



## Session 4

# Additional Approaches: Using Design Rights to Protect Your Technology in Japan

A decorative graphic on the left side of the slide, featuring a stylized red and yellow flower or leaf design with a blue and white polka-dot pattern.

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Conference 2017**



## Speakers:

Yukei Mizuno, CoTech International

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## Seattle:

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# Overview of Design Protection in Japan

Yukei MIZUNO

Japan Patent Attorneys Association  
International Activities Center

A red rectangular logo with white text that reads 'Discover IP JAPAN Conference 2017'. The logo is partially overlaid by a decorative graphic of colorful, stylized leaves or petals in shades of red, yellow, and blue.

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# Agenda

- Summary of Japanese Design Registration System
- Procedures for Obtaining Design Registration
- Major requirements for Obtaining Design Registration
- Statistics of Japanese Design System
- Introduction of Today's Topics



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# Summary of Japanese Design Protection

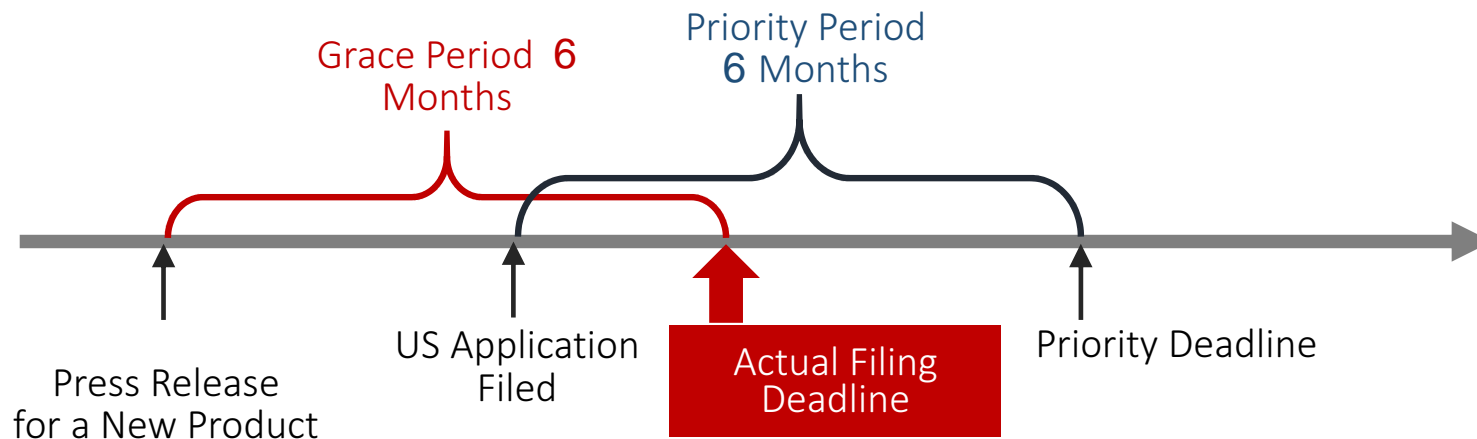
Applicable Laws	Japan Design Law
Object of Protection	Industrial Design <ul style="list-style-type: none"><li>• <i>“Design” is the shape, patterns or colors, or any combination thereof, of an article (including a part of an article), which creates an aesthetic impression through the eye. [Design Law Sec.2-(1)]</i></li></ul>
Priority	Within 6 Months from Priority Dates
Grace Period	Within 6 Months from Losing Novelty
Duration of Protection	20 Years from Registration Dates (cf. Patents: 20 Years from <u>Filing Dates</u> )





# Grace Period

	Japan	US
Grace Period	6 Months	1 year
Written Statement	At the Time of Filing	N/A
Certificate	30 Days from the Filing Date	N/A



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# Procedures for Obtaining Design Registration

## Filing An Application

- Name and address of each creator
- Name and address of each applicant
- The name of article
- Drawings
- Priority information and certificates

## Examination

- No unexamined publication
- Not required to request substantial examination

NO

Substantial requirements?

YES

Decision of Refusal

Decision of Registration

Registration Publication



# Major Requirements for Obtaining Design Registration

- Industrial Applicability
  - Possibility of repeatedly producing the same articles using industrial technology is needed
- Novelty
  - Another design which is identical or similar to the design did not exist prior to the filing of the application for design registration
- Creative Difficulty
  - A person ordinarily skilled in the art of the design would have not been able to easily create the design
- First to file
  - The applicant who filed the application for design registration on the earliest date shall be entitled to obtain a design registration for the design





## Statistics – Number of Filings

Year	Design Applications	Patent Applications	USPTO (US)
2011	30,805	342,610	29,059
2012	32,391	342,796	30,467
2013	31,125	328,436	32,799
2014	29,738	325,989	36,034
2015	29,903	318,721	34,742



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# Statistics – Applicants Top 20 (2015)

	Company Name	Number of Filings		Company Name	Number of Filings
1	Panasonic	538	11	Apple	137
2	Mitsubishi Electric	445	12	Nissan	133
3	Okamura	368	13	Suzuki	129
4	LIXIL	289	14	Daikin	127
5	Sharp	281	15	Dai Nippon Printing	126
6	Honda	209	16	Bridgestone	122
7	Toshiba	153	17	Toyota	119
8	NIKE	148	18	Elecom	118
9	Samsung	142	19	FUJIFILM	114
10	Yanmar	141	19	TOTO	114





# Statistics

Average Period  
from Filing to  
Issuing the First Action

6.1 months (2015)

c.f. Patents: Approx. 11 months from  
Requesting Examination

Registration Rate

Around 90%

c.f. Patents: Around 60%



# What We Would Like To Introduce Today

- Various Options of Protection
  - Related Design Registration
  - Partial Design Registration
  - Secret Design System
- Japanese Design is Possible to Use as Completion of Patents
  - Protection of Graphic Images is Available
  - Functional Shapes Can Be Protected
  - Quicker Examination – 6 Months from Filings
  - Easy to Recognize, Easy to Use While Enforcement Without Technical Discussion



# Thank You for Your Attention

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# Maximize Your Design Assets in Japan

## Comparison of Designs, Patents and Utility Model, and Infringement Test

Chikako Mori

Japan Patent Attorneys Association

International Activities Center



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# Topics

1. Comparison of Designs, Patents and Utility Models
2. Infringement Test - Determine the Scope of Protection
3. How US Companies can Highlight Characteristic Features of Designs to Protect Designs Effectively in Japan

# Comparison of Designs, Patents and Utility Models

	Design Law	Patent Law	Utility Model Law
Scope	Industrial design	Inventions	Inventions
	Shape, patterns or colors, or any combination of article *Graphic image on a screen is protectable	Technical ideas	Technical ideas relating to the shape or structure of an article or combination of articles
Required documents for filing (Power of Attorney is not mandatory)	Application Form Drawings or Photographs *figures with contain enough views to completely describe the design- 6 view drawings (+ perspective view etc., when necessary) *No claim	Application Form Claims Specification Abstract Drawings (when necessary)	Application Form Claims Specification Abstract Drawings



# Comparison of Designs, Patents and Utility Models

	Design Law	Patent Law	Utility Model Law
Examination	Substantive examination	Substantive examination *a request must be made	Basic requirements examination only
Average length of examination	6 months (FA) *through registration, it typically takes around 8 months	9 months (FA) *through issuance of patents, it is not rare to take 20 months or longer	2 months from filing through registration (for regular applications)
Publication	After registration *secret design system is available	After 18 months from filing	After registration

# What is Secret Design System?

Article 14 (1):

An applicant for design registration may request that the design be kept in secret for a period that shall be designated in the request and shall be **no more than three years** from the date of the registration establishing the design right.

Secret design system is a unique system to Japan which is introduced due to the nature of designs which tend to be copied or counterfeited relatively easily (not all products are brought into market soon after registration).

No “secret invention”.

# Secret Design: What you need to be aware of

- 1) Up to 3 years (can be shortened or extended by request)
- 2) A request to be secret must be made at the time of filing **or at the time of making the 1st year annuity payment**
- 3) **Not applicable for design registration through the Hague system**

# Comparison of Designs, Patents and Utility Models

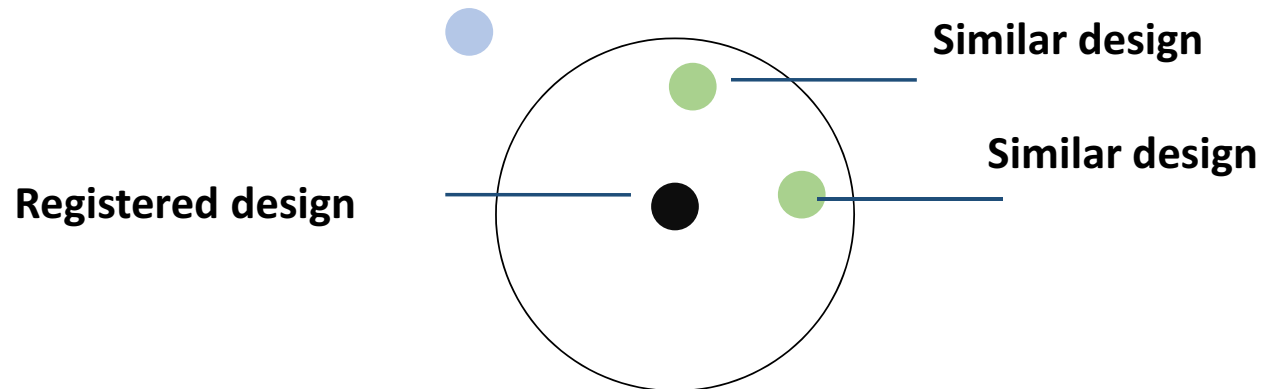
	Design Law	Patent Law	Utility Model Law
Opposition	No <b>*Only invalidation</b>	Yes (post-grant opposition)	No
Invalidation	Yes	Yes	Yes
Term	20 years from registration date	20 years (up to 25 years) from filing date	10 years from filing date
Scope	Exclude others from making, using, offering for sale, selling, import, export of article with rights		
	Designs and similar designs <b>*appearance of product</b>	Claims	Claims

# Comparison of Designs, Patents and Utility Models

	Design Law	Patent Law	Utility Model Law
Conversion	Between design and patent/utility model application	Between patent and design/utility model application	Between utility model and design/patent application *utility model <b>right</b> can be converted to a patent application, but not a design application
Remedies	Injunction, damages etc.		Injunction, damages etc. but less enforceable (restricted)

## Design Rights Extending to Similar Designs (scope of the design for litigation)

Article 23: A holder of a design right shall have the **exclusive right to work the registered design and designs similar thereto** as a business . . . .”



