

Roundtable on Refusals Issued by Designated Offices

Practice and Experience of the Japan Patent Office

Seminar on the Hague System

WIPO, Geneva
October 29, 2019

Mayako Oe

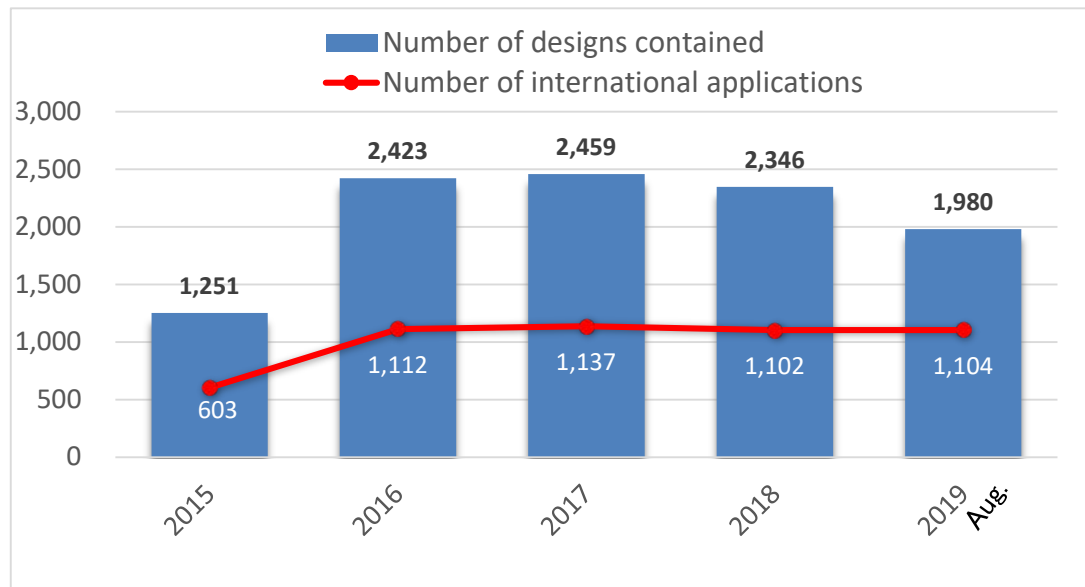
Senior Specialist for International Application

Japan Patent Office

- 1. Recent Trend of International Applications Designating Japan**
2. Refusals Issued by JPO
3. Practical Advice on Designation of Japan
4. Recent Revision of the Design Act and the Examination Guidelines for Design

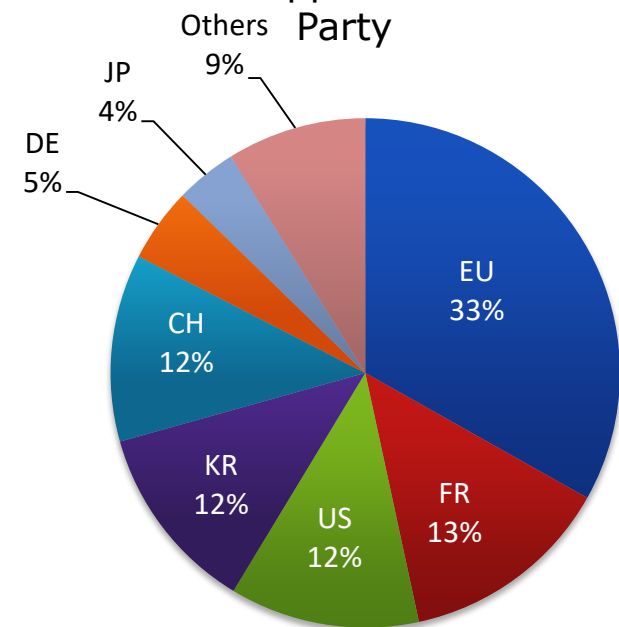
International Applications Designating Japan

- On May 13, 2015, Japan became the 49th contracting party to the Geneva Act of the Hague Agreement.
- During the period from May 13, 2015 to August 31, 2019;
 - ✓ Number of international applications designating Japan: 5,058
 - ✓ Number of designs contained: 10,459
- International applications designating Japan filed by European applicants accounted for 70% of the totality followed by the US (12%) and KR (12%).



Source: WIPO statistics under the Hague System

Breakdown of applicant's Contracting Party



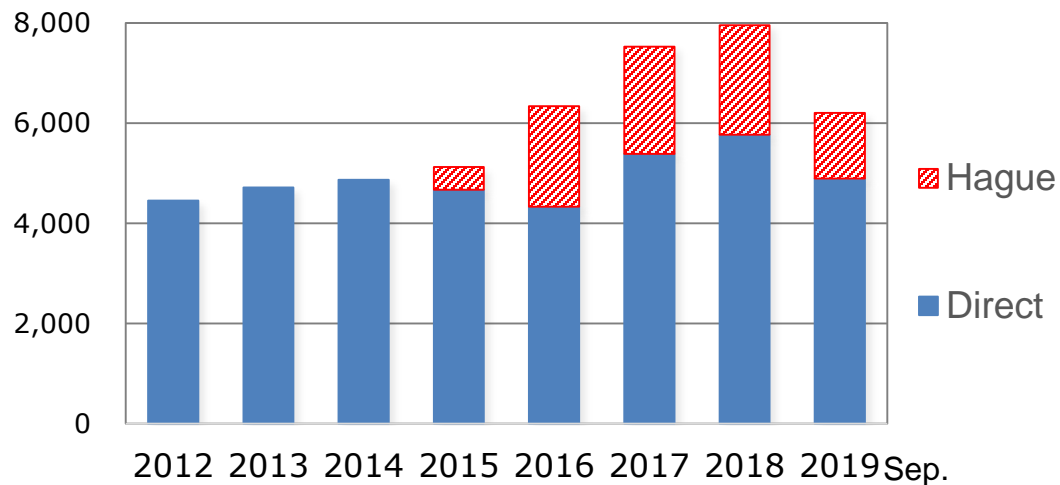
Source: WIPO Hague Express

- 3 most popular Locarno Classes are:
 - ✓ Class 14 Recording, Communication or Information Retrieval Equipment (9.5%)
 - ✓ Class 12 Means of transport or hoisting (9.5%)
 - ✓ Class 9 Packages and containers for the transport or handling of goods (8.7%)

