

Design Right	Date	December 25, 2023	Court	Intellectual Property High Court, First Division
	Case number	2023 (Gyo-Ke) 10071		
<p>- A case in which, concerning an application for design registration wherein articles embodying the design are "Bags", the Court did not acknowledge that the design, which is indicated in a certificate that the Plaintiff submitted to be granted the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (3) of the Design Act, is identical to the Cited Design, and held that the Plaintiff's publication of the Cited Design cannot be subject to the application of Article 4, paragraph (2) of the same Act.</p>				

Case type: Rescission of Appeal Decision of Refusal

Result: Dismissed

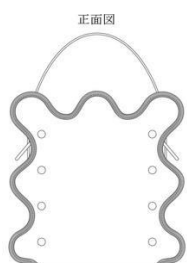
References: Article 4, paragraph (2) and paragraph (3), and Article 3, paragraph (1), item (iii) of the same Act

Related rights, etc.: Design Application No. 2021-19105; Appeal against Examiner's Decision No. 2022-13077

#### Summary of the Judgment

1 On September 3, 2021, the Plaintiff filed an application for design registration wherein articles embodying the design are "Bags" (Design Application No. 2021-19105; hereinafter referred to as "Application", and the design pertaining to the Application is referred to as "Applied Design"; for reference, a part of a drawing indicating the design is cited from Exhibit 1 of the Judgment and shown below), and submitted a certificate dated September 10, 2021 (hereinafter referred to as "Certificate", and the design indicated in the Certificate is referred to as "Design Indicated in Certificate"; for reference, the image of the Design Indicated in Certificate is cited from Image 1 attached to Exhibit 3 of the Judgment and shown below) for the Application to be granted the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (3) of the Design Act (paragraph (3) was revised by Act No. 51 of 2023 (hereinafter referred to as "Revised Act"), but the date of enforcement of the revision to Article 4, paragraph (3) of the Design Act pertaining to Article 1, item (ii) of the Supplementary Provisions to the Revised Act is January 1, 2024, and in regards to the applications for design registration that were filed earlier than said date pursuant to Article 4 of the Supplementary Provisions to the Revised Act, the provisions in force at the time in question continue to apply), but received a decision of rejection on May 23, 2022. The Plaintiff filed a request for an appeal against the examiner's decision of rejection, but the JPO determined that the Applied Design is similar to the Cited Design (the design posted on the website on August 31, 2021; for reference, an image of the Cited

Design is cited from the Cited Design in Exhibit 2 of the Judgment and shown below), and that the Cited Design and the Design Indicated in Certificate cannot be acknowledged as identical, so that the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the Design Act is not applicable, and by holding that the Applied Design falls under the design listed under Article 3, paragraph (1), item (iii) of the Design Act, rendered the JPO's decision to the effect that the request shall not be granted (hereinafter referred to as "JPO Decision"). The present case is a suit for rescission of the JPO Decision, and the issue concerns whether or not the exception to lack of novelty of design according to Article 4, paragraph (2) of the Design Act is applicable (cause for rescission).



(Applied Design)



(Cited Design)



(Design Indicated in Certificate)

2 In the judgment of the present case, concerning whether or not there is error in the JPO Decision not to grant application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the Design Act for the Cited Design, the Court determined as follows and dismissed the Plaintiff's request.

(1) The purport of Article 4, paragraph (3) of the Design Act is to provide for a special requirement to be granted the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the same Act, as the exception to Article 3, paragraph (1) of the same Act. In principle, before the filing of an application for design registration, a certificate pertaining to the design must be submitted for each design that is published as a result of an act by a person who has the right to be granted design registration. Accordingly, it is understood that the design indicated in the certificate must be identical to the cited design. Of course, it is not reasonable to consider that the two designs lack identicalness if the difference between the design indicated in the certificate and the cited design is only minor. Also, by taking into consideration the burden of the applicant of design registration in terms of the procedures involved, if it can be acknowledged that the points of difference between the design indicated in the certificate and the cited design are

within a scope wherein, in light of the nature and functions of articles, it can be sufficiently understood that such points of difference are substantively identical, it is reasonable to acknowledge that the design indicated in the certificate and the cited design are identical as well.

