

TOKYO - JAPAN

NAKAMURA & PARTNERS

中 村 合 同 特 許 法 律 事 務 所
PATENT TRADEMARK & LEGAL AFFAIRS

OUTLINE OF DESIGN PROSECUTION IN JAPAN

1. Application	1
2. Registration Requirements	2
3. Graphic Image Designs	3
4. Substantive Examination	6
5. International Registration of Industrial Designs under Hague Agreement	7
6. Invalidation Trial	8

For further information, please contact:

SHIN-TOKYO BUILDING
3-1, MARUNOUCHI 3-CHOME
CHIYODA-KU, TOKYO
100-8355 JAPAN

TELEPHONE: 81-3-3211-8741
FACSIMILE: 81-3-3214-6358
81-3-3214-6359
E-MAIL: pat@nakapat.gr.jp

www.nakapat.gr.jp

1. Application

(1) Article (Title)

A title is the name of the article in which the design is embodied. A title of design, i.e., an article having the design, should be determined in accordance with the Japanese design classification specified under the ordinance of the Ministry of Economy, Trade and Industry.

In case of filing a so-called partial design where a design of a part of an article is claimed, the title of the design may not be that of the part for which design protection is sought (“the claimed portion”); instead, it must be that of the entire article. For example, in a case where a design protection for the handle part of a coffee cup is sought, a title such as “HANDLE FOR COFFEE CUP” is not permissible; it should be “COFFEE CUP.”

(2) Drawings

Generally, drawings of a design must show six views of the embodying article: front, rear, left side and right side, and top plan and bottom plan views, preferably with a perspective view. Further, a cross-sectional view may be required when, for example, the design includes a depressed portion whose shape is not apparent from the six views. Shading for showing the surface shape of the article is not required in the drawings, although it is not prohibited.

In the case of filing a partial design, it is not sufficient if only the part of the article is shown in the drawings; i.e., the design of the whole article must be shown. The claimed portion is normally depicted in solid lines and the remaining portion (“the unclaimed portion”) in broken lines.

(3) Paris Convention Priority

A priority under the Paris Convention can be claimed. The grace period for claiming the priority is six months from the filing date of the earliest design application. A certified copy of the basic application must be filed within 3 months from the filing date of the Japanese application.

(4) Exceptions to Loss of Novelty

In a case where a design has been intentionally disclosed to the public by the person having the right to obtain a design registration (“the Person”) or unintentionally disclosed to the public by a third party, it is deemed that the novelty has not been lost (“exception to loss of novelty”) if the following conditions are met:

(a) It is required that the Person file a design application in Japan within 6 months from the first disclosure date.

(b) In the case of an intentional disclosure, the request for the exception to loss of novelty should be indicated in the application. Further, it is required that the

Person submit to the Japan Patent Office ("the JPO") a document proving that the design was disclosed by the Person and giving the date and the situation of the disclosure within 30 days from the filing date of the design application. With regard to an unintentional disclosure, there are no such requirements since it is often the case where the applicant is not aware of the unintentional disclosure at the time of filing.

(c) The exception does not apply where the design has been disclosed in a patent, utility model, design or trademark official gazette published anywhere in the world before the filing date of the design application.

2. Registration Requirements

(1) Industrial Use Requirement

A creator of a design that is industrially applicable may be entitled to obtain a design registration for the design. In order to be considered as industrially applicable, the article on which the design is used should be capable of being mass-produced and be tradable in market. Mere graphic symbols and logos, surface patterns, ornamentation, or characters are not registrable.

(2) Novelty Requirement

If a design is publicly known anywhere in the world prior to the filing of a design application, it is not registrable. In particular, if a design has been described in a distributed publication, or has been made publicly available through electronic telecommunication, such as the Internet, anywhere in the world, prior to the filing of an application for design registration, it is not registrable. In addition, a design that is similar to the publicly known or published design is also not registrable. However, there is an exception to loss of novelty. Please see Subsection (4) above.

(3) Preclusion of Design of Later-filed Application

A design of an application filed later ("the later application") that is identical or similar to a part of a design of another application filed earlier ("the earlier application") by another applicant cannot be registered. This rule applies even if the later application is filed before the publication of the design of the earlier application in an official gazette, and/or even if both designs as a whole are not similar to each other. It does not apply to the case where the applicant of the earlier application and that of the later application are the same.

(4) Easy-to-create Requirement

Even if a design is novel, if the design is one which a person ordinarily skilled in the art of the design ("the skilled artisan") would be able to easily create, the design is not registrable. In particular, if, prior to the filing of an application for design registration, a skilled artisan would have been able to easily create the design based on shape, patterns or colors, or any combination of these that were publicly known in Japan or a foreign country, a design registration shall not be granted.

