

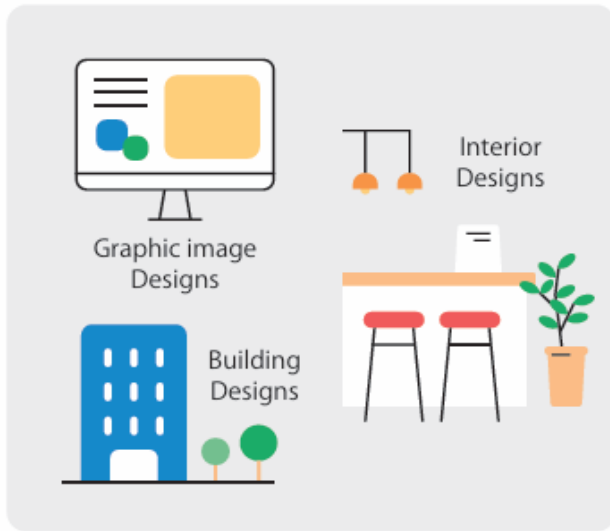
Japan's Related Design System

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Founder & CEO
Konishi & Nakamura

Agenda-

- Update in 2020 Design Act
- Statistic
- Overview & Benefits
- Term of Related Design
- Requirement
- Hague Practices
- Discussions

