

Trial decision

Invalidation No. 2013-880020

Ibaraki, Japan

Demandant

WATANABE, Hajime

Tokyo, Japan

Patent Attorney

KAWASHIMA, Jun

Tokyo, Japan

Patent Attorney

WATANABE, Tsuneo

Chiba, Japan

Demandee

ORBIC CO. LTD.

Tokyo, Japan

Patent Attorney

HOSAKA, Michiko

Tokyo, Japan

Patent Attorney

MURAKAMI, Koichi

The case of trial regarding the invalidation of design registration for Design Registration No. 1381318, entitled "Motorcycle Wheel", between the parties above has resulted in the following trial decision.

Conclusion

Design Registration No. 1381318 is invalidated.

The costs in connection with the trial shall be borne by the demandee.

Reason

No. 1 The demandant's object of the demand and the grounds therefor

The demandant demanded the trial decision, "the Design Registration No. 1381318 is invalidated. The costs in connection with the trial shall be borne by the demandee", summarized grounds for the demand as follows, and submitted Evidences A

No. 1 to A No. 4 as means of evidence.

1. Gist of reasons for invalidation of design registration

The design of Design Registration No. 1381318 (hereinafter referred to as the "Registered Design") is, or is similar to, the design described in a publication that had been distributed in Japan before the Registered Design's application was filed on February 26, 2009, and thus the design cannot be granted design registration pursuant to the provisions of Article 3(1) of the Design Act.

Accordingly, the Registered Design should be invalidated under Article 48(1)(i) of the Design Act.

2. Registered Design

The Registered Design is a design that is granted design registration as Design Registration No. 1381318 (Evidence A No. 1), and the history of procedures and the like are as follows.

(1) History of procedures

The history of procedures for the Registered Design is as outlined below (Evidences A No. 1 and A No. 2).

February 26, 2009	Application for design registration
January 29, 2010	Establishment of the design right
March 1, 2010	Issue of a design bulletin

(2) Outline of the Registered Design

The article to the design of the Registered Design is a "motorcycle wheel" (Evidences A No. 1 and A No. 2), and the form of the Registered Design is as described in a design bulletin issued on March 1, 2010 with the registration number of "Design Registration No. 1381318" (Evidence A No. 2).

3. Designs of evidences (Cited Designs)

The designs cited by the demandant for invalidating the Registered Design (hereinafter referred to as the "Cited Designs") concern a "motorcycle wheel" described in a publication that had been distributed in Japan before the application date of the Registered Design, and are the following.

(1) Cited Designs (designs described in a publication)

(a) Cited Design 1

A wheel that is shown in the lower right of "CUSTOM AND RESTORE SHOP/MAD☆STAR" on page 209 of a magazine titled "Mr. Bike BG" issued on

December 1, 2005 (Motor Magazine Ltd.; Vol. 20, Issue No. 12) (Evidence A No. 3).

(b) Cited Design 2

A "cast wheel for GS400" that is shown in the upper right of "Extra Special Custom Bike & Original Seat" on page 118 of a magazine titled "CHAMP ROAD" issued on November 1, 2004 (KASAKURA PUBLISHING CO. LTD.; Vol. 18, Issue No. 11) (Evidence A No. 4).

4. Comparison between the Registered Design and Cited Designs

(1) Article to the design

The Registered Design and Cited Designs (Cited Designs 1 and 2) both related to a "motorcycle wheel", and thus they have the same article to the design.

(2) Form of the design

(A) Form of the Registered Design

a) The form of the Registered Design is as per Design Registration No. 1381318 described in a design bulletin issued on March 1, 2010 (Evidence A No. 2).

b) Since the article to the design of the Registered Design is a "motorcycle wheel", its essential features are the forms of the front view and rear view as shown in the above-mentioned design bulletin. The different feature of the front view and rear view is merely the presence or absence of the two very small semicircular notches that appear between the six small holes and the hole for an axle inside a hub in the rear view. So, this difference is such that it is not easy to uncover even its presence even by detailed comparison and study. As such, it can even be said that the front and back are identical, and it is sufficient for one side of the design to be compared with other designs.

(B) Forms of Cited Designs

The forms of Cited Designs are as follows. Cited Design 1 is as per Evidences A No. 3-2 and A No. 3-3. Cited Design 2 is as per Evidences A No. 4-2 and A No. 4-3.

(C) Basic constitution

Since the Registered Design and Cited Designs 1 and 2 consist of a hub, spokes, and a rim, with a circular hub and rim being connected to star-shaped spokes having seven apexes, and thus the Registered Design and Cited Designs 1 and 2 have the same basic constitution.

(D) Specific form

a) In the Registered Design and Cited Designs 1 and 2, fourteen spokes form around a hub a star shape with seven apexes (seven-pointed star), with apex portions of the star

shape being connected to the inside of a rim at equal spaces, and each of seven holes that are formed by a rim and spokes forms an almost fan shape. This form is identical or similar

b) The Registered Design and Cited Designs 1 and 2 have the same ratio of "4:1" for the wheel diameter and hub diameter. The proportion of a hub in the entire front or back is 1/16, or 6.25%, in area ratio, and the form of the above-mentioned star shape (seven-pointed star) and the shape of the fan shape, which constitute at least 90% (93.75%) of the entirety in area ratio, are identical or similar.

c) In the Registered Design and Cited Designs 1 and 2, six small holes and a hole for mounting an axle are formed inside a hub, and the form of a hub is identical or similar.

(E) Differences

As described above, the front and back of the Registered Design are its prominent features, but the front and back are so alike that they can almost be called identical, and it is difficult to find any difference. Now, when the front and back of the Registered Design are compared with those of Cited Designs 1 and 2, both designs are identical in the above-mentioned characteristics, and it is impossible to find any difference in their forms.

(F) Similarity

As described above, since the Registered Design and Cited Designs 1 and 2 have the same or common basic constitution and specific form, which form characteristics of a design, and it is difficult to find any difference in both designs, the Registered Design is identical with or similar to Cited Designs 1 and 2 in its form.

5. Conclusion

As described above, the Registered Design is, or is similar to, the design described in a publication that had been distributed in Japan before the Registered Design's application was filed, and thus there is no doubt that the Registered Design was registered while violating the provisions of Article 3(1) of the Design Act.

