

Judgments of Intellectual Property High Court, First Division

Date of the Judgment: 2006.8.24

Case Number: 2006(Gyo-Ke)No.10136

Title (Case):

A case wherein the court upheld a trial decision of the Japan Patent Office (JPO) that denied retroactive effect asserted based on the filing date of the original application, holding that the term “design” as used in “two or more designs” prescribed in Article 10-2 of the Design Act means a “design for which registration is requested,” and that division of application from the original application cannot be allowed under this provision where the design for which registration is requested in the divisional application is a design represented in the reference drawing of the original application

Reference: Article 10-2, para.1 of the Design Act

Summary of the Judgment:

In this case, the plaintiff filed an application for design registration in which registration of a design for “piano pedal extender platform” was requested. The drawings attached to said application, which disclosed the design of the piano extender platform, contained a reference drawing disclosing the design of the piano extender platform in a state of using an attachment. Then, the plaintiff filed a divisional application under Article 10-2, para.1 of the Design Act for the design depicting the appearance of the piano pedal extender platform with an attachment part affixed. However, a JPO trial decision denied retroactive effect asserted based on the filing date of the original application and upheld an examiner’s decision refusing the application under Article 3, para.1, item 3, ruling that the latter application could not be considered as being extracted “out of a single application for design registration containing two or more designs” as prescribed in Article 10-2(1) of the Design Act, so division of an application from the original application under this provision was not allowed. In response, the plaintiff sought rescission of the JPO trial decision by filing this case, claiming that the term “design” as used in “two or more designs” prescribed in Article 10-2 of the Design Act is not limited to a “design for which registration is requested” but should be interpreted as any “design expressed in the application for design registration.”

The court first stated that “the question of whether or not the term ‘design’ as used in ‘two or more designs’ prescribed in the provision (of Article 10-2(1) of the Design Act) is limited to a ‘design for which registration is requested’ is effectively the point of issue in this case.” Then, the court cited the provisions of Article 6(1), (2), (3) and (4), Article 20(3) and Article 24 of the Design Act and Article 3 of the

Ordinance for Enforcement of the same Act, and held as follows:

“According to the provisions above, the basis for deciding the scope of a ‘design for which registration is requested’ is the design stated in the application and depicted in the drawing or represented in the photograph, model or specimen attached to the application, in other words, the design disclosed in the statement of the ‘article to the design’ and depicted in the drawing attached to the application or the design represented in the ‘photograph, model or specimen representing the design for which the registration is requested, in lieu of the drawing,’ and when the above statements alone are considered to be insufficient for expressing the design, necessary drawings such as the developed view, sectional view, end view of a cut section, and perspective view may be added, and when it is further necessary for helping the understanding of the design, reference drawings such as a drawing showing the status of use may be added. The question of whether or not an application is a ‘single application for design registration containing two or more designs’ prescribed in Article 10-2, para.1 of the Design Act should be decided based on the design stated in the application and depicted in the drawing or represented in the photograph, model or specimen attached to the application, similar to the case of Article 24 of the same Act, and if necessary, reference would also be made to necessary drawings such as the developed view, sectional view, end view of a cut section, and perspective view, and reference drawings such as a drawing showing the status of use. Therefore, even if a design other than the ‘design for which registration is requested’ were disclosed in the necessary drawings such as the developed view, sectional view, end view of a cut section, and perspective view, or the reference drawings such as a drawing showing the status of use, it would not be subject to examination for deciding whether or not an application is a ‘single application for design registration containing two or more designs.’ ” Based on this understanding, the court held that “while the disputed application seeks design registration for a design pertaining to a piano extender platform including the attachment part as attached, which is indicated in the reference drawing of the original application, by specifying the ‘piano extender platform’ as the article for which registration of the design is requested, the design for which registration is requested in the disputed application is not the design for which registration was requested in the original application, so the disputed application cannot be regarded as a divisional application that satisfies the requirements under Article 10-2, para.1 of the Design Act,” and upheld the JPO trial decision that had denied retroactive effect asserted based on the filing date of the original application and had held that the application for registration should be refused pursuant to Article 3, para.1, item 3 of the Design Act.

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