Nevertheless, concerning the studs, which constitute a point of difference between the Two Designs, it can be said that the placement, per se, of studs is common, given the nature of the article as a bag. Meanwhile, the number and layout of studs are not uniform, and the number and layout of studs can affect the aesthetics of the bag. As for the appearance of studs, which is a point of difference between the Two Designs, it is sufficiently possible to observe the studs with the naked eye, so that the studs function as decorative composition elements of the design of the front of the bag. The layout of three studs, with regard to which "the space between the second and the third, counted from the top, is slightly longer than the space between the first and second", is different in construction from the layout of "a set of four studs each, almost at regular intervals", and furthermore, in relation to the forms of the top hem and the three hems on the right and left in the front of the storage unit, which are shared by the Two Designs, the Design Indicated in Certificate has three studs laid out against the same number of three mountain parts on the right and left hems, with the second stud laid out on a line which connects, in a straight line, the peaks of the mountain parts at the center of the right and left hems. In contrast, the Cited Design has four studs laid out, which is one stud more than the three mountain parts, on each of the right and left hems, and the second stud is positioned nearer to the bottom of a valley part, between the mountain parts of the upper corners on the right and left and the mountain parts at the center of the right and left hems, and the third stud, counted from the top, is positioned slightly nearer to the upper part of the center of the valley part between the mountain parts at the center of the right and left hems and the mountain parts of the lower corners on the right and left. As such, it can be said that even in relation to the mountain parts on the right and left hems, when the storage unit, which is commonly found in the Two Designs, is seen from the front, each design has its own aesthetics unlike the other.

In that case, given that it can be said that the points of difference between the Two Designs, as shown in the number and layout of studs on the front side, are points of difference that affect the aesthetics relating to the forms, etc. of articles, it cannot be said that it can be acknowledged that the points of difference between the design indicated in the certificate and the Cited Design are within a scope wherein it can sufficiently be understood that the points of difference are substantively identical in

light of the nature and functions of the articles.

(2) Based on the above, it cannot be acknowledged that the Cited Design is identical to the Design Indicated in Certificate, which is shown in the Certificate, and thus it cannot be acknowledged that the publication of the Cited Design was based on the publication of the prior Design Indicated in Certificate.

In that case, since it leads to the conclusion that the certificate as stipulated in Article 4, paragraph (3) of the Design Act was not submitted for the Cited Design, the Plaintiff cannot be granted the application of Article 4, paragraph (2) of the same Act for the Cited Design.

Judgment rendered on December 25, 2023

2023 (Gyo-Ke) 10071 Case of seeking rescission of JPO decision

Date of conclusion of oral argument: October 25, 2023

### Judgment

Plaintiff: Rainbow Shake Inc.

Defendant: Commissioner of JPO

### Main text

1. The Plaintiff's claims shall be dismissed.
2. Court costs shall be borne by the Plaintiff.

### Facts and reasons

#### No. 1 Trial sought by the Plaintiff

The decision made by the JPO on May 22, 2023 for Appeal against Examiner's Decision No. 2022-13077 shall be rescinded.

#### No. 2 Outline of the case

The present case is a suit for rescission of the JPO decision which dismissed a request for appeal against the examiner's decision of refusal of an application for design registration.

##### 1. Background to the procedures of JPO

On September 3, 2021, the Plaintiff filed an application for design registration with the details described below in 2 (Design Application No. 2021-19105; hereinafter referred to as "Application", and the design pertaining to the Application is referred to as "Applied Design"), and submitted a certificate dated September 10, 2021 (Exhibit Ko 1; hereinafter referred to as "Certificate", and the design indicated in the Certificate is referred to as "Design Indicated in Certificate") for the Application to be granted the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (3) of the Design Act (paragraph (3) was revised by the Act No. 51 of 2023 (hereinafter referred to as "Revised Act"), but the date of enforcement of the revision to Article 4, paragraph (3) of the Design Act pertaining to

Article 1, item (ii) of the Supplementary Provisions to the Revised Act is January 1, 2025, and in regards to the applications for design registration that were filed earlier than said date pursuant to Article 4 of the Supplementary Provisions to the Revised Act, the provisions in force at the time in question continue to apply), but received a decision of rejection on May 23, 2022.

On August 22 of the same year, the Plaintiff submitted a notice of appeal and requested for an appeal against the examiner's decision of refusal, and the JPO examined the request for trial as Invalidation Trial No. 2022-13077, and on May 22, 2023, rendered a decision to the effect that the "request for a trial of the present case has no grounds" (hereinafter referred to as "JPO Decision"), and a copy of the decision was sent to the Plaintiff on June 8 of the same year.

2. Applied Design

The Applied Design for which the Plaintiff filed the Application is as indicated in Exhibit 1 (Exhibit Otsu 3).

3. Gist of the reasons for the JPO Decision

(1) Comparison of the articles embodying the design and determination of similarity

The articles embodying the Applied Design and the design indicated in Exhibit 2 (the part indicating "Cited Design" on the second page of Exhibit 2, and the part circled in red in the indication of "Enlargement of Cited Design" on the third page of Exhibit 2; hereinafter referred to as "Cited Design") are "Bags" for the Applied Design, and "Bags" for the Cited Design as well, so that there is similarity of articles embodying the design. Accordingly, the articles embodying the Applied Design and the Cited Design are identical.

(2) Comparison of the forms, etc. of the Applied Design and the Cited Design

A. The forms, etc. of the Applied Design and the Cited Design are similar in the following respects.

As the basic structure of an embodiment,

(Similarity A) Both designs have the overall structure consisting of the main unit, which is shaped like a chassis, with the top surface opened, and a holding unit.