Thus, the Registered Design should be invalidated according to Article 48(1)(i) of the Design Act.

6. Means of evidence

(1) Evidence A No. 1 is submitted in proof of the Design Registration No. 1381318.

(2) Evidence A No. 2 is submitted in proof of the article to the design of, and the form of, the Registered Design.

(3) Evidences A No. 3 and A No. 4 are submitted in proof of the Registered Design

being identical or similar to the design described in a publication that had been distributed in Japan before the Registered Design's application was filed.

Evidence A No. 1: Registry of design registration for Design Registration No. 1381318 (copy)

Evidence A No. 2: Design bulletin for Design Registration No. 1381318 (copy)

Evidence A No. 3: Excerpt from "Mr. Bike BG" (Motor Magazine Ltd.; Vol. 20, Issue No. 12) (copy)

Evidence A No. 4: Excerpt from "CHAMP ROAD" (KASAKURA PUBLISHING CO. LTD.; Vol. 18, Issue No. 11) (copy)

No. 2 Demandee's reply and reasons

1. Purport of reply

The demandee, in response to the demandant's object of the demand and the grounds therefor, made a response to the effect that the demandee "requests the trial decision that the demand for trial of the case is groundless, and that the costs in connection with the trial shall be borne by the demandant".

2. Reasons for reply

2-1 Concerning Design Registration No. 1381318

(1) History of procedures

Design Registration No. 1381318 (hereinafter referred to as the "Registered Design") pertains to the application filed on February 26, 2009 and the registration granted on January 29, 2010.

(2) Outline of the Registered Design

As shown by Evidence B No. 1, the [article to the design] of the Registered Design is a "motorcycle wheel", and the [form of the design] is as shown by the [front view], [rear view], [left side view], [top view], [A-A sectional view], [B-B enlarged, end elevational view], [right-side view], and [bottom view].

2-2 Outline of reasons for invalidation as alleged by the demandant

The Registered Design is identical with or similar to Cited Design 1 or 2, which are described in a publication that had been distributed in Japan before the application of the Registered Design, and thus the Registered Design was registered while violating the provisions of Article 3(1) of the Design Act. Accordingly, the Registered Design should be invalidated pursuant to Article 48(1)(i) of the Design Act.

(1) Cited Design 1

Photograph shown in the magazine, "Mr. Bike BG" (Issued on December 1, 2005)
(Motor Magazine Ltd.; Vol. 20, Issue No. 12)

(2) Cited Design 2

Photograph shown in the magazine, "CHAMP ROAD" (Issued on November 1, 2004)

2-3 Similarity in the articles to the designs of the Registered Design and Cited Design 1 or 2

The article to the design of the Registered Design, and the articles to the design of the Cited Designs 1 and 2 both concern a motorcycle wheel, and thus both designs have the common article to the design.

2-4 Similarity in the forms of designs of the Registered Design and Cited Design 1 or 2

2-4-1 Essential features of the design

In a "motorcycle wheel" that is the article to the design of the Registered Design, essential features of the design include not just the top or rear. In other words, in determining the similarity of a motorcycle wheel, the difference from the perspective of the form that appears not just in the front view or the rear view, but also in the top view/bottom view, left-side view/right-side view, and sectional view, or namely, the difference from the perspective of a) the ratio of a rim diameter and rim width, b) the shape of the connecting part between a spoke and a rim, and c) whether or not a spoke projects in the front/rear direction to a rim, provides an important basis for the determination. Examples of registration are listed below.

(1) Design Registration No. 1381317 and Design Registration No. 1429079

(2) Design Registration No. 1325445 and Design Registration No. 1361413

(3) Design Registration No. 1369195 and Design Registration No. 1362149

2-4-2 Comparison in form of design between the Registered Design and Cited Design 1 or 2

As the subject of comparison with the form of the front view of the Registered Design, the photograph of Cited Design 1 or 2 as viewed from the front is available, but Cited Designs 1 and 2 do not provide information concerning their forms to be compared with the form of each of the drawings of the rear view, left-side view, top view, A-A sectional view, and B-B enlarged, end elevational view of the Registered Design.

2-4-3 Study

(1) Common features and different features in form

A Basic constitution

The Registered Design and Cited Designs 1 and 2 both consist of a hub, spokes, and a rim, with a circular hub and rim being connected to star-shaped spokes having seven apexes, and thus the Registered Design and Cited Designs 1 and 2 have the common basic constitution.

B Specific constitution

(i) In both the Registered Design and Cited Designs 1 and 2, when viewed from the front, fourteen spokes form around a hub a star shape with seven apexes, with apex portions of the star shape being connected to the inside of a rim at equal spaces, and each of seven holes that are formed by a rim and spokes forms an almost fan shape.

The holes of said almost fan shape are identical or similar between the Registered Design and Cited Designs 1 and 2, and thus both designs have these common features.

(ii) In both the Registered Design and Cited Designs 1 and 2, when viewed from the front, the ratio of wheel diameter to hub diameter is approximately 4:1, and thus both designs have this common feature.

(iii) In both the Registered Design and Cited Designs 1 and 2, when viewed from the front, six small holes and a hole for mounting an axle are formed inside a hub, and the form of a hub is identical or similar, and thus both designs have these common features.

On the other hand,

(iv) In the Registered Design, the ratio of the rim diameter to rim width is 13.5:1. In contrast, Cited Design 1 or 2 lacks the information concerning the form as viewed from the top or the side, and thus the ratio of the rim diameter to rim width of Cited Design 1 or 2 is unknown, and cannot be compared with that of the Registered Design.

Also on the other hand,

(v) In the Registered Design, a hub is on the concentric circle of a rim. In contrast, Cited Design 1 or 2 lacks the information concerning the form as viewed from the top or the side, and thus the positional relationship of the front-rear direction of a hub and rim of Cited Design 1 or 2 is unknown, and cannot be compared with that of the Registered Design.

Also on the other hand,

(vi) In the Registered Design, spokes connect a hub and a rim by a straight line, and spokes do not project forward or backward. In contrast, Cited Design 1 or 2 lacks the information concerning the form as viewed from the top or the side, or the information concerning the shape of the cross-section, and thus the form of the front-rear direction

of spokes of Cited Design 1 or 2 is unknown, and cannot be compared with that of the Registered Design.

