

**QUESTIONS AND ANSWERS
REGARDING JAPANESE DESIGN PRACTICE
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QUESTIONS AND ANSWERS compiled
by the International Activities Center of
the Japan Patent Attorneys Association¹

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I. APPLICATION

Q1. What kind of design can be registered in Japan?

A1. A registerable design is a shape, patterns or colors, or any combination thereof, of an article (including a part of an article), which creates an aesthetic impression through the eye (Design Law Art. 2(1)), i.e. a visual aesthetic impression.

(1) Thus, a design needs to satisfy the following requirements:

(i) It must be a form or configuration of an article.

An article means a tangible entity which can be distributed in a market. Therefore, a mere two-dimensional figure or image such as a graphic symbol can not be the subject of a design registration.

The design law provides for a partial design registration system which permits design registration for a part of an article. However, even in this case, it is necessary to specify the form or configuration of an article which includes the part.

(ii) It must be recognized through the eye.

In principle, the article should be recognized with the naked eye.

(iii) It has to produce a visual aesthetic impression.

(2) Further, the shape, patterns or colors or any combination thereof in a part of an article shall include those in a graphic image on a screen that an image which 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 (Art. 2(2)).

For example, an image appearing in a display of a copying machine to notify magnification rate falls in "an image which is provided for use in the operation carried out in order to enable the article to perform its function". On the other hand,

an image displayed by an OS (operating system) of a computer is excluded from the registerable image.

Q2. Under which criteria is a design not registered? And, is there any measure to register a design that has already been known to the public?

A2.(1). The following cases are examples under which a design application is not granted by a known fact.

(i) In Japan or any other country, prior to the filing of the application, a design in the application is publicly known, or described in a publication distributed or made available to the public through electric telecommunication lines(Art. 3(1)(i),(ii));

(ii) a design similar^(See Note A2-A) to the design of the aforementioned (i) (Art. 3(1)(iii)); or

(iii) a design easily created by a person who has an ordinary skill in the art to which the design pertains, on the basis of publicly known design features^(See Note A2-B) in Japan or any other country, prior to the filing of the application (Art. 3(2)).

Note A2-A: "similarity" is defined as follows:

(i) In comparing two designs, the article is the same or similar to each other and the design feature^(See Note A2-B) is similar; or

(ii) In comparing two designs, the article is similar and the design feature^(See Note A2-B) is the same.

"Similarity" is determined as a whole, based on the aesthetic impressions extracted by individually assessing a common part or different part between two designs to be compared, from the view point of a consumer (including a dealer).

Note A2-B: The design feature is a form or configuration

of a design including a shape, patterns or colors, or any combination thereof.

A2.(2). Even if a design has been publicly known before filing in Japan, in the following cases, the design is exceptionally deemed to be kept secret and can be filed.

(i) In the case where the act which made the design to be publicly known was performed by a person who is entitled to file the design application: or

(ii) In the case where the act which made the design to be publicly known was performed against the intention of the person who is entitled to file the design application.

An applicant who seeks the exceptional handling explained above has to file the application within six months from the date when the design was publicly known.

In addition in the case of (i), the applicant has to submit a document which explains why and how the design was publicly known within 30 days from the filing date.

Q3. What documents and/or information are required to file a design application in Japan?

A3.

1. A written Request which includes the following information:

(i) Name of article

The name of the article must be included in the written request. The name of the article should be carefully chosen and decided upon because the name sometimes plays a significant role in interpreting the scope of the design right.

(ii) Explanation of article

The explanation of the article need not be necessarily submitted, but if the explanation of the article is clear, the problem of new-matter in the future can be avoided. Further, when the article itself is not known in Japan, information about

the article such as use, function, structure etc., should be explained.

(iii) Explanation of design

For example, in a case where a change in the configuration of the article is beyond expectation, it is preferable that the change of the configuration before and after its movement be explained with explanatory drawings. Further, when it is not clearly self-evident that the entire article or a part of the article is transparent, it should be explained so. When the article is lengthy, for example, a rope or a rail, it should be explained so. In the case of a partial design application, the part for which the registration is sought is to be identified and explained.

