

# Design Act

(Act No. 125 of April 13, 1959)

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## Chapter I General Provisions

(Purpose)

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

(Definition)

Article 2 (1) "Design" in this Act means the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same applies 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 includes those in a graphic image on a screen that is provided for use in the operation of the article (limited to the 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 relevant article in an integrated manner.

- (3) "Working" of a design in this Act means the manufacturing, using, assigning, leasing, exporting or importing, or offering for assignment or lease (including displaying for the purpose of assignment or lease, the same applies hereinafter) of an article to the design.
- (4) "Registered design" in this Act means a design for which a design registration has been granted.

## **Chapter II Design Registrations and Applications for Design Registration**

(Conditions for Design Registration)

Article 3 (1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the design, except for the following:

- (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.
- (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 may not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

Article 3-2 Where a design in an application for design registration is identical with or similar to part of a design described in the statement in the application and drawing, photograph, model or specimen attached to the application of another application for design registration which has been filed prior to the date of filing of the application and published after the filing of the application in the design gazette pursuant to Article 20, paragraph (3) or Article 66, paragraph (3) (hereinafter referred to in this Article as the "earlier application"), a design registration may not be granted for such a design, notwithstanding paragraph (1) of the preceding Article; provided, however, that this does not apply where the applicant of the application and the applicant of the earlier application are the same person and the application was filed before the date when the design gazette in which the earlier application was published pursuant to Article 20, paragraph (3) (except for a

design gazette in which the matters listed in Article 20, paragraph (3), item (iv) were published pursuant to Article 20, paragraph (4)) was issued.

(Exception to lack of novelty of design)

Article 4 (1) In the case of a design which has fallen under item (i) or (ii) of Article 3 , paragraph (1) against the will of the person having the right to obtain a design registration, such a design is deemed not to have fallen under item (i) or (ii) of Article 3, paragraph (1) for the purposes of Article 3, paragraphs (1) and (2) for any design in an application for design registration which has been filed by the person within six months from the date on which the design first fell under either of those items.

(2) In the case of a design which has fallen under item (i) or (ii) of Article 3, paragraph (1) as a result of an act of the person having the right to obtain a design registration (excluding those which have fallen under item (i) or (ii) of Article 3, paragraph (1) by being published in a gazette relating to an invention, utility model, design or trademark), the preceding paragraph also applies for the purposes of Article 3, paragraphs (1) and (2) to any design in an application for design registration which has been filed by the person within six months from the date on which the design first fell under either of those items.

(3) Any person seeking the application of the preceding paragraph must submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration, a document stating that the person is seeking the application and, within thirty days from the date of filing of the application for design registration, a document proving the fact that the design which has otherwise fallen under Article 3, paragraph (1), item (i) or (ii) is a design to which the preceding paragraph (referred to as a "certificate" in the following paragraph) may be applicable.

(4) Notwithstanding the preceding paragraph, where the person is unable to submit the certificate within the time limit as provided in the paragraph, due to cause not attributable to the person,, the person may submit to the Commissioner of the Patent Office the certificate within 14 days (where overseas resident, within two months) from the date on which the cause ceased to be applicable, but not later than six months following the expiration of the time limit.

(Unregistrable designs)

Article 5 Notwithstanding Article 3, the following designs may not be registered.

(i) a design that has a risk to impair public policy;

(ii) a design which has a risk of creating confusion with an article pertaining to another person's business; or

(iii) a design solely consisting of a shape that is indispensable for retaining functions of the article.

(Provisional non-exclusive license)

Article 5-2 (1) A person who has the right to obtain a design registration may grant a provisional non-exclusive license of the design right to be obtained based on the right to obtain a design registration to a third person within the scope of a design stated in the application for design registration and depicted in the drawing, or represented in the photograph, model or specimen attached to the application or a design similar thereto.

(2) Where a design right has been registered for its establishment with regard to the application for design registration pertaining to the provisional non-exclusive license under the preceding paragraph, a non-exclusive license is deemed to have been granted with regard to the design right to a person who has the provisional non-exclusive license to the extent permitted by the contract granting the provisional non-exclusive license.

(3) The provisions of Article 33, paragraphs (2) and (3), Article 34-3, paragraphs (4), (6), (8) through (10) and Article 34-5 of the Patent Act (Act No.121 of 1959) apply mutatis mutandis to a provisional non-exclusive license. In this case, the term "Article 46, paragraph (1)" in Article 34-3, paragraph (8) of the Patent Act is deemed to be replaced with "Article 13, paragraph (2) of the Design Act," the term "Article 46, paragraph (2) of the Patent Act with regard to an application for design registration pertaining to a provisional non-exclusive license under Article 5-2, paragraph (1) of the Design Act (Act No.125 of 1959)" in Article 34-3, paragraph (9) of the Patent Act is deemed to be replaced with "Article 13, paragraph (1) of the Design Act with regard to a patent application pertaining to a provisional non-exclusive license under paragraph (1) or (4) of the preceding Article."

Article 6 (1) A person requesting a design registration must 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 of the design.

(2) Where so provided by an Order of the Ministry of Economy, Trade and Industry, the applicant may submit photograph, model or specimen representing the design for which the registration is requested, in lieu of the drawing in the preceding paragraph. In this case, the applicant must indicate in the application which among photograph, model and specimen is submitted.

- (3) When neither the statement of the article subject to the design required under paragraph (1), item (iii), nor the drawing, photograph or model attached to the application would enable a person ordinarily skilled in the art to which the design pertains to understand the material or size of the article, and by this reason such a person would not be able to recognize the design, the material or size of the article to the design must be specified in the application.
- (4) Where the shape, patterns or colors of the article subject to the design is changeable based on the function possessed by the article, if the applicant intends to request a design registration of the shapes, patterns or colors, or a combination thereof as it appears before, during and after the change, the applicant must state such an intention and include an explanation of the relevant function of the article in the application.
- (5) Where colors of the design are applied to the drawing, photograph or model to be submitted pursuant to paragraph (1) or (2), the applicant may omit the application of colors to either black or white.
- (6) When the applicant omits to apply color to either black or white pursuant to the preceding paragraph, the applicant must state thereof in the application.
- (7) Where the applicant submits the drawing depicting the design pursuant to paragraph (1) or the photograph or model representing the design pursuant to paragraph (2), if the whole or part of the article to the design is transparent, the applicant must state thereof in the application.

(One application per design)

Article 7 An application for design registration must be filed for each design in accordance with a classification of articles as provided by an Order of the Ministry of Economy, Trade and Industry.

(Design for a set of articles)

Article 8 Where two or more articles are used together and are specifically designated by an Order of the Ministry of Economy, Trade and Industry (hereinafter referred to as a "Set Articles") if the Set Articles is coordinated as a whole, an application for design registration may be filed as one design.

(Prior application)

Article 9 (1) Where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration on the earliest date may be entitled to obtain a design registration for the design.

(2) Where two or more applications for design registration have been filed for identical or similar designs on the same day, only one applicant, who was selected by consultations between the applicants who filed the applications, is

entitled to obtain a design registration for the design. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants is entitled to obtain a design registration for the design.

- (3) Where an application for design registration has been waived, withdrawn or dismissed, or where the examiner's decision or appeal and trial decision to the effect that an application for design registration is to be refused has become final and binding, the application for design registration, for the purpose of the preceding two paragraphs, is deemed never to have been filed; provided, however, that this does not apply to the case where the examiner's decision or appeal and trial decision to the effect that the application for design registration is to be refused has become final and binding on the basis that the latter sentence of the preceding paragraph is applicable to that application for design registration.
- (4) In the case of paragraph (2), the Commissioner of the Patent Office must order the applicants to hold consultations as specified under paragraph (2) and to report the result thereof, designating an adequate time limit.
- (5) Where no report under the preceding paragraph is submitted within the time limit designated pursuant to that paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) has been reached.

(Amendment of statement in the application or the drawing and change of gist)

Article 9-2 Where, after the registration establishing a design right, it is found that an amendment made to any statement in the application (excluding the statements listed in items (i) and (ii) of Article 6, paragraph (1) and the statement made pursuant to Article 6, paragraph (2), the same applies to Article 17-2, paragraph (1) and Article 24, paragraph (1)) or to the drawing, photograph model or specimen attached to the application has changed the gist thereof, the application for design registration is deemed to have been filed at the time of submission of the written amendment of proceedings therefor.

(Related designs)

Article 10 (1) Notwithstanding Article 9, paragraph (1) or (2), an applicant for design registration may obtain design registration of a design that is similar to another design selected from the applicant's own designs either for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the "Principal Design" and a design similar to it is referred to as a "Related Design"), if the filing date of the application for design registration of the Related Design (or when the application for design registration of the Related Design contains a priority claim under Article 43, paragraph (1), 43-3, paragraph (1) or 43-3, paragraph (2) of the Patent Act as applied mutatis

mutandis under Article 15 of this Act, the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application pursuant to Article 4.C (4) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, or the filing date of an application that is recognized as the earliest application pursuant to Article 4. A (2) of the Paris Convention, hereinafter the same applies in this paragraph) is on or after the filing date of the application for design registration of the Principal Design and before the date when the design gazette in which the application for design registration of the Principal Design is published pursuant to Article 20, paragraph (3) (except for a design gazette in which the matters listed in Article 20 , paragraph (3), item (iv) were published pursuant to Article 20, paragraph (4)) is issued.

- (2) Where an exclusive license has been established for the design right of the Principal Design, a design registration may not be granted to its Related Designs, notwithstanding the preceding paragraph.
- (3) A design registration may not be granted to a design that is similar only to a Related Design to be registered pursuant to paragraph (1).
- (4) Where applications for design registration are filed for two or more Related Designs pertaining to the Principal Design, the provisions of Article 9 paragraph (1) or (2) do not apply to these Related Designs.

(Division of applications for design registration)

Article 10-2 (1) An applicant for design registration may extract one or more new applications for design registration out of a single application for design registration containing two or more designs only while examination, appeal and trial or retrial of the application for design registration is pending.