2-4-4 Conclusion about the similarity in form

As described above, Cited Design 1 or 2 lacks the information concerning the form, such as the ratio of the rim diameter to rim width, shape of the connecting part between a spoke and a rim, and whether or not a spoke projects in the front/rear direction of a rim, which constitute elements of a design, and thus Cited Design 1 or 2 cannot be compared with the Registered Design.

Accordingly, it is impossible to determine that the form of the Registered Design is identical with or similar to the form of Cited Design 1 or 2.

3. Summary

The Registered Design and Cited Design 1 or 2 do not have the identical or similar form. Accordingly, the demandant's allegation that the Registered Design should be invalidated pursuant to Article 48(1)(i) of the Design Act because the Registered Design was registered while violating the provisions of Article 3(1) of the Design Act in relation to Cited Design 1 or 2 is groundless.

As such, the trial decision is requested as per the purport of reply.

4. Means of evidence

Evidences B No. 1 to B No. 6 provide proof of the matters described in the paragraph "2-4-1" of the reasons for reply.

- (1) Evidence B No. 1: Copy of Publication of Design Registration No. 1381317
- (2) Evidence B No. 2: Copy of Publication of Design Registration No. 1429079
- (3) Evidence B No. 3: Copy of Publication of Design Registration No. 1325445
- (4) Evidence B No. 4: Copy of Publication of Design Registration No. 1361413
- (5) Evidence B No. 5: Copy of Publication of Design Registration No. 1369195
- (6) Evidence B No. 6: Copy of Publication of Design Registration No. 1362149

No. 3 Oral proceeding

The body held an oral proceeding for the trial on December 3, 2014. (Trial record of oral proceedings dated December 3, 2014)

1. Demandant

The demandant made a statement to the effect that the purport of the request and

the reasons therefor are as per the written request for trial and the oral proceedings statement brief dated November 7, 2014. Furthermore, the demandant submitted, by a written statement dated December 3, 2014, a list of corrections to the evidences for the written request for trial and the oral proceedings statement brief.

In the oral proceedings statement brief, the demandant rebutted the demandee's written reply concerning the comparison between the Registered Design, and the design of Evidence A No. 3 and the design of Evidence A No. 4. The demandant alleged that Cited Design 1 concerns Evidence A No. 3 and Cited Design 2 concerns Evidence A No. 4, and also that Part Number 34 of Evidence A No. 3-2 and Evidence A No. 4-2 concern the identical article because the car model indicating the compatible car type of the wheel is the same "GS400". In the oral proceeding, the demandant brought in the originals of Evidence A No. 3 and Evidence A No. 4 and stated, concerning the photograph of Evidence A No. 7, which was submitted with the written statement dated December 3, 2014, that it is the photograph of the article to Cited Design 2 (Evidence A No. 4), and submitted as evidences, along with the oral proceedings statement brief, Evidence A No. 3-4, Evidence A No. 5, and Evidence A No. 6, and submitted, along with the written statement dated December 3, 2014, Evidences A No. 4-4, A No. 4-5, A No. 6-6, A No. 7, A No. 8, and a list of corrections.

(Means of evidence)

A Oral proceedings statement brief dated November 7, 2014

(1) Evidence A No. 3-2 (already submitted), Evidence A No. 3-3 (already submitted), and Evidence A No. 3-4 are evidences indicating that the demandee had sold the wheel for the Registered Design before its application, and that the Registered Design was publicly known before its application. (Excerpt (copy) from "Mr. Bike BG" Motor Magazine Ltd.; Vol. 20, Issue No. 12)

(2) Evidence A No. 3-3 is the evidence indicating that Evidence A No. 3-2 is an advertisement by the demandee.

Enlargement of the description in the upper right of Evidence A No. 3-2

(3) Evidence A No. 5 is an evidence for the motorcycle "GS400". (Documents from a website (Wikipedia, corporate history of SUZUKI MOTOR CORPORATION) and copies of photographs (excerpts from a magazine) of GS400

(4) Evidence A No. 6 is the evidence indicating that a cast wheel for "GS400" called "Seven Star" had been provided by "Daytona" before the application of the Registered Design. (Excerpt (copy) from "Motorcycle (Issued in August 1979)" (Motor Magazine Ltd.; Vol. 45, Issue No. 9) and advertisement (copy of an excerpt from a magazine) by "Daytona" for the "Seven Star" wheel)

B Written statement dated December 3, 2014

Concerning Cited Design 2 described in the written request for trial, Evidence A No. 4-4, Evidence A No. 4-5 (different page of the publication of Evidence A No. 4), Evidence A No. 7 (the photograph of the article to Cited Design 2; referred to as "Cited Design 3"), and Evidence A No. 8 were submitted as supplementary documents, and corrections were made to the written request for trial and the oral proceedings statement brief as well as to Evidence A No. 6-6.

The demandant alleged that Evidence A. No. 7, which is the photograph of the article to Cited Design 2 and is submitted to make correction to page 8 of the oral proceedings statement brief and provides evidence indicating that the front and back are almost identical, is a photograph of a wheel for SUZUKI GS400 that is owned by the president of "COLORS" in Ibaraki prefecture, and that the photograph was taken by the demandant's patent attorney on April 19, 2013, and states that the photograph of SUZUKI GS400 with this wheel mounted thereon was provided to a magazine titled "Kyushakai" and was published in "Kyushakai CHAMP -Champ Road Special Edition" (KASAKURA PUBLISHING CO. LTD.; Issued on August 1, 2007) (Evidence A No. 8).

(1) Evidences A No. 4-4 and A No. 4-5

(2) Evidence A No. 6-6

(3) Evidence A No. 7

(4) Evidence A No. 8 "Kyushakai CHAMP -Champ Road Special Edition"
(KASAKURA PUBLISHING CO. LTD.; Issued on August 1, 2007) page 16

2. Demandee

The Demandee made a statement as described in the written reply for the trial case. The demandee stated that the purport of reply and the reasons therefor are as per the written reply for trial dated February 17, 2014 and the oral proceedings statement brief dated November 20, 2014.

