

# **Design Act (Article 69, Article 69-2, Article 70, Article 71, Article 72, Article 73, Article 73-2 paragraph (1) and Article 77 Not enforced (Tentative translation))**

(Act No. 125 of April 13, 1959)

## Table of Contents

Chapter I General Provisions (Article 1 and Article 2)
Chapter II Design Registration and Application for Design Registration (Articles 3 through 15)
Chapter III Examination (Articles 16 through 19)
Chapter IV Design Rights
Section 1 Design Rights (Articles 20 through 36)
Section 2 Infringement on Rights (Articles 37 through 41)
Section 3 Registration Fees (Articles 42 through 45)
Chapter V Trials and Appeals (Articles 46 through 52)
Chapter VI Retrial and Judicial Litigation (Articles 53 through 60-2)
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 (Articles 60-3 through 60-5)
Section 2 Special Provisions on International Applications for Design Registration (Articles 60-6 through 60-23)
Chapter VII Miscellaneous Provisions (Articles 60-24 through 68)
Chapter VIII Penal Provisions (Articles 69 through 77)

## **Chapter I General Provisions**

### (Purpose)

Article 1 The purpose of this Act is to encourage the creation of designs by enabling the protection and utilization of designs, and thereby contributing to the development of industry.

### (Definitions)

Article 2 (1) The term "design" in this Act means the shape, patterns, or colors, or any combination of them (hereinafter referred to as the "shape or equivalent features"), of an article (including a part of an article; the same applies hereinafter); the shape or equivalent features of a building (including a part of a building; the same applies hereinafter); or a graphic image (limited to one

used in the operation of a device or displayed as a result of the device performing its function, and including a part of a graphic image; hereinafter the same applies excluding paragraph (2) of the following Article, Article 37, paragraph (2), Article 38, items (vii) and (viii), Article 44-3, paragraph (2), item (vi) and Article 55, paragraph (2), item (vi)), which is aesthetically pleasing in its visual presentation.

- (2) The term "working" as used in this Act with respect to a design means the following acts:
- (i) manufacturing, using, transferring, leasing, exporting, or importing (including an act of a person in a foreign country having another person bring an article embodying the design from the foreign country into Japan; the same applies hereinafter), or offering to transfer or lease (including displaying for the purpose of transferring or leasing; the same applies hereinafter) an article embodying the design;
  - (ii) constructing, using, transferring, or leasing, or offering to transfer or lease a building embodying the design;
  - (iii) acts falling under any of the following sub-items performed in connection with the graphic image embodying the design (including a computer program or anything equivalent (refers to a computer program or anything equivalent provided in Article 2, paragraph (4) of the Patent Act (Act No.121 of 1959); the same applies hereinafter) that has a function to display the graphic image; hereinafter the same applies in this item):
    - (a) creating or using the graphic image embodying the design, or providing or offering to provide it through a telecommunications line (this includes displaying it in order to provide it; the same applies hereinafter);
    - (b) transferring, leasing, exporting or importing, or offering to transfer or lease a recording medium on which the graphic image embodying the design has been recorded or a device that incorporates the graphic image embodying the design (hereinafter referred to as a "recording medium or device holding a graphic image").
- (3) The term "registered design" as used in this Act means a design for which a design registration has been made.

## **Chapter II Design Registration and Application for Design Registration**

(Requirements for Design Registration)

Article 3 (1) A creator of a design that is industrially applicable may have a design registration made for the design, except for the following designs:

- (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 contained in a distributed publication, or designs that

were made publicly available through a telecommunications 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) If, 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 a shape or equivalent features or graphic images that were publicly known, contained in a distributed publication, or made available to the public through a telecommunications line in Japan or a foreign country, a person may not have a design registration made for that design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

Article 3-2 If a design in an application for design registration is identical or similar to part of a design depicted 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 as the "earlier application for design registration" in this Article), a design registration may not be made for that design, notwithstanding paragraph (1) of the preceding Article; provided, however, that this does not apply if the applicant of the application and the applicant of the earlier application for design registration are the same person and the application was filed before the date when the design gazette in which the earlier application for design registration was published pursuant to Article 20, paragraph (3) (except for the 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 applying the provisions of Article 3, paragraphs (1) and (2) to a design in an application for design registration that the person with the right to have a design registration made has filed within one year after the day on which that design, contrary to the person's wishes, came to fall under the provisions of Article 3, paragraph (1), item (i) or (ii), the design in question is deemed not to have come to fall under the provisions of Article 3, paragraph (1), item (i) or (ii).

- (2) The preceding paragraph also governs the application of the provisions of Article 3, paragraphs (1) and (2) to a design in an application for design registration that the person with the right to have a design registration made

has filed within one year after the day on which that design, due to that person's actions, came to fall under the provisions of Article 3, paragraph (1), item (i) or (ii) (excluding a design that came to fall under those items by being published in a gazette for inventions, utility models, designs, or trademarks).

- (3) A person seeking the application of the preceding paragraph must submit to the Commissioner of the Japan 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 30 days from the date of filing of the application for design registration, a document proving the fact that the design which came to fall under Article 3, paragraph (1), item (i) or (ii) is a design to which the preceding paragraph (hereinafter referred to as a "certificate" in this Article and Article 60-7) may be applicable. However, in cases where there have been two or more actions conducted by a person with the right to have a design registration which came to falling under Article 3, paragraph (1), item (i) or (ii) of the Design Act in respect of the identical or similar design, it would be sufficient to submit the certificate with respect to one of the two or more actions conducted on the earliest date.
- (4) Notwithstanding the preceding paragraph, if the person is unable to submit the certificate within the period as provided in that paragraph due to causes not attributable to the person, the person may submit the certificate to the Commissioner of the Japan Patent Office within 14 days (or, if the person is an overseas resident, within two months) of the date on which the cause ceased to exist, but not later than six months following the lapse of the period.

#### (Designs Not Eligible for Design Registration)

Article 5 Notwithstanding the provisions of Article 3, the following designs may not have a design registration made:

- (i) a design that may damage public order or morals;
- (ii) a design that risks giving rise to confusion with an article, building, or graphic image connected with another person's business; or
- (iii) a design consisting solely of shapes that are essential to ensure the functioning of an article or consisting solely of shapes that are essential to the usage of a building, or a design consisting solely of indications that are essential to the usage of the graphic image.

#### (Provisional Non-Exclusive Licenses)

Article 5-2 (1) A person that has the right to have a design registration made may grant a provisional non-exclusive license of the design right to be obtained based on the right to have a design registration made to another person within the scope of a design depicted 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 to it.

- (2) If a registration establishing design rights has been made in connection with an application for design registration to which a provisional non-exclusive license under the preceding paragraph is linked, a non-exclusive license is deemed to be granted under those design rights to the person that has that provisional non-exclusive license, to the extent permitted by the act establishing the provisional non-exclusive license.
- (3) The provisions of Article 33, paragraphs (2) and (3), Article 34-3, paragraph (4), paragraph (6), paragraphs (8) through (10), and Article 34-5 of the Patent Act 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 to which a provisional non-exclusive license under Article 5-2, paragraph (1) of the Design Act (Act No.125 of 1959) is linked" 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 to which a provisional non-exclusive license under paragraph (1) or (4) of the preceding Article is linked".

#### (Application for Design Registration)

Article 6 (1) A person seeking to have a design registration made must submit to the Commissioner of the Japan Patent Office an application stating the following matters accompanied by a drawing depicting the design for which the registration is sought:

- (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 embodying the design, or the usage of the building or graphic image embodying the design.
- (2) If so provided by Order of the Ministry of Economy, Trade and Industry, the applicant may submit photographs, models, or specimens representing the design for which the registration is sought, in lieu of the drawing referred to in the preceding paragraph. In this case, the applicant must indicate in the application whether they are photographs, models, or specimens that are being submitted.
- (3) If neither the statement concerning the article embodying the design or the usage of the building embodying the design that is referred to in paragraph (1), item (iii), nor the drawings, photographs, or models attached to the application would give a person ordinarily skilled in the art of the design a concept of the material or size of the article or building, and by this reason the person would

not be able to discern the design, the material or size of the article or building embodying the design must be stated on the application.

- (4) If the shape, pattern, or color of an article embodying a design, the shape, pattern, or color of a building embodying a design, or a graphic image embodying a design changes due to the way the article, building, or graphic image functions, and the applicant seeks to have a design registration made for the shapes and equivalent features of the article, the shapes and equivalent features of the building, or the graphic image as it appears before, during, and after that change, the applicant must indicate this and give an explanation of that function of the article, building, or graphic image in the application.
- (5) If colors of the design are applied to the drawing, photograph, or model to be submitted pursuant to the provisions of paragraph (1) or (2), the applicant may omit applying either the color black or white.
- (6) When the applicant omits applying the color black or white pursuant to the provisions of the preceding paragraph, the applicant must indicate this in the application.
- (7) If the applicant submits a drawing depicting a design pursuant to paragraph (1) or a photograph or model representing a design pursuant to paragraph (2), and the whole or part of the article embodying the design, building embodying the design, or graphic image embodying the design is transparent, the applicant must state this fact in the application.

#### (One Application per Design)

Article 7 An application for design registration must be filed for each design as provided by Order of the Ministry of Economy, Trade and Industry.

#### (Design for a Set of Articles)

Article 8 A design for two or more articles, buildings or graphic images that are used together and that are specifically designated by Order of the Ministry of Economy, Trade and Industry (hereinafter referred to as a "set of articles") may be filed as one design and have a design registration made if the set of articles has a sense of unity as a whole.

#### (Designs for Interiors)

Article 8-2 A design for articles, buildings, or graphic images that constitute equipment and decorations inside a store, office, and the other facilities (hereinafter referred to as "interior") may be filed as one design in an application, and have a design registration made if the interior creates a coordinated aesthetic impression as a whole.

#### (Prior Application)

Article 9 (1) If 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 have a design registration made for the design.

(2) If two or more applications for design registration have been filed for identical or similar designs on the same day, only one applicant designated through consultation among the applicants who filed the applications may have a design registration made for the design. If the consultation produces no result or cannot be held, none of the applicants may have a design registration made for the design.

(3) If an application for design registration has been abandoned, withdrawn, or dismissed, or if the examiner's decision or the trial or appeal decision rejecting an application for design registration has become final and binding, the application for design registration, for the purpose of applying the preceding two paragraphs, is deemed not to have been filed from the beginning; provided, however, that this does not apply to the case if the examiner's decision or the trial or appeal decision to reject the application for design registration has become final and binding on the basis that the second sentence of the preceding paragraph is applicable to that application for design registration.

(4) In the case referred to in paragraph (2), the Commissioner of the Japan Patent Office must order the applicants to have consultation referred to in paragraph (2) and to notify its results, by specifying a reasonable period of time.

(5) If no notification under the preceding paragraph is made within the period specified pursuant to that paragraph, the Commissioner of the Japan 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 If, after the registration establishing the design rights is made, it is found that an amendment made to the statement in the application (excluding the matters set forth in Article 6, paragraph (1), items (i) and (ii) and the matters stated pursuant to paragraph (2) of that Article; the same applies in Article 17-2, paragraph (1) and Article 24, paragraph (1)) or to the drawing, photograph, model, or specimen attached to the application has changed its gist, the application for design registration is deemed to have been filed at the time the written amendment of procedures was submitted.