# Determine the Scope of a Registered Design

Article 24: . . .the design stated in the **application** and depicted in the **drawing or** represented in the **photograph**, model or specimen attached to the application.

## **Application**

**Name of Article (mandatory)**

**Description of Figures (optional)**

**Feature Description (optional)**

**Common functions or applications of the article**

# Infringement Test: What is “Similar Designs”?

Article 24 (2): the aesthetic impression that the designs would create through the eyes of their consumers.

Test: Whether common aesthetic impression on the basis of general consumer’s sense?

Yes – Identical or Similar (infringed)

No – Dissimilar (not infringed)



# Making a Comparison between an Accused Product and a Product of a Registered Design by Courts and Customs

**Observe as a whole and the characteristic features of the design (attracted part)**

“...to ascertain the characteristic features of the design by assessing the part to which consumers or dealers are most attracted, based on the properties, purpose, and embodiment of usage of the article of the design, and based on the presence of the newly created portion that the prior design did not have” (“Self-Propelled Crane Case” (Tokyo High Court / Case H09 (Ne) 404 (Jun. 18, 1998(H10)

# **Key: Companies should Consider Looking at Characteristic Features when Filing for Design Protection in Japan**

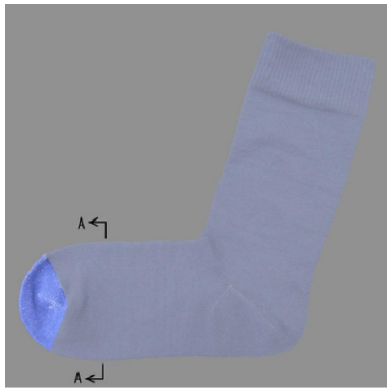
To accomplish:  
partial design and related design is often useful

# What is the “Partial Design System”?

Similar to US practice, using solid lines for claiming rights and using broken lines for environment or background\* is available in Japan. Filing applications for partial designs are popular in Japan.

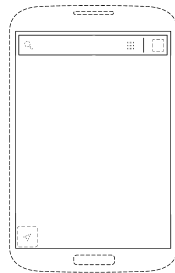
\*differentiating claimed parts by colors is also available.

Japanese Design Registration  
No.1552707



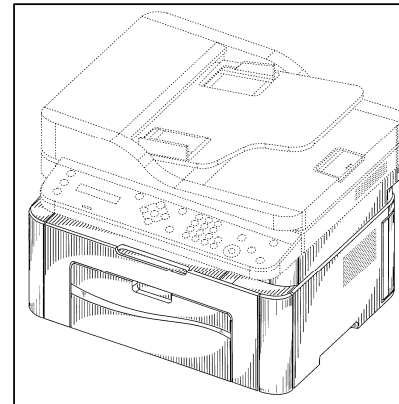
socks

Japanese Design Registration  
No.1540348



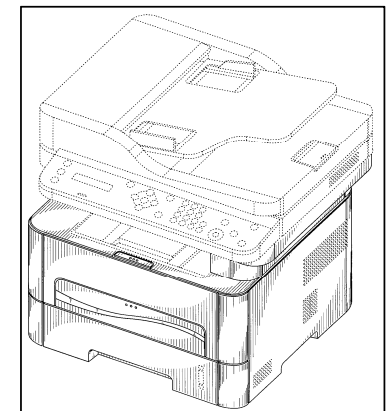
personal digital assistants

Japanese Design Registration  
No.1536571



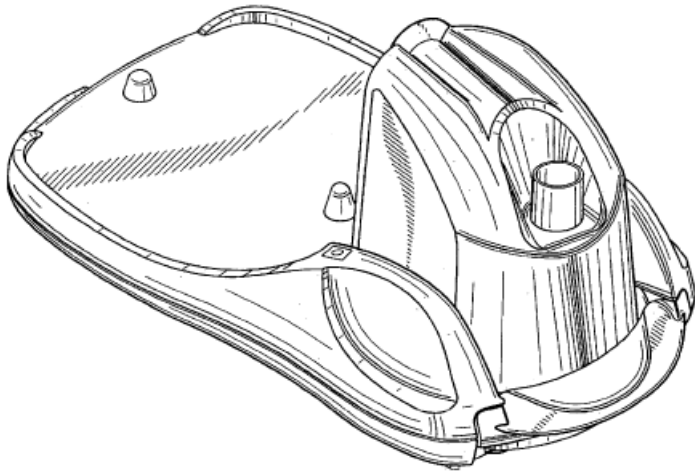
printer

Japanese Design Registration  
No.1536572

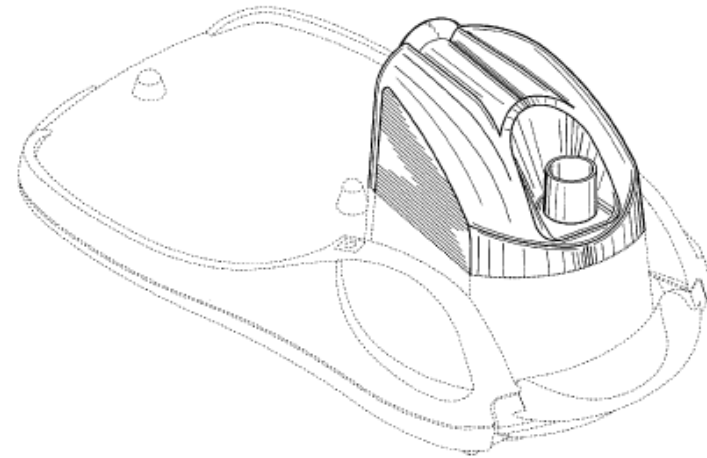


# US Practice – Partial Designs - Example

**D545594 (Resmed) - humidifier**



**D569958 (Resmed) – portion of humidifier tub**

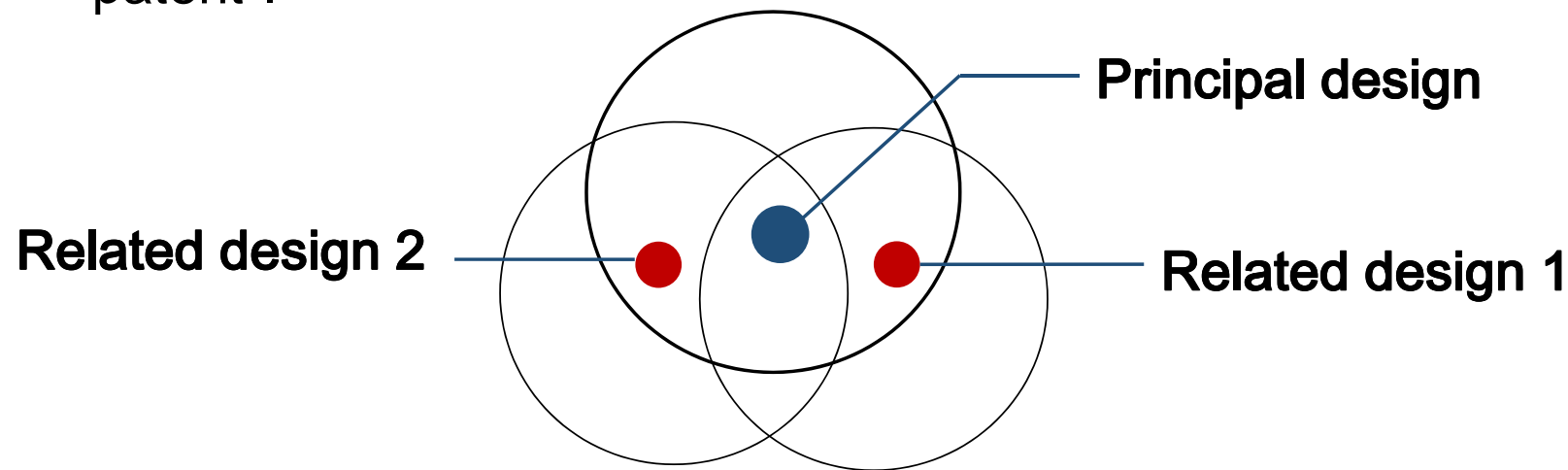


# US Damages Law – Apple v. Samsung (Supreme Court, 2016)

- Issue: what is the appropriate damages calculation for design infringement
- Held: damages for a design can be limited to the “article of manufacture” claimed in the design patent application
  - Supreme Court did not provide a specific test to calculate the damages
- Strategy point: use partial designs is to include a broader “article of manufacture” by including solid lines for some features of the end product to which the component is attached.
  - Other examples
    - tire maker may claim the tire and a part of the wheel (or car).
    - app maker may claim app and at least an edge of a mobile device

# What is the “Related Design System”?

In Japan, if two or more designs are similar to one another and owned by the same company, they should be registered as **related designs**. Without a claim of “related designs”, an application will be refused due to “double patent”.