- (2) Where an application for design registration is divided under the preceding paragraph, the new application for design registration is deemed to have been filed at the time of the filing of the original application; provided, however, that this does not apply for the purposes of applications of Article 4, paragraph (3) of this Act and Articles 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis under Article 15 of this Act (including the cases where they are applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act).
- (3) Where a new application for design registration is filed under paragraph (1), any statements or documents which have been submitted in relation to the original application for design registration and are required to be submitted in relation to the new application under Article 4, paragraph (3) of this Act and

Articles 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15 of this Act (including the cases where they are applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act) are deemed to have been submitted to the Commissioner of the Patent Office along with the new application for design registration.

Article 11 Deleted

Article 12 Deleted

(Conversion of application)

Article 13 (1) An applicant of a patent may convert the patent application into an application for design registration; provided, however, that this does not apply after the expiration of three months from the date the certified copy of the examiner's initial decision to the effect that the patent application is to be refused has been served.

(2) An applicant of a utility model registration may convert the application for a utility model registration into an application for design registration

(3) Where the period provided in Article 121, paragraph (1) of the Patent Act is extended pursuant to Article 4 of the Act, the period provided in the proviso to paragraph (1) is deemed to have been extended only for that period so extended.

(4) Where an application is converted under paragraph (1) or (2), the original application is deemed to have been withdrawn.

(5) When there is a person who has a provisional exclusive license on a patent application, an applicant of the patent may convert the patent application pursuant to paragraph (1) only in the case where the consent of the person is obtained.

(6) The provisions of Articles 10-2, paragraphs (2) and (3) apply mutatis mutandis to the case of conversion of an application under paragraph (1) or (2).

(Special provisions on conversion of application concerning international applications under the Patent Cooperation Treaty)

Article 13-2 (1) An international application that has been deemed to be a patent application pursuant to Article 184-3, paragraph (1) or 184-20, paragraph (4) of the Patent Act may be converted to an application for design registration, only after the fees payable pursuant to Article 195, paragraph (2) of the Act have been paid (or, in the case of an international application that is deemed to be a patent application pursuant to Article 184-20, paragraph (4) of the Act, after the ruling as provided in 184-20, paragraph (4) has been rendered), and, in the case of a Patent Application in Japanese Language under Article 184-6,

paragraph (2) of the Act, the procedures under Article 184-5, paragraph (1) of the Act have been completed, or, in the case of a Patent Application in Foreign Language under Article 184-4, paragraph (1) of the Act, the procedures under Articles 184-4, paragraph (1) or (4) and 184-5, paragraph (1) of the Act have been completed.

- (2) An international application that has been deemed to be an application for utility model registration under Article 48-3, paragraph (1) or 48-16, paragraph (4) of the Utility Model Act (Act No. 123 of 1959) may be converted to an application for design registration, only after the fees payable under Article 54, paragraph (2) of the Act have been paid (or, in the case of an international application that is deemed to be an application for utility model registration under Article 48-16, paragraph (4) of the Act, after the ruling as provided in Article 48-16, paragraph (4) has been given), and, in the case of a Utility Model Application in Japanese under Article 48-5, paragraph (4) of the Act, the procedures under Article 48-5, paragraph (1) of the Act have been completed, or, in the case of a Utility Model Application in Foreign Language under 48-4, paragraph (1) of the Act, the procedures under Articles 48-4, paragraph (1) or (4) and 48-5, paragraph (1) of the Act have been completed.

(Secret design)

- Article 14 (1) An applicant for design registration may request that the design be kept in secret for a period designated in the request of no more than three years from the date of the registration establishing the design right.
- (2) A person filing a request under the preceding paragraph must submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration or payment of registration fee for the first year under Article 42, paragraph (1), a document stating the following:
- (i) the name and domicile or residence of the applicant for design registration;
  - and
  - (ii) the period for which the secrecy is requested.
- (3) The applicant for design registration or the holder of design right may request extension or reduction of the period for which the secrecy is requested pursuant to paragraph (1).
- (4) The Commissioner of the Patent Office must disclose the design for which the secrecy is requested under paragraph (1) to persons other than the holder of the design right, when:
- (i) consent of the holder of the design right to do so has been obtained;
  - (ii) so requested by a party or an intervenor of examination, appeal and trial, retrial or litigation relating to the design or a design identical with or similar to the design;
  - (iii) so requested by a court; or

(iv) so requested by an interested person who has submitted a document stating the name of the holder of the design right and the registration number and other documents required by an Order of the Ministry of Economy, Trade and Industry to the Commissioner of the Patent Office.

(Application mutatis mutandis of provisions of the Patent Act)

Article 15 (1) The provisions of Articles 38 (Joint Applications), 43, paragraphs (1) through (4), (8) and (9) ( Priority Claim Procedures under the Paris Convention) and Article 43-3 (Priority Claims as under the Paris Convention) of the Patent Act apply mutatis mutandis to applications for design registration. In this case, the term "within the time limit provided by Order of Ministry of the Economy, Trade and Industry" in Article 43, paragraph (1) of the Act is deemed to be replaced with "at the time of filing of the application for design registration", the term "within one year and four months from the earliest of the following dates" in Article 43, paragraph (2) is deemed to be replaced with "within three months from the date of filing of the application for design registration", the terms "a person who have received a notice under paragraph (6)" and "the preceding paragraph" in Article 43, paragraph (8) are deemed to be replaced with "a person who submits documents under paragraph (2)" and "the paragraph", respectively, and the term "the preceding two articles" in Article 43-3, paragraph (3) of the Act is deemed to be replaced with "Article 43".

(2) The provisions of Article 33 and Article 34, paragraphs (1), (2) and (4) through (7) of the Patent Act (right to obtain patent) apply mutatis mutandis to the right to obtain the design registration.

(3) The provisions of Article 35 (excluding except the part pertaining to a provisional exclusive license) (inventions by employees) of the Patent Act apply mutatis mutandis to creation of a design by an employee, an officer of a corporation, or a national or local government employee.

### **Chapter III Examination**

(Examination by examiner)

Article 16 The Commissioner of the Patent Office must have an examiner examine applications for design registration.

(Examiner's decision of refusal)

Article 17 The examiner must render a decision to reject the application for design registration where the application for design registration falls under any of the following:

(i) the design in the application for design registration is not registrable

- pursuant to Articles 3, 3-2, 5, 8, 9, paragraph (1) or (2), and 10, paragraphs (1) through (3) of this Act, Article 38 of the Patent Act as applied under Article 15, paragraph (1) of this Act, or Article 25 of the Patent Act as applied under Article 68, paragraph (3) of this Act;
- (ii) the design in the application for design registration is not registrable pursuant to the provisions of any relevant treaty;
  - (iii) the application for design registration does not comply with the requirements under Article 7; and
  - (iv) where an applicant of a design registration does not have the right to obtain a design registration on the design for the design.

(Dismissal of amendments)

Article 17-2 (1) Where an amendment made to any statement in the application, or to the drawing, photograph, model or specimen attached to the application has changed the gist thereof, the examiner must dismiss the amendment by a ruling.

- (2) The ruling dismissing an amendment under the preceding paragraph must be made in writing and state the reasons therefor.
- (3) Where the ruling dismissing an amendment under the preceding paragraph (1) has been rendered, the examiner must not render a decision on the application for design registration before the expiration of three months from the date on which a certified copy of the ruling has been served.
- (4) Where an applicant for design registration files a request for appeal against an examiner's ruling dismissing an amendment under paragraph (1), examination of the application for design registration must be suspended until the appeal and trial decision becomes final and binding.

(New application for amended design)

Article 17-3 (1) Where an applicant for design registration files a new application for design registration for the amended design within three months from the date on which a certified copy of the ruling dismissing an amendment under paragraph (1) of the preceding Article has been served, the new application is deemed to have been filed at the time when the written amendment of proceedings for the amendment was submitted.

- (2) Where a new application for design registration is filed under the preceding paragraph, the original application for design registration is deemed to have been withdrawn.
- (3) The provisions of the preceding two paragraphs apply only when the applicant for design registration has submitted to the Commissioner of the Patent Office, at the time of the filing of a new application, a document stating a request for the application of paragraph (1) to the new application for design registration

under paragraph (1).

Article 17-4 (1) The Commissioner of the Patent Office may, upon request or ex officio, extend the period provided for in paragraph (1) of the preceding Article for a person in a remote area or an area with transportation difficulty.

(2) The chief administrative judge may, upon request or ex officio, extend the period provided for in paragraph (1) of the preceding Article as applied mutatis mutandis under Article 50, paragraph (1) (including its application under Article 57, paragraph (1)) for a person in a remote area or an area with transportation difficulty.

(Examination of a design registration)

Article 18 Where no reason for refusal is found for an application for design registration, the examiner must give a decision to the effect that a design registration is to be granted.

(Application mutatis mutandis of provisions of the Patent Act)

Article 19 The provisions of Article 47, paragraph (2) (Qualifications of Examiners), Articles 48 (Exclusion of Examiners), 50 (Notice of Grounds for Rejection), 52 (Formal Requirements for Examiner's Decision) and 54 (In Relation to Litigation) of the Patent Act apply mutatis mutandis to examination of applications of design registration.

## **Chapter IV Design Right**

### **Section 1 Design Rights**

(Registration of establishment of a design right)

Article 20 (1) A design right becomes effective upon registration of its establishment.

(2) The establishment of a design right is registered where the registration fee for the first year under Article 42, paragraph (1) has been paid.

(3) Where the registration under the preceding paragraph has been effected, the following matters must be published in the design gazette:

(i) the name, and the domicile or residence of the holder of the design right;

(ii) the number and the filing date of the application for the design registration;

(iii) the registration number and the date of registration of establishment;

(iv) the contents of the application and drawing, photograph, model or specimen attached to the application; and

(v) other necessary matters.

(4) With regard to the design for which secrecy is requested under Article 14,

paragraph (1), notwithstanding the preceding paragraph, matters provided for in item (iv) of the preceding Article must be published without delay after the lapse of the period designated pursuant to Article 14, paragraph (1).

(Duration of design rights)

Article 21 (1) The duration of a design right (excluding design right of a Related Design) expires after a period of 20 years from the date of registration of its establishment.

(2) The duration of a Related Design expires after a period of 20 years from the date when the establishment of the design right of its Principal Design is registered.

(Transfer of the design right of a Related Design)

Article 22 (1) A design right of a Principal Design and that of its Related Design may not be transferred independently of each other.

(2) Where the design right of a Principal Design has been extinguished pursuant to Article 44, paragraph (4), appeal and trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, the design right of its Related Design thereof may not be transferred independently.

