Appeal Decision

Appeal No. 2020-14335

Appellant Ferrari S.p.A.

Patent Attorney ITOH, Tadashige

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The case of appeal against the examiner's decision of refusal of Japanese Design Application No. 2019-17755, entitled "Racing car" has resulted in the following appeal decision.

Conclusion

The examiner's decision is revoked.

The design in the application shall be registered.

Reason

No. 1 History of the procedures

The present application is an application for design registration filed on August 8, 2019, claiming a priority under the Paris Convention, based on an application to the European Union Intellectual Property Office filed on February 13, 2019. Despite submission of a written opinion on April 21, 2020 in response to a notice of reasons for refusal dated January 8, 2020, an examiner's decision of refusal was issued dated July 2, 2020. Against this, a demand for appeal against the examiner's decision of refusal was made on October 13, 2020.

No. 2 The design in the application

An article to the design of the design in the application is "Racing car," and the shape, patterns or colors, or any combination thereof (hereinafter, "the shape, patterns or colors, or any combination thereof" are referred to as "the form") are as described in the description of the application and the drawings attached to the application (see Appendix 1).

No. 3 Reasons for refusal stated in the examiner's decision and the cited design

The reasons for refusal stated in the examiner's decision is that the design in the application is similar to a design that was described in a distributed publication or a design that was made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application (hereinafter, referred to as "the Cited Design"), and thus, it falls under the design 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), and cannot be granted the design registration. The design cited in the reasons for refusal is as follows (see Appendix 2).

The Cited Design

European Union Design Bulletin July 27, 2018

The designs of Automobile (Registration No. 004709616-0002 Motor cars)

(Publicly Known Information in Design Division of Japan Patent Office No. HH30204279)

No. 4 Comparison

1 Comparison with the article to the design

Although the article to the design of the design in the application is "Racing car," and the article to the design of the Cited Design is "Automobile," since both are a formula car type automobile, the articles to the design of the design in the application and the Cited Design (hereinafter, referred to as "the two designs") are identical.

2 Comparison of the form

(1) In the comparison of the form of the two designs, a direction seen from a vehicle body front side is made to be "a front direction" (in the drawings of the design in the application, it is shown as "a left side view"), and a direction seen from a vehicle body right side is made to be "a right side direction" (in the drawings of the design in the application, it is shown as "a front view"). Concerning the form of members on both of left and right sides in the front direction, the member on the right side is mainly mentioned.

(2) Common features of the form

The two designs are common in (A) a basic constitution in which at a part near a tip end of an elongated nose that extends forward from a cockpit in the center of a vehicle body, front suspensions projecting out to the left and right are provided to arrange front wheels; a front wing is arranged in a hammer head shape at a tip end part of the nose; side pods that bulge to the left and right of the cockpit and narrow down rearward are provided; an induction pod is provided in front of a rear protrusion portion of the cockpit; the protrusion portion is gradually lowered rearward to form both left and right sides in an inclined surface shape; rear suspensions are provided on the left and right sides near the rear part of the vehicle body to arrange rear wheels; diagonally

above it, over approximately the entire width of the left and right rear wheels, a rear wing composed of a substantially horizontally long rectangular platy plate and vertical plates on both left and right ends is provided; and an under tray that bulges slightly wider than the widest part of the vehicle body from the side pods to a rear wheel front sides is attached to a vehicle body lower end portion.

Then, concerning specific constitutions, the two designs are common in the points that (B) for the front wing, multiple blades that spread in a wing shape on the left and right are laminated by shifting them rearward, and end plates in a substantially rectangular in side direction are provided at both ends in the vertical direction, (C) an opening portion of the cockpit is formed in a substantially vertical trapezoidal shape in the top direction and a halo arranged on an upper portion thereof is formed in a substantially thong shape in the top direction, and (D) the rear wing has two plates of a narrow upper plate and a wide lower plate, and the vertical plates have an lying J-shaped cutout at the upper rear corner in the right side direction.

(3) Different features of the form

(A) The front wing

The two designs are different in the points that: the front wing of the design in the application has generally the same width as the outside width of the front wheels, whereas the front wing of the Cited Design has a slightly narrow width; the front wing of the Cited Design is provided with four vertical fins curving substantially concentrically near both front left and right ends, whereas the design in the application is not provided with such fins; and the end plate of the design in the application is of a substantially L-shape in the front direction, whereas the end plate of the Cited Design is

of a substantially inverted C-shape in the front direction, has an arc-shaped fin in an intermediate portion thereof, and has a rear end portion folded outward.

