

# Design Act

(Act No. 125 of April 13, 1959)

## Chapter I General Provision

(Purpose)

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

(Definition, etc.)

Article 2 (1) "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

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

(3) "Use" of a design in this Act shall mean the manufacturing, using, assigning, leasing, exporting or importing, or offering for assignment or lease (including displaying for the purpose of assignment or lease, the same shall apply hereinafter) of an article to the design.

(4) "Registered design" in this Act shall mean a design for which a design registration has been granted.

## Chapter II Design Registrations and Applications for Design Registration

(Conditions for Design Registration)

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

(i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;

(ii) Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration; or

- (iii) Designs similar to those prescribed in the preceding two items.
- (2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

Article 3-2 Where a design in an application for design registration is identical with or similar to part of a design described in the statement in the application and drawing, photograph, model or specimen attached to the application of another application for design registration which has been filed prior to the date of filing of the said application and published after the filing of the said application in the design bulletin under Article 20(3) or Article 66(3) (hereinafter referred to in this Article as the "earlier application"), a design registration shall not be granted for such a design, notwithstanding paragraph (1) of the preceding Article; provided, however, that this shall not apply where the applicant of the said application and the applicant of the earlier application are the same person and the said application was filed before the date when the design bulletin in which the earlier application was published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) was issued.

(Exception to lack of novelty of design)

- Article 4 (1) In the case of a design which has fallen under item (i) or (ii) of Article 3(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 item (i) or (ii) of Article 3(1) for the purposes of Article 3(1) and (2) for any design in an application for design registration which has been filed by the said person within six months from the date on which the design first fell under either of those items.
- (2) In the case of a design which has fallen under item (i) or (ii) of Article 3(1) as a result of an act of the person having the right to obtain a design registration, the preceding paragraph shall also apply for the purposes of Article 3(1) and (2) to any design in an application for design registration which has been filed by the said person within six months from the date on which the design first fell under either of those items.
  - (3) Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration, a document stating thereof and, within thirty days from the date of filing of the application for design registration, a document proving

the fact that the design which has otherwise fallen under item (i) or (ii) of Article 3(1) is a design to which the preceding paragraph may be applicable.

(Unregistrable designs)

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

- (i) a design which is liable to injure public order or morality;
- (ii) a design which is liable to create confusion with an article pertaining to another person's business; or
- (iii) a design solely consisting of a shape that is indispensable for securing functions of the article.

(Application for design registration)

Article 6 (1) A person requesting a design registration shall submit to the Commissioner of the Patent Office an application stating the following matters and drawing depicting the design for which registration is requested:

- (i) the name, and domicile or residence of the applicant for the design registration;
  - (ii) the name and domicile or residence of the creator of the design; and
  - (iii) the article to the design.
- (2) Where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, the applicant may submit photograph, model or specimen representing the design for which the registration is requested, in lieu of the drawing in the preceding paragraph. In such case, the applicant shall indicate in the application which among photograph, model and specimen is submitted.
- (3) When neither the statement of the article to the design required under item (iii) of paragraph (1), nor the drawing, photograph or model attached to the application would enable a person ordinarily skilled in the art to which the design pertains to understand the material or size of the article, and by this reason such a person would not be able to recognize the design, the material or size of the article to the design shall be specified in the application.
- (4) Where the shape, patterns or colors of the article to the design is changeable based on the function possessed by the article, if the applicant intends to request a design registration of the shapes, patterns or colors, or a combination thereof as it appears before, during and after the said change, he/she shall state such an intention and include an explanation of said function of the article in the application.
- (5) Where colors of the design are applied to the drawing, photograph or model to be submitted under paragraph (1) or (2), the applicant may omit to apply either black or white to them.
- (6) When the applicant omits to apply black or white under the preceding paragraph, the applicant shall state thereof in the application.

(7) Where the applicant submits the drawing depicting the design under paragraph (1) or the photograph or model representing the design under paragraph (2), if the whole or part of the article to the design is transparent, the applicant shall state thereof in the application.

(One application per design)

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

(Design for a set of articles)

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

(Prior application)

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

(2) Where two or more applications for design registration have been filed for identical or similar designs on the same date, only one applicant, who was selected by consultations between the applicants who filed the said applications, shall be entitled to obtain a design registration for the design. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a design registration for the design.

(3) Where an application for design registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that an application for design registration is to be refused has become final and binding, the application for design registration shall, for the purpose of the preceding two paragraphs, be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the application for design registration is to be refused has become final and binding on the basis that the latter sentence of the preceding paragraph is applicable to said application for design registration.

(4) An application for design registration filed by a person who neither has

created a design nor is the successor in title to the right to obtain a design registration shall, for the purpose of application of paragraphs (1) and (2), be deemed never to be an application for design registration.

- (5) The Commissioner of the Patent Office shall, in the case of paragraph (2), order the applicants to hold consultations as specified under paragraph (2) and to report the result thereof, designating an adequate time limit.
- (6) Where no report under the preceding paragraph is submitted within the time limit designated under said paragraph, the Commissioner of the Patent Office may deem that no agreement under paragraph (2) has been reached.