(Effect of design right)

Article 23 A holder of a design right has the exclusive right to work the registered design and designs similar thereto as a business; provided, however, that where an exclusive license regarding the design right is granted to a licensee, this does not apply to the extent that the exclusive licensee is licensed to exclusively work the registered design and designs similar thereto.

(Scope of registered design)

Article 24 (1) The scope of a registered design must 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 with or similar to another design must be determined based upon the aesthetic impression that the designs would create through the eye of their consumers.

Article 25 (1) A request may be made to the Japan Patent Office for its advisory opinion on the scope of a registered design and designs similar thereto.

(2) Where a request under the preceding paragraph is made, the Commissioner of the Patent Office must designate three administrative judges to make an advisory opinion on the requested matter.

(3) The provisions of Article 71, paragraphs (3) and (4) of the Patent Act apply mutatis mutandis to the advisory opinion under paragraph (1).

Article 25-2 (1) Where a Commissioner of the Patent Office is requested by a court to provide an expert opinion on the scope of a registered design and designs similar thereto, the Commissioner of the Patent Office must appoint three administrative judges and direct them to provide an expert opinion on the requested matter.

(2) The provisions of Article 71-2, paragraph (2) of the Patent Act apply mutatis mutandis to the request of an expert opinion prescribed in the preceding paragraph.

(Relationship to registered designs held by others)

Article 26 (1) Where a registered design uses another person's registered design, patented invention or registered utility model for which an application was filed prior to the date of filing of the application for the design, or a design similar to another person's registered design, or where part of a design right pertaining to the registered design is in conflict with another person's patent right, utility model right or trademark right obtained based on an application filed prior to the date of filing of the application for the registered design, or copyright which arose prior to the date of filing of the application for the registered design, the holder of the design right or exclusive licensee or non-exclusive licensees of the design right may not work the registered design as a business.

(2) Where a design similar to a registered design uses another person's registered design, patented invention or registered utility model for which an application was filed prior to the date of filing of the application for the design, or a design similar to another person's registered design, or where part of a design right pertaining to designs similar to the registered design is in conflict with another person's design right, patent right, utility model right or trademark right obtained based on an application filed prior to the date of filing of the application for the registered design, or copyright which arose prior to the date of filing of the application for the registered design, the holder of the design right or exclusive licensee or non-exclusive licensees of the design right may not work the similar design as a business.

(Special provisions for pertaining to transfer of a design right)

Article 26-2 (1) Where a design registration falls under the requirements provided for in Article 48, paragraph (1), item (i) (limited to cases where the design registration has been granted obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis in Article 15, paragraph (1)) or in

- Article 48, paragraph (1), item (iii), a person who has the right to obtain a design registration on the design pertaining to the design registration may, pursuant to the provision of an Order of the Ministry of Economy, Trade and Industry, request an owner the holder of the design right to transfer the design right as provided by an Order of the Ministry of Economy, Trade and Industry.
- (2) A request with regard to the design right of a Principal Design or a Related Design under the preceding paragraph may not be filed after any of the right of its Principal Design or its Related Design has been extinct, unless the extinct design right has been deemed never to have existed from the beginning pursuant to Article 49.
- (3) Where the transfer of a design right has been registered based on the request under paragraph (1), the design right is deemed to have belonged to a person who has obtained the registration from the beginning. The same applies to the right to claim on the design pertaining to the design right under Article 60-12 (1).
- (4) Where a share of a jointly owned design right is transferred based on the request under paragraph (1), the provisions of Article 73, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 36 of this Act do not apply.

(Exclusive license)

- Article 27 (1) A holder of a design right may grant an exclusive license on the design right; provided, however, an exclusive license on a design right of a Principal Design or exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Principal Design and its Related Designs are granted to the same person at the same time.
- (2) An exclusive licensee has an exclusive right to work the registered design or designs similar thereto as a business to the extent permitted by the contract granting the license.
- (3) Where the design right of a Principal Design is extinct pursuant to Article 44, paragraph (4), appeal and trial decision of invalidation of a design right of a Principal Design becomes final and binding, or the design right of a Principal Design has been waived, exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Related Designs are granted to the same person at the same time.
- (4) The provisions of Articles 77, paragraph (3) through (5) (Transfer), Article 97, paragraph (2) (Waiver) and Article 98, paragraph (1), item (ii) and paragraph (2) (Effect of Registration) of the Patent Act apply mutatis mutandis to exclusive licenses.

(Non-exclusive license)

Article 28 (1) A holder of a design right may grant a non-exclusive license on the design right to any third party.

(2) A non-exclusive licensee has a right to work the registered design or designs similar thereto as a business to the extent prescribed by this Act or permitted by the contract granting the license.

(3) The provisions of Article 73, paragraph (1) (Joint Ownership), Articles 97, paragraph (3) (Waiver) and 99 (Perfection of a Non-exclusive License) of the Patent Act apply mutatis mutandis to non-exclusive licenses.

(Non-exclusive license based on prior use)

Article 29 A person who, without knowledge of a design in an application for design registration, created a design identical or similar to the design, or a person who, without knowledge of a design in an application for design registration, learned of the design from a person who created a design identical or similar to the design, and has been working the design or a design similar thereto or preparing for the working of the design or a design similar thereto in Japan at the time of the filing of the application for design registration (where the application for design registration is deemed to have been filed at the time of submission of the written amendment of proceedings pursuant to Article 9-2 or Article 17-3, paragraph (1) (including the cases where it is applied mutatis mutandis pursuant to Article 50, paragraph (1) (including the cases where it is applied mutatis mutandis pursuant to Article 57, paragraph (1))), at the time of filing the original application or the written amendment of proceedings), has a non-exclusive license on the design right, only to the extent of the design and the purpose of the business worked or prepared.

(Non-exclusive license based on prior application)

Article 29-2 A person who, without knowledge of a design in an application for design registration, created a design identical or similar to the design, or a person who, without knowledge of a design in an application for design registration, learned the design from a person who created a design identical or similar to the design, and has been working the design or a design similar thereto or preparing for the working of the design or a design similar thereto in Japan at the time of the filing of the application for design registration (excluding a person falling under the preceding paragraph), has a non-exclusive license on the design right, only if both of the following conditions are satisfied and only to the extent of the design and the purpose of the business of the working or the business being prepared for the working:

(i) the person filed an application for design registration of the design in the application for design registration or design similar thereto prior to the date

of filing of the application, and has been working the design in the application or preparing for the working of the design in the application, and (ii) with regard to the application for design registration filed by the person as prescribed in the preceding item, an examiner's decision or appeal and trial decision to the effect that the application is to be refused on the ground that the design in the application falls under any of items of Article 3, paragraph (1) has become final and binding.

(Non-exclusive licenses on the ground of the working of the design prior to the before registration of transfer of a design right)

Article 29-3 (1) A person who had a design right, an exclusive license on the design right or a non-exclusive license on the design right or the exclusive license at the time of the registration of transfer of design right based on the request pursuant to Article 26-2, paragraph (1), and is doing a business consisting of working the design in Japan or is preparing the business, before the registration of transfer of the design right, without knowledge that the design registration falls under the requirements as provided in Article 48, paragraph (1), item (i) (limited to cases where the design registration has been obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis in Article 15, paragraph (1) of this Act) or Article 48, paragraph (1), item (iii), has a non-exclusive license on the design right only to the extent of the design and the purpose of the business of the working or the business being prepared for the working.

(2) A request with regard to the design right of a the Principal Design or a the Related Design under the preceding paragraph may not be filed after any of the right of its the Principal Design or its the Related Design has become extinct, unless the extinct design right has been deemed never to have existed from the beginning pursuant to Article 49.

(Non-exclusive license due to the working of the design prior to the registration of the request for invalidation trial)

Article 30 (1) A person falling under any of the following items, who is doing a business of working a design or a design similar thereto in Japan or preparing the business, before the registration of a request for invalidation trial of the design registration, without knowledge that the design registration falls under any of the items of Article 48, paragraph (1), has a non-exclusive license regarding the invalidated design right or the exclusive license existing at the time of the invalidation, only to the extent of the design and the purpose of the business worked or prepared:

(i) the original holder of a design right in the case where one of two or more design registrations granted for the same or similar design has been

- invalidated,
- (ii) the original holder of a design right in the case where, after a design registration has been invalidated, a design registration is granted to the person who is entitled to obtain a design registration for the same or similar design,
  - (iii) in the case referred to in items (i) and (ii), a person that, at the time of the registration of the request for invalidation trial of design registration, has an exclusive license regarding the design right pertaining to the design registration invalidated, or a non-exclusive license regarding the design right or an exclusive license on the design right
- (2) The holder of a design right or the exclusive licensee has a right to receive reasonable consideration from the non-exclusive licensee pursuant to the preceding paragraph.

(Non-exclusive license after expiration of duration of design right)

Article 31 (1) Where part of a design right that pertains to designs similar to the registered design with regard to an application for a design registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application, the original holder of design right, upon expiration of the duration of the design right, has a non-exclusive license on the design right or on the exclusive license actually existing at the time of expiration of the duration of the design right, limited to the extent of the original design right.

- (2) The provisions of preceding paragraph apply mutatis mutandis to the case where a patent right or utility model right with regard to an application for registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application upon expiration of the duration of the patent right or utility model right.

Article 32 (1) Where part of a design right that pertains to designs similar to the registered design with regard to an application for a design registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application, a person who, at the time of expiration of the duration of the design right, actually owns the exclusive license on the expired design right, or a non-exclusive license on the design right or on the exclusive license, upon expiration of the duration of the design right, has a non-exclusive license on the design right or on the exclusive license actually existing at the time of expiration of the duration of the design right, limited to the extent of the original right.

- (2) The provisions of preceding paragraph apply mutatis mutandis to the case where a patent right or utility model right with regard to an application for

registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application upon expiration of the duration of the patent right or utility model right.

- (3) The holder of a design right or the exclusive licensee has a right to receive reasonable consideration from the non-exclusive licensee pursuant to the preceding two paragraphs.

(Award granting non-exclusive license)

Article 33 (1) Where a registered design or a design similar thereto falls under any of the cases as provided in Article 26, the holder or exclusive licensee of the design right may request the other person under the Article to discuss granting a non-exclusive license to work the registered design or a design similar thereto or a non-exclusive license on the patent right or the utility model right.

