



(Provisional Translation)

Design Law*
(Law No. 125 of April 13, 1959,
as amended by Law No. 220 of December 22, 1999)

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Attached Table (Related to Section 67)

CHAPTER I GENERAL PROVISIONS

Purpose

1. The purpose of this Law shall be to encourage the creation of designs by promoting their protection and utilization so as to contribute to the development of industry.

Definitions

2.—(1) “Design” in this Law means a shape, pattern or color or any combination thereof in an article (including part of an article — hereinafter the same except in Section 8) which produces an aesthetic impression on the sense of sight.

(2) “Registered design” in this Law means a design for which a design registration has been effected.

(3) “Working” of a design in this Law means any act of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease — hereinafter the same) of articles to which the design has been applied.

CHAPTER II DESIGN REGISTRATION AND APPLICATIONS THEREFOR

Registrability of Designs

3.—(1) Any person who has created a design capable of being used in industrial manufacture may obtain a design registration therefor, except in the case of the following designs:

(i) designs which were publicly known in Japan or elsewhere prior to the filing of the design application;

(ii) designs which were described in a publication distributed or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the design application;

(iii) designs which are similar to those referred to in the two preceding paragraphs.

(2) Where a design could easily have been created, prior to the filing of the design application, by a person with ordinary skill in the art to which the design pertains, on the basis of a shape, pattern or color or any combination thereof publicly known in Japan or overseas

(other than a design referred to in any of the paragraphs of the preceding subsection), a design registration shall not be effected for such a design, notwithstanding the preceding subsection.

3bis. Where a design in an application for a design registration is identical with or similar to part of a design stated in the request or represented in a drawing, photograph, model or sample attached to the request of another application for a design registration which was filed prior to the filing date of the design application and for which the publication in the Design Gazette under the provision of Section 20(3) or 66(3) was made after the date of filing of said application, a design registration shall not be effected for such a design, notwithstanding Section 3(1).

Exceptions to Lack of Novelty of Design

4.—(1) In the case of a design which has fallen under Paragraph (i) or (ii) of Section 3(1) against the will of the person having the right to obtain a design registration, such a design shall be deemed not to have fallen under Paragraph (i) or (ii) of Section 3(1) in the application of Section 3(1) and (2) to the design claimed in the application for design registration which has been filed by that person within six months from the date on which the design first fell under those paragraphs.

(2) In the case of a design which has fallen under Paragraph (i) or (ii) of Section 3(1) due to an act on the part of the person having the right to obtain a design registration, the same shall also apply to the application of Section 3(1) and (2) to the design claimed in the application for design registration which has been filed by such person within six months from the date on which the design first fell under those paragraphs.

(3) Any person who desires the application of the preceding subsections shall submit a written statement to that effect to the Commissioner of the Patent Office simultaneously with the application for design registration and also submit to the Commissioner of the Patent Office a document proving that the design which has fallen under Paragraph (i) or (ii) of Section 3(1) is a design to which the preceding subsection may be applied, within 14 days of the filing of the application for design registration.

Unregistrable Designs

5. A design registration shall not be effected for the following designs, notwithstanding Section 3:

- (i) designs liable to contravene public order or morality;
- (ii) designs liable to give rise to confusion with respect to articles connected with any other person's business;
- (iii) designs composed of only shapes indisposed to secure the functions of an article.

Applications for Design Registration

6.—(1) Any person desiring a design registration shall submit a request to the Commissioner of the Patent Office, together with a drawing of the design for which registration is sought, stating the following:

- (i) the name and the domicile or residence of the applicant for a design registration;
- (ii) the name and the domicile or residence of the creator of the design;
- (iii) the article or articles to which the design is applied.

(2) Whenever an ordinance of the Ministry of Economy, Trade and Industry so prescribes, a photograph, model or sample of the design for which registration is sought may be submitted instead of the drawing referred to in the preceding subsection. In such a case, the fact that a photograph, model or sample has been submitted shall be noted in the request.

(3) Where the statement referred to in Subsection 1 (iii) concerning the article or articles to which the design is applied, or of which the drawing, photograph or model is attached to the request, is not such as to enable a person with ordinary skill in the art to which the design pertains to visualize the material or dimensions of the article or articles to which the design is applied, so that such a person is unable to recognize the design, the material or dimensions referred to shall be stated in the request.

(4) Where the shape, pattern or color of an article to which the design is applied varies according to the function that the article possesses and where registration is sought for the shape, pattern or color or a combination thereof as it appears before, during and after the variation referred to, the request shall contain a statement to that effect as well as an explanation concerning the said function of the article.

(5) When the colors of the design are applied on the drawing, photograph or model submitted under Subsection (1) or (2), any parts that are white or black need not be colored.

(6) Where parts are not colored, in accordance with the preceding subsection, the request shall contain a statement to that effect.

(7) In the case of the drawing of a design submitted under Subsection (1) or the photograph or model submitted under Subsection (2), where the whole or part of the article to which the design has been applied is transparent, the request shall contain a statement to that effect.

Unity of Design

7. An application for a design registration shall relate to a single design corresponding to an article in the classes of articles prescribed by an ordinance of the Ministry of Economy, Trade and Industry.

Design of a Set of Articles

8. In the case of a design of two or more articles that are used together as a set of articles, for among the articles prescribed by an ordinance of the Ministry of Economy, Trade

and Industry (hereinafter referred to as a “set of articles”), an application for design registration may be made as for one design, provided that the set of articles is coordinated as a whole.

First-to-File Rule

9.—(1) Where two or more design applications relating to the same or a similar design are filed on different dates, only the first applicant may obtain a design registration for the design.

(2) Where two or more design applications relating to the same or a similar design are filed on the same date, only one such applicant, agreed upon after mutual consultation among all the applicants, may obtain a design registration for the design. If no agreement is reached or no consultation is possible, none of the applicants shall obtain a design registration for the design.

(3) Where a design application is surrendered, withdrawn or dismissed or where an examiner’s decision or trial decision that a design application is to be refused has become final and conclusive, such applications shall, for the purpose of Subsections (2) and (3), be deemed never to have been made. However, this provision shall not apply where an examiner’s decision or trial decision that the design application is to be refused under the provision of the last sentence of Subsection (2) becomes final and conclusive.

(4) A design application filed by a person who is neither the creator of the design nor the successor in title to the right to obtain design registrations shall, for the purposes of Subsections (1) and (2), be deemed not to be a design application.

(5) The Commissioner of the Patent Office shall, in the case of Subsection (2), order the applicant to hold consultations for an agreement under that subsection and to report the result thereof, within an adequate time limit.

(6) Where the report under the preceding subsection is not made within the time limit designated in accordance with that subsection, the Commissioner of the Patent Office may deem that no agreement under Subsection (2) has been reached.

Amendment of Statement in a Request or of Drawings, etc., and Change of Gist

9bis. Where, after registration of the establishment of the design right, it is found that an amendment of the statement in the request (excluding matters listed in Section 6(1)(i) and (ii) and matters described under Section 6(2) — referred to in Sections 17 *bis*(1) and 24 as “the statement in the request”) or of drawings, photographs, models or samples attached to the request has changed the gist thereof, the design applications shall be deemed to have been filed at the time when the amendment in writing was submitted.

