

Date	March 25, 1980	Court	Tokyo High Court
Case number	1978 (Gyo-Ke) 30		
– A case in which the court held that the characters "CUP NOODLE" attached to a container do not constitute a design.			

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

Number of related rights, etc.: Design Registration No. 359633

Summary of the Judgment

The defendant holds a design right for the design in question ("Design"; Design Registration No. 359633) for which an article to the design is a "packaging container" (one of the pictures substituting the drawing contained in the Design Bulletin is shown below).



In response to a request for a trial for invalidation of registration filed by the plaintiff with respect to the design registration in question, the JPO rendered a trial decision to dismiss the request for a trial by determining that the character portion "CUP NOODLE" also constitutes the design.

Even if a container of which the shape is similar to the shape of the container of the Design has been publicly known prior to the filing of the application, the Design cannot be considered to be similar to the design of the container that is similar merely in the shape because in the Design, figures, such as horizontal stripe-like belts and characters, are inscribed at the peripheral side part, and the constitution of the characters is also creative and falls under the scope of those that can be recognized as a pattern.

In this judgment, the court determined as follows and rescinded the JPO Decision on the grounds that it contains errors in its determination.

Incidentally, there is room to find creativity as a pattern in characters that are deemed to have lost their original function as a means of linguistic communication as a result of having been made into a pattern.

However, the characters, "CUP" and "NOODLE," are arranged in an ordinary method of arrangement to write Roman characters. A product name meaning noodle

put in a cup (a type of noodle) is indicated as if it is a trademark aiming to have those who see this understand in that manner, and such understanding is considered to be sufficiently possible. Therefore, it cannot be said that the Roman characters have changed into a pattern and have lost their original function as characters.

Therefore, it must be said that the JPO decision contains an error in its determination that said Roman characters fall under those that can be recognized as a pattern.

Judgment rendered on March 25, 1980

1978 (Gyo-Ke) 30

(Indication of the parties is omitted)

Main Text

The JPO decision rendered regarding JPO Trial No. 1973-9234 on December 9, 1977 shall be rescinded.

The defendant shall bear the court costs.

Facts

No. 1 Judicial decision sought by the parties

1. Plaintiff

The same as the main text of this judgment.

2. Defendant

A judgment as follows: "The plaintiff's claim shall be dismissed. The plaintiff shall bear the court costs."

No. 2 Allegations of the parties

1. Statement of claim

(1) JPO proceedings

The defendant is the holder of a design right pertaining to Design Registration No. 359633 (the application filed on March 19, 1971; registered on December 1, 1972; hereinafter referred to as the "Design") for which an article to the design is a "packaging container" as indicated in the attachment.

On December 22, 1973, the plaintiff filed a request for a trial for invalidation of design registration in relation to the Design, designating the defendant as the demandee. The case was examined as JPO Trial No. 1973-9234. The JPO rendered a decision to the effect that "The request for a trial in question shall be dismissed" on December 9, 1977, and a certified copy of the JPO decision was served to the plaintiff on February 15, 1978.

(2) Gist of the reasons for the JPO decision

The demandant sought a JPO decision that invalidates the registration of the Design. As reasons therefor, the demandant alleged that the Design is one that should be invalidated pursuant to the provisions of Article 48 of the Design Act as it is a design wherein characters, which do not fall under the design under the Design Act, are inscribed on the peripheral side part of a container of which the shape is well-known.

On the other hand, the demandee sought a JPO decision to the effect that "The request for a trial in question shall be dismissed." As reasons therefor, the demandee alleged as follows:

Patterns other than characters are also inscribed on the peripheral side part of the Design, and the characters are also not simple characters; therefore, the Design fulfills the conditions for design registration.