- (2) The other person under Article 26 who is requested to discuss under the preceding paragraph may request the holder of design right or exclusive licensee requesting the discussion to discuss granting a non-exclusive license to the extent of the registered design or a design similar thereto that the holder of design right or exclusive licensee intends to work with a non-exclusive license on the design right, on the patent right or on the utility model right granted through consultations

- (3) Where no agreement is reached by the discussion or it is not possible to discuss as provided in paragraph (1), the holder of design right or the exclusive licensee may request the Commissioner of the Patent Office for an award.

- (4) Where no agreement is reached by consultations or no consultations are able to be held as provided in paragraph (2) and where a request for an award is filed under the preceding paragraph, the other person under Article 26 may request the Commissioner of the Patent Office for an award only within the time limit for the submission of a written answer by that other person designated by the Commissioner of the Patent Office pursuant to Article 84 of the Patent Act as applied *mutatis mutandis* under paragraph (7) .

- (5) In the case of paragraph (3) or (4), the Commissioner of the Patent Office may not render an award to the effect that a non-exclusive license is to be granted where the granting of the non-exclusive license will be unreasonably prejudicial to the interests of the other person under Article 26, the holder of design right or the exclusive licensee.

- (6) In the case of paragraph (4), beyond the case provided for in the preceding paragraph, the Commissioner of the Patent Office may not render an award ordering a non-exclusive license to be granted if an award ordering a non-exclusive license to be granted is not rendered with respect to the request for an award under paragraph (3).

(7) The provisions of Articles 84, 84-2, 85, paragraph (1) and 86 through 91-2 (Procedures for Award) of the Patent Act apply mutatis mutandis to the award under paragraph (3) or (4).

(Transfer of non-exclusive license)

Article 34 (1) Except for a non-exclusive license granted by an award under paragraph (3) or (4) of the preceding Article, Article 92, paragraph (3) of the Patent Act or Article 22, paragraph (3) of the Utility Model Act, a non-exclusive license may be transferred only where the business involving the working of the relevant design is also transferred, where the consent of the holder of a design right (or, in the case of a non-exclusive license on the exclusive license, the holder of a design right and the exclusive licensee) is obtained and where the transfer occurs as a result of general succession including inheritance.

(2) Except for a non-exclusive license granted by an award under paragraph (3) or (4) of the preceding Article, Article 92, paragraph (3) of the Patent Act or Article 22, paragraph (3) of the Utility Model Act, a non-exclusive licensee may establish a right of pledge on the non-exclusive right only where the consent of the holder of a design right (or, in the case of a non-exclusive license on the exclusive license, the holder of a design right and the exclusive licensee) is obtained.

(3) Where a non-exclusive license is granted by an award under paragraph (3) of the preceding Article, Article 92, paragraph (3) of the Patent Act or Article 22, paragraph (3) of the Utility Model Act, the non-exclusive license is transferred together with the design right, patent right or utility model right of the non-exclusive licensee on which the non-exclusive license is granted and the business involving the working of the relevant design in the case where each right is transferred together with the business, and cease to exist in the case where each right of the non-exclusive licensee is extinguished or transferred independently of the business.

(4) A non-exclusive license granted by an award under paragraph (4) of the preceding Article is transferred together with the design right, patent right or utility model right of the non-exclusive licensee on which the non-exclusive license is granted, and ceases to exist in the case where the design right, patent right or utility model right ceases to exist.

(Right of pledge)

Article 35 (1) Unless otherwise agreed by contract, where a right of pledge is established on a design right, exclusive license or non-exclusive license, the pledge may not work the registered design or design similar thereto.

(2) The provisions of Article 96 (extension of a right of pledge to the proceeds of

the patent right) of the Patent Act apply mutatis mutandis to a right of pledge established on a design right, exclusive license or non-exclusive license.

- (3) The provisions of Article 98, paragraph (1), item (iii) and paragraph (2) (Effect of Registration) of the Patent Act apply mutatis mutandis to a right of pledge established on a design right or exclusive license.

(Application mutatis mutandis of provisions of the Patent Act)

Article 36 The provisions of Article 69, paragraphs (1) and (2) (Limitations of Patent Right), Articles 73 (Jointly-owned Patent Rights), 76 (Forfeiture of Patent Rights in Absence of an Heir), 97, paragraph (1) (Waiver of Patent Right) and 98, paragraph (1), items (i) and (ii) (Effect of Registration) of the Patent Act apply mutatis mutandis to design rights.

## **Section 2 Infringement of rights**

(Right to seek injunction)

Article 37 (1) A holder of a design right or an exclusive licensee may demand of a person who infringes or is likely to infringe the design right or exclusive license to stop or prevent the infringement.

- (2) In making a demand under the preceding paragraph, the holder of a design right or an exclusive licensee may demand measures necessary for the prevention of the infringement including the disposal of products constituting the act of infringement (including Computer Program, etc. (refers to Computer Program, etc. as provided in Article 2, paragraph (4) of the Patent Act; the same applies for the following Article); the same applies hereinafter) and the removal of facilities used for the act of infringement.

- (3) With regard to a design for which secrecy is requested pursuant to Article 14, paragraph (1), the holder of the design right or the exclusive licensee may not make a demand under paragraph (1) unless that person has given warning with documents stating the matters listed in Article 20, paragraph (3) and certified by the Commissioner of the Patent Office.

(Acts Deemed to constitute infringement)

Article 38 The following acts are deemed to constitute infringement of a design right or an exclusive license:

- (i) acts of producing, assigning, etc. (assigning and leasing and, in the case where the product is a computer program, etc., including providing through an electric telecommunication line, the same applies hereinafter) or importing or offering for assignment, etc. (including displaying for the purpose of assignment, etc., the same applies hereinafter) any product to be used exclusively for the producing of the article to the registered design or a

- designs similar thereto as a business; and
- (ii) acts of possessing an article to the registered design or a design similar thereto for the purpose of assigning, leasing or exporting it as a business.

(Presumption of Amount of Damage)

- Article 39 (1) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer assigned articles that composed the act of infringement, the amount of damages sustained by the holder of the design right or the exclusive licensee may be presumed to be the amount of profit per each unit of article which would have been sold by the holder of the design right or the exclusive licensee if there had been no such act of infringement, multiplied by the quantity (hereinafter referred to in this paragraph as the "assigned quantity" of articles) assigned by the infringer, the maximum of which is the amount attainable by the holder of the design right or the exclusive licensee in light of the capability of the holder of the design right or the exclusive licensee to work the articles; provided, however, that if any circumstances exist under which the holder of the design right or the exclusive licensee would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of articles not able to be sold due to these circumstances will be deducted.
- (2) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer is presumed to be the amount of damages sustained by the holder of the design right or exclusive licensee.
- (3) A holder of a design right or an exclusive licensee may claim against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, by regarding the amount the holder of the design right or exclusive licensee would have been entitled to receive for the working of the registered design or design similar thereto as the amount of damages sustained.
- (4) The provisions of preceding paragraphs do not prevent any relevant party from claiming compensation for damages in an amount exceeding the amount provided for therein. In such a case, where the infringer committed the infringement of the design right or exclusive license without intent or gross negligence, the court may take these circumstances into consideration in determining the amount of damages.

(Presumption of negligence)

Article 40 An infringer of a design right or an exclusive license of another person is presumed negligent in the commission of the act of infringement; provided, however, that this does not apply to a design for which secrecy is requested pursuant to Article 14, paragraph (1).

(Application mutatis mutandis of provisions of the Patent Act)

Article 41 The provisions of Articles 104-2 through 105-6 (Obligation to clarify the specific conditions, restrictions on the exercise of rights of patentee, etc., limitation to assertion restriction on claim, production submission of documents, etc., expert opinion for calculation of damages, determination of reasonable damages, protective order, rescission of protective order and notice, etc. of a request inspection of record, etc.) and Article 106 (Measures to Restore Credibility) apply mutatis mutandis to infringement of a design right or an exclusive license.

### **Section 3 Registration Fees**

(Registration fees)

Article 42 (1) A person obtaining the registration establishing a design right, or a holder of a design right, must pay as registration fees the amounts specified in the following items, for each design registration and for each year to the expiration of the duration as provided in Article 21:

(i) first to third year: annually 8,500 yen

(ii) fourth to twentieth year: annually 16,900 yen

(2) The provisions of preceding paragraph do not apply to design rights belonging to the State.

(3) Notwithstanding the provisions of paragraph (1), where a design right is jointly owned by the State and any other persons, and the portions of their respective shares of the design right have been agreed upon, the registration fees payable under paragraph (1) is determined as the sum calculated by multiplying the applicable registration fees as provided in paragraph (1) by the ratio of the share of persons other than the State, and the persons other than the State must pay the amounts.

(4) For the amount of registration fees calculated pursuant to the preceding paragraph, a figure with less than ten yen is rounded down.

(5) The payment of registration fees under paragraph (1) must be made by patent revenue stamps as provided by an Order of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Order of the Ministry of Economy, Trade and Industry, a cash payment thereof is acceptable.

(Time limit for payment of registration fees)

- Article 43 (1) The registration fee for the first year under Article 42, paragraph (1), item (i) must be paid within 30 days from the date on which a certified copy of the examiner's decision or the appeal and trial decision to the effect that the design is to be registered has been served.
- (2) The registration fees for each year from the second and subsequent years under Article 42, paragraph (1) must be paid by the end of the previous year.
- (3) The Commissioner of the Patent Office may, upon a request by a person by whom the registration fees are to be paid, extend the time limit under paragraph(1) by a period not exceeding 30 days.
- (4) Where, due to reasons beyond the control of a person who pays registration fees, the person is unable to pay the registration fees within the time limit as provided in paragraph (1) (where the time limit under the preceding paragraph is extended, within the extended time limit), the person may, notwithstanding paragraph (1), pay the registration fees within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the time limit.

(Payment of registration fees by interested persons)

- Article 43-2 (1) An interested person may pay the registration fees even against the will of the person by whom the registration fees are to be paid.
- (2) The interested person who has paid the registration fees pursuant to the preceding paragraph may request the reimbursement of the expenses arising therefrom to the extent of the actual benefit obtained by the person by whom the patent fees were to be paid.