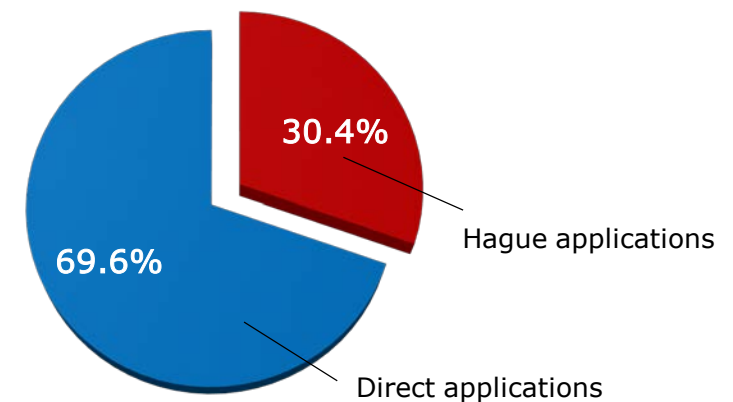
Source: WIPO Hague Express

- After the Japan's accession to the Geneva Act, the total number of design applications filed by foreign applicants has been increasing.

Design applications filed by foreign applicants via Hague route and direct route (Design count)

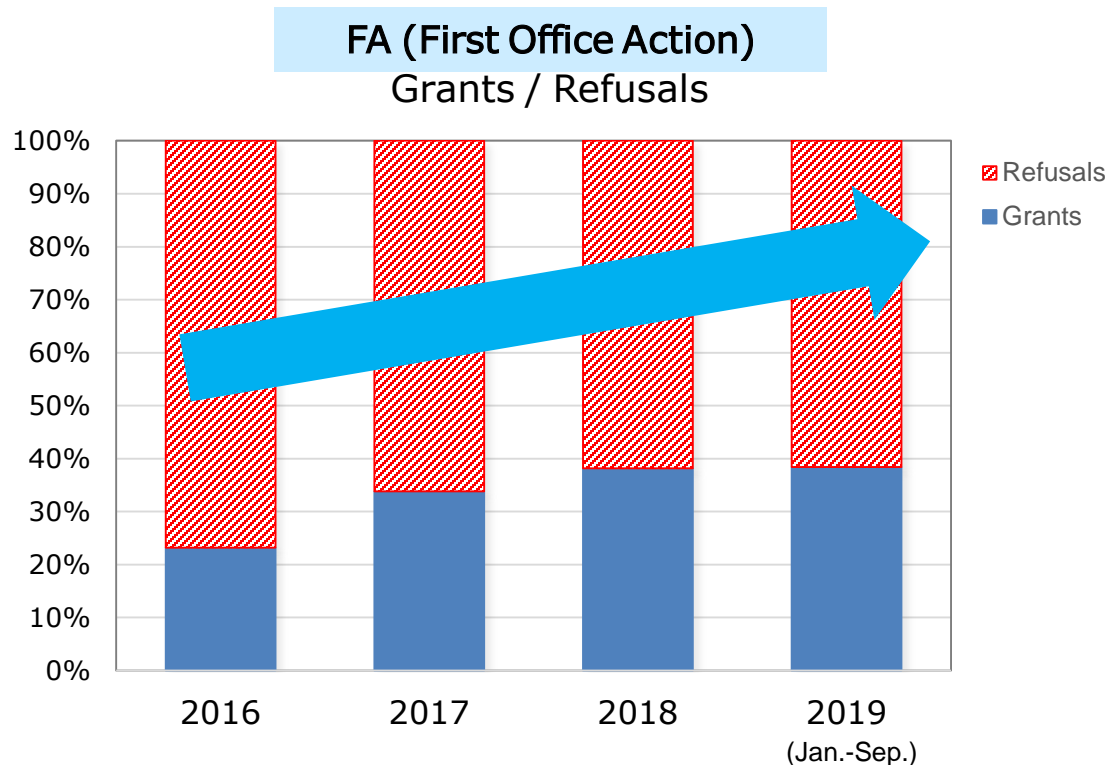


Breakdown of design applications filed by foreign applicants in 2019 (Jan. to Sep.)

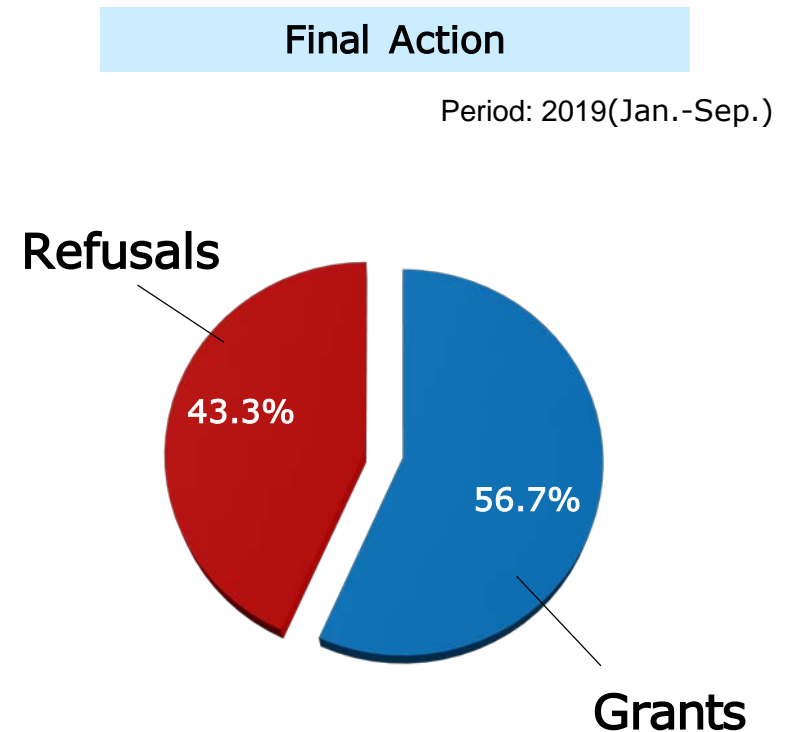


Source: JPO internal statistics

- In the last three years, the percentage of number of grants (statement of grant of protection as FA) in the totality has increased.
- As a result of the applicant responding in order to overcome the grounds for refusal, more than half of the international registration were granted.



