

Novelty (related to Prior designs)

(Date) March 25, 1980

**<Tokyo High Court> 1978 (Gyo-Ke) 30
"CUP NOODLE" Case**

(Conclusion) Novelty should not be found. (Applicant lost.)



(The applied design)

As the characters "CUP NOODLE" on the surface of a container is not deemed a "pattern" in this case, these characters do not generate Novelty. There is room for interpretation that the characters lost their original function as a means of communication and as a result became a pattern. However, in this case, the characters "CUP" and "NOODLE" are arranged in an ordinary way, and as a result, the characters can be understood as a product name meaning noodle(s) put into a cup.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/813/001813.pdf

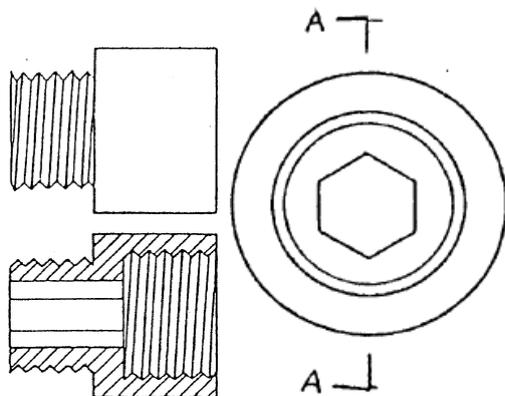
Novelty (related to Prior designs)

(Date) July 30, 1985

<Tokyo High Court> 1984 (Gyo-Ke) 7

"Faucet Fitting" Case

(Conclusion) Novelty should not be found. (Design right owner lost.)



(The applied design)

DIN 621.643.614 : 620.1 : 606.1 DEUTSCHE NORMEN Januar 1969

Wasser-Armaturen für Hausinstallation
Verlängerungen DIN 3523

Water fittings for house installation, lengthenings

Maße in mm

Bohrung mit Innenmehrkant (max. 12-kant) passend für Sedskant-Schraubendreher nach DIN 911

Eine Hinterdrehung bis zum Außendurchmesser d_1 des Innengewindes ist zulässig.

Bezeichnung einer Verlängerung von Gewinde $d_1 = R \frac{1}{2}$ und Länge $l_1 = 20$ mm, Ausführung verchromt [cr]
 Verlängerung $R \frac{1}{2} \times 20$ DIN 3523 - cr

Gewinde d_1		$R \frac{1}{2}$ "	$R \frac{1}{2}$ "	$R \frac{1}{2}$ "	$R 1$ "
d_1		22	27	32	39
l_1		10	11	12	14
l_1	l_2	l_2 min.			
15	12	11	11	11	11
20	17				
25	22	12	13	14	16
30	24,5				
35	31,5				
40	34	12	13	14	16
50	44				
65	48,5				
80	75,5	12	13	14	16
100	95				

Werkstoff: CuZn40Pb2 (Werkstoffnummer 2.0402) nach DIN 17 650
 Das Halbzeug zur Herstellung der Verlängerungen muß vor der Bearbeitung entspannt sein.

Ausführung (bei Bestellung angeben): roh
 poliert (möglichst vermeiden)
 cr (verchromt)

Gewinde: Whitworth-Rohrgewinde nach DIN 259
 Toleranz für das Außengewinde: grob; jedoch oberes Abmaß nicht 0 sondern gleich dem unteren Abmaß für Innengewinde nach DIN 2999.
 Auf dem Außengewinde ist eine Rändelung aufzubringen.

Kennzeichnung: Verlängerungen, die dieser Norm entsprechen, sind auf dem Umfang von d_1 mit dem Verbindungszeichen (nach DIN 311) und zwar in Verbindung mit dem Herstellerzeichen, zu versehen. Durch diese Kennzeichnung übernimmt der Lieferer die Gewähr, daß die Verlängerung dieser Norm entspricht.

Erläuterungen Seite 2
 Fachnormenausschuß Maschinenbau im Deutschen Normenausschuß (DIN)

Attenvermerk der Normblätter durch Beuth-Vertrieb GmbH, Berlin 30 und Köln DIN 3523 Jan. 1969 Preistr. 7

(Prior design "DIN 3523 of the German industrial standard")

A request for an invalidation trial before the JPO by a non-exclusive licensee shall not be contrary to the doctrine of good faith, unless there are special circumstances.

When identifying a design shown in a Prior design, not only the drawing(s), but also the text of the appended table etc. can be considered.

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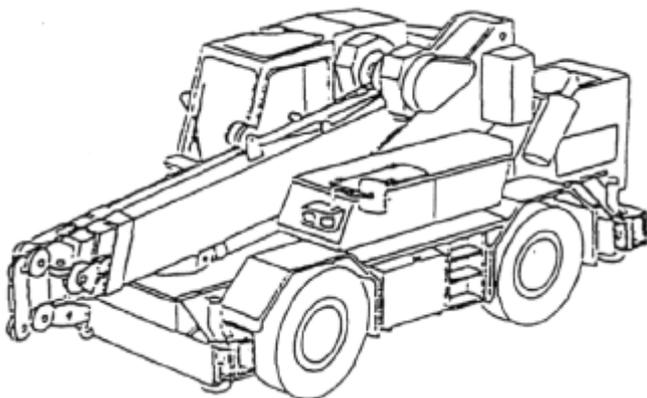
https://www.ip.courts.go.jp/app/files/hanrei_en/846/001846.pdf

Similarity of design (Infringement case)

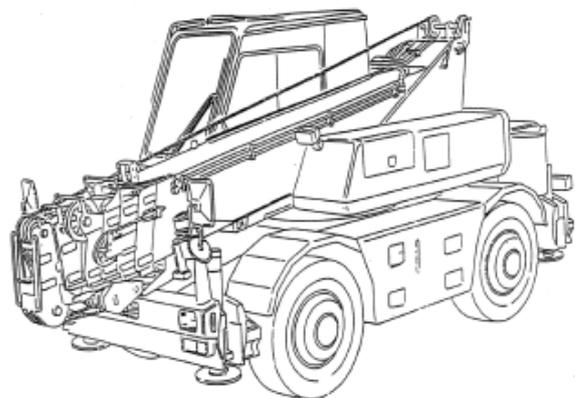
(Date) June 18, 1998

**<Tokyo High Court> 1997 (Ne) 404
"Self-propelled Crane" Case**

**(Conclusion) Infringer's design is similar to the registered design.
(Design right owner won.)**



(The resistered design)



(Infringer's design)

This case showed the general criterion of similarity between the registered design and an infringer's design as follows. (This criterion has been followed by the later court cases still now.)

- (1) Taking into consideration the nature, use and usage of the article embodying the design and the "newly created part" which is not in the Prior designs,
- (2) Understand the most attractive parts by suppliers and users as a essential part of the design, and
- (3) Observe whether "common configuration aspects in the essential part"

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/133/002133.pdf

Similarity of design (Infringement case)

(Date) September 28, 1981

<Osaka High Court> 1980 (Ra) 542

"Storage Cabinet" Case

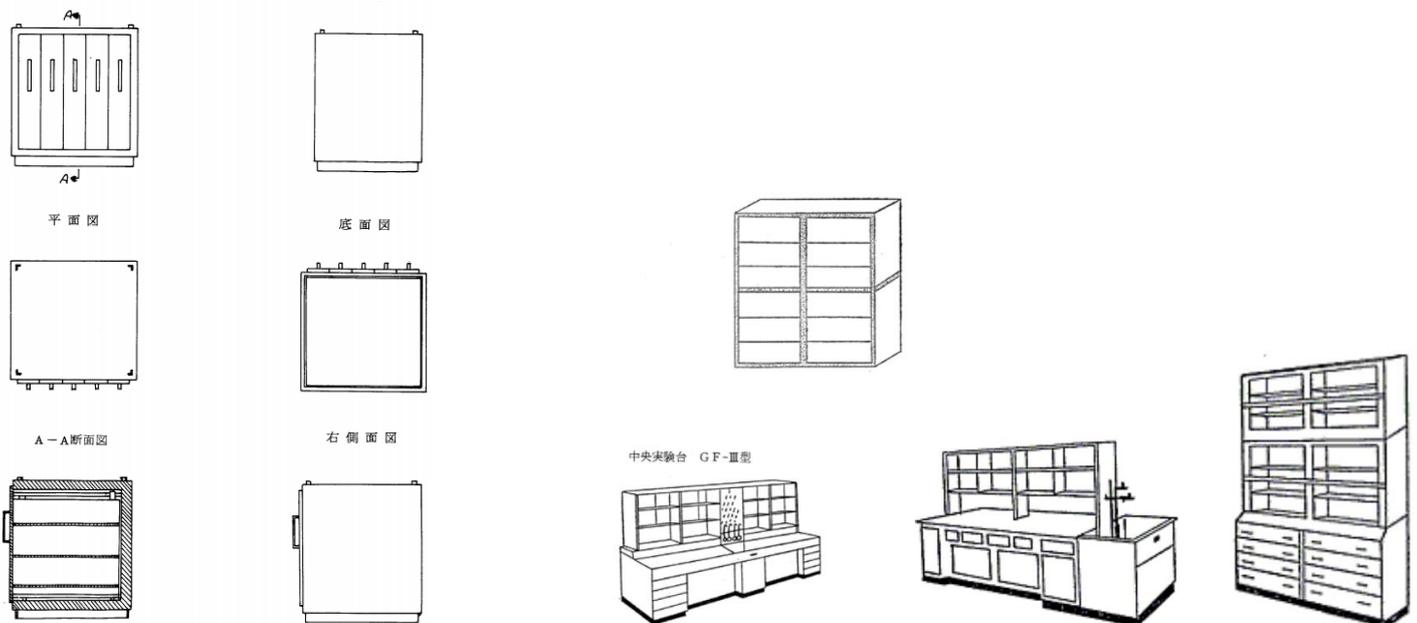
**(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost.)**

This case showed the general criterion on how to consider publicly-known designs when determining the main part of a registered design. (This criterion is still being followed by later court cases now.)

No special creativity or aesthetic value can be recognized in the basic shape of a registered design because publicly known designs having the same or very similar basic structure already exist.

Therefore, the essential part of the registered design is the shape and arrangement of the detail (handle of the front face of the mirror plate attached to the right basic shape, hook and other front shapes, the overall impression derived from the rectangular frame-shaped assembly structure of the cabinet body etc.)

Though the Defendant's design is the same in basic shape to the registered designs, it is not similar because there are significant differences in such detail (the framework of the cabinet body on other surfaces, excluding the bottom, and the shape of the nails and screws).



(The registered design)

(publicly known designs)

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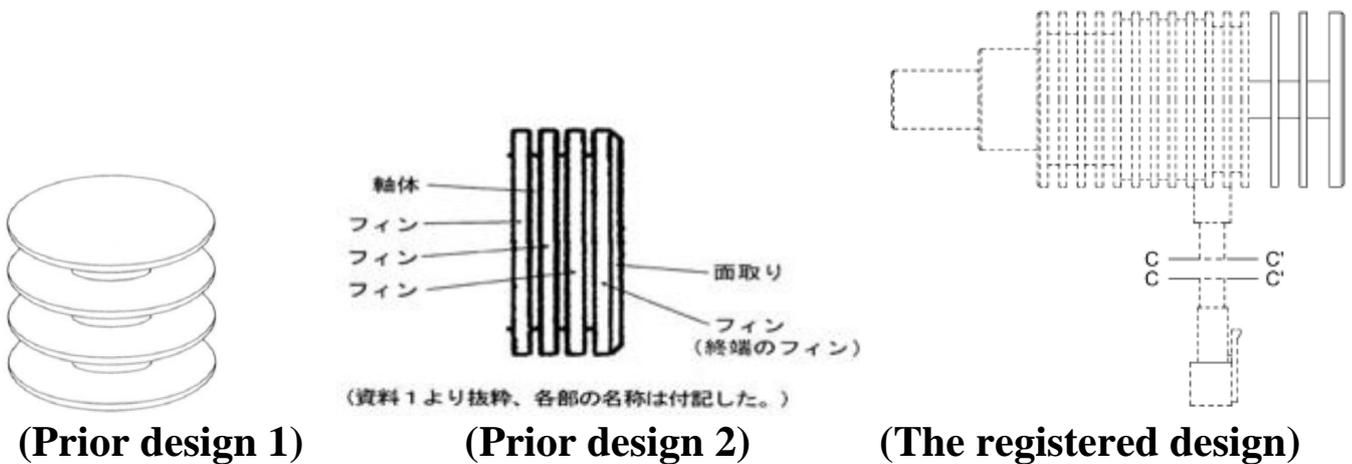
https://www.ip.courts.go.jp/app/files/hanrei_en/893/001893.pdf

Easiness to create the design

(Date) September 5, 2019

<Osaka High Court> 2018 (Ne) 2523
=<IP High Court> 2018 (Gyo-ke) 10181
"Inspection Lighting Apparatus" Case

(Conclusion) The registered design is not easy to create based on Prior designs. (Design right owner won.)



If a person skilled in the art can apply Prior design 2 to Prior design 1, the registered design can be reached.

However, as a premise that “motivation” is require to apply a Prior design to another Prior design even when considering easiness to create the design just like the logic to deny inventive step of a patent invention, in this judgement it was decided that there is no “motivation” to apply the lateral design type (Prior design 2) to the vertical design type (Prior design 1).

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https://www.ip.courts.go.jp/app/files/hanrei_en/806/002806.pdf

=<IP High Court> 2018 (Gyo-ke) 10181
https://www.ip.courts.go.jp/app/files/hanrei_en/473/002473.pdf

Similarity of design (Infringement case)

(Date) August 29, 2019

**<Osaka District Court> 2017 (Wa) 8272
"Flowing Somen Noodle Machine" Case**

**(Conclusion) Infringer's design is similar to the registered design.
(Design right owner won.)**



(The resistered design)



(Infringer's Flowing Somen Noodle Machine)

Before this application, a water-slider-type "Flowing Somen Noodle Machine" which also has a rotator in the center of the tray portion like a running-water-pool-type did not exist.

Therefore, the novel feature of the registered design was the combination of both water-slider-type and running-water-pool-type features.

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https://www.ip.courts.go.jp/app/files/hanrei_en/839/002839.pdf

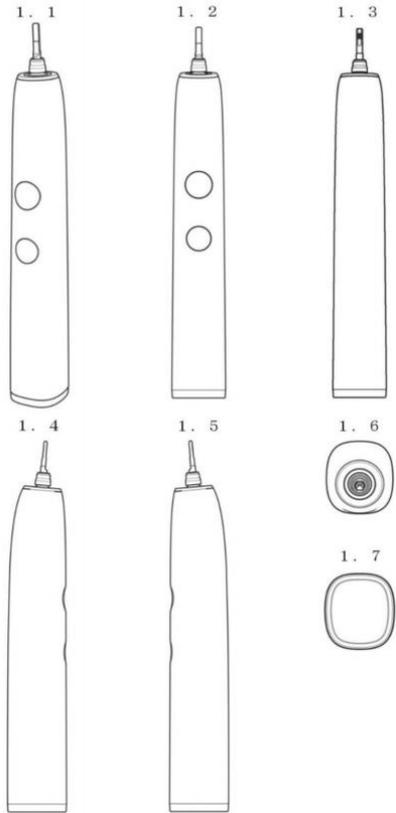
Novelty (related to Prior designs)

(Date) April 11, 2019

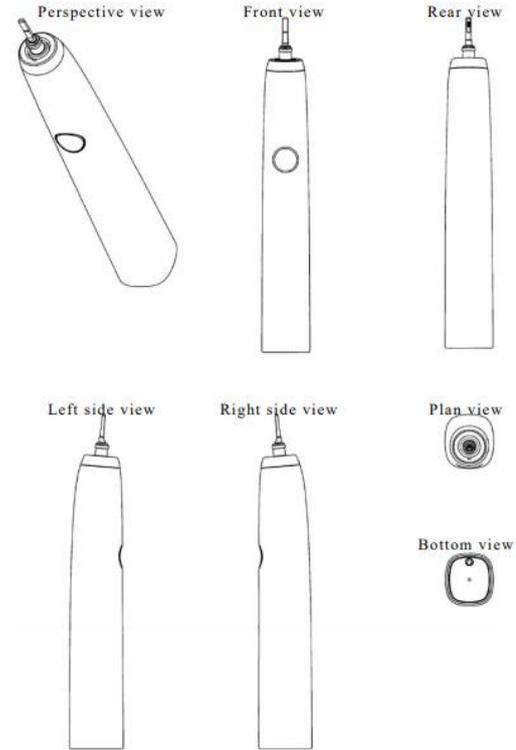
<IP High Court> 2018 (Gyo-ke) 10152

"Electric Toothbrush" Case

(Conclusion) Novelty should not be found. (Applicant lost.)



(The applied design)



(Attachment 3)

Drawings of Exhibit Ko 2

(Prior design)

General consumers, which are the main users of this designation, pay special attention to the overall shape of the gripping portion with emphasis on the easiness of gripping and operation.

Therefore, as the whole shape is common between the applied design and the Prior design, they are similar to each other.

Though the applicant asserted that the difference in the number of buttons formed on the front side of the main body (small circular parts) is the main portion, such difference was not deemed the main portion in view of the publicly known designs. (Applicant asserted common patterns between the applied design and the Prior design, but such assertion was rejected because not all of the common patterns were publicly known.)

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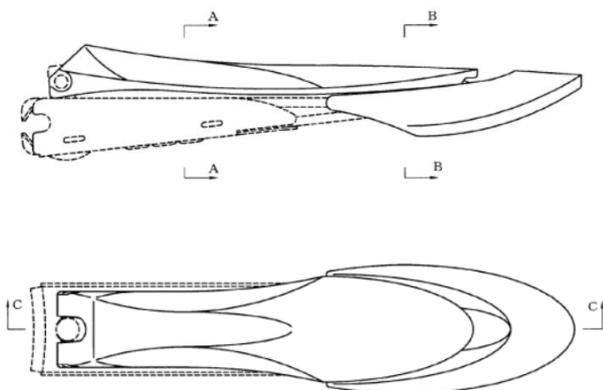
https://www.ip.courts.go.jp/app/files/hanrei_en/482/002482.pdf

Damages calculation (partial design)

(Date) March 28, 2019

**<Osaka District Court> 2017 (Wa) 5011
"Nail Clipper" Case**

(Conclusion) The damages were calculated at 28% (0.7×0.4) of the Infringer's profits.



(The resistered design)



(Infringer's nail clipper)

No dispute for infringement. (Design right owner won.)

The registered partial design (solid line portion) has a significant influence on the aesthetics of the entire nail clipper as it stands out when placing down or holding it.

Therefore, for calculating damages, the partial design contributes to 70% of the whole design.

In addition, as it is not often that an infringer's products are sold with an emphasis on design, the damages estimation should be further overturned (eliminated) 60%.

Consequently, the damages were calculated at 28% (0.7×0.4) of the Infringer's profits.

***This judgement includes another issue related to Unfair Competition Law.**

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https://www.ip.courts.go.jp/app/files/hanrei_en/834/002834.pdf

Prior Use Right (Design Act Article 29)

(Date) March 28, 2019

**<Osaka District Court> 2017 (Wa) 849
"Electronic Cigarette Case" Case**

(Conclusion) Prior use defense was affirmed. (Design right owner lost.)



(The resistered design)



(Defendant's Electronic Cigarette Case)

Defendant had ordered a third party to make a sample of the alleged Defendant's product before the date on which the design right owner's product was released.

Given this developmental status of the alleged Defendant's product, it can be said that the alleged Defendant created its own design without knowledge of the registered design.

Japanese Design Act, Article 29 (Non-exclusive license based on prior use)

A person who, without knowledge of a design in an application for design registration, created a design identical or similar to the said design, or a person who, without knowledge of a design in an application for design registration, learned of the design from a person who created a design identical or similar to the said design, and has been working the design or a design similar thereto or preparing for the working of the design or a design similar thereto in Japan at the time of the filing of the application for design registration (where the application for design registration is deemed to have been filed at the time of submission of the written amendment of proceedings under Article 9-2 or 17-3(1) (including the cases where it is applied mutatis mutandis pursuant to Article 50 (1) (including the cases where it is applied mutatis mutandis pursuant to Article 57 (1)), at the time of filing the original application or the written amendment of proceedings), shall have a non-exclusive license on the design right, only to the extent of the design and the purpose of such business worked or prepared.

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https://www.ip.courts.go.jp/app/files/hanrei_en/797/002797.pdf

Damages calculation (partial design)

(Date) December 20, 2018

**<Tokyo District Court> 2017 (Wa) 40178
"Eye Mask" Case**

**(Conclusion) Infringer's design is similar to the registered design.
(Design right owner won.)**



(The registered design)



(Infringer's eye mask)

Though the registered design and the infringer's eye mask have many common elements, these elements were shown in publicly known designs. Further, the different point between the registered design and the infringer's eye mask, "in the registered design, roughly spherical shapes exist also at the distal end of the string beads, and the beads of the distal end portions are passed through the string", was shown in publicly known designs. Therefore, as this part strongly attracts user's attention, this part is included in the main part of the registered design.

