

Date	December 15, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2011 (Gyo-Ke) 10239		
<p>○ Article 3, paragraph (2) of the Design Act deals with the novelty and originality of the idea of a design from the perspective of a person ordinarily skilled in the art, based on well-known abstract motifs which are separated from articles.</p> <p>○ The constitution of a relevant publicly-known design is as follows: four-step horizontally-long strip-shaped printing parts are formed on the surface of a horizontally-long rectangular board; three horizontally-long round-cornered rectangles are allocated at each of the strip-shaped printing parts; the strip-shaped printing parts are outlined by a solid line; and perforated lines are formed in a longitudinal direction between neighboring horizontally-long round-cornered rectangles as well as at the center. The constitution of the design in the application concerned is as follows: three-step strip-shaped printing parts are formed; three horizontally-long round-cornered rectangles are allocated at each of the strip-shaped printing parts; and perforated lines are formed in a longitudinal direction at the center thereof. From the perspective of a person ordinarily skilled in the art at the time of filing of the design application concerned, to create the design in the application concerned based on said publicly-known design does not have novelty or originality in terms of the idea of a design. Therefore, the design in the application concerned is one which a person ordinarily skilled in the art would have been able to easily create.</p>			

References:

Article 3, paragraph (2) of the Design Act

The plaintiff filed the design application concerned for the article to the design, "release papers for printing," but received an examiner's decision of refusal. In response, the plaintiff filed a request for a trial. However, the JPO rendered a decision to the effect that the request for a trial is to be dismissed. The reason for the JPO decision in brief is that the design in the application concerned falls under the provisions of Article 3, paragraph (2) of the Design Act and is thus unregistrable as it is one which a person ordinarily skilled in the art would have been able to easily create based on the cited design.

The plaintiff filed this case to seek rescission of the JPO decision. As a ground for rescission, the plaintiff asserted error in determining whether a person ordinarily skilled in the art would have been able to easily create the design in the application concerned.

The Intellectual Property High Court dismissed the plaintiff's claim, determining as

follows.

"As a requirement for registration, Article 3, paragraph (2) of the Design Act stipulates that a design is not one which a person ordinarily skilled in the art of the design (hereinafter referred to as a "person ordinarily skilled in the art") would have been able to easily create based on shapes, patterns or colors, or any combination thereof that were widely known in Japan as abstract motifs which are separated from articles (well-known motifs). The provision deals with the novelty or originality of the idea of a design from the perspective of a person ordinarily skilled in the art, based on the aforementioned well-known motifs"

"The constitution of the publicly-known design is as follows: four-step horizontally-long strip-shaped printing parts are formed on the surface of a horizontally-long rectangular board; three horizontally-long round-cornered rectangles are allocated at each of the strip-shaped printing parts; the strip-shaped printing parts are outlined by a solid line; and a thin strip-shaped back part for the front cover is formed at the center of the rightmost horizontally-long round-cornered rectangles of the strip-shaped printing parts at the first and third steps, and for others, perforated lines are formed in a longitudinal direction between neighboring horizontally-long round-cornered rectangles as well as at the center. The constitution of the design in the application concerned is as follows: three-step strip-shaped printing parts are formed; three horizontally-long round-cornered rectangles are allocated at each of the strip-shaped printing parts; and perforated lines are formed in a longitudinal direction at the center thereof. To create the design in the application concerned based on said publicly-known design is little more than to cut out part of the design and change some of the perforated lines to solid lines. It is not regarded as having novelty or originality in terms of the idea of a design from the perspective of a person ordinarily skilled in the art at the time of filing of the design application concerned. Therefore, the design in the application concerned should be regarded as one which a person ordinarily skilled in the art would have been able to easily create.

Consequently, the design in the application concerned falls under Article 3, paragraph (2) of the Design Act."