

Notes for Hague System Users to Designate Japan

Keisuke Soeda*

I. Introduction

On May 13, 2015, the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs (the “Geneva Act”)¹ came into force in Japan. Japan’s accession to the Geneva Act allowed natural persons or legal entities of the Contracting Parties to the Hague Agreement (hereinafter “Hague system users”) to designate Japan in international applications filed under the Geneva Act.

As explained on WIPO’s website,² Japan has adopted a design registration system that requires substantive examination before a design is registered.

The former half of this paper explains the manner to file an international application to designate Japan. The latter half of this paper explores objections raised by the JPO, as well as appropriate responses including, amendments to overcome these refusals.

II. International registration procedures designating Japan

1. Filing an international application to designate Japan

1-1. International application

Hague system users may file an international application directly with the International Bureau of WIPO (hereinafter the IB) or through the Patent Office of the applicant’s Contracting Party (Article 4 of the Geneva Act).³ If necessary, an applicant can claim priority of a national or regional application filed earlier under Article 4 of the Paris Convention or for any member country of the WTO (Article 6 of the Geneva Act).

Unlike an international trademark application, in the case of an international design application, no prior national application or registration in the country of origin is required in order for the applicant to be entitled to file an international application. One single international application/registration can cover up to one hundred (100) designs which are classified in the same class of the Locarno Classification.

* Patent Attorney, Kyowa Patent & Law Office

1-2. Formality check

The IB conducts a formality check on each international application (Article 8 (1) of the Geneva Act). When the international application is considered to satisfy the requirements under the regulations of Geneva Act, the IB will record the subject design(s) in the International Register.

1-3. Registration/and Publication

The date of filing an international application is considered to be the date of the international registration unless the application contains any errors that necessitate deferment of the filing date (Article 9 of the Geneva Act). As long as no request is filed for immediate publication or publication deferment, the international registration will be published in the International Designs Bulletin after six (6) months from the date of the international registration.

The Office of each designated Contracting Party may refuse the effect of the international registration within a certain period of time from the date of the publication of the international registration⁴ (Article 14 (2) of the Geneva Act).

The term of protection for the international registration is five (5) years counted from the date of international registration. The international registration can be renewed for successive periods of five (5) years each up to the expiry of the maximum term of protection allowed by the legislations of the designated Contracting Parties.

2. The JPO's substantive examination

2-1. Starting a substantive examination

Pursuant to Article 60-6 of the Design Act of Japan, after the publication of an international registration (hereinafter

referred to as "international publication" as defined to in the Design Act of Japan) designating Japan, the international registration shall be deemed to be an application for a design registration filed on the date of the international registration. When an international registration is published, the JPO assigns a design application serial number to each design contained in the international registration (Article 8-2 of the Regulations under the Design Act of Japan) and proceeds with the substantive examination of the design(s) claimed in the application under its own legislation, the Design Act of Japan.⁵ In order to determine whether the design application satisfies the registration requirements (Article 3, Article 7, etc. of the Design Act), the JPO examiner conducts a substantive examination mainly based on the following:

- [i] Whether the drawings/photographs are depicted in accordance with the Regulations of the Design Act of Japan⁶ in such way that the design and/or the claimed part of the design can be identified;⁷
- [ii] Whether the indication of products and/or the description clearly defines the article to which the design is applied;
- [iii] Whether the design is deemed to be novel in comparison with prior arts that were publicly known on/before filing the application; and
- [iv] Whether the design satisfies the requirement of Unity of Design.^{8,9}

Since the Office of the designated Contracting Party cannot refuse protection on the grounds of non-compliance with formal requirements except for the declared matters (Article 12(1) of the

Geneva Act)¹⁰, the JPO does not refuse registration of a design on the grounds that the design fails to satisfy the formality requirements.¹¹

2-2. Grant of Registration

If a JPO examiner does not find any reasons for refusal in the substantive examination, the JPO will issue a decision of registration and a national registration certificate to the holder of the international registration.

In present practice, said registration certificate is issued a few months after a decision of registration. The maximum protection term of design registration is 20 years counted from the Japanese design registration date indicated in the registration certificate issued by the JPO.

In addition to issuing a registration certificate, the JPO sends a Statement of Grant of Protection to the IB and publishes the registered design in the Japanese Official Gazette.

