

Design Right	Date	December 19, 2024	Court	Intellectual Property High Court, Third Division
	Case number	2024 (Gyo-Ke) 10034		
<p>- A case in which, with regard to an application for a design registration for a design where the article embodying the design is a "beverage in a container," the court determined that the design in question does not fall under a design for which a design registration can be obtained, and therefore that the applicant cannot obtain a design registration.</p>				

Case type: Rescission of Appeal Decision on Examiner's Decision of Refusal Application

Result: Dismissed

References: Article 2, paragraph (1) and Article 6, paragraph (4) of the Design Act

Related rights, etc.: Application for Design Registration No. 2022-000060

Decision of the JPO: Appeal against Examiner's Decision of Refusal No. 2023-11292

Summary of the Judgment

1. The Plaintiff filed an application for a design registration for which the article embodying the design is a "beverage in a container" (the application is referred to as the "Application"; Attachment "Design in the Application (Application for Design Registration No. 2022-000060)"); however, the Plaintiff received the examiner's decision of refusal and filed an appeal against the examiner's decision of refusal (Appeal against Examiner's Decision of Refusal No. 2023-11292). In response, the Japan Patent Office (hereinafter referred to as the "JPO") made the trial decision to the effect that the request was groundless (hereinafter referred to as the "JPO Decision") and the Plaintiff filed the present action.

2. The summary of the grounds for the JPO Decision is that a design related to the shape, etc. of an article from among designs to be protected by the Design Act must fulfill all the following requirements: it is a shape, etc. that has the definite form of a movable property that is a tangible object being distributed in the market; the shape, etc. can be recognized by a person through their vision; and, as a result, it gives an aesthetic impression to the person. The shape, etc. of the parts stated in the Application when the lid is opened wherein the major components are the dark brown liquid that appears inside the container when the lid of the article embodying the Design in the Application, a "beverage in a container," is opened and the shape of milky bubbles that appear as if they cover the top of said dark brown liquid, etc. sequentially, is not deemed to

constitute a design under the Design Act. Therefore, the Design in the Application is not found to constitute a design as provided for in Article 2, paragraph (1) of the Design Act.

3. The grounds for rescission of the JPO Decision that were argued by the Plaintiff are errors in the determinations as to whether the Design in the Application falls under the category of a design.

4. In this judgment, the court determined as follows and dismissed the Plaintiff's request.

(1) [Article embodying the design] of the Design in the Application is a "beverage in a container." The applicant intends to obtain a design registration for the shape, etc. of a "beverage in a container" before, during, and after the change, including from the shape, etc. of the container when the lid is closed to the shape, etc. of the container, and the shape, etc. of the foaming of the sparkling beverage in the container when the lid is opened, and thus intends to obtain a registration as a so-called design for movable elements.

(2) Apart from a design for a set of articles (Article 8 of the Design Act), in the same way as a regular design, a design for movable elements needs to meet the requirements of general designs that are provided for in Article 2, Article 3, etc., of the Design Act, including the requirements of the one application per design (Article 7 of the Design Act).

According to the provisions of Article 2, paragraph (1) of the Design Act, a design is required to be a shape, etc. of an article. In consideration of the statements in the literature as well, the shape of an article as indicated in the literature is required to maintain a certain shape for a specific period as an attribute of the article, and to have the nature of a shape for which a border, which is information on its recognition as a shape, can be identified. In cases where the shape changes, it is understood to be necessary that the mode of change has specific rules or that changing shapes are constant.

(3) In addition, Article 6, paragraph (4) of the current Design Act that stipulates a design for movable elements (Article 6, paragraph (5) of the Design Act before the amendment by Act No. 51 of 1998) was introduced by the amendment by Act No. 125 of 1959. In the process of the amendment, the example of a "flexible iron wire toy" was cited and whether it should be protected as a design for movable elements was examined and it was determined that "Such an article has no specific form, and is not subject to the design." It was construed that articles in a state where a specific shape cannot be identified since a specific shape makes various irregular changes and the transition of changes in the shape has no reproducibility cannot be identified as the "design" under

the Design Act. On the other hand, concerning a "jack-in-the-box," since the first shape and the shape after the change can be shown concerning the transition from shrunken state to extended state, it was recognized to be different from the aforementioned "flexible toy."

Based on these discussions, what was assumed first was the case of filing an application for a design for "the shape before and after the change" "in cases where the shape of an article embodying the design ... changes"; however, in response to a remark pointing out that such design may be considered to be multiple designs, the aforementioned phrase, "the shape before and after the change," was determined to be modified.

Then, based on the idea that the movement of an article itself is considered to be the article itself and based on the assumption that a design for movable elements is one design, special provisions for exception were not established but it was determined to modify the phrase to "the shape of an article before, during, and after the change." In this way, as the premise, the shape of an article in cases of a design for movable elements is required to fulfill the requirements for shape that is necessary for an article under the Design Act in any state before, during, and after the change.

In consideration of the above, concerning the design for movable elements for which the shape of an article changes from among those specified in Article 6, paragraph (4) of the Design Act, it is construed that the shape of the article must meet the requirements for an article under the Design Act in any state before, during, and after the change, that is, the shape of the article maintains a certain shape for a specific period as an attribute of the article and has the nature of a shape for which a border, which is information on its recognition as a shape, can be identified, and the mode of change has specific rules or changing shapes are constant.

(4) Concerning the Design in the Application that is a design for movable elements and partial design, the design for which the applicant intends to obtain a design registration in the Application is a shape, etc. that changes by opening the lid of the container. When the lid is closed, which is before the change, the design is the shape, etc. of the large-diameter ring-shaped marginal part that is located in the periphery of the lid part on top of the container, and when the lid is opened, which is after the change, the design is the shape, etc. of part of the inside of the container and the dark brown liquid that appear inside the container, as well as the shape, etc. of milky bubbles that appear to cover the top of the liquid sequentially, in addition to the shape, etc. of the large-diameter ring-shaped marginal part. From among the above, changes over time in the foaming state for said 10 seconds based on Plan views after the lid is opened that show changes in

foaming state 1 through 10, which is "the shape of the article before, during, and after the change," are changes approximately for every second per photograph.

