the entire article of the whole design.

If the designs are identical with regard to all of (i) through (iv) above, the two designs are substantially identical.

(1) Finding of common points and different points in the articles to the designs
The common points and different points in the usage and function of the article to the design of a whole design and those of the article to the design of a partial design are found.

(2) Finding of common points and different points in the usage and function of the relevant parts

The common points and different points in the usage and function of the article to the design in an application for design registration for a whole design and those of the “part for which the design registration is requested” in an application for design registration for a partial design are found.

(3) Finding of common points and different points in the forms of the relevant parts

The common points and different points in the forms of the whole design and the “part for which the design registration is requested” of the partial design are found.

(4) Finding of common points and different points in the position, size and scope of the relevant parts

The common points and different points between the position, size and scope of the whole design and those of the “part for which the design registration is requested” of the partial design in the form of the entire article are found.

(5) Determination of similarity between a whole design and a partial design

Determination of similarity between a whole design and a partial design refers to determination as to whether designs are similar or not in terms of aesthetic impression. Specifically, the determination is made by comprehensively observing the common points and different points with regard to (1) through (4) above for the entire design, and evaluating the influence that these points have on the determination of similarity between the two designs. Meanwhile, the influence that the common points and different points have on the determination of similarity between the designs varies by individual design, but the following generally applies:

(i) An easily visible part has a relatively large influence.

(ii) A part of an ordinary form has a relatively small influence.

(iii) A difference in size hardly has any influence if it is within a common-sense range in the art of the design.

(iv) A difference in material hardly has any influence if it does not appear

as a characteristic of the outer appearance.

(v) A difference only in color hardly has any influence as compared to a difference in shape or pattern.

(vi) A difference in position, size or scope hardly has any influence if it is commonplace in the art of the design.

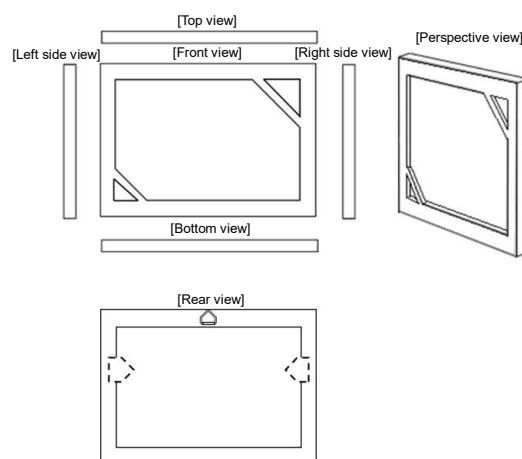
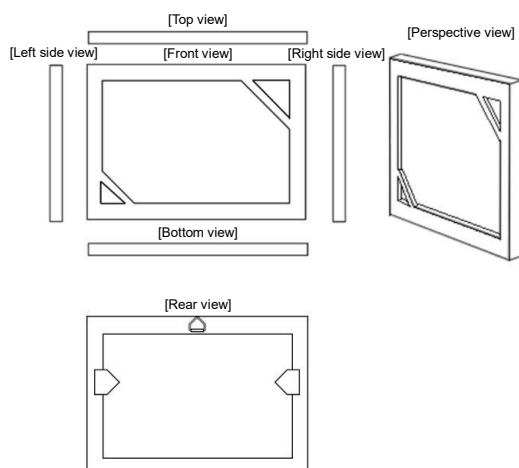
The form of “any other parts” alone is not made subject to comparison.

71.9.2.1 Examples of applications for design registration for a whole design and a partial design that are found to be similar under Article 9(1) of the Design Act

[Case example] “Frame”

Application for design registration for a whole design in a prior application

Application for design registration for a partial design



Where the application for design registration for a partial design shown on the right-hand side in the case example above is filed during the period from the filing date of the application for design registration for a partial design in the prior application shown on the left-hand side to the publication date (including said date) of the Design Bulletin for said prior application for design registration (a 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 consultation or consultations were unable to be held where two or more applications have been filed for identical or similar

designs on the same date), the application also falls under the provision of Article 3-2 of the Design Act, so the provision of Article 3-2 of the Design Act is applied in examination practice.

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

71.10.1 Gist of design of a partial design

The “gist of design of a partial design” refers to the contents of a specific design that can be directly derived from the respective elements ((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,” and (iv) the form of the “part for which the design registration is requested”) for finding the partial design represented in the statement in the application and drawing, etc. attached to the application based on the ordinary skill in the art of the design.

71.10.2 Categories of amendments that change the gist

Where an amendment made to the statement in the application or any drawings, etc. attached to the application falls under any of the following, it changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part VIII “Amendment of Statement in the Application/Drawings, etc.,” Chapter II “Dismissal of Amendments.”

- (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
- (2) Where the amendment is found to clarify the gist of design that was unclear when originally filed

71.10.3 Specific handling of an amendment made to the statement of an application

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

Even 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” in the application as originally filed, and the “part for which the design registration is requested” is unclear and no specific design can be inevitably derived even by comprehensive determination based on the statement in the application and drawings, etc. attached to the application, 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 changes the gist.

Even 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” in the application as originally filed, but it is clear that the application for design registration is an 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, etc. attached to the application, 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 application for design registration for a partial design

Where form, position, size and scope of the part for which the design registration is requested and boundaries with any other parts cannot be inevitably derived only from the drawings even by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, an amendment to delete the 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, making it unclear whether the application for design registration is one for a partial design or a whole design, or making it unclear which part is the “part for which the design registration is requested” in the application for design registration, changes the gist.

71.10.4 Specific handling of an amendment made to the drawing, etc. attached to the application

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

An amendment, made when dividing an 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, etc. attached to the 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 parts” 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 parts” without dividing the 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 changes the position, size or scope of the “part for which the design registration is requested” in the form of the entire article 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 is unclear even by making comprehensive determination based on the statement in the application and drawings, etc. 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 parts”

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 parts” 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 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 parts” changes the gist.

Where it can be inevitably derived that the application for design registration is an application for design registration for a partial design by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, an amendment to correct “any other parts” to be depicted solely by solid lines changes the gist.

71.11 Division concerning an application for design registration for a partial design

71.11.1 Division of a partial design for which an application has not been filed for each design

Where two or more physically separate “parts for which the design registration is requested” for which formal or functional identity is not found are included in the article to the design of one partial design, the application for design registration is not found to be filed for each design, and is treated as not complying with the requirements provided in Article 7 of the Design Act. (See 71.7.1.2 “Examples of cases where an application is not filed for each design” above)

In this case, division based on the provisions of Article 10-2 of the Design Act is allowed as an application for design registration for a partial design including two or more partial designs, and the new application for design registration for a partial design is deemed to have been filed at the time of filing the original application for design registration for a partial design.

However, where a new application for design registration is filed as an application for design registration for a whole design (for example, where a new application for design registration is filed by making one of the “parts for which the design registration is requested” in the original application for design registration for a partial design the design of a component), it is not found to be legitimate division based on the provisions of Article 10-2 of the Design Act and the new application for design registration is treated as having been filed at the time of the division.

71.11.2 Division of a part of an application for design registration filed for each design into one or more applications for design registration for partial designs

Where an application for design registration for a design for a whole design that is found to be one design or for a partial design that is treated as one design is divided into one or more new applications for design registration for partial designs, it is not found to be legitimate division based on the provisions of Article 10-2 of the Design Act, and the new application for design registration is treated as having been filed at the time of the division.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part IX “Special Application for Design Registration,” Chapter I “Division of Application for Design Registration.”

71.12 Conversion of a patent application or an application for utility model registration into an application for design registration for a partial design

Where the initial description and drawings of the patent application or application for utility model registration contain a concrete description based on which the partial design in the new converted application for design registration can be clearly recognized, and the contents before and after the conversion of the application are found to be identical, the new converted application for design registration for a partial design is deemed to have been filed at the time of filing the original patent application or application for utility model registration.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part IX “Special Application for Design Registration,” Chapter II “Conversion of Application.”

71.13 Application for design registration for a partial design containing a priority claim under the Paris Convention, etc.

A priority claim under the Paris Convention, etc. is effective where the partial design pertaining to the application for design registration filed in Japan and the partial design pertaining to the corresponding first application on which the priority claim under the Paris Convention, etc. is based are identical.

Therefore, in a case that falls under any of the following, a priority claim under the Paris Convention, etc. is not effective.

- (1) Where the first application is an application disclosed as a design for which the design registration is requested for the form of the entire article and the application for design registration filed in Japan is an application for design registration for a part of the article that is disclosed as a whole design in the first

application

- (2) Where the first application is an application for a partial design and the “part for which the design registration is requested” as a partial design in the application for design registration filed in Japan includes additional contents that are not included in the first application or does not include a part of the contents that are included in the first application
- (3) Where the first application is multiple applications for partial designs, and the application for design registration filed in Japan is an application for design registration for a partial design that combines them
- (4) Where the first application is an application for a partial design, and the application for design registration filed in Japan is an application for design registration for a whole design that has changed the line representing “any other parts,” which is generally a broken line, into a solid line
- (5) Where the application for design registration is for a part that is not disclosed in the first application, and the “part for which the design registration is requested” is added to the application for design registration upon filing the application in Japan

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part X “Procedure for Priority Claim under the Paris Convention, etc.”

Chapter II Design for a Set of Articles

72 Relevant provisions

Design Act

Article 2 (1) "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(Paragraphs (2) through (4) omitted)

Article 8 Where two or more articles are used together and are specifically designated by an Ordinance of the Ministry of Economy, Trade and Industry (hereinafter referred to as a "Set of Articles"), if the Set of Articles is coordinated as a whole, an application for design registration may be filed as for one design, and the applicant may obtain a design registration, for designs for the articles that constitute the Set of Articles.

72.1 Design for a set of articles

Subject matter that comply with both of the requirements that (i) the subject matter stated in the column of "Article to the Design" of the application are designated by the Ordinance of the Ministry of Economy, Trade and Industry provided in Article 8 of the Design Act and (ii) the constituent articles^(Note) are appropriate to be used together are referred to as "a set of articles," and where the constituent articles of the set of articles are coordinated as a whole, they may be registered as a design for a set of articles.

(Note)

A "constituent article" refers to an article constituting a set of articles, as stated in 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," 24.1.3.3 "In the case of an application for design registration for a design for a set of articles."

72.1.1 Requirements for being found to be a design for a set of articles

In order for an 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" of the application is designated by an Ordinance of the Ministry of Economy, Trade and Industry (→72.1.1.1)
- (2) The constituent articles are appropriate (→72.1.1.2)

(3) The set of articles is coordinated as a whole (→72.1.1.3)

72.1.1.1 The subject matter stated in the column of “Article to the Design” of the application 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” of the application 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.

Where the subject matter stated in the column of “Article to the Design” of the application 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 is given.

72.1.1.2 The constituent articles are appropriate

Constituent articles need to be two or more articles that are used at the same time from a common sense perspective, such as the examples shown in the Table of Constituent Articles of Sets of Articles (See Part XIII Appendix). If articles are not appropriate constituent articles, they are not found to constitute a set of articles, and a notice of the reason for refusal under Article 8 of the Design Act is given.

72.1.1.3 The set of articles are coordinated as a whole

Even where the subject matter stated in the column of “Article to the Design” of the application are designated by an Ordinance of the Ministry of Economy, Trade and Industry, and they are found to be a set of articles constituted by specified constituent articles, the shapes, patterns or colors or any combinations thereof of the constituent articles must be coordinated as a whole.

In this manner, even where the subject matter are found to be a set of articles, if the constituent articles are not coordinated as a whole, they are not found to be a design for a set of articles, and a notice of the reason for refusal under Article 8 of the Design Act is given.

72.1.1.3.1 Categories of constituent articles that are found to be coordinated as a whole

Where the constituent articles fall under any of the following, they are found to be coordinated as a whole.

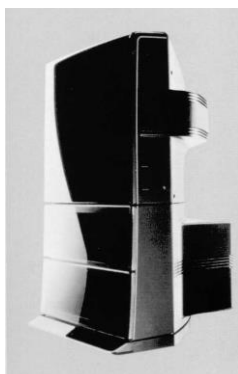
- (1) Where the shapes, patterns or colors or any combinations thereof of the constituent articles are represented through equivalent formative processing, and thereby are found to be coordinated as a whole (→72.1.1.3.1.1)
- (2) Where the constituent articles represent one collective shape or pattern as a whole, and thereby are found to be coordinated as a whole (→72.1.1.3.1.2)
- (3) Where the shapes, patterns or colors or any combinations thereof of the respective constituent articles give a conceptually related impression, such as narrativity, and thereby are found to be coordinated as a whole (→72.1.1.3.1.3)

72.1.1.3.1.1 Examples of cases where the shapes, patterns or colors or any combinations thereof of the constituent articles are represented through equivalent formative processing, and thereby are found to be coordinated as a whole

- (1) Where the constituent articles are found to be coordinated in shape
 - (i) Where the shapes of all constituent articles have a constant order or tone

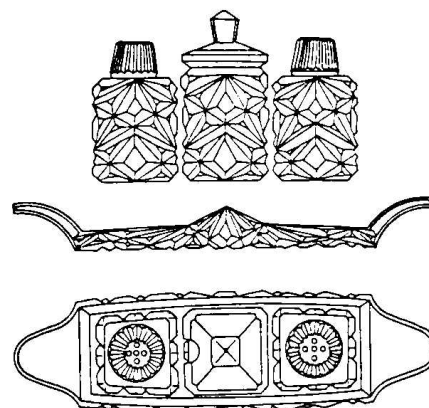
[Case example 1]

“Set of television receivers”



[Case example 2]

“Set of spice containers”

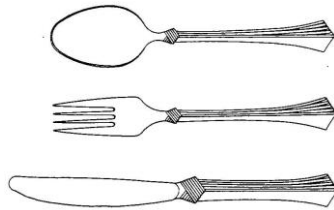


Part VII Individual Applications for Design Registration
Chapter II Design for a Set of Articles

- (ii) Where each constituent article represents a shape with equivalent characteristics

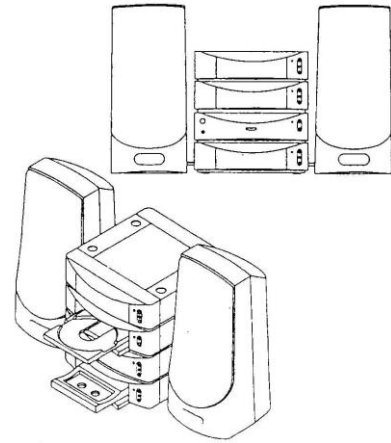
[Case example 1]

“Set of dining knives,
forks and spoons”



[Case example 2]

“Set of audio equipment”



(2) Where the constituent articles are found to be coordinated in pattern

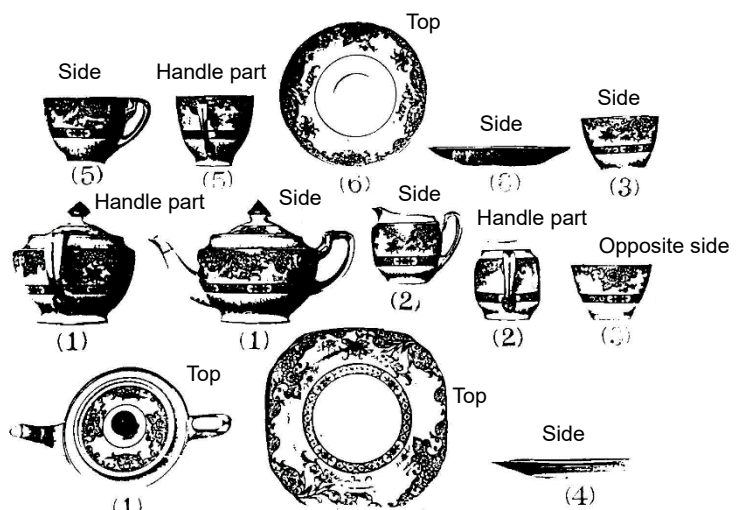
(i) Where a pattern with the same motif is represented on each constituent article with an equivalent composition

[Case example] “Set of storage racks”



(ii) Where a pattern with the same mode of expression is represented on each constituent article with an equivalent composition

[Case example] “Set of coffee ware”



(3) Where the constituent articles are found to be coordinated in color

The constituent articles are not found to be coordinated as

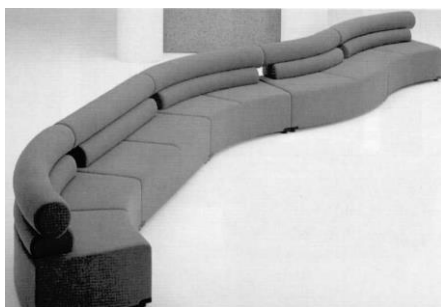
a whole solely based on the mode of the color itself, but a specific color combined with a coordinated shape or pattern can serve as the basis for establishing coordination as a whole.

72.1.1.3.1.2 Examples of cases where the constituent articles represent one collective shape or pattern as a whole, and thereby are found to be coordinated as a whole

(1) Where the constituent articles are found to be coordinated in shape

Where the constituent articles constitute one collective shape in an integrated manner

[Case example 1] "Set of chairs"



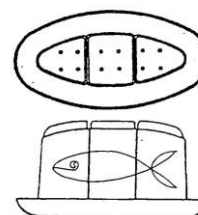
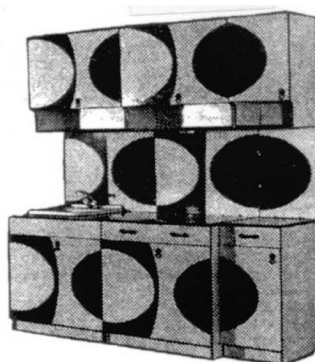
[Case example 2] "Set of tables"



(2) Where the constituent articles are found to be coordinated in pattern

Where the patterns represented on the constituent articles form one collective pattern in an integrated manner

[Case example 1] "Set of kitchen equipment" [Case example 2] "Set of spice containers"

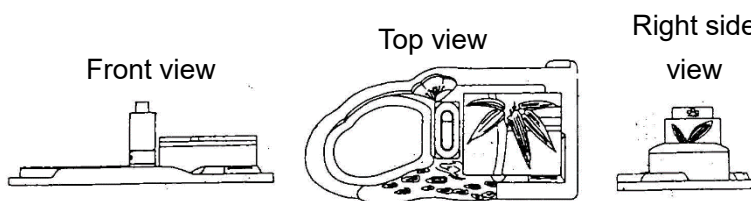


- (3) Where the constituent articles are found to be coordinated in color

The constituent articles are not found to be coordinated as a whole solely based on the mode of the color itself, but a specific color combined with a coordinated shape or pattern can serve as the basis for establishing coordination as a whole.

72.1.1.3.1.3 Example of a case where the shapes, patterns or colors or any combinations thereof of the respective constituent articles give a conceptually related impression, such as narrativity, and thereby are found to be coordinated as a whole

[Case example] “Set of smoker’s articles”



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

Article 2 of the Design Act provides that the design of a set of articles provided in Article 8 of the Design Act does not include a part of an article.

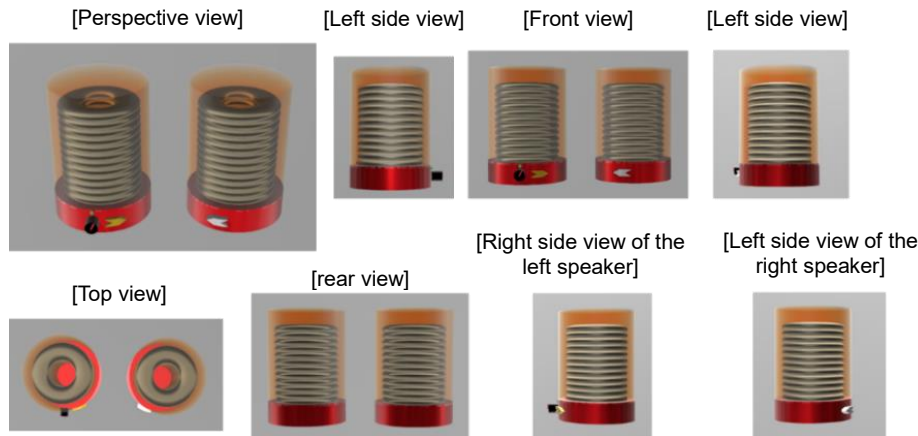
Therefore, an application for design registration for a design for a set of articles that includes a partial design is not found to be a set of articles, and a notice of the reason for refusal under Article 8 of the Design Act is given.

However, in the case of subject matter that is used while being placed on the floor, on a table or the like in a horizontal position whose bottom is normally not seen and the contents of a specific design can be derived by making comprehensive determination based on the statement in an application and drawings without the bottom view, the descriptions are treated as appropriate disclosure of constituent articles even without the bottom view.

(Note) Subject matter that is used while being placed on the floor, on a table or the like in a horizontal position means subject matter that is not lifted up upon use. This excludes subject matter that is used by lifting it up, such as a teapot. (Reference: 2000 (行ケ[Gyo Ke]) No. 58, the "teapot" case)

Example of a case where descriptions are found to be appropriate disclosure of constituent articles even without the bottom view

[Case example] Set of speaker enclosures



72.1.3 Determination on the requirements for design registration, etc. concerning a design for a set of articles

Where an application for design registration for a design for a set of articles complies with the requirements provided in Article 8 of the Design Act, determination is made as to whether or not the application falls under the provisions including the following as the entire set of articles: the main paragraph of Article 3(1) of the Design Act (as well as Article 2 of the Design Act”); novelty (Article 3(1) of the Design Act); creative difficulty (Article 3(2) of the Design Act); exclusion from protection of a design in a later application that is identical or similar to part of a design in a prior application (Article 3-2 of the Design Act); unregistrable designs (Article 5 of the Design Act); prior application (Article 9 of the Design Act); and related designs (Article 10 of the Design Act).

Meanwhile, with regard to the determination standards for applying the respective provisions mentioned above, the determination standards for a whole design apply, so see the parts concerning the respective provisions.

72.1.4 Exception to lack of novelty concerning an application for design registration for a design for a set of articles

An application for design registration for a design for a set of articles is also subject to application of the provision of Article 4(1) or (2) of the Design Act.

Meanwhile, with regard to the requirements, etc. and any other determination standards for receiving application of the provision of Article 4(1) or (2) of the Design Act, the determination standards for a whole design apply, so see Part III “Exception to Lack of Novelty.”

72.1.5 Change of the gist concerning an application for design registration for a design for a set of articles

72.1.5.1 Gist of design of a design for a set of articles

The “gist of design of a design for a set of articles” refers to the contents of a specific design that can be directly derived from the statement in the application and drawings, etc. attached to the application based on the ordinary skill in the art of the design.

72.1.5.2 Categories of amendments that change the gist

Where an amendment made to the statement in the application or any drawings, etc. attached to the application falls under any of the following, it changes the gist of the statement in the application or drawings, etc. attached to the application as originally filed.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part VIII “Amendment of Statement in the Application/Drawings, etc.,” Chapter II “Dismissal of Amendments.”

- (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
- (2) Where the amendment is found to clarify the gist of design that was unclear when originally filed

72.1.5.3 Specific handling of an amendment made to the statement of an application

- (1) Amendment to correct into a set of articles listed in Appended Table 2

Where a set of articles listed in Appended Table 2 was not stated in the column of “Article to the Design” of the application as originally filed and designs for all articles of the specified constituent articles are described in the drawings, etc. attached to the application, an amendment to correct the statement in the column of “Article to the Design” of the application into a set of articles listed in Appended Table 2 changes the gist.

However, where the statement in the column of “Article to the Design” of the application as originally filed was, for example, “a set

(pair) of xxx set (unit),” “a set (pair) of xxx” or “xxx set (unit),” and is unregistrable under Article 8 of the Design Act, but a set of articles listed in Appended Table 2 can be inevitably derived by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application, an amendment to correct the statement in the column of “Article to the Design” into such set of articles that could be inevitably derived does not change the gist.

- (2) Amendment to correct into a classification of articles listed in Appended Table 1

Where a set of articles listed in Appended Table 2 is stated in the column of “Article to the Design” of the application, but only one design for a specified constituent article is described or only one design for any other article which is inappropriate is described in the drawings, etc. attached to the application, an amendment to correct the statement in the column of “Article to the Design” of the application into a classification of articles listed in the right-hand column of Appended Table 1 to which the article to such one design belongs or into a classification of articles equivalent in level to such classification does not change the gist.

72.1.5.4 Specific handling of an amendment made to the drawing, etc. attached to an application

- (1) Amendment to delete an article that is found to be inappropriate as a constituent article of a set of articles

Where a set of articles listed in Appended Table 2 is stated in the column of “Article to the Design” of the application, but designs for all articles of the specified constituent articles as well a design for any other article which is inappropriate are described in drawings, etc. attached to the application, an amendment, made when dividing the application for design registration into one application for design registration for a design for a set of articles and one or more other applications for design registration, to delete the design for any other article which is inappropriate from drawings, etc. attached to the application does not change the gist.

- (2) Amendment to supplement or delete an article that is found to be appropriate as a constituent article

An amendment to supplement or delete an article that is found to be appropriate as a constituent article exceeds the scope of identity that can be inevitably derived by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application as originally filed, and it changes the gist.

- (3) Amendment to supplement drawings of the respective constituent articles with regard to an application for design registration that only has a drawing of the articles in a combined state

An amendment to supplement, in drawings, etc. attached to the application, drawings representing the forms of the respective constituent articles that cannot be inevitably derived by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application as originally filed changes the gist.

Where the forms of the constituent articles can be inevitably derived by making comprehensive determination based on the statement in the application and drawings, etc. attached to the application as originally filed, an amendment to supplement drawings representing the forms of the respective constituent articles does not change the gist.

72.1.6 Division concerning an application for design registration for a design for a set of articles

72.1.6.1 Division of an application for design registration the design of which is found to be a design for a set of articles

Where a design constituted by multiple articles complies with the requirements provided in Article 8 of the Design Act, such design is found to be one design as a whole, so if one or more new applications for design registration are filed for respective constituent articles, it is not found to be legitimate division based on the provisions of Article 10-2 of the Design Act and the new application for design registration is treated as having been filed at the time of the division.

72.1.6.2 Division of an application for design registration the design of which is not found to be a design for a set of articles

Where an application for design registration for a design for a set of articles does not comply with the requirements provided in Article 8 of

the Design Act, such design is not found to be one design as a whole, so division based on the provisions of Article 10-2 of the Design Act is allowed, and the new application for design registration is deemed to have been filed at the time of filing the original application for design registration.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part IX “Special Application for Design Registration,” Chapter I “Division of Applications for Design Registration.”

72.1.7 Application for design registration for a design for a set of articles containing a priority claim under the Paris Convention, etc.

A priority claim under the Paris Convention, etc. is effective with regard to an application for design registration for a design for a set of articles only where the constituent articles are filed as one application in the first country equivalent to the case of a set of articles in Japan.

Meanwhile, with regard to any other determination standards, the determination standards for a whole design apply, so see Part X “Procedure for Priority Claim under the Paris Convention, etc.”

Chapter III Related Design

73 Relevant provisions

Design Act

Article 10 (1) Notwithstanding Article 9(1) or (2), an applicant for design registration may obtain design registration of a design that is similar to another design selected from the applicant's own designs either for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the "Principal Design" and a design similar to it is referred to as a "Related Design"), if the filing date of the application for design registration of the Related Design (or when the application for design registration of the Related Design contains a priority claim under Article 43(1), 43-3(1) or 43-3(2) of the Patent Act as applied mutatis mutandis under Article 15 of this Act, the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application under Article 4C(4) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, or the filing date of an application that is recognized as the earliest application under Article 4(A)2 of the Paris Convention, hereinafter the same shall apply in this paragraph) is on or after the filing date of the application for design registration of the Principal Design and before the date when the design bulletin in which the application for design registration of the Principal Design is published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) is issued.