# Special Requirements for Related Design System

1. Applicant must be the same person (to avoid confusion)
2. Related design must be similar to the principle design

If designs are not similar, the JPO will refuse an application. **In other words, if a design is registered as a "related design", it tells us that the JPO (design examiner) finds that the design is similar to the principle design.**

Core design features (characteristic features) become clearer.

# Special Requirements for Related Design System

3. The related design application must be filed on or after the date of filing of the principle design application but before the date of publication of the Design Gazette.

When the application for the related design fulfills the above requirements, the application for the related design will not be refused on the basis of the similarity with the principle design.



# Different design rights but...

A right of related design is separate from that of its principle design.

However, the duration of right of related design is the same as that of principle design (related design cannot be used for extension of rights) .

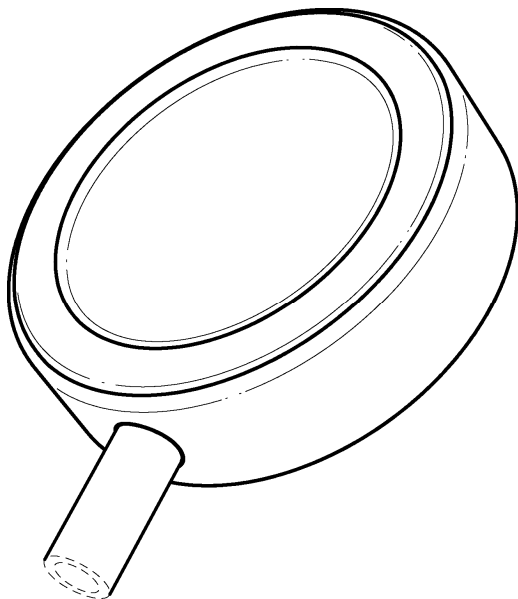
Principle design and related designs must always be commonly owned/exclusively licensed.

# Having Broader and Stronger

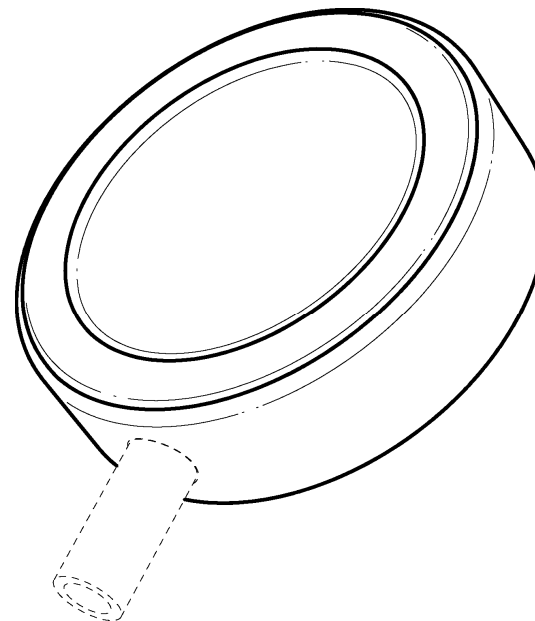
## What are the common parts in these designs?

Chargers

Japanese Design Registration  
No. 1539650 (principle design)



Japanese Design Registration  
No. 1539784 (related design)



# Having Broader and Stronger

## What are the common parts in these four designs?

Animal toys

Japanese Design Registration  
No.1393371 (principle design)



Japanese Design Registration  
No.1393487 (related design)



Japanese Design Registration  
No.1393486 (related design)



Japanese Design Registration  
No.1393488 (related design)





Thank you for your attention

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Sun East IP Firm

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Essential Information About  
Design Protection in Japan

# Protection of Functional Shape

~Utility Patent or Design Patent?~

**In the light of differences between the U.S. and Japanese systems**

Tomoya Kurokawa

Japan Patent Attorneys Association

International Activities Center



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## Protection of functional shape under the law

### Design Law Sec. 2-(1)

"Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article, which creates an **aesthetic impression** through the eye.

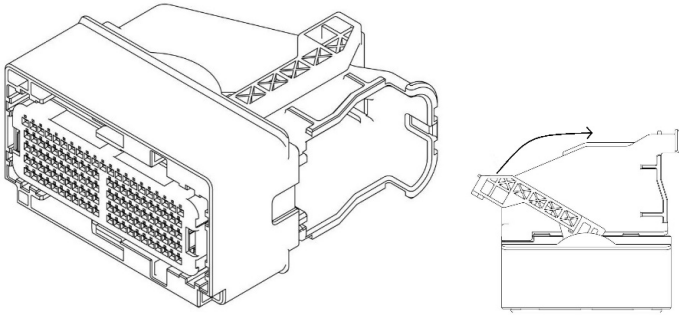
### Design Law Sec. 5

The following designs shall **not** be registered.

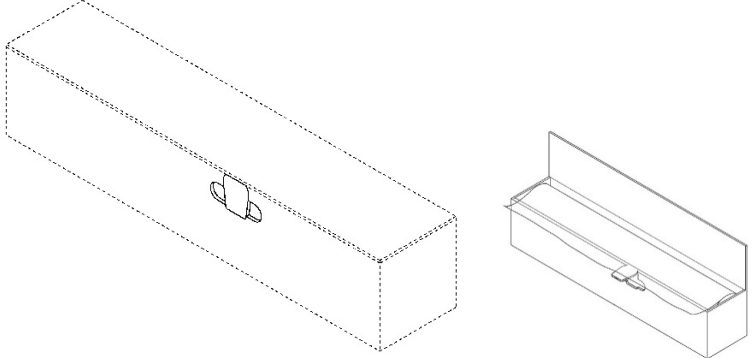
...

(iii) a design **solely** consisting of a shape that is **indispensable** for securing functions of the article.

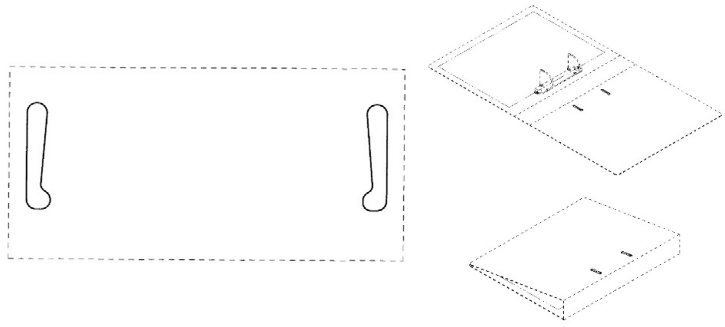
# Examples of registered design which may be related to a function of an article



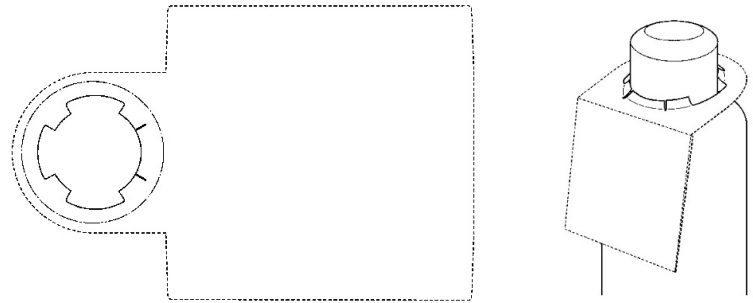
JPD1565244  
Electrical connector



JPD1226386  
Container box (for plastic wrap)

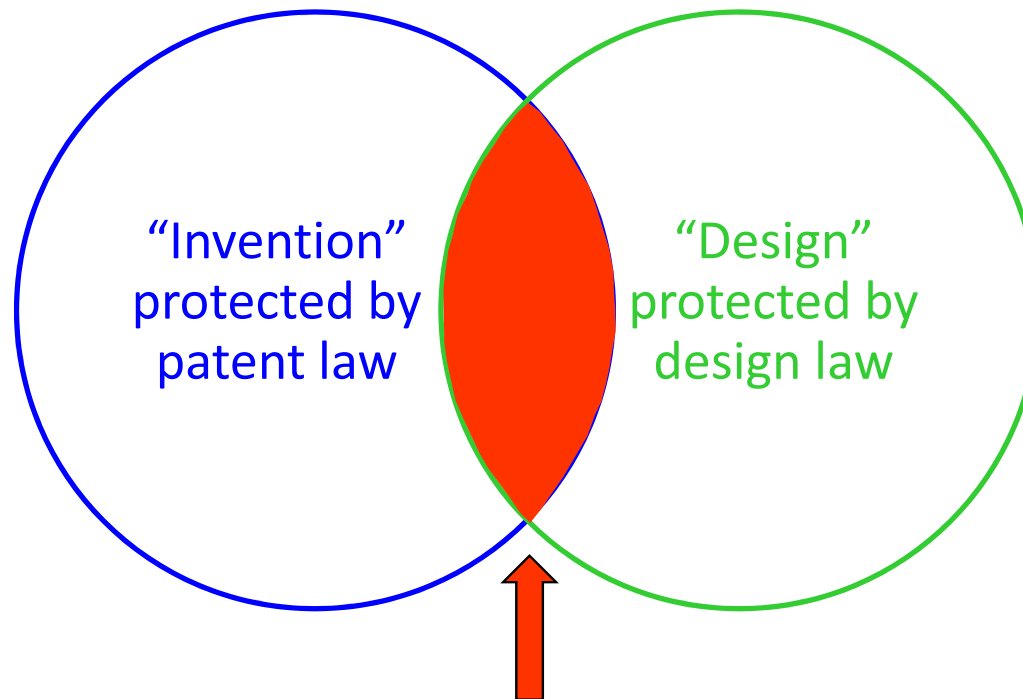


JPD1156811  
Filing cover



JPD1150294  
Pendant label for bottle

Functional shape can be protected by both patent law and design law



Functional design which is **not** "solely" consisting of a shape that is **indispensable** for securing functions of the article"



