

5 Method of the Design System to Promote Diversifying Design Creation Activities

The use of design is said to be an important element for strengthening a company's competitiveness. The Japan Patent Office has been facilitating a review of the design system as needed in order to promote design creation activities and to protect them appropriately, and is also continuously exchanging opinions with industry and designers, etc. This research study was conducted to create the base materials to review the method of a design system that protects and promotes the increasing diversity of design creation activities.

I Introduction

1 Background of this research study

Attractive designs enable products to differentiate themselves from other companies' products and to add high values. Using designs is said to be an important element for strengthening a company's competitiveness. The Japan Patent Office has been reviewing the design system as needed in response to changes in social situations in order to protect appropriately the increasing diversity of design creation activities. It has also been exchanging opinions with industry and designers, etc. in order to promote further creative activities and to engage in improvements to the methods of the design system and its convenience. Based on the results of this exchange of opinions, this research study was conducted in order to research and analyze the needs for protection pertaining to design creation activities and the standpoint of international harmony, etc. through a survey of the actual conditions for the development and protection of design in Japan and overseas, and to create base materials for reviewing the method for the design system to protect and promote design creation activities and their diversity.

2 Method of this research study

(1) Establishment of the Committee

A research study committee composed of persons with relevant knowledge and experience, attorneys, patent attorneys, and industry experts, has been established and the committee met for four times in total in order to obtain its reviews, analyses, and advice for this research study from the perspective of specialists.

(2) Questionnaire survey in Japan

Related questionnaire surveys were conducted with approximately 1,200 users of the design system, such as companies, organizations, patent offices, designers, etc. in Japan.

(3) Oral interviews in Japan

Based on the responses to the questionnaire surveys, face-to-face interviews were conducted with 20 companies, patent offices, design offices, and design related organizations in Japan.

(4) Overseas interviews

Face to face interviews were conducted with Patent Offices, law firms, and design related organizations in foreign countries in order to obtain information on related systems, their operation, and the awareness that users have of them in their countries.

(5) Document investigation in Japan and overseas

Relative information in Japan and overseas was collected and used as base material and reference for examining issues in the Committee.

II Further Adjustment of Screen Design Protection

1 Expansion of protection of screen designs for which configurations change

(1) Overview of activities for design protection of screen designs

In the past, figures, etc. that appear on a screen were not included in the subjects of protection under the Design Act since they were not considered to be patterns which are components of a design. However, since 1986, those that fulfill certain requirements, such as being essential for the completion of an article,

etc., are regarded as elements composing a design as prescribed in Article 2, paragraph (1) of the Design Act.

After multiple investigations, the definition set forth in Article 2, paragraph (2) of the Design Act was newly provided for by the Design Act amendment in 2006 and screen designs that are provided for use in the operation of an article are newly protected by the Design Act as images that compose a configuration of a part of the article. In response to the amendment, the Design Examination Guidelines were developed and published.

(2) Issues

Under the current Design Examination Guidelines, one design has one image in principle. In cases of a design including multiple images, the Guidelines do not have room to interpret it as a single design to a limited extent. However, it has been indicated that the changes and movement of displayed images are one of the important points for the creation of screen designs; screen designs are therefore not sufficiently protected under the operations based on the current Design Examination Guidelines.

(3) Perspectives for examination

- (i) Possibility of responses by reviewing the Design Examination Guidelines (responses under the current Design Act)

[Issue 1] Range and configuration changes that can be considered as a single design

- (a) Preconditions to be regarded as components of a design
- (b) Range that can be considered as a single design
- (c) Approval as a design and approval or disapproval of configurational relevance

[Issue 2] Method of specifying changing configurations

- (a) Specifying method
- (b) Treatment of reference drawing

[Issue 3] Evaluation of movements in the changing images

- (a) Appropriateness of attempts to obtain design registration only for forms of movement
- (b) Approvals for the design
- (c) Judgments of similarity
- (d) Judgments on the difficulty of creating the design

- (ii) Possibility of responses by amendment of the Design Act (example of countermeasures that exceed the framework of the current Design Act)

- (a) Introduction of the system of one application for multiple designs into screen designs
- (b) Protection of screen designs, for which the configuration changes, as a design for a set of articles

(4) Summary of examinations

When considering the actual conditions of screen design creation at companies and other circumstances, there is a significant need among design system users to protect screen designs, for which the configuration changes, as single design.