As a specific embodiment,

(Similarity B) The main unit, which constitutes a storage unit, has the shape of an approximate cuboid consisting of thin plate-like materials, which are extended upward and in the directions of right and left on the front and back surfaces, with the edges formed into wave shapes, and there are mountain parts, in sets of three, on the top hem and on the right and left hems, including the upper corners on the right and left,

and the mountain parts in the upper corners on the right and left look as if the mountain parts on the top hem and on the right and left hems have been joined, and are shaped like approximate half ovals protruding upward in right and left oblique directions, when seen from the front, and the mountain parts on the right and left sides of the bottom hem having the form of an approximate arc with the bottom hem being a straight line.

(Similarity C) The similarity consists of the holding unit having a thin belt-like shape, and studs, as fasteners, and ring-shaped metal fittings being placed vertically nearer to the upper part of the center of the right and left sides, and when seen from the front, one holding unit being formed into an arc whose height is approximately 1/4 of the entire form.

(Similarity D) The similarity in terms of studs is such that small round studs are placed nearer to the right and left edges in the front, with some room on top and bottom, in a vertical line in sets of four, being placed almost at regular intervals.

B. The Applied Design and the Cited Design have forms, etc. that are different in the following respects.

As a specific embodiment,

(Point of Difference a) There is the difference in the manner of attachment of the holding unit, which is that the Applied Design has the holding unit being fastened with two studs that are placed vertically, with a D-ring metal fitting placed in-between, whereas in the Cited Design, the place corresponding to the upper stud cannot be observed, and only the lower stud and the upper ring-shaped metal fitting can be observed.

(Point of difference b) There is the difference in that, in the Applied Design, the part consisting of studs has sets of four small round studs placed in a vertical line nearer to the right and left edges on the front and back surfaces, whereas in the Cited Design, the layout of studs on the back surface is unknown.

(Point of difference c) The difference is such that in the Cited Design, the coloring is ivory for the main unit of the bag, and brown for the holding unit, and metal coloring (silver) for the studs and metal fittings, whereas in the Applied Design, no color is used.

(3) Evaluation of forms, etc. of the Applied Design and the Cited Design

A. Concerning Similarity (A) and Similarity (C) pertaining to the basic structure of an embodiment, such similarities apply when the forms, etc. of the Applied Design and the Cited Design are generally captured as bags, and in the field of goods that include bags, the forms, etc. are very commonly found as composition elements, so

that it cannot be said that it has a great impact on the determination of similarity between the Applied Design and the Cited Design.

On the other hand, in regards to Similarity (B) and Similarity (D), the similarities concern the overall form and the specific forms, etc. of the main unit, which attract the attention of consumers, and in particular, the appearance in which thin plate-like materials are extended upward and in the directions of right and left on the front and back surfaces, with the edges formed into wave shapes, and there are mountain parts, in sets of three, on the top hem and on the right and left hems, including the upper corners on the right and left, and the mountain parts in the upper corners on the right and left look as if the mountain parts on the top hem and on the right and left hems have been joined, and are shaped like approximate half ovals protruding upward in right and left oblique directions, when seen from the front, and the mountain parts on the right and left sides of the bottom hem having the form of an approximate arc with the bottom hem being a straight line. These features are shared by both the Applied Design and the Cited Design, and strongly give the impression to consumers that the Applied Design and the Cited Design share similarity, so that they perform a very significant function as a decorative accent, with the part consisting of studs being placed nearer to the right and left edges in the front, where it can easily be seen. Accordingly, these similarities have a very significant effect on the determination of similarity between the Applied Design and the Cited Design.

In that case, even if the effect which Similarity (A) and Similarity (C) have on the determination of similarity between the Applied Design and the Cited Design may be small, the effect which Similarity (B) and Similarity (D) have on the determination of similarity between the Applied Design and the Cited Design is very significant, so that Similarities (A) to (D), when considered together, give a stronger impression of similarity to observers.

B. In contrast, Point of Difference (a) and Point of Difference (b) have a small effect on the determination of similarity between the Applied Design and the Cited Design, and Point of Difference (c) has an imperceptible effect on such determination of similarity, so that even when Points of Difference (a) to (c) are considered together, it does not result in an effect that would influence such determination of similarity.

C. In that case, the Applied Design and the Cited Design have forms, etc. in which Similarities (A) to (D), when considered together, give a stronger impression of similarity to observers, whereas Points of Differences (a) to (c), even when considered together, do not have an effect that would influence the determination of similarity between the Applied Design and the Cited Design. Accordingly, the impression of



the points of difference is not such that it overturns the impression of similarity, and thus the Applied Design and the Cited Design are similar.

(4) Determination of similarity between the Applied Design and the Cited Design

Accordingly, the Applied Design and the Cited Design have the same articles embodying the design, and in regards to the forms, etc., the similarities have a significant effect on the determination of similarity between the Applied Design and the Cited Design, and give a stronger impression of similarity to observers, whereas the points of difference are small, and they are not sufficient to overturn the impression given by similarities. Accordingly, when the designs are observed on the whole, the Applied Design is similar to the Cited Design.