Related Designs

10.—(1) Notwithstanding Section 9(2), an applicant for a design registration may obtain registration of a design which is similar to a principal design (meaning one design selected from designs in his own design applications) (hereinafter referred to as a “related design”), provided that the filing date of the application for the principal design [in the case of a design application containing a priority claim under Section 43(1) or Section 43 *bis*(1) or (2) of the Patent Law (Law No. 121 of 1959) as applied under Section 15 of this Law, the filing date of the first application or the application considered to be the first application in accordance with Article 4C(4) or A(2) of the Paris Convention (meaning the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967) or an application recognized as the first application in accordance with Article A(2) of the Paris Convention (hereinafter the same in this subsection)] is the same as the filing date of the application for the registration of that related design.

(2) A design registration shall not be effected for a design that is similar only to a related design to be registered under the preceding subsection.

(3) Where there are two or more design applications for related designs relating to the principal design, the provision of Section 9(2) shall not apply to these related designs.

Division of Design Applications

10bis.—(1) An applicant for a design registration may divide a design application comprising two or more designs into one or more new design applications, only during the pendency of the application in examination, trial or retrial.

(2) Where a design application has been divided under the preceding subsection, the new design applications shall be deemed to have been filed at the time of filing of the original application. However, this provision shall not apply for the purposes of Section 4(3) of this Law and Section 43(1) and (2) of the Patent Law as applied under Section 15(1) of this Law (including its application under Section 43 *bis*(3) of the Patent Law as applied under Section 15(1) of this Law).

(3) Where the new application for design registration under Subsection (1) is filed, any statements or documents which have been submitted with respect to the original application for design registration and which shall be submitted with respect to the new application for design registration in accordance with Section 4(3) of this Law or Section 43(1) and (2) of the Patent Law as applied under Section 15(1) of this Law (including its application under Section 43 *bis*(3) of the Patent Law as applied under Section 15(1) of this Law), shall be deemed to have been submitted to the Commissioner of the Patent Office simultaneously with the said new application for design registration.

11. [Deleted]

12. [Deleted]

Conversion of Applications

13.—(1) An applicant for a patent may convert this application into a design application. However, this provision shall not apply after 30 days from the transmittal of the examiner's first decision [including the transmittal thereof deemed to have been made under the provisions of the Law on Special Provisions for Procedures, etc. relating to Industrial Property (Law No. 30 of 1990)] that the patent application is to be refused.

(2) An applicant for a utility model registration may convert this application into a design application.

(3) The period prescribed in the proviso to Subsection (1) shall, when the time limit prescribed in Section 121 (1) of the Patent Law has been extended in accordance with Section 4 of that Law, be deemed to have been extended only for that period as extended.

(4) Where the conversion of an application is made under Subsection (1) or (2), the original application shall be deemed to have been withdrawn.

(5) Section 10 *bis* (2) and (3) shall apply *mutatis mutandis* to the conversion of an application under Subsection (1) or (2).

Special Provisions Concerning Conversion of Applications under the Patent Cooperation Treaty

13bis.—(1) Conversion of an international application having been deemed a patent application under Section 184 *ter* (1) or 184 *vicies* (4) of the Patent Law into a design application may not be made until, in respect of a Japanese language patent application referred to in Section 184 *sexies* (2) of the Patent Law, after the proceeding under Section 184 *quinquies* (1) of the Patent Law has been taken, and in respect of a foreign language patent application referred to in Section 184 *quater* (1) of the Patent Law, after the proceedings under the said subsection and Section 184 *quinquies* (1) of the Patent Law have been taken and, further, after the fee to be paid under Section 195 (2) of the Patent Law has been paid (or —in respect of an international application having been deemed a patent application under Section 184 *vicies* (4) of the Patent Law —after the decision referred to in the said subsection has been made).

(2) Conversion of an international application having been deemed a utility model application under Section 48 *ter* (1) or 48 *sedecies* (4) of the Utility Model Law (Law No. 123 of 1959) into a design application may not be made until, in respect of a Japanese language utility model application referred to in Section 48 *quinquies* (4) of the Utility Model Law, after the proceeding under Section 48 *quinquies* (1) of the Utility Model Law has been taken, and in respect of a foreign language utility model application referred to in Section 48 *quater* (1) of the Utility Model Law, after the proceedings under the said subsection and Section 48 *quinquies* (1) of the Utility Model Law have been taken and, further, after the fee to be paid under Section 54 (2) of the Utility Model Law has been paid (or —in respect of an international application having been deemed a utility model application under Section 48 *sedecies* (4) of the Utility Model Law —after the decision referred to in the said subsection has been made).

Secret Designs

14.—(1) An applicant for a design registration may demand that the design be kept secret for a period which shall be designated in the demand and shall not exceed three years from the date on which the establishment of the design right was registered.

(2) A person who desires to make that demand under the preceding subsection shall, at the time of filing the design application, submit to the Commissioner of the Patent Office a document stating the following:

- (i) the name and the domicile or residence of the applicant for a design registration;
- (ii) the period for which secrecy is demanded.

(3) An applicant for a design registration or the owner of a design right may extend or reduce the period for which secrecy is demanded under Subsection (1).

(4) In any of the following cases, the Commissioner of the Patent Office shall allow persons other than the owner of the design right to have access to a design for which secrecy has been demanded under Subsection (1):

- (i) when the consent of the owner of the design right has been obtained;
- (ii) when so requested by a party or an intervenor in the examination, trial, retrial or litigation relating to the design or any identical or similar design;
- (iii) when so requested by a court;
- (iv) when so requested by an interested person submitting to the Commissioner of the Patent Office a document stating the name of the owner of the design right and the registration number and other documents prescribed by an ordinance of the Ministry of Economy, Trade and Industry.

Application mutatis mutandis of Patent Law

15.—(1) Section 38 (joint applications), Section 43 (1) to (4) (priority claim under the Paris Convention) and Section 43 *bis* (such a priority claim as one under the Paris Convention) of the Patent Law shall apply *mutatis mutandis* to design applications. In such a case, “within one year and four months from the earliest date among the dates given in each of the following paragraphs” in Section 43 (2) of the Patent Law shall read “within three months from the filing date of the design application”.

(2) Sections 33 and 34 (1) and (2) and (4) to (7) (right to obtain patent) of the Patent Law shall apply *mutatis mutandis* to the right to obtain a design registration.

(3) Section 35 (employees' inventions) of the Patent Law shall apply *mutatis mutandis* to the creation of a design by an employee, an executive officer of a legal entity or a national or local public official.

CHAPTER III THE EXAMINATION

Examination by Examiner

16. The Commissioner of the Patent Office shall have applications for design registration examined by an examiner.

Examiner's Decision of Refusal

17. The examiners shall make a decision that a design application is to be refused where it falls under any of the following paragraphs:

(i) the design in the design application is not registrable in accordance with Section 3, 3bis, 5, 8, 9(1) or (2) or 10(1) or (2) of this Law, Section 38 of the Patent Law — as applied under Section 15(1) of this Law — or Section 25 of the Patent Law as applied under section 68(3) of this Law;

(ii) the design in the design application is not registrable in accordance with the provisions of a treaty;

(iii) the design application does not comply with the requirements of Section 7;

(iv) the applicant for design registration who is not the creator of the design has not succeeded to the right to obtain registration for the design concerned.

Declining of Amendments

17bis.—(1) Where an amendment of the statement in the request or of the drawings, the photographs, models or samples attached to the request would change the gist thereof, the examiners shall decline the amendment by a ruling.

(2) The ruling to decline an amendment under the preceding subsection shall be in writing and state the reason therefor.

