



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

Discover IP Japan Conference

2018

Session 4



Speakers

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Paul Hunter

Foley & Lardner LLP

Agenda

- Overview of Design Protection in Japan
 - Statistics
 - Summary of Japanese Design Registration System
 - Unique Protection Systems
 - Major Advantages of Obtaining Design Rights in Japan
- Case Studies
 - Functional Designs
 - Protectable Icons/User Interface (UI)

Statistics – Number of Filings

Year	Design Applications	Patent Applications	USPTO (US)
2012	32,391	342,796	32,799
2013	31,125	328,436	36,034
2014	29,738	325,989	35,378
2015	29,903	318,721	39,128
2016	30,879	318,381	47,389

[JPO Status Report 2017]

Statistics – Registrants Top 20 (2016)

	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

[JPO Status Report 2017]

Statistics – Country of Origin of Applicant Top 10 (2016)

	Country	Number of Filings	%
1	Japan	24,543	79.5%
2	US	1,776	5.8%
3	Korea	630	2.0%
4	Germany	613	2.0%
5	Switzerland	587	-
6	China	586	-
7	France	425	-
8	Italy	272	-
9	Netherlands	252	-
10	Taiwan	243	-

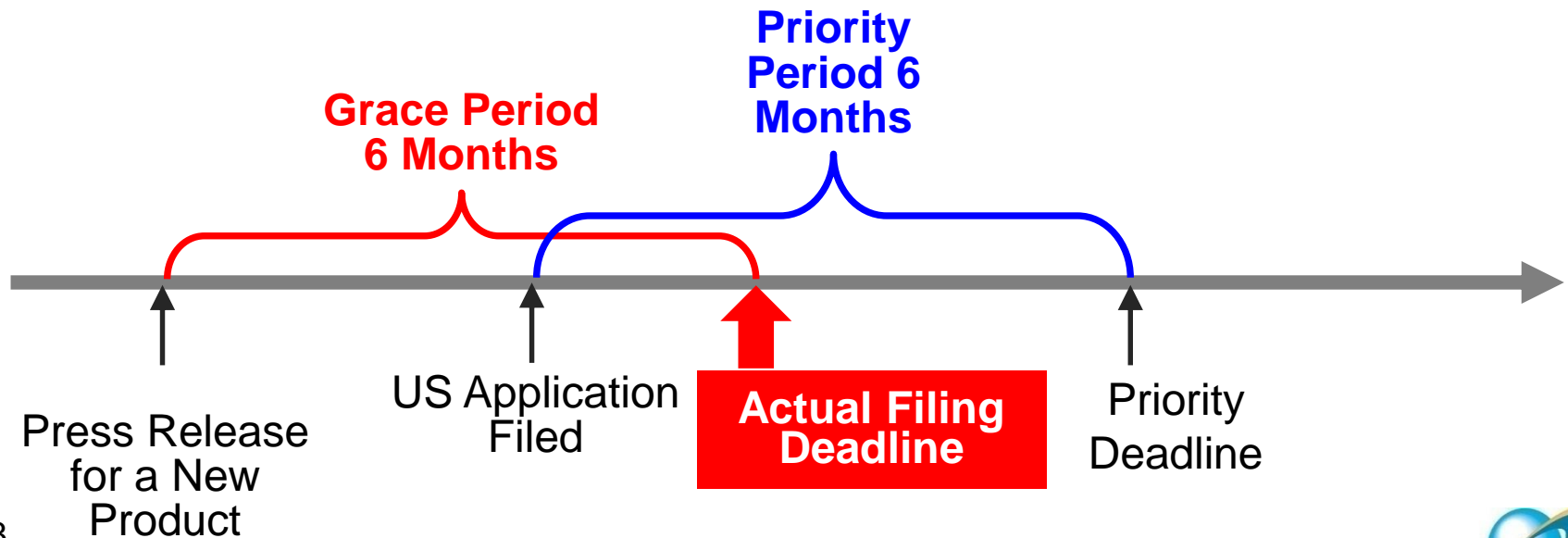
[JPO Status Report 2017]

Summary of Japanese Design Protection

	Designs	Patents
Scope	Industrial Design <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.</i> [Design Law Sec.2-(1)]	Inventions -Technical ideas
Priority	Within 6 Months from Priority Dates	Within 12 Months from Priority Dates
Grace Period	Within 6 Months from Losing Novelty	

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 Dates	N/A



Summary of Japanese Design Protection

	Designs	Patents
Examination	Substantive Examination <ul style="list-style-type: none"> - Industrial Applicability - Novelty - Creative Difficulty - First to File - Not Required to Request Examination	Substantive Examination After Requesting Examination
First Office Action Pendency	Approx. 6.1 months (2016) (From Filing to Issuing the First Action)	Approx. 9.7 months (2016) (From Requesting Examination to Issuing the First Action)
Registration Rate	Around 90%	Around 70%

Summary of Japanese Design Protection

	Designs	Patents
Publication	<ul style="list-style-type: none"> - After Registration (No Unexamined Publication) - Secret Design Requests Applicable 	<ul style="list-style-type: none"> - After 18 Months from Filing Dates (Unexamined Publication) - After Registration (Granted Patents)
Opposition	No	Yes (Post-Grant Opposition)
Invalidation	Yes	Yes
Term	20 Years from Registration Dates	20 Years from Filing Dates

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
 - Containing enough views to completely describe the design
 - 6 view drawings, Perspective views (if required) etc.,
- Priority information and certificates, if claimed

Examination

NO

**Decision of
Refusal**

YES

Substantial
requirements?

**Decision of
Registration**

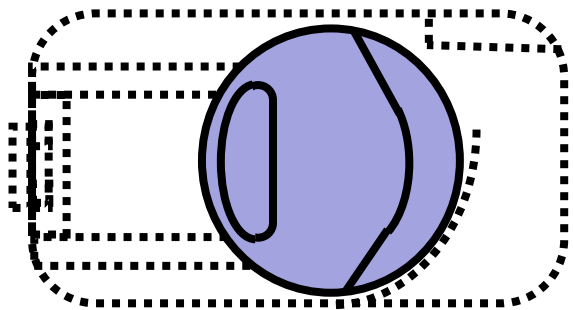
**Registration
Publication**

Unique Protection Systems

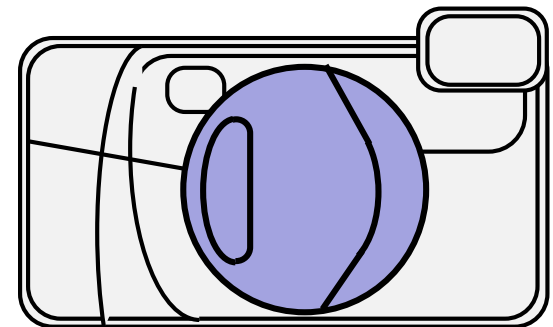
- Partial Designs
- Related Designs
- Secret Designs

Partial Designs

- Protection of Parts of a Design for the Characteristic Parts of an Article
 - “Design” in this law means a shape, pattern or color or any combination thereof in an article (*including part of an article*) which produces an aesthetic impression on the sense of sight. (Section 2(1))



