

# Industrial Design Law

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## Topics

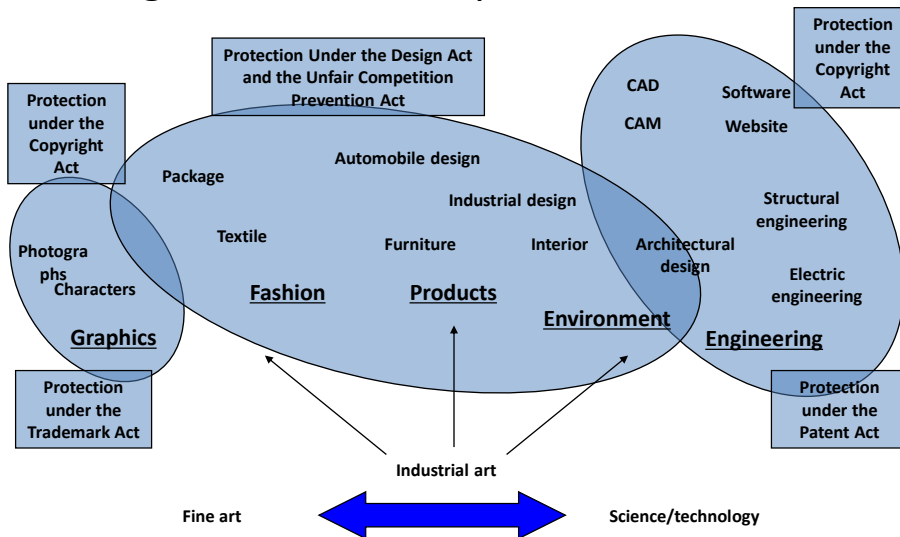
1. Scope of Protection and Registration Requirements
2. Exercise of Design Right
3. Diverse Protection Systems
4. Impact of Participation in Hague Rules

# Topics

1. Scope of Protection and Registration Requirements
2. Exercise of Design Right
3. Diverse Protection Systems
4. Impact of Participation in Hague Rules

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## Design Fields and Scope of Protection



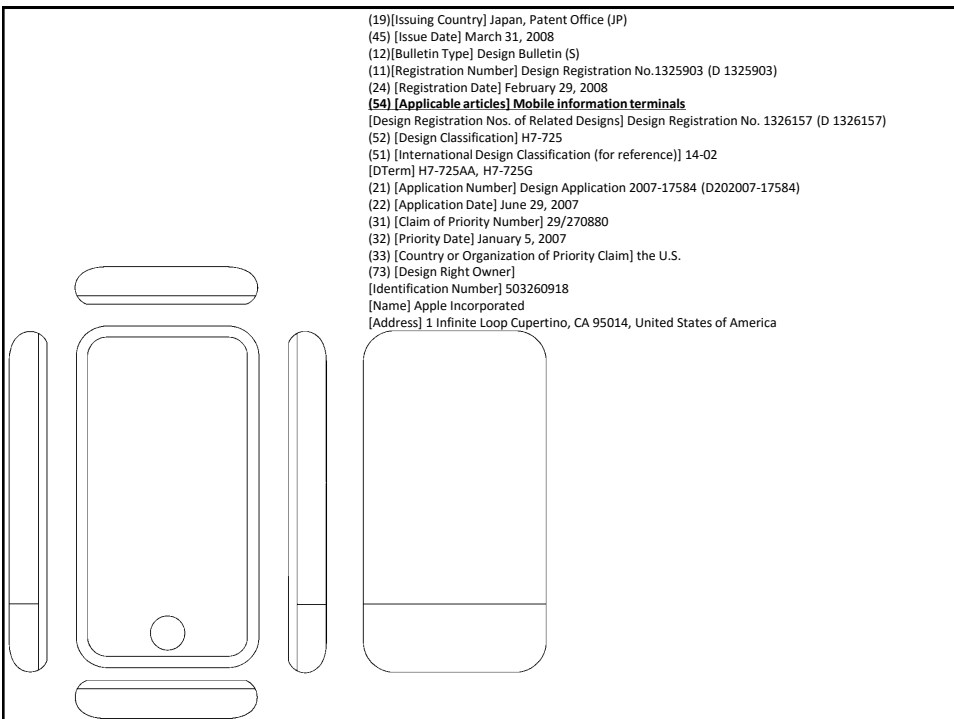
Source: Created by Suzuki by referencing the diagram on p.10, Borja de Mozota, Brigitte, 2003, *Design Management*, Allworth Press

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# Example of Product Design



Source: <http://www.apple.com/jp/iphone/iphone-3gs/>



## Overview of Design System

- "Designs" refer to designs of mass-producible articles. The Design Act protects those designs.
- The purpose of the Design Act is to encourage the creation of designs and contribute to industrial development.
- The owner of a design right has exclusive right to use the registered design and designs similar thereto.
- The design right is guaranteed for 20 years from the registration.

## Scope of Protection of Design Right

- Design (forms, patterns and/or colors) of the appearance of an article (including a part of an article)
- "Articles" = Tangible, distributable and movable properties. Immovable properties, typefaces, fountains and the like are not included in "articles" for the purpose of the design right protection.
- "Parts" that comprise an article are also treated as "articles" as long as they are traded as separate items in the market.
- Part of an article: Protected as partial design
- A group of articles: Protected as "design for a set of articles"

## Purpose of the Design Act

(Purpose)

Article 1 The purpose of this Article is, through promoting the protection and the utilization of designs, to encourage the creation of designs, and thereby to contribute to the development of industry.

## Definition of Design (Article 2)

- "Design" shall mean 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.

### Requirements (criteria) to be recognized as a "design"

- (1) The item must be comprised of a design defined in the Design Act, and
- (2) The design must be concrete.

## Application for Design Registration

### Article 6

(1) A person requesting a design registration shall submit to the Commissioner of the Patent Office an application stating the following matters, and a drawing depicting the design for which registration is requested:

- (i) the name, and domicile or residence of the applicant for the design registration;
- (ii) the name and domicile or residence of the creator of the design; and
- (iii) the article to which the design applies

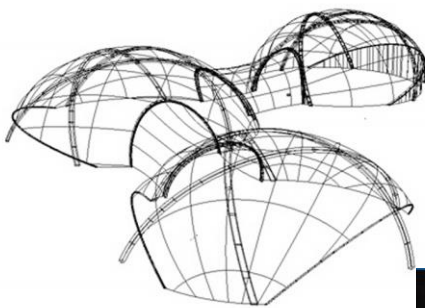
(Paragraph 2 and subsequent paragraphs are omitted.)