Furthermore, it was decided that the demandee submit a written statement no later than by December 25, 2014 in addition to sending the same by fax to the other party and the Infringement and Invalidation Affairs Office of the JPO. In the oral proceeding, the demandee made arguments against the demandant's oral proceedings statement brief, and alleged that the Registered Design, and the designs of Evidence A No. 3 and A No. 4 are not similar.

(Means of evidence)

Oral proceedings statement brief dated November 20, 2014

- (1) Evidence B No. 7 The fact that multiple types of products of different rim widths are available as a wheel that is compatible to the motorcycle of the same vehicle type
- (2) Evidence B No. 8 The purport of proof is the same as Evidence B No. 7
- (3) Evidence B No. 9 The fact that there exists a motorcycle wheel with the rear shape that is significantly different from the front shape

3. Chief administrative judge

In the oral proceeding, the chief administrative judge informed both parties that the trial will be conducted by documentary proceedings after this.

4. Demandee's written statement

The demandee submitted a written statement dated December 25, 2014 against the demandant's written statement dated December 3, 2014, alleging that Cited Design 1 (A-3) and Cited Design 2 (A-4) are different products with different shapes in details.

As shown in the enlarged view of the surrounding area of a hub (B 10-1: Front view, B 10-2: Rear view) of the front view and rear view of the Registered Design, the presence or absence of a thin, folded, projecting part drawn by oblique lines is a characterizing portion to visually recognize that the Registered Design does not have the same shape as Cited Design 1 (A-3) and Cited Design 2 (A-4).

In other words, this thin, folded, projecting part is not present in Cited Design 1 (manufactured by Daytona, vintage), or in such other wheels manufactured by Daytona as A6-6 (a wheel that was manufactured by Daytona and was published in a magazine in 1979) resubmitted by the demandant along with a written statement (December 3, 2014). It is visually recognized that the Registered Design and Cited Design do not have the same shape.

On the other hand, this thin, folded, projecting part is present in Cited Design 2 (A-4), and thus it is also visibly recognized that Cited Design 1 (A-3) and Cited Design 2 (A-4) do not have the same shape.

Means of evidence

Written statement dated December 25, 2014

- (1) Evidence B No. 10 Enlarged view of a design bulletin (front view and rear view) of the Registered Design (presence of the shape (thin, folded, projecting part) around a hub in the Registered Design)
- (2) Evidence B No. 11 Written statement by the demandee's patent attorney (the fact that the demandant found that the wheels of A-3 and A-4 are different products with different shapes)

No. 4 The body's notice of reasons for invalidation

A notice of reasons for invalidation dated May 1, 2015 was sent to the parties informing that, since it is found that the Registered Design is similar to the design described in a publication that had been distributed in Japan before the application of Evidence A No. 3-2 attached to a written request for trial as submitted by the demandant, the Registered Design cannot be granted design registration because it falls under the design according to the provisions of Article 3(1)(iii) of the Design Act (a design that cannot be granted design registration because of its similarity to a prior, publicly known design) (hereinafter referred to as "Cited Design"). The notice also indicated the following.

Cited Design

The design of a wheel (on the right) of "Real vintage Seven Star cast wheel for GS400" published as No. 34 in the center of the lowest paragraph on page 209, "CUSTOM AND RESTORE SHOP/MAD-STAR" of a magazine issued by Motor Magazine Ltd., "Mr. Bike BG" (Vol. 20, Issue No. 12) on December 1, 2005 (the design of Evidences A No. 3-1 to A No. 3-3 as submitted by the demandant: Refer to Appendix 2).

While the rear view of the Registered Design has almost the same shape as the front view except for a shaft portion at the center, and the photograph of the above Cited Design fails to show the shape itself of the rear or the shape of the cross-section, it can be found, from the form as viewed from the front side and shown sterically in the photograph, that at least the shape of the spoke portion on the rear side is the same as that on the front side, and thus the Registered Design and the above Cited Design have the common shape in the spoke part, and that they are similar to each other based on the strong impression given by this common feature.

No. 5 Written opinion submitted by the demandee

The demandee submitted a written opinion dated June 9, 2015 alleging the following.

As pointed out by the notice, it can be visibly recognized that the general constitution of the spokes on the rear side of the present Cited Design (a star-shaped heptagon with sharp apex angles) is the same as that of the spokes on the front side, and the constitution may give a strong impression to an observer. However, while the general constitution (a star-shaped heptagon with sharp apex angles) of the spokes on

the rear side of the present Cited Design is presumable, specific shapes thereof are unknown. Also, as for the constituent parts other than the spokes on the rear side as well as the entire constituent parts on the lateral side, nothing is visibly recognizable.

In case that the circumstances are exceptional, such as when the shapes of most constituent parts of Cited Design are made clear, and if, in spite of some parts with unknown shapes, the scope (area) occupied by said parts compared to the entire design is so small that said parts are highly unlikely to affect the determination of similarity regardless of the shapes of said parts, it may be permissible, as an exceptional case, to make the determination of similarity without visually recognizing said parts. However, as in the present case, when the rear and the side that constitute at least half of Cited Design cannot be visually recognized, the method of determining the similarity of the design while said parts remain unknown is illegal as per the holding in a suit to revoke the trial decision (B-12).

Means of evidence

Written opinion dated June 9, 2015

(1) Evidence B No. 12 "Information about Court Cases" (copy) from the website of "COURTS IN JAPAN" (In Case of 2005 (Gyo-Ke) 10620, the fact that a judgement was rendered to the effect that it is illegal to make a determination of similarity of a design if the rear view and the like of cannot be confirmed)

(2) Evidence B No. 13 Appeal/Trial Decision Publication (copy) (the fact that the shape on the rear side of a cited design in Invalidation No. 2005-88003 is unknown like Cited Design in the present trial)

(3) Evidence B No. 14 "JPO Data Bank for IP Information about Developing Nations, Etc."