#### (Related Designs)

Article 10 (1) Notwithstanding the provisions of Article 9, paragraph (1) or (2), an applicant for design registration may have a registration made for a design

that is similar to a single design which the applicant has selected either from among the applicant's own designs for which an application for design registration has been filed or from among the applicant's own registered designs (hereinafter the selected design is referred to as the "principal design" and a design similar to it is referred to as a "related design"), but only if the filing date of the application to register the related design (or, if the application to register the related design contains a priority claim under Article 43, paragraph (1), Article 43-2, paragraph (1), Article 43-3, paragraph (1) or Article 43-3, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1), the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application pursuant to Article 4C.(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 The 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 4A.(2) of the Paris Convention; hereinafter the same applies in this paragraph) falls on or after the filing date of the application to register the principal design, and also falls prior to the last day before the lapse of 10 years' time after the filing date of the application to register the principal design; provided, however, that this does not apply if, as of the time of the registration establishing the rights to the related design, the rights to the principal design have ceased to exist pursuant to Article 44, paragraph (4), a trial or appeal decision to invalidate them has become final and binding, or they have been abandoned.

- (2) In applying the provisions of Article 3, paragraphs (1) and (2) to any of the applicant's own designs that have come to fall under Article 3, paragraph (1), item (i) or (ii) and that are identical or similar to the principal design selected for the design that the applicant seeks to have a design registration made pursuant to the preceding paragraph, those designs are deemed not to have come to fall under Article 3, paragraph (1), item (i) or (ii) with regard to the design that the applicant seeks to have a design registration made.
- (3) In applying the proviso to Article 3-2 to a design that an applicant seeks to have a design registration made pursuant to paragraph (1), the phrase "except for a design gazette in which the matters set forth in Article 20, paragraph (3), item (iv) were published pursuant to Article 20, paragraph (4)" in the proviso to Article 3-2 is deemed to be replaced with "if the secrecy is requested for the earlier application for design registration under Article 14, paragraph (1), limited to a design gazette in which the matters set forth in Article 20, paragraph (3), item (iv) were published pursuant to the provisions of Article 20, paragraph (4)".



- (4) A design that is similar only to the related design for which a design registration is granted pursuant to paragraph (1) may be granted a design registration pursuant to that paragraph by deeming the related design to be the principal design. This also applies for a design that is similar only to the related design for which it is provided that the design registration may be granted, and for a design that is similar only to a further-removed related design which is linked to a related design for which it is provided that a design registration may be granted.
- (5) In a case as referred to the preceding paragraph, to apply the provisions of paragraph (1), the term "the principal design" in that paragraph is deemed to be replaced with "the single design that was first selected in connection with the related design".
- (6) If an exclusive license has been established on the design rights to the principal design, a design registration may not be granted for related designs associated with the principal design, notwithstanding the provisions of paragraphs (1) and (4).
- (7) If applications to register related designs have been filed for two or more designs, each of which constitutes a related design associated with a fundamental design ("fundamental design" means the single design that was first selected in connection with a related design; the same applies hereinafter) ("related designs associated with a fundamental design" means a related design for which a fundamental design has been selected and any further-removed related design that is linked to the related design; the same applies hereinafter), Article 9, paragraph (1) or (2) does not apply to those designs.
- (8) In a case as provided in the preceding paragraph, in applying the provisions of Article 3, paragraphs (1) and (2) to any of the applicant's own designs that have come to fall under Article 3, paragraph (1), item (i) or (ii) and that are identical or similar to a related design associated with the fundamental design in question (excluding the cases in which an application to register the related design has been abandoned, withdrawn, or dismissed, the examiner's decision or trial or appeal decision rejecting the application for design registration associated with the related design has become final and binding, the rights to the related design have ceased to exist pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision to invalidate the rights to the related design has become final and binding, or the rights to the related design have been abandoned), those designs are deemed not to have come to fall under Article 3, paragraph (1), item (i) or (ii) with regard to the design that the applicant seeks to have a design registration made pursuant to the provisions of paragraph (1).

(Division of Applications for Design Registration)

- Article 10-2 (1) An applicant for design registration may divide a single application for design registration containing two or more designs into one or more new applications for design registration only while examination, trial, appeal, or retrial of the application for design registration is pending.
- (2) If an application for design registration is divided pursuant to the preceding paragraph, the new applications for design registration are deemed to have been filed at the time of filing the original application; provided, however, that this does not apply for the purposes of applying Article 4, paragraph (3) of this Act and Article 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) of the Patent Act (including as 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) and Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act).
- (3) If a new application for design registration is filed pursuant to the provisions of paragraph (1), any papers or documents (including in the case of a submission in accordance with Article 43, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of Article 15 (including the cases as applied mutatis mutandis pursuant to 43-2, paragraph (2) of the Patent Act (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of Article 15, the same shall apply hereinafter in this paragraph) and Article 43-3, paragraph (3) of the Patent Act, as applied mutatis mutandis pursuant to paragraph (1) of Article 15), this includes those provided by electronic or magnetic means (meaning by electronic means, magnetic means, or other means that is impossible to perceive through the human senses alone)) 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 Article 43, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15 of this Act (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) of the Patent Act (including as 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) is deemed to have been submitted to the Commissioner of the Japan Patent Office along with the new application for design registration.

Article 11 and Article 12 Deleted

(Conversion of Application)

- Article 13 (1) An applicant of a patent application may convert the patent application into an application for design registration; provided, however, that this does not apply after three months have lapsed from the date the certified copy of the examiner's initial decision to reject the patent application has been served.
- (2) An applicant of an application for utility model registration may convert the application for utility model registration into an application for design registration.
- (3) If the period provided in Article 121, paragraph (1) of the Patent Act is extended pursuant to Article 4 of that Act, the period provided in the proviso to paragraph (1) is deemed to have been extended only for that extended period.
- (4) If an application is converted pursuant to the provisions of paragraph (1) or (2), the original application is deemed to have been withdrawn.
- (5) When there is a person that has a provisional exclusive license on a patent application, an applicant of the patent application may convert the patent application pursuant to the provisions of paragraph (1) only if the consent of the person is obtained.
- (6) The provisions of Articles 10-2, paragraphs (2) and (3) apply mutatis mutandis to the conversion of an application pursuant to the provisions of paragraph (1) or (2).

(Special Provisions on the 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 Article 184-20, paragraph (4) of the Patent Act may be converted into an application for design registration, only after the fees payable pursuant to the provisions of Article 195, paragraph (2) of that Act have been paid (or, in the case of an international application that is deemed to be a patent application pursuant to the provisions of Article 184-20, paragraph (4) of the Act, after the ruling as provided in Article 184-20, paragraph (4) has been rendered), and, in the case of a patent application in the 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 a foreign language under Article 184-4, paragraph (1) of the Act, the procedures under Article 184-4, paragraph (1) or paragraph (4) and Article 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 Article 48-16, paragraph (4) of the Utility Model Act (Act No. 123 of 1959) may be converted

into an application for design registration, only after the fees payable under Article 54, paragraph (2) of that 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 rendered), and, in the case of the Japanese language application for utility model registration 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 foreign language application for utility model registration under Article 48-4, paragraph (1) of the Act, the procedures under Article 48-4, paragraph (1) or (4) and Article 48-5, paragraph (1) of the Act have been completed.

(Secret Designs)

- Article 14 (1) An applicant for design registration may designate a period of three years or less after the date of registration establishing the design rights and request that the design be kept secret during that period.
- (2) A person seeking to file a request under the preceding paragraph must submit a document stating the following information to the Commissioner of the Japan Patent Office, at the time of filing the application for design registration or at the time of making a payment of registration fee for the first year pursuant to the provisions of Article 42, paragraph (1):
- (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 rights may request extension or shortening of the period for which the secrecy is requested pursuant to the provisions of paragraph (1).
- (4) The Commissioner of the Japan Patent Office must disclose the design for which the secrecy is requested pursuant to the provisions of paragraph (1) to persons other than the holder of the design rights, if:
- (i) the consent of the holder of the design rights to do so has been obtained;
  - (ii) a request has been made by a party or an intervenor of examination, trial, appeal, retrial, or judicial litigation relating to the design or a design identical or similar to the design;
  - (iii) a request has been made by a court; or
  - (iv) a request has been made by an interested person through submitting a document stating the name of the holder of the design rights and the registration number, and other documents prescribed by Order of the Ministry of Economy, Trade and Industry to the Commissioner of the Japan Patent Office.

(Mutatis Mutandis Application of the Patent Act)

Article 15 (1) Article 38 (Joint Applications) and Articles 43 to 43-3 (Priority Claim Procedures Under the Paris Convention; and Priority Claims as Under the Paris Convention) of the Patent Act apply mutatis mutandis to applications for design registration. In this case, the phrase "within the period provided by Order of the Ministry of the Economy, Trade and Industry" in Article 43, paragraph (1) of that Act is deemed to be replaced with "at the time of filing of the application for design registration"; the phrase "within one year and four months from the earliest of the following dates" in Article 43, paragraph (2) of that Act is deemed to be replaced with "within three months from the date of filing of the application for design registration".

(2) The provisions of Article 33 and Article 34, paragraph (1), paragraph (2), and paragraphs (4) through (7) of the Patent Act (Right to Obtain Patent) apply mutatis mutandis to the right to have a design registration made.

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

### **Chapter III Examination**

(Examination by Examiners)

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

(Examiner's Decision of Rejection)

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

- (i) the design in the application for design registration is not registrable pursuant to the provisions of Article 3, Article 3-2, Article 5, Article 8, Article 8-2, Article 9, paragraph (1) or (2), Article 10, paragraph (1), (4), or (6) of this Act, Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act, or Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (3) of this Act;
- (ii) the design in the application for design registration is not registrable pursuant to the provisions of a relevant treaty;
- (iii) the application for design registration does not comply with the requirements under Article 7; and
- (iv) if the applicant for design registration does not have the right to have a design registration made for the design.

(Dismissal of Amendments)

- Article 17-2 (1) If an amendment made to a statement in the application, or to the drawing, photograph, model, or specimen attached to the application has changed its gist, the examiner must dismiss the amendment in a ruling.
- (2) The ruling dismissing an amendment pursuant to the provisions of the preceding paragraph must be made in writing with its reasoning.
- (3) If the ruling dismissing an amendment pursuant to the preceding paragraph (1) has been rendered, the examiner must not render a decision on the application for design registration until three months have lapsed from the date on which a certified copy of the ruling has been served.
- (4) If an applicant for design registration files a request for trial of an examiner's ruling dismissing an amendment pursuant to the provisions of paragraph (1), the examiner must suspend the examination of the application for design registration until the trial decision becomes final and binding.

(New Application for Amended Design)

- Article 17-3 (1) If an applicant for design registration files a new application for design registration for the amended design within three months from the date on which the certified copy of the ruling dismissing an amendment pursuant to the provisions of 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 procedures for the amendment was submitted.
- (2) If a new application for design registration under the preceding paragraph is filed, 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 Japan Patent Office a document stating a request for the application of the provisions of paragraph (1) to the new application for design registration under paragraph (1), at the time of filing a new application.