(5) Exception to lack of novelty of design

A. As indicated in Exhibit 3, the Design Indicated in Certificate was published on the Internet on March 14, 2021 by Ko, who is the creator of the Applied Design, and is the design for the "Bag" that was posted on Instagram (\* (omitted) \*) by an account holder whose name is "Ko".

The Design Indicated in Certificate is as shown in Images 1 and 2 attached to Exhibit 3, and the forms, etc. are as follows: [A] The entire form consist of the main unit, which is shaped like a chassis, with the top surface opened, and a holding unit; and [B] The main unit, which constitutes a storage unit, has the shape of an approximate cuboid consisting of thin plate-like materials, and the thin plate-like materials are extended upward and in the directions of right and left on the front and back surfaces, with the edges formed into wave shapes, and there are mountain parts, in sets of three, creating a total of seven mountain parts on one surface, on the top hem and on the right and left hems, including the upper corners on the right and left, and the mountain parts in the upper corners on the right and left look as if the mountain parts on the top hem and on the right and left hems have been joined, and are shaped like approximate half ovals protruding upward in right and left oblique directions, when seen from the front, and the mountain parts on the right and left sides of the bottom hem having the form of an approximate arc with the bottom hem being a straight line; and [C] The holding unit has a thin belt-like shape, and studs, as fasteners, are placed vertically nearer to the upper part of the center of the right and left sides, and when seen from the front, one holding unit is formed into an arc whose height is approximately 1/4 of the entire form; and [D] The part consisting of studs has small round studs being placed nearer to the right and left edges in the front, with some room on top and bottom, in a vertical line in sets of three, being placed with the space between the second and the third, counted from the top, being slightly longer

than the space between the first and second; and [E] All edges other than the bottom hem are bordered with a bordering material; and [F] The main unit of the bag and the holding unit are colored in black and the studs and metal fittings are colored in metal color (silver).

B. When the Design Indicated in Certificate and the Cited Design (hereinafter sometimes referred to as "Two Designs") are compared, first of all, the articles embodying the designs are both "Bags", so that the articles embodying the design are identical.

Next, in regards to the forms, etc., in the Design Indicated in Certificate, the studs on the front side are placed in sets of three, in a single vertical line nearer to the right and left, with the space between the second and the third, counted from the top, being slightly longer than the space between the first and second, and the main unit and the holding unit being black, whereas in the Cited Design, the studs on the front side are placed nearer to the right and left directions in a vertical line, in sets of four, almost at regular intervals, and the main unit is ivory and the holding unit is brown, with ring-shaped metal fittings placed on the fastener sides. As such, the Two Designs are different in terms of the presence or lack of ring-shaped metal fittings on the holding unit, the number and layout of studs on the front side, and the colors of the holding unit and the main unit. Accordingly, the Two Designs have points of difference, so that they cannot be acknowledged as identical designs, and thus it cannot be acknowledged that the Cited Design was published based on the publication of the prior Design Indicated in Certificate.

In that case, the Cited Design cannot be the subject of application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the Design Act, and shall not be excluded from the materials for determining the novelty of the Applied Design.

Accordingly, the Cited Design is a design that was published prior to the filing of the Application, and as indicated in the above (4), the Applied Design is similar to the Cited Design, and thus the Applied Design falls under the design listed in Article 3, paragraph (1), item (iii) of the Trademark Act.

(omitted)

No. 5 Judgment of this court

1. Cause for rescission

(1) The Plaintiff's argument that there is error in the JPO Decision, which did not

grant to the Cited Design the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the Design Act, shall be considered below.

(2) Article 4, paragraph (2) of the Design Act provides that, regarding the application of the provisions of Article 3, paragraphs (1) and (2) to a design in an application for design registration that the person with the right to register the design has filed within one year after the day on which that design, due to that person's actions, came to fall under the provisions of Article 3, paragraph (1), item (i) or (ii), the Court approves the exception to lack of novelty of design by deeming that the design in question not to have come to fall under the provisions of Article 3, paragraph (1), item (i) or (ii).

A person intending to be granted such application of the exception to lack of novelty of design must submit to the Commissioner of the JPO a document indicating such intention, at the same time as the filing of an application for design registration, and must submit to the Commissioner of the JPO a document that proves that the design, which came to fall under the provisions of Article 3, paragraph (1), item (i) or (ii) of the Design Act, is a design that can be granted the application of Article 4, paragraph (2) of the same Act, within 30 days from the date of filing the application for design registration (Article 4, paragraph (3) of the same Article).

Accordingly, in order for the Plaintiff to be granted the application of Article 4, paragraph (2) of the Design Act for the Cited Design, there must be the premise that the Plaintiff submitted the certificate prescribed in Article 4, paragraph (3) for the Cited Design.