## Requirements to be recognized as a "design"

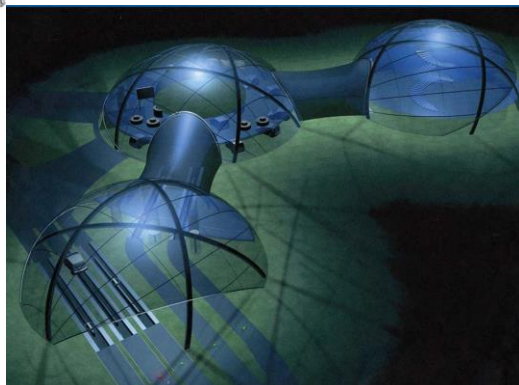
- (1) An item must be comprised of a design defined in the Design Act, and
- (2) The design must be concrete.

(1) The item must be comprised of a design defined in the Design Act

- The item must be an "article" as defined in the Design Act
- The design must be in form of an article
- The design must appeal to the visual sense and
- The design must create an aesthetic impression through the eyes of their consumers.



Design Registration No. 1235805  
Gas Station Roof

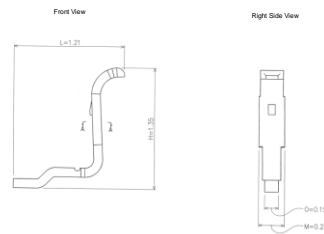


## Intellectual Property High Court Judgment March 31, 2006, Connector Connecting Terminal" Case

".....where it is a normal practice to observe the shape and other looks of articles associated with designs by the naked eye when trading such articles, if the shape and other looks of an article cannot be observed by the naked eye, the article cannot be recognized as "creating an aesthetic impression through the eye," and design registration should not be granted for that article. However, where it is a normal practice in trading to observe the shapes and other looks of articles associated with the design or samples of articles by viewing their enlarged images through a microscope or by presenting enlarged photographs or enlarged illustrations in catalogs, specifications or other documents, it is appropriate to interpret that these articles can be recognized as "creating an aesthetic impression through the eye," even if their shapes and other looks cannot be recognized by the naked eye."

Real scale drawing of the design in the present application

Created by Noboru Fujimoto, Patent Attorney, October 26, 2005



## (2) The design must be concrete.

Concrete contents must be directly derived regarding (1) and (2) below:

- (1) The use purpose of the article to which the design applies and the applications and functions based on the use conditions; and
- (2) The form of the article to which the design applies



## Requirements for acquiring a design right

- The design is industrially producible.
- The design has novelty.
- A person ordinarily skilled in the art would not have been able to easily create the design.
- No prior design application has been filed for an identical or similar design.
- Others

## Industrially Applicable Designs

### Article 3

A creator of a design that is industrially applicable may be entitled to obtain a design registration for mentioned design, except in the following cases:

(Items (i) to (iii) are omitted.)

# Novelty

## Article 3

A creator of a design that is industrially applicable may be entitled to obtain a design registration for mentioned design, except in the following cases:

- (i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;
- (ii) Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration; or
- (iii) Designs similar to those prescribed in the preceding two items.

## Approach to Judging Similarity (ex parte)

◆ Judging entity: Users (including traders)

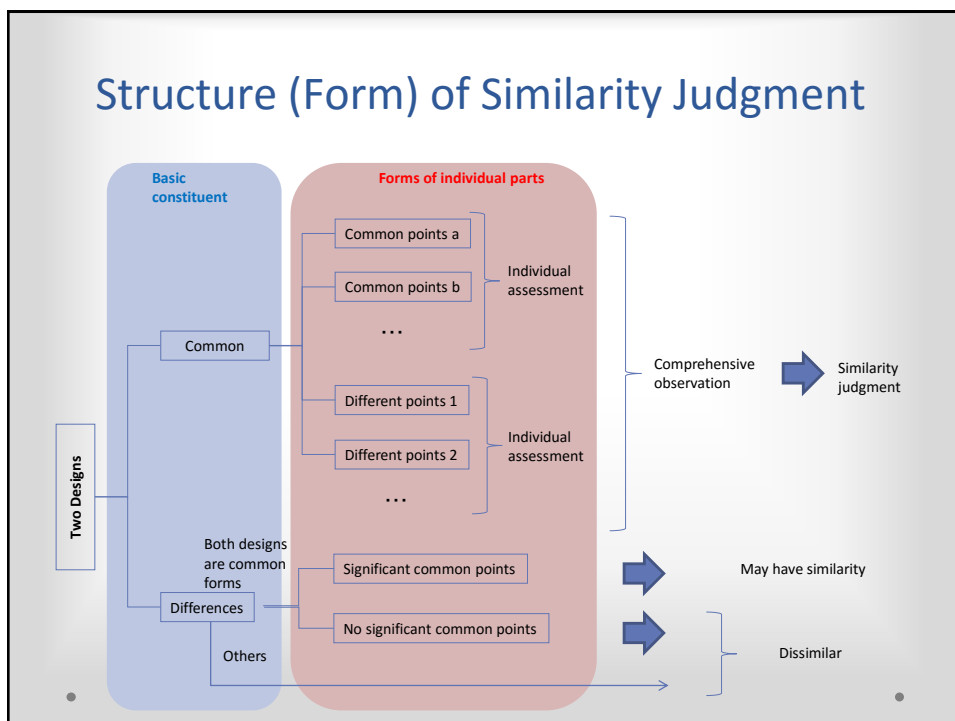
◆ Judging points:

- (a) Identifying articles to which each of two confronting designs apply, and judging the similarity between those articles
- (b) Identifying the forms of the confronting designs
- (c) Identifying common forms and different forms
- (d) Assessing each of the common forms and different forms
- (e) Judging the similarity of the overall designs

