

Revision to the design practice effective on April 1, 2021

Tomohiro Gyoda
Design, Patent and Trademark Attorney

1. Extension of deadline for responding to an office action

Traditionally, the deadline for responding to an office action can be extended by one month. The revision changed the extension period from one month to two months. In addition, a post-deadline extension of two months is available, if the applicant missed extending the deadline within the response period of three months. Therefore, after April 1, an applicant has a maximum of five months for responding to an office action.

2. Priority deadline

If an applicant cannot file a design application claiming priority within 6 months for justifiable reasons, the applicant can file the application within 2 months after the deadline. The applicant must prove the reasons.

3. DAS codes or priority documents

If an applicant does not inform the JPO of the DAS code or does not submit the priority document to the JPO by the deadline (3 months after filing an application in Japan), the JPO will issue a notification of reminder. Within 2 months after the notification is issued, the applicant can inform the JPO of the DAS code or submit the priority document to the JPO.

4. Title of application

The revision made the requirement for titles of applications more relaxed. Before the revision, if the title of an application does not fall within a range of the table of acceptable titles prepared by the JPO, the application was rejected.

The revision abolished the table. After the revision, the JPO accepts any title, as long as the use and function of an article can be clearly recognized from the title, drawings, and descriptions of an application.

5. Number of designs in one application

In Japan, one design application is allowed to include only one design.

On or after April 1, 2021, it is allowed to include multiple designs in one application. Currently, the JPO provides two application forms: a traditional application form for a single design (called “S-form” in the following); and a new application form for multiple designs (called “M-form” in the following). In the case of an application containing multiple designs using the M-form, the applicant pays the official fees for each design at the time of filing the application, and the JPO automatically divides the application into multiple applications without issuing any office action. The JPO examines and registers the designs separately. Filing one application by using the M-form is substantially the same as filing multiple applications by using the S-form.

It is still possible to temporarily include multiple designs in the S-form. If the applicant cannot decide which designs (embodiments) should be protected in Japan at the time of filing, the applicant can apply for multiple designs by using the S-form in a traditional manner and pay the official fees only for one design. The applicant may select one design to be protected in the application and delete the other designs after the JPO issues an office action due to multiple designs in one application. The applicant can file divisional applications for the deleted designs at the same time as the deletion.

Points 1 to 3 apply to applications for which the deadline comes on or after April 1, 2021. Points 4 and 5 apply to applications filed on or after April 1, 2021, regardless of priority dates.