- (2) Where an exclusive license has been established for the design right of the Principal Design, a design registration shall not be granted to its Related Designs, notwithstanding the preceding paragraph.
- (3) A design registration shall not be granted to a design that is similar only to a Related Design to be registered under paragraph (1).
- (4) Where applications for design registration are filed for two or more Related Designs pertaining to the Principal Design, Article 9(1) or (2) shall not apply to these Related Designs.

Article 21 (1) The duration of a design right (excluding design right of a Related Design) shall expire after a period of 20 years from the date of registration of its establishment.

- (2) The duration of a Related Design shall expire after a period of 20 years from the date when the establishment of the design right of its Principal Design is registered.

Article 22 (1) The design right of a Principal Design and that of its Related Design may

not be transferred independently of each other.

- (2) Where the design right of a Principal Design has been extinguished under Article 44(4), a trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, the design right of its Related Design thereof may not be transferred independently.

Article 27 (1) A holder of a design right may grant an exclusive license on the design right; provided, however, an exclusive license on a design right of a Principal Design or exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Principal Design and its Related Designs are granted to the same person at the same time.

- (2) An exclusive licensee shall have an exclusive right to work the registered design or designs similar thereto as a business to the extent permitted by the contract granting the license.
- (3) Where the design right of a Principal Design has been extinguished under Article 44(4), a trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Related Designs are granted to the same person at the same time.
- (4) Articles 77 (iii) to (v) (Transfer, etc.), 97(2) (Waiver) and 98(1)(ii) and (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to exclusive licenses.

73.1 Related design

Although Article 9 of the Design Act provides that two or more rights should not be granted for one creation, based on the purport of eliminating overlapped rights, in design development there is an actual situation that many design variations are created from one design concept.

Only if applications for such design variations are filed by the same applicant as that for the principal design before the publication date of the Design Bulletin for the principal design (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published), the design variations are exceptionally protected as related designs as those having equivalent value as the principal design, and a design right can be enforced for each design.

73.1.1 Design that is registrable as a related design

In order for a design in an application for design registration to be registered as a related design under Article 10(1) of the Design Act, it must comply with

all of the following requirements.

- (1) The application for design registration is filed by the same applicant for design registration as that for the principal design (→73.1.1.1)
- (2) The application for design registration pertains to a design similar to the principal design (→73.1.1.2)
- (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 (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published) (→73.1.1.3)

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

Since the application for design registration is an application for which the applicant's own design similar to the principal design can be registered as a related design, the applicant for design registration for a related design must be the same as that for the principal design. The determination on whether or not the applicants for design registration are the same in the examination is made at the time of rendering the examiner's decision, but the applicants for design registration also need to be the same at the time of the registration establishing the design right. Meanwhile, where the establishment of a design right has been registered for the principal design, the applicant for design registration for a related design must be the same person as the holder of the design right of the principal design.

73.1.1.2 The application for design registration pertains to a design similar to the principal design

The design in an application for design registration which can be registered as a related design must be similar to the principal design. Therefore, where the design is identical to the principal design, it cannot be registered as a related design. (With regard to determination of similarity between two or more whole designs, see Part VI "Prior Application," 61.1.4 "Determination of similarity between a whole design and a whole design"; with regard to determination of similarity between a partial design and a partial design, see Part VII "Individual Applications for Design Registration," Chapter I "Partial Design," 71.9.1 "Determination of similarity between a partial design and a partial

design”; with regard to determination of similarity between a whole design and a partial design, see 71.9.2 “Determination of similarity between a whole design and a partial design” in the same chapter.)

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 (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published)

Where the filing date of an application for design registration for a related design is 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 (excluding a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were published), the related design may be registered notwithstanding the provisions of Article 9(1) and (2) of the Design Act. Since this Design Bulletin includes a Design Bulletin pertaining to a design which was requested to be kept secret and in which the statement in the application and drawings, etc. attached to the application were not published (the first Design Bulletin pertaining to a secret design), even where the principal design is a design which was requested to be kept secret, an application for design registration for a related design is required to be filed before the publication date of the first Design Bulletin, just as in the case of an ordinary design.

* Please take note that although this Design Bulletin does not include an International Designs Bulletin of an international publication in case of an international application for design registration, a design that was placed in the International Designs Bulletin that was internationally published shall fall under a design provided in Article 3(1)(ii) of the Design Act (a design that was described in a distributed publication or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country).

73.1.1.3.1 Reference date for determination on application of the provision of Article 10(1) 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

In the case of division of an application for design registration under Article 10-2(1) of the Design Act, conversion of a patent application or an application for utility model registration into an application for design registration under Article 13(1) or (2) of the Design Act, or filing of a new application for design registration for an amended design for which a ruling dismissing an amendment has been made under Article 17-3 of the Design Act, if the procedures are conducted legitimately, such application for design registration is deemed to have been filed at the time of filing the original application or at the time of submitting the written amendment of proceedings.

However, since determination on application of the provision of Article 10(1) of the Design Act is made on the basis of the day of filing the application for design registration, with regard to the new application for design registration resulting from division, that resulting from conversion, or that for an amended design for which a ruling dismissing an amendment has been made, the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized will be the reference date for the determination as to whether or not an application for design registration is found to be an application for a related design filed on or after the filing date of the principal design and before the publication date of the Design Bulletin for the principal design.

73.1.1.3.2 Reference date for determination on application of the provision of Article 10(1) of the Design Act with regard to an application for design registration containing a priority claim under the Paris Convention, etc.

Whether or not an application for design registration containing a priority claim under the Paris Convention, etc. is found to be an application for design registration for a related design filed on or after the filing date for the principal design and before the publication date of the Design Bulletin for the principal design is determined based on the filing date of the first application instead of the filing date in Japan.

Therefore, with regard to an application containing a priority

claim, etc. seeking design registration for a related design under Article 10(1) of the Design Act, if the claim is legitimate, whether or not it is an application for design registration for a related design filed on or after the filing date for the principal design and before the publication date of the Design Bulletin for the principal design is determined based on the filing date of the first application.

73.1.1.3.3 Reference date for determination on application of the provision of Article 10(1) of the Design Act with regard to an international application for design registration

The date of the international registration on which an application for design registration was deemed to have been filed under Article 60-6(1) of the Design Act will be the reference date for the determination as to whether or not an international application for design registration is found to be an application for design registration for a related design filed on or after the filing date of the principal design and before the publication date of the Design Bulletin for the principal design (this excludes cases where a priority claim under the Paris Convention, etc. was legitimately made.).

73.1.2 Handling in the case where an exclusive license has been established on the design right of the principal design

A related design whose principal design is a design pertaining to a design right on which an exclusive right has been established may not be registered according to the provision of Article 10(2) of the Design Act.

When establishing exclusive licenses on the design rights of the principal design and its related designs, they must be established for all of the designs to the same person and at the same time under Article 27(1) of the Design Act.

73.1.3 Handling of a design that is similar only to a related design

A design that is similar only to the applicant's own related design to be registered may not be registered, according to Article 10(3) of the Design Act.

A "design that is similar only to a related design" refers to a design that is similar to the applicant's own related design to be registered but is not similar to the principal design pertaining to said related design.

73.1.4 Handling of the case where two or more related designs pertaining to the principal design are similar to each other

Since the design rights of related designs are subject to restrictions on duration, transfer and establishment of an exclusive license, along with the design right of the principal design, and their overlapping parts are adjusted, the provisions of Article 9(1) and (2) of the Design Act do not apply even if the related designs pertaining to the design are similar to each other, according to Article 10(4) of the Design Act.

The same applies to related designs that continue to exist after the principal design has been extinguished.

Where the principal design is extinguished as a result of waiver of the design right, a failure to pay registration fees or a trial decision of invalidation becoming final and binding, or where the application for design registration for the principal design was filed prior to the date on which the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006; hereinafter referred to as the “Revising Act”) came into effect and its duration has expired under Article 21(1) of the Design Act prior to the revision (Article 125 of 1959; hereinafter referred to as the “Old Design Act”) which was to remain applicable under Article 2(1) of the Supplementary Provisions of the Revising Act, the design rights of the related designs continue to exist; similar related designs that continue to exist in such a case will continue to exist while maintaining the restrictions that have been imposed centering on the principal design, considering that the respective designs have equivalent creative values and that the stability of relations of rights need to be secured, and they do not become subject to the provisions of Article 9(1) and (2) of the Design Act even if the related designs are similar to each other.

[Transitional measures]

Act for Partial Revision of the Design Act (Act No. 55 of 2006)

Supplementary Provisions

(Transitional Measure upon Revision of the Design Act)

Article 2 The provisions of Article 2(2), Article 3-2, Article 10, Article 14, Article 17, Article 21, Article 42 and Article 48 of the Design Act as revised by the provisions of Article 1 (hereinafter referred to as the “New Design Act”) shall apply to applications for design registration filed after the date on which this Act comes into effect, and with regard to applications for design registration filed prior to the date on which this Act comes into effect, the provisions then in force shall remain effective.

(Delegation to Cabinet Order)

Article 14 In addition to what is provided for in Articles 2 through 11 of the Supplementary Provisions and the preceding Article, any necessary transitional measures for the enforcement of this Act shall be specified by a Cabinet Order.

Cabinet Order Specifying Transitional Measures for Enforcement of the Act for Partial Revision of the Design Act, etc. (Cabinet Order No. 341 of October 27, 2006)

(Transitional Measures Concerning Design Rights of Related Designs)

Article 1 Where the filing date of an application for design registration for a Principal Design (meaning the principal design provided in Article 10(1) of the Design Act as revised (Act No. 125 of 1959; hereinafter referred to as the “New Design Act”) by the provisions of Article 1 of the Act for Partial Revision of the Design Act, etc. (hereinafter referred to as the “Revising Act”); the same shall apply hereinafter) pertaining to the related design provided in said paragraph is prior to the date on which the Revising Act comes into effect, with regard to application of the provision of Article 22(2) of the Design Act to transfer of the design right of said related design, the term “or the design right of a Principal Design has been waived” in said paragraph shall be deemed to be replaced with “the design right of a Principal Design has been waived, or the duration has expired under the provision of Article 21(1) prior to the revision which were to remain applicable under Article 2(1) of the Supplementary Provisions of the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006).”

Article 2 Where the filing date of an application for design registration for a Principal Design pertaining to the related design provided in Article 10(1) of the New Design Act is prior to the date on which the Revising Act comes into effect, with regard to application of the provision of Article 27(3) of the Design Act to an exclusive license on the design right of said related design, the term “or the design right of a Principal Design has been waived” in said paragraph shall be deemed to be replaced with “the design right of a Principal Design has been waived, or the duration has expired under the provision of Article 21(1) prior to the revision which were to remain applicable under Article 2(1) of the Supplementary Provisions of the Act for Partial Revision of the Design Act, etc. (Act No. 55 of 2006).”

- Application of the Revising Act to an application for design registration for a related design filed after the date on which the Revising Act comes into effect

whose principal design is a design in an application for design registration filed prior to the date on which the Revising Act comes into effect

The provision of Article 10(1) of the Revising Act applies to an application for design registration for a related design filed after the date on which the Revising Act comes into effect whose principal design is a design in an application for design registration filed prior to the date on which the Revising Act comes into effect, based on the provisions of Article 2 of the Supplementary Provisions of the Revising Act, and the design may be registered as a related design. In this case, the duration of the right of the related design will be 20 years from the date of registration of its principal design, based on the provision of Article 21(2) of said Act. However, the duration of the design right of said principal design will be 15 years from the date of registration of the principal design, based on the provision of Article 21(1) of the Old Design Act, so the design right of the principal design will be extinguished through expiration of the duration, even without waiver of the design right, a failure to pay registration fees or a trial decision of invalidation becoming final and binding. In such a case as well, transfer of the design right and establishment of an exclusive license will be restricted based on the provision of Article 1 or 2 of the Cabinet Order Specifying Transitional Measures for Enforcement of the Act for Partial Revision of the Design Act, etc.

- Application of the Revising Act to an application pertaining to division of an application for design registration, conversion of an application or filing of a new application for an amended design

The Revising Act applies to an application pertaining to division of an application for design registration, conversion of an application or filing of a new application for an amended design where the filing date of the original application or the date of submission of the written amendment of proceedings for which a retroactive effect was recognized under Article 10-2(2) of the Design Act (including the cases where applied *mutatis mutandis* pursuant to Article 13(5) of said Act) or Article 17-3(1) of said Act is after the date on which the Revising Act comes into effect.

- Application of the Revising Act to an application for design registration containing a priority claim under the Paris Convention, etc.

The Revising Act applies to an application for design registration containing a priority claim under the Paris Convention, etc. where the filing date in Japan is after the date on which the Revising Act comes into effect, based on the provision of Article 4B of the Paris Convention.

Chapter IV Design Including a Graphic Image on a Screen

74 Relevant provisions

Design Act

Article 2 (1) "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(2) The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner.

(Paragraphs (3) and (4) omitted)

Ordinance for Enforcement of the Design Act

Form No. 2 [Notes]

(39) (See Part I "Application/Drawing," Chapter I "Application for Design Registration," 11 "Relevant provisions")

(40) When filing an application for design registration for a design including a graphic image on a screen that is provided for use in the operation of the article (limited to the operations carried out in order to enable the article to perform its functions) under the provision of Article 2(2) of the Design Act, the description of the functions and the operations of said article to the graphic image in the column of "[Description of Article to the Design]."

Form No. 6 [Notes]

(8) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(9) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(10) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(11) If requesting a design registration for a part of an article, and the graphic image view (meaning the view representing the graphic image displayed on an article that is used with the article in an integrated manner as provided in Article 2, paragraph (2) of the Design Act; the same applies hereinafter) prescribed in (8) through (10) and (14) includes both the part for which the design registration is requested and any other parts, the part for which the design registration is requested is to be specified by

drawing the part for which the design registration is requested with solid lines and any other parts with broken lines, etc. If the part for which the design registration is requested cannot be specified merely by indicating the drawing, the way of specifying the part for which the design registration is requested is to be stated in the column of "[Description of the Design]" of the application.

(14) (See Part II "Requirements for Design Registration," Chapter I "Industrially Applicable Design," 21 "Relevant provisions")

(22) Above each view, an indication such as "[Front View]," "[Rear View]," "[Left Side View]," "[Right Side View]," "[Top View]," "[Bottom View]," "[Surface View]," "[Back Side View]," "[Development View]," "[Sectional View of ○○]," "[End Elevational View of the Sectioned Part of ○○]," "[Enlarged View of ○○]," "[Perspective View]," "[View Showing the Front, Top and Right Side]," "[Graphic Image View]" shall be made, corresponding to each kind of view. Where these views are reference views, a statement to that effect shall also be indicated. In these cases, indications for multiple views should not be the same.

Form No. 7 [Notes]

(4) Form No. 6 Notes (2), (3), (6), (8) through (12), (14) and (18) through (24) shall also apply to other matters.

74.1 The graphic image on a screen constitutes a design

In order for a graphic image on a screen included in the design in the application for design registration to constitute a design subject to protection under the Design Act, the graphic image must comply with either (1) or (2) below.

(1) The graphic image displayed on the display part of the article is found to be the shape, patterns or colors, or any combination thereof, of a part of the article as provided in Article 2(1) of the Design Act.

(2) The graphic image on a screen included in the design constitutes a graphic image as provided in Article 2(2) of the Design Act.

In addition, in order to comply with either (1) or (2) above, the graphic image displayed on the display part of the article needs to be a graphic image that has been recorded in the article (For specific requirements, See 74.4.1.1.1 "The graphic image on a screen constitutes a design").

74.1.1 The graphic image on a computer

Since the fundamental function of a computer is information processing, in the case where an article to the design is a computer, a graphic image displayed by arbitrary software is not categorized as the shape, patterns or colors, or any combination thereof, of a part of the article as provided in Article 2(1) of the Design Act or a graphic image as provided in Article 2(2) of the Design Act (the

shape, patterns or colors, or any combination thereof, of a part of the article).

On the other hand, a computer may constitute a new article (a computer with additional function) with specific function where it is integrated with software. In this case, a graphic image that has been recorded in the article shall be handled as if may constitute the shape, patterns or colors, or any combination thereof, of a part of the article as provided in Article 2(1) of the Design Act or a graphic image as provided in Article (2) of the Design Act (For specific handling, see 74.4.1.1. 1.3 “Graphic image on a computer”).

74.2 Application/drawing of an application for design registration for a design including a graphic image on a screen

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

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

When filing an 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. (“A graphic image for xx” or “an 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 based on an equivalent level of classification must be stated in the column of “Article to the Design” of the application 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, “Video disc player” must be stated in the column of “Article to the Design” of the application because the article to the design which is the object of the right is a video disc player including the graphic image (See 74.7.1.1 in this Chapter “Examples of statements in the column of “Article to the Design” of the application that are not based on classification of articles”).

(i) Statements in the column of “Article to the Design” in the case of a computer with additional function

When filing an application for design registration for a design including a graphic image on a screen of a computer with additional function, “Computer with “xx” function” must be stated in the column of “Article to

the Design” of the application. In this case, “xx” function shall be related and achieved by its addition to the computer and it shall be one function equivalent to the a function of the article indicated by a classification of articles specified by Ordinance of the Ministry of Economy, Trade and Industry or a classification of articles based on an equivalent level of classification.

(ii) Appropriate examples of statements in the column of “Article to the Design” in the case of a computer with additional function

- (a) In the case where a computer has a function equivalent to a “route guidance machine” due to its additional function: “Computer with the route guidance machine function”
- (b) In the case where a computer has a function equivalent to a “telephone” due to its additional function: “Computer with the phone-call function”
- (c) In the cases where a computer has a function equivalent to a “digital camera” due to its additional function: “Computer with the camera function”
- (d) In the case where a computer has a function equivalent to a “pedometer” due to its additional function: “Computer with the pedometer function”
- (e) In the case where a computer has a function of a “multi-media player due to its additional function, “Computer with the multi-media playing function”
- (f) In the case where a computer has a function of a “numerically-controlled device for machine tool” due to its additional function, “Computer with the function of numerically-controlled device for machine tool”
- (g) In the case where a computer has multiple additional functions simultaneously (see above-mentioned examples (a) to (f)) which are equivalent level of classification of articles and where filing an application for design registration for a menu screen for selecting and deciding a specific function therefrom to execute it, “Computer with the home menu function” must be stated in the column.

(2) Statement in the column of “Description of the Design”

With regard to a graphic image on a screen that changes, where the changing order or the changing mode is unclear from the contents of the drawing alone, an explanation on these matters should be stated.

When filing an application for design registration by adopting a design including a graphic image on a screen as a partial design, the way of specifying the part for which the design registration is requested must be stated in the column of “Description of the Design” of the application, based on the provision of the Form No. 6 Note (11) of the Ordinance for Enforcement of the Design Act.

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

- (i) The provision of the Form No. 2 Note (39) of the Ordinance for Enforcement of the Design Act also applies to an application for design registration for a partial design.

Therefore, where the article to the design of the design including a graphic image on a screen does not belong to any of the items of the classification of articles specified by Ordinance of the Ministry of Economy, Trade and Industry, an explanation which can help in understanding the article, such as the purpose of use or the state of use of the article, must be stated in the column of “Description of Article to the Design” of the application.

- (ii) Where a graphic image on a screen is found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act, if it is unclear from the contents of the drawing alone what kind of function of the article the graphic image makes necessary indications for or the usage and function of the graphic image, an explanation on these matters should be stated.

In the case of the graphic image on a screen provided in Article 2(2) of the Design Act, an explanation on enabling the performance of what kind of function of the article the operation pertaining to the graphic image on a screen is carried out for and on the operation method. (Form No. 2 Note (40) of the Ordinance for Enforcement of the Design Act)

- (iii) Where an application for design registration is filed for a graphic image displayed in an article that is used with the article in an integrated manner provided in Article 2(2) of the Design Act, an explanation to the effect that “the article that is used in an integrated manner is display equipment must be stated in the column of “Description of Article to the Design” as “the graphic image on a screen represented in the graphic Image View is displayed on display equipment that is used with the article in an integrated manner.” (A more specific name of an article (e.g. TV monitor, data indicator or projector screen) may be stated as “display equipment” in accordance with the filed design.)

(4) Statement in drawing, etc. of an application for design registration for the design including a graphic image on a screen

(i) Drawings

With regard to the form of the article to the design of the design including the graphic image on a screen, in the case of a whole design, the form of the entire article must be clear, and in the case of a partial design, the form of the “part for which the design registration is requested,” the position, size and scope of the “part for which the design registration is requested” in the entire article, and the boundary between the “part for which the design registration is requested” and “any other parts” must be clear.

Meanwhile, a graphic image on a screen is not found to be a flat and thin article like a woven cloth fabric; therefore, a [Surface View] and [Back Side View] alone may not be used as a set of drawings for a graphic image.

(ii) View of the graphic image displayed on other display equipment.

With regard to the graphic image on a screen provided in Article 2(2) of the Design Act, a view representing the graphic image displayed on display equipment. That is used with the article in an integrated manner should be drawn as a [Graphic Image View].

The outline of a [Graphic Image View] should be the peripheral line of the display part of the display equipment, etc. that is used with the article in an integrated manner. Also, a graphic image on a screen that can be represented by a [Graphic Image View] is limited to the graphic image provided in Article 2(2) of the Design Act where the article to the design is operated by displaying the graphic image on other display equipment.

(iii) Omission of views

Views can be omitted in a case that falls under any of (i) to (iv) below.

- i. Omission of views that are identical or mirror images as prescribed in the Form No. 6 Note (8) of the Ordinance for Enforcement of the Design Act
- ii. Omission of views that is permitted under the Form No. 6 Note (9) of the Ordinance for Enforcement of the Design Act
- iii. In the case of an application for a partial design requesting design registration only for a graphic image that is displayed on another article that is used with the article in an integrated manner as provided in Article 2(2) of the Design Act, omission of parts or all of the views

representing the article to the design, other than the graphic image view

When filing an application for design registration by adopting a design including a graphic image that is displayed on another article that is used with the article to the design in an integrated manner (display equipment) as a partial design, a set of drawings representing the form of the entire article to the design can be omitted. In other words, a design application for design registration based only on a [Graphic Image View] can be filed.

- iv. In the case the position, size, and scope of the part for which a design registration is requested can be specified, omission of views representing only a part other than the part for which the design registration is requested

(iv) Reference views

Where a design cannot be sufficiently represented by the statement in the application, such as the column of [Description of Article to the Design], alone, reference views for explaining the usage and function of each part of the graphic image on a screen and the operation method should be attached.

In addition to the above, with regard to a whole design, see Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design,” and with regard to a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.2.2 “Statement in drawings, etc. of an application for design registration for a partial design.”

74.3 Finding of a design in an application for design registration for a design including a graphic image on a screen

The finding of a design in an application for design registration for a design including a graphic image on a screen should be made by making comprehensive determination based on the statement in the application and drawing, etc. attached to the application.

Consequently, documents that are not categorized as an application or drawing, etc. attached to the application, such as a feature statement, a priority certificate or a certificate for receiving application of the provision of Article 4(2) of the Design Act, are not used as the basis for finding a design in an application for design registration for a design including a graphic image on a screen. (With regard to a whole design, see Part I “Application/Drawings,” Chapter II “Finding of the Design in an Application

for Design Registration,” and with regard to a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.3 “Finding of a design in an application for design registration for a partial design”)

(1) Article to the design

The usage and functions of the article to the design should be found based on the purpose of use, state of use, etc. of the article to the design of the design including a graphic image on a screen.

(2) Usage and functions of the “graphic image on a screen”

The usage and functions of the “graphic image on a screen” should be found based on the usage and functions of the article to the design of the design including a graphic image that has been found as mentioned above.

(3) Form of the “design including a graphic image on a screen”

The form of the “design including a graphic image on a screen” should be found based on the set of drawings and other necessary drawings, such as a sectional view, perspective view or graphic image view.

74.4 Requirements for registration of a design including a graphic image on a screen

In order for the subject matter of an application for design registration for a design including a graphic image on a screen to be registered, it must comply with all of the following requirements.

- (1) The subject matter is an industrially applicable design
- (2) The subject matter is novel
- (3) The subject matter involves creative difficulty
- (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

74.4.1 Industrially applicable design

In order for the subject matter of an application for design registration for a design including a graphic image on a screen 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.

- (1) The subject matter constitutes a design
- (2) The subject matter is a specific design
- (3) The subject matter is industrially applicable

74.4.1.1 The subject matter constitutes a design

With regard to the requirements for subject matter to constitute a design, see Part II “Requirements for Design Registration,” Chapter I

“Industrially Applicable Design” and Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design.”

74.4.1.1.1 The subject matter is the graphic image on a screen constitutes a design

In order for a graphic image on a screen included in a design of the application for design registration to constitute a design, it must comply with either (1) or (2) below.

- (1) The graphic image displayed on the display part of the article is found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act
- (2) The graphic image on a screen included in the design constitutes a graphic image as provided in Article 2(2) of the Design Act

74.4.1.1.1.1 The graphic image displayed on the display part of the article is found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act

In order for the graphic image displayed on the display part of the article to be found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act, it must comply with all of the following requirements.

- (1) The article to the design of the design including the graphic image on a screen is found to be an article subject to the Design Act (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.1.1 “The subject matter is found to be an article”)
- (2) The graphic image displayed on the display part of the article is a graphic image for making necessary indications for performing the functions of the article
- (3) The graphic image displayed on the display part of the article is a graphic image recorded in the article

74.4.1.1.1.1.1 The graphic image displayed on the display part of the article is a graphic image for making necessary indications for performing the functions of the article

In order for a graphic image displayed on the display part of an article to constitute a design as provided in Article 2(1) of the Design Act, the graphic image must be a graphic image for making necessary indications for performing the functions of the article.

A “function” of an article means a function that can be generally expected from the article (refers to a classification of articles under Appended Table 1 or a classification of articles equivalent in level to such classification). For example, in the case of a “Table clock,” the function to indicate the time is the “function” of the article. Where an article itself has multiple functions, each function can be regarded as a “function” of the article ([Case Example 1]). For example, in the case of a “Wrist watch body” with a stop watch function, the time indication function and the time measurement indication function can be regarded as the “functions” of the article ([Case Example 2]).

Meanwhile, where the article to the design of the design for which design registration is requested has a function that cannot be generally expected, by indicating what kind of function it has in the statement in the column of “Description of Article to the Design” in the application, etc., protection can also be obtained for a graphic image on a screen for making necessary indications for performing that function ([Case Example 3]).

With regard to functions of an article, a digital camera for example has not only a photographing function, but also incidental function that is closely related to the function, such as a level indication for confirming that the level is horizontal when photographing. A graphic image on a screen for making necessary indications for performing such

incidental function is also regarded as a graphic image for making necessary indications for performing the function of the article ([Case Example 4]).

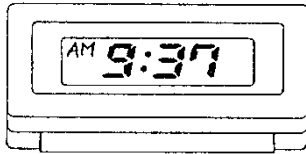
(Note) Handling of an article that has multiple functions

With regard to an article that has multiple functions for which it cannot be directly derived from the article which of the functions the graphic image on a screen is necessary for, it is necessary to add a description to that effect.