2. Drawing (photograph, computer graphic)

A set of drawings from six directions i.e. front view, rear view, left side view, right side view, plan view and bottom view have to be submitted. The drawings are to be depicted by the orthographic method. Depending on the design, a perspective view, sectional view or partial enlarged view, etc would help the Examiner accurately and quickly understand the design. In the case of a partial design application, a part which is sought to be protected as a partial design and the other part are to be clearly distinguished and shown diagrammatically. When a design of a set of articles is filed, a set of drawings in six views is required for each article. If the article includes a movable part, and the movement is not duly expected, drawings which show the change of the configuration of the article before and after the movement should be submitted. Further, if it is not clearly self-evident that the article contains a transparent part, it is necessary to submit a cross-sectional drawing to specify the transparent part.

3. Claiming priority

A priority claim must be made at the time of filing the design application and the priority document has to be

submitted within three months from the filing date. If the priority document is not filed within three months from the filing date, the priority claim will not be considered in the examination.

4. Power of attorney

A power of attorney is not required for filing the application. However, in case of abandonment, withdrawal, conversion of application and demand for appeal a power of attorney is necessary. Therefore, we recommend forwarding a power of attorney in advance to the Japanese agent.

Q4. How can you file a plurality of designs?

A4. An application may include a single design because Japan follows the one application-one design system.

Therefore, even if a plurality of different designs are directed to the same article and are similar to one another, they must be filed as separate applications (Art. 7). However, as an exception, in the case of designs of articles where two or more articles are used together and the designs of those articles are unified, those designs can be filed in a single application as a Design for a Set of Articles (Art. 8).

Examples: a dinner set; a coffee set; a set of knife, fork and spoon.

Q5. How can you file for a plurality of *similar* designs?

A5. If applications for similar designs are filed separately, one application will be cited to reject another application on the basis of similarity. To avoid this situation, there is a Related design system. In case of applications filed under the Related design system, the applications are not cited against one another (Art.10). It should be noted that under the Related

design system, the duration of their design rights are deemed to have the same length as that of the earliest registration (Art. 21(2)). In addition, Related designs cannot be separated after registration, and therefore, they must be transferred together if they are transferred from one owner to another (Art. 22).

It should also be noted that if the Examiner finds that the applications filed as Related designs are not similar to one another, he/she will issue notices of rejection. In this case, the applicant is entitled to amend the Related design applications to independent applications. Further, if one of the independent applications is rejected over another application on the basis of similarity, the rejection can be overcome by amending the independent applications into Related design applications.

II. EXAMINATION

Q6. What are the procedures for obtaining a design right? And, how long does it take to obtain the design right from filing of an application?