- Article 17-4 (1) The Commissioner of the Japan Patent Office may, upon request or ex officio, extend the period provided for in paragraph (1) of the preceding Article for persons in remote areas or areas with transportation difficulties.
- (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 pursuant to Article 50, paragraph (1) (including as applied mutatis mutandis pursuant to Article 57, paragraph (1)) for persons in remote areas or areas with transportation difficulties.

(Decision to Grant a Design Registration)

Article 18 If no reasons for rejection are found for an application for design registration, the examiner must reach the decision to grant the design registration.

(Mutatis Mutandis Application of the Patent Act)

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

## **Chapter IV Design Rights**

### **Section 1 Design Rights**

(Registration of Establishment of Design Rights)

Article 20 (1) Design rights come into existence through registration of their establishment.

- (2) The establishment of a design right is registered once the registration fee for the first year under Article 42, paragraph (1) has been paid.
- (3) If the registration referred to in the preceding paragraph has been made, 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 application number and the filing date of the application for the design registration;
  - (iii) the registration number and the date of the registration establishing the right;
  - (iv) the content 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 pursuant to the provisions of Article 14, paragraph (1), notwithstanding the provisions of the preceding paragraph, matters provided for in item (iv) of the preceding Article must be published without delay after the period designated pursuant to the provisions of Article 14, paragraph (1) has lapsed.

(Duration of Design Rights)

- Article 21 (1) The duration of design rights (excluding rights to a related design) ends 25 years after the filing date of the application for design registration.
- (2) The duration of design rights for a related design ends 25 years after the filing date of the application to register the fundamental design selected for it.

(Transfer of the Rights to a Related Design)

Article 22 (1) The rights to a fundamental design and to its related designs may not be transferred independently of each other.

(2) If the rights to a fundamental design have been extinguished pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision invalidating the rights to a fundamental design has become final and binding, or the rights to a fundamental design have been abandoned, the rights to the related designs associated with the fundamental design may not be transferred independently.

(Effect of Design Rights)

Article 23 A holder of a design right has the exclusive right to work the registered design and designs similar to it in the course of trade; provided, however, that if 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 to it.

(Scope of Registered Design)

Article 24 (1) The scope of a registered design must be determined based on the design depicted in the application, and in the drawing or represented in the photograph, model, or specimen attached to the application.

(2) Whether a registered design is 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 to it.

(2) If a request under the preceding paragraph is made, the Commissioner of the Japan Patent Office must designate three administrative judges to provide 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 referred to in paragraph (1).

Article 25-2 (1) If the Commissioner of the Japan Patent Office is requested by a court to provide an expert opinion on the scope of a registered design and designs similar to it, the Commissioner must appoint three administrative judges and have them 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 commissioning of the provision of an expert opinion as referred to in the preceding paragraph.



(Relationship with Registered Designs Held by Other Persons)

- Article 26 (1) If 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 if 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 in the course of trade.
- (2) If 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 if 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 licensee of the design right may not work the similar design in the course of trade.

(Special Provisions on the Transfer of a Design Right)

- Article 26-2 (1) If a design registration falls under the requirements provided for in Article 48, paragraph (1), item (i) (limited to cases in which the design registration has been obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1)) or provided for in Article 48, paragraph (1), item (iii), a person that has the right to have a design registration made on the design pertaining to the design registration may request the holder of the design right to transfer the design right, pursuant to the provisions of Order of the Ministry of Economy, Trade and Industry.
- (2) A request under the preceding paragraph concerning the rights to a fundamental design or related design may not be filed after the rights to either the fundamental design or related design have ceased to exist, unless the design rights that have ceased to exist are deemed not to have existed from the beginning pursuant to the provisions of Article 49.
- (3) If 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 that has obtained the registration from the beginning. The same applies to the right to claim compensation pursuant to the provisions of Article 60-12, paragraph (1) for the design pertaining to the design right.

- (4) If a part of a co-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 design rights may grant an exclusive license on their design rights; provided, however, that an exclusive license on the rights to a fundamental design or exclusive licenses on the rights to its related designs may be granted only if all the exclusive licenses on the rights to the fundamental 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 to it in the course of trade to the extent permitted by the act establishing the license.
- (3) If the rights to a fundamental design cease to exist pursuant to the provisions of Article 44, paragraph (4), a trial or appeal decision to invalidate the rights to a fundamental design becomes final and binding, or the rights to a fundamental design have been abandoned, exclusive licenses on the rights to related designs associated with the fundamental design may be granted only if all the exclusive licenses on the rights to related designs are granted to the same person at the same time.
- (4) The provisions of Articles 77, paragraphs (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 design rights may grant a non-exclusive license on the design right to another person.

- (2) A non-exclusive licensee has a right to work the registered design or designs similar to it in the course of trade to the extent prescribed by this Act or permitted by the act establishing the license.
- (3) The provisions of Article 73, paragraph (1) (Co-Ownership), Article 97, paragraph (3) (Waiver), and Article 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 that, without knowledge of a design in an application for design registration, created a design identical or similar to the design, or a person that, without knowledge of a design in an application for design registration, learned of the design from a person that created a design identical or similar to the design, and has been working the design or a design similar to it or preparing for the working of the design or a design similar to it in Japan at the time of filing the application for design registration (if the application for design registration is deemed to have been filed at the time of submission of the written amendment of procedures pursuant to Article 9-2 or Article 17-3, paragraph (1) (including as applied mutatis mutandis pursuant to Article 50, paragraph (1) (including as applied mutatis mutandis pursuant to Article 57, paragraph (1))), at the time of filing the original application or the written amendment of procedures), has a non-exclusive license on the design right, only to the extent of the design and the purpose of the business being worked or prepared.

(Non-Exclusive License Based on Prior Application)

Article 29-2 A person that, without knowledge of a design in an application for design registration, has created a design identical or similar to the design, or a person that, without knowledge of a design in an application for design registration, has learned the design from a person that created a design identical or similar to the design, and has been working the design or a design similar to it or preparing to work the design or a design similar to it 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 under the design rights, only if both of the following conditions are satisfied and only to the extent of the design and the purpose of the business being worked or prepared:

- (i) the person filed an application for design registration of the design in the application for design registration or design similar to it prior to the date of filing of the application, and has been working the design in the application or preparing to work 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, the design in the application falls under any of items of Article 3, paragraph (1) and an examiner's decision or trial or appeal decision rejecting the application has become final and binding.

(Non-Exclusive Licenses on the Ground of the Working of the Design Before Registration of Transfer of a Design Right)

Article 29-3 (1) A person that 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 the provisions of Article 26-2, paragraph (1), and is doing a business 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 provided in Article 48, paragraph (1), item (i) (limited to cases in which the design registration has been obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1)) or provided in 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 working or the business being prepared for the working.

- (2) The holder of the design right has the right to receive reasonable consideration from a person that holds a non-exclusive license pursuant to the provisions of the preceding paragraph.

(Non-Exclusive License Due to Working the Design Prior to the Registration of the Demand for Invalidation Trial)

Article 30 (1) Before the registration of a request for a trial for invalidation of design registration is made, if a person falling under any of the following items is engaged in or making preparations for the business of working the design in question or a design similar to it in Japan without knowledge that the design registration falls under any of the items of Article 48, paragraph (1), the person has a non-exclusive license on the design right or the exclusive license existing at the time of the invalidation of the design registration, only to the extent of the design and the purpose of the business being worked or prepared:

- (i) the original holder of a design right, in a case in which one of two or more design registrations granted for the identical or similar design has been invalidated;
  - (ii) the original holder of a design right, in a case in which, after a design registration has been invalidated, a design registration is granted to the legitimate right holder for the identical or similar design; or
  - (iii) in the cases referred to in the preceding two items, at the time of the registration of the request for trial for invalidation of design registration, a person that has an exclusive license connected with the design right pertaining to the invalidated design registration, or a non-exclusive license connected with that design right or with an exclusive license on that design right.
- (2) The holder of design rights or the exclusive licensee has a right to receive reasonable consideration from a person that holds a non-exclusive license pursuant to the provisions of the preceding paragraph.

(Non-Exclusive Licenses After Expiration of the Duration of the Design Right)

Article 31 (1) If 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, only to the extent of the original design right.

(2) If a patent right or utility model right connected with an application for registration filed on or before the filing date of a design application is in conflict with the design rights connected with that design application, the provisions of the preceding paragraph apply *mutatis mutandis* upon expiration of the duration of the patent right or the duration of the utility model right.

Article 32 (1) If part of the design rights for a design similar to a registered design which is related to an application for a design registration filed on or before the filing date of a design application is in conflict with the design rights connected with that design application, a person that, 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, to the extent of the original right.

(2) If a patent right or utility model right connected with an application for registration filed on or before the filing date of a design application is in conflict with the design right connected with that design application, the provisions of preceding paragraph apply *mutatis mutandis* upon expiration of the duration of the patent right or the duration of the utility model right.

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

(Award Granting Non-Exclusive License)

Article 33 (1) If a registered design or a design similar to it falls under any of the cases provided in Article 26, the holder of design rights or the exclusive licensee may request the other person referred to in that Article to have consultation on the grant of a non-exclusive license to work the registered design or a design similar to it, or a non-exclusive license on the patent right or the utility model right.

- (2) The other person referred to in Article 26 who is requested a discussion under the preceding paragraph may request the holder of design right or exclusive licensee requesting the discussion to have consultation on the grant of a non-exclusive license to the extent of the registered design or a design similar to it that the holder of design rights or the exclusive licensee seeks to work with a non-exclusive license on the design right, on the patent right or on the utility model right to be granted through the discussion.
- (3) If no agreement is reached by the discussion referred to in paragraph (1) or the discussion cannot be held, the holder of design rights or the exclusive licensee may request the Commissioner of the Japan Patent Office to render an award.
- (4) If no agreement is reached by the discussion referred to in paragraph (2) or the discussion cannot be held, and if a request for an award under the preceding paragraph is filed, the other person referred to in Article 26 may request the Commissioner of the Japan Patent Office to render an award only within the period for the submission of a written answer by that other person designated by the Commissioner pursuant to Article 84 of the Patent Act as applied *mutatis mutandis* under paragraph (7).
- (5) In the case referred to in paragraph (3) or the preceding paragraph, the Commissioner of the Japan Patent Office may not render an award granting a non-exclusive license if the granting of the non-exclusive license would be unreasonably prejudicial to the interests of the other person referred to in Article 26, the holder of the design right, or the exclusive licensee.
- (6) In the case referred to in paragraph (4), in addition to the case provided for in the preceding paragraph, the Commissioner of the Japan Patent Office may not render an award to grant a non-exclusive license if the award granting a non-exclusive license is not rendered with respect to the request for an award under paragraph (3).
- (7) The provisions of Article 84, Article 84-2, Article 85, paragraph (1), and Articles 86 through 91-2 (Procedures for Award) of the Patent Act apply *mutatis mutandis* to the award referred to in paragraph (3) or (4).

(Transfer of Non-Exclusive License)

Article 34 (1) Except for a non-exclusive license granted by an award referred to in 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 if the business involving the working of the relevant design is also transferred, if the consent of the holder of design rights (or, in the case of a non-exclusive license on the exclusive license, the holder of design rights and the exclusive licensee) is obtained, and if the transfer occurs as a result of general succession including inheritance.