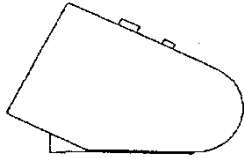
[Case example 1]

[Article to the design] Table clock

[Front view]



[Right side view]



[Case example 2]

[Article to the design] Wrist watch body

[Front view]



[Case example 3]

[Article to the design] Mobile phone

[Front view]

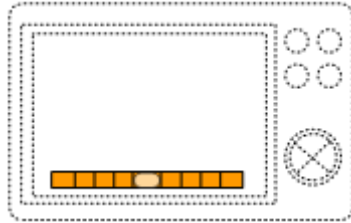


[Description of Article to the Design]

The article is a mobile phone having an azimuth measurement function. The figure displayed on the display part in the front view indicates the measured azimuth, and the compass rotates according to the measured azimuth.

[Case example 4]

[Article to the Design] Digital camera
[Front view]



Indication of information for supporting
taking pictures or vidoes (level indication)

[Description of Article to the Design]

The article is a digital camera with a level function that senses the tilt of the camera.

The figure displayed on the display part in the front view is the level indication for confirming that the level is horizontal when taking pictures or videos.

74.4.1.1.1.2 The graphic image displayed on the display part of the article is a graphic image recorded in the article

The graphic image displayed on the display part of the article needs to be a graphic image that has been recorded in the article (including a graphic image of update relating to the function of the article), since the design as provided in Article 2(1) of the Design Act is “the shape (omitted), patterns or colors, or any combination thereof, of an article”. Accordingly, subject matter displaying a graphic image based on signals sent from outside of the article, such as a graphic image of a television program, a graphic image from the Internet, or a graphic image based on signals sent from another article, subject matter displaying a graphic image recorded on a recording medium connected to or inserted in the article are not found to be a graphic image constituting a design.

74.4.1.1.1.2 The graphic image on a screen included in the design constitutes a graphic image as provided in Article 2(2) of the Design Act

In order for a graphic image on a screen included in a design to constitute a graphic image as provided in Article 2(2) of the Design Act, it must comply with all of the following requirements.

- (1) The article to the design of the design including a graphic image on a screen is found to be an article subject to the Design Act (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.1.1.1 “The subject matter is found to be an article”)
- (2) The graphic image on a screen is provided for use in the operation of the article in order to enable the article to perform its functions
- (3) The graphic image is displayed on the article itself or another article that is used with the article in an integrated manner.
- (4) The graphic image on a screen has been recorded in the article.

74.4.1.1.1.2.1 The graphic image on a screen is provided for use in the operation of the article in order to enable the article to perform its functions

A “function” of an article means a function that can be generally expected from the article (refers to a classification of articles under Appended Table 1 or a classification of articles equivalent in level to such classification). For example, in the case of a “Telephone,” the function of the “article” is of achieve voice communications with a designated destination via a communication line. Where an article itself has multiple functions, each function can be regarded as a “function” of the article. For example, in the case of a “Mobile phone with a camera,” functions such as making phone calls, taking images displaying such taken images and sending and receiving emails can be regarded as the “functions” of the article.

Meanwhile, where the article to the design of the design for which design registration is requested has a function that cannot be generally expected, by indicating what kind of function it has in the statement in the column of “Description of Article to the Design” in the application, etc., protection can also be obtained for a graphic image on a screen

provided for use in the operation of the article in order to enable the article to perform that functions.

“Enable the article to perform” its functions refers to a state where the function of the article is ready to be exercised (for example, in the case of a ticket issuing machine, a state where tickets can be issued; in the case of the “video playing function” of an optical disc recording and playing machine, a state where the viewing of contents can be started; and in the case of the “money transfer function” of an automatic machine for cash payment, a state where the processing of money transfer can be started, etc.), and it means that a state where the article is actually working according to that function (for example, in the case of a mobile phone, the state during making phone calls or sending emails; and in the case of a magnetic disk recorder, the state during playing or recording, etc.) is not included in the subject matter of protection.

“Operation” refers to giving an instruction in order to enable an article to work according to its function. Therefore, a graphic image which merely displays the state of the article in action without including any figure, etc. for the operation is not found to be a graphic image for operation. (However, where the graphic image is for making necessary indications for performing the functions of the article, which has been recorded in the article the graphic image could become subject to protection as a graphic image that falls under Article 2(1) of the Design Act (see 74.4.1.1.1.1 “The graphic image displayed on the display part of the article is found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act”).)

Meanwhile, with regard to “operation” here, it is sufficient to be able to find that the entire graphic image on a screen is provided for use in the

operation, and it is not necessary to find such fact in detail for each figure for operation included in the graphic image.

With regard to graphic images on a screen for enabling the article to perform its functions through multiple steps, every step is found to be for enabling the article to perform its functions, so the graphic images could be made subject to protection if they are provided for use in the operation.

Meanwhile, with regard to an article that has multiple functions, even if a graphic image on a screen for operation is used while the article is performing one of such functions, if the graphic image includes a figure for an operation in order to enable the performance of another new function, etc., it could be found to be a graphic image provided for use in the operation for enabling the article to perform its functions and become subject to protection.

(Note) Handling of an article that has multiple functions

With regard to an article that has multiple functions for which it cannot be directly derived from the article which of the functions the graphic image on a screen is provided for use in the operation in order to enable the article to perform its functions, it is necessary to add a description to that effect.

74.4.1.1.1.2.2 The graphic image is displayed on the article itself or another article that is used with the article in an integrated manner

In order for a graphic image to be found as one provided in Article 2(2) of the Design Act, it needs to be a graphic design displayed on the displayed part of the article to the design in the application for design registration or a graphic design displayed on another article that is used with the article in an integrated manner.

A graphic image displayed on another article that is

used with the article in an integrated manner refers to one displayed not on the article but on display equipment that is used simultaneously when the article is used for the sake of convenience of the use of the article.

For example, a graphic image of the operation of a magnetic disk recorder displayed on a TV monitor and a graphic image of the operation of a computer with additional function displayed on a data indicator can be regarded as a graphic image displayed on another article that is used with the article in an integrated manner. On the other hand, since the fundamental function of a computer is information processing, a graphic image used on a computer that is another terminal by means of network computing is not found to be a graphic image displayed on display equipment, so such graphic image is not categorized as a graphic image displayed on another article that is used with the article in an integrated manner.

Where an application for design registration is filed for a graphic image displayed on another article that is used with the article in an integrated manner, an explanation to the effect that “the graphic image on a screen represented in graphic Image View is displayed on display equipment that is used with the article in an integrated manner” must be stated in the column of “Description of Article to the Design.” (A more specific name of article (e.g. a television monitor, data indicator or projector screen) can be stated as “display equipment” in accordance with the filed design.)

[Case example 1]

Graphic image displayed on the article
“Mobile phone”



(Example of a graphic image displayed on the display part of an article itself)

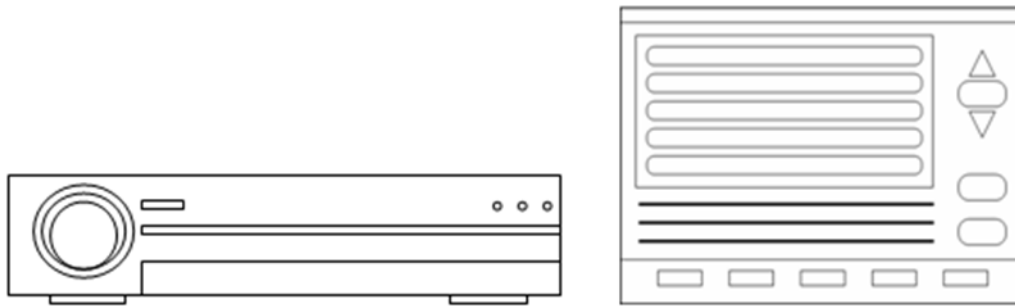
* It is assumed that the graphic image displayed on the display part is provided for use in the operation carried out in order to enable the article to the design to perform its functions, such as the function to make phone calls.

[Case example 2]

Graphic image displayed on another article that is used with the article in an integrated manner

Article 2(2) of the Design Act provides “shall include those in a graphic image on a screen that is displayed on the article itself or another article that is used with the article in an integrated manner,” and makes a graphic image that is used in the operation in order to enable the performance of the functions of the article and is displayed on a display device, etc., which is used with the article in an integrated manner, subject to protection.

“Magnetic disk recorder”



(Example of a graphic image displayed on another article that is used with the article in an integrated manner (e.g., a television monitor))

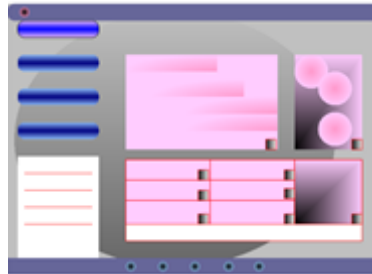
* It is assumed that the graphic image on a screen is provided for use in the operation carried out in order to enable the article to perform its functions, such as a function to reserve video recording.

In addition to the above, with regard to a partial design, see the definition in Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design.”

74.4.1.1.2.3 The graphic image on a screen has been recorded in the article

Since the design provided in Article 2(1) of the Design Act is “the shape, patterns or colors, or any combination thereof, of an article (omitted)” (including a graphic image of update relating to the function of the article), the graphic image displayed on the display part of the article needs to be a graphic image that has been recorded in the article. Accordingly, subject matter displaying a graphic image based on signals sent from outside of the article, such as a graphic image of a television program, a graphic image from the Internet, or a graphic image based on signals sent from another article, subject matter displaying a graphic image recorded on a recording medium connected to or inserted in the article are not found to be a graphic image constituting a design.

[Case example of a graphic image on a screen that is not found to constitute a design]
(Graphic image of a website)



74.4.1.1.1.3 Graphic image on a computer

74.4.1.1.1.3.1 Graphic image of a computer

Since the fundamental function of a computer is information processing only, information processing has already been carried out for a graphic image displayed using arbitrary software, etc. where the article to the design is a “computer” and it is not necessary for performing the information processing function of the article (computer), so such graphic image displayed through a computer is not categorized as a shape, patterns or colors, or any combination thereof, of a part of an article as provided in Article 2(2) of the Design Act.

Moreover, a graphic image displayed using software is categorized as a graphic image on a screen in a state where the article (computer) is performing its information processing function, so such graphic image displayed through a computer is not categorized as a graphic image as provided in Article 2(2) of the Design Act.

However, a graphic image of BIOS (Basic Input/Output System) relating to the information processing function of a computer or a graphic image relating to the adjustment of functions of a computer as hardware (e.g. A graphic image of adjustment of screen brightness on a screen-integrated computer) is categorized as a shape, patterns or colors, or any combination thereof, of a

part of an article as provided in Article 2(1) of the Design Act or a graphic image on a screen as provided in Article 2(2) of the Design Act.

74.4.1.1.3.2 Graphic image of a computer with additional function

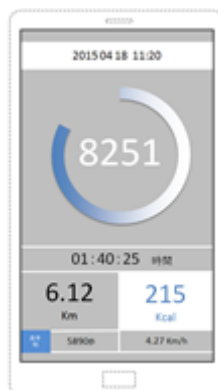
Although the fundamental function of a computer itself is information processing only, it can constitute a new article with specific function when it is integrated with software. This new article constituted by installing software on the computer without requiring other than hardware which a computer generally has to be installed is regarded as a computer with additional function.

Since a computer with additional function is an article that has not only the information processing function but also specific added function, in the case where a graphic image on a screen is one for making necessary indications for performing the functions of the article, the graphic image on a screen is categorized as a shape, patterns or colors, or any combination thereof, of a part of an article as provided in Article 2(1) of the Design Act or a graphic image on a screen as provided in Article 2(2) of the Design Act.

Moreover, in the case where a graphic image on a screen is provided for use in the operation in order to enable the article to perform the additional function, it is categorized as a graphic image on a screen provided for use in the operation of the article as provided in Article 2(2) of the Design Act.

[Case example 1 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a pedometer function”



Graphic image displaying step count data

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Case example 2 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a function of creating postcards”

[Graphic image view]



This graphic image on a screen is to enable the article to perform its function by entering data from the address book

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Case example 3 of a graphic design on a screen that is found to constitute a design of the computer with additional function]

“Computer with a machining center control function”

[Front view]



This graphic image on a screen is to set the content of cutting work

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Case example of a graphic image on a screen that is not found to constitute a design of the computer with additional function]

Since the function and purpose of a “machining center” is cutting work and hardware other than a computer is essential component for performing the cutting work, in the case of a design shown in the following drawing, the article to the design cannot be registered as a “computer with a machining center function” or “computer with a machining center control function.” In the case of such design, the article to the design is a “machining center.”

[Front view]



[Enlarged view of a part for which the design registration is requested]



This graphic image on a screen is to set the content of cutting work

*For the sake of convenience of explanation, the matters described in the application and other drawings were omitted.

[Article to the design]

- × “Computer with a machining center function”
- × “Computer with a machining center control function”
- “Machining center”

74.4.1.1.2 Graphic image on a screen that is not categorized as a graphic image that constitutes a design

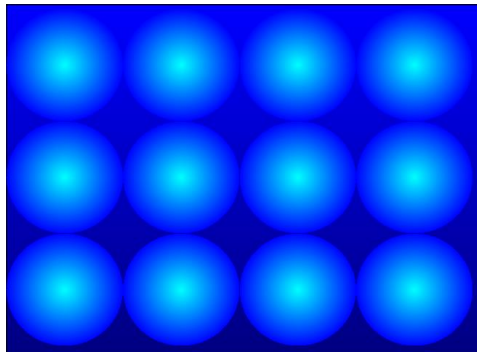
The following graphic image on a screen is not categorized as a graphic image that constitutes a design, and may not be registered as a design under the provision of the main paragraph of Article 3(1) of the Design Act.

(1) A graphic image on a screen solely intended for decorative expression

A graphic image on a screen solely intended for decorative expression is not found to be a graphic image for making necessary indications for performing the functions of the article, and is not found to be a graphic image provided for use in the operation in order to enable the article to perform its functions, so it does not constitute a design.

[Case example of a graphic image on a screen that is not found to constitute a design]

Graphic image on a screen for decorating the background of the display part (so-called “wallpaper”)



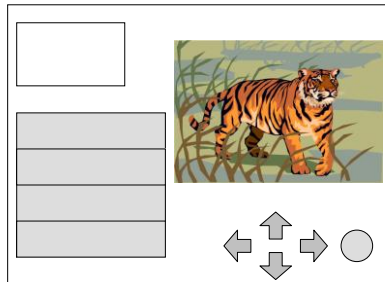
(2) A graphic image displaying a movie, etc. (so-called “content”)

Subject matter displaying a graphic image based on signals sent from outside of the article, such as a graphic image of a television program or a graphic image from the Internet and subject matter displaying a graphic image recorded on a recording medium connected to or inserted in the article are not graphical images recorded in the article, so they are not found to be the shape, patterns or colors, or

any combination thereof, of a part of an article provided in Article 2(1) of the Design Act. Also, they are not found to be graphic images used in the operation for the performance of the functions of the article as provided in Article 2(2) of the Design Act.

Where content (or an image suspected of being content) independent from the article, such as a scene from a movie or a graphic image on a screen of a game, is displayed in the graphic image on a screen included in a design, the content is independent from the article to the design, so the content part should be treated as not constituting a design, and a notice of the reason for refusal under Article 3(1) is given with regard to the design including the content independent from the article. In this case, an amendment to delete the content and to indicate that said part is a content display part by using reference views for explanation, etc. does not change the gist of the design.

[Example where content is displayed in a graphic image on a screen included in a design]



[Article to the Design] Video player

[Description of the Design] (Omitted) The graphic image view shows a graphic image on a screen for operation in order to enable the article to perform the video recording function which is displayed when the menu button of the article is pressed down while playing a video. Video recording can be set up while displaying the graphic image that is being displayed at top right. (The rest omitted)

[Graphic Image View]

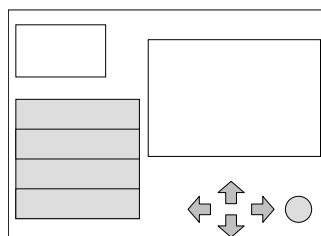
* Any other necessary drawings, etc. are omitted.

With regard to a design application where content independent from the article is displayed in the graphic image on a screen included in the design, the examiner gives a notice of the reason for refusal under the main paragraph of Article 3(1).

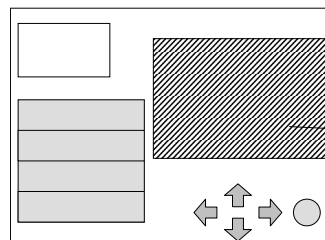
(Reference) Example of depicting a design including a graphic image on a screen which has a content display part

[Article to the Design] Video player

[Description of the Design] (Omitted) The part shown in oblique lines within the reference graphic image view indicates the part that displays a video being played. (The rest omitted)



[Graphic Image View]



[Reference Graphic Image View]

Content display part

* Any other necessary drawings, etc. are omitted.

(3) A graphic image displayed on a general purpose display device

Subject matter displaying a graphic image on a general purpose display device based on signals sent from outside of the article, such as subject matter displaying a graphic image based on signals sent from another article that is used with the article in an integrated manner or subject matter displaying a graphic image recorded on a recording medium connected to the article, is not a graphic image that has been recorded in the article, which is a display device, so it is not found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act.

Article 2(2) of the Design Act provides “shall include those in a graphic image on a screen that” “is displayed on the article itself or another article that is used with the article in an integrated manner,” and accordingly, a graphic image that is provided for use in the operation to enable the article to perform its functions and is displayed on a display device, etc., which is used with the article in an integrated manner, is subject to protection; but in such case, the article to the design will be said article, instead of the display device. Therefore, a graphic image for operation displayed on the display part of a general-purpose display device is not found to be a graphic image that is provided for use in the operation to enable the article to perform its functions, except where it is a graphic image that is provided for use in the operation in order to enable the performance of the functions of the article as provided in Article 2(2) of the Design Act.

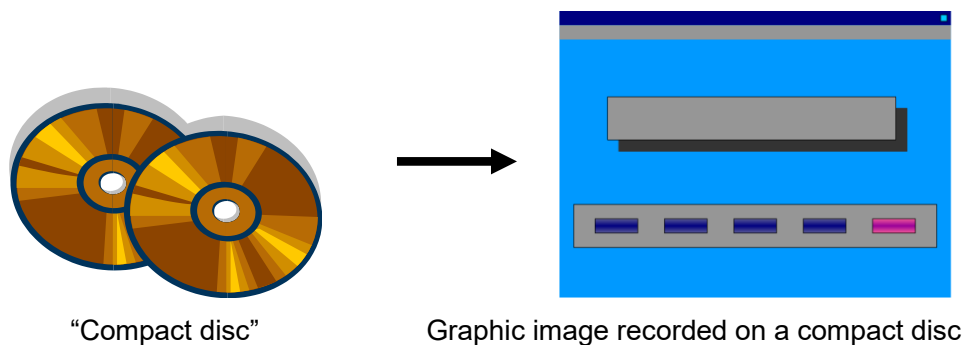
(4) A graphic image recorded on a recording medium

Since a recording medium does not have a display part, a graphic image recorded on a recording medium is not found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act. Meanwhile, an article which is a recording medium (for example, a compact disc, etc.) is capable of recording information pertaining to a graphic design in the article, but the recording medium itself does

not have an operation mechanism, so a graphic image that uses the article to the design as a recording medium is not found to be a graphic image that is provided for use in the operation to enable the article to perform its functions as provided in Article 2(2) of the Design Act.

[Case example of a graphic image on a screen that is not found to constitute a design]

Graphic image recorded on a recording medium



(5) A graphic image displayed by a game machine

A graphic image of a game that is displayed as a result of installing game software created and sold independent from the article (including a graphic image preinstalled on the game machine) and a graphic image of a game that is displayed as a result of inserting a recording medium on which the game is recorded are not found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act, since each graphic image is contents independent from the article.

However, a graphic image on a screen for making necessary indications for performing the functions of the main body of the game machine, not resulting from game software, which has been recorded in the article, such as an indication of the remaining battery power, is found to be the shape, patterns or colors, or any combination thereof, of a part of an article provided in Article 2(1) of the Design Act.

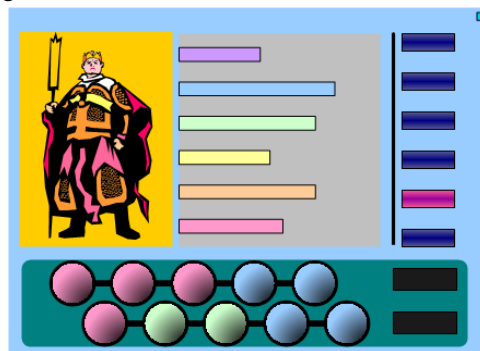
Meanwhile, a graphic image on a screen of a game is the content independent from the article, so it is not found to be

a graphic image as provided in Article 2(2) of the Design Act.

However, a graphic image on a screen for setting up the main body of a game machine, etc. is found to be a graphic image used in the operation for the performance of the functions of the article as provided in Article 2(2) of the Design Act.

[Case example of a graphic image on a screen that is not found to constitute a design]

Graphic image of a game machine



74.4.1.2 The subject matter is a specific design

First, it must be possible to directly derive that the method and subject matter of the application for design registration are those of an application for design registration for a design including a graphic image on a screen, from the statement in the application and drawing, etc. attached to the application as originally filed, based on the ordinary skill in the art of the design.

Next, in order for the design in an application for design registration for a design including a graphic image on a screen to be found to be a specific design, the design must be one for which contents of a specific single design, that is, specific contents concerning (i) through (iv) below, can be directly derived from the statement in the application and drawing, etc. attached to the application as originally filed, based on the ordinary skill in the art of the design.

- (i) The article to the design of a design including a graphic image on a screen
- (ii) The usage and functions of the “graphic image on a screen”
- (iii) In the case of requesting a design registration for a “graphic image on a screen” as a partial design, its position, size and scope

However, in the case of filing an application for design registration by adopting a design including a “graphic image on a screen” displayed on another article that is used with the article in an integrated manner as a partial design, and making the graphic image the part for which the design registration is requested, the position, size and scope of the part for which the design registration is requested in the other article that is used with the article in an integrated manner will not be evaluated.

(iv) Form of a “design including a graphic image on a screen”

As for the accuracy of the statement in the application and drawing, etc. attached to the application, with regard to a whole design, see Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design,” and with regard to a partial 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 not found to be a specific design

Where an application or drawing, etc. attached to the application contains any of the following improper descriptions, and where contents of a specific single design cannot be directly derived upon making comprehensive determination on the statement in the application and drawing, etc. attached to the application, the subject matter is not found to be a specific design.

- (i) Where the specific usage and functions of the article to the design or the “graphic image on a screen” are unclear
- (ii) Where the entire form of the “graphic image on a screen” is not represented
- (iii) Where the entire form of the article to the design is not represented
- (iv) Where the form of the entire article to the design, including the “graphic image on a screen,” 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” of the application (in the case of a partial design)
- (v) Where it is unclear whether the “graphic image on a screen” is displayed on the display part of the article or displayed on the

display part of another article that is used with the article in an integrated manner

- (vi) Where the “graphic image on a screen” changes, but the changing order or the changing mode is unclear

74.4.1.3 The subject matter is an industrially applicable design

The article to the design of a design including a graphic image on a screen must be industrially applicable.

74.4.2 Novelty

Application of the provisions of the items of Article 3(1) of the Design Act is to be determined by making determination as to whether or not the design including a graphic image on a screen is categorized as any publicly known design or categorized as any design similar to a publicly known design.

74.4.2.1 Article 3(1)(i) and (ii) of the Design Act

In order to be able to determine whether or not a design including a graphic image on a screen is categorized as a publicly known design, if the form of the entire design including a graphic image on a screen for which an application for design registration has been filed is sufficiently represented to a comparable level in the publicly known design, it can be used as the basis for determining novelty.

Meanwhile, where a graphic image on a screen displayed on a publicly known information such as publication is found to be a graphic image on a screen of software installed on a computer, it is treated as a design of a graphic image on a screen of a computer with additional function.

With regard to other determination standards concerning a whole design, see Part II “Requirements for Design Registration,” Chapter II “Novelty,” 22.1.1 “Article 3(1)(i) of the Design Act” and 22.1.2 “Article 3(1)(ii) of the Design Act,” and with regard to those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.4 “Requirements for design registration concerning a partial design,” 71.4.2 “Novelty,” 71.4.2 “Article 3(1)(i) and (ii) of the Design Act” and 71.4.2.2 “Article 3(1)(iii) of the Design Act.”

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

74.4.2.2.1 Determination of similarity between a publicly known design and a design including a graphic image on a screen

In the case of a design including a graphic image on a screen, where the two designs to be compared satisfy all of (i) through (iii) below, they are similar.

- (i) The articles to the design of the two designs to be compared are identical or similar.
- (ii) The usage and functions of the graphic images of the two designs to be compared are identical or similar.

- (iii) The forms of the two designs to be compared are identical or similar.

Since the article and the form are inseparably integrated in a design, unless the article to the design and the article to the design of a publicly known design are identical or similar, the designs are not similar.

A graphic image on a screen is included in the shape, patterns or colors, or any combination thereof, of a part of an article. In order for designs including graphic images on a screen to be similar, the usage and functions of the graphic images of the two designs to be compared must be identical or similar.

Additionally, the determination of similarity of a design including a graphic image is made according to the examination standards for a whole design and a partial design.

Meanwhile, the determination of similarity between graphic images on a screen that change, consisting of plural graphic images, and a graphic image that does not change and the determination of similarity between two or more graphic images that change are made by comprehensively observing the graphic images including the modes of the graphic images that change before and after the change.

74.4.2.2.1.1 Determination of similarity between the articles to the design of the two designs to be compared

Since a graphic image on a screen visually embodies a function which the article has electronically inside thereof and realizes the functions of the article, in the case of a design including a graphic image on a screen, the determination of similarity of the usage and functions of the articles to the design as well as the determination of similarity of the usage and functions of the graphic images included therein are made.

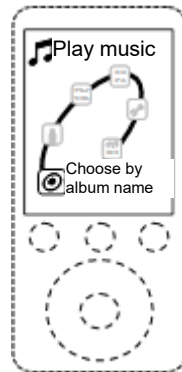
Even if the usage and functions of the articles to the design are different, where the difference cannot be taken into consideration based on a comprehensive determination, since it does not appear as a feature of the shape of the article, the articles to the design are determined to be similar. On the other hand, generally, even

if the usage and functions of the graphic images on a screen are common, where there are other usage and functions to be taken into consideration, for example, an obviously-different purpose of use is included other than the usage and functions of the graphic images on a screen by making a comprehensive determination of the usage and functions of the articles to the design of the designs to be compared, the articles to the design are found to be not similar.

For example, in the case of the designs of computers with additional functions, if the articles to the design are similar where the additional function are mutually similar and, in relation to other articles than the computers with additional function, the computer itself can realize the usage and functions similar to those of another article, the articles to the design are found to be similar. On the other hand, where hardware other than one which a computer generally has in order to realize the usage and functions identical or similar to those of another article, the articles to the design of the two designs are found to be not similar.