Responding to this need may lead to limiting the scope of the effectiveness of design rights as the number of images composing single design increases, while it enables claiming rights including the characteristics of configuration changes. Therefore, it is considered to have significance to the extent that it provides applicants flexibility to choose the means to obtain a right.

This research study assumed maintaining the definition of Article 2, paragraph (2) of the current Design Act and primarily investigated possible response measures within the framework of the current Design Act by reviewing the Design Examination Guidelines.

Based on the interpretation of the provisions of the Design Act, there is room for a more flexible interpretation than the current examination guidelines, which assume a single still image to be a single design. If the interpretation is eased to a reasonable extent, it is possible to proceed to the protection of screen designs with configuration changes to some extent under the current Design Act.

On the other hand, in cases of attempting to consider screen designs with configuration changes as a single design, it is pointed out that it is necessary for justifying this perspective to develop the relationship between the definition of design set forth in Article 2 of the Design Act and movable design set forth in Article 6, paragraph (4) of the same Act.

In the future, it may be necessary to proceed to specific countermeasures in consideration of possible responses by revising the examination guidelines and responses by amendment of the Design Act.

(i) **Possibility of responses by revision of the Design Examination Guidelines**

In the examination of this Committee, the following ideas and opinions were indicated as possible responses by revision of the design Examination Guidelines based on the provisions of the current Design Act.

[Issue 1] Range and configuration changes that can be considered as a single design

- (a) Even if part of the multiple images does not fulfill the requirements for operation images by itself, it is allowable if the multiple images are regarded as an image provided for use in the operation of the article as a whole; provided however, that the content is excluded.
- (b) In light of the provisions of Article 2, paragraph (2) of the Design Act, it is considered to be appropriate to set a single operation as the base of range of a single design. Based on the provisions of Article 6, paragraph (4) of the Design Act, it is considered to be possible to regard unlimited and arbitrary configuration changes as a single design; if so, it cannot be denied that multiple images that are uncoordinated as a design creation may compose a single design. Therefore, it is necessary to establish certain restrictions on configurations, etc. Consequently, as to the range of images that can be considered as a single design, the following two ideas are assumed:

[Proposal 1] Arbitrary configuration changes shall be regarded as a single design for up to one operation.

[Proposal 2] Configuration changes within a certain range shall be regarded as a single design up to operation.

- (c) According to the results of the questionnaire survey, it is desired to consider the range in which a “visual consistency” is found as a set of design creations. As a result of the examination of the Committee, based on unity of design creation and the convenience of applicants, the range that is considered to be a single design is considered to be in the direction based on the idea in [Proposal 2] above.

[Issue 2] Method of specifying changing configurations

- (a) It may be appropriate to indicate drawings of multiple images that show the form of

configuration changes, for which an applicant requires to obtain patents, in the order of said changes, and to specify the form of specific configuration changes by stating an explanation of said changes in the application.

- (b) As to the treatment of reference drawings, it may be appropriate to retain the use of drawings that can help in understanding the design as reference drawings, as they are currently treated.

[Issue 3] Evaluation of movement in changing images

- (a) It may be appropriate not to allow design registration to be granted only for the form of conceptual changes (or movement) by changing the form, position, size, and range of drawings, etc. that are shown by dashed lines.
- (b) It may be appropriate to regard an overall design that is presented by means of multiple images as a single design that may change or move.
- (c) It may be appropriate to judge that, in cases where each drawing has novelty, they are regarded to have novelty as a whole, and that, in cases where each drawing does not have novelty, if the forms of the specific configuration changes have original and significant characteristics, they are judged not to be similar to prior designs.
- (d) If individual drawings are publicly known and the form of the configuration changes is also publicly known, it may be appropriate to reject it as a design that can be created easily.