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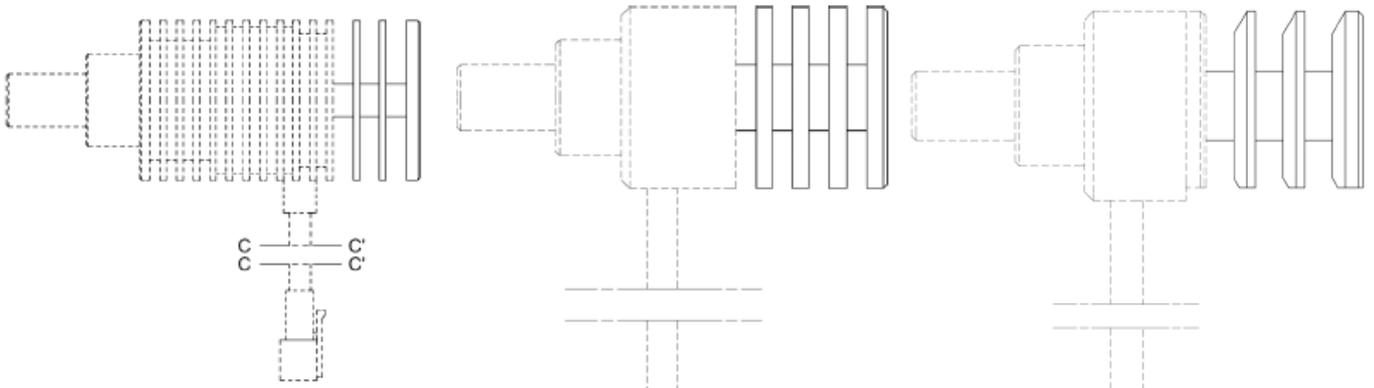
https://www.ip.courts.go.jp/app/files/hanrei_en/715/002715.pdf

Similarity of design (Infringement case)

(Date) November 6, 2018

<Osaka District Court> 2016 (Wa) 12791
"Lighting Equipment for Testing" Case

(Conclusion) Defendant's equipment 1 is similar to the registered design. (Design right owner won.) / Defendant's design 2 is not Similar to the registered design. (Design right owner lost.)



(The resistered design) (Defendant's equipment 1) (Defendant's equipment 2)

(Defendant's equipment 1)

When observing from the front or oblique front, a user does not recognize the existence of a screw hole.

Even when observing from the rear, a user only recognize it as a functional difference and does not recognize it as a difference in aesthetics.

(Defendant's equipment 2)

The fact that the outer peripheral surface is a flat surface with a part of the arc cut off gives a strong visual impression.

The large taper on the edge of the front surface of the fin also gives a strong visual impression.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/723/002723.pdf

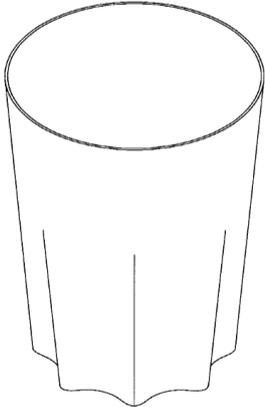
Damages calculation

(Date) October 18, 2018

<Osaka District Court> 2016 (Wa) 6539

"Trash Can" Case

(Conclusion) No dispute for infringement. (Design right owner won.)



(The resistered design)



(Infringer's Trash Can 2)



(Infringer's Trash Can 3)

The infringer's profit should be calculated on the basis of the actual sales amount even if the infringer sells at less than cost, unless the infringer's sales are substantially deemed as the disposal of the infringing products.

In order to obtain more damages, a design right holder can assert damages under Article 39 Paragraph 1.

Japanese Design Act, Article 39 (Presumption of Amount of Damage, etc.)

(1) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer assigned articles that composed the act of infringement, the amount of damages sustained by the holder of such design right or the exclusive licensee may be presumed to be the amount of profit per each unit of article which would have been sold by the holder of the design right or the exclusive licensee if there had been no such act of infringement, multiplied by the quantity (hereinafter referred to in this paragraph as the "assigned quantity" of articles) assigned by the infringer, the maximum of which shall be the amount attainable by the holder of the design right or the exclusive licensee in light of the capability of the holder of the design right or the exclusive licensee to work such articles; provided, however, that if any circumstances exist under which the holder of the design right or the exclusive licensee would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of articles not able to be sold due to such circumstances shall be deducted.

(2) Where a holder of design right or an exclusive licensee claims against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer shall be presumed to be the amount of damages sustained by the holder of the design right or exclusive licensee.

(3) A holder of a design right or an exclusive licensee may claim against an infringer compensation for damages sustained as a result of the intentional or negligent infringement of the design right or exclusive license, by regarding the amount the holder of the design right or exclusive licensee would have been entitled to receive for the working of the registered design or design similar thereto as the amount of damages sustained.

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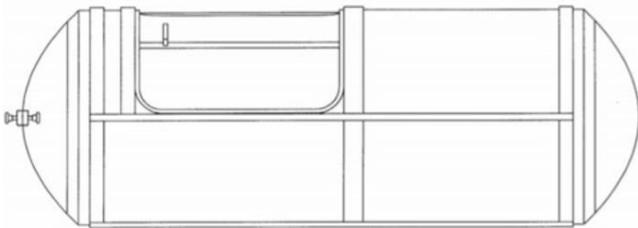
https://www.ip.courts.go.jp/app/files/hanrei_en/728/002728.pdf

Similarity of design (Infringement case)

(Date) September 21, 2018

**<Tokyo District Court> 2017 (Wa) 11295
"High-pressure Oxygen Capsule" Case**

**(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)**



(The resistered design)



(Defendant's high-pressure oxygen capsule)

It is emphasized in the [Explanation of Design] of the Publication of Registered Design that the door and both ends of the capsule are transparent and that it is possible to look into the bed inside.

The registered design gives a stronger impression to the viewer in that the shape of the components outside the article and the components inside the article together form an aesthetic feeling of the entire design, as well as give a brighter impression with a feeling of openness in comparison with the same kind of articles having no or few transparent parts.

Defendant's high-pressure oxygen capsule is opaque at both ends of the capsule, thus it was determined to be non-infringement.

⇒ non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

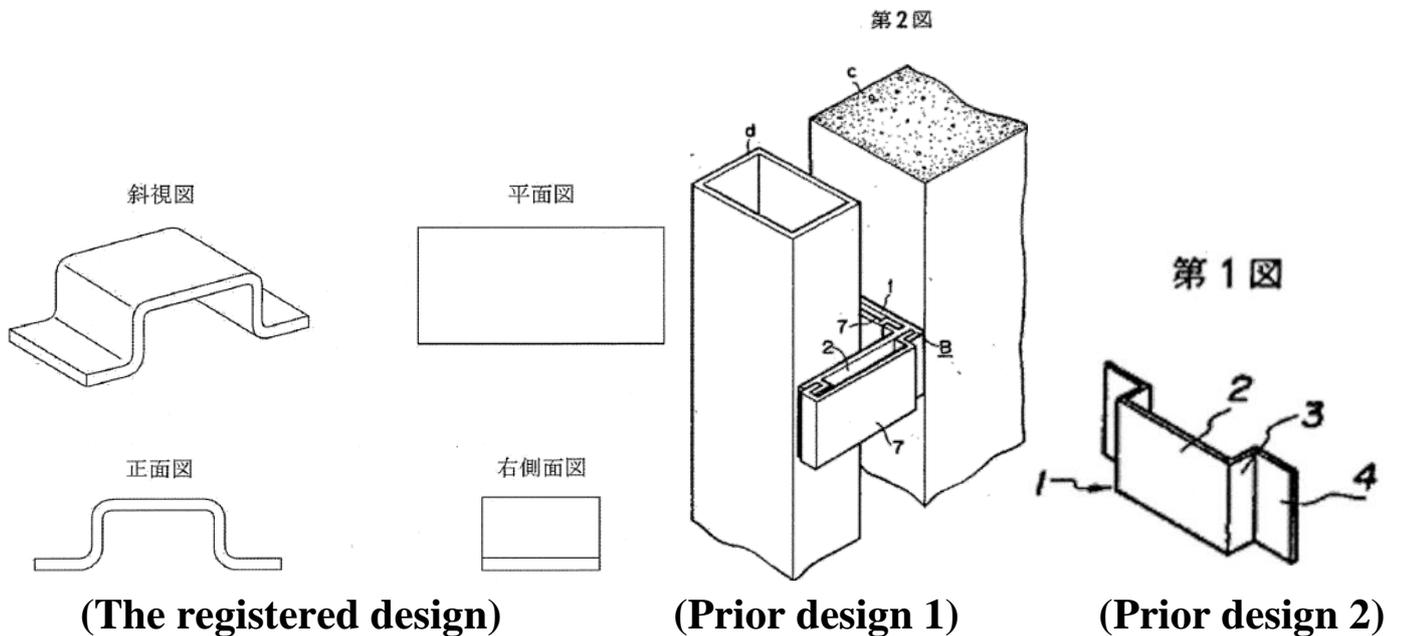
https://www.ip.courts.go.jp/app/files/hanrei_en/611/002611.pdf

Easiness to create the design

(Date) May 30, 2018

<IP High Court> 2018 (Gyo-Ke) 10009
"Bolt Cover for a Hollow Steel Pipe" Case

(Conclusion) The registered design was easy to create based on Prior designs. (Design right owner lost.)



The shape of the end of the **Prior design 1** is formed arbitrarily so as to mate with the opposite parts (the locking rib of the fixing plate).

Therefore, a person skilled in the art in the field of building parts easily change the shape of the end of the **Prior design 1** by applying the shape of the end of the **Prior design 2** to make the front view hat-shaped and the plan view horizontally rectangular plate-shaped so as to mate with the opposite parts (the locking rib of the fixing plate).

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https://www.ip.courts.go.jp/app/files/hanrei_en/313/002313.pdf

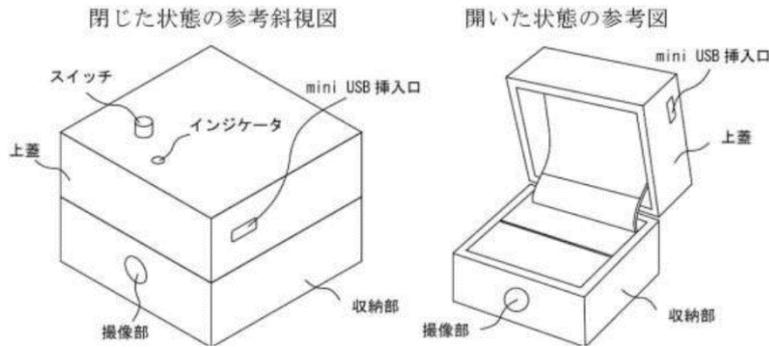
Easiness to create the design

(Date) March 12, 2018

<IP High Court> 2017 (Gyo-Ke) 10188

"Accessory Case Shaped Camera" Case

(Conclusion) The applied design was easy to create based on Prior designs. (Design right owner lost.)



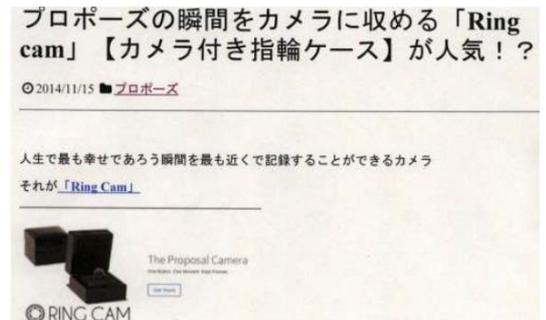
(The applied design)



(Prior design 1)



(Prior design 3)



(Prior design 4)

The applied design has a usage and function as an accessory case, and also has a usage and function as a concealed camera of photographing and recording so as not to be understood by the counterpart.

A person skilled in the art relating to the applied design is a person who has both ordinary knowledge in the field of accessory cases and hidden cameras.

In the **Prior design 1**, an imaging unit is provided on the upper lid portion so as to be suitable for the custom of the U.S.A. in which an accessory case is opened to show a ring and a proposal is made in a knee-stuck state.

Thus, there is a motivation to change the position of the imaging unit to be suitable for use with accessory cases in a different manner.

Accordingly, it was easily created by a person skilled in the art to change the imaging unit of **Prior design 1** from the upper lid to the storage unit with reference to **Prior design 3** and **Prior design 4** in which the imaging unit was installed in the storage unit.

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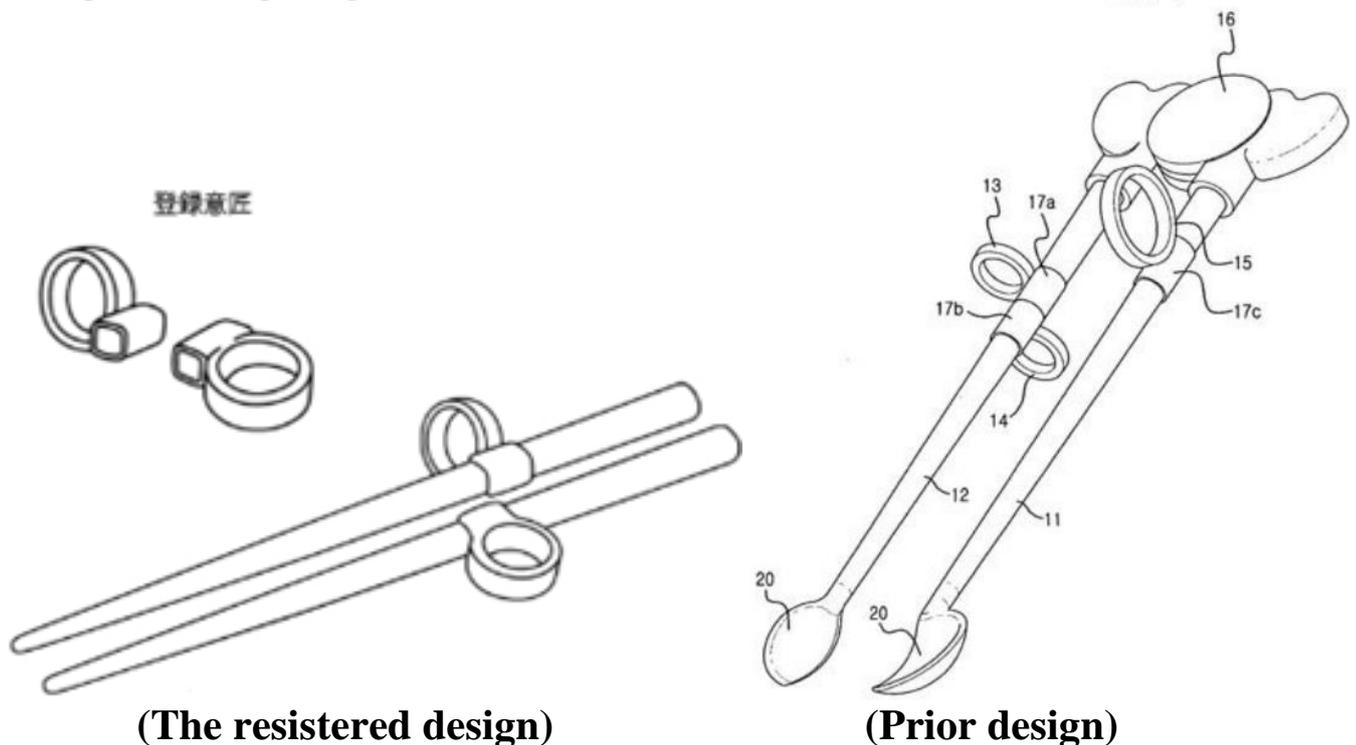
https://www.ip.courts.go.jp/app/files/hanrei_en/285/002285.pdf

Easiness to create the design

(Date) February 26, 2018

<IP High Court> 2017 (Gyo-Ke)10181
"Tool for Correcting how to hold Chopsticks" Case

(Conclusion) The registered design was easy to create based on Prior designs. (Design right owner lost.)



The registered design is composed of two parts (i) to be attached and detached to chopsticks for the purpose of training infants how to use chopsticks, and these two parts give (ii) an integral aesthetic feeling from a linear impression by part A and an inclined impression by part B.

The above (i) and (ii) together give newness and originality as a design, and it was not easily created by a person skilled in the art from the **Prior design to the resistered design.**

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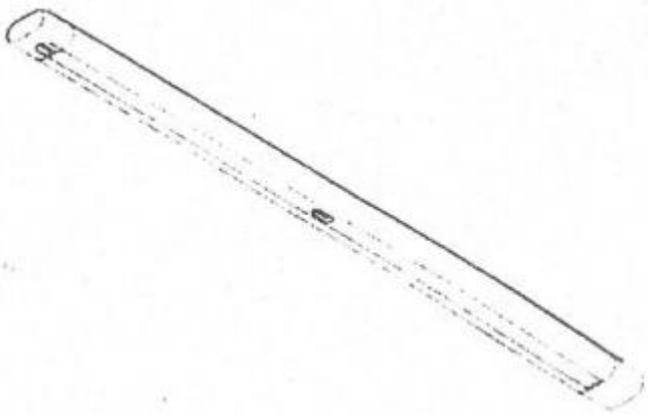
https://www.ip.courts.go.jp/app/files/hanrei_en/283/002283.pdf

Claim for the compensation for an employee design against company

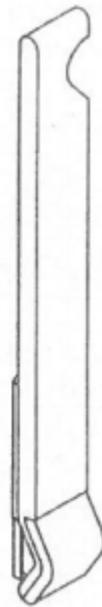
(Date) October 12, 2017

**<Osaka District Court> 2015 (Wa) 8271
"Clothes Drying Stand" Case**

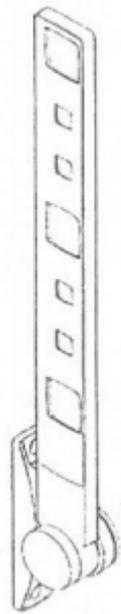
(Conclusion) The Plaintiff's claim was dismissed.



(The resistered design 1)



(2)



(3)

To be admitted as a co-creator of a registered design, it is not enough to simply provide an idea as an assistant or adviser, but it is required to be involved with the creation. In addition, the creation must be a level to contribute to make the design registered.

Plaintiff is not recognized as a co-creator of the registered designs.
It is not verified how Plaintiff contributed to the registered designs.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/516/002516.pdf

Eligibility of Design

(Date) May 30, 2017

<IP High Court> 2016 (Gyo-Ke) 10239
"Vehicle with an Imaging Device" Case

(Conclusion) The applied image is not a graphic image allowed in the **OLD** Japanese Design Act. (Design right owner lost.)



(The applied graphic image)



(Reference to show usage state)

A "graphic image ... for use in the operation of the article" (limited to the operations carried out in order to enable the article to perform its functions) refers to a graphic image in which a figure, etc. used for the operation of the article is displayed so that it can be selected or designated.

***NOTE: Under the revised Design Act in 2020, this design may be able to be registered as a "[a graphic image displayed on another article](#)".**

Design Act ([Revised in 2020](#))

Article 2 (1) "Design" in this Act shall mean the shape, patterns or colors, or any combination thereof, of an article (including a part of an article, the same shall apply hereinafter except in Article 8), which creates an aesthetic impression through the eye.

(2) The shape, patterns or colors, or any combination thereof, of a part of an article as used in the preceding paragraph shall include those in [a graphic image on a screen](#) that is provided for use in the [operation of the article \(limited to the operations carried out in order to enable the article to perform its functions\)](#) and is [displayed on](#) the article itself or [another article](#) that is used with the article in an integrated manner.

Examination Guidelines for **Design** | Japan Patent Office

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https://www.ip.courts.go.jp/app/files/hanrei_en/315/002315.pdf

Similarity of design (Infringement case)

(Date) January 31, 2017

<Tokyo District Court> 2016 (Wa) 13870
"Wheeled Platform" Case

(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)



(The resistered design)



(Defendant's Wheeled platform)

Regardless of the presence or lack of Push Bars, the resistered design and Defendant's Wheeled plat are not similar, because, when seen in its entirety, there is a different aesthetic impression from these two designs.

⇒ non-infringement

(+Indirect infringement was also denied.)

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

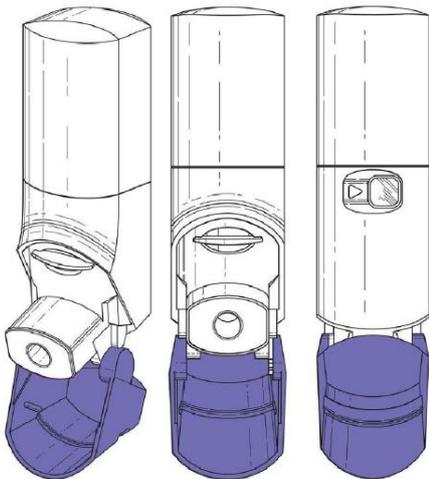
https://www.ip.courts.go.jp/app/files/hanrei_en/444/002444.pdf

Novelty (related to Prior designs)

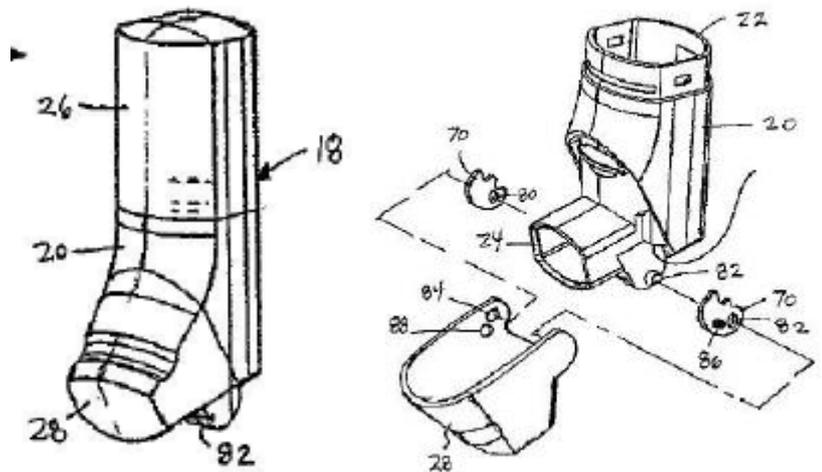
(Date) November 30, 2016

<IP High Court> 2016 (Gyo-Ke) 10121
"Inhaler" Case

(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)



(The applied design)



(Prior design)

At the end of the mouthpiece portion of the applied design, the circular hole is formed in the center, combined with that the mouthpiece cover portion is transparent. As a result, this portion attracts the user's attention and gives a strong impression.

⇒ The description that a part of a design is "transparent" affects aesthetics.

<Ref.> Obligation to indicate "transparent" (Design ACT Article 6-7)

"Where the applicant submits the drawing depicting the design under paragraph (1) or the photograph or model representing the design under paragraph (2), if the whole or part of the article to the design is transparent, the applicant shall state thereof in the application."