Registered Partial Design



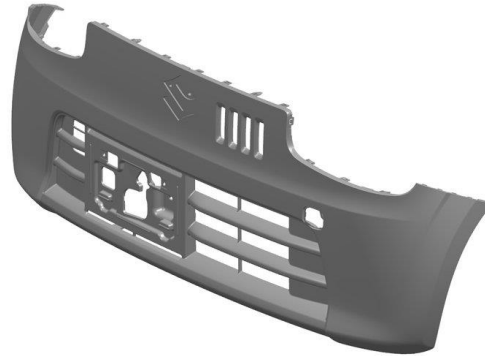
Product by Others

Partial Designs



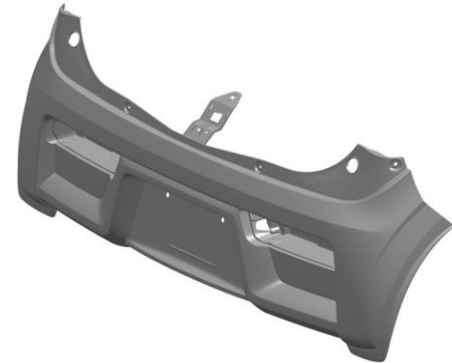
JP Design Reg. No. 1531039
Automobile / Suzuki Motor Corp.

Overall Design



JP Design Reg. No. 1531040
Front Bumper for Automobile

Parts Design



JP Design Reg. No. 1531041
Rear Bumper for Automobile

Parts Design



JP Design Reg. No. 1531042
Automobile

Partial Design



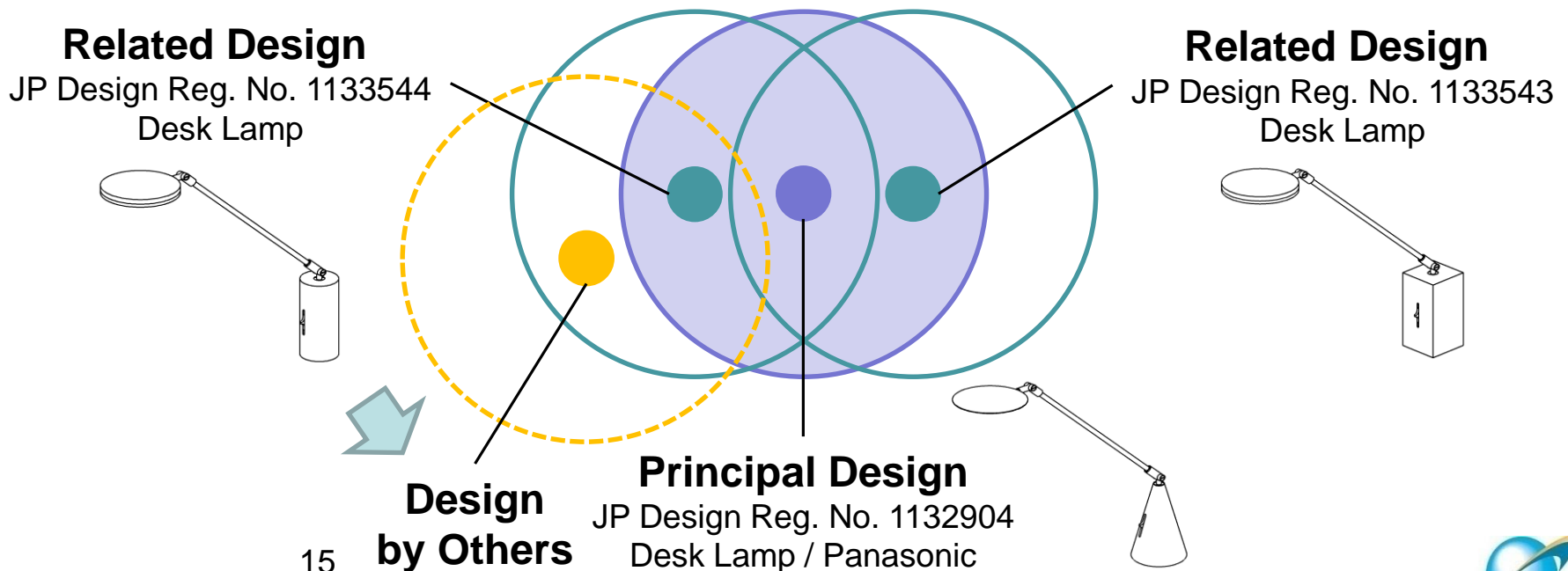
JP Design Reg. No. 1531043
Automobile

Partial Design

Related Designs

– Protection System for Designs of Variations

- Similar designs basically face rejection based on the prior similar designs
- The system allows registrations of similar designs
- The system helps to clear the scope of design rights

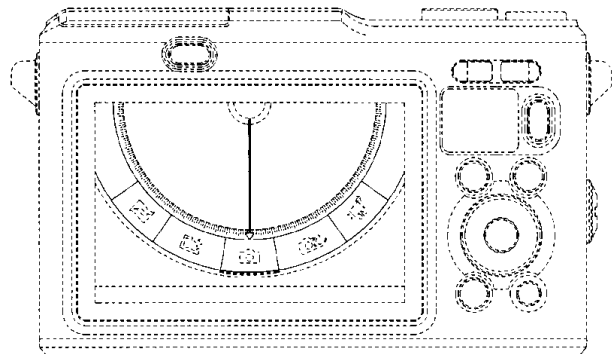


Related Designs

- Requirements
 - Related designs must be similar to the principle design
 - Applicant must be the same
 - Related design applications should be filed before publication of the principle design
- Limitation
 - Need to grant licenses to the principle design and the related designs
 - The related design rights expire 20 years after the registration dates of its principle design rights

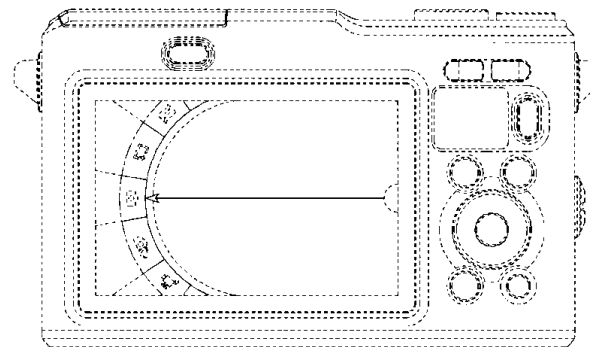
Related Designs

Partial Design (Principal Design)



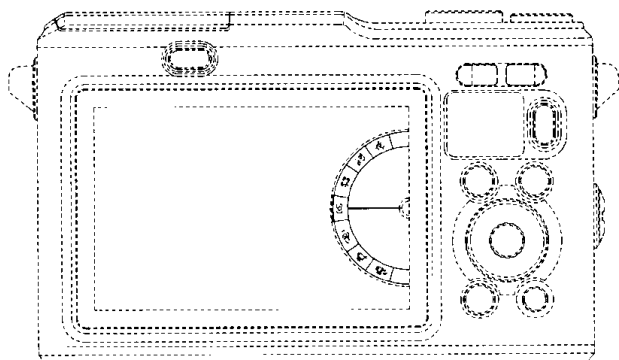
JP Design Reg. No. 1496341
Digital Camera / Nikon