(5) In Plan views after the lid is opened that show changes in foaming state 1 through 3 in the Application, the width of bubbles that is in the shape of a belt around the edge of the can is not constant and the shape of the outline is an awkward circle, and in the process, there are parts where the width of the bubble belt increases, while there are parts where the width disappears or decreases. In addition, after the white part at the center disappears and small groups of white bubbles spread irregularly, the diameter of the annular shape becomes narrower by gradation; however, the narrowing degree of the outline diameter is not constant depending on the location. After the shape presents an irregular shape, not a circle, it becomes the two-layer frustum of a circular cone. The aforementioned states of generation and disappearance of bubbles are not deemed to meet the requirements for the aforementioned design or a design for movable elements, that is, maintaining a certain shape for a specific period, having the nature of a shape for which a border can be identified. In addition, it is difficult to find that the mode of change has specific rules or changing shapes are constant.

Even based on the disclosed information of a product where the Design in the Application is worked, the shape of all the bubbles and their changes differ for each can opened. What can only be found are the state where multiple large bubbles can be visually identified around the outer edge of the can, the state where bubbles that are generated in a patchy manner increases, the state where all the bubbles swell into the shape of a dome where part of the ball is cut off, the state where groups of bubbles can scarcely be seen at the outer edge of the liquid surface in the can, etc. It is not found that the same shape, etc. as in the photographs attached to the written application of the Application is reproduced whenever the lid is opened. In light of this point, the aforementioned findings that the states of generation and disappearance of bubbles shown in the Design in the Application lack the nature of a shape and the mode of change has no specific rules, and it is also difficult to find that the changes in the shapes are constant, is reasonable.

Based on the above, the Design in the Application does not fall under a design for which a design registration can be obtained.

Judgment rendered on December 19, 2024

2024 (Gyo-Ke) 10034 Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: October 31, 2024

Judgment

Plaintiff: ASAHI BREWERIES, LTD.

Defendant: Commissioner of the Japan Patent Office

Main text

1. The claim of the Plaintiff shall be dismissed.
2. The Plaintiff shall bear the court costs.

Facts and reasons

No. 1 Claim

1. The decision made by the JPO on February 28, 2024, concerning the case of Appeal against Examiner's Decision of Refusal No. 2023-11292 shall be rescinded.
2. The Defendant shall bear the court costs.

No. 2 Outline of the case

1. History of the procedures at the JPO

(1) The Plaintiff filed an application for a design registration for an article embodying a design as a "beverage in a container" on January 5, 2022, (Application for Design Registration No. 2022-000060; Exhibit Ko 17; hereinafter the application is referred to as the "Application" and an article for which an applicant intends to obtain a design registration related to the application is referred to as the "Design in the Application" regardless of whether it falls under the design provided for by the Design Act.).

(2) The Plaintiff received a notice of grounds for refusal (Exhibit Ko 18) dated September 29, 2022. The notice of grounds for refusal has the following statement: "This application for a design registration specifies the article embodying the design to be a 'beverage in a container' and intends to obtain a design registration for parts of the article. However, based on the application and attached drawings, the parts for which a design registration is sought seem to be inside the container, including the opening edges, and the content that is a 'sparkling beverage' as stated in the field for explanation of design. However, said 'beverage in a container' is a liquid and it stays inside the container only when it is packaged in the package can, but it does not have its own unique shape, etc. Therefore, it is not found to constitute a design as provided for by Article 2, paragraph (1) of the Design Act."

The Plaintiff submitted a written opinion (Exhibit Ko 19) dated October 28, 2022; however, the Plaintiff received an examiner's decision of refusal dated April 13, 2023, (Exhibit Ko 20; hereinafter referred to as the "Examiner's Decision of Refusal"). Therefore, the Plaintiff filed an appeal against the examiner's decision of refusal (Appeal against the Examiner's Decision of Refusal No. 2023-11292; Exhibit Ko 21) on July 5, 2022.

(3) The JPO made the decision to the effect that "the request for the appeal in question is groundless" (hereinafter referred to as the "JPO Decision") on February 28, 2024, and the certified copy was served upon the Plaintiff on March 15, 2024.

(4) On April 12, 2024, the Plaintiff filed the present action to seek rescission of the JPO Decision.

2. Summary of the grounds for the JPO Decision

The grounds for the JPO Decision are as stated in the attached written trial decision (copy). "In short, a design related to the shape, etc. of an article from among designs to be protected by the Design Act must fulfill all the following requirements: it is a shape, etc. that has the definite form of a movable property, which is a tangible object being distributed in the market; the shape, etc. can be recognized by a person through their vision; and as a result, it gives an aesthetic impression to the person. The shapes, etc. of the parts stated in the Application when opening the lid of an article related to the Design in the Application (as stated in the attachment to the attached written trial decision (copy), "Design in the Application (Application No. for Design Registration: 2022-000060)", "beverage in a container," wherein major components are the dark brown liquid that appears inside the container when the lid is opened, the shape of milky bubbles that appear as if they cover the top of said dark brown liquid, etc., are not deemed to constitute a design under the Design Act. Therefore, the design for which an applicant intends to obtain a design registration through the Application (Design in the Application) is not found to constitute the design provided for in Article 2, paragraph (1) of the Design Act.

3. Grounds for rescission argued by the Plaintiff

Error concerning the determination on whether the Design in the Application falls under the category of a design

No. 4 Decision of this court

1. Design in the Application

(1) The statements in the written application of the Application (Exhibit Ko 17) and the photographs attached to the application are as stated in the Attachment to the attached

written trial decision (copy), "Design in the Application (Application No. for Design Registration: 2022-000060)."

