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JAPANESE DESIGN LAW AND PRACTICE

Yoichiro Yamaguchi†

I. INTRODUCTION

At the beginning of the seventeenth century, Japan was a country closed under a national isolation policy, except for business which it conducted with the Netherlands and China. In 1853, Commodore Perry pushed Japan to open its markets for trade with foreign countries. As a result, Japan entered into and ratified trade and voyage treaties with the United States, the United Kingdom, the Netherlands, Russia, and other countries; however, these treaties frequently included provisions which deprived Japan of tariff autonomy.

A constitutional monarchy was established in Japan in 1867, replacing the Samurai government which had been in existence for seven hundred years. The goal of the new government was to encourage domestic industry, strengthen the armed forces, and seek equal treatment under the treaties which the preceding government had ratified. In order to modify these unequal treaties, Japan first had to establish a system of national laws. To encourage its domestic industry, it was important for Japan to establish laws for the protection of industrial property.

In 1881, the Ministry of Agriculture and Trade was established, and Korekiyo Takahashi became Commissioner of the Patent Office. Takahashi was assigned the task of drafting industrial property laws, and traveled to the United States and Europe to study their industrial property protection systems. In 1889, a new Design Law was enacted, together with amendments to the Patent and Trademark Laws which had come into existence a few years before.

The Design Law of Japan has the following features: (1) a substantial examination is made by an examiner; (2) the design is defined as "the shape, pattern or color or a combination of these in an article which produces an aesthetic impression on the sense of human sight;"¹ (3) a first-to-file system has been adopted;² (4) the scope of the design right covers the

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1. Design Law, No. 125, Apr. 13, 1959, as amended, § 2(1).

2. Design Law § 9, which translates as follows:

(1) Where two or more design applications concerning the same or similar designs are filed on different dates, only the first applicant may obtain a design registration for the design.

(2) Where two or more design applications concerning the same or similar designs are filed on the same date, only one such applicant as agreed upon after mutual negotiation with all the applicants may obtain a design registration for the design. If no agreement has been reached or no negotiation has been possible, none of the applicants shall obtain a design registration for the design.

(3) A design application which has been withdrawn or invalidated shall, for the purposes of the two preceding subsections, be deemed not to have been made.

registered design per se and a design similar thereto,³ (5) the duration of the design right is for fifteen years after the date of registration.⁴

II. DESIGN AND OTHER INTELLECTUAL PROPERTY RIGHTS

A. *Design, Patent, and Utility Model Rights*

The subject matter protected under the Japanese Design Law is the shape, pattern, color, or a combination of these, in an article which produces an aesthetic impression on the sense of the consumer's sight. In other words, the creation of an appearance, which attracts consumers by giving an aesthetic impression, is protected under the Japanese Design Law.

The subject matter protected by patent or utility model rights, on the other hand, is a creation of a technical idea by which a law of nature is utilized.⁵ A technical idea relating to the shape of an article can be protected under the Patent and the Utility Model Laws, as well as under the Design Law. This means that there can be some overlap of the subject matter covered by the Design, Patent, and Utility Model Laws. For example, where an article which is beautifully created, so as to attract consumers, and also has some advantageous effect over the prior art, that article is protected under the Patent Law, the Utility Model Law, and the Design Law.

Subject matters protected under the Patent or Utility Model Laws are usually created at the beginning or middle stages in the development of a product, while subject matters protected under the Design Law are usually created at the final stage of development. That is, the creations protected under each law are usually made at different stages during the development of the article. It is strongly recommended in Japan, however, to apply for both design registration and patent or utility model registration where a

(4) A design application filed by a person who is neither the creator of the design nor the successor in title to the right to obtain a design registration shall not for the purposes of subsections (1) and (2) be deemed to be a design application.

(5) The Commissioner of the Patent Office shall order the applicants to hold negotiations for an agreement under subsection (2) and to report the result thereof, within an adequate time limit.

(6) Where the report under the preceding subsection is not made within the time limit designated under that subsection, the Commissioner of the Patent Office may deem that no such agreement as prescribed under subsection (2) has been reached.

3. Design Law § 23, which translates as follows:

The owner of a design right shall have an exclusive right to commercially work the registered design and/or designs similar thereto. However, where the design registration is the subject of a registered exclusive license, this provision shall not apply to the extent that the registered exclusive licensee has an exclusive right to work the registered design and designs similar thereto.

4. Design Law § 21.

5. Patent Law, No. 121, Apr. 13, 1959, as amended, § 2(1); Utility Model Law, No. 123, Apr. 13, 1959, as amended, § 2(1).

design creation of an article also involves an inventive structure of an article. If a registered design conflicts with a patented invention, the one having the earlier filing date for its application will have superior rights.⁶ It may be apparent that there is no rejection of a design application on the ground of functionality.

B. *Design Right and Copyright*

A creator is entitled to a copyright at the time of the completion of the artistic creation without any registration of such copyright being necessary.⁷ Copyright is the right to prevent others from duplicating one's subject

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6. Design Law § 26; Patent Law § 72; Utility Model Law § 17. Design Law § 26 translates as follows:

(1) Where a registered design utilizes a registered design or a design similar thereto, a patented invention or a registered utility model owned by others on the basis of part of a design right relating to the registered design conflicts with a patent right, a utility model right or a trademark right owned by others on the basis of an application filed prior to the filing date of the design application concerned, or conflicts with another person's copyright taking effect prior to that date, the owner of the design right, registered exclusive licensee or non-exclusive licensee shall not commercially work the registered design.