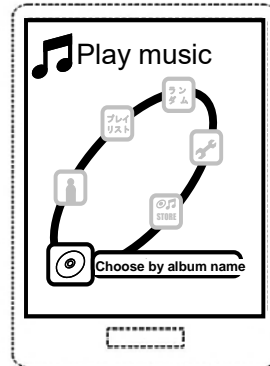
[Example of a case where the two articles are found to be similar 1]

Publicly known design



“Music player”
(Graphic image for choosing
a music selection method)

Filed design

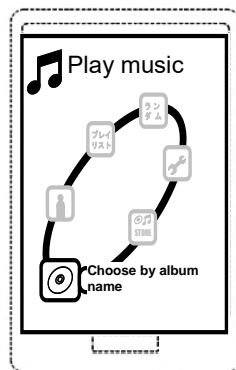


“Computer with the music playing function”
(Graphic image for choosing
a music selection method)

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

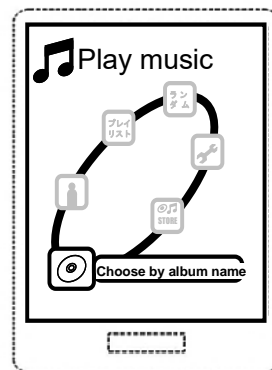
[Example of a case where the two articles are found to be similar 2]

Publicly known design



“Mobile information terminal”
(This article has the music playing
function, the schedule managing
function and the camera function.
This graphic image shows a music
selection method of the music
playing function)

Filed design



“Computer with the music playing
function”
(Graphic image for choosing a
music selection method)

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Example of a case where the two articles are found to be similar 3]

publicly known design



“Machining center controlling machine”
(Graphic image for setting the content of cutting work)

filed design



“Computer with the machining center controlling function”
(Graphic image for setting the content of cutting work)

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

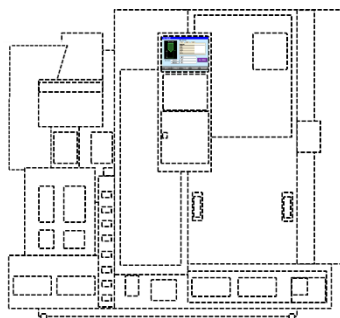
[Example of a case where the two articles are found to be not similar]

publicly known design

Enlarged view of a part for which the design registration is requested



[Front view]



“Machining center”
(Graphic image on a screen for setting the content of cutting work)

filed design



*For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

Even if the usage and functions of the graphic images of the two designs to be compared are common, where a computer with additional function (e.g. a computer with the machining center controlling function) requires hardware other than one which a computer generally has (e.g. a mechanism for cutting work) in order to realize the usage and functions identical or similar to another article (e.g. a machining center), the articles to the design of the two designs are found to be not similar.

*This filed design is subject to refusal based on the requirement for creative difficulty.

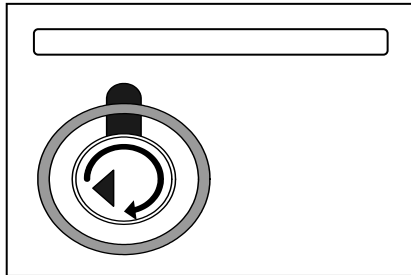
74.4.2.2.1.2 Example where the two designs are found to be similar

The graphic images on a screen in the following case examples are found to be similar.

[Case example 1]

Design that was publicly known

[Graphic Image View]

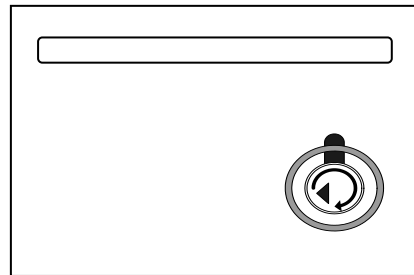


“Digital video disc recorder”

(Graphic image on a screen provided for use in the operation in order to enable the performance of the video edit function)

Filed design

[Graphic Image View]



“Digital video disc recorder”

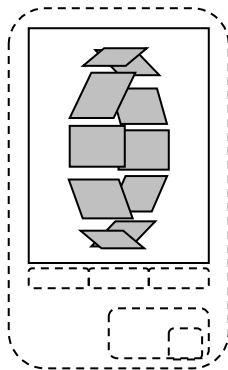
(Graphic image on a screen provided for use in the operation in order to enable the performance of the video edit function)

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 2]

Design that was publicly known

[Front View]

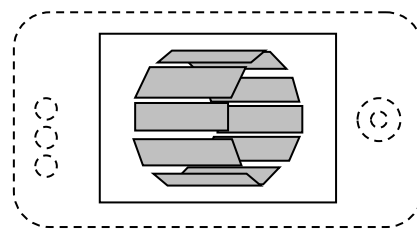


“Portable video player”

(Graphic image on a screen for selecting the video)

Filed design

[Front View]



“Portable video player”

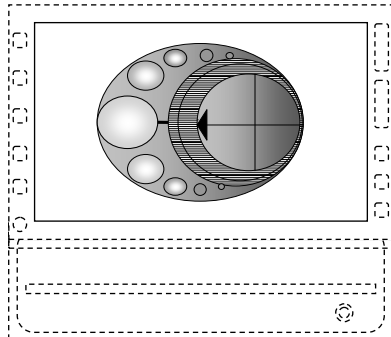
(Graphic image on a screen for selecting the video)

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 3]

Design that was publicly known

[Front View]

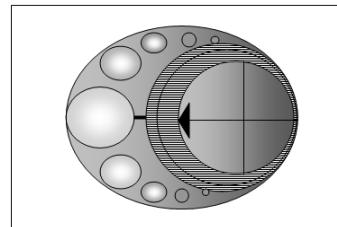


“In-vehicle route guidance machine”
(Graphic image displayed on the
display part of the article itself)

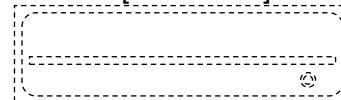
* No particular characteristics are
found in the position, size and scope
of the part for which the design
registration is requested.

Filed design

[Graphic Image View]



[Front View]



“In-vehicle route guidance machine”
(Graphic image displayed on
another article that is used with the
article in an integrated manner)

* The position, size and scope of the
part for which the design registration
is requested is not evaluated.

* For the convenience of explanation, the matters to be stated
in the application and any other views are omitted.

A design in relation to a graphic image displayed on the display part of
the article itself and a design in relation to a graphic image displayed on
another article that is used with the article in an integrated manner are
sometimes similar.

However, where the forms of the graphic images on a screen are in
common, but the position and scope of the part for which the design
registration is requested in the entirety differ between the two, and the
difference is considered to have a large influence on the determination of
similarity, the two are determined to be not similar.

[Case example 4]

Design that was publicly known



“Computer with the function of
creating sticky”

(Graphic image on a screen for
selecting sticky notes)

Filed design

[Graphic image View]



“Computer with the function of
creating sticky”

(Graphic image on a screen for selecting
sticky notes)

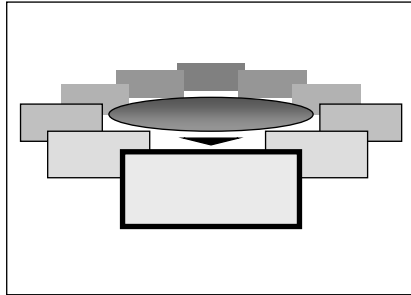
* For the convenience of explanation, the matters to be
stated in the application and any other views are omitted.

With regard to a graphic image on a screen displayed on a publicly known information such as publication, where the graphic image on a screen is found to be a graphic image on a screen of software installed on a computer, it is treated as a design of the graphic image on a screen of the computer with additional designs.

[Case example 5]

Design that was publicly known

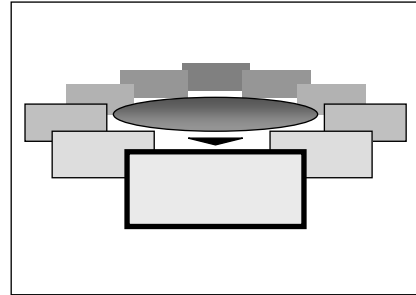
[Graphic Image View]



“Digital video disc recorder”
(Graphic image on a screen for selecting various settings)

Filed design

[Graphic Image View]



“Digital video disc recorder”
(Graphic image on a screen for selecting various settings)

* Graphic image that changes by operation



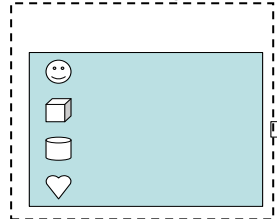
Graphic image that changes where a rectangular title display part rotates clockwise around the oval part at the center

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

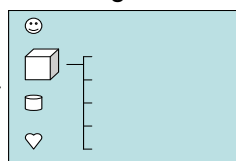
[Case example 6]

Design that was publicly known

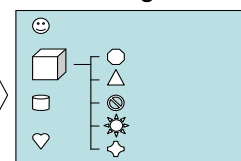
[Graphic Image View]



[Graphic Image View of the Changed State1]



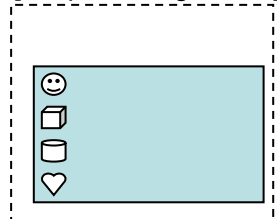
[Graphic Image View of the Changed State 2]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

Filed design

[Graphic Image View]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

Where the design that was publicly known was graphic images on a screen that change, consisting of plural graphic images, the determination of similarity is made between the filed design and a part of the plural graphic images constituting the design that was publicly known.

74.4.3 Creative difficulty

Application of the provision of Article 3(2) of the Design Act is to be determined by making determination as to whether or not, in the constitution of designs including graphic image on a screen (all designs found to be under Articles 2(1) and 2(2) of the Design Act), the constituent elements or specific constitution on which the designs are based were publicly known or widely known prior to the filing of the application for design registration, and whether or not those constituent elements have been added almost as they are or by only adding an ordinary modification regularly seen in the art thereto and this change is a mere combination that is an ordinary technique in the art or all of or part of the constituent elements have been merely replaced.

Meanwhile, with regard to other determination standards concerning a whole design, see Part II “Requirements for Design Registration,” Chapter III “Creative Difficulty,” and with regard to those concerning a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.4.3 “Creative difficulty.”

74.4.3.1 Person Ordinarily skilled in the art of the design

A person ordinarily skilled in the art of the design with regard to a design including a graphic image on a screen refers to a person who had ordinary skills concerning designs in the industry in which the article to the design is to be manufactured or sold as of the time of the filing of the application for design registration and ordinary skills concerning the design (the usage and functions of the graphic image part and the shape, patterns or colors, or any combination thereof) that do not question whether or not they are identical to or different from the article to the design.

74.4.3.2 Examples of ordinary modifications and ordinary techniques in the art

(1) Examples of ordinary modifications in the art of the design including a graphic image on a screen

Shape, patterns or colors, or any combination thereof

(a) Changes made to detailed designs such as rounding of a rectangle corner part, addition of shades to make three-dimensional shape, placement of gaps between constituent elements, changes in the width between gaps and introduction of the pull-down function

(b) Simple addition of colors such as simple coloring in each compartment and standard coloring based on required functions

- (c) A mere combination of ordinary modifications in (a) and (b)
- (2) Examples of ordinary techniques in the art of the design including a graphic image on a screen
 - (a) Replacement
 - (b) Aggregation
 - (c) Change of layout
 - (d) Change of the component ratio or the increase or decrease of the number of units of a continuous constituent element
 - (e) Use or diversion of a constituent element beyond the framework of article
 - (f) Change of the mode of frame division
 - (g) Deletion of organized compartment elements
 - (h) Addition of existing changing mode
 - (i) Mere combination of ordinary techniques mentioned from (a) to (h)

74.4.3.3 Graphic images on a screen that change

Application of the provision of Article 3(2) of the Design Act to graphic images on a screen that change is to be determined by making determination as to whether or not the respective graphic images indicating before and after the change could have been easily created by a person skilled in the art based on shapes, patterns or colors, or any combination thereof that were publicly known prior to the filing of the application for design registration, and whether or not the mode of the change is a change based on an ordinary technique for a person skilled in the art. In other words, in the cases set forth in (i) and (ii) below, the design in the application is not found to be a design that could have been easily created, and does not fall under the provision of Article 3(2) of the Design Act.

- (i) Where the respective graphic images on a screen indicating before and after the change could have been easily created by a person skilled in the art based on shapes, patterns or colors, or any combination thereof that were publicly known prior to the filing of the application for design registration, but the mode of the change is not a change based on an ordinary technique for a person skilled in the art
- (ii) Where the mode of the change is a change based on an ordinary technique for a person skilled in the art, but the respective graphic images on a screen indicating before and after the change could not have been easily created by a person skilled in the art based on

shapes, patterns or colors, or any combination thereof that were publicly known prior to the filing of the application for design registration

74.4.3.4 Ideas and originality of a design from the standpoint of a person skilled in the art

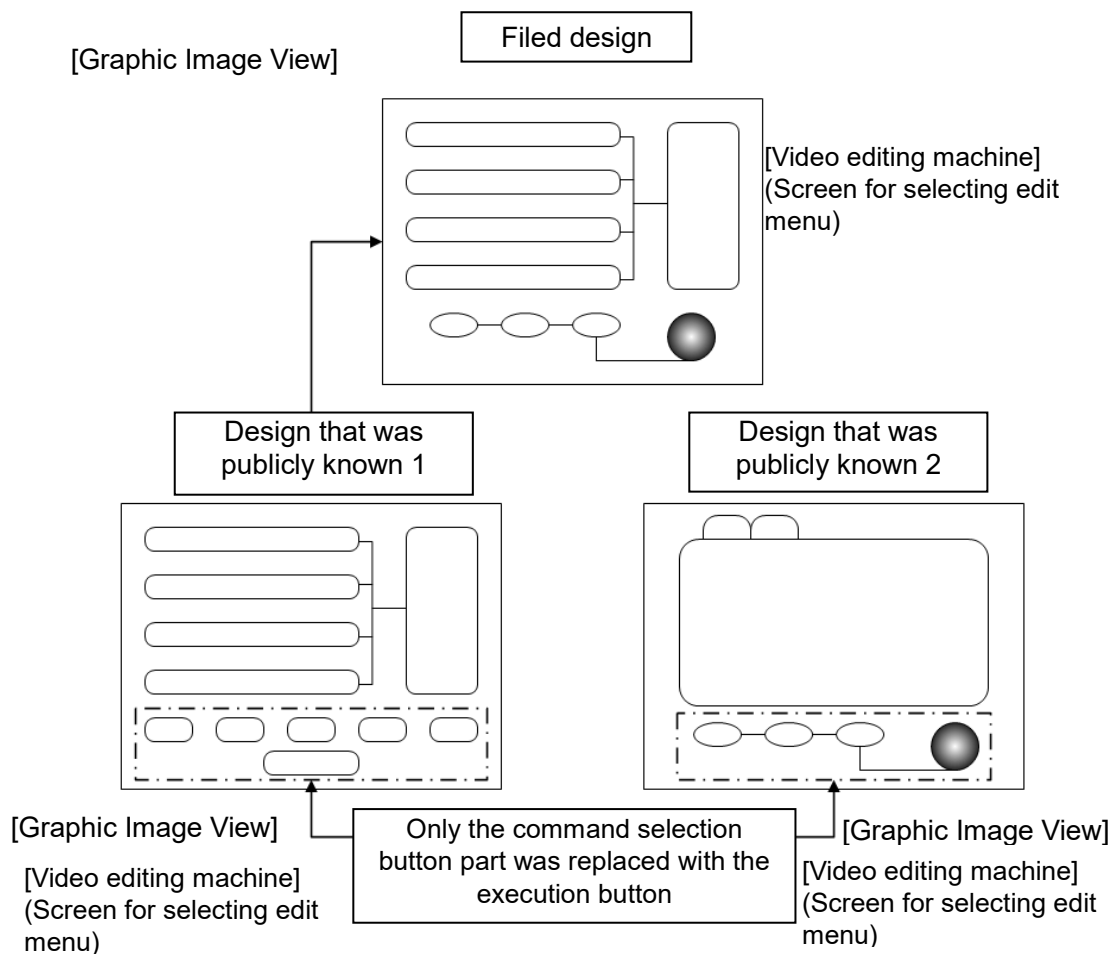
Where application of the provision of Article 3(2) of the Design Act is to be determined, if a visual feature of the design appears and this is found to be an idea of the design or original from the standpoint of a person skilled in the art based on own creativity, it shall be taken into consideration. However, where the description of a feature statement or written opinion is taken into account before making the determination, only the description falling under the scope derived from the statement of the application and drawings at the time of the filing of the original application for design registration is to be taken into consideration.

74.4.3.5 Examples of designs that are found to be designs that could have been easily created

(i) Design constituted by replacement

[Case example]

A design that merely constitutes a single graphic image on a screen by replacing a part of a graphic image on a screen that was publicly known with a part of another graphic image on a screen.

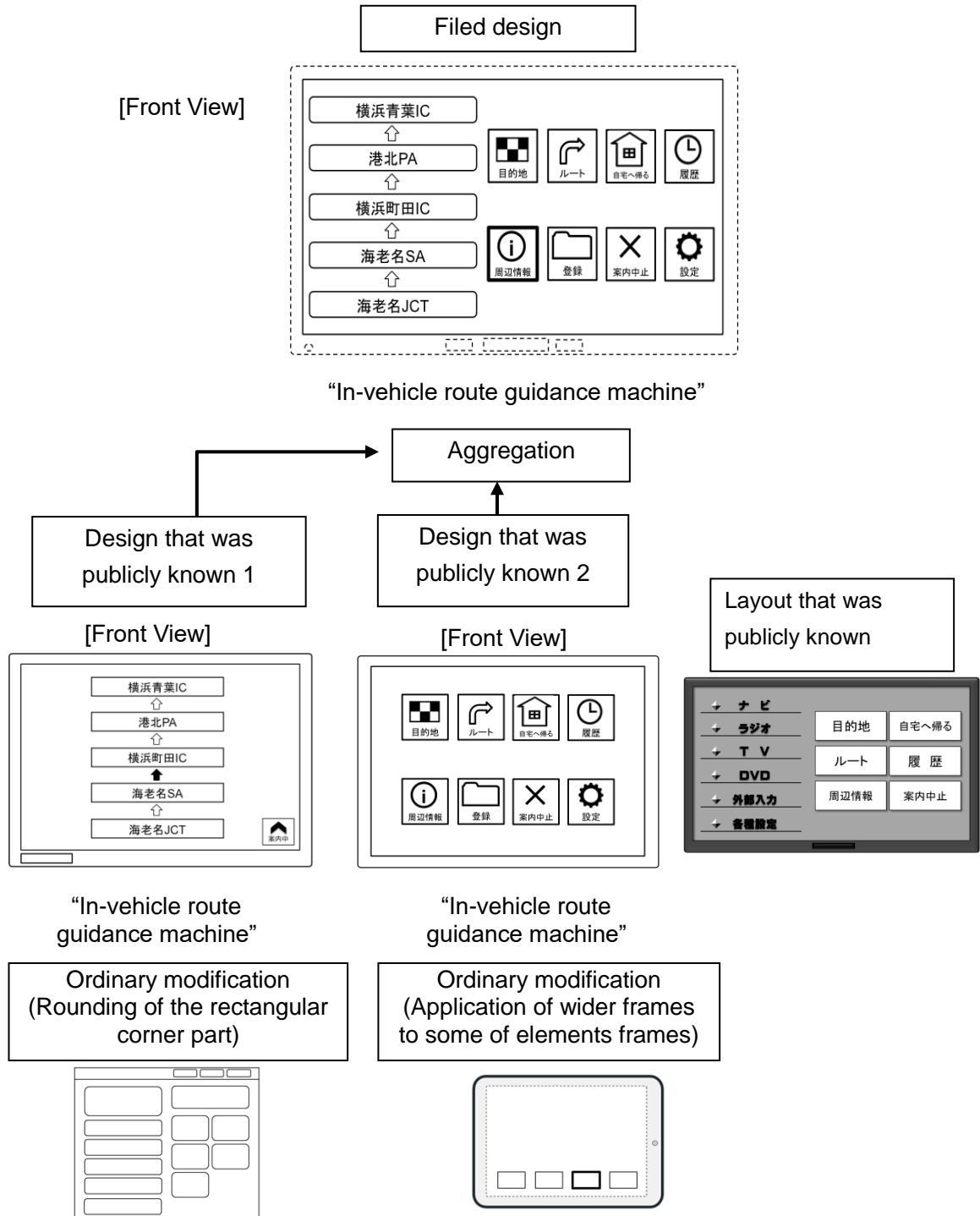


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

(ii) Design constituted by aggregation

[Case example]

A design that merely constitutes a single graphic image on a screen by aggregating multiple graphic images that were publicly known by adding ordinary modifications.

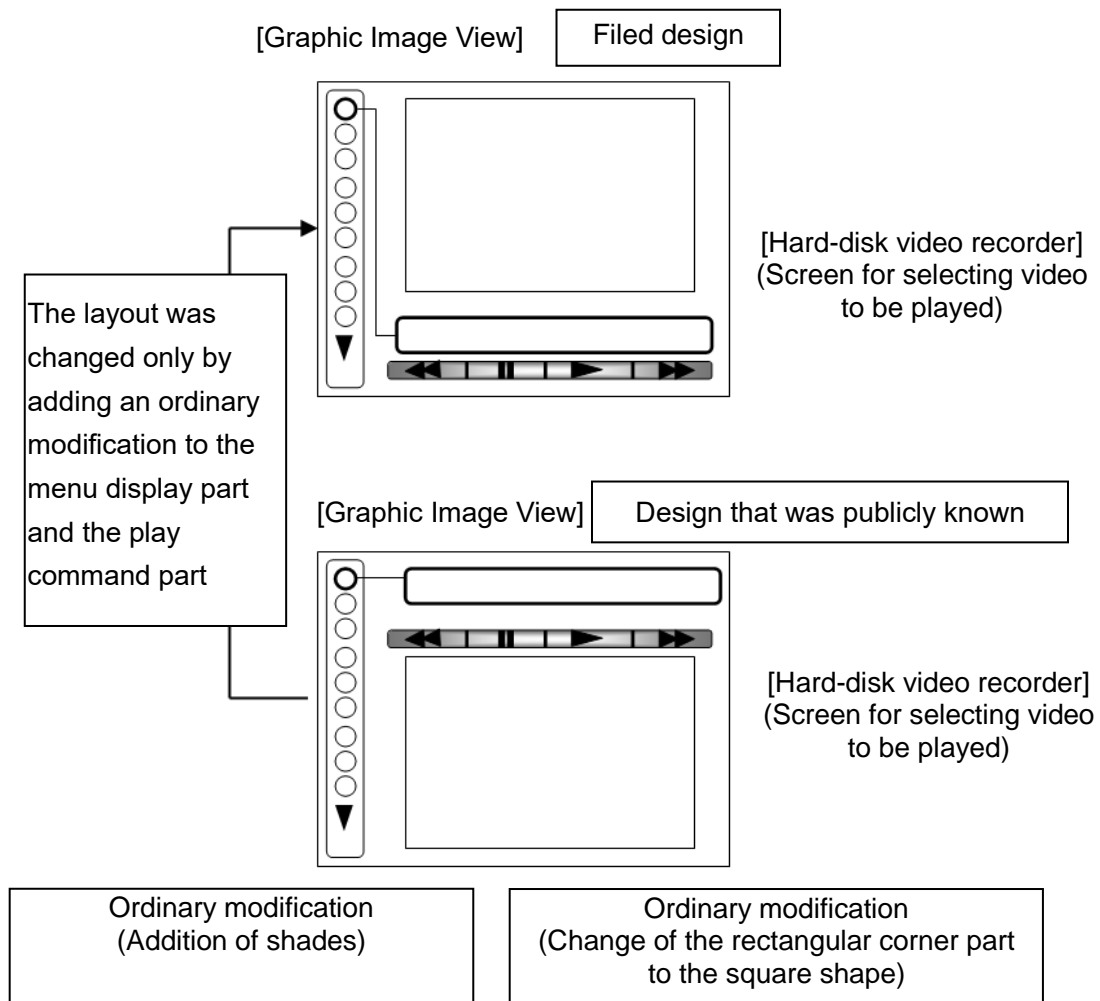


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

(iii) Design constituted by changing the layout

[Case example]

A design constituted only by changing the layout of a part of a graphic image on a screen by adding an ordinary modification.

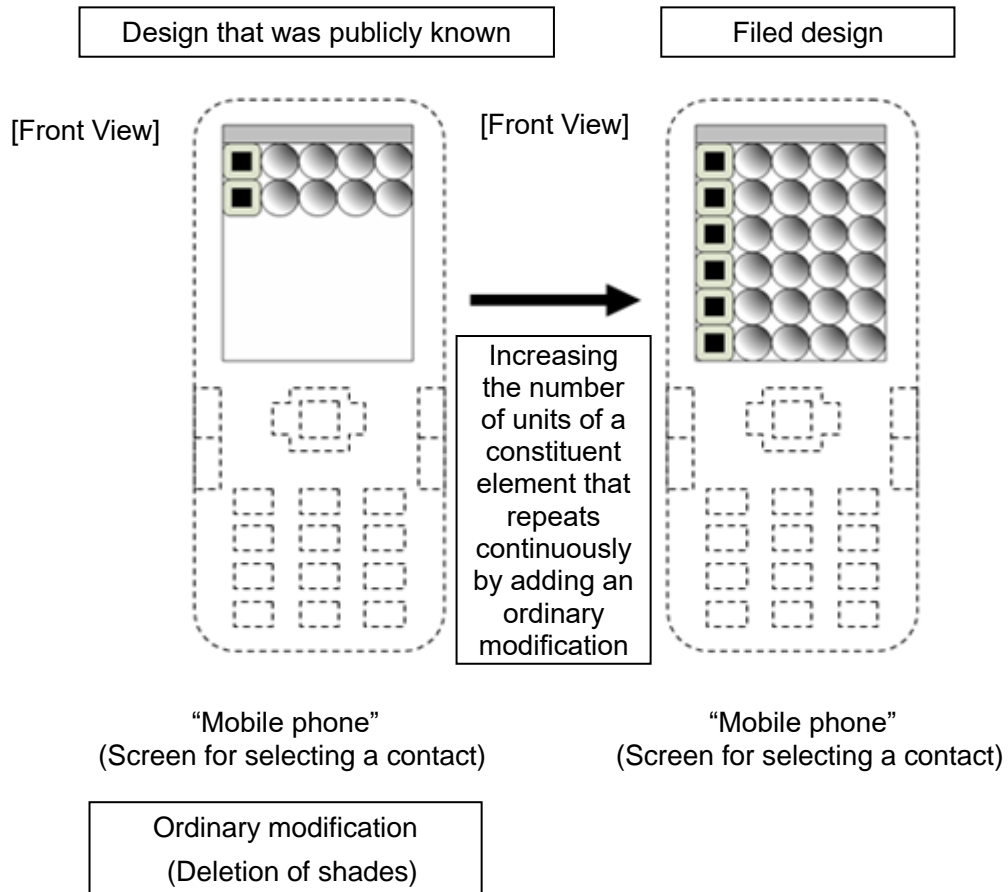


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

- (iv) Design constituted by changing the component ratio or by increasing or decreasing the number of units of a continuous constituent element

[Case example]

A design constituted merely by increasing the number of units of a constituent element of a design that was publicly known by adding an ordinary modification to a continuous constituent element.