(Late payment of registration fees)

- Article 44 (1) Where a holder of a design right is unable to pay the registration fees within the time limit prescribed in Article 43, paragraph (2), the holder of the design right may make a late payment of the registration fees after the expiration of the time limit, but not later than 6 months following the expiration of the time limit.
- (2) The holder of the design right who makes a late payment of the registration fees pursuant to the preceding paragraph must pay, beyond the registration fees to be paid pursuant to Article 42, paragraph (1), a registration surcharge in the same amount as the registration fees.
- (3) The payment of the registration surcharge under the preceding paragraph must be made by patent revenue stamps as provided by an Order of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Order of the Ministry of Economy, Trade and Industry, a cash

payment thereof is acceptable.

- (4) Where a holder of a design right fails to pay, within the time limit for late payment of the registration fees pursuant to paragraph (1), the registration fees and the registration surcharge under paragraph (2), the design right is deemed to have ceased to exist retroactively upon expiration of the time limit as provided in the Article 43, paragraph (2).

(Restoration of design right by late payment of registration fees)

Article 44-2 (1) Where an original holder of a design right which was deemed to have been extinguished pursuant to paragraph (4) of the preceding Article, has justifiable reasons for having been unable to pay the registration fees and the registration surcharge prescribed in Articles 44, paragraph (4) within the time limit for late payment of the registration fees pursuant to Article 44, paragraph (1), the original holder of the design right may make a late payment of the registration fees and the surcharge within two months from the date on which the justifiable reasons ceased to exist, but not later than one year following the expiration of the time limit.

- (2) Where the registration fees and the surcharge are paid under the preceding paragraph, the design right is deemed to have been maintained retroactively from the time of expiration of the time limit as provided in Article 43 , paragraph (2).

(Restriction on effect of restored design right)

Article 44-3 (1) Where a design right has been restored pursuant to paragraph (2) of the preceding Article, the design right is not effective against an article to the registered design or a design similar thereto, which was imported into, manufactured or acquired within Japan after the lapse of the time limit during which the late payment of the registration fees is allowed pursuant to Article 44, paragraph (1) but before the registration of the restoration of the design right.

- (2) A design right restored pursuant to paragraph 2 of the preceding Article is not effective against the following acts conducted after the lapse of the time limit during which the late payment of the registration fees is allowed pursuant to Article 44, paragraph (1) but before the registration of the restoration of the design right:
- (i) the using of the registered design or a design similar thereto;
  - (ii) manufacturing, assigning, etc., importing or offering for assignment, etc. of any product to be used exclusively for manufacturing an article to the registered design or a design similar thereto. ; and
  - (iii) possessing an article to the registered design or a design similar thereto for the purpose of assigning, leasing or exporting it.

(Application mutatis mutandis of provisions of the Patent Act)

Article 45 The provisions of Article 111, paragraphs (1) (excluding item (iii)) through (3) (Refund of patent fees) of the Patent Act apply mutatis mutandis to registration fees.

## **Chapter V Trials and Appeals**

(Appeal against a Rejection)

Article 46 (1) A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for an appeal against a rejection within three months from the date the certified copy of the examiner's decision has been served.

(2) Where, due to reasons beyond the control of the person, the person is unable to file a request for appeal against a rejection within the time limit as provided in the preceding paragraph, the person may, notwithstanding the paragraph, file the request within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the time limit.

(Appeal against dismissal of request for correction)

Article 47 (1) A person who has received an examiner's decision to dismiss an amendment prescribed in Article 17-2, paragraph (1) and is dissatisfied may file a request for an appeal against dismissal of request for correction within three months from the date on which the certified copy of the examiner's decision has been served; provided, however, that this does not apply where a new application for design registration prescribed in Article 17-3, paragraph (1) has been filed.

(2) The provisions of paragraph (2) of the preceding Article apply mutatis mutandis to a request for appeal against dismissal of request for correction.

(Invalidation trial of design registration)

Article 48 (1) Where a design registration falls under any of the following, a request for invalidation trial of design registration may be filed.

(i) where the design registration has been granted in violation of Articles 3, 3-2, 5, 9, paragraph (1) or (2), and Article 10, paragraph (2) or (3) of this Act, Article 38 of the Patent Act as applied mutatis mutandis under Article 15, paragraph (1) of this Act, or Articles 25 of the Patent Act as applied mutatis mutandis under Article 68, paragraph (3) of this Act (where the design registration has been obtained in violation of Article 38 as applied mutatis mutandis under Article 15, paragraph (1), excluding the case where the

- transfer of a design right pertaining to the design has been registered based on the request under Article 26-2, paragraph (1)).
- (ii) where the design registration has been granted in violation of a treaty;
  - (iii) where the design registration has been granted on an application for design registration filed by a person who has not had the right to obtain the design registration for the design (excluding the case where the transfer of a design right pertaining to the design registration has been registered based on the request under Article 26-2, paragraph (1)); and
  - (iv) where, after the grant of a design registration, the holder of the design right has become unable to hold a design right pursuant to Article 25 of the Patent Act as applied *mutatis mutandis* under Article 68, paragraph (3) of this Act, or the design registration has become in violation of a treaty.
- (2) Any person may file a request for invalidation trial of design registration; provided, however, that where a request for invalidation trial of design registration is filed on the ground that the design registration falls under item (i) of the preceding paragraph (limited to cases where the design registration is obtained in violation of Article 38 of the Patent Act as applied *mutatis mutandis* under Article 15, paragraph (1) of this Act) or item (iii) of the preceding paragraph, only a person who has the right to obtain a design registration pertaining to the design registration may file a request for invalidation trial of design registration.
- (3) A request for invalidation trial of design registration may be filed even after the lapse of the design right.
- (4) Where a request for invalidation trial of design registration has been filed, the chief administrative judge must notify the exclusive licensee of the design right and other persons who have any registered rights relating to the design registration.

(Trial to invalidate a design registration)

Article 49 Where a trial decision to the effect that a design registration is to be invalidated has become final and binding, the design right is deemed never to have existed; provided, however, that where a design registration falls under paragraph (1), item (iv) of the preceding Article and where a trial decision to the effect that the design registration is to be invalidated has become final and binding, the design right is deemed not to have existed from the time the item first became applicable to the design registration.

(Application *mutatis mutandis* of provisions on examination)

Article 50 (1) Article 17-2 and Article 17-3 apply *mutatis mutandis* to an appeal against a rejection. In this case, the term "three months" in Article 17-2, paragraph (3) and 17-3, paragraph (1) is deemed to be replaced with "thirty

days," and the term "files a request for an appeal against" in Article 17-2, paragraph (4) is deemed to be replaced with "institutes, under Article 59, paragraph (1), an action against."

- (2) The provisions of Article 18 apply mutatis mutandis where a request for appeal against a rejection is found to have reasonable grounds; provided, however, that this does not apply where a trial decision is made to order a further examination to be carried out pursuant to Article 161, paragraph (1) of the Patent Act as applied mutatis mutandis under Article 52.
- (3) The provisions of Article 50 (notice of reasons for refusal) of the Patent Act apply mutatis mutandis where a reason for refusal which was not contained in an examiner's decision is found in appeal against a rejection.

(Special provisions for appeal against dismissal of request for correction)

Article 51 Where appeal decision is made to rescind an examiner's ruling in appeal against dismissal of request for correction, the decision made in the appeal decision binds upon the examiner with respect to the case.

(Application mutatis mutandis of provisions of the Patent Act)

Article 52 The provisions of Article 131, paragraphs (1) and (2), Articles 131-2 (excluding items paragraphs(1), item (iii) and paragraph (2), item (i)) through 134, 135 through 154, 155, paragraphs (1) and (2), 156, paragraphs (1), (3) and (4), Articles 157, 158, 160, paragraphs (1) and (2), Articles 161, and 167 through 170 (request for appeal and trial, administrative judge, procedures of appeal and trial, relation to litigation and costs of appeal and trial) of the Patent Act apply mutatis mutandis to appeal and trial. In this case, the term ", in appeal and trial other than invalidation trial, notify" in Article 156, paragraph (1) is deemed to be replaced with "notify" the term "appeal against a rejection" in Article 161 and the term "appeal against a rejection and correction trial" in Article 169, paragraph (3) of the Act is deemed to be replaced with "an appeal against a rejection and appeal against dismissal of request for correction."

## **Chapter VI Retrial and Litigation**

(Request for retrial)

- Article 53 (1) A party or an intervenor may file a request for a retrial against a final and binding trial decision.
- (2) The provisions of Article 338, paragraphs (1) and (2), and Article 339 (Grounds for retrial) of the Code of Civil Procedure (Act No.109 of 1996) apply mutatis mutandis to a request for a retrial under the preceding paragraph.

Article 54 (1) Where a demandant for a trial, in conspiracy with the demandee, has caused the trial decision to be rendered for the purpose of harming the right or interest of a third party, the third party may file a request for a retrial against the final and binding trial decision.

(2) A request for a retrial under the preceding paragraph must be filed against the demandant and the demandee in the trial as joint demandees.

(Restriction on effect of design right restored by retrial)

Article 55 (1) Where a design right pertaining to an invalidated design registration has been restored by a retrial, the design right is not effective against any article to the registered design or a design similar thereto, which was imported into or manufactured or acquired in Japan without knowledge, after the trial decision became final and binding but before the registration of the request for a retrial.

(2) Where a design right pertaining to an invalidated design registration has been restored by a retrial, that design right is not effective against the following acts conducted after the trial decision became final and binding but before the registration of the request for a retrial:

- (i) using of the design or a design similar thereto without knowledge;
- (ii) producing, assigning, etc., importing or offering for assignment, etc., any product to be used exclusively for the manufacturing of an article to the registered design or a design similar thereto without knowledge; and
- (iii) possessing an article to the registered design or a design similar thereto for the purpose of assigning, leasing or exporting it without knowledge.

Article 56 Where a design right pertaining to an invalidated design registration has been restored through a retrial or where the establishment of a design right with respect to an application for design registration refused by a trial decision has been registered through a retrial, and where a person has, without knowledge, been working the design or a design similar thereto in Japan or has, without knowledge, been making preparations therefor, after the trial decision became final and binding but before the registration of the demand for a retrial, the person has a non-exclusive license on the design right, to the extent of the design and the purpose of the business worked or prepared.