(<https://www.globalipdb.jpo.go.jp/precedent/2852/>) (copy)

(The fact that the Higher People's Court of Beijing rendered a civil judgement to the effect that it is illegal to make a determination of similarity for a design that has an unknown surface as to the shape of its appearance)

(4) Evidence B No. 15 "Reference Material 2 Specific methods of determining similarity of a design in court cases" in "3rd Design System Subcommittee (November 17, 2004)" (copy)

(5) Evidence B No. 16 Published appeal and trial decisions (copy)

(Contents of examination and trial decision for the trial over rear wheel (Invalidation No. 2013-880011))

No. 6 Judgment by the body

The body renders the judgment that, as per indicated in the notice of reasons for invalidation, the Registered Design is found to be similar to Cited Design of the "cast wheel for GS400" for a motorcycle as shown in cited documents and falls under the category of Article 3(1)(iii) of the Design Act, and thus it cannot be granted design registration.

1. Registered Design

The Registered Design (design of Design Registration No. 1381318) applied for design registration on February 26, 2009, and an establishment of the design right was registered on January 29, 2010, with the article to the design being a "motorcycle wheel" and the form being as described in the application and in the drawing attached to the application. (Evidences A No. 2-1 to A No. 2-4 as submitted by the demandant: Refer to Appendix 1).

In other words, the Registered Design concerns a wheel for mounting a tire on a vehicle's wheel that is used for a motorcycle to run.

The form thereof consists of an annular rim portion, which is the outer-ring, an almost short cylindrical hub portion that surrounds a shaft portion in the center, and an almost bar-like spoke portions connecting the rim portion and the hub portion. Between the hub portion and the rim portion are fourteen thin almost bar-like spoke portions that form around the hub portion an almost star shape portion consisting of seven identical shapes of isosceles triangles (hereinafter this portion is called "Almost-Star-Shaped Portion"), and on the front side and rear side of the rim portion that is positioned at tip portions of the Almost-Star-Shaped Portion, as well as on the front side and rear side of the external side of the hub portion, seven rib portions of almost small rectangular shapes are provided respectively, and between the spoke portion on the front side and on the spoke portion on the rear side, a thin plate portion (hereinafter this portion is called "Thin Plate Portion") is provided, and in the Thin Plate Portion, seven holes of almost fan shapes with rounded corners, with the rim portion side shaped arc-like, are provided on the front-view outside of the Almost-Star-Shaped Portion, and seven holes of almost triangular shapes with rounded corners are provided on the front-view inside of the Almost-Star-Shaped Portion, and the hub portion has an almost short cylindrical shape with a diameter of almost $\frac{1}{4}$ of the outer diameter of the rim portion, and the shaft portion has a circular hole in the center, having a cylindrical shape with a diameter of almost $\frac{1}{9}$ of the outer diameter of the rim portion, projecting from the hub portion to the front side and rear side, and the hub portion of an almost short cylindrical shape surrounding the shaft portion, formed stepwise in a

cross-sectional view, is thinly provided in the direction of the Thin Plate Portion, with six small circular hole portions radially arranged around the shaft portion on the front side and rear side of the hub portion, and very small notch portions provided in the two opposite places on the circular edge portion surrounding the shaft portion on the rear side, and the frame part of the rim portion has a cross-sectional shape that is in an almost arrow feather shape, and the thickness thereof gets slightly thinner as it approaches the hub portion.

2. Concerning Cited Design

Cited Design is a design of a wheel of the photograph shown in the right side of "Real vintage Seven Star cast wheel for GS400" published as No. 34 in the center of the lower paragraph on page 209, "CUSTOM AND RESTORE SHOP/MAD-STAR" of the magazine issued by Motor Magazine Ltd., "Mr. Bike BG" (Vol. 20, Issue No. 12) on December 1, 2005 (the design of Evidences A No. 3-1 to A No. 3-3 as submitted by the demandant: Refer to Appendix 2).

Cited Design has a tire on the external side, but it is a design of a wheel. Also, the direction of Cited Design is found to be the front to be matched with the direction of the drawing of the Registered Design. Observation is made based on the direction of the front view of the Registered Design.

The form thereof consists of an annular rim portion, which is the outer-ring, an almost short cylindrical hub portion that surrounds a shaft portion in the center, and almost bar-like spoke portions connecting the rim portion and the hub portion, and the hub portion and the rim portion form around the hub portion an Almost-Star-Shaped Portion consisting of seven identical shapes of isosceles triangles by fourteen thin almost bar-like spoke portions, and on the front side of the rim portion that is positioned at tip portions of the Almost-Star-Shaped Portion, and on the external side of the hub portion, seven rib portions of almost small rectangular shapes are provided respectively, and between the spoke portion on the front side and the spoke portion on the rear side, a Thin Plate Portion is provided, and in the Thin Plate Portion, seven holes of almost fan shapes with rounded corners, with the rim portion side shaped arc-like, are provided on the front-view outside of the Almost-Star-Shaped Portion, and seven holes of almost triangular shapes with rounded corners are provided on the front-view inside of the Almost-Star-Shaped Portion of the spoke portion, and the hub portion has an almost short cylindrical shape with a diameter of almost $\frac{2}{5}$ of the outer diameter of a rim portion, and the hub portion of an almost short cylindrical shape surrounding the shaft portion, formed stepwise in a cross-sectional view, is thinly provided in the direction of

the Thin Plate Portion, and the thickness of the rim portion surrounding the shaft portion gets slightly thinner as it approaches the hub portion.

3. Comparison between the Registered Design and Cited Design

(1) The article to the design

First, the article to the design of the Registered Design is a "motorcycle wheel", and that of Cited Design is a "cast wheel", but both concern a wheel that is used on a motorcycle, and thus both designs have the common article to the design.

(2) Common features in form

Both designs have the following main common features:

- (a) Consisting of an annular rim portion, which is the outer-ring, an almost short cylindrical hub portion that surrounds a shaft portion in the center, and almost bar-like spoke portions connecting the rim portion and the hub portion, and the hub portion and the rim portion forming around the hub portion an Almost-Star-Shaped Portion consisting of seven identical shapes of isosceles triangles by fourteen thin almost bar-like spoke portions;
- (b) On the front side of the rim portion side at tip portions of the Almost-Star-Shaped Portion, and on the external side of the hub portion, seven rib portions of small rectangular shapes being provided;
- (c) a Thin Plate Portion being provided between the spoke portion on the front side and the spoke portion on the rear side, and in the Thin Plate Portion, seven holes of almost fan shapes with rounded corners, with the rim portion side shaped arc-like, being provided on the front-view outside of the Almost-Star-Shaped Portion, and seven holes of almost triangular shapes with rounded corners being provided on the front-view inside of the Almost-Star-Shaped Portion; and
- (d) The hub portion having an almost short cylindrical shape with a diameter of almost $\frac{2}{5}$ of the outer diameter of the rim portion.