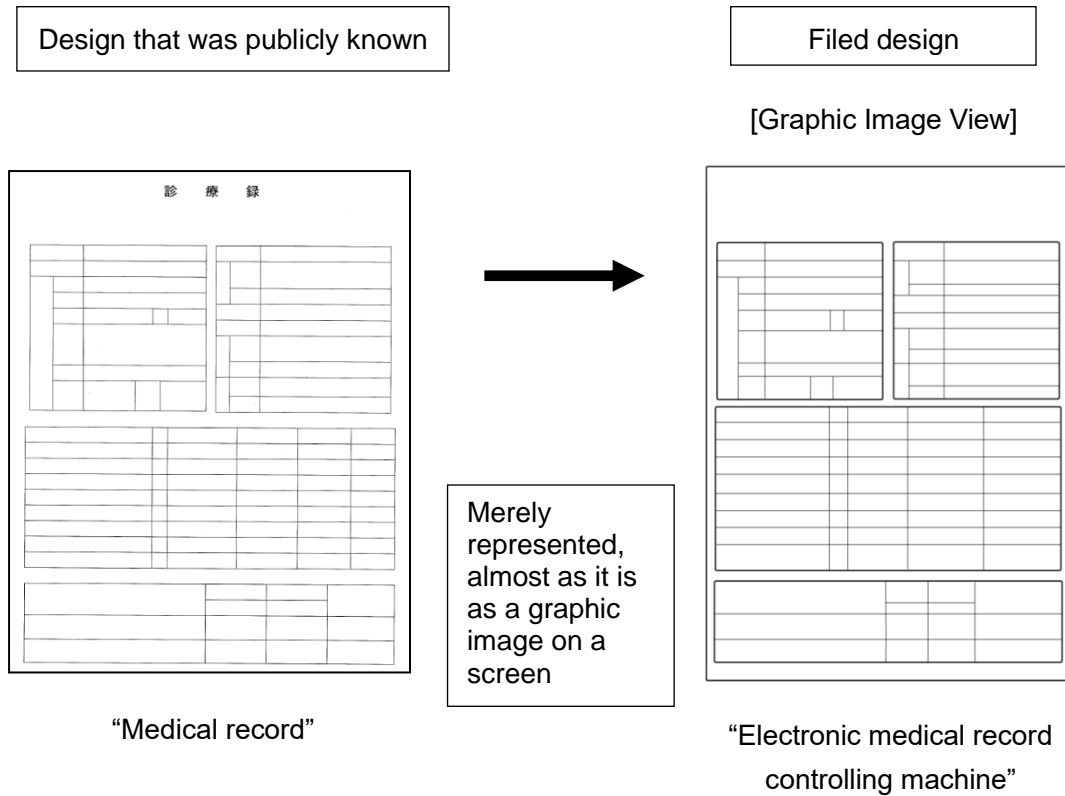


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

- (v) Design constituted by using or diverting a constituent element beyond the framework of the article

[Case example 1]

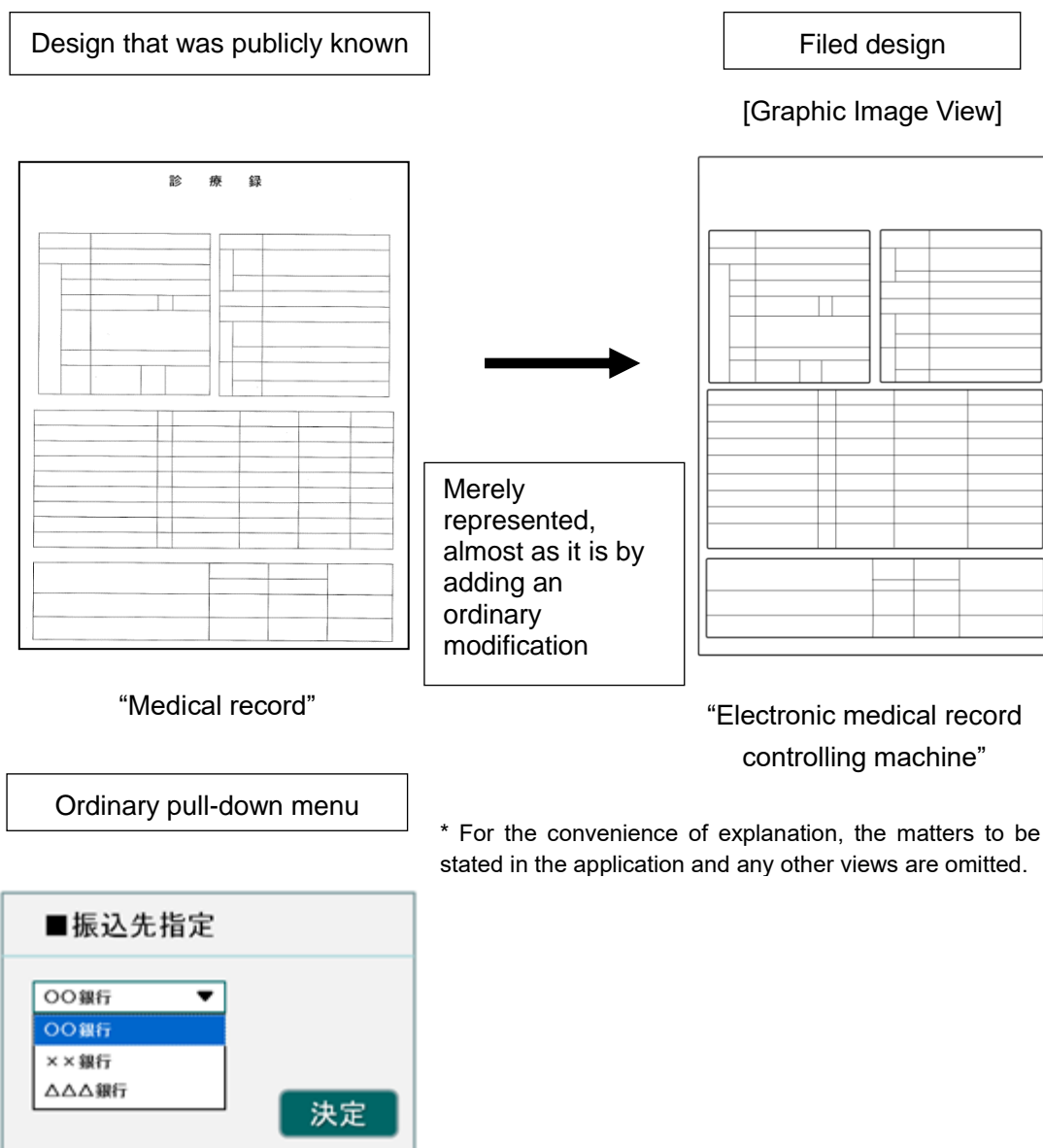
Design that merely represents the appearance of the article that was publicly known, almost as it is as a graphic image on a screen.



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

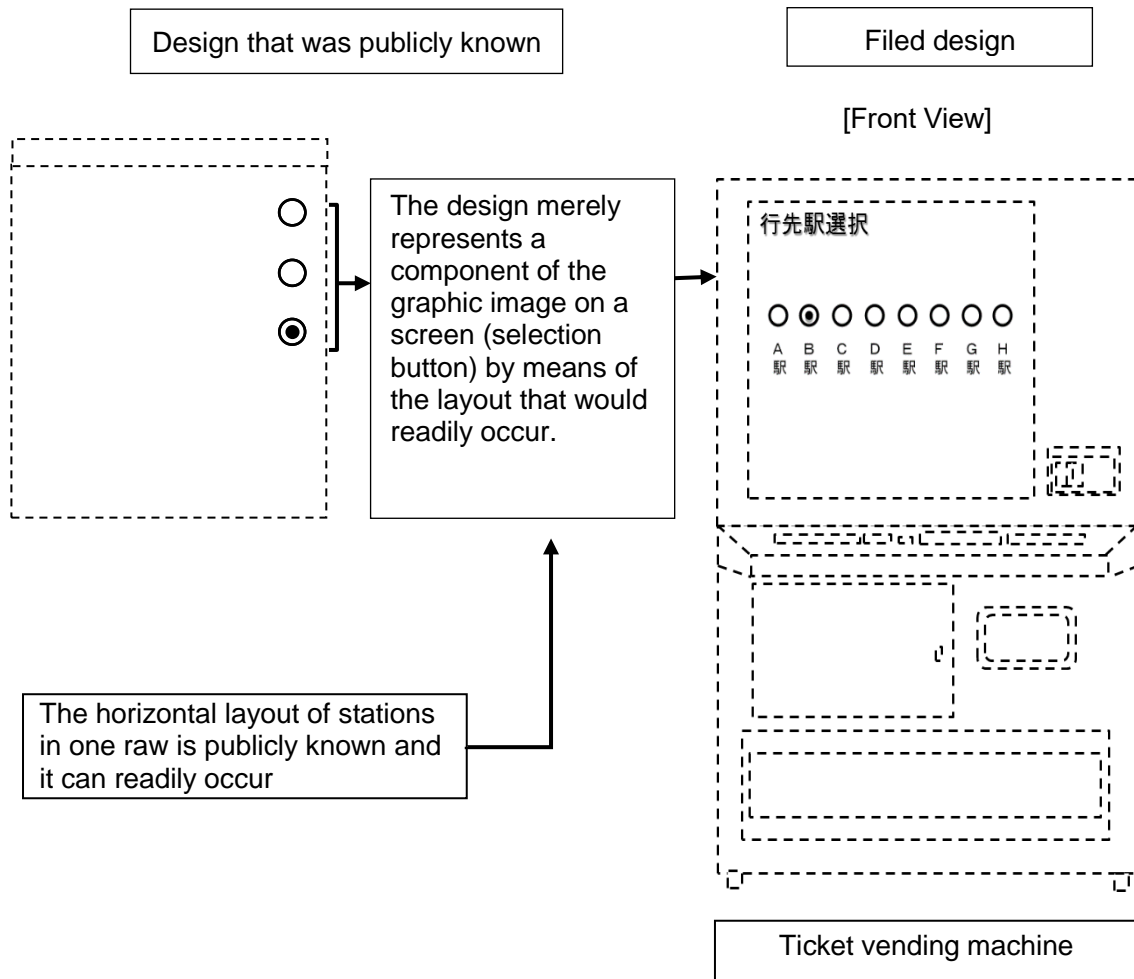
[Case example 2]

Design that merely represents the appearance of the article that was publicly known, almost as it is as a graphic image on a screen by adding an ordinary modification thereto.



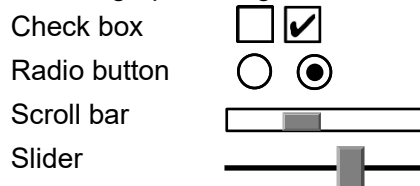
[Case example 3]

Design that merely represents a constituent element (component) of a graphic image on a screen that was publicly known, almost as it is by means of a layout that will readily occur (1).



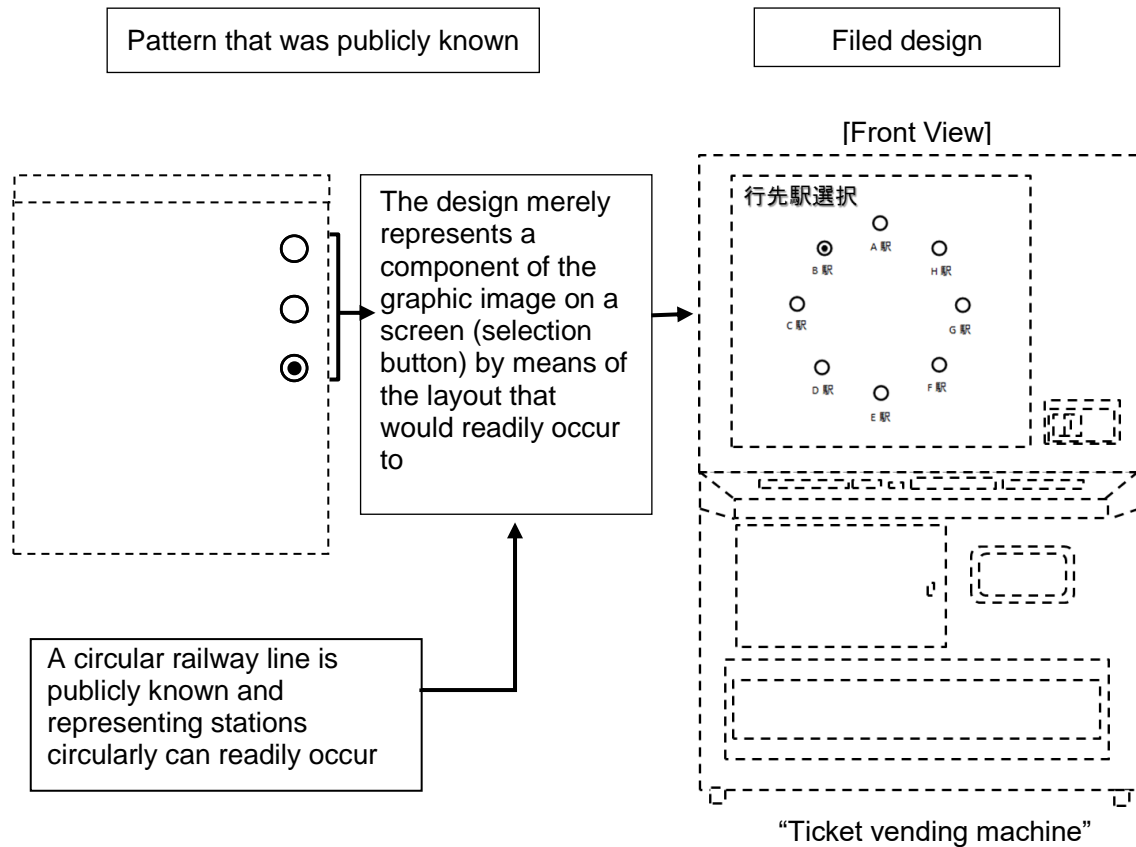
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Reference] Examples of components of graphic images on a screen



[Case example 4]

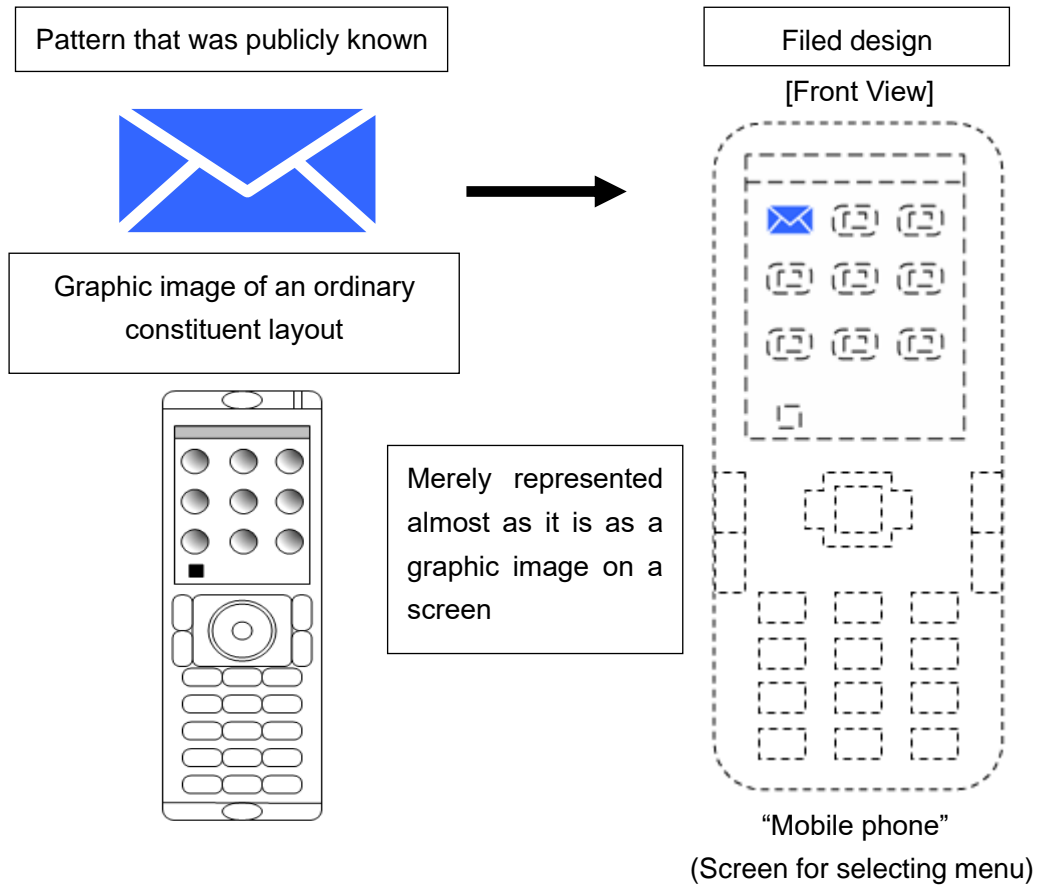
Design that merely represents a constituent element (component) of a graphic image on a screen that was publicly known, almost as it is by means of a layout that will readily occur. (2).



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 5]

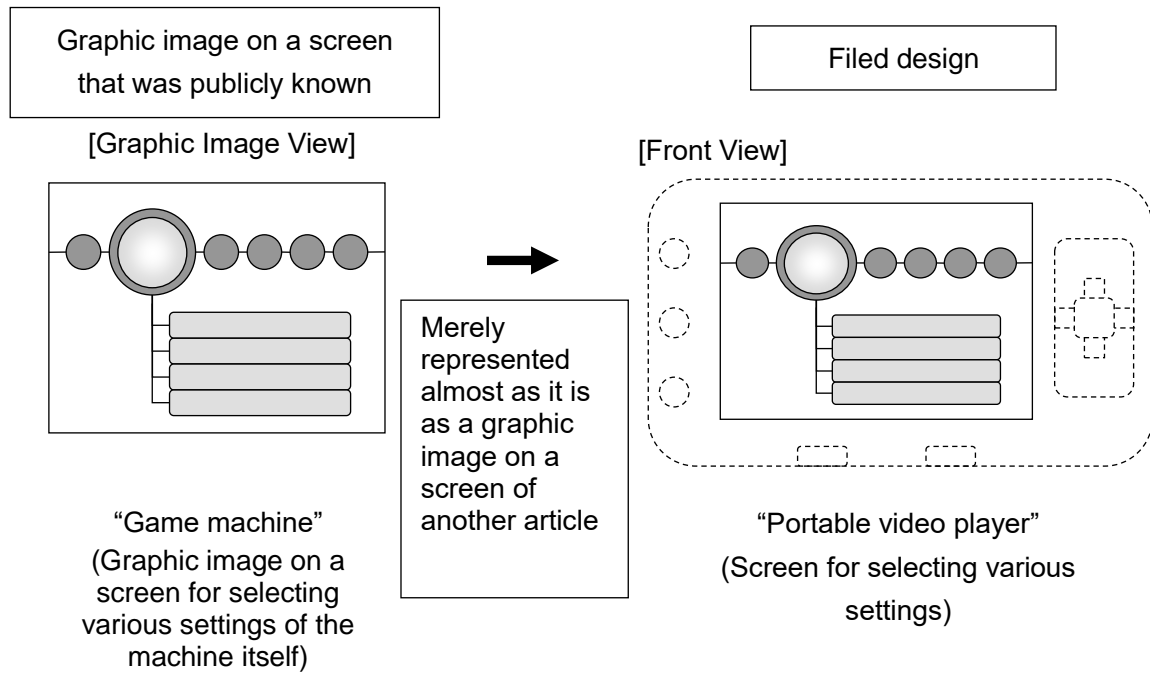
Design that merely represents a pattern that was publicly known, almost as it is.



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 6]

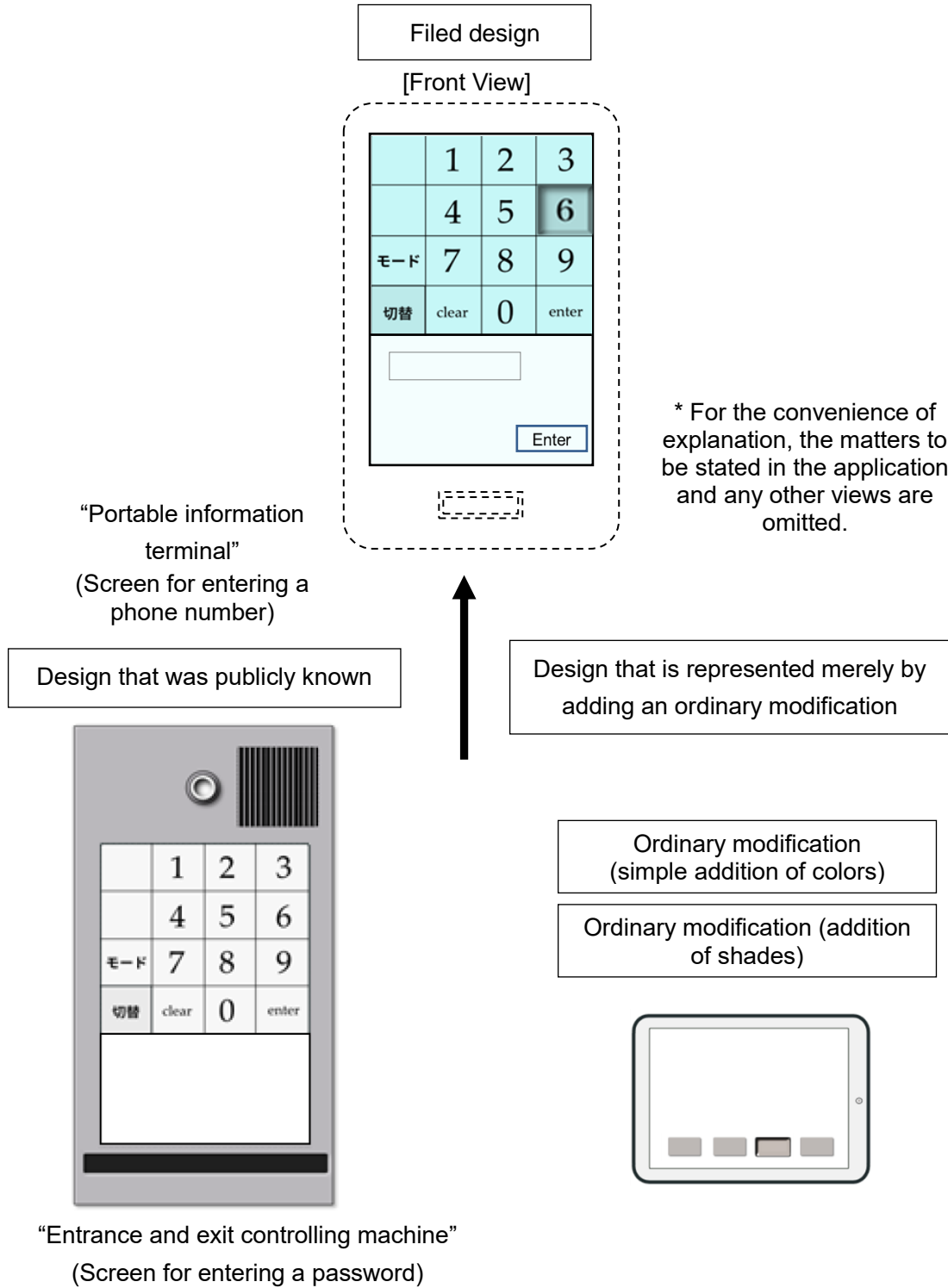
Design that merely represents a graphic image on a screen that was publicly known, almost as it is, as a graphic image on a screen of another article.



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 7]

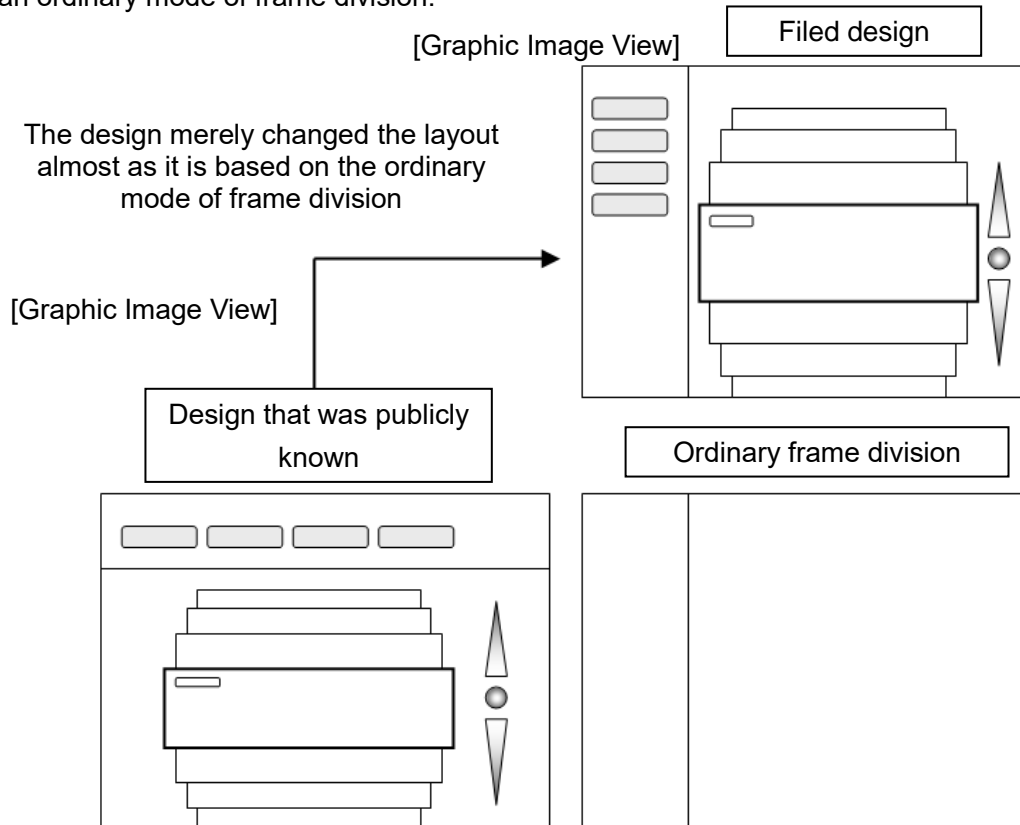
Design that merely represents a graphic image on a screen that was publicly known, almost as it is, as a graphic image on a screen of another article by adding an ordinary modification thereto.



(vi) Design that is constituted by changing the mode of frame division

[Case example]

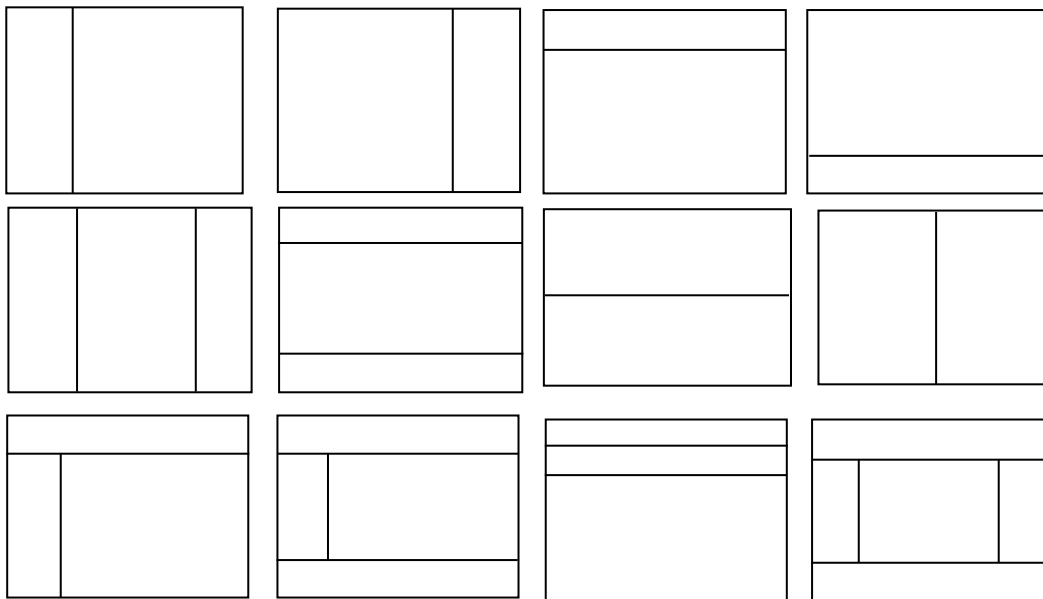
Design that is represented merely by changing the layout of a graphic image on a screen that was publicly known, almost as it is, based on the mode of frame division based on an ordinary mode of frame division.