Partial Design (Related Design)



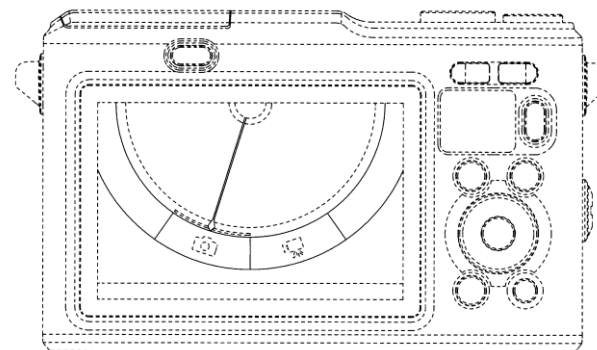
JP Design Reg. No. 1496919
Digital Camera

Partial Design (Related Design)



17 JP Design Reg. No. 1496920
Digital Camera

Partial Design (Related Design)



JP Design Reg. No. 1496918
Digital Camera

Secret Designs

The Japan Patent Office (JPO) issues only a formality in publication without pictures / drawings

(19)[Publication country]Japan Patent Office (JP)
(45)[Publication date] 2017.X.X
(12)[Kind of official gazette]Design Gazette (S)
(11)[Registration number]DXXXXXX
(24)[Registration date] 2017.X.X
(21)[Application number]D2016-XXXXX
(22)[Filing date] 2016.X.X
(73)[Owner of a design right]
[Identification Number]000000000
[Name]ABC Corp.
(74)[Representative]
[Identification Number]100000000
[Patent Attorney]
[Name]Design Taro
[Examiner]Design Jiro
There are no Drawings for a secret design.

Filing Design Application

Notice of Allowance

Payment of Registration Fee

Registration

Publication

Publication of Pictures / Drawings

Possible to Request Postponement of the Publication

Postponement of the Publication (Up to 3 Years)

(19)[Publication country]Japan Patent Office (JP)
(45)[Publication date] 2017.X.X
(12)[Kind of official gazette]Design Gazette (S)
(11)[Registration number]DXXXXXX
(24)[Registration date] 2017.X.X
(21)[Application number]D2016-XXXXX
(22)[Filing date] 2016.X.X
(73)[Owner of a design right]
[Identification Number]000000000
[Name]ABC Corp.
(74)[Representative]
[Identification Number]100000000
[Patent Attorney]
[Name]Design Taro
[Examiner]Design Jiro
[Drawing]
[Front view]



Secret Designs


 ヘルプデスク (9:00-21:00)
 03-6666-8801
helpdesk@j-platpat.inpit.go.jp

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[特許庁](#)
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[トップページ](#) > [意匠](#) > [意匠公報テキスト検索](#)

意匠公報テキスト検索
[← 前画面へ戻る](#)
[? ヘルプ](#)
[入力画面](#) → [結果一覧](#) → [詳細表示](#)

物品名、意匠権者等のキーワードから、2000年1月以降発行の意匠公報を検索できます。

検索結果一覧
 表示形式 ☒ 項目表示 ☐ PDF表示

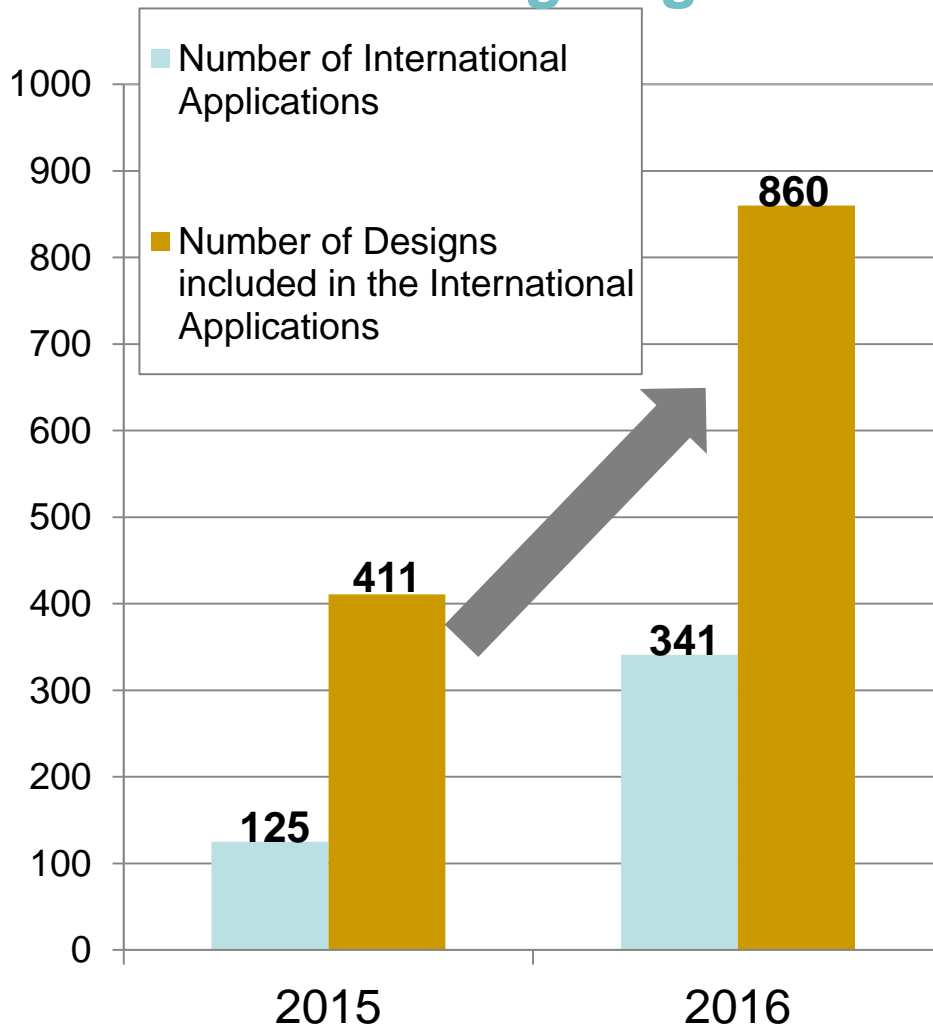
検索結果 26件中1から26件を表示

1. 意匠登録1589970 マツダ株式会社 	2. 意匠登録1589969 マツダ株式会社 	3. 意匠登録1582966 マツダ株式会社 	4. 意匠登録1589257 マツダ株式会社 	5. 意匠登録1571141 自動車用リヤランプ マツダ株式会社 
6. 意匠登録1571140 自動車用ヘッドランプ マツダ株式会社 	7. 意匠登録1570850 自動車用リヤランプ マツダ株式会社 	8. 意匠登録1570849 自動車用ヘッドランプ マツダ株式会社 	9. 意匠登録1568691 マツダ株式会社 	10. 意匠登録1568239 自動車用フロントフェンダー マツダ株式会社 
11. 意匠登録1568238 自動車用リヤバンパー マツダ株式会社 	12. 意匠登録1568237 自動車用フロントバンパー マツダ株式会社 	13. 意匠登録1568236 乗用自動車 マツダ株式会社 	14. 意匠登録1568235 乗用自動車 マツダ株式会社 	15. 意匠登録1568234 乗用自動車 マツダ株式会社 

