

Date	July 7, 2010	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Gyo-Ke) 10079		
A case in which the court ruled that, in the process of making a determination on similarity between designs as set forth in Article 3, paragraph (1), item (iii) of the Design Act, it is inappropriate to consider that the filed design could be defined by taking into consideration matters other than those depicted in the drawing attached to the application or represented in the photograph, model or specimen attached to the application, or matters recognized from those depicted or represented as above			

References:

Article 3, paragraph (1), item (iii), Article 6, paragraphs (1), (2), and (4), and Article 24 of the Design Act, Article 3 of the Ordinance for Enforcement of the Design Act

The plaintiff filed an application for registration of a partial design indicated in Attachment 1, and was given a decision by the examiner of the Japan Patent Office (JPO) refusing the application pursuant to Article 3, paragraph (1), item (iii) on the grounds of the similarity to the cited design. The plaintiff then filed a request for a trial against the examiner's decision of refusal, which was dismissed by the JPO. In this suit, the plaintiff seeks rescission of the JPO decision of dismissal.

As the grounds for rescission of the JPO decision, the plaintiff alleges an error in the JPO's finding on the similarity between the plaintiff's design and the cited design, arguing that the shape of the article pertaining to the plaintiff's design changes from the state when not in use, the state immediately before use, and to the state when in use (put onto the user's face), and that when making a judgment, weight should be put on the shape in the state when in use.

The court determined that the plaintiff's design and the cited design were similar to each other, and dismissed the plaintiff's claim, holding as follows.

"In order to refuse a design application by determining that the filed design falls under Article 3, paragraph (1), item (iii) of the Trademark Act because of its similarity with a publicly known design as set forth in items (i) and (ii) of said paragraph, first, the goods pertaining to the respective designs must be identical or similar to each other, and then, the designs themselves must be found to be identical or similar to each other. A design right is effective in relation to the registered design and designs similar thereto, and the similarity between the registered design and another design should be determined based upon the aesthetic impression that the designs would create through the eyes of their consumers (Article 23 and Article 24, paragraph (2) of the Design Act). Accordingly, in the meaning under Article 3, paragraph (1), item (iii) of said Act,

the issue to be addressed is the similarity in terms of the aesthetic impression between the identical or similar designs of articles when seen from the eyes of consumers.”

“If the plaintiff, from an applicant’s standpoint, meant to say that the shape of the article pertaining to the filed design would change from the state when not in use, the state immediately before use, and to the state when in use, the plaintiff should have additionally submitted necessary drawings in due course or prepared drawings that could show the state of the design before and after the change. Yet, while stating in the application that the article would become flat when it is folded, the plaintiff did not state that the state when in use would be different from that shown in the drawing indicated in Attachment 1. The plaintiff neither gave any explanation about the state when in use nor submitted drawings other than the drawing indicated in Attachment 1. Even in accordance with the requirement that the scope of a registered design shall be determined based upon the design stated in the application, depicted in the drawing attached to the application, or represented in the photograph, model or specimen attached to the application (Article 24, paragraph (1) of the Design Act), it is inappropriate to consider that the filed design could be defined by taking into consideration matters other than those depicted in the drawing attached to the application or represented in the photograph, model or specimen attached to the application, or matters recognized from those depicted or represented as above.”