(3) Where a ruling to decline an amendment under Subsection (1) has been rendered, the examiner's decision with respect to the design application shall not be rendered before the expiration of 30 days from the transmittal of that ruling.

(4) Where an applicant has demanded a trial under Section 47 (1) against a ruling to decline an amendment under Subsection (1), the examiners shall suspend the examination of the design application until the trial decision has become final and conclusive.

New Application for Design as Amended

17ter.—(1) Where an applicant for design registration has filed a new design application for the design as amended within 30 days from the transmittal of a ruling to



decline an amendment under Section 17 *bis*(1), the design application shall be deemed to have been filed at the time of submission of that amendment.

(2) Where a new design application referred to in the preceding subsection has been filed, the original design application shall be deemed withdrawn.

(3) The two preceding subsections shall be applicable only where the applicant has submitted, at the same time as the new design application, a statement to the Commissioner of the Patent Office indicating his desire for the application of Subsection (1) to the new design application referred to in that subsection.

17^{quater}.—(1) The Commissioner of the Patent Office may, for the benefit of a person residing in a place that is remote or difficult of access, extend upon request *ex officio* the period prescribed in Subsection (1) of the preceding section.

(2) The tria examiner-in-chief may, for the benefit of a person residing in a place that is remote or difficult of access, extend upon request *ex officio* the period prescribed in Section 17^{ter} (1) as applied under Section 50(1) (including its application under Section 57(1)).

Decision to Register Design

18. Where the examiner finds no reason for refusing a design application, he shall make a decision that the design is to be registered.

Application mutatis mutandis of Patent Law

19. Section 47(2) (qualifications of examiners), Section 48 (exclusion of examiners), Section 50 (notification of reasons for refusal), Section 52 (formal requirements of examiner's decision) and Section 54 (relationship with litigation) of the Patent Law shall apply *mutatis mutandis* to the examination of design applications.

CHAPTER IV THE DESIGN RIGHT

1. The Design Right

Registration of Establishment of Design Right

20.—(1) A design right shall come into force upon registration of its establishment.

(2) The establishment of a design right shall be registered when the annual fee for the first year under Section 42(1)(i) has been paid.

(3) When registration under the preceding subsection has been effected, the following shall be published in the Design Gazette (Ishô Kôhô):

- (i) the name and the domicile or residence of the owner of the design right;
- (ii) the number and the date of the design application;
- (iii) the registration number and the date of registration of the establishment;
- (iv) the contents of the request and the drawing, photograph, model or sample attached to the request;
- (v) necessary matters other than those listed in the preceding paragraphs.

(4) In the case of a design for which secrecy has been demanded under Section 14(1), the matters referred to in Paragraph (iv) of the preceding subsection shall, notwithstanding Section 14(1), be published immediately after the period designated under Section 14(1) has expired.

Term of Design Right

21.—(1) The term of a design right (excluding a right of a related design) shall be 15 years from the date of registration of its establishment.

(2) The term of a right of a related design shall be 15 years from the date of registration of the principal design right.

Effect of Design Rights

22.—(1) Rights of a principal design and a related design relating thereto may not be transferred independently.

(2) Where a principal design right is extinguished under the provision of Section 44(4), is abandoned, or a trial decision to invalidate has become final and conclusive, the right of the related design relating to the principal design may not be transferred independently.

Effect of Design Right

23. The owner of a design right shall have an exclusive right to commercially work the registered design and design similar thereto. However, where the design right is the subject of an exclusive license, this provision shall not apply to the extent that the exclusive licensee has an exclusive right to work the registered design and design similar thereto.

Scope of Registered Design

24. The scope of a registered design shall be decided on the basis of the statement in the request and the design represented in the drawing attached to the request or shown in the photograph, model or sample attached to the request.

25.—(1) A request for interpretation may be made to the Patent Office with respect to the scope of a registered design and design similar thereto.

(2) Where such a request is made, the Commissioner of the Patent Office shall designate three trialexaminers to give the requested interpretation.

(3) Section 71(3) and (4) of the Patent Law shall apply *mutatis mutandis* to the interpretation under Subsection (1).

25bis.—(1) Where the Commissioner of the Patent Office is commissioned by a court to give an expert opinion with respect to the scope of a registered design and design similar thereto, he shall appoint three trialexaminers to give the opinion.

(2) Section 71 *bis*(2) of the Patent Law shall apply *mutatis mutandis* to the commission therefor under the preceding subsection.

Relationship with Another's Registered Design, etc.

26.—(1) When a registered design would utilize another person's registered design or design similar thereto, patented invention or registered utility model under an application filed prior to the filing date of the design application concerned, or when the part of a design right relating to the registered design conflicts with another person's patent, utility model or trademark right under an application filed prior to the filing date of the design application concerned, or conflicts with another person's copyright taking effect prior to that date, the owner of the design right, exclusive licensee or non-exclusive licensee shall not commercially work the registered design.

(2) When a design similar to a registered design would utilize another person's registered design or design similar thereto, patented invention or registered utility model under an application filed prior to the filing date of the design application concerned, or when the part of a design right relating to design similar to the registered design conflicts with another person's design, patent, utility model or trademark right under an application filed prior to the filing date of the design application concerned, or conflicts with another person's copyright taking effect prior to that date, the owner of the design right, exclusive licensee or non-exclusive licensee shall not commercially work the design similar to the registered design.

Exclusive Licenses

27.—(1) The owner of a design right may grant an exclusive license on the design right. The exclusive license on a right of a principal design or rights of related designs may be granted only where the exclusive license on the right of the principal design and the rights of all related designs relating thereto is granted simultaneously to the same party.

(2) An exclusive licensee shall have an exclusive right to commercially work the registered design and design similar thereto to the extent laid down in the license contract.

(3) Where the design right of a principal design is extinguished under Section 44(4), is abandoned, or a trial decision to invalidate becomes final and conclusive, the exclusive

license on the rights of related designs may be granted only where the exclusive license on the rights of all related designs is granted simultaneously to the same party.

(4) Section 77(3) to (5) (transfer etc.), Section 97(2) (surrender) and Section 98(1)(ii) and (2) (effects of registration) of the Patent Law shall apply *mutatis mutandis* to exclusive licenses.

Non-Exclusive Licenses

28.—(1) The owner of a design right may grant an non -exclusive license on such right.

(2) An non -exclusive licensee shall have the right to commercially work the registered design and designs similar thereto to the extent prescribed in this Law or laid down in the license contract.

(3) Section 73(1) (joint ownership), Section 97(3) (surrender) and Section 99 (effects of registration) of the Patent Law shall apply *mutatis mutandis* to non -exclusive licenses. In such a case “Section 79” in Subsection (2) of the same sections shall read “Section 29 or 29 *bis* of the Design Law” .

Non-Exclusive License by Virtue of Prior Use

29. Where, without knowledge of a design in a design application, a person has created the design or a design similar thereto by himself, without knowledge of the design in the design application, has learnt the design from another person who has created the design or the design similar thereto, and has been commercially working the design or the design similar thereto or has been making preparation therefor in Japan at the time of filing of the design application or at the time of filing of the original design application or of submission of an amendment when the design application is deemed to have been filed at the time of submission of the amendment in accordance with Section 9 *bis* of this Law or in accordance with Section 17 *ter* (1) (including its application under Section 50(1) (including its application under Section 57(1) of this Law)), such person shall have a non -exclusive license on the design right under the design application limited to the extent of the design which is being worked or for which preparations for working are being made and to the purpose of such working or the preparation therefor.

