



Revision of Design Examination Guidelines in relation to “Shading”, “Reference view” and “Lack of novelty”

Minako Mizuno (partner: patent attorney)

Seiwa Patent & Law (Tokyo, JAPAN)

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Abstract

As from April 1, 2017, with regard to Japanese design applications, the number of first Office Actions based on a lack of description relating to shading may decrease, since the Japan Patent Office (JPO) has partially revised the Design Examination Guidelines for the relevant parts.

1. Introduction

- The Design Examination Guidelines (“Guidelines”) were revised after having undergone a public comment process. The revised Guidelines apply to design applications examined on or after April 1, 2017, irrespective of the filing date of the application.
- The revision of the Guidelines relates to the following three subject matters.
 - a) Description of the shading used in drawings in an application request,
 - b) Reference view in the drawings, and
 - c) Form for requesting application of the exception to lack of novelty (grace period).
- The revision of the Guidelines is summarized as follows.

2. Description of Shading

- Background

In 2015, Japan participated in the framework of international design protection by the Hague Agreement Geneva Act. However, the requirements for showing drawings are not always identical in each member country, and the drawings included in a design application entering Japan from abroad, i.e., through the Paris route and the Hague route, are sometimes not in conformity with the JPO’s requirements and should be refused. Also, the technology for drafting drawings has developed rapidly using computer graphics. Under the circumstances, the current drawing-related requirements should have been relaxed without discriminating inbound applications from domestic ones, in particular, relaxing of the requirement for “shading” in the drawings.
- For example, in a US design patent application, it is possible to show a design depicted by line drawings with shading, without any explanation of shading (examples below). In the past, in the case of a Japanese design application claiming priority over such a US application, the JPO normally issued a first Office Action as a refusal due to lack of

explanation of shading, and thereby that the design was not clearly specified (Japanese Design Law Article 3). In response to the refusal, the applicant would then have to submit an amendment to clarify, e.g., that the parallel fine lines in the drawings indicate a surface shape of the three-dimensional product.



(Source of drawings: revised Guidelines)

- Subject to the revised Guidelines, if shading is shown in the drawings, an Office Action would not be issued, as long as the Examiner recognizes that the parallel fine lines, dots, light and dark tones in the drawings, etc., clearly indicate shading, e.g., shading on glasses and shading on the window glass of a car.
- However, in a case where the Examiner cannot clearly identify that parallel fine lines, etc. indicate shading, an Office Action as a refusal will still be issued as in the past.

3. Reference View

➤ Background

In Japanese design applications, reference views are often included in the drawings, so as to help the Examiner easily recognize the design as filed. However, reference views have recently begun to be used improperly, although no definite rules are stipulated in the Guidelines regarding reference views. Therefore, users have requested the JPO to establish standards for the interpretation of reference views.

- The JPO clearly states in the revised Guidelines that reference views showing elements different from the subject design as filed should not be taken into consideration, in order to clarify as to how reference views should be interpreted. Specifically, the following statement has been added in the revised Guidelines:

---“**in a case where reference views in drawings, etc., shows a shape, a pattern, or a color different from those shown in a set of drawings and the other required drawings, the different elements per se are not taken into consideration in finding the form of the design of the application.**”---

- This revision will reduce ambiguity in identifying the scope of design, not only in the examination stage but also in the post-grant phase.



4. Proceedings related to Lack of Novelty (Grace Period)
(Updating)

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