

Internal Process for Substantive Examination of International Registrations and National Applications

March 2016

**Design Division
Japan Patent Office**

Revision of the Examination Guidelines for Designs

1. Matters that must be clarified in order to appropriately examine an international application for design registration as an application for design registration in Japan
 - e.g., Correspondence relationship between the matters recorded in the international register and the matters to be stated in the application or depicted in the drawing of the application for design registration

2. Impact on examination of domestic applications that is caused by the acceptance of international applications
 - e.g., Judgement of prior and later applications in cases where the prior application is an international application for design registration

3. Procedure of examination based on the purport of the Geneva Act
 - e.g., Cases requiring notification of refusal

- Correspondence relationship between matters recorded in the international register and matters stated in the application

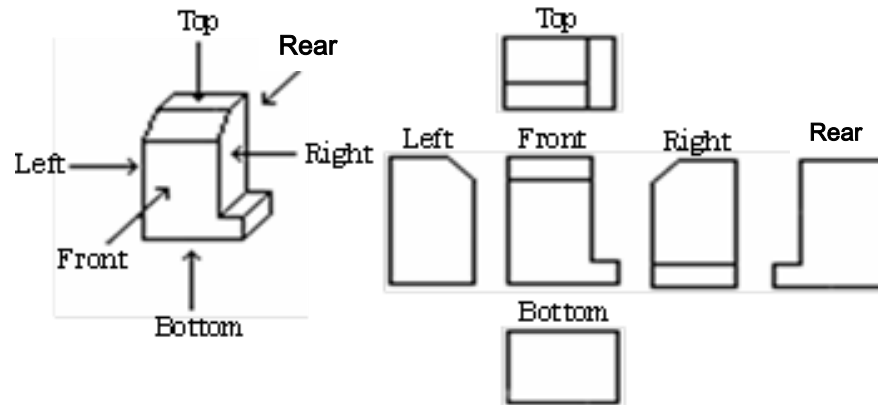
Matters recorded in the international register	Matters stated in the application for design registration
Product or products which constitute the industrial design that is the subject of the international registration or in relation to which the industrial design that is the subject of the international registration is to be used	[Article to the design]
Name and address of the holder of the international registration	Name and domicile or residence of the [Applicant for the design registration]
Name and address of the person who created the design that is the subject of the international registration	Name and address or residence of the [Person who created the design]
Brief description of the reproduction or of the characteristic features of the industrial design that is the subject of the application	[Description of the Design] or [Description of Article to the Design] * In an international application for design registration, these matters are both stated in the column of [Description of the Design] without being distinguished.
Indication of principal application or registration or principal industrial design	[Indication of the principal design]
Declaration concerning exception to lack of novelty	Statement of “Application for design registration with the request for the application of the provision of Article 4, paragraph (2) of the Design Act” in the column of [Special notes]
Declaration claiming the priority of earlier application	[Priority Claim under the Paris Convention, etc.]

- Correspondence relationship between the reproduction and drawing of the design

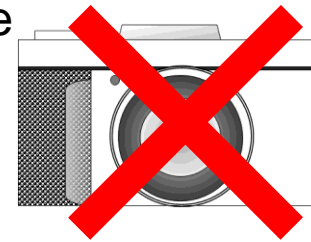
Reproduction of the design recorded in the international register