Non-Exclusive License by Virtue of Preceding Application

29bis. Where, without knowledge of a design in a design application, a person has created the design or a design similar thereto by himself or has learnt the design from another person who has created the design or the design similar thereto, without knowledge of the design in the design application and has been commercially working the design or the design similar thereto or has been making preparation therefor in Japan at the time of registration of the establishment of the design right under the design application, such person (excluding a person falling under the provision of the preceding section) shall have a non -exclusive license on the design right limited to the extent of the design which is being worked or for which

preparations for working are being made and to the purpose of such working provided that each of the following is satisfied:

(i) that the person has filed, prior to the filing date of the design application, a design application with respect to his own design or the design similar thereto and has been commercially working the design or making preparation therefor; and

(ii) that the person has received, with respect to his own design application referred to in the preceding paragraph, an examiner's decision or a trial decision to the effect that the design in the design application falls under any of the paragraphs of Section 3(1) and the application is to be refused, and such decision has become final and conclusive.

*Non-Exclusive License due to Working
Prior to Registration of Demand for Invalid Design Trial*

30.—(1) When a person coming within any of the paragraphs set out below has been commercially working a design or design similar thereto in Japan or has been making preparations therefor, prior to the registration of a demand for a trial under Section 48(1), without knowing that the design registration falls under any of the paragraphs of the subsection referred to, such person shall have a non-exclusive license on the design right or on the exclusive license existing at the time when the design registration was invalidated, to the extent of the design being worked or preparations being made for its commercial working :

(i) the original owner of the design right where one of two or more design registrations granted for the same or a similar design has been invalidated;

(ii) the original owner of the design right, where his design registration has been invalidated and a design registration for the same or a similar design has been granted to the person entitled;

(iii) in the case referred to in the two preceding paragraphs, a person who, at the time of registration of the demand for a trial under Section 48(1), has an exclusive license on the design right that has been invalidated or a non-exclusive license which is effective, under Section 99(1) of the Patent Law as applied under Section 28(3) of this Law, against the design right or the exclusive license.

(2) The owner of the design right or the exclusive license shall have a right to a reasonable remuneration as consideration for the non-exclusive license under the preceding subsection.

Non-Exclusive License after Expiration of Design Right, etc.

31.—(1) Where one design application was filed prior to or on the filing date of another design application and part of the design right (relating to design similar to the registered design concerned) under the first-mentioned application conflicts with the design right under the other application and the term of the first-mentioned design right has expired, the owner of the original design right shall, to the extent of such right, have a non-exclusive license on

the other design right or the exclusive license existing at the time when his design right expired.

(2) Where a patent right or a utility model right under an application filed prior to or on the filing date of a design application conflicts with the design right under that application, the preceding subsections shall apply *mutatis mutandis* where the term of the patent right or utility model right has expired.

32.—(1) Where one design application was filed prior to or on the filing date of another design application and part of the design right (relating to designss similar to the registered design concerned) under the first -mentioned application conflicts with the design right under the other application and the term of the first -mentioned design right has expired, a person who, at the time of expiration, has an exclusive license on the expired design right or an -exclusive license which is effective under Section 99(1) of the Patent Law, as applied under Section 28(3) of this Law, against the expired design right or the exclusive license, shall, to the extent of the expired right, have an -exclusive license on the other design right or on the exclusive license existing when the first -mentioned design right has expired.

(2) Where a patent right or a utility model right under an application filed prior to or on the filing date of a design application conflicts with the design right under that application, the preceding subsections shall apply *mutatis mutandis* where the term of the patent right or utility model right has expired.

(3) The owner of the design right or the exclusive license shall have a right to a reasonable remuneration as consideration for the non -exclusive license under the two preceding subsections.

Arbitration Decision on Grant of Non -Exclusive License

33.—(1) Where a registered design or designs similar thereto falls under any of the cases provided for in Section 26, the owner of the design right or the exclusive license may request the other person referred to in that section to hold consultations on the grant of a non -exclusive license to work the registered design or the designs similar thereto or of a non -exclusive license on the patent right or the utility model right.

(2) The other person referred to in Section 26 who has been requested to hold the consultations under the preceding subsection may request the owner of the design right or the exclusive license having requested the consultation to hold consultations on the grant of a non-exclusive license within the scope of the registered design which the owner of the design right or the exclusive license desires to work by obtaining the non -exclusive license on the design right, the patent right or the utility model right through the consultations requested by the owner of the design right or the exclusive license.

(3) If no agreement is reached or no consultation is possible under Subsection (1), the owner of the design right or the exclusive license may request the Commissioner of the Patent Office for an arbitration decision.

(4) If no agreement is reached or no consultation is possible under Subsection (2) and an arbitration under the preceding subsection is requested, the other person referred to in Section 26 may request the Commissioner of the Patent Office for an arbitration decision only within the time limit which the Commissioner of the Patent Office designates as the time limit for the other person to submit a written reply in accordance with Section 84 of the Patent Law as applied under Subsection (7).

(5) If, in the case of Subsection (3) or the preceding subsection, the grant of a non-exclusive license would unduly injure the interests of the other person referred to in Section 26 or the owner of the design right or the exclusive licensee, the Commissioner of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted.

(6) In the case of Subsection (4) in addition to the case provided for in the preceding subsection, the Commissioner of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted if an arbitration decision ordering a non-exclusive license to be granted is not rendered with respect to the request for the arbitration decision under Subsection (3).

(7) Sections 84, 85(1) and 86 to 91 *bis* (arbitration procedure, etc.) of the Patent Law shall apply *mutatis mutandis* to arbitration under Subsection (3) or (4).

Transfer, etc. of Non-Exclusive License

34.—(1) A non-exclusive license, with the exception of one which results from an arbitration under Section 33(3) or (4) of this Law, Section 92(3) of the Patent Law or Section 22(3) of the Utility Model Law, may be transferred, but only together with the business in which it is worked or only with the consent of the owner of the design right (or the owner and the exclusive licensee in the case of a non-exclusive license on an exclusive license) or in the case of inheritance or other general succession.

(2) A non-exclusive license may, except in the case of a non-exclusive license resulting from an arbitration under Section 33(3) or (4) of this Law, Section 92(3) of the Patent Law or Section 22(3) of the Utility Model Law, establish a pledge on the non-exclusive license but only with the consent of the owner of the design right (or the owner and the exclusive licensee in the case of a non-exclusive license on an exclusive license).

(3) A non-exclusive license resulting from an arbitration under Section 33(3) of this Law, Section 92(3) of the Patent Law or Section 22(3) of the Utility Model Law shall be transferred together with the design, patent or utility model right to which the non-exclusive license is entitled and which is transferred together with the business in which it is worked and shall be extinguished at the time when such design, patent or utility model right has been transferred separately from the business in which it is worked or has been extinguished.

(4) A non-exclusive license resulting from an arbitration under Section 33(4) of this Law shall be transferred together with the design, patent or utility model right to which the non-exclusive license is entitled, and shall be extinguished at the time when such design, patent or utility model right has been extinguished.

Pledges

35.—(1) Where a design right or an exclusive or non-exclusive license is the subject of a pledge, the pledgee may not work the registered design or design similar thereto except as otherwise provided by contract.

(2) Section 96 (attachment) of the Patent Law shall apply *mutatis mutandis* to pledges on a design right, exclusive license or non-exclusive license.