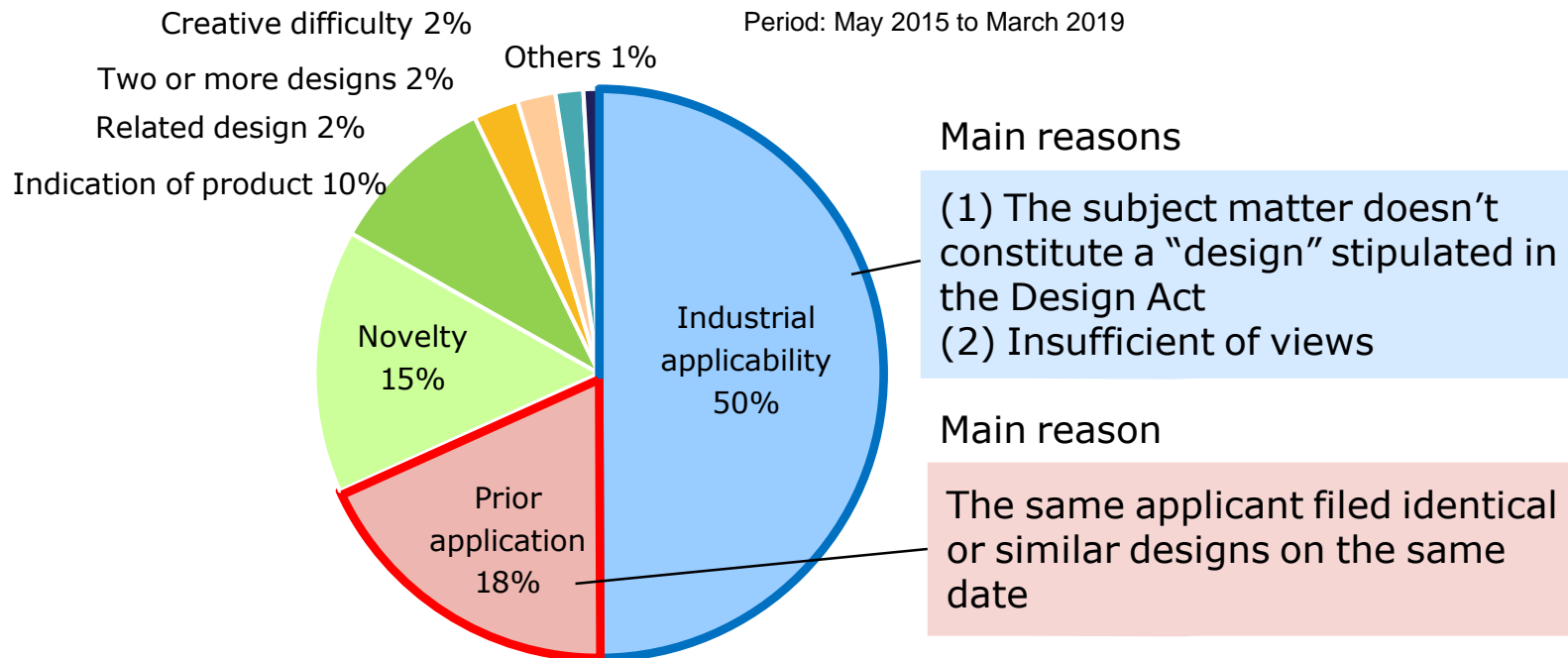
Source: JPO internal statistics



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- During the period from May 13, 2015 to September 30, 2019;
 - ✓ Number of grants (statement of grant of protection as FA): 2577
 - ✓ Number of refusals (notification of refusal as FA): 4,931
 - ✓ Average office action period: 5.9 months
- “Industrial applicability” and “Prior application” are two major grounds for refusal.

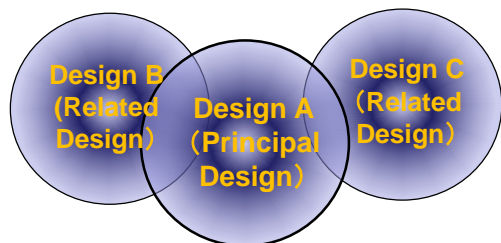
Breakdown of the refusals by ground



Source: JPO internal statistics

- Related design system is designed for better protection of variation designs and is the exception to the first-to-file rule.

Expansion and clarification of the scope of design right



- Where Design B is similar or identified to Design A which was filed on the same day or earlier, Design B is refused on the ground of conflict with Design A. However, if both designs belong to the same applicant/holder, Design B may be registered as a "Related design" * to Design A (in this case, Design A is called a "Principal design").

* Under the current Design Act, an application for the related design must be filed on or after the filing date of the principal design and before the date of its publication in the national design bulletin/international bulletin.

For more information, please see the following page on WIPO website(<https://www.wipo.int/portal/en/>);

"How to submit an international application to the International Bureau: E-filing or DM/1 form"

Item 16: Relation with a principal design (optional element applicable to the designation of Japan and/or Republic of Korea only)

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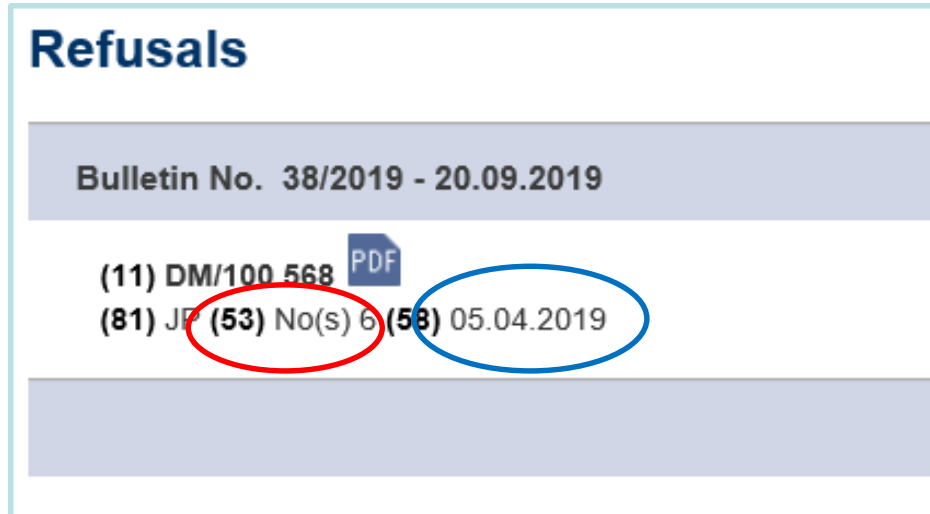
■ Response to the Refusal