Drawing depicting the design for which registration is requested

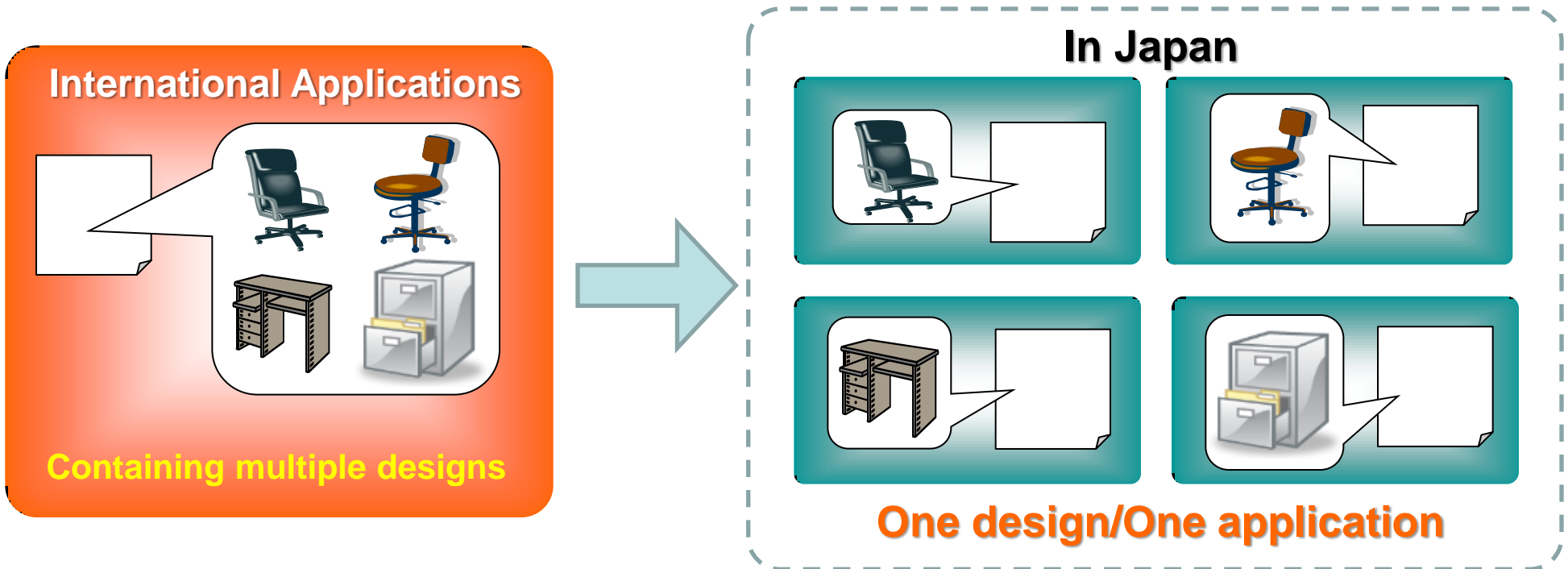
- The standards for determining whether or not a design contained in an IAD shall be the same as the standards for domestic applications
- where the design contained in an International Application for Design registration is found unspecific (e.g. it does not include a set of 6 view drawing (six-sided views, although the design is of a three-dimensional article)), such application shall be the subject of refusal based on the substantive requirements under the Japanese Design Act