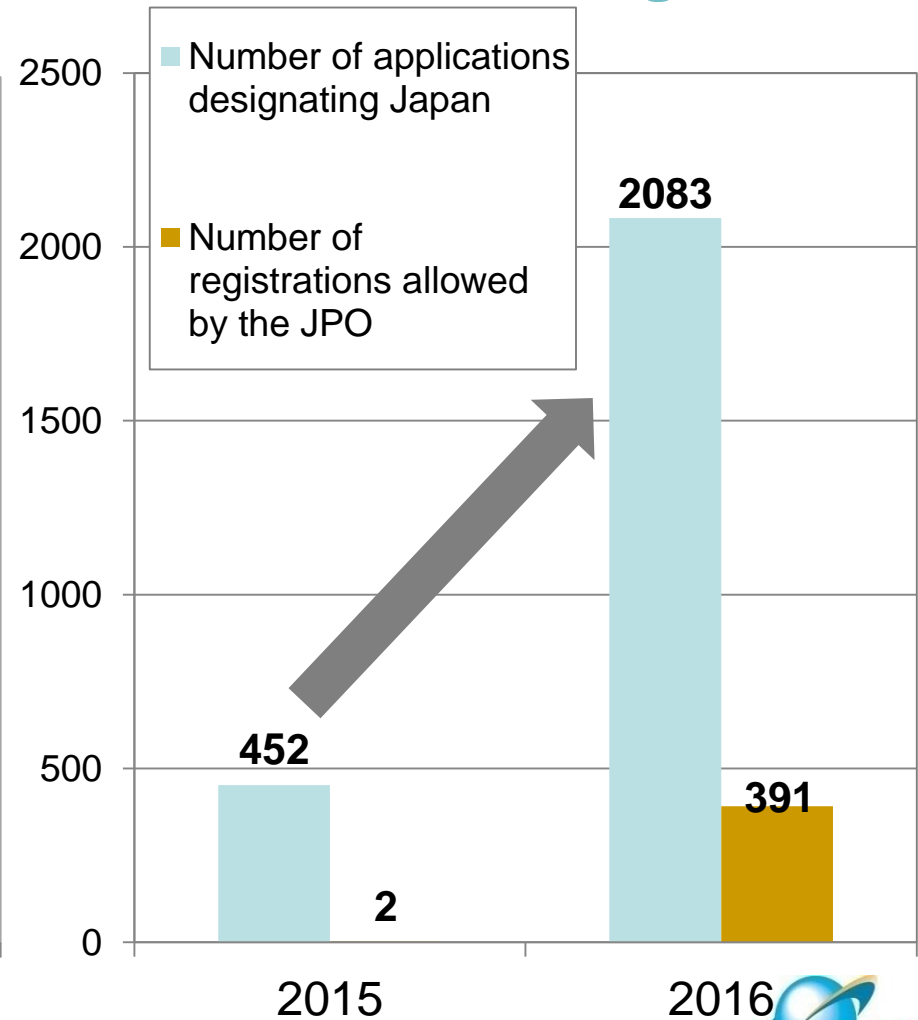
Search Results
from JPO's
Design Database

Cases through the Hague System

Outgoing



Incoming

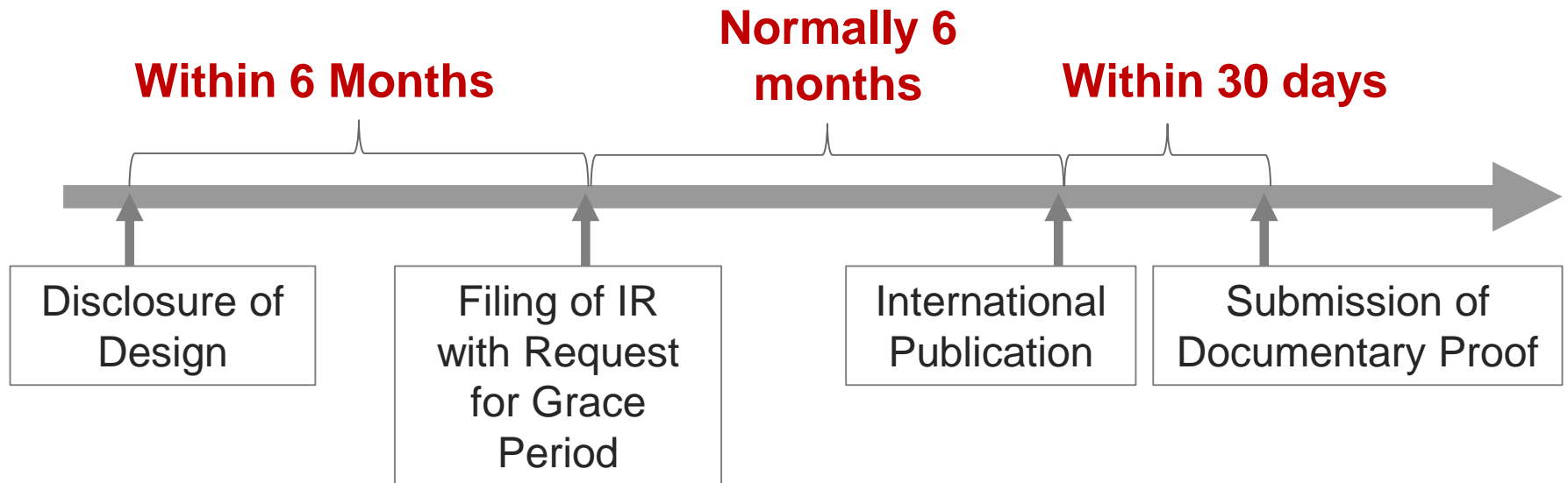


Tips for Designating Japan in Hague Application

- Priority Documents
 - Must be submitted directly to the JPO within 3 months from the International Publication date
 - Should be filed through a Japanese representative
- Six Orthographical Views are Basically Required
- An Intl. Design Reg. with Multiple Designs
 - Automatically divided into multiple applications
 - Applicants need not to file divisional applications at the Japanese national phase

Tips for Designating Japan in Hague Application

- Grace Period
 - Should be requested at the time of filing an international design application



Major Advantages of Obtaining Design Rights in Japan

- Quicker Registration
 - 6 months from filing to first actions
- Higher Percentage of Registration
 - Almost 90%
- Longer Duration of Registered Right
 - 20 years from Registration Dates

