

Judgments of Intellectual Property High Court, Second Division

Date of the Judgment: 2005.9.15

Case Number: 2005 (Gyo-Ke) No.10134

Title (Case):

A case wherein the court upheld the JPO decision to invalidate the registration of the design for a postbox on the grounds of its similarity to a design described in a publication

References: Article 3(1)(ii) and (iii) of the Design Act

Summary of the Judgment:

In this case, the plaintiff who holds the registered design applied to the “postbox” seeks reversal of the decision of the Japan Patent Office (JPO) to invalidate the plaintiff’s design registration that was made in the invalidation proceedings initiated by the defendant (Japan Post).

As grounds for the invalidation, the JPO held as follows: the “Handouts for the Regular Press Conference by the Director-General of the Postal Bureau” dated July 8, 1996, which were distributed by the Ministry of Posts and Telecommunications (MPT) (hereinafter referred to as the “Handouts”), fall under the category of publications distributed prior to the filing of the design application, and the registered design is similar to the design of a “quasi-medium-sized postbox” (Design A) published in one of the Handouts, “Handout 2: Concerning the Establishment of New-Type Postboxes”. The registered design therefore falls under the category of unregistrable designs prescribed in Article 3(1)(iii) of the Design Act.

The court affirmed that the Handouts fell under the category of “publications distributed,” holding as follows.

“(i) The Handouts were distributed, on July 8, 1996, at the regular press conference held by the Director-General of the Postal Bureau, to news agencies belonging to the press clubs, i.e. the Postal Press Club, Iikura Club, and MPT Telecom Club, in order for the MPT to publicize, via the media, the installation of new-type postboxes nationwide from FY1996, the shape and other features of the appearance of the new-type postboxes, and improvements offered by the new-type postboxes compared with the conventional ones. (ii) The number of copies of the Handouts distributed at the regular press conference was 76 in total: 50 copies to the Postal Press Club and 13 copies to both the Iikura Club and MPT Telecom Club. (iii) The contents of the Handouts were intended to be disclosed to the public, and the MPT was able to distribute the Handouts to reporters other than those belonging to the above-mentioned

clubs at the time of their request for interviews or to the general public upon inquiry by phone. (iv) In reality, in the newspapers dated July 9, 1996, the day following the distribution date, the summary of the Handouts was reported with photos of the new-type postboxes. Additionally, in the MPT publicity magazine ‘POST21’ issued in August 1996 (Publisher: Yuseikoseikai), external views of the new-type postboxes completely identical to those in the Handouts were published.

Consequently, since the Handouts were created as documents to be distributed and disclosed to an unspecified number of people and they had in reality been distributed to the public, it is appropriate to regard the Handouts as falling under the category of ‘distributed publications’ prescribed in Article 3(1)(ii) of the Design Act.”

Based on such conclusions, the court found that the JPO decision that determined the registered design to be similar to Design A contained no particularly unreasonable aspects, and therefore dismissed the plaintiff’s claim.

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