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/128/002128.pdf

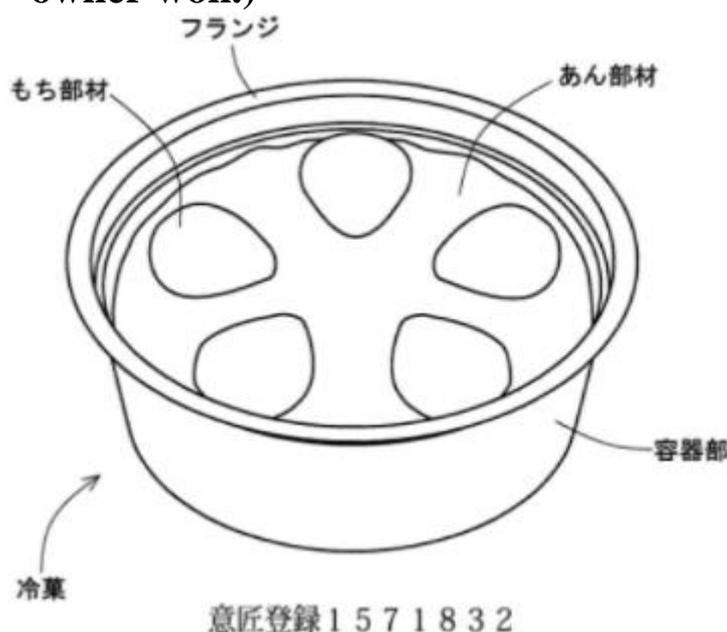
“One application per design” (Design Act Article 7)

(Date) September 21, 2016

<IP High Court> 2016 (Gyo-Ke) 10034

"Frozen Dessert with Cap" Case

(Conclusion) Admitted as “One application per design” (Design right owner won.)



(The resistered design)



(Real product)

In order to comply with the requirements of Design Act Article 7 (“One application per design”), the design must be one product in one form.

"Frozen dessert with Cap" is considered to be composed mainly of "Frozen dessert" and accompanied by "Cap" from its name.

In every stage of manufacture, distribution, and use, the "Frozen dessert" is an integral condition that is filled into "Cap" and cooled or consolidated.

It is not easy to separate the "Frozen dessert" from the "Cap" by keeping the shape. Moreover, "Frozen dessert" is not traded normally independently of "Cap".

Considering these overall considerations, "Frozen dessert with Cap" is, in social common sense, considered to be an product having one particular application and function, and the "Frozen dessert" does not have an application and function independently from the part of "Cap."

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

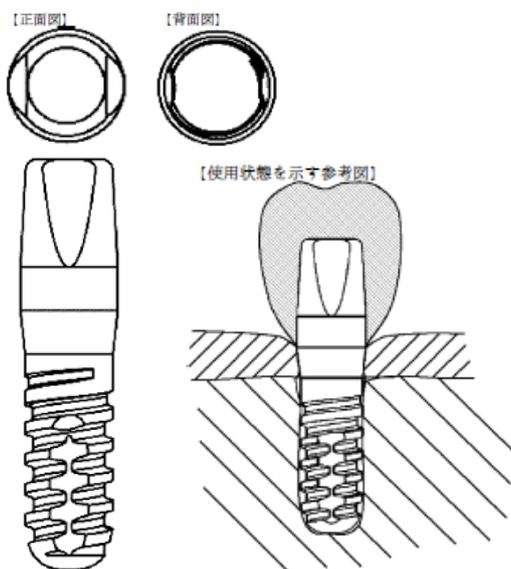
https://www.ip.courts.go.jp/app/files/hanrei_en/123/002123.pdf

Similarity of design (Infringement case)

(Date) May 29, 2014

<Tokyo District Court> 2013(Wa)6920
"Dental Implant" Case

(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)



(The resistered design)



(Defendant's Dental implant)

*This judgment indicated the logic how to identify the "essential part of the design" in a registered design right.

Considering nature, purpose, application, function, and usage of the dental implant, the essential part of the registered design is the part that attracts the attention of the user (dentist).

They are not similar in the identified essential part.

⇒ non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/573/001573.pdf

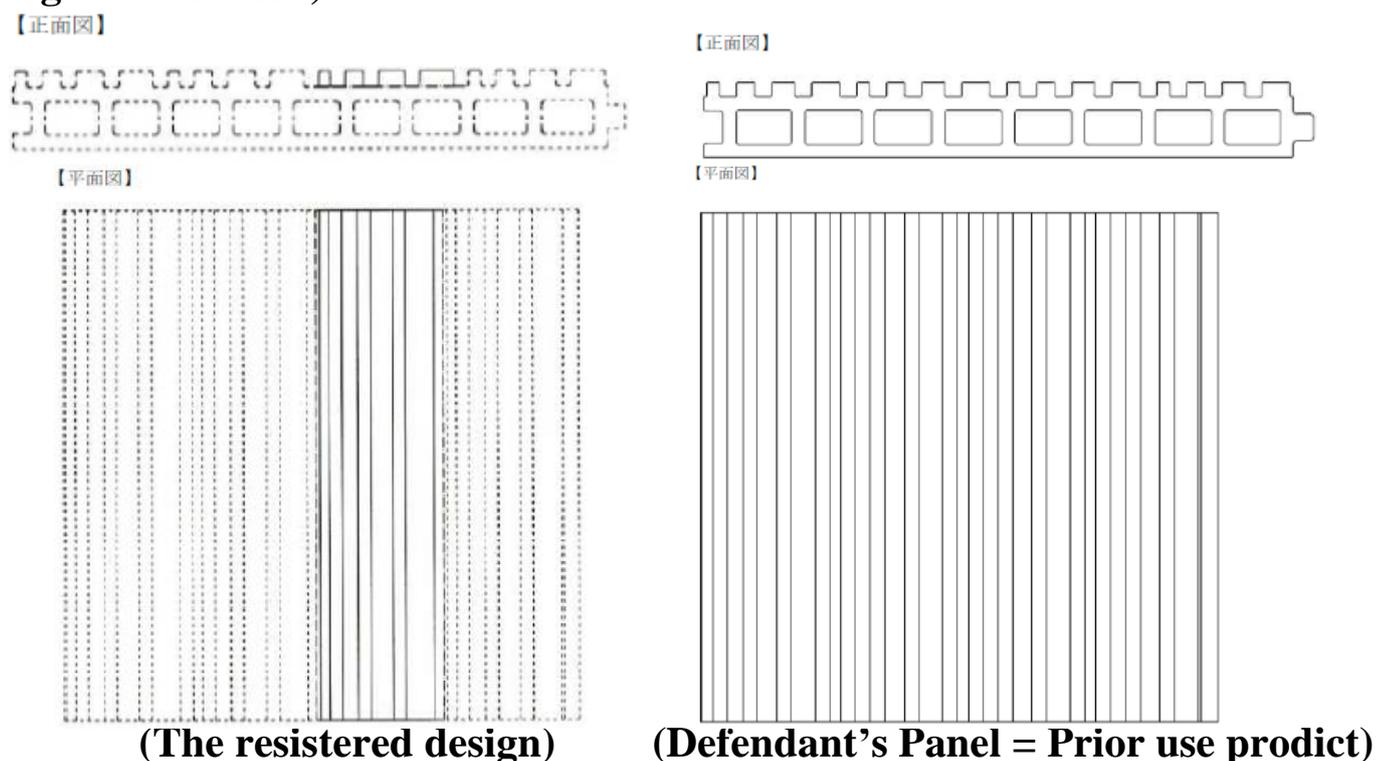
Prior Use Right (Design Act Article 29)

(Date) April 21, 2014

<Osaka District Court> 2013 (Wa) 2462

"Panel for Construction Use" Case

(Conclusion) Prior use right was admitted for a partial design . (Design right owner lost.)



Defendant ordered and received the manufacture of the parts (mouthpiece) of the Defendant's Panel and manufactured/sold it afterward.

Therefore, at the latest on the date of receipt of the parts (mouthpiece), Defendant had an intention of immediate working of it and the intention was expressed to the extent to be objectively recognized.

⇒ non-infringement

(Non-exclusive license based on prior use)

Article 29 A person who, without knowledge of a design in an application for design registration, created a design identical or similar to the said design, or a person who, without knowledge of a design in an application for design registration, learned of the design from a person who created a design identical or similar to the said design, and has been working the design or a design similar thereto or preparing for the working of the design or a design similar thereto in Japan at the time of the filing of the application for design registration (where the application for design registration is deemed to have been filed at the time of submission of the written amendment of proceedings under Article 9-2 or 17-3(1) (including the cases where it is applied mutatis mutandis pursuant to Article 50 (1) (including the cases where it is applied mutatis mutandis pursuant to Article 57 (1)), at the time of filing the original application or the written amendment of proceedings), shall have a non-exclusive license on the design right, only to the extent of the design and the purpose of such business worked or prepared.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

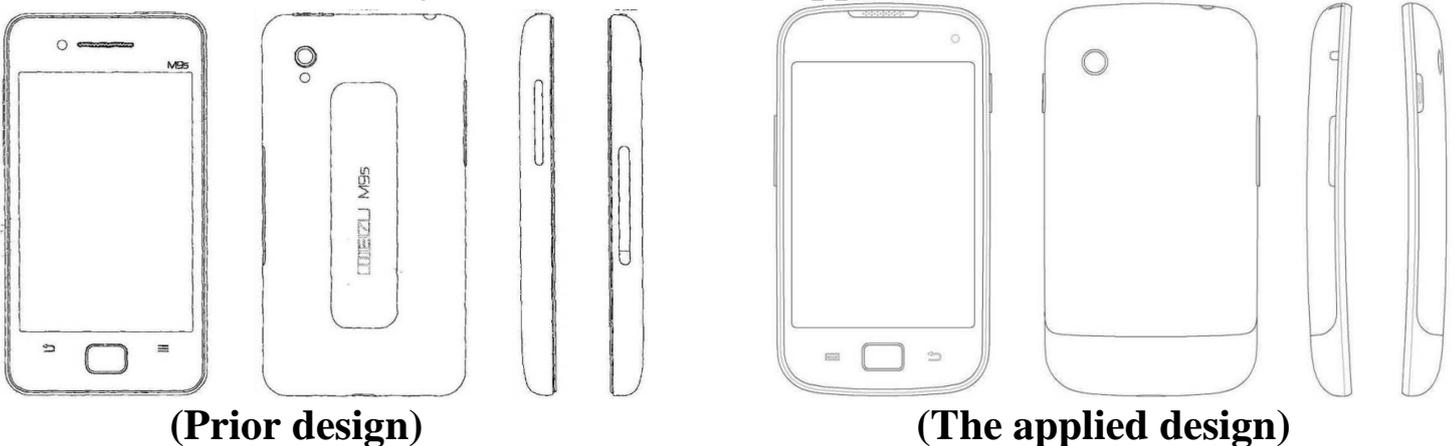
https://www.ip.courts.go.jp/app/files/hanrei_en/420/001420.pdf

Novelty (related to Prior designs)

(Date) March 27, 2014

<IP High Court> 2013 (Gyo-Ke) 10287
"Cell Phone" Case

(Conclusion) Novelty should be found. (Applicant won.)



The applied design gives a generally rounded, soft impression.
On the other hand, the Prior design gives a sharper and flatter impression as a whole compared with the applied design.
⇒ Not similar.

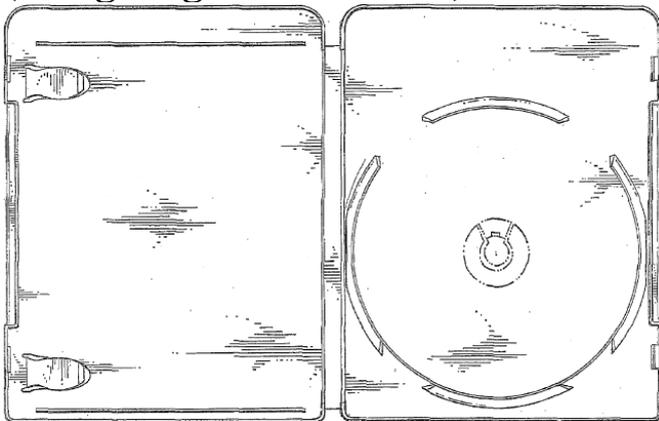
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/107/001107.pdf

Similarity of design (Infringement case)

(Date) January 23, 2014

**<Tokyo District Court> 2013 (Wa) 12233
"Package for Disc Packaging" Case**

**(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)**



(The resistered design)



(Defendant's Package)

Because all parts other than the number of the bank-shaped support were publicly known, this number is the essential part of the registered design.

The resistered design has 4 bank-shaped support.
The Defendant's Package has 6 bank-shaped support.
⇒ non-infringement

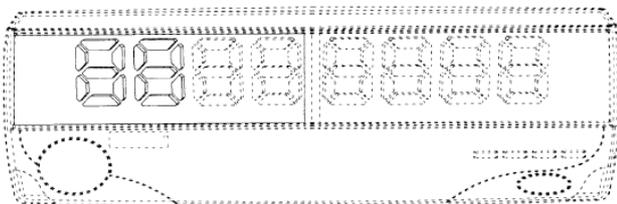
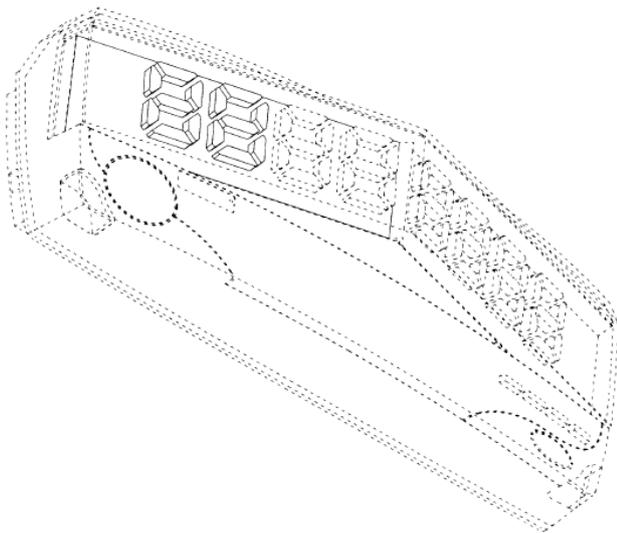
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/170/001170.pdf

Similarity of design (Infringement case) (Partial Design right)

(Date) September 26, 2013

**<Osaka District Court> 2011 (Wa) 14336
"Indicator Light for Game Machines" Case**

**(Conclusion) Defendant's design is similar to the registered design.
(Design right owner won.)**



(The resistered (partial) design)



(Defendant's Indicator light)

The Design right holder had many partial design rights for "Indicator light for game machines," and enforced several ones of them.

Other designs were judged invalid, but this resistered (partial) design was admitted valid and also admitted to be similar in the part resistered.

The Design right holder's strategy to have many partial design rights was successful.

⇒Infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

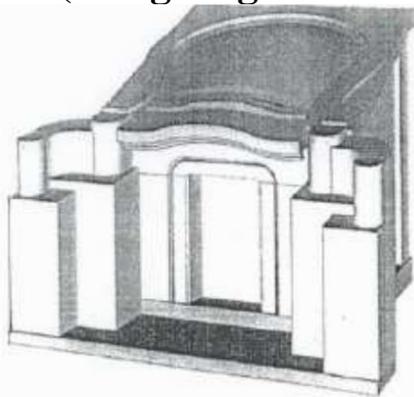
https://www.ip.courts.go.jp/app/files/hanrei_en/037/001037.pdf

Similarity of design (Infringement case)

(Date) August 22, 2013

**<Osaka District Court> 2012 (Wa) 6771
"Tomb" Case**

**(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)**



(The resistered design)



(Defendant's Tomb)



(Prior design)

Defendant's tomb and the registered design are different in the essential part and rectangular portion.

The parts in which they are similar was generally equipped for publicly known Turtleback tombs.

⇒Non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

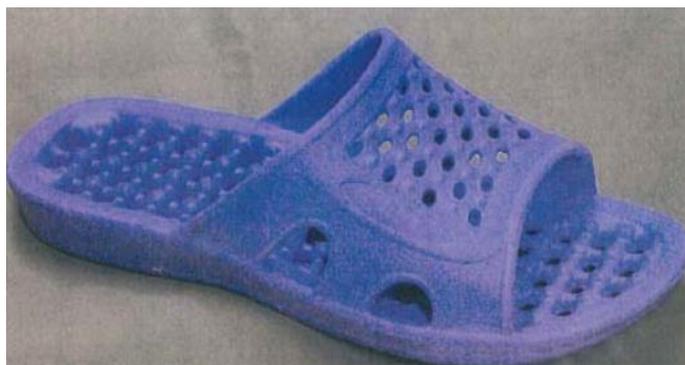
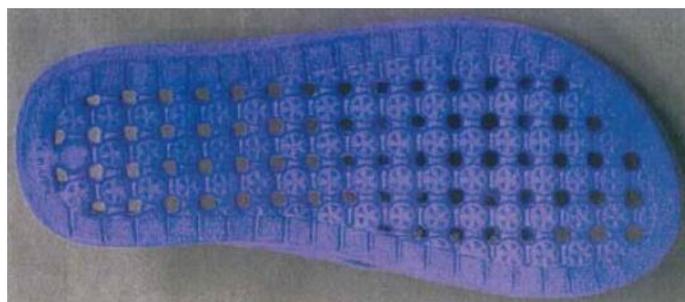
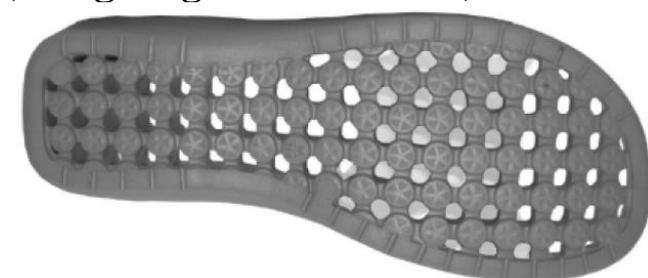
https://www.ip.courts.go.jp/app/files/hanrei_en/042/001042.pdf

Similarity of design (Infringement case)

(Date) April 19, 2013

<Tokyo District Court> 2012 (Wa) 3162
"Sandal" Case

(Conclusion) Defendant's design is similar to the registered design.
(Design right owner won.)



(The resistered design)

(Defendant's Sandal)

<Difference Point 1 (color)> The registered designs does not limit the color.
<Difference point 2 (number of disc-shaped members)> The number of rows in the vertical and horizontal are the same. Only the difference is the number in the interior of the column, and difference of the number is small.
<Difference point 3 (the number of grooves on the bottom and the presence of grooves in the area where the tread is not stepped on)> It is a typical pattern, which is not so different as to attract the attention of the viewer.
⇒Infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

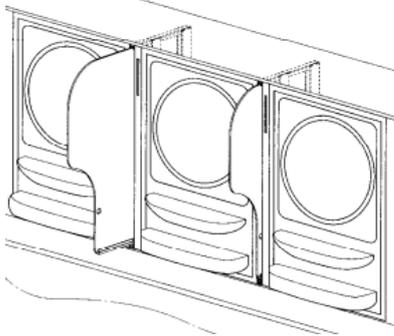
https://www.ip.courts.go.jp/app/files/hanrei_en/042/001042.pdf

Similarity of design (Infringement case)

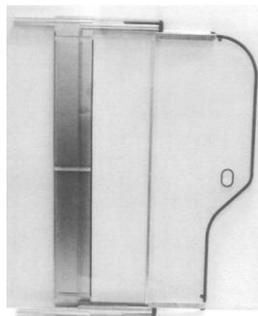
(Date) March 7, 2013

<Osaka District Court> 2012 (Wa) 4224
= <Osaka High Court> 2013 (Ne) 1136
"Slot Machine Partition" Case

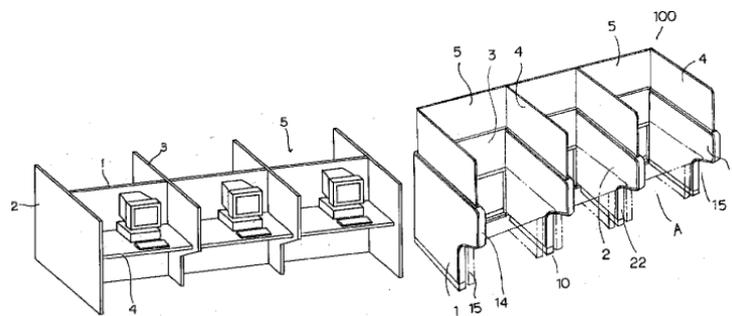
(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)



(The resistered design)



(Defendant's partition)



(Prior designs)

Even if a registered design contains the same components as those of Prior design, it should not immediately be interpreted as not becoming a essential part of the registered design, because that part may attract the attention of users.

Prior designs aim to maintain privacy.

The registered design, contrary to the maintenance of privacy, try to realize a good prospect.

As the registered design and Prior designs are different in use and function, these Prior designs should not be considered in examining the essential part of the registered design.

