

SUMMARY OF INTRODUCTION TO THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS IN JAPAN

May 2015

With the enforcement of the Revised Japanese Design Act (hereinafter referred to as “Act”) in Japan on May 13, 2015, which provides the introduction of the Hague system for the international registration of industrial designs (hereinafter referred to as “international registration”), any foreign applicants may designate Japan as a Contracting Party when filing applications for international registration.

We would like to provide some basic information which are considered to be useful and necessary when one wishes to obtain protection of its industrial design in Japan through the Hague system.

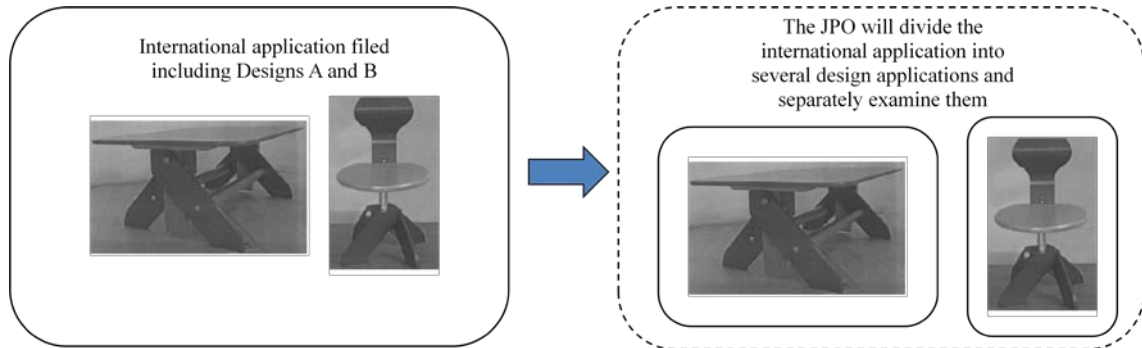
1. Publication

According to the Act, the international application which includes Japan as its designated Contracting Party shall be deemed to be a Japanese design application filed on the international application date, provided that the international application is registered and subsequently published by the International Bureau (Article 60-6(1) of the Act).

Please note that the Japan Patent Office (JPO) approves the maximum period of 30 months for deferment of publication counted from either the filing date or the priority date. Thus, in the case where an international application designating Japan requests deferment of publication, such international application will not be deemed to be a Japanese design application until it is published by the International Bureau. Consequently, the design right based on the international registration will not become effective until the expiry of deferment period.

2. One design per an application

Under the Hague system, the applicant may include several designs (100 different designs at the maximum) in one application, provided that all the designs belong to the same class of the Locarno Classification. However, since a single application with multiple designs is not accepted in Japan, an international application requesting protection of multiple designs will be deemed to be as multiple applications corresponding to the number of designs included in the international application (Article 60-6(2) of the Act).



e.g.)

One single international application filed for designs A and B will be considered as two Japanese design applications filed for the respective designs.

3. Exceptions to lack of novelty of the design

If the applicant wishes to claim exceptions to lack of novelty of the design, it is necessary to submit a document stating thereof and also documents proving the fact that the design deserves to claim exceptions to lack of novelty. These documents should be submitted with the JPO within 30 days after the international publication. (Article 60-7 of the Act) In conformity with this rule, the international application form (DM/1) shall be revised and new ANNEX shall be added.

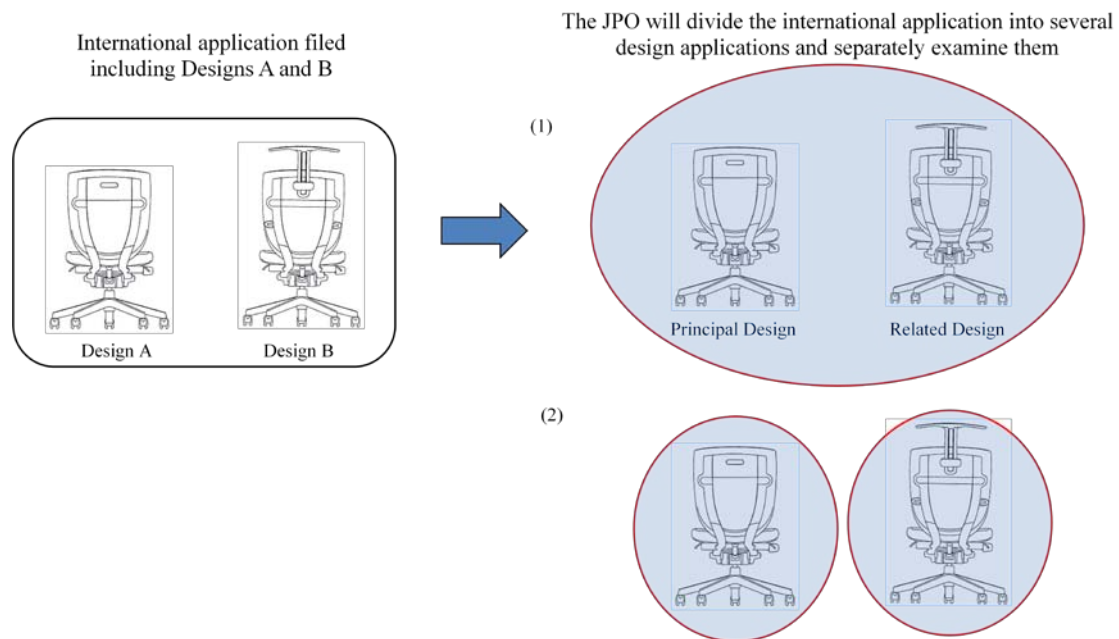
Thus, please note that the system “exceptions to lack of novelty of design” is different from the grace period system, for example, in Community Design or U.S. design patent, in terms of necessary requirements, since the applicant does not need to take any additional procedures when he/she wishes to enjoy the benefit of grace period for Community Design applications or U.S. design patent applications.