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

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

(Related designs)

Article 10 (1) Notwithstanding Article 9(1) or (2), an applicant for design registration may obtain design registration of a design that is similar to another design selected from the applicant's own designs either for which an application for design registration has been filed or for which design registration has been granted (hereinafter the selected design is referred to as the "Principal Design" and a design similar to it is referred to as a "Related Design"), if the filing date of the application for design registration of the Related Design (or when the application for design registration of the Related Design contains a priority claim under Article 43(1), 43-2(1) or 43-2(2) of the Patent Act (Act No. 121 of 1959) as applied mutatis mutandis under Article 15 of this Act, the filing date of the earliest application, the filing date of an application that is deemed to be the earliest application under Article 4.C(4) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, or the filing date of an application that is recognized as the earliest application under Article 4.(A)2 of the Paris Convention, hereinafter the same shall apply in this paragraph) is on or after the filing date of the application for design registration of the Principal

Design and before the date when the design bulletin in which the application for design registration of the Principal Design is published under Article 20(3) (except for a design bulletin in which the matters listed in Article 20(3)(iv) were published under Article 20(4)) is issued.

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

(Division of applications for design registration)

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

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

Article 11 Deleted

Article 12 Deleted

(Conversion of application)

- Article 13 (1) An applicant of a patent may convert the patent application into an application for design registration; provided, however, that this shall not apply after the expiration of 30 days from the date the certified copy of the examiner's initial decision to the effect that the patent application is to be refused has been served (including the case where it is deemed that service of such a certified copy is made under the provision of the Act on Special Provisions to the Procedure, etc. Relating to an Industrial Property Right (Act No.30 of 1990)).
- (2) An applicant of a utility model registration may convert the application for a utility model registration into an application for design registration
- (3) Where the period as provided in Article 121(1) of the Patent Act is extended under Article 4 of said Act, the period as provided in the proviso to paragraph (1) shall be deemed to have been extended only for that period as extended.
- (4) Where an application is converted under paragraph (1) or (2), the original application shall be deemed to have been withdrawn.
- (5) Articles 10-2(2) and (3) shall apply mutatis mutandis to the case of conversion of an application under paragraph (1) or (2).

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

- Article 13-2 (1) An international application that has been deemed to be a patent application under Article 184-3(1) or 184-20(4) of the Patent Act may be converted to an application for design registration, only after the fees payable under Article 195(2) of said Act have been paid (or, in the case of an international application that is deemed to be a patent application under Article 184-20(4) of said Act, after the ruling as provided in 184-20(4) has been rendered), and, in the case of a Patent Application in Japanese Language under Article 184-6(2) of said Act, the procedures under Article 184-5(1) of said Act have been completed, or, in the case of a Patent Application in Foreign Language under Article 184-4(1) of said Act, the procedures under Articles 184-4(1) and 184-5(1) of said Act have been completed.
- (2) An international application that has been deemed to be an application for utility model registration under Article 48-3(1) or 48-16(4) of the Utility Model Act (Act No. 123 of 1959) may be converted to an application for design registration, only after the fees payable under Article 54(2) of said 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(4) of said Act, after the ruling as provided in Article 48-16(4) has been rendered), and, in the case of a Utility Model Application in Japanese under Article 48-5(4) of said Act, the procedures under Article 48-5(1) of said Act have been completed, or,

in the case of a Utility Model Application in Foreign Language under 48-4(1) of said Act, the procedures under Articles 48-4(1) and 48-5(1) of said Act have been completed.

(Secret design)

Article 14 (1) An applicant for design registration may request that the design be kept in secret for a period that shall be designated in the request and shall be no more than three years from the date of the registration establishing the design right.

(2) A person filing a request prescribed in the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the application for design registration or payment of registration fee for the first year under Article 42(1), a document stating the following:

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

(ii) the period for which the secrecy is requested.

(3) The applicant for design registration or the holder of design right may request extension or reduction of the period for which the secrecy is requested under paragraph (1).

(4) The Commissioner of the Patent Office shall disclose the design for which the secrecy is requested under paragraph (1) to persons other than the holder of the design right, when:

(i) consent of the holder of the design right to do so has been obtained;

(ii) so requested by a party or an intervenor of examination, trial, retrial or litigation relating to the design or a design identical with or similar to the design;

(iii) so requested by a court; or

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

(Application mutatis mutandis of provisions of the Patent Act)

Article 15 (1) Articles 38 (joint applications), 43(1) to (4) (procedures for a priority claim under the Paris Convention) and 43-2 (priority claims recognized under the Paris Convention) of the Patent Act shall apply mutatis mutandis to applications for design registration. In this case, the term "within one year and four months from the earliest of the following dates:" in Article 43(2) of said Act shall be deemed to be replaced with "within three months from the date of filing of the application for design registration."

(2) Article 33 and Article 34(1), (2) and (4) to (7) of the Patent Act (right to obtain



patent) shall apply mutatis mutandis to the right to obtain the design registration.

- (3) Article 35 (inventions by employees) of the Patent Act shall apply mutatis mutandis to creation of a design by an employee, an officer of a juridical person, or a national or local government employee.

### **Chapter III Examination**

(Examination by examiner)

Article 16 The Commissioner of the Patent Office shall direct the examination of applications for design registration by an examiner.

