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Date of the judgement

1995.02.24

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Case Number

1991(Gyo-Tsu)139

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Reporter

Minshu Vol. 49, No. 2 at 460

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Title

Judgment concerning, in the case where the design in the application for design registration of similar design is similar to another person's design for which an application for design registration has been filed on an earlier date, whether or not said application for design registration of similar design is acceptable or not

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Case name

Case to seek revocation of the trial decision

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Result

Judgment of the Second Petty Bench, quashed and decided by the Supreme Court

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Court of the Second Instance

Tokyo High Court, Judgment of March 28, 1991

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Summary of the judgement

In cases where the design in the application for design registration of similar design is similar to another person’s design for which an application for design registration has been filed on an

earlier date, except where the application for design registration regarding such other person's design has been withdrawn or invalidated, the application for design registration of similar design should be refused pursuant to Article 9, paragraph (1) of the Design Act, irrespective of whether or not such other person's design is similar to the principal design.

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References

Article 9, paragraph (1) and Article 10, paragraph (1) of the Design Act

Article 9, paragraph (1) of the Design Act
Where two or more applications for design registration have been filed for identical or similar designs on different dates, only the applicant who filed the application for design registration on the earliest date shall be entitled to obtain a design registration for the design.

Article 10, paragraph (1) of the Design Act
A holder of a design right, with regard to a design that is similar only to his/her own registered design (hereinafter referred to as a "similar design"), shall be entitled to obtain a design registration of similar design.

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Main text of the judgement

The judgment in prior instance is quashed.
The claims of the appellee of final appeal are all dismissed.
The appellee of final appeal shall bear the total court cost.

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Reasons

Concerning the reasons for final appeal argued by the appeal counsels, KATO Kazuo, NAKANO Tetsuhiro, IIMURA Toshiaki, AOKI Akira, OKAZAKI Kenyu, GOTO Haruo, SUGIMOTO Fumikazu, and HONKAWA Noriko
I. The facts legally determined by the court of prior instance are as follows. (1) The appellee of final appeal filed an application for design registration of similar design, while designating his/her own registered design as the principal design (hereinafter referred to as the "Principal Design") (the design pertaining to this application shall hereinafter be referred to as the "Design in the Application Concerned"). The Design in the Application Concerned was similar to another person's design for which an application for design registration had been filed on an

earlier date (hereinafter referred to as the "Cited Design"). (2) The application for design registration of the Cited Design had been filed after the filing of the application for design registration of the Principal Design and before the filing of the application for design registration of the Design in the Application Concerned. An examiner's decision to refuse the application of the Cited Design became final and binding. (3) Dissatisfied with the examiner's decision to refuse the application for design registration of the Design in the Application Concerned, the appellee filed a request for trial. The Japan Patent Office, without determining whether or not the Cited Design and the Principal Design were similar to each other, made a trial decision not to accept the appellee's request for trial, on the grounds that since the Design in the Application Concerned was similar to the Cited Design, it fails to satisfy the registrability requirement set forth in Article 9, paragraph (1) of the Design Act and therefore a design registration shall not be granted (this trial decision shall hereinafter be referred to as the "Trial Decision").

Given the facts mentioned above, the court of prior instance revoked the Trial Decision, holding as follows. (1) Even in cases where, at the time of the filing of an application for design registration of similar design, there exists another person's design for which an application for design registration has been filed on an earlier date such person's design shall hereinafter be referred to as the "design in the prior application"), and the design in the former application for design registration of similar design is similar to the design in the prior application, if the filing regarding the design in the prior application came after the filing of the application for design registration of the principal design, and the design in the prior application is similar to the principal design, the use of the design in the prior application should have basically been prohibited by reason that the design falls within the scope of the design right for the principal design, and therefore the design in the prior application cannot be acknowledged as a prior design in its relationship with the design in the application for design registration of similar design. (2) Consequently, even in cases where the design in the application for design registration of similar design is similar to the design in the prior application, if the filing regarding the design in the prior application came after the filing of the application for design registration of the principal design, and the design in the prior application is similar to the principal design, and then the application regarding the design in the prior application has been refused, it is appropriate to construe that a design registration shall be granted for the design in the application for design registration of similar design pursuant to Article 10, paragraph (1) of the Design Act, as long as it is similar to the principal design. (3) Consequently, the Trial Decision is illegal in that it acknowledged the Cited Design as a prior design in relation to the Design in the Application Concerned, without determining whether or not the Cited Design and the Principal Design were similar to each other.

II. However, we cannot affirm the holdings of the court of prior instance mentioned above, on the following grounds.

In cases where the design in the application for design registration of similar design is similar to the design in the prior application, it is appropriate to construe that except where the application regarding the design in the prior application has been withdrawn or invalidated, the application for design registration of similar design should be refused pursuant to Article 9, paragraph (1) of the Design Act, irrespective of whether or not the design in the prior application is similar to the principal design. In terms of the application of the provision of Article 9, paragraph (1) of the Design Act, an application for design registration shall be deemed never to have been filed only in cases where said application has been withdrawn or invalidated pursuant to paragraph (3) of said Article, and in light of this, it should be construed that even when an examiner's decision has been made to refuse the application regarding the design in the prior application and this decision has become final and binding, such prior application does not lose the status of a prior application. This construction does not affect the scope of the principal design, and therefore it does not undermine the purport of the similar design registration system, the purpose of which is to protect the principal design. Furthermore, in the case described above, the holder of the design right for the principal design is unable to obtain a design registration of similar design only because he/she has failed to file the application for said design registration of similar design prior to the filing of the application for design registration of the design in the prior application, and we should say that this is an unavoidable consequence inasmuch as the Design Act does not include any special provision for giving preference to the holder of the design right for the principal design in terms of the timing of filing an application for design registration of similar design.

The judgment in prior instance, which found the Trial Decision to be illegal based on grounds that contravene this reasoning, is illegal for its erroneous construction and application of laws and regulations, and such illegality apparently affects the conclusion of the judgment of prior instance. The appeal counsels' arguments are well-grounded, and the judgment in prior instance should inevitably be quashed. Given the facts mentioned above, there is no illegality in the Trial Decision concluding that the Design in the Application Concerned fails to satisfy the registrability requirement set forth in Article 9, paragraph (1) of the Design Act and therefore a design registration shall not be granted. Since the appellee has not asserted any other grounds for revocation of the Trial Decision, the appellee's appeal in this action to seek revocation of the decision should be dismissed as groundless.

Therefore, according to Article 7 of the Administrative Case Litigation Act, and Article 408,

Article 96, and Article 89 of the Code of Civil Procedure, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices.

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Presiding judge

Justice ONISHI Katsuya

Justice NAKAJIMA Toshijiro

Justice NEGISHI Shigeharu

Justice KAWAI Shinichi

(This translation is provisional and subject to revision.)

(* Translated by Judicial Research Foundation)