(3) Regarding this point, the Plaintiff asserts that the Design Indicated in Certificate, as indicated in the Certificate, and the Cited Design are substantively identical designs, and asserts that based on the Plaintiff's submission of the Certificate to the Commissioner of the JPO, it should be acknowledged that the Cited Design was published based on the publication of the prior Design Indicated in Certificate.

Upon considering the case in view of the above, the Design Indicated in Certificate is as shown in Exhibit Ko 1 (Images 1 and 2 attached to Exhibit 3), which shows that the forms, etc. consist of a storage unit, which has the overall shape of an approximate cuboid with a gusset, and a handle cross-linked in the shape of an arc from both right and left sides of the top hem of the storage unit, and both the storage unit and the handle being colored in black, and on the storage unit, there are the three hems; namely, the top hem in the front as well as the right and left hems, being formed into wave forms, creating a total of seven mountain parts as follows: There are three mountain parts on each hem of the top hem and the right and left hems of the

storage unit, including where the mountain parts on the top hem and on the right and left hems constitute the upper corners on the right and left; The mountain parts in the upper corners on the right and left look as if the mountain parts on the top hem and on the right and left hems have been joined, and are shaped like approximate half ovals protruding upward in right and left oblique directions, when seen from the front; the arc-shaped mountain parts at the center of the right and left hems; the mountain parts in the lower corners on the right and left, having the form of an approximate arc with the bottom hem being a straight line. Starting from a position slightly apart from the top hem of the storage unit, small roughly round-shaped studs are lined up along the right and left hems in a straight line from top down. The space between the second and the third studs, counted from the top, is slightly longer than the space between the first and second studs, and the studs are placed in sets of three. As for the layout of the studs, the first stud, counted from the top, is placed nearer to the upper part of the valley part between the mountain parts, which constitute the upper corners on the right and left, and the mountain parts, which are at the center of the right and left hems, and the second stud, counted from the top, is placed on a straight line which connects the peaks of the mountain parts at the center of the right and left hems, and the third stud, counted from the top, is placed on a straight line which connects the peaks of the mountain parts in the lower corners on the right and left.

On the other hand, the Cited Design is as shown in Exhibit Ko 2 (pages 2 and 3 of Exhibit 2), and when compared with the Design Indicated in Certificate as recognized above, the points of difference in the forms, etc. of the Two Designs are as follows, as described above in No. 2-3 (5) B, as recognized in the JPO Decision: The Design Indicated in Certificate has the studs on the front side placed nearer to the right and left in a single vertical line, in sets of three, with the space between the second and the third, counted from the top, being slightly longer than the space between the first and second, and the main unit and the holding unit being colored in black, whereas in the Cited Design, the studs on the front side are placed nearer to the right and left directions in a vertical line, in sets of four, almost at regular intervals, and the main unit is ivory and the holding unit is brown, with ring-shaped metal fittings placed on the fastener sides; the Two Designs are different in terms of the presence or lack of ring-shaped metal fittings on the holding unit, the number and layout of studs on the front side, and the coloring of the holding unit and the main unit.

Next, as determined below in (4), the Design Indicated in Certificate and the Cited Design have points of difference in the number and layout of studs on the front side, at least when seen from the front, and since it cannot be said that such points of

difference are within a scope that can sufficiently be recognized as substantively identical in light of the nature and functions of articles, it cannot be said that the Two Designs are identical.

(4) The Plaintiff asserts the following: The forms that are commonly found in the Two Designs are unique and give a strong impression to consumers, so that it cannot be helped that the points of difference of the number and layout of studs on the front side leave little impression; as such, although the studs relate to the appearance of the front side of the bag, instead of the number and layout of studs being clearly recognized as points of difference between the Two Designs, it is natural to consider that both of the Two Designs respectively give rough impressions such as that "a plural number of studs are aligned", and since consumers receive the same impression from the points of difference of the Two Designs, it can be said that they are substantively identical, and the Plaintiff asserts that the Two Designs are identical.

However, the purport of Article 4, paragraph (3) of the Design Act is to provide for a special requirement to be granted the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the same Act, as the exception to Article 3, paragraph (1) of the same Act. In principle, before the filing of an application for design registration, a certificate pertaining to the design must be submitted for each design that is published as a result of an act by a person who has the right to be granted design registration. Accordingly, it is understood that the design indicated in the certificate must be identical to the cited design. Of course, it is not reasonable to consider that the two designs lack identicalness if the difference between the design indicated in the certificate and the cited design is only minor. Also, by taking into consideration the burden of the applicant of design registration in terms of the procedures involved, if it can be acknowledged that the points of difference between the design indicated in the certificate and the cited design are within a scope wherein, in light of the nature and functions of articles, it can be sufficiently understood that such points of difference are substantively identical, it is reasonable to acknowledge that the design indicated in the certificate and the cited design are identical as well.