➤ Notification of Refusal will be issued design by design

➤ Time Limit for Responding to Refusal

3 months : overseas resident (extendable)

60 days : resident in Japan (not extendable)

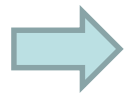


Refusals

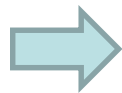
Bulletin No. 38/2019 - 20.09.2019

(11) DM/100 568 PDF

(81) JP (53) No(s) 6 (58) 05.04.2019



No response



“Decision of refusal”



See slide 12

➤ Representation Before the Office

local representation is required for all persons who do not have either a residence or domicile, or in the case of a legal entity, an establishment in Japan.

■ National procedures to be done after publication of the international registration

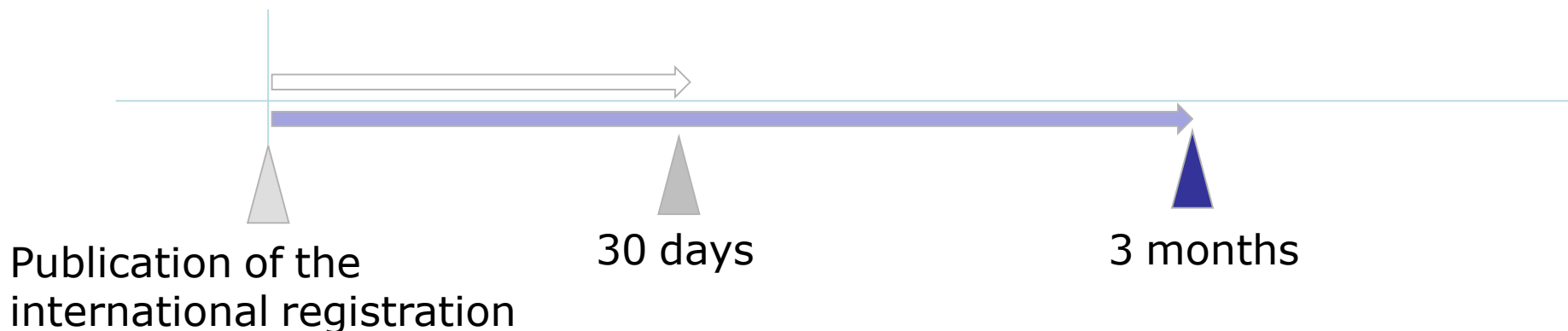
➤ Declaration of exception to lack of novelty

Supporting documentation must be submitted directly to the JPO within 30 days from the date of publication of the international registration.

➤ Priority document

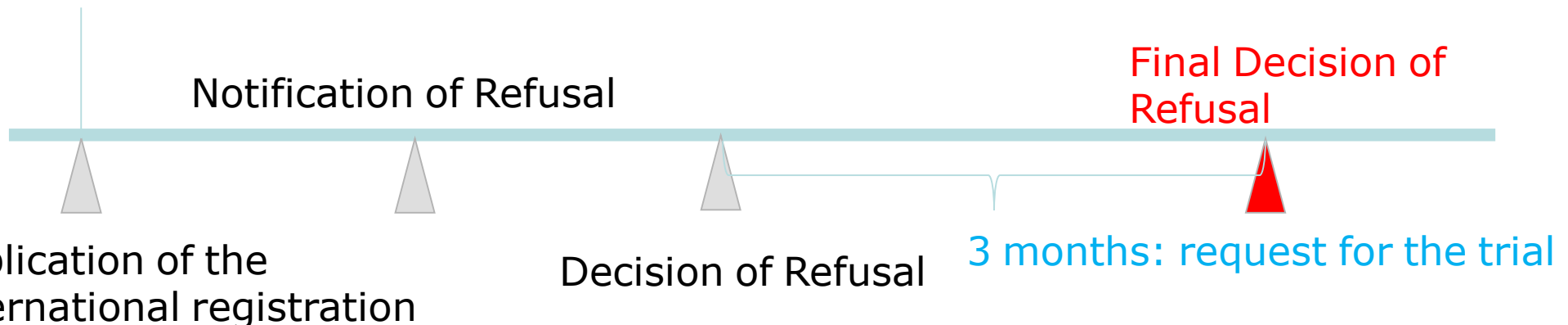
An original certified priority document must be submitted directly to the JPO within 3 months from the date of publication of the international registration.

The WIPO Digital Access Service (DAS) will be available from January 1, 2020.