(2) Where a design similar to a registered design utilizes a registered design or a design similar thereto, a patented invention or a registered utility model owned by others on the basis of an application filed prior to the filing date of the design application concerned, or where a part of a design right relating to designs similar to the registered design conflicts with a design right, a patent right, a utility model right or a trademark right owned by others on the basis of an application filed prior to the filing date of the design application concerned, or conflicts with other's copyright taking effect prior to that date, the owner of the design right, registered exclusive licensee or non-exclusive licensee shall not commercially work the design similar to the registered design.

Patent Law § 72 translates as follows:

Where a patented invention utilizes a patented invention, a registered utility model, a registered design or a design similar thereto owned by others on the basis of an application filed prior to the filing date of the patent application concerned, or where the patent right conflicts with other's design right obtained on the basis of an application for registration of a design filed prior to the filing date of the patent application concerned, the patentee, registered exclusive licensee or non-exclusive licensee shall not commercially work the patented invention.

Utility Model Law § 17 translates as follows:

Where a registered utility model utilizes a registered utility model, a patented invention, a registered design or a design similar thereto owned by others on the basis of an application filed prior to the filing date of the utility model application concerned, or where the utility model right conflicts with a design right owned by others on the basis of an application for a design registration filed prior to the filing date of the utility model application concerned, the owner of the utility model right, registered exclusive licensee or non-exclusive licensee shall not commercially work the registered utility model.

7. Copyright Law, No. 48, May 6, 1970, as amended, § 17(2), which translates as follows: "No particular execution of formality shall be required for an author to enjoy his or her personal right or copyright."

matter, but the copyright does not cover minor changes made in the subject matter. The design right, on the other hand, covers not only the registered design per se but also covers designs similar to it. It should be noted that the scope of coverage by the design right is broader than that of a copyright. If a design right conflicts with a copyright, the copyright has priority in the case where the copyrighted subject matter was created before the filing date of the application for the design registration.⁸

C. *Design and Circuit Layout Rights*

Since a design must produce an aesthetic impression on one's sense of sight, there is no registrability for extremely small sized designs under Japanese law. For example, integrated circuit (IC) chip designs can only be viewed through use of a microscope, and therefore, do not produce an aesthetic impression. Following the enactment of the Semiconductor Chip Protection Act of 1984 in the United States,⁹ the Act Concerning the Circuit Layout of a Semiconductor Integrated Circuit was passed by the Diet in 1985, and became effective in 1986 in Japan.¹⁰ During the consideration by the Cabinet Legislation Bureau before enactment of such law in Japan, the possibility of giving design protection to IC chips under the Design Law was urged. It was recognized, however, that the IC chip design is too small to produce an aesthetic impression on the consumer's sense of sight, and that a new law for IC chip design protection was required.

III. EXAMINATION AND REGISTRABILITY

In adopting a better design protection system, the balance between stability of the design right and the earliest grant of the design right must be taken into account when choosing one of the two systems—the examination system or the nonexamination system. If the examination system is adopted, the design rights would become more stable, but granting of the design rights would be delayed. On the other hand, if the nonexamination

8. Design Law § 26(2); *see also supra* note 6 (translating Design Law § 26(2)).

9. 17 U.S.C. §§ 901-914 (1988).

10. Act Concerning the Circuit Layout of a Semiconductor Integrated Circuit, No. 43, May 31, 1985, §§ 2, 3. Section 2 of the Act translates as follows:

(1) A "semiconductor integrated circuit" in this Act shall mean a product having transistors or other circuitry elements which are inseparably formed on a semiconductor material or an insulating material or inside the semiconductor material, and designed to perform an electronic circuitry function.

(2) A "circuit layout" in this Act shall mean a layout of circuitry elements and lead wires connecting such elements in a semiconductor integrated circuit.

Section 3 of the Act translates as follows:

The creator of a circuit layout or such person's successor (hereinafter referred to as the "creator") may obtain registration for establishment of a circuit layout right (hereinafter referred to as a "registration for establishment") with respect to the circuit layout. In such a case, if there are two or more creators of the layout, they shall jointly obtain registration for establishment.

system is adopted, the design registrations would quickly issue, and such design registrations also would be easily canceled because of anticipatory prior art. All applications for design registrations in Japan are examined for the purpose of making design rights stable and thus more meaningful. Measures for preventing the delay of such examination will be discussed below.

Examination is made with regard to the following design registration requirements. First, an alleged design must be a shape, pattern, color, or a combination of these, in an article which produces an aesthetic impression on the sense of sight.¹¹ The design should be applied to an article. An article is defined as a movable property having shape which is independently transferable.

For example, a house is not an article per se and is nonregistrable, but a prefabricated house is considered to be a movable property and independently transferable. Consequently, a design on a prefabricated house would be registrable as an article. Conversely, a mere shape, sketch, or part of an article, which is not related to a specific article, would not be construed as being an article in and of itself.

A part of an article is not construed as an article either. Since a design is defined as producing an aesthetic impression on one's sense of sight, a minute design which can be identified only with a microscope, such as IC chip pattern, or a design of a fungible commodity, such as powders, grains, gases or liquids, would not be registrable.