⇒ non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

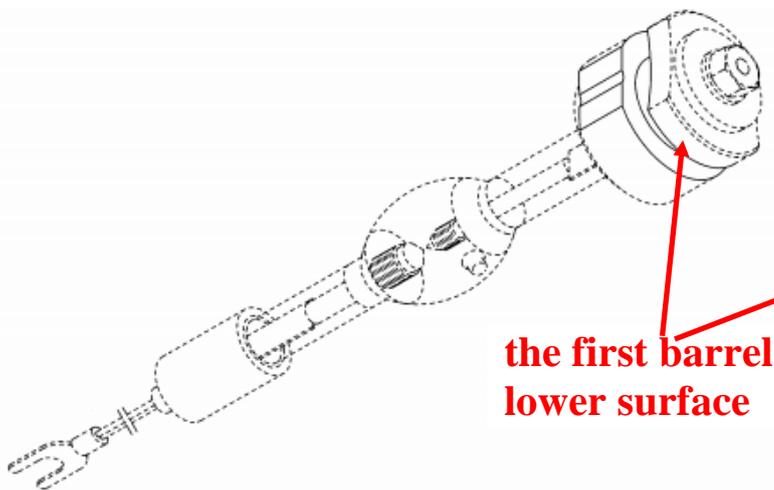
https://www.ip.courts.go.jp/app/files/hanrei_en/851/000851.pdf

Similarity of design (Infringement case)

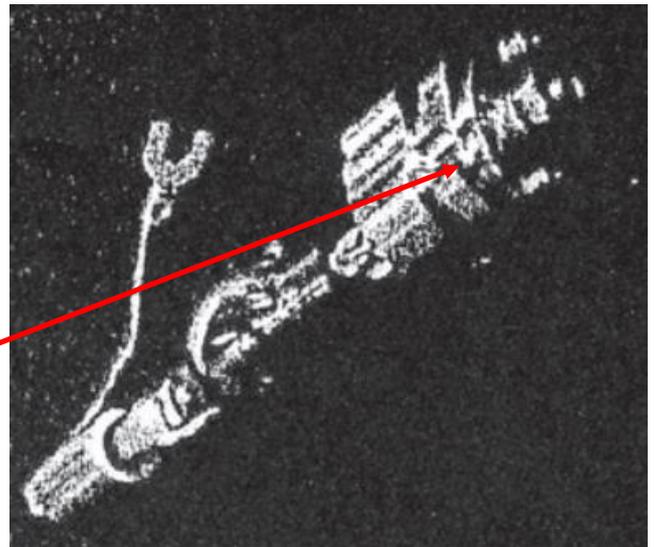
(Date) January 22, 2013

<Osaka District Court> 2011 (Wa) 529
"Discharge Lamp" Case

(Conclusion) Defendant's design is not Similar to the registered design.
(Design right owner lost.)



(The resistered design)



(Defendant's Discharge lamp)

The registered design intensifies the regular and static impression because the first barrel lower surface is line symmetric.

On the other hand, Defendant's Discharge lamp intensifies the irregular and dynamical impression because the first barrel lower surface is not line-symmetric.

⇒ non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

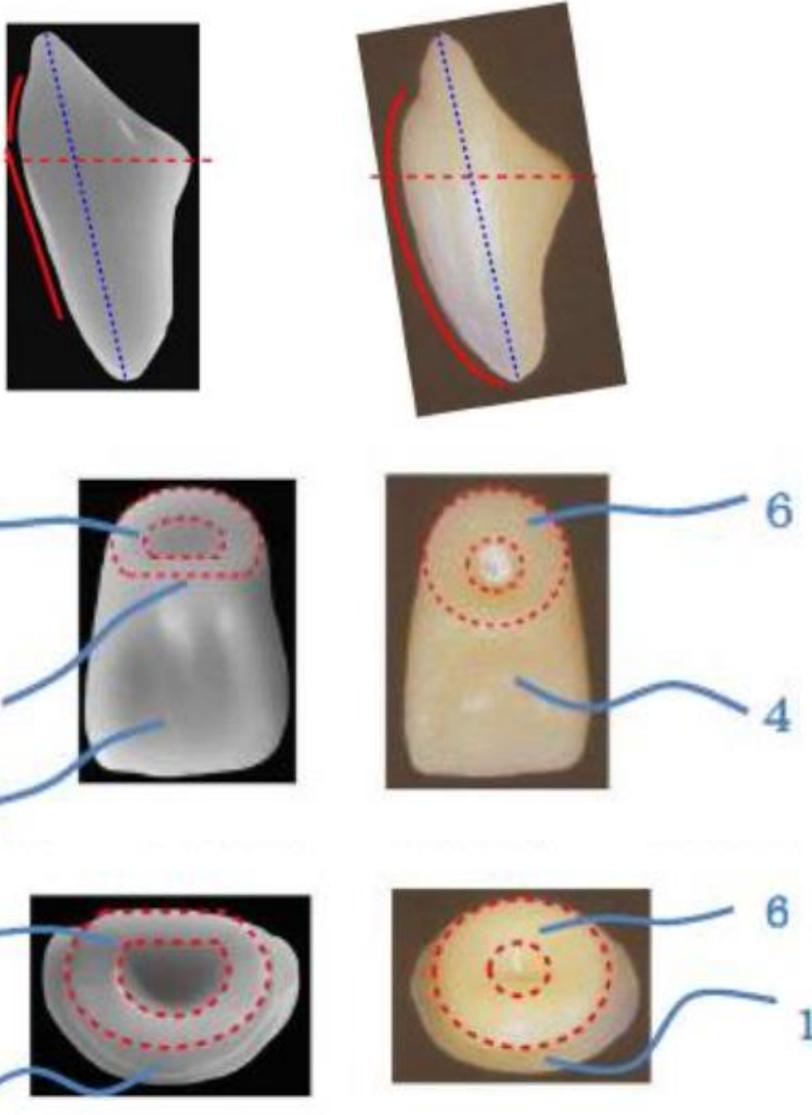
https://www.ip.courts.go.jp/app/files/hanrei_en/803/000803.pdf

Novelty (related to Prior designs)

(Date) November 26, 2012

**<IP High Court> 2012 (Gyo-ke) 10105, 10106, 10107, 10108, 10109, 10110
"Artificial Tooth" Case**

(Conclusion) Novelty should be found. (Design right owner won.)



(The applied design) (Prior design)

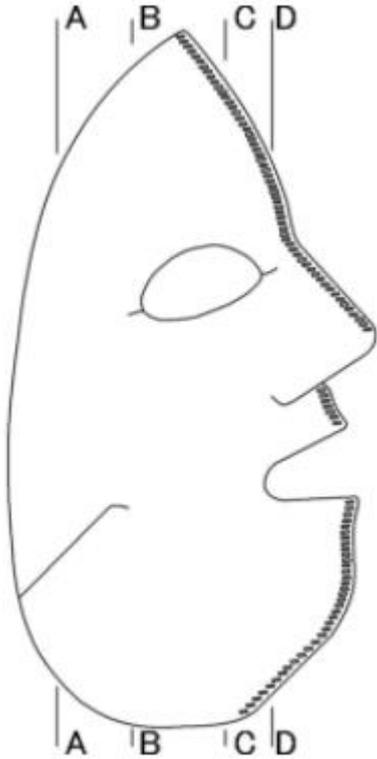
Since the consumers of artificial teeth are specialists like dentists, and they select artificial teeth by noticing the difference in small form, such a small difference should be also recognized by them. ⇒Not similar.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/720/000720.pdf

Damages calculation (partial design)

(Date) November 8, 2012

<Osaka District Court> 2011 (Wa) 3361
"Cubic Face Mask" Case



(The resistered design)



(Defendant's Cubic face mask)

- (1) Average royalty rate for textile products is 6.1%.
 - (2) Plaintiff invested time and effort in developing this design.
 - (3) This design contributed considerably to the sales of the Defendant's products.
 - (4) There is a perfect competitive relationship between Plaintiff and Defendant, as a result, it was not assumed that Plaintiff granted Defendant a license at an average rate.
- ⇒ The royalty rate is 15% (Admitted around 1million yen)

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

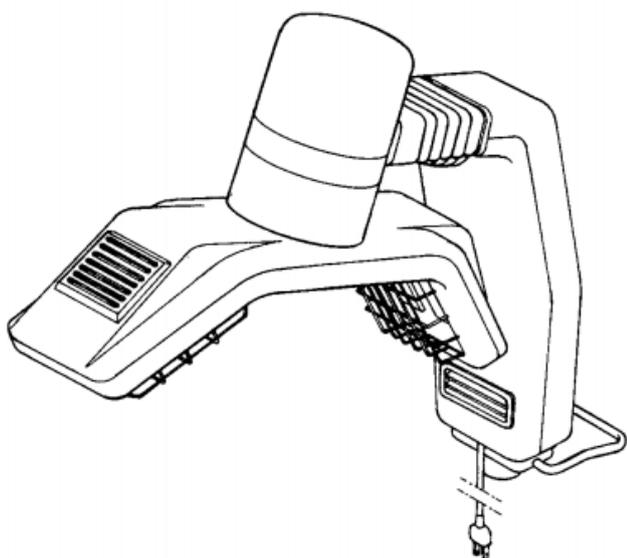
https://www.ip.courts.go.jp/app/files/hanrei_en/766/001766.pdf

Similarity of design (Infringement case)

(Date) September 20, 2012

<Osaka District Court> 2010 (Wa) 16066
"Hair Dryer" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The resistered design)



(Defendant's Hair dryer)

Although the registered design and Defendant's Hair dryer have a common pattern in the shape of the shaded portion, the essential part of the registered design is not limited to the shape of the shaded portion, and the difference in the impression brought about by other differences is large.

Furthermore, even if looking at the concrete shape of the shaded portion, the registered design gives a more angular impression in a substantially rectangular shape, whereas Defendant's Hair dryer gives a more rounded impression in a substantially oval shape shape, giving a different impression.

⇒ Non-infringement

*This judgement incudes another issue related to Unfair Competition Law.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

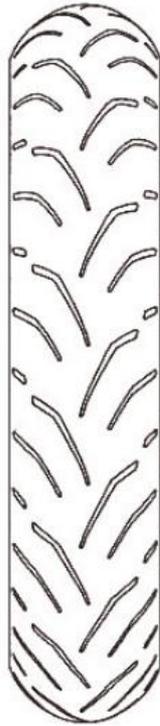
https://www.ip.courts.go.jp/app/files/hanrei_en/762/001762.pdf

Novelty (related to Prior designs)

(Date) July 18, 2012

**<IP High Court> 2012 (Gyo-ke) 10042
"Tires for two-wheeled vehicles" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

The three grooves in the applied design have straight edges, and the width of the grooves tapers toward the ends. This gives the viewer an aesthetic impression that the grooves are composed of thin straight lines with a sharp point at one end, which is inorganic and very clean, and gives the impression of flowing from the sidewall to the equator. On the other hand, the three grooves of the prior design, combined with the fact that there is basically no change in the width of the grooves as a whole, give the viewer the impression that the grooves of the same width are curved and twisted, or, to put it another way, give the viewer the impression that cylindrical bacteria or cells with rounded tips are arranged in an unorganized manner.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

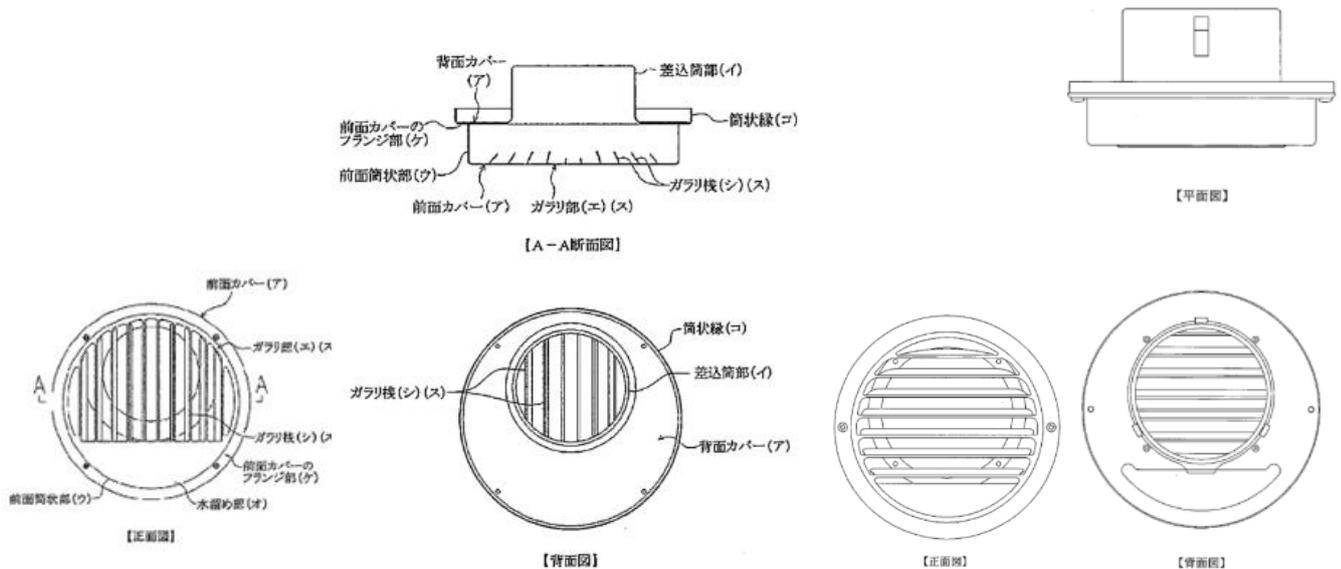
https://www.ip.courts.go.jp/app/files/hanrei_en/699/000699.pdf

Similarity of design (Infringement case)

(Date) June 28, 2012

<Tokyo District Court> 2011 (Wa) 10705
"Ventilation opening" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The registered design)

(Defendant's Ventilation opening)

All of the essential parts, i.e., (1) the ratio of the rattle part to the water reservoir part is approximately 7 to 3 in the registered design, whereas it is approximately 8 to 2 in the Defendant's Ventilation opening; (2) the designs have a vertical rattle consisting of 10 rattle piers, whereas the accused design has a horizontal rattle consisting of 7 rattle piers; and (3) the water reservoir part, which is in the shape of a semicircle (bow), is formed on the same plane as the rest of the front end of the front cylindrical part in the designs. (3) The water reservoir is formed on the same plane as other parts of the front end surface of the front cylindrical part in the designs in question, while it is formed slightly protruding forward from other parts of the front end surface of the front cylindrical part in the defendant's design. The common points do not outweigh the differences in aesthetics.

⇒ Non-infringement

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/747/001747.pdf

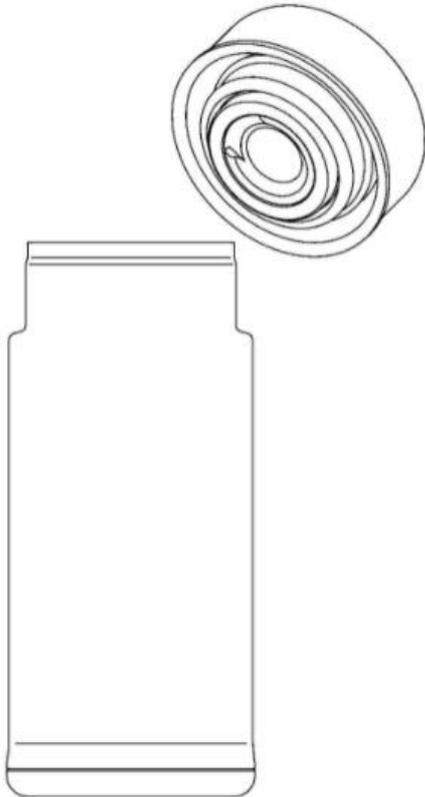
Similarity of design (Infringement case)

(Date) June 21, 2012

**<Osaka District Court> 2011 (Wa) 9600
"Portable thermos" Case**

**(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)**

⇒Appeal Court<Osaka High Court> 2012 (Ne) 2216 judged the same.



(The resistered design)



(Defendant's Portable thermos)

The plaintiff asserts that the fact that the defendant's design has almost no unevenness on the sides does not make the two designs completely different from each other when viewed as a whole. However, since it is known that the overall shape of portable vacuum flask is cylindrical and consists of a body and a cap, the uneven parts on the other sides should also attract the attention of consumers.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

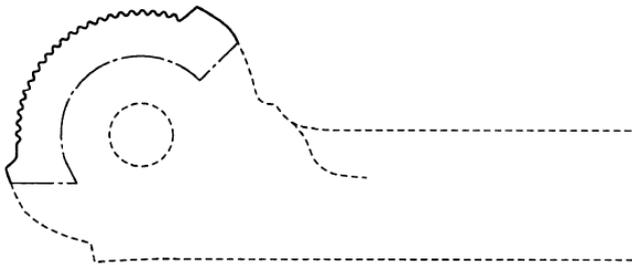
https://www.ip.courts.go.jp/app/files/hanrei_en/759/001759.pdf

Similarity of design (Infringement case)

(Date) May 24, 2012

**<Osaka District Court> 2011 (Wa) 9476
"Angle adjuster" Case (Partial Design)**

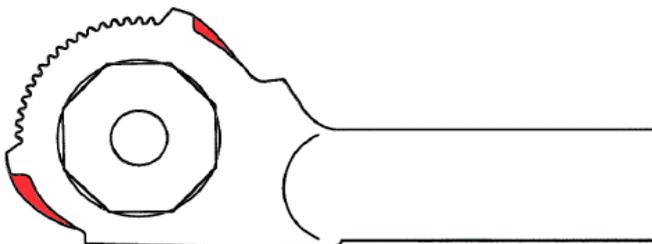
(Conclusion) Defendant's designs 2-1 and 2-2 are similar to the registered design. (Design right owner won) / Defendant's design 2-3 is not similar to the registered design. (Design right owner lost)



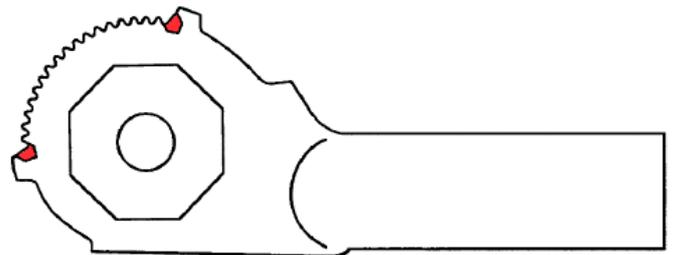
(The resistered design)



(Defendant's Angle adjuster 2-1)



(Defendant's Angle adjuster 2-2)



(Defendant's Angle adjuster 2-3)

(*The red parts were eliminated from the Defendant's Angle adjuster 2-1)

(1) Defendant's Angle adjuster 2-1 is similar.

(2) Defendant's Angle adjuster 2-2 is similar. (The red-colored portion is outside the scope of the partial design in the resistered design.)

(3) Defendant's Angle adjuster 2-3 is not similar. (The red-colored portion is within the scope of the partial design in the resistered design.)

*This judgement incudes another issue related to the Converted Application from the patent application to the design application.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

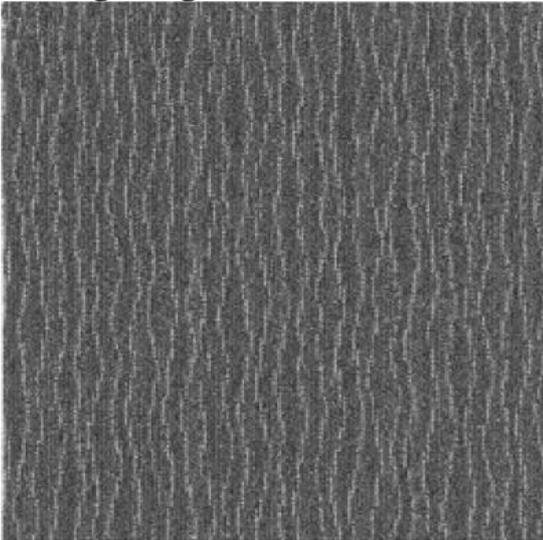
https://www.ip.courts.go.jp/app/files/hanrei_en/777/001777.pdf

Similarity of design (Infringement case)

(Date) March 15, 2012

**<Osaka District Court> 2010 (Wa) 805
"Tile carpet" Case**

**(Conclusion) Defendant's design is similar to the registered design.
(Design right owner won)**



(The resistered design [Magnified 150 times])



(Defendant's Tile carpet)

Carpet tile is an interior product that is laid on the floor for interior decoration. For this reason, in the course of transactions, differences in patterns, textures, colors, etc. are emphasized in catalogs etc. by showing small pieces of actual products (samples), photographs, images, etc. so that customers can compare and examine many products of various designs. Consumers pay attention to the atmosphere of the room when the product is actually used. It can be said that consumers place importance on not only the overall design of each product that distinguishes it from other products, but also the impression they receive when multiple sheets are combined and spread out on the floor. The consumer will recognize that there is no difference in aesthetics in the actual state of use.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/773/001773.pdf

Damages calculation (Article 39(2) and Article 39(3))

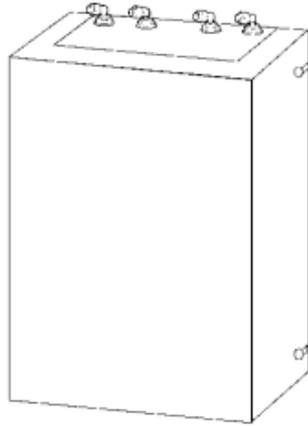
(Date) December 15, 2011

<Osaka District Court> 2010 (Wa) 13746

"Water cleaner" Case

(Conclusion) Defendant's design is not similar to the registered design.

(Design right owner lost)



(The resistered design)



(Defendant's Water cleaner)

*The design of Defendant's Water cleaner and the resistered design are identical, and there was no dispute.

Article 39(2) of the Design Act (lost profits based on an infringer's profit)

Since the product is an under-sink type and is usually installed in a place where it cannot be seen, the design does not contribute much to the sales.

⇒"Contribution ratio of the design" was judged 10%.

Article 39(3) of the Design Act (reasonable license fee)

(1) The product is a piece of standard equipment and it was necessary to deliver the same product as the plaintiff.

(2) The water purifier was adopted because it was a reverse osmosis membrane water purifier, and the design was not focused on.

(3) Since the product is an under-sink type of product and is usually installed in a place where it cannot be seen, the design does not contribute much to the sales.