Major Advantages of Obtaining Design Rights in Japan

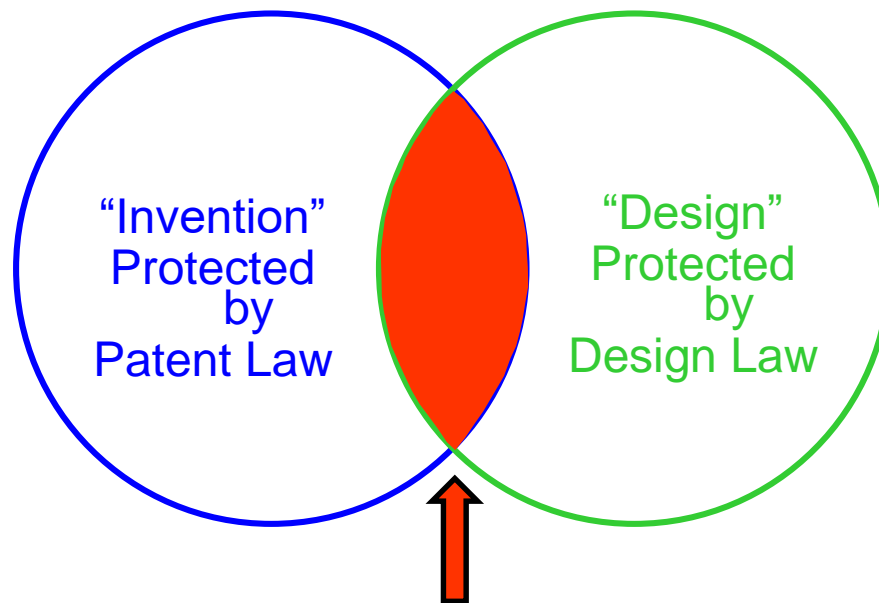
- Easier Enforcement
 - Discussion based on appearance of products
 - Useless technical discussion less likely in litigation
 - Greater resistance to invalidation
- Unique Protection Options
 - Partial design
 - Related design
 - Secret design
 - Protection of graphic images
 - Protection of functional shape

Case Studies

- Functional Designs
- Protectable Icons/User Interface (UI)

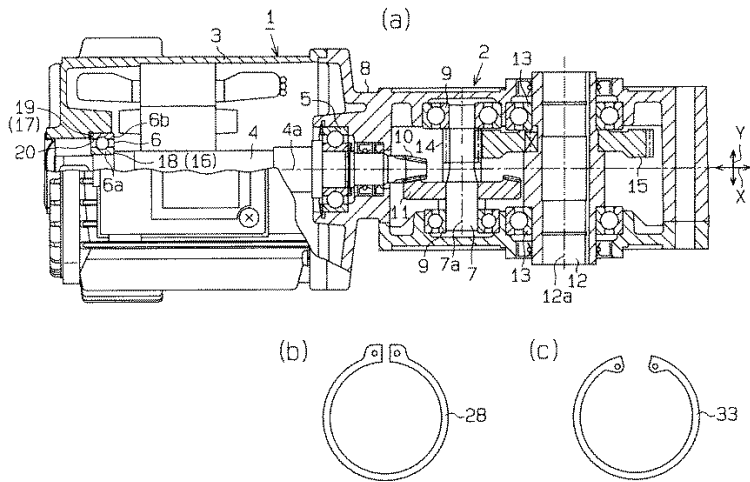
Functional Designs

Functional Shape Can Be Protected by Both Patent Law and Design Law

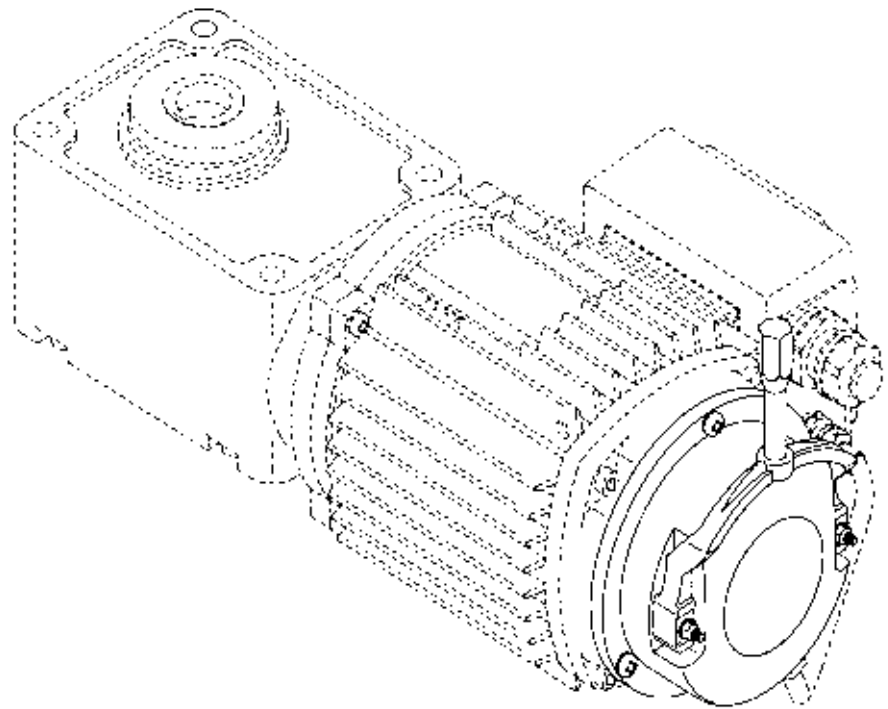


Functional design which is **not** "solely" consisting of a shape that is **indispensable** for securing functions of the article"

Registration Examples of Functional Designs

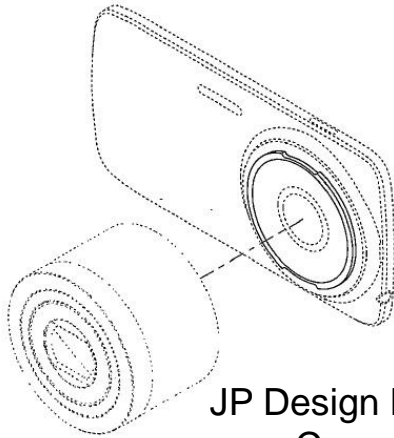


JP Pat. No. 4250454
Gear Transmission for Electric Motors



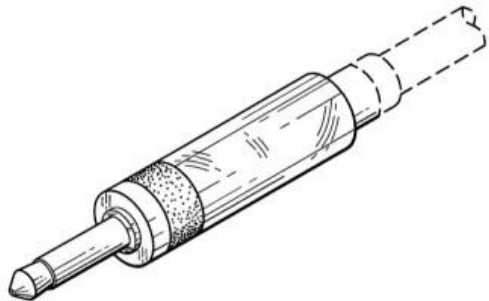
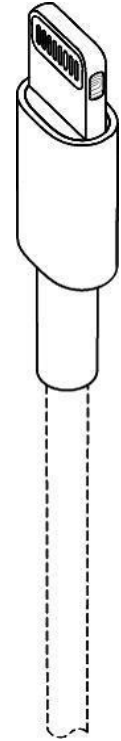
JP Design Reg. No. 1266915
Speed Reducer with a Motor
(Partial Design)