Second, the alleged design for which registration is sought must neither be publicly known in the world prior to its filing, nor be similar to a design publicly known in the world before its filing.¹² Designs which are publicly known or described in publications in Japan or elsewhere, prior to the filing of an application for design registration, do not have novelty, and are therefore not registrable. The similarity between various designs is determined

11. See Design Law, No. 125, Apr. 13, 1959, as amended, § 2(1); see also *supra* text accompanying note 1.

12. Design Law § 3, which translates as follows:

(1) Any person who has created a design capable of being used in industrial manufacture may obtain a design registration therefor, except for the following designs:

(i) designs which were publicly known in Japan or anywhere else prior to the filing of the design application;

(ii) designs which were described in a publication distributed in Japan or anywhere else prior to the filing of the design application;

(iii) designs which are similar to those prescribed under the two preceding paragraphs.

(2) Where, prior to the filing of the design application, a design could have easily been created by a person with ordinary skill in the art to which the design pertains, on the basis of a shape, pattern or color or a combination thereof widely known in Japan, such a design (other than a design referred to in any of the paragraphs of the preceding subsection), shall not be registered notwithstanding the preceding subsection.

by considering whether there is an aesthetic impression from the viewpoint of a general consumer. In other words, if a consumer could confuse one design with that of another, then the two designs would be considered similar.

In the case where a creator of a design or his or her assignee discloses the design to the public, the design is deemed not to be known to the public so long as the application is made within six months from the date of the public disclosure.¹³ For example, if a design is disclosed in the United States, the application in Japan is not rejected as lacking novelty, if the application is made within the six-month grace period from the date of the design disclosure in the United States.

Having a treaty provision for a grace period with respect to patent applications has been discussed by the World Intellectual Property Organization (WIPO) Committee of Experts on the Harmonization of the Laws for the Protection of Patents meeting in Geneva. Therefore, the next stage of this analysis will address the harmonization of a grace period for the protection of designs.

Third, the alleged design must not have been easily created on the basis of a motif well known to the public in Japan prior to the filing.¹⁴ A design is not registrable in the case where the design is made by a person skilled in the art on the basis of a motif publicly known in Japan. For example, a vase design on the basis of the Statue of Liberty, or a miniature car design on the basis of a well-known automobile is not registrable.

Fourth, the alleged design must be filed first.¹⁵ A design identical or similar to a design in an earlier filed application is not registrable. However, a design similar to a registered design may also be registered, provided the similar design registration is granted to the owner of the originally

13. Design Law § 4, which translates as follows:

(1) In the case of a design which has fallen under paragraph (i) or (ii) of Section 3(1) against the will of the person having the right to obtain a design registration, such a design shall not be deemed to have fallen under the said paragraph (i) or (ii), provided that such a person has filed an application for a design registration within six months from the date on which the design first fell under those paragraphs.

(2) In the case of a design which has fallen under paragraph (i) or (ii) of Section 3(1) due to an act on the part of the person having the right to obtain a design registration, the preceding subsection shall also apply, provided that such a person has filed application for a design registration within six months from the date on which the design first fell under those paragraphs.

(3) Any person who desires the application of the preceding subsection with respect to a design in an application shall submit a written statement to that effect to the Commissioner of the Patent Office simultaneously with the design application. Within 14 days of the filing of the design application, he shall also submit to the Commissioner of the Patent Office a document proving that the design in the application is a design falling under the said subsection.

14. Design Law § 3(2); *see also supra* note 12 (translating Design Law § 3(2)).

15. Design Law § 9; *see also supra* note 2 (translating Design Law § 9).

registered design. The drafters of the Design Law adopted a first-to-file system at the law's inception;¹⁶ whereas, the Patent Law initially adopted the first-to-invent system.¹⁷ It was believed at the time of the Design Law's inception, that such a differentiation would encourage earlier filing and an earlier granting of registration for a fashionable and copyable design.

IV. SCOPE OF PROTECTION COVERED BY DESIGN RIGHT

A. *Recent Trend in Japanese Court Decisions*

Section 24 of the Design Law states: "The scope of a registered design shall be decided on the basis of the statement in the request and the design represented in the drawing attached to the request or shown in the photograph, model or sample attached to the request." Judges handling the design registration infringement cases generally start by first recognizing the registered design on the basis of the description in the request and the drawings attached thereto. Then, they compare the design of the alleged infringing article with that in the design registration.

The "major portion" of a registered design is that element which attracts the consumer's attention. Judges consider whether or not the major portion of the registered design is similar to the major portion of the allegedly infringing design to the extent that both designs seem likely to lead to the confusion of consumers, together with making observations of both designs as a whole.

The definition of this standard is the most difficult to comprehend and usually becomes the focus of the dispute. For example, a majority of courts have held that the features of an article, such as its nature, object, use, technical function, and use mode, are to be taken into consideration.¹⁸ Likewise, the features of an article which are not observed carefully by a consumer, such as the inside of a cap, would not be taken into consideration.¹⁹ Moreover, in the case where there is prior art, the publicly known portion of a registered design is generally disregarded, and any other portion which has novelty and attracts the consumer's attention is considered a major portion.²⁰ In one case, however, a combination of publicly known designs was found to have constituted a major portion of the design.²¹

16. Emperor Order, No. 85, Dec. 18, 1888, § 8.

17. Cabinet Order, No. 7, Apr. 18, 1885, § 4.

18. Osaka Dist. Ct., Dec. 22, 1971; Tokyo Dist. Ct., Oct. 29, 1975; Tokyo Dist. Ct., Mar. 12, 1979; Osaka High Ct., Sept. 16, 1982; Tokyo High Ct., May 16, 1983; Nagoya Dist. Ct., June 24, 1983.

