

Protection System for Industrial Designs in Japan

The process of filing design applications in Japan has undergone a revamp in order to quicken the process whilst reserving protection during the application procedure. Satoru Asakura comments on the changes to the procedures.



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The *Japanese Design Law* uses a substantive system to examine requirements for protecting designs before they are registered. The pre-examination system allows the registrants of designs to easily execute their design rights.

However, the downside of this system has been that it prolongs the time between filing of design applications and actually obtaining registration. To facilitate faster protection of design rights, the *Unfair Competition Prevention Law* has been improved and the examination process accelerated.

At present, Japan's design protection system is organized to help people planning to release their commodities into the Japanese market.

Characteristics of the Japanese Design Law

Pre-examination system

As with many other countries, novelty is one requirement to protect designs that are filed for registration in Japan. Novelty is judged from the view of consumers and merchandisers.

In addition to novelty, there is another requirement in place to avoid registration of uncreative designs. The designs cannot be easily invented from publicly known designs by designers with ordinary skills in the art.

In Japan, design applications are registered after examination verifies that the applied-for designs fulfil the above requirements and are not identical, or similar to, any prior design applications.

As all registered designs must be examined and fulfil the requirements for protection, design registrations are much more than simple official records. By granting registration, the Japanese Patent Office (JPO) verifies that the registered designs are new and do not infringe the rights of others. Design proprietors can, therefore, feel at ease to start using the designs after they are registered.

In addition, the design proprietors can bring lawsuits against infringement of their design rights. During such lawsuits, if the defendants demand invalidation trials against the design registrations owned by the proprietors as a countermeasure, the filing of an invalidation trial itself does not, in practice, suspend the lawsuits against infringement of design rights.

Due to substantive examination prior to registration, registered designs are considered fully effective unless the JPO issues a cancellation decision as a result of the filed invalidation trials and that the cancellation is binding and final.

As for third parties planning to manufacture and sell commodities, if they conduct searches for registered designs, which are published in design gazettes within one month of registration, they are able to consider beforehand whether their designs are likely to violate the rights of others. This is one great advantage of the Japanese design registration system.

As with anywhere else, there are negative aspects in the design examination system. Pre-examination of the requirements for design protection prolongs the period between filing applications and registering designs.

However, as the time required for examination has been recently shortened, it now takes approximately 10 months for a design application to be registered. Moreover, if applied-for designs are suffering from infringement due to the distribution of counterfeit products, the applicants can submit a request to the JPO to accelerate examination and obtain the outcome in one month. Given this, it can be said that almost all applicants are satisfied with the swift examination of design applications filed in Japan.

Sophisticated search system of designs

In order to rapidly examine design applications, there is a need for an ample number of examiners but also for a search system that can break down and process necessary data and materials for examination.

The Japanese Design Classification consists of approximately 3,000 categories, which are a combination of items and forms of designs, and thus is far more sophisticated than the 400 categories produced by the International Classification for Industrial Designs.

Furthermore, the online database for reviewing prior design applications has been constructed on the basis of the electronic filing system. As the database is released in public via the internet, online searches for prior design applications can be efficiently conducted by entering a combination of keywords, such as categories in the design classification, registrants and publication date of designs in the design gazettes.

Protection of portions of an item as partial designs

As in the United States, it is possible to obtain design registrations in Japan for portions of an item. If portions of the item are identical to the registered partial designs, design rights can be exercised on the basis of the partial designs, regardless of the form of the other portions of the item.

This practice is very useful in preventing counterfeits. According to JPO statistics, the rate of partial design applications increases each year. In 2004, partial designs accounted for approximately 23% of all design applications.

Registering related designs

If two or more designs filed on the same date are similar, only one design can be registered. Under the *Japanese Design Law*, proprietors of design registrations will exclusively own the rights to commercially work the registered designs and similar designs (article 23), so registration of similar designs is prohibited to prevent double patenting. Technically, it does not make sense to file design applications that are similar to registered designs.

However, in order to enhance the design rights, a registration system has been established for related designs. Specifically, if one applied-for design (the principal design) is similar to all the other designs, the other designs can be registered as "related designs", under the strict conditions that all these designs are filed on the same date by the same applicant.

It is important to note here that the JPO will relax the conditions regarding the filing date of related designs from April 1 2007. After

this date, applicants will be able to file to register related designs not only on the same date as principal designs, but before the publication of principal designs in official gazettes. This revision will drastically increase the opportunities to obtain registration of related designs.

Protection of screen designs

Along with the development of electronic devices, the manner of operating machines has changed from pressing buttons and/or levers to using touch-screens. This technical innovation has resulted in a wide variety of screen designs for operating machines. From April 1 2007, the *Japanese Design Law* will grant design rights to screen designs that are deemed essential for operating machines.

However, the Design Law will not protect other screen designs, displayed by software, that have nothing to do with operating machines. For example, protection of screen designs for computer game programs is limited to protection only by *Copyright Law* or by the *Unfair Competition Prevention Law*.

Protection systems for designs

Converting from patent applications

In Japan, patent applications can be converted to design applications in order to register the form of items indicated in drawings attached to specifications of the patent applications, retaining the same filing date of the original patent applications. This "conversion of applications" procedure was established to grant registration of new designs created along with applied-for inventions even if the applicants fail to obtain a patent regarding the inventions.

