

Design Right	Date	December 21, 2023	Court	Intellectual Property High Court, Fourth Division
	Case number	2023 (Gyo-Ke) 10066		
<p>- A case in which, concerning a registered design whose article to the design is "Tile", the Court rescinded the JPO Decision by finding that the JPO Decision, which dismissed a demand for a trial for invalidation of the registered design by holding that the registered design is not similar to a prior, publicly known design, has a cause for rescission by erroneous determination of similarity.</p>				

Case type: Rescission of Trial Decision to Maintain

Result: Granted

References: Article 3, paragraph (1), item (iii) of the Design Act

Related rights, etc.: Design Registration No. 1697530; Design Registration No. 1663938

Decision of JPO: Invalidation Trial No. 2022-880001

#### Summary of the Judgment

1 The present case is a suit against the appeal decision made by the JPO which dismissed a demand for a trial for invalidation of the design pertaining to Design Registration No. 1697530, whose article to the design is "Tile" (Registered Design). The Plaintiff asserted that the Registered Design is similar to the Cited Design (Design Registration No. 1663938), as indicated in a design gazette that was published prior to the filing date of the application for the Registered Design (Article 3, paragraph (1), item (iii) of the Design Act), and demanded a trial for invalidation. In the JPO Decision, the JPO determined that it cannot be said that the Registered Design is similar to the Cited Design, so that the demand has no grounds. In response, the Plaintiff filed the suit of the present case on the grounds of erroneous determination of similarity, which constitutes a cause for rescission.

2 In the judgment of the present case, the Court rescinded the JPO Decision, for the reasons outlined below.

(1) The basic compositions of the Registered Design and the Cited Design are such that both have well-known tile shapes called "Honbuki Ittaigawara", which is created by the integrated molding of plain tiles (concave tiles) and round tiles (convex tiles) that are used in a traditional roofing method. Many of the specific compositions of the Registered Design adhere to the composition of the conventional Honbuki Ittaigawara.

(2) As a specific composition that is commonly found in the Registered Design and the Cited Design, there is a vertically-long pattern of a U-shape, whose outline is

turned around 270 degrees so that the opening faces downward, placed on the right and left sides as well as the top of the convex tile (U-Shaped Pattern).

In Okinawa, the roofing method of using plaster to cement the joint parts of tiles is traditionally used, and the appearance created by the contrast of the red color of the tiles and the white color of the plaster is valued highly and is known by the name of "Okinawa Red Tile", etc.

The idea of placing white patterns on the convex tile part of the Honbuki Ittaigawara and giving the appearance resembling Okinawa Red Tiles, and the design that has the pattern of a U-shape with the opening facing upward are indicated in publicly known literature. However, there is no indication of a design whose opening faces downward, as in the case of the U-Shaped Pattern, in publicly known literature, etc. It is acknowledged that the pattern of a U-shape with the opening facing upward, and the pattern of a U-shape with the opening facing downward, have different impressions when the roofing with the tiles is completed.

(3) From the viewpoint of aesthetics, on which consumers place emphasis, the main consumers of tiles are clients of the buildings that have tile roofs, so that the aesthetics sought by such consumers relate to the post-construction appearance. As such, it is assumed that consumers such as builders and sellers ultimately place the greatest emphasis on the post-construction appearance. On the other hand, the effect, which is brought about by the composition that cannot be observed once the roofing is done, on the determination of similarity between designs, remains relatively small.

(4) In regard to the appearance after completion of the roofing with Honbuki Ittaigawara, the way the convex tiles are lined up along the slopes of the roof and extend in a methodical manner gives a gorgeous and stately impression, and it can be said that the shape and pattern pertaining to such convex tiles being lined up strongly attracts the attention of observers.

Next, the U-Shaped Pattern, which is given to the convex tiles, creates the appearance that has a touch of Okinawa Red Tiles once the roofing is completed, so that the appearance strongly appeals to the aesthetics of observers, and this is a novel creative part of the Cited Design which cannot be found in any publicly known design.

Accordingly, in the Registered Design and the Cited Design, the shape that attracts the attention of observers most strongly (the important part) is the U-Shaped Pattern, which is commonly found in the two designs, and it should be said that this commonality is what most strongly affects the determination of similarity.

(5) On the other hand, the points of difference in the compositions of the Registered Design and the Cited Design are minor differences in said pattern, and

they constitute [i] the part that cannot be observed from the post-construction state of roofing with tiles, [ii] the difference within the scope of a known shape that is adopted in conventional Honbuki Ittaigawara, or [iii] the commonality pertaining to the U-Shaped Pattern, which is a novel creative part that could not be found in a conventional design.

(6) As described above, it should be said that the important parts of the Registered Design and the Cited Design are the composition parts pertaining to the convex tiles being lined up, which attracts the attention of observers in the Honbuki Ittaigawara, as well as the U-Shaped Pattern, which is newly created and cannot be found in conventional designs. This commonality has an extremely strong effect on the determination of similarity between the two designs. On the other hand, the points of difference of the two marks include points that have a certain level of effect on the determination of similarity, yet such effect must be determined as being relatively small, and when evaluated on the whole, it should be said that the Registered Design is similar to the Cited Design.

The JPO Decision, which determined otherwise, has the illegality of erroneously determining similarity as stipulated in Article 3, paragraph (1), item (iii) of the Design Act.