The gist of the Design is found to be as follows based on the photographs attached to the application that are used as substitutes for drawings and the statements in the application: in a container of which the entire shape is a nearly inverted truncated cone (the ratio between the height, the diameter of the upper edge, and the diameter of the lower edge is 7 to 6 to 4) and of which the entire top surface is an aperture, the color of the entire basis thereof is a light tone, and patterns are inscribed on the peripheral side part in a medium or dark tone; specifically looking at the Design, in a container comprising a shape wherein a thin edging of which the cross-sectional surface is square-shaped is formed like a ring at the upper edge part of the peripheral side, the shape of the part from said edging to the part at a height about one-tenth of the entire height of the container from the lower edge is a nearly inverted truncated cone, and the peripheral side part of the lower edge that is below said height is vertical, the following are inscribed: [i] a thin line is horizontally inscribed in a medium tone at the upper edge-sided part of the peripheral side; [ii] below said line, a belt made by horizontally lining up small, long, vertical rectangles in a manner that they make up a break line is inscribed in a medium tone in parallel with said thin line at the upper edge-sided part; [iii] furthermore, with a slight space below said belt, a belt made by horizontally lining up small squares of which the width is the same as that of the long, vertical rectangles of the upper belt in a manner that they make up a break line is horizontally inscribed in a medium tone, thereby making said thin line and two belts form horizontal stripes; [iv] then, a thin line is horizontally inscribed in a medium tone at the lower edge-sided part of the peripheral side that is inclined; [v] just above it, a belt made by horizontally lining up small, long, vertical rectangles in a manner that they make up a break line in the same way as the belt at the upper edge-sided part is inscribed in a medium tone in parallel with said thin line to make up horizontal stripes; [vi] Roman characters, "CUP" and "NOODLE," are inscribed in a considerably stylized font by surrounding the characters with a line in a medium tone, in two tiers at the center of the front and back peripheral sides that are sandwiched between the upper and lower horizontal stripe-like belts, with each character arranged closely side by side as if overlapping with each other; and [vii] furthermore, a figure structured in a manner that a light-toned wavy line passes through the center of a dark-toned circle is inscribed at the center of the peripheral side on the right side.

Based on this, even if a container of which the shape is similar to the shape of the container of the Design has been publicly known prior to the filing of the application, the Design cannot be considered to be similar to the design of the container that is similar merely in the shape because in the Design, figures, such as horizontal stripe-like belts and characters, are inscribed

at the peripheral side part as mentioned above, and the constitution of the characters is also creative and falls under the scope of those that can be recognized as a pattern.

Therefore, the Design does not fall under the design provided for in Article 3, paragraph (1), item (iii) of the Design Act, and it thus cannot be invalidated.

(3) Grounds for rescission of the JPO decision

The JPO decision should be rescinded because it contains the following error that led to drawing a conclusion that the registration of the Design cannot be invalidated.

1. In the trial procedures, the plaintiff alleged that the registration of the Design is invalid because the Design includes characters, which cannot become the constituent elements of a design under the Design Act. However, the JPO omitted to make a determination concerning said allegation. That is, the plaintiff did not seek a determination by the JPO concerning whether the Design is similar to a publicly known design but sought a determination by the JPO concerning whether the Design falls under the design mentioned in the main paragraph of Article 3, paragraph (1) of the Design Act, and furthermore, the design mentioned in Article 2, paragraph (1) of said Act. However, the JPO determined that the request for a trial is to be dismissed by ruling that "The registered design in question does not fall under the design provided for in Article 3, paragraph (1), item (iii) of the Design Act, and it thus cannot be invalidated." Therefore, the JPO should be considered to have omitted to make a determination concerning said allegation of the plaintiff.

2. Even if the JPO is considered to have made a determination that the Design falls under the design mentioned in the main paragraph of Article 3, paragraph (1) of the Design Act, and furthermore, the design mentioned in Article 2, paragraph (1) of said Act, mere characters that have not been made into a pattern and are not recognized as a pattern cannot become the constituent elements of a design under the Design Act. The characters "CUP NOODLE" in the Design indicate a product name and have not lost their function as characters. Therefore, the Design cannot be considered to fall under the design mentioned in the main paragraph of Article 3, paragraph (1) of the Design Act, and furthermore, the design mentioned in Article 2, paragraph (1) of said Act.

(omitted)

Reasons

1. There is no dispute among the parties over the facts mentioned in (1) and (2) in the statement of claim.
2. Therefore, whether there are grounds for rescission of the JPO decision is examined.
 - (1) First of all, whether the JPO omitted to make a determination is examined.

1. There is no dispute among the parties in that, in the trial procedures, the plaintiff alleged that the registration of the Design is invalid because the Design includes characters ("CUP NOODLE"), which cannot become the constituent elements of a design under the Design Act.