(Application mutatis mutandis of provisions on trial)

Article 57 (1) The provisions of Article 50 , paragraphs (1) and (3) apply mutatis mutandis to a retrial against a final and binding trial decision in appeal against a rejection.

(2) The provisions of Article 51 apply mutatis mutandis to a retrial against a final and binding trial decision in appeal against an examiner's ruling

dismissing an amendment.

(Application mutatis mutandis of provisions of the Patent Act)

Article 58 (1) The provisions of Articles 173 and 174, paragraph (5) of the Patent Act apply mutatis mutandis to a retrial.

(2) The provisions of Articles 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), Articles 133, 133-2, 134, paragraph (4), Articles 135 through 147, 150 through 152, 155, paragraph (1), Article 156, paragraphs (1), (3) and (4), Articles 157, 158, 160, the main clause of Article 167-2, Articles 168, 169, paragraph (3) through (6), and Article 170 of the Patent Act apply mutatis mutandis to a retrial against a final and binding trial decision in appeal against a rejection. In this case, the term "appeal against a rejection and a trial for correction" in Article 169, paragraph (3) of the Act is deemed to be replaced with "appeal against a rejection."

(3) The provisions of Articles 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraph (3) and (4), Articles 133, 133-2, 134, paragraph (4), 135 through 147, 150 through 152, 155, paragraph (1), Article 156, paragraphs (1), (3) and (4), 157, the main clause of Articles 167-2, 168, 169, paragraphs (3) through (6), and Article 170 of the Patent Act apply mutatis mutandis to a retrial against a final and binding appeal and trial decision in appeal against dismissal of request for correction. In this case, the term "appeal against a rejection and correction trial" in Article 169, paragraph (3) of the Act is deemed to be replaced with "appeal against dismissal of request for correction."

(4) The provisions of Article 174, paragraph (3) of the Patent Act apply mutatis mutandis to retrial against a final and binding trial decision in invalidation trial of design registration

(Actions against appeal and trial decisions)

Article 59 (1) The Tokyo High Court has exclusive jurisdiction over any action against appeal and trial decision, a ruling dismissing an amendment under Article 17-2, paragraph (1) as applied mutatis mutandis under Article 50, paragraph (1) (including its application under Article 57, paragraph (1)), and a ruling to dismiss a written request for appeal and trial or a retrial.

(2) The provisions of Articles 178, paragraph (2) through (6) (Statute of limitations for filing an action), 179 (Appropriate party as defendant), 180, paragraph (1) (Notice of institution of action) and 180-2 through 182 (Opinion of the Commissioner of the Patent Office in litigation rescinding the appeal and trial decision, rescission of the appeal and trial decision or ruling and delivery of original copy of judgment) of the Patent Act apply mutatis mutandis to an action under the preceding paragraph. In this case, the term "necessary for

identifying claims pertaining to an action with respect to which" in Article 182, item (ii) is deemed to be replaced with "stating that".

(Action against amount of compensation)

Article 60 (1) A persons who has received an award under Article 33, paragraph (3) or (4) may, if not satisfied with the amount of the compensation determined in the award, institute an action demanding an increase or decrease of the amount.

(2) The provisions of Articles 183, paragraph (2) (Statute of Limitations for Filing an Action) and 184 (The Proper Defendant) of the Patent Act apply mutatis mutandis to an action under the preceding paragraph.

(Relationship between administrative objection and litigation)

Article 60-2 The provisions of Article 184-2 (Connection between administrative Objection and Litigation) of the Patent Act apply mutatis mutandis to an action demanding the rescission of dispositions imposed by this Act or an order thereunder (excluding dispositions prescribed in Article 68, paragraph (7)).

**Chapter VI-2 Special Provisions based on Geneva Act of the Hague  
Agreement concerning the International Registration of Industrial  
Designs  
Section 1 Application for International Registration**

(Application for International registration)

Article 60-3 (1) A Japanese national or a foreign national domiciled or resident (or, in the case of a corporation, with a business office) in Japan may file to the Commissioner of the Patent Office an international application as provided in Article 1 (vii) of Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs (hereinafter referred to as "Geneva Act") (hereinafter referred to as "international application"). In this case, where the requirements as provided by Order of the Ministry of Economy, Trade and Industry are satisfied, two or more persons may jointly file an international application.

(2) A person filing an international application under the preceding paragraph (hereinafter referred to as "application for international registration") must submit an application written in a foreign language and necessary materials as provided by Order of the Ministry of Economy, Trade and Industry.

(Application mutatis mutandis of provisions related to applications for design registration)

Article 60-4 The provisions of Articles 17, paragraph (3) (limited to the part

pertaining to item(iii)) and 18, paragraph (1) of the Patent Act as applied mutatis mutandis under Article 68, paragraph (2) of this Act apply mutatis mutandis to the application for international registration.

(Delegation to Order of the Ministry of Economy, Trade and Industry)

Article 60-5 Beyond those prescribed in the preceding two Articles, details of matters necessary for enforcing Geneva Act and the rules under Geneva Act relating to application for international registration are prescribed by Order of the Ministry of Economy, Trade and Industry.

### **Section 2 Special Provisions Concerning International Applications for Design Registration (Article 60-6 through Article 60-23)**

(Application for design registration based on International Application)

Article 60-6 (1) An international application designating Japan as a designated Contracting Party prescribed in Article 1 (xix) of Geneva Act, where publication of an international registration prescribed in Article 1 (vi) of Geneva Act (hereinafter referred to as "international registration") pertaining to the International Application (hereinafter referred to as "international publication") have been made under Article 10 (3)(a) of Geneva Act is deemed to be an application for design registration filed on an international registration date prescribed in Article 10 (2) of Geneva Act (hereinafter referred to as "date of the international registration").

(2) For the purpose of application of the preceding paragraph to an international application including two or more designs, "an application for design registration filed" in the paragraph is replaced with "an application for design registration filed for each design that is the subject of an international registration".

(3) Matters listed in the left columns of the following table recorded on International Register prescribed in Article 1 (viii) of Geneva Act (hereinafter referred to as "International Register") pertaining to an international application deemed to be an application for design registration pursuant to paragraph (1) (including cases of replacing pursuant to the preceding paragraph) (hereinafter referred to as "international application for design registration") is deemed to be the matters listed in the right columns of the table stated in an application submitted pursuant to Article 6, paragraph (1) of this Act.

the name, and domicile of the registered person of an international registration;	the name, and domicile or residence of the applicant for design registration;
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the name and the domicile of a person who has created a design that is the subject of an international registration;	the name, and the domicile or residence of a person who has created a design;
one or more products that constitute a design that is the subject of an international registration, or one or more products that will use a design that is the subject of an international registration;	the article to the design;

(4) The design recorded on International Register concerning international applications for design registration is deemed to be a design for which registration is requested, which is depicted in the drawing submitted pursuant to Article 6, paragraph (1) of this Act.

(Special provision for exception to lack of novelty of design)

Article 60-7 Notwithstanding Article 4, paragraph (3), an applicant of an international application for design registration who requests the application of Article 4, paragraph (2) may submit to the Commissioner of the Patent Office, after the date of international publication, but not later than the time limit as provided in Order of the Ministry of Economy, Trade and Industry, a document stating thereof and a document proving the fact that the design which has fallen under items (i) and (ii) of Article 3 , paragraph (1) is a design to which Article 4, paragraph (2) may be applicable.

(Special provision for registration of related designs)

Article 60-8 For the purpose of application of Article 10, paragraph (1) in the case where either or both of the application for design registration of a principal design and the application for design registration of a related design are international applications for design registration, "or under Article 43-3, paragraph (1) or (2)" in the paragraph is replaced with "or under Article 43-3, paragraph (1) or (2), or Article 6 (1) (a) of Geneva Act."

(Special provision for secret designs)

Article 60-9 The provisions of Article 14 do not apply to the applicant of an international application for design registration.

(Special provisions for procedures for a priority claim under the Paris Convention)

Article 60-10 (1) The provisions of Articles 43, paragraphs (1) through (4), (8) and (9) (including its mutatis mutandis application in Article 43-3, paragraph

(3) of Patent Act to be applied mutatis mutandis in Article 15, paragraph (1) and 43-3, paragraph (2) of Patent Act to be applied mutatis mutandis in Article 15, paragraph (1) do not apply to international applications for design registration.

(2) The provisions of Article 43, paragraphs (2) through (4), (8) and (9) of Patent Act apply mutatis mutandis to a person who has made a declaration of priority under Article 6 (1) (a) of Geneva Act. In this case, the term "within one year and four months from the earliest of the following dates" in Article 43, paragraph (2) of the Act is deemed to be replaced with "within the time limit provided by Order of the Ministry of Economy, Trade and Industry," and the terms "a person who has received notice under paragraph (6)" and "the preceding paragraph" in Article 43 (8) are deemed to be replaced with "a person who submits documents under paragraph (2)" and "the paragraph," respectively.

(Special provisions for the right to obtain a design registration)

Article 60-11 (1) For the purpose of application of Article 34, paragraph (4) of Patent Act as applied mutatis mutandis under Article 15, paragraph (2) of this Act to an international application for design registration, the term "except in the case of general successions including inheritance, ... the Commissioner of the Patent Office " in the paragraph is replaced with "the International Bureau prescribed in Article 1 (xxviii) of Geneva Act".

(2) The provisions of Article 34, paragraphs (5) and (6) as applied mutatis mutandis under Article 15, paragraph (2) of this Act do not apply to the international application for design registration.

(Effect of international publication)

Article 60-12 (1) After the international publication, where the applicant of an international application for design registration has given warning with documents stating the design in the international application for design registration, the applicant of the international application for design registration may claim the amount of compensation against a person who has worked the design in the international application for design registration or designs similar thereto, as a business after the warning, prior to the registration establishing a design right, as equivalent to the amount the applicant would be entitled to receive for the working of the registered design or designs similar thereto if the design in the international application for design registration was the registered design. Even where the warning has not been given, the same applies to a person who worked the design in the international application for design registration or designs similar thereto as a business prior to the registration establishing a design right, with knowledge

of the design having been claimed in the international application for design registration that the international publication has been effected.