⇒The reasonable royalty rate was judged 2%.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

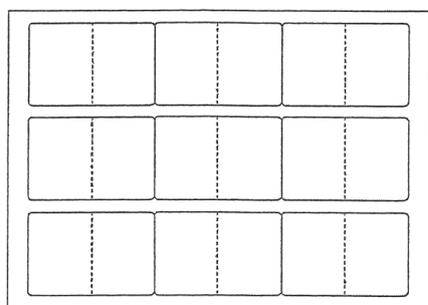
https://www.ip.courts.go.jp/app/files/hanrei_en/618/001618.pdf

Easiness of Creation (Article 3(2) of the Design Act)

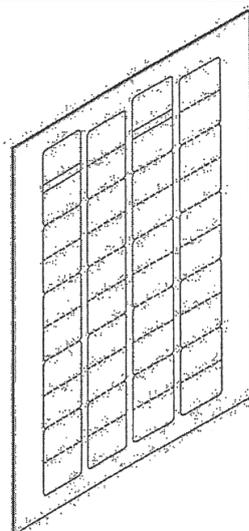
(Date) December 15, 2011

**<IP High Court> 2011 (Gyo-Ke) 10240
"Release paper for printing" Case**

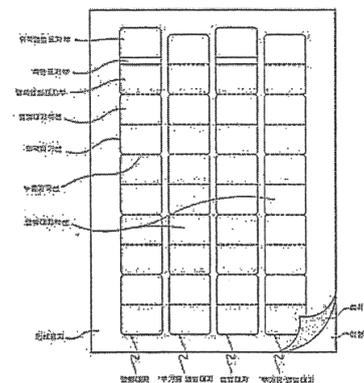
(Conclusion) A person ordinarily skilled in the art could have easily created the design based on the cited design. (Applicant lost)



(The applied design)



(Prior design)



Article 3(2) of the Design Act questions the novelty and/or originality of the conception of the design from the standpoint of a person ordinarily skilled in the art, based on the reasoning that abstract well-known motifs are separate from articles as a benchmark.

In light of the similarities between the applied design of the cited Prior design, the motivation to create the applied design from the cited Prior design is sufficient.

⇒When considering Easiness of Creation (Article 3(2) of the Design Act), the Japanese court considers “motivation” to create the applied design just like when considering Inventive Step of patent applications.

=<IP High Court> 2017 (Gyo-Ke) 10188

=<IP High Court> 2018 (Gyo-Ke) 10181

=<Osaka High Court> 2018 (Ne) 2523

=<IP High Court> 2007 (Gyo-Ke) 10078 etc.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

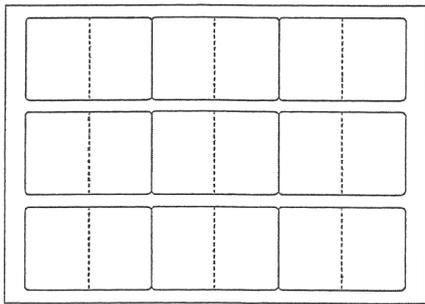
https://www.ip.courts.go.jp/app/files/hanrei_en/977/000977.pdf

Easiness of Creation (Article 3(2) of the Design Act)

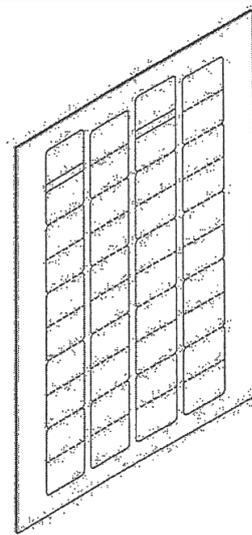
(Date) December 15, 2011

**<IP High Court> 2011 (Gyo-Ke) 10239
"Release paper for printing" Case**

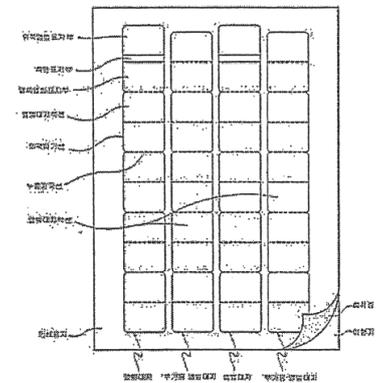
(Conclusion) A person ordinarily skilled in the art could have easily created the design based on the cited design. (Applicant lost)



(The applied design)



(Prior design)



Article 3(2) of the Design Act questions the novelty and/or originality of the conception of the design from the standpoint of a person ordinarily skilled in the art based on the reasoning that abstract well-known motifs are separate from articles as a benchmark.

From the standpoint of a person ordinarily skilled in the art at the time of filing of the design application concerned, to create the applied design based on the cited prior design does not have novelty and/or originality in terms of the idea of the design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/652/000652.pdf

Novelty (related to prior designs)

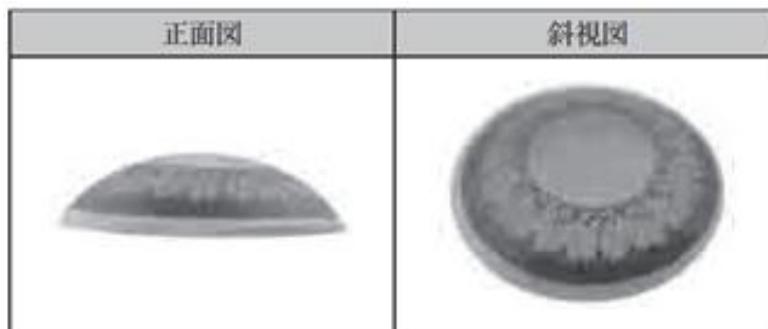
(Date) November 30, 2011

**<IP High Court> 2011 (Gyo-Ke) 10159
"Contact lens" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

In comparison with the human eye, the applied design has an aesthetic that gives a more natural, harmonious, and gentle impression.

In comparison with the human eye, the prior design has an aesthetic that gives an artificial and mechanical impression by discarding naturalness.

⇒Different aesthetic.

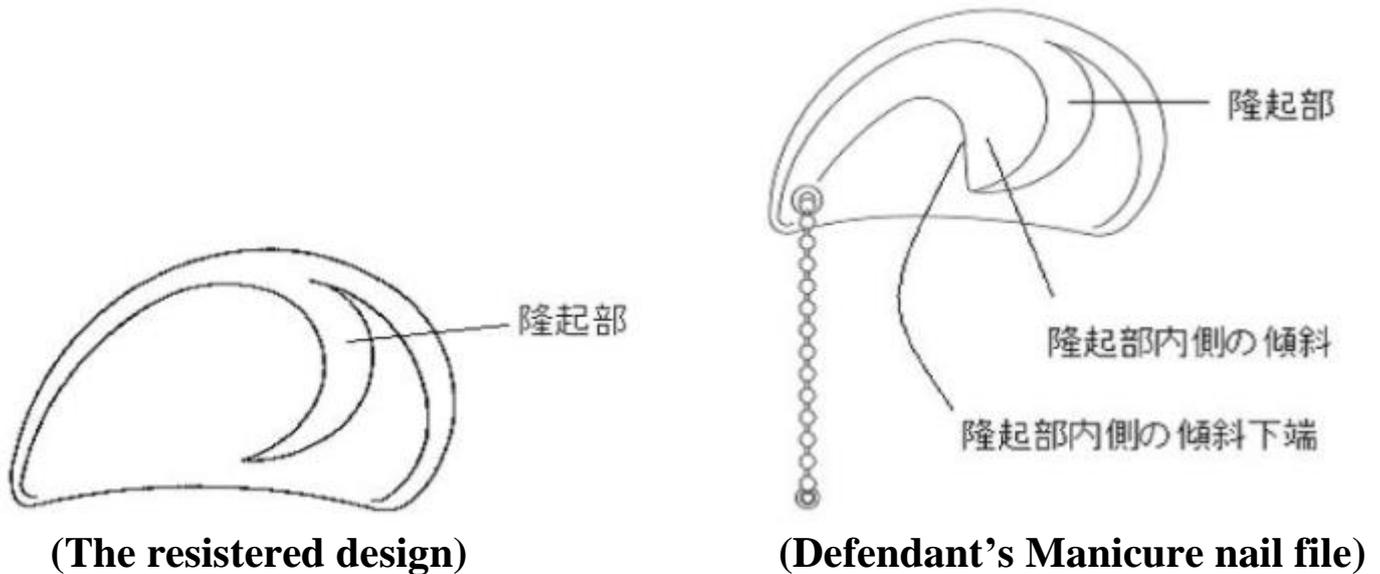
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/963/000963.pdf

Damages calculation (Article 39(1))

(Date) September 15, 2011

<Osaka District Court> 2010 (Wa) 9966
"Manicure nail file" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



Article 39(1) of the Design Act (Lost profits based on a right holder's profit)

- (i) The price of the defendant's product was much cheaper than the plaintiff's product. (plaintiff's product: 500 yen; defendant's product: 100 yen)
- (2) Contribution of features that are not similar to the design in question (size, presence of chains, and color)
- (3) Different sales routes (the defendant's product is sold at a 100-yen shop)
- (4) Existence of competing products

⇒ 66% of the calucuated damages based on the Article 39(1) of the Design Act was eliminated as "any circumstances exist under which the holder of the design right or the exclusive licensee would have been unable to sell the assigned quantity in whole or in part".

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/590/001590.pdf

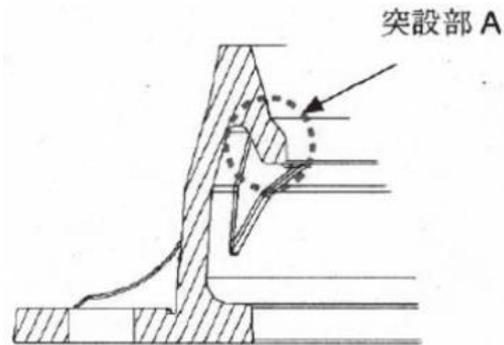
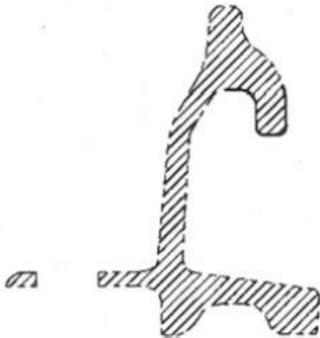
Similarity of design (Infringement case)

(Date) March 28, 2011

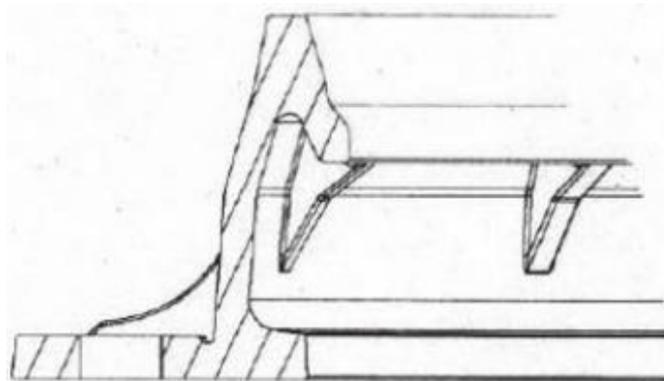
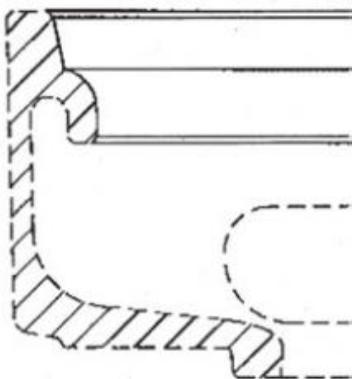
<IP High Court> 2010 (Ne) 10014

"Covers for underground structure (manhole)" Case

**(Conclusion) Defendant's designs are not similar to the registered design.
(Design right owner lost)**



(The resistered design 1 [partial design]) (Defendant's Covers for manhole)



(The resistered design 2 [partial design]) (Defendant's Covers for manhole)

In judging whether designs are similar or dissimilar, it is necessary to observe the design as a whole. In this case, it is necessary to grasp the part of the design that is most likely to attract the attention of traders and consumers as the main part of the design, taking into account the nature, use, and manner of use of the article pertaining to the design, as well as the existence or non-existence of a new creative part not found in known designs, and to observe whether the registered design and the other party's design share the same compositional style in the main part of the design.

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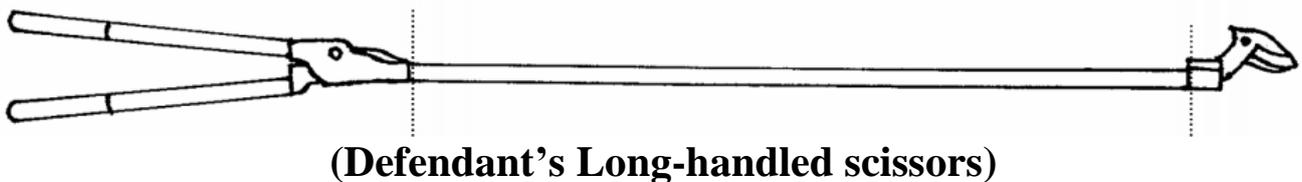
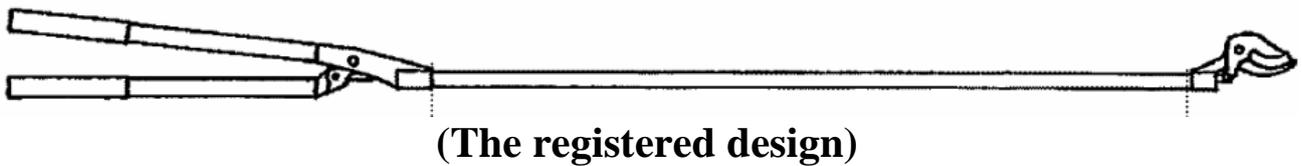
https://www.ip.courts.go.jp/app/files/hanrei_en/540/000540.pdf

Similarity of design (Infringement case)

(Date) December 16, 2010

**<Osaka District Court> 2010 (Wa) 4770
"Long-handled scissors" Case**

(Conclusion) Novelty should be found. (Applicant won)



The essential features of the registered design are the "shape of the blade part as well as the ratio of the length of the fixed coupling part or the handle part to the entire length".

The design of the Defendant's Design is identical to the registered design in said essential features.

The form of the joint part, which was alleged by the defendant as a difference, was not originally an essential feature and merely gives an impression of a device for slight reinforcement compared to the registered design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/606/001606.pdf

Procedural Defects (Copy is NOT allowed of a priority certificate that must be submitted in the procedure for claiming priority under the Paris Convention.)

(Date) October 8, 2010

**<Tokyo District Court> 2009 (Gyo-U) 597
"Magnetic Separation Rack" Case**

Cf. <Tokyo District Court> 2009 (Gyo-U) 540

**(Conclusion) The applicant's procedural defects cannot be amended.
(The applicant lost)**

The priority certificate required to be filed in proceedings to claim priority under the Paris Convention does not include a copy thereof.

The procedure in which a copy has been filed as a priority certificate above cannot be amended.

⇒The amendment after the decision of <Tokyo District Court> 2009 (Gyo-U) 540 was rejected.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/493/001493.pdf

Procedural Defects (Copy is NOT allowed of a priority certificate that must be submitted in the procedure for claiming priority under the Paris Convention.)

(Date) October 8, 2010

**<Tokyo District Court> 2009 (Gyo-U) 540
"Magnetic Separation Rack" Case**

Cf. <Tokyo District Court> 2009 (Gyo-U) 597

**(Conclusion) The applicant's procedural defects cannot be amended.
(The applicant lost)**

The priority certificate required to be filed in proceedings to claim priority under the Paris Convention does not include a copy thereof.

The procedure in which a copy has been filed as a priority certificate above cannot be amended.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/492/001492.pdf

Similarity of design (Infringement case)

(Date) August 26, 2010

<Osaka District Court> 2008 (Wa) 8761

"Measurement-point memory-tag-accommodating washer" Case

(Conclusion) Defendant's OLD design is similar to the registered design.
However, Defendant's NEW design is not similar to the registered design.
(Design right owner won regarding Defendant's old design)



In the transaction of a measurement-point indication plate, the consumer considers not only the state of the display at the time of installation but also the method of reading the data of the IC tag etc.

Usually, the consumer mainly observes the plate from above or diagonally upward, but also makes a general observation including the state of the IC tag housing and the state of the incision related to the reading of electromagnetic waves.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/605/001605.pdf

Procedural Defects (The applicant did not submit the certificate of exception to lack of novelty of design within the period specified in Article 4.)

(Date) August 6, 2010

<Tokyo District Court> 2010(Gyo-U)92

**(Conclusion) The applicant's procedural defects cannot be amended.
(The applicant lost)**

The court dismissed the plaintiff's claim by holding that the JPO's disposition to dismiss the application for the commencement of a procedure is lawful.

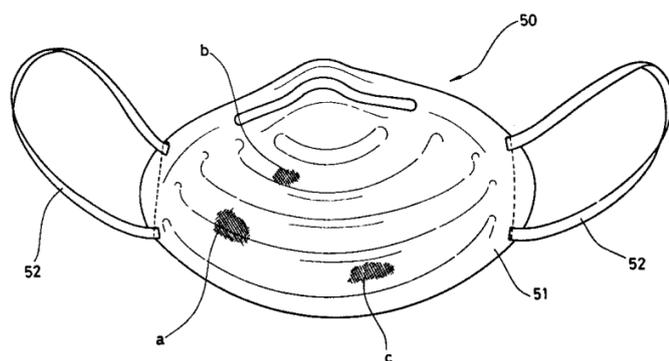
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/492/001492.pdf

Novelty (related to Prior designs)

(Date) July 7, 2010

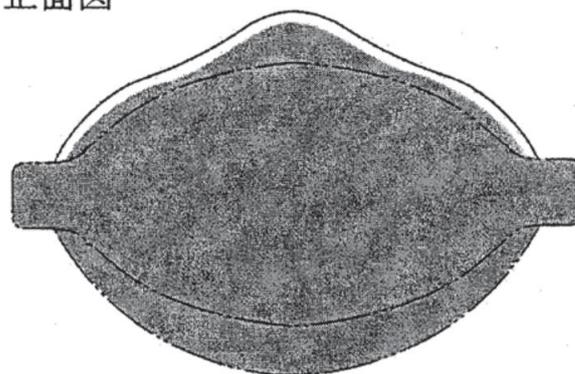
<IP High Court> 2010 (Gyo-Ke) 10079
"Mask" Case

(Conclusion) Novelty should not be found. (Applicant lost)



(The applied design)

正面図



(Prior design)

When “Similarity” between designs are judged, it is inappropriate to consider that the applied design could be defined by taking into consideration matters other than those depicted in the drawing attached to the application or represented in the photograph, model, or specimen attached to the application, or matters recognized from those depicted or represented as above.

The plaintiff asserts that the wavy shape of the upper edge of the present design is significantly different from the corresponding part of the cited design, especially when it is mounted.

However, as stated above, no drawing of the design in the mounted state was submitted in the application. Matters other than those described in the drawing attached to the application should not be taken into consideration.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

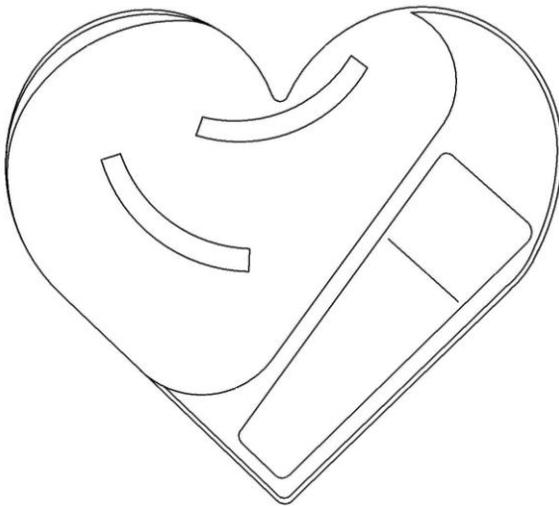
https://www.ip.courts.go.jp/app/files/hanrei_en/533/000533.pdf

Similarity of design (Infringement case)

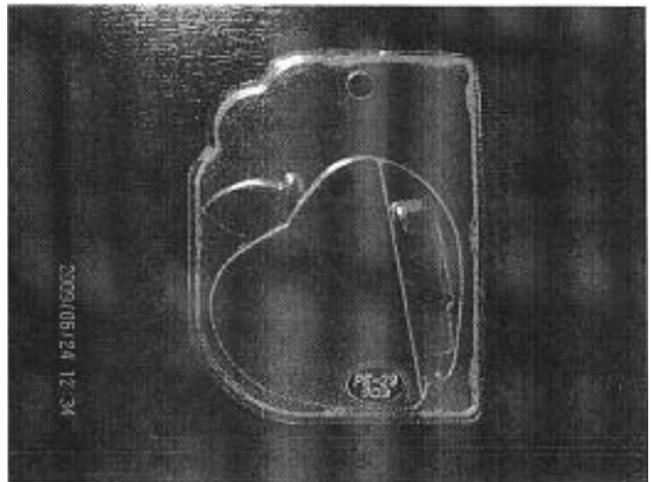
(Date) May 14, 2010

<Tokyo District Court> 2008 (Wa) 36851
"False eyelash case" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The resistered design)



(Defendant's False eyelash case)

The plaintiff asserts that the heart-shaped three-dimensional shape of the case was an essential feature of the registered design because there were no false eyelash cases as of the filing date of the registered design that had a heart shape like the case of the registered design.

However, given the fact that a clear case with a symmetrical heart shape is recognized as a prior design, the point claimed by the plaintiff is not an essential feature of the resistered design.