(Examiner's decision of refusal)

Article 17 The examiner shall render an examiner's decision to the effect that an application for design registration is to be refused where the application for design registration falls under any of the following:

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

(Dismissal of amendments)

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

- (2) The ruling dismissing an amendment under the preceding paragraph shall be made in writing and state the reasons therefor.
- (3) Where the ruling dismissing an amendment under the preceding paragraph (1) has been rendered, the examiner shall not render a decision on the application for design registration before the expiration of 30 days from the date on which a certified copy of the ruling has been served.
- (4) Where an applicant for design registration files a request for a trial against an examiner's ruling dismissing an amendment under paragraph 1,

examination of the application for design registration shall be suspended until the trial decision becomes final and binding.

(New application for amended design)

Article 17-3 (1) Where an applicant for design registration files, within 30 days from the date on which a certified copy of the ruling dismissing an amendment under paragraph 1 of the preceding Article has been served, a new application for design registration for the amended design, the new application shall be deemed to have been filed at the time when the written amendment of proceedings for the said amendment was submitted.

(2) Where a new application for design registration is filed under the preceding paragraph, the original application for design registration shall be deemed to have been withdrawn.

(3) The preceding two paragraphs shall apply only when the applicant for design registration has submitted to the Commissioner of the Patent Office, at the time of the filing of a new application, a document stating a request for the application of paragraph 1 to the new application for design registration under paragraph 1.

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

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

(Examiner's decision to the effect that a design registration is to be granted)

Article 18 Where no reasons for refusal are found for an application for design registration, the examiner shall render a decision to the effect that a design registration is to be granted.

(Application mutatis mutandis of provisions of the Patent Act)

Article 19 Articles 47(2) (qualifications of examiners), 48 (exclusion of examiners), 50 (notice of reasons for refusal), 52 (formal requirements for decision) and 54 (in relation to litigation) of the Patent Act shall apply mutatis mutandis to examination of applications of design registration.

## **Chapter IV Design Right**

### **Section 1 Design Rights**

(Registration of establishment of a design right)

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

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

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

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

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

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

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

(v) other necessary matters.

(4) With regard to the design for which secrecy is requested under Article 14(1), notwithstanding the preceding paragraph, matters provided for in item (iv) of the preceding Article shall be published without delay after the lapse of the period designated under Article 14(1).

(Duration of design rights)

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

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

(Transfer of the design right of a Related Design)

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

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

(Effect of design right)

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

licensed to exclusively work the registered design and designs similar thereto.

(Scope of registered design, etc.)

- Article 24 (1) The scope of a registered design shall be determined based upon the design stated in the application and depicted in the drawing or represented in the, photograph, model or specimen attached to the application.
- (2) Whether a registered design is identical with or similar to another design shall 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 Patent Office for its advisory opinion on the scope of a registered design and designs similar thereto.
- (2) Where a request under the preceding paragraph is made, the Commissioner of the Patent Office shall designate three trial examiners to make an advisory opinion on the requested matter.
- (3) Article 71(3) and (4) of the Patent Act shall apply mutatis mutandis to the advisory opinion under paragraph (1).

- Article 25-2 (1) Where the Commissioner of the Patent Office is commissioned by the court for the provision of an expert opinion on the scope of a registered design and designs similar thereto, the Commissioner of the Patent Office shall appoint three trial examiners and direct them to provide an expert opinion on the requested matter.
- (2) Article 71-2(2) of the Patent Act shall apply mutatis mutandis to the commissioning of the provision of an expert opinion prescribed in the preceding paragraph.

(Relationship to registered designs, etc. held by others)

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

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

(Exclusive license)

- Article 27 (1) A holder of a design right may grant an exclusive license on the design right; provided, however, an exclusive license on a design right of a Principal Design or exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Principal Design and its Related Designs are granted to the same person at the same time.
- (2) An exclusive licensee shall have an exclusive right to work the registered design or designs similar thereto as a business to the extent permitted by the contract granting the license.
- (3) Where the design right of a Principal Design has been extinguished under Article 44(4), a trial decision to the effect that the design right of a Principal Design is to be invalidated has become final and binding, or the design right of a Principal Design has been waived, exclusive licenses on design rights of its Related Designs may be granted only where all the exclusive licenses on the design rights of the Related Designs are granted to the same person at the same time.
- (4) Articles 77 (iii) to (v) (Transfer, etc.), 97(2) (Waiver, etc.) and 98(1)(ii) and (2) (effect of registration) of the Patent Act shall apply mutatis mutandis to exclusive licenses.

(Non-exclusive license)

- Article 28 (1) A holder of a design right may grant a non-exclusive license on the design right to any third party.
- (2) A non-exclusive licensee shall have a right to work the registered design or designs similar thereto as a business to the extent prescribed by this Act or permitted by the contract granting the license.
- (3) Articles 73(1) (Jointly owned patent rights), 97(3) (Waiver) and 99 (Effect of registration) of the Patent Act shall apply mutatis mutandis to non-exclusive licenses. In this case, "Article 79" in Article 99(2) of said Act shall be deemed to be replaced with "Article 29 or 29-2 of the Design Act."