2-3. Refusal

If a JPO examiner finds reasons for refusal in an application, the JPO will directly send a notification of refusal to the IB (Article 12(2)(a) of the Geneva Act).¹² Even if a local representative in Japan has been appointed¹³, the first notification of refusal will not be sent to the representative in Japan.¹⁴ Thus, when the holder or their representative before the WIPO receives the notification of refusal from the IB, they should report the first notification to their Japanese representative in order to discuss the response to the JPO. It is necessary to respond to a notification of refusal within three (3) months from the issue date of the notification of refusal (the original due term, three (3) months, is extendible one (1) month by a

request filed prior to the original deadline.).

In the case the applicant does not reply to the notice of refusal in due time or the reasons for refusal are not overcome despite of submitting an amendment and/or an argument, the JPO examiner will issue a decision of refusal (if no representative has been appointed in Japan, the JPO will send it to the applicant via the IB).

Even if a decision of refusal is issued, it is possible to demand an appeal to the JPO's appeal board within three (3) months after the issue date of the decision of rejection (Article 46 of the Design Act of Japan). As a next step, if the applicant receives a decision of refusal from an appeal board and intends to file an appeal against the appeal board's decision, the applicant may file a lawsuit with the Intellectual Property High Court within 120 days from the issue date of said decision (Article 59 of the Design Act).

In case the design is not registered in Japan, the applicant can demand the refund of a part of the registration fee (i.e., a part of an individual designation fee) pursuant to Article 60-22 of the Design Act.

3. Supporting documents for priority claiming and/or for seeking privileged treatment in the case of lack of novelty

It is preferable for Hague system users designating Japan to understand submission deadlines for priority documents and documents for seeking privileged treatment in the case of lack of novelty. More specifically,

[i] A priority document must be submitted to the JPO within three (3)

months from the date of international publication (Article 60-10(2) of the Design Act and Article 12-2 of Regulation under the Design Act);

- [ii] A document for seeking privileged treatment in the case of lack of novelty

ely by stating the fact that the subject design has been disclosed within six (6) months before the actual filing date must be submitted to the JPO within thirty (30) days from the date of international publication

Figure 1: Post-international publication flow when no refusal reasons for refusal have been found (in the case of overseas applicants)