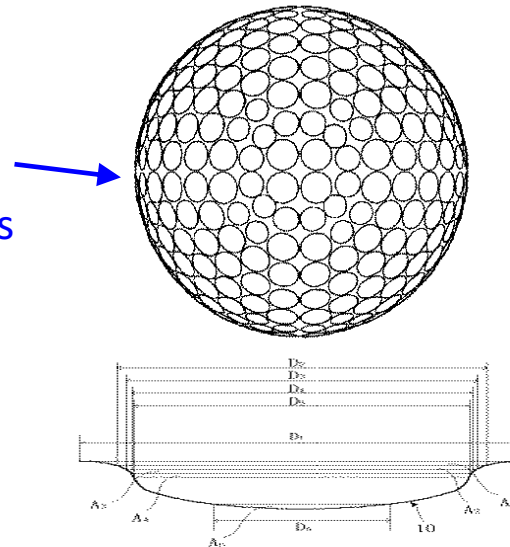
# US Practice Comparison – Function in Designs

Standard under 35 USC 171 as explained in - *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, (Fed. Cir. 2015)

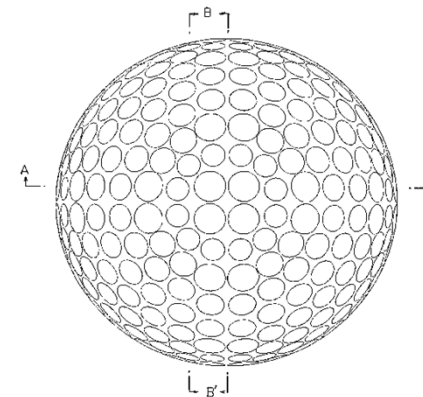
- “Articles of manufacture necessarily serve a utilitarian purpose, but design patents are directed to *ornamental designs of such articles*. 35 U.S.C. §171. If a particular design is *essential to the use of an article*, it cannot be the subject of a design patent.
- “We have found designs to be *essential to the use* of an article when the claimed design is ‘*dictated by*’ the use or purpose of the article.
- “Design patents on such primarily functional rather than ornamental designs are invalid.”

# Example of using design right to protect invention "Golf Ball" by BRIDGESTONE SPORTS

Shape and arrangement of dimples to enable golfers to improve their distance



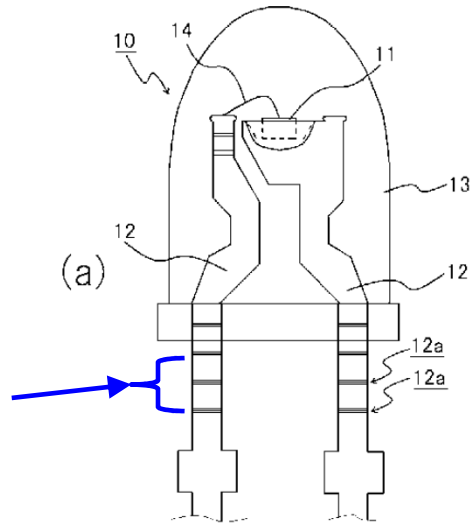
Pat. Reg. No. 3698195  
Status : Registered



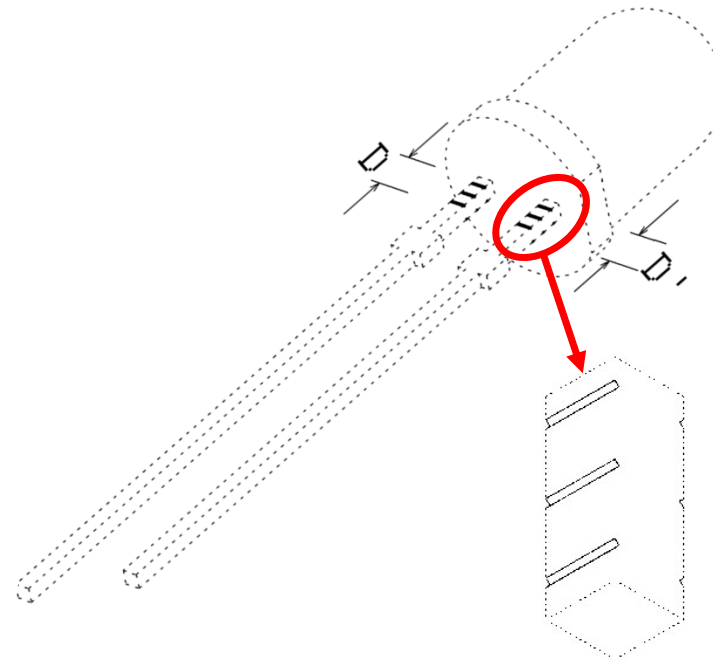
Des. Reg. No. 1144546  
Status : Registered

# Example of using design right to protect invention "LED" by NICHIA

Concaves  
for absorbing  
climbing  
solder paste  
to protect  
device



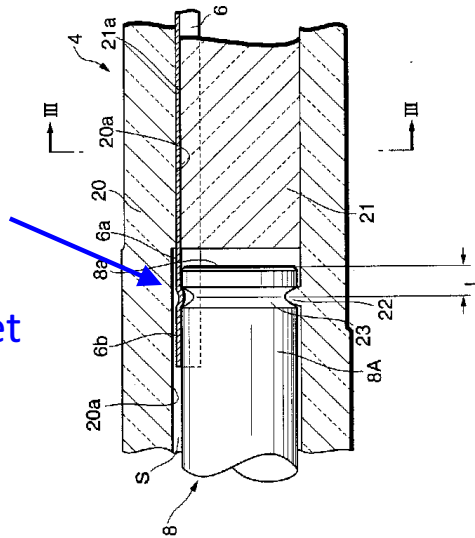
Pat. App. No. 2007-41663  
Status : Rejected



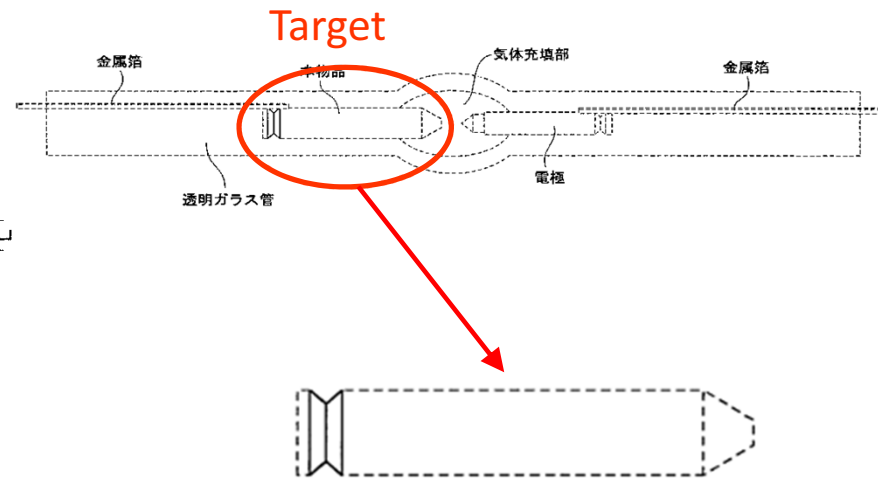
Des. Reg. No. 1314093  
Status : Registered

# Example of using design right to protect invention “Target of Discharge Lamp” by Hamamatsu Photonics

Grooves to extend lamp life by absorbing heat expansion of the target



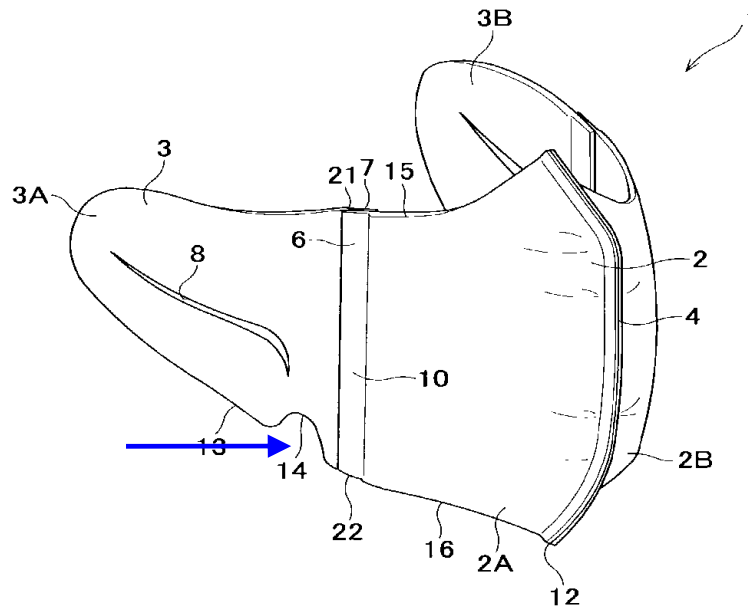
Pat. App. No. 1998-339897  
 Status : Rejected