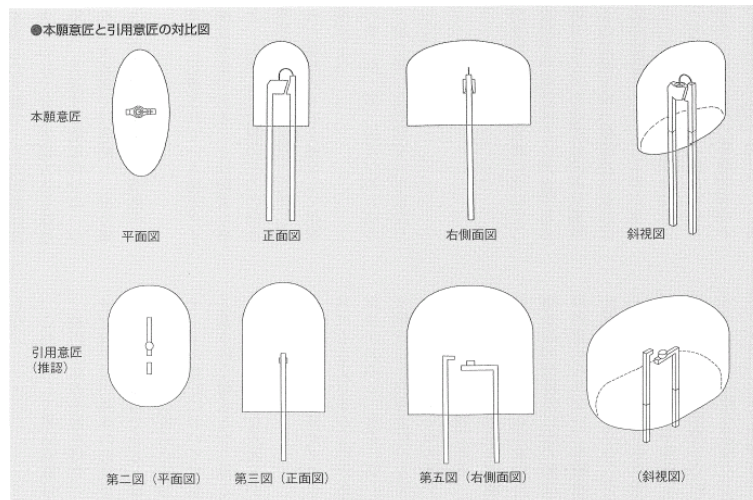
## Identical, Similar and Dissimilar Designs

| Article \ Form | Identical         | Similar           | Dissimilar        |
|----------------|-------------------|-------------------|-------------------|
| Identical      | Identical design  | Similar design    | Dissimilar design |
| Similar        | Similar design    | Similar design    | Dissimilar design |
| Dissimilar     | Dissimilar design | Dissimilar design | Dissimilar design |

## Structure (Form) of Similarity Judgment



# Light-Emitting Diode Case



Article: Light-emitting diode

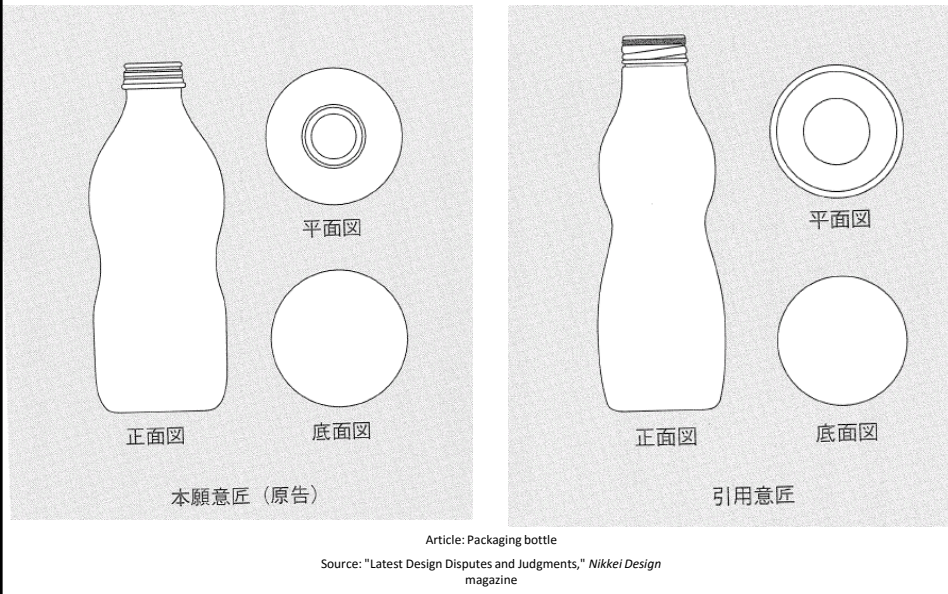
Source: "Latest Design Disputes and Judgments," *Nikkei Design* magazine

## Tokyo High Court Judgment, July 30, 2002

The form of the "main part," identified in the appeal decision as the basic constitution common to the present design and the cited design, which is an almost-flat long cylinder whose shape is elliptical in the planar view, with its top end convexly protruding almost semicircular in the front view and gently circular in the side view, as the plaintiff claimed, apparently is not a technically necessary form for a light emitting diode, and moreover, it comprises the main part of the design of a light emitting diode which is recognizable as a basic component featuring the design; accordingly, unless a distinctive difference that outweighs this common feature is found, persons who observe these two designs will have strong impression that they are common.

As for "leads" that are "provided by extending two thin leads perpendicularly from the bottom of the main part by maintaining the distance between the leads,".....which is a constitution common to the present design and the cited design,..... although the structure is commonly used in the designs of light emitting diodes, it forms, together with the basic constitution of the above-mentioned "main part," the key tone of the overall design as relating to the overall form of the article (light emitting diode), thus, it will give a strong impression of commonality to persons who observe these designs.

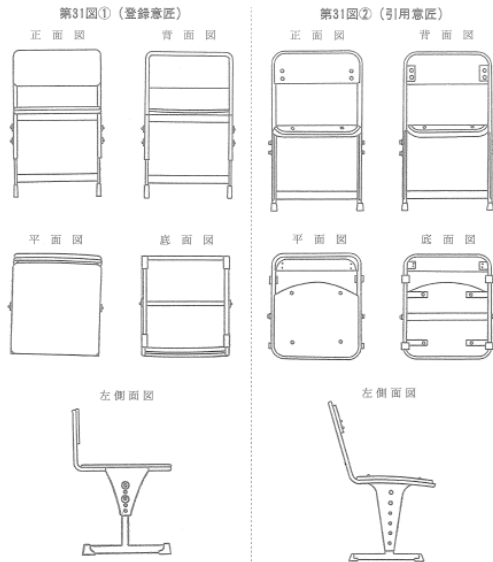
## Packaging Bottle Case



## Tokyo High Court Judgment, November 14, 2002

The present design and the cited design have .....common components: Common Point 1 (the basic constitution), Common Point 2 (a mouth in the form of a short cylinder having convex threads), Common Point 3 (the upper part of the body with a swelled downside), Common Point 4 (the lower part of the body with a swelled middle section) and Common Point 5 (a constriction with a recessed curve surface). Common Point 1 (the basic constitution) represents the basic component of each design when observed generally. Common Point 3 (the upper part of the body with a swelled downside), Common Point 4 (the lower part of the body with a swelled middle section) and Common Point 5 (a constriction with a recessed curve surface) represent the overall peripheral swelling and narrowing shape extending from the upper part to the lower part of the body of the bottle. Together with Common Point 2 (a mouth in the form of a short cylinder having convex threads), these components create the basic tone of the overall shapes of both designs. (Exhibits No.2 and No.3) Given this, the fact that the present design and the cited design have a common structure containing Common Points 1 to 5 should have great impact on the judgment of similarity of the two designs.

# Chair Case



Article: Chair  
Source: Design Act, Wataru Sueyoshi,  
published by Chuo Keizai Sha, Inc.