(3) Section 98 (1) (iii) and (2) (effects of registration) of the Patent Law shall apply *mutatis mutandis* to pledges on a design right or exclusive license.

(4) Section 99 (3) (effects of registration) of the Patent Law shall apply *mutatis mutandis* to pledges on a non-exclusive license.

Application mutatis mutandis of Patent Law

36. Section 69 (1) and (2) (limits of patent right), Section 73 (joint ownership), Section 76 (extinguishment of patent right in absence of heir), Section 97 (1) (surrender) and Section 98 (1) (i) and (2) (effects of registration) of the Patent Law shall apply *mutatis mutandis* to design rights.

2. Infringement

Injunctions

37.—(1) The owner of a design right or exclusive license may require a person who is infringing or is likely to infringe the design right or exclusive license to discontinue or refrain from such infringement.

(2) The owner of a design right or exclusive license who is acting under the preceding subsection may demand the destruction of the articles by which the act of infringement was committed, the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

(3) In the case of a design for which secrecy has been demanded under Section 14 (1), the owner of the design right or exclusive license may not take the action provided for in Subsection (1) until he has given a warning in the form of a document which states the matters referred to in each paragraph of Section 20 (3) and which has been certified by the Commissioner of the Patent Office.

Acts Deemed to be Infringement

38. Acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in the course of trade, things to be used exclusively for the manufacture of the article to which the registered design or design similar thereto has been applied shall be deemed to be an infringement of the design right or exclusive license.

Presumption, etc. of Amount of Damage

39.—(1) Where the owner of a design right or exclusive license claims, from a person who has intentionally or negligently infringed the design right or exclusive license, compensation for damage caused to him by the infringement, and the person's act is the assignment of articles by which the act of the infringement was committed, the sum of money with the unit price of such articles multiplied by the number of articles (hereinafter referred to in this paragraph as the "number of assigned articles") which the owner of the design right or exclusive license could have sold in the absence of the infringement may be estimated as the amount of damages suffered by the owner of the design right or exclusive license within a limit not exceeding an amount attainable depending on working capability of the owner of the design right or exclusive license. Where there is any circumstance that prevents the owner of the design right or exclusive license from selling part or the whole of the number of assigned articles, a sum equivalent to the number of assigned articles subject to that circumstance shall be deducted.

(2) Where the owner of a design right or exclusive license claims, from a person who has intentionally or negligently infringed the design right or exclusive license, compensation for damage caused to him by the infringement, the profits gained by the infringer through the infringement shall be presumed to be the amount of damages suffered by the owner or exclusive licensee.

(3) The owner of a design right or exclusive license may claim, from a person who has intentionally or negligently infringed the design right or exclusive license, an amount of money which he would be entitled to receive for the working of the registered design or design similar thereto, as the amount of damages suffered by him.

(4) The preceding subsections shall not preclude a claim to damages exceeding the amount referred to therein. In such a case, where there has been either willfulness or gross negligence on the part of the person who has infringed the design right or the exclusive license, the court may take this into consideration when awarding damages.

Presumption of Negligence

40. A person who has infringed a design right or exclusive license of another person shall be presumed to have been negligent as far as the act of infringement is concerned. However, this provision shall not apply with respect to the infringement of a design right or exclusive license relating to a design for which secrecy has been demanded under Section 14(1).

Application mutatis mutandis of Patent Law

41. Sections 104 *bis* 106 (obligation to clarify relevant act in concrete manner, production of documents, etc., expert opinion for proof of damage, award of reasonable damages, and measures for recovery of reputation) of the Patent Law shall apply *mutatis mutandis* to the infringement of a design or an exclusive license.

3. Annual Fees

Annual Fees

42.—(1) A person who obtains registration of a design right or the owner of a design right shall pay as annual fees the amounts specified below, for each case and for each year until the expiration of the design right under Section 21:

- (i) first to third year: 8,500 yen per annum;
- (ii) fourth to tenth year: 16,900 yen per annum;
- (iii) eleventh to fifteenth year: 33,800 yen per annum.

(2) The preceding subsections shall not apply to design rights belonging to the State or independent administrative institutions (referring to the independent administrative institutions prescribed in Section 2(1) of the Law concerning the General Provisions of Independent Administrative Institutions (Law No. 103 of 1999), hereinafter referred to as the Law) which are to be set up by Cabinet Order by taking into consideration the substance of their business and other circumstances.

(3) The provision of Subsection (1) shall not apply to a design right owned jointly by the State and the independent administrative institutions prescribed by Cabinet Order in the preceding subsection or owned jointly by the independent administrative institutions prescribed by Cabinet Order in the same subsection.

(4) Where the State and the like (referring to the State or the independent administrative institutions prescribed by Cabinet Order in Subsection (2), the same in Section 67(3) and (5)) and the person other than the State and the like (referring to the person other than the State and the independent administrative institutions prescribed by Cabinet Order in Subsection (2), hereinafter referred to as the same in this subsection and the same section (5)) own jointly a design right and there is an agreement with respect to their shares of the right, the annual fees under Subsection (1) shall be a sum with prescribed fees under this subsection multiplied by the ratio of the share of the person other than the State and the like, and the person other than the State and the like shall pay such sum, notwithstanding the provision of Subsection (1).

(5) Where the amount of the fees calculated in accordance with the provision of the preceding subsection has a fractional figure less than 10 yen, that fractional figure shall be discarded.

(6) The payment of the fees under Subsection (1) shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where so prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

Time Limit for Payment of Annual Fees

43.—(1) The annual fee for the first year under Section 42(1)(i) shall be paid within 30 days from the transmittal of the examiner's decision or registration is to be effected. (i) shall be paid within 30 days from the transmittal of the examiner's decision or registration is to be effected.

(2) The annual fees for these second and subsequent years under Section 42(1) shall be paid during the preceding year or prior thereto.

(3) Upon the request of a person liable to pay an annual or registration fee, the Commissioner of the Patent Office may extend the period prescribed in Subsection (1) by a period not exceeding 30 days.

Late Payment of Annual Fees

44.—(1) Where the owner of a design right is unable to pay an annual fee within the time limit prescribed in Section 43(2), he may pay the annual fee belatedly within six months from the expiration of that time limit.

(2) In the case of late payment of an annual fee in accordance with the preceding subsection, the owner of the design right shall, in addition to the annual fee provided for in Section 42(1), pay a surcharge of the same amount as the annual fee.

(3) The payment of the fee under the preceding subsections shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where the reverse is prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

(4) Where the owner of a design right fails to pay an annual fee and the surcharge under the preceding subsection within the time limit for late payment under Subsection (2), the design right shall be deemed to have been extinguished retroactively from the moment that the time limit prescribed in Section 43(2) expired.

Restoration of Design Right by Late Payment of Annual Fees

44bis.—(1) Where the original owner of the design right which is deemed to have been extinguished under Section 44(4) is unable to pay an annual fee and the surcharge prescribed in Section 44(4) within the time limit within which he may pay the annual fee and surcharge belatedly under Section 44(1) due to reasons outside his control, he may pay the annual fee and surcharge belatedly but only within 14 days (where he is a resident abroad, within two months) and within six months after the expiration of the time limit.

(2) Where the annual fee and surcharge prescribed in Subsection (1) are paid, such design right shall be deemed to have been maintained retroactively from the time of the expiration of the time limit prescribed in Section 43(2).