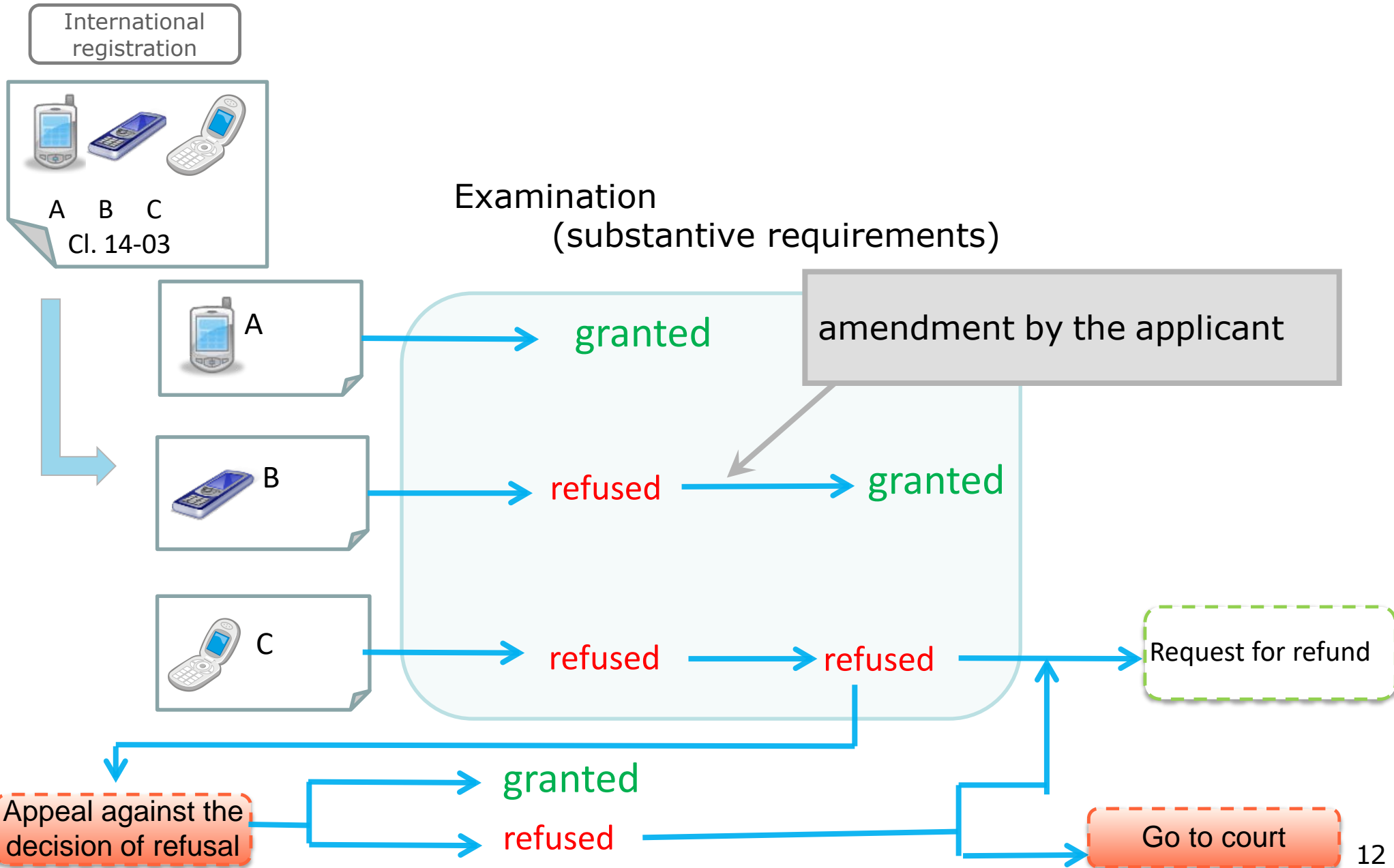


■ Request for refund of the individual designation fee

- The individual designation fee (Japan) may be partially refunded upon request to the JPO within 6 months;
 - ✓ 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.)



National Procedures after the International Publication



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Six view requirement on reproduction

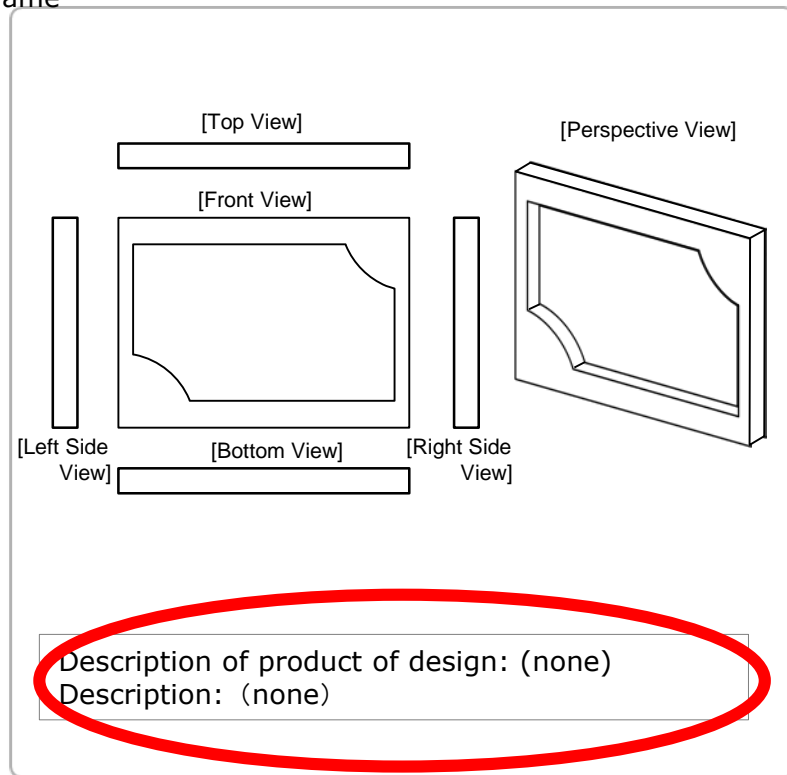
withdrew

- **Japan withdrew the declaration** under Rule 9(3)(a) of the Common Regulations, whereby, where the product which constitutes the industrial design is three-dimensional, a front view, a back 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, were required.
- The withdrawal **took effect on May 1, 2019** and is applicable to the cases whose date of the international registration is on or after the said date.

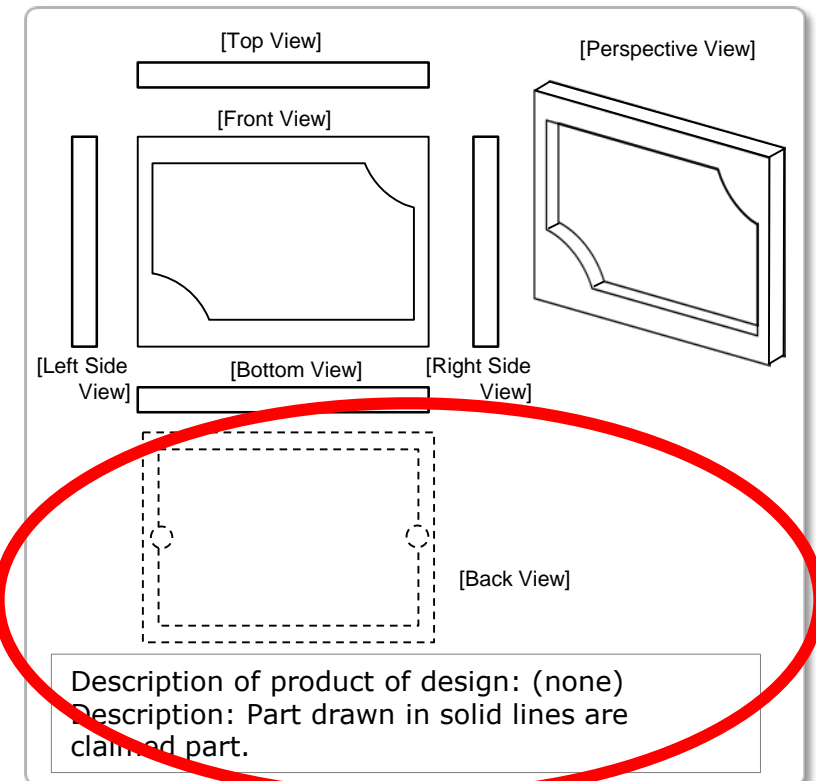
Ease the rules of disclosure the Unclaimed Part