(Non-exclusive license based on prior use)

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

(Non-exclusive license based on prior application)

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

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

(Non-exclusive license due to the working of the design prior to the registration)

of the request for a trial for invalidation)

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

- (i) the original holder of a design right in the case where one of two or more design registrations granted for the same or similar design has been invalidated,
  - (ii) the original holder of a design right in the case where, after a design registration has been invalidated, a design registration is granted to the person who is entitled to obtain a design registration for the same or similar design,
  - (iii) in the case referred to in items (i) and (ii)], a person that, at the time of the registration of the request for a trial for invalidation of design registration, has an exclusive license regarding the design right to be invalidated, or a non-exclusive license effective under Article 99(1) of the Patent Act as applied *mutatis mutandis* under Article 28(3) regarding the design right or an exclusive license on the design right.
- (2) The holder of a design right or the exclusive licensee shall have a right to receive reasonable consideration from the non-exclusive licensee under the preceding paragraph.

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

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

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

- Article 32 (1) Where part of a design right that pertains to designs similar to the registered design with regard to an application for a design registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application, a person who, at the time of expiration of the duration of the design right, actually owns the exclusive license on the expired design right, or a non-exclusive license having effect under Article 99(1) of the Patent Act as applied under Article 28(3) of the design Act on the design right or on the exclusive license shall, upon expiration of the duration of the design right, have a non-exclusive license on the design right or on the exclusive license actually existing at the time of expiration of the duration of the design right, limited to the extent of the original right.
- (2) The preceding paragraph shall apply mutatis mutandis to the case where a patent right or utility model right with regard to an application for registration filed on or before the date of filing of a design application is in conflict with the design right with regard to the design application upon expiration of the duration of the patent right or utility model right.
- (3) The holder of a design right or the exclusive licensee shall have a right to receive reasonable consideration from the non-exclusive licensee under the preceding two paragraphs.

(Award granting non-exclusive license)

- Article 33 (1) Where a registered design or a design similar thereto falls under any of the cases as provided in Article 26, the holder or exclusive licensee of the design right may request the other person under the said Article to hold consultations to discuss granting a non-exclusive license to work the registered design or a design similar thereto or a non-exclusive license on the patent right or the utility model right.
- (2) The other person under Article 26 who is requested to hold consultations under the preceding paragraph may request the holder of design right or exclusive licensee requesting such consultations to hold consultations to discuss granting a non-exclusive license to the extent of the registered design or a design similar thereto that the said holder of design right or exclusive licensee intends to work with a non-exclusive license on the design right, on the patent right or on the utility model right granted through consultations
- (3) Where no agreement is reached by consultations or no consultations are able to be held as provided in paragraph (1), the holder of design right or the exclusive licensee may request the Commissioner of the Patent Office for an award.
- (4) Where no agreement is reached by consultations or no consultations are able to be held as provided in paragraph (2) and where a request for an award is filed under the preceding paragraph, the other person under Article 26 may



request the Commissioner of the Patent Office for an award only within the time limit for the submission of a written answer by the said other person designated by the Commissioner of the Patent Office under Article 84 of the Patent Act as applied mutatis mutandis under paragraph (7) .

- (5) In the case of paragraph (3) or (4), the Commissioner of the Patent Office shall not render an award to the effect that a non-exclusive license is to be granted where the granting of the non-exclusive license will be unreasonably prejudicial to the interests of the other person under Article 26, the holder of design right or the exclusive licensee.
- (6) In the case of paragraph (4), in addition to the case provided for in the preceding paragraph, the Commissioner of the Patent Office shall not render an award ordering a non-exclusive license to be granted if an award ordering a non-exclusive license to be granted is not rendered with respect to the request for an award under paragraph (3).
- (7) Articles 84, 85(1) and 86 to 91-2 (procedures for award) of the Patent Act shall apply mutatis mutandis to the award under paragraph (3) or (4).

(Transfer, etc. of non-exclusive license)

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

(4) A non-exclusive license granted by an award under paragraph (4) of the preceding Article shall be 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 shall be extinguished in the case where the said design right, patent right or utility model right is extinguished.

(Right of pledge)

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

(2) Article 96 (extension of a right of pledge to the proceeds of the patent right, etc.) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a design right, exclusive license or non-exclusive license.

(3) Article 98(1)(iii) and (2) (Effect of registration) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a design right or exclusive license.

(4) Article 99(3) (Effect of registration) of the Patent Act shall apply mutatis mutandis to a right of pledge established on a non-exclusive license.

(Application mutatis mutandis of provisions of the Patent Act)

Article 36 Articles 69(1) and (2) (Limitations of patent right), 73 (Jointly owned patent rights), 76 (Lapse of patent rights in absence of heir), 97(1) (Waiver of patent right, etc.) and 98(1)(i) and (ii) (Effect of registration) of the Patent Act shall apply mutatis mutandis to design rights.

## **Section 2 Infringement of rights**

(Right to seek injunction)

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

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

(3) With regard to a design for which secrecy is requested under Article 14(1), the holder of the design right or the exclusive licensee may not make a demand under paragraph (1) unless he/she has given warning with documents stating

the matters listed in Article 20(3) and certified by the Commissioner of the Patent Office.

(Acts Deemed to constitute infringement)

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

- (i) acts of producing, assigning, etc. (assigning and leasing and, in the case where the product is a computer program, etc., including providing through an electric telecommunication line, the same shall apply hereinafter) or importing or offering for assignment, etc. (including displaying for the purpose of assignment, etc., the same shall apply hereinafter) any product to be used exclusively for the producing of the article to the registered design or a designs similar thereto as a business; and
- (ii) acts of possessing an article to the registered design or a design similar thereto for the purpose of assigning, leasing or exporting it as a business.