(2) [Article embodying a design] of the Design in the Application is a "beverage in a container." Based on the provisions of Article 6, paragraph (1), item (iii) of the Design Act, Article 2, paragraph (1) and Form No. 2, Remarks 8 and 39 of the Regulation for Enforcement of the Design Act ("If the statements in the field for '[Articles embodying a design]' alone cannot define the intended use, use state, etc. of the article, building, or graphic image, an explanation shall be stated in the field for '[Explanation of articles embodying a design]' so that it helps people understand the article, building, or graphic image, such as their intended use, use state, etc."), an object in combination of a container and a sparkling beverage in the container is called a "beverage in a container" and the "beverage" is the main part and the "container" is the incidental part.

In addition, based on the provisions of Article 2, paragraph (1) and Article 6, paragraph (1) of the Design Act, Article 3 and Form No. 6, Remarks 12 of the Regulation for Enforcement of the Design Act ("In cases where an applicant intends to obtain a design registration for part of an article, building, or graphic image and where both the part for which the applicant intends to obtain a design registration and other parts are included in the figures specified in Remarks 8 through 11, the part for which the applicant intends to obtain a design registration shall be specified by such means as drawing the relevant part in a solid line and other parts in a dashed line. If it is impossible to specify the part for which the applicant intends to obtain a design registration only by the statements in the drawing, the method for specifying the part in question shall be stated in the field for '[Explanation of design]'. The same shall apply to cases where an applicant intends to obtain a design registration for part of the design of a set of articles prescribed in Article 8 of the Design Act or part of the interior design prescribed in Article 8-2 of said Act"), the applicant intends to obtain a design registration for the shapes, etc. of the parts other than the parts colored in pink of the "beverage in a container."

In addition, based on the provisions of Article 6, paragraph (4) of the Design Act, Article 2, paragraph (1) and Form No. 2, Remarks 42 of the Regulation for Enforcement of the Design Act ("In cases prescribed in Article 6, paragraph (3), paragraph (4), and paragraph (7) of the Design Act, matters to be stated pursuant to the respective provisions shall be stated in the field for '[Explanation of design], ' respectively."), and provisions of Article 6, paragraph (1) of the Design Act and Article 3 and Form No. 6, Remarks 22 of the Regulation for Enforcement of the Design Act ("In cases of a design of movable object, opening object, etc. and for which the design cannot be fully

expressed without drawings that depict the statuses before and after the design change, such as its movement, opening, etc., drawings shall be added so that statuses before and after the design change, such as its movement, opening, etc., can be understood."), the applicant intends to obtain a design registration for the shape, etc. of a "beverage in a container" before, during, and after the change, including from the shape, etc. of the container when the lid is closed to the shape, etc. of the container, and the shape, etc. of the foaming of the sparkling beverage in the container when the lid is opened, and thus intends to obtain a registration as a so-called design for movable elements.

In addition, the shape, etc. after the aforementioned change (the shape, etc. of the container and the shape, etc. of foaming of the sparkling beverage in the container when the lid is opened) expresses the configuration when a removable lid is removed from the main body of the container based on Article 3 and Form No. 6, Remarks 19 of the Regulation for Enforcement of the Design Act ("For an article which can be separated, such as into a lid and a main body, a saucer and a bowl, etc., and for which the design cannot be fully expressed if they are combined, drawings described in Remarks 8 through 10 and the figure described in Remarks 15 shall be added for each component of the article, in addition to the figures of the article where the components are combined.").

These determinations in the JPO Decision (page 6, line 19 through line 37 of the JPO Decision) are acknowledged by the Plaintiff (page 2, line 8 of the Plaintiff's brief 1), and there are no disputes between the parties.

As stated above, the Application is filed for a design for movable elements and for a partial design.

2. Interpretation of Article 6, paragraph (4) of the Design Act that provides for a design for movable elements

(1) Article 6, paragraph (4) of the Design Act that provides for a design for movable elements stipulates that "If the shape, pattern, or color of the article embodying a design, the shape, pattern, or color of the building embodying a design, or the graphic image embodying a design changes due to the way the article, building, or graphic image functions, and the applicant seeks to have a design registration made for the shapes and equivalent features of the article, the shapes and equivalent features of the building, or the graphic image as it appears before, during, and after that change, the applicant must indicate this and give an explanation of that function of the article, building, or graphic image in the application."

On the other hand, it is stipulated clearly that, in cases where the design of an article that is configured with two or more articles, etc. can obtain a design registration by

filing an application for them as one design, for such design for a set of articles (Article 8 of the Design Act), an application may be filed as one design for a set of articles as a whole to obtain a design registration. The provision with the same purport as above is also provided for the interior design (Article 8-2 of the Design Act). They are stipulated separately as exceptions to the principle of one application per design (Article 7 of the Design Act). Apart from these, there is no specific provisions for a design for movable elements. Therefore, in the same way as a regular design, a design for movable elements needs to meet the requirements for general designs that are provided for in Article 2, Article 3, etc., of the Design Act, including the requirements of the aforementioned one application per design (Article 7 of the Design Act).

Article 2, paragraph (1) of the Design Act stipulates as follows and a design must be a "shape," etc. "of an article": "The term 'design' in this Act means the shape, patterns or colors, or any combination thereof (hereinafter referred to as the 'shape or equivalent features'), of an article (including a part of an article; the same applies hereinafter); the shape or equivalent features of a building (including a part of a building; the same applies hereinafter); or a graphic image (limited to one used in the operation of a device or displayed as a result of the device performing its function, and including a part of the graphic image; hereinafter the same applies excluding paragraph (2) of the following Article, Article 37, paragraph (2), Article 38, items (vii) and (viii), Article 44-3, paragraph (2), item (vi) and Article 55, paragraph (2), item (vi)), which is aesthetically pleasing in its visual presentation."