Registration Examples of Functional Designs



JP Design Reg. No. 1508821
Camera/ Samsung

JP Design Reg. No. 1480642
Connector/ Apple



JP Design Reg. No. 1305908
Cable Assembly/ Microsoft



JP Design Reg. No. 1073322
Terminal Pin/ Samsung

Protection of Graphic Images

Graphic Image on a Screen is Protectable



JP Design Reg. No. 1447100
PDA

Protection of Graphic Images

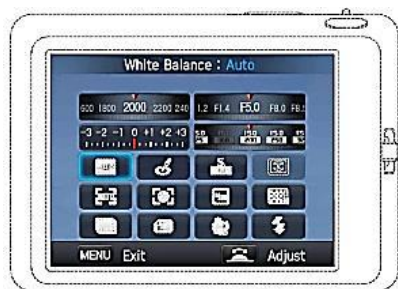
Graphical images that have been registrable



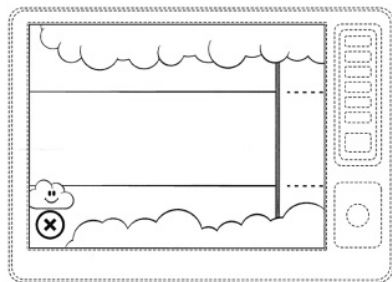
Graphic Images that are prerecorded on an article

- Graphic Images that are prerecorded on a device for a specific use like digital camera

(Example)

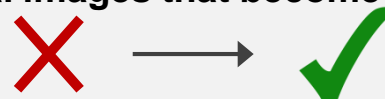


JP Design Reg. No.
1456916
Digital camera



JP Design Reg. No.
1470457
Breath analysis
device

Graphical images that become registrable



Graphic Images that are recorded on an article

- Graphical images of update of functions of a device for a specific use
- Graphical Images of specific functions that are prerecorded on electronic computers (personal computers, tablet computers, smartphones, etc.)

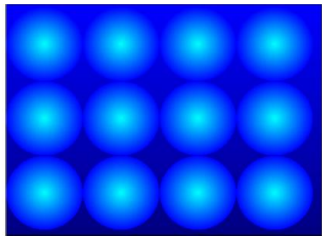
(Example)



Electronic computer with pedometer function

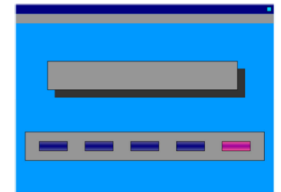
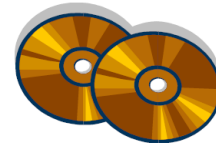
Case Examples of Unregisterable Graphic Images on a Screen

Graphic image of a television program or from the Internet



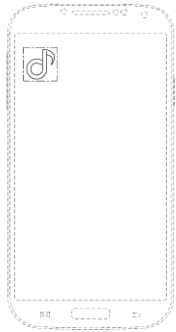
Wallpaper on a screen solely intended for decorative expression

Graphic image recorded on a recording medium

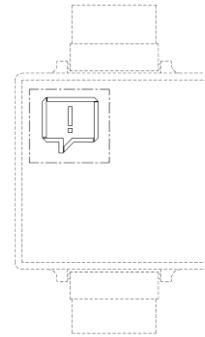
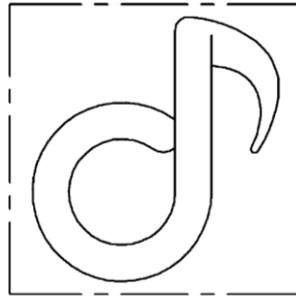


Graphic image displayed by a game machine

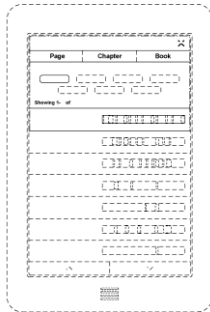
Examples of Registered Designs including a Graphic Image on a Screen



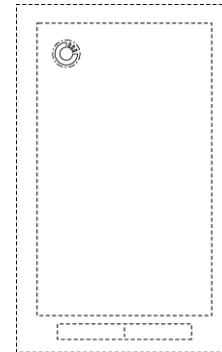
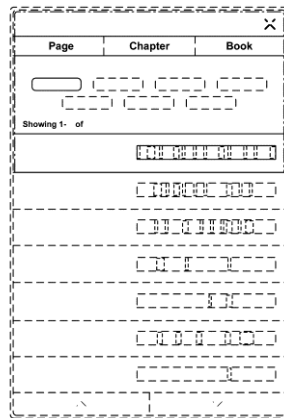
JPD1507638
Mobile terminal device / Samsung



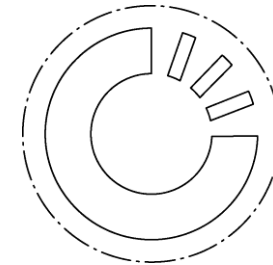
JPD1506186
Mobile terminal device / Samsung



JPD1457799
Electronic book / Amazon



JPD1526530
Mobile terminal device / Dropbox

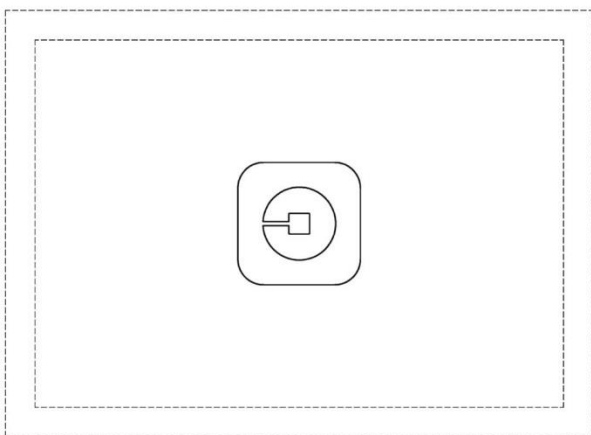


Examples of “Computer with Function of XYZ”

JP Design Reg. No. 1582445

**“Computer with function of
requesting a ride”**

Uber Technologies Inc.



JP Design Reg. No. 1584266

**“Computer with function of
fingerprint authentication”**

Microsoft Corporation



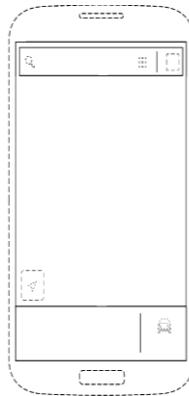
JP Design Reg. No. 1576805

**“Computer with function of
travel reservation “**

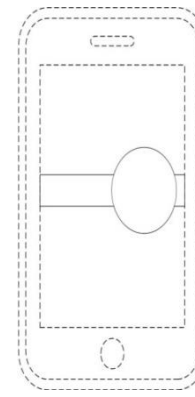
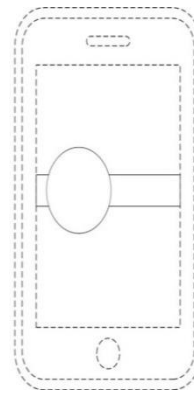
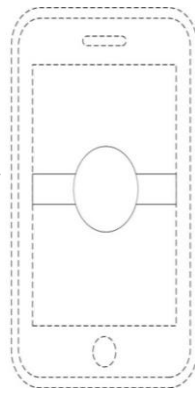
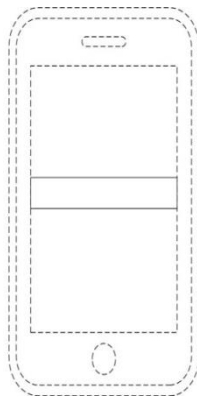
Yahoo KK