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Reference]

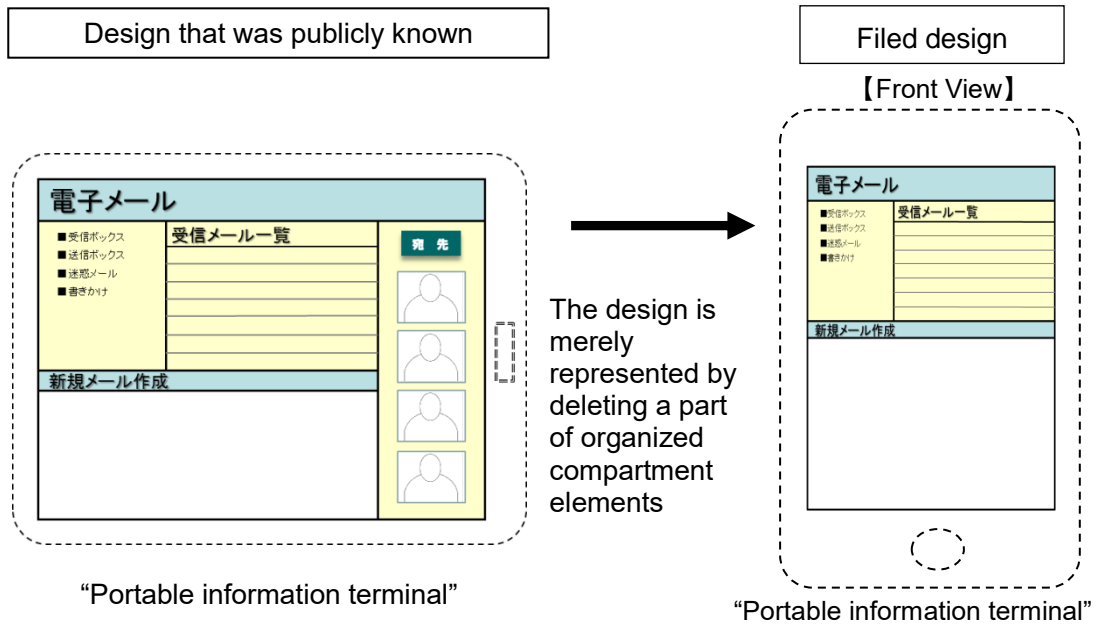
Examples of ordinary modes of frame division



(vii) Design that is constituted by deleting organized compartment elements

[Case example]

Design that merely represents a graphic image on a screen that was publicly known, almost as it is, by deleting a part of organized compartment elements

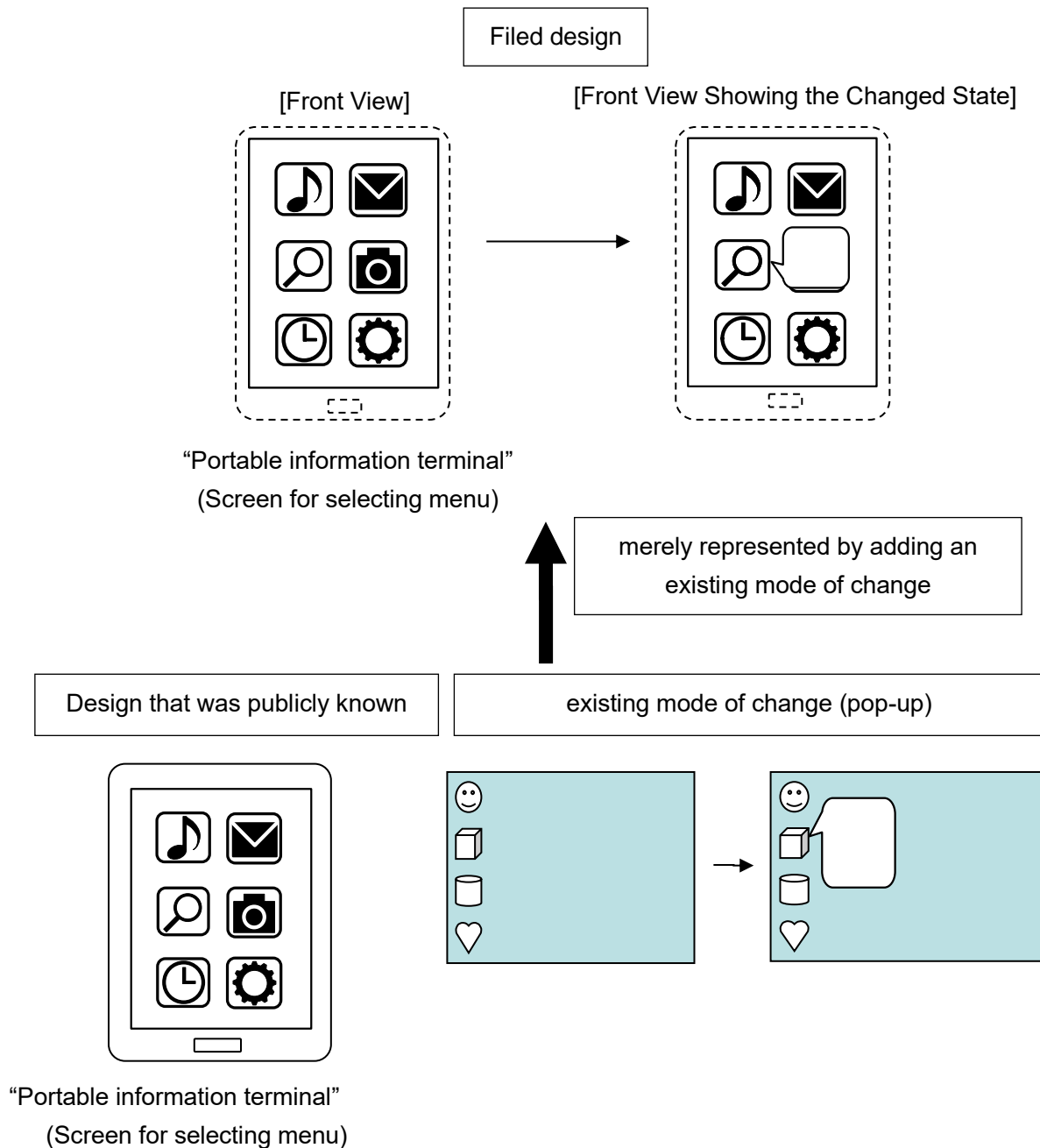


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

(viii) Design that is constituted by adding an existing mode of change

[Case example 1]

Design that is merely represented by adding an existing mode of change, almost as it is, to a graphic image on a screen that was publicly known.



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

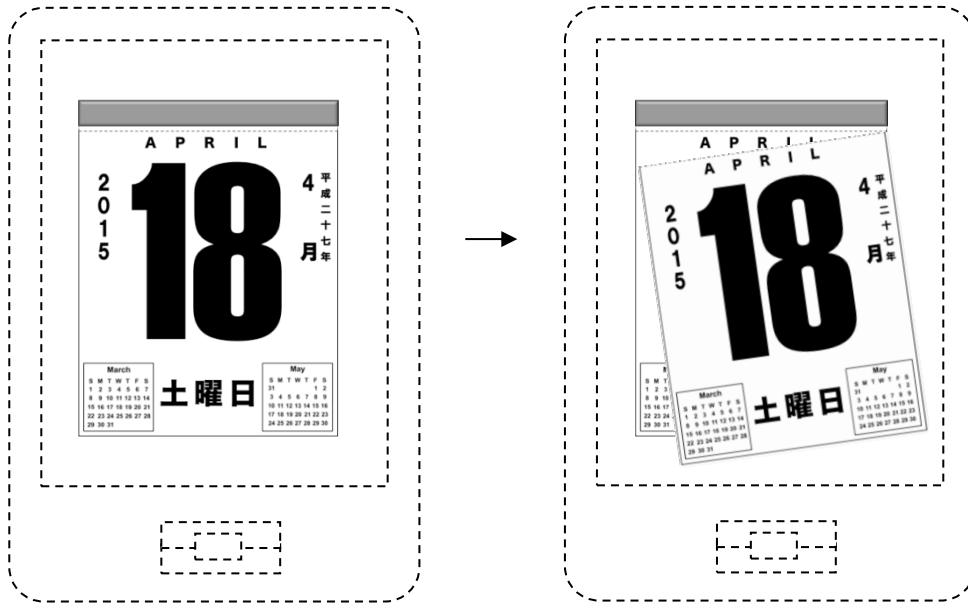
[Case example 2]

Design that is merely represented by adding an existing mode of change, almost as it is, to the appearance of a graphic image on a screen that was publicly known.

Filed design

[Front View]

[Front View Showing the Changed State]



“Portable information terminal”
(Screen for displaying the calendar)

* For the convenience of explanation,
the matters to be stated in the
application and any other views are
omitted.

The design merely represents an
existing mode of change by adding it,
almost as it is, as a graphic image on a
screen

Design that was publicly known



“Daily calendar”

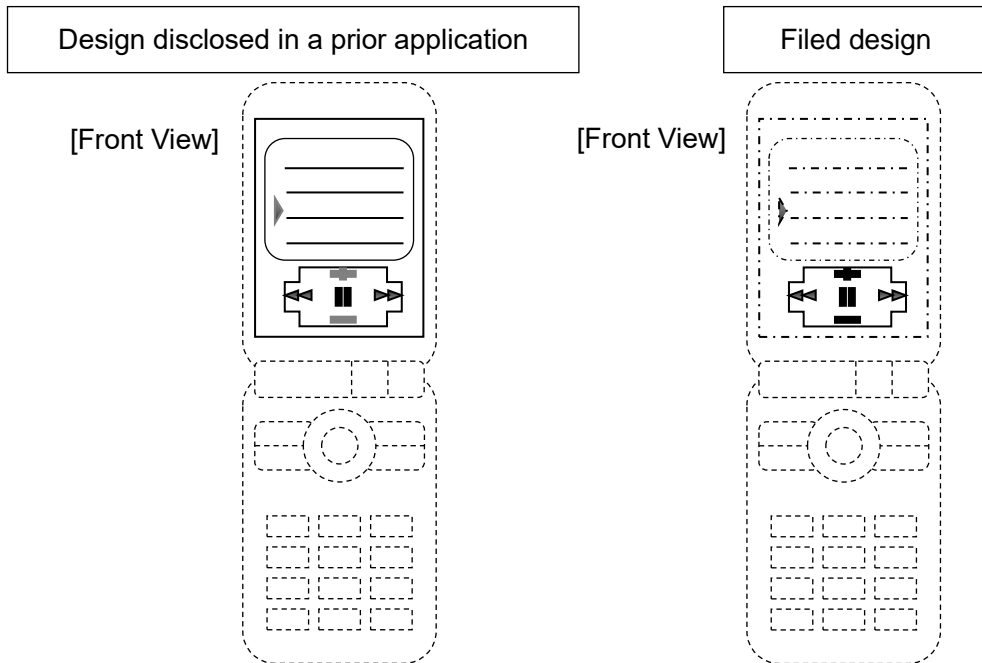
Meanwhile, where the graphic image on a screen before the change could have been easily created by a person skilled in the art based on shapes, patterns or colors, or any combination thereof that were publicly known prior to the filing of the application for design registration, but the mode of change is not a change based on an ordinary technique for a person skilled in the art, the filed design is not found to be a design that could have been easily created, and does not fall under the provision of Article 3(2) of the Design Act.

74.4.4 Design in a later application including a graphic image on a screen that is identical or similar to part of a design in a prior application including a graphic image

With regard to determination standards concerning a whole design, 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,” and with regard to those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.4.4.1 Determination of similarity between part of a design disclosed in a prior application and a partial design in a later application.”

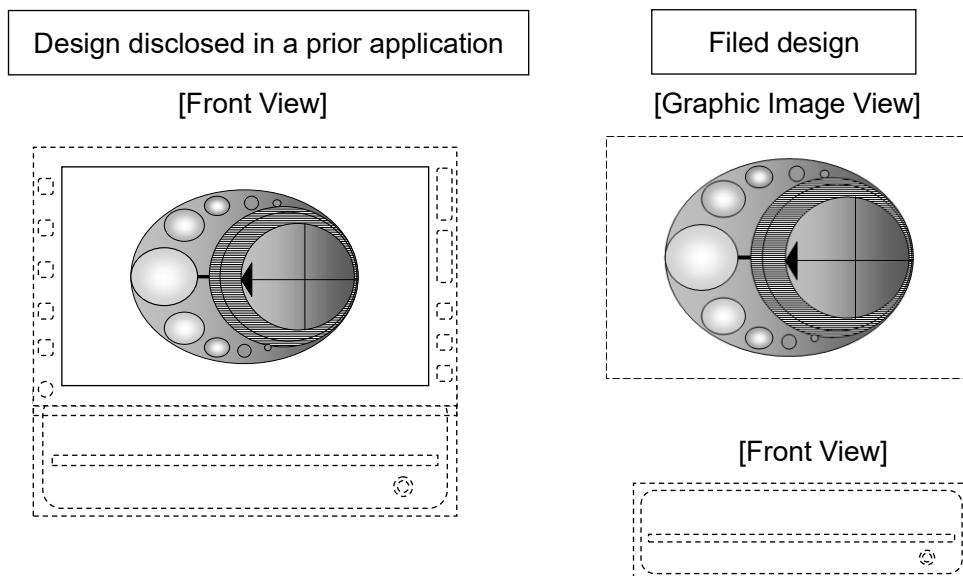
[Case examples where Article 3-2 of the Design Act is applied]

[Case example 1]



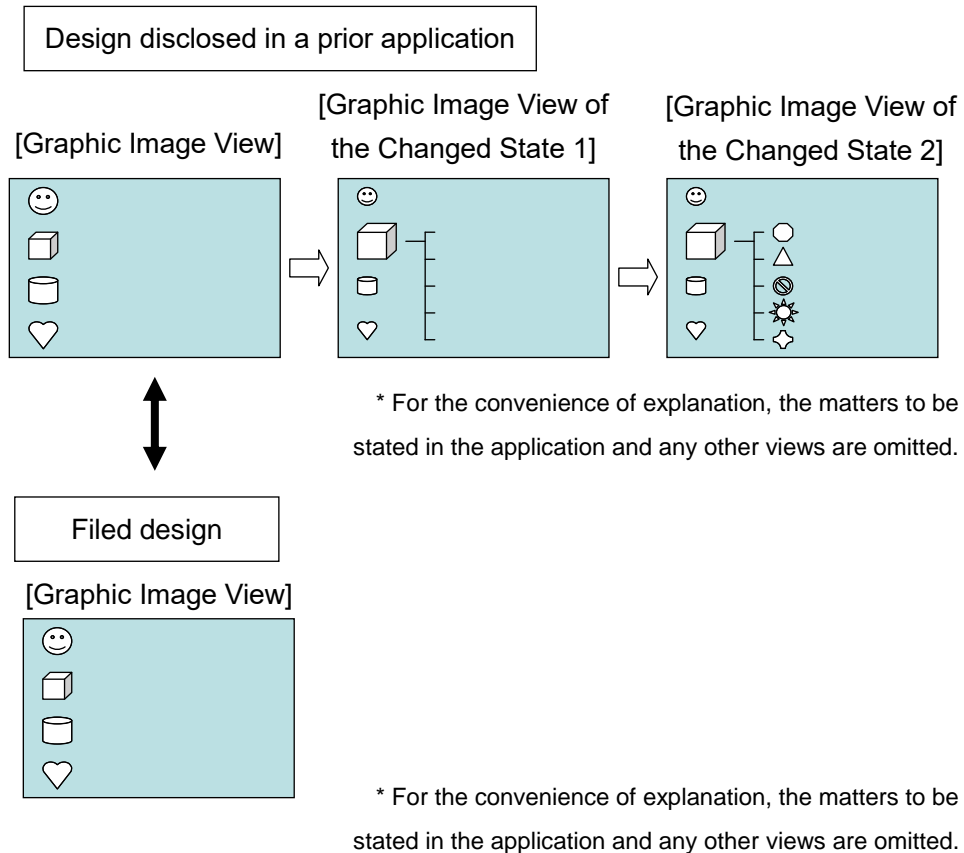
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 2]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Case example 3]



74.5 Exception to lack of novelty concerning an application for design registration for a design including a graphic image on a screen

With regard to the requirements, etc. for receiving application of the provision of Article 4(1) or (2) of the Design Act and any other determination standards concerning a whole design, see Part III “Exception to Lack of Novelty,” and with regard to those concerning a design 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.”

74.6 Provisions of Article 5 of the Design Act concerning an application for design registration for a design including a graphic image on a screen

A design which includes a graphic image on a screen containing another person’s trademark or a product sold by another person, etc. and which is liable to create confusion with an article pertaining to another person’s business is found to not comply with the requirement under Article 5(ii).

With regard to determination standards concerning a whole design, see Part IV “Unregistrable Designs,” and with regard to those concerning a design 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.”

74.7 One application per design concerning an application for design registration for a design including a graphic image on a screen

An application for design registration for a design including a graphic image on a screen must also comply with the requirements provided in Article 7 of the Design Act.

With regard to determination standards concerning a whole design, see Part V “One Application per Design,” and with regard to those concerning a design 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.”

74.7.1 Examples of cases that do not comply with the requirements provided in Article 7 of the Design Act

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

- (1) Where, in an application for design registration for a design including a graphic image on a screen, there is a statement that has added such words as “graphic image of ...” or “screen of ...” after a classification of articles in the column of “Article to the Design” of the application (for example, “graphic image of a video disc recorder”), such statement is not found to be a classification of articles listed in Appended Table 1 or a classification of articles equivalent in level to such classification.
- (2) Where, in an application for design registration for a design including a graphic image of a computer with additional functions, a statement in the column of “Article to the Design” of the application falls under any of the following, such statement is not found to be a classification of articles listed in Appended Table 1 or a classification of articles equivalent in level to such classification.
 - (a) The statement describes a comprehensive function as its additional function (e.g. “Computer with the data processing function)
 - (b) The statement describes an abstract function as its additional function (e.g. “Computer with the decision-making function,”

“Computer with the selection function”)

- (c) The statement does not represent one specific additional function (e.g. “Computer with the mobile information terminal function,” “Computer with the information processing function”)

74.7.1.2 Examples of applications that are not filed for each design

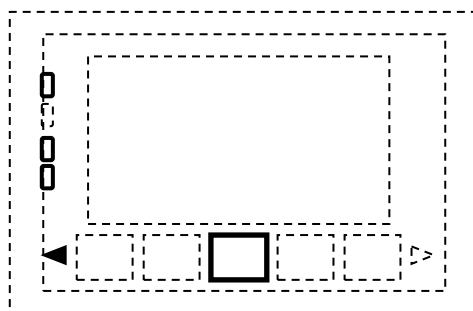
Where two or more different graphic images on a screen or two or more physically separate “parts for which the design registration is requested” are included in the article to the design of one partial design, the application for design registration is not found to be filed for each design.

- (1) Where two or more different additional functions are stated in the column of “Article to the Design” of an application for design registration, the application for design registration is not found to be filed for each design. However, it does not apply where the two or more additional functions are displayed in a graphic image which is displayed simultaneously or used in an integrated manner.
- (2) Where two or more different graphic images on a screen or two or more physically separate “parts for which the design registration is requested” are included in the article to the design of one partial design, the application for design registration is not found to be filed for each design.

[Case example]

Application for design registration for a partial design

[Graphic Image View]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

Where subject matter falls under any of the following, it is treated as one design even if it includes two or more physically separate “parts for which the design registration is requested.”

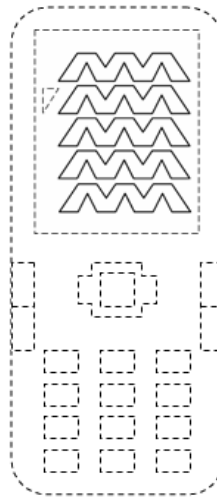
(i) Where unity in form is found

Unity in form is found for two or more physically separate “parts for which the design registration is requested” if they have been created with relevance to each other, such as forms in mirror images or forms that constitute a set.

[Case example]

Application for design registration for a partial design

[Front View]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

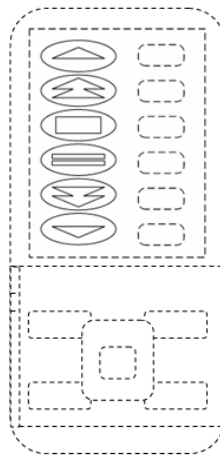
(ii) Where unity in functions is found

Unity in functions is found for two or more physically separate “parts for which the design registration is requested” if they have been created in an integrated manner because they perform one function as a whole.

[Case example]

Application for design registration for a partial design

[Front View]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

74.7.1.3 Where the graphic image on a screen changes in a design including a graphic image

In a design including a graphic image on a screen, because a graphic image is a form of a part of an article, one graphic image is represented in one design, in principle. Accordingly, where plural graphic images are represented in one application, it is regarded that one application contains multiple “designs including a graphic image” and is not found to be an application for design registration filed for each design as provided in Article 7 of the Design Act.

However, where it can be found from the contents of the statement in the application and drawing, etc. attached to the application, such as the description of the article to the design, that the plural graphic images on a screen are graphic images for making necessary indications for performing the same function of the article or graphic images that are provided for use in the operation carried out in order to enable the article to perform the same function (hereinafter referred to as “graphic images for the same function of the article”), and that they have relevance in form, the subject matter in the state of including such plural graphic images can be found to be one design.

For example, where the state in which graphic images on a screen switch continuously is represented by using multiple figures as the design for which design registration is requested (including the case where it is found that the graphic images are intended to show the so-called animation effect), among such plural graphic images, graphic images for the same function of the article which have relevance in form could be regarded as figures showing the state before and after the change and could be treated as one design.

74.7.1.4 Where plural graphic images on a screen are found to be one design

In a design including plural graphic images, if the graphic image on a screen before the change and the graphic image after the change are found to be graphic images for the same function of the article, and the graphic image before the change and the graphic image after the change are found to have relevance in form, the subject matter in the state of including such plural graphic images can be found to be one design.

74.7.1.4.1 Graphic images for the same function of the article

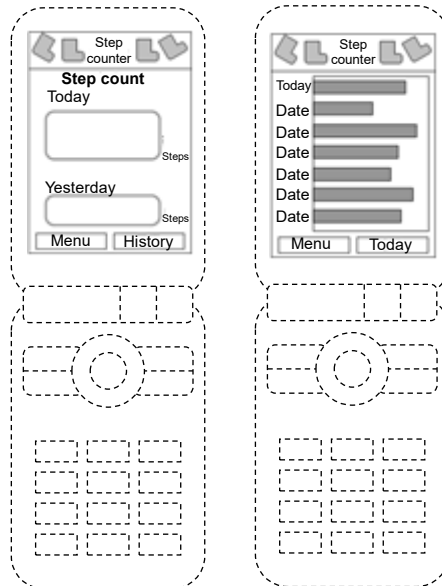
In order for the subject matter in the state of including plural

graphic images on a screen to be found to be one design, it must be found from the contents of the statement in the application and drawing, etc. attached to the application, such as the description of the article to the design, that the plural graphic images are graphic images for making necessary indications for performing the same function of the article or graphic images that are provided for use in the operation carried out in order to enable the article to perform the same function.

[Example of a case where plural graphic images on a screen are found to be one design 1]

[Front View]

[Front View Showing the Changed State]



Both are graphic images for the step count indication function.

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The article is a mobile phone having step count measurement and indication functions. By selecting the history button in the front view, a past step count record can be displayed in a graph. The graphic images on a screen represented in the front view and the front view showing the changed state are graphic images for the step count indication function.

(Note) In this case example, relevance in form can be found in the figures, etc. represented at the top part and the bottom part.

Where continuation of operation is found, such as where it is necessary to give a series of multiple input instructions (selection instructions) for enabling the article to perform one of its functions, the series of graphic images on a screen that continuously change in correspondence to such input instructions (selection instructions) are found to be graphic images for the same function of the article.

For example, as in the case of the money transfer function of an

automatic machine for cash payment of a bank, the graphic images on a screen ranging from the corresponding icon on the initial menu screen, to those for selecting the bank, entering the transfer destination, entering the transfer amount, to making the transfer are found to be graphic images for the same function of the article, either as individual graphic images or as a transition screen for the entire money transfer functions including all of these graphic images.

[Example of a case where plural graphic images on a screen are found to be one design 2]

[Enlarged View of the Display Part]



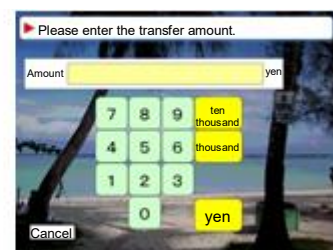
[Enlarged View of the Display Part Showing the State after the Change 1]



[Enlarged View of the Display Part Showing the State after the Change 2]



[Enlarged View of the Display Part Showing the State after the Change 3]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Automatic machine for cash payment

[Description of Article to the Design] (Omitted) The graphic image displayed on the display part is used for setting the transfer destination and inputting the transfer amount for the money transfer function.

(Note) In this case example, relevance in form can be found in the background, etc.

74.7.1.4.2 Relevance in form can be found

In order for the subject matter in the state of including plural graphic images on a screen to be found to be one design, relevance in form based on commonality in figures, etc. must be found in the graphic images before and after the change.

In the case of a design including three or more graphic images on a screen, determination on the presence or absence of relevance in form is made for the graphic images immediate before and immediately after the change.

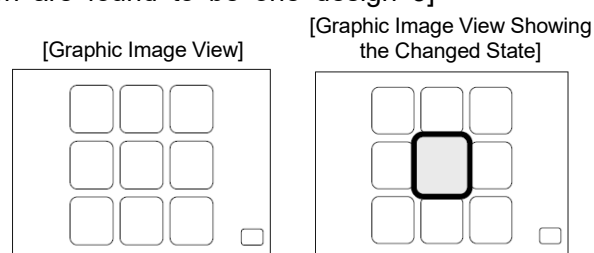
With regard to an application for design registration adopting a part of a graphic image on a screen as the part for which the design registration is requested, relevance in form based on commonality in figures, etc. must be found in the graphic images before and after the change in relation to the part for which the design registration is requested.

74.7.1.4.2.1 Typical examples of cases where relevance in form is found

(a) Movement, etc. of a figure, etc.

Where a figure, etc. continuously moves, expands, shrinks, rotates or changes in color within the graphic image on a screen, while hardly changing its own shape

[Example of a case where plural graphic images on a screen are found to be one design 3]

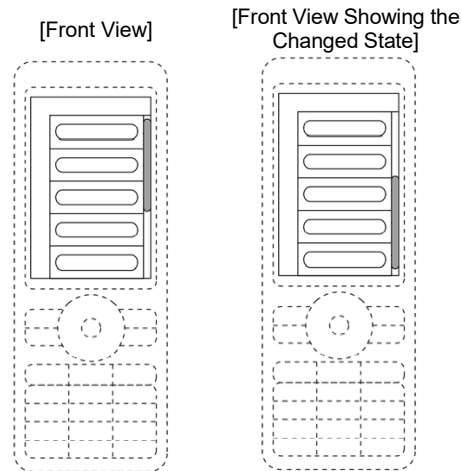


* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Access management device

[Description of the Design] (Omitted) The graphic image view showing the changed state shows the state where the shape of the designated icon has changed.