- Applicant is required to submit “sufficient number of views”.
- Examiner considers undisclosed part as Unclaimed Part.
- Examiner examines industrial applicability based on disclosed part in application

(Hypothetical example) Indication of product: Picture frame



(Hypothetical example) Indication of product: Picture frame



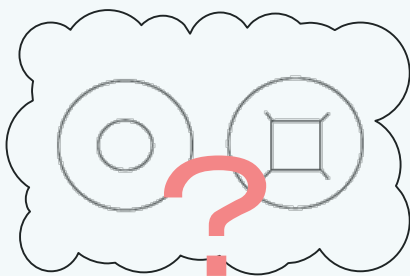
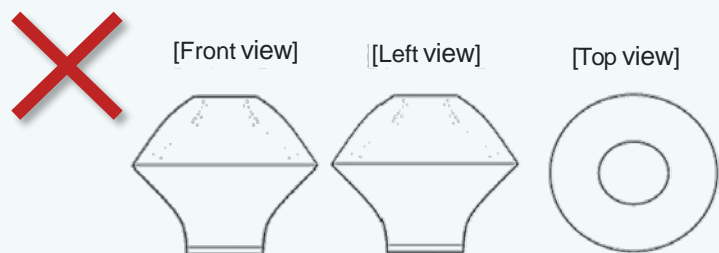
Examiner considers example on left substantially by the same standard as example on right

Ease the rules of disclosure the Unclaimed Part

If one of the following is unclear, it is deemed that the design is not specific.

- Form of claimed part
- Purpose of use and function of claimed part
- Position, size and scope of claimed part in entire article
- Boundary of claimed part and unclaimed part

The design is not specific and it may bring refusal.



Forms near the bottom are variously assumed.

[Indication of product] Vase (hypothetical example)
 [Description of product of design] (none)
 [Description] Back and front views are identical. Right view is omitted because is identical to Left view.



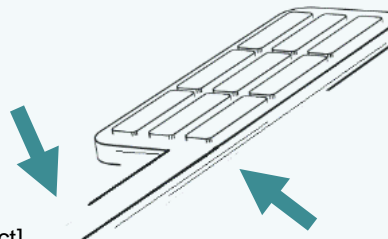
[Indication of product] Coffee cup (hypothetical example)
 [Description of article of design] (none)
 [Description] (none)



Shape of handle is not specific.



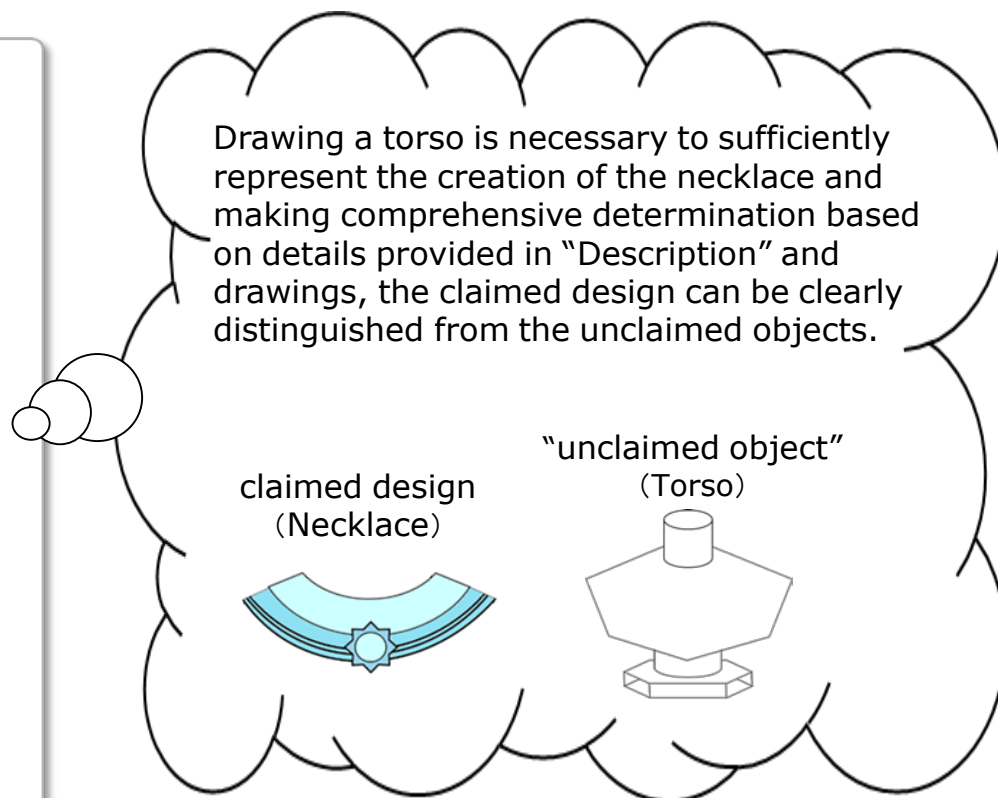
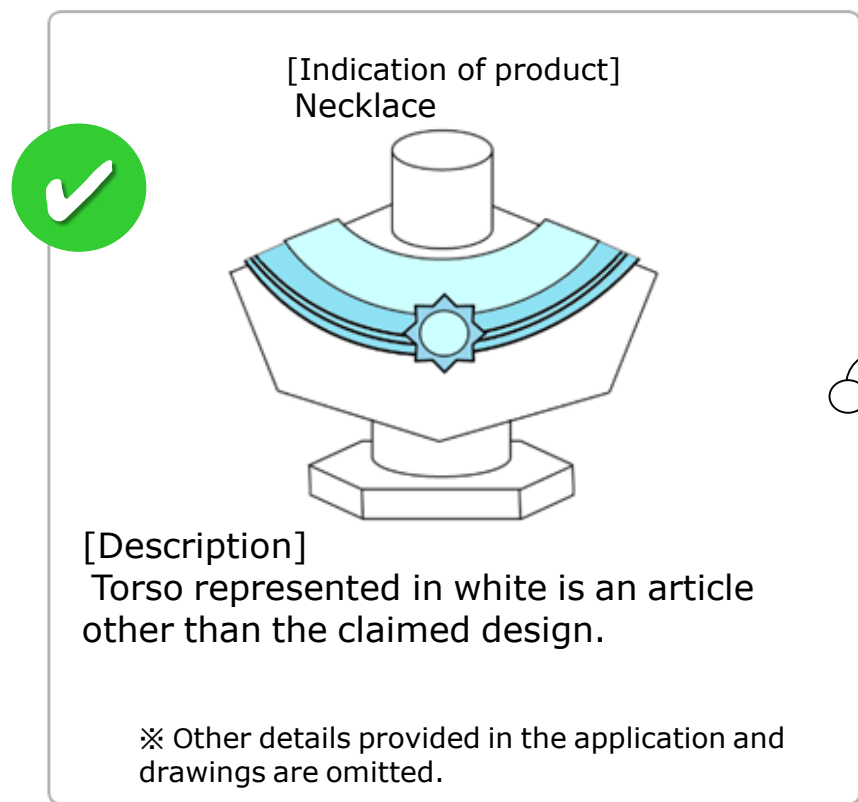
[Indication of product] Brake pedal for automobile (hypothetical example)
 [Description of article of design] (none)
 [Description] (none)