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

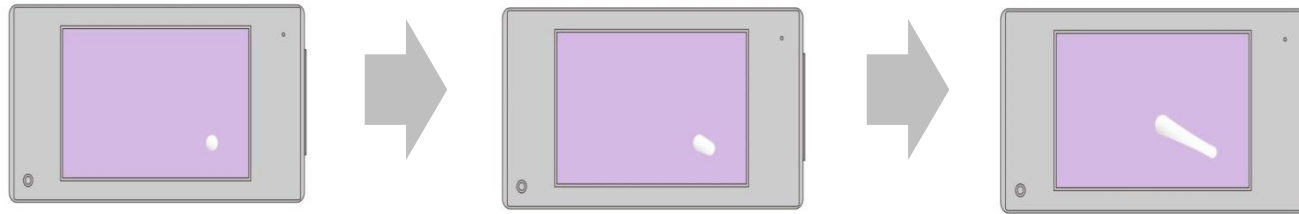


JP Design Reg. No.
1540348
Mobile terminal device /
Google

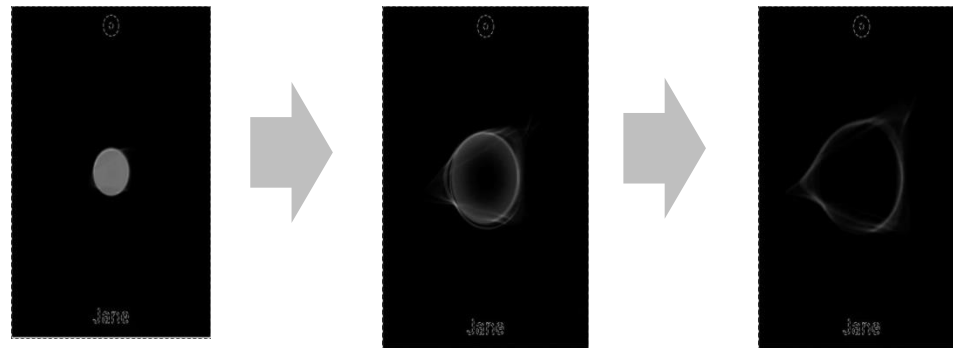


JP Design Reg. No. 1529903
Mobile terminal device /
Yahoo

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



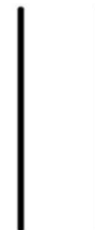
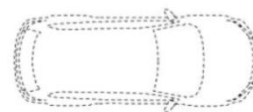
JP Design Reg. No. 1513085
Mobile terminal device / Sony



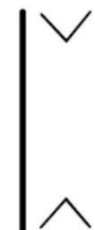
JP Design Reg. No. 1537024
Mobile terminal device / Apple

Graphical Image Itself

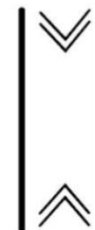
使用状態を示す参考図 1



使用状態を示す参考図 2



使用状態を示す参考図 3



e.g. Hologram or Projection

Not Registrable

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: USD704212(Apple)



US - GUI Examples

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

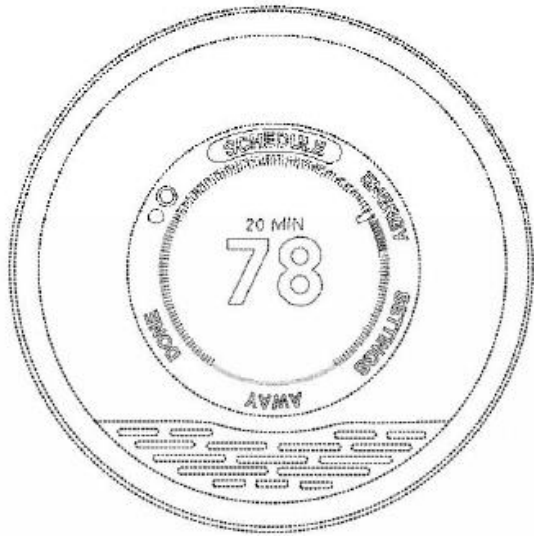
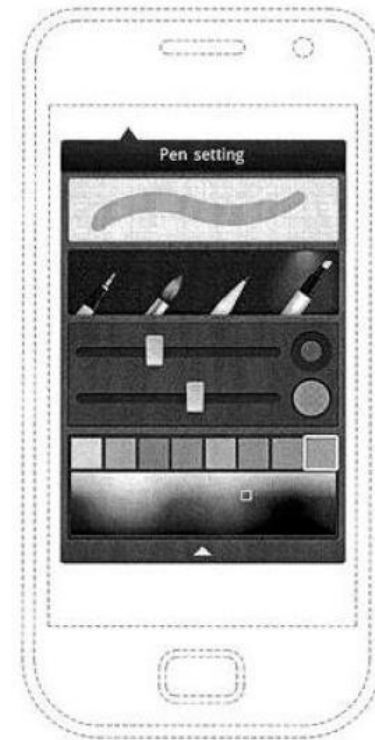


FIG. 1

Smartphone UI: D725662 (Samsung)



Conversion of Application from Patent to Design

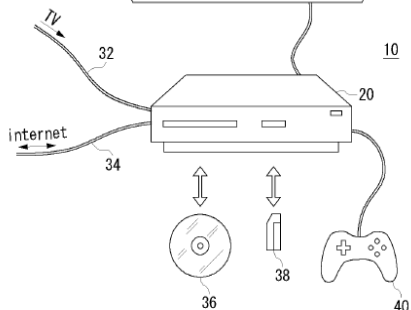
Basic Precautions

- 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.

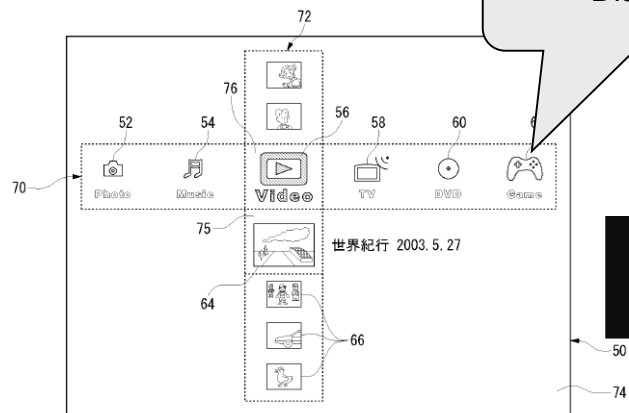
**Original JP Patent Application JP2004-356774
Multimedia Reproducing Apparatus and
Multimedia Reproducing Method**

【図1】

Front View of the Monitor is Disclosed.



Screen View is Disclosed.