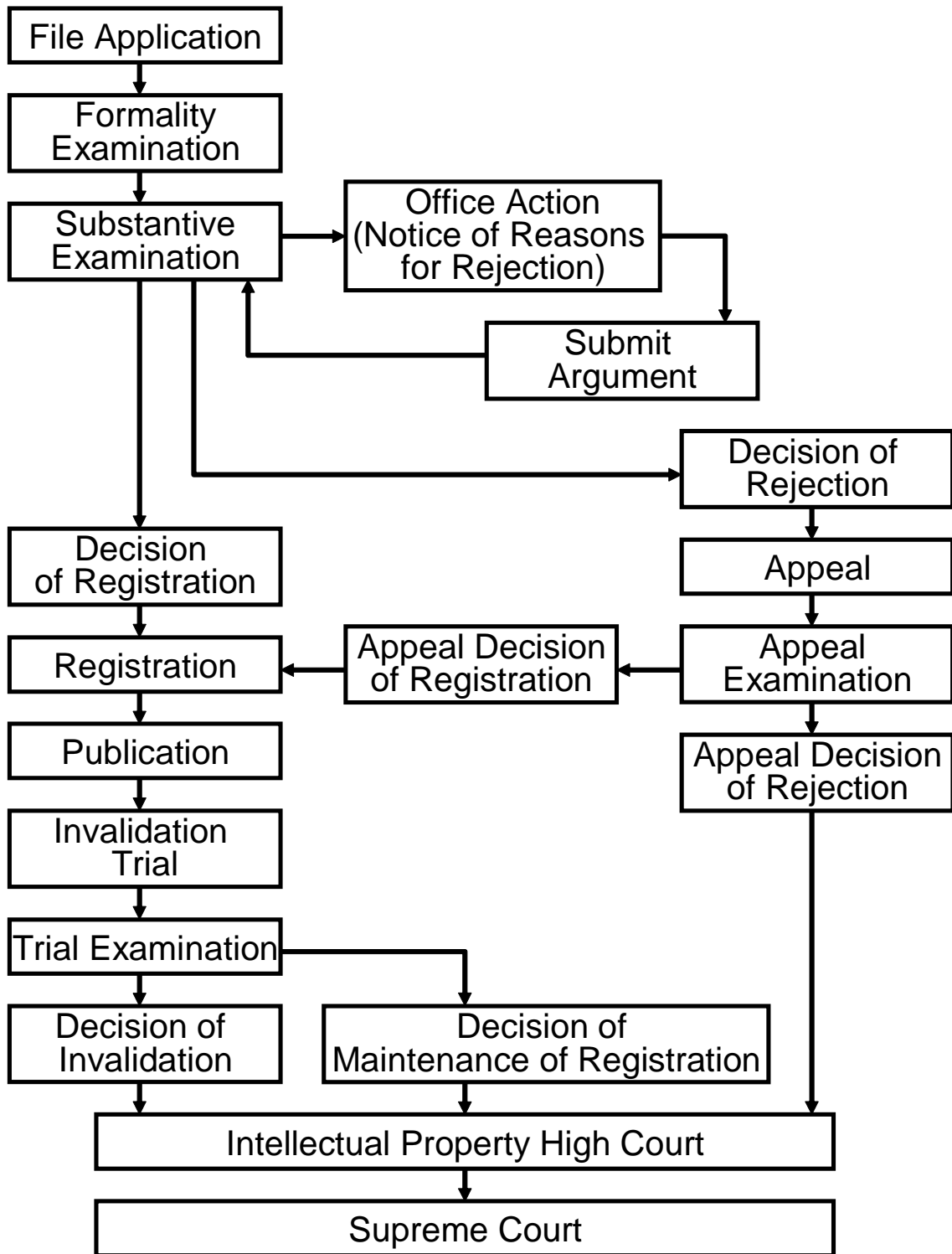
A6. When an application is filed, it is subjected to a formality examination and then substantive examination. A request for examination need not be filed.

In 2007, on average a first Office Action will be issued about 7 months from the filing date. An accelerated examination can be requested if the application meets specified requirements e.g. the application has a counterpart foreign application. If the accelerated examination is approved, the applicant may expect the first Office Action to be generally issued in about 2 months from the submission of such a request. The time period for obtaining a design right from the filing of the application depends on whether the first Office Action

is a decision of registration or a notice of reasons for rejection.

If an Examiner issues a Decision of Rejection, the applicant is entitled to file an appeal to the Appeal Board.

The flow chart below shows the procedures from the filing to registration of an application.



Q7. What are typical reasons a design application may be rejected?

A7.

- (1) The design lacks novelty (see A2.(1)(i) and (ii)).
- (2) The design is easily created (see A2.(1)(iii)).
- (3) The application lacks unity of design (see A4.).
- (4) The application does not comply with the first-to-file rule (see A9.).
- (5) The partial design is identical or similar to a part of the whole design disclosed in another application having an earlier filing date but its Gazette was published after the application (Art.3^{bis}).

Q8. Are a whole design application and a partial design application judged in accordance with the first-to-file rule?

A8. No, they aren't, but it should be noted that there is Design Law Article 3^{bis} (see A7.(5)).

Q9. If an applicant files a design application and receives an Office Action which says that the design is similar to a design of an application that the applicant filed previously, what should applicant do?