19. Tokyo High Ct., May 31, 1973; Osaka High Ct., Sept. 16, 1982.

20. Osaka Dist. Ct., Sept. 9, 1980; Osaka High Ct., Sept. 28, 1981; Osaka Dist. Ct., Oct. 16, 1981; Tokyo Dist. Ct., Mar. 14, 1983.

21. Osaka Dist. Ct., Sept. 19, 1980.

B. *Assembly and Parts*

As explained above, the design right covers only the registered designs per se and any design similar thereto. It should be noted that an assembly design right covers only the assembly and not its separate parts. Therefore, it is recommended that design registrations be applied for in Japan on all of the minimum units which form the assembly.

In the case of a telephone which consists of a main body and a receiver, for example, it is recommended to apply for three design registrations separately—the telephone consisting of the receiver and main body, the main body, and the receiver. If a third party sells receivers or main bodies, the holder of a design right can stop such sales on the basis of each of the three design rights referenced above. On the other hand, the holder of a design right only for a “telephone” cannot stop sales with respect to receivers or main bodies.

V. SYSTEMS CHARACTERISTIC OF JAPANESE DESIGN PROTECTION

There are three special types of applications under the Japanese Design Law. They are applications for article set design registration, for similar design registration, and for secret design registration.

A. *Set Design Registration*²²

An application shall relate to a single design;²³ however, some sets of articles, such as a dinner set, usually sold as one unit, may be included in a single application for design registration. The registration process, with respect to a set of articles, is prescribed under the Design Law's Design Regulations.²⁴ In addition to dinner sets, numerous other sets of articles

22. Design Law § 8, which translates as follows:

(1) In the case of a design of articles of two or more kinds that are customarily sold or used together as a set of articles, and further prescribed under an ordinance of the Ministry of International Trade and Industry (hereinafter referred to as a “set of articles”), design registration of such set of articles may be applied for in an application of a single design, provided that the set of articles is coordinated as a whole.

(2) In the case of the preceding subsection, design registration may be effected only where each of the designs of the articles forming the set of articles is eligible for registration under Sections 3, 5, and 9(1) and (2).

23. Design Law § 7, which translates as follows: “An application for design application shall relate to a single design corresponding to an article in the classes of articles prescribed under an ordinance of the Ministry of International Trade and Industry.”

24. Regulations under article 6 of the Design Law, which translate as follows: “Sets of articles prescribed under an ordinance of the Ministry of International Trade and Industry, referred to in Section 8(1) of the Design Law, shall be those as listed in the attached Table 2.” Table 2 of the Design Law translates as follows: “A set of smoking accessories; a coffee set; a spices set; a set of cruets; a green tea set; a dinner set; a set of table knives, forks and spoons; a toy spices set; a toy set of cruets; a toy dinner set; a toy set of table knives, forks and spoons; and, a set of ‘Hina-ningyo’ dolls.”

are enumerated in the regulations and may be included in a single application.

B. Similar Design Registration

A design similar to a registered design may also be registered, provided that the similar design registration is granted to the owner of the originally registered design, but only after that original design is registered.²⁵ A similar design registration is advantageous for two reasons. First, it helps to clarify the scope of the originally registered design. Second, it prevents others from producing articles with similar designs.

C. Secret Design Registration

A secret design registration application is filed in order to obtain an early filing date under the first-to-file system, thereby precluding others from copying such designs, even though the applicant will not be making and selling the article of the design application in the near future.²⁶ An applicant may request that the application be kept secret and not published,

25. Design Law § 10, which translates as follows:

(1) The owner of a design right may obtain a registration of a design which is similar only to his registered design (hereinafter referred to as a "similar design").

(2) The preceding subsection shall not be applied to a design that is similar only to a similar design registered under that subsection.

26. Design Law § 14, which translates as follows:

(1) An applicant for a design registration may demand that the design be kept secret for a period which shall be designated in the demand and shall not exceed three years from the date of the establishment of the design right registration.

(2) Any person who desires to make the demand under the preceding subsection shall, at the time of filing of the design application, submit to the Commissioner of the Patent Office a document including the following statements:

(i) the name and the domicile or residence of the applicant of a design registration;

(ii) the period for which secrecy is demanded.

(3) An applicant for a design registration or the owner of a design right may extend or reduce the period for which secrecy has been demanded under subsection (1).

(4) In any of the following cases, the Commissioner of the Patent Office shall allow persons other than the owner of the design right to have access to a design for which secrecy has been demanded under subsection (1):

(i) when the consent of the owner of the design right has been obtained;

(ii) when so requested by a party or an intervenor in the examination, trial, retrial or litigation relating to the design or any identical or similar design;

(iii) when so requested by a court;

(iv) when so requested by a person having an interest who has submitted to the Commissioner of the Patent Office a document stating the name of the owner of the design right and the registration number and other documents prescribed under an ordinance of the Ministry of International Trade and Industry.

even after it is allowed. The period of keeping a design application secret is usually three years. However, the period for secrecy may be reduced or extended upon an applicant's request.

VI. DESIGN APPLICATION PROCEDURE

A. *Request and Drawings*

To apply for a design registration, a request and drawings attached thereto are required.²⁷ In the request, the article, the applicant, the creator, and the agent shall be named, together with the addresses of such persons. Drawings may be substituted with photographs, a model, or a sample. If drawings are submitted they must describe a single specific design by way

27. Design Law § 6, which translates as follows:

(1) Any person desiring a design registration shall submit a request to the Commissioner of the Patent Office, together with a drawing of the design for which registration is sought, including the following statements:

(i) the name and domicile or residence of the applicant for a design registration and, in the case of a legal entity, the name of an officer entitled to represent it;

(ii) the date of submission;

(iii) the name and the domicile of the creator of the design;

(iv) the article or articles to which the design is applied.