Restriction on Effects of Design Right Restored

44ter.—(1) Where a design right has been restored under Section 44 *bis*(2), the effects of the design right shall not extend to any article to which there is a registered design or design similar thereto has been applied and which was imported into, manufactured or acquired in Japan after the expiration of the time limit within which he may pay an annual fee belatedly under Section 44(1) but before the registration of the restoration of the design right.

(2) The effects of a design right which has been restored under Section 44 *bis*(2) shall not extend to the following acts after the expiration of the time limit within which he may pay an annual fee belatedly under Section 44(1) but before the registration of the design:

(i) the working of the design or designs similar thereto;

(ii) acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, things to be used exclusively for the manufacture of an article to which there is a registered design or design similar thereto has been applied.

Application mutatis mutandis of Patent Law

45. Section 110 (payment of annual fees by an interested person) and Section 111(1) [excluding (iii)] and (2) (refund of annual fees) of the Patent Law shall apply *mutatis mutandis* to the annual fees under this Law.

CHAPTER V
TRIAL

Trial Against Examiner's Decision of Refusal

46.—(1) A person who has received the examiner's decision that his application is to be refused and is dissatisfied may demand a trial thereon within 30 days from the transmittal of the examiner's decision.

(2) Where, due to reasons outside his control, a person is unable to demand a trial under the preceding subsection within the time limit prescribed therein, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.

Trial Against Ruling to Decline Amendment

47.—(1) A person who has received a ruling to decline an amendment under Section 17 *bis*(1) of this Law and is dissatisfied may demand a trial thereon within 30 days from the transmittal of the ruling. However, this provision shall not apply when a new application for a design registration has been filed under Section 17 *ter*(1).

(2) Section 46(2) shall apply *mutatis mutandis* to the demand for a trial under the preceding subsection.

Trial for Invalidation of Design Registration

48.—(1) In the following cases, a trial may be demanded for the invalidation of a design registration:

(i) where the registration has been effected contrary to Section 3, 3 *bis*, 5, 9(1) or (2) or 10(2) or to Section 38 of the Patent Law as applied under Section 15(1) of this Law or to Section 25 of the Patent Law as applied under Section 68(3) of this Law ;

(ii) where the registration has been effected contrary to the provisions of a treaty;

(iii) where the registration has been effected in respect of a design application filed by a person who is not the creator of the design and has not succeeded to the right to obtain a design registration for the design concerned;

(iv) where, after the registration, the owner of the design right has become a person who can no longer enjoy such right under Section 25 of the Patent Law as applied under Section 68(3) of this Law or the registration no longer complies with a treaty.

(2) Even after the extinguishment of a design right, a trial under the preceding subsection may be demanded.

(3) Where a trial under Subsection (1) has been demanded, the trial examiner-in-chief shall notify the exclusive licensee with respect to the design right and other persons who have any registered rights relating to the design registration.

49. Where a trial decision that a design registration is to be invalidated has become final and conclusive, the design right shall be deemed never to have existed. However, where a design registration fell under Section 48(1)(iv) and a trial decision that the registration is to be invalidated has become final and conclusive, the design right shall be deemed not to have existed from the time when the registration first fell under that paragraph.

Application mutatis mutandis of Provisions Concerning Examination

50.—(1) Sections 17 *bis* and 17 *ter* shall apply *mutatis mutandis* to the trial under Section 46(1). In such a case, “has demanded a trial under Section 47(1)” in Section 17 *bis*(4) shall read “has instituted an action under Section 59(1)” .

(2) Section 18 shall apply *mutatis mutandis* where a demand for a trial under Section 46(1) is considered acceptable. However, this provision shall not apply where a trial decision is rendered ordering a further examination in accordance with Section 160(1) of the Patent Law as applied under Section 52 of this Law.

(3) Section 50 (notification of reasons for refusal) of the Patent Law shall apply *mutatis mutandis* where a reason for refusal not contained in the examiner’s decision is found in the trial under Section 46(1).

Special Provisions for Trials Against Ruling to Decline Amendment

51. The adjudication in the case of a trial decision after a trial under Section 47(1) to the effect that the ruling shall be cancelled shall be binding on the examiner with respect to the case concerned.

Application mutatis mutandis of Patent Law

52. Sections 131(1) and (2), 132 to 133 *bis*, 134(1), (3) and (4), 135 to 154, 155(1) and (2), 156 to 158, 160(1) and (2), 161 as well as Sections 167 to 170 (demands for trial, trial examiners, trial proceedings, relationship with litigation and costs of trial) of the Patent Law shall apply *mutatis mutandis* to trials under this Law. In such a case, “Section 121(1)” in Section 161 and “Section 121(1) or 126(1)” in Section 169(3) of the Patent Law shall read “Section 46(1) or 47(1) of the Design Law”.

CHAPTER VI
RETRIAL AND LITIGATION

Demand for Retrial

53.—(1) Against a final and conclusive trial decision, the party concerned or an interventionally demand a retrial.

(2) Sections 338(1) and (2) and 339 (grounds for retrial) of the Code of Civil Procedure (Law No. 109 of 1996) shall apply *mutatis mutandis* to demands for a retrial under the preceding subsection.

54.—(1) Where the demandant and the defendant in a trial have in collusion caused a trial decision to be rendered, with the purpose of injuring the rights or interests of a third person, such person may demand a retrial against the final and conclusive trial decision.

(2) In such a retrial, the demandant and the defendant shall be made joint defendants.

Restriction on Effects of Design Rights Restored by Retrial

55.—(1) Where a design right relating to an invalidated design registration has been restored through a retrial, the effects of the design right shall not extend to any article to which the registered design or a design similar thereto has been applied and which was imported into, manufactured or acquired in Japan, in good faith after the time when the trial decision became final and conclusive but before the demand for a retrial was registered.

(2) Where a design right relating to an invalidated design registration has been restored through a retrial, the effects of the design right shall not extend, after the trial decision became final and conclusive but before the registration of the demand for a retrial, to the following acts:

(i) the working of the design or design similar thereto in good faith;

(ii) acts of manufacturing, assigning, leasing, importing or offering for assignment or lease of, in good faith, things to be used exclusively for the manufacture of an article to which the registered design or designs similar thereto has been applied.

56. Where a design right relating to an invalidated design registration has been restored through a retrial or where the establishment of a design right under a design application which was refused by a trial decision has been registered through a retrial, and where a person has, in good faith, been commercially working the design or designs similar thereto in Japan or has, in good faith, been making preparations therefor, after the trial decision becomes final and conclusive but before the registration of the demand for a retrial, such persons shall have a non-exclusive license on the design right, to the extent of the design being worked or preparations being made for its commercial working.

Application mutatis mutandis of Provisions on Trial

57.—(1) Sections 50(1) and (3) shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision on a trial under Section 46(1).

(2) Section 51 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision on a trial under Section 47(1).

Application mutatis mutandis of Patent Law

58.—(1) Sections 173 and 174(5) of the Patent Law shall apply *mutatis mutandis* to retrials under this Law.

(2) Sections 131, 132(3) and (4), 133, 133 *bis*, 134(4), 135 to 147, 150 to 152, 155(1), 156 to 158, 160, 168, 169(3) to (6) and 170 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision in a trial under Section 46(1). In such a case, “Section 121(1) or 126(1)” in Section 169(3) of the Patent Law shall read “Section 46(1) of the Design Law”.

