

Judgments of Intellectual Property High Court, Second Division

Date of the Judgment: 2006.3.31

Case Number: 2005 (Gyo-Ke) No.10679

Title (Case):

A Case in which the court discussed in what case a minute design that is invisible to the naked eye may be recognized as something that “aesthetically appeals to a person’s sense of sight” and therefore may be regarded as registrable under the Design Act

Reference: Article 2, para.1 and Article 3, para.1 of the Design Act

Outline of the Case:

The plaintiff filed a design application for a design pertaining to a “connector terminal” (hereinafter referred to as the “Design”), but received a JPO examiner’s decision of refusal, and further received the JPO’s trial decision to dismiss a request for a trial against said examiner’s decision of refusal. The reasons for the dismissal were as follows: (1) in order for a design to be registrable, the shape of the entire design needs to be visible to the naked eye; and (2) because the Design is so minute that the specific details of its shape are invisible to the naked eye with the actual width of its bottom part being 0.15 mm, it cannot be recognized that it “aesthetically appeals to a person’s sense of sight,” and therefore it is not a registrable design.

This case is a lawsuit in which the plaintiff sought rescission of the above-mentioned trial decision.

It should be noted that the JPO’s Design Examination Guidelines provide that “because a registrable design should aesthetically appeal to a person’s sense of sight, a design that does not appeal to the eye is not recognized as a registrable design,”

“a design that appeals to a person’s sense of sight is a design where the shape of the entire design for which a design application has been filed is visible to the naked eye” and “if a single unit of the matter [note: powder matter or granular matter] is so minute that its shape is invisible to the naked eye, it is not recognized as a design that appeals to a person’s sense of sight.”

Summary of the Judgment:

First, regarding whether or not a registrable design (the principal sentence of Article 3, para.1 and Article 2, para.1 of the Design Act) is limited to a design that is visible to the naked eye, the court pointed out as follows: “When trading the article to which a design has been incorporated or to which it has been applied, if it is a normal practice to observe the shape of the article with the naked eye, a shape that is invisible to the naked eye should not be registrable because it does not ‘aesthetically appeal to

a person's sense of sight.' However, when trading the article to which a design has been incorporated or to which it has been applied, if it is a normal practice to observe the shape of the article by magnifying the shape by way of observing the actual article or a sample through a magnifying glass or publishing an enlarged photograph or an enlarged drawing in a catalog or a specification sheet, it is reasonable to construe that the shape of the article 'aesthetically appeals to a person's sense of sight.'

Then, after finding facts concerning the status of trade of the article to which the Design has been incorporated, the court ruled as follows regarding the registrability of the Design: "According to these, when trading the 'connector terminal,' which is the article to which the Design is to be incorporated, the shape of the article is not being observed by magnifying the shape, so it should be construed that the shape of the article is not a design protectable under the Design Act unless it is found to be visible to the naked eye" ; "With regard to the size of the Design, the actual width of the bottom part shown in the right side view is 0.15 mm. When the size of the entire article is derived based on the size of this part, the width would be approximately 1.21 mm and the length would be approximately 1.35 mm in the front view and the maximum width would be approximately 0.28 mm in the right side view" ; "According to this, the points claimed by the plaintiff as being the distinctive features of the shape of the Design such as 'the upper part being bent in an R-shape like a snake neck' and 'the lower part being bent with stepwise bents' would only be in sizes of a 0.1 mm level, and it would be impossible to see the specific details of the Design to the naked eye." Based on these findings, the court upheld the JPO's trial decision, which had denied the registrability of the Design, and dismissed the plaintiff's claim.

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