Decided on	September 10, 2007	Court	Intellectual Property High Court, Third Division
Case number	2007 (Gyo-Ke) 10119		
- A case, with respect to a trial decision that rejected a design registration application for a design concerning “a craft puncher” on the grounds that it was similar to the design included in a publication distributed prior to the application, which was upheld			

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

This case concerns a trial seeking to cancel the trial action (Fufuku 2006-16366) that maintained the examiner’s decision to reject the application for design registration of “a craft puncher”(Igan 2005-37466).

To contest the trial decision determining that the design as the subject of the application (“the Design”) was similar to the design included in a publication distributed prior to the application (“the Cited Design”), the applicant, X, argued, firstly, that the judgment on similarity between a publicly known design stipulated in Article 3, paragraph (1), item (iii) of the Design Act and the design for which the application is filed should follow recognition of important elements of the publicly known design (i.e the Cited Design) after the comparison with yet older existing publicly known designs; and, secondly, that those forms of the publicly known design that would be normally adopted in relation to the functions of components, specifically the rectangular form of the housing that covers the base of the puncher and the curved upper outline of the housing, should be excluded from the important elements in estimating the similarity to the design in the application.

The court judgment found no fault in the trial decision deeming the Design similar to the Cited Design and dismissed X’s claim. With respect to X’s first argument, it pronounced as follows: “It is not reasonable to compare the publicly known design with older existing publicly known designs and to recognize important elements for the purpose of determining similarity between publicly known designs and the design that is the subject of the application in connection with the applicability of Article 3, paragraph (1), item (iii) of the Design Act. The judgment on similarity should be based simply on commonalities and differences between them.” In response to X’s second argument, above, it reads: “In the field of goods concerned with the design that is the subject of the application and the publicly known designs, forms indispensable to the functions of the goods in question should indeed be excluded from the subjects of consideration for judgment on similarity. Such forms include, for instance, the configuration according to which the puncher for making punching

holes has a punching blade, a hole through which the blade is inserted and a slit in which a sheet-shaped material is placed. However, it is known that there exist various forms of punchers for making punching holes. (…) It cannot be said that the rectangular form of the unit or the curved corner-less upper outline are essential to ensure the functions of punching apparatuses. It is hence impossible to find erroneous the trial decision that confirmed that the Design and the Cited Design were similar due to similarity in form, including these points."

In a trial involving the infringement of design rights, the registered design is compared with publicly known designs prior to its application to recognize important elements, and a judgment on similarities between the registered design and the product suspected of infringement, the so-called Object I, is made after assessing if the product suspected of infringement has the important elements. X's first argument above is interpreted as asserting that the same should apply to the judgment on similarity to publicly known designs in the case of an application for design registration. In litigation trial involving infringement, the product suspected of infringement is deemed to have none of the creative traits of the registered design and is confirmed not to infringe the registered design if the similarities between them are all found in any specific design made public prior to the registered design in question. However, in the examination of an application for design registration, the publicly known design is no different from older existing publicly known designs since it is already in the public domain prior to the application for registration. Judgments on similarity should be made after comparing the design that is the subject of the application with the entirety of any publicly known design. It is evident that X's argument is unfounded but it provides useful information for those engaged in the business of design registration. So does the judgment pronounced in answer to X's second argument, above.