- (2) Except for a non-exclusive license granted by an award referred to in 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 if the consent of the holder of design rights (or, in the case of a non-exclusive license on the exclusive license, the holder of design rights and the exclusive licensee) is obtained.
- (3) A non-exclusive license granted by an award referred to paragraph (3) of the preceding Article, Article 92, paragraph (3) of the Patent Act, or Article 22, paragraph (3) of the Utility Model Act 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, if each right is transferred together with the business, or ceases to exist if each right of the non-exclusive licensee is transferred independently of the business or extinguished.
- (4) A non-exclusive license granted by an award referred to in 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 if the design right, patent right, or utility model right ceases to exist.

#### (Right of Pledge)

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

#### (Mutatis Mutandis Application of the Patent Act)

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

## **Section 2 Infringement on Rights**

(Right to Demand an Injunction)

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

- (2) In making a demand pursuant to the provisions of the preceding paragraph, a holder of a design right or an exclusive licensee may demand measures necessary for the prevention of infringement, including the disposal of articles, buildings, or graphic images (including a computer program or anything equivalent that has the function of displaying a graphic image; the same applies hereinafter except in Article 64 and Article 65, item (i)) or a recording medium onto which a graphic image has been recorded or a device incorporating the graphic image (hereinafter referred to as a "recording medium or device holding an ordinary graphic image"), or a computer program or anything equivalent (except for a computer program or anything equivalent that has the function of displaying a graphic image; the same applies hereinafter) or a recording medium onto which a computer program or anything equivalent has been recorded or a device onto which a computer program or anything equivalent has been recorded (hereinafter referred to as a "recording medium or device containing a computer program or anything equivalent") constituting the act of infringement and the removal of the facilities used for the act of infringement.
- (3) With regard to a design for which secrecy is requested pursuant to the provisions of Article 14, paragraph (1), the holder of design rights or the exclusive licensee may not make a demand under paragraph (1) unless that person has given a warning by presenting documents stating the matters listed in the items of Article 20, paragraph (3), which are certified by the Commissioner of the Japan Patent Office.

(Acts Deemed to Constitute Infringement)

Article 38 The following acts are deemed to constitute infringement on the design right or exclusive license:

- (i) an act falling under any of the following that a person does in the course of trade in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used exclusively in the manufacturing of the article embodying a registered design or a design similar to it:
- (a) the act of manufacturing, transferring, leasing, importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent that is used exclusively in the manufacturing of the article;
- (b) the act of creating a computer program or anything equivalent that is



- used exclusively in the manufacturing of the article, or of providing it or offering to provide it through a telecommunications line;
- (ii) an act falling under any of the following that a person does in the course of trade in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the manufacturing of the article embodying the registered design or a design similar to it (excluding cases in which these are widely distributed within Japan), and that is indispensable to the aesthetically pleasing visual presentation that the registered design or design similar to it creates, while knowing that the design is a registered design or a design similar to it and that the article or computer program or anything equivalent or the recording medium or device containing a computer program or anything equivalent, is used for the working of the design:
    - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease any article or the recording medium or device containing a computer program or anything equivalent that is used in the manufacturing of the article;
    - (b) the act of creating any computer program or anything equivalent that is used in the manufacturing of the article, or providing it or offering to provide it through a telecommunications line;
  - (iii) the act of possessing an article that uses a registered design or a design similar to it for the purpose of transferring, leasing, or exporting it in the course of trade;
  - (iv) an act falling under any of the following that a person does in the course of trade in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, which is used exclusively in the construction of a building embodying a registered design or a design similar to it:
    - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent that is used exclusively in the construction of the building;
    - (b) the act of creating a computer program or anything equivalent that is used exclusively in the construction of the building, or of providing or offering to provide it through a telecommunications line;
  - (v) an act falling under any of the following that a person does in the course of trade in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the construction of a building embodying the registered design or a design similar to it (excluding cases in which these

- are widely distributed within Japan), and that is indispensable to the aesthetically pleasing visual presentation that the registered design or design similar to it creates, while knowing that the design is a registered design or a design similar to it and that the article, computer program or equivalent thing, or recording medium or device containing the computer program or equivalent thing is used in the working of the design:
- (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent that is used in the construction of the building;
  - (b) the act of creating a computer program or anything equivalent that is used in the construction of the building, or of providing it or offering to provide it through a telecommunications line;
- (vi) the act of owning a building embodying a registered design or a design similar to it for the purpose of transferring or leasing it in the course of trade;
- (vii) an act falling under any of the following that a person does in the course of trade in connection with an article, graphic image, recording medium or device holding an ordinary graphic image, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used exclusively in the creation of the graphic image embodying the registered design or a design similar to it:
- (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article, recording medium or device holding an ordinary graphic image, or recording medium or device containing a computer program or anything equivalent, that is used in the creation of the graphic image;
  - (b) the act of creating a graphic image or computer program or anything equivalent that is used exclusively in the creation of the graphic image, or providing it or offering to provide it through a telecommunications line;
- (viii) an act falling under any of the following that a person does in the course of trade in connection with an article, graphic image, recording medium or device holding an ordinary graphic image, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the creation of the graphic image embodying a registered design or a design similar to it (excluding cases in which these are widely distributed within Japan), and that is indispensable to the aesthetically pleasing visual presentation that the design creates, while knowing that the design is a registered design or a design similar to it and that the article, graphic image, recording medium or device holding the ordinary graphic image, computer program or equivalent thing, or recording

medium or device containing the computer program or equivalent thing, is used in the working of the design:

- (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article, recording medium or device holding an ordinary graphic image, or recording medium or device containing a computer program or anything equivalent, that is used exclusively in the creation of the image;
- (b) the act of creating any graphic image or computer program or anything equivalent that is used in the creation of the image, or of providing it or offering to provide it through a telecommunications line;
- (ix) the act of holding a graphic image embodying a registered design or a design similar to it for the purpose of providing it through a telecommunications line in the course of trade, or the act of possessing a recording medium or device holding a graphic image embodying a registered design or a design similar to it for the purpose of transferring, leasing, or exporting it in the course of trade.

#### (Presumption of the Value of Damage)

Article 39 (1) If the holder of design rights or exclusive licensee files a claim for compensation for damage that the holder or licensee personally incurs due to infringement, against a person that, intentionally or due to negligence, infringes the design rights or exclusive license, and the infringer has transferred articles that constitute the act of infringement, the amount of damages sustained by the holder of design rights or exclusive licensee may be established to be the total of the amounts set forth in each of the following items:

- (i) the amount arrived at when the amount of profit per unit for the products that the holder of the design rights or exclusive licensee would have been able to sell if the infringement had not taken place is multiplied by that part of the quantity of articles that the person infringing the design rights or exclusive license has transferred (referred to as the "quantity transferred" in the following item) which does not exceed the quantity covered by the right holder's or exclusive licensee's ability to work the design (referred to as the "workable quantity" in the item) (if there are circumstances that render the holder of design rights or the exclusive licensee unable to sell a quantity of products equivalent to all or part of the workable quantity, the workable quantity less the quantity not sellable due to those circumstances (referred to as the "specified quantity" in the item));
- (ii) if applicable, an amount equivalent to the amount of money that is to be received in exchange for the working of the registered design under the design right or exclusive license, for any quantity exceeding the workable

quantity which is part of the quantity transferred, or for any specified quantity which is part of the quantity transferred (except when it is not found that the holder of design rights would have been able to establish an exclusive license or grant a non-exclusive license under the holder's design rights, or that the holder of design rights or the exclusive licensee would have been able to grant a non-exclusive license under the exclusive licensee's exclusive license).

- (2) If a holder of design rights or exclusive licensee files a claim for compensation for damage that the holder of design rights or exclusive licensee personally incurs due to infringement, against a person that, intentionally or due to negligence, infringes the design right or exclusive license, and the infringer has profited from the infringement, the amount of that profit is presumed to be the value of damage incurred by the holder of design rights or the exclusive licensee.
- (3) The holder of design rights or the exclusive licensee may fix the value of the damages that the holder of design rights or the exclusive licensee has personally incurred as being equivalent to the amount of money the holder of design rights or the exclusive licensee would have been entitled to receive for the working of the registered design or a design similar to it, and may claim compensation for this against a person that, intentionally or due to negligence, infringes the design rights or exclusive license.
- (4) When a court determines the amount equivalent to the amount of money to be received for the working of the registered design as provided in paragraph (1), item (ii) or the preceding paragraph, the court may take into account the consideration that the holder of design rights or the exclusive licensee would hypothetically obtain if they reached an agreement with the infringer, based on the premise that the design rights or exclusive license had been infringed, concerning the consideration for the working of the registered design that is covered by their design right or exclusive license.
- (5) The provisions of paragraph (3) do not preclude any claim to compensation for damage in excess of the amount provided for in that paragraph. In this case, the court may consider the absence of intent or gross negligence by the person that has infringed the design right or exclusive license in fixing the value of damage.

#### (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 the provisions of Article 14, paragraph (1).

(Mutatis Mutandis Application of the Patent Act)

Article 41 The provisions of Articles 104-2 through 105 (Obligation to Clarify the Specific Circumstances of Infringement; Restrictions on the Exercise of Rights of the Patentee; Limitation on Assertions; and Submission of Documents), Articles 105-2-12 through 105-6 (Expert Opinion for Calculation of Damages; Determination of Reasonable Amount of Damage; Confidentiality Protective Orders; Rescission of Confidentiality Protective Orders; and Notice for a Request of Inspection of a Case Record) and Article 106 (Measures to Restore Credibility) apply mutatis mutandis to infringement on a design right or an exclusive license.

### **Section 3 Registration Fees**

(Registration Fees)

- Article 42 (1) A person that has had a registration made establishing design rights, or the holder of design rights, must pay as registration fees the amount specified by Cabinet Order not exceeding 16,900 yen, for each design registration and for each year to the expiration of the duration of design rights provided for in Article 21:
- (2) The provisions referred to in the preceding paragraph do not apply to design rights belonging to the national government.
- (3) Notwithstanding the provisions of paragraph (1), if a design right is co-owned by the national government and persons other than the national government, and their respective ownership of the design right has been specified, 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 ownership of persons other than the national government, and the persons other than the national government must pay the amount.
- (4) If there is a fraction of less than 10 yen in the amount of registration fees calculated pursuant to the preceding paragraph, the fraction is to be discarded.
- (5) The payment of registration fees referred to in paragraph (1) must be made by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that cash payment may be made, if so specified by Order of the Ministry.

(Due Date for Payment of Registration Fees)

Article 43 (1) The registration fee for the first year pursuant to the provisions of paragraph (1) of the preceding Article must be paid within 30 days from the date on which a certified copy of the examiner's decision or trial or appeal decision to register the design has been served.

- (2) The registration fees for each year after the second year prescribed in paragraph (1) of the preceding Article must be paid by the end of the previous year.
- (3) The Commissioner of the Japan Patent Office may extend the period provided for in paragraph (1) by up to 30 days, upon the request of a person who is required to pay the registration fees.
- (4) If the person is unable to pay the registration fees within the period provided for in paragraph (1) due to reasons beyond the control of a person that pays registration fees (if the period under the preceding paragraph is extended, within the extended period), the person may pay the registration fees within 14 days notwithstanding the provisions of paragraph (1) (or, if the person is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the lapse of the period.