## Tokyo High Court Judgment, June 17, 1981

The trial decision stated that "Comparing and examining these common points and different points,.....especially, the part of the legs that support the seat, which is a longwise inverse isosceles triangular plate, is very distinctive, and with which persons observing the article would be most strongly impressed, thus it is the dominant form of both designs and is one of the main components that determine the similarity of the two designs. On the other hand,....the difference in the apparent height of the inverse T-shaped leg perpendicular pillar .....absolutely cannot be regarded as a difference in design. Even if illustrated designs are examined, there are partial differences when the designs are observed overall." Each of the two designs is comprised of the shapes and forms as identified in the trial, and because it is reasonable to recognize that the two designs are similar on the whole for the same reason as stated in the trial decision, the judgment in the trial was not wrong; thus, the claim of the plaintiff that the two designs are dissimilar does not have a supporting reason.

## Creative Difficulty

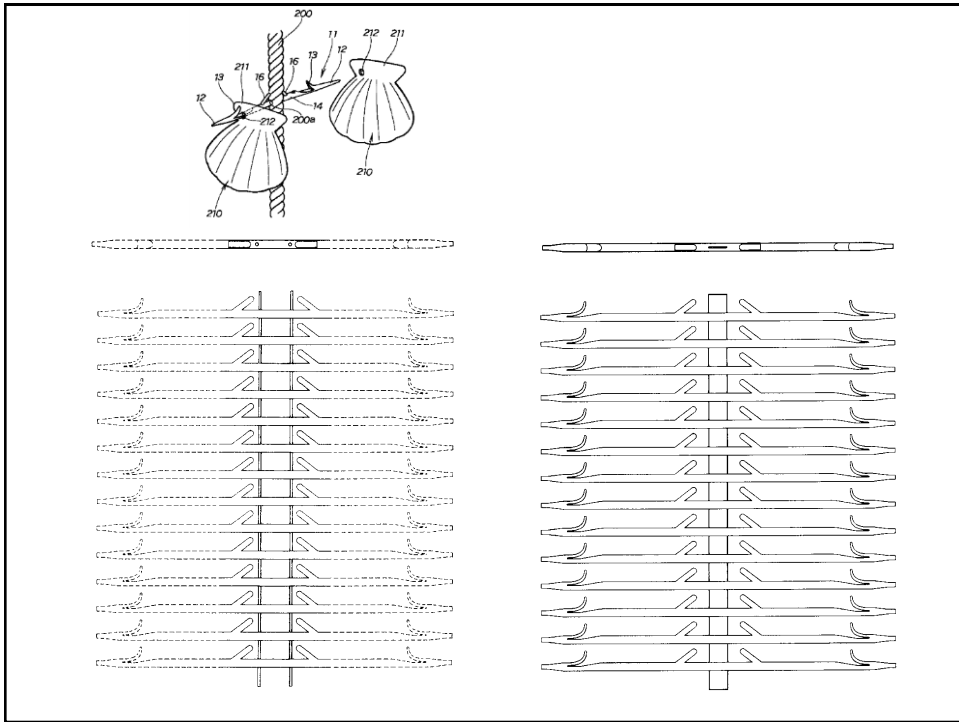
### Article 3

(Paragraph 1 is omitted.)

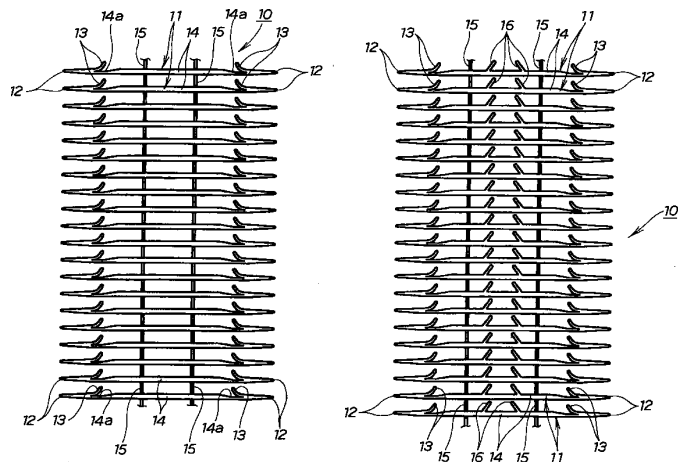
(2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design ....

## Types of "Easily Create"

- Creation by replacement
- Creation by assembling
- Creation by changing the layout
- Creation by changing the ratios of components or by increasing or decreasing the number of serial units
- Creation that represents all or part of a publicly known form, pattern, work, structure or natural object.
- Creation by diversion in a business practice



Exemplary design 2 Fig.2 Fig.7





## Intellectual Property High Court Judgment, June 13, 2007

First of all, when cylindrical axes made from plastics or the like are connected, the components of the design can be chosen from various options, even if functional limitations are taken into account, including what form should be used for the connecting part, what material should be used, whether a single item or two or more items should be used, and even if connecting strings are chosen, how far the distance should be, and at which position they should be placed in relation to other members (such as rope-holding prongs). Therefore, by replacing a strip of thin tape for connection, which is the difference between the present design and Exemplary Design 1, with two connecting strings as shown in Fig.2 of Exemplary Design 2, the characteristic of the present design is formed in which two connecting strings are placed near the rope-holding prongs, and as a result, an almost triangular space is formed between each connecting string and the rope-holding prong, and at the same time an oblong rectangular space is formed which is large enough to enable the placing of a rope between the two connecting strings and between the two horizontally placed pins, by maintaining the distance between the two connecting strings. From its overall impression, it cannot be said that a person ordinarily skilled in the art would have been able to easily create the design by choosing these unique cohesive characteristics.....

## Topics

1. Scope of Protection and Registration Requirements
2. Exercise of Design Right
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4. Impact of Participation in Hague Rules

## Effect of Design Right

- The owner of a design right has the exclusive right to use the registered design and designs similar thereto.
- The owner of a design right has the right to eliminate any third party's use of the registered design or designs similar thereto.
- Injunction, damage compensation, confidence recovery or other relief may be demanded against infringers of the design right.

## Scope of Registered Design

### Article 24

- (1) The scope of a registered design shall be determined based upon the design stated in the application and depicted in the drawing or represented in the photograph, model or specimen attached to the application.
- (2) Whether a registered design is identical or similar to another design shall be determined based upon the aesthetic impression that the designs would create through the eyes of their consumers.