In addition to the above, in cases of a design for movable elements, it is stipulated that "If the shape, ... of an article embodying a design, ... changes due to the way the article, ... functions, and the applicant seeks to have a design registration made for the shapes ... of the article ... as it appears before, during, and after that change" (Article 6, paragraph (4) of the Design Act). Therefore, this point must also be fulfilled. When entering information in the application, in addition to the requirements set forth in Article 2, paragraph (1) and Form No. 2, Remarks 42, etc. of the Regulation for Enforcement of the Design Act as mentioned in 1. (2) above, the requirements related to Article 3 and Form No. 6, Remarks 22 of the Regulation for Enforcement of the Design Act ("In cases of a design of movable object, opening object, etc. and for which the design cannot be fully expressed without drawings that depict the statuses before and after the design change, such as its movement, opening, etc., drawings shall be added so that statuses before and after the design change, such as its movement, opening, etc., can be understood."), also affect.

(2) As stated above, a design for movable elements is also required to fulfill the

requirements for general design. Concerning the requirements of the aforementioned "shape of an article" (Article 2, paragraph (1)) that is required for a design, there are the following statements in the literature.

A. "An 'article' that is a prerequisite for the establishment of a design refers to, first, a substance that is a tangible existence. In terms of physical characteristics, it refers to a tangible object that exists by setting a unique border composed of lines and surfaces on a space. ... In addition, an article that has no certain shape, such as a liquid, etc., is considered to lack the requirements regarding the nature as an article. However, in cases of showing a definite shape along with other components, its nature as an article is not always denied." (SAITO Ryoji, "Ishoho Gaisetsu (Overview of the Design Act) [revised version]," page 56 through page 57; 2nd issue of the revised version issued on September 20, 1996; Yuhikaku; Exhibit Ko 2)

B. "An article is required to have the nature of a shape that has a definite form with a specific shape for a specific period. Therefore, it is understood that fluids, semi-fluids, liquids, gases, granulated substances, powder substances, etc. do not have the nature of a shape, and therefore, they are not considered to be articles. However, 'a design for movable elements' that changes under certain rules based on the article's functions, such as a jack-in-the-box, umbrella, etc., is protected (Article 6, paragraph (4))." (TATSUMI Naohiko, "Taikeikasuru Chitekizaisanho (Jo) (Systematizing Intellectual Property Law (Vol. 1)," page 291; 1st issue of the first printing issued on December 3, 2013; Seirinshoin; Exhibit Ko 23)

C. As a statement in the section on "Nature of a shape," there is the following statement: "The shape of an article is often considered to be static and fixed. However, the shape of an article is not limited thereto. For example, there is the shape of an article that changes due to the characteristics of the material constituting the article or the shape of an article that changes based on the functions of the article. In these cases, if the mode of change has regularity or changing shapes are constant, the form or state of an article is usually identified by including said change. Therefore, the 'shape of an article' for such article is identified as including the relevant mode. However, an article which has a certain quantitative existence but whose borders on a line or surface, which is information on its recognition as a shape, cannot be identified as a definite shape, such as an article where powder substances or granulated substances are gathered, etc., deviates from the concept of shape under this law." (MITSUDA Shigeaki, MATSUO Kazuko, ed., "Chukai Ishoho (Commentary of the Design Act)," page 114; 1st issue of the first printing issued on October 22, 2010; Seirinshoin; Exhibit Ko 24)

D. As a statement in the section on "Shape of the article itself," there is the following

statement: "The shape subject to the Design Act is the 'shape of an article.' Therefore, it is required to be the shape of the article itself. In other words, it is the shape that is inherent as an attribute of the article; however, the shape that is generated by the article secondarily does not belong to the 'shape of an article' as used in the Design Act." (Same as C. above, MITSUDA Shigeaki, MATSUO Kazuko, ed., "Chukai Ishoho (Commentary of the Design Act)," page 114; 1st issue of the first printing issued on October 22, 2010; Seirinshoin; Exhibit Ko 24)

E. "The 'shape of an article' is understood to be the spatial outline of an article that is divided by itself, regardless of being three-dimensional or flat. ... The shape, pattern, color, etc. of an article must have consistency. However, a design for movable elements that is designed to change them (e.g., the design of a jack-in-the-box) changes in a regular manner based on the article's functions and does not lack said consistency. Therefore, a design for movable elements is considered to be a design." (MONYA Nobuo, "Ishoho 25 Ko (25 Lectures on the Design Act), pages 25 through page 27; 1st issue of the first printing issued on June 25, 1980; Yuhikaku; Exhibit Ko 25)

(3) In consideration of the statements in the literature in (2) above together, concerning a design that is the shape of an article, the shape of an article is required to maintain a certain shape for a specific period as an attribute of the article, and to have the nature of a shape for which a border, which is information on its recognition as a shape, can be identified. In cases where the shape changes, it is understood to be necessary that the mode of change has specific rules or that changing shapes are constant.

(4) In addition, Article 6, paragraph (4) of the current Design Act (Article 6, paragraph (5) of the Design Act before the amendment by Act No. 51 of 1998) that stipulates a design for movable elements was introduced by the amendment by Act No. 125 of 1959 and its legislative process is found to be as stated below.

A. Overview of the amendment of the Design Act in 1959 is as stated in the following literature.

"The design for movable elements is stated in problems that were compiled first at the Industrial Property Right System Amendment Council for the period from 1950 to 1957 ('Matters deemed to be a problem in relation to the amendment of the Design Act'). In the section on 'Subject of design,' there is the following statement: There is the problem of 'whether it is appropriate to include a design for movable elements (for example, a jack-in-the-box) in the design or whether it should be protected as a utility model' (...). Prior to this, in the 'meeting on the amendment of industrial property right laws' in 1928, '(2) Whether a design is required to be fixed is a problem. It is required to be fixed in popular theories.' Therefore, protection of a design for jack-in-the-boxes,

bobble-head dolls, movable advertising towers, etc. is problematic.' (...). After these discussions, the protection of designs for movable elements was included in the Design Act of 1959." (MITSUDA Shigeaki, MATSUO Kazuko, ed., "Chukai Ishoho (Commentary of the Design Act)," page 221; 1st issue of the first printing issued on October 22, 2010; Seirinshoin; Exhibit Ko 39)

B. Concerning discussions related to the aforementioned law amendment for the period from 1954 through 1955, the materials had the following statements, etc.

