

Flexible Elastic Hose Case
(Similarity and Creativity in Designs)
Supreme Court
S45 (Gyo-Tsu) No. 45, March 19, 1974

FACTS

Appellants filed an invalidation action with the Japan Patent Office against the registration of the present design as being similar to a prior hose design under Article 3(1)* of the Design Law and as lacking creativity under Article 3(2)** of the law. This action was not granted by the Appeals Board of the JPO. The Appellants filed a suit to revoke the appeal decision with the Tokyo High Court.

DISPOSITION IN THE LOWER COURT

The Tokyo High Court rejected the Appellants' claims by finding the present design dissimilar to the prior hose design:

“Whereas Article 3(1) of the law stipulates creativity of designs for identical or similar articles as a registration requirement, Article 3(2) requires creativity in designs for other articles (i.e., articles that are not identical or similar to the article in question). Therefore, in determining whether or not a design is creative for an article in the same field as the hoses in the present case, Article 3(1) of the law should solely be applicable, and Article 3(2) has no application thereto.”

The Appellants proceeded to appeal this ruling to the Supreme Court.

ISSUES

Is Article 3(2) of the Design Law applicable to designs for identical or similar articles? How does identicalness or similarity of articles relate to the determination of similarity and creativity in designs? How do the provisions of Article 3(1) and Article 3(2) complement each other?

HOLDING AND REASONING

The present appeal is dismissed since the present design is found to be neither similar to the prior design nor could it have been easily created therefrom. However, the opinion set forth in the original decision, that Article 3(2) of the law has no application to designs for identical or similar articles, should be deemed illegal in its interpretation of the law.

In contrast to Article 3(1), where identicalness or similarity in designs is in question, Article 3(2) concerns whether a person ordinarily skilled in the art would have been able to create the design easily on the basis of widely-known shapes, patterns or colors, or any combination thereof as abstract motifs separate from the articles. In other words, Article 3(2) is unconcerned as to whether articles are identical or similar.

The relationship between Article 3(1)III and Article 3(2) of the law may be further elaborated as follows:

Article 3(1)III concerns itself with similarity, in the eye of the ordinary consumer, in aesthetic impression of a design for an article that is identical or similar to the article to which the registered design is applied. On the other hand, Article 3(2) questions the novelty in conception or the creativity of a design in the eye of a person skilled in the art, based on widely known motifs outside the framework of identicalness or similarity of articles. Thus, these two provisions are considered fundamentally different in approach.

Therefore, designs for identical or similar articles may be refused under Article 3(1)III or Article 3(2). While such designs may not be found similar, the later design may be held to lack creativity under Article 3(2). If they are similar and the later design lacks creativity, it would only be necessary to apply 3(1)III as set forth in the provisions in parenthesis in Article 3(2).

* Article 3(1) of the Design Law

A creator of a design that is industrially applicable may be entitled to obtain a design registration for the design, except for the following:

(i) Designs that were publicly known in Japan or a foreign country, prior to the filing of the application for design registration;

- (ii) Designs that were described in a distributed publication, or designs that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application for design registration; or
- (iii) Designs similar to those prescribed in the preceding two items.

** Article 3(2) of the Design Law

(2) Where, prior to the filing of the application for design registration, a person ordinarily skilled in the art of the design would have been able to easily create the design based on shapes, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country, a design registration shall not be granted for such a design (except for designs prescribed in any of the items of the preceding paragraph), notwithstanding the preceding paragraph.