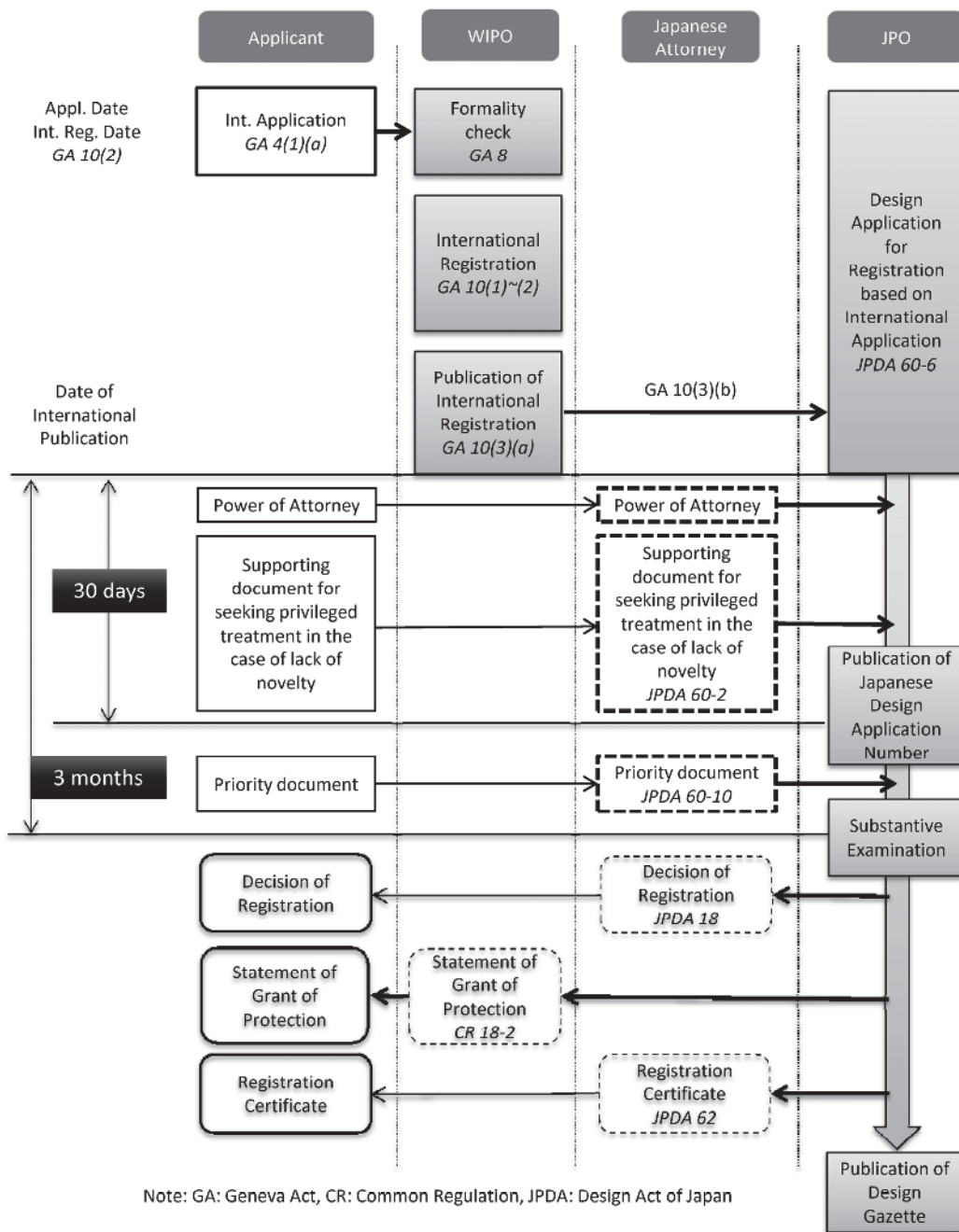
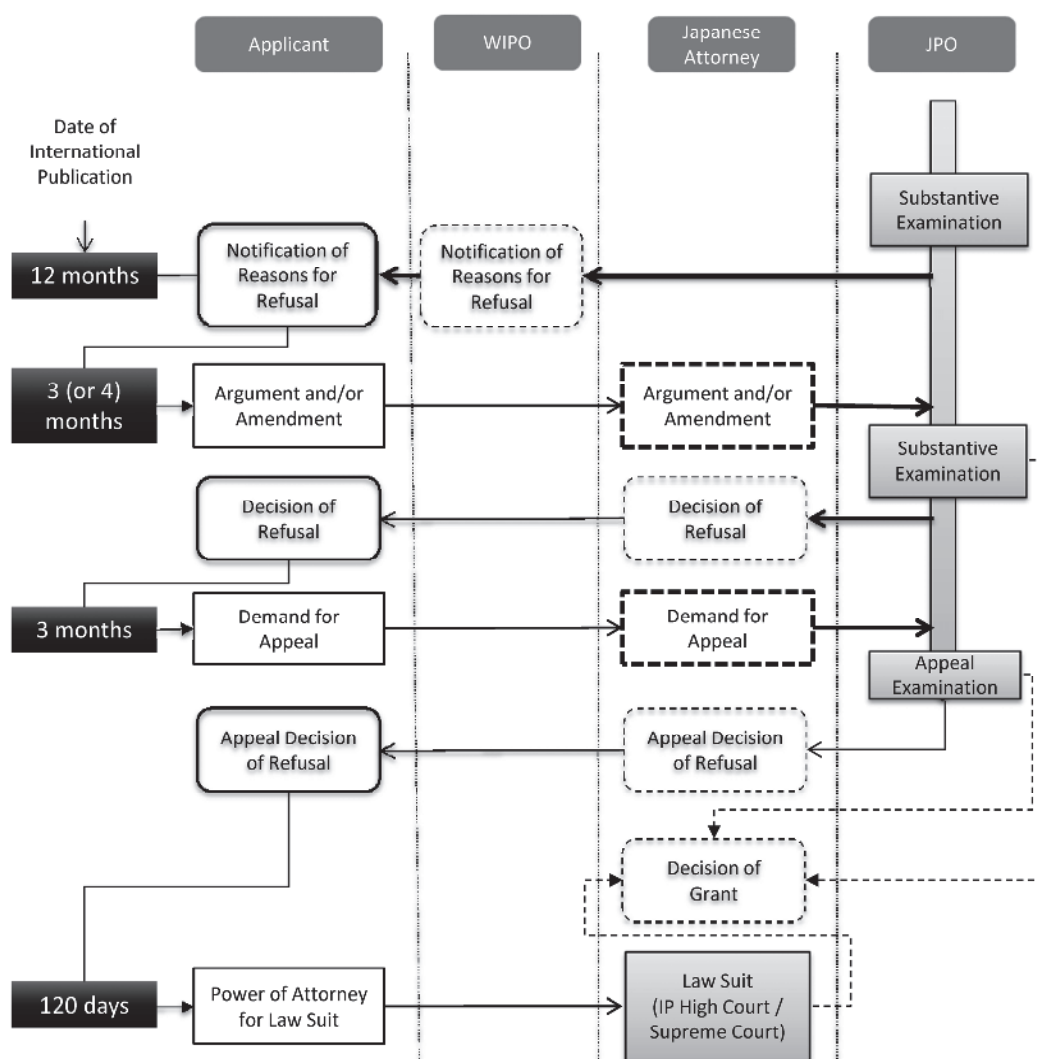


