Decided on	December 26, 2007	Court	Intellectual Property High Court, Third Division
Case number	2007 (Gyo-Ke) 10209 2007 (Gyo-Ke) 10210		
- A case, with respect to trial decisions rejecting applications for partial and whole design registration with a packaging container as the article to the design due to the provision in Article 3, paragraph (2) of the Design Act, which were cancelled			

Reference: Article 3, paragraph (2) of the Design Act

Case 1 (Case Number 2007 (Gyo-Ke) 10209) concerns a legal action seeking cancellation of the Japan Patent Office (JPO) trial decision (1), which rejected an application for registration of the partial design for a packaging container (hereinafter referred to as “the Partial Design”). Case 2 (Case Number 2007 (Gyo-Ke) 10210) concerns a legal action seeking cancellation of JPO trial decision (2), which rejected an application for registration of the whole design for a packaging container (hereinafter referred to as “the Whole Design”). The court held joint proceedings on the two cases. In trial decision (1), the Partial Design was described as “partial design concerning the position and scope of the upper near-half of a packaging container equipped with an applicator at the mouth of the cylindrical container; comprising the main body of the container in a cylindrical form with a round cross-section, the top near-half part of the cylinder shaped in a near right-angled trapezium when seen from the lateral aspect with its cross-section gradually shrinking as it nears the top end, a short cylindrical mouth with a smaller diameter than the diameter of the main body of the container formed at an approximate inclination angle of 60 degrees on the end of the cylinder, an applicator in the form of a thick disk with a considerably larger diameter than that of the mouth set on the mouth, and a cap in the form of an open-ended disk with its top face mildly curved and with slip-proof projections on the lateral edge placed over the applicator.” According to trial decision (2), the Whole Design was for “a packaging container equipped with an applicator at the mouth of the cylindrical container; comprising the main body of the container in a cylindrical form with a circular cross-section, the top near-half part of the cylinder shaped in a near right-angled trapezium when seen from the lateral aspect with its cross-section gradually shrinking as it nears the top end, a short cylindrical mouth with a smaller diameter than the diameter of the main body of the container formed at an approximate inclination angle of 60 degrees on the end of the cylinder, an applicator in form of a thick disk with a considerably larger diameter than that of the mouth set on the mouth,

and a cap in form of an open-ended disk with its top face mildly curved and with slip-proof projections on the lateral edge placed over the applicator."
The trial decisions named Design 3 mentioned below as the basis of creation of the Partial Design or the Whole Design. Given that an applicator with a larger diameter than the diameter of the mouth was disclosed for Designs 1 and 2 specified below, the JPO determined that it was easy to create the Partial Design or the Whole Design by enlarging the diameters of the applicator and the cap in Design 3.

Design 1: The design stated in Publication of Registered Design No. 1014164
Design 2: The design stated in Publication of Registered Design No.1142539
Design 3: The design for the form, excluding the pattern, of a packing container stated in the upper right part of page 147 in a domestic magazine received by the National Center for Industrial Property Information, specifically the September 21, 2000 issue (No. 19) of *DIME* (JPO Publicly Known Design No. HA12010944)

The court judged that trial decision (2) should be cancelled by reasoning as follows. It also ruled that trial decision (1) should be cancelled.

"To compare the Whole Design with Design 3, they are identical in that they are both for a packaging container equipped with an applicator at the mouth of the cylindrical container; comprising the top near-half part of the cylinder shaped in a near right-angle triangle when seen from the lateral aspect with the front face inclined at an approximate angle of 60 degrees and with its cross-section gradually shrinking as it nears the top end, a short cylindrical mouth with a slightly smaller diameter than the diameter of the main body of the container formed at an approximate inclination angle of 60 degrees on the end of the cylinder, and a cap in the form of an open-ended disk with its top face mildly curved and with slip-proof projections provided on the lateral edge placed over the mouth. However, these two designs differ significantly from each other in three points. First, the Whole Design envisions that the main body of the container has a cylindrical form with an ellipse-shaped cross-section with a narrower front side and a wider back side. In Design 3, the main body is presumed to have a cylindrical form but its precise cross-sectional form is unknown. Second, according to the Whole Design, the cap has an open-ended disk form. Slip-proof projections are provided only on the bottom half of the entire lateral edge. The ratio of the diameter of the part of the main body that extends to the mouth and the

diameter of the cap is approximately 1 to 1.7. The ratio of the height (from the top to bottom) of the cap to its width (or diameter) is about 1 to 2. In other words, the cap looks horizontally long. According to Design 3, the cap is shaped like a disk and slip-proof projections are provided on almost the entire lateral edge. The ratio of the diameter of the part of the main body that extends to the mouth and the diameter of the cap is approximately 1 to 1. The gap between the main body of the container and the cap is hardly observed. The ratio of the height (from the top to bottom) of the cap to its width (or diameter) is about 1 to 1.2. It looks as if it were vertically long. And third, there lies a difference in relationship between the cap and the main body of the container when viewed from the lateral side. In Whole Design, the end of the cap is behind the extension of the front face of the main body of the container. In Design 3, the end of the cap is projected forward from the linear extension drawn to link the front faces of the main body of the container. (…) The Whole Design is characterized in that a large applicator surface is secured by enlarging the cap in the radial direction to make the cap diameter 1.7 times larger than that of the mouth or, precisely, than the diameter of the part of the main body that extends to the mouth and to set the vertical-horizontal ratio of the cap at nearly 1 to 2. In addition to this peculiarity, it reflects several improvements in terms of appearance. For example, the vertical length of the cap is minimized. Slip-proof projections are limited to the bottom half of the lateral edge. The top face of the cap is shaped in a gently curved form. And the cap diameter is set at nearly the same as the front-back width of the main body of the container. These features ensure a well-balanced look and cancel out the negative visual effects of widening the cap in the radial direction, which results in excessive visibility of the cap that induces a feeling of intimidation, that produces an odd impression of the container and that disrupts harmony with the container. In this respect as well, the Whole Design has its own characteristics. (…) According to Designs 1 and 2, it is observed that a packaging container equipped with an applicator that was larger in diameter than the mouth on the main body of the container was publicly known prior to design registration application (2) in the field of packaging containers. However, the comparison between the Whole Design and Design 3 confirms disparities in appearance as mentioned (…) above. In addition, the Whole Design has several characteristics discussed (…) above. Given that the Whole Design is a result of creative efforts made from among a wide variety of design options, it is impossible to confirm that it could have easily been created on the basis of Design 3 by applying Designs 1 and 2 for a publicly known packaging container with an applicator that is larger in diameter than the mouth on the main body of the

container.”