

Decision in Respect of Substantive Requirements for Grant of Protection

March 2016

**Design Division
Japan Patent Office**

Article 18 (Examiner's decision to the effect that a design registration is to be granted)
Where no reasons for refusal are found for an application for design registration, the examiner shall render a decision to the effect that **a design registration is to be granted.**

Article 20 (Registration of establishment of a design right)

(1) A design right shall become effective upon registration of its establishment.

(2) The establishment of a design right shall be registered where the registration fee for the first year under Article 42(1) has been paid.

(3) Where the registration under the preceding paragraph has been effected, the following matters shall be published in the design bulletin:

- (i) the name, and the domicile or residence of the holder(s) of the design right;
- (ii) the number and the filing date of the application for the design registration;
- (iii) the registration number and the date of registration of establishment;
- (iv) the contents of the application and drawing , photograph , model or specimen attached to the application; and
- (v) other necessary matters.

(The rest is omitted)

Industrial Applicability

[Body of paragraph 1 of Article 3]

(Possibility of repeatedly producing the same articles using industrial technology is needed)

Novelty

[Paragraph 1 of Article 3]

(Another design which is identical or similar to the design did not exist prior to the filing of the application for design registration.)

Creative Difficulty

[Paragraph 2 of Article 3]

(A person ordinarily skilled in the art of the design would have not been able to easily create the design .)

[Examples of objects that can be easily created]



Soap in a simple star pattern



Stationary article in the shape of the Eiffel Tower

First to file

[Article 9]

(The applicant who filed the application for design registration on the earliest date shall be entitled to obtain a design registration for the design.)

(1) Finding of a design in connection with an application for design registration



(2) Prior design search



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



(4) Notification of reasons for refusal



(5) Where a written opinion or a written amendment of proceedings has been submitted



(6) Examiner's decision

Article 6.(1), Design Act

A person requesting a design registration shall submit to the Commissioner of the Patent Office **an application** stating the following matters and **drawings** depicting the design for which registration is sought

1. Name and domicile or residence of the applicant;
2. Name and domicile or residence of the creator of the design; and
3. Article to the design

Article 6 (2) to (7) of the Design Act and the Ordinance for Enforcement of the Design Act stipulate in detail how the application and drawings should be prepared.

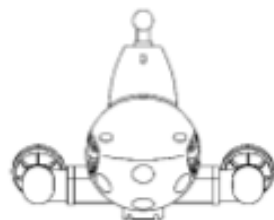
Form 6 (In relation to Article3), and the Ordinance for Enforcement of the Design Act
“As for the drawings showing the three-dimensional shape, front view, rear view, left side view, right side view, top view and bottom view which made on the same scale by the Orthographic Projection Drawing Method shall be prepared as a set of drawings.”

* The above matters are formality requirements.

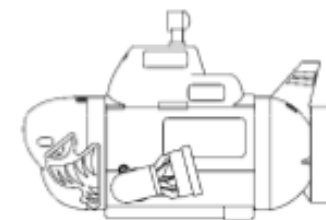
【書類名】	意匠登録願
【整理番号】	19-A-3-AN
【提出日】	平成〇〇年〇〇月〇〇日
【あて先】	特許庁長官 殿
【意匠に係る物品】	安全用スイッチ錠
【意匠の創作をした者】	
【住所又は居所】	東京都千代田区霞が関3-3-2
【氏名】	意匠一郎
【意匠登録出願人】	
【識別番号】	000000003
【住所又は居所】	東京都千代田区霞が関3-3-3
【氏名又は名称】	意匠株式会社
【代理人】	
【識別番号】	100000023
【住所又は居所】	東京都千代田区霞が関3-3-4
【弁理士】	
【氏名又は名称】	代理一郎
【電話番号】	03-3123-4567
【手数料の表示】	
【予納台帳番号】	012345
【納付金額】	16000
【提出物件の目録】	
【物件名】	図面 1
【意匠に係る物品の説明】	この物品は…
【意匠の説明】	背面図は…
【書類名】	図面
【正面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>
【背面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>
【左側面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>
【右側面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>
【平面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>
【底面図】	<input type="checkbox"/>
イメージ	<input type="checkbox"/>