Figure 2: Post-international publication flow when refusal reasons for refusal have been found (in the case of overseas applicants)



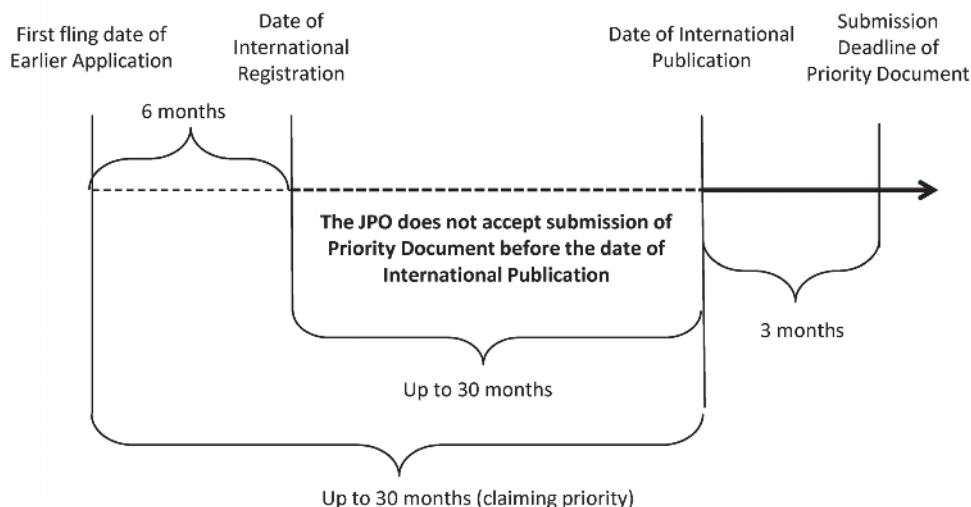
(Article 60-7 of the Design Act and Article 1-2 of the Regulations of the Design Act); and

- [iii] No remedies are available after the expiration of submission deadlines for these documents.

For instance, in case the applicant claims priority to an earlier application and also requests deferment of publication for thirty (30) months from the date

of the earlier filing (i.e., the priority date), the priority document must be submitted thirty (30) months after the priority date and within three (3) months from the international publication date.

Also, in case the applicant requests the earlier publication to the WIPO during the period of deferment (Article 11(4)(a) of the Geneva Act), the priority document must be submitted three (3) months after the international publication



date prior to the expiry of the deferment period requested at the time of filing the international application.

Accordingly, if the applicant claims priority and requests a deferment of international publication, it is recommendable to collaborate with a Japanese patent attorney to manage the submission deadline of a priority document in order to avoid missing the opportunity to submit the above mentioned supporting documents to the JPO¹⁵.

III. Reasons for refusal and overcoming them

According to WIPO statistics,¹⁶ the JPO issues notifications of refusal on the following main grounds.

- [i] Lack of novelty
- [ii] Disclosure insufficiently to specifying the design
- [iii] Ambiguous/broad indication of product
- [iv] Incompliance with definition of industrially applicable design

[v] Unity of design

Applicants designating Japan may study the records of the Hague Express in order to understand the above reasons for refusal and responses thereto.

The following cases showcase appropriate responses to overcome the reasons of refusal issued by the JPO.

