Practical Guidance to Users for Meeting the Requirements Set by the Offices of Japan and the Republic of Korea

Seminar on the Hague System for the International Registration of Industrial Designs

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Today’s topics

1. Multiple designs application
2. Views
3. Related design
4. Priority claim
5. Exception to lack of novelty
# 1. Multiple designs application

<table>
<thead>
<tr>
<th>Japan</th>
<th>Republic of Korea</th>
</tr>
</thead>
<tbody>
<tr>
<td>“Only one independent and distinct design may be included in a single application” (Declaration under Article 13 of the 1999 Act)</td>
<td>Multiple designs application is accepted (No declaration under Art.13 of the 1999 Act)</td>
</tr>
</tbody>
</table>

### National application: in JP

An application for design registration shall be filed for each design.

**Application A**

- D1

**Application B**

- D2

**Application C**

- D3

**Application D**

- D4

### National application: in KR

An application containing several designs (max.100 designs) may be filed.

**Application A**

- D1
- D2

**Application A**

- D3
- D4
How the declaration under Art. 13 is implemented in JP?

International application:
According to the revised national law of Japan, “an international application containing several designs is deemed to be a bundle of several domestic applications filed for each design”.

International application
Designating Japan
May contain max. 100 designs belonging to the same class

The international registration
Divided by the JPO (the national application is created for each design)

Application A
D1
 Application B
D2
 Application C
D3
 Application D
D4
How the declaration under Art. 13 is implemented by the JPO?

- **No refusal** on the ground of containing multiple designs in the same IR
- **Notification of refusal or Statement of Grant of Protection prepared for each design** is sent to the IB
- **National application number** given to each design, which is required for the subsequent procedure before the JPO, **is indicated in the notification of refusal or the Statement of grant of protection**
2. Views

<table>
<thead>
<tr>
<th>Declaration under Rule 9(3) of the Common Regulations</th>
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<tbody>
<tr>
<td>Japan</td>
</tr>
<tr>
<td>✓ <strong>Six views</strong> <em>(a front view, a back view, a top view, a bottom view, a left side view and a right side view)</em> are required</td>
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<tr>
<td>✓ Each view shall be made in compliance with the method of <strong>orthographic projection</strong></td>
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<tr>
<td>✓ Only where the product which constitutes the industrial design is <strong>three-dimensional</strong></td>
</tr>
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</table>
Views required by the JPO

Submission of six views (front, rear, right side, left side, top and bottom views) are mandatory

Six views created by the orthographic projection method
Views required by the JPO

Even if protection of a design in a certain view is not requested, the view must be submitted by means for disclaimer (dotted or broken lines, or coloring).
Views required for a design of typefaces

views of the given characters

a sample sentence

The quick brown fox jumped over the lazy dog

typical characters

Registration No. : 30-0686789 (Design registration in Republic of Korea)
Views required by KIPO

Views required for a design of a set of articles*

One view of the coordinated whole of the several products

Corresponding views of each of the components

“Set of storage boxes for clearing up small objects”
(Registration No. 30-0505701: Design registration in Republic of Korea)

* Under the national law of KR, where a design is constituted by two or more articles which are used together and belong to any of the prescribed 86 categories of set of articles, and where such set of articles is coordinated as a whole, protection may be requested as for one design
Are rules and practices regarding views in each Office so different from the other?

“Electronic device” (title of invention in the US)

Pat. No. US D638030 S1

Description: [...] The shade lines in the Figures show contour or transparency and not surface ornamentation. The broken lines in the Figures show portions of the electronic device which form no part of the claimed design.

Reg. No. 1427809

Description: Parts represented by solid lines are parts for which the design registration as a partial design is sought. The lines shown in each representation by horizontal and parallel lines, vertical and parallel lines and oblique and parallel lines do not show surface ornamentation but show contour of the product.
Considerations regarding views

✓ To avoid a refusal on the ground of insufficient disclosure of a design, the appearance of each product should be fully disclosed
Considerations regarding views

- To avoid any confusion, the legend of each view should be precisely indicated.
If a certain view is omitted, it is recommended to explain in the description which view is omitted and why it is omitted.

Description:
“Left side view is omitted because it shows a symmetric image of the right side view.”
3. Related design

You can request protection of a design as a “related design” in the international application designating JP and KR
What is a “related design”? 

Several similar designs produced based on the same design concept.

Protection of several similar are requested by the same applicant.

Design B may be also protected as a “Related Design of a Principal design A”

Application A

Application B

A

B

filed on the same day

filed after the filing of application A (within a prescribed period)

Protection of both designs may be granted
How an international application can be filed for protection of a design as a related design?

**Principal design**

- Design A

**Related designs**

- Design B
- Design C

**Int. Application A**

- Principal design: Design A
- Related designs: Design B and C

**OR**

- Application/registration A (international/domestic)
  - Principal design: Design A of the application/registration A
  - Related design: Design B

**Int. Application B**

- Principal design: Design A of the application/registration A
- Related design: Design B

A single principle design corresponding to each related design (and the relevant application/registration) must be identified in the international application!

filed after the filing of the app.A (within a prescribed period)
4. Priority claim

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<tr>
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<td>may be made in the international application</td>
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<tr>
<td>Supporting document</td>
<td>must be submitted directly to the Offices within 3 months from the date of publication</td>
<td></td>
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</table>
Priority claim for JP and KR

Application

Priority period (6 months)

Design A

Int. application

Same as or similar to Design A

Design B

International publication

Designation: JP or KR with priority claim

(Supporting document cannot be attached to the IA)

Supporting document

within 3 months

Design B does not become a ground of refusal

Direct submission to JPO/ KIPO

In country A
5. Exception to lack of novelty

You can make a declaration to request the application of “exception to lack of novelty” when filing an international application designating JP or KR.
What is “Exception to lack of novelty”?

Disclosure of Design A

- In an exhibition, published materials such as a magazine, catalog, or through the internet media, etc.

Filing of an IA

- Filing within 6 months from the date of disclosure of Design A
- With declaration concerning exception to lack of novelty of Design A

Examination by JPO/KIPO

Disclosure of Design A does not become a reason for lack of novelty
Exception to lack of novelty for JP and KR

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<tr>
<td>- may be made in the international application</td>
<td>1. may be made in the international application</td>
<td></td>
</tr>
<tr>
<td>- may be made directly to the JPO within 30 days from the date of publication</td>
<td>2. may be also made, for instance, when an applicant submits an 'Opinion' against notification of refusal</td>
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<td>must be submitted directly to the JPO within <strong>30 days</strong> from the date of publication</td>
<td>In the case 1: must be attached to the international application by using ANNEX II (direct submission to the KIPO within 30 days from the date of the IR is also possible).</td>
<td></td>
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<td></td>
<td>In the case 2, at the time of making the declaration</td>
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Exception to lack of novelty for JP and ROK

As an exceptional treatment, Design A is not refused.

For the JPO:
Direct submission to the JPO within 30 days from the publication date.
Notes concerning exception to lack of novelty

☑ Do **NOT** use ANNEX II when declaration is made for JP

☑ The declaration might affect the applicant’s rights in other jurisdictions (it is the responsibility of the applicant to ensure that his rights are preserved).
Today’s conclusions

✓ Don’t worry about the declaration under Article 13 made by JP (it has no effect)

✓ Submit six views with their legends and you are never in trouble

✓ Ask yourself about related designs and prior disclosure before filing an international application designating JP or KR

✓ Try to make your international application your first application to avoid having to file a priority documentation later
Thank you!