【意匠に係る物品】無線操縦玩具

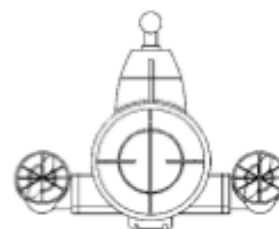
【正面図】



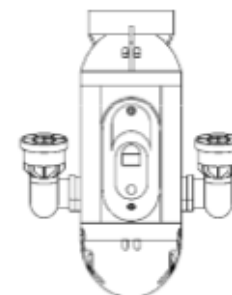
【右側面図】



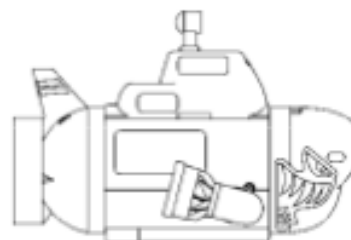
【背面図】



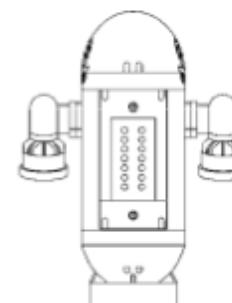
【平面図】



【左側面図】



【底面図】



Application for Design Registration

【Article to Design】

: should be based on examples of articles shown in the lower column of the appended table 1 of the Ordinance for Enforcement of the Design Act.

【Creator of Design】

: should be an individual, not company or group name.

【Applicant for Design Registration】

: Creator of a design or individual or company who inherited the right of

【Description of article to design】

: Explanation to help understanding of the purpose of use or the state of use of the article, .etc. It should be written if necessary.

【Description of design】

: Explanation to help understanding of the change of form based on the function, transparency and so on.

Article 3, Design Act

A creator of a **design that is industrially applicable** is 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 foreign countries, prior to the filing of the application for design registration; or
- (iii) Designs similar to those prescribed in the preceding two items.

(Paragraph (2) is omitted.)

Structured as a design

The design must be specific.

The design must be applicable to industrial use.

Structured as a designs

Examples of things not considered as a design

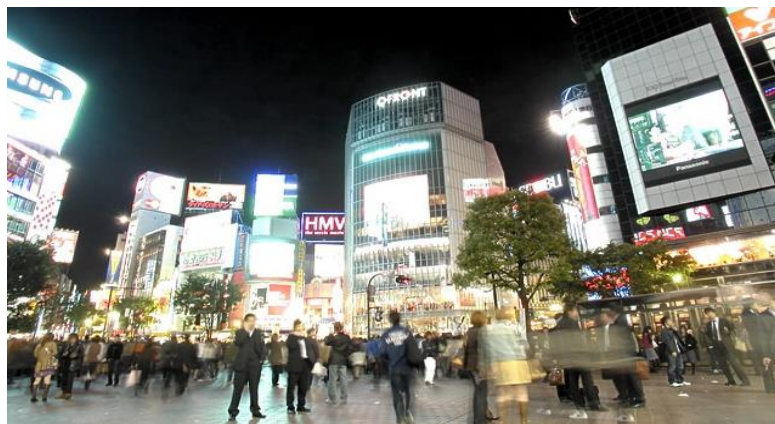


Fountains



Fireworks

Nightscapes



Powder

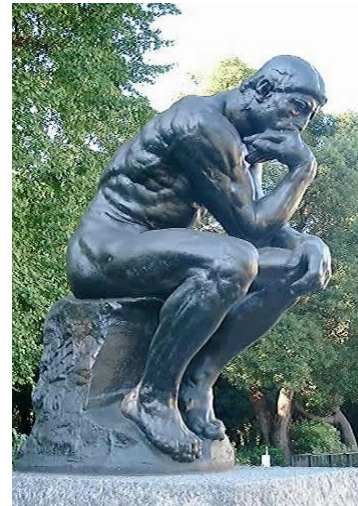


Icons

The design must be applicable to industrial use

<Examples of designs not considered as applicable to industrial use>

- (i) Articles that use a natural object as a major element of the design and are not mass-producible
- (ii) Immovable articles such as land and buildings
- (iii) Works of fine art



Novelty. (Article 3. (1), Design Act)

A design that has been publicly known or described in a distributed publication may not be registered because of the lack of novelty.

Not only designs that are identical but also those that are similar to publicly known designs shall be regarded as lacking in novelty.