2. In examining this point, in the JPO decision, there is certainly no part that directly and conclusively expresses a determination concerning said allegation. However, in the reasons for the JPO decision, the JPO instructs that "In the registered design in question, figures, such as horizontal stripe-like belts and characters, are inscribed at the peripheral side part ..., and the constitution of the characters is also creative and falls under the scope of those that can be recognized as a pattern." Taking this into account, it is obvious that the JPO did not accept the aforementioned allegation of the plaintiff, but recognized the "CUP NOODLE" part as a pattern, determined that the Design falls under the design mentioned in the main paragraph of Article 3, paragraph (1) of the Design Act, and furthermore, the design mentioned in Article 2, paragraph (1) of said Act, and advanced discussion on this premise. Therefore, the JPO cannot be considered to have omitted to make a determination concerning the plaintiff's allegation, leaving aside the question of the propriety of the instruction of the reasons for the JPO decision.

(2) The JPO is recognized as having instructed, on the premise of said determination, that the Design cannot be considered to be a design that falls under Article 3, paragraph (1), item (iii) of the Design Act in relation to a publicly known design (according to Exhibit Ko No. 3 for which existence and establishment of the original are undisputed, the plaintiff is also recognized as having made, in the trial, an allegation that the shape of the container of the Design is well-known and that there is no other special element that constitutes a design) and as having ruled that the request for a trial for invalidation filed by the plaintiff is to be dismissed.

(3) The propriety of determinations in the JPO decision mentioned in (1)2. and (2) above is examined.

1. According to Exhibit Ko No. 2 of which establishment is undisputed, the gist of the Design (see the attachment) is recognized as found in the JPO decision. The part at issue is that Roman characters, "CUP" and "NOODLE," are inscribed in a considerably stylized font by surrounding the characters with a line in a medium tone, in two tiers at the center of the front and back peripheral sides, with each character arranged closely side by side as if overlapping with each other.

2. Incidentally, it is needless to say that there is room to find creativity as a pattern in characters that are deemed to have lost their original function as a means of linguistic communication as a result of having been made into a pattern.

However, looking at the aforementioned part in the Design, the characters, "CUP" and "NOODLE," are arranged in an ordinary method of arrangement to write Roman characters. A product name meaning noodle put in a cup (a type of noodle) is indicated as if it is a trademark,

aiming to have those who see this understand in that manner, and such understanding is considered to be sufficiently possible. Therefore, it cannot be said that the Roman characters have changed into a pattern and have lost their original function as characters.

Therefore, it must be said that the JPO decision contains an error in its determination that said Roman characters fall under those that can be recognized as a pattern.

3. In that case, it is impossible to uphold, as a justifiable one, the determination in the JPO decision, which is based on this erroneous determination, to the effect that the Design does not fall under the main paragraph of Article 3, paragraph (1) of the Design Act (furthermore, Article 2, paragraph (1) of said Act) and Article 3, paragraph (1), item (iii) of said Act (incidentally, in consideration of the aforementioned undisputed facts, it is recognized that the emphasis in the plaintiff's allegation in the trial existed in the point that the inclusion of the characters, "CUP NOODLE," in the Design as a constituent element immediately leads to invalidation of the Design as a whole; depending on the determination concerning this allegation, the aforementioned error in the JPO decision affects the conclusion without the need to discuss the issue concerning Article 3, paragraph (1), item (iii) of the Design Act).

(4) In that case, the JPO decision is inevitably rescinded as an illegal one.

3. Therefore, the claim in this action shall be upheld. For the court costs, the judgment shall be rendered in the form of the main text by applying Article 7 of the Administrative Case Litigation Act and Article 89 of the Code of Civil Procedure.

Tokyo High Court

Judge: KOBORI Isao

Judge: OGASAWARA Akio

Judge: FUNABASHI Sadayuki

(Attachment)

Design bulletin

1973-359633

Application: March 19, 1971

Design application: 1971-9125

Registration: December 1, 1972

Creator: Momofuku Ando

7-34, Masumi-cho, Ikeda-shi

Holder of the design right: Nisshin Foods Holdings Co., Ltd.

13-1, Ohata-cho, Takatsuki-shi

Representative: Yoshiyuki Kamata, patent attorney

Article to the design: Packaging container

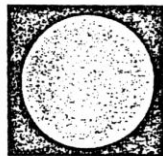
Front view



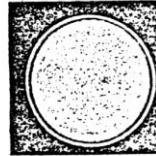
Back view



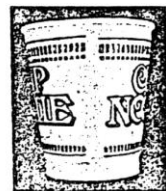
Plan view



Bottom view



Left side view



Enlarged front central longitudinal sectional view



Right side view