(3) Sections 131, 132(3) and (4), 133, 133 *bis*, 134(4), 135 to 147, 150 to 152, 155(1), 156, 157, 168, 169(3) to (6) and 170 shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision in a trial under Section 47(1). In such a case, “Section 121(1) or 126(1)” in Section 169(3) of the Patent Law shall read “Section 47(1) of the Design Law”.

(4) Section 174(3) shall apply *mutatis mutandis* to a retrial against a final and conclusive trial decision under Section 48(1).

Actions Against Trial Decisions, etc.

59.—(1) An action against a trial decision or a ruling to decline an amendment under Section 17 *bis* (1) as applied under Section 50(1) (including its application under Section 57(1)) or an action against a ruling of dismissal of a demand for a retrial or a retrial shall come under the exclusive jurisdiction of the Tokyo High Court.

(2) Section 178(2) to (6) (time limit for institution of action, etc.) and Sections 179 to 182 (defendant in the action, notification of institution of action, annulment of trial decision or ruling, and sending of certified copy of judgment) of the Patent Law shall apply *mutatis mutandis* to actions under the preceding subsection.

Actions on Amount of Remuneration

60.—(1) Where a person who is concerned in an arbitration decision under Section 33(3) or (4) is dissatisfied with the amount of remuneration fixed in the decision, he may institute an action for the increase or decrease of the remuneration.

(2) Section 183(2) (time limit for institution of action) and Section 184 (defendant in the action) of the Patent Law shall apply *mutatis mutandis* to actions under the preceding subsection.

Relationship Between Administrative Appeal and Litigation

60bis. Section 184bis (relationship between administrative appeal and litigation) of the Patent Law shall apply *mutatis mutandis* to actions for the annulment of measures (with the exception of measures under Section 68(7)) taken under this Law or an order or ordinance thereunder.

CHAPTER VII MISCELLANEOUS PROVISIONS

Amendment

60ter. With respect to a procedure relating to a design application, a demand or other procedure relating to design registration, the person carrying on such procedure may make an amendment only during the pendency of the case in the examination, trial or retrial.

Registration in Design Register

61.—(1) The following matters shall be registered in the Design Register kept in the Patent Office:

(i) the establishment, transfer, extinguishment, restoration or restriction on disposal of a design right;

(ii) the establishment, maintenance, transfer, modification, extinguishment or restriction on disposal of an exclusive or non-exclusive license;

(iii) the establishment, transfer, modification, extinguishment or restriction on disposal of rights in a pledge upon a design right or an exclusive or non-exclusive license.

(2) The Design Register, either in whole or in part, may be prepared by means of magnetic tapes (including other material on which matters can be accurately recorded by an equivalent method — hereinafter referred to as “magnetic tapes”).

(3) Other matters relating to registration that are not provided for in this Law shall be prescribed by Cabinet Order.

Issuance of Design Registration Certificate

62.—(1) When the establishment of a design right has been registered, the Commissioner of the Patent Office shall issue a design registration certificate to the owner of the registered design.

(2) Re-issuance of the certificate shall be prescribed by an ordinance of the Ministry of Economy, Trade and Industry.

Request for Certification, etc.

63.—(1) Any one may request the Commissioner of the Patent Office to issue a certificate, a copy or an extract of documents, to allow the inspection or copying of documents, models or samples or issued documents whose contents are recorded in the part of the Design Register prepared by magnetic tapes, where such documents, models or samples relate to design registrations. However, this provision shall not apply in the case of the following documents, models or samples if the Commissioner of the Patent Office considers it necessary to keep them secret:

(i) a request, a drawing, photograph, model or sample attached thereto or documents concerning the examination of a design application, where the design registration concerned has not been effected;

(ii) a document, model or sample, where the secrecy of the design concerned has been demanded under Section 14(1);

(iii) documents concerning a trial under Section 46(1) or 47(1), where a design registration has not been effected with respect to the design application pending in the trial case;

(iv) documents concerning a trial under Section 48(1) or a retrial of the final and conclusively decided trial, with respect to which the parties or intervenors concerned have given a notice that there has been described a trade secret (meaning the trade secret as referred to in Section 2(4) of the Unfair Competition Prevention Law (Law No. 47 of 1993)) owned by the parties or intervenors concerned;

(v) matters liable to damage the reputation or peaceful existence of an individual;

(vi) documents liable to contravene public order or morality.

(2) Where a demand made with respect to documents, models or samples as prescribed in the paragraphs of the preceding subsection is accepted, the Commissioner of the Patent

Offices shall notify a person, who has submitted such documents, models or samples, to that effect with a reason therefor.

(3) The Law Concerning Access to Information held by Administrative Organs (Law No. 42 of 1999) shall not apply to the documents concerning design registrations and the part of the Design Register, which have been prepared by magnetic tapes.

Indication of Existence of Design Registration

64. The owner of a design right or an exclusive or non-exclusive license shall take steps, as prescribed in an ordinance of the Ministry of Economy, Trade and Industry, to mark articles to which a registered design or a design similar thereto has been applied or the packaging of such articles, with a statement to the effect that the articles are covered by a registered design or a design similar thereto (hereinafter referred to as "indication of a design registration").

Prohibition of False Marking

65. The following acts shall be unlawful:

(i) the marking of an article to which a registered design or a design similar thereto has not been applied or the packaging of such article, with an indication of a design registration or a confusingly similar indication;

(ii) the assignment, lease or display for the purpose of assignment or lease of an article to which a registered design or a design similar thereto has not been applied, where such article or its packaging is marked with an indication of a design registration or a confusingly similar indication;

(iii) the inclusion in an advertisement of an indication that an article is covered by a registered design or a design similar thereto or of a confusingly similar indication, for the purpose of causing others to produce or use the article or of assigning or leasing it, where a registered design or a design similar thereto has not been applied to the article.

Design Gazette

66.—(1) The Patent Office shall publish the Design Gazette (Ishô Kôhô).

(2) In addition to those provided for in this Law, the Design Gazette shall contain the following matters:

(i) the extinguishment (with the exception of extinguishment due to expiration of term and extinguishment under Section 44(4)) or restoration (limited to that under Section 44bis(2)) of a design right;

(ii) demands for a trial or retrial or withdrawal thereof and final and conclusive decisions of a trial or retrial (limited where the establishment of a design right is registered);

(iii) requests for an arbitration decision or withdrawal thereof and arbitration decisions;

(iv) final judgments in an action under Section 59(1) (limited where the establishment of a design right is registered).

(3) Where an examiner's decision or a trial decision that a design application is to be refused under the provision of the last sentence of Section 9(2) has become final and conclusive, the under-mentioned matters relating to the design application shall be published in the Design Gazette in addition to those mentioned in the paragraphs of the preceding subsection. In the case where such design application is one in which secrecy has been demanded under Section 14(1), all the matters prescribed in Paragraph (iii) shall be published without delay after the expiration of a period designated under the same subsection (where there are two or more design applications in which secrecy is demanded, whichever the demanded secrecy period is longer) following the date when an examiner's decision or a trial decision that the design application is to be refused has become final and conclusive :

- (i) the name and the domicile or residence of an applicant for a design application;
- (ii) the application number and filing date of the application;
- (iii) the request and the contents of drawings, photographs, models or samples attached thereto;
- (iv) necessary matters other than those listed in the preceding paragraph (iii).