Judgment of Design Similarity

Principles of Judging Similarity

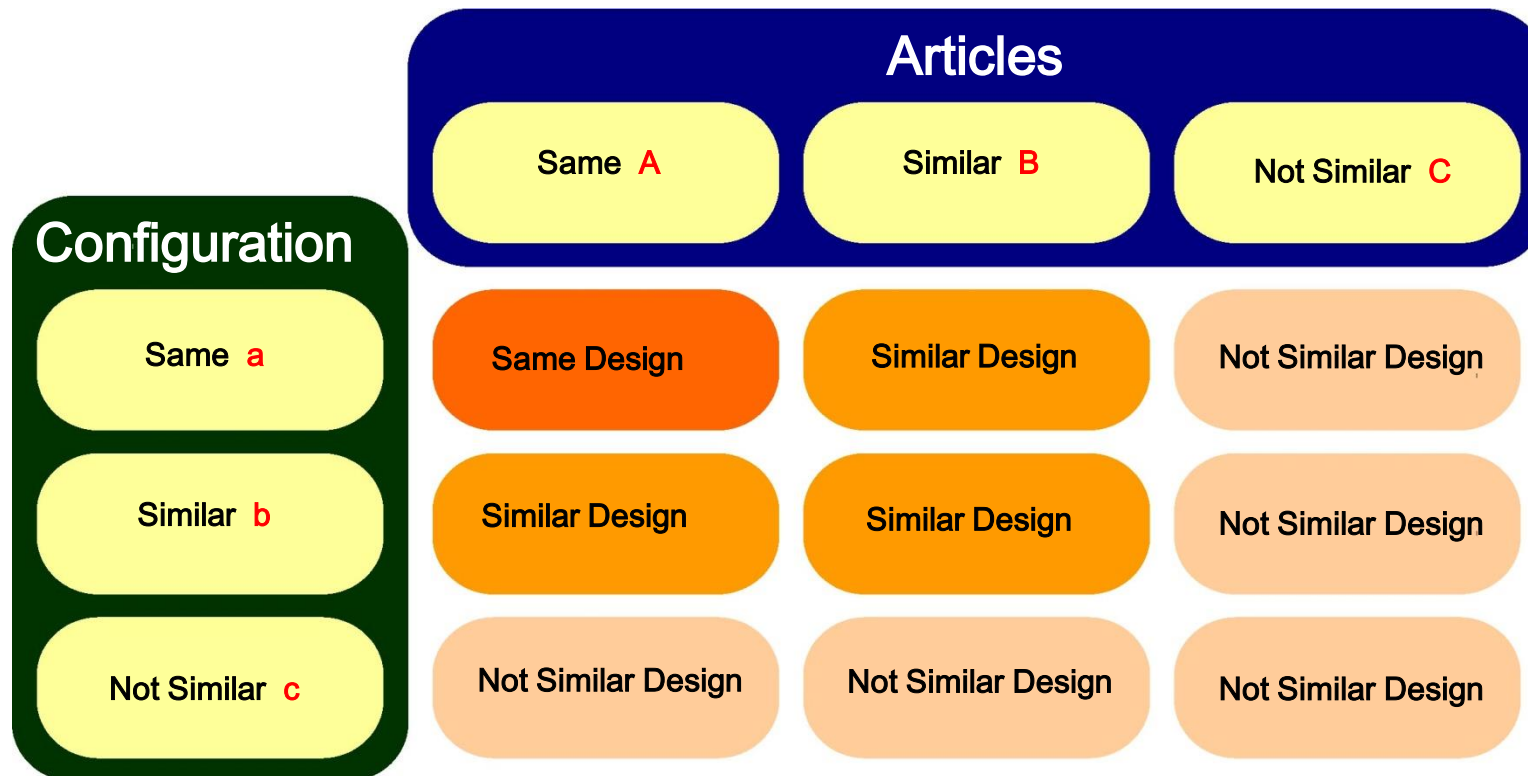
- Persons who make a judgment are users (incl. business partners)
- Observation by direct comparison
- Overall observation
- Judgment based on comparison with prior designs

Method of Judging Design Similarity

Points focused on in judging similarity:

Recognition of an article pertaining to both designs being compared, and judgment of similarity

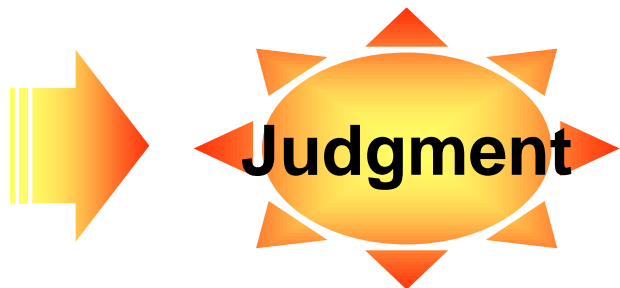
Relationship between an article and its shape/form/configuration or pattern in connection with the judgment of similarity