(Presumption of Amount of Damage, etc.)

Article 39 (1) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer assigned articles that composed the act of infringement, the amount of damages sustained by the holder of such design right or the exclusive licensee may be presumed to be the amount of profit per each unit of article which would have been sold by the holder of the design right or the exclusive licensee if there had been no such act of infringement, multiplied by the quantity (hereinafter referred to in this paragraph as the "assigned quantity" of articles) assigned by the infringer, the maximum of which shall be the amount attainable by the holder of the design right or the exclusive licensee in light of the capability of the holder of the design right or the exclusive licensee to work such articles; provided, however, that if any circumstances exist under which the holder of the design right or the exclusive licensee would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of articles not able to be sold due to such circumstances shall be deducted.

(2) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer shall be presumed to be the amount of damages sustained by the holder of the design right or exclusive licensee.

(3) A holder of a design right or an exclusive licensee may claim against an

infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, by regarding the amount the holder of the design right or exclusive licensee would have been entitled to receive for the working of the registered design or design similar thereto as the amount of damages sustained.

(4) The preceding paragraphs shall not prevent any relevant party from claiming compensation for damages in an amount exceeding the amount provided for therein. In such a case, where the infringer committed the infringement of the design right or exclusive license without intent or gross negligence, the court may take these circumstances into consideration in determining the amount of damages.

(Presumption of negligence)

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

(Application mutatis mutandis of provisions of the Patent Act)

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

### **Section 3 Registration Fees**

(Registration fees)

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

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

(ii) Fourth to tenth year: annually 16,900 yen

(iii) Eleventh year to twentieth year: annually 33,800 yen

(2) The preceding paragraph shall not apply to design rights belonging to the State.

(3) Notwithstanding the provisions of paragraph (1), where a design right is jointly owned by the State and any other persons, and the portions of their

respective shares of the said design right have been agreed upon, the registration fees payable under paragraph (1) shall be determined as the sum calculated by multiplying the applicable registration fees as provided in paragraph (1) by the ratio of the share of persons other than the State, and the persons other than the State shall pay such amounts.

- (4) For the amount of registration fees calculated under the preceding paragraph, fractional figures of less than ten yen shall be discarded.
- (5) The payment of registration fees under paragraph (1) shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.

(Time limit for payment of registration fees)

Article 43 (1) The registration fee for the first year under Article 42(1)(i) shall be paid within 30 days from the date on which a certified copy of the examiner's decision or the trial decision to the effect that the design is to be registered has been served.

- (2) The registration fees for each year from the second and subsequent years under Article 42(1) shall be paid by the end of the previous year.
- (3) The Commissioner of the Patent Office may, upon a request by a person by whom the registration fees are to be paid, extend the time limit under paragraph (1) by a period not exceeding 30 days.

(Late payment of registration fees)

Article 44 (1) Where a holder of a design right is unable to pay the registration fees within the time limit under Article 43(2), the holder of the design right may make a late payment of the registration fees after the expiration of the said time limit, but not later than 6 months following the expiration of the said time limit.

- (2) The holder of the design right who makes a late payment of the registration fees under the preceding paragraph shall pay, in addition to the registration fees to be paid under Article 42(1), a registration surcharge in the same amount as the registration fees.
- (3) The payment of the registration surcharge under the preceding paragraph shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.
- (4) Where a holder of a design right fails to pay, within the time limit for late payment of the registration fees under paragraph (1), the registration fees and

the registration surcharge under paragraph (2), the design right shall be deemed to have been extinguished retroactively upon expiration of the time limit as provided in the Article 43(2).

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

Article 44-2 (1) A person who was the holder of a design right which became extinguished under Article 44(4), if a failure to pay the registration fees and the registration surcharge prescribed in Articles 44(4) within the time limit provided in Article 44(1) was for reasons not attributable to the person, may make a late payment of the registration fees and the surcharge within 14 days (in the case of an overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said time limit.

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

(Restriction on effect of restored design right)

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

(2) A design right restored under paragraph 2 of the preceding Article shall not be effective against the following acts conducted after the lapse of the time limit during which the late payment of the registration fees is allowed under Article 44(1) but before the registration of the restoration of the design right:

- (i) the using of the registered design or a design similar thereto;
- (ii) manufacturing, assigning, etc., importing or offering for assignment, etc. of any product to be used exclusively for manufacturing an article to the registered design or a design similar thereto. ; and
- (iii) possessing an article to the registered design or a design similar thereto for the purpose of assigning, leasing or exporting it.

(Application mutatis mutandis of provisions of the Patent Act)

Article 45 Article 110 (Payment of patent fees by interested persons) and Article 111(1) (Excluding item (iii)) and (2) (Refund of patent fees) of the Patent Act shall apply mutatis mutandis to registration fees.

## Chapter V Trial

(Trial against examiner's decision of refusal)

Article 46 (1) A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for a trial against the examiner's decision of refusal within 30 days from the date certified copy of the examiner's decision has been served.

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

(Trial against examiner's ruling dismissing an amendment)

Article 47 (1) A person who has received an examiner's decision to dismiss an amendment and is dissatisfied may file a request for a trial against the examiner's ruling dismissing an amendment within 30 days from the date on which the certified copy of the examiner's decision has been served; provided, however, that this shall not apply where a new application for design registration under Article 17-3(1) has been filed.