(2) Where an ordinance of the Ministry of International Trade and Industry so prescribes, a photograph, model or sample of the design for which registration is sought may be submitted instead of the drawing referred to in the preceding subsection. In such a case, the fact that a variety of a photograph, model or sample submitted shall be named in the request.

(3) Where a person desires a design registration for a design that is similar to one which has been registered in his name or which has been applied for registration in his name, the number of the relevant design registration or application shall be stated in the request.

(4) Where a person with ordinary skill in the art to which the design pertains is unable to recognize the design due to his incapability to visualize the material or size of the article or articles to which the design is applied notwithstanding the statement referred to in subsection 1(iv) concerning the article or articles to which the design is applied, or the drawings, photograph or model attached to the request, the material or size referred to shall be stated in the request.

(5) Where the shape, pattern or color of an article to which the design is applied varies in accordance with the function that the article possesses and where registration is sought for the shape, pattern or color or a combination thereof as it appears before, during and after the variation referred to, the request shall contain a statement to that effect as well as an explanation concerning the said function of the article.

(6) When the colors of the design are applied on the drawing, photograph or model submitted under subsection (1) or (2), any part of the design that is white or black need not be colored.

(7) Where a part is not colored, in accordance with the preceding subsection, the request shall contain a statement of the design to that effect.

(8) In the case of the drawing of a design submitted under subsection (1) or the photograph or model submitted under subsection (2), where the whole or a part of the article to which the design has been applied is transparent, the request shall contain a statement to that effect.

of a six-view drawing: front, rear, left side, right side, top plane, and bottom views.²⁸

The size of each drawing must be accurate, and no shaded lines which usually show shade or transparency are allowed. If a six-view drawing is not sufficient to completely illustrate the design, a cross-sectional view, a perspective view, or other necessary figures must be supplied. For purposes of clarity, reference drawings may be included and the function of the article may be described in the request.

The examination of the drawings is often quite rigorous. In fact, where a discrepancy among the six-view drawings is found, the examiner issues an office action stating that the design is "indefinite" or "non-specific." At the absolute minimum, a six-view drawing should be submitted, even though some of the views may be considered unnecessary, such as in the case of the bottom view of a refrigerator or the back view of a clock.

B. Amendment of Drawings

The six-view drawings should be submitted at the time of filing. In the case where only a part of the requisite drawings are submitted at the time of filing, an amendment to add other drawings which constitute the remaining parts of the six-view perspective will be declined, if the amendment is found to include a new design which changes the gist of the design originally filed.²⁹ If the amendment is declined, the original application may be rejected on the ground that the design is indefinite or nonspecific.

28. See Appendix A at 431.

29. See Design Law § 19; Patent Law § 53; Design Law §§ 17bis, 17ter. Section 19 of the Design Law translates as follows:

Section 47(2) (qualifications of examiners), Section 53 (declining amendments), Section 63 (formal requirements of examiner's decision) and Section 65 (relationship with litigation) of the Patent Law shall apply mutatis mutandis to the examination of design applications.

Section 53 of the Patent Law translates as follows:

(1) Where an amendment to the specification or drawings attached to the request, made before the transmittal of the ruling that the application is to be published, would change the gist thereof, the examiner shall decline the amendment by a ruling.

(2) The ruling to decline an amendment under the preceding subsection shall be in writing and state the reasons thereof.

(3) Where a ruling to decline an amendment under subsection (1) has been rendered, the examiner's decision with respect to the patent application (or a ruling that the application is to be published or the examiner's decision that the application is to be refused when the ruling to decline an amendment under subsection (1) was rendered prior to the ruling that the application is to be published) shall not be rendered before the expiration of 30 days from the transmittal of that ruling.

(4) Where an applicant has demanded a trial under Section 122(1) against a ruling to decline an amendment under subsection (1), the examiner shall suspend the examination of the patent application until the trial decision has become final and conclusive.

Section 17bis of the Design Law translates as follows:

For instance, the bottom view of a refrigerator or the back view of a clock, which usually are considered to be unnecessary, may be included later during prosecution. However, if a specific design is illustrated in the amended drawings, the amendment will not be allowed. If an applicant cannot prepare complete six-view drawings at the time of filing the application, the submission of a perspective view drawing is recommended, since the chance of acceptance of the late filed part of the six-view drawings is usually very good.

Of course, drawing requirements differ from country to country. If applicants residing overseas, where the drawing requirements for design applications are different, wish to obtain design rights in Japan, they must prepare new drawings which meet Japanese requirements.³⁰ It should be emphasized that the Paris Convention priority period is only six months for design applications. Therefore, it is strongly recommended to those who intend to apply for design registration in Japan to prepare all necessary drawings well in advance.

C. *Unity of Design and Division of Applications*

The unity of design requirement is also strictly adhered to in Japan.³¹ Designs of article sets prescribed under the Design Regulations are the exception and not the rule. Therefore, except for such article sets, two or more articles may not be included in a design application. Consequently, if two or more embodiments are applied for in another country, each embodiment must be filed separately in Japan. Moreover, should an applicant wish to file only one application with two or more embodiments, the applicant is required to submit a set of six-view drawings and other necessary drawings

(1) Where an applicant for a design has filed a new design application for the design as amended within 30 days from the transmittal of a ruling to decline an amendment under Section 53(1) of the Patent Law as applied under Section 19 of this Law, the design application shall be deemed to have been filed at the time of submission of that amendment.