Claimed part is not specified by solid lines and broken lines.

Ease the rules of disclosure the Unclaimed Part -Unclaimed objects in the drawing

- Showing Unclaimed object in required drawings may be allowed, provided that it is necessary for sufficient representation of the creation of the claimed design and such design is specifically recognized by description and/or depiction.



https://www.jpo.go.jp/e/system/laws/rule/guideline/design/shinsa_kijun/overview_20190501.html

Ease the rules for illustrating of middle part omission

- Various way to illustrate for middle part omission will be allowed under new rules.
- Length details of middle part omitted may NOT be required in case that;
 - cannot be a determining feature of the design
 - length variation is common (e.g. power source cord)

Currently permitted illustration for middle part omission

[Indication of product]
"Warm-Air Heater"

[Description]
The length of omitted part in the reproductions is 5 cm.

※ Other details provided in the application and drawings are omitted.

Examples of illustration for middle part omission to be allowed under the new rule

[Perspective view]

[Left view] [Front view]

[Perspective view]

Omitted parts are clearly indicated

※ Other details provided in the application and drawings are omitted.

Examples where length details of omitted part is not required

[Indication of product]
Window Frame Material

[Top view] [Perspective view]

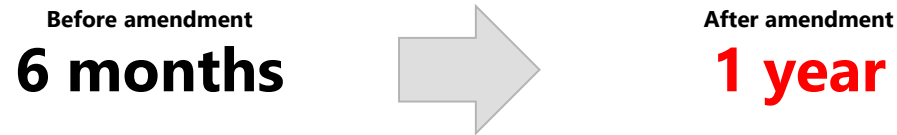
[Left view] [Front view] [Right view] [Back view]

[Bottom view]

[Description] (None)

Judging from the form and the subject matter being a "material" for window frame, the omitted part is found to continue to left and right even without any length details.

(1) Extension of the period for the Exception to lack of novelty



Came into force on June 8, 2018

(2) Participation to the WIPO Digital Access Service

WIPO DAS Participating Offices (Industrial Design Application)

Canada
Chile
China
Georgia
Republic of Korea
Spain
USA

WIPO DAS



India

Depositing only

(Japan) **Effective date: January 1, 2020**

- The revised Design Act was **promulgated on May 17, 2019**.
- The revised Design Act **will be implemented within one year from the date of promulgation** (within two years for some of the revised items).

List of revised items of the Design Act

	revised items	Date of implementation
a.	Expansion of the scope of protection	A day within a period not exceeding one year from the date of Promulgation
b.	Enhancement of the related design systems	
c.	Changes in the duration of design rights	
d.	Clarification of the level of creativity	
e.	Introduction of partial design for a set of articles	
f.	Expansion of indirect infringement acts	A day within a period not exceeding two years from the date of Promulgation
g.	Review of the damage presumption methods	
h.	Introduction of collective application for multiple designs	
i.	Elimination of the article classification table	
j.	Expansion of remediable procedures	

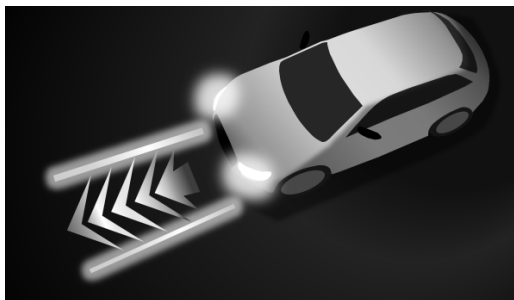
- With the revision of the Design Act in 2019, GUI (Graphical User Interface) designs and building & interior designs will become protection scope as well.

Designs to be protected after implementation of the revised Design Act in 2019



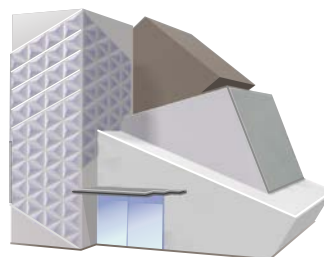
GUI designs

GUI to be recorded at the server and transmitted via a network every time they are used, and GUI to be projected at places other than articles will also become protectable.



Building designs

The appearance of buildings, which is an immovable property, will also become protectable.