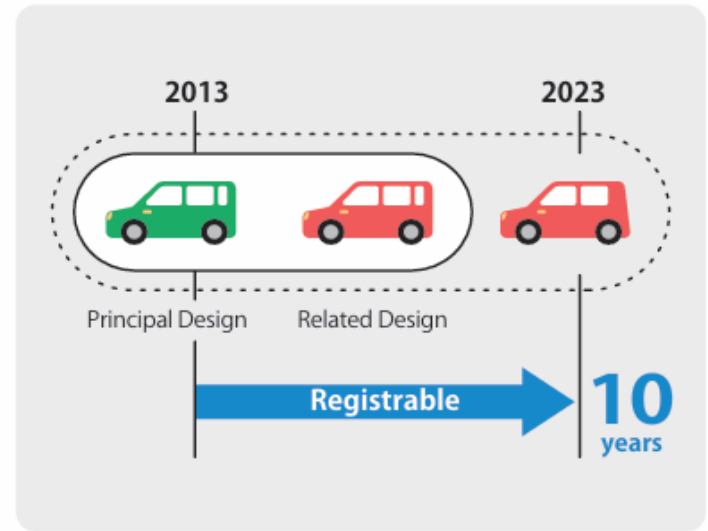
Update in 2020 Design Act



Expansion of protection scope



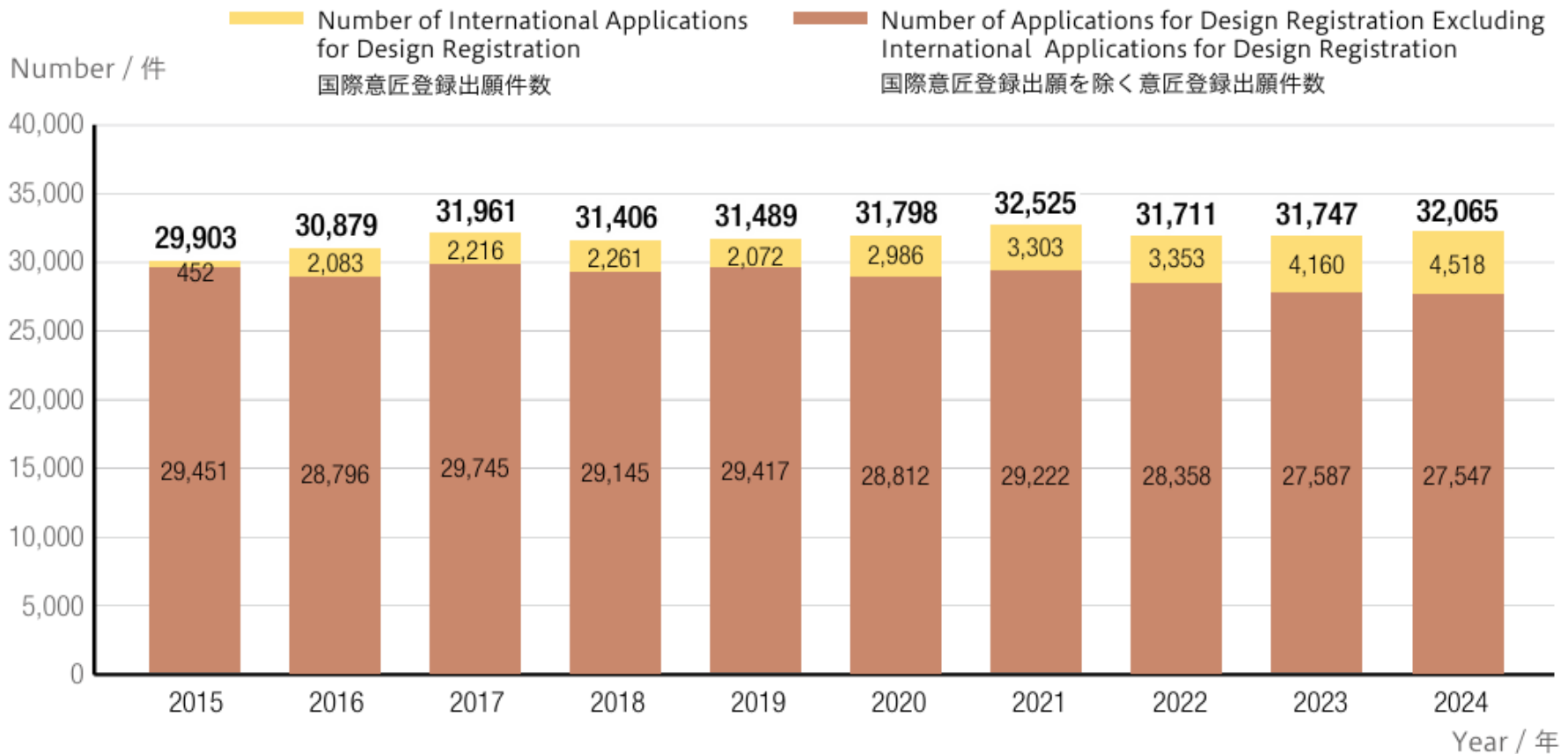
Change in the duration of design rights



Enhancement of the Related Design System



Statistics



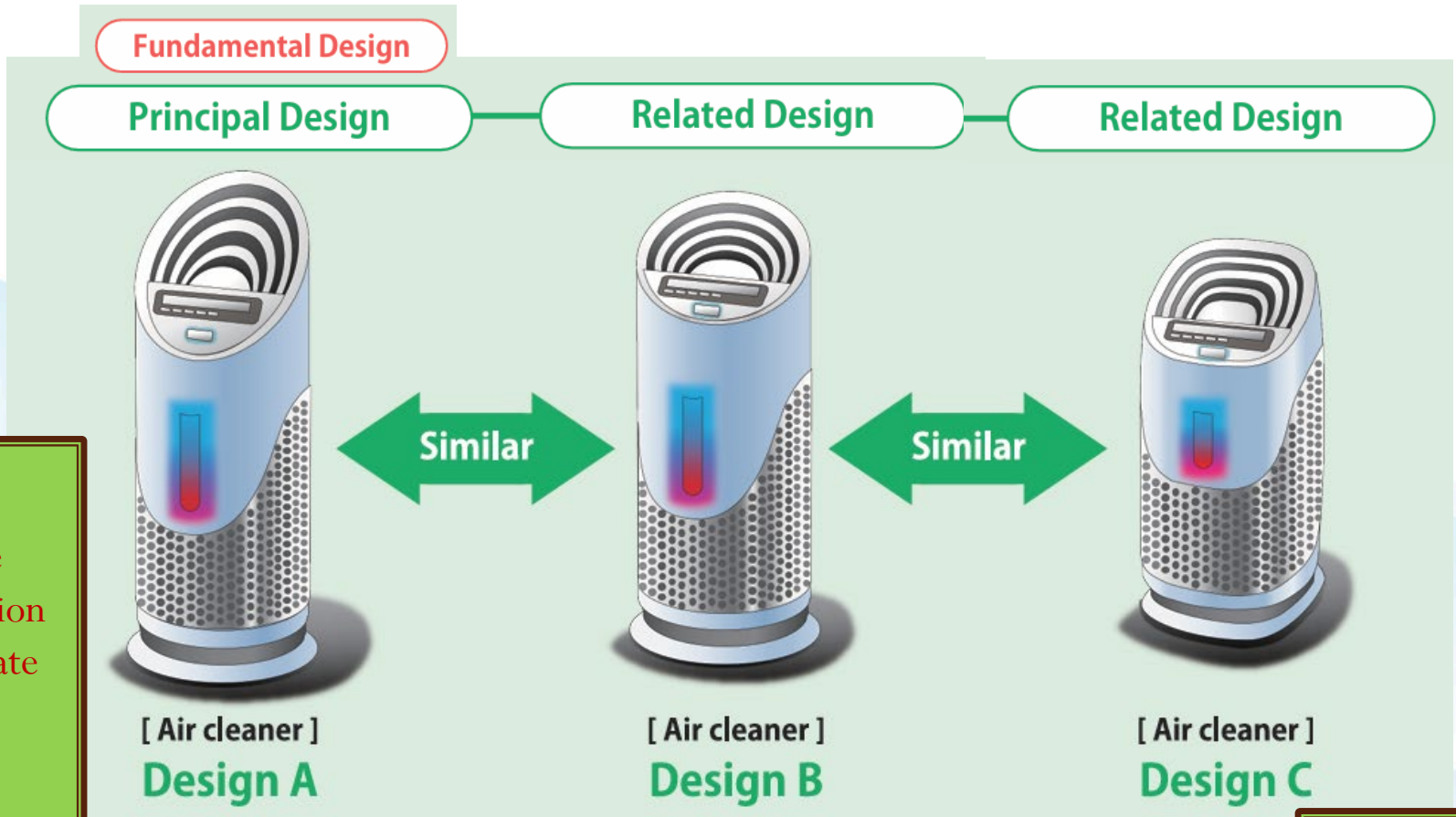
Statistics

Top 10 Filers (Foreign Companies)

Rank in 2023 前年順位		Rank in 2024 順位	Applicant 出願人	Number of Registrations 登録件数
1	→	1	Apple Inc. アップル インコーポレイテッド	287 (354)
2	→	2	Huawei Technologies Co., Ltd. 華為技術有限公司	147 (123)
4	↗	3	Google LLC グーグル エルエルシー	115 (88)
5	↗	4	NIKE Innovate C.V. ナイキ イノベイト シーブイ	92 (77)
7	↗	5	Louis Vuitton Malletier ルイ ヴィトン マルチェ	78 (63)
3	↘	6	Harry Winston SA ハリー・ウィンストン・エス アー	71 (93)
18	↗	7	Dyson Technology Limited ダイソン・テクノロジー・リミテッド	51 (32)
109	↗	8	Ugreen Group Ltd. 深▲セン▼市緑聯科技股▲フン▼有限公司	48 (8)
23	↗	9	Spigen Korea Co., Ltd. シュビゲン コリア カンパニー リミテッド	46 (28)
28	↗	10	Adidas AG アディダス アーゲー	44 (24)

Overview & Benefit (Article 10)

Structure



- 1. National Filing Date
- 2. Convention Priority Date
- 3. Hague Intentional Reg. Date



Benefit in Practices

A design that has **lost its novelty by a previous disclosure of registered design** is still registerable if requirements met.

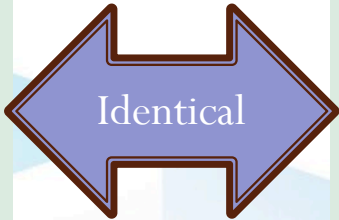
Article 10:
The Disclosed Design
A is **not a prior art**.