[i] As "Opinions concerning matters deemed to be a problem in relation to the amendment of the Design Act," concerning "1. Subject of design," the following opinion is indicated as "(Opinion)": "Concerning the issue of "(e) Whether it is appropriate to have a design for movable elements (for example, a jack-in-the-box) be subject to the design right," "the amendment is not necessary since current treatment (the form after an object popped out from the box is subject to the design right) is appropriate." (1953 "Report of Special Committee on the Amendment of the Design Act, page 5, Opinion of committee member Saito; Exhibit Otsu 12)

[ii] In the report of the Special Committee on the amendment, there are the following statements as "Committee opinions" in the section on "Problem and its purport," concerning the issue of "Whether it is appropriate to include a design for movable elements (for example, a jack-in-the-box) in the design or whether it should be protected as a utility model": "A design for a jack-in-the-box is protected in the form where an object pops out and fully extends (an applicant is required to submit two drawings). Some remarked that it should not be protected as a design. There was another opinion that, in cases of protecting it as a design, since there are two shapes, such as the first shape and the shape after change, two applications should be submitted instead of one application." There is another statement on "Future method of treatment" that "If the Utility Model Act and the Design Act remain unchanged respectively, it is determined to treat this problem as it is treated currently and the problem shall be deleted." (1953 "Report of Special Committee on the Amendment of the Design Act, page 26; Exhibit Otsu 12)

[iii] In the section of "Design for movable elements," concerning the question "How is it treated in cases of a flexible iron wire toy, etc.?", some remarked, "Such an article has no specific form, and is not subject to the design." This remark led to the conclusion that the "Original proposal should be adopted." ("121st Patent Sub-committee Minutes" dated March 24, 1955, page 8, opinion of committee member Takada to the question by committee member Tokumaru; Exhibit Otsu 13)

[iv] In the draft proposal of the amendment of the Design Act, there is the following

statement concerning "Expansion of the scope of those subject to the Design Act": "We considered the issue of strengthening the means of protection for objects protected under the current Design Act. This is an issue regarding whether the design right is to be granted to those that are not protected under the current Design Act (for example, ... a design for movable elements, etc.). However, it is considered that there are not many objects that must be protected beyond the current Design Act." ("Draft proposal of the amendment of the Design Act" prepared by the Industrial Property Right System Amendment and Investigation Office dated August 11, 1954, page 7; Exhibit Otsu 14)

[v] Subsequently, in said draft proposal, there is a statement that "Design for movable elements: (see 310, 1. (e) of the Report," and as stated in the Reports of the Special Committee above, it is stated that "it should be treated in the same manner as under the current Act." ("Draft proposal of the amendment of the Design Act" prepared by the Industrial Property Right System Amendment and Investigation Office dated August 11, 1954, page 8; Exhibit Otsu 14)

C. Based on materials related to the amendment of the Design Act as of 1958, the following facts are found.

[i] In the original draft of Article 6, paragraph (5) of the Design Act (before the amendment by Act No. 51 of 1998; hereinafter the same applies to Article 6, paragraph (5) of the Design Act; it is currently Article 6, paragraph (4) of the Design Act), there was no statement concerning a design for movable elements in Article 6, which is a provision regarding an application for a design registration. ("Draft of the Design Act (Fourth reading)" from March 26, 1958 to April 3, 1958, page 7) (Exhibit Otsu 15)

[ii] Concerning Article 6, paragraph (5) of the Design Act, the first draft was modified and specified as follows: in cases of filing an application for a design "for the shape, pattern, color, or any combination thereof before and after the change, if the shape, pattern, or color of the article embodying the design changes due to the way the article functions," "that fact and an explanation of the article's functions must be indicated in the application." ("Draft of the Design Act (Fifth reading)" from April 16, 1958 to April 23, 1958, page 7, modification; Exhibit Otsu 16)

[iii] In the examination by the Cabinet Legislation Bureau on April 21, 1958, the point that "A jack-in-the-box embodies multiple designs at the same time, and may fall under multiple designs" is listed as a problem. To this problem, the Design Division replied that "The movement of an article itself is considered to be the article itself." (Fifth reading (dated April 21, 1958), page 1 of Memo; Exhibit Otsu 17)

[iv] There is a statement that Article 6, paragraph (5) of the Design Act should be amended to "In cases where an applicant intends to obtain a registration for a movable

design, that fact should be stated." (Fifth reading (same as above), page 2 of Memo) (Exhibit Otsu 17)

[v] As a conclusion for amendment of Article 6, paragraph (5) of the Design Act, it is determined to stipulate that "The function is to be entered in V (Note by the judgment: it was stated as 'IV' in the Memo). In cases of seeking a design registration for various kinds of forms of a movable article, the information is to be entered so that said fact can be defined." (Fifth reading (same as above), page 3 of Memo; Exhibit Otsu 17)

[vi] In the review of the aforementioned amendment draft, there was a proposal, stating "It may be multiple designs. Exceptions to Article 7 should be established." In response, provisions for the application set forth in Article 6, paragraph (5) were adjusted and a design for movable elements was deemed to be one design. (Fifth reading (dated April 22, 1958), page 1 of Memo, statement of Mr. Saito and response to it; Exhibit Otsu 18)