▪ Example



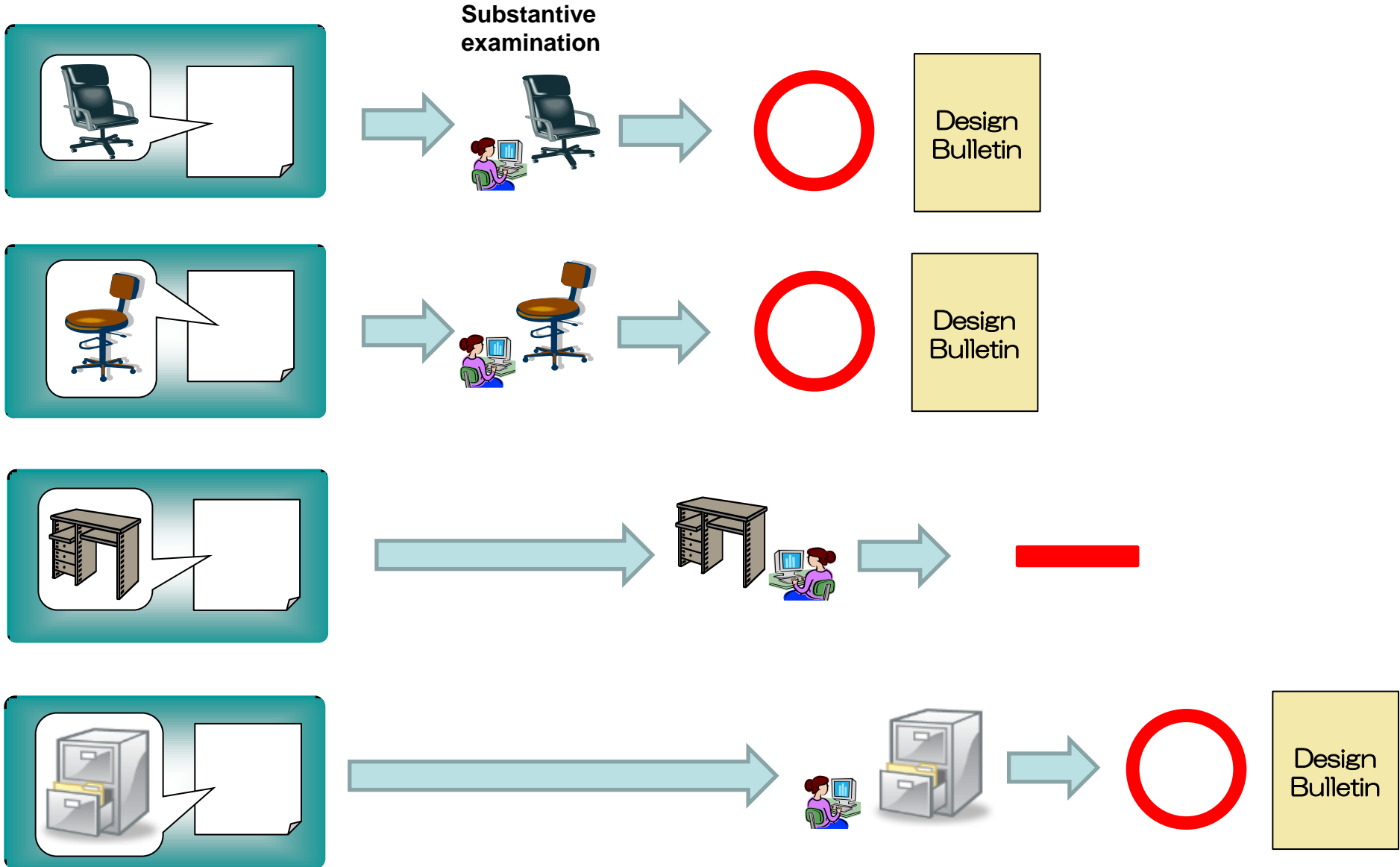
The design of a three-dimensional article is shown in only one view.