## Carabiner Case

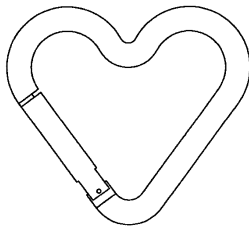
Registered Design No. 1156116

[Article to which the design applies]

Carabiner

[Description of the article to which the design applies]

The article to which the present design applies is used as a tool for mountain climbing and as a general tool. It is also used as a part for a key holder or key chain and other accessories

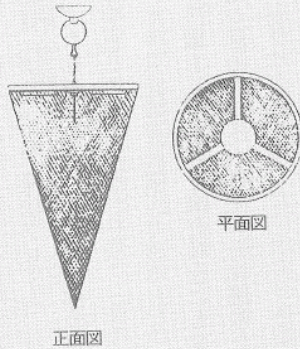


## Intellectual Property High Court Judgment, October 31, 2005

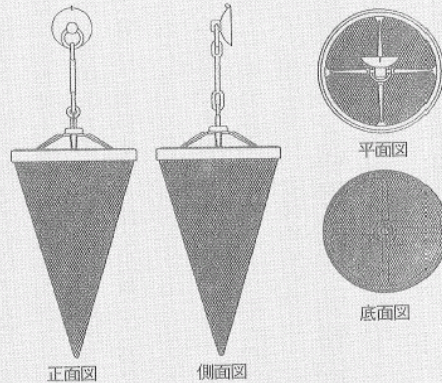
The range of articles to which a registered design applies should be defined by the classification of the article stated in the "Article to which the design applies" box; the description in the "Description of the article to which the design applies" box is provided to help the understanding of the article specified in the "Article to which the design applies" box. Therefore, the description related to the article in a design application should be defined by the classification of the article stated in the "Article to which the design applies" box, in principle; the classification of the article should not be influenced by the description in the "Description of the article to which the design applies" box.

## What is the similarity in design?

●本件意匠（昭和53年2月7日登録478216）



●被告意匠



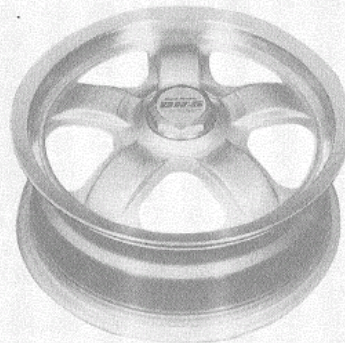
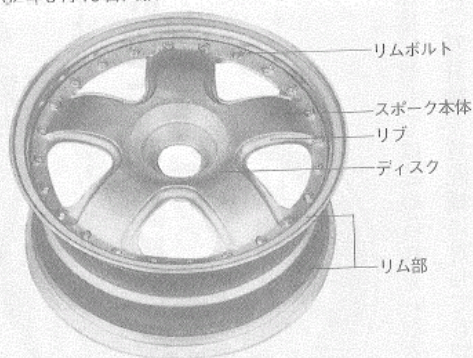
Article: Laundry lint catcher

Source: "Latest Design Disputes and Judgments," *Nikkei Design magazine*

## What is the similarity in design?

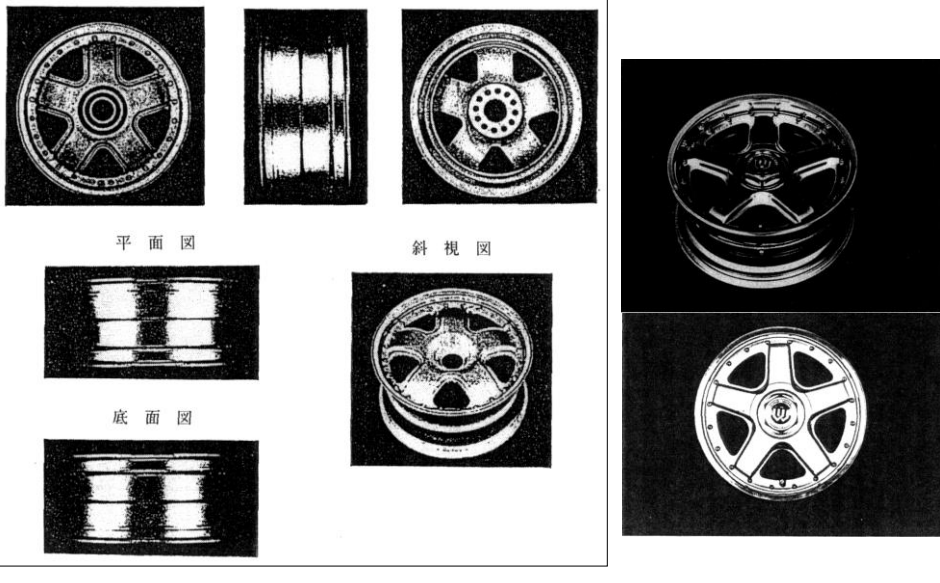
●本件意匠（意匠登録第761059号「自動車用ホイール」昭和62年9月16日出願、平成元年2月13日登録）