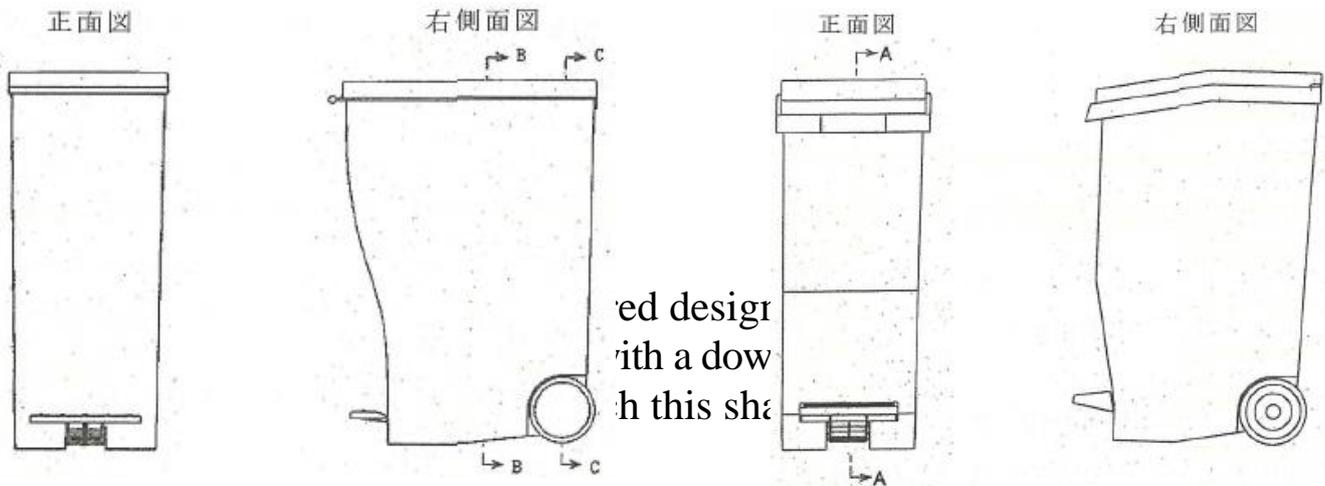
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/483/001483.pdf

Similarity of design (Infringement case)

(Date) March 25, 2010

**<Osaka District Court> 2009 (Wa) 11520
"Garbage box" Case**

**(Conclusion) Defendant's designs are not similar to the registered design.
(Design right owner lost)**



<The resistered design> **Smart and stylish design with abstract water birds** imaged by only smooth curved frontal walls, handles, treadboards, and wheels with uneven surfaces on both sides of the ceiling and the body of the lid, and with a smooth, curved surface with no unevenness in the vicinity of the bottom.

<Defendant's Garbage box> The ceiling surface of the front wall and the lid are composed of a plurality of surfaces with different inclinations, each of which can be seen by a crest folding line near the center, and the peripheral edge of the flange is formed into a downwardly folded angle, which is a **geometric and complicated design** using many large and small surfaces.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/601/001601.pdf

Similarity of design (Infringement case) <File wrapper estoppel>

(Date) November 5, 2009

**<Osaka District Court> 2009 (Wa) 2726
"Boots" Case**

(Conclusion) It is prohibited to assert what is contradictory to what an applicant asserted during the application procedure.

⇒Defendant's design is not similar to the registered design. (Design right owner lost)



In this case, however, the applicant asserted that the difference in the number of banded parts does not affect the aesthetic of the registered design. Such contradicting assertion is prohibited based on file wrapper estoppel or faithful principle.

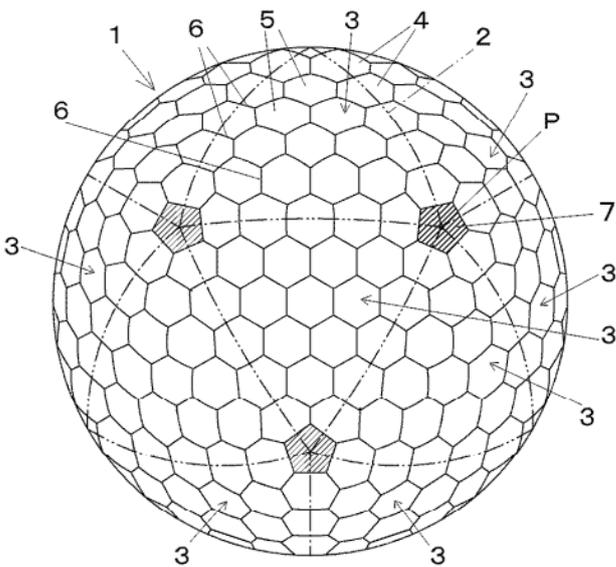
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/575/001575.pdf

Novelty (related to Prior designs)

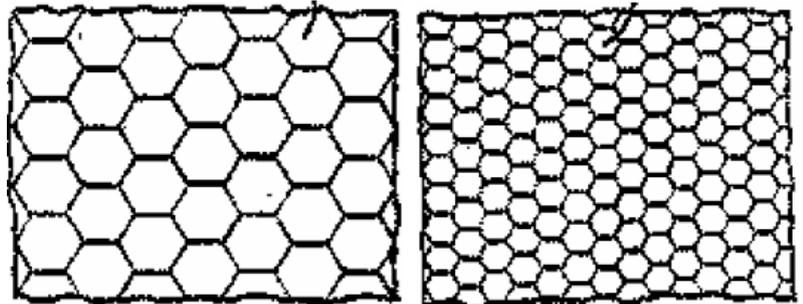
(Date) September 10, 2009

**<Osaka District Court> 2008 (Wa) 5712
"Golf ball" Case**

(Conclusion) Novelty should not be found. (Design right owner lost)



(The registered design)



(Prior design)

*12/362 of the dimples in the registered design are not hexagons but pentagons.

Differences in the specific constitution of the design, such as that there is a small number of pentagonal dimples ... do not cause any difference that is visually significant to the aesthetic impression.

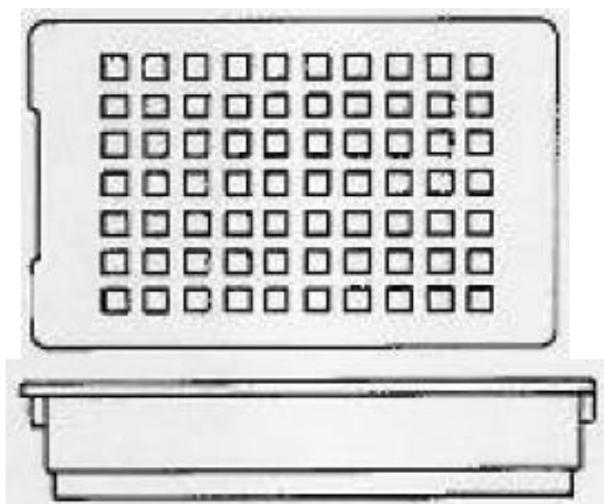
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/581/000581.pdf

Similarity of design (Infringement case)

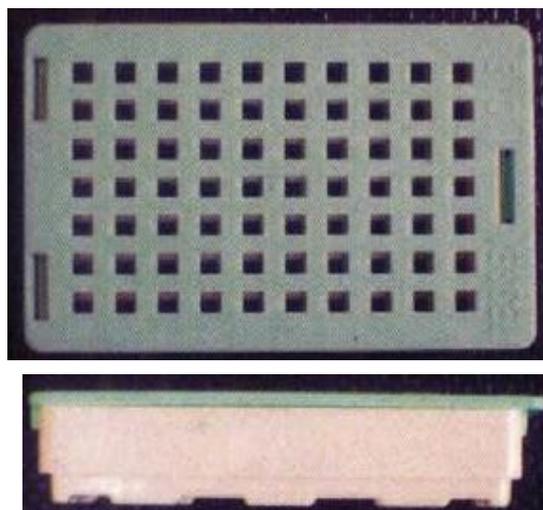
(Date) July 23, 2009

<Osaka District Court> 2008 (Wa) 13282
"Cell container for medical testing" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The resistered design)



(Defendant's Cell container)

The essential feature of the registered design is a step which is provided in a manner that it projects nearly perpendicular to the side surface at the level around one-fourth the height of the container body from the bottom of the long side of the container body and also becomes nearly perpendicular to the bottom.

The design of the Defendant's Cell container also has a similar step, but such a step is not highly novel in consideration of publicly known designs; rather, the design of the Defendant's Cell container has a prominent difference to which consumers pay attention in the configuration of its leg part.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/595/001595.pdf

Novelty (related to Prior designs)

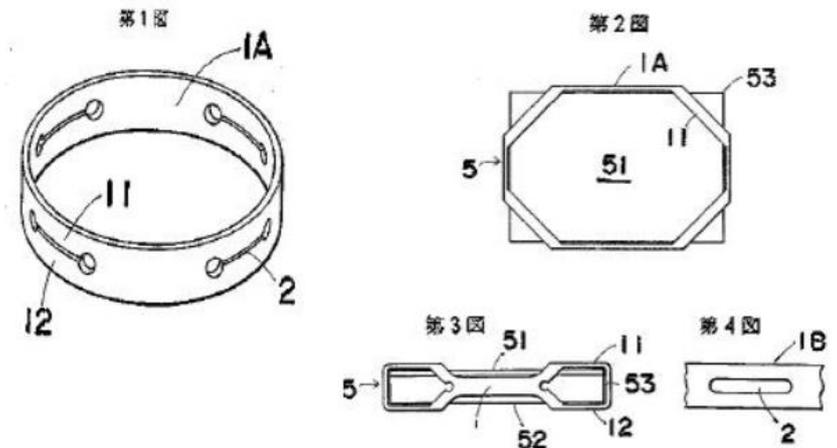
(Date) July 21, 2009

**<IP High Court> 2009 (Gyo-Ke) 10036
"Rubber band" Case**

(Conclusion) Novelty should be found. (Applicant won)

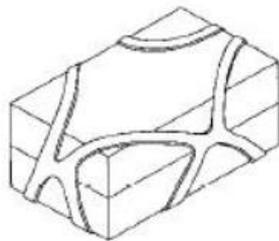


(The applied design)

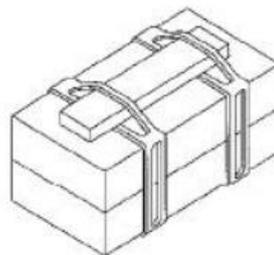


(Prior design)

使用状態を示す参考図 1



使用状態を示す参考図 2



(Reference Figures showing the usage state")

When considering similarity, the shape when the applied design is used should be considered.

Submission of a certificate of exception to lack of novelty of design does not constitute an admission of similarity.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

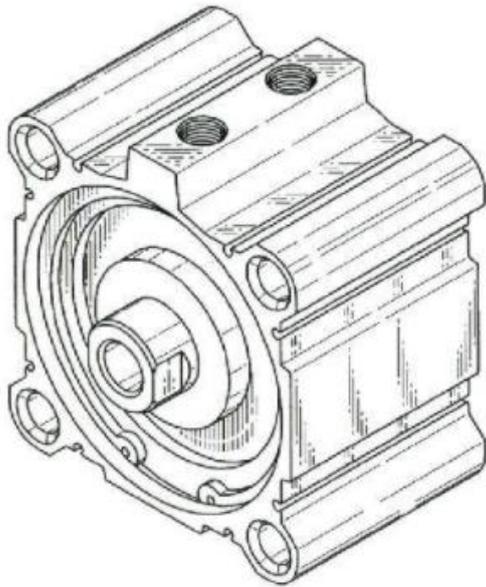
https://www.ip.courts.go.jp/app/files/hanrei_en/424/001424.pdf

Novelty (related to Prior designs)

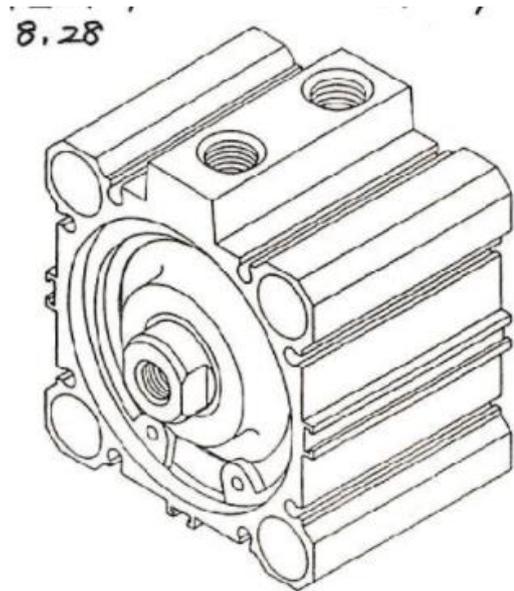
(Date) May 28, 2009

**<IP High Court> 2008 (Gyo-Ke) 10401
"Fluid pressure cylinder" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

The most common form attracts the attention of the consumer when the aesthetic feeling caused by a form other than the common form is not sufficient to exceed the aesthetic feeling caused by the common form.

It is not immediately possible to judge that the two designs are similar from the aesthetic appearance arising from the common point, and it is necessary to judge the aesthetic appearance arising from the part other than the usual form in order to judge whether or not the two designs are similar.

In light of the fact that the content and degree of the design effect and the form of the applied design relating to the difference are common, the design effect that the forms of the applied design relating to the difference are common is sufficient to exceed the common aesthetic feeling that the form relating to the common point of the two designs is common. Therefore, the applied design is not similar to the prior design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

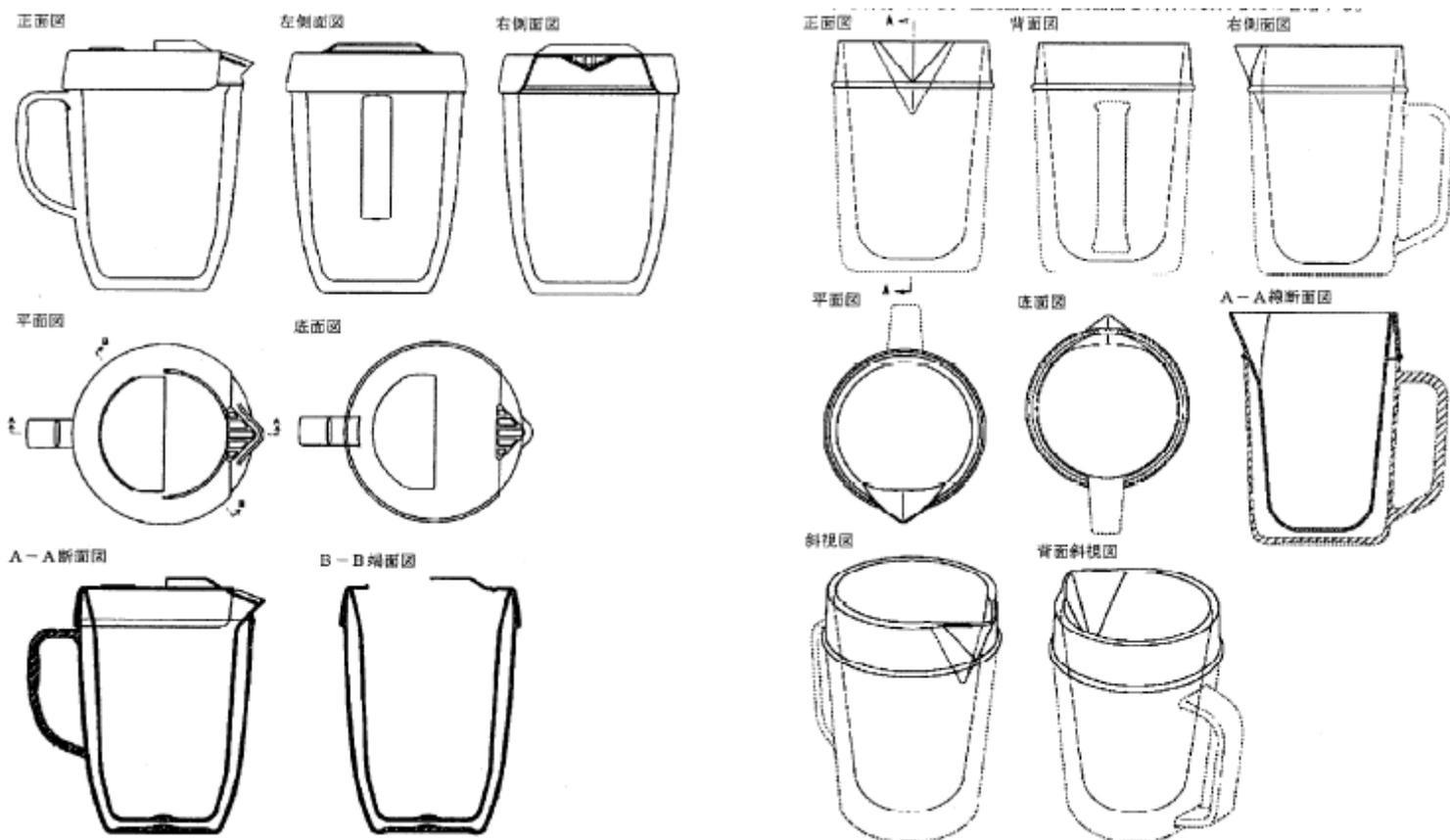
https://www.ip.courts.go.jp/app/files/hanrei_en/689/001689.pdf

Novelty (related to Prior designs)

(Date) December 25, 2008

**<IP High Court> 2008 (Gyo-Ke) 10251
"Beer pitcher" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)

(Prior design)

The applied design is basically formed by a straight line in both the folded portion and the pouring spout, the whole length is long, the pouring spout is large and deep, and has a double substantially V-shape from the front view, and when these features are combined, it gives a regular but sharp impression.

Prior design is basically formed by curves at both the folded portion and the spout except for the side view of the spout, and the overall longitudinal length is short compared to the horizontal length, the spout is small and shallow, exhibiting a circular arc shape from the front view, and in plan view, the spout changes the radius of curvature as it travels from the front to the tip, and the curves are frequently used, and when these features are combined, it gives an irregular and complicated but a flexible and warm impression as a whole.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/137/000137.pdf

Novelty (related to Prior designs)

(Date) November 26, 2008

**<IP High Court> 2008 (Gyo-Ke) 10185
"Wristwatch" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

<Prior design> ① Mounting portion of the belt connecting portion is planar, ② no pattern on the thickness portion of the outer peripheral edge portion of the glass pressing substantially circular ring-shaped portion + 8 fixing screw portions having one groove therein hexagonal screw, ③ the tornado has a substantially hexagonal prism shape, there is no slit on the circumferential surface, the upper and lower push button portions have a cylindrical shape, ④ upper and lower guard portions have a notched portion, each of which is provided with a push button portion, the guard portion is planar in front.

⇒ Clear and flat impression as a whole

<The applied design> ① two ribs to the mounting portion of the belt connecting portion (waviness pattern), ② vertical slit pattern + 8 fixing screws on the entire surface of the thickness portion of the outer peripheral edge portion of the glass pressing substantially circular ring-shaped portion is provided with a hexagonal recess on the inside cylindrical screw, ③ tornado is substantially cylindrical, the slit is applied to the circumferential surface, the upper and lower push button portions are rectangular, ④ push button portion is provided so as to protrude from the upper guard portion and the lower guard portion.

⇒ Three-dimensional impression with many irregularities as a whole

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/125/000125.pdf

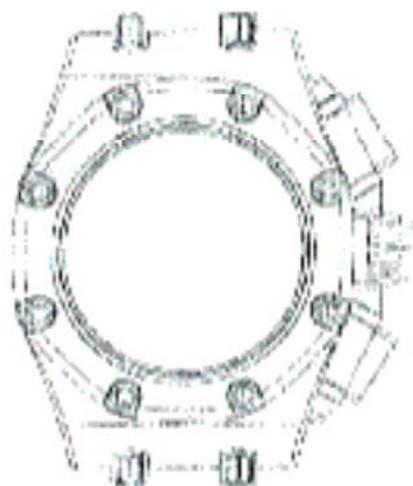
Novelty (related to Prior designs)

(Date) November 26, 2008

<IP High Court> 2008 (Gyo-Ke) 10184

"Wristwatch side" Case

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

<Prior design> ① Mounting portion of the belt connecting portion is planar, ② no pattern on the thickness portion of the outer peripheral edge portion of the glass pressing substantially circular ring-shaped portion + 8 fixing screw portions having one groove therein hexagonal screw, ③ the tornado has a substantially hexagonal prism shape, there is no slit on the circumferential surface, the upper and lower push button portions have a cylindrical shape, ④ upper and lower guard portions have a notched portion, each of which is provided with a push button portion, the guard portion is planar in front.

⇒ Clear and flat impression as a whole

<The applied design> ① two ribs to the mounting portion of the belt connecting portion (waviness pattern), ② vertical slit pattern + 8 fixing screws on the entire surface of the thickness portion of the outer peripheral edge portion of the glass pressing substantially circular ring-shaped portion is provided with a hexagonal recess on the inside cylindrical screw, ③ tornado is substantially cylindrical, the slit is applied to the circumferential surface, the upper and lower push button portions are rectangular, ④ push button portion is provided so as to protrude from the upper guard portion and the lower guard portion.

⇒ Three-dimensional impression with many irregularities as a whole

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/124/000124.pdf

Similarity of design (Infringement case)

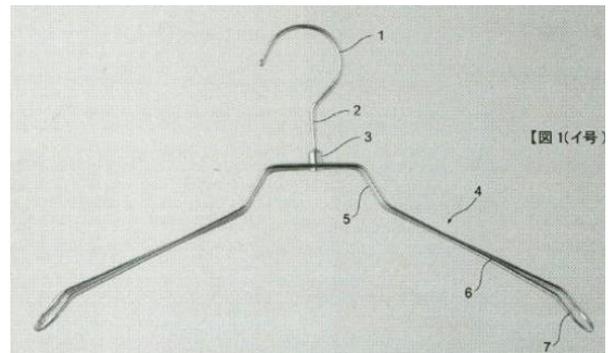
(Date) October 30, 2008

<Tokyo District Court> 2008 (Wa) 1089
"Clothes hanger)" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The resistered design)



(Defendant's Clothes hanger)

In the resistered design, a semicircular thin plate is attached to a wire-like line on the upper side of the front side of the neck, whereas in the design of the Defendant's Clothes hanger, the thin plate like the Design is not attached to the front side of the neck.

In this regard, the design of Defendant's Clothes hanger provides the viewer with an aesthetic impression that differs from the resistered design.