Judgment of Design Similarity

Generally,

- Recognition of the gist of both designs
- Recognition of common points and different points regarding the use and functions of an article of the designs
- Recognition of common appearances/points and different appearances/points regarding shape/form/configuration
- Evaluation of common appearances/points and different appearances/points
 - (1) Where the shape/form/configuration or pattern are compared, recognition of which part thereof draws attention and evaluation on to what degree it draws attention
 - (2) Evaluation of the degree to which the design draws attention based on the comparison with earlier designs

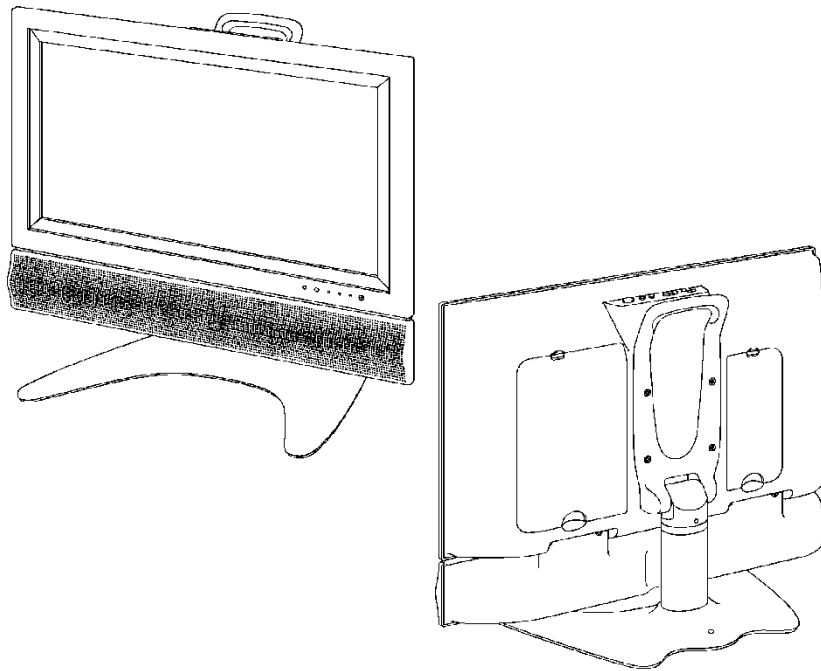


Design similarity is finally judged as overall designs by comprehensively observing and evaluating common appearances/points and different appearances/points.

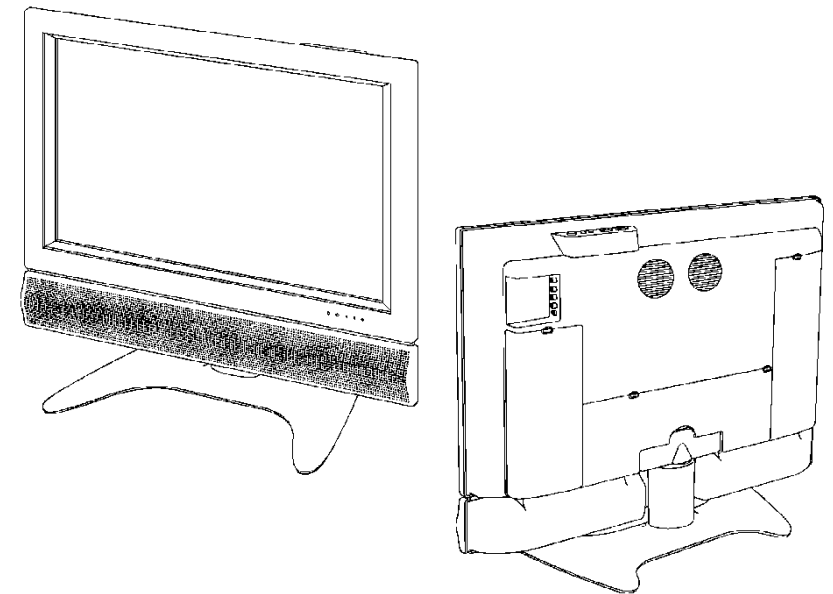
General evaluation point (1) regarding common appearances/points and different appearances/points

- Visible parts have relatively large impact.