Principal Design

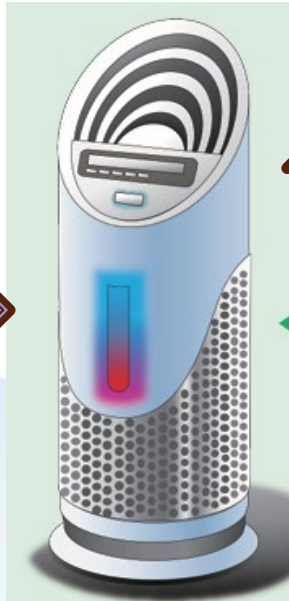


[Air cleaner]
Design A

Principal
Design A
Filed by X



Identical



[Air cleaner]
Design A

Design A
Disclosed
By X



Similar



[Air cleaner]
Design B

Related Design
B Filed by X

Related Design



Going
to
register

Transition



April 1st, 2020

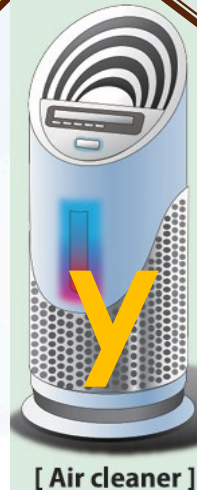
2020 Act
Implemented

Related Design
Available file
in 10 years

10 years

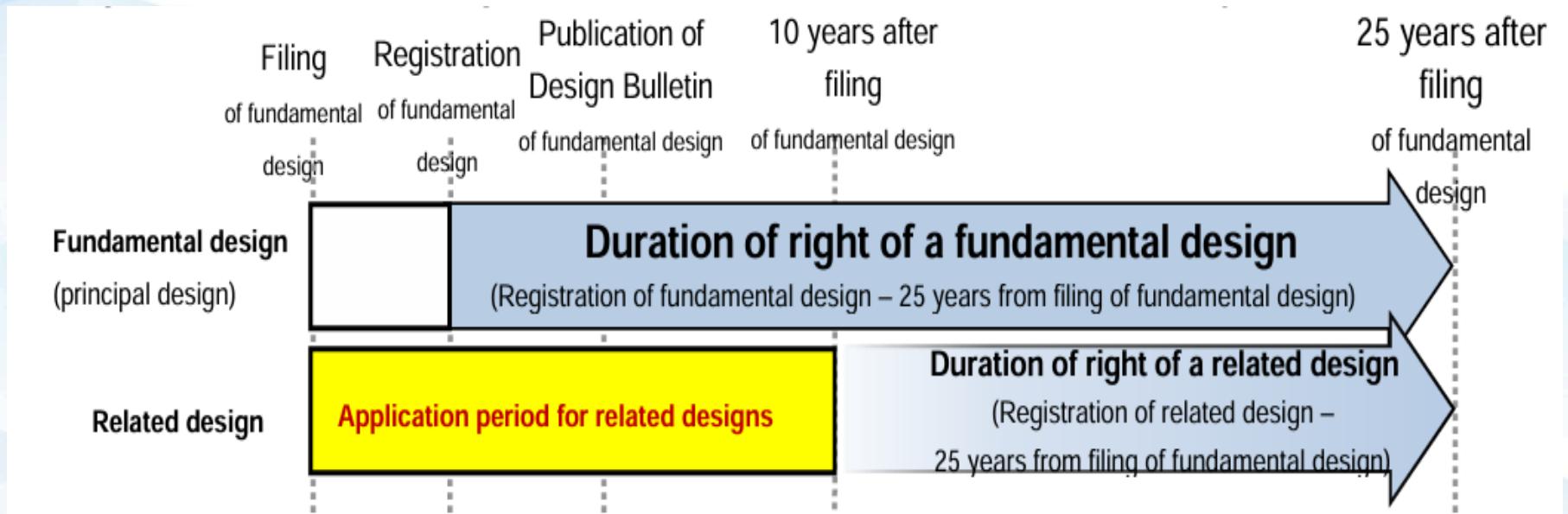
Principal
Design
Filing Date

Principal
Design
Filing Date



Term of Related Design

Remainder of Principal Design's Term



Requirements

Same applicant.