A9. The applicant may file an argument contending that the designs are not similar. However, since an Examiner's judgment of similarity is subjective, it is generally difficult to overcome the judgment by the Examiner simply by filing an argument.

Another possible measure is to amend the application into a Related design application (See Q5 & A5).

Also, it may be possible to abandon the application considering that the scope of protection of the rejected design

is covered by the design in the earlier filed application. However, if the rejected application is abandoned, the overall scope of protection would be narrowed because the scope of the remaining design right would not cover the range of the scope of similarity of the abandoned design.

III. POST-GRANT

Q10. After a design application has been filed, how long does it take before the design is registered?

A10. Usually, it takes about seven months to obtain a decision of registration. Then the applicant pays a registration fee, and the design right takes effect. In certain circumstance a request can be made to the Japan Patent Office (JPO) to accelerate the examination. The circumstance must be explained.

Q11. How long does a design right last?

A11. A design right lasts 20 years from the date of registration, subject to the payment of annuities. A Related design right lapses when the legal term of its Principal design right expires, but when it expires for other reason such as failure to pay an annuity, the Related design right can survive up to 20 years from the date of registration of the Principal design.

Q12. What countermeasure can be taken against copying of a pending design application?

A12. No legal protection is available until the design is registered. The Design Law has no provision for intermediate

publication or provisional protection.

Q13. After having received a decision of registration, can the applicant defer publication?

A13. Yes, the applicant can use the Secret design system. When paying the registration fee, the applicant can make a request to the JPO by specifying a period of deferment not exceeding 3 years from the date of registration. The period of secrecy can be shortened or extended. If there is a need for deferment of publication at the time of filing, a request for deferment must be attached to the application with a prescribed fee.

Q14. When a registered design right is in conflict with another's copyright, is there any measure that can be taken to avoid copyright infringement?

A14. Art. 26 of the Design Law prohibits a design proprietor from commercially manufacturing or selling another's copyrighted work if the copyright is senior. If the design proprietor wishes to work it, he or she must obtain permission from the copyright owner.

Q15. When a registered design includes another's prior registered design, what measures are available for working our design in no danger of infringement?

A15. Three alternative options:

- (1) Obtain a license from the design proprietor,
- (2) Change or modify the design or
- (3) Stop working the design.

Q16. After a pending design application was allowed and the registration fee was paid, the design has been slightly modified so as to tailor to the latest fashion. Is this design preferentially registered as a similar design related to the registered design?

A16. The modified design can be registered only when it is filed as a Related design before the allowed design is published in an official gazette (Art. 10). No advantageous treatment is given to the Related design.

Q17. When a proprietor has two design rights; that is, a Principal design registration and a Related design registration, is it possible for him/her to assign one of them to another?

A17. It is not possible. Art. 22 of the Design Law prohibits mutually similar designs from being separately owned by different persons. In this case, the two design rights must be entirely assigned to the same person.

Q18. What types of licensing are available?

A18. There are two types of licenses; one is non-exclusive and the other is exclusive. The exclusive license must be registered at the JPO because of its exclusivity. If a licensor owns two rights to a Principal design and its Related design, he or she must grant an exclusive license at the same time to one licensee covering the two design rights (Art. 27).

Q19. Does the lapsing of the Principal design registration due to failure to timely pay an annuity fatally affect the Related design right?

A19. The Related design right nevertheless can survive up to 20 years from the date of registration of the Principal design, subject to payment of annuities.

Q20. A competitor has a design registration, but the prospective user has prior art possibly relevant to the competitor's registered design. Is it possible to invalidate the design registration, and how?

A20. The user can do it by filing an Invalidation Trial with the Appeal Board of the JPO, where the prior art will prove the lack of novelty of the design.

Q21. A product expected to be marketed has been found to include another's registered design. In such a situation, is a declaratory judgment action available in Japan?

A21. Yes, it is available, but apart from it, everyone can request the JPO to provide an opinion as to whether the product falls within the scope of other registered design under Art. 25 of the Design Law. If the request is made, a collegial body of three Examiners compares the requester's design with the registered design at issue. The charge is reasonable, and the time is short, as compared with a judicial declaratory judgment action in a court. This system is called "Hantei" accepted as "administrative judgment" which is not enforceable or appealable. However, the judicial judges respect the "Hantei" as an officially recognized opinion.