(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 required to pay the registration fees.
- (2) The interested person that has paid the registration fees pursuant to the preceding paragraph may request the reimbursement of the expenses to the extent of the actual benefit obtained by the person required to pay the registration fees.

(Late Payment of Registration Fees)

- Article 44 (1) If a holder of design rights is unable to pay the registration fees within the period prescribed in Article 43, paragraph (2), the holder of design rights may make a late payment of the registration fees even after the lapse of the period, but not later than 6 months after the lapse of the period.
- (2) The holder of design rights who makes a late payment of the registration fees pursuant to the provisions of the preceding paragraph must pay a registration surcharge in the same amount as the registration fees, in addition to the registration fees to be paid pursuant to the provisions of Article 42, paragraph (1); provided, however, that if the holder of the design right is unable to pay the registration fees within the period prescribed in Article 43, paragraph (2) due to reasons beyond the control of the holder of the design right, the holder of the design right is not required to pay the registration surcharge.
  - (3) The payment of the registration surcharge referred to in the preceding paragraph must be made by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry; provided, however, that cash payment may be made, if so provided by Order of the Ministry.
  - (4) If a holder of the design right fails to pay the registration fees and the registration surcharge to be paid under paragraph (2) within the period that

late payment of the registration fees may be made pursuant to the provisions of paragraph (1), the design right is deemed to have ceased to exist retroactive to the lapse of the period provided in Article 43, paragraph (2).

(Restoration of Design Right by Late Payment of Registration Fees)

- Article 44-2 (1) If the original holder of the design right which was deemed to have ceased to exist pursuant to the provisions of paragraph (4) of the preceding Article, may make a late payment of the registration fees and the registration surcharge prescribed in Article 44, paragraph (4) as provided by Order of the Ministry of Economy, Trade and Industry within two months from the date on which the original holder becomes able to pay the registration fees and the registration surcharge, but not later than one year after the lapse of the period during which the late payment of the registration fees is allowed under Article 44, paragraph (1); provided, however, that this does not apply if the original holder is found to have intentionally failed to pay the registration fees and the registration surcharge within the period during which the late payment of the registration fees is allowed under Article 44, paragraph (1).
- (2) If late payment for the registration fees and the registration surcharge are made pursuant to the provisions of the preceding paragraph, the design right is deemed to have been maintained retroactively from the time of the lapse of the period prescribed in Article 43, paragraph (2).

(Restriction on Effect of Restored Design Right)

- Article 44-3 (1) If a design right has been restored pursuant to the provisions of paragraph (2) of the preceding Article, that design right is not effective against an article embodying the registered design or design similar to it, or a recording medium or device holding a graphic image embodying the registered design or design similar to it, which was imported into, or manufactured or acquired within Japan, a building embodying the registered design or a design similar to it, which was built or acquired within Japan, or a graphic image embodying the registered design or a design similar to it, which was created or acquired within Japan after the lapse of the period during which the late payment of the registration fees is allowed pursuant to the provisions of Article 44, paragraph (1) but before the registration of the restoration of the design right.
- (2) A design right restored pursuant to the provisions of paragraph (2) of the preceding Article is not effective against the following acts conducted after the lapse of the period during which the late payment of the registration fees is allowed pursuant to the provisions of Article 44, paragraph (1) but before the registration of the restoration of the design right:
- (i) the working of the design or a design similar to it;

- (ii) an act falling under any of the following that a person does in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the manufacturing of the article embodying the registered design or a design similar to it:
  - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent, that is used in the manufacturing of the article;
  - (b) the act of creating a computer program or anything equivalent that is used in the creation of the article, or of providing it or offering to provide it through a telecommunications line;
- (iii) the act of possessing an article embodying a registered design or a design similar to it for the purpose of transferring, leasing or exporting it;
- (iv) an act falling under any of the following that a person does in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, which is used in the construction of the building embodying the registered design or a design similar to it:
  - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease any article, or recording medium or device containing a computer program or anything equivalent, to be used for the building;
  - (b) the act of creating any computer program or anything equivalent to be used for the building, or providing it or offering to provide it through a telecommunications line;
- (v) the act of owning a building embodying a registered design or a design similar to it for the purpose of transferring or leasing it;
- (vi) an act falling under any of the following that a person does with regard to an article, graphic image, recording medium or device holding an ordinary graphic image, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used to create the graphic image embodying a registered design or a design similar to it:
  - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease any article or recording medium or device holding an ordinary graphic image, or recording medium or device containing a computer program or anything equivalent, that is used in the creation of the image;
  - (b) the act of creating a graphic image or computer program or anything equivalent that is used in the creation of the image, or of providing it or offering to provide it through a telecommunications line;



- (vii) the act of holding a graphic image embodying a registered design or a design similar to it for the purpose of providing it through a telecommunications line, or the act of possessing a recording medium or device holding a graphic image embodying a registered design or a design similar to it for the purpose of transferring, leasing, or exporting it.

(Mutatis Mutandis Application of the Patent Act)

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

## **Chapter V Trials and Appeals**

(Appeal against an Examiner's Decision of Refusal)

- Article 46 (1) A person that has been rendered an examiner's decision rejecting an application and that is dissatisfied with this decision may file a request for an appeal against an examiner's decision of refusal within three months from the date the certified copy of the examiner's decision has been served.
- (2) Due to reasons beyond the control of the person, if the person is unable to file a request for appeal against an examiner's decision of refusal within the period provided for in the preceding paragraph, the person may file the request within 14 days, notwithstanding the provisions of that paragraph (or, if the person is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the lapse of the period.

(Appeal Against an Examiner's Decision to Dismiss Amendment)

- Article 47 (1) A person that has received an examiner's decision to dismiss amendment prescribed in Article 17-2, paragraph (1) and is dissatisfied with the ruling may file a request for an appeal against an examiner's decision to dismiss amendment 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 if 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 an appeal against examiner's decision to dismiss amendment.

(Trials for Invalidation of Design Registration)

- Article 48 (1) If a design registration falls under any of the following items, a request for a trial for invalidation of design registration may be filed.
- (i) if the design registration has been made in violation of Article 3, Article 3-2,

Article 5, Article 9, paragraph (1) or (2), Article 10, paragraph (6) of this Act, Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act, or Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (3) of this Act (if the design registration has been made in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act, excluding the case in which the transfer of a design right pertaining to the design registration has been registered based on the request under Article 26-2, paragraph (1)).

- (ii) if the design registration has been made in violation of a treaty;
  - (iii) if the design registration has been made for an application for design registration filed by a person that has not had the right to have the design registration made for the design (excluding the case in which 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) after the design registration has been made, if the holder of the design right has come to fall under a category of a person that is not permitted the enjoyment of design rights pursuant to the provisions of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (3) of this Act, or the design registration has come to violate a treaty.
- (2) Any person may file a request for trial for invalidation of design registration; provided, however, that a request for a trial for invalidation of design registration filed on the grounds that the design registration falls under item (i) of the preceding paragraph (limited to cases in which the design registration is obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act) or under item (iii) of the preceding paragraph, maybe filed only by a person that has the right to have a design registration made for the design associated with the design registration in question.
- (3) A request for a trial for invalidation of design registration may be filed even after the lapse of design rights.
- (4) If a request for a trial for invalidation of design registration has been filed, a chief administrative judge must notify any exclusive licensee under the design right and other persons with registered rights relating to the design registration to that effect.

Article 49 Once 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 from the beginning; provided, however, that if a design registration falls under paragraph (1), item (iv) of the preceding Article and a trial decision to invalidate the design registration has become final and

binding, the design right is deemed not to have existed from the time the design registration came to fall under that item.

(Mutatis Mutandis Application of Provisions on Examination)

- Article 50 (1) The provisions of Article 17-2 and Article 17-3 apply mutatis mutandis to an appeal against an examiner's decision of refusal. In this case, the term "three months" in Article 17-2, paragraph (3) and Article 17-3, paragraph (1) is deemed to be replaced with "30 days", and the phrase "files a request for an appeal against an examiner's decision to dismiss amendment" in Article 17-2, paragraph (4) is deemed to be replaced with "institutes an action referred to in Article 59, paragraph (1)".
- (2) The provisions of Article 18 apply mutatis mutandis if there are found to be reasonable grounds to file a request for an appeal against an examiner's decision of refusal; provided, however, that this does not apply if an appeal decision is made to order a further examination to be carried out pursuant to the provisions of Article 160, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 52.
- (3) The provisions of Article 50 (Notice of Reasons for Refusal) of the Patent Act apply mutatis mutandis if any of the reasons for rejection that differ from the reasons for the examiner's decision are found in an appeal against an examiner's decision of refusal.

(Special Provisions on Trial over Examiner's Ruling Dismissing an Amendment)

- Article 51 If an appeal decision is made to rescind the examiner's ruling in a trial over examiner's decision to dismiss amendment, the determination will be binding on the examiner with respect to the case.

(Mutatis Mutandis Application of the Patent Act)

- Article 52 The provisions of Article 131, paragraphs (1) and (2), Articles 131-2 (excluding items paragraph (1), item (iii) and paragraph (2), item (i)) through Article 134, Articles 135 through 154, Article 155, paragraphs (1) and (2), Article 156, paragraphs (1), (3), and (4), Article 157, Article 158, Article 160, paragraphs (1) and (2), Article 161, and Articles 167 through 170 (Request for Trial or Appeal; Administrative Judge; Trial or Appeal Procedures; Relationship with Judicial Litigation; and Costs of Trial and Appeal) of the Patent Act apply mutatis mutandis to trials and appeals. In this case, the phrase "a case ... in a trial or appeal other than a trial for invalidation" in Article 156, paragraph (1) is deemed to be replaced with "a case", the phrase "appeal of the examiner's decision of rejection" in Article 161 and the phrase "appeal against examiner's decision of rejection and trial for correction" in

Article 169, paragraph (3) of the Act is deemed to be replaced with "an appeal against an examiner's decision of refusal and trial over examiner's decision to dismiss an amendment".

## **Chapter VI Retrial and Judicial 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 or appeal 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) If a requester and a respondent in a trial or appeal have conspired to bring about a decision on the trial or appeal with the aim of harming the rights or interests 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 as referred to in the preceding paragraph must be filed against the requester and the respondent in the trial or appeal as joint respondents.

### **(Restriction on Effect of Design Right Restored by Retrial)**

Article 55 (1) If design rights under an invalidated design registration has been restored by retrial, the effect of the design rights does not extend to any article or recording medium or device holding a graphic image that embodies the registered design or a design similar to it, which was imported into, or manufactured or acquired within Japan in good faith, any building embodying the registered design or a design similar to it, which was constructed or acquired within Japan in good faith, or any graphic image embodying the registered design or a design similar to it, which was created or acquired within Japan in good faith after the trial decision becomes final and binding but before the registration of the request for a retrial.