1. Lack of novelty

If a JPO examiner finds that the design of an international registration designating Japan is identical or similar to a design that has been publicly known before the filing of the international application, the examiner may issue a notification of refusal on the grounds of lack of novelty (Article 3 (1)(i) or (ii) of the Design Act). In order to prevent such refusal based on the publication of the subject design or on a disclosure thereof, it is necessary for an applicant to consider [i] claiming priority¹⁷, or [ii] filing an application for seeking privileged treatment in the case of exception to lack of novelty, since these relief measures may be applied only at the time of filing an international application.¹⁸

In other words, if a priority is not claimed at the time of filing an international application, but an earlier filed application has already been published in the Design Gazettes issued by the Office of first filing before the international application date, the publication in the Official Gazette is cause of lack of novelty in Japan. Since there is no procedure to overcome the above refusal grounds, significant attention should be paid to claiming priority when filing an international application and to submitting an original priority document¹⁹.

2. Insufficient disclosure to specify the design to be protected in Japan

As shown in the following example, the JPO issued a notification of refusal on the grounds that the design cannot be identified.

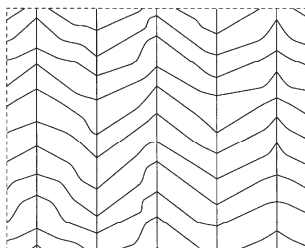
Case 2-1

Reasons for refusal

Regarding DM/087054 “Parquet” Cl.25-02A, the JPO issued a notification on the grounds of the omitted views and broken lines.

Note:

- i) *The thickness and the forms of the end surface and the back surface of the design are not clear, because only one drawing was attached to the application*



- ii) *The outline of the subject in the view drawn by a broken line; however, there is no description about it. Therefore, it is unclear what the broken line indicates; for example, where it indicates the disclaimed part.*

Amendments to overcome the refusal

The applicant has overcome the reasons for refusal by adding Views 1.2 (the rear view), 1.3 (the right side view), and 1.4 (the top plan view) and by explaining that the broken lines are not a part of the claimed design, and that the left side view is the same as the right side view and that the bottom plan view is the same as the plan view.

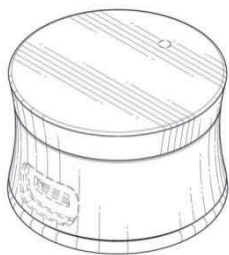
Remarks

- i) In the case the applicant omits a certain view, the applicant should explain which view was omitted and the reason for the omission.²⁰
- ii) In the case broken lines, dotted lines or coloring are used to indicate disclaimed part(s), the applicant should include a description explaining that the part(s)²¹ thus identified are not part of the claimed design.
- iii) Alternatively, an explanation that this product consists of a thin board and that no claim is made about its back side may be added (Article 3, Format 6, Remarks 10 of the Regulations of the Design Act) in response to such notification of reasons for refusal.

Case 2-2

Reasons for refusal

Regarding DM/088498 “Electronic stethoscope” Cl.24-02, the JPO issued a notification concerning the shading (narrow lines on the surface of the article).²²



Note:

- i) Whereas the reproductions of this design are described by means of solid lines and broken lines, no description was provided as to the part described with broken lines. Accordingly, it is unclear whether this application is to obtain a design registration for a design of a part of an article (partial design²³) or not.
- ii) In the representation, thin and discontinuous lines are shown in the area inside the contour lines; however, the purpose of these lines is not stated in DESCRIPTION. Therefore, it is not clear whether the thin lines indicate a relief of surfaces or pattern on the surface of the product.

Amendments to overcome the refusal

The applicant has overcome the reasons for refusal by amending to add the statement, “the thin lines indicate a relief of surfaces”.

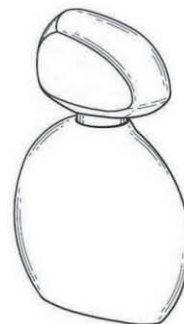
Remarks

According to the JPO examination guidelines modified on April 1, 2017, if it is obvious that thin lines, dots and/or dark tone area depicted in drawings as shading, the application will not be refused on the grounds that the explanation of the shading is omitted. Nevertheless, it is recommendable that the applicant provides a description clarifying whether the narrow lines drawn on the surface of the article represent shading.

Cases 2-3

Reasons for refusal

Regarding DM/090201 “Bottle” Cl. 09-01, a notification of reasons for refusal has been issued requesting a view showing the bottle in the open state.



Grounds of refusal: [Ground 1] [Note 1] 2) The design in this application for design registration indicates that the article to the design is “Bottle”, and it is considered that the bottle cap is open when used. However, this application does not contain a figure indicating that the bottle cap is opened, thus the shape of the bottle with the cap opened is unclear (for example, whether the bottle’s head has a discharge opening or not), and it is not possible to specify the use state of the design. Therefore, the design is not a specific design.