Similar to a principal design immediately filed before.



File in 10 years since a principal design files.

Requirements

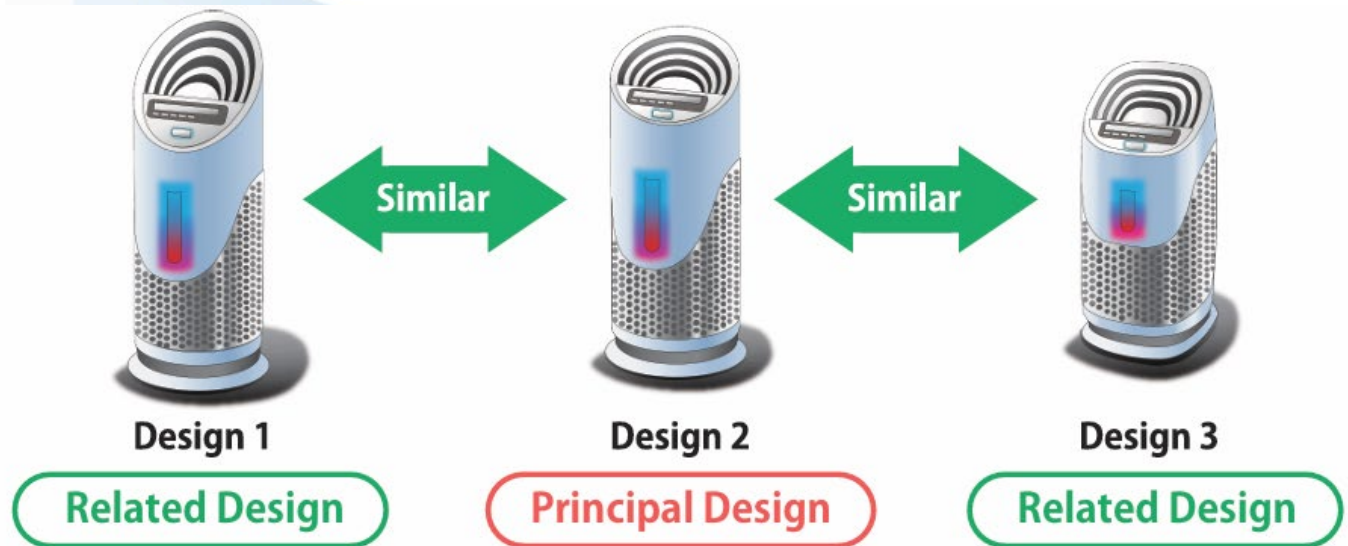
Principal design* remains effective. (*either registered or applied)



No exclusive license granted based on principal design.

Hague Practices

When Use DM1-You **may** submit a request about related designs. **Otherwise**, you can divide the designs into three independent applications in a response to an office action issued in a national phase.



Hague Practices –Sample DM1

16. Main or Principal Design (if applicable)

(omitted)

NO.16. is related to the related design system

Japan and / or the Republic of Korea: principal and related designs

If designating **Japan** and / or **the Republic of Korea**, designs may be registered as related to a principal design.

(a) Contracting Party(ies) concerned: Japan Republic of Korea

Select Japan

(b) The applicant requests that the following designs contained in the present application be registered as **related designs**:

all designs, or

the following designs (e.g. design 1, design 2):

Indicate which of the designs in the application are "Related Designs."

Design 1, Design 3

(c) Information concerning **the principal design** to which the designs indicated under item (b) are related (Note: The principal design must be subject of an application or a registration with the Office of the Contracting Party concerned):

(i) **The principal design** is the subject of:

the present international application

Select "the present international application."

