

**Judgments of Intellectual Property High Court, Fourth Division**

**Date of the Judgment: 2006.9.20**

**Case Number: 2006(Gyo-Ke)No.10088**

**Title (Case):**

A case wherein the court revoked the JPO's trial decision that dismissed a request for a trial against the examiner's decision of refusal filed with regard to an application for design registration of the "metal blind louver" on the ground that prior to the filing of the application, a person ordinarily skilled in the art of the design would have been able to easily create the design based on a shape publicly known in Japan

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

**Summary of the Judgment:**

In the trial, the Patent Office (JPO) made, by citing a drawing of the design of a "decorative holder for a coping of a structure" (the cited publication), a trial decision to dismiss the request for trial under Article 3, para.2 of the Design Act on the ground that the basic configuration of the claimed design had been publicly known prior to the filing of the application as shown in the cited document.

In this lawsuit, where the plaintiff sought rescission of the above-mentioned trial decision, the defendant (the Patent Office) argued that the purpose of citing the cited publication was to show that the shape of a part of the cited design that was observed from the external wall surface to the locking part attached to the position where the locking area started (the design consisting of a certain shape of cross-section extended in the longitudinal direction, a locking area established on the back side, and the external wall surface convexing outward to the front side in the cross-section shape of a semicircle) was publicly known prior to the filing of the plaintiff's application for design registration of the claimed design. In addition, the defendant mentioned the design of traditional "bamboo blind fences" and pointed out that the basic shape of the half-split bamboo used to create a nailless bamboo-stick board composing a part of the fence was exactly the same as the shape of the external wall surface of the claimed design. Based on this observation, the defendant argued that the claimed design simply imitates the well-known Japanese traditional shape by adopting the basic shape of half-split bamboo as the shape of its external wall surface.

This court, however, revoked the trial decision by rejecting the defendant's argument as follows:

"Although Article 3, para.2 of the Design Act focuses on the novelty and originality in the conception of the design in light of socially-known motifs without taking into consideration whether the articles concerned are identical or similar,

this provision use as a registration requirement, not the perspective of general consumers, but the level of difficulty that a person skilled in the art would experience to create the design. Therefore, the judgment as to whether the creation of a design is easy or difficult should be made in light of the art to which the design pertains.

The claimed design has been created for an article, ‘metal blind louver.’ It cannot be said that a person skilled in the art could easily create the claimed design based on a publicly-known shape unless the publicly-known shape may easily be adopted as the shape of the louver of the metal blind.

… Blind louvers are designed to protect against sunlight and rain. Those louvers are aligned across each aperture in order to protect against sunlight and rain by adjusting the angle of the louvers with respect to the aperture. Needless to say, such functions and structure must be taken into consideration when a design of blind louvers is created. Inevitably, those required functions and structure would impose certain restrictions on the creation of louvers.

Based on the above, we examined the level of difficulty that a person skilled in the art would experience to create the claimed design as follows:

(a) … The cited design is registered for an article ‘decorative holder for a coping of a structure,’ and the article is described as that “after being cut to a certain length, the article is attached to the outdoor side of the coping that has been installed on the roof of a building in advance. The decorative coping is attached to the article.’

In this way, the article for which the cited design has been registered is used as a holder to attach the decorative coping to the existing coping. Therefore, the article is completely different from the “metal blind louver” of the claimed design in terms of function and structure. For this reason, it would not be easy for a person skilled in the art who has seen the cited design to create the claimed design based on the above-mentioned ‘publicly-known shape.’

(b) Next …a bamboo blind fence, which is a type of bamboo fence, has a common feature with the blind in that both have the function of blindfold. However, the two are different in that a blind has a basic function and structure of protecting against sunlight and rain by adjusting the angle of louvers whereas a bamboo blind fence has no such function and structure. The semicircular cross-section of the bamboo used to create a bamboo-stick board for the fence is a natural result of using half-split natural bamboo. In the case of creating a metal blind louver, however, there is no reason for adopting the semicircular shape as in the case where natural bamboo is used.

Based on these grounds, it cannot be concluded that it would be easy for a person skilled in the art to apply the semicircular shape of the half-split bamboo used in a board for a bamboo blind fence to the ‘metal blind louver.’ Therefore, the above-mentioned argument of the defendant is unacceptable.

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