

Date	December 15, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2011 (Gyo-Ke) 10240		

– A case in which the court determined that Article 3, paragraph (2) of the Design Act questions the novelty or originality of an idea of a design from the perspective of a person ordinarily skilled in the art by using abstract well-known motifs that are separate from articles as a benchmark.

– A case in which the court determined as follows: Creating the design in the application for design registration (the "Design") based on the cited design is nothing more than making the rounded corners of horizontally oriented rectangles into right-angled corners by cutting part thereof and extending part of the perforations up to the upper and lower margins or changing them into solid line; Even seeing the Design as a whole, it cannot be said to have the novelty or originality of an idea of a design from the perspective of a person ordinarily skilled in the art as of the time the application for design registration was filed; In light of common points between the cited design and the Design, there is sufficient motivation to create the Design based on the cited design.

References: Article 3, paragraph (2) of the Design Act

The plaintiff filed an application for design registration for the Design in relation to the article, "release paper for printing," but received an examiner's decision of refusal. Therefore, the plaintiff filed a request for a trial against the examiner's decision of refusal. However, the JPO rendered a decision dismissing the request (the "JPO Decision"). The reasons for the JPO Decision is, in a word, that the Design falls under the provisions of Article 3, paragraph (2) of the Design Act and is not registrable as a design because it is one that a person ordinarily skilled in the art could have easily created based on the cited design.

This is an action instituted by the plaintiff to seek rescission of the JPO Decision. As a ground for rescission, the plaintiff asserted an error in the determination concerning whether the Design could have been easily created by a person ordinarily skilled in the art.

In this judgment, the court determined as follows and dismissed the plaintiff's claim.

"Article 3, paragraph (2) of the Design Act provides for a requirement for registration, that is, the design is determined 'not to fall under a design that a person ordinarily skilled in the art of the design (hereinafter referred to as a "Person Ordinarily Skilled in the Art") could have easily created based on the shape, patterns or colors, or

any combination thereof that were widely known in Japan as abstract motifs that are separate from articles (the "Well-Known Motifs"), by using said Well-Known Motifs as a benchmark. It questions the novelty or originality of an idea of a design from the perspective of a Person Ordinarily Skilled in the Art by using the aforementioned Well-Known Motifs as a benchmark. ..."

"In the publicly known design, there are horizontally oriented belt-like printing parts in four tiers on the surface of a horizontally oriented rectangular mounting, with five horizontally oriented rectangles with rounded corners being arranged in each of the belt-like printing parts, whose outlines are surrounded by a solid line; and there are the band-like backrest parts for the front cover at the center of the rightmost horizontally oriented rectangles with rounded corners on the first and third tiers, while other horizontally oriented rectangles with rounded corners have perforations in a longitudinal direction at the center thereof as well as between adjacent horizontally oriented rectangles with rounded corners. On the other hand, in the Design, there are belt-like printing parts in two tiers, with two horizontally oriented rectangles being arranged in each of the belt-like printing parts, the belt-like printing parts have perforations, which extend up to the upper and lower margins in a longitudinal direction, at the center. Creating the Design based on said publicly known design is nothing more than making the rounded corners of the horizontally oriented rectangles into right-angled corners by cutting a part thereof and extending part of the perforations up to the upper and lower margins or changing them into solid line. Even seeing the Design as a whole, it cannot be said to have the novelty or originality of an idea of a design from the perspective of a Person Ordinarily Skilled in the Art as of the time when the application for design registration was filed. It should be regarded as a design that a Person Ordinarily Skilled in the Art could have easily created.

Therefore, the Design falls under Article 3, paragraph (2) of the Design Act."

"If the belt-like printing parts of the same shape are made into two tiers and perforations are extended to the upper and lower margins in the cited design, the shape of the margins other than the belt-like printing parts automatically becomes like that of the Design. There is sufficient motivation to create the Design based on the cited design in light of the common points between the cited design and the Design, that is: [i] the article pertaining to the design is printing paper that can be used by peeling the printing parts on which photographs, etc. can be printed from the mounting and making it into a booklet-like shape; [ii] when used, the printing paper can be formed into booklet-like shape by folding it up into concertinas along with the fold lines and perforations and by pasting the back sides; [iii] there are multiple horizontally oriented belt-like printing

parts on the surface of the horizontally oriented rectangular mounting; [iv] there are multiple horizontally oriented rectangles on the horizontally oriented belt-like printing parts; and [v] there are perforations in a longitudinal direction at the center."