Amendments overcoming the refusal

In response to the aforementioned notification, the applicant submitted the additional view shown below.



Remarks

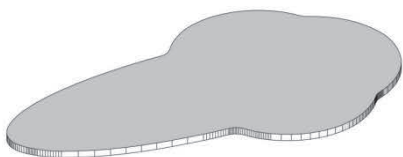
In Japan, applicants seeking design protection for the appearance of a container/bottle with a lid are required to submit a view in an open state (lid removed) pursuant to Article 3, Format 6, Remarks 18 of the Regulations of the Design Act.

3. Ambiguous/broad indication of product

Case 3

Reasons for refusal

Regarding DM/089390 “Collagen membrane” Cl.24-04, a notification of reasons for refusal was issued due to the purpose or manner of use of the subject article being unclear.



Note:

- i) *The article to the design stated in the column of “Products Which Constitute the Industrial Design or in Relation to Which It Is to Be Used” in this application is “Collagen membrane”. However, the article to the design of this application cannot be found to be specific, as the purpose and method of use is not described in the column of “description” and the purpose and method of use cannot be derived from the reproductions accompanying the application.*

Amendments overcoming the refusal

In response to the aforementioned notification, the applicant submitted the additional description shown below.

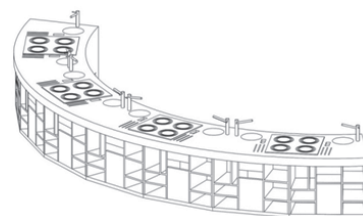
“The subject article, a collagen membrane, is designed for medical use, in particular, dental use for oral tissue-regeneration; The article integrates with surrounding tissues to protect the initial coagulum; The gray tones are not patterns but shading used for depicting the three-dimensionally surface of the article; The right side view is a mirror image of the left side view; The bottom plan view is a mirror image of the top plan view; 1.1)”

4. Incompliance with definition of design

Case 4

Reasons for refusal

Regarding DM/087657 Design Number: 2 “Get-ups (kitchen arrangement)” Cl. 32-00, the JPO issued a notice of refusal on the grounds that the word “get-up” does not represent a single article.²⁴



Note:

“Get-ups (kitchen arrangement)” is stated in the indication of product in the application for the design registration. However, the word “get-up” does not represent a single article; the word “kitchen” represents a place where a person cooks; and the word “arrangement” represents a situation where things are put into a specific order or relation. Therefore, each of these words does not represent an individual article itself.

Amendments to overcome the refusal

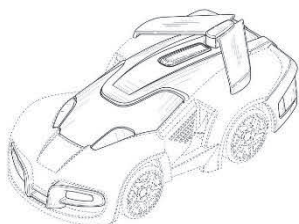
Even though the indication of the product is “Get-ups (kitchen arrangement)” in Class 32-00 of the Locarno Classification, since the reproduction appears to be a set of sink cabinets, the applicant has overcome the refusal by modifying the indication of the product to “sink cabinet with cooking stove”.

5. Unity of Design

Case 5

Reasons for refusal

Regarding DM/087354 Design Number: 3 “Vehicles [toys]” Cl. 21-01, the JPO issued a notification of reasons for refusal stating that the application contains two designs and does not satisfy the requirement of Unity of Design.



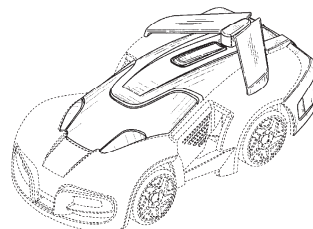
Note:

The design in the application for design registration indicated the article parts for which design registration is requested, and the two parts, the front bumper, roof and rear bumper part are to be requested for design registration; however, the front bumper part, roof and rear bumper part are physically separated from each other, and neither unity in form nor function is found in both parts; therefore, the application for design registration related to two designs.

Amendments to overcome the refusal

In response to the aforementioned notice of reasons for refusal, the applicant

has overcome the reasons for refusal by amending to replace solid lines with broken lines to draw the front bumper as shown below.



Remarks

In case the claimed design of an international application is not in a single and/or continuous area as a result of disclaiming, if the separated areas cannot be unified as a single design, the JPO will judge that the application does not satisfy the Requirement of Article 7 of the Design Act (i.e., Unity of Design).²⁵

If the JPO issues such notification of refusal on the grounds of multiple designs included in a single application pursuant to Article 7 of the Design Act, the applicant may retain one design and file divisional national application(s) for the other desired design(s) or claimed area(s) (Article 10-2 of the Design Act).