(ii) **Possibility of response by amendment of the Design Act**

In cases of responding by amendment of the Design Act, it is necessary to note the following points:

- In cases of screen designs that are positioned as the form of part of articles, it is also considered that the screen design may include configuration changes without restriction or extension according to the provisions of Article 6, paragraph (4) of the Design Act. Therefore, it is considered as a proposal to impose some restrictions on said provisions in cases of configuration changes of a screen design.
- With regard to the application of a design for a set of articles, it is necessary to examine further the relationship with

the fact that it has no concept of the continuity of changes and the arrangement of the current Act.

- The system of one application for multiple designs cannot respond to applicants' needs since it does not allow applicants to claim rights based on the characteristics of the form of the configuration changes.

2 Simplifying requirements for the submission of drawings

(1) Issues

With regard to "a graphic image that is displayed on the article that is used with the article in an integrated manner," which has become subject to protection by the newly established definition set forth in Article 2, paragraph (2) of the Design Act, it is different from a normal partial design and cannot be evaluated in terms of the location, size, and range of the part for which a design registration is requested in comparison with other designs. Therefore, there is an indication that it is not necessary to require submission of a set of 6 drawings of the design of an article even for images with said characteristics.

(2) Perspectives for examination

(i) In cases of a "graphic image that is displayed on the article that is used with the article in an integrated manner," it may be permitted to omit the submission of drawings other than "images" arbitrarily by stating the explanation for the omission of drawings.

(ii) Is it appropriate to allow the arbitrary omission of the submission of drawings other than the "front view" of articles on which the graphic image is displayed, in cases of a "graphic image that is displayed on the article"?

(3) Summary of examinations

(i) In cases of a "graphic image that is displayed on the article that is used with the article in an integrated manner," it is appropriate to permit the arbitrary omission of submitting drawings other than "images," by stating explanation that the drawings of articles are omitted, in addition to the explanation of functions and operation of the articles pertaining to the image.

(ii) In cases of a "graphic image that is displayed on the article," since the judgment of similarity of

partial design requires an evaluation of the location, size, and range of the part for which the design registration is requested, it may be appropriate to examine for other drawings in the direction that the arbitrary omission of drawings is allowed, while disclosing at the applicant's own risk the necessary and sufficient drawings for specification of the position, size, and range of the part of the images to be displayed for which the approval for the articles pertaining to the design and design registration is requested.

With regard to the method of omitting drawings in the case of these screen designs, it is preferable to facilitate responses in future comprehensive examinations pertaining to the simplification of requirements for the submission of drawings as well.

3 Arrangement of the relationship of images that are approved under Article 2, paragraph (1) and (2)

(1) Issues

Subject images that are seen to be a design component and the requirements for them are different under Article 2, paragraph (1) and (2) of the Design Act. On the other hand, with regard to images considered as a component of a design pursuant to the provisions of Article 2, paragraph (1), their treatment is not clearly indicated in the current Design Examination Guidelines. Therefore, there is a possible lack of clarity when judging whether a general design, including its images, corresponds to Article 2, paragraph (1) or (2).

(2) Summary of examinations

(i) As to the treatment of a design, including its images, it may be preferable to state clearly in the Design Examination Guidelines about the treatment of images based on the definition of Article 2, paragraph (1) that has been considered as a component of a design, in addition to operational images based on the definition of Article 2, paragraph (2) of the Design Act.

(ii) Considering the understandability for applicants and the convenience of examinations at the Patent Office, it is possible to arrange for Article 2, paragraph (2) of the Design Act to apply to all "images on a screen provided for use in the operation of the article," including the initial menu display, etc. of composite articles that have been considered to compose a design, and for Article 2, paragraph (1) to apply only to "essential

display images in light of the completion of articles.”

(iii) With regard to certain display images that do not correspond to operational images as defined in Article 2, paragraph (2) of the Design Act, but are inherent to articles of design, and fulfill the functions required by its display, it may be appropriate to clarify that they become subject to design protection as “essential display images in light of the completion of articles,” which is considered to be a component of a design under the definition of Article 2, paragraph (1).

(iv) As to restrictions on configuration changes in cases of images subject to Article 2, paragraph (1), a proposal may be considered to set requirements concerning configurations, etc. set forth in 1., (4), (i), [Issue 1], (b), [Proposal 2] in cases of the abovementioned operational images as requirements to be recognized as a single design.