Hague Practices –Sample DM1

(i) **The principal design** is the subject of:

the present international application

Select "the present international application."

a prior international application designating Japan and / or the Republic of Korea

a prior international registration designating Japan and / or the Republic of Korea

a prior national application filed with the Office of Japan and / or the Republic of Korea

a prior national registration at the Office of Japan and / or the Republic of Korea

(ii) If the above national or international application or registration contains several designs, indicate **the number of the design to be considered as the principal design**:

Design 2

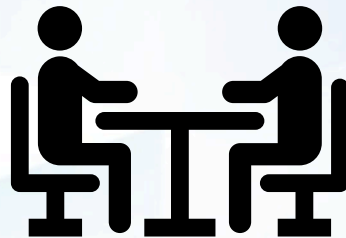
Fill in the "principal design" of the related design indicated in (b).

CAUTION !

Only a design in an application filed directly with the JPO or a registration at the JPO, or an application / registration under the Hague System designating Japan can be designated as the principal design. For example, an application filed with a country other than Japan as the basis for a priority claim cannot be designated as the principal design.

Hague Practices

**Recommend
Pre-Filing Consultation
with Japanese counsel!**



Discussions

Article 10 (2)

If there is an **Own Design** lacking a novelty before filing a related design, the **Own Design** is not considered as a prior art which bars an applicant from registering a related design, provided that the **Own Design** is identical or similar to a principal design.

Own Design-Guideline 3.7.1.

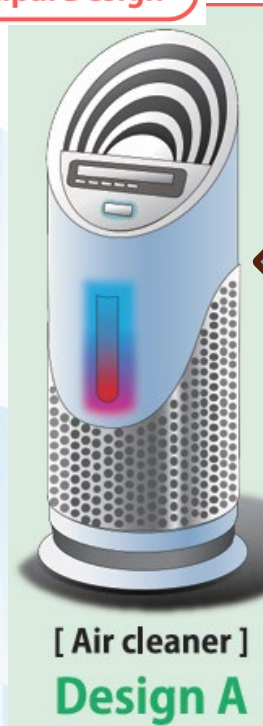
The term “applicant’s own design” means those designs for which the applicant for design registration for a related design holds the design rights or holds the right to obtain a design registration.

It does not include designs for which others hold the design rights or hold the right to obtain a design registration.

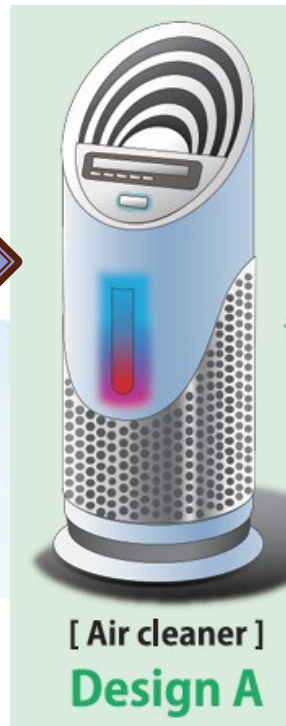
Discussions-1

The Examiner for Design B treats that the disclosed Design A is **not** a prior art as Design A is Own Design of Filer X.