Nevertheless, concerning the studs, which constitute a point of difference between the Two Designs, it can be said that the placement, per se, of studs is common, given the nature of the article as a bag (Exhibits 4 to 11). Meanwhile, the number and layout of studs are not uniform, and the number and layout of studs can affect the aesthetics of the bag. As for the appearance of studs, which is a point of difference between the Two Designs, it is sufficiently possible to observe the studs with the

naked eye, so that the studs function as decorative composition elements of the design of the front of the bag. The layout of three studs, with regard to which "the space between the second and the third, counted from the top, is slightly longer than the space between the first and second", is different in construction from the layout of "a set of four studs each, almost at regular intervals", and furthermore, in relation to the forms of the top hem and the three hems on the right and left in the front of the storage unit, which are shared by the Two Designs, the Design Indicated in Certificate has three studs laid out against the same number of three mountain parts on the right and left hems, with the second stud laid out on a line which connects, in a straight line, the peaks of the mountain parts at the center of the right and left hems. In contrast, the Cited Design has four studs laid out, which is one stud more than the three mountain parts on the right and left hems, and the second stud is positioned nearer to the bottom of a valley part, between the mountain parts of the upper corners on the right and left and the mountain parts at the center of the right and left hems, and the third stud, counted from the top, is positioned slightly nearer to the upper part of the center of the valley part between the mountain parts at the center of the right and left hems and the mountain parts of the lower corners on the right and left. As such, it can be said that even in relation to the mountain parts on the right and left hems, when the storage unit, which is commonly found in the Two Designs, is seen from the front, each design has its own aesthetics unlike the other.

In that case, given that it can be said that the points of difference between the Two Designs, as shown in the number and layout of studs on the front side, are points of difference that affect the aesthetics relating to the forms, etc. of articles, it cannot be said that it can be acknowledged that the points of difference between the design indicated in the certificate and the Cited Design are within a scope wherein it can sufficiently be understood that the points of difference are substantively identical in light of the nature and functions of the articles.

Accordingly, the Plaintiff's argument against the above determination cannot be accepted.

(5) Based on the above, it cannot be acknowledged that the Cited Design is identical to the Design Indicated in Certificate, which is shown in the Certificate, and thus it cannot be acknowledged that the publication of the Cited Design (Ko 2) was based on the publication of the prior Design Indicated in Certificate.

In that case, since it leads to the conclusion that the certificate as stipulated in Article 4, paragraph (3) of the Design Act was not submitted for the Cited Design, the Plaintiff cannot be granted the application of Article 4, paragraph (2) of the same Act

for the Cited Design.

Accordingly, it cannot be acknowledged that there is error in the JPO Decision not to grant the application of the exception to lack of novelty of design as stipulated in Article 4, paragraph (2) of the Design Act for the Cited Design.

2. Based on the above, the Cited Design is a design that was published prior to the Application, and as determined in the JPO Decision under No. 2-3 (3), the Applied Design is similar to the Cited Design (the Plaintiff does not argue against this point), so that it cannot be said that there is error in the JPO Decision which held that the Applied Design falls under the design listed in Article 3, paragraph (1), item (iii) of the Design Act. Accordingly, the cause of rescission as asserted by the Plaintiff has no grounds.

#### No. 6 Conclusion

As described above, the Court dismisses the Plaintiff's request which has no grounds, and renders a judgment as per the main text.