4. Related designs

It is possible to file two or more designs similar to each other in Japan by using “related design” system. Specifically, under the current Japanese design law, a related design application is available, which enables an applicant to include one principal design in a first application and include each subsequent design (related design) similar to the principal design in each subsequent application. Either a principal design or a related design can be filed with the international application. (Article 60-8 of the Act) The time limit for filing a related application is not yet clearly specified in the Act or any other

regulations, however, we assume the related designs can be filed before the international publication of the principal design.

*Please note that the national related designs must be filed in a time period between the filing date of a principal design and the publication of the principal design.



*Related Design System

If two or more designs are registered as related designs as shown in the above case (1), the scope of protection of the whole design will be broader when compared with the case (2), where two or more designs are registered without claiming “related design”.

5. Secret designs

A secret design system is not available for international applications (Article 60-9 of the Act).

*Secret design system: The applicant may request the JPO not to make the details of design (e.g. drawings, photographs) available through the design gazette for a maximum period of 3 years counted from the registration date.

6. Claim of compensation

In case any third party has used design(s) which is identical or similar with the design(s) claimed in international application for its commercial products in a period from the international publication date to the registration date of the international

application, the registrant may claim compensation against such third party in the amount equivalent to the amount the registrant would be entitled to receive in relation to the claimed design (Article 60-12 of the Act).

7. Individual fees

For an international application designating Japan, an individual fee of 74,600 JPY (per one design) in addition to the basic fee is payable. For instance, if two designs are included in the international application, individual fee would be 149,200 JPY (74,600 JPY × 2).

8. Other issues

1) Priority claim

Any international application claiming the Conventional Priority of the basic application is required to indicate the details of the claim in the application form (DM/1) and also submit a priority document with the JPO within 3 months after the international publication.

It should be noted that the priority document must be submitted through a Japanese patent attorney. In such a case, a professional fee will be usually incurred.

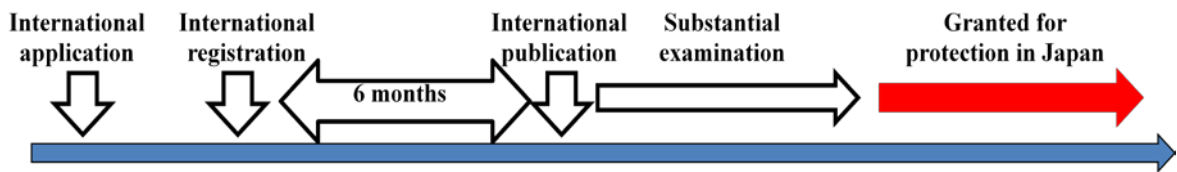
2) Number of drawings

While the international application can even be filed only with one view, six views (front view, rear view, plan view, bottom view and side views) need to be filed in Japan. An application filed with five or smaller views is likely to be refused on the ground that the claimed design cannot be specified by the submitted figures, and it will be very difficult to overcome such refusal. Therefore, if Japan is designated in the international application, the applicant is recommended to prepare and file six views in order to avoid such refusal.

3) Disclaimer

In the international application, a part of the design which is shown in the drawings but for which protection is not sought may be represented in dotted or broken lines or color, along with the statement of disclaimer in the description. Since the JPO accepts disclaimer in the same manner as stipulated in the Hague system, the applicant must clearly define the disclaimed portion in each figure as well as in the description. In the event that the Examiner of the JPO finds the portions which protection is sought cannot be clearly defined by drawings and/or description, a refusal notice may be issued.

<Registration process of international application in Japan>



*The substantial examination by the JPO will be started after the international publication.

*The application will be examined per one design, even if it includes several designs.

*In the event the examiner does not find any grounds of refusal, the JPO will notify the statement of grant of protection to the International Bureau.

*If the Examiner finds grounds of refusal, a refusal notification is sent to the International Bureau and the applicant will subsequently receive the notice from the International Bureau.

*The applicant may respond to the refusal notice by means of submitting argument and/or amendment through a Japanese patent attorney.

Should you have any questions relating to the above information, please do not hesitate to contact us.

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