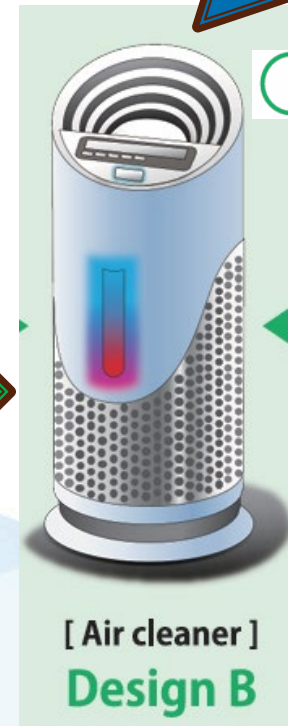
Principal Design



Identical



Similar



Related Design

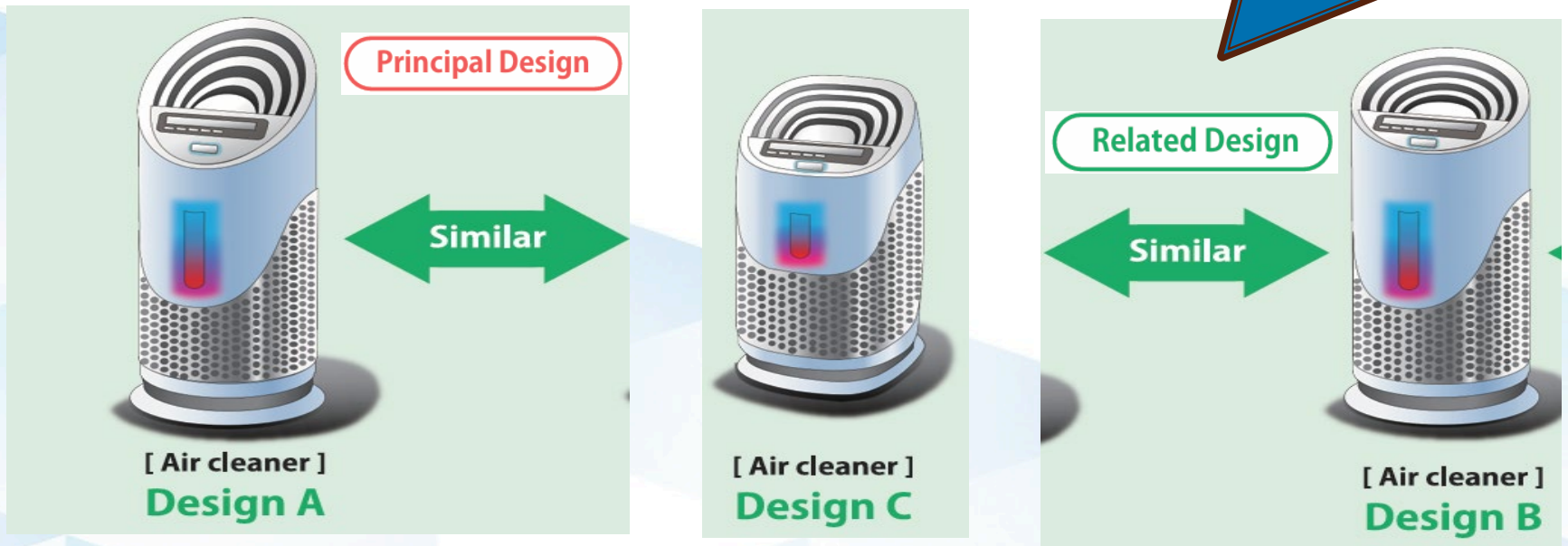
Filed by X

Disclosed by X

Filed by X

Discussions-2

The Examiner for Design B treats that the disclosed Design C is not a prior art as Design C is Own Design of Filer X.



Filed by X

Created &
Disclosed by X

Filed by X

Discussions-3

The Examiner for Design B treats that the Design A disclosed by the authorized distributor Y is **not** a prior art as Design A is Own Design of Filer X.



Discussions-4

The Examiner for Design B **likely** treats that the Design A disclosed **by Y** is **not** a prior art as Design A is Own Design of Filer X.