III Use of the right to obtain design registration at an early stage

1 Revision of provisions on pledges

(1) Issues

Today, in order to facilitate further promotion of the use of patents, it has been examined whether to lift pledges for the right to obtain patents. The establishment of a system to register and publish changes in rights pertaining to rights to obtain patents under application is also examined.

Consequently, it should be considered whether it enables the lifting of pledges for the right to obtain a design registration along with the lifting of pledges for the right to obtain a patent.

(2) Summary of examinations

If the establishment of pledges for the right to obtain a patent is lifted, while the establishment of pledges for the right to obtain a design registration remains impossible as is the case now, it is estimated that the system will be hard to use due to its imbalance. Although the right to obtain a patent and the right to obtain a design registration originally have similar characteristics as property rights, if the right to obtain a patent and the right to obtain a design registration are treated differently, such as whether pledges can be established or not, it cannot be denied that some detriment may be caused to applicants due to mistakes, etc.

For this reason, in cases where the system that enables the establishment of pledges for the right to obtain a patent is reformed, the establishment of pledges for the right to obtain a design registration should also be made possible.

2 Introduction of the provisional exclusive license and provisional non-exclusive license system

(1) Issues

In cases of licensing work on a product to another person, it is conducted in the form of a contract to license patent rights and design rights related to the work of the product comprehensively in a business transaction. When a creation is protected by both a patent right and a design right, if the existence of protection differs due to the difference of systems, using the system can remain difficult. Therefore, there is an indication that the same system as the one used for patents should be introduced.

Under the condition that the unilateral licensing of a design right is not so active, including at the stage of application, whether the design system should also take the same measures as the patent system should be examined from the perspective of convenience of users based on the conditions of amendment of the Patent Act, etc.

(2) Summary of examinations

Based on the fact that there were no indications on the inconvenience that arises from the absence of a provisional exclusive license and provisional non-exclusive license system with the design system as a result of the questionnaire survey, it is found that the need to introduce a provisional exclusive license and provisional non-exclusive license system is not high at this moment.

In the examination pertaining to the patent system, such as the current patent system study meeting, etc., the need to review the automatic perfection of licenses has been recommended. If a natural perfection is found with the license for the right to obtain a patent, it is considered that the necessity for registering provisional non-exclusive licenses decreases comparatively.

Therefore, it is found that the necessity of introducing the system is not so high at this moment. It is appropriate to review the introduction again as needed in the future based on the usage conditions of the system under the patent system.

IV Reviewing Exemptions to Lack of Novelty

1 Whether later submission of certification pertaining to application of exemption to lack of novelty is allowed

(1) Issues

Along with the globalization of economic activities, the number of cases where an overseas subsidiary company releases a new product prior to its release in Japan has increased recently. The exemption to lack of novelty requires certification by the third party. There is an indication that this imposes burden on business.

Therefore, the adoption of more flexible choices as to the time of submission of the documents certifying the fact of lack of novelty is indicated.

(2) Summary of examinations

If declaration at the application and submission of certification within the prescribed period from the application are not required, it may provide a certain benefit to applicants, while it may be detrimental to the third party. This is likely to damage promptness of overall design examination during the examination of the Patent Office.

In addition, the operational burden of applicants, etc. will not be reduced nor will it become difficult to provide sufficient certification when responding to notification of grounds for refusal as time elapses from publication. Therefore, as a result, it is also considered that the possibility that a right cannot be obtained for the design will increase. Consequently, it is considered that there is little need to change the current system based on these points.

2 The period subject to the exemption to lack of novelty

(1) Issues

The Design Act establishes provisions of related designs in Article 10 and enables the registration of similar designs within a certain period by the same applicant. However, this related design system is an exemption from double patents (prior and later applications), while it does not constitute an exemption to requirements of novelty. Therefore, in cases where an article, for which a design of prior application for design registration is worked, is published before filing a later application, its improved design lacks novelty due to the

published article and, therefore, the period to obtain additional protection as a related design becomes limited.

In response to this situation, expanding the period to which the exemption to lack of novelty applies is indicated.