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

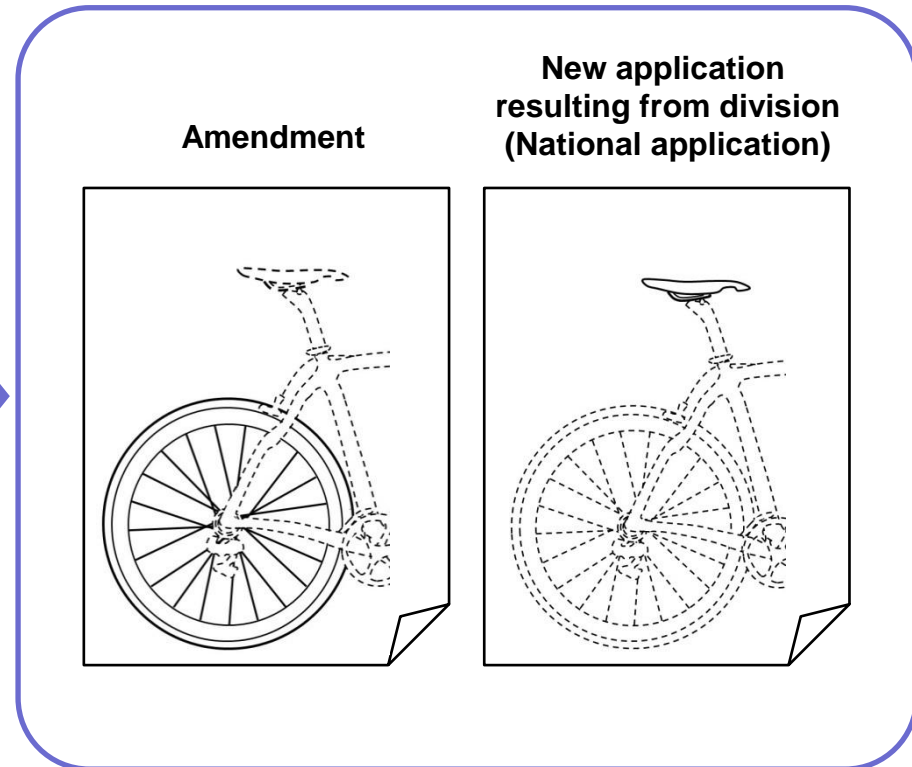
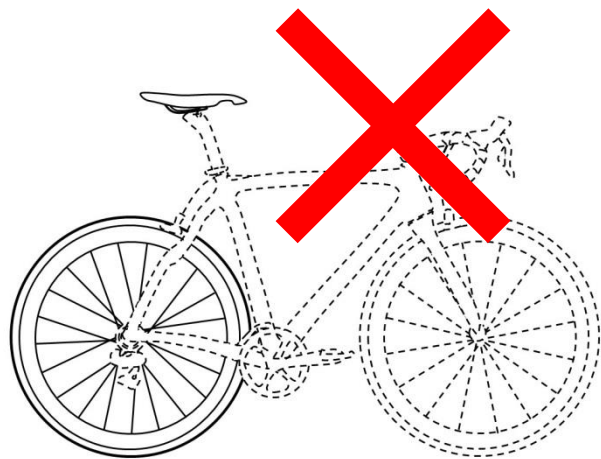
- Substantive examination is carried out independently on each design.
- When an examiner decides to grant a design right for one of the designs, the individual design right is established and registered.

Accepting Int. Applications Containing Multiple Designs



- A design in an international registration which does not satisfy the requirement of one application per design rule stipulated in Article 7 of the Design Act shall become the subject of refusal

□ Example for not satisfying “one application per design” rule



- The application form for international applications has no section to specify the design that is the subject of the international application is a “partial design.”
- Where an international application for design registration satisfies all of the following requirements, such application shall be determined to be an application for a “partial design” in Japan.
 - Clearly indicates that design registration is sought for a part of an article in both drawings and description.
 - Based on the ordinal skill in the art of the design, the article to the design and specific contents of the usage and function, position, size and scope and form of the “part for which design registration is requested” may be directly drawn from the application and drawing.

■ Examples determined to be applications for a “partial design”



Omitting other drawings

DM/076606 (Design No. 6)

“No protection is sought for the features of the designs indicated by broken lines, shown in the representations.”



Omitting other drawings

DM/072618 (Design No. 7)

“The broken line disclosure (head) does not form part of the claimed design ”



