Protecting Technical Features through Design Rights in Japan

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What we will cover

1. Design rights that protect technology
   - The Japanese framework: functional shapes & partial designs
2. Why reach for a design right?
   - Practical advantages over a patent
3. Case study: GOP v. Daido Kikai (2024)
   - A 'protective member' enforced as a registered design
4. How the court found infringement
   - Article identity → essential part → similarity
5. More registrations of technical features
   - Golf balls, LEDs, erasers, masks
6. Takeaways for your filing strategy
   - Building a patent-plus-design portfolio in Japan

Summary

- In Japan, a design right can protect the technical features of a product
  - not only its ornamental appearance.

- Functional ≠ unprotectable
  - A shape driven by function can still be registered and enforced, so long as it is not the single shape indispensable to that function.
- Partial designs capture the point of novelty
  - You can claim just the feature that matters and ignore the rest of the product.
- A complement to patents
  - Design and patent protection can run in parallel over the very same feature.

Functional shapes under the Design Act

Article 2(1) — what a design is

- The shape, patterns or colors (or any combination) of an article that creates an aesthetic impression through the eye.

Article 5(iii) — the only bar

- Not registrable: a design consisting solely of a shape that is indispensable for securing the function of the article.
- Read narrowly. If alternative shapes could perform the function, the shape is basically registrable, even when it is chosen for technical reasons.

The partial-design system

- **Claim only the feature you care about.**
  - **Solid lines = the claimed portion.**
  - **Broken lines** = the rest of the article (context, **unclaimed**).
- **In the case study**, the protective disc + grip are claimed in solid line; the pipe is shown broken.

数字要確認

A design right can out-perform a patent

~6.8 months

to registration for a design

vs 13.8 months for a patent (from exam request)

~85% grant rate

of design applications registered

vs ~76% for patents

25 years

of term from filing

vs 20 years for a patent

And in ***litigation***:

- Cleaner infringement story
  - Similarity of appearance, judged through the eyes of the informed consumer, and less room for endless claim construction arguments.
- Harder to invalidate on the merits
  - No detailed enablement / written description attacks of the kind patents attract.

GOP v. Daido Kikai and others

- Tokyo District Court
- Judgment of March 29, 2024
- Case No. 2021 (Wa) 30281, 30283, 30290
- Plaintiff — GOP Co., Ltd.
  - maker of construction & temporary-works equipment; owner of two patents and two registered designs.
- Defendants
  - Itabashi Kenzai (manufacturer) → Daido Kikai (seller / rental) → SRS (seller) — the accused grip's supply chain.

Four rights, one feature

Patent 6,535,792

"Protective member" — claims 1–4

Patent 6,783,478

"Push-handle member & transport cart"

Design 1,623,018

Partial design — push-handle member

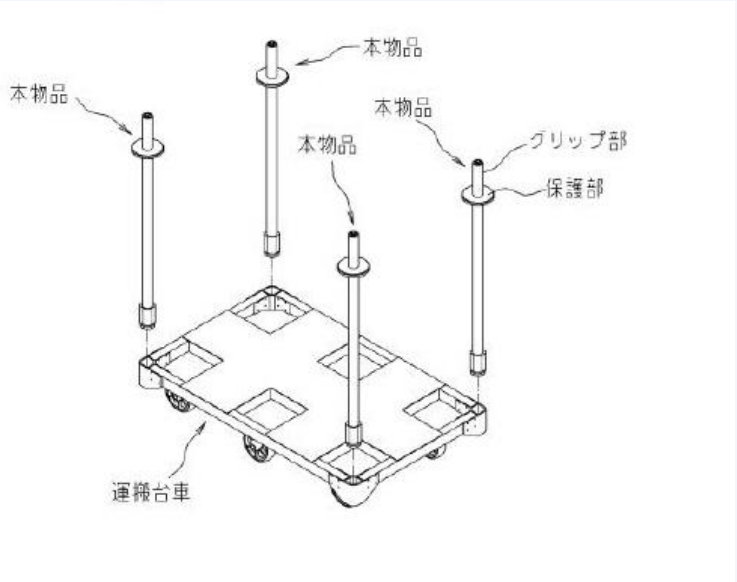
Design 1,623,019

Partial design — protective part

Today's focus: the two designs.

A technical problem, solved by a shape

Registered design in use — a grip at each corner of a transport cart



The setting

Workers move heavy transport carts on construction sites by pushing single pipes fitted into the four corners.

The problem The hand gripping the pipe can strike walls and surrounding objects — a real injury risk.

The solution A **protective member** — a circular disc that projects outward beyond the grip, shielding the hand from those objects. Its whole reason for existing is technical, yet its specific shape is what GOP registered as a design.