(B) The two designs are different in the point that the intake member inside the front wheels of the design in the application has a size enough to fit within the radius of the wheel, whereas in the Cited Design, it is about the size of the radius of the tire.

(C) The barge board and its surroundings

The two designs are different in the points that: the barge board of the design in the application is formed in a shape of a staircase descending rearward in the right side direction, whereas the barge board of the Cited Design is formed so as to incline in an arc-shape at a rear end; and the Cited Design is provided with a side fin above the barge board, whereas the design in the application is not provided with such a side fin.

(D) The two designs are different in the point that the supporting portion of a side mirror of the design in the application extends long to the left and right, whereas it does not do so in the Cited Design.

(E) The induction pod and the engine cover

The two designs are different in the points that: in the design in the application, in the front direction, the induction pod is formed in a substantially isosceles triangle shape and the rear engine cover is formed in a continuous mountain shape, whereas in the Cited Invention, the induction pod is formed in a horizontally long substantially elliptical shape and the rear engine cover changes from a substantially elliptical shape to a mountain shape; and in a right side view, the engine cover of the design in the application gently inclines from the induction pod to the cover rear end, whereas the engine cover of the Cited Design has a flat part continuing from the induction pod and then greatly inclines toward the cover rear end.

(F) The two designs are different in the point that a right side ridge line of the side pod has a very gentle convex arc shape toward the rear side, whereas in the Cited Design, it changes from a convex arc shape to a concave arc shape and then linearly inclines.

(G) The two designs are different in the point that in the top direction, the T-wing in front of the rear wing of the design in the application has a uniform width, whereas in the Cited Design, it is tapered toward both ends.

(H) The two designs are different in the point that the vertical plate of the rear wing in the Cited Design is configured by one curving plate, whereas in the design in the application, about 2/3 of the rear side thereof is divided into upper and lower parts.

No. 5 Judgment

1 Determination of similarity of the article to the design

The articles to the design according to the two designs are identical.

2 Evaluation of the common features and the different features

(1) Regarding a method of determining similarity between the two designs

Since the article to the design of the design in the application is a racing car, and consumers are specialists involved in auto racing, a consumer will carefully observe the appearance in detail while understanding the functional characteristics and design constraints.

Therefore, in the determination of similarity between the design in the application and the Cited Design, not only by comparing the entire form, but also by focusing on the details determined by the technical requirements, the impression given by the common features and the impression given by the different features of the two

designs are compared, and the effects of these on the determination of similarity between the two designs will be evaluated and integrated to determine whether or not the designs are similar as a whole.

(2) Evaluation of the common features

First, although the overall constitution of the common feature (A) and the constitution of each part of the common features (B) to (D) form the basis of the two designs and give a common impression to the consumers, the consumers of racing cars carefully observe their appearance in detail. Thus, although it is admitted that there is a certain degree of impact of the common features (A) to (D) on determination of similarity between the two designs, it can be said that the common features alone are not strong enough to lead to the determination of similarity between the two designs.

(3) Evaluation of the different features

Against this, although (A) the front wing, (C) the barge board and its surroundings, and (H) the rear wing are portions decided by the technical requirements, since those are portion which professional consumers involved in automobile racing observe with emphasis, it can be said that the effects of these different features on the determination of similarity between the two designs are large, respectively.

Next, since the constitutions of (E) the induction pod and the engine cover and (F) the side pod occupy about a half of the entire design, make the visual impression very different, and give the consumers a different impression, it should be said that the effects of these different features on the determination of similarity between the two designs are large.

Therefore, the different features mentioned above strongly give the consumers a different impression, when viewed as the entire design, and it can be said that those greatly affect the determination of similarity between the two designs.

On the other hand, since (B) the intake member inside the front wheels, (D) the supporting portion of the side mirror, and (G) the T-wing in front of the rear wing are partial differences, when viewed as a whole, it can be said that the effects of these different features on the determination of similarity between the two designs are small.

3 Determination of similarity between the two designs

As mentioned above, the articles to the design of the two designs are identical, and concerning the form of the two designs, although it is admitted that there is a certain degree of impact of the common features on determination of similarity between the two designs, those are not strong enough to lead to the determination of similarity between the two designs, as the overall common features. Whereas, as described in (1) above, in the determination of similarity of the designs of a racing car, since the form of the detailed parts are compared with more emphasis, the visual effects created by the combination of the different features have a great influence on the determination of similarity between the two designs. When viewed as the entire design, these different features give the consumers a different impression and cause a different aesthetic impression in the two designs, so that it cannot be said that the design in the application is similar to the Cited Design.