[Example of a case where plural graphic images on a screen are found to be one design 4]



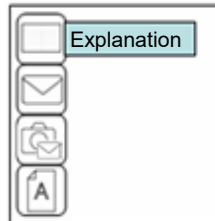
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

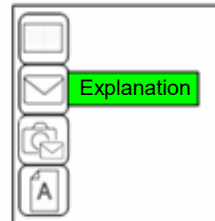
[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the front view and the front view showing the changed state are graphic images for the operation to select the call destination from the address book for enabling the performance of the function to make phone calls. The scroll bar part at the right end of the graphic image part moves up and down.

[Example of a case where plural graphic images on a screen are found to be one design 5]

[Enlarged View of
the Display Part]



[Enlarged View of the
Display Part Showing the
State after the Change]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

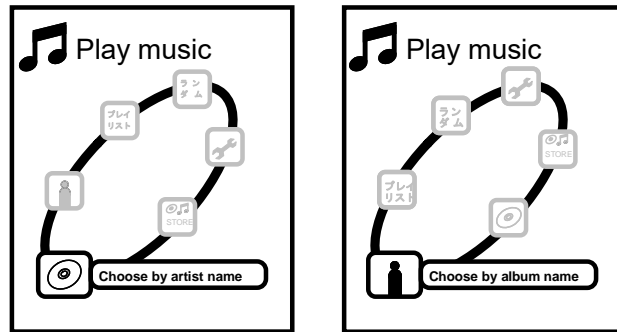
[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the enlarged view of the display part and the enlarged view of the displayed part showing the state after the change can be used for enabling the performance of the email function of the mobile phone. As shown in the enlarged view of the display part and the enlarged view of the displayed part showing the state after the change, when each figure, etc. for operation is designated, the explanation for said figure, etc. for operation also moves in conjunction.

[Example of a case where plural graphic images on a screen are found to be one design 6]

[Enlarged View of the
Display Part]

[Enlarged View of the
Display Part Showing
the State after the
Change]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone with a music player

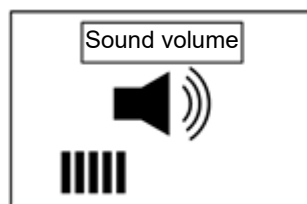
[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the enlarged view of the display part and the enlarged view of the display part showing the state after the change are used for selecting the information based on which music should start to play for enabling the performance of the music playing function of the mobile phone. As shown in the enlarged view of the display part and the enlarged view of the display part showing the state after the change, when each figure, etc. for operation is designated, the explanation for said figure, etc. for operation also changes in conjunction.

(b) Increase or decrease of the same figure, etc.

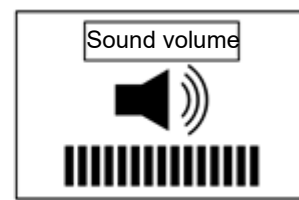
Where the same figure, etc. increases or decreases (appears, disappears) continuously within the graphic image on a screen

[Example of a case where plural graphic images on a screen are found to be one design 7]

[Enlarged View of the
Display Part]



[Enlarged View of the
Display Part Showing the
State after the Change]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Music player

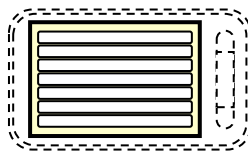
[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the enlarged view of the display part and the enlarged view of the display part after the change are used for controlling the sound volume. The level gauge changes in conjunction with the operation of the sound control dial, and the current sound volume level is indicated.

(c) Change of the layout within the graphic image on a screen

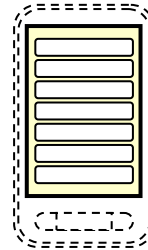
Where the direction or the aspect ratio of the arrangement of figures, etc. changes according to the status of use of the device; where the figures, etc. change their arrangement within the graphic image on a screen, while hardly changing their own shapes

[Example of a case where plural graphic images on a screen are found to be one design 8]

[Front View]



[Front View Showing the State after the Change]



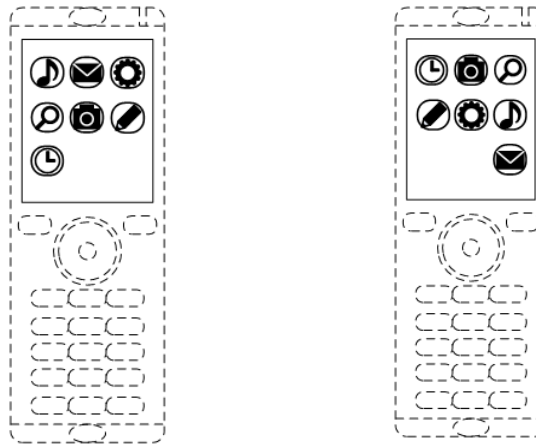
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile information terminal

[Description of Article to the Design] (Omitted) The graphic image on a screen represented in the front view is the menu screen for selecting a specific function from among the multiple functions of the article. When the article is rotated 90 degrees, the layout of the icons is changed in the direction corresponding to the direction of the article, as shown in the graphic image represented in the front view showing the state after the change.

[Example of a case where plural graphic images on a screen are found to be one design 9]

[Front View] [Front View Showing the State after the Change]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The graphic image on a screen represented in the front view is the menu screen for selecting a specific function from among the multiple functions of the article. The layout of the icons can be changed as shown in the front view showing the state after the change.

- (d) Gradual change of the graphic image on a screen or figure, etc. itself

Where a new graphic image gradually appears on a screen while a part of the graphic image before the transition still remains, and the transition to the new graphic image eventually completes; where the form of the figure, etc. differs at the beginning and the end of the change, but by disclosing the graphic image in the midst of the change, the figure, etc. is found to change gradually

[Example of a case where plural graphic images on a screen are found to be one design 10]

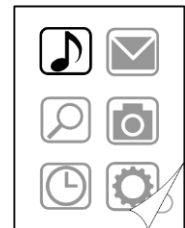
[Enlarged View of the
Display Part]



[Enlarged View of
the Display Part 2]



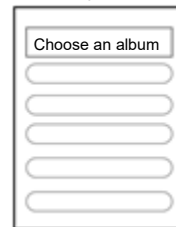
[Enlarged View of
the Display Part 3]



[Enlarged View of the
Display Part 4]



[Enlarged View of the
Display Part 5]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile information terminal

[Description of Article to the Design] (Omitted) The graphic image displayed on the display part is the menu screen for selecting a specific function from among the multiple functions of the article. The graphic image represented in the enlarged view of the display part 5 is a graphic image for the music playing function used in the operation to select the album to be played. The enlarged view of the display part 2

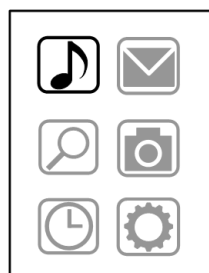
to the enlarged view of the display part 5 represents the change in the graphic images when having selected the icon for playing music from the menu screen represented in the display part; the album selection screen appears as if turning a page from the bottom right of the menu screen.

(e) Continuous use of a common motif

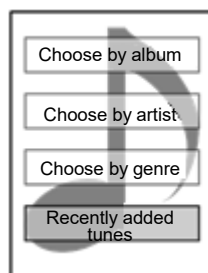
Where a common motif comprised of the same figure, etc. is continuously used in the header part or the background of the graphic image on a screen

[Example of a case where plural graphic images on a screen are found to be one design 11]

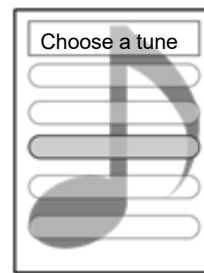
[Enlarged View of
the Display Part]



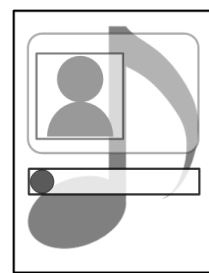
[Enlarged View
of the Display
Part 2]



[Enlarged View
of the Display
Part 3]



[Enlarged View
of the Display
Part 4]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The graphic image displayed on the display part is the menu screen for selecting a specific function from among the multiple functions of the article. By selecting an icon within the graphic image of the display part, the graphic image makes a transition to a graphic image for the music playing function, and the operation for selecting the music to be played is carried out in order. The enlarged view of the display part 4 is a graphic image representing the status of progress of the playing of the selected music.

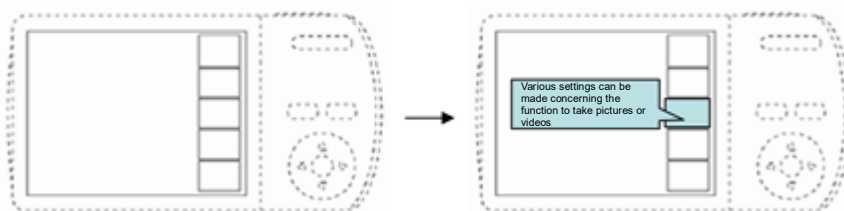
The motif of a musical note is in common, and relevance in form can be found. Also, the change from the graphic image on a screen for operation to the graphic image for making necessary indications for performing the function of the article can be found to be one design.

(f) Development of an additional figure, etc.

Where a new figure, etc. appears within or disappears from the graphic image on a screen in conjunction with the operation (for example, development of a pull-down menu, sub-menu or sub-window, or appearance or disappearance of a pop-up indication in relation to an icon, etc.)

[Example of a case where plural graphic images on a screen are found to be one design 12]

[Front View] [Front View Showing the State after the Change]



* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile information terminal

[Description of Article to the Design] (Omitted) The graphic image on a screen represented in the front view is used in the operation to start up or set up the camera for the function to take pictures or videos. As shown in the front view showing the state after the change, when a certain time period passes while in a state of designating a figure, etc. for operation, an explanation in a speech balloon is displayed with regard to the contents that can be set by the figure, etc. for operation.

74.7.1.5 Where plural graphic images on a screen are not found to be one design

With regard to plural graphic images on a screen for different

functions of the article or plural graphic images that are found to have no relevance in form, the subject matter in the state of including such plural graphic images cannot be found to be one design.

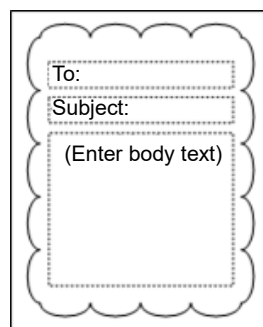
A design including plural graphic images on a screen that are not found to be one design is found not to comply with the requirement under Article 7 of the Design Act. Among views representing graphic images that are not found to be one design, those that can be used to help in understanding the design may be used as reference views.

74.7.1.5.1 Plural graphic images on a screen for different functions of the article

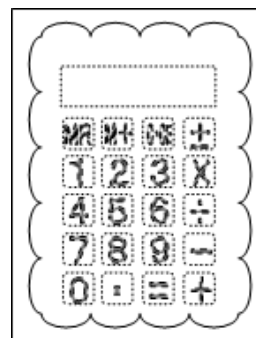
A design including plural graphic images on a screen for different functions of the article cannot be found to be one design.

[Example of a case where plural graphic images on a screen are not found to be one design since they are for different functions 1]

[Enlarged View of the Display
Part]



[Enlarged View of the Display Part
Showing the State after the Change]



While the graphic image on a screen showing the state before the change is a graphic image for the email function, the graphic image showing the state after the change is a graphic image for the calculator function, and they are not found to be graphic images for the same function of the article.

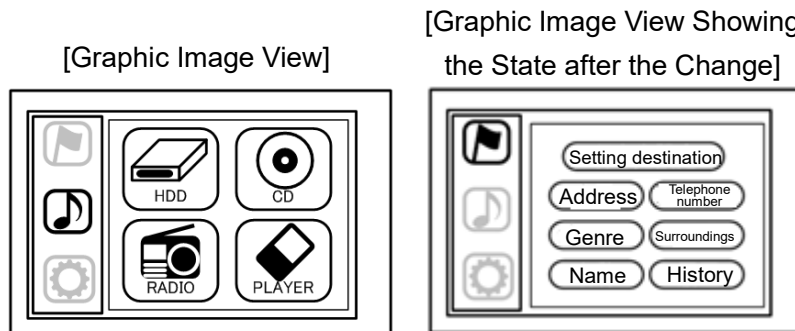
* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The graphic image displayed on the display part is used for the input operation for writing emails. The

graphic image represented in the enlarged view of the display part showing the state after the change is a graphic image used for the calculator function, and calculation is carried out by selecting buttons.

[Example of a case where plural graphic images on a screen are not found to be one design since they are for different functions 2]



While the graphic image on a screen showing the state before the change is a graphic image for the music playing function, the graphic image showing the state after the change is a graphic image for the route guidance function, and they are not found to be graphic images for the same function of the article.

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

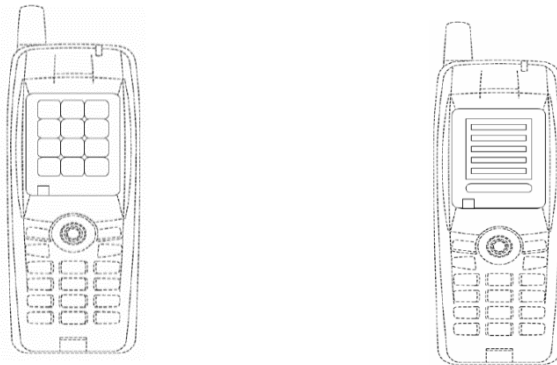
[Article to the Design] Route guidance indicator

[Description of Article to the Design] (Omitted) The graphic image on a screen represented in the graphic image view is for the operation to select the sound source of the music to be played. By selecting the flag icon in the menu part at the left, the graphic image changes to a graphic image for setting the destination for route guidance, as in the graphic image showing the state after the change.

74.7.1.5.2 Plural graphic images on a screen that have no relevance in form

Where the graphic images on a screen before and after the change are not coordinated, such as where the figures, etc. in the graphic images before and after the change have no commonality (or have a very minor commonality), relevance in form is not found, and the graphic images are not found to be one design.

[Example of a case where plural graphic images on a screen are not found to be one design since there is no relevance in form 1]



[Front View] [Front View Showing the State after the Change]

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

[Article to the Design] Mobile phone

[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the front view and the front view showing the state after the change are used in the operation to select the method for selecting the call designation. By pressing the lowermost button in the right-hand row in the front view, the graphic image changes into a list display, as shown in the front view showing the state after the change.

* The front view showing the state after the change may continue to be used as a reference view.

[Example of a case where plural graphic images on a screen are not found to be one design since there is no relevance in form 2]

[Partial Enlarged View of the Display Part]

Basic settings	Useful functions	Number of copies
Monochrome/Color	Magnification	Paper selection
Monochrome	100%	Automatic
Full color	Automatic	Tray 1 A4
Copy density	141% A4→A2	Tray 2 A3
	70% A3→A4	Manual feed
	Other magnification	

[Partial Enlarged View of the Display Part Showing the Changed State]

Basic settings	Useful functions	Number of copies
Settings	Number of copies	
Monochrome	100%	
Magnification	A4 Tray 1	
Paper	One side	
Copy density	Normal	
	Clear	
	Copies	

* For the convenience of explanation, the matters to be stated in the application and any other views are omitted.

With regard to the part for which the design registration is requested, the graphic images on a screen before and after the change have no common elements and lack coordination, and are found to have no relevance in form.

[Article to the Design] Copying machine

[Description of Article to the Design] (Omitted) The graphic images on a screen represented in the front view, the partial enlarged view of the display part, and the partial enlarged view of the display part showing the changed state are for carrying out various settings for the copying.

74.8 Design for a set of articles including a graphic image on a screen

A design for a set of articles including a graphic image on a screen becomes subject to protection only when it is filed as a whole design.

With regard to determination standards concerning a whole design, see Part VII “Individual Applications for Design Registration,” Chapter II “Design for a Set of Articles,” and with regard to those concerning a design for a partial design, 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.”

74.9 Provisions of Articles 9 and 10 of the Design Act concerning an application for design registration for a design including a graphic image on a screen

With regard to determination standards concerning a whole design, see Part VI “Prior Application” and Part VII “Individual Applications for Design Registration,” Chapter III “Related Design,” and with regard to those concerning a design 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.”

Meanwhile, the determination of similarity between a still graphic image on a screen and a graphic image that changes and the determination of similarity between two or more graphic images that change are made by comprehensively observing the graphic images including the modes of the graphic images that change before and after the change.

74.10 Change of the gist concerning an application for design registration for a design including a graphic image on a screen

With regard to determination standards concerning a whole design, see Part VIII “Amendment of Statement in the Application/Drawings, etc.,” Chapter II “Dismissal of Amendments,” and with regard to those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.10 “Change of the gist concerning an application for design registration for a partial design.”

74.11 Division concerning a design including a graphic image on a screen

With regard to determination standards concerning a whole design, see Part IX “Special Application for Design Registration,” Chapter I “Division of Applications for Design Registration,” and with regard to those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.11 “Division concerning an application for design registration for a partial design.”

74.12 Conversion of a patent application or an application for utility model registration into an application for design registration for a design including a graphic image on a screen

With regard to determination standards concerning a whole design, see Part IX “Special Application for Design Registration,” Chapter II “Conversion of Application,” and with regard to those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.12 “Conversion of a patent application or an application for utility model registration into an application for design registration for a partial design.”

74.13 Application for design registration for a design including a graphic image on a screen containing a priority claim under the Paris Convention, etc.

With regard to determination standards concerning a whole design, see Part X “Procedure for Priority Claim under the Paris Convention, etc.,” and with regard to

those concerning a design for a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.13 “Application for design registration for a partial design containing a priority claim under the Paris Convention, etc.”

Part VIII Amendment of Statement in the Application/Drawings, etc.

Chapter I Amendment

81 Relevant provisions

Design Act

Article 60-24 A person undertaking a procedure with regard to an application for design registration, a request or any other procedures relating to design registration, may make amendments only while the case is pending in examination, trial or retrial.

Article 68

(Paragraphs (1) and (3) onward omitted)

(2) Article 6 to 9, 11 to 16, 17(3) and 17(4), 18 to 24 and 194 (Procedures) of the Patent Act shall apply mutatis mutandis to an application for design registration, a request, or any other procedures relating to design registration. In this case, the term "trial against an examiner's decision of refusal" in Article 9 of the Patent Act shall be deemed to be replaced with "trial against an examiner's decision of refusal or trial against examiner's ruling dismissing an amendment" and the term "trial against an examiner's decision of refusal" in Article 14 of the Patent Act shall be deemed to be replaced with " trial against an examiner's decision of refusal or trial against examiner's ruling dismissing an amendment."

Patent Act

Article 17

(Paragraphs (1) and (2) omitted)

- (3) The Commissioner of the Patent Office may require an applicant to amend a procedure, designating an adequate time limit, in the following cases:
- (i) where the procedures do not comply with paragraphs (1) to (3) of Article 7 or Article 9;
 - (ii) where the procedures do not comply with the formal requirements prescribed by this Act or an order thereunder; and
 - (iii) where the fees relating to the procedures payable under paragraphs (1) to (3) of Article 195 are not paid.
- (4) For any amendment of procedures (except in the case of the payment of fees), written amendment shall be submitted in writing, except for cases provided by Article 17-2(2).

81.1 Amendment

Amendment refers to a procedural act which an applicant voluntarily performs or performs based on an order issued by the Commissioner of the Patent Office or the chief administrative judge to correct or supplement the filing documents, etc. after the filing so as to remedy improper descriptions, where documents, etc. relating to the filing contain any improper descriptions such as an error or ambiguous statement in light of law or the prescribed forms.

Amendment is a procedural act that has been admitted under law for applicants within certain limitations, for the purpose of achieving smooth implementation of procedures under the first-to-file system. If an applicant submits a legitimate written amendment of proceedings (Article 17(4) of the Patent Act as applied *mutatis mutandis* pursuant to Article 68(2) of the Design Act), the documents, etc. will be treated as having been submitted in the amended state when originally filed.

However, due to such effect of amendment, if the contents that were described when originally filed could be freely amended, it would run contrary to the purport of the first-to-file system, and would give unexpected disadvantage to third parties, so limitations are imposed on the contents of and period for amendment.

81.1.1 Limitation on the contents of amendment

Since amendment should only be made to correct or supplement any error or ambiguous statement in the documents, etc. as originally filed, amendment made to the statement in the application or any drawings, etc. attached to the application must not change the gist thereof.

81.1.2 Limitation on the period for amendment

A person undertaking a procedure with regard to an application for design registration, a request or any other procedures relating to design registration may make amendments only while the case is pending in examination, trial or retrial.

Chapter II Dismissal of Amendments

82 Relevant provisions

Design Act

Article 17-2 (1) Where an amendment made to any statement in the application, or to the drawing, photograph, model or specimen attached to the application has changed the gist thereof, the examiner shall dismiss the amendment by a ruling.

(2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state the reasons therefor.

(3) Where the ruling dismissing an amendment under the preceding paragraph (1) has been rendered, the examiner shall not render a decision on the application for design registration before the expiration of three months from the date on which a certified copy of the ruling has been served.

(4) Where an applicant for design registration files a request for a trial against an examiner's ruling dismissing an amendment under paragraph 1, examination of the application for design registration shall be suspended until the trial decision becomes final and binding.

82.1 Dismissal of an amendment

Dismissal of an amendment under Article 17-2 of the Design Act refers to dismissal of an amendment by a ruling where the case is pending in examination, trial or retrial and an amendment that has been made to the statement in the application or any drawings, etc. attached to the application changes the gist thereof.

82.1.1 Gist of design and the finding of the gist of design

The statement in the application and drawings, etc. attached to the application represent the contents of the design filed as an aesthetic creation, which serves as the basis for specifying the scope of the registered design. On such basis, the content of a specific design that can be directly derived from the statement in the application and drawings, etc. attached to the application based on the ordinary skill in the art of the design is called the gist of design, and the process of directly deriving the gist of design from the statement in the application and drawings, etc. attached to the application based on the ordinary skill in the art of the design is called the finding of the gist of design.

82.1.2 Change of the gist

82.1.2.1 Categories of amendments that change the gist

Where an amendment made to the application or drawing, etc. attached to the application falls under any of the following, it changes the gist of the application or drawing, etc. attached to the application as originally filed.

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

From the viewpoint that allowing an amendment that makes a change exceeding the scope of identity of a design that can be inevitably derived based on the ordinary skill in the art of the design from the application and drawing, etc. attached to the application as originally filed would run contrary to the purport of the first-to-file system, and would give unexpected disadvantage to third parties, such amendment is to be found to change the gist of the application or drawing, etc. attached to the application as originally filed.

Meanwhile, the scope of identity refers to the scope of identity with regard to the gist of design, and does not include the concept of similarity.

82.1.2.1.2 Where the amendment is found to clarify the gist of design that was unclear when originally filed

From the viewpoint that an amendment to make subject matter that is not categorized as an industrially applicable design as provided in the main paragraph of Article 3(1) of the Design Act and whose gist of design cannot be identified even by making comprehensive determination based on the application and drawing, etc. attached to the application as originally filed, into an industrially applicable design, that is, allowing an amendment that clarifies the gist of design that was unclear when originally filed, would run contrary to the purport of the first-to-file system, and would give unexpected disadvantage to third parties, equivalent to the above, such amendment is also to be found to change the gist of the application or drawing, etc. attached to the application as

originally filed.

82.1.2.1.3 Where change is made to the scope for which the design registration is requested

An amendment made to change the scope that was not disclosed in the application or drawing, etc. attached to the application as originally filed, to the scope for which the design registration is requested, that is, an amendment to change the scope for which the design registration is requested, is found to change the gist of the design.

(However, this excludes the case of an amendment to make an additional statement that views are omitted since they are identical to or mirror images of other views)

Where it is suggested by the application or drawing, etc. attached to the application as originally filed that a certain scope is the scope for which the design registration is requested, and the shape is also indicated, adding such scope by making an amendment is not found to change the gist of the design.

82.1.2.2 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 the following upon making comprehensive determination on the application and drawing, etc. attached to the application, the amendment does not change the gist of the application or drawing, etc. attached to the application as originally filed.

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

Even where the application or drawing, etc. attached to the application as originally filed contains an improper description such as an error or ambiguous statement, if it is clear by making comprehensive determination that the improper description has arisen from an error or mishandling in preparing the application or drawing attached to the application or from restrictions in constructing drawings, and if a proper description can be inevitably and directly derived based on the ordinary

skill in the art of the design, an amendment to correct it into a proper description does not change the gist of the application or drawing, etc. attached to the application as originally filed. (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design”)

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

Even where the application or drawing, etc. attached to the application as originally filed contains an improper description such as an error or ambiguous statement and it is not possible to determine the correct contents by making a comprehensive determination, if the improper description is found to be an improper description of a part that is minor enough to not affect the finding of the gist of design, an amendment to correct it into a proper description does not change the gist of the application or drawing, etc. attached to the application as originally filed. (See Part II “Requirements for Design Registration,” Chapter I “Industrially Applicable Design,” 21.1.2 “The subject matter is a specific design”)

Part IX Special Application for Design Registration

Chapter I Division of Applications for Design Registration

91 Relevant provisions

Design Act

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

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

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

91.1 Provisions of Article 10-2 of the Design Act

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

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

Here, “a new application for design registration” includes a new application for design registration resulting from division of an international application for design registration.

91.1.1 Requirements for division of applications for design registration

In order for a new application for design registration resulting from division to be deemed to have been filed at the time of the filing of the original application for design registration, it must comply with all of the following requirements.

- (1) Examination, trial or retrial of the application for design registration is pending

The procedure of division can only be taken where the examination, trial or retrial of the application for design registration is pending. In other words, an application for design registration may not be divided after the application for design registration has been waived, withdrawn or dismissed, or where an examiner's decision or trial decision on the application has become final and binding (excluding the case where retrial of the application is pending).

- (2) The applicants for design registration are the same

The applicant of the new application for design registration resulting from division must be the same as the applicant of the original application for design registration. However, where the new applicant for design registration has legitimately succeeded to the right to obtain a design registration from the original applicant for design registration, the applicants are found to be the same.

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

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

- (4) The design in a new application for design registration resulting from division is a design identical to any of the two or more designs contained in the original application for design registration

91.1.2 Examples of cases that are not found to be a legitimate procedure for division of an application for design registration

- (1) Where an application for design registration that has been filed for each

design and that complies with the requirements provided in Article 7 of the Design Act is divided by each component constituting the article

- (2) Where an application for design registration for a design for a set of articles that complies with the requirements provided in Article 8 of the Design Act is divided by each constituent article
- (3) Where a new application for design registration resulting from division has a gist that is outside the scope of the design represented by the statement in the initial application and drawings, etc. attached to the application of the original application for design registration, that is, where the design represented in the new application for design registration changes the gist from the viewpoint of all of the two or more designs contained in the original application for design registration

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

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

91.1.4 Documents to be submitted when requesting application of the provisions on exception to lack of novelty of design or filing a priority claim under the Paris Convention, etc. for a new application for design registration resulting from division

Where a new application for design registration resulting from division is filed, any statements or documents which have been submitted in relation to the original application for design registration and are required to be submitted for the procedure to request application of the provisions on exception to lack of novelty of design (the documents required to be submitted under Article 4(3) of the Design Act) or are required to be submitted for filing a priority claim under the Paris Convention, etc. (including a priority claim recognized under the Paris Convention) (documents required to be submitted under Article 43(1) and (2) of the Patent Act Article or 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act) are deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration under Article 10-2(3) of the Design Act.