Omitting other drawings

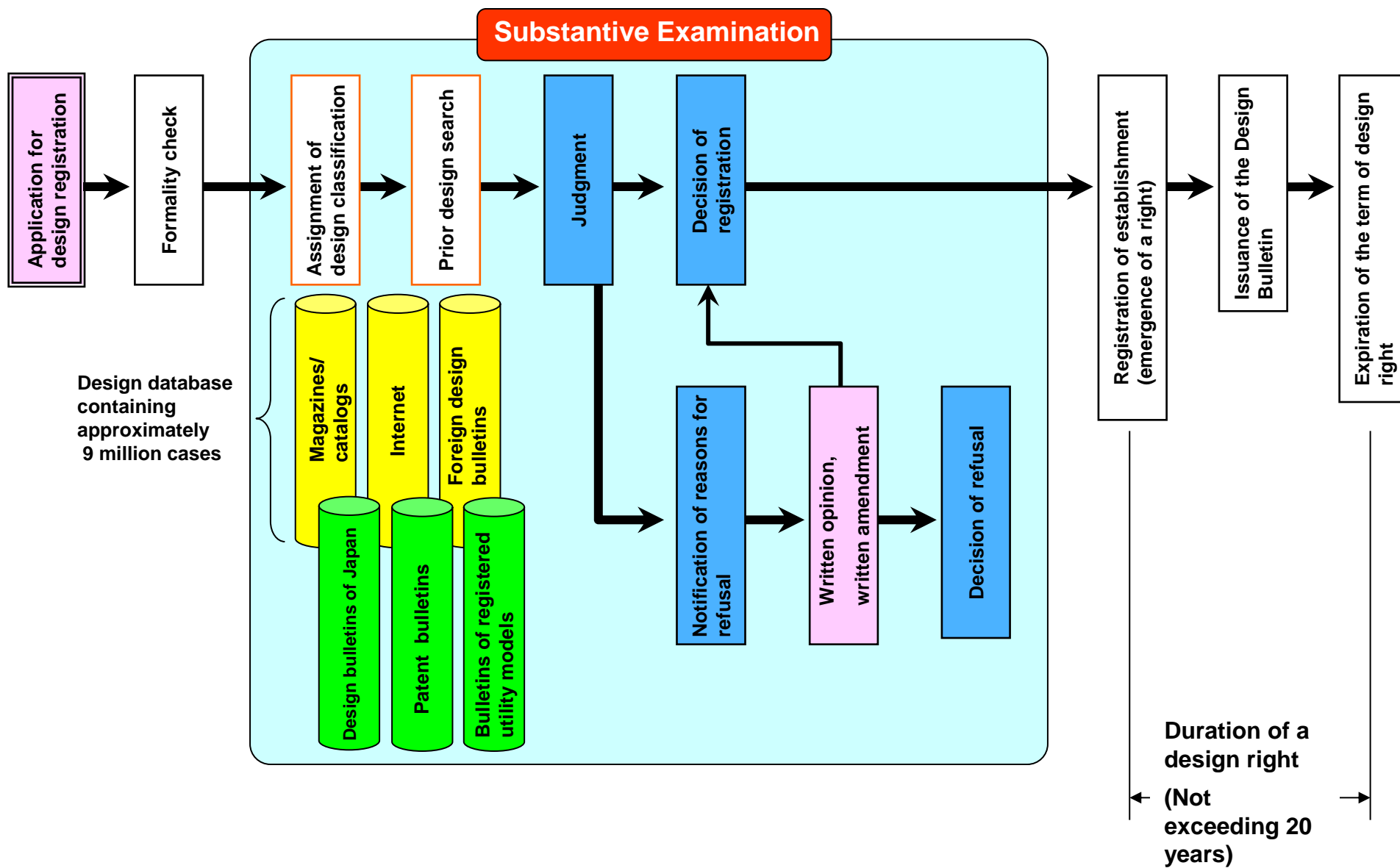
DM/081639 (Design No. 2)

“the blue marked parts are not coming into the scope of the industrial design (disclaimer)”

- The JPO will send a notification of refusal via the International Bureau of WIPO in the following cases where the international application for design registration falls under the case “where the conditions for the grant of protection under the law of that Contracting Party are not met.”
 1. Cases where any of the reasons for refusal (the items of Article 17 of the Design Act) is applicable to the international application for design registration concerned.
 2. Cases where there is a need to wait for the procedures or disposition related to the IAD concerned to become final and binding.
 3. Cases where there is a need to wait for a disposition for an application other than the IAD concerned to become final and binding.
- As a response to the notification of refusal issued by the JPO, the holder of the international registration may submit a written opinion or an amendment to the JPO.

