

Relaxed Procedure to Apply for the Exception to Lack of Novelty of Design in Japan (Revised Design Law, 2024)

April 30, 2024

Seiwa Patent & Law (Tokyo, Japan)

Abstract

The Japanese Design Law was revised by the partial revision of the Unfair Competition Prevention Act, etc. (Act No. 51 of June 14, 2023). Under the revised Design Law, which entered into effect on January 1, 2024, the procedures to apply for the exception to lack of novelty when filing a design application in Japan have been relaxed. Specifically, when an applicant has published designs that are identical or similar to a claimed design multiple times prior to the filing date of a design application, under the revised Law, the applicant needs to submit a certificate only for the first disclosure, while before the revision, it was necessary to submit a certificate for each and every publication prior to the filing date. This revision is expected to considerably reduce the burden on design applicants. This IP News article will outline the relaxed procedure of applying for the exception to lack of novelty in Japan and provide our suggestions.

Contents

- I. Background
- II. Procedures under the Revised Law
- III. Points to Note
- IV. SEIWA Comments

I. Background

In principle, a design that was published prior to the filing of a design application or a design similar thereto is no longer eligible for design registration (Article 3, paragraph 1 of the Design Law). However, as an exception, a design that was published by or based on approval or request by a person entitled to obtain a design registration or his/her assignee (basically, designer or applicant), is treated as not having lost novelty due to the publication, provided that a design application is filed in Japan within one year from the date of first publication, a request to apply for the exception to lack of novelty is submitted at the time of filing, and a **Certificate for Applying for Exception to Lack of Novelty of Design**¹ (hereinafter “**certificate**”) for the publication is submitted within 30 days from the filing date of the

¹ Certificate for Applying for Exception to Lack of Novelty of Design: According to the Guidelines for Exception to Lack of Novelty by the JPO, the certificate must include the date and place of the disclosure, photos of the design being disclosed, person who published the design and the brief explanation of the history of succession of the right to obtain a design registration and the fact of disclosure.

application (Article 4, paragraphs 2 and 3). This procedure allows for a design that has already been published to be still eligible for design registration.

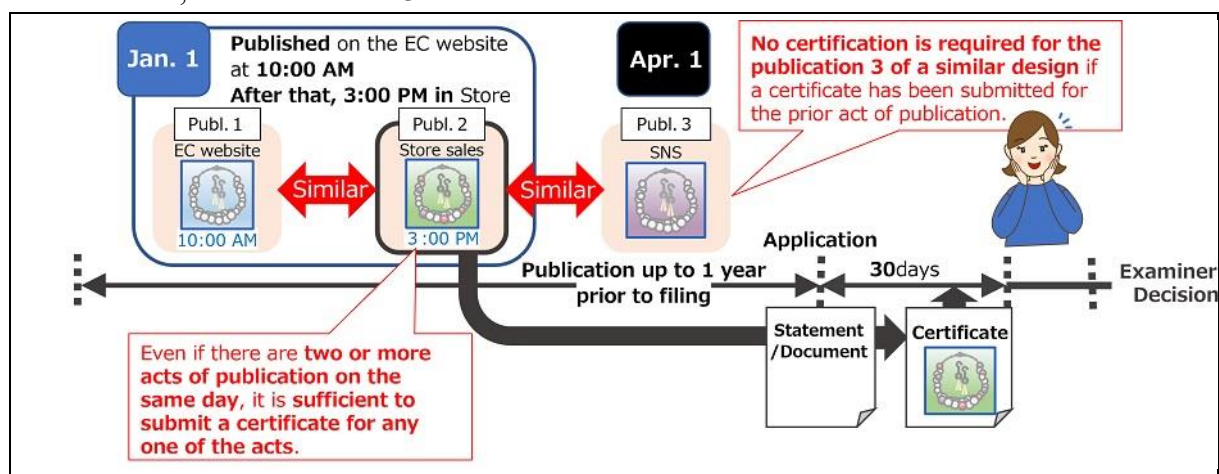
Prior to the revision of the Design Law, if a design identical or similar to a design claimed in a design application was published two or more times prior to the filing date, it was necessary to submit a certificate for each and every publication, in principle. Otherwise, the design application could be rejected citing the publication of the design for which a certificate was not submitted.

However, since the number of opportunities for publication of designs has increased in recent years due to recent changes in business environments, sales on e-commerce sites, increased advertising activities through SNS, etc., the burden of submitting proof of all instances of publication can be excessive. This revision aims to reduce the burden of such procedures for design applicants.

II. Procedures under the Revised Law

Under the revised Design Law, for a design application filed on or after January 1, 2024, when a certificate for a design published before the filing date is submitted, the effect of the exception to lack of novelty applies not only to the published design shown in the certificate, but also to any identical or similar designs subsequently published by or based on approval or request by a person entitled to obtain a design registration or his/her assignee. In other words, **even when the applicant has published designs multiple times prior to the filing date, the applicant needs to submit a certificate only for the first disclosure if the first published design is identical or similar to the subsequently published designs.**

In the example shown in the graphic below, where the designs of Publication 1, Publication 2, and Publication 3 are similar to each other, if the design applicant submits a certificate for either Publication 1 or Publication 2, which were published on the same day and have the earliest publication date, then the exception to lack of novelty applies to all of Publication 1, Publication 2, and Publication 3.



Cited from the JPO website:

<https://www.jpo.go.jp/e/system/laws/rule/other/design/ishou-reigai-tetsuduki.html>

III. Points to Note

➤ **Separate Certificate is Necessary for Dissimilar Designs**

A separate certificate is required for any published design that is dissimilar to the design shown in the submitted certificate. In the above example, if the design of Publication 3 is not similar to the design of Publication 1 or 2, then it is not possible to omit a certificate for Publication 3 in order to apply for the exception of lack of novelty for the design of Publication 3.

➤ **Procedures for Hague Design Applications**

Since the previous revision of Design Law effective on October 1, 2021, an applicant of an international application designating Japan under the “Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs” may submit a certificate in ANNEX II form at the time of filing of the international application (Article 60-7(2)). Alternatively, it is also possible to submit a certificate within 30 days from the international publication to the JPO via a Japanese agent (Article 60-7(1)).

IV. SEIWA Comments

This revision is expected to reduce the burden on applicants who publish a design multiple times before filing a design application. However, in order to safely enjoy the benefit of the exception to lack of novelty in Japan, it is necessary to carefully select which publication to disclose in the certificate and which to omit. If an Examiner judges a design published prior to the filing date to be dissimilar to a design shown in the submitted certificate, the design application may be rejected without accepting the request for application of the exception to lack of novelty. Therefore, when a design has been published multiple times before filing, it would be advisable to consult with a Japanese agent so as to preparation of appropriate certificates.

It should be noted that even if the exception to lack of novelty is applied, the filing date of the design application is not retroactive. In addition, a design will not be eligible to claim the exception to lack of novelty if it was published by a third party (i.e., neither a person entitled to obtain a design registration or his/her assignee) or in an official gazette of patents, utility models, designs or trademarks in any countries before the filing date of a Japanese design application. Therefore, it is recommended that an applicant file a design application as soon as possible, hopefully before publication of any identical or similar designs so as not to rely on the exception to lack of novelty.

Relevant links:

- Procedures for Seeking the Application of Exceptions to Lack of Novelty of Design, corresponding to the Design Act Article 4: [JPO website](#)
- Your Key to Success for Obtaining a Design Right in Japan: [JPO website](#)
- Exceptions to Lack of Novelty of Design and “Proving Document” (Last updated 9 November 2021): [JPO website](#)

END