

Differences of Design Prosecution in Japan

March 10, 2011

A. Six Drawing Requirements

The application must accompany six drawings of front, rear, right, left, top and bottom sides. The exact same drawing, however, can be omitted. They must be in the same scale and consistent with each other.

If holes and/or recesses cannot be understood from the six drawings, one or more perspective, cross-sectional, or dotted (stippled) drawings must be submitted to help understand the design. Lines showing surface curvature are sometimes rejected by JPO, if it is not clear as to whether the lines show curvature or are actually written on the product.

Centerlines of circular holes must not be drawn. Transparent or movable portion must be identified in the application.

B. Single Design per Application

Each application may include only a single design of single shape. Multiple applications can be filed by claiming priorities from the single priority application that includes multiple designs.

Designs that are similar to a principal design can be filed as associated designs. Current law of 2008 allows the associated designs to be filed up until the principal design registration is published. Rights of the associated designs expire together with the principal design right.

C. Acceptable Subjects

(1) Screen images can be protected, if they indicate functions that are necessary for operating the article, or it is used for putting the article into a state that fulfills its functions.

(2) Parts that are not seen by customers in normal use, can be registered. For example, brake systems for trains are registerable.

(3) Subject matter must be a mass-producible product. Paintings, sculptures, logos, typefaces, and characters are not allowable.

D. Portion Designs

Design of a portion of a product can be filed, even when the portion is not detachable. Non-similarity requirements are strict in Japan. If only a portion of a new product differs from a known design, we suggest filing a portion design application, in which only the new portion is depicted using solid lines. Boundaries of the portion are drawn by lines having a dot and short line alternately, and the other portions are drawn by broken lines.

E. Priority Can Be Denied

Drawings of foreign originated applications must be often modified before the filing in Japan. Consequently, priority claim is denied. If the design is already published by a foreign PTO, Japanese design application is rejected based on the publication. We, therefore, suggest including the drawings mentioned in A in a priority application and deferring the publication of the priority application.

If the six drawings were not included in the priority application and a design of only portion of a product is understood, the portion design application can be filed with priority claim.

F. Exceptions for Loss of Novelty

If a design was publicly known due to applicant's acts, such as sales and advertisement within the last six months, exception for loss of novelty or grace period can be requested at the time of filing the application. A document, which proves that the design was publicly known, must be submitted within 30 days from the filing.

G. Substantive Examination

Design applications are substantively examined as to whether it is 1) not similar to publicly known designs and 2) not easily created. There is no opposition procedure.

H. Registration and Publication

Design is protected for 20 years from the registration. Publication of design can be deferred up to three years from the registration.

Should you have any questions, please feel free to contact us.

Best regard
Aki Ryuka