

# **Legislative Work for Accession of Japan to the Hague Agreement as an Examining Office**

**March 2016**

**Design Division  
Japan Patent Office**

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# Background of Japan's Accession to the Geneva Act

## The number of design applications being filed overseas by Japanese companies show an increasing trend reflecting economic globalization

- Companies that have increased the number of design applications filed overseas in the last decade : **61%**
- Rate of increase in the last decade **has doubled**.

Source: IIP Research 2012

### Opinions from Japanese industry

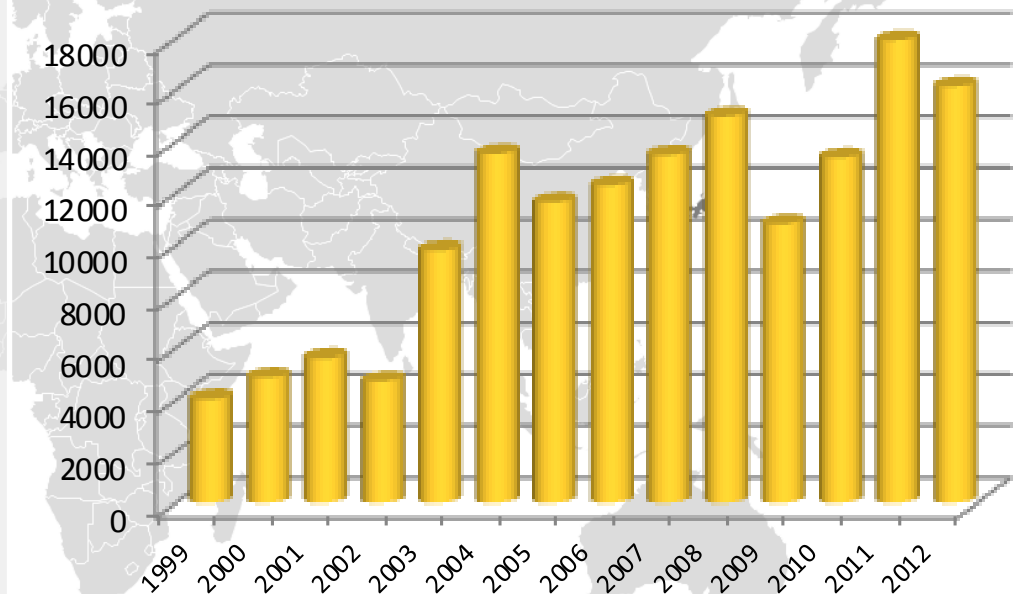
- We consider design rights as a means not only for combating counterfeits but also for expanding our market. We have increased the number of countries when filing applications. (Automobile industry)

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- Our company's management policy attaches great importance to the international market, so our filing strategy for designs is also becoming overseas-oriented. (Electronic equipment industry)

- Designs are the "face" of our products. We are actively filing design applications overseas to expand global businesses. (General electronics industry)

### Number of Design Applications Filed from JP to Overseas



Source: WIPO statistics

## 2011-2012

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2011.6 “Intellectual Property Strategic Program 2011” by Intellectual Property Strategy Headquarters, established in the Cabinet, “Consider Japan’s Accession to the Hague Agreement Concerning the International Registration of Industrial Designs, and reach a conclusion.”

2011.12 - Research, analysis, and discussion by the members of the Design System Subcommittee of the Intellectual Property Committee of the Industrial Structure Council, advisory body for Ministry of Economy, Trade and Industry

## 2013

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2013.6 “Japan Revitalization Strategy” by the Cabinet:  
“... the government will finalize a draft that reviews the industrial design protection system corresponding to the Hague Agreement within this fiscal year, and subsequently will submit relevant bills to the Diet in a timely manner, in order to make protection of product designs and such easier on a global level”

## 2014

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- 2014.2 Final Report by the Intellectual Property Committee of the Industrial Structure Council
- 2014.3 Relevant bill and the Act were submitted to the Diet
- 2014.4 Diet approves amendments to the Design Act
- 2014.5 Diet approves accession to the Geneva Act of the Hague Agreement
- 2014.12 Revised Examination Guidelines for Design was approved at the WG on the Examination Guidelines for Designs