Intellectual Property High Court, First Division

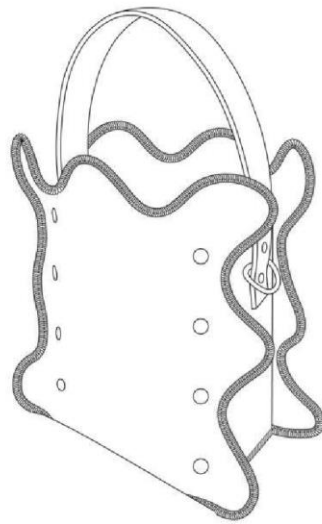
Presiding Judge: HONDA Tomonari

Judge: TOYAMA Atsushi

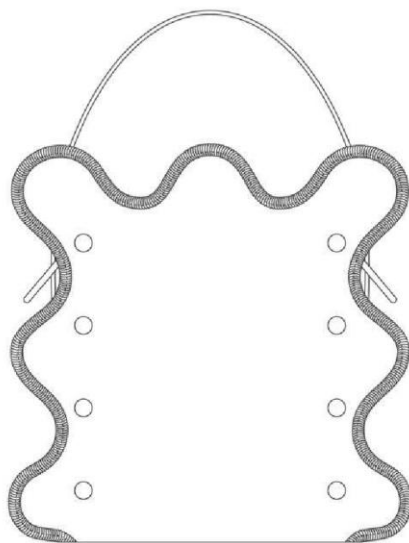
Judge: AMANO Kenji

[Articles embodying the design] Bags

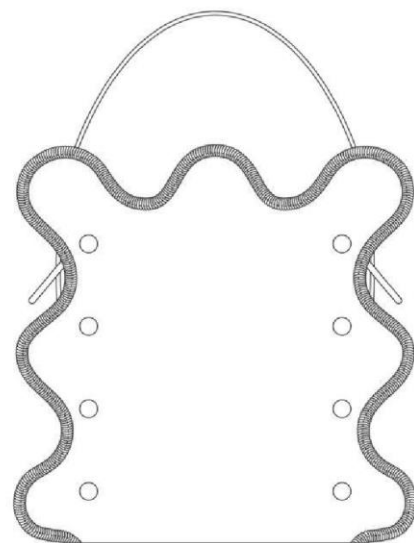
Perspective view



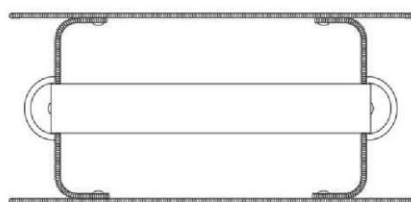
Front view



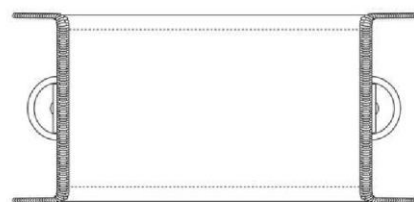
Rear view



Plan view

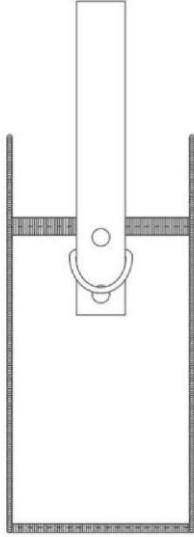


Bottom view

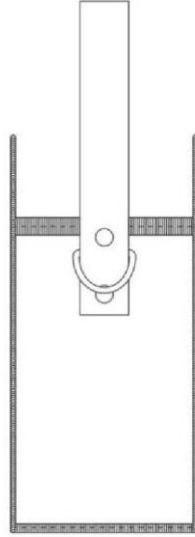




Left-hem view



Right-hem view



## Exhibit 2 Cited Design

Design of the bag shown on the website below

Title: nori enomoto Limited pre-orders of wavy and three-dimensional new bag "mardi matin"

Medium: [Online]

Date of post: August 31, 2021

Search date: [February 10, 2022]

Information source: Internet

URL address for information: <https://strend.jp/article/15038>

2022/2/10 nori enomoto ウェイビーで立体的な新作バッグ「マルディマタン」を限定受注販売。 | STREND. [ストレンド]

STREND. + フォローする 🔍 ☰

HOME FASHION MUSIC LIFESTYLE BEAUTY

🏠 > FASHION > nori enomoto ウェイビーで立体的な新作バッグ「マルディマタン」を限定受注販売。

FASHION

### nori enomoto ウェイビーで立体的な新作バッグ「マルディマタン」を限定受注販売。

「nori enomoto (ノリエノモト)」が、ウェーブが印象的な新作バッグ「mardi matin (マルディマタン)」を発売。東京・渋谷の「WHITE ROOM」でポップアップも開催。

© 2021.08.31 | 👁 761 VIEWS

🐦 ツイート 📌 シェア 🗨 LINEで送る

公開日

「nori enomoto (ノリエノモト)」が、新作バッグ「mardi matin (マルディマタン)」を、2021年9月3日(金) 21:00 ~ 7日(火) 21:00までの期間、公式サイトにて数量限定で受注販売。

また、9月4日(土)と5日(日)には、東京・渋谷の「WHITE ROOM (ホワイトルーム)」でポップアップストアを開催。

STREND.

LATEST POSTS

FASHION

ANREALAGEがCH... 初の  
のゴシックコレクション

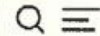
RACETOP

<https://strend.jp/article/15038>

1/7

## STREND.

+ フォローする



HOME

FASHION

MUSIC

LIFESTYLE

BEAUTY

ヘアアクセを切り替えて、フォーマルなシーンでも活用でき、デザイン性だけではなく使い勝手がいいのもポイント。カラーは、nori enomotoならではのポップなカラーが揃い、グリーンやピンク、オレンジをはじめ、ピュアなホワイトやシックなブラックなども取り揃えています。



全て表示 +



ランキング

## &lt;ポップアップストア概要&gt;

開催期間：2021年9月4日（土）～ 5日（日）

場所：WHITE ROOM

住所：[REDACTED]