[vii] As "Draft of the Design Act (Fourth reading (Note by the judgment: Serial number may switch places, but they are indicated as indicated on the cover page))" as of November 20, 1958, Article 6, paragraph (5) of the Design Act stipulates that "In cases where the shape, pattern, or color of the article embodying the design changes due to the way the article functions, when an applicant intends to obtain permission for a design for the shape, pattern, color or combination thereof before, during, and after the change, that fact and an explanation of the article's functions must be stated in the application." ("Draft of the Design Act (Fourth reading)" from November 20, 1958 to December 10, 1958; Exhibit Otsu 19)

D. Based on B. above, in the discussions at the Special Committee on the Amendment of the Design Act for the period from 1954 to 1955, whether a design for movable elements should be protected as a design right was examined. As stated in B. [iii] above, concerning whether a "flexible iron wire toy" should be protected as a design for movable elements, the conclusion was issued based on the remark that "Such an article has no specific form, and is not subject to the design." It can be understood that it was construed that articles where a specific shape changes into various irregular shapes and the transition of changes in the shape has no reproducibility, such as a toy using flexible iron wires, etc., cannot be identified as the "design" under the Design Act.

On the other hand, concerning the "jack-in-the-box" in the discussions in B. [ii] above, it is seen that objects with an elastic feature were assumed, also based on B. [i] above. Since the first shape and the shape after the change can be shown concerning the transition from shrunken state to extended state, a "jack-in-the-box" was recognized to be different from the aforementioned "flexible toy."

Based on the aforementioned discussions at the Special Committee, etc., in the

process of amendment of the Design Act mentioned in C. above, as stated in C. [ii] and [iii] above, protection of a design for movable elements by the Design Act was deliberated on again on the assumption of the "jack-in-the-box" in B. above. As stated in C. [ii] above, what was assumed first was the case of filing an application for a design for "the shape before and after the change" "in cases where the shape of an article embodying the design ... changes" (underlined by the Judgment). In response to the problem raised by the Cabinet Legislation Bureau that "A jack-in-the-box embodies multiple designs at the same time, and may fall under multiple designs," as stated in C. [iii] above and to the remark pointing out that it is multiple designs as stated in C. [vi] above, it was considered that there would be a risk that the aforementioned phrase, "the shape before and after the change," may be understood to refer to multiple designs. Therefore, the phrase was determined to be modified.

Then, based on the idea that the movement of an article itself is considered to be the article itself as stated in C. [iii] above, and based on the assumption that a design for movable elements is one design as stated in C. [vi] above, special provisions for exception were not established but it was determined to amend the Design Act by modifying the phrase in Article 6, paragraph (5) of the Design Act (currently Article 6, paragraph (4) of the Design Act) as stated in C. [vii] above to refer to the case of intending to obtain a design registration for "the shape of an article before, during, and after the change" (underlined by the Judgment) .

As stated above, in the process of amendment of the Design Act in 1959, a question arose on the point of whether a design for movable elements is one design if the shape of an article is defined as "the shape before and after the change." Therefore, based on the recognition that the movement of an article itself is considered to be the article itself, it was stipulated to be "the shape of an article before, during, and after the change" and special provisions for exceptions were not established. Based on these facts, it is obvious that the amendment was based on the premise that the shape of an article must fulfill the requirements for shape required of an article under the Design Act in any state before, during, and after the change.

(5) In consideration of (3) and (4) above, concerning the design for movable elements for which the shape of an article changes from among those specified in Article 6, paragraph (4) of the Design Act, it is construed that the shape of the article must meet the requirements for an article under the Design Act in any state before, during, and after the change, that is, the shape of the article maintains a certain shape for a specific period as an attribute of the article and has the nature of a shape for which a border, which is information on its recognition as a shape, can be identified, and the mode of

change has specific rules or changing shapes are constant.

(6) Determination on the Plaintiff's argument on interpretation of Article 6, paragraph (4) of the Design Act

As stated in No. 3 [Plaintiff's Argument], 1. above, the Plaintiff argued that if a design for movable elements is in a mode of change that has specific rules based on the article's functions, it has the "nature of a shape," and therefore, the JPO Decision contains an error in the interpretation of Article 6, paragraph (4) of the Design Act.

However, it is difficult to understand that the requirements for the shape of an article necessary for a design are immediately changed based on the provisions for application of Article 6, paragraph (4) of the Design Act that "If the shape of an article embodying a design, ... changes due to the way the article functions," "the shapes ... of the article as it appears before, during, and after that change" shall be stated in the written application. As examined in (1) through (5) above, in consideration of the history of the amendment of Article 6, paragraph (4) of the Design Act that provides for a design for movable elements and provisions of the Design Act related to general designs, it is construed that the shape of the article must meet the requirements as an article under the Design Act in any state before, during, and after the change as stated above, that is, the shape of the article maintains a certain shape for a specific period as an attribute of the article and has the nature of a shape for which a border, which is information on its recognition as a shape, can be identified, and the mode of change has specific rules or changing shapes are constant.

Consequently, the aforementioned Plaintiff's argument cannot be accepted.

3. Details of the Design in the Application

(1) In consideration of the examinations in 1. and 2. above, the details of the Design in the Application, which is a design for movable elements and partial design, for which an applicant intends to obtain a design registration are found as stated below.

A. As stated in [Explanation of an article embodying a design], it is stated that "the present article is a sparkling beverage in a container, and when the pressure in the container is released after the lid is opened, it foams from the inner peripheral surface of the container." In [Explanation of a design], the following are stated: "... After the lid is opened, it foams from the inner peripheral surface of the container, and the foaming state changes over time from the state shown in 'Plan view after the lid is opened' to the state shown in 'Plan views after the lid is opened that show changes in foaming state 1 through 10.' The time of change from the state shown in 'Plan view after the lid is opened' to the state shown in 'Plan views after the lid is opened that show changes in foaming state 1 through 10' is 10 seconds." Given these, the sparkling

beverage in the can foams from the inner peripheral surface of the container due to changes in the pressure in the container and the foaming state changes as shown in "Plan views after the lid is opened that show changes in foaming state 1 through 10" within 10 seconds.