IV. Conclusion

In order to secure design protection in Japan based on international registrations, Hague system users need to pay attention to the deadlines for submitting the necessary documents and respond within the appropriate period of time. Therefore, it is recommendable for Hague system users to collaborate with their representative in Japan by informing them of the international registration number and the scheduled international

publication date indicated in the certificate of international registration in order to manage the deadlines of the application.

Regarding reproductions, if a design can be represented by using a set of six-view photographs, the design application using said photographs will likely satisfy the requirements of the Regulations of the Design Act. From this viewpoint, Hague system users designating Japan are advised to submit a set of six-view photographs in order to present subject designs in accordance with Japanese design practice.

Whereas, in case Hague system users designating Japan wish to use line drawings or computer graphics in order to smoothly register the design or to secure opportunities to amend, it is necessary to sufficiently disclose the design by preparing drawings in line with the Guidance on reproductions issued by the WIPO and by providing explanations regarding the design, article and/or drawings in the column of “Legends and/or Description” at the time of the filing of the international application.

Thanks to the Hague international design registration system, a global system to protect designs, applicants who wish to protect their designs based on Japanese design registrations may select the preferable application route, the national application route or the Hague route.

In the case of a national application, the applicant will be able to obtain the necessary information from their agent in Japan in advance or as necessary, which allows estimating the costs for registering the design in Japan.

While the Hague system allows for easy management and efficient maintenance

of their design registrations efficiently, international applications should be prepared by taking into account each designating country/party’s local practices and by taking into account the opinion of the experts. Moreover, since notifications of reasons for refusal issued by the designated patent office(s) will be published in the Hague Express, it is advisable to use the national filing route, if the applicant desires to obtain the examination report directly from the designated patent office(s).

I hope that this article helps applicants to select the desired filing route with confidence and to secure design protection in Japan.

(Notes)

- ¹ See WIPO Media Center - United States of America, Japan Join International Design System” (http://www.wipo.int/pressroom/en/articles/2015/article_0001.html)
- ² See “Japan (JP) General Information” (<http://www.wipo.int/hague/en/members/profiles/jp.html?part=general>)
- ³ In principle, in the case of an international application filed through the Office of a Contracting Party, the date on which the Office of the Contracting Party receives the application shall be considered to be the filing date (Article 9 of the Geneva Act).
- ⁴ The period for notification of refusal is six (6) months from the date of the international publication or twelve (12) months from the same date upon declaration of the Contracting Party. The refusal period in Japan is 12 months. See “WIPO INFORMATION NOTICE NO. 3/2015 - Accession to the 1999 Act: Japan” (http://www.wipo.int/edocs/hagdocs/en/2015/hague_2015_3.pdf)
- ⁵ The design application numbers are publicized in the form of an Excel file on the JPO website (Japanese language) (http://www.jpo.go.jp/seido/s_ishou/hague_kokusaitouroku_banngou.htm) the fourth Tuesday after the international publication date. The columns in the above mentioned Excel sheet (http://www.jpo.go.jp/seido/s_ishou/files/ishou_banngou.xls) represent

sent, from the left, “International publication date,” “Application No.,” “International registration No.,” and “Design No.”

⁶ In principle, the JPO requires that a design is represented by a set of six-view orthographic drawings (front, rear, left side, right side, plan and bottom views).

⁷ The declaration referred to in Rule 9(3)(a) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement, 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, are required.

⁸ In Japan, a single application may contain only one design (Article 7 of the Design Act). However, unlike the USPTO, the JPO accepts an international application containing multiple designs by dividing it into applications containing one design. (i.e., the number of Japanese applications corresponding to the number of designs of the international application) (Article 60-6, paragraph (2)). As a result, in principle, the JPO does not issue a notice of refusal on the grounds that an international registration contains two or more designs.

⁹ The declaration referred to in Article 13(1) of the 1999 Act that Article 7 of the Design Act of Japan requires that only one independent and distinct design may be included in a single application.