Fees

67.—(1) The persons specified hereunder shall pay the fee the amount of which shall be prescribed by Cabinet Order with the actual cost taken into consideration:

- (i) person requesting access to design in accordance with Section 14(4);
- (ii) person making notification of succession in accordance with Section 34(4) of the Patent Law as applied under Section 15(2);
- (iii) person requesting extension of time limit under Sections 4 and 5(1) of the Patent Law as applied under Sections 17 *quater*, 43(3) or 68(1), or change of date under Section 5(2) of the Patent Law as applied under Section 68(1) of the said Law;
- (iv) person requesting re-issuance of design registration certificate;
- (v) person requesting issuance of certificate in accordance with Section 63(1);
- (vi) person requesting issuance of copy or extract of documents in accordance with Section 63(1);
- (vii) person requesting inspection or copying of documents, models or samples in accordance with Section 63(1);



(viii) person requesting issuance of documents containing matters recorded in that part of the Design Register as prepared on magnetic tapes, in accordance with Section 63(1).

(2) The persons specified in the left-hand column of the attached table shall pay the fee the amount of which shall be prescribed by Cabinet Order within the limit of the amounts specified in the right-hand column of the table.

(3) The two preceding subsections shall not apply where the person to pay the fee in accordance with these subsections is the State and the like .

(4) The provisions of Subsections (1) and (2) shall not apply where the person to pay the fee in accordance with these provisions is the State entitled to own jointly a design right or a right to obtain a design registration and the independent administrative institutions prescribed by Cabinet Order in Section 42(2), or the independent administrative institutions entitled to own jointly such rights prescribed by Cabinet Order in the same subsection .

(5) Where the State and the like and the person other than the State and the like own jointly a design right or a right to obtain a design registration and there is an agreement with respect to their share of the right, the annual fees under Subsection (1) or (2) (limited to the fees prescribed by Cabinet Order) shall be a sum with prescribed fee under these subsections multiplied by the ratio of the shares of the persons other than the State and the like, and the persons other than the State and the like shall pay such sum, notwithstanding the provision of these subsections.

(6) Where the amount of the fee calculated in accordance with the provision of the preceding subsection has a fractional figure less than 10 yen, that fractional figure shall be discarded.

(7) The payment of the fee under Subsection (1) or (2) shall be made by patent revenue stamps as prescribed by an ordinance of the Ministry of Economy, Trade and Industry. However, where so prescribed by an ordinance of the Ministry of Economy, Trade and Industry, such payment may be made in cash.

(8) A fee paid by mistake or in excess shall be refunded upon the request of the person making the payment.

(9) No request for a refund of a fee under the preceding subsection may be made after one year from the date of payment.

Application mutatis mutandis of Patent Law

68.—(1) Sections 3 to 5 (time limits and dates) of the Patent Law shall apply *mutatis mutandis* to the time limits and dates prescribed in this Law. In such a case, “Section 121(1)” in Section 4 of the Patent Law shall read “Section 46(1) or 47(1) of the Design Law” .

(2) Sections 6 to 9, 11 to 16, 17(3) and (4) and 18 to 24 as well as Section 194 (proceedings) of the Patent Law shall apply *mutatis mutandis* to design applications, demands and any other proceedings relating to design registrations. In such a case, “Section 121(1)” in

Section 9 of the Patent Law shall read “Section 46(1) or 47(1) of the Design Law”, and “Section 121(1)” in Section 14 of the Patent Law shall read “Section 46(1) or 47(1) of the Design Law”.

(3) Section 25 (enjoyment of rights by aliens) of the Patent Law shall apply *mutatis mutandis* to design rights and to the rights relating to design registrations.

(4) Section 26 (effect of treaties) of the Patent Law shall apply *mutatis mutandis* to design registrations.

(5) Sections 189 to 192 (transmittal) of the Patent Law shall apply *mutatis mutandis* to transmit a design under this Law.

(6) Section 195 *ter* of the Patent Law shall apply *mutatis mutandis* to measures under this Law or an order or ordinance thereunder.

(7) Section 195 *quater* (restriction on appeals under Administrative Appeal Law) of the Patent Law shall apply *mutatis mutandis* to ruling to decline an amendment, examiners' decisions, trial decisions and rulings of dismissal of a demand for trial or retrial under this Law as well as to measures from which no appeal lies under this Law.

CHAPTER VIII PENAL PROVISIONS

Offense of Infringement

69. Any person who has infringed a design right or an exclusive license shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 3,000,000 yen.

Offense of Fraud

70. Any person who has obtained a design registration or a trial decision by means of a fraudulent act shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 1,000,000 yen.

Offense of False Marking

71. Any person infringing Section 65 shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 1,000,000 yen.

Offense of Perjury, etc.

72.—(1) A witness, expert witness or interpreter who, having taken an oath under this Law, has made a false statement or has given a false expert opinion or has interpreted falsely before the Patent Office or a court commissioned thereby shall be liable to imprisonment with labor for a term of not less than three months nor more than ten years.

(2) Where a person committing the offense in the preceding subsection has made a voluntary confession before, concerning the case, the certified copy of the interpretation is transmitted or the examiner's decision or trial decision has become final and conclusive, his sentence may be reduced or suppressed.

Offense of Divulging Secrets

73. Where any presenter or former official of the Patent Office has divulged or made surreptitious use of these secrets relating to a design in a design application to which he had access in the course of his duties, he shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 500,000 yen.

Dual Liability

74. Where an officer representing a legal entity or a representative, employee or any other servant of a legal entity or of a natural person has committed an act in violation of Sections listed in the following paragraphs with regard to the business of the legal entity or natural person, the legal entity or the natural person shall, in addition to the offender, be liable to the fine prescribed in those paragraphs :

- (i) Section 69, a fine not exceeding 100 million yen;
- (ii) Section 70 or 71, a fine not exceeding 30,000,000 yen .

Administrative Penalties

75. Where a person who has taken an oath under Section 207(1) of the Code of Civil Procedure as applied under Section 151 of the Patent Law as applied under Section 71(3) of the Patent Law as applied under Section 25(3) of this Law or under Section 52 of this Law or under Section 58(2) or (3) of this Law or under 174(3) of the Patent Law as applied under Section 58(4) of this Law, respectively has made a false statement before the Patent Office or a court commissioned thereby, he shall be liable to an administrative penalty not exceeding 100,000 yen.

76. Where a person who has been summoned by the Patent Office or a court commissioned thereby in accordance with this Law has failed to appear or has refused to take an oath, to make a statement, to testify, to give an expert opinion or to interpret, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 100,000 yen.

77. Where a person who has been ordered by the Patent Office or a court commissioned thereby to produce or show documents or other evidence in accordance with the provisions of this Law relating to the examination or preservation of evidence has failed to comply with the order, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 100,000 yen.

Attached Table (Related to Section 67)



	<i>Person liable to pay</i>	<i>Amounts</i>
1.	Person filing design application	¥16,000 per case
2.	Person demanding secrecy of design in accordance with section 14(1)	¥5,100 per case
3.	Person requesting interpretation in accordance with Section 25(1))	¥40,000 per case
4.	Person requesting arbitration design	¥55,000 per case
5.	Person requesting cancellation of arbitration decision	¥27,500 per case
6.	Person demanding trial or retrial	¥55,000 per case
7.	Person demanding intervention in trial or retrial	¥55,000 per case

* Entry into force : January 6, 2001 (Section 63(3) shall enter into force as of April 1, 2001.)