B. The photographs attached to the written application have figures showing the shape, etc. outside the container in the state where the lid is opened after the lid is opened and the shapes, etc. of inside the container and the sparkling beverage that appear inside the container (Diagonal perspective view after the lid is opened, Plan view after the lid is opened, Plan views after the lid is opened that show changes in foaming state 1 through 10, and Diagonal perspective view where the opening after the lid is opened is enlarged and that shows the foaming state), in addition to a diagonal perspective view and six side views of the shape, etc. outside the container before the lid is opened (Front view, Back view, Left view, Right view, Plan view, and Bottom view).

C. The parts for which the applicant intends to obtain a design registration in the Application, other than the parts colored in pink in each figure are: [i] the large-diameter ring-shaped marginal part in metallic color that is placed on the periphery of the lid on top of the container (hereinafter referred to as the "large-diameter ring-shaped marginal part") as shown in Diagonal perspective view, Plan view, Diagonal perspective view after the lid is opened, Plan view after the lid is opened, Plan views after the lid is opened that show changes in foaming state 1 through 10, and Diagonal perspective view where the opening after the lid is opened is enlarged and that shows foaming state; [ii] the inside of the container that is between the top of the beverage and the large-diameter ring-shaped marginal part as shown in the Diagonal perspective view after the lid is opened and that is very thin and crescent moon-shaped and in a dark metallic color, and [iii] a dark brown beverage and milky bubbles as shown in Diagonal perspective view after the lid is opened, Plan view after the lid is opened, Plan views after the lid is opened that show changes in foaming state 1 through 10, and Diagonal perspective view where the opening after the lid is opened is enlarged and that shows the foaming state.

D. The design for which the applicant intends to obtain a registration in the Application is a shape, etc. that changes by opening the lid of the container. When the lid is closed, which is before the change, the design is the shape, etc. of the large-diameter ring-shaped marginal part that is located in the periphery of the lid part on top of the container, and when the lid is opened, which is after the change, the shape, etc. of part of the inside of the container and the dark brown liquid that appear inside the container, and the shape, etc. of milky bubbles that appear to cover the top of the liquid sequentially, in addition to the shape, etc. of the large-diameter ring-shaped marginal

part.

From among the above, changes over time in the foaming state for said 10 seconds based on the Plan views after the lid is opened that show changes in foaming state 1 through 10, which is "the shape of the article before, during, and after the change," are as stated below and they are changes approximately for every second per photograph.

(A) According to Plan view after the lid is opened that shows changes in foaming state 1, in Plan view after the lid is opened in B. above, the top of the whole surface of the beverage inside the large-diameter ring-shaped marginal part is dark brown, while milky bubbles are generated along the top of the liquid surface on the outer edge of the can. There are parts where the bubble amount is small and the bubbles are in a thin belt shape, where there are no bubbles (upper right part and lower part, etc. in the view), and where the bubble amount is large and bubbles are in a thick belt shape (upper part, lower right part, etc.), and there is a slightly white part in the center.

(B) Concerning Plan view after the lid is opened that shows changes in foaming state 2, the bubbles generate an almost annular outline; however, the width of bubbles that is in a shape of a belt around the edge of the can is not constant and the shape of the outline is an awkward circle.

In comparison with (A) above, there are parts where the width of the bubble belt increases (upper right part), while there are parts where the width disappears or decreases (lower right part). In addition, in the center, the white part shown in the Plan view 1 above has disappeared and small groups of white bubbles are spread irregularly.

(C) In Plan views after the lid is opened that show changes in foaming states 3 and 4, the diameter of the annular shape becomes narrower by gradation; however, the narrowing degree of the outline diameter is not constant depending on the location, the outline deviates towards the upper direction from the can's center as a whole, and the shape is not a circle, but an awkward shape. Around the center of the annular shape, there are white bubbles.

(D) In Plan view after the lid is opened that shows changes in foaming state 5, the diameter of the annular shape has become narrower and longitudinal. In said plan views 5 and 6, the diameter of the annular shape becomes narrower by gradation; however, the narrowing degree of the outline diameter is not constant depending on the location, the outline deviates towards the upper direction from the can's center as a whole, and the shape is an awkward shape which is far from a circle. In said plan views 7 and 8, the generated bubbles cover the whole surface of the opening gradually; however, there is a hole around the center and the hole becomes smaller from said plan view 7 to said plan view 8.

(E) In Plan views after the lid is opened that show changes in foaming states 9 and 10 and Diagonal perspective view where the opening after the lid is opened is enlarged and that shows the foaming state, the foam surface swells toward the can opening and forms a three-dimensional shape that is almost the frustum of a circular cone, at the top of the can opening part; however, the foaming state is not constant, there are parts where big single bubbles appear on and off (left part) and the three-dimensional shape where the bubbles swell are the two-layer frustum of a circular cone.

(2) Determination on the Plaintiff's argument related to the findings of the summary of the Design in the Application

A. The Plaintiff argued that, as stated in No. 3 [Plaintiff's Argument], 2. and 3., the summary of the Design in the Application is the dark brown liquid after the lid is opened and the shape, etc. of the entire milky "foam" that appears as if it covers the top of the liquid sequentially, changes by swelling as if it covers the top of the dark brown liquid; and therefore, the findings of the summary of the Design in the Application by the JPO Decision contains an error.

However, as examined in 2. above, the shape of the article in the design for movable elements fulfills the requirements regarding the shape required for an article under the Design Act in any state before, during, and after the change. The summary of a design application for which the applicant intends to obtain a design registration for movable elements, should also be found based on the above; however, the aforementioned argument of the Plaintiff is not necessary and sufficient based on the statement in the written application and attached photographs.