No. 6 Closing

As described above, the design in the application is not similar to the Cited

Design, and does not fall under the category of Article 3(1)(iii) of the Design Act. Therefore, the application cannot be rejected due to the reasons of the examiner's decision.

In addition, no other reasons for rejecting the application concerned is found.

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

April 20, 2021

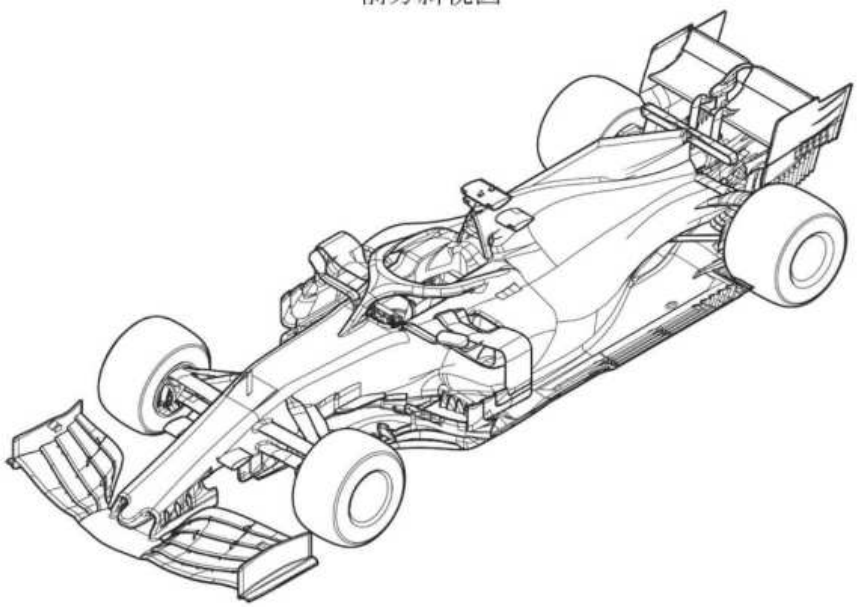
Chief administrative judge: KOBAYASHI, Hirokazu
Administrative judge: INOUE, Kazuyuki
Administrative judge: EZUKA, Naohiro

別紙第１　　本願意匠（意願２０１９－０１７７５５）

【意匠に係る物品】競走用自動車

【意匠の説明】背面図は、正面図と対称に表れるため省略する。各図に表された直線状、及び曲線状の細線は、いずれも立体表面の形状を特定するためのものである。

前方斜視図



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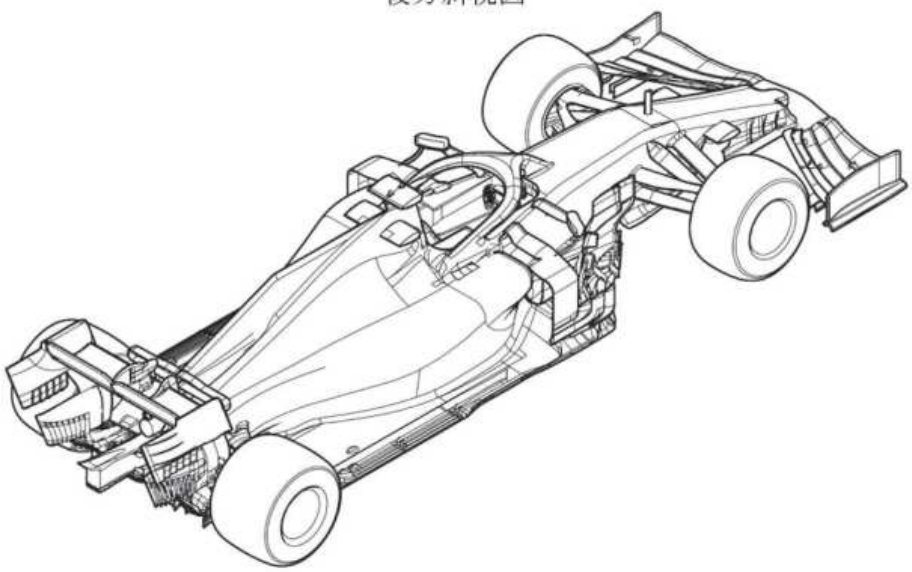
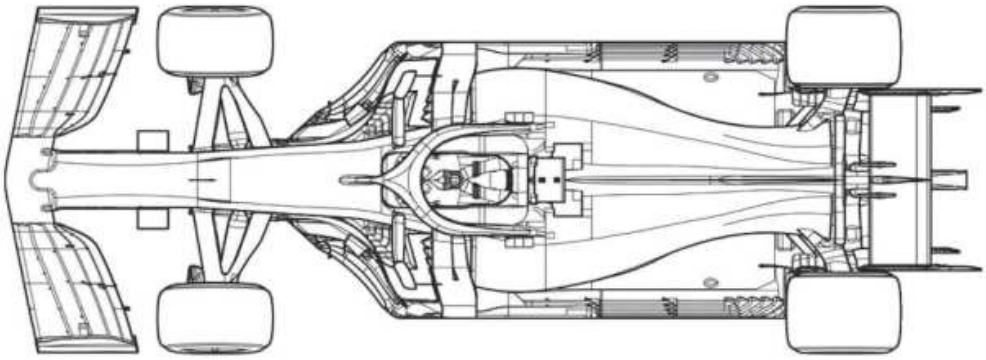