(2) If design rights under an invalidated design registration have been restored by retrial, the effect of the design rights does not extend to the following acts as performed after the trial decision becomes final and binding but before the registration of the request for a retrial:

- (i) the working of the design or a design similar to it in good faith;
- (ii) an act falling under any of the following that a person performs in good faith, in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the manufacturing of the article

- embodying the registered design or a design similar to it:
- (a) (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent that is used in the manufacturing of the article;
  - (b) the act of creating a computer program or anything equivalent that is used in the manufacturing of the article, or of providing it or offering to provide it through a telecommunications line;
  - (iii) the act of possessing an article embodying a registered design or a design similar to it for the purpose of transferring, leasing or exporting it in good faith;
  - (iv) an act falling under any of the following that a person performs in good faith, in connection with an article, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in the construction of a building embodying the registered design or a design similar to it:
    - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article or recording medium or device containing a computer program or anything equivalent that is used in the construction of the building;
    - (b) the act of creating a computer program or anything equivalent that is used in the construction of the building, or of providing it or offering to provide it through a telecommunications line;
  - (v) the act of owning a building embodying the registered design or a design similar to it for the purpose of transferring or leasing it in good faith;
  - (vi) an act falling under any of the following that a person performs in good faith, in connection with an article, graphic image, recording medium or device holding an ordinary graphic image, computer program or anything equivalent, or recording medium or device containing a computer program or anything equivalent, that is used in a creation of the graphic image embodying a registered design or a design similar to it:
    - (a) the act of manufacturing, transferring, leasing, or importing, or offering to transfer or lease an article, recording medium or device holding an ordinary graphic image, or recording medium or device containing a computer program or anything equivalent, that is used in the creation of the image;
    - (b) the act of creating a graphic image or computer program or anything equivalent that is used in the creation of the image, or of providing it or offering to provide it through a telecommunications line;
  - (vii) The act of holding a graphic image embodying a registered design or a design similar to it for the purpose of providing it through a

telecommunications line, or the act of possessing a recording medium or device holding a graphic image embodying the registered design or a design similar to it for the purpose of transferring, leasing or exporting it in good faith.

Article 56 If design rights under an invalidated design registration have been restored by a retrial or if the establishment of design rights has been registered by a retrial in connection with an application for design registration that was refused by examination and the examiner's decision of refusal is maintained by an appeal decision, and if a person has been working the design or a design similar to it in Japan or has been making preparations for it in good faith, after the trial decision or the appeal decision became final and binding but before the registration of the request for a retrial, the person has a non-exclusive license under those design rights, to the extent of the design and the purpose of the business being worked or prepared.

(Mutatis Mutandis Application of Provisions on Trials)

- Article 57 (1) The provisions of Article 50, paragraphs (1) and (3) apply mutatis mutandis to a retrial against a final and binding appeal decision for an appeal against an examiner's decision of refusal.
- (2) The provision of Article 51 apply mutatis mutandis to a retrial against a final and binding appeal decision for a trial over examiner's ruling dismissing an amendment.

(Mutatis Mutandis Application of the Patent Act)

- Article 58 (1) The provisions of Article 173 and Article 174, paragraph (5) of the Patent Act apply mutatis mutandis to a retrial.
- (2) The provisions of Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), Article 133, Article 133-2, Article 134, paragraph (4), Articles 135 through 147, Articles 150 through 152, Article 155, paragraph (1), Article 156, paragraphs (1), (3), and (4), Article 157, Article 158, Article 160, the main clause of Article 167-2, Article 168, Article 169, paragraphs (3) through (6), and Article 170 of the Patent Act apply mutatis mutandis to a retrial against a final and binding appeal decision for an appeal against an examiner's decision of refusal. In this case, the phrase "appeal against an examiner's decision of refusal and a trial for correction" in Article 169, paragraph (3) of the Act is deemed to be replaced with "appeal against an examiner's decision of refusal".
- (3) The provisions of Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), Article 133, Article 133-2, Article 134, paragraph (4), Articles 135 through 147, Articles 150 through 152,

Article 155, paragraph (1), Article 156, paragraphs (1), (3), and (4), Article 157, the main clause of Article 167-2, Article 168, Article 169, paragraphs (3) through (6), and Article 170 of the Patent Act apply mutatis mutandis to a retrial against a final and binding appeal decision for an appeal against an examiner's decision to dismiss amendment. In this case, the phrase "appeal over the examiner's decision of rejection or a trial for correction" in Article 169, paragraph (3) of that Act is deemed to be replaced with "appeal against an examiner's decision to dismiss amendment".

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

(Revocation Actions Against Trial or Appeal Decisions)

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

- (2) The provisions of Article 178, paragraphs (2) through (6) (Statute of Limitations for Filing an Action), Article 179 (Eligibility for Defendant), Article 180, paragraph (1) (Notice of Commencement of Action) and Articles 180-2 through 182 (Opinion of the Commissioner of the Japan Patent Office in a Revocation Action against a/an Trial or Appeal Decision; Vacating a Trial or Appeal Decision or a Ruling; and Sending of Original Copy of a Decision) of the Patent Act apply mutatis mutandis to a revocation action under the preceding paragraph. In this case, the phrase "necessary for identifying claims pertaining to a revocation action with respect to which" in Article 182, item (ii) is deemed to be replaced with "stating that".

(Revocation Actions against Amount of Consideration)

Article 60 (1) If a person that has received an award referred to in Article 33, paragraph (3) or (4) is not satisfied with the amount of the consideration determined in the award, the person may institute an action demanding an increase or decrease in that amount.

- (2) The provisions of Article 183, paragraph (2) (Statute of Limitations for Filing an Action) and Article 184 (Eligibility for Defendant) of the Patent Act apply mutatis mutandis to an action referred to in the preceding paragraph.

Article 60-2 Deleted

**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 citizen or a foreign national that has an address or residence (or, in the case of a corporation, a business office) in Japan may file to the Commissioner of the Japan Patent Office an international application provided in Article 1 (vii) of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as the "Geneva Act") (hereinafter the application is referred to as "international application"). In this case, if the requirements prescribed 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 pursuant to the provisions of 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.

(Mutatis Mutandis Application of Provisions Related to Applications for Design Registration)

- Article 60-4 The provisions of Article 17, paragraph (3) (limited to the part related to item (iii)) and Article 18, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to 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 In addition to what is provided for in the preceding two Articles, the details of necessary matters for enforcing the Geneva Act and the Common Regulations Under the Geneva Act relating to application for international registration are prescribed by Order of the Ministry of Economy, Trade and Industry.

**Section 2 Special Provisions on International Applications for Design  
Registration**

(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 the Geneva Act for which



publication of an international registration prescribed in Article 1 (vi) of the 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 the Geneva Act is deemed to be an application for design registration filed on an international registration date prescribed in Article 10 (2) of the Geneva Act as provided by Order of the Ministry of Economy, Trade and Industry.

- (2) In applying the provisions of the preceding paragraph to an international application including two or more designs, "an application for design registration filed" in that 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-hand columns of the following table recorded on the international register prescribed in Article 1 (viii) of the 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 as applied following the deemed replacement of terms pursuant to the preceding paragraph) (hereinafter referred to as "international application for design registration") are deemed to be the matters listed in the right-hand columns of the table stated in the application submitted pursuant to Article 6, paragraph (1).

the name, and domicile or residence of the registered person of an international registration	the name, and domicile or residence of the applicant for design registration
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 embodying the design, or the usage of the building or graphic image embodying the design (if the product listed in the left column is a building or graphic image, limited to the cases where it is possible to recognize the usage of the building or the graphic image from the matters recorded on the international register related to the product);

- (4) A design recorded on the international register concerning international applications for design registration is deemed to be a design for which registration is sought, which is depicted in the drawing submitted pursuant to Article 6, paragraph (1).

(Special Provisions on Exception to Lack of Novelty of Design)

- Article 60-7 (1) Notwithstanding the provisions of the main clause of Article 4, paragraph (3), the applicant of an international application for design registration that seeks the application of the provisions of Article 4, paragraph (2) may submit to the Commissioner of the Japan Patent Office, after the date of international publication, but within the period provided by Order of the Ministry of Economy, Trade and Industry, a document stating that fact and a certificate. In this case, the provisions of the proviso in paragraph (3) shall apply *mutatis mutandis*.
- (2) When the applicant provided in the preceding paragraph submits a certificate to the International Bureau prescribed in Article 1 (xxviii) of the Geneva Act (hereinafter referred to as the "International Bureau") at the time of submitting the international application, for the purpose of application of Article 4, paragraph (3), the applicant is deemed to have submitted the certificate to the Commissioner of the Patent Office on the date of international application prescribed in Article 10 (2) of the Geneva Act.

(Special Provision on Registration of Related Designs)

- Article 60-8 (1) In applying the provisions of Article 10, paragraph (1) (including as applied following a deemed replacement of terms pursuant to paragraph (5) of the Article; hereinafter the same applies in this paragraph and the following paragraph) if 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, the phrase "or under Article 43-3, paragraph (1) or (2)" in that paragraph is deemed to read "or under Article 43-3, paragraph (1) or (2), or Article 6 (1)(a) of the Geneva Act".
- (2) In applying the provisions of the proviso to Article 10, paragraph (1), if the rights to a principle design are design rights that are based on the international registration prescribed in Article 60-14, paragraph (2), the phrase "Article 44, paragraph (4)" in the proviso to that paragraph is deemed to read "Article 60-14, paragraph (2)".
- (3) In applying the provisions of Article 10, paragraph (8) if the rights to one or more related designs that are associated with a fundamental design are design rights that are based on an international registration as prescribed in Article 60-14, paragraph (2), the term "Article 44, paragraph (4)" in that paragraph is deemed to read "Article 44, paragraph (4) or Article 60-14, paragraph (2)".

(Special Provisions on 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 on Procedures for a Priority Claim Under the Paris Convention)

- Article 60-10 (1) For the international applications for design registration, the provisions of Article 43 of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act following the deemed replacement of terms (including Article 43-2, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act (including as 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) and including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act), and Article 43-2, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act (including as 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 and Article 43-3, paragraph (2) of the Patent Act do not apply.
- (2) The provisions of Article 43, paragraphs (2) through (9) of the Patent Act apply mutatis mutandis to a person that has made a priority claim under Article 6 (1)(a) of the 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 Patent Act is deemed to be replaced with "within the period prescribed by Order the Ministry of Economy, Trade and Industry".

(Special Provisions on the Right to Have a Design Registration Made)

- Article 60-11 (1) In applying the provisions of Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (2) of this Act to an international application for design registration, the phrase "except in the case of general successions including inheritance, ... the Commissioner of the Japan Patent Office" in that paragraph is replaced with "the International Bureau prescribed in Article 60-7, paragraph (2) of the Design Act."
- (2) The provisions of Article 34, paragraphs (5) and (6) as applied mutatis mutandis pursuant to Article 15, paragraph (2) of this Act do not apply to an international application for design registration.

(Effect of International Publication)

- Article 60-12 (1) After international publication is made, if the applicant of an international application for design registration has given a warning by presenting documents depicting the design in the international application for design registration, the applicant of the international application for design

registration may demand payment of the amount of compensation against a person that has worked the design in the international application for design registration or a design similar to it, in the course of trade after the warning is given, prior to the registration establishing a design right, which is equivalent to the amount the applicant would be entitled to receive for the working of the registered design or a design similar to it if the design in the international application for design registration was the registered design. Even if the warning has not been given, the same applies to a person that worked the design in the international application for design registration or a design similar to it in the course of trade prior to the registration establishing a design right, knowing that the design is the design in the international application for design registration for which the international publication has been effected.