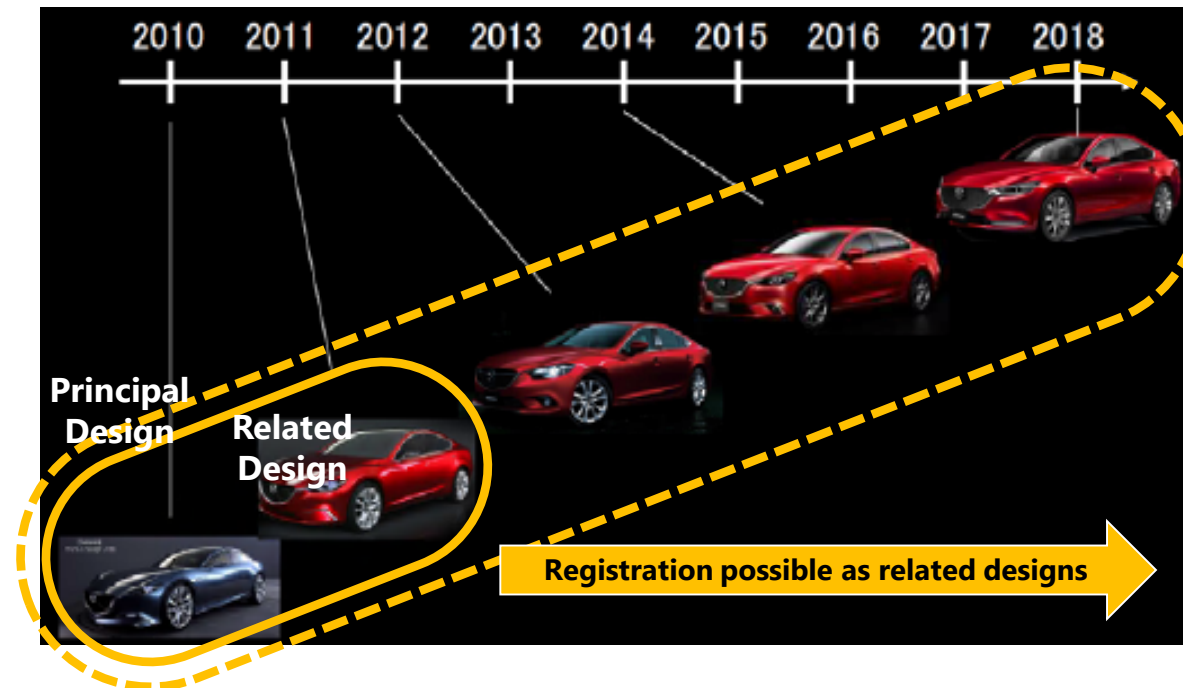


Interior designs

Interiors, which comprise multiple articles such as desks, chairs, and walls, will also become protectable.

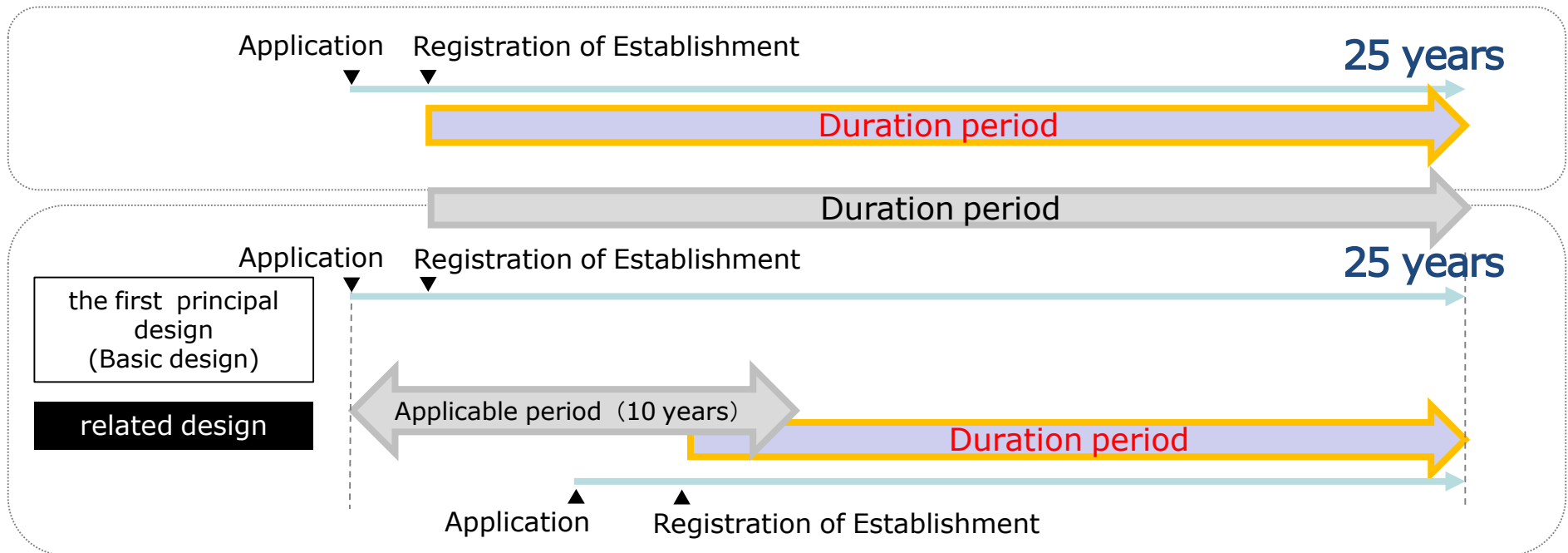
- Related Designs can be filed and registered within 10 years from the initial Principal Design application (within approx. 8 months at present)
- Designs similar only to Related Designs can also be registered
- Related design system may be strategically useful to protect designs forming brands.

Variation designs continuously developed based on a single design concept can be protected under the revised Design Act



Changes in the duration of design rights

- Under the current Design Act, a design right will be expired after 20 years from the date of the Registration of Establishment.
- Under the revised Design Act, a design right will be expired after 25 years from the filing date, and a design right for the related design will be expired after 25 years from the filing date of the first principal design.



Thank you very much for your kind attention!

ありがとうございました。

Japan Patent Office

<http://www.jpo.go.jp/index.htm>