Chapter II Conversion of Application

92 Relevant provisions

Design Act

- Article 13 (1) An applicant of a patent may convert the patent application into an application for design registration; provided, however, that this shall not apply after the expiration of three months from the date the certified copy of the examiner's initial decision to the effect that the patent application is to be refused has been served.
- (2) An applicant of a utility model registration may convert the application for a utility model registration into an application for design registration
- (3) Where the period as provided in Article 121(1) of the Patent Act is extended under Article 4 of said Act, the period as provided in the proviso to paragraph (1) shall be deemed to have been extended only for that period as extended.
- (4) Where an application is converted under paragraph (1) or (2), the original application shall be deemed to have been withdrawn.
- (5) An applicant of a patent may, when there is a person who has a provisional exclusive license on the patent application, may convert the patent application pursuant to paragraph (1) only in the case where the consent of the person is obtained.
- (6) Articles 10-2(2) and (3) shall apply mutatis mutandis to the case of conversion of an application under paragraph (1) or (2).

92.1 Provisions of Article 13 of the Design Act

Conversion of an application is not conversion of the contents of an application, but conversion of the format of an application that was originally a patent application or an application for utility model registration into an application for design registration. Where such conversion is made, the new application for design registration is deemed to have been filed at the time of the filing of the original patent application or application for utility model registration, and the original patent application or application for utility model registration is deemed to have been withdrawn.

92.1.1 Requirements for conversion into an application for design registration

In order for a new application for design registration resulting from conversion to be deemed to have been filed at the time of the filing of the original patent application or application for utility model registration, it must comply with all of the following requirements.

- (1) In the case of conversion from a patent application into an application for design registration, that it is within three months from the date the certified copy of the examiner's initial decision to the effect that the patent application is to be refused has been served

- (2) In the case of conversion from an application for utility model registration into an application for design registration, that the original application for utility model registration is pending before the Patent Office
- (3) The applicant of the new application for design registration resulting from conversion and the original applicant of a patent or the original applicant of a utility model registration are the same

However, where the new applicant for design registration has legitimately succeeded to the right to obtain a design registration from the original application of a patent or applicant of a utility model registration, the applicants are found to be the same.

- (4) The initial description and drawings of the original patent application or application for utility model registration contain a concrete description based on which the design in the new application for design registration resulting from conversion can be clearly recognized
- (5) The design in the new application for design registration resulting from conversion is identical to the design represented in the initial description and drawings of the original patent application or application for utility model registration

92.1.2 Examples of cases that are not found to be a legitimate procedure for conversion of an application for design registration

- (1) Where the initial description and drawings of the original patent application or application for utility model registration do not contain a concrete description based on which the design in the new application for design registration resulting from conversion can be clearly recognized
- (2) Where the design in the new application for design registration resulting from conversion is not found to be identical to the design that is represented in the initial description and drawings of the original patent application or application for utility model registration by a concrete description based on which the design can be clearly recognized
- (3) Where the design in the new application for design registration resulting from conversion has added anything other than the contents of the initial description and drawings of the original patent application or application for utility model registration

92.1.3 Handling of a new application for design registration that does not comply with the requirements for conversion

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

treated as having been filed at the time of the conversion.

92.1.4 Documents to be submitted when requesting application of the provisions on exception to lack of novelty of design or filing a priority claim under the Paris Convention, etc. for a new application for design registration resulting from conversion

Where a new application for design registration resulting from conversion is filed, any statements or documents which have been submitted in relation to the original patent application or application for utility model registration and are required to be submitted for the procedure to request application of the provisions on exception to lack of novelty of design (the documents required to be submitted under Article 4(3) of the Design Act) or are required to be submitted for filing a priority claim under the Paris Convention, etc. (including a priority claim recognized under the Paris Convention) (documents required to be submitted under Article 43(1) and (2) of the Patent Act Article or 43-3(3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act) are deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration under Article 10-2(3) of the Design Act as applied mutatis mutandis pursuant to Article 13(6) of the Design Act.

Chapter III Special Provisions on Conversion of Application Concerning International Applications under the Patent Cooperation Treaty

93 Relevant provisions

Design Act

Article 13-2 (1) An international application that has been deemed to be a patent application under Article 184-3(1) or 184-20(4) of the Patent Act may be converted to an application for design registration, only after the fees payable under Article 195(2) of said Act have been paid (or, in the case of an international application that is deemed to be a patent application under Article 184-20(4) of said Act, after the ruling as provided in 184-20(4) has been rendered), and, in the case of a Patent Application in Japanese Language under Article 184-6(2) of said Act, the procedures under Article 184-5(1) of said Act have been completed, or, in the case of a Patent Application in Foreign Language under Article 184-4(1) of said Act, the procedures under Articles 184-4(1) or (4) and 184-5(1) of said Act have been completed.

(2) An international application that has been deemed to be an application for utility model registration under Article 48-3(1) or 48-16(4) of the Utility Model Act (Act No. 123 of 1959) may be converted to an application for design registration, only after the fees payable under Article 54(2) of said Act have been paid (or, in the case of an international application that is deemed to be an application for utility model registration under Article 48-16(4) of said Act, after the ruling as provided in Article 48-16(4) has been rendered), and, in the case of a Utility Model Application in Japanese under Article 48-5(4) of said Act, the procedures under Article 48-5(1) of said Act have been completed, or, in the case of a Utility Model Application in Foreign Language under 48-4(1) of said Act, the procedures under Articles 48-4(1) or (4) and 48-5(1) of said Act have been completed.

93.1 Handling of special provisions on conversion of application concerning international applications under the Patent Cooperation Treaty

An international application for which the international filing date has been recognized under the provisions of the Patent Cooperation Treaty and which includes Japan in its designated States is deemed to be a patent application or an application for utility model registration filed on the international filing date.

Such application can only be converted into an application for design registration only after the applicant has submitted a document containing such information as the name and address of the applicant, the name and address of the inventor (creator) and the international filing date and has paid the prescribed fees where the original application is an international patent application (international application for utility model registration) filed in Japanese, and only after the applicant has submitted the abovementioned document and the Japanese translations of the description and the

scope of claims and has paid the prescribed fees where the original application is an international patent application in foreign language (international application for utility model registration).

Chapter IV New Application for Amended Design

94 Relevant provisions

Design Act

Article 17-3 (1) Where an applicant for design registration files, within three months from the date on which a certified copy of the ruling dismissing an amendment under paragraph 1 of the preceding Article has been served, a new application for design registration for the amended design, the new application shall be deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted.

(2) Where a new application for design registration is filed under the preceding paragraph, the original application for design registration shall be deemed to have been withdrawn.

(3) The preceding two paragraphs shall apply only when the applicant for design registration has submitted to the Commissioner of the Patent Office, at the time of the filing of a new application, a document stating a request for the application of paragraph 1 to the new application for design registration under paragraph 1.

94.1 Provisions of Article 17-3 of the Design Act

A new application for design registration for an amended design for which a ruling dismissing an amendment has been made is deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted, and the original application for design registration is deemed to have been withdrawn.

94.1.1 Requirements for a new application for design registration for an amended design for which a ruling dismissing an amendment has been made

In order for a new application for design registration for an amended design for which a ruling dismissing an amendment has been made to be deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted, it must comply with all of the following requirements.

- (1) The subject matter of the new application for design registration is the amended design for which a ruling dismissing an amendment has been made
- (2) The new application for design registration is filed within three months from the date on which a certified copy of the ruling dismissing an amendment has been served
- (3) The new application for design registration is filed according to the Form No.

5 provided in Article 2(4) of the Ordinance for Enforcement of the Design Act

Part X Procedure for Priority Claim under the Paris Convention, etc.

101 Relevant provisions

Design Act: Article 15 (1)

Patent Act: Article 43, Article 43-3

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

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

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

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

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

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

A person who intends to make a priority claim for an application for design

registration under Article 4D(1) of the Paris Convention must follow the procedure provided in Article 43(1), (2) and (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.

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

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

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

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

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

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

- (1) The first application that serves as the basis for the right of priority is the first application (including an international application based on the Geneva Act^(Note)) that has been duly filed in one of the countries of the Union of the Paris Convention
(Article 4A(1), Article 4A(2), Article 4A(3) and Article 4C(4) of the Paris Convention, Article 6(2) of the Geneva Act)
- (2) The applicant for design registration filing in Japan is the person who has filed the first application that serves as the basis for the right of priority or such person's successor in title, who is eligible to enjoy the advantages of the Paris Convention (Article 2, Article 3 and Article 4A(1) of the Paris Convention)
- (3) The first application that serves as the basis for the right of priority is an application for design registration or an application for utility model registration (Article 4E(1) of the Paris Convention)
- (4) The application for design registration has been filed in Japan within six months

from the filing date of the first application

(Article 4C(1) and Article 4E(1) of the Paris Convention)

(5) A right of priority has been declared based on the first application

(Article 4D of the Paris Convention)

(6) The design in the application for design registration filed in Japan is identical to the design in the first application that serves as the basis for the right of priority

(Article 4A(1) and Article 4B of the Paris Convention)

(Note)

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

Meanwhile, the requirements for a priority claim recognized under the Paris Convention to be effective are the same as those for a priority claim under the Paris Convention to be effective.

(Article 43-3(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act)

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

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

(15.07 of the Design Examination Manual)

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

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

101.3.1 Statement in the column of “Article to the Design”

In principle, in order for the design described in the priority certificate to be found to be identical to the design in the application for design registration filed

in Japan, the articles to the designs of the two designs must also be identical.

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

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

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

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

[Example 1] Where a classification of articles corresponding to the usage and function that are clear by making comprehensive determination based on the entire contents of the priority certificate is stated

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

Japanese application: It is an application for a partial design where the article to the design is a “Mobile phone” and the part for which the design registration is requested is the display part of the mobile phone. A graphic image is displayed on the display part. Meanwhile,

the forms of the parts other than the display part are consistent with the form of the mobile phone represented by a broken line in the priority certificate.

(Explanation)

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

101.3.1.2 Where the name of the article to the design, etc. of the design described in the priority certificate is a generic name and there are multiple classifications of articles corresponding to its usage and function

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

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

[Example 2] Where the name of the article to the design, etc. in the priority certificate is a generic name and the statement in the column of “Article to the Design” of the application for design registration filed in Japan is a classification of articles equivalent in level to a classification of articles under Appended Table 1 that is included in such generic name

First application: The name of the article to the design, etc. is “bottle”

and the drawings contain the form of a general PET bottle for beverages.

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

101.3.2 Number of designs included in one application

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

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

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

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

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

Where the designs in the multiple priority certificates and the design

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

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

[Example 3] Where a design combining designs based on multiple priority certificates is specified as the design in the application for design registration filed in Japan

First application A: A design of the cap of a ball point pen

First application B: A design of the main body of a ball point pen

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

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

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

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

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

Where the part(s) other than the part(s) for which the design registration is requested in the first country is(are) specified as the part(s) for which the design registration is requested in Japan, even

by making comprehensive determination based on the contents of the entire priority certificate, the two designs are not found to be identical.

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

- (i) Where the position, size and scope of the part of which the specific form was represented, in the entire article, cannot be derived by making comprehensive determination based on the contents of the priority certificate, the two designs are not found to be identical.
- (ii) Where, with regard to the design described in the priority certificate, it is possible to derive the position, size and scope of the part of which the specific form was represented, in the entire article, by making comprehensive determination based on the contents of the priority certificate, other than drawings, or based on the characteristics of the article, etc., the two designs are found to be identical in determining the approval or disapproval of the right of priority.

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

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

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

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

(Explanation)

By making comprehensive determination based on the contents of the priority certificate, the first application is found to correspond to an

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

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

[Example 5] Where the position, size and scope of the part for which the design registration is requested can be derived by making comprehensive determination based on the contents of the priority certificate (graphic image on a screen)

First application: The name of the article to the design, etc. is “Graphical user interfaces” and the drawings contain the front view of a mobile phone (A) in a state where a graphic image (a) is displayed on the display part (the parts other than the display part are represented by broken lines) and multiple views that only represent plural graphic images (b, c and d).

Japanese application: It is an application for a partial design where the article to the design is a “Mobile phone” and the part for which the design registration is requested is the display part of the mobile phone. The shape of the entire mobile phone is consistent with mobile phone (A) represented by broken lines in the priority certificate, and graphic image (c) is displayed on the display part.

(Explanation)

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

In foreign countries, there are cases where design registration can be obtained for a graphic image on a screen alone, but in the design in an application for design registration filed in Japan, design registration cannot be obtained for a graphic image alone. Therefore, where a classification of articles that can be derived by making comprehensive determination based on the entire contents of the priority certificate is

specified as the article to the design (see Example 2), and only the display part displaying graphic image (c) on mobile phone (A) is specified as the part for which the design registration is requested, the specific position, size and scope of the display part in the entire article to the design can be derived by making comprehensive determination based on the entire contents of the priority certificate, so a design identical to the design in the application for design registration filed in Japan is found to be indicated in the priority certificate.

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

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

First application: The name of the article to the design, etc. is “Package” and the drawings only depict a pattern.

Japanese application: It is an application for a partial design for which the article to the design is a “Packaging box” and the pattern part represented on a part of the packaging box is specified as the part for which the design registration is requested.

(Explanation)

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

101.3.4 Combination or separation of parts constituting a design

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

101.3.4.1 Where the design in the application for design registration filed in Japan is the design of a finished product combining the design of a component described in the priority certificate and the design of another component that is not described in the priority certificate

The two designs are not found to be identical.

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

The two designs are not found to be identical.

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

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

Japanese application: A design of a bicycle saddle

(Explanation)

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

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

- (i) Where it is found that design registration is being requested in the first country for subject matter including the mode of combination specified as the design in the application for design registration filed in Japan, by making comprehensive determination based on the entire contents of the priority certificate, the two designs are found to be identical in determining the approval or disapproval of the right of priority.
- (ii) Where it is unclear whether design registration is being requested in the first country for the combination specified as the design in the application for design registration filed in Japan, by making comprehensive determination based on the entire contents of the priority certificate, the two designs are not found to be identical.

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

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

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

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

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

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

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

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

In order for the two designs to be found to be identical, the shapes, patterns,

and colors (hereinafter referred to as the “constituent elements of the design”) of the articles to the design of the two designs must be identical.

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

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

(Examples of cases where the methods of expression of the designs differ)

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

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

<p>[Example 9] Where the methods of expression differ but a design identical to the design described in the application for design registration filed in Japan can be inevitably derived by making comprehensive determination based on the contents of the priority certificate</p>
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First application: A design of a nail. It is represented by uncolored drawings, but the application contains a statement that it is made of iron.

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

(Explanation)

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

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

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

First application: The design is represented by a perspective view showing the front, top and right side, and a perspective view showing the rear, bottom and left side.

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

(Explanation)

The drawings described in the priority certificate are two perspective views showing the six sides, and the contents that can be inevitably derived by making comprehensive determination based on these views and the design in the application filed in Japan are consistent, so the mere difference is in the drawing method, and the two designs are found to be identical in determining the approval or disapproval of the right of priority.

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

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

First application: The design is represented by photographs in color.

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

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

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

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

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

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

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

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

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

Also, where the application for design registration filed in the first country that serves as the basis for the right of priority was a three-

dimensional trademark, the priority claim will not be effective.

101.3.7 Concept of identicalness of design of individual applications for design registration containing a priority claim under the Paris Convention, etc.

- (i) With regard to a partial design, see Part VII “Individual Applications for Design Registration,” Chapter I “Partial Design,” 71.13 “Application for design registration for a partial design containing a priority claim under the Paris Convention, etc.”
- (ii) With regard to a design for a set of articles, see Part VII “Individual Applications for Design Registration,” Chapter II “Design for a Set of Articles,” 72.1.7 “Application for design registration for a design for a set of articles containing a priority claim under the Paris Convention, etc.”

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 "an 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 providing 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

Matters recorded on the International Register	Matters stated in an application of the application for design registration
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)	the article to the design;
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)	the name, and domicile or residence of the applicant for design registration;
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)	the name, and the domicile or residence of a person who has created a design;

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

Matters recorded on the International Register	Matters stated in an application of the application for design registration
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	the description of the design or the description of the article to the design; * Any of them is stated in a column of [Description of the Design] in

Act, Rule 7(5)(a) of the Common Regulations of the Hague Agreement)	an international application for design registration without identifying them.
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)	the indication of the principal design;
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)	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];
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)	the priority claim under the Paris Convention, etc.;

[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;
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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,^(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,^(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 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 of 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”.

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”.

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”.

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”.

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”, Chapter VIII “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

Patent Act: Article 43, Article 43-3

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.”

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.

Chapter II Details

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

design”)

- (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”)

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

Common Regulations of the Hague Agreement).

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

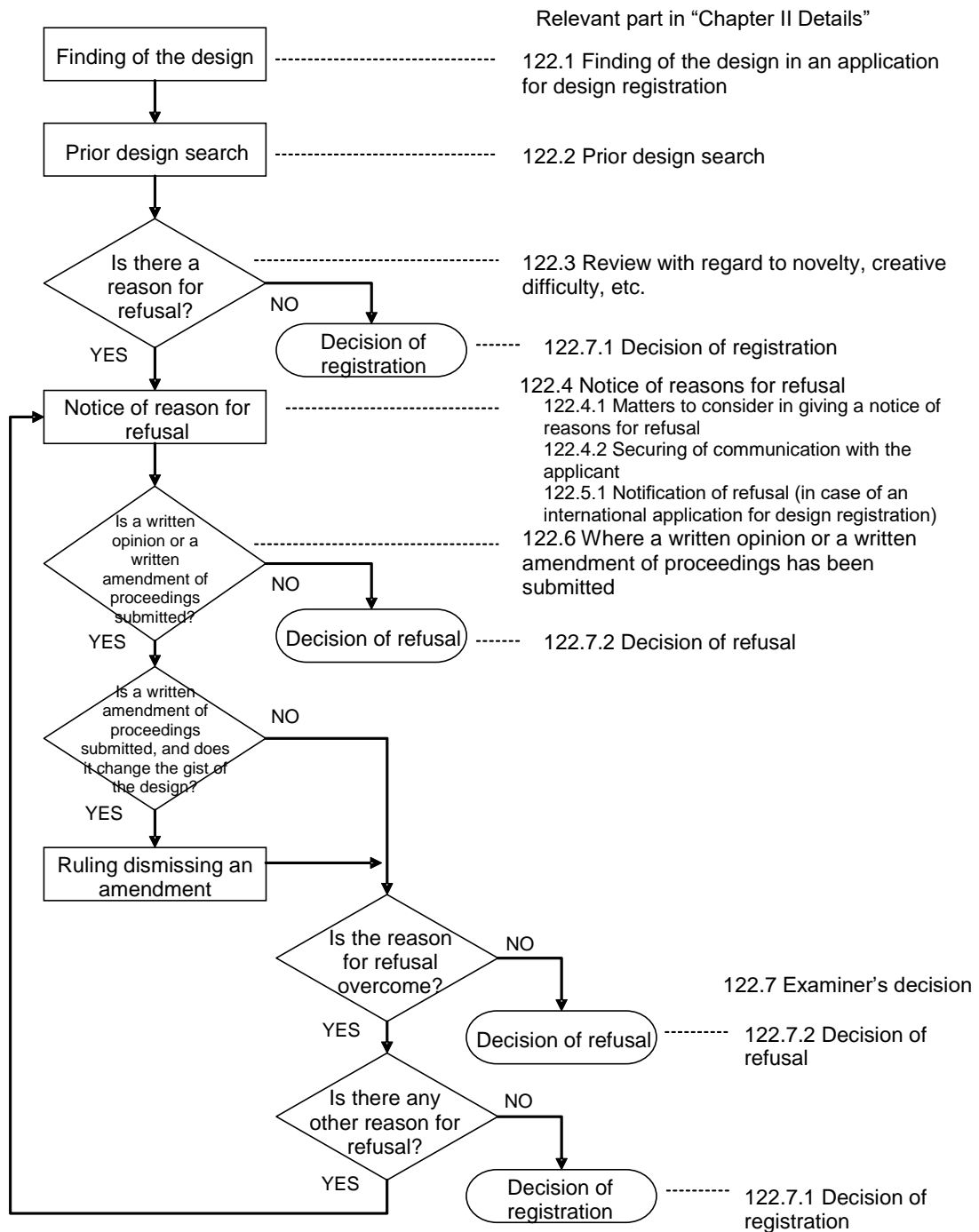
Where the reason for refusal is not overcome by a written opinion or a written amendment of proceedings submitted in response to a notice of reasons for refusal, a reason for refusal is to be rendered promptly (Article 17 of the Design Act).

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



Part XIII Others

Chapter I Feature Statement

131 Relevant provisions

Ordinance for Enforcement of the Design Act

Article 6 (1) A person requesting a design registration or an applicant for design registration may submit a feature statement containing features of the design for which the design registration is requested or the design in the application for design registration when submitting the application or while the case is pending in examination, trial or retrial.

(2) Where submitting a feature statement, it shall be submitted according to the Form No. 9.

(3) Where specifying the scope of a registered design, the contents of a feature statement must not be taken into consideration.

131.1 Feature statement

The examiner must not use its contents as the direct basis for the finding of the design in an application for design registration (see Part I “Application/Drawings,” Chapter II “Finding of the Design in an Application for Design Registration”), determination of similarity, or a reason for refusal; however, access to such contents is expected to expedite examination, because, for example, it will serve as reference information for deciding an accurate scope for the search in examination.

Where a design is registered, publication of the contents of the feature of the design and the explanation view in the Design Bulletin makes it possible to let third parties know the subjective intention of the applicant with regard to creation of the registered design.

Since the contents are not used as the basis for specifying the scope of the registered design provided in Article 24 of the Design Act, they do not have any direct influence on the scope of the right.

131.1.1 Submission procedure

Submission of a feature statement is not an obligation, but it is a voluntary procedure whereby a person requesting a design registration or an applicant for design registration may choose to submit the statement.

The submission can only be made when submitting the application or while

the application is pending in examination, trial or retrial.

131.1.2 Publication in the Design Bulletin

The contents of the feature of the Design and the explanation view of a feature statement are published in the Design Bulletin exactly as they have been submitted by the applicant, in principle. If a new feature statement has been submitted, only the contents of the latest feature statement are published.

Meanwhile, such contents are not published in the Design Bulletin based on the provisions of Article 66(3) of the Design Act (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 application have been filed for identical or similar designs on the same date). Where a feature statement contains any expression, etc. that is improper to be published in the Design Bulletin, such part is not to be published in the Design Bulletin.

Appendix: Examples of Constituent Articles of Sets of Articles

	Set of Articles	Constituent Article	Notes
1	A set of underwear	Brassiere Girdle Panty Slip Camisole Petticoat Body suit	
2	A set of cuff links and tie clips	Cuff link Tie clip	
3	A set of personal ornaments	Necklace Earring	
4	A set of smoker's articles	Table lighter Ashtray	
5	A set of beautification equipment	Electric massager Electric eyebrow shaver Electric facial cleansing puff Electric suction patten	Set that has a combination of constituent articles in any of the columns
6	A set of girl's festival dolls	Emperor and empress dolls Three court ladies Five court musicians Minister of the right and minister of the left	
7	A set of washing equipment	Electric washing machine Clothes drying machine	
8	A set of lavatory cleaning tools	Scrub brush with a case Sanitary bin	
9	A set of toilet articles	Tooth brush stand Cup	
10	A set of electric toothbrushes	Electric tooth brush Holder	
11	A set of camping pans	Pot Frying pan	

	Set of Articles	Constituent Article	Notes
12	A set of tea ware	Tea cup and saucer Teapot Milk pitcher Sugar container	
13	A set of coffee ware	Coffee cup and saucer Coffee pot Milk pitcher Sugar container	
14	A set of alcoholic beverage vessels	Glass Ice container Glass Decanter Tokkuri * Tokkuri: sake (Japanese rice wine) bottle Sakazuki * Sakazuki: sake (Japanese rice wine) cup	Set that has a combination of constituent articles in any of the columns
15	A set of table plates and cups	Table plate Cup	
16	A set of tea cups and teapots for green tea	Tea cup for green tea Teapot for green tea	
17	A set of dinnerware	Meat plate Bread plate Soup plate Tea cup and saucer Large bowl Milk pitcher Sugar container	
18	A set of spice containers	Table salt shaker Pepper shaker Soy sauce server Worcester sauce server	Set that has a combination of constituent articles in any of the columns

	Set of Articles	Constituent Article	Notes
19	A set of dining knives, forks and spoons	Knife Fork Spoon	
20	A set of chairs	Chair (at least two)	
21	A set of living room furniture	Table Armchair	
22	A set of outdoor chairs and tables	Outdoor chair Outdoor table	
23	A set of hall storage units	Shoe cupboard Storage rack	
24	A set of storage racks	Storage rack (at least two)	
25	A set of desks	Desk Side desk	
26	A set of tables	Table (at least two)	
27	A set of ceiling lights	Ceiling light Ceiling light hanging ornament	
28	A set of air conditioners	Air conditioner Air conditioner outdoor unit	
29	A set of bathroom vanities	Bathroom vanity Toilet mirror Storage rack	
30	A set of kitchen equipment	Sink cabinet Cooking table Gas cooking table Storage rack	
31	A set of accessories for a toilet bowl	Toilet lid cover Toilet seat cover Toilet floor mat	
32	A set of toy tea ware	The respective constituent articles are similar to the abovementioned sets that are not toys.	
33	A set of toy coffee ware		
34	A set of toy dinnerware		
35	A set of toy spice containers		

	Set of Articles	Constituent Article	Notes
36	A set of toy dining knives, forks and spoons		
37	A set of golf clubs	Golf club (at least two)	
38	A set of drums	Drum Cymbal	
39	A set of office supplies	Scissors Paper knife Paper cutter Ruler Stapler	
40	A set of writing tools	Mechanical pencil Ball point pen Fountain pen Marking pen	
41	A set of car spoilers	Car spoiler (at least two)	
42	A set of car seat covers	Seat cover (at least two)	
43	A set of car floor mats	Floor mat (at least two)	
44	A set of car pedals	Accelerator pedal Brake pedal	
45	A set of motorbike cowls	Cowl (at least two)	
46	A set of motorbike fenders	Front fender Rear fender	
47	A set of on-vehicle route guidance systems	On-vehicle route guidance system main body Monitor television receiver	
48	A set of audio equipment	Tuner Amplifier Speaker enclosure	
49	A set of in-vehicle audio equipment	In-vehicle tuner In-vehicle amplifier Speaker enclosure	
50	A set of speaker enclosures	Speaker enclosure (at least two)	
51	A set of television receivers	Television receiver Television stand	

	Set of Articles	Constituent Article	Notes
52	A set of optical disc players	Monitor television receiver Optical disc player	
53	A set of computers	Computer Computer data display or data output equipment Computer with a computer data display Computer keyboard or data input equipment Computer with a computer keyboard Computer data display Computer (at least two (consisting of multiple cabinets)) Computer Auxiliary equipment for data input/output	Set that has a combination of constituent articles in any of the columns
54	A set of automatic vending machines	Automatic vending machine (at least two)	
55	A set of medical x-ray machines	X-ray camera Medical bed	
56	A set of gateposts, gates and fences	Gate post Gate door Fence	