Then, the summary of the design should be found based on the explanation and photographs attached to the written application. As stated in (1) D. (A) and (B) above, the aforementioned argument of the Plaintiff does not mention the fact that the bubbles that are first generated around the center disappear (the part where dark brown liquid appears again after the milky bubbles are generated once). Therefore, the Plaintiff's argument is not based on the written application.

Consequently, the aforementioned Plaintiff's argument cannot be accepted.

B. As argued in No. 3 [Plaintiff's Argument], 4., the Plaintiff argued that the part found by the JPO Decision where the dark brown liquid appears again after the milky bubbles are generated once is the part that attracts no attention from consumers, for example, a person who actually saw the article did not mention that part at all, etc. (Exhibits Ko 28 and Ko 29), and that the aforementioned "milky bubbles" are particles of air in the liquid that are distinguished from the foam; the bubbles float to the liquid surface and grow into foam around the outer edge of the can, but do not disappear; therefore, the

JPO Decision contains an error, even seen technically as a means of finding the summary.

However, including the fact that part of the bubbles first generated around the center disappear (the state where the dark brown liquid appears again after milky bubbles are generated once), the details of the Design in the Application should be found as stated in (1) above based on the photographs attached to the written application. In addition, the state of the liquid surface after the lid is opened is usually seen by consumers and it cannot be said that it attracts no attention from consumers. On the other hand, the details argued by the Plaintiff concerning the difference between bubbles and foam cannot be identified from the statements in the written application and the "foaming state" shown in the attached photographs, and such details cannot be considered to be the details for which the applicant intends to obtain a design.

Consequently, the aforementioned Plaintiff's argument cannot be accepted.

4. Whether the Design in the Application falls under the category of a design

(1) As examined above, in cases where a design related to the application changes its elements, such as the shape, etc., while maintaining the state of being a "design" as set forth in Article 2, paragraph (1) of the Design Act, a design for movable elements is to be identified as one movable shape, etc. as a whole, including the states before and after the change that are the process of the change, and is to be protected as one design. Therefore, including the intermediate state, that is the shape of the article before, during, and after the change, the article need to have the nature of a shape, etc. that can be identified as a shape, etc. of the article as a whole.

In concrete terms, as stated in 2. (5) above, the shape of an article must meet the requirements as an article under the Design Act in any state before, during, and after the change, that is, the shape of the article maintains a certain shape for a specific period as an attribute of the article and has the nature of a shape for which a border, which is information on its recognition as a shape, can be identified, and the mode of change has specific rules or changing shapes are constant.

Applying the above to the Application, as stated in 3. (1) D. above, in Plan views after the lid is opened that show changes in foaming state 1 through 3, the width of bubbles that is in the shape of a belt around the edge of the can is not constant and the shape of the outline is an awkward circle. In the process, there are parts where the width of the bubble belt increases, while there are parts where the width disappears or decreases. In addition, after the white part at the center disappears and small groups of white bubbles spread irregularly, the diameter of the annular shape becomes narrower by gradation; however, the narrowing degree of the outline diameter is not constant

depending on the location. After the shape presents an irregular shape, not a circle, it becomes the two-layer frustum of a circular cone. The aforementioned states of generation and disappearance of bubbles are not deemed to meet the requirements for the aforementioned design or a design for movable elements, that is, maintaining a certain shape for a specific period, having the nature of a shape for which a border can be identified. In addition, it is also difficult to find that the mode of change has specific rules or changing shapes are constant.

Even based on the disclosed information on "Nama Jokki Kan (Draft Beer Jug Can)" that is deemed to be a product where the Design in the Application is worked, the shape of all the bubbles and their changes differ for each can opened. What can only be found are the state where multiple large bubbles can be visually identified around the outer edge of the can (Exhibit Ko 31, page 15), the state where bubbles that are generated in a patchy manner increases (Exhibit Otsu 8), the state where all the bubbles swell into the shape of a dome where part of the ball is cut off (Exhibit Otsu 9), the state where groups of bubbles can scarcely be seen at the outer edge of the liquid surface in the can (Exhibit Otsu 10, page 4), etc. It is not found that the same shape, etc. as in the photographs attached to the written application of the Application is reproduced whenever the lid is opened (Exhibits Ko 1, 17, and 31; Exhibits Otsu 7 through 10). In light of this point, the aforementioned findings that the states of generation and disappearance of bubbles shown in the Design in the Application lack the nature of a shape and the mode of change has no specific rules, and it is also difficult to find that the changes in the shapes are constant, is reasonable.

Based on the above, the Design in the Application does not fall under a design that can obtain a design registration.

(2) Determination on the Plaintiff's argument as to whether the Design in the Application falls under the category of a design

As argued in No. 3 [Plaintiff's Argument], 5. above, the Plaintiff argued that the Design in the Application has a shape that changes under certain rules and it is supported technically since the patent has been registered.

However, as examined above, it cannot be said that, in the Design in the Application, the shape of the article changes under certain rules. In addition, even if the drinkable liquid filling the can foams as if covering the top edge of the can thanks to the technology related to the patent argued by the Plaintiff (Patent No. 7161596; Claim 6; Exhibit Ko 34), it cannot be found that there is a statement suggesting that the shape of the article always changes as stated in the written application of the Application and as shown in the photographs attached thereto.

Consequently, the aforementioned Plaintiff's argument cannot be accepted.

The Plaintiff argues various other matters, but even in consideration of those arguments, the determination that the Design in the Application does not fall under a design as provided for by the Design Act is not affected.

5. Conclusion

As stated above, the Design in the Application does not fall under a design provided for by the Design Act. There are no errors in the findings and determination in the JPO Decision that has the same purport as the above, and the grounds for rescission argued by the Plaintiff are groundless.

Consequently, the claim of the Plaintiff shall be dismissed, and the judgment is rendered as indicated in the main text.

Intellectual Property High Court, Third Division

Presiding judge: NAKADAIRA Ken

Judge: IMAI Hiroaki

Judge: MIZUNO Masanori

(Copy of the Attached Written Trial Decision, omitted)