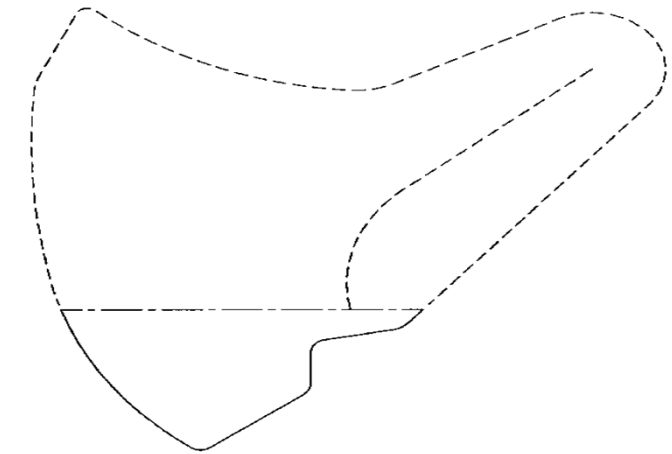
Des. Reg. No. 1082924  
 Status : Registered

# Example of using design right to protect invention “Mask” by Unicharm

Cutout  
to reduce tension  
on the ears

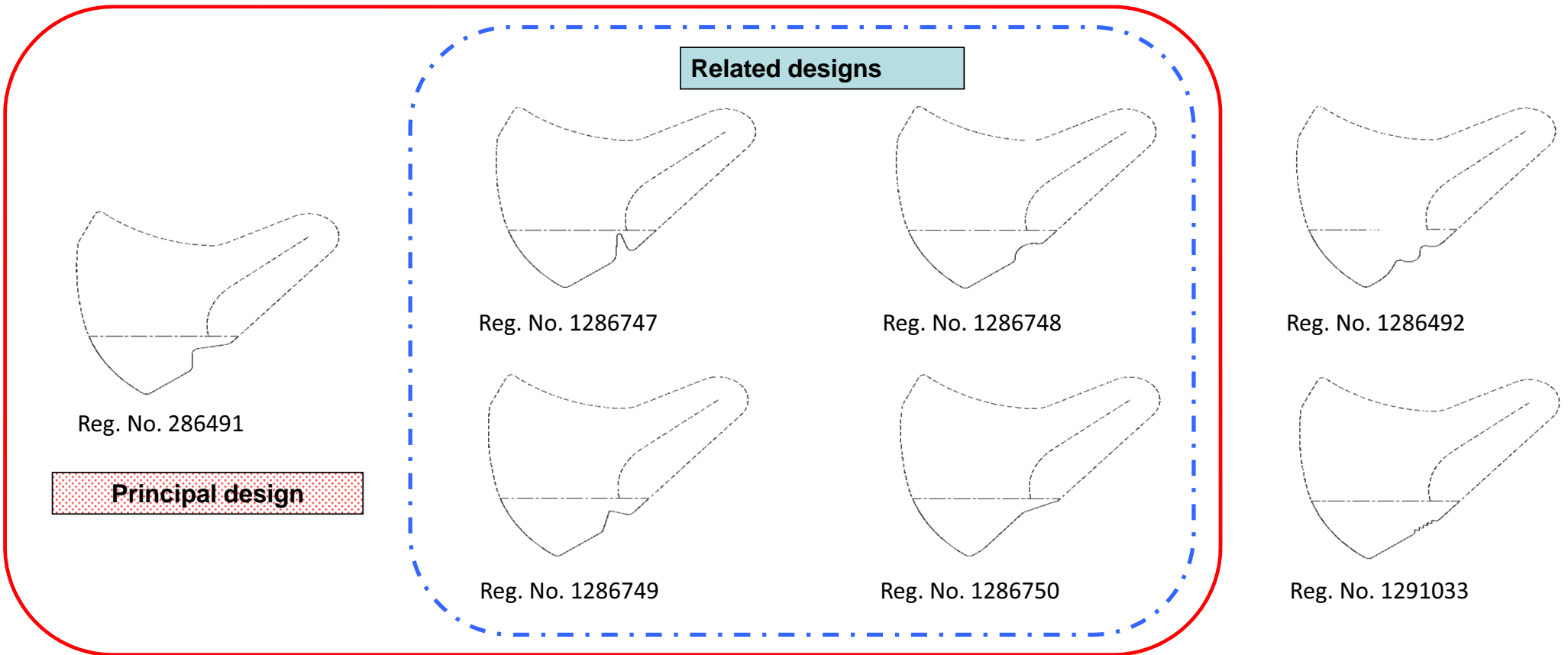


Pat. Reg. No. 5074746  
Status : Registered



Des. Reg. No. 1286491  
Status : Registered

# Example of using design right to protect invention “Mask” by Unicharm



## Advantages of design compared to utility patent

- Quicker registration
  - 6 months from filing to first action in design
  - c.f. 10 months from Req. for Ex. to first action in patent
- Higher percentage of registration
  - 88 percent of all design applications are registered
  - c.f. 54 percent of all patent applications are registered
- Longer duration of registered right
  - 20 years from registration for design
  - c.f. 20 years from filing for patent
- Easier Enforcement
  - Useless technical discussion less likely in litigation
  - greater resistance to invalidation



Thank you for your attention

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SOEI PATENT & LAW FIRM





Essential Information About  
Design Protection in Japan

# Protection of Graphic Images

In the light of differences between the U.S. and Japanese systems




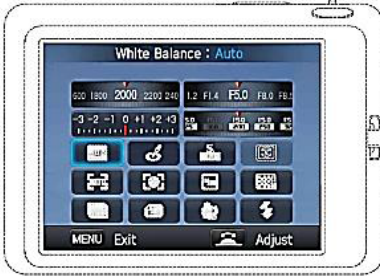
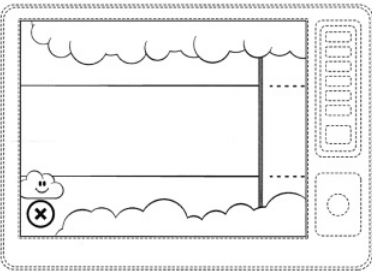
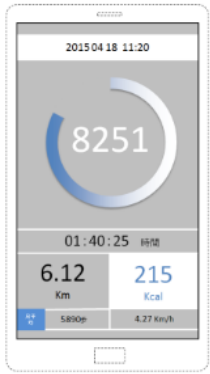
Makoto Onda

Japan Patent Attorneys Association  
International Activities Center

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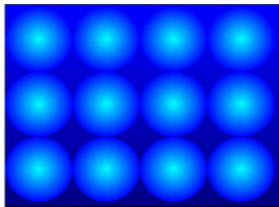
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# Registrable Graphic Images

Graphical images that have been registrable 	Graphical images that become registrable  → 
<p>Graphic Images that are prerecorded on an article</p> <ul style="list-style-type: none"> <li>- Graphic Images that are prerecorded on a device for a specific use like digital camera</li> </ul> <p>Example)</p> <div style="display: flex; justify-content: space-around; align-items: center;"> <div style="text-align: center;">  <p>Digital camera JPD1456916</p> </div> <div style="text-align: center;">  <p>Breath analysis device JPD1470457</p> </div> </div>	<p>Graphic Images that are recorded on an article</p> <ul style="list-style-type: none"> <li>- Graphical images of update of functions of a device for a specific use</li> <li>- Graphical Images of specific functions that are prerecorded on electronic computers (personal computers, tablet computers, smartphones, etc.)</li> </ul> <p>Example)</p> <div style="text-align: center;">  <p>Electronic computer with pedometer function</p> </div>

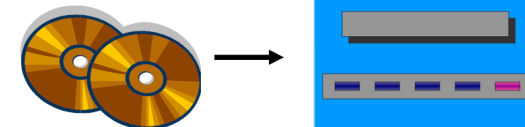
# Case Examples of Unregisterable Graphic Images on a Screen

Graphic image of a television program or from the Internet



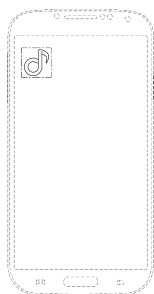
Wallpaper on a screen solely intended for decorative expression

Graphic image recorded on a recording medium

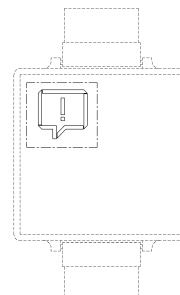
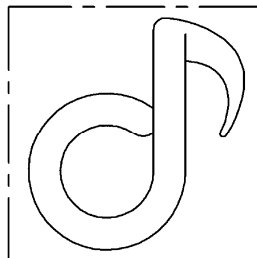


Graphic image displayed by a game machine

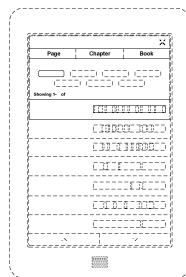
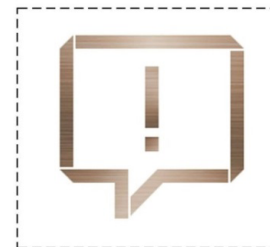
# Examples of Registered Designs including a Graphic Image on a Screen



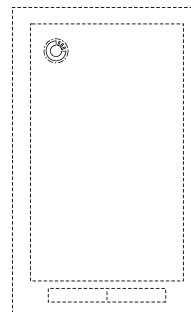
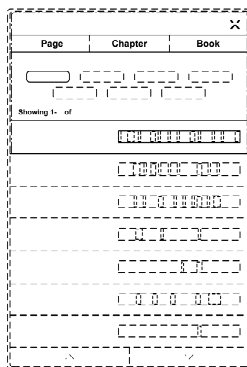
JPD1507638  
Mobile terminal device / Samsung