## 2015

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- 2015.1-2 Revised ordinances and revised regulations were promulgated
- 2015.2.13 Deposit of the instrument of accession to the Geneva Act of the Hague Agreement
- 2015.5.13 The Act came into force in Japan  
Amendment to the Design Act came into force  
(International applications based on the Geneva Act started being accepted)

# Declarations

Article 7(2)	Individual fee in respect of a designation made under the 1999 Act and in respect of a renewal requested under the 1999 Act
Article 13(1)	Requirement of unity of design
Article 17(3)(c)	Maximum duration of protection under the national law <ul style="list-style-type: none"><li>- 20 years from the date of the registration of the establishment of a design right in Japan.</li></ul>
Rule 9(3)(a)	Certain views of the design required <ul style="list-style-type: none"><li>- where the product which constitutes the industrial design is three-dimensional article, a front view, a rear view, a top view, a bottom view, a left side view and a right side view, each made in compliance with the method of orthographic projection method, are required.</li></ul>
Rule 18(1)(b)	Extension to 12 months of the refusal period
Rule 18(1)(c)(ii)	Date of effect of the international registration <ul style="list-style-type: none"><li>- where a decision regarding the grant of protection was unintentionally not communicated within the period of 12 months from the publication of the international registration, the international registration shall produce the effect referred to in Article 14(2)(a) of the 1999 Act at a time at which protection is granted according to the Design Act of Japan.</li></ul>



## Individual Designation Fee

**Amounts  
(in Swiss francs)**

International Application	– for each industrial design	582
First Renewal	– for each industrial design	659
Second Renewal	– for each industrial design	659
Third Renewal	– for each industrial design	659
Fourth and Subsequent Renewals	– for each industrial design	0

# Amendment of the Design Act

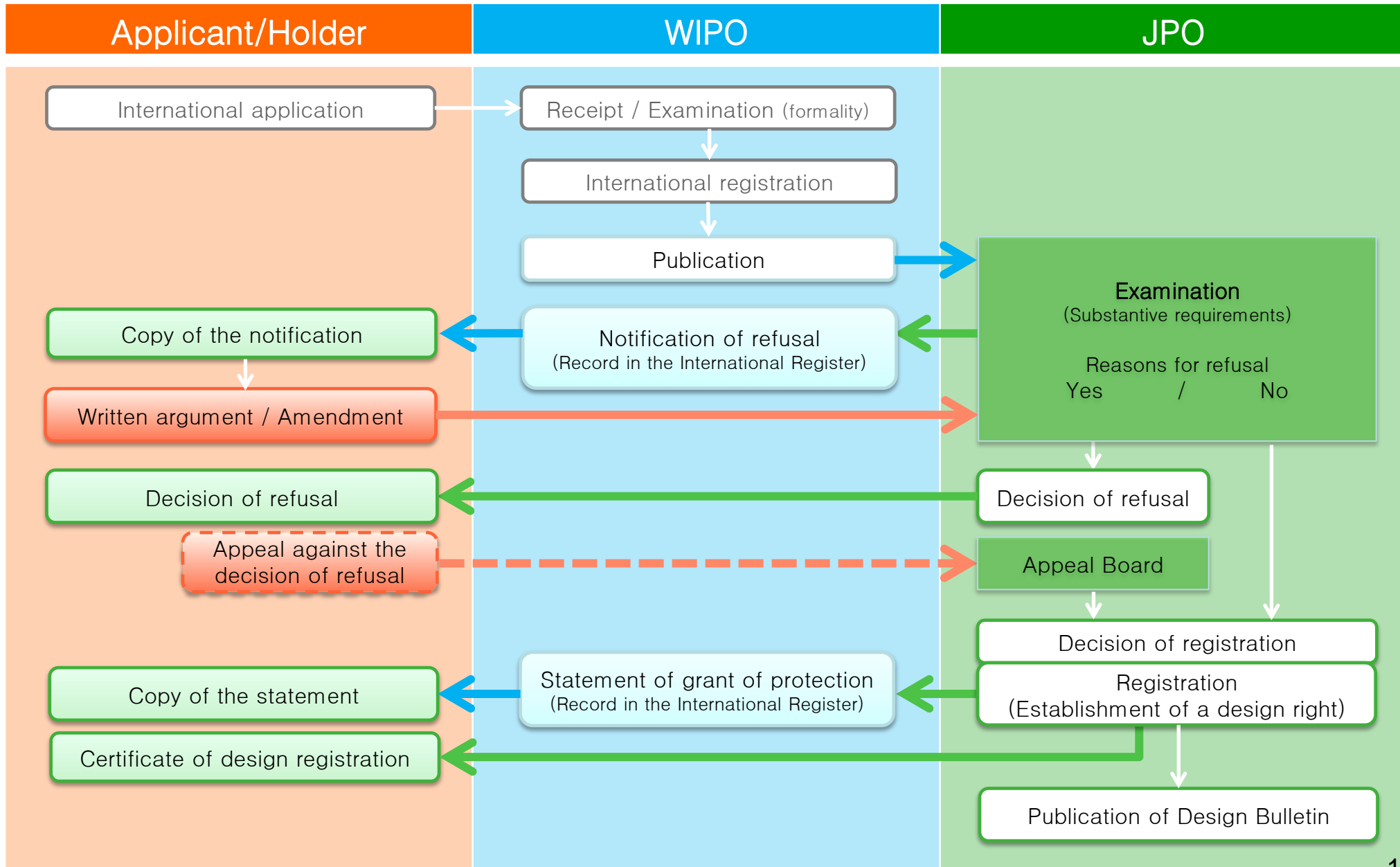
## Issues that were considered in acceding to the Geneva Act of the Hague Agreement and their solutions