According to this procedure, if applicants file patent applications only and do not file design applications, on analyzing the market trends after releasing new products the applicants are able to convert patent applications to design applications when necessary, enjoying the benefit of the original filing date of the patent applications.

Design protection under the *Unfair Competition Prevention Law*

It would be useful to conduct searches via the online database of design registrations to find out all of the right-holders of utility goods designs that differ only slightly due to the operation restrictions.

However, because of the time and cost required to obtain design registrations, some right-holders are reluctant to file applications to register designs. Under the circumstances, there are other systems in place to protect non-registered designs in Japan, one of which is protection under the *Unfair Competition Prevention Law*.

The *Unfair Competition Prevention Law* prohibits "acts of unfair

competition”, including the act to assign, rent, exhibit, export or import counterfeit goods, imitating the form of products supplied by others.

Those whose business interests are infringed by acts of unfair competition can demand an injunction of infringement and claim compensation for damages. The protection by the *Unfair Competition Prevention Law* to prevent counterfeit goods lasts for three years from the date that products are first sold in Japan. As for protection of design rights, it is necessary to obtain design registrations under the *Design Law* after the three years have passed.

Protection under Copyright Law

The copyright law is well known as one legal protection system that does not require any fees or registration procedures. In Japan, if the appearance of utility goods can be appreciated as fine arts apart from their practical use, such goods can be protected as

copyrighted artworks. For example, craftwork such as ceramic dolls and furniture carvings can be protected by *Copyright Law*.

As can be seen, there are a variety of useful systems in Japan that offer design protection.

About the author

Satoru Asakura graduated from Chiba University, Department of Industrial Designs, Faculty of Engineering in March of 1974, and from its master's course in March of 1976. He was registered as a patent attorney in February 1994. He has 13 years' experience working at the Japanese Patent Office (JPO) as an examiner, four years' experience working at Ministry of International Trade and Industry, and he worked at a patent firm for 12 years before joining Kyowa Patent and Law Office. He was one of the writers of "JPO's Standard Text for Industrial Property Rights (Design)" published by JIII in 2001. His speciality is designs in general and he speaks English.

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Copyright Disputes and the “1953 Problem”

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The Tokyo District Court's initial decision affirming the copyrights to movies released in 1953 had already expired. The court rejected an injunction request filed by US movie company Paramount Pictures Corporation to suspend sales of low-priced DVDs produced by a Japanese company. Paramount had the copyright to movies such as *Roman Holiday*, which was released in 1953, and a provisional disposition was filed in May this year. Since then, there has been concern that this is a “1953 problem” because a relatively large number of premier movies were released that year. If the decision becomes irrevocable, Cheap DVDs are expected to be distributed in large quantities breaking free from copyright controls.

Japan's former *Copyright Law* initially set movie copyright at 50 years from the date of their release. The protection period for movie copyrights was then extended to 70 years as in the US by the revised law that became effective on January 1 2004.

With the enforcement of the *Copyright Law* amendments, the central issue in a suit resided as to whether *Roman Holiday* was eligible for the benefits of the revised law or not. In order to enjoy extended protection of 70 years, copyrights must actually exist at the time when the revised law came into force, ie: the extension only applies to the copyrights that had not expired as of January 1 2004.

In contrast, the 50-year duration still applied to copyrights that had already expired at that time, and no extension was available. For movies released in 1953, the copyright protection period was counted from the initial date of reckoning, January 1 1954, and expired on December 31 2003 after a 50-year protection period.

However, there had been a contention about the end of the term because of two different ways of thinking, ie: the copyright protection period ended at 23:59:59 on December 31 2003 and the protection continued up to 00:00:00 on January 1 2004. In this regard, Japan's Cultural Affairs Agency represented its perception that the 24th hour of December 31 2003 when the protection period ended is the same time as 0 hour of January 1 2004 when the revised law went into effect.

Thus the movies released in 1953 are subject to the revised law the since the copyright protection period was still in force on the enforcement date. This was an interpretational issue caused by the

boundary between 2003 and 2004 where the copyright protection period expired.

A group insisting on continuous existence in the same camp as the Cultural Affairs Agency considers that 12pm on December 31 2003 is the same time as 0am on January 1 2004. According to this point of view, copyrights to movies including *Roman Holiday* released in 1953 were kept alive at the time when the new law was administered, and the period of protection is to be extended to 70 years ending on December 31 2023 under the new law.

In contrast, a group insisting on extinguishing the copyright considers December 31 2003 as distinct from January 1 2004 and these two days are two separate dates. The court decision recently made is derived from the latter opinion, and the revised law has not applied to the case due to the fact that the copyrights had already expired one day before it was enforced. As described, a detailed analysis of the definition for the term in the copyright law has been made up to the second unit while the period is set up with the year, such as 50 or 70.

Paramount plans to appeal to the Intellectual Property High Court as the decision is not satisfactory.

Most recent court decision

On August 9 2006 the Intellectual Property High Court ruled in favour of a trademark proprietor who appealed against the decision by the Japan Patent Office to cancel the trademark registration due to non-use. A cancellation trial was lodged by another person for the reason that the trademark could not be deemed to have been used for the past three years and, accordingly, the registration should be partially cancelled with respect to the designated services in question. The court decided to deny the JPO's decision and the registration was kept without any cancellation.

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