The commonality between the resistered design and the design of the Defendant's Clothes hanger does not have an impact on the viewer beyond the difference in the absence of the neck lamellae described above, in light of the geometry that is also found in prior designs.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

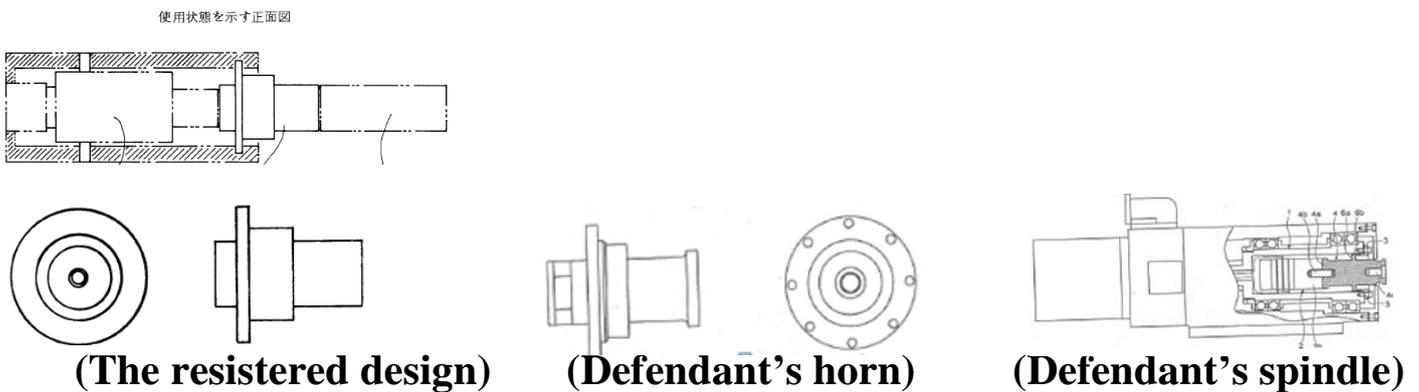
https://www.ip.courts.go.jp/app/files/hanrei_en/370/001370.pdf

Similarity of design (Infringement case)

(Date) September 11, 2008

**<Osaka District Court> 2007 (Wa) 1411
"Coupling horn" Case**

(Conclusion) Basically, a hidden shape shall not be taken into consideration when considering similarity. Thus, the Defendant's design is not similar to the registered design. (Design right owner lost)



"Use relationship" when only part of the product is visually recognizable from the outside

Since the Defendant's horn is contained in a spindle, it does not appear in the distribution process and cannot be visually recognized.

A hidden shape etc. of an article shall not be taken into consideration when considering similarity.

The appearance-recognizable head of the design of the Defendant's horn is markedly different from resistered design.

Whether or not "use relationship" is established cannot be considered when a hidden shape that does not appear in the distribution process and cannot be visually recognized. In addition, when the Defendant's horn is replaced, photographs or explanatory drawings showing the shapes of Defendant's horn are not recognized by customers.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

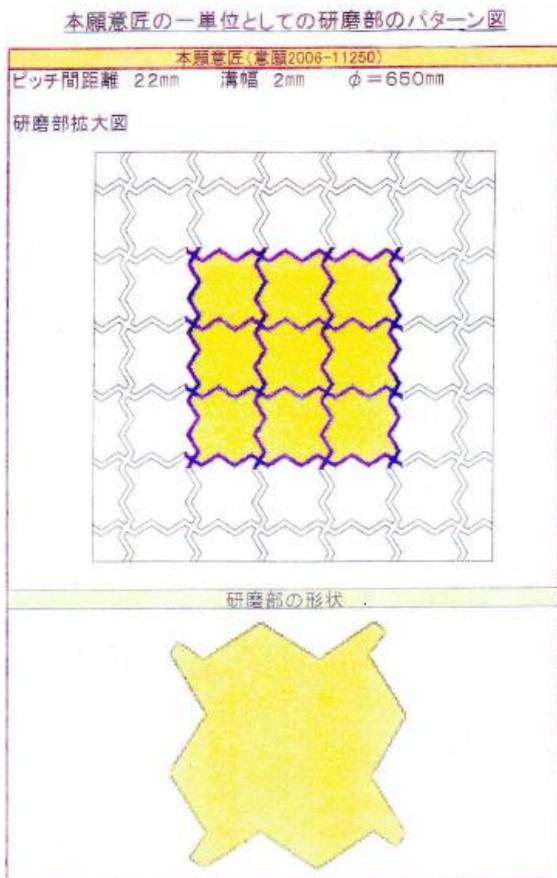
https://www.ip.courts.go.jp/app/files/hanrei_en/411/001411.pdf

Easiness to create the design

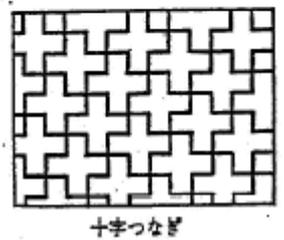
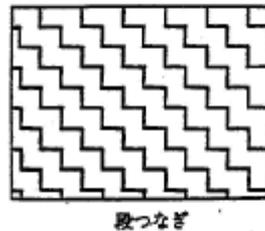
(Date) August 28, 2008

**<IP High Court> 2008 (Gyo-Ke) 10069
"Polishing pad" Case**

(Conclusion) The registered design is not easy to create based on prior designs. (Design right owner won)



(The applied design)



(Prior design)

Among the triangular wave zigzag line patterns, there are various line thicknesses and lengths and forming angles of respective linear portions, and there is room for selection, and the width of the groove interval to be selected is decided in consideration of the impression received from the design, and therefore, considerable creativity is required.

The applied design give the viewer a delicate, sharp, unstable, etc. impression as a whole.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/104/000104.pdf

Similarity of design (Infringement case)

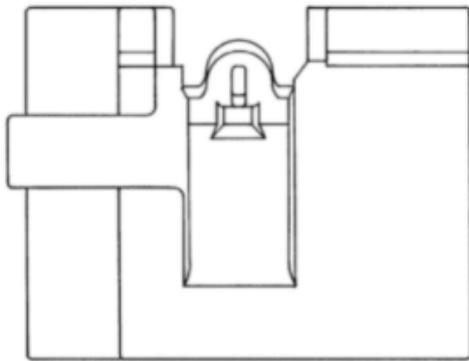
(Date) February 19, 2008

<Tokyo District Court> 2007 (Wa) 1972

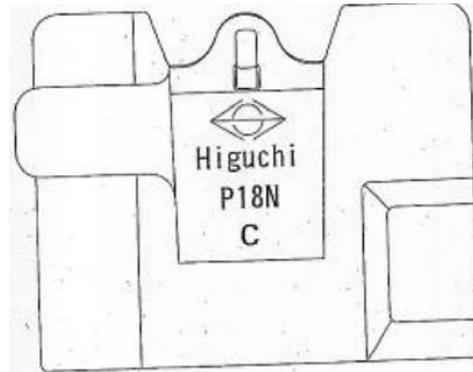
"Bucket tip shroud" Case

(Conclusion) Defendant's design is not similar to the registered design.

(Design right owner lost)



(The resistered design)



(Defendant's Bucket tip shroud)

The resistered design has a considerably lower top of the fitted portion as compared with the position of the upper side portions of the left and right tooth plate portions, which when mounted on the bucket, closes the gap between the bucket as much as possible, and has a shape capable of preventing earth and sand leakage during operation.

On the other hand, the design of Defendant's Bucket tip shroud is shaped differently from the resistered design in a configuration that attracts the attention of the consumer in that the height of the apex in that the curved portion of the chevron is substantially the same as that of the upper portions of the tooth plates on the left and right sides, and therefore, when mounted on the bucket, a gap is created between the bucket and the apex, and earth and sand leakage may occur.

Since the common structural details between the resistered design and the design of the Defendant's Bucket tip had all been publicly known prior to the filing of the design application in question, said common structural details do not attract consumers' attention as a structural characteristics of the resistered design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

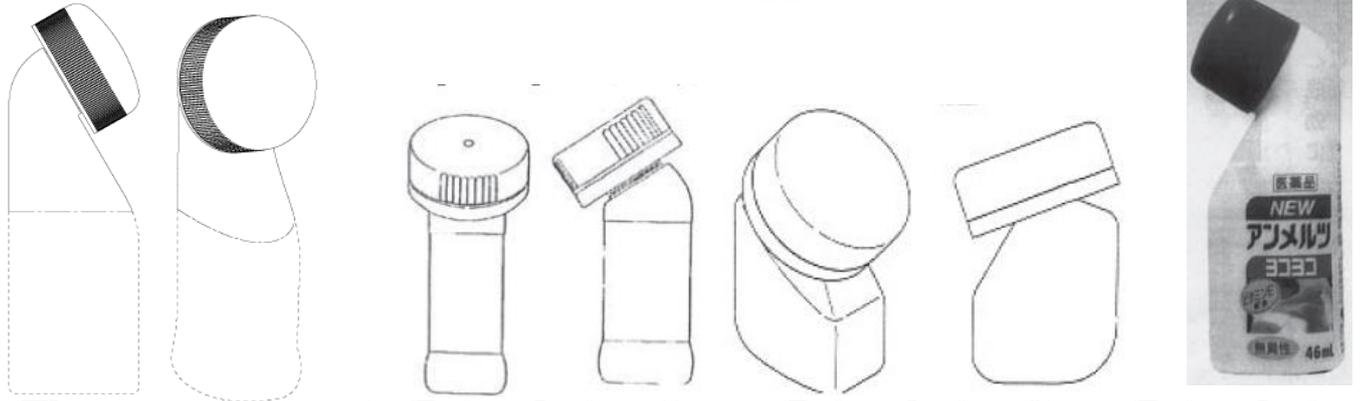
https://www.ip.courts.go.jp/app/files/hanrei_en/339/001339.pdf

Easiness to create the design

(Date) December 26, 2007

**<IP High Court> 2007 (Gyo-Ke) 10209
"Packaging container" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design) (Prior design 1) (Prior design 2) (Prior design 3)

Since the applied design was created with creative ingenuity from various design choices, it is not easy for a person skilled in the art to create the applied design on the basis of the Prior design 3 by applying the Prior design 1 and the Prior design 2 (a design for a known packaging container in which the diameter of the applicator part is larger than that of the container main body part).

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/037/000037.pdf

Novelty (related to Prior designs)

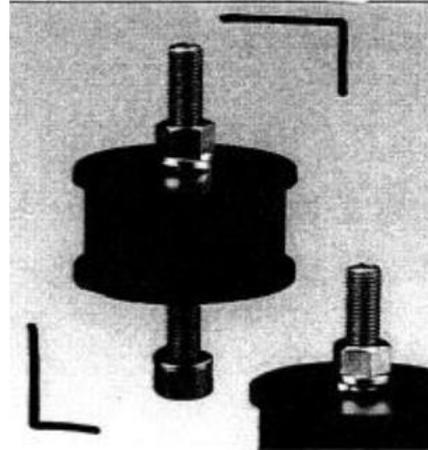
(Date) November 29, 2007

**<IP High Court> 2007 (Gyo-Ke) 10107
"Elastic damper" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

A combination of common points between the applied design and the prior design does not have a significant design effect on the determination on similarity.

In the additional consideration of several differences between them, when the whole of the designs in the present case is observed, the aesthetic appearances of the designs are not similar from the viewpoint of the consumer.

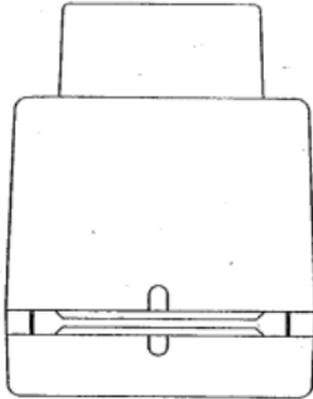
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/030/000030.pdf

Novelty (related to Prior designs)

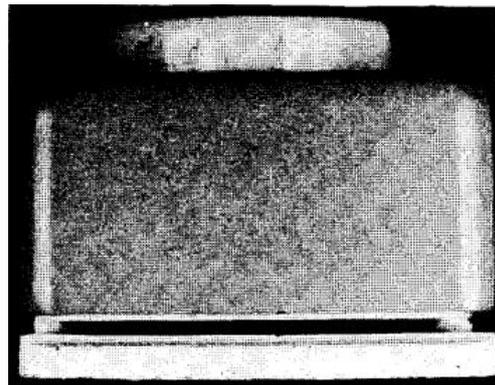
(Date) September 10, 2007

**<IP High Court> 2007 (Gyo-Ke) 10119
"Craft puncher" Case**

(Conclusion) Novelty should not be found. (Applicant lost)



(The applied design)



(Prior design)

It is not reasonable to compare the publicly known design with older existing publicly known designs and to recognize essential features for the purpose of determining similarity between the prior designs and the applied design.

The judgment on similarity should be based simply on commonalities and differences between the prior designs and the applied design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

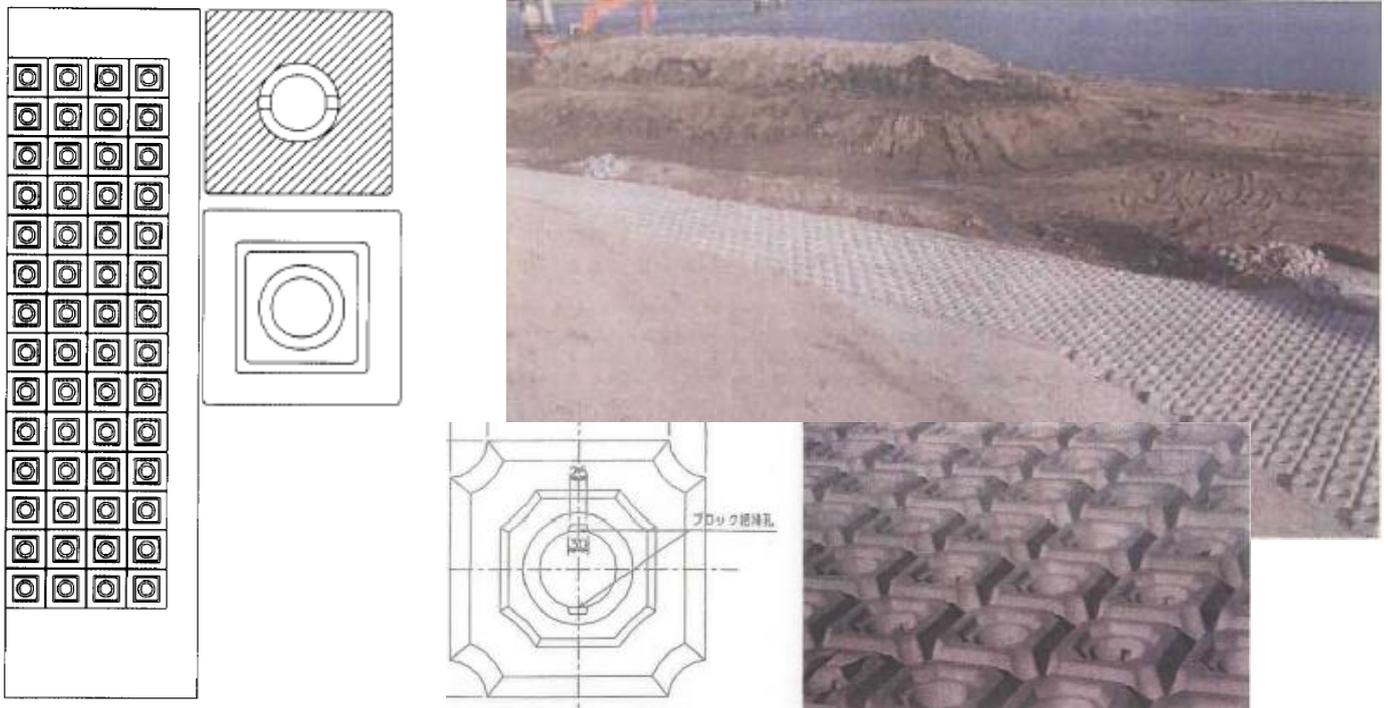
https://www.ip.courts.go.jp/app/files/hanrei_en/091/000091.pdf

Similarity of design (Infringement case)

(Date) December 21, 2006

<Osaka District Court> 2006 (Wa) 7014
"Block mat" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The resistered design)

(Defendant's Block mat)

Consumers (contractors) select products by looking at catalogs or the physical products. The catalogs show front-view drawings as product drawings.

Whereas the resistered design provides an orderly aesthetic feel, in the Defendant's Block mat, the quarter-circle notches provide a decorative aesthetic feel that differs from the resistered design due to the fact that they are circular when aligned with the quarter-circle notches of the other blocks and the relatively wide grooves between the blocks.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

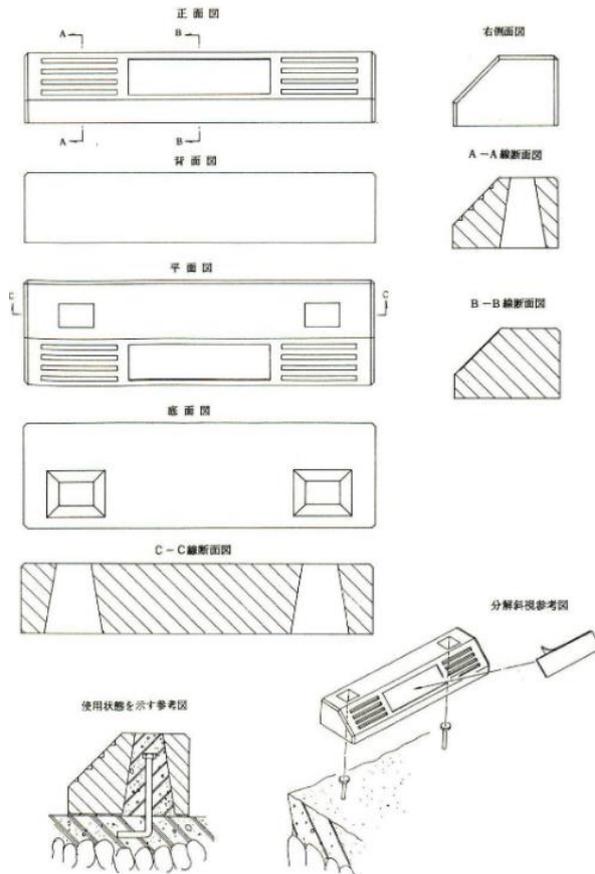
https://www.ip.courts.go.jp/app/files/hanrei_en/522/000522.pdf

Novelty (related to Prior designs)

(Date) December 11, 2006

**<IP High Court> 2006 (Gyo-ke) 10337
"Car stopper block" Case**

(Conclusion) Novelty should be found. (Applicant won)



(The applied design)



(Prior design)

Since the cited defendant's brochure was a mere color-printed document, the defendant could have made the brochure with a false preparation date, and therefore that the preparation date printed on the document was insufficient to prove the date when it was actually prepared.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

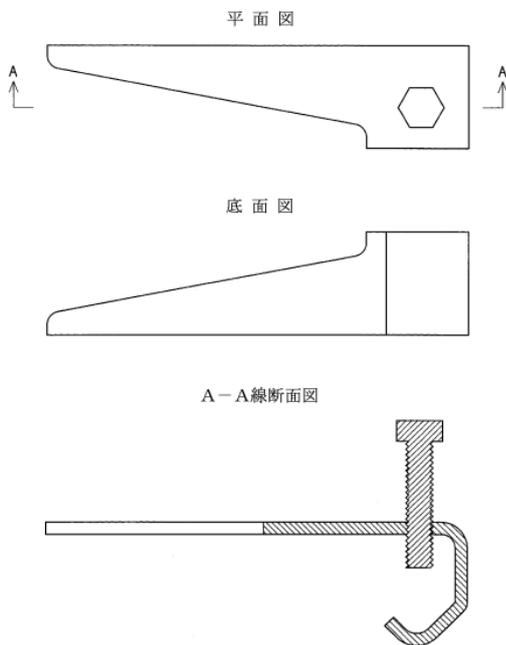
https://www.ip.courts.go.jp/app/files/hanrei_en/496/000496.pdf

Novelty (Infringement case - Invalid)

(Date) November 30, 2006

**<Osaka District Court> 2006 (Wa) 3563
"Metal product to support concrete frame" Case**

(Conclusion) Novelty should not be found. (Applicant lost)



(The applied design)



(Prior design)

There are no differences between the prior Plaintiff's product #100 shown in the broucher and the registered design.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

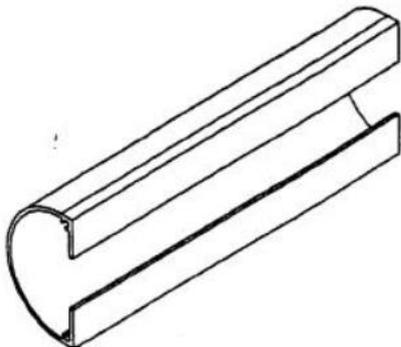
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Easiness to create the design

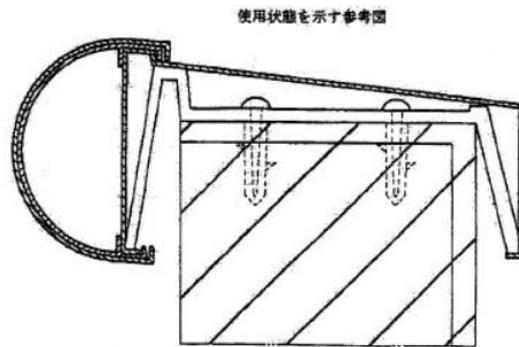
(Date) September 20, 2006

**<IP High Court> 2006 (Gyo-ke) 10088
"Metal blind louver" Case**

(Conclusion) The registered design is not easy to create based on Prior designs. (Design right owner won)



(The applied design)



(Prior design)

In determining whether or not it is easy to create a design, the field to which the design belongs shall be considered.