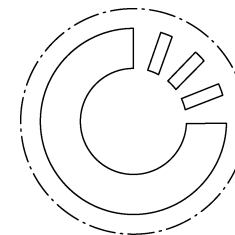
JPD1506186  
Mobile terminal device / Samsung



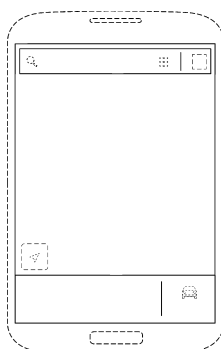
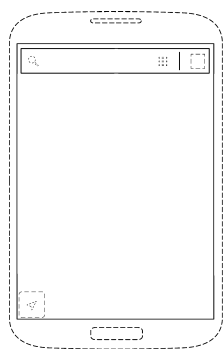
JPD1457799  
Electronic book / Amazon



JPD1526530  
Mobile terminal device / Dropbox

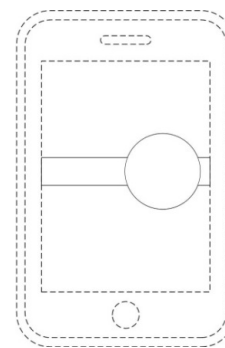
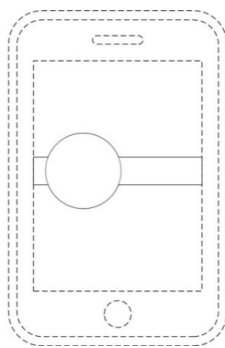
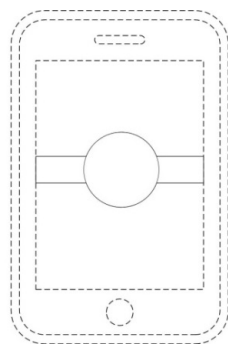
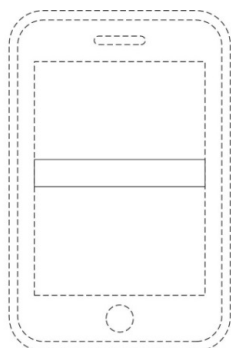


# Examples of Designs including a Graphic Image on a Screen (Transitional)



JPD1540348

Mobile terminal device / Google



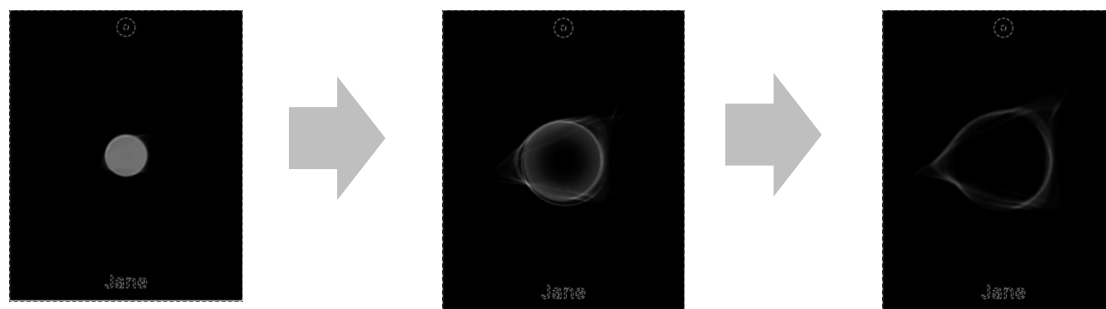
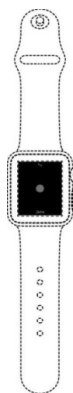
JPD1529903

Mobile terminal device / Yahoo

# Examples of Register Designs including a Graphic Image on a Screen (Transitional)



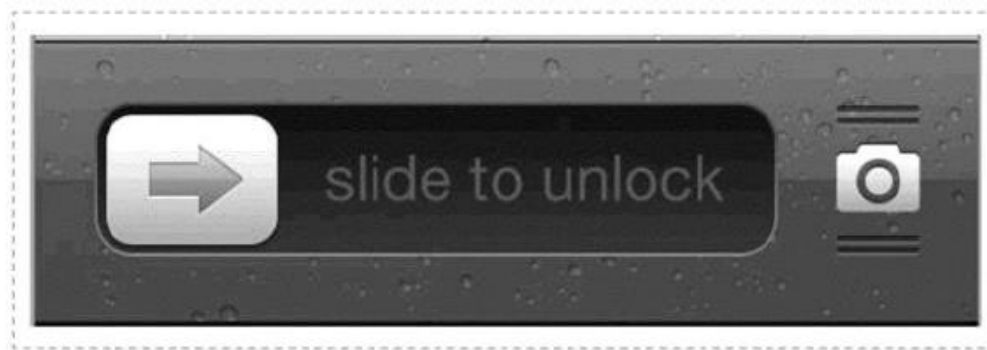
JPD1513085  
Mobile terminal device / Sony



JPD1537024  
Mobile terminal device / Apple

# US Practice on GUI

- GUI Design is protectable as an ornamentation on an article of manufacture; the article of manufacture (e.g., display screen) is shown in broken lines
- Examples
  - Slide Lock: D704212(Apple)



# US - GUI Examples

**Animation: D687047 (Nest) – must include  
*description of the animation***

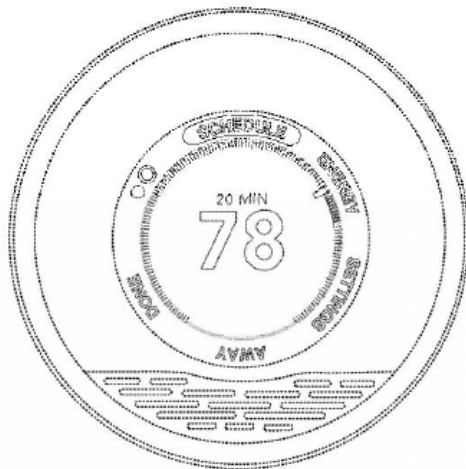
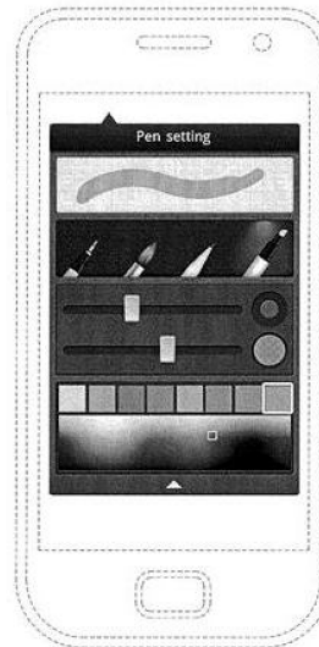


FIG. 1

**Smartphone UI: D725662 (Samsung)**

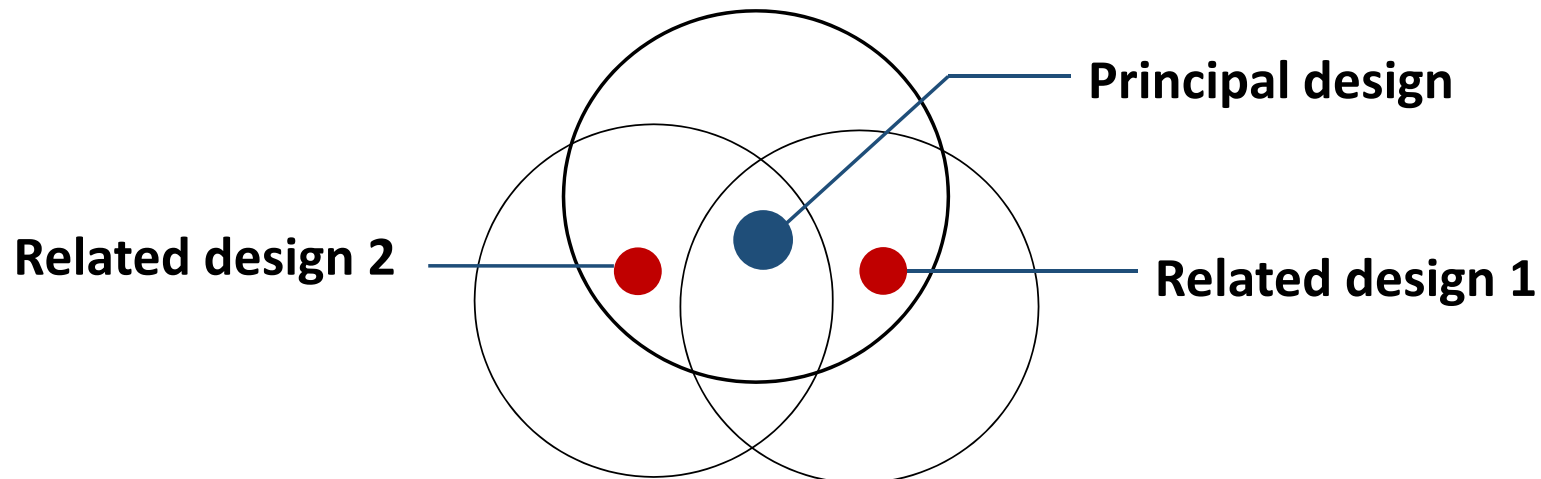




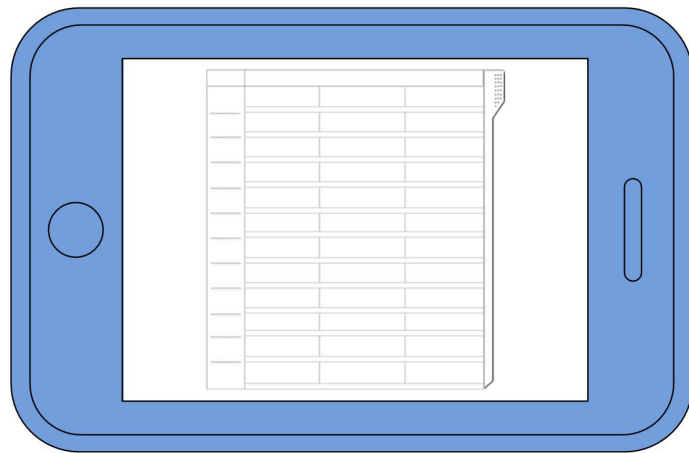
# Protectable scope of a design right

In Japan, if two or more designs are similar to one another, they should be registered as **related designs** for making a broader and stronger right of protection in the design.