(3) Differences in form

On the other hand, the following main differences are found in both designs:

- (i) Concerning the form of the hub portion, in the Registered Design, there are six small circular hole portions arranged radially around the shaft portion on the front side and rear side of the hub portion, whereas in Cited Design, the presence of small circular hole portions is unclear, and thus the form of the hub portion on the rear side is not visibly recognizable;
- (ii) Concerning the form of the rim portion, in the Registered Design, the frame part has a cross-sectional shape that is in an almost arrow feather shape, whereas in Cited Design,

the cross-sectional shape of the frame part is unknown; and

(iii) Concerning the form of the shaft part, ((iii)-1) in the Registered Design, it is a cylindrical shape having the diameter of almost $\frac{1}{9}$ of the outer diameter of the rim portion, whereas in Cited Design, the diameter of the shaft portion is unclear.

Furthermore, ((iii)-2) in the Registered Design, very small notch portions are provided in the two opposite places on the circular edge portion surrounding the shaft portion on the rear side, whereas in Cited Design, the surrounding of the shaft portion on the rear side is not visibly recognizable.

(4) Determination of similarity between the two designs

In view of the above, concerning the form of common features, the feature (a) of consisting of an annular rim portion, which is the outer-ring, and a circular hub portion that surrounds a shaft portion in the center, and almost bar-like spoke portions connecting the rim portion and the hub portion, and the hub portion and the rim portion forming around the hub portion an Almost-Star-Shaped Portion consisting of seven identical shapes of isosceles triangles by fourteen thin almost bar-like spoke portions, constitutes the framework of the shape of both designs, and it relates to the whole entirety that easily attracts the attention of consumers, and thus it greatly affects the determination of similarity of both designs. Furthermore, concerning the feature (b) of seven rib portions of small rectangular shapes being provided on the front side of the rim portion that is positioned at tip portions of the Almost-Star-Shaped Portion, and on the external side of the hub portion, while this common feature is minor, it, along with the form of the Almost-Star-Shaped Portion, gives the impression of being a feature common in the two designs, and thus it can be said that it affects the determination of similarity of the design to some extent. In addition, the feature (c) of a Thin Plate Portion between the spoke portion on the front side and the spoke portion on the rear side, which has seven holes of almost fan shapes with rounded corners, with the rim portion side shaped arc-like, being provided on the front-view outside of the Almost-Star-Shaped Portion, and which has seven holes of almost triangular shapes with rounded corners being provided on the front-view inside of the spoke portion, is not an outstanding characteristic, but when even the Thin Plate Portion is shared in common, it further increases the shared sense of similarity between the two designs, thus affecting the determination of similarity between both designs to some extent. Additionally, concerning the feature of (d) that the hub portion has an almost short cylindrical shape with a diameter of almost $\frac{2}{5}$ of the outer diameter of the rim portion, it is a common feature in an eye-catching site provided at the center place that easily attracts attention, and thus it can be said that it affects the determination of similarity

between both designs to some extent.

Then, the form pertaining to the above-mentioned common features (a) to (d) strongly gives consumers the common aesthetic impression when the visual effect synergistically produced therefrom is also taken into consideration, thus defining the determination of similarity between both designs.

To the contrary, the effect produced by above differences on the determination of similarity of both designs is so slight that it cannot be considered as changing the aesthetic impression that is shared by both designs.

In other words, the form of a hub portion of Difference (i) is the difference of whether the presence of small circular hole portions is visibly recognizable or not, and this site is such that it is hidden by a disk portion or the like to be invisible at the time of use, and when the design is viewed in its entirety, Difference(i) can be considered as a partial and minor difference. Furthermore, the subject having the same form as the hub portion of the Registered Design was already published in a publication before the application of the Registered Design (for example, the designs of the above-mentioned Evidences A No. 4-2 and A No. 4-3 as submitted by the demandant: Refer to Appendix 3), therefore the form of the hub portion of the Registered Design cannot be considered as being new only to the Registered Design. Thus, it cannot be said that the difference would greatly affect the determination of similarity of both designs.

Next, concerning the form of the rim portion of the difference (ii), in the field of articles of this type of wheels, a tire is mounted at the time of use, and the difference in the shape of the cross-section in the rim portion is a difference concerning a site that is normally not visibly recognizable, and thus even if there is difference in this shape, the effect of this difference on the determination of similarity between both designs is only slight.

Then, as for the form of the shaft portion of Difference (iii), concerning the feature that the diameter of the shaft portion of Cited Design is unclear in the diameter of the shaft portion of the Difference (iii-1), the feature that the shaft portion has a cylindrical shape is naturally presumable based on the structure of the article, and as for the diameter, the diameter is inevitably limited to a certain size if it is a motorcycle wheel. Furthermore, the subject having the same form as the shaft portion of the Registered Design is already published in a publication before the application of the Registered Design (for example, the designs of the above-mentioned Evidences A No. 4-2 and 4-3 as submitted by the demandant; refer to Appendix 3), therefore the form of the shaft portion of the Registered Design cannot be considered as being new only to the Registered Design In addition, Difference(iii-2), concerning the presence or absence of

very small notch portions in the two opposite places on the circular edge portion surrounding the shaft portion on the rear side, can be considered as small and pertaining to a detail that is unnoticeable. Furthermore, the subject having the form that consists of very small notch portions like the shaft portion of the Registered Design is already found to have existed before the application of the Registered Design (for example, Reference Design 1: Similar Design No. 4 of Design Registration No. 478640; refer to Appendix 4), therefore the form that consists of very small notch portions cannot be considered as being new only to the Registered Design, or the form is especially characteristic. Accordingly, the effect of the difference on the determination of similarity between the two designs is small.