“Liquid crystal TV receiver”



Similar



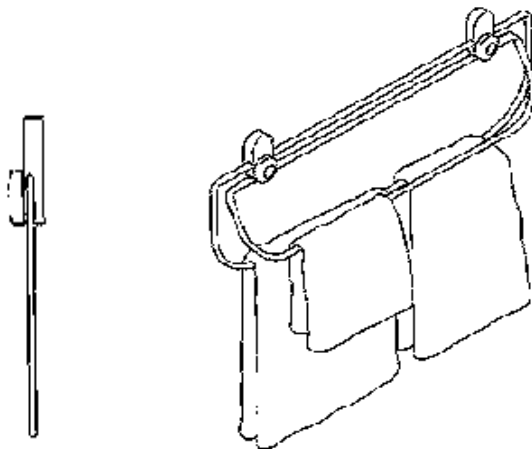
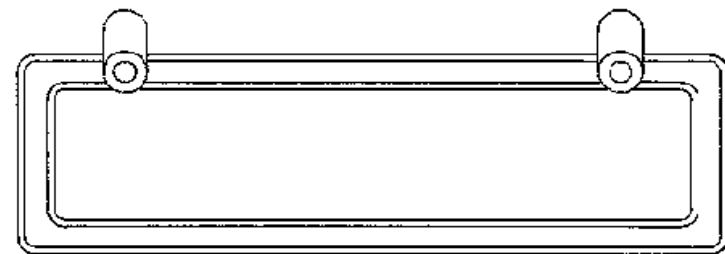
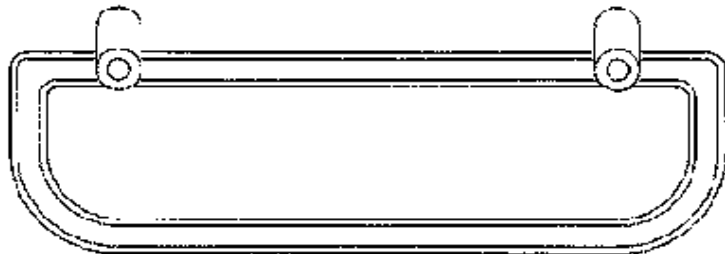
Design Registration No. 1193615 (Principal design)
LC TV receiver

Design Registration No. 1193716 (Related design)
LC TV receiver

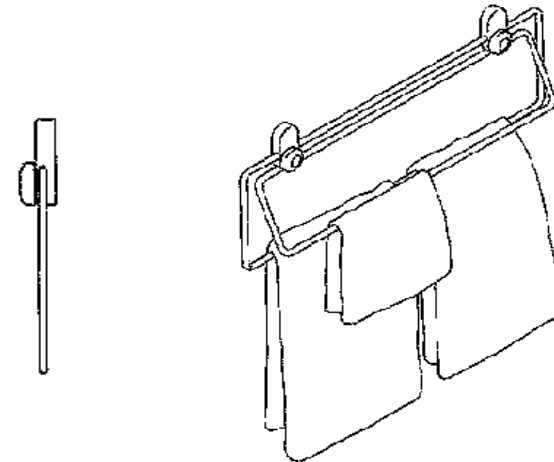
General evaluation point (2) regarding common appearances/points and different appearances/points

- Commonplace shape/form/configuration has relatively small impact.

“Towel hanger”



Similar



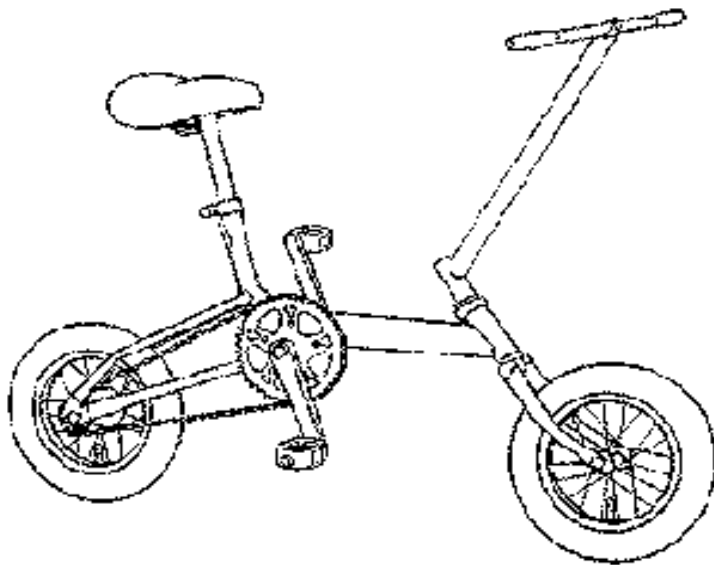
Design Registration No. 896055
“Towel hanger”