¹⁰ Based on the requirements for design registration specified in the Design Act, Japan made the following six (6) declarations as “Declarations Made by Contracting Parties” under Article 30 of the Geneva Act:

1. Individual fee in respect of a designation made under the 1999 Act and in respect of a renewal requested under the 1999 Act Article 7(2)
2. Requirement of unity of design Article 13(1)
3. Maximum duration of protection under the national law Article 17(3)(c)
4. Certain views of the design required Rule 9(3)(a)
5. Extension to 12 months of the refusal period Rule 18(1)(b)
6. Date of effect of the international registration Rule 18(1)(c)(ii)

See “WIPO INFORMATION NOTICE NO. 3/2015 - Accession to the 1999 Act: Japan” (http://www.wipo.int/edocs/hagdocs/en/2015/hague_2015_3.pdf)

¹¹ Regarding this point, there is a difference

between the Hague-route design applications and the national-route design applications. In the case of national-route design applications, the JPO issues a notification of order for amendment within a few months from the filing date of application, stating that the formality requirements are not satisfied (1) if the application does not contain a front view or other necessary views or (2) if the application with drawings/photographs contains disclaimed areas but lacks the indication of “BUBUN-ISHO” to clarify a design containing disclaimed areas. In response to the notice of order for amendment, the applicant needs to reply within thirty (30) days. If no reply is made, the design application will be dismissed.

¹² A notification of reasons for refusal is issued within twelve (12) months from the international publication date.

¹³ If an original power of attorney cannot be submitted to the JPO at the time of the response, it is possible to submit it later with an amendment.

¹⁴ Starting with the second notification of reasons for refusal, notices are sent directly to the representative in Japan.

¹⁵ As a countermeasure, the JPO currently provides an administrative service of sending reminders, one week after the international publication, to applicants regarding the submission of a priority document.

¹⁶ See “WIPO/HS1/16/4 “STATISTICS FOR GROUNDS OF REFUSALS” (http://www.wipo.int/edocs/mdocs/hague/en/wipo_hs1_16/wipo_hs1_16_4.pdf)

¹⁷ In the case of an application claiming priority based on a Registered Community Design (RCD), a color print of the PDF format registration certificate downloaded from the EUIPO website is deemed to be an original priority document. Since the EUIPO’s PDF-format registration certificate has an authentication code, the JPO uses said code to obtain the necessary information from the EUIPO. However, in the case of an RCD that is subject to deferment, since it is impossible to obtain a PDF-format registration certificate, the applicant needs to submit the original (paper) priority document issued by the EUIPO.

¹⁸ In South Korea, due to the amendment of the Industrial Design Protection Act on July 1, 2014, it has become possible to file an application for seeking privileged treatment in the case of lack of novelty at the time of making a reply to an Office Action or in the procedures of an invalidation trial (Article 36 of the Industrial Design Protection Act of South Korea).

However, Japan does not offer such relief measure.

- ¹⁹ The JPO has not introduced DAS system for Japanese/International design applications at this stage.
- ²⁰ For more details, please refer to “Guidance on preparing and providing reproductions in order to forestall possible refusals on the ground of insufficient disclosure of an industrial design by Examining Offices” (http://www.wipo.int/export/sites/www/hague/en/how_to/pdf/guidance.pdf).
- ²¹ Please refer to “Notes for the Designation of Japan in an International Design Application under the Geneva Act of the Hague Agreement 2 (2)” (http://www.jpo.go.jp/english/applications/pdf/hague_notes_e/notes_e.pdf).
- ²² The USPTO requires that the drawing is provided with appropriate surface shading which clearly shows the character and contour of all surfaces of any three-dimensional aspects of the design and that shading should be provided only in the claimed part of the design in order to clearly distinguish the claimed part from the disclaimed part.
- ²³ The phrase “partial design” in the aforementioned notification of reasons for refusal is an English translation of “BUBUN ISHO” (while “partial design” is Japanese origin English, “BUBUN ISHO” started to be used in some English-speaking countries). In the case of an international application, if a JPO examiner finds that the disclaimed parts of the article presented in drawings are drawn in broken lines, the examiner will amend by adding the section title “BUBUN ISHO” ex officio (modification to add the item “BUBUN ISHO”).
- ²⁴ In “Notes for the Designation of Japan in an International Design Application under the Geneva Act of the Hague Agreement” (I. 1 (2) a.), the JPO explained that “Where the product does not constitute an article, for instance, where the product belongs to class 32 of the Locarno Classification (e.g. surface pattern, logo, ornamentation, etc.), protection is not granted under the Japan’s Design Act, and therefore becomes the subject of a refusal.”
- ²⁵ In Japanese practice, the disclaimed part is taken into account when specifying the claimed part to be registered.