●イ号意匠（「自動車用ホイール」平成元年7月5日出願、平成3年12月27日拒絶査定）



Source: "Latest Design Disputes and Judgments," *Nikkei Design magazine*

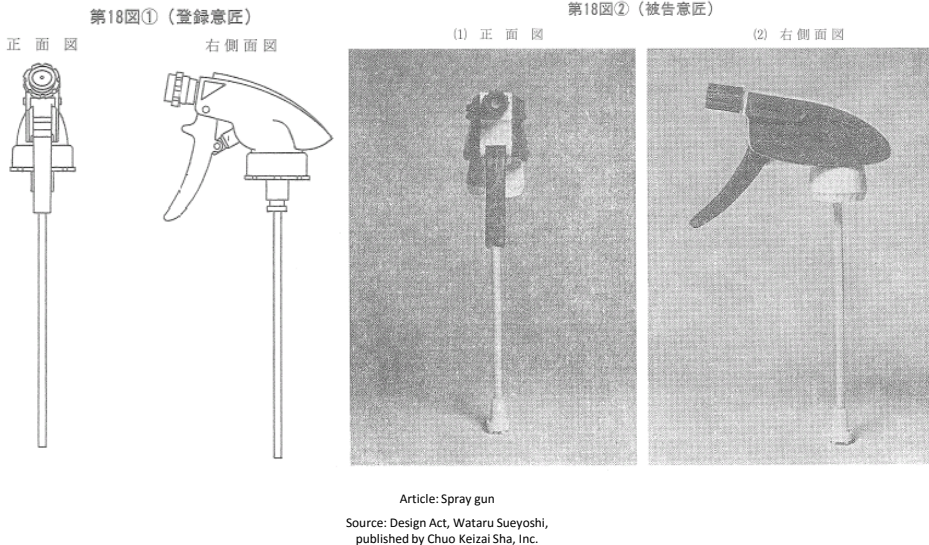
# Automobile Wheel Case



## Tokyo High Court Decision, September 8, 1992

In the present design, Alleged Infringing Design A and Alleged Infringing Product Design B, it is reasonable to consider that the form of the wheel appearing in the front side, especially the form of the front side of the disk excluding the center area most strongly attracts the attention of users. When examining the present design and Alleged Infringing Design A from this point of view, in the present design, the width of each spoke is same from its root to the end, the end of each spoke makes contact with the inner end of the front side perimeter wall of the disk, and the spokes form convex arcs in the longitudinal direction on the whole, which emphasizes the strength and the curve of the spokes; the form appearing in the front side of the disk gives a massive and solid impression. On the other hand, in the alleged infringing design, the spokes slightly taper off, the ends of the spokes extend to and contact virtually the center of the front perimeter wall of the disk, the spokes form convex arcs in the longitudinal direction about one fifth of the distance from the end of the spokes to the inner end of the front perimeter wall of the disk, and the remaining part of the spoke is straight and slopes down mildly, which emphasizes the lack of constraint and flatness of the spokes; thus, the form appearing in the front side of the disk gives a light and flat impression. These differences in the major component are distinctive and outweigh the above-mentioned common points of the two designs when observed in their entirety. These differences give unique and different aesthetic impressions to the two designs.

# Spray Gun Case



## Tokyo High Court Judgment, April 2, 1975

..... In the design of a spray gun, the main part can show a distinctive form, and at the same time, the main part of the present design and the main part of the disputed design obviously have quite different characteristics.

Accordingly, although the basic constituents of the present design and the disputed design have similarity because they are both in the form of a pistol which is a common design for spray guns, when they are observed comprehensively in their entirety, it cannot be said that they are similar to each other.

## Similarity Judgment in Recent Court Judgments

- Based on the identification of major components

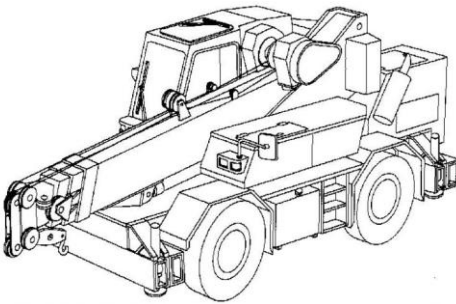
Possibility of confusion



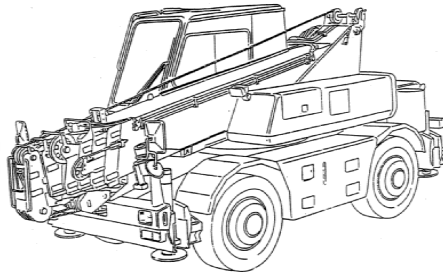
Commonality in overall aesthetic impression

## Rough Terrain Crane Case

Registered design



Defendant's product



## Recent Court Judgment

Charge in Rough Terrain Crane Case (Tokyo High Court Judgment, June 18, 1998)

"To judge the similarity between two designs, it is necessary to observe the designs in their entirety. In so doing, the nature, purpose and use mode of the article to which the design applies, the existence of any novel creative part which has not been found in publicly known designs, and other factors should be taken into account, and the part that will most strongly attract the attention of traders and users must be identified as the major component of each design, to observe whether or not the registered design and a design of another party have common constituents in their major components.

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The present design and Alleged Infringing Design A have common constituents as identified in 1. above, and Alleged Infringing Design A has the major component of the present design as identified in 4. above. When observing the two designs comprehensively in their entirety, they give a common aesthetic impression to persons who observe them, and thus, Alleged Infringing Design A is similar to the present design.

The present design and Alleged Infringing Design A have a difference in the components as defined in 2. above; however, these are differences that are not related to the major component of the present design, or they are differences in minor parts. Thus, they do not outweigh the above-mentioned common aesthetic impression or give unique and different aesthetic impressions.

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## Topics

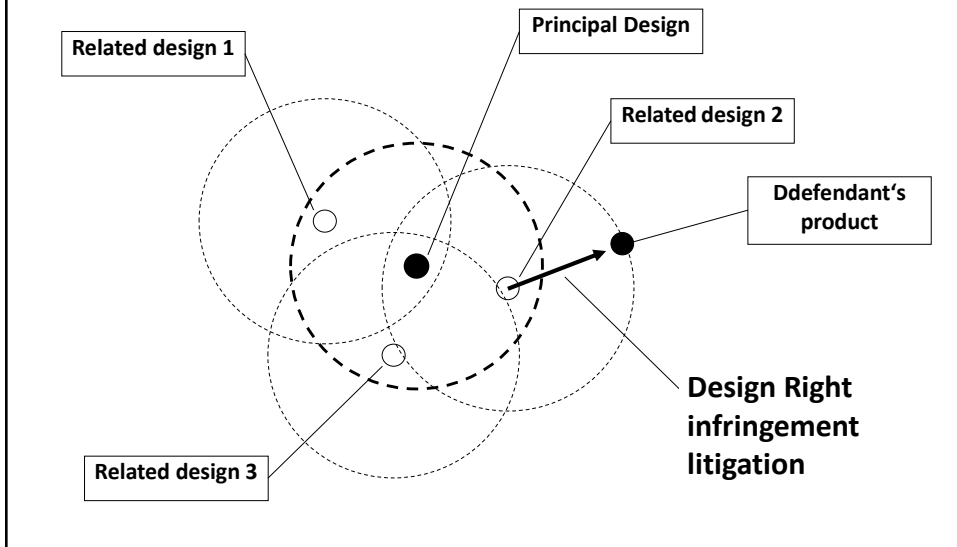
1. Scope of Protection and Registration Requirements
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## Related Designs