Similar Design No. 1 of Design Registration
No. 896055 “Towel hanger”

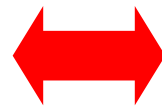
General evaluation point (3) regarding common appearances/points and different appearances/points

- **Difference in size has practically no impact if it is within a normal range in the area to which the design in question pertains.**

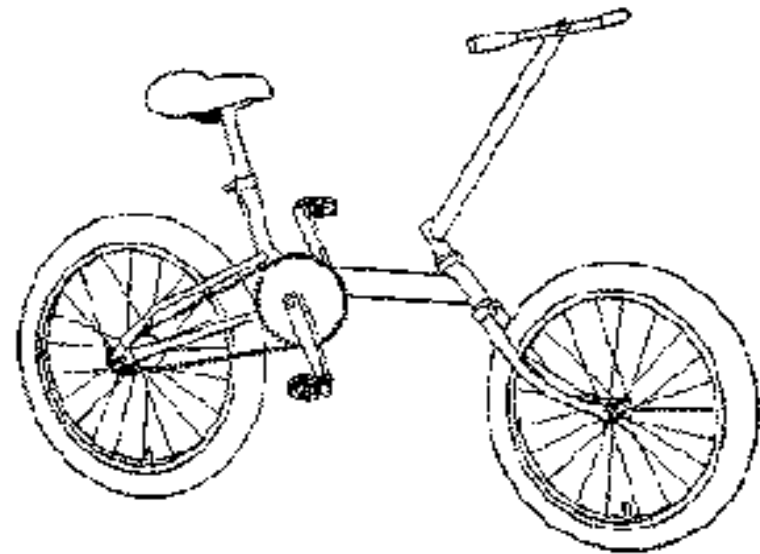
“Bicycle”



Design Registration No. 1050871
“Bicycle”



Similar




Similar Design No. 2 of Design Registration
No. 1050871 “Bicycle”

General evaluation point (4) regarding common appearances/points and different appearances/points

- If difference is merely in color and/or material, there is hardly impact compared with differences in shape/form/configuration or pattern.

“Shopping basket”




Similar



Design Registration No. 168756
“Shopping basket”

Similar Design No. 1 of Design Registration
No. 168756 “Shopping basket”

Points of judgment on whether or not the design is easy to create

1. Person has common knowledge in the technical field to which the design pertains (**person skilled in the art**).
2. The design **in question** is created based on a publicly known **shape/configuration**.
3. The design **in question** is created based on a publicly known **shape/configuration** and by an ordinary and commonplace **method by a person skilled in the art**.

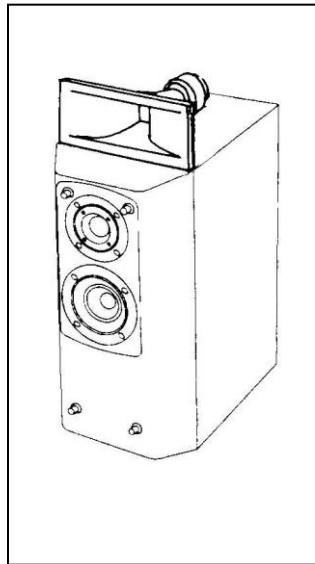
* The deciding factor for making a judgment on creative difficulty

Based on the Design Act, the deciding factor for making a judgment on creative difficulty is a “person who has common knowledge in the technical field to which the design pertains (person skilled in the art).”

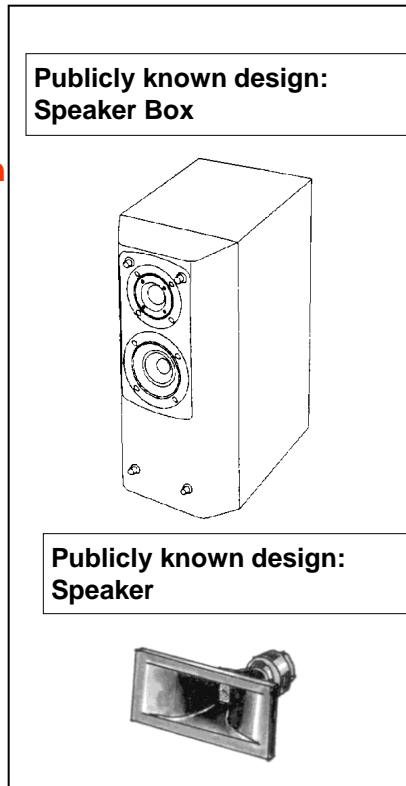
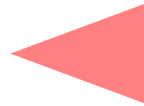
The person skilled in the art stated here is **a person who belongs to the industry that manufactures and sells the article to which the design is applied, and has common knowledge of designs in that industry (person skilled in the art)** at the time the design registration application was filed.