- (2) The provisions of Article 65, paragraphs (2) through (6) of the Patent Act apply *mutatis mutandis* to the exercise of the right to claim compensation pursuant to the provisions of the preceding paragraph. In this case, the term "after the publication of the patent application" in paragraph (5) of that Article is deemed to be replaced with "after international publication is made", and the phrase "Article 101, Articles 104 through 104-3, Articles 105 through 105-2-12, Articles 105-4 through 105-7, and" in paragraph (6) of that Article is deemed to be replaced with "Article 38 of the Design Act, Articles 104-2 through 105 of the Patent Act as applied *mutatis mutandis* pursuant to Article 41 of the Design Act, Article 105-2-12, and Articles 105-4 through 105-6 of the Patent Act, and the Patent Act as applied *mutatis mutandis* pursuant to Article 52 of the Design Act".

(Special provisions for formal requirements for examiner's decision of design registration)

Article 60-12-2 (1) For the purpose of application of Article 52, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 19 to an international application for design registration, the Commissioner of the Patent Office may notify the holder of international registration of the matters stated in an examiner's decision (limited to an examiner's decision to the effect that a design registration is to be granted under Article 18) via the International Bureau as provided by Order of the Ministry of Economy, Trade and Industry, in lieu of serving a certified copy of the examiner's decision under Article 52, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 19.

- (2) In the case of the preceding paragraph, the service prescribed in the preceding paragraph is deemed to have been made at the time when the notification under the preceding paragraph is recorded in the International

Register.

(Special Provisions on Registrations of Establishment of the Design Rights)

Article 60-13 In applying the provisions of Article 20, paragraph (2) to an international application for design registration, the phrase "payment of the registration fee for the first year pursuant to the provisions of Article 42, paragraph (1)" in that paragraph is deemed to read "examiner's decision or trial or appeal decision to register the design".

(Effect of the Extinction of International Registration)

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

(2) A design right for which registration of its establishment has been made pursuant to Article 20, paragraph (2) as applied *mutatis mutandis* following a replacement of terms pursuant to the preceding Article (hereinafter referred to as "design right based on international registration") is deemed to have ceased to exist if the international registration on which it is based has ceased to exist.

(3) The preceding two paragraphs become effective as of the date on which the international registration has ceased to exist in the international register.

(Special Provisions on the Transfer of the Rights to a Related Design)

Article 60-15 In applying the provisions of Article 22, paragraph (2) to the rights to a fundamental design based on international registration, the term "Article 44, paragraph (4)" in that paragraph is deemed to read "Article 60-14, paragraph (2)".

(Special Provision on the Creation of an Exclusive License on the Rights to a Related Design)

Article 60-16 In applying the provisions of Article 27, paragraph (3) to the rights to a fundamental design based on an international registration, the term "Article 44, paragraph (4)" in that paragraph is deemed to read "Article 60-14, paragraph (2)".

(Special Provisions for Waiving a Design Right)

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

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

(Special Provisions on the Effect of a Design Right Registration)

Article 60-18 (1) Transfer, modification due to trust, extinguishment 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 the Patent Act as applied mutatis mutandis pursuant to Article 36 do not apply to the design right based on international registration.

(Special Provisions on Registration in the Design Register)

Article 60-19 (1) In applying the provisions of Article 61, paragraph (1), item (i) to a design right based on international registration, the phrase "establishment, transfer, modification due to trust, extinguishment, restoration, or restriction on disposition of a design right" in that item is deemed to read "establishment, modification due to trust, extinguishment (limited to extinguishment upon expiration of the duration of design right), or restriction on disposition of a design right".

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

(Special Provisions on Design Gazettes)

Article 60-20 In applying the provisions of Article 66, paragraph (2), item (i) to a design right based on international registration, the phrase "excluding extinguishment pursuant to the provisions of Article 44, paragraph (4)) or its restoration (limited to restoration pursuant to the provisions of Article 44-2, paragraph (2))" in that item is deemed to read "excluding extinguishment pursuant to the provisions of Article 60-14, paragraph (2) (limited to extinguishment due to the fact that renewal under Article 17 (2) of the Geneva Act was not made))."

(Individual Designation Fee of International Applications for Design Registration)

Article 60-21 (1) A person seeking to file an international application for design registration must pay as the individual designation fee under Article 7, paragraph (2) of the Geneva Act (hereinafter referred to as "individual designation fee"), the amount equivalent to the amount specified by Cabinet Order not exceeding 100,500 yen per case to the International Bureau.

(2) A person making a renewal under Article 17 (2) of the 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 must pay as the individual designation fee, the amount equivalent to the amount specified by Cabinet Order not exceeding 84,500 yen per case to the International Bureau.

- (3) The provisions of Articles 42 through 45, and Article 67, paragraph (2) (limited to the part listed in item (1) of the Appended Table) do not apply to a design right based on an international application for design registration or on an international registration.

(Refund of Individual Designation Fees)

Article 60-22 (1) If an international application for design registration has been withdrawn, or a decision or trial or appeal decision to reject on an international application for design registration has become final and binding, the amount prescribed by Cabinet Order will be refunded upon the request of the person that paid the individual designation fee required 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 lapse of six months from the date on which the international application for design registration has been withdrawn, or a decision or trial or appeal decision to reject on the international application for design registration has become final and binding.

- (3) Notwithstanding the provisions of paragraph (1), due to reasons beyond the control of a person that files a request for refund of the individual designation fee under that paragraph, if the person is unable to file the request within the period provided in the preceding paragraph, the person may file the request within 14 days (or, if the person is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the lapse of the period.

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

Article 60-23 In addition to what is provided for in Articles 60-6 through the preceding Article, the details of the necessary matters for enforcing the Geneva Act and the Common Regulations Under the Geneva Act are prescribed by Order of the Ministry of Economy, Trade and Industry.

## **Chapter VII Miscellaneous Provisions**

(Amendment of Procedures)

Article 60-24 A person that undertakes a procedure with regard to an application for design registration, a request or any other procedures regarding design registration, may make amendments only while the case is pending in

examination, trial, appeal, or retrial.

(Registration in the Design Register)

Article 61 (1) The following matters are to be registered in the design register kept at the Japan Patent Office:

- (i) the establishment, transfer, modification due to trust, extinguishment, restoration, or restriction on disposition, of a design right;
  - (ii) the establishment, maintenance, transfer, modification, extinguishment, or restriction on disposal, of an exclusive license; and
  - (iii) the establishment, transfer, modification, extinguishment, or restriction on disposal, of a right of pledge on a design right or exclusive license.
- (2) The design register may be prepared, in whole or in part, in the form of magnetic tapes (this includes any other medium onto which certain information can be securely recorded by equivalent means; the same applies hereinafter).
- (3) In addition to what is provided for in this Act, the necessary matters for registration are prescribed by Cabinet Order.

(Issuance of Certificate of Design Registration)

Article 62 (1) The Commissioner of the Japan Patent Office issues a certificate of design registration to the holder of the design right once the registration establishing the design rights has been made or a registration transferring the design rights has been made based on the request under the provisions of Article 26-2, paragraph (1).

- (2) Reissuance 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 Japan Patent Office to issue a certificate, a certified copy of documents or an extract of documents, to allow inspection or copying of documents, model, or specimen, or to issue documents stating the information stored on magnetic tape that constitute a part of the design register; provided, however, that if the Commissioner considers it necessary to keep the following documents, models, or specimens confidential, these provisions do not apply to those documents, models, or specimens:

- (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, models, or specimens related to a design for which the secrecy is requested pursuant to the provisions of Article 14, paragraph (1);



- (iii) documents related to an advisory opinion on the technical scope of a registered design, which a party to the case has reported to contain a trade secret (meaning a trade secret prescribed in Article 2, paragraph (6) of the Unfair Competition Prevention Act (Act No. 47 of 1993); the same in the next item and item (vi)) owned by that party;
  - (iv) documents concerning an award to which parties or non-parties with registered rights relating to the design registration, or a non-exclusive licensee that has stated an opinion pursuant to Article 84-2 of the Patent Act as applied mutatis mutandis under Article 33, paragraph (7), have given notice that proprietary trade secrets of those persons have been described;
  - (v) documents related to an appeal against an examiner's decision of refusal or a trial against an examiner's decision to dismiss amendment filed for an application for design registration for which the design has not been registered;
  - (vi) documents related to a trial for invalidation of design registration or a retrial against the final and binding trial decision in the trial, with respect to which a party in the case or an intervenor has reported to contain a trade secret owned by the party or the intervenor;
  - (vii) documents that may damage an individual's reputation or peaceful existence; and
  - (viii) documents that may damage public order or morals.
- (2) If the Commissioner of the Japan Patent Office approves of the request under the main clause of the preceding paragraph with regard to the documents, models, or specimens set forth in items (i) through (vii) of that paragraph, the Commissioner must notify the person that submitted the documents, models, or specimens of the fact and reasons for it.
- (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 register recorded on magnetic tapes.
- (4) The provisions of Chapter V, Section 4 of the Act on the Protection of Personal Information (Act No. 57 of 2003) do not apply to the retained personal information (refers to the retained personal information prescribed in Article 60, paragraph (1) of the Act) recorded in the documents concerning design registrations and the part of the design register recorded on magnetic tapes.

#### (Indication of Design Registration)

**Article 64** A holder of design rights, exclusive licensee or non-exclusive licensee must try to place an indication (hereinafter referred to as an "indication of design registration") as provided by Order of the Ministry of Economy, Trade and Industry, on the article or its package, building, or graphic image or recording medium or device holding a graphic image, or its package embodying

the registered design or a design similar to it, showing that the design of the article, building, or graphic image has been registered or that the design is similar to it.

(Prohibition of False Indication)

Article 65 It is prohibited for any person to do the following acts:

- (i) the act of putting an indication of design registration or an indication that can be confused with this on an article or its packaging, a building, graphic image, or recording medium or device holding a graphic image or its packaging which does not constitute an article, building, or graphic image embodying a registered design or design similar to it or a recording medium or device holding a graphic image embodying a registered design or a design similar to it;
- (ii) an act falling under any of the following that a person does in connection with an article, building, graphic image, or recording medium or device holding a graphic image that does not constitute an article, building, or graphic image embodying a registered design or a design similar to it or a recording medium or device holding a graphic image embodying a registered design or a design similar to it, if an indication of design registration or an indication that can be confused with this has been put on the article or its packaging, the building, the graphic image, or the recording medium or device holding a graphic image or its packaging:
  - (a) the act of transferring, leasing, or displaying for the purpose of transferring or leasing the article, building, or recording medium or device holding the graphic image;
  - (b) the act of providing the graphic image through a telecommunications line or displaying it for the purpose of providing it;
- (iii) an act falling under any of the following that a person does in connection with an article, building, graphic image, or recording medium or device holding a graphic image that does not constitute an article, building, or graphic image embodying a registered design or design similar to it or a recording medium or device holding a graphic image embodying a registered design or a design similar to it:
  - (a) the act of placing an indication in an advertisement showing that the article in question embodies, or the recording medium or device in question holds a graphic image that embodies, a registered design or a design similar to it, or of placing an indication that can be confused with this, for the purpose of having the article or recording medium or device holding the graphic image manufactured or used, or for the purpose of transferring or leasing it;
  - (b) the act of placing an indication in an advertisement showing that the

building in question embodies a registered design or a design similar to it, or of placing an indication that can be confused with this, for the purpose of having the building constructed or used, or for the purpose of transferring or leasing it;

- (c) the act of placing an indication in an advertisement showing that the graphic image in question embodies a registered design or a design similar to it, or of placing an indication that can be confused with this, for the purpose of having the graphic image created or used, or providing the graphic image through a telecommunications line.