### Outline of the System

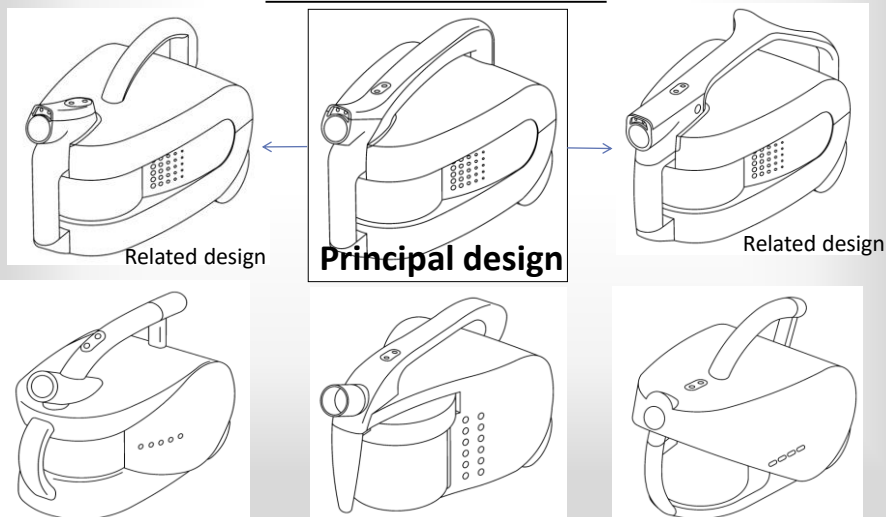
- If more than one similar design is created at the same time, one of them can be registered as the **Principal Design** and others may be registered as **Related Designs** (exception to the first-to-file principle).
- Related designs may be registered if applications for them are filed before the publication of the registration of the principal design.

## Concept of the Related Design System



## Toshiba's Application Strategy

### Product in the Market



## Partial Design/ Design Containing a Graphic Image

(Definition)

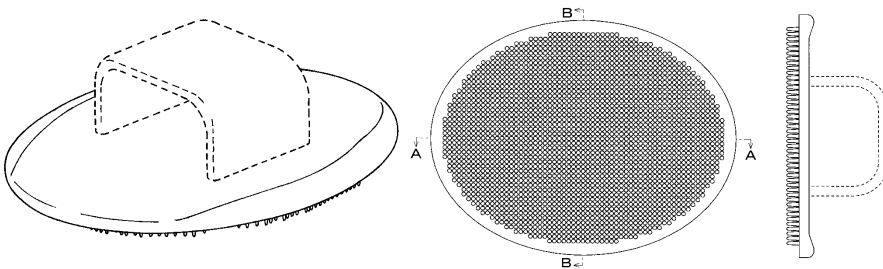
### Article 2

1 "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article; the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(2) The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in a graphic image on a screen that is provided for use in the operation of the article (limited to operations carried out in order to enable the article to perform its functions) and is displayed on the article itself or another article that is used with the article in an integrated manner.

## Definition of Partial Design and Expression

Shapes, patterns or colors of a part of an article or combination thereof



## Products in the Market

スティック  
サイクロン

本体を大切に  
紙パックを使わない  
サイクロン式



-S (ホワイトシルバー)



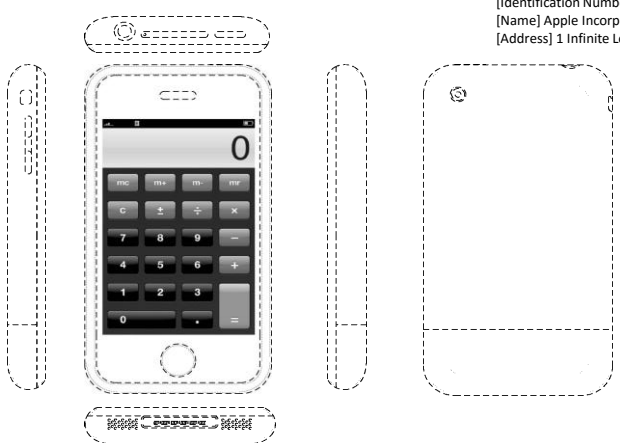
-G (キウイグリーン)



-D (マンゴーオレンジ)  
(伸縮パイプ伸長時)