Procedures of Design Examinations

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Main articles relating to the procedures for examination

- Examination by examiners: Design Act Article 16
- Decision of refusal: Article 17
- Dismissal of amendment: Article 17-2
- Decision of design registration: Article 18
- Notification of reasons for refusal: Patent Act Article 50 as applied mutatis mutandis pursuant to Article 19
- Formality of examiner's decision: Patent Act Article 52 as applied mutatis mutandis pursuant to Article 19

Basic principle for examination

- (1) Timely, high quality, fair and transparent examination: Unified examination
- (2) Determination based on prior design searches and requirements for registrability:
Maintenance and further improvement of the quality of examination
- (3) Communications between the applicant and his/her representative: Efficient examination

Procedures for examination

(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

(1) Finding of the design in an application for design registration

(i) Finding of a whole article

- 1) The article to the design
- 2) The form of the article to the design

(ii) Finding of a partial design

- 1) The article to the design of the partial design
- 2) The usage and function of the “part for which the design registration is requested”
- 3) The position, size and scope of the “part for which the design registration is requested”
- 4) The form of the “part for which the design registration is requested”

(iii) Matters to consider in finding a design

improper statement or depiction: determination is made as to whether or not it is reasonable to give a favorable construction

(2) Prior design search

(i) Reference material

Information for use in examination are published prior designs etc., which contribute to the determination on the novelty, creative difficulty, etc. of the design in the application

(ii) Method of a prior design searches

- 1) Setting of the scope of search: Forms of the request and attached drawings which attract attention
- 2) Targeting at information for use in applications, documents of nationally and internationally publicly-known designs, websites and documents of patent and utility model
- 3) Setting of the scope of information for use in examination to be searched
- 4) Consideration of whether or not the scope of search should be expanded

(iii) 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.

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

- (i) Confirmation of bibliographic data of the information

- (ii) Determination of similarity between designs in determining novelty, etc.
 - 1) The determining entity of similarity is consumers (incl. traders)
 - 2) Whether or not the use and function of an article are identical or similar
 - 3) Whether or not a cited design is expressed to the extent that it can be compared with the design
 - Finding of the common points and different points
 - Evaluation of the common points and different points
 - (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) Evaluating the extent to which the forms draw attention in comparison to prior designs
 - 4) Whether or not the designs create different aesthetic impressions on consumers (including traders)

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

(iii) Determination of creative difficulty

- 1) The determining entity of creative difficulty is a person ordinarily skilled in the art of the design (a person skilled in the art)
- 2) The information that serves as the basis for determination of creative difficulty is information that was publicly known or widely known.
- 3) Evidence of a specific fact showing that the design was created by an ordinary technique for a person skilled

(iv) Determination on whether or not the application for design registration falls under any of the items of Article 17 of the Design Act

Article 5: Grounds of unregistrability

Article 7: Whether the application for design registration is under a classification of articles as designated by the Ordinance of the METI or a classification of articles equivalent in level to such classification

(*METI = Ministry of Economy, Trade and Industry)

(4) Notification 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.

Points

- (1) With plain sentences and easy-to-understand key points
- (2) With regard to a design which is not specific and which is clearly not an industrially applicable designs, the improper parts in the statement in the application and drawings, etc. attached to the application and the reason therefor should be specifically indicated.
- (3) Where the design in the application does not comply with the requirements for novelty or prior application:
 - The reason for the determination in the examination should be specifically indicated source of the cited design should be stated.
- (4) Creative difficulty
 - Basic documents should be shown / It should be shown that the design was created easily by an ordinary strategy for those skilled in the art.
- (5) Where the application for design registration does not comply with the requirement of one application per design, the reason(s) for it should be specifically indicated.

(5) When a written opinion or a written amendment is submitted

- (1) Consideration of the content of a written opinions or written amendments:
Whether or not the reasons for refusal shown earlier have been dissolved.
- (2) Handling of written amendments
In the case where the amendment changes the gist of drawings attached to the request at the time of the filing: The amendment should be dismissed.
- (3) Notification of reasons for refusal after a written opinion or a written amendment is submitted:
When any other reasons for refusal are found, the reasons for refusal are notified again.

(6) Decision (Decision of registration / Decision of refusal)