Issues	Solutions
International registration containing multiple designs	Deemed as multiple applications filed for each design contained in the international registration
Deferment of publication	Permit max 30 months
Application to international applications	
Exceptions to lack of novelty	Applicable
Partial design	Applicable
Secret design	Not applicable
Related design	Applicable
Publication of bulletins and administration of the design register	Publish design bulletins and maintain the design register in Japan
Payment of fees (Individual designation fee)	One-time payment (Payment in two parts NOT applicable) (In case of refusals, the amount equivalent to the registration fee may be refunded.)
Self designation	Applicable
Indirect filing through the JPO	Applicable
Right to compensation after the international publication	Introduced (New)

**DA:** Article of revised Japanese Design Act

**A:** Article of Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs

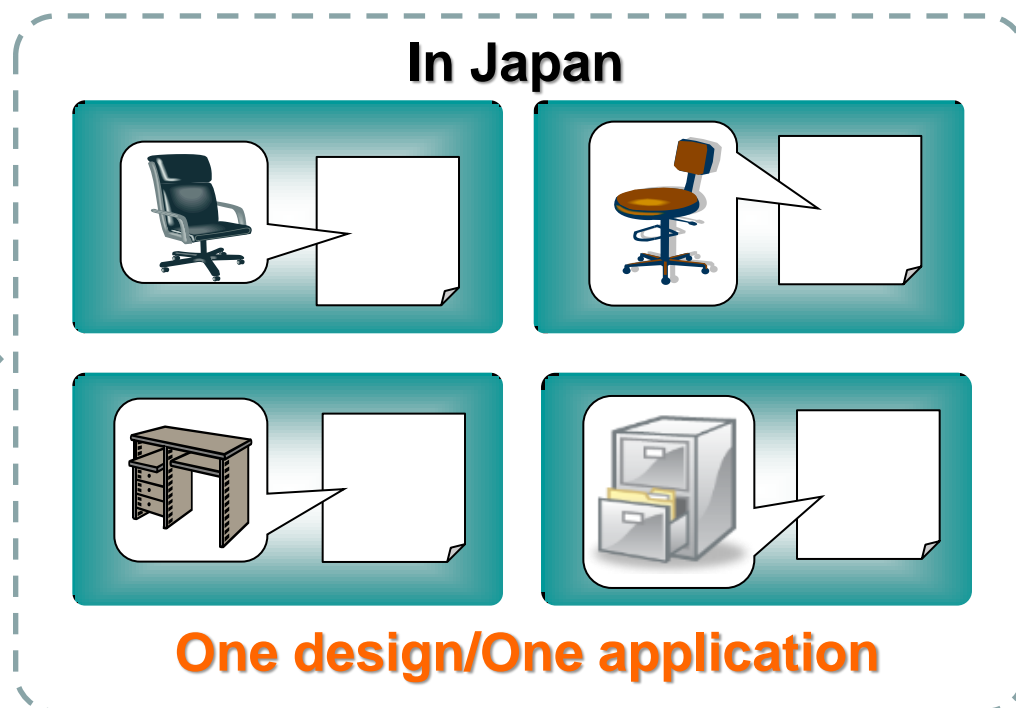
**S:** Section of Administrative Instructions for the Application of the Hague Agreement