Juxtaposition/ aggregation of designs

“Speaker Box”

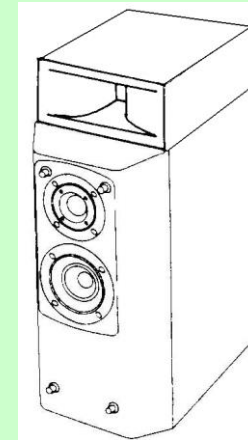


Ordinary juxtaposition



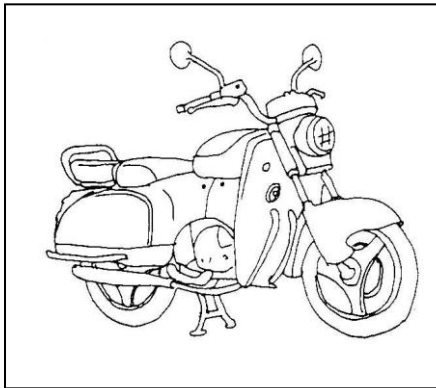
[Reference]

Example where a design is NOT recognized as constituted by collection of designs which were publicly known (lower left) by ordinary technique of a person skilled in the art

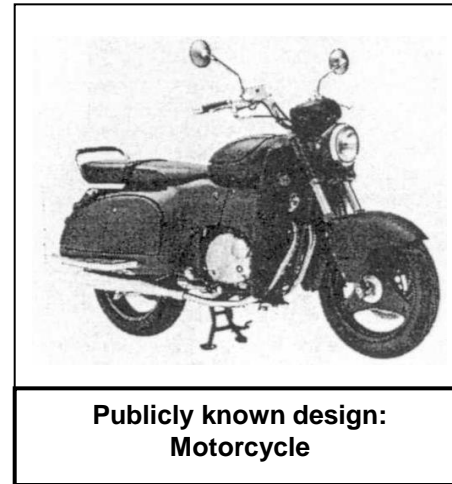
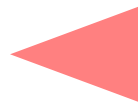


Design created by conversion of common commercial practice

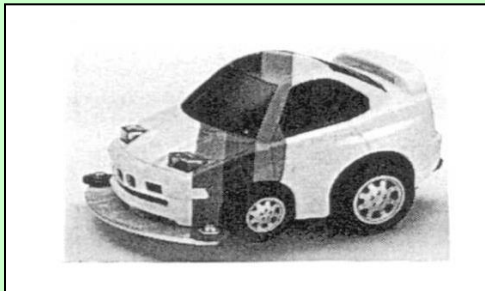
“Toy Motorcycle”



Ordinary
conversion



[Ref] “Toy Car”



[Example of NOT admissible as difficult to create]
The left “Toy Car” design transcends the scope of transformation common to commercial practices for a person skilled in the art.
Accordingly, it is not admissible as difficult to create even by a person skilled in the art.

Prior Application (Article 9 of the Design Act)

[Two or more design applications relating to the same or similar design filed on different dates]

(1) When the prior application and subsequent applications are filed by **different** applicants

When two or more design applications relating to the same or similar design are filed on different dates by different applicants, only the first applicant may obtain a design registration for the design, pursuant to Article 9, paragraph 1 of the Design Act.