Q22. A competitor has a registered design similar to a prospective seller's product, but the seller's design was once placed in the market by another distributor in Japan. Can the seller qualify for any advantages due to the prior use?

A22. Yes. The seller may assert a prior user's right under the Design Law Art. 29. The fact of prior use also can be used as a ground for invalidating the registered design.

Q23. If a registered design has not been used in Japan for a long time, is there a possibility of a compulsory license or invalidation due to non-working?

A23. No. The Design Law has no provision for a compulsory license or invalidation due to non-working.

Q24. How can the proprietor of a secret registered design warn an alleged infringer?

A24. The warning must be done by showing a copy of the registered design certificate authenticated by the JPO. The Design Law provides no presumption of negligence for secret design.

Q25. What remedies for infringement of a registered design are available?

A25. The remedies that can be enjoyed are an injunction, a compensation for monetary damages and an order for apology in print media, such as newspaper, magazines (Art. 37 to 41).

IV. APPLICATION BASED ON FOREIGN APPLICATION

Q26. What point or points should be carefully considered when a Japanese design application is filed claiming priority based on an U.S. design patent application?

A26.

(A) Drawings

(1) It is required to submit front and rear views, top and bottom views, and right and left side views of an article. If the earlier U.S. application does not include one or more of these views, it should be necessary to newly prepare the missing views.

(i) If the overall appearance of a design to be protected cannot be specified by only the above six views, it may be necessary to submit a sectional view(s). For example, in a case where a design has a cylindrical shape provided at its top surface with a recess, a sectional view taken along a vertical line passing through the recess would have to be submitted.

(ii) If an article, to which a design relates, can change its shape in use or a portion of the article is releasable or deployed in use, it may be necessary to submit a view showing the article in its changed state. For example, if an article, to which a design relates, is a container with a removable lid, a bottom view of the lid and a top view of the container body may have to be submitted.

(2) The above views should be submitted upon the filing of a design application. It might not be allowed to submit the same in a later stage.

(B) Explanation of Article

If it might be difficult for an Examiner to understand a function of an article and/or how to use it, an "Explanation of Article" stating such a function etc. would have to be given. For example, if a design relates to an article which has not yet been known, the above "Explanation of Article" would have to be given.

(C) The number of designs to be included in a (single) design application

In a case where the earlier U.S. application includes

therein more than one design (embodiments), it would be necessary to confirm whether a (single) design application with drawings including more than one design should be filed or separate applications, one for each design, should be filed.

In this connection, please refer to Q4 and A4.

(D) Grace period for loss of novelty

If, before the earlier U.S. application is filed, a design has already been publicly known anywhere, a Japanese design application should be filed within six months from the date on which the design was publicly known, while claiming priority based on the earlier U.S. application.

Q27. What point or points should be carefully considered when a Japanese design application is filed claiming a priority based on a Community Design (CD) application?

A27. It is basically the same as that to Q26 and the following would have to be particularly considered:

It is often found that CD applications were filed with color photographs. Nevertheless, the applicant of the above CD application may provide Japanese patent attorneys with drawings without colors for Japanese design application.

Additionally, the applicant may send a priority certificate to a Japanese patent attorney before the filing of a Japanese design application and photographs, which are attached to the priority certificate, may be of black and white.

Thus, in case where it is assumed that a CD application was filed with color drawings or photographs, the same should be confirmed before the filing of a Japanese design application.

Q28. What point or points should be carefully considered when a Japanese design application is filed claiming a priority based on a foreign application?

A28. It is basically the same as that to Q26 and the following would have to be particularly considered:

A partial design application, in which only a portion(s) of a design is claimed, is not acceptable in foreign countries that have no partial design registration system (e.g. China). Therefore, it is not allowed to claim a priority based on such an earlier foreign application for a Japanese design application when a partial design application is filed in Japan.

CONCLUDED