(2) Summary of examinations

Expansion of the period to which exemption to lack of novelty applies is considered to have certain effects, such as that applicants will better enjoy the period allowable for later submission of a related design, etc. However, in addition to the fact that the expansion of the period may increase the risk of rejection based on work of a similar design by the third person after publication, it will require a long time, more than one year after publication of the prior design, when the later improved design may be rejected due to an own prior design. Therefore, it is presumed that an application for design registration that can actually enjoy the expansion of the period to approximately one year is limited. In order to improve the design system so it is convenient for more applicants, it may be necessary to facilitate the comprehensive revision of provisions concerning treatment of own prior designs, such as requirements for application of novelty and related design systems, etc.

V Ideal Design System (Proposal)

There were many opinions and requests related to the design system in this research study. These indications are seen as guidelines for considering the ideal design system. Therefore, based on these indications, proposals for the ideal design system are summarized as follows in consideration of various issues, such as the strengthening of company competitiveness, promoting the use of valuable designs for brand strategies, and promoting international harmony.

1 Method of the design system to promote the strategic use of designs

(1) Method to protect a design in later applications that are similar to one's own prior design

It may be necessary to facilitate comprehensive revision of the treatment of a design in a later application that is similar to an own prior design in order to support a company's long-term brand strategy by using designs.

(i) Is it appropriate to consider the introduction of a system to extend the period in which a design in a later application is treated as an exemption to lack of novelty only in cases where the prior design is the applicant's own registered design or a design pertaining to the application for design registration?

(ii) Is it appropriate to consider a later application for a related design in the direction of further easing time requirements?

(iii) If it is checked whether a design in a later application is similar to the applicant's own prior design and convenient means are provided to make some public notice, is it possible to respond to certain needs of the applicants?

(2) Method to extend the use of the partial design system

(i) With regard to the amendment to expand (to change dashed lines to solid lines in the drawings) the part for which a design registration is requested, can the examination be started to allow the adjustment of changing them to a solid line only in cases where it is disclosed (with the dashed lines, etc.) from the beginning of the application? Along with this examination, can an examination begin as to whether the amendment from partial design to full design is allowed?

(ii) With respect to the amendment to reduce (to change solid lines to dashed lines in the drawings) the part for which a design registration is requested, since it limits the characteristics of the part that was indicated at the beginning of the application and for which a design registration is requested, a wider range of rights may be considered to be involved. Therefore, it may be necessary to respond to those cases carefully.

(3) Promoting clarification of design rights by provision of peripheral information of applied designs

(i) Can an examination be started to determine indices for leveling the standards of publication of reference document information as publicly known designs that exist peripheral to registered designs?

(ii) Can an examination be started in order to respond also to peripheral information other than reference document information that has been published in the Design Gazette as soon as an environment, such as a system, etc., is developed

in the future?

(4) Method to define designs for screen designs

The appropriateness of the introduction should be examined constantly and carefully based on the current status of protection, effects from the introduction of the system and the awareness of design system users in Japan.

2 Method for the design system to allow diversified methods to obtain a right

(1) Examination of the diversification of application procedures

Can an examination be started on the introduction of a system to secure application dates promptly by easy and inexpensive procedures, or a system under which a design strategy to obtain a right within a certain period can be considered, such as having the application date secured by filing preliminary applications for multiple design proposals so that the design for which the right is requested can be selected subsequently?

(2) Mitigation of requirements for submission of drawings

(i) Can an examination be started to allow the omission of drawings attached to the application at applicant's judgment only in cases where a single design can be clearly identified? In that case, it may be necessary to organize issues from the perspective of international harmony.

(ii) Can an examination be started as to the requirements for the submission of drawings of partial designs concerning whether the extent to which the "location, size, and range" of articles pertaining to the design and the part for which a design registration is requested is sufficient disclosure?

(3) Introducing a one application system for multiple designs

Can we examine allowing statements of multiple articles pertaining to a design in an application in cases where the same configuration is used with multiple articles?

3 Other

In cases where the introduction of the right licensing system and development of relief measures for misappropriated applications are

examined under the patent system, it may be appropriate to examine them under the design system at the same time.

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