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Designs

Introduction

Japan and Australia's design systems are generally similar in that they protect any new design of the shape, pattern or appearance of a product or the combination of these that creates an aesthetic feeling and is suitable for industrial application. A simple picture or drawing, unless applied industrially, may not be a valid subject. The Japanese system of protection of designs nevertheless has its unique aspects, which have been outlined later in this fact sheet.

Designs are protected in Japan under the Designs Act which was amended in 2006. A key difference in Japan is the longer, recently extended term of protection now available, 20 years from registration, subject to an annual renewal fee payment. In comparison, Australia's design protection right has an initial protection term of five years with renewal at the fifth year if required.

Term of Design Right

The term of a design right including the right of a related design is 20 years from the date of registration (15 years prior to 1 April 2007). It must be renewed annually by payment of a fee. Unlike Australia, in exceptional cases, where the form of a registered design becomes famous, it may be possible to extend its protection under the Unfair Competition Prevention Law *after* the design registration lapses.

Requirements

As is the case in Australia and most other countries, in order to qualify for registration of a design, it must be novel and not previously disclosed to any third party (e.g. by marketing a product embodying the design or possibly by disclosing the design to a manufacturer in Japan). In Japan, the design must also be unique and not able to be created easily.

Unlike Australia, a design right is granted after a formality and substantive examination (e.g. novelty and creativity). A shape that is inherent to the function of a design or to meeting standards is not registrable.

Australian applicants should be aware differences exist in the examination process in Japan, including time limits to complete actions, amendment opportunities and appeal mechanisms.

Note also that Japanese design applications must be submitted in Japanese through a qualified patent attorney resident in Japan. Translation of documents first filed in English may be replaced by Japanese translations within a short time limit.

Accelerated examination

If you are concerned your design is being counterfeited, examination can be accelerated for any Japanese design application having a corresponding foreign application. To accelerate the examination, the applicant must obtain and submit a search report. This must include at least specified Japanese sources and details of any



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other pre-existing designs of the applicant. When an accelerated examination is requested, a first office action is usually issued within two months. For the "accelerated examination for responding to anti-counterfeit measures" program, introduced in April 2005, this is about two weeks. However, for most designs, the average time from request to examination until the first office action is approximately seven months.

Design system

As well as the conventional design, there are a number of variations of the type of designs that can be registered to suit specific situations.

Related designs

The related design system allows a group of similar designs to be registered. One of the designs must be specified as the principal design, while the others become related designs. Registered related designs have their own scope of protection and have a right independent of the principal design. To enable the enforcement of related design rights, it must be filed before the publication date of the principal design. A related design may vary in such minor matters such as colour, or may be a shape that varies from the basic design in a minor way.

Design of a set of objects

Design applications and registration usually follow a one-design-per-object principle, however there is an exception to that rule for products that are designed to be used together. It is possible to register a set of products as a single design, for example, kitchen sets (knife, fork and spoon), or golf club sets. This helps keep costs to a minimum.

Secret designs

A design may be kept secret for three years, by postponing publication in the Design Gazette. The request can be made when paying the first year's registration fee. Secrecy may be requested if, for

example, an applicant believes the design may be infringed quickly before the owner is ready to exploit it to its reasonable potential.

Partial designs

The partial design system allows registration of a part of the product which has distinct characteristics. Thus, it is possible to register designs of a part that cannot be physically separated from the entire product, giving them protection of a single design. When an earlier design is secret, a subsequent partial design application will not be granted.

Protection of screen designs

Under legislation amended in 2006, screen designs or graphic images (such as the designs of operation screens for DVD players, cellular phones and printers) are now protectable.

Rights and enforcement

Before the grant of a design, the inventor has very limited means to enforce rights. Once the design is granted, a range of legal remedies is available such as an injunctive order, damages and repayment of lost profits.

Further Information

Japan Patent Office

This site provides limited general information on application process, examination timeframes and fees.

www.jpo.go.jp

See also the Japan Contact fact sheet for attorneys specialising in design applications.



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Disclaimer:

This information is intended to help the reader gain a basic understanding of some IP concepts. It is not designed to provide legal, business or other relevant professional advice. IP Australia recommends that you seek independent legal, business or other relevant specialist advice as necessary. This fact sheet has been developed in conjunction with Hodgkinson McInnes Patents.

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