The same feature, protected twice

PATENT

Protects the technical concept

• a grip + an outward-projecting part that keeps the hand clear of surrounding objects

• coverage defined by claim wording, independent of exact look

Protective member (grip + disc)

DESIGN

Protects the specific shape

• the disc-shaped protective part and cylindrical grip as they appear in use

• coverage defined by visual similarity — bites even where claim wording might be avoided

Two independent rights over one innovation — if a defendant designs around one, the other may still catch them.

Two registered designs were enforced together

A layered pair — one claims the whole member; the other isolates the protective disc. The court found BOTH similar to the accused product.

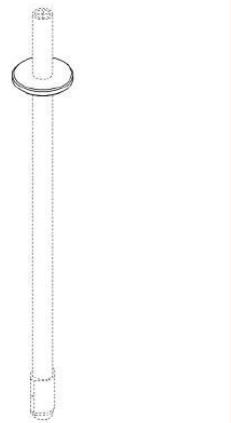
Design 1,623,018 *whole member*

Grip AND disc claimed in solid line

- cylindrical grip + circular protective part projecting beyond it
- disc ≈ 3× the member diameter; upper & lower edges chamfered; flat face
- the pipe is shown broken (context)

Protects the grip-and-disc as a whole.

Design 1,623,019 *protective part only*



Only the disc is in solid line

- the circular protective part projecting beyond the grip's outer surface
- same disc geometry: ≈ 3× diameter, chamfered edges, flat face
- the grip AND pipe are shown broken (context)

Zooms in on the protective disc itself.

The accused “single-pipe grip”

Perspective

Plan view — the protective disc

In use on a cart

Sold as a “grip for the Rakurin cart” / “single-pipe grip.”
Same cylindrical grip, same outward-projecting protective disc.

How Japanese courts judge design infringement

1	**Article identity**	Are the registered design's article and the accused article the same in use and function?
2	**Essential part**	Identify the part that most draws the attention of the informed consumer — the point of novelty in use.
3	**Overall similarity**	Weighing common points and differences, do the two create the same aesthetic impression to that consumer?

Article identity — same use, same function

Defendants argued...

their product is merely a “hand grip,” a different article from a “push-handle member.”

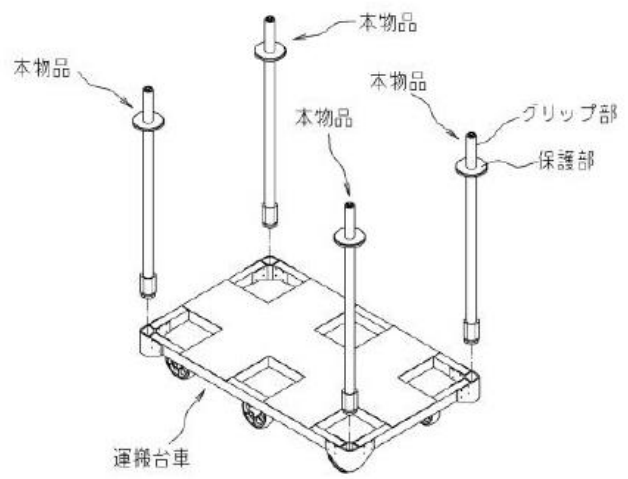
The court held...

Fitted to a cart's pipe, the grip becomes the cart's push-handle member. Both are used on a transport cart and both protect the gripping hand from surrounding objects.

→ ***Same use and function. The articles are identical.***

Because the grip is made only to build the push-handle member, its sale was an **indirect infringement** (Design Act Art. 38(i)(a)).

The essential part: what the eye sees in use



The consumer is the cart user — who looks down at the grip from eye level while working.

Essential — draws the eye

The combined shape of the **grip and the protective disc**, seen obliquely from above during use — its overall proportion, the smooth grip, the size and chamfer of the disc.

Not essential

The **bottom face** of the disc (the mounting hole, any ribs). A user rarely looks at the underside — so features there carry little weight.

Common points outweigh the differences

Shared - the impression that counts

- Cylindrical grip + circular disc projecting beyond it
- Disc set at the lower end of the grip
- Upper and lower disc edges both chamfered
- Flat disc face
- Overall inverted-“T” silhouette; rounded, soft impression

Differences - off the essential part

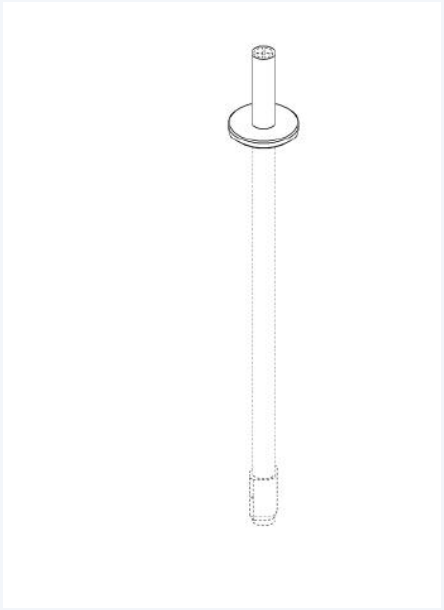
9 ring-shaped ridges on the accused grip — small texture — doesn’t overcome the soft “T” impression

Disc-to-grip diameter 3.0 vs 2.6–2.7 — a fine difference on a ~48 mm pipe

8 radial ribs on the disc underside — on the non-essential bottom face

Slightly larger grip diameter — negligible to the eye

Similar — therefore infringing



Registered design

≈

Accused product

Both registered designs are similar to the accused product.