※ポップアップでの商品購入はできない。受注販売はwebにて。

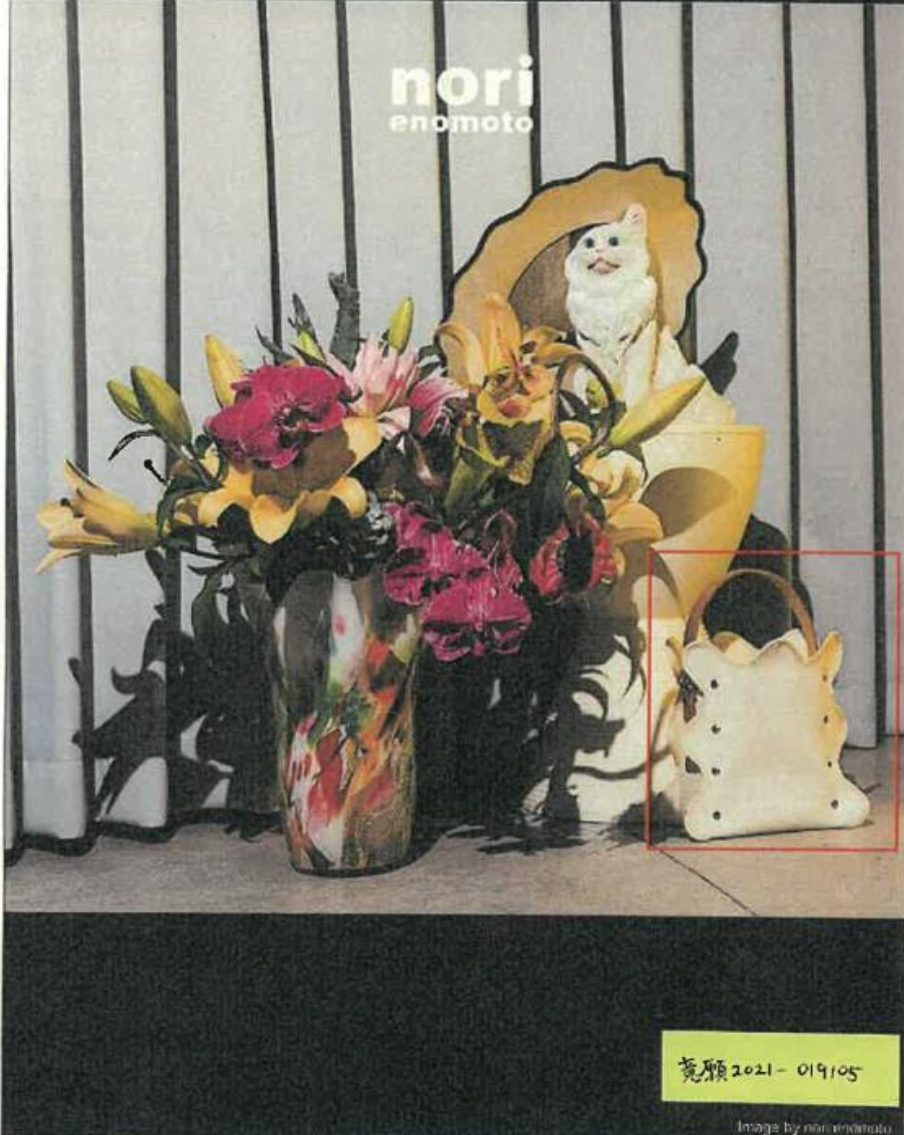
## &lt;web数量限定受注販売&gt;

期間：2021年9月3日（金）21:00～7日（火）21:00

「nori enomoto」公式WEBストア

  
 登録 2021-019105

引用先匠の拡大





別紙第3 証明書記載意匠

【添付書類】



新規性の喪失の例外規定の適用を受けるための証明書

1. 公開の事実

1) ウェブサイトの掲載日 2021年3月14日

2) ウェブサイトのアドレス

██

3) 公開者 ██████████

4) 公開された意匠の内容

██████████が、上記アドレスのウェブサイトにて、自身が創作したバッグの意匠を公開した。当該意匠が掲載されているページ及び該ページに掲載された写真を別紙として添付する。

2. 意匠登録を受ける権利の承継等の事実

1) 公開意匠の創作者 ██████████ (██ 株式会社レインボーシェイク内)

2) 意匠の公開の原因となる行為時の意匠登録を受ける権利を有する者(行為時の権利者)

██████████

3) 意匠登録出願人(願書に記載された者) 株式会社レインボーシェイク (██)

4) 公開者 ██████████

5) 意匠登録を受ける権利の承継について

公開の事実に記載の公開行為により公開された意匠は、██████████によって創作されたものである。██████████氏によるInstagramにおける上記公開後、翌日の2021年3月15日に株式会社レインボーシェイクとの間で譲渡契約を交わし、株式会社レインボーシェイクが意匠登録を受ける権利を承継した。その後、2021年9月3日に株式会社レインボーシェイクが意匠登録出願を行った。

上記記載事項が事実と相違ないことを証明します。

令和3年9月10日

██

株式会社レインボーシェイク  
代表取締役社長 ██████████ 印

(別紙第3 添付画像1)

2

別紙

氏のウェブサイト (Instagram: ) にて、氏が創作したバッグの意匠が掲載されているページ



(別紙第3 添付画像2)

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L

