

Date	September 21, 2016	Court	Intellectual Property High Court, Second Division
Case number	2016 (Gyo-Ke) 10034		
<p>– A case in which the court rescinded a JPO decision that dismissed a request for a trial against an examiner's decision of refusal of an application for design registration for a design for which the article to the design is "frozen dessert with container," by ruling that the JPO decision contains an error in its determination concerning the fulfillment of the one application per design requirement (Article 7 of the Design Act).</p>			

References: Article 7 of the Design Act

Numbers of related rights, etc.: Trial against Examiner's Decision of Refusal No. 2014-16810, Design Application No. 2013-5010

Summary of the Judgment

1. The plaintiff filed an application for design registration in relation to a design for which the article to the design is "frozen dessert," but received an examiner's decision of refusal. Therefore, the plaintiff first amended the article to the design to "frozen dessert with container" and then filed a request for a trial against the examiner's decision of refusal (Trial against Examiner's Decision of Refusal No. 2014-16810). The JPO rendered a decision that dismissed said request for a trial against the examiner's decision of refusal.

2. The JPO ruled as follows. A design should be examined in terms as a unified creation of a design, as well as being considered from the perspective of the requirements for being recognized as one design as alleged by the demandant (plaintiff), that is, [i] the article to the design is always handled as one unified subject in the working thereof and [ii] the design always keeps specific identity in the working thereof. Specifically, it is necessary that in creation of a design, the content of creation of each subject part that leads to the entire creation is considered and coordinated so that it is necessarily related to each other part and is also comprehensively designed and formed as a whole and that the content of each creation made for each subject part can be evaluated while being understood as one unity. On that basis, the JPO ruled as follows: Considering the design in the application from the perspective of the attribution of the subject of the creation and unity as the content of the creation, the content of the creation of the configuration of the article that is eaten, i.e. "frozen dessert," and special considerations, etc. in terms of the configuration of the article that is a tool for convenience purposes, such as protection and storage of the content during distribution and sale, i.e. "container," should be understood respectively; even in the case of seeing the design as a unity of creation of design from the perspective of unity

as a configuration, the design is nothing more than an expression of the state where "frozen dessert" is contained in an approximate inverted cone trapezoidal "container"; therefore, the design cannot be considered as one unified creation; consequently, the design cannot be considered as an expression of one design but is one that expresses the configurations of two different articles, "frozen dessert" and "container," that is, two designs.

3. In this judgment, the court recognized the design in the application as one design by showing the reasons as outlined below and rescinded the JPO decision.

(1) Article 7 of the Design Act provides that an application for design registration shall be filed for "each article" and for "each configuration." "Each article" means being one article that has one specific usage and function, and "each configuration" means that the configuration depicted in an application for design registration is a single configuration that is unified on the whole.

Whether an article can be considered as one article that has one specific usage and function and whether the configuration depicted in the drawing attached to the application can be considered as a single configuration that is unified on the whole should be determined in light of common sense in reference to the statements in the "Article to the design" column and the "Explanation of the article to the design" column in the application and in consideration of [i] the content, manufacturing process, and forms of distribution and use of the article stated in the application for design registration, [ii] whether or not part of the article stated in the application for design registration can be separated from other parts while maintaining the appearance of the article, and [iii] whether or not said part independently becomes subject to transaction under normal conditions, if the article stated in the application for design registration does not fall under the classification of articles listed in Appended Table 1 of the Ordinance for Enforcement of the Design Act.

(2) The article to the design in the design in the application, "frozen dessert with container," does not fall under the aforementioned classification of articles listed in Appended Table 1. According to the name of the article, it is considered that "frozen dessert" is the main part while "container" is incidental.

Referring to the statement of the "explanation of the article to the design" for the application for design registration, "frozen dessert" pertaining to the design in the application is recognized as being manufactured by filling a frozen dessert material in a container, arranging a bean paste material and a rice cake material on the frozen dessert material in order, and solidifying these materials by cooling. The "frozen dessert" is recognized as being in a unified state, in which it is filled in the "container"

and solidified by cooling, in each of the stages of manufacturing, distribution, and use. In addition, based on the manufacturing process, it is not easy to separate the "frozen dessert" pertaining to the design in the application from the "container" while keeping its configuration, and it cannot be said that the "frozen dessert" becomes subject to transaction independently from the "container" under normal conditions.

Comprehensively considering these points, "frozen dessert with container," which is the article to the design in the application, is recognized as one article that has one specific usage and function in light of common sense.

(3) The drawing attached to the application for the design in the application does not formally depict two or more configurations. The drawing is in essence a drawing of the state where the frozen dessert is contained in the container, and the frozen dessert and the container are in contact with each other with no space and are in the state of being unified. Therefore, the drawing cannot be considered as depicting two or more configurations. Consequently, the configuration pertaining to the design in the application is recognized as being one.

(4) Therefore, the application fulfills the requirement referred to in Article 7 of the Design Act.