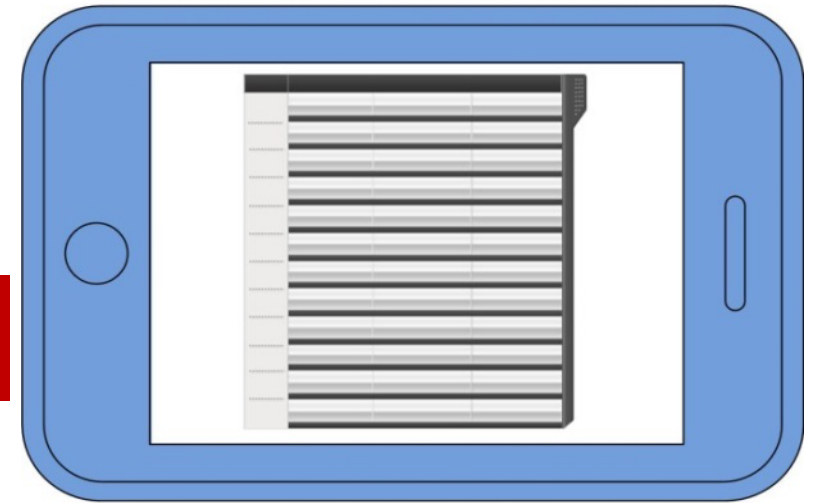
## What is Related Design System?



# Related design system



**YES,  
they are RELATED**



**Principal design**

JPD1471018  
Electronic device/ Yahoo

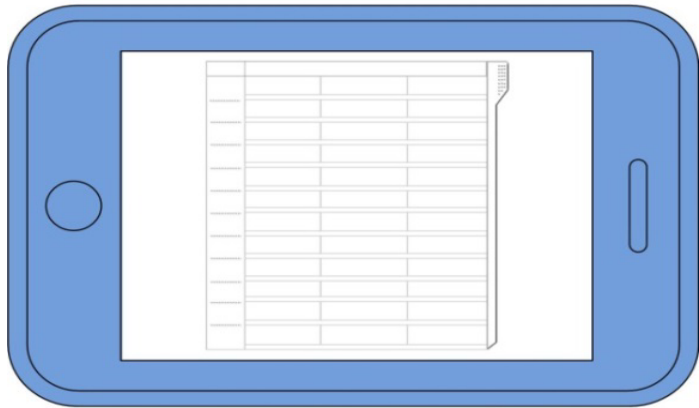
**Related design**

JPD1471203  
Electronic device/ Yahoo

If the applicant fails to use the Related design system, and if the Examiner considers the designs are similar to each other, the later application (or both if they are filed on the same date) will receive a double-patenting rejection.

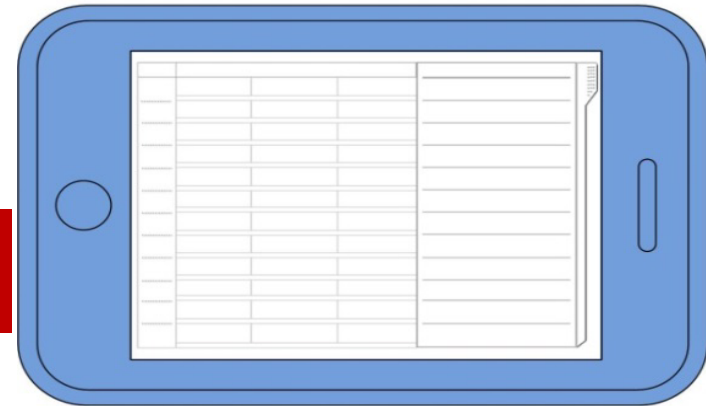
In this case, we can overcome the rejection by amending either one of the applications to a related design application.

# Related design system



JPD1471018  
Electronic device / Yahoo

**No, they are  
NOT RELATED**



JPD1471019  
Electronic device / Yahoo

If the applicant fails to use the Related design system, and if the Examiner does not consider (or overlook) that they are similar to each other, they will be registered as independent dissimilar design.

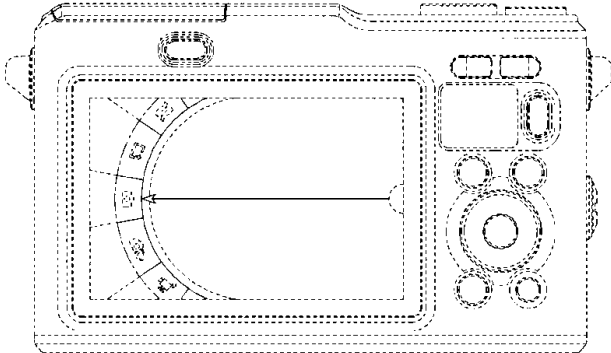
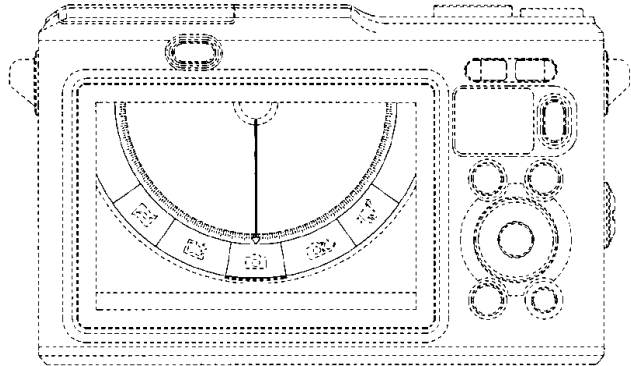
- Scopes of Independently registered designs are basically apt to be interpreted more narrowly compared with related designs
- Whether a design is related to another design or not provides a clue to competitors as to how to avoid infringements.

# Example of related design registered with broad scope of design protection

**Principal design**

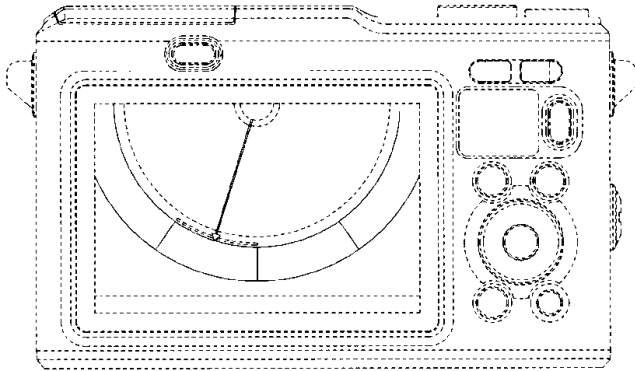
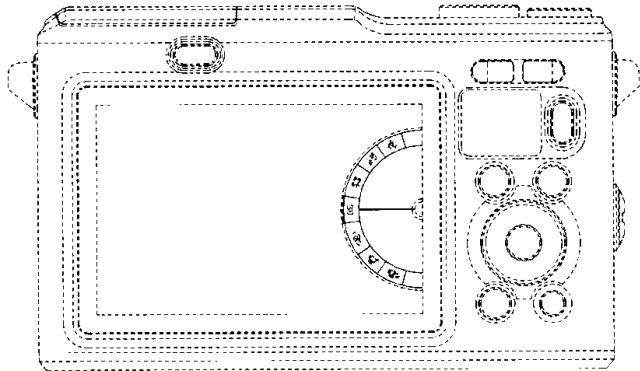
JPD1496341  
Digital camera / Nikon

**Related design**



**Related design**

**Related design**



# Conversion of Application from Patent to Design

## Basic Precautions

- Strictly limited to the same applicant and the same design.
- When the converted application is filed, the original patent application shall be deemed to have been withdrawn unless a divisional is filed prior to the conversion.
- A Paris Convention priority claim is effective in the design application only when the patent application was filed from **6 months** from the first application that serves as the basis for the priority right.

