

## Design law reform

### Outline of the design law reform in fiscal year 2014

#### I Purpose of reform

The purpose of this design legal revision is to join "the Hague Agreement Geneva act" (Hereinafter called "the Hague Agreement"), and to be able to correspond to an international application for design by applying a system of the Hague Agreement. Therefore, a domestic application prior to the design legal revision would not be affected by the design legal revision. "The protection expansion of the picture design" which had been under discussion was left over.

#### II The Hague Agreement

The Hague Agreement is a treaty which regulates the procedure of an international application for design. It can be said as the system corresponding to PCT in patents and the Madrid protocol in trademarks. Forty six countries and organizations (as of the end of 2013), mainly European non-examination countries (the countries where applications are registered without examination), joined in the past, but examination countries such as USA, Japan and Korea will join hereafter.

#### III About international application for design

"International Application": The application which Japanese people file in each country (As in "international registration application" for trademarks regarding article 68bis of the Japan trademark law).

"International Design Registration Application": The application which people of each country file in Japan (As in "international trademark registration application" for trademarks regarding article 9 of the Japan trademark law).

##### 1. International phase of an international application for design

A design right can be acquired at more than one member country by one application procedure. However, the right of registered design is registered in "every country". No "worldwide right of registered design" exists. When in an examination country, the application is examined according to the design law of each country.

In principle, the application shall be filed to "WIPO" (International Bureau) directly. Applications cannot be made to the Japan Patent Office

The Japan Patent Office is planning to implement reception work as an agency government office, but WIPO accepts an application via the Japan Patent Office and application procedure is completed then.

Including Japan to a designated country of international application is possible, but it is necessary to make an application form in English in that case as well.

When an international application is accepted, in principle, the application is registered internationally within the day, and this international registration date is handled as a filing date in each "designated country". But a right has not arisen yet.

It will undergo an official and international publication 6 months after the international registration date.

## 2 National phase of an international application for design

In non-examination countries, the application is registered in that timeframe, and the right of registered design has arisen. On the other hand, in the examination countries, the registrability of the design application is examined according to the law of each country.

## 3 Examination in Japan

### a. When the refusal reason was not found

The Japan Patent Office sends a "protection approval notification" to WIPO, and the design is registered in Japan.

### b. When the refusal reason was found

The Japan Patent Office sends a "refusal notification" in English to WIPO, and this notification is sent to the applicant from WIPO.

Thereafter, the procedure enters into Japan national phase and the applicant can submit a remark and an amendment to the Japan Patent Office.

The remark shall be Japanese and the part of the amendment shall be English.

When a refusal reason is overcome, the Japan Patent Office notifies WIPO of "withdrawal of a refusal notification", and the design is registered in Japan. When the refusal reason is not overcome, it will be a "decision of

refusal". Thereafter, the procedures are the same as a domestic application regarding the appeal procedure and the revocation suit.

#### 4 Special handling

##### a. Application including more than one design

"International Design Registration Application" can include more than one design in one application. However, the domestic application can only have one design in one application according to the Japanese design law. Thus, the international application which comes into Japan will be the handed as an individual application with respect to each design and also brings about a right separately.

##### b. Procedure of an exception to lack of novelty

There is no procedure to insist an exception to lack of novelty in the "International Design Registration Application". Thus, the applicant can insist an exception to lack of novelty to the Japan Patent Office during a fixed period from an international publication.

##### c. Secret design

When the "International Design Registration Application" is registered in Japan, the design was already published internationally. Thus, the applicant cannot file the secret design.

If the applicant would like to maintain the design as a secret, the said international publication can be postponed 30 months at the most. However, the arising of a right also will be delayed.

## National phase at JPO