- An international application which designates Japan under the Geneva Act and has been registered and published shall be deemed to be an application for design registration in Japan filed on the date of the international registration. (“International Application for Design registration (IAD)”)
- treated in the subsequent procedures in the same manner as that used for a regularly filed national application based on the provisions of the Design Act.

[DA60-6(1)]





When an international application (registration) includes two or more designs, the international application is regarded to be multiple domestic applications in Japan.

- Substantive examination is carried out independently on each design.
- When an examiner decides to grant a design right for one of the designs, the individual design right is established and registered.

- In considering an IAD, “the matters recorded in the International Register” pertaining to the relevant international application shall be considered to be “the matters stated in the application submitted pursuant to Article 6, paragraph (1) of the Design Act”
- In considering an IAD, “the design recorded in the International Register” pertaining to the relevant international application shall be considered to be “the design for which design registration is requested as depicted in the drawing submitted pursuant to Article 6, paragraph (1) of the Design Act”

[DA60-6(3)]

[DA60-6(4)]



## 1. Statement

[A5(3)]  
[S408]

➤ Submit to the International Bureau of WIPO at the time of filing an international application: or

[DA60-7]

➤ Submit to the JPO within 30 days after the international publication

## 2. Certificate proving that the relevant design is eligible

[DA60-7]

➤ Submit to the JPO within 30 days after the international publication

## 1. Claim

- [A6(1)(a)] ➤ State necessary matters in the application form of the international application (DM/1) at the time of filing an international application

## 2. Certificate

- [DA60-10] ➤ Submit to the JPO within 3 months after the international publication

- 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

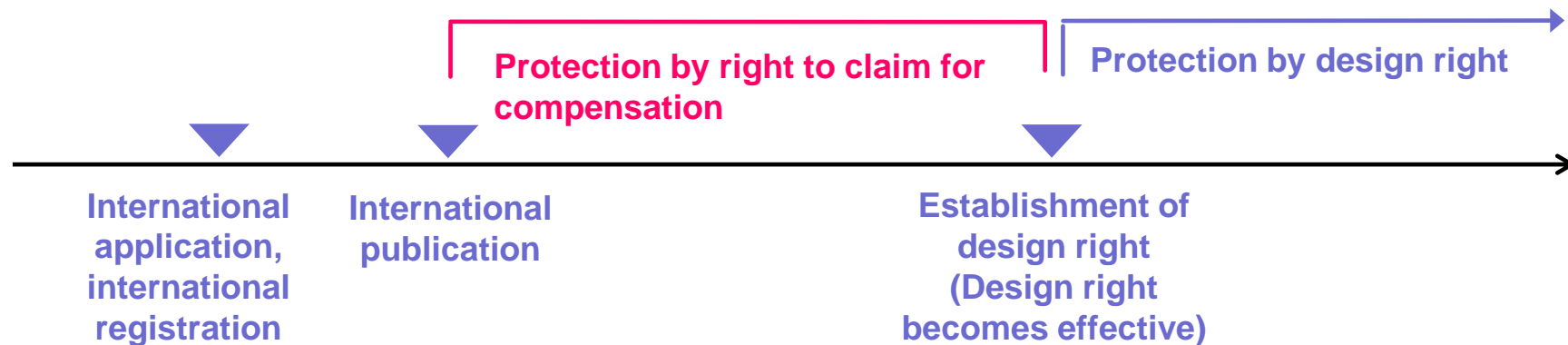
- Establishment of a design right;
- Transfer of the design right;
- Extinction of the design right (except in the case of the expiry of the term);
- Extinction of design right (due to the expiry of the term);
- Establishment of exclusive license;
- Establishment of pledges;
- etc.