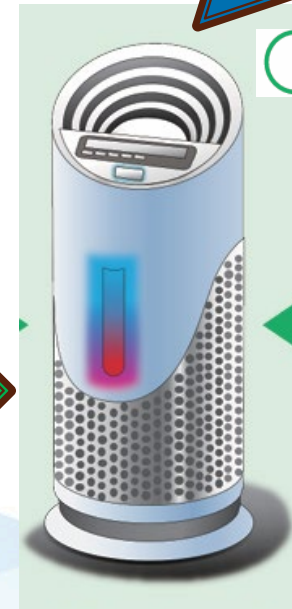
Principal Design



[Air cleaner]
Design A



[Air cleaner]
Design A



[Air cleaner]
Design B

Related Design

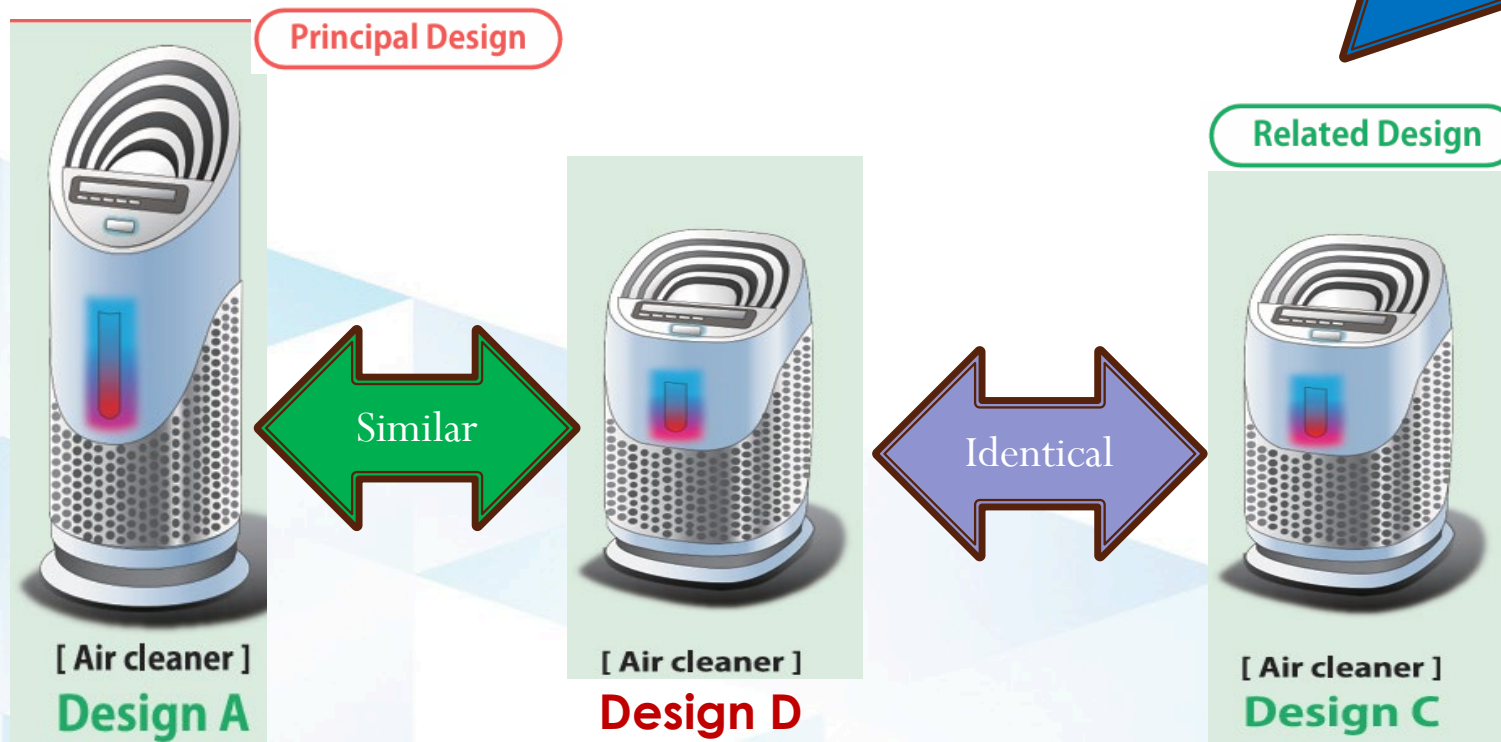
Filed by X

Counterfeits sold by Y

Filed by X

Discussions-5

The Examiner for Design C treats that the Design D disclosed by Y is **a prior art** as Design D is **not** Own Design of Filer X.



Filed and disclosed by X

Created & disclosed by Y

Filed by X

Discussions-6

The Examiner for Design C treats **likely** that the Design B disclosed by Y itself is **not** a prior art as Design B is Own Design of Filer X & Y.



Filed by X & Y

X-Y jointly created the Design B. Y breached NDA and disclosed Design B by itself.

Filed by X & Y

**Use Related Design?
Better than Never, or,
The Best than Never.**

Thanks. Any Questions? Contact :

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**& KONISHI
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