Prior Application (Article 9 of the Design Act)

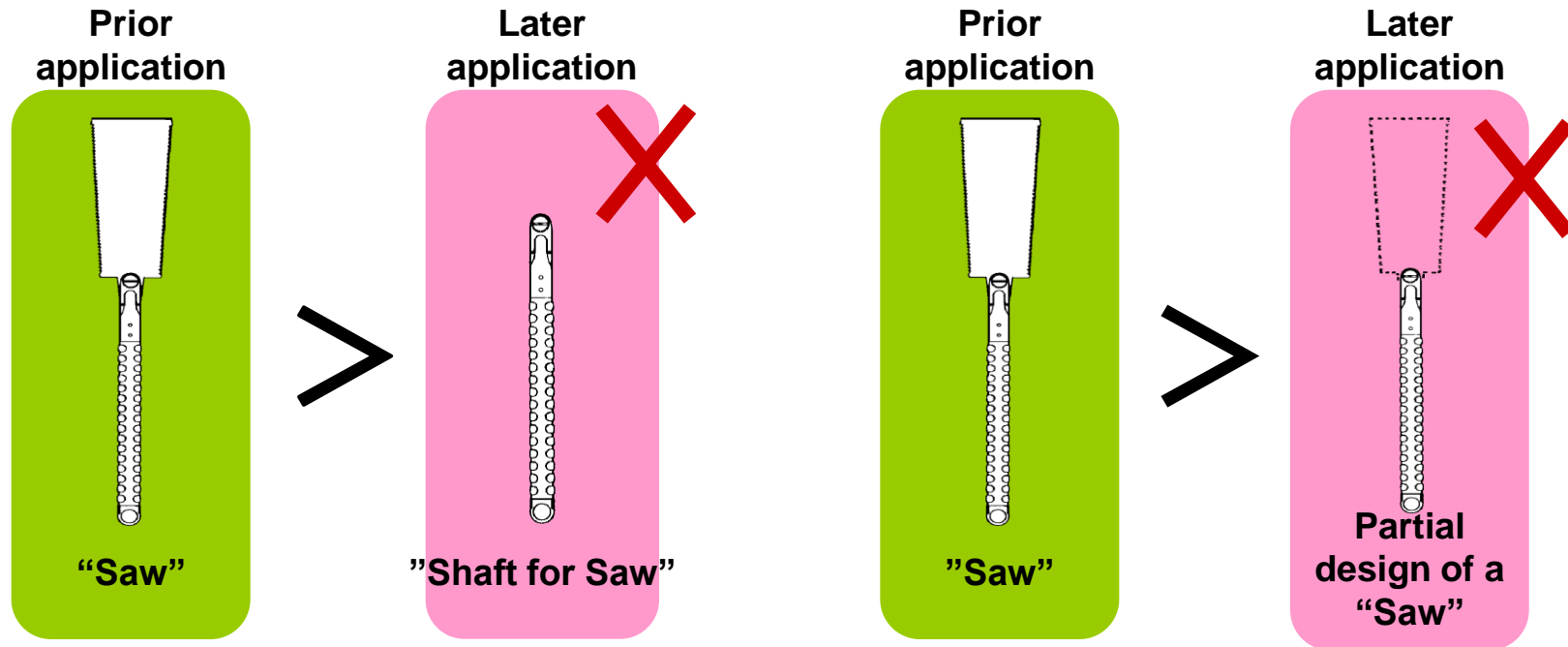
[Two or more design applications relating to the same or similar design filed on different dates]

(2) When the prior application and subsequent applications are filed by the **same** applicant

When two or more design applications relating to a similar design are filed by the same person on different dates, the applicant may obtain registration for a design related to his/her own design application, or a design similar or related to one design selected from designs in his own design registrations (hereinafter, “principal design”) and designs related to the principal design, only if the design falls under Article 10, paragraph 1 of the Design Act.

No Protection for Later-Applied Design which is Same or Similar to Part of Prior-Applied Design (Article 3 bis.)

A design in a later application that is identical with or similar to part of a design as claimed in an earlier application does not qualify for design registration.



* Provided, however, that a design registration shall be effected for any design that meets the following conditions:
① The prior application and a later application for the design registration is filed by the same applicant; or
② The application for design registration is filed prior to the publication of the prior application in the Design Bulletin.

- Design Bulletin [DA20(3)]
 - Issued in the same format as used for nationally-filed designs, in order to make it easy to conduct searches for prior design rights based on international registration
- Design Register [DA60-19]
 - Allowing you to understand design rights based on international registration regarding all items recorded in the National Design Register

National Design Register

- Establishment of a design right
- Transfer of the design right
- Extinction of the design right
(except in the case of the expiry of the term)
- Extinction of design right
(due to the expiry of the term)
- Establishment of exclusive license
- Establishment of pledges
etc.

▪ These are the duplications of what has been recorded in the International Register, and transfer and extinction of design rights based on international registration (except in the case of the expiry of the term) are based on what has been recorded in the International Register.

National Procedures after the International Publication