(2) Where a new design application referred to in the preceding subsection has been filed, the original design application shall be deemed to have been withdrawn.

(3) The two preceding subsections shall be applicable only where the applicant submits, at the same time as the new design is filed, a statement to the Commissioner of the Patent Office indicating his desire for the application of subsection (1) to the new design application referred to in that subsection.

Section 17ter of the Design Law translates as follows:

(1) The Commissioner of the Patent Office may, for the benefit of a person residing in a place that is remote or difficult of access, extend upon request or ex officio the period referred to in Section 17bis(1).

(2) The trial examiner-in-chief may, for the benefit of a person residing in a place that is remote or difficult of access, extend upon request or ex officio the period prescribed in Section 17bis(1) as applied under Section 51(1) (including its application under Section 56bis).

30. See Appendix B at 432-34.

31. Design Law § 7; see also *supra* note 23 (translating Design Law § 7).

on each embodiment for the purpose of examiner's office action advising the applicant to file divisional applications.³²

VII. FOR A BETTER DESIGN PROTECTION SYSTEM AND INTERNATIONAL HARMONIZATION OF DESIGN LAWS

If the examination system is adopted in Japan, the granting of a design right will take longer than it would under a nonexamination system. To cope with this delay problem, two measures have been proposed in Japan, namely, an accelerated examination procedure and a paperless project.

A. Accelerated Examination Procedure

If the design for which a design registration has been applied for is worked by an applicant in Japan, and a third party has started to work the design without a license, the applicant may apply for the accelerated examination procedure.

B. Promotion of Design Paperless System

The paperless project started in 1984 as a ten-year project for the purpose of facilitating a quicker processing of design applications. Under this project, all applications in machine-readable form are to be accepted and put into the database in the Japanese Patent Office. All reference materials, which have been given D-terms,³³ are also placed in the database. Pertinent prior art can be retrieved through use of the D-term retrieval system.

Many countries have adopted design laws that differ considerably from those employed in Japan.³⁴ Some countries have examination systems and others have nonexamination systems. Japan has the six-view drawing prac-

32. Design Law § 10bis, which translates as follows:

(1) An applicant for a design registration may divide a design application including two or more designs into one or more new design applications.

(2) A design application may not be divided under the preceding subsection after the examiner's decision or the trial decision with respect to the application becomes final and conclusive.

(3) Where a design application has been divided under subsection (1), the new design application shall be deemed to have been filed at the time of filing of the original application.

33. D-term is a tool used for the computer retrieval system for retrieving design prior art stored in the database. In the database, design patents, utility patents which include designs, magazines, books, and the like, useful for examination of applications for design registrations are stored as image data. In addition to D-terms, design classification and bibliographic data are used as tools for the retrieval system. D-terms have been developed by design examiners on the basis of analysis of search materials available for examination. D-terms consist of shapes, patterns, colors or designs, and functions or uses of articles to which designs are applied. D-term retrieval system is currently used on a trial basis, and is expected to be used as an actual search tool for examiners in the mid-1990s.

34. See Appendix C at 435.

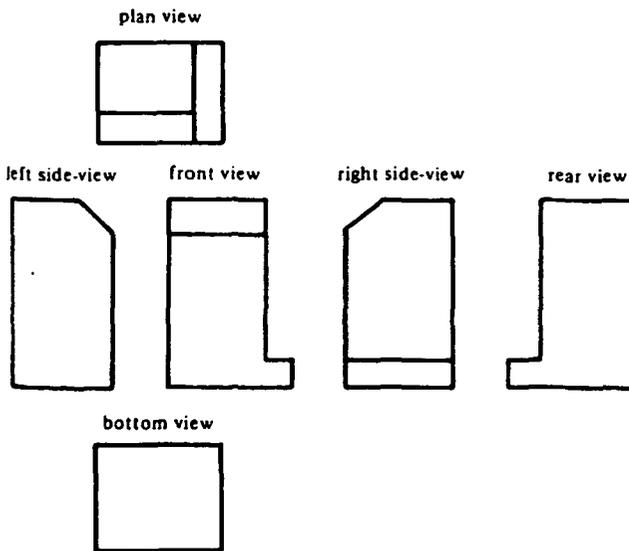
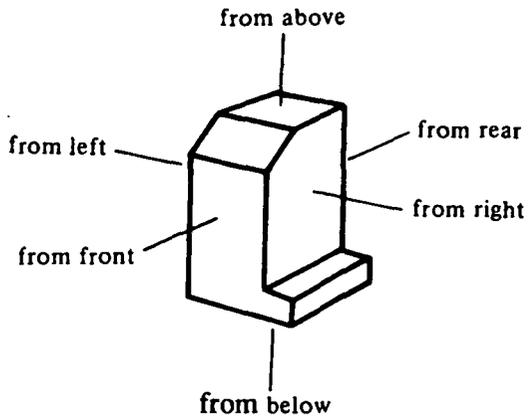
tice, and the design right is extended to provide similar design coverage. Other countries do not have these features in their laws.

VIII. CONCLUSION

Harmonization of certain provisions of patent laws is currently being discussed at the WIPO meetings of the Committee of Experts. A proposed treaty for the harmonization of such patent laws is presently being drafted. To cope with the recent trend of highly advanced communications between countries, and vast numbers of goods and articles traveling quickly throughout the world, harmonization of design protection laws is needed to simplify the procedures, so the creators of designs can obtain internationally uniform protection for their designs.