(5) First-to-File Principle

The first-to-file principle applies not only to design registration applications covering identical designs, but also to those applications covering similar designs. In case two or more design applications are filed on different dates with respect to an identical design or similar designs, only the applicant of the design application with the earliest filing date (or the earliest priority date in case of a design application claiming the Paris Convention priority) may obtain a design registration with respect to such design.

When two or more design applications are filed with respect to similar designs by the same applicant on the same date, such designs can be registered as “related designs.” If these applications are filed on different dates, the designs can be registered as “related designs” if the filing date (a priority date in case of a design application claiming the Paris Convention priority) of the latest filed application is before publication of a Japanese design gazette of the earliest design application.

The related design has its own scope when registered as with a principal design. The design rights of the principal and related designs have restrictions such as: 1) the terms of the design rights of the principal design and the related design(s) end at the same time; and 2) the principal design and its related design(s) may not be transferred separately.

(6) One-Design-per-Application Principle

A separate design application must be filed for each design. As an exception, a single application may cover different articles forming one of specific sets provided under the ordinance of the Ministry of Economy, Trade and Industry. Please contact us to see what sets of articles are acceptable.

3. Graphic Image Designs

Graphic image designs are registrable subject matter under the Japanese design system if the following requirements are met.

(1) Registrable/Unregistrable Graphic Image Designs

(1-1) Registrable Graphic Image Designs

- (i) Graphic image designs under Article 2, Paragraph 1 (Category 1)

If a graphic image design shown on an article’s display screen meets the following conditions, it is registrable under this category.

- (A) The article including the graphic image design must be considered to be "an article" under the Design Act.

(B) The graphic image design to be shown on the display screen must meet the following requirements.

- (a) It is a graphic image design necessary to perform a function of the article; and
- (b) It is recorded on the article.



article "WATCH BODY"
Cited from the Examination Guidelines

(ii) Graphic image designs under Article 2, Paragraph 2 (Category 2)

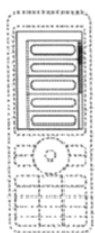
If a graphic image design shown on an article's display screen meets the following conditions, it is registrable under this category.

(A) The article including the graphic image design must be considered to be "an article" under the Design Act.

(B) The graphic image design to be shown on the display screen must meet the following requirements.

- (a) It is for use in the article's operation(s) (limited to the operations necessary to enable the article to perform its functions); and
- (b) It is recorded on the article.

For example, if the article is a cell phone, "to enable the article to perform its functions" means the operations necessary for the cell phone to make or receive a call.



article "CELL PHONE"
Cited from the Examination Guidelines

(iii) Graphic image designs of computers

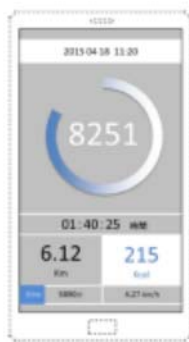
(A) As to the article a "COMPUTER"

The inherent function of the "COMPUTER" is only the information processing function. When a graphic image design is displayed by software, the information processing function is already performed so that such a graphic image design is neither necessary to perform the function nor necessary to enable the COMPUTER to perform the function. Thus, a graphic image design displayed by software

does not meet the above-stated conditions for Categories 1 and 2 and is not registrable. However, for example, a graphic image design of a BIOS (Basic Input/Output System) relating to an information processing function of a computer is registrable because it meets the above-stated conditions for Category 1 or 2.

(B) As to the article a "COMPUTER WITH [ADDITIONAL] FUNCTION"

The article a "COMPUTER WITH [ADDITIONAL] FUNCTION," which has a concrete function by integrating with installed software, has been newly allowed under the Guidelines as of April 1, 2016. Thus, a graphic image design of a "COMPUTER WITH [ADDITIONAL] FUNCTION" is registrable if it meets the above-stated conditions for Category 1 or 2.



article "COMPUTER WITH PEDOMETER FUNCTION"

Cited from the Examination Guidelines

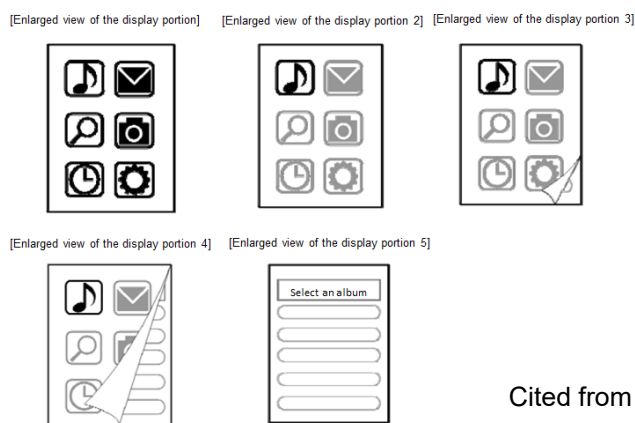
(1-2) Unregistrable Graphic Image Designs

A wall paper design, a graphic image design that includes contents such as a scene of a movie, and a scene of a video game shown on a display screen of a game player are not registrable.