(2) Paragraph (2) of the preceding Article shall apply mutatis mutandis to a request for a trial against an examiner's ruling dismissing an amendment.

(Trial for invalidation of design registration)

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

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

(ii) where the design registration has been granted in violation of a treaty;

(iii) where the design registration has been granted on an application for design registration filed by a person who is not the creator of the design and has not succeeded to the right to obtain a design registration for the said design; and

(iv) where, after the grant of a design registration, the holder of the design right has become unable to hold a design right under Article 25 of the Patent Act as applied mutatis mutandis under Article 68(3) of this Act, or the design registration has become in violation of a treaty.

- (2) Any person may file a request for a trial for invalidation of design registration; provided, however, that where a request for a trial for invalidation of design registration is filed on the ground that the design registration falls under item (i) of the preceding paragraph (limited to cases where the design registration is obtained in violation of Article 38 of the Patent Act as applied mutatis mutandis under Article 15(1) of this Act) or item (iii) of the preceding paragraph, only an interested person may file a request for a trial for invalidation of design registration.
- (3) A request for a trial for invalidation of design registration may be filed even after the lapse of the design right.
- (4) Where a request for a trial for invalidation of design registration has been filed, the chief trial examiner shall notify the exclusive licensee of the design right and other persons who have any registered rights relating to the design registration.

(Trial to invalidate a design registration)

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

(Application mutatis mutandis of provisions on examination)

- Article 50 (1) Article 17-2 and Article 17-3 shall apply mutatis mutandis to a trial against an examiner's decision of refusal. In this case, the term "files a request for a trial against" in Article 17-2(4) shall be deemed to be replaced with "institutes, under Article 59(1), an action against."
- (2) Article 18 shall apply mutatis mutandis where a request for a trial against an examiner's decision of refusal is found to have reasonable grounds; provided, however, that this shall not apply where a trial decision is made to order a further examination to be carried out under Article 161(1) of the Patent Act as applied mutatis mutandis under Article 52.
  - (3) Article 50 (notice of reasons for refusal) of the Patent Act shall apply mutatis mutandis where a reason for refusal which was not contained in an examiner's decision is found in a trial against the examiner's decision of refusal.

(Special provisions for trial against examiner's ruling dismissing an amendment)

Article 51 Where a trial decision is made to rescind an examiner's ruling in a



trial against the examiner's ruling dismissing an amendment, the decision made in the trial decision shall be binding upon the examiner with respect to the case.

(Application mutatis mutandis of provisions of the Patent Act)

Article 52 Articles 131(1) and (2), 131-2 (excluding item (i) of paragraph 2) to 134, 135 to 154, 155(1) and (2), 156 to 158, 160(1) and (2), 161, and 167 to 170 (request for trial, trial examiner, procedures of trial, relation to litigation and costs of trial) of the Patent Act shall apply mutatis mutandis to a trial. In this case, the term "a trial against the examiner's decision of refusal" in Article 161 and the term "a trial against an examiner's decision of refusal and a trial for correction" in Article 169(3) of the said Act shall be deemed to be replaced with "a trial against an examiner's decision of refusal and a trial against an examiner's ruling dismissing an amendment."

## **Chapter VI Retrial and Litigation**

(Request for retrial)

Article 53 (1) A party or an intervenor may file a request for a retrial against a final and binding trial decision.

(2) Articles 338(1), 338(2) and 339 (Grounds for retrial) of the Code of Civil Procedure (Act No.109 of 1996) shall apply mutatis mutandis to a request for a retrial under the preceding paragraph.

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

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

(Restriction on effect of design right restored by retrial)

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

(2) Where a design right pertaining to an invalidated design registration has been restored by a retrial, such design right shall not be effective against the following acts conducted after the trial decision became final and binding but

before the registration of the request for a retrial:

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

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

(Application mutatis mutandis of provisions on trial)

- Article 57 (1) Article 50(1) and (3) shall apply mutatis mutandis to a retrial against a final and binding trial decision in a trial against an examiner's decision of refusal.
- (2) Article 51 shall apply mutatis mutandis to a retrial against a final and binding trial decision in a trial against an examiner's ruling dismissing an amendment.

(Application mutatis mutandis of provisions of the Patent Act)

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

refusal and a trial for correction" in Article 169(3) of the said Act shall be deemed to be replaced with "a trial against an examiner's ruling dismissing an amendment."

(4) Article 174(2) of the Patent Act shall apply mutatis mutandis to retrial against a final and binding trial decision in a trial for invalidation of design registration

(Actions against trial decisions, etc.)

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

(2) Articles 178(2) to (6) (Statute of limitations for filing an action, etc.), 179 to 180-2 (Appropriate party as defendant, Notice of institution of action and Opinion of the Commissioner of the Patent Office in litigation rescinding the trial decision), 181(1) and (5) (Rescission of the trial decision or ruling), and 182 (Delivery of original copy of judgment) of the Patent Act shall apply mutatis mutandis to an action under the preceding paragraph.

(Action against amount of compensation)

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

(2) Articles 183(2) (Statute of limitations for filing an action) and 184 (Standing as defendant) of the Patent Act shall apply mutatis mutandis to an action under the preceding paragraph.