Strengthening the protection given to intellectual property, including design rights in the world, is an important issue. It is this author's hope that this Article will help lead toward a better understanding of the Japanese Design Law, and will promote discussion on the achievement of international uniform laws for design protection.

APPENDIX A

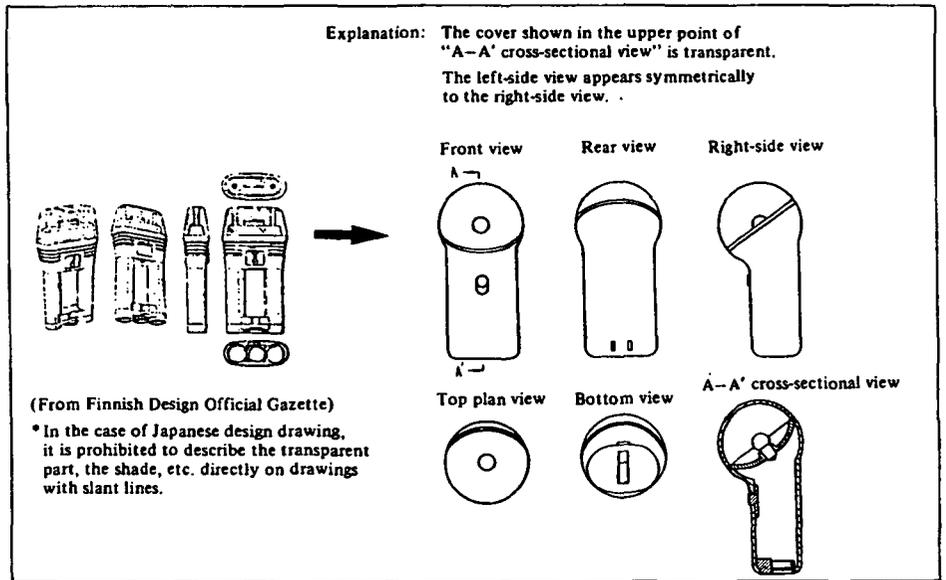


Six-View Drawing

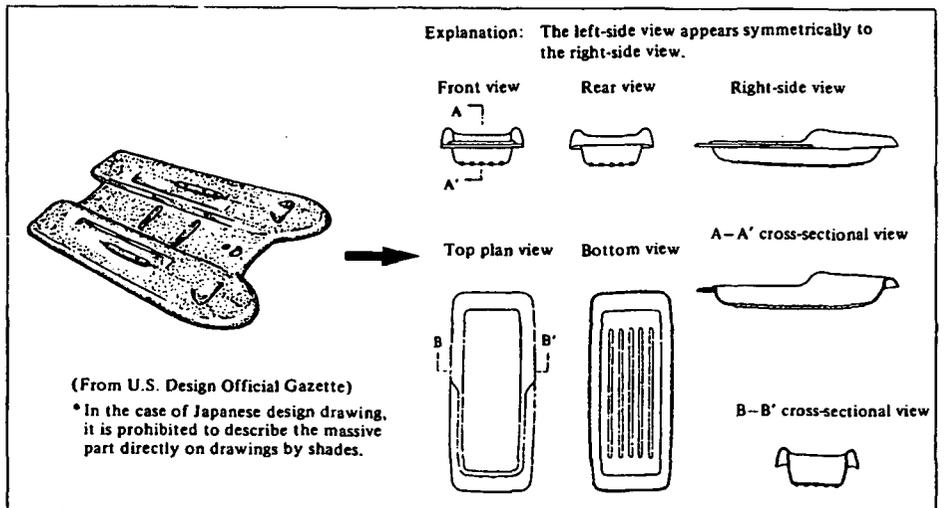
APPENDIX B

Examples of Differences Between Japanese Design Drawings and Foreign Design Drawings