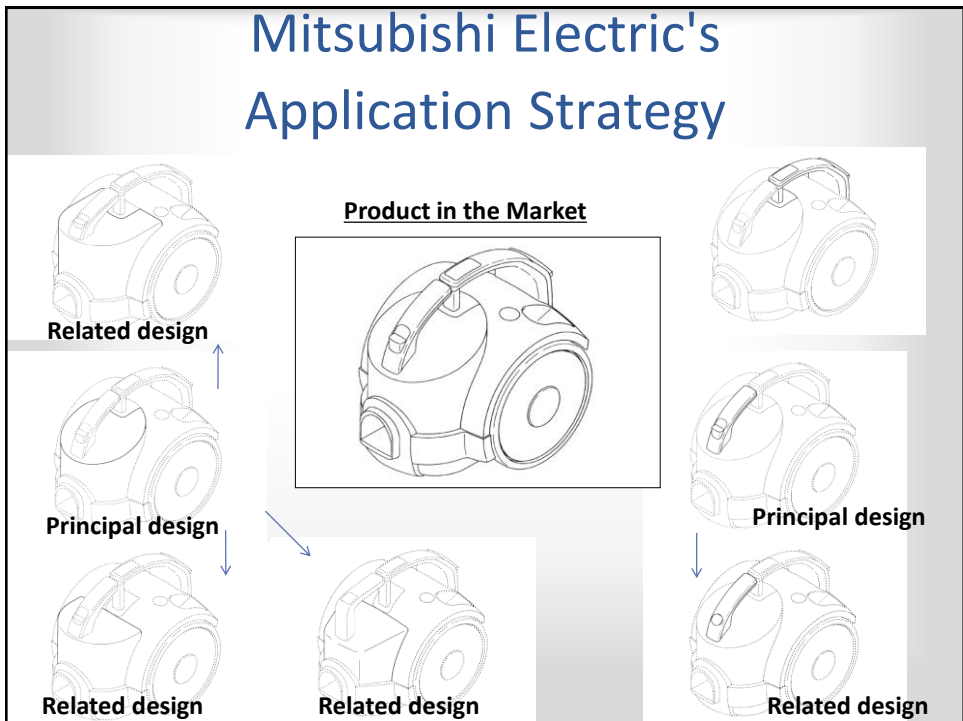
## 5 Registered Designs



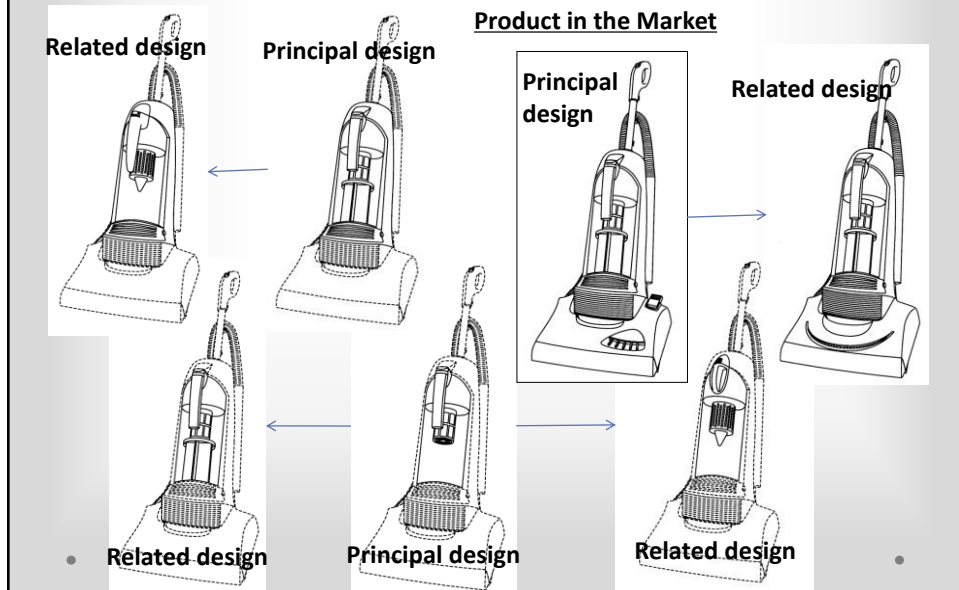


(19)[Issuing Country] Japan, Patent Office (JP)  
 (45) [Issue Date] February 7, 2011  
 (12)[Bulletin Type] Design Bulletin (S)  
 (11) [Registration Number] Design Registration No.1406751 (D1406751)  
 (24) [Registration Date] January 7, 2011  
 (54) [Applicable Items] Mobile information terminals  
**[Partial Design]**  
 (52) [Design Classification] H7-725W  
 (51) [International Design Classification (for reference)] 14-02, 14-03  
 [Term] H7-725AA, H7-725D, H7-725G  
 (21)[Application Number] Design Application 2009-27451 (D2009-27451)  
 (22) [Application Date] September 3, 2008  
 (62) [Presentation of Division] Design Application 2008-22735 (D2008-22735)  
 (73) [Design Right Owner]  
 [Identification Number] 503260918  
 [Name] Apple Incorporated  
 [Address] 1 Infinite Loop Cupertino, CA 95014, United States of America

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## Sharp's Application Strategy



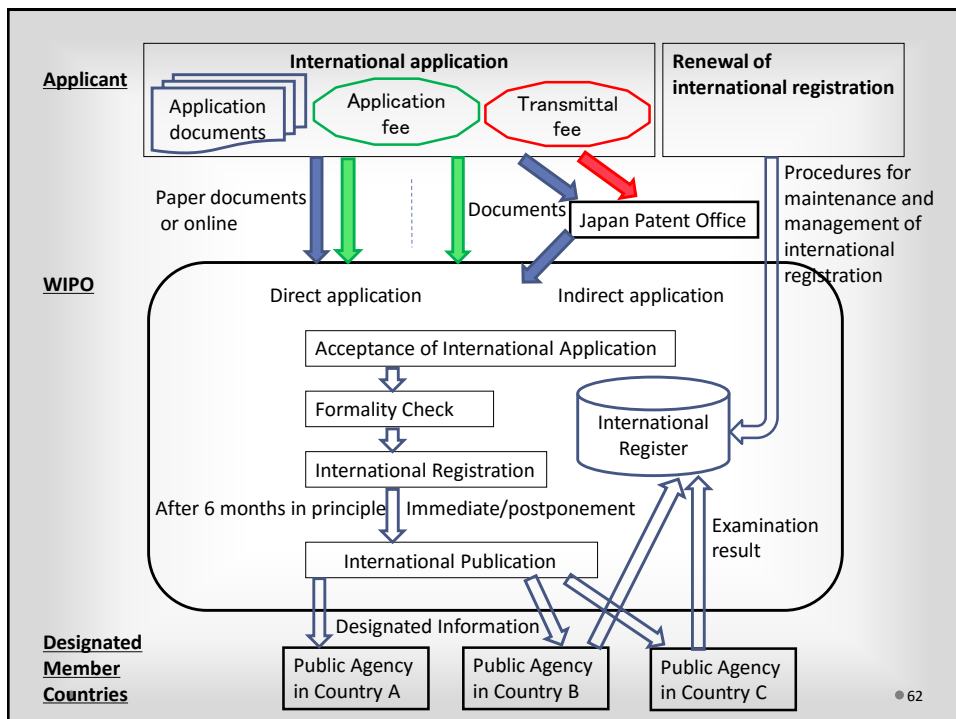
## Secret Design

### Outline of the System

- The details of a registered design may be kept secret for up to three years from its registration.
- The intention to keep a secret should be expressed at the time of application or payment of the registration fee.
- The secret period may be set in monthly units. The set period may be extended or reduced within a maximum period of three years.
- Presumption of negligence cannot be applied to infringements.
- Injunction can be claimed only after the details of the registered design are disclosed.

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## International application

- File application documents directly with the WIPO International Bureau (direct application) or via the Japan Patent Office (indirect application).
- A single set of application documents can be filed
  - (a) for applications in more than one country (designated member countries); and
  - (b) for up to 100 designs.
- Application procedures in a single language chosen by the applicant (English, French or Spanish).
- Lump sum payment of fees in a single currency (Swiss Francs) (or payment to the Japan Patent Office in Japanese currency in the case of indirect application).
- Appointment of an attorney is optional.

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## International Registration

- International registration has the same effect as regular application in each designated member country (fees are transmitted to each designated member country).
- The effective period of international registration is five years (renewable repeatedly in units of five years).
- The shortest protection period in designated member countries is 15 years from the date of international registration.
- Procedures for maintenance and management of the international registration (renewal of registration, change, disclaimer of or limitation in the ownership of the design right, change in the name or address of the international registrant) are also controlled centrally by the WIPO International Bureau.



## Protection in Designated Member Countries

- By international publication, the details of the international registration of a design at a specific time are identified.
- The design right will arise in each designated country
  - (a) within 6 or 12 months from the international publication  
(each designated member country may refuse the effect of protection based on its local legal requirements in force).
  - (b) The 12-month period applies only to a country where the novelty of the design is examined.
- If the protection is refused in a designated member country, the same remedies as applied to regular applications in that country are available (such designated member country may subsequently withdraw the refusal).