(5) Summary

As described above, both the Registered Design and Cited Design have the common article to the design. As for the form, even when the foregoing differences are synthesized, the effect produced by the common features is superior to the effect produced by the different features in terms of the effect as a visually appealing design, so that both designs in the entirety produce a common aesthetic impression to the consumers. As such, the form of both designs is similar.

4. Concerning the demandee's allegation

The demandee alleges that in Cited Design, nothing about the constituent parts except for spokes on the rear side, and about the entire constituent parts on the lateral side, is visibly recognizable. However, in the field of articles of this type of motorcycle wheels, it is often the case that the cross section of a rim of a front wheel is narrow in width, and especially the front side and the rear side have the same design in many cases. Also in the case of a cast wheel for GS400, the same design appears as the form of both sides of a motorcycle wheel, as is indicated by the design of Evidence A No. 7 (Refer to Appendix 5) submitted by the demandant.

Furthermore, as for the design of Evidence A No. 7, Evidence A No. 8-2 (Refer to Appendix 6) shows that a magazine issued in 2007 indicates the condition of using a cast wheel for GS400, and based on the description in Evidence A No. 4-2 (refer to Appendix 3), at least before July 2006, the fact that the form of a "cast wheel for GS400" was published in a publication that was already publicly known can be confirmed. According to the written statement dated December 3, 2014, Evidence A No. 7 is a photograph of a wheel for SUZUKI GS400 owned by the representative of "COLORS" located in Ibaraki prefecture, and a photograph of the motorcycle GS400 on which this wheel was mounted was provided to the magazine "Kyushakai", and was

published in page 16 of the magazine "Kyushakai CHAMP -Champ Road Special Edition" (above-mentioned Evidence A No. 8-2 (refer to Appendix 6)).

Also, from the description of Evidence A No. 3-2 of Cited Design of "Real vintage Seven Star cast wheel for GS400", it is clear that at least a real Seven Star cast was sold before December 2005 and the photograph of the real Seven Star cast was published for sale of the wheel at secondhand. The Cited Design is a design published in a publication before the application of the Registered Design, and it is the front wheel of a "cast wheel for GS400" for a motorcycle, and furthermore, it is found based on Evidence A No. 7 that the form on the front side and the form on the rear side of the front wheel of a "cast wheel for GS400" has almost the same form.

In view of the above, Cited Design is a design published in a publication before the application of the Registered Design as a cast wheel for GS400, and although the form of the hub portion and the form on the rear side are not visibly recognizable, in the field of this type of article, it can be said that the form of a spoke portion is what attracts attention and interest from consumers the most, and the form of the spoke portion of Cited Design is visibly recognizable from the photograph of Cited Design. It is presumably recognizable that in Cited Design, the form of the spoke portion on the rear side is the same as that on the front side. Furthermore, concerning the feature that the diameter of the shaft portion of Cited Design is unclear, the form of the shaft portion of the Registered Design is merely the form that is seen in a design that was already published in a publication before the application of the Registered Design, and cannot be found as being original to the Registered Design. As such, it is found that the Registered Design is similar to Cited Design.

In addition, the demandee alleges that the rear side of Cited Design is not visibly recognizable, and that it is illegal to use such a design as a cited design, but there exists a decision of the Intellectual Property High Court which held that "the plaintiff's argument cannot be adopted because the unclear specific form of the cited design is such a detailed form that it cannot be said to define the cited design" (Decision rendered on January 31, 2008; 2007 (Gyo-Ke) 10247; case of a request to revoke the trial decision). As such, it does not mean that a cited design cannot be used unless the entirety of the specific form of the cited design is completely disclosed. As described above, citation of Cited Design that is published in the publication as a design that is similar to the Registered Design cannot be considered as illegal.

5. Summary

Thus, as per the notice of reasons for invalidation, it is found that the Registered

Design is similar to the design of a "cast wheel for GS400" for a motorcycle as shown in the cited documents (Evidences A No. 3-1 to A No. 3-3), and thus it is found that the Registered Design is similar to Cited Design described in the publication that had been distributed in Japan before the application of the Registered Design.

Accordingly, the Registered Design falls under the category of Article 3(1)(iii) of the Design Act and cannot be granted the design registration, and the design registration of the Registered Design has the reasons for invalidation and falls under the category of Article 48(1)(i) of the same act.

No. 7 Conclusion

As described above, the Registered Design was granted design registration in spite of falling under the category of Article 3(1)(iii) of the Design Act based on the design shown by Cited Design described in the notice of reasons for invalidation. As such, the design registration of the Registered Design falls under the category of Article 48(1)(i) of the Design Act and shall be invalidated.

Therefore, the trial decision shall be made as described in the conclusion.

July 15, 2015

Chief administrative judge:	KOBAYASHI, Hirokazu
Administrative judge:	SAITO, Takae
Administrative judge:	EZUKA, Naohiro

別紙第1 本件登録意匠 #1

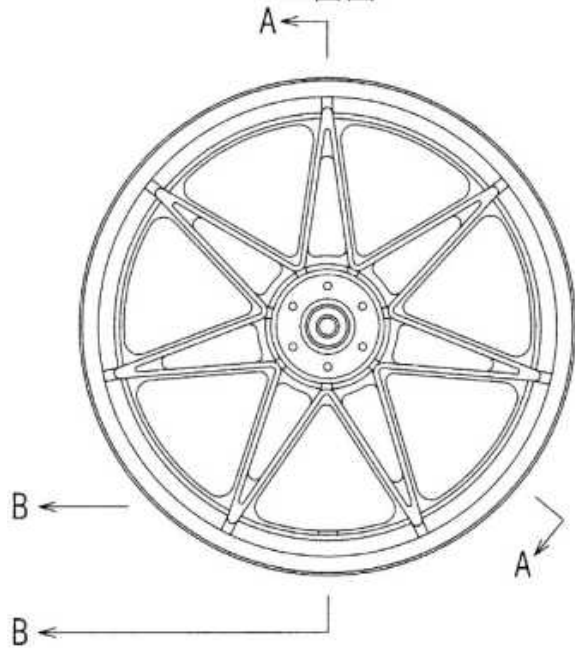
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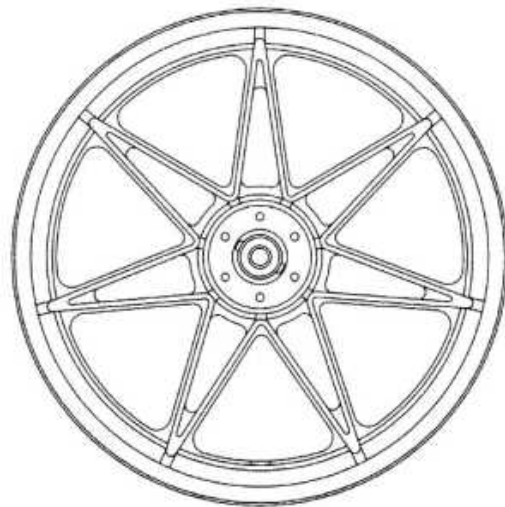
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#2 正面図