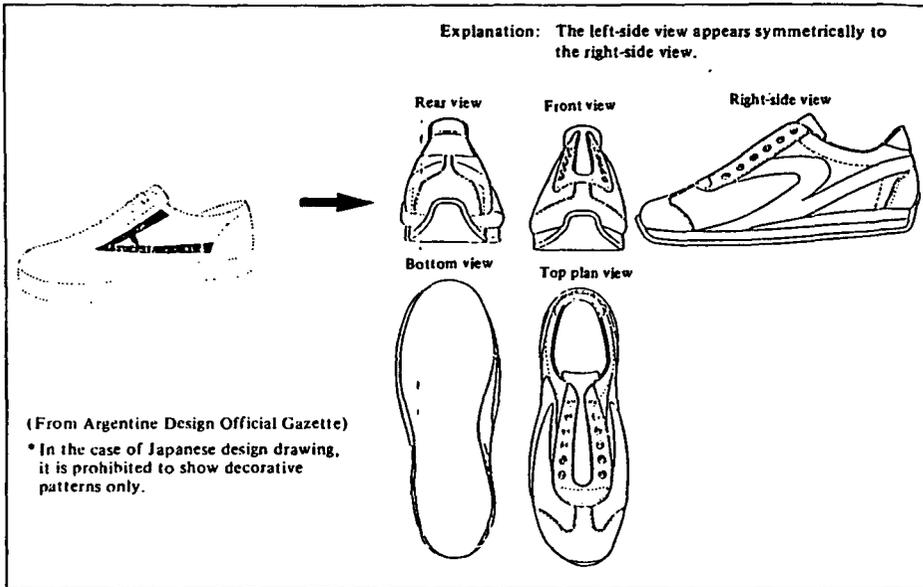
Example (1) Portable lamp



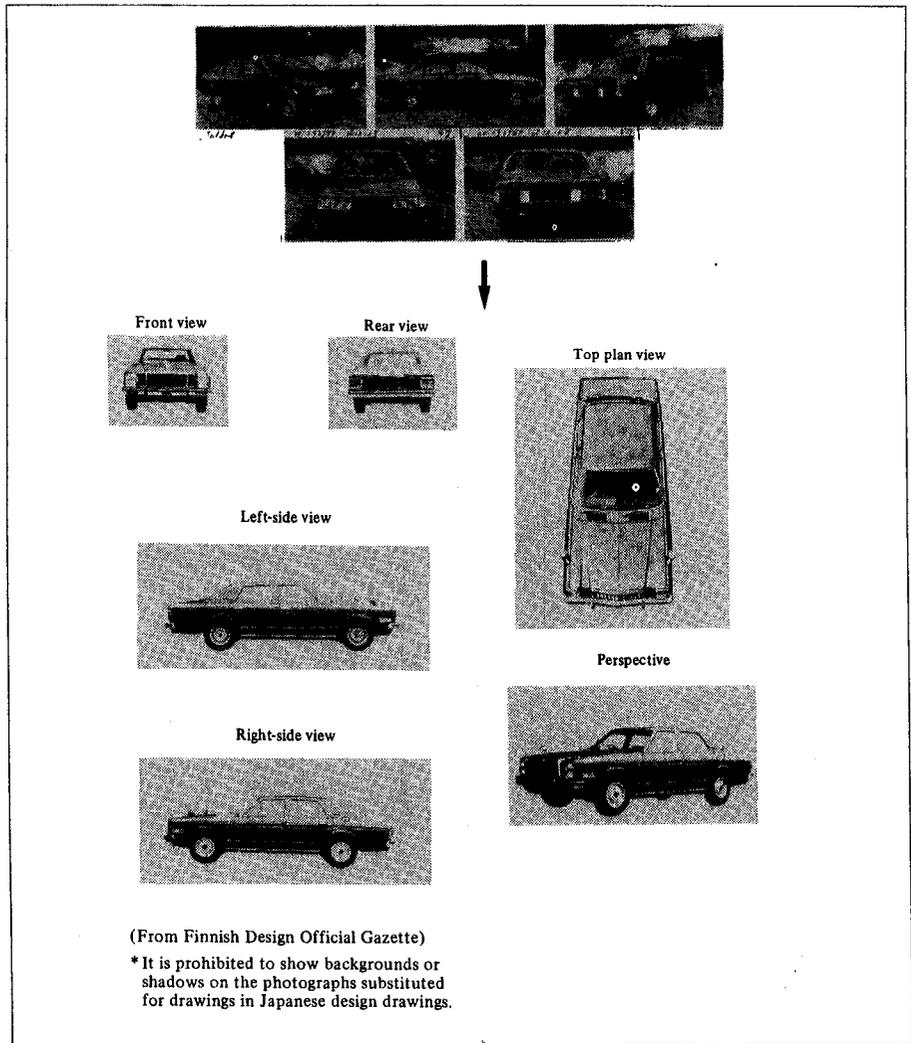
Example (2) Sleigh



Example (3) Shoes



Example (4) Passenger car



APPENDIX C

Comparison of Design Registration Systems of Major Countries

| | Japan | U.S.A. | U.K. | Nordic | W. Germany | France |
|-----------------------|--|--|--|--|--|--|
| Object for Protection | Shape, pattern or color of an article or a combination thereof which creates a sense of beauty, which can be industrially utilized, and which has novelty, originality and creativity. | Any new, original and ornamental design for an article of manufacture. | Outward appearance (shape, pattern and ornament) of an article of manufacture. It is judged by the eye, but does not include a method or principle of construction or elements of form or configuration dictated solely by the function of the products. Design must be new and original. | The prototype for an article's appearance or for an ornament. | Only new and original products (eigentümliche Erzeugnisse) shall be considered to be designs. | Every novel design, new plastic form or industrial object which is distinguished from similar objects either by a distinct configuration giving a character of novelty or by one or more external effects giving an individual and novel appearance. |
| Application | Submit application papers and three sets of drawings to Patent Office. One application for one design. | Submit application papers conforming to formalities for an invention and drawings to Patent Office. One application for a plurality of designs. | Submit application papers and drawings to Patent Office. One application for one design. | Submit application papers and drawings to Patent Office. One application for one design but for up to 20 designs according to conditions. | Make application by depositing papers and drawings with Patent Office. One deposit for not more than 50 designs in the same classification. | Deposit documents with Patent Office or court for commercial case. One deposit for not more than 100 designs. |
| Examination | Conducted | Conducted | Conducted | Conducted Opposition may be raised within two months after publication of examined application. | Not conducted | Not conducted |
| Protection period | One year forming one period and 15 years at most. | Applicant selects any of the following periods: 14 years after delivery of certificate of design patent grant. | Five years forming one period and 15 years at most. | Five years forming one period and 15 years at most. | 5 years from the day after application 5 years or a multiple of 5 years forming prolonged period and 20 years at most. | Not longer than 50 years from the date of deposit. |
| Official Gazette | Official Gazette carries design. | Official Gazette carries design. | Official Gazette carries list only. | Official Gazette carries design. | Official Gazette carries design. | Official Gazette carries list only. |