The shared inverted-“T”, rounded impression is not overcome by the minor differences.

Result: indirect infringement of both design rights under Design Act Art. 38(i)(a) — reaching manufacturer and sellers alike.

Designs upheld — and enforced

Validity challenge rejected

Defendants argued the designs lost their priority date because a bottom view was added on the divisional/converted filing.

The court disagreed: the original disclosure already described the protective part as a flat circular disc, so the bottom view added nothing new. Novelty and creativity challenges failed — the designs stand.

Remedies granted

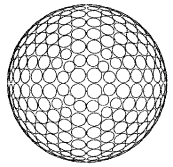
- **Injunction**
  Manufacture, sale, lease & offers stopped
- **Disposal**
  Products and half-finished stock destroyed
- **Damages**
  Awarded against the sellers (Design Act Art. 39(2) profit presumption)

What Daido Kikai teaches?

1 Function does not defeat a design	The disc existed purely to protect the hand — yet it was a valid, enforced design. Only shapes solely dictated by function are barred.
2 Frame the essential part around use	Because the court judged the design as seen in real use, the defendant's changes on the hidden underside simply didn't matter.
3 Layer your rights over one feature	A patent + two designs — one on the whole member, one on the disc alone — so a design-around of one need not defeat the others.
4 Indirect infringement reaches the chain	A component made only to build the protected article pulls in the manufacturer and every seller.

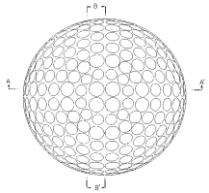
Technical features registered as designs

PATENT



Patent 3,698,195

DESIGN



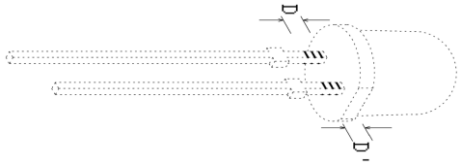
Design 1,144,546

Golf ball

Dimple pattern for greater distance

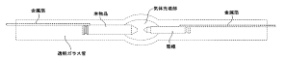
Bridgestone Sports

PATENT



Pat. app. 2007-041663

DESIGN



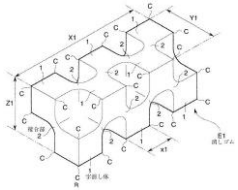
Design 1,314,093

LED

Indentations that absorb rising solder

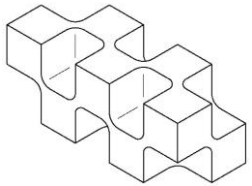
Nichia

PATENT



Patent 4,304,926

DESIGN



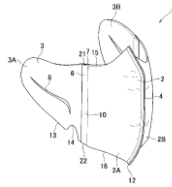
Design 1,191,186

Eraser

Many corners for erasing fine detail

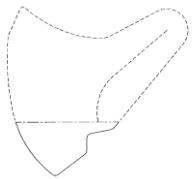
Kokuyo

PATENT



Patent 5,074,746

DESIGN



Design 1,286,491

Mask

Cut-away that eases tension on the ears

Unicharm

Branching a design from a patent application

"Conversion of application" under the Design Act, Article 13

Patent application

(or utility-model application), still pending

CONVERSION

Design application

protects the product's shape

Filing date retained

→ the original patent application is then deemed withdrawn

1 What it is

Convert a pending patent (or utility-model) application into a design application, so the same development is protected as a shape.

2 Filing date is retained

The design application is treated as filed on the original application's date — the early priority position is preserved.

3 Keep the shape consistent

The design must stay within what the original application disclosed. New matter can forfeit the back-dated date.

4 Why do it

Capture the appearance once you realize it is worth protecting, and gain a fast, independent second right — while the original is still pending.

In GOP v. Daido Kikai: the asserted designs branched from the patent side, and a bottom view added on conversion did **not** lose the filing date — the shape was already disclosed. Conversion (change of type) differs from a divisional (a split within the same type).

Takeaway

1 File designs alongside patents

For any product with a distinctive functional feature, add a Japanese design filing. It registers fast and gives you a second right to assert.

2 Use partial designs deliberately

Claim the functional feature in solid line; leave the rest broken. File more than one cut — e.g. the whole member and the key part alone.

3 Draw for how the product is used

Because the essential part is judged in use, choose views and a broken-line strategy that put your feature front and center.

4 Mind the priority chain

Design can branch from a patent application via conversion/divisional — but keep the disclosed shape consistent to hold the early date.

Thank you!

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