別紙第１　本願意匠（意願２０１９－０１７７５５）　Appendix 1 The design in the application (Japanese Design Application No. 2019-017755)

平面図



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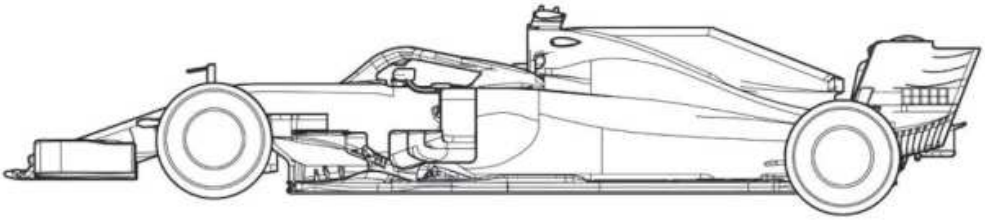

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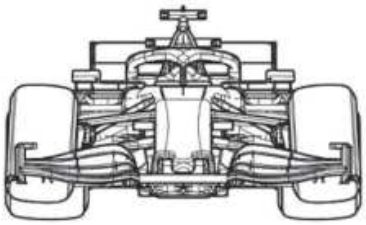

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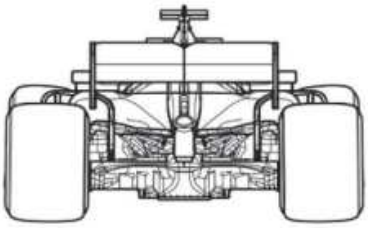
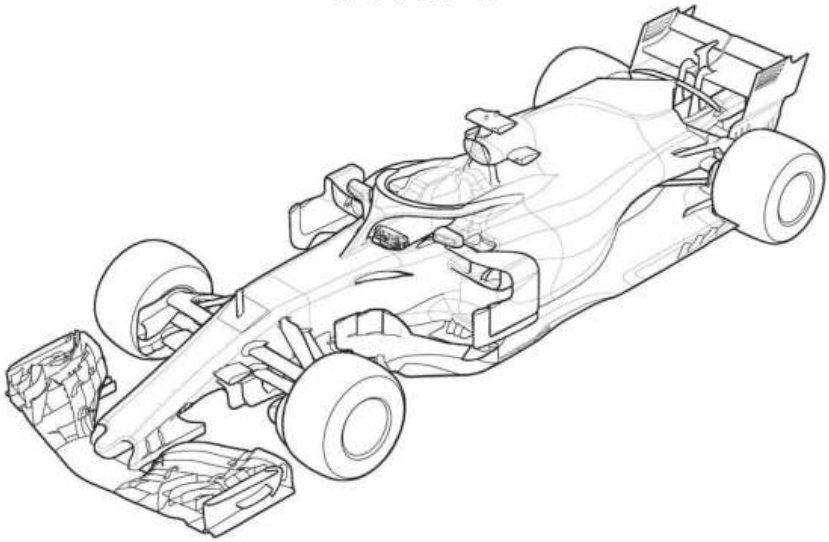


別紙第２　引用意匠

欧州連合意匠公報　２０１８年　７月２７日
自動車（登録番号００４７０９６１６－０００２
Ｍｏｔｏｒ　ｃａｒｓ）の意匠
（特許庁意匠課公知資料番号第ＨＨ３０２０４２７９号）

０００２．１



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