(Design Gazette)

Article 66 (1) The Japan Patent Office issues the design gazette.

(2) In addition to what is provided for in this Act, the following matters must be published in the design gazette:

- (i) the extinguishment of design rights (excluding extinguishment upon expiration of the duration of the design right and extinguishment pursuant to the provisions of Article 44, paragraph (4)) or its restoration (limited to restoration pursuant to the provisions of Article 44-2, paragraph (2));
- (ii) the filing of requests for trials, appeals or retrials, or their withdrawals, or final and binding trial decisions, appeal decisions, or retrial decisions (limited to cases in which a registration of establishment of the design rights has been made);
- (iii) requests for an award, their withdrawal, or the Commissioner's decisions; and
- (iv) final and binding judgments in actions referred to in Article 59, paragraph (1) (limited to cases in which a registration of establishment of the design rights has been made).

(3) In addition to what is provided for in the preceding paragraph, if an application for design registration for which an examiner's decision of rejection or the trial and appeal board's decision to reject on the grounds that application falls under the provisions of the second sentence of Article 9, paragraph (2) has 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 (iii) must be published without delay after the lapse of the period designated pursuant to that paragraph (if secrecy was requested for two or more applications for design registration, the period which is the longest among the periods of secrecy requested for the applications) from the date the examiner's decision or trial or appeal decision became final and binding.

- (i) the name, and domicile or residence of the applicant for design registration;

- (ii) the application number and the filing date of the application for design registration;
- (iii) the content of the application and the content of the 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 specified by Cabinet Order in consideration of the actual costs:

- (i) a person that requests disclosure of a design pursuant to the provisions of Article 14, paragraph (4);
  - (ii) a person that notifies the succession pursuant to the provisions of Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (2);
  - (iii) a person that files a request for an extension of period pursuant to the provisions of Article 17-4, Article 43, paragraph (3), or Article 4 or Article 5, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of the following Article, or for a change of the due date pursuant to the provisions of Article 5, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of the following Article;
  - (iv) a person that files an application for international registration;
  - (v) a person that files a request for the reissuance of the certificate of design registration;
  - (vi) a person that files a request for the issuance of a certificate pursuant to the provisions of Article 63, paragraph (1);
  - (vii) a person that files a request for the issuance of a certified copy of documents or an extract of documents pursuant to the provisions of Article 63, paragraph (1);
  - (viii) a person that files a request to inspect or copy documents, models, or specimens pursuant to the provisions of Article 63, paragraph (1); and
  - (ix) a person that files a request for the issuance of documents which contain matters recorded on the magnetic tapes that constitute a part of the design register pursuant to the provisions of Article 63, paragraph (1).
- (2) A person listed in the middle column of the Attached Table must pay fees in their respective amount as provided by Cabinet Order within the amount specified in the corresponding right-hand column of the table.
- (3) The provisions of the preceding two paragraphs do not apply if the person required to pay the fees pursuant to these paragraphs is the national government.
- (4) If the national government has co-ownership of a design right or a right to have a design registration made with a person other than the national

government, and their respective ownership has been specified, notwithstanding the provisions of paragraph (1) or (2), the fees payable for the national government and a person other than the national government to have their own design right or a design registration made under those provisions (limited to the fees provided by Cabinet Order) must be determined as the sum of the fees multiplied by the ratio of the ownership of each person other than the national government, and, the person other than the national government must pay the amount.

- (5) If there is a fraction of less than 10 yen in the amount of the fees calculated pursuant to the preceding paragraphs, the fraction is to be discarded.
- (6) The payment of the fees referred to in paragraphs (1) and (2) must be made by patent revenue stamps as provided by Order of the Ministry of Economy, Trade and Industry provided, however, that cash payment may be made, if so specified by Order of the Ministry.
- (7) Fees paid in excess or in error are refunded upon the request of the person that made the payment.
- (8) No request for a refund of the fees under the preceding paragraph may be filed after one year has lapsed from the date on which the payment has been made.
- (9) Notwithstanding the provisions of paragraph (7), if, due to reasons beyond the control of a person that files a request for refund of fees under that paragraph, the person is unable to file the request within the period provided in the preceding paragraph, the person may file the request within 14 days (or, if the person is an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months after the lapse of the period.

(Mutatis Mutandis Application of the Patent Act)

- Article 68 (1) The provisions of Articles 3 through 5 (Periods and Due Dates) of the Patent Act apply mutatis mutandis to the periods and due dates provided in this Act. In this case, the term "Article 46-2, paragraph (1), item (iii), Article 108, paragraph (1), Article 121, paragraph (1), or Article 173, paragraph (1)" in Article 4 of the Patent Act is deemed to be replaced with "Article 43, paragraph (1), Article 46, paragraph (1), or Article 47, paragraph (1) of the Design Act, or Article 173, paragraph (1) as applied mutatis mutandis pursuant to Article 58, paragraph (1) of that Act".
- (2) The provisions of Articles 6 through 9, Articles 11 through 16, Article 17, paragraphs (3) and (4), Articles 18 through 24, and Article 194 (Procedures) of the Patent Act apply mutatis mutandis to procedures for an application for design registration or a request, and any other procedures related to design registration. In this case, the phrase "appeal against an examiner's decision of

refusal" in Article 9 of the Patent Act is deemed to be replaced with "appeal against an examiner's decision of refusal or appeal against an examiner's decision to dismiss amendment" and the phrase "appeal of the examiner's decision of rejection" in Article 14 of that Act is deemed to be replaced with "appeal against an examiner's decision of refusal or trial against an examiner's decision to dismiss amendment".

- (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 related to design registration.
- (4) The provisions of Article 26 (Effect of Treaties) of the Patent Act apply *mutatis mutandis* to 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 under this Act or an order based on this Act.
- (7) The provisions of Article 195-4 (Limitation on Request for Administrative Review Under the Provisions of the Administrative Complaint Review Act) of the Patent Act apply *mutatis mutandis* to a decision to dismiss amendment, examiner's decision, trial or appeal decision, or ruling to dismiss a written request for trial, appeal, or retrial, and dispositions of which no appeal may be filed in accordance with this Act, or their inaction.

## **Chapter VIII Penal Provisions**

### **(Crime of Infringement)**

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

Article 69-2 A person that has committed an act which is deemed to constitute infringement on a design right or an exclusive license pursuant to the provisions of Article 38 is punished by imprisonment for a term not exceeding 5 years, a fine not exceeding 5 million yen, or both.

### **(Crime of Fraud)**

Article 70 A person that has obtained a design registration or has been issued trial or appeal decision by means of a fraudulent act is punished by imprisonment for a term not exceeding one year or a fine not exceeding 1 million yen.

(Crime of False Indication)

Article 71 A person that violates the provisions of Article 65 is punished by imprisonment for a term not exceeding one year or a fine not exceeding 1 million yen.

(Crime of Perjury)

Article 72 (1) A witness, expert witness, or interpreter who has sworn an oath pursuant to this Act and then offered a false statement, a false expert opinion or interpretation to the Japan Patent Office or the court commissioned by the Office is punished by imprisonment for not less than three months but not more than ten years.

(2) If a person that has committed the crime referred to 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 trial or appeal decision has become final and binding, the punishment may be reduced or remitted.

(Crime of Divulging Secrets)

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

(Crime of Violating a Confidentiality Protective Order)

Article 73-2 (1) A person that violates an order given under Article 105-4, paragraph (1) of the Patent Act (including as applied mutatis mutandis pursuant to Article 65, paragraph (6) of the Act as applied mutatis mutandis pursuant to Article 60-12, paragraph (2)) as applied mutatis mutandis pursuant to Article 41 is punished by imprisonment for a term not exceeding five years, a fine not exceeding 5 million yen, or both.

(2) The crime referred to in the preceding paragraph may not be prosecuted unless a complaint is filed.

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

(Dual Criminal Liability Provision)

Article 74 (1) If a representative of a corporation or an agent, employee, or other worker of a corporation or an individual has committed a violation prescribed in the following items in the course of performing their duties for the

corporation or individual, in addition to the offender being punished, the corporation is punished by a fine as provided in the relevant item and the individual is punished by a fine as provided in the respective Articles:

- (i) Article 69, Article 69-2, or paragraph (1) of the preceding Article: a fine not exceeding 300 million yen; and
  - (ii) Article 70 or Article 71: a fine not exceeding 30 million yen.
- (2) In the case of the preceding paragraph, a criminal complaint referred to in the provisions of paragraph (2) of the preceding Article which is filed against the offender has effect on the corporation or the individual, and a criminal complaint filed against the corporation or the individual has effect on the offender.
- (3) The period of statute of limitations in cases where a fine is imposed on a corporation or an individual pursuant to the provisions of paragraph (1) with regard to a violation of Article 69, Article 69-2, or paragraph (1) of the preceding Article is that for the crimes in these provisions.

(Civil Fine)

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

**Article 76** A person that has been summoned by the Japan Patent Office or a court commissioned by the Office pursuant to the provisions of this Act, but fails to appear or refuses to swear an oath, make a statement, testify, give an expert opinion, or provide interpretation without legitimate grounds for doing so is subject to punishment by a civil fine not exceeding 100,000 yen.

**Article 77** A person that has been ordered by the Japan Patent Office or a court commissioned by the Office to submit or present documents, other objects, or electronic or magnetic records (meaning records used in computerized information processing which are created in electronic form, magnetic form, or any other form that cannot be perceived by the human senses) for the purpose of examination or preservation of evidence pursuant to the provisions of this Act but fails to comply with the order without legitimate grounds for doing so



is subject to punishment by a civil fine not exceeding 100,000 yen.

Appended Table (Re: Article 67)

	Person who must pay fees	Amounts
1	A person filing an application for design registration	16,000 yen per case
2	A person filing a request for secrecy of the design under Article 14, paragraph (1)	5,100 yen per case
3	A person undertaking any of the procedures pursuant to Article 43-2, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 15, paragraph (1) of this Act (including the case where it is 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), or Article 44-2, paragraph (1) of this Act (excluding a person who was to result in undertaking any of the procedures prescribed in these provisions due to reasons beyond the person's control)	25,000 yen per case
4	A person requesting an advisory opinion under Article 25, paragraph (1)	40,000 yen per case
5	A person filing a request for an extension of a period under Article 5, paragraph (3) of the Patent Act as applied mutatis mutandis under Article 68, paragraph (1) of this Act (except for the period designated in Article 50 of the Patent Act as applied mutatis mutandis under Article 19 of this Act)	4,200 yen per case
6	A person filing a request for an extension of period under Article 5, paragraph (3) of the Patent Act as applied mutatis mutandis under Article 68, paragraph (1) of this Act (limited for the period designated in Article 50 of the Patent Act as applied mutatis mutandis in Article 19 of this Act)	7,200 yen per case
7	A person requesting an award	55,000 yen per case

8	A person requesting canceling of an award	27,500 yen per case
9	A person filing a request for trial, appeal, or retrial	55,000 yen per case
10	A person applying for intervention in trial, appeal, or retrial	55,000 yen per case