(2) Changing Graphic Image Design

In case where a graphic image design changes, the views showing changed states are registrable as "one design" if the following two requirements are fulfilled.

- (i) If they are necessary for performing the same function or for the operation of exerting the same function of the article.
- (ii) If there is any relevance in their forms, etc. between a view and the next sequential view. It includes a case where two or more views showing changed states of an animated design have the relevance between a view and the next sequential view.



Cited from the Examination Guidelines

(3) Preparation of Drawings for Graphic Image Design

A registrable design is a design of an article (See Subsection (1) above). Therefore, a graphic image design must be filed for a particular article embodying it such as “CELL PHONE,” “PORTABLE INFORMATION TERMINAL,” “COMPUTER WITH MUSIC PLAYING FUNCTION,” “COMPUTER WITH POSTCARD MAKING FUNCTION,” etc.

In case of filing a Japanese design application claiming the Paris Convention priority (hereafter, “the convention application”) to an application filed in the applicant’s home country (“the first application”), the first application should include all six views of the article, even if all these views of the article embodying a graphic image design are not required under the design system in the applicant’s home country, in order to keep the priority intact. That is, if the first application does not include all the views required under the Japanese system, and if a missing view(s) is(are) added to the convention application at the time of filing in Japan, the priority right would be lost. In order to disclaim the shape of the article, the shape thereof can be shown in broken lines.

4. Substantive Examination

(1) Examination procedure

Since there is no system of deferred examination of applications, the next step concerns substantive examination of the design application. If, during the substantive examination, the Examiner finds any reason to reject the application, he/she issues a notice of reasons for rejection. The Examiner gives the applicant an opportunity to submit his/her arguments against the indicated rejection and/or to make an amendment within 3 months from the issuance date of the notice. If, in spite of the applicant’s argument or amendment, the Examiner still maintains his/her reasons for rejection, he/she issues a decision of rejection. The applicant may then file an appeal before the Patent Office. The board of appeals, consisting of three appeal Examiners, reviews the rejected application.

(2) Registration

If the Examiner finds no reason for rejection, he/she issues an allowance. For an application to proceed to registration, the applicant must pay the first year's registration fee within thirty days from receiving the Examiner's decision to register. Upon timely payment, the design right is established by registration.

(3) Publication of Design

After registration, the design is published in the Design Gazette.

When an applicant wishes to keep a design secret, the applicant can request deferment of the publication for a desired period up to three years from the registration date of the design. Such a request can be made at the time of filing or at the time of paying the registration fee.

If the applicant requests deferment of the publication, only formal matters such as the name and address of the design owner, a design application number and filing date, a design registration number and a registration date will be published during the requested period.

(4) Term of Design Right

For those design applications filed on or before March 31, 2007, the term of a design right is for a maximum period of 15 years from registration. Due to an amendment to the Design Act, for the applications filed on or after April 1, 2007, the term of a design right is for a maximum period of 20 years.

5. International Registration of Industrial Designs under Hague Agreement

Beginning May 13, 2015, applicants filing international design applications can designate Japan for design protection. If an international design application designating Japan is filed, the WIPO will review whether it complies with the prescribed formal requirements. If an international application complies with the formal requirements, the WIPO will record it in the International Register by publishing the corresponding registration in the International Designs Bulletin ("the Bulletin").

Please note that, if the Paris Convention priority is claimed, the priority document must be submitted to the JPO within 3 months from the publication date of the Bulletin. Further, if an applicant wishes to claim the exception to the loss of novelty (See Section 1(4) above), the claim can be made to the JPO within 30 days from the publication date of the Bulletin. The evidence showing that the exception is applicable must be submitted within the 30-day period. In order to submit all the necessary documents to the JPO in a timely manner, it is important that you notify us, preferably soon after the Bulletin has been published, to arrange for its submission.

If an International design application that designates Japan has been published in the Bulletin, it will be subject to substantive examination by the JPO based on the Japanese Examination Guidelines for Design.

6. Invalidation Trial

Reasons for invalidation of a registration (Design Act, Article 48) are almost the same as those used by the Examiner to reject a design registration application. One of the differences is that a design registration cannot be invalidated on the ground that the application for such design registration violates the one-design-per-application principle of Article 7 of the Design Act.

A trial for invalidation may be demanded by any person demonstrating a valid interest in the invalidation at any time during the term and even after expiration of a design right.

When the decision in a trial to invalidate a design registration has become final and conclusive, the design right shall be deemed never to have existed. However, when the reasons for invalidation arose after the registration, the design right shall be not to have existed from the time such reasons arose.

© NAKAMURA & PARTNERS, 2018
Copyright 2018 NAKAMURA & PARTNERS.
All rights reserved.

No reproduction or republication without written permission.