# USPTO Practice: Conversion from Utility to Design

## Process

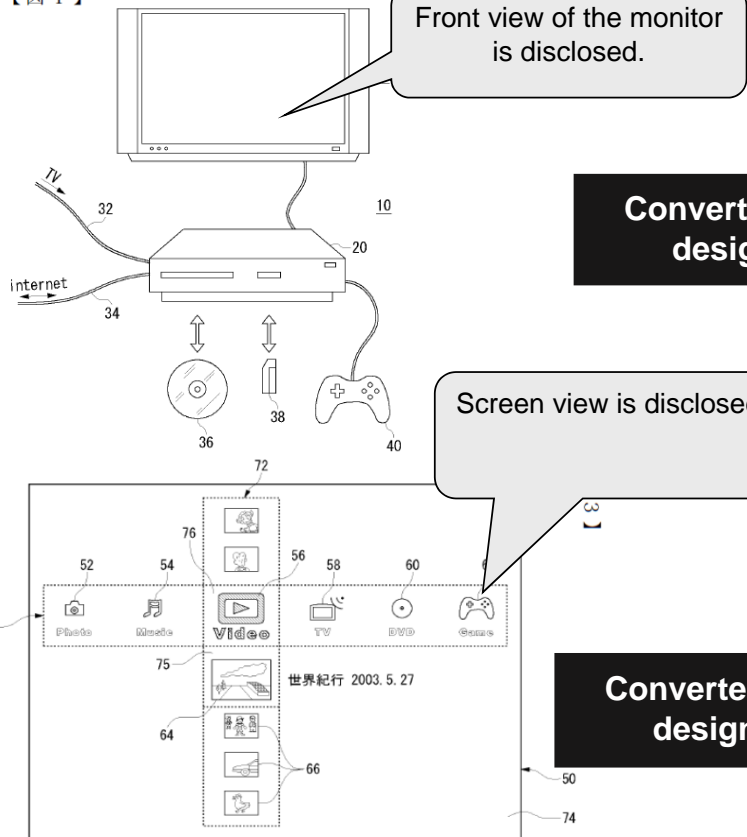
1. File a single “omnibus” utility patent application
2. Convert the utility application into a design application that claims priority to the omnibus utility application.
3. Example
  1. utility application includes multiple inventive features, including both function and design.
  2. Design applications may be filed, claiming domestic priority to the utility patent application.
4. This may also be useful to show “acquired distinctiveness” under US trademark law for product configurations.

## Demerits:

- U.S. Provisional priority cannot be used for design
- Paris Route foreign application must be filed within 6 months of the utility date
- PCT does not include designs->Hague or Paris Route only

**Original patent application JP2004-356774  
MULTIMEDIA REPRODUCING APPARATUS AND  
MULTIMEDIA REPRODUCING METHOD**

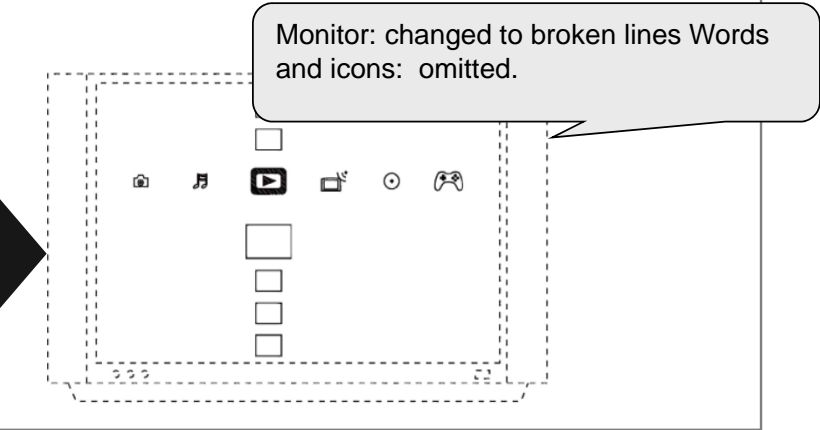
【図1】



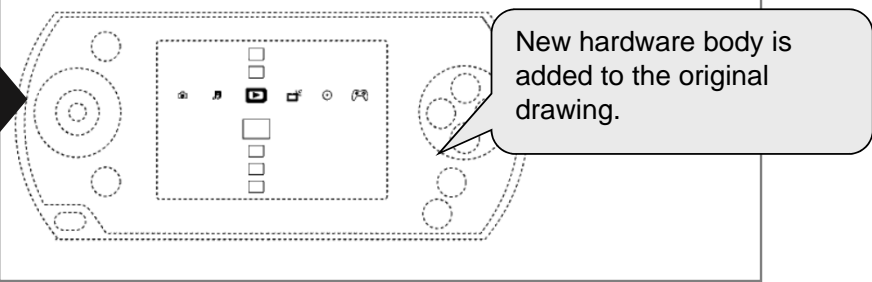
**Converted to design**

**Converted to design**

**Conversion design-1:  
partial / principle design D1350709  
MULTIMEDIA PLAYER**



**Conversion design-2:  
partial / related design D1380985  
MULTIMEDIA PLAYBACK EQUIPMENT**



## Examples of Registered Design that has overcome non-obviousness rejection at appeal stage

### Design Law Sec. 3-(2)

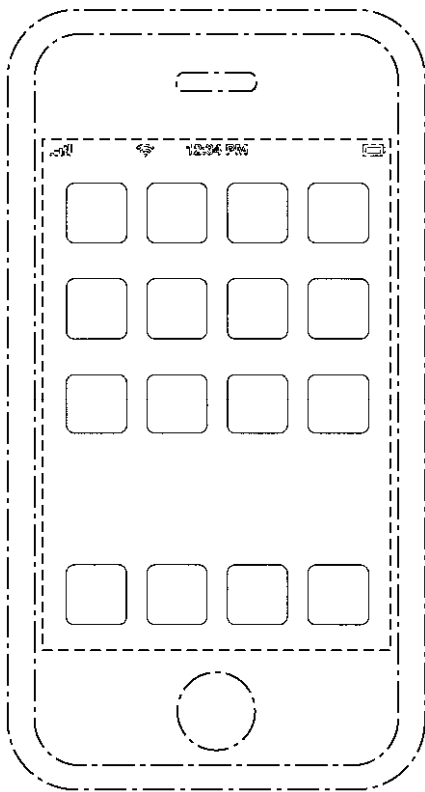
Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.



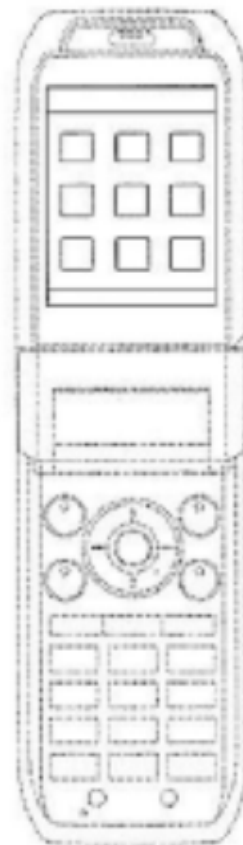
# Example of Designs registered after appeal 1

JPD1349661 Mobile terminal device / Apple

### Registered Design



### Cited reference 1

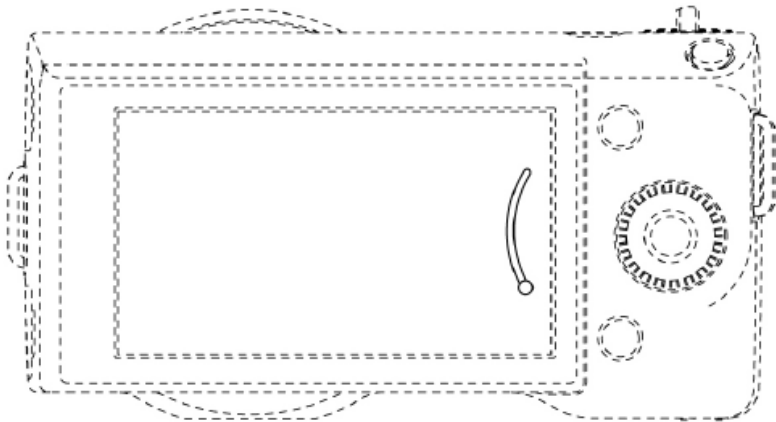


### Cited reference 2



**Example of Designs registered after appeal 2**  
JPD1453870 Digital Camera / Sony

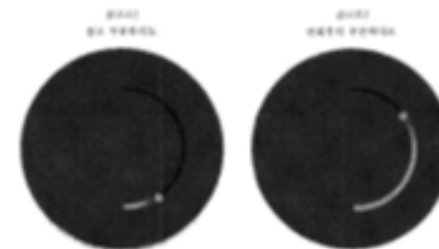
Registered Design



Cited reference 1

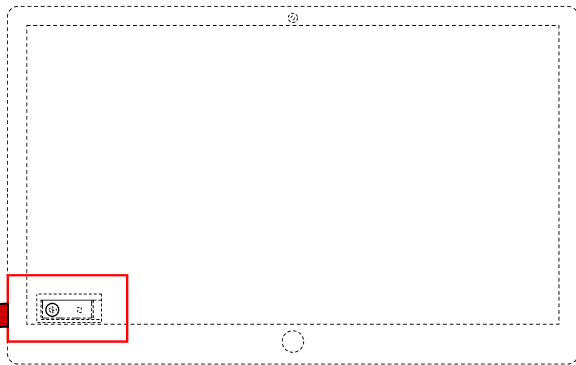


Cited reference 2

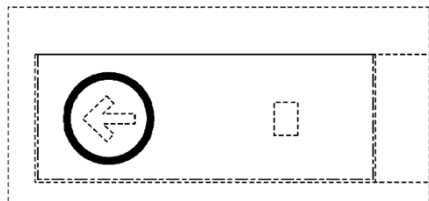


**Example of Designs registered after appeal 3**  
JPD1491807 Mobile terminal device / Microsoft

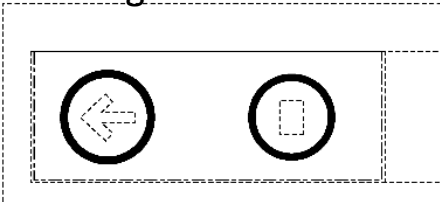
**Registered Design**



Partial enlarged view



Partial enlarged view after transition



**Discover IP JAPAN  
Conference 2017**

Cited reference 1



Cited reference 2





Thank you for your attention

Makoto Onda

[makoto@ondatechno.co.jp](mailto:makoto@ondatechno.co.jp)

ONDA TECHNO Intl. Patent Attys.