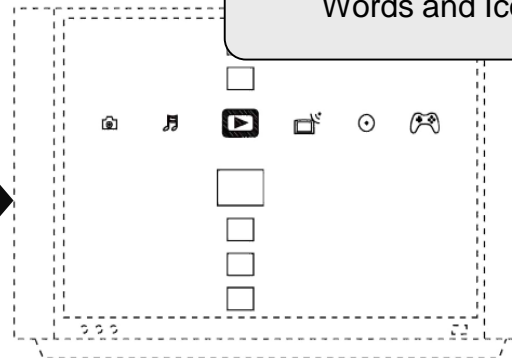


Converted to Design

Converted to Design

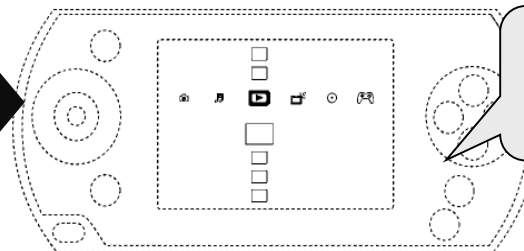
**Conversion Design-1:
Partial / Principle Design JPD1350709
Multimedia Player**

Monitor: Changed to Broken Lines
Words and Icons: Omitted.



**Conversion Design-2:
Partial / Related Design JPD1380985
Multimedia Playback Equipment**

New Hardware Body is
Added to the
Original Drawing.



Examples of Registered Design That Has Overcome Non-obviousness Rejection at Appeal Stage

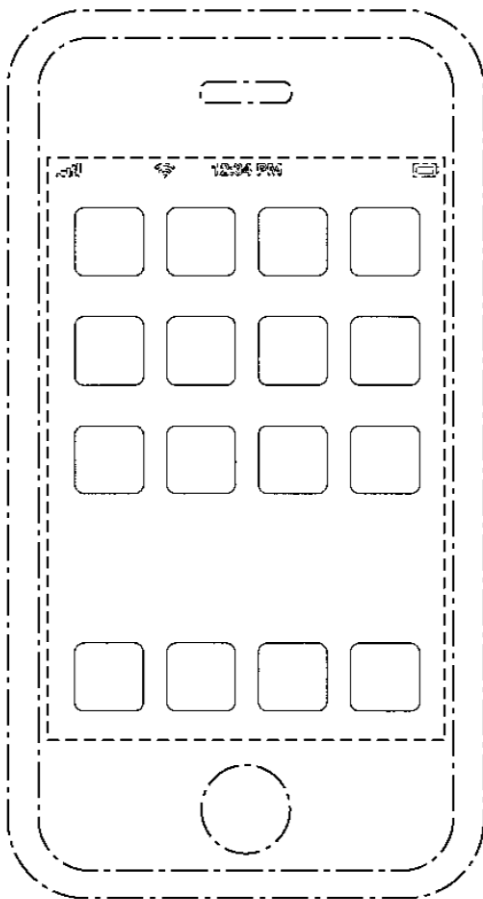
Design Law Sec. 3-(2)

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.

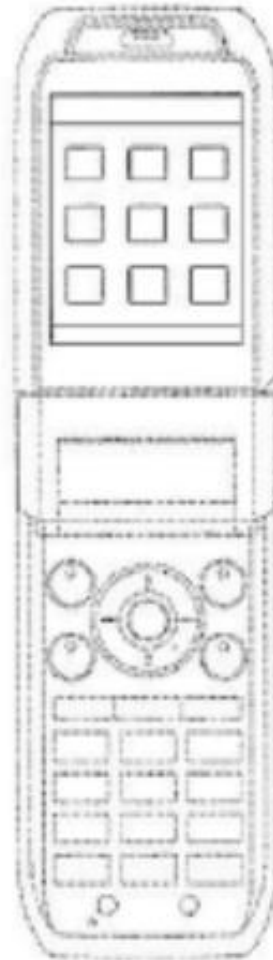
Example of Designs Registered After Appeal 1

JPD1349661 Mobile Terminal Device / Apple

Registered Design



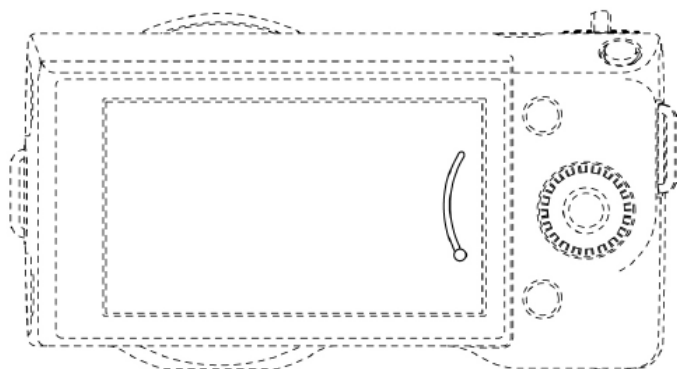
Cited Reference 1 Cited Reference 2



Example of Designs Registered After Appeal 2

JPD1453870 Digital Camera / Sony

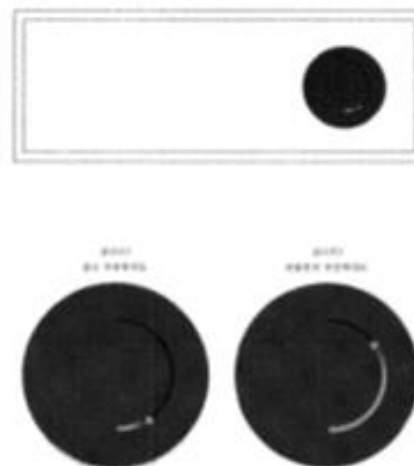
Registered Design



Cited Reference 1



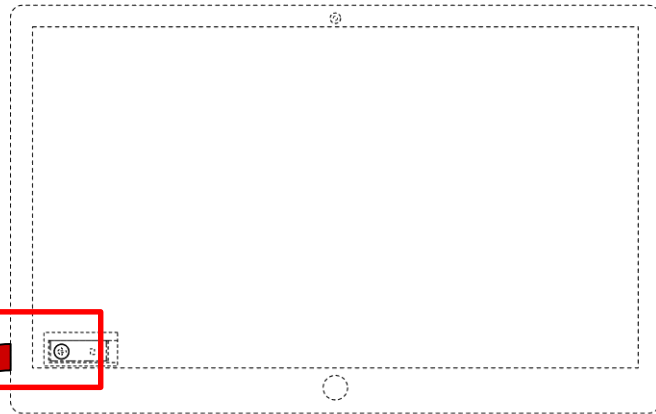
Cited Reference 2



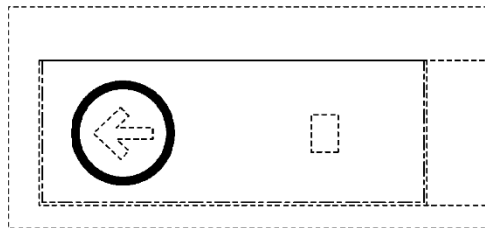
Example of Designs Registered after Appeal 3

JPD1491807 Mobile Terminal Device / Microsoft

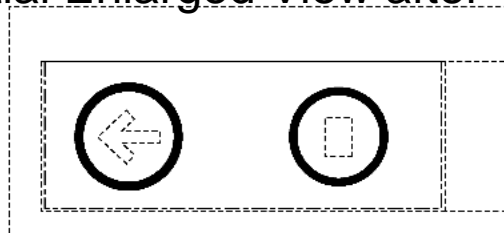
Registered Design



Partial Enlarged View



Partial Enlarged View after Transition



Cited Reference 1



Cited Reference 2





Thank you.