- (2) The provisions of Article 65, paragraphs (2) through (6) of Patent Act apply mutatis mutandis to the exercise of the right to claim compensation pursuant to the preceding paragraph. In this case, the term "after the laying open" in paragraph (5) of the Article is replaced with "after international publication", and the term "Articles 101, 104 through 104-3, 105, 105-2, 105-4 through 105-7 and "in paragraph (6) of the Article is replaced with "Articles 104-2 through 105-2 and 105-4 through 105-6 of Patent Act as applied mutatis mutandis under Articles 38 and 41 of Design Act, and Patent Act as applied mutatis mutandis under Article 52 of Design Act."

(Special provision for registration of establishment of a design right)

Article 60-13 For the purpose of application of Article 20, paragraph (2) of this Act to an international application for design registration, the term "payment of the registration fee for the first year under Article 42, paragraph (1)" in the paragraph is replaced with "decision or the appeal decision to the effect that the design is to be registered."

(Effect by extinguishment of international registration)

Article 60-14 (1) Where international registration on which an international application for design registration is based is extinguished, the international application for design registration is deemed to have been withdrawn.

- (2) A design right obtained the registration establishment pursuant to Article 20, paragraph (2) to be applied mutatis mutandis in the preceding paragraph (hereinafter referred to as "design right based on international registration") is deemed to have been extinguished where the international registration is extinguished.

- (3) The preceding two paragraphs become effective as of the date on which the international registration is extinguished from the International Register.

(Special provision for pertaining to transfer of a design right of a related design)

Article 60-15 For the purpose of application of Article 22, paragraph (2) to the design right of a principal design based on international registration, the term "Article 44, paragraph (4)" in the paragraph is replaced with "Article 60-14, paragraph (2)."

(Special provision for creation of an exclusive license on the design right of a related design)

Article 60-16 For the purpose of application of Article 27, paragraph (3) to the

design right of a principal design based on international registration, the term "Article 44, paragraph (4)" in the paragraph is replaced with "Article 60-14, paragraph (2)."

(Special provisions for waiving a design right)

Article 60-17 (1) A person who has a design right based on international registration may waive the design right.

(2) The provisions of Article 97, paragraph (1) of Patent Act as applied mutatis mutandis under Article 36 do not apply to the design right based on international registration.

(Special provisions for the effect of a design right registration)

Article 60-18 (1) Transfer, modification due to trust, lapse due to abandonment, or restriction on disposition of a design right based on international registration must be registered to take effect.

(2) The provisions of Article 98, paragraph (1), item(i), and paragraph (2) of Patent Act as applied mutatis mutandis under Article 36 do not apply to the design right based on international registration.

(Special provisions for registration in the design registry)

Article 60-19 (1) For the purpose of application of Article 61, paragraph (1), item (i) to a design right based on international registration, the term "establishment, transfer, modification due to trust, lapse, restoration or restriction on disposition of a design right" in the paragraph is replaced with "establishment, modification due to trust, extinguishment (limited to extinguishment upon expiration of the duration), or restriction on disposition of a design right."

(2) Transfer or extinguishment (excluding extinguishment upon expiration of the duration) of a design right based on international registration depends on the place at which the design right is registered in the International Register.

(Special provision for Design Gazette)

Article 60-20 For the purpose of application of Article 66, paragraph (2), item (i) to a design right based on international registration, the term "excluding extinguishment under Article 44, paragraph (4)) or the restoration thereof (limited to restoration under Article 44-2, paragraph (2))" in the item is replaced with "excluding extinguishment under Article 60-14, paragraph (2) (limited to extinguishment due to the fact that renewal under Article 17 (2) of Geneva Act was not made))."

(Individual designation fee of international applications for design

registration)

- Article 60-21 (1) A person filing international applications for design registration must pay, as the individual designation fee under Article 7, paragraph (2) of Geneva Act (hereinafter referred to as individual designation fee, the amounts equivalent to 74,600 yen per case to the International Bureau prescribed in Article 1 (xxviii) of Geneva Act (referred to as "International Bureau" in the following paragraph).
- (2) A person making renewal under Article 17 (2) of Geneva Act with regard to the international registration on which an international application for design registration or a design right based on the international registration is based (excluding renewal made after fifteen years has elapsed from the date of the international registration) must pay, as the individual designation fee, the amounts equivalent to 84,500 yen per case to International Bureau.
- (3) The provisions of Articles 42 through 45 and 67, paragraph (2) (limited to the part listed in item (i) of Appended Table) do not apply to a design right based on an international application for design registration or an international registration.

(Refund of individual designation fee)

- Article 60-22 (1) Where an international application for design registration has been withdrawn, or decision of refusal or trial decision to the international application for design registration has become final and binding, amounts as provided in Cabinet Order will be refunded upon the request of the person who paid the individual designation fee to be paid pursuant to paragraph (1) or (2) of the preceding Article.
- (2) No request for refunding the individual designation fee under the preceding paragraph may be filed after the expiration of six months from the date on which the international application for design registration has been withdrawn, or decision of refusal or trial decision to the international application for design registration has become final and binding.
- (3) Notwithstanding paragraph (1), where, due to reasons beyond the control of a person who files request for refund of the individual designation fee under the paragraph, the person is unable to file the request within the time limit as provided in the preceding paragraph, the person may file the request within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the time limit.

(Delegation to Order of the Ministry of Economy, Trade and Industry)

- Article 60-23 Beyond those prescribed in Articles 60-6 through 60-22, details of matters necessary for enforcing Geneva Act and the rules under Geneva Act

will be prescribed by Order of the Ministry of Economy, Trade and Industry.

## **Chapter VII Miscellaneous Provisions**

(Amendment of proceedings)

Article 60-24 A person undertaking a procedure with regard to an application for design registration, a request or any other procedures relating to design registration, may make amendments only while the case is pending in examination, appeal and trial or retrial.

(Registration in the design registry)

Article 61 (1) The following matters must be registered in the design registry maintained in the Japan Patent Office:

- (i) the establishment, transfer, modification due to trust, lapse, restoration or restriction on disposition, of a design right;
- (ii) the establishment, maintenance, transfer, modification, lapse or restriction on disposal, of an exclusive license; and
- (iii) the establishment, transfer, modification, lapse or restriction on disposal, of a right of pledge on a design right or exclusive license.

(2) The design registry may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media using a similar method that may record and reliably store certain matters, the same applies hereinafter.)

(3) Beyond those prescribed in this Act, matters relating to registration will be prescribed by Cabinet Order.

(Issuance of certificate of design registration)

Article 62 (1) The Commissioner of the Patent Office issues the certificate of design registration to the holder of the design right where the establishment of a design right has been registered or transfer of the design right has been registered based on the request under Article 26-2, paragraph (1).

(2) Re-issuance of the certificate of design registration is prescribed by Order of the Ministry of Economy, Trade and Industry.

(Request for certificate)

Article 63 (1) Any person may file a request with regard to design registrations to the Commissioner of the Patent Office to issue a certificate, a certified copy of documents or an extract of documents, to allow the inspection or copying of documents, model or specimen, or to issue documents which contain matters recorded on the magnetic tapes that constitute the part of the Design Registry; provided, however, that if the Commissioner of the Patent Office considers it necessary to keep the documents, model or specimen confidential, these

provisions do not apply to the following documents, model or specimen:

- (i) an application or drawing, photograph, model or specimen attached to an application, or any document pertaining to the examination of an application for design registration for which the design has not been registered;
  - (ii) documents, model or specimen related to a design for which the secrecy is requested pursuant to Article 14, paragraph (1);
  - (iii) documents concerning appeal against a rejection or appeal against dismissal of request for correction requested for an application for design registration for which the design has not been registered;
  - (iv) documents concerning invalidation trial of design registration or a retrial of the final and binding trial decision in the trial, with respect to which a party in the case or intervenor has given notice that a trade secret owned by the party in the case or intervenor has been described (trade secret as provided in Article 2, paragraph (6) of the Unfair Competition Prevention Act (Act No. 47 of 1993));
  - (v) documents which are liable to cause damage to an individual's reputation or peaceful life; and
  - (vi) documents which are liable to cause damage to public order or morality.
- (2) Where the Commissioner of the Patent Office approves of the request under the main clause of the preceding paragraph with regard to the documents, model or specimen as provided in items (i) through (v) of the paragraph, the Commissioner of the Patent Office must notify the person who submitted the documents, model or specimen thereof and reasons therefor.
- (3) The provisions of the Act on Access to Information Held by Administrative Organs (Act No. 42 of 1999) do not apply to the documents concerning design registrations and the part of the Design Registry stored on magnetic tapes.
- (4) The provisions in Chapter IV of the Act on Protection of Personal Information Possessed by Administrative Organs (Act No. 58 of 2003) do not apply to the possessed personal information (refers to the possessed personal information as provided in Article 2, paragraph (3) of the Act) recorded in the documents concerning design registrations and the part of the Design Registry stored on magnetic tapes.

(Mark of Design Registration)

Article 64 A holder of a design right, exclusive licensee or non-exclusive licensee must make efforts to place a mark (hereinafter referred to as a "mark of design registration ") as provided by an Order of the Ministry of Economy, Trade and Industry, on the article to the registered design or a design similar thereto or package thereof, indicating that the design for the article has been registered.

(Prohibition of false marking)

Article 65 Any person may not do the following acts:

- (i) putting a mark of design registration or a mark confusing therewith on an article which is not the article to the registered design and is not the article to a design similar to the registered design, or the package thereof;
- (ii) assigning, leasing or displaying for purposes of assignment or lease an article which is not the article to the registered design and is not the article to a design similar to the registered design, putting a mark of design registration or a mark confusing therewith on the article or package thereof;  
or
- (iii) giving in an advertisement an indication to the effect that the article, which is not the article to the registered design and is not the article to a design similar to the registered design, is related to the registered design, or an indication confusing with the indication for the purpose of having the article manufactured or used, or assigning or leasing the article.

(Design Gazette)

Article 66 (1) The Japan Patent Office publishes the Design Gazette (Isho Koho).

