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judgedate

1974.03.19

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caseid

1970(Gyo-Tsu)45

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reporter

Minshu Vol. 28, No. 2

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casetitle

Judgment regarding the application of Article 3, paragraph (2) of the Design Act to the design of an identical or similar article

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casename

Case to seek revocation of a trial decision

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caseresult

Judgment of the Third Petty Bench, dismissed

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court_second

Tokyo High Court, Judgment of January 29, 1970

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summary_judge

Article 3, paragraph (2) of the Design Act shall apply to the design of an identical or similar article.

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references

Article 3 of the Design Act

Design Act
Article 3 (1) A creator of a design that is industrially applicable may be entitled to obtain a design registration for the said design, except for the following cases:
(i) Designs that were publicly known in Japan or a foreign country prior to the filing of the application for design registration;
(ii) Designs that were described in a distributed publication in Japan or a foreign country prior to the filing of the application for design registration; or
(iii) Designs similar to those prescribed in the preceding two items.
(2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were widely known in Japan, a design registration shall not be granted for such design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.

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maintext

The final appeal is dismissed.
The cost of the final appeal shall be borne by the appellant of the final appeal.

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reason

Item I in the reasons for final appeal filed by the counsels for the final appeal
It is apparent from the text of the judgment in prior instance that the judgment in prior instance found and determined that the registered design in this case is not similar to the cited design mentioned in the holding in the judgment. This finding and determination can be affirmed as appropriate. The judgment in prior instance does not contain the illegality alleged in the argument of the counsels for the final appeal, and therefore the argument cannot be accepted.
Item II in the reasons for the final appeal
In order to reject the appellant's allegation that the registered design in this case is invalid because it falls under Article 3, paragraph (2) of the Design Act (hereinafter referred to as the "Act"), the judgment in prior instance held that since paragraph (1) of

the same Article is a provision that requires a design relating to an identical or similar article to possess creativity, as a registration requirement, and paragraph (2) of the same Article is a provision that requires a design relating to an article other than the above article to possess creativity, as a registration requirement, in order to determine whether or not a design possesses creativity in relation to an article in the same field as a hose pertaining to the registered design in this case, paragraph (1) of the same Article should be applied, and there is no room for paragraph (2) of the same Article to be applied.
Since a design and article come together, in order to refuse the registration of a design based on Article 3, paragraph (1) of the Act on the grounds that the design is identical or similar to a design that was publicly known in Japan or a foreign country prior to the filing of the application for design registration, or a design that was described in a distributed publication in Japan or a foreign country prior to the filing of the application for design registration, firstly, articles pertaining to the designs are required to be identical or similar, and secondly, designs themselves must be acknowledged to be identical or similar. On the other hand, in contrast with paragraph (1) of the same Article, which focuses on the identicalness or similarity of a design linked to a specific article, paragraph (2) of the same Article, as apparent from its provision, based on shape, patterns or colors, or any combination thereof that were widely known in Japan as an abstract motif that is not connected to an article, requires a design not to be one that a person ordinarily skilled in the art of the design would have been able to easily create, as a registration requirement, and does not focus on whether or not an article linked to the motif is identical or similar. This relationship can also be applied to the relationship between item (iii) of paragraph (1) of the same Article and paragraph (2) of the same Article. The effect of a design right covers designs similar to the registered design, namely, designs that convey beauty that is similar to that of the registered design to general traders and consumers with regard to articles that are identical or similar to the article pertaining to the registered design (Article 23 of the Act). In connection with this, with regard to the design of such articles, item (iii) of paragraph (1) of the same Article focuses on whether or not the beauty is similar from the perspective of general traders and consumers. On the other hand, Article 3, paragraph (2) removed the limit of identicalness or similarity of articles, and based on a motif that was widely known in society, focuses on whether the idea of a design possesses novelty or creativity from the perspective of a person ordinarily skilled in the art of the design. It can be understood that the two provisions are based on different points of view. Therefore, even with regard to designs relating to identical or similar articles, the determination of the similarity referred to in item (iii) of paragraph (1) of the same Article made by whether or not the

effects of designs are similar, and the determination of the easiness of creation referred to in paragraph (2) of the same Article made by whether or not a person ordinarily skilled in the art of the design would have been able to easily create one of the designs based on shape, patterns, colors, etc. of another design, do not necessarily correspond with each other. There may be a case where one design is similar to another design and also falls under a design that can be easily created as referred to in paragraph (2) of the same Article, and there may also be a case where one design cannot be said to be similar to another design because the effects of the design differ from each other, but the easiness of creation referred to in paragraph (2) of the same Article can be acknowledged. In the former case, the information in parentheses in paragraph (2) of the same Article stipulates that it is necessary to refuse the registration by applying only a provision of item (iii) of paragraph (1) of the same Article.

At the same time, with regard to a design in the case where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create said design based on designs set forth in the preceding two items (designs that were publicly known in a foreign country prior to the filing of the application for registration, and designs that were described in a distributed publication in a foreign country prior to the filing of the application for registration), Article 49, item (iii) of the Act limits the period for filing a request for an invalidation trial for the registration of such design. If substantive provisions that set forth grounds for invalidation in response to the above provision are to be cited, there is nothing other than Article 3, paragraph (1), item (iii). With that being said, however, in light of the above holding, it is not appropriate to construe the meaning of "similar" set forth in item (iii) of paragraph (1) of the same Article to have the same meaning as easiness of creation, and to understand that item (iii) of paragraph (1) of the same Article is to refuse registration of a design that a person ordinarily skilled in the art of the design would have been able to easily create based on the designs set forth in item (i) and item (ii) of paragraph (1) of the same Article.

Therefore, it should be said that the determination in prior instance, which held that there is no room for paragraph (2) of the same Article to be applied to a design of an identical or similar article, taking the point of view that does not go along with the above conclusion, contains illegality of making an error in construction of the same Article.

However, according to facts that became final and binding in the judgment in prior instance, the registered design in this case has plain and siding stripes of highly elevated spirals. Between the spirals, there are siding stripes in a mesh pattern at one level lower. The two types of stripes emerge alternately in the longitudinal direction, and such

contrast and repetition leave a visual impression for viewers. The cited design and the flexible and elastic hose addressed in the holding in the judgment in prior instance have totally different effects on design. Based on these facts, the registered design in this case can be acknowledged to have creativity in the context of its idea and cannot be said to be a design that a person ordinarily skilled in the art of the design would have been able to easily create based on shape, patterns or colors, or any combination thereof of the above cited design, etc. Therefore, there are no grounds for the appellant's argument, which alleges that the registered design in this case falls under Article 3, paragraph (2) of the Act, and the conclusion of the determination in prior instance, which rejected such argument, should be said to be legitimate. As a result, the argument of the counsels for the final appeal cannot be accepted.

Accordingly, pursuant to Article 7 of the Administrative Case Litigation Act, and Article 401, Article 95, and Article 89 of the Code of Civil Procedure, the judgment has been rendered as set forth in the main text by the unanimous consent of the justices.

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presiding

Justice TAKATSUJI Masami

Justice SEKINE Kosato

Justice AMANO Buichi

Justice SAKAMOTO Yoshikatsu

Justice ERIKUCHI Kiyoo

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note_other

(This translation is provisional and subject to revision.)