

Date	November 26, 2012	Court	Intellectual Property High Court, Second Division
Case number	2012 (Gyo-ke) 10105, 10106, 10107, 10108, 10109, 10110		
<p>– A case in which, by holding that the Japan Patent Office (JPO) overlooked the differences and made an erroneous finding on similarity with regard to designs embodied in the article "artificial tooth," the court rescinded a JPO trial decision which dismissed a request for a trial against an examiner's decision of refusal on the grounds that said designs are similar to publicly-known designs</p>			

References:

Article 3, paragraph (1), item (iii) of the Design Act

1. Background

In this case, the plaintiff filed an action to seek rescission of a trial decision made by the Japan Patent Office (JPO) which dismissed a request for a trial against an examiner's decision of refusal of design application. All of the designs in dispute are related to an artificial anterior tooth to be used as a denture, etc. The issue in this action lies in design similarity. Design A of case number 2012 (Gyo-ke) 10105 (hereinafter referred to as "Design A") and design B of case number 2012 (Gyo-ke) 10106 (hereinafter referred to as "Design B") are the designs of an artificial upper anterior tooth, while design C of case number 2012 (Gyo-ke) 10107 (hereinafter referred to as "Design C") is the design of an artificial lower anterior tooth. Design D of case number 2012 (Gyo-ke) 10108 (hereinafter referred to as "Design D") is a partial design of Design A, while design E of case number 2012 (Gyo-ke) 10109 (hereinafter referred to as "Design E") and Design F of case number 2012 (Gyo-ke) 10110 (hereinafter referred to as "Design F") are partial designs of Design B and Design C respectively.

On June 30, 2008, the plaintiff, who had filed applications for registration of Designs A through F (Design Applications No. 2008-016902, No. 2008-016903, No. 2008-016906, No. 2008-016914, No. 2008-016915, and No. 2008-016918), received an examiner's decision of refusal on the grounds that said designs are similar to publicly-known designs. Dissatisfied with this decision, the plaintiff filed a request for a trial against the examiner's decision of refusal. The plaintiff received JPO trial decisions dismissing the request (hereinafter referred to as the "JPO Trial Decisions A through F") on February 13, 2012 with respect to Design B, and on February 14, 2012 with respect to Designs A, and C through F. Therefore, the plaintiff filed this action to

seek rescission of these trial decisions. The JPO made said trial decisions generally on the grounds that Designs A through F are similar to the cited designs, by pointing out that that Designs A through F were identical to the cited designs in terms of the articles embodying the designs and that the impression gained from the similarities between Designs A through F and the cited designs in terms of configuration was so strong that the differences, which were all minor, were unable to obscure the impression gained from the similarities.

2. Summary of the Court decision

The court rescinded the JPO Trial Decisions A through F on the grounds that the JPO Trial Decisions A through F overlooked the differences and made an erroneous finding on similarity with the cited designs, by mainly holding as follows.

Primarily, users of artificial teeth, i.e., dental technicians and dentists, examine, in light of the configuration of a natural tooth, each of the artificial teeth supplied from manufacturers and distributors from the perspective of whether the artificial teeth perform the functions of occlusion and mastication. Secondly, they also examine the supplied artificial teeth from the perspective of the ease of use in their practice, the stability of the connection with the denture base, and the aesthetic quality, as well as the quality of material, which is not a design-related perspective. From these perspectives, it is reasonable to conclude that, the basic design configuration, which has been determined based on the configuration of a natural tooth, may be regarded as a less significant similarity between said Designs and the cited designs in determining the similarities regarding the designs of artificial teeth.

Design A is different from Cited Design A (Design Registration No. 1197533; Exhibit Ko A No. 18) at least in terms of the side-view shape of the labial face, the contour shape of the basal surface, and the existence or nonexistence of a facet. The JPO Trial Decision A overlooked these differences. In comparison with Cited Design A, Design A gives a patient the impression that Design A is slimmer and an impression created by the existence of said facet. Although the design of an artificial tooth emulates the configuration of a natural tooth, the impressions caused by the differences between Design A and Cited Design A are so significant that they cannot be obscured by the impressions caused by the similarities such as the basic design configuration shared between the two designs. Therefore, the two designs are not similar.

Design B is different from Cited Design B (Design Registration No. 1197059; Exhibit Ko B No. 16) at least in terms of the side-view shape of the labial face, the contour shape of the basal surface, and the existence or nonexistence of a facet. The

JPO Trial Decision B overlooked these differences. In comparison with Cited Design B, Design B gives a patient an impression that Design B is slimmer, an impression that Design B is asymmetrical, and an impression created by the existence of said facet. The impressions caused by the differences between Design B and Cited Design B are so significant that they cannot be obscured by the impressions caused by the similarities such as the basic design configuration shared between the two designs. Therefore, the two designs are not similar.

Design C is different from Cited Design C (Design Registration No. 1197056; Exhibit Ko C No. 16) at least in terms of the side-view shape of the labial face, the contour shape of the basal surface, the side-view shape of the crista and the existence or nonexistence of a facet. The JPO Trial Decision C overlooked these differences. In comparison with Cited Design C, Design C gives a patient an impression that Design C is slimmer, an impression that Design C is asymmetrical, and also an impression created by the existence of said facet. The impressions caused by the differences between Design C and Cited Design C are so significant that they cannot be obscured by the impressions caused by the similarities such as the basic design configuration shared between the two designs. Therefore, the two designs are not similar.

Similarly, regarding Designs D through F, the JPO Trial Decisions D through F overlooked the difference with regard to the existence or nonexistence of a facet. The impressions caused by the differences between Designs D through F and Cited Designs D through F (the edges of Cited Designs A through C respectively) are so significant that they cannot be obscured by the impressions caused by the similarities. Therefore, said Designs may not be regarded to be similar to said Cited Designs.