(2) Beyond the matters provided for in this Act, the Design Gazette must contain:

- (i) the extinguishment of design rights (excluding extinguishment upon expiration of the duration and under Article 44, paragraph (4)) or the restoration thereof (limited to restoration under Article 44-2, paragraph (4));
- (ii) filings for a request for trials or retrials, or withdrawals thereof, or final and binding trial decisions or retrial decisions (limited to cases where the establishment of a design right has been registered);
- (iii) requests for an award, the withdrawal thereof or a Commissioner's decision; and
- (iv) final and binding judgments in an action under Article 59, paragraph (1) (limited to cases where the establishment of a design right has been registered)

(3) Beyond the matters provided for in the preceding paragraph, with regard to an application for design registration for which an examiner's decision or appeal and trial decision to the effect it is to be refused under the latter sentence of Article 9, paragraph (2) have become final and binding, the following matters must be published in the Design Gazette. In this case, if secrecy was requested pursuant to Article 14, paragraph (1) for any of those applications, with regard to all of those applications, the matters prescribed in item (3) below must be published without delay after the lapse of the period designated pursuant to Article 14, paragraph (1) (in the case where secrecy was requested for two or more applications, the period which is the longest among the periods of secrecy requested for the applications) from the date the examiner's decision or appeal and trial decision became final and binding.

- (i) the name, and domicile or residence of the applicant for design registration;
- (ii) the number and the filing date of the application for design registration;
- (iii) the application and drawing, photograph, model or specimen attached to the application; and
- (iv) other necessary matters.

(Fees)

Article 67 (1) The following persons must pay fees in an amount to be provided by Cabinet Order in view of the actual costs:

- (i) persons requesting disclosure of a design pursuant to Article 14 (4);
  - (ii) persons notifying of succession pursuant to Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis under Article 15, paragraph (2)
  - (iii) persons filing a request for an extension of period under Article 4 or 5, paragraph (1) of the Patent Act as applied mutatis mutandis under Article 17-4, 43, paragraph (3) or 68, paragraph (1), or a change of the date under Article 5, paragraph (2) of the Patent Act as applied mutatis mutandis under Article 68, paragraph (1);
  - (iv) persons who file applications for international registration;
  - (v) persons filing a request for the re-issuance of the certificate of design registration;
  - (vi) persons filing a request for the issuance of a certificate pursuant to Article 63, paragraph (1);
  - (vii) persons filing a request for the issuance of a certified copy of documents or an extract of documents pursuant to Article 63, paragraph (1):
  - (viii) persons filing a request to allow the inspection or copying of documents, model or specimen pursuant to Article 63, paragraph (1); and
  - (ix) persons filing a request for the issuance of documents which contain matters recorded on the magnetic tapes that constitute the part of the Design Registry pursuant to Article 63, paragraph (1).
- (2) The persons listed in the center column of the attached table must pay fees in the amount as provided by Cabinet Order within the range of the amounts specified in the corresponding right-hand column of the table.
- (3) The provisions of the two preceding paragraphs do not apply where the person to pay the fee in accordance with these paragraphs is the State.
- (4) Where the State has joint ownership of a design right or a right to obtain a design registration with a person other than the State, and the portion of their respective shares of the right has been agreed, notwithstanding the provisions of paragraph (1) or (2), the fees payable thereunder (limited to those provided by Cabinet Order) must be determined as the sum of the provided fees multiplied by the ratios of the shares of each person other than the State, and, the person other than the State must pay the amounts.

- (5) Where the amount of the fees calculated pursuant to the preceding paragraphs has a figure of less than ten yen, the number must be rounded down.
- (6) The payment of the fees under paragraphs (1) and (2) must be made by patent revenue stamps as provided by an Order of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Order of the Ministry of Economy, Trade and Industry, a cash payment thereof is acceptable.
- (7) Fees paid in excess or in error are refunded upon the request of the person who made payment thereof.
- (8) No request for a refund of the fees under the preceding paragraph may be filed after one year from the date on which the payment thereof has been made.
- (9) Notwithstanding paragraph (7), where, due to reasons beyond the control of a person who files request for refund of fees under the paragraph, the person is unable to file the request within the time limit as provided in the preceding paragraph, the person may file the request within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to be applicable, but not later than six months following the expiration of the time limit.

(Application mutatis mutandis of provisions of the Patent Act)

- Article 68 (1) The provisions of Articles 3, 4 and 5, paragraphs (1), and (2) (Time Periods and Dates) of the Patent Act apply mutatis mutandis to time periods and time limits provided in this Act. In this case, the term "Articles 46-2, paragraph (1), item (iii), 108, paragraph (1), 121, paragraph (1) or 173, paragraph (1)" in Article 4 of the Patent Act is deemed to be replaced with "Articles 43, paragraph (1), 46, paragraph (1) or Article 47, paragraph (1), or Article 173, paragraph (1) applied mutatis mutandis in 58, paragraph (1) of the Design Act."
- (2) The provisions of Article 6 through 9, 11 through 16, 17, paragraph (3) and 17, paragraph (4), 18 through 24 and 194 (Procedures) of the Patent Act apply mutatis mutandis to an application for design registration, a request, or any other procedures relating to design registration. In this case, the term "hearing against a rejection" in Article 9 of the Patent Act is deemed to be replaced with "request for an appeal against a rejection and appeal against dismissal of request for correction." and the term "hearing against a rejection " in Article 14 of the Patent Act is deemed to be replaced with "request for appeal against a rejection and appeal against dismissal of request for correction."
  - (3) The provisions of Article 25 (Enjoyment of rights by foreign nationals) of the Patent Act apply mutatis mutandis to design rights and other rights relating to the design registration.
  - (4) The provisions of Article 26 (Effect of Treaties) of the Patent Act apply

mutatis mutandis to the design registration.

(5) The provisions of Articles 189 through 192 (Service) of the Patent Act apply mutatis mutandis to services provided for under this Act.

(6) The provisions of Article 195-3 of the Patent Act apply mutatis mutandis to dispositions imposed by this Act or an order thereunder.

(7) The provisions of Article 195-4 (Restriction on Appeals under Administrative Appeal Act) of the Patent Act apply mutatis mutandis to a ruling to dismiss an amendment, an examiner's decision, an appeal and trial decision, or a ruling to dismiss a written request for appeal and trial or retrial, or dispositions against which no appeal lies in accordance with this Act.

## **Chapter VIII Penal Provisions**

(Crime of infringement)

Article 69 A person who infringe on a design right or exclusive license (excluding one who has committed any acts which are deemed to constitute infringement of a design right or an exclusive license pursuant to Article 38) is punished by imprisonment for a term not exceeding 10 years or a fine not exceeding 10,000,000 yen or combination thereof.

Article 69-2 A person who has committed any acts which are be deemed to constitute infringement of a design right or an exclusive license pursuant to Article 38 is punished by imprisonment for a term not exceeding 5 years or a fine not exceeding 5,000,000 yen or combination thereof.

(Crime of fraud)

Article 70 Any person who has obtained a design registration or appeal and trial decision by means of a fraudulent act is punished by imprisonment for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of false marking)

Article 71 A person who fails to comply with Article 65 is punished by imprisonment for a term not exceeding one year or a fine not exceeding 1,000,000 yen.

(Crime of perjury)

Article 72 (1) A witness, an expert witness or an interpreter who has sworn pursuant to this Act and made a false statement or given a false expert opinion or interpretation to the Japan Patent Office or the court commissioned thereby is punished by imprisonment for a term between three months and ten years.

(2) Where a person who has committed the crime in the preceding paragraph has

made a voluntary confession before a certified copy of the advisory opinion on the case has been served or an examiner's decision or appeal and trial decision has become final and binding, the punishment may be reduced or exculpated.

(Crime of divulging secrets)

Article 73 A present or former official of the Japan Patent Office who has divulged any secret relating to a design in a pending application for design registration that has become known to them in the course of performing their duties, or misappropriated the design is punished by imprisonment for a term not exceeding one year or a fine not exceeding 500,000 yen.

(Crime of breach of protective order)

Article 73-2 (1) A person who fails to comply with an order given under Article 105-4, paragraph (1) of the Patent Act (including its mutatis mutandis application in Article 65, paragraph (6) of the Act to be applied mutatis mutandis in Article 60-12, paragraph (2)) as applied mutatis mutandis under Article 41 is punished by imprisonment for a term not exceeding five years or a fine not exceeding 5,000,000 yen or combination thereof.

(2) The prosecution of the crime under the preceding paragraph may not be initiated unless a complaint is filed.

(3) The provisions for the crime under paragraph (1) apply to a person who commits the crime outside Japan.

(Dual liability)

Article 74 (1) Where a representative of a corporation or an agent, employee or other worker of a corporation or an individual has committed in the course of performing their duties for the corporation or individual, any act in violation prescribed in the following items, beyond the offender, the corporation is punished by a fine as provided in the corresponding item and the individual is punished by a fine as provided in the Article prescribed in the corresponding item:

(i) Article 69, 69-2 or 73-2, paragraph (1), a fine not exceeding 300 million yen; and

(ii) Article 70 or 71, a fine not exceeding 30 million yen.

(2) In the case of the preceding paragraph, the complaint filed under Article 73-2, paragraph (1) against the offender has effect on the corporation or individual and the complaint filed against the corporation or individual has effect on the offender.

(3) Where a fine is imposed on a corporation or individual pursuant to paragraph (1) with regard to a violation of Articles 69, 69-2 or 73-2, paragraph (1), the period of prescription is governed by the same rules as for crimes in the

provisions thereof.

(Civil fine)

Article 75 Where a person who has sworn pursuant to Article 207, paragraph (1) of the Code of Civil Procedure as applied mutatis mutandis under Article 151 of the Patent Act as applied mutatis mutandis under Article 71, paragraph (3) of the Patent Act as applied mutatis mutandis under Article 25, paragraph (3) of this Act, Articles 52, 58, paragraph (2) or (3) of this Act, or Article 174, paragraph (3) of the Patent Act as applied mutatis mutandis under Article 58, paragraph (4) of this Act has made a false statement before the Japan Patent Office or a court commissioned thereby, the person is punished by a civil fine not exceeding 100,000 yen.

Article 76 A person who has been summoned by the Japan Patent Office or a court commissioned thereby in accordance with this Act, and fails to appear or refuses to swear, make a statement, testify, give an expert opinion or interpret without a justifiable reason is punished by a civil fine not exceeding 100,000 yen.

Article 77 A person who has been ordered by the Japan Patent Office or a court commissioned thereby to submit or present documents or other materials for the purpose of examination or preservation of evidence in accordance with this Act and fails to comply with the order without a justifiable reason is punished by a civil fine not exceeding 100,000 yen.