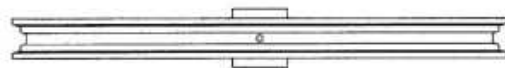
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#4 平面図



#5 底面図



#6

左側面図



#7

右側面図



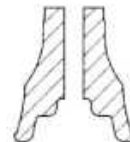
#8

A-A断面図



#9

B-B拡大端面図



- #1 Appendix 1 Registered Design
- #2 Front View
- #3 Rear View
- #4 Top View
- #5 Bottom View
- #6 Left-Side View
- #7 Right-Side View
- #8 A-A Sectional View
- #9 B-B Enlarged, End Elevational View

別紙第 4 参考意匠 1

#1

日本国特許庁

昭和 54.3.5 発行

意 匠 公 報

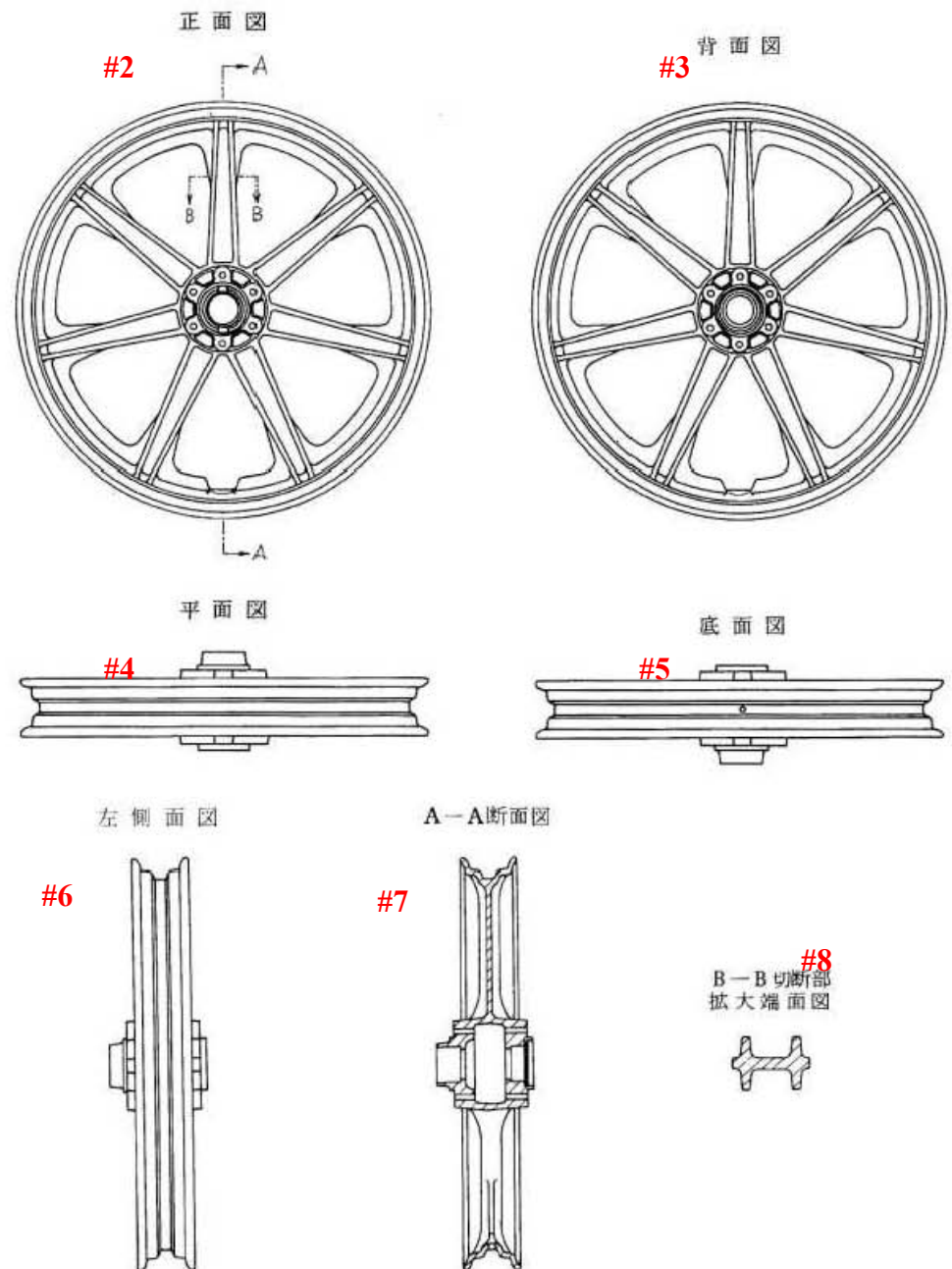
47—93 類似

478640 の類似 4 出願 昭 51.11.24 意願 昭 51—46111 登録 昭 53.11.28

創 作 者 鈴 木 俊 之 島田市中溝町 2384 の 8

意 匠 権 者 ヤマハ発動機株式会社 磐田市新貝 2500

意匠に係る物品 自動二輪車用ホイール
 説 明 右側面図は左側面図と対称にあられる



- #1 Appendix 4 Reference Design 1
- #2 Front View
- #3 Rear View
- #4 Top View
- #5 Bottom View
- #6 Left-Side View
- #7 A-A Sectional View
- #8 B-B Enlarged, End Elevational View