(Relationship between (administrative) objection and litigation)

Article 60-2 Article 184-2 (Relationship between (administrative) objection and litigation) of the Patent Act shall apply mutatis mutandis to an action demanding the rescission of dispositions imposed by this Act or an order thereunder (excluding dispositions under Article 68(7)).

## **Chapter VII Miscellaneous Provisions**

(Amendment of proceedings)

Article 60-3 A person undertaking a procedure with regard to an application for design registration, a request or any other procedures relating to design registration, may make amendments only while the case is pending in

examination, trial or retrial.

(Registration in the design registry)

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

- (i) the establishment, transfer, lapse, restoration or restriction on disposition, of a design right;
  - (ii) the establishment, maintenance, transfer, modification, lapse or restriction on disposal, of an exclusive or non-exclusive license; and
  - (iii) the establishment, transfer, modification, lapse or restriction on disposal, of a right of pledge on a design right or exclusive or non-exclusive license.
- (2) The design registry may be prepared, in whole or in part, in the form of magnetic tapes (including other storage media using a similar method that may record and reliably store certain matters, the same shall apply hereinafter.)
- (3) In addition to those prescribed in this Act, matters relating to registration shall be prescribed by Cabinet Order.

(Issuance of certificate of design registration)

Article 62 (1) The Commissioner of the Patent Office shall issue the certificate of design registration to the holder of the design right when the establishment of a design right has been registered

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

(Request for certificate, etc)

Article 63 (1) Any person may file a request with regard to design registrations to the Commissioner of the Patent Office to issue a certificate, a certified copy of documents or an extract of documents, to allow the inspection or copying of documents, model or specimen, or to issue documents which contain matters recorded on the magnetic tapes that constitute the part of the Design Registry; provided, however, that if the Commissioner of the Patent Office considers it necessary to keep such documents, model or specimen confidential, this provision shall not apply to the following documents, model or specimen:

- (i) an application or drawing, photograph, model or specimen attached to an application, or any document pertaining to the examination of an application for design registration for which the design has not been registered;
- (ii) Documents, model or specimen related to a design for which the secrecy is requested under Article 14(1);
- (iii) Documents concerning a trial against an examiner's decision of refusal or a trial against an examiner's ruling dismissing an amendment requested for an

application for design registration for which the design has not been registered;

- (iv) Documents concerning a trial for invalidation of design registration or a retrial of the final and binding trial decision in such trial, with respect to which a party in the case or intervenor has given notice that a trade secret owned by the said party in the case or intervenor has been described (trade secret as provided in Article 2(6) of the Unfair Competition Prevention Act (Act No. 47 of 1993));
  - (v) Documents which are liable to cause damage to an individual's reputation or peaceful life; and
  - (vi) Documents which are liable to cause damage to public order or morality.
- (2) Where the Commissioner of the Patent Office approves of the request under the main clause of the preceding paragraph with regard to the documents, model or specimen as provided in items (i) to (v) of the said paragraph, the Commissioner of the Patent Office shall notify the person who submitted the said documents, model or specimen thereof and reasons therefor.
- (3) Provisions of the Act on Access to Information Held by Administrative Organs (Act No. 42 of 1999) shall not apply to the documents concerning design registrations and the part of the Design Registry stored on magnetic tapes.
- (4) Provisions in Chapter IV of the Act on Protection of Personal Information Possessed by Administrative Organs (Act No. 58 of 2003) shall not apply to the possessed personal information (refers to the possessed personal information as provided in Article 2(3) of the said Act) recorded in the documents concerning design registrations and the part of the Design Registry stored on magnetic tapes.

#### (Mark of Design Registration)

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

#### (Prohibition of false marking)

Article 65 It shall be prohibited for a person to do the following acts:

- (i) putting a mark of design registration or a mark confusing therewith on an article which is not the article to the registered design and is not the article to a design similar to the registered design, or the package thereof;
- (ii) assigning, leasing or displaying for purposes of assignment or lease an article which is not the article to the registered design and is not the article

to a design similar to the registered design, putting a mark of design registration or a mark confusing therewith on the article or package thereof;  
or

- (iii) Giving in an advertisement an indication to the effect that the article, which is not the article to the registered design and is not the article to a design similar to the registered design, is related to the registered design, or an indication confusing with the indication for the purpose of having the article manufactured or used, or assigning or leasing the article.

(Design Bulletin)

Article 66 (1) The Patent Office shall publish the Design Bulletin (Isho Koho).

(2) In addition to the matters provided for in this Act, the Design Bulletin shall contain:

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

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

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

(Fees)

Article 67 (1) Fees shall be paid by the following persons in an amount to be provided by Cabinet Order in view of the actual costs:

- (i) persons requesting disclosure of a design under Article 14(4);
  - (ii) persons notifying of succession under Article 34(4) of the Patent Act as applied mutatis mutandis under Article 15(2)
  - (iii) persons filing a request for an extension of period under Article 4 or 5(1) of the Patent Act as applied mutatis mutandis under Article 17-4, 43(3) or 68(1), or a change of the date under Article 5(2) of the Patent Act as applied mutatis mutandis under Article 68(1);
  - (iv) persons filing a request for the re-issuance of the certificate of design registration;
  - (v) persons filing a request for the issuance of a certificate under Article 63(1);
  - (vi) persons filing a request for the issuance of a certified copy of documents or an extract of documents under Article 63(1):
  - (vii) persons filing a request to allow the inspection or copying of documents, model or specimen under Article 63(1); and
  - (viii) persons filing a request for the issuance of documents which contain matters recorded on the magnetic tapes that constitute the part of the Design Registry under Article 63(1).
- (2) The persons listed in the center column of the attached table shall pay fees in the amount as provided by Cabinet Order within the range of the amounts specified in the corresponding right-hand column of the table.
- (3) The two preceding paragraphs shall not apply where the person to pay the fee in accordance with these paragraphs is the State.
- (4) Where the State has joint ownership of a design right or a right to obtain a design registration with a person other than the State, and the portion of their respective shares of said right has been agreed, notwithstanding the provisions of paragraph (1) or (2), the fees payable thereunder (limited to those provided by Cabinet Order) shall be determined as the sum of the provided fees multiplied by the ratios of the shares of each person other than the State, and, the person(s) other than the State shall pay such amounts.
- (5) Where the amount of the fees calculated under the preceding paragraphs has a fractional figure of less than ten yen, said portion shall be discarded.
- (6) The payment of the fees under paragraphs (1) and (2) shall be made by patent revenue stamps as provided by an Ordinance of the Ministry of Economy, Trade and Industry; provided, however, that where so provided by an Ordinance of the Ministry of Economy, Trade and Industry, a cash payment thereof shall be accepted.
- (7) Fees paid in excess or in error shall be refunded upon the request of the person who made payment thereof.

(8) No request for a refund of the fees under the preceding paragraph may be filed after one year from the date on which the payment thereof has been made.

(Application mutatis mutandis of provisions of the Patent Act)

Article 68 (1) The provisions of Articles 3 to 5 (Time periods and dates) of the Patent Act shall apply mutatis mutandis to time periods and time limits provided in this Act. In this case, the term "Article 121(1)" of Article 4 of the Patent Act shall be deemed to be replaced with "Article 46(1) or 47(1) of the Design Act."

(2) Article 6 to 9, 11 to 16, 17(3) and 17(4), 18 to 24 and 194 (Procedures) of the Patent Act shall apply mutatis mutandis to an application for design registration, a request, or any other procedures relating to design registration. In this case, the term "hearing against an examiner's decision of refusal" in Article 9 of the Patent Act shall be deemed to be replaced with "request for a trial against an examiner's decision of refusal and trial against examiner's ruling dismissing an amendment." and the term "hearing against an examiner's decision of refusal" in Article 14 of the Patent Act shall be deemed to be replaced with "request for a trial against an examiner's decision of refusal and trial against examiner's ruling dismissing an amendment."

(3) Article 25 (Enjoyment of rights by foreign nationals) of the Patent Act shall apply mutatis mutandis to design rights and other rights relating to the design registration.

(4) Article 26 (Effect of treaties) of the Patent Act shall apply mutatis mutandis to the design registration.

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

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

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

## **Chapter VIII Penal Provisions**

(Crime of infringement)

Article 69 An infringer of a design right or exclusive license (excluding one who has committed any acts which are deemed to constitute infringement of a design right or an exclusive license under Article 38) shall be punished by imprisonment with work for a term not exceeding 10 years or a fine not



exceeding 10,000,000 yen or combination thereof.

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

(Crime of fraud)

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

(Crime of false marking)

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

(Crime of perjury, etc.)

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

(2) Where a person who has committed the crime in the preceding paragraph has made a voluntary confession before a certified copy of the advisory opinion on the case has been served or an examiner's decision or a trial decision has become final and binding, the punishment may be reduced or exculpated.

(Crime of divulging secrets)

Article 73 A present or former official of the Patent Office who has divulged any secret relating to a design in a pending application for design registration that has become known to him/her in the course of performing his/her duties, or misappropriated the said design shall be punished by imprisonment with work for a term not exceeding one year or a fine not exceeding 500,000 yen.

(Crime of breach of protective order)

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

(2) The prosecution of the crime under the preceding paragraph may not be

initiated unless a complaint is filed.

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

(Dual liability)

Article 74 (1) Where a representative of a juridical person or an agent, employee or other worker of a juridical person or an individual has committed in the course of performing his/her duties for the juridical person or individual, any act in violation prescribed in the following items, in addition to the offender, the juridical person shall be punished by a fine as provided in the corresponding item and the individual shall be punished by a fine as provided in the Article prescribed in the corresponding item:

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

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

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

- (3) Where a fine is imposed on a juridical person or individual under paragraph (1) with regard to a violation of Article 69, 69-2 or 73-2(1), the period of prescription shall be governed by the same rules as for crimes in the provisions thereof.

(Civil fine)

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

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

Article 77 A person who has been ordered by the Patent Office or a court commissioned thereby to submit or present documents or other materials for

the purpose of examination or preservation of evidence in accordance with this Act and fails to comply with the order without a justifiable reason shall be punished by a civil fine not exceeding 100,000 yen.

Appended Table (In relation to Article 67)

	The person (s) who shall 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(1)	5,100 yen per case
3	A person requesting an advisory opinion under Article	40,000 yen per case 25(1)
4	A person requesting an award	55,000 yen per case
5	A person requesting canceling of an award	27,500 yen per case
6	A person filing a request for a trial or retrial	55,000 yen per case
7	A person applying for intervention in a trial or retrial	55,000 yen per case