▪ 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.

## Right to claim compensation after international publication

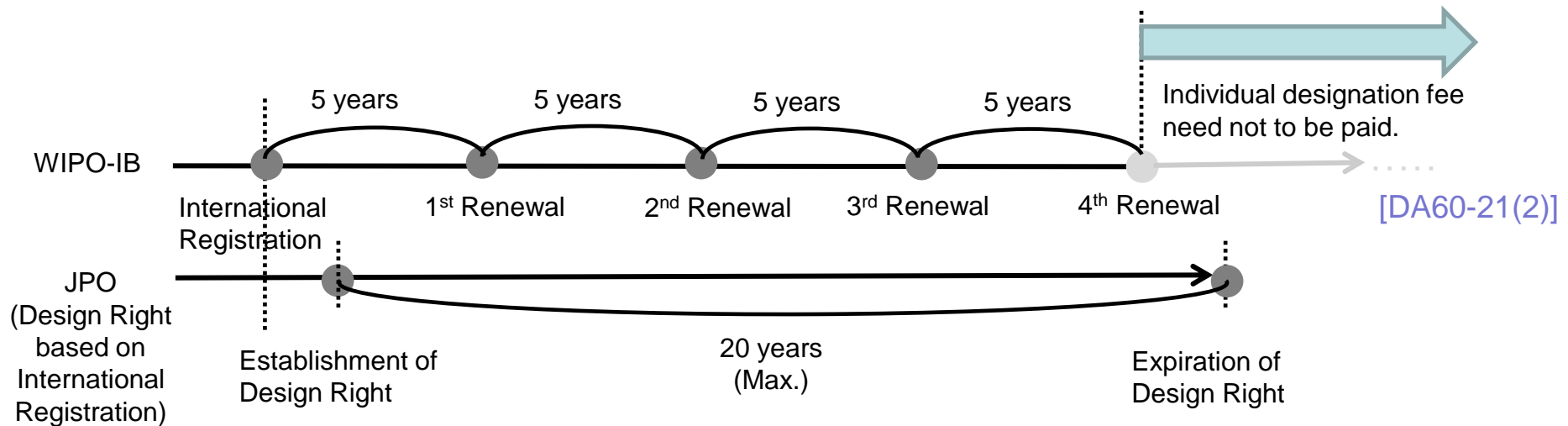
With regard to the industrial design contained in an international registration, upon registration establishing a design right in Japan, the holder may also claim compensation against a person who has worked the industrial design or industrial designs similar thereto as a business after the publication of the international registration and prior to the registration establishing a design right in Japan.

[DA60-12]



## Duration of design rights

- The maximum duration of a design right in Japan is 20 years from the date of the registration of the establishment of a design right in Japan (not from the date of the international registration).



## Request for refund of the individual designation fee

In the following cases, the individual designation fee paid in respect of the designation of Japan may be partially refunded (in Japanese yen) upon request to the JPO within six months;

[DA60-22(1)(2)]

- where the examiner's decision or trial decision of refusal has become final and binding in Japan, or
- where the application for design registration deriving from an international registration designating Japan has been deemed withdrawn and such an application does not exist any longer (e.g. renunciation and/or limitation of the international registration in respect of Japan, etc.).