The article related to the prior design is used as a holder material for attaching the decorative shade wood to the shade wood body, and is completely different from the applied design ("Metal blind louver") in its function and construction.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

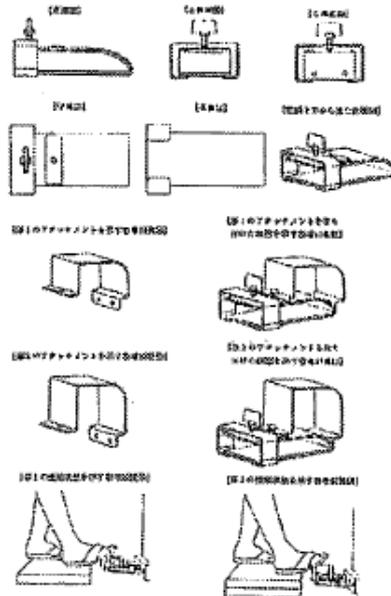
https://www.ip.courts.go.jp/app/files/hanrei_en/478/000478.pdf

Divisional application (Japanese Design Act, Article 10bis(1))

(Date) August 24, 2006

**<IP High Court> 2006 (Gyo-ke) 10136
"Piano pedal extender platform" Case**

(Conclusion) Divisional application based on the "reference drawing" was rejected. (Applicant lost)



(The original application)



(The applied design)

***Under the Japan Design Act, applied design which is not registered as design right would not be published.**

"Two or more designs" as used in Article 10-2(1) of the Design Act shall be limited to "designs for which registration is sought."

In the reference drawing of the drawing attached to the original application, the design of the piano auxiliary pedal including the attachment portion with the attachment attached thereto is shown. However, such a reference drawing is shown for the purpose to aid in understanding the design to be registered, and it is outside of the design to be registered.

Since the applied design for which registration is sought is not the design for which registration is sought in the original application, the applied application cannot be regarded as a divisional application that satisfies the requirements of Article 10bis(1) of the Design Law.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

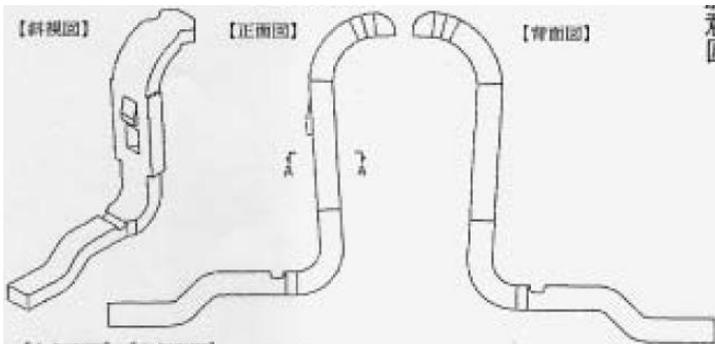
https://www.ip.courts.go.jp/app/files/hanrei_en/481/000481.pdf

Novelty (related to Prior designs)

(Date) March 31, 2006

<IP High Court> 2005 (Gyo-ke) 10679
"Connector terminal" Case

(Conclusion) Novelty should not be found because the applied design is too small to be visible to the naked eye. (Applicant lost)



(The applied design)

Even if a small size is invisible to the naked eye, the design is accepted if it is usually observed in a magnified manner at the time of trade.

In light of the purpose of the Designs Act, in cases where it is usual to magnify and observe the shape etc. of an article by means such as observing the actual or sample article with a magnifying glass etc., or publishing an enlarged photograph or an enlarged drawing in a catalog or specification etc., when dealing with the article pertaining to the design, the shape etc. of the article falls under the category of "to create an aesthetic feeling through vision, even if it cannot be recognized by the naked eye."

With regard to the applied design, the shapes of the "Connector terminal" is NOT observed in an enlarged manner in the course of the transaction.

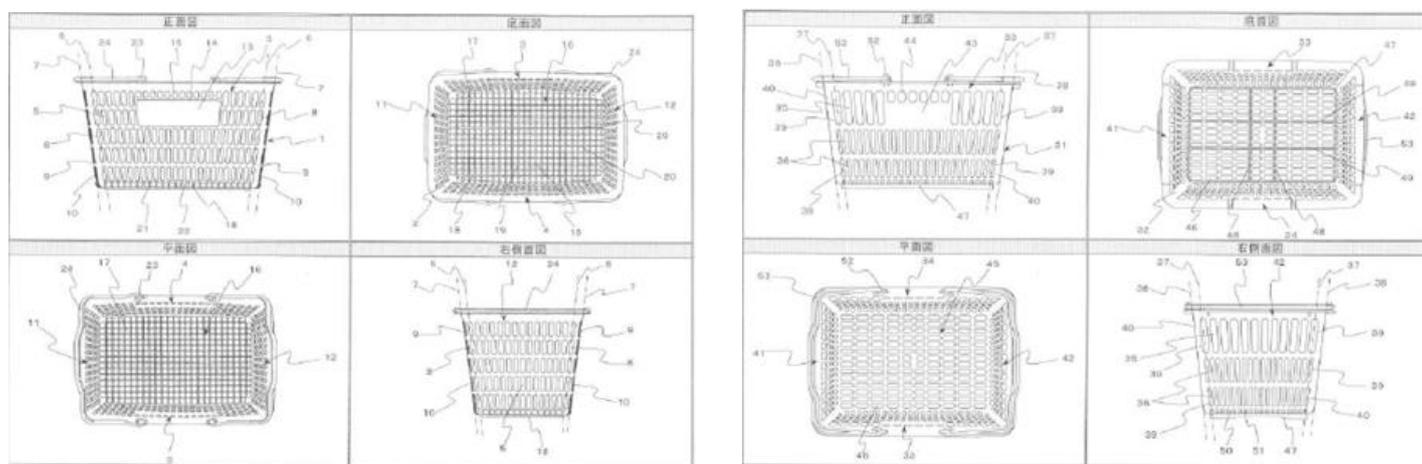
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/371/000371.pdf

Similarity of design (Infringement case)

(Date) January 17, 2006

<Osaka District Court> 2004 (Wa) 14355
"Shopping basket" Case

(Conclusion) Defendant's design is not similar to the registered design.
(Design right owner lost)



(The registered design)

(Defendant's Shopping basket)

The persons in the purchasing division of a supermarket or a department store etc. should be regarded as consumers of such shopping baskets and therefore as observers of them.

Observers would observe a shopping basket by evaluating whether the design of the shopping basket is, from the viewpoint of their customers, aesthetically appropriate for the image of their shop.

The observers would first pay attention to the overall configuration of the basket and, in order for the user to grasp the entire configuration, it would be natural for them to look at the basket from a distance that allows them to observe the entire picture of the basket from an obliquely upward position.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/280/000280.pdf

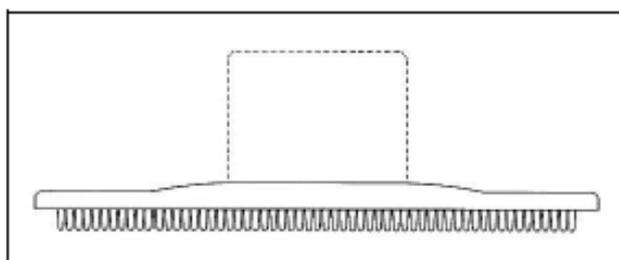
Similarity of “article (goods)” (Infringement case)

(Date) December 15, 2005

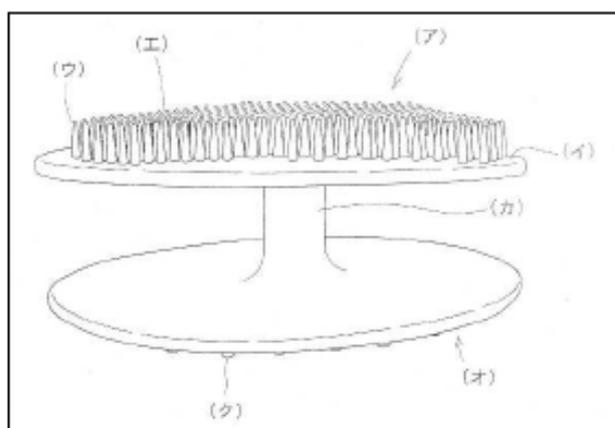
<Osaka District Court> 2004 (Wa) 6262

"Face puff" Case

(Conclusion) Defendant’s “article” is similar to the registered design.
(Design right owner won)



(The resistered design)



(Defendant’s brush)

Whether articles are similar each other or not should be judged based on the similarity of the “purposes” and “functions”.

Even if the "function" is different, as long as the "purpose" is the same, it is often judged that the articles are similar each other.

In addition to its original purpose and function of applying grates, foundations, etc. to the skin of the face etc., Puff is recognized as having an purpose and function as a facial cleanser, and the object product (note: brush) and its purpose and function are similar to those of a brush.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

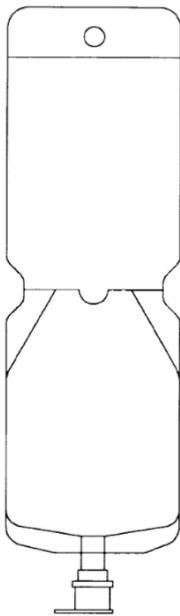
https://www.ip.courts.go.jp/app/files/hanrei_en/241/000241.pdf

Prior use right (Japanese Design Act, Article 29)

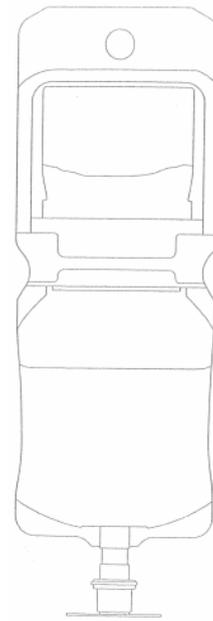
(Date) November 24, 2005

**<Osaka District Court> 2004 (Wa) 8657
"Infusion solution bag" Case**

(Conclusion) Prior use right was admitted. (Design right owner lost)



(The resistered design)



(Defendant's Infusion solution bag)

The defendants had started making preparations for the production of its products before the plaintiff's filing of an application for registration of the design, and by concluding that the defendants had a non-exclusive license based on prior use.

As evidence to prove a prior use right, in this case, digital camera shots and photographs stored in a computer were also utilized.

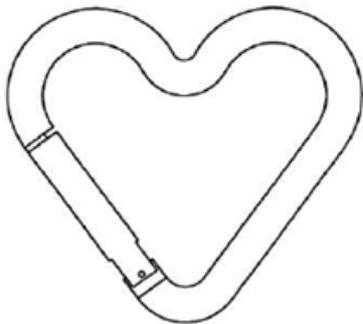
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/247/000247.pdf

Similarity of “article (goods)” (Infringement case)

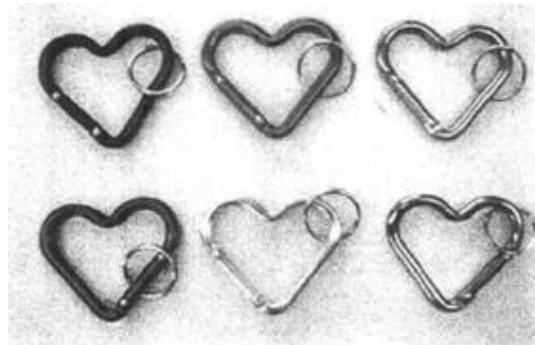
(Date) October 31, 2005

**<IP High Court> 2005 (Ne) 10079
"Carabiner" Case**

(Conclusion) Defendant’s “article” is not similar to the registered design. (Design right owner lost)



(The resistered design)



(Defendant’s heart-shaped accessory)

There may be no design separated from an article. Simirality of articles means that when a registered design or a design similar thereto is applied to an article, confusion may occur.

In this case, the article of the resistered design is "Carabiner" (mountain climbing tool), while the Defendant'article is a "heart-shaped accessory"; therefore, as an "article" they are not similar each other.

※In this case, in the column "Description of the article to the design," the phrase "for decorating the key holder etc." was written. However, the phrase "Description of the article to the design" was judged to only help in the understanding of the article and not to affect the classification of the article.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

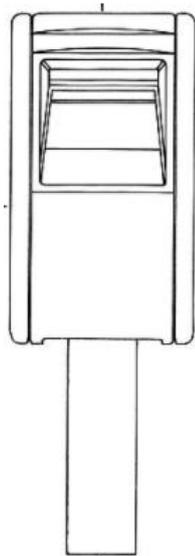
https://www.ip.courts.go.jp/app/files/hanrei_en/416/000416.pdf

Novelty (related to prior designs)

(Date) September 15, 2005

**<IP High Court> 2005 (Gyo-ke) 10134
"Postbox" Case**

(Conclusion) Novelty should not be found. (Design right owner lost)



(The applied design)



(Prior design)

The court affirmed that the Handouts fell under the category of “publications distributed”.

When the resistered design and the prior design are observed as a whole, the difference is a partial and weak difference that is limited to "a difference to the extent that it can be seen by looking at this point only," and does not give the observer a different aesthetic impression as a whole.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/314/000314.pdf

Similarity of design (Infringement case)

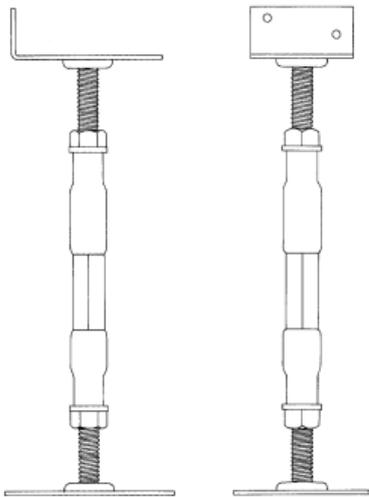
(Date) January 17, 2005

<Osaka District Court> 2004 (Wa) 1099

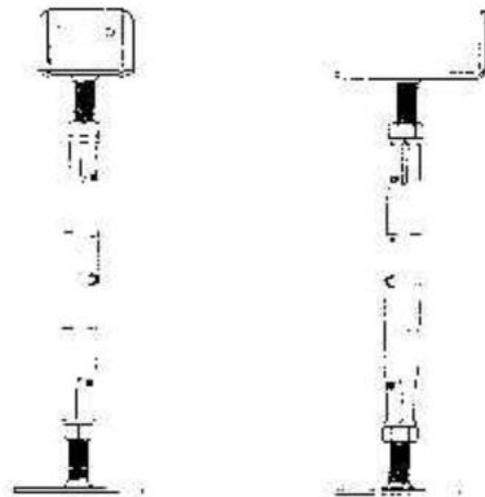
"Yukazuka (floor post)" Case

(Conclusion) Defendant's design is not similar to the registered design.

(Design right owner lost)



(The resistered design)



(Defendant's Yukazuka [floor post])

The essential parts of the design should be identified by observing the design as a whole and taking into account the nature, use, etc. of the article to which the design relates.

Although some of the main parts of the resistered design and the design of Defendant's Yukazuka have common features, the difference as a whole exceeds the common features, and the design of the defendant's products have different aesthetics from the resistered design.

The resistered design is distinguished by the narrow angular shape of the intermediate portion in contrast to the rounded shape of the upper and lower cylindrical portions, and the **sharp and smart impression** resulting from such a shape is strongly felt by the viewer in the aesthetic feeling received from the whole.

The design of **Defendant's Yukazuka**, including the middle part, as a whole gives the nurse a **rounded soft impression**.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

https://www.ip.courts.go.jp/app/files/hanrei_en/234/000234.pdf

Prior application (Design Act Article 9(1))

(Date) February 24, 1995

**<Supreme Court> 1991 (Gyo-tsu) 139
"Embedded light for ceiling" Case**

(Conclusion) Rejected as prior application (Design Act Article 9(1)).

In cases where the design in the application for design registration of a 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 the Design Act Article 9(1), irrespective of whether or not such other person's design is similar to the principal design.

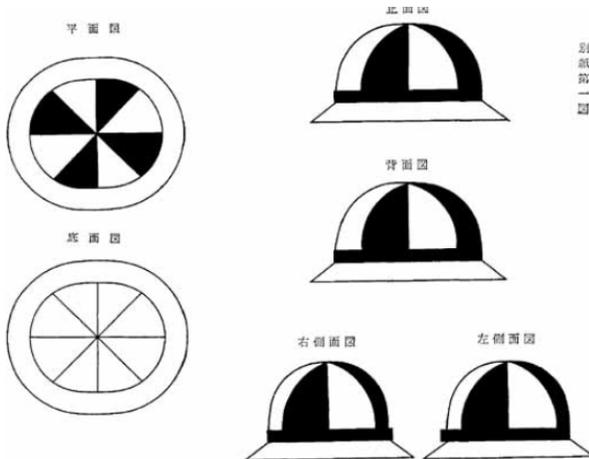
<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>
https://www.ip.courts.go.jp/app/files/hanrei_en/635/001635.pdf

Novelty (related to Prior designs)

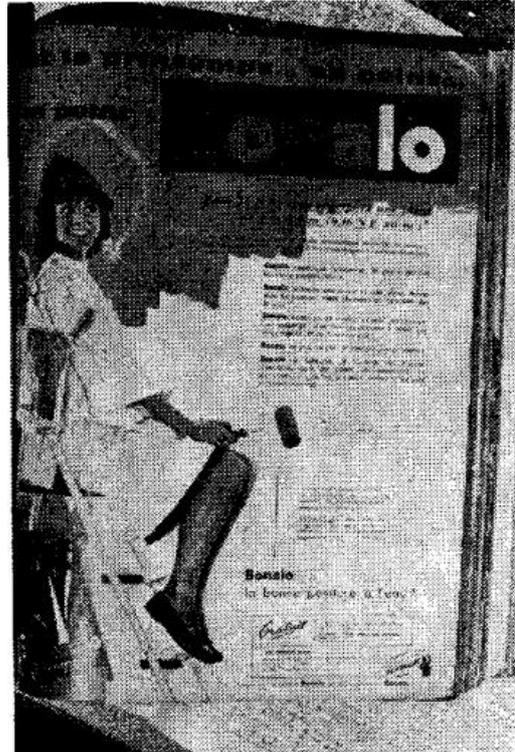
(Date) February 28, 1975

**<Supreme Court> 1973(Gyo-Tsu)82
"Cap" Case**

(Conclusion) Novelty should not be found. (Applicant lost)



(The applied design)



(Prior design)

Difference of colors might contribute to “Novelty,” but was denied in this case.

The combination of colors as pointed out as a difference between the two designs in the court of prior instance (black and yellow in the applied design, dark red and orange in the cited prior design) is, in short, merely a combination of two colors even by taking into consideration the difference in lightness and hue, which were pointed out in the court of prior instance.

As determined in the court of prior instance, the bicolor combination of the applied design is very common, and thus it is difficult to say that the difference in the color combination of the two designs is necessarily noticeable.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

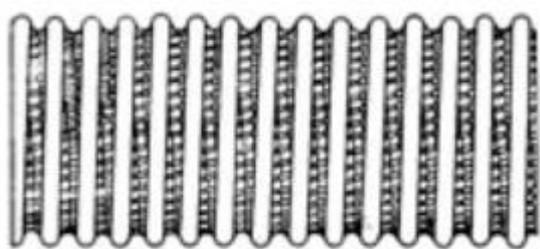
https://www.ip.courts.go.jp/app/files/hanrei_en/421/002421.pdf

Novelty (related to Prior designs)
Easiness to create the design

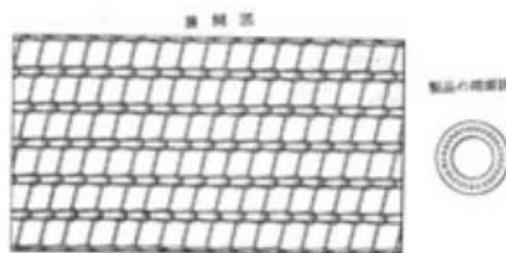
(Date) March 19, 1994

<Supreme Court> 1970(Gyo-Tsu)45
"Flexible and elastic hose" Case

(Conclusion) Novelty should be found. The registered design is not easy to create based on prior designs. (Design right owner won)



(The registered design)



(Prior design)

"Similarity" of novelty should be judged from the standpoint of general consumers.

In order to refuse registration on grounds of lack of novelty, the design is integral with the article and (1) the article of the applied design must be identical or similar to prior designs and (2) the design itself (= the article + shape etc.) also must be identical or similar to prior designs.

"Easiness to create" is not restricted based on the same or similar articles, but judged based on a motif widely known in society from the standpoint of a person skilled in the art.

<Writer: Hideki Takaishi (Attorney-at-law licensed in Japan and California)>

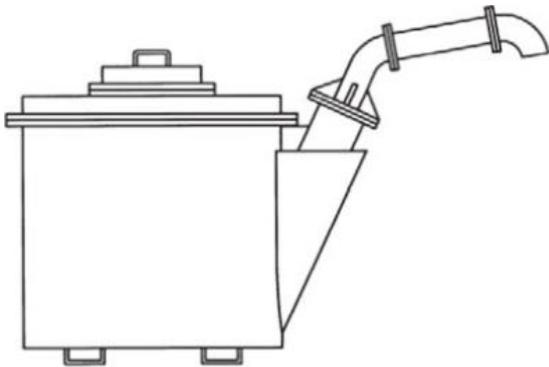
https://www.ip.courts.go.jp/app/files/hanrei_en/342/002342.pdf

Similarity of design (Infringement case)

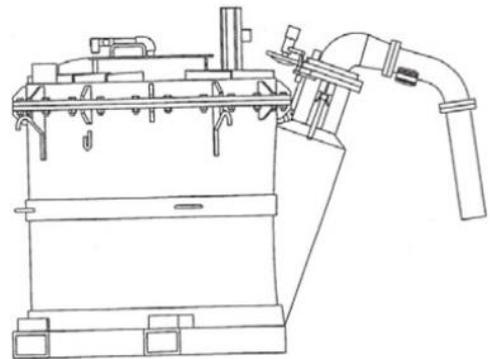
(Date) July 20, 2010

**<IP High Court> 2007 (Ne) 10032
"Container for Molten Metals " Case**

**(Conclusion) Defendant's design is similar to the registered design.
(Design right owner won)**



(The resistered design)



(Defendant's Container)

Even if a registered design includes public designs in part of its design, it is assumed that it will coexist with other features and constitute a different design.

Therefore, the inclusion of well-known or publicly-known designs does not necessarily mean that the part of the registered design should be immediately excluded from the essential feature.

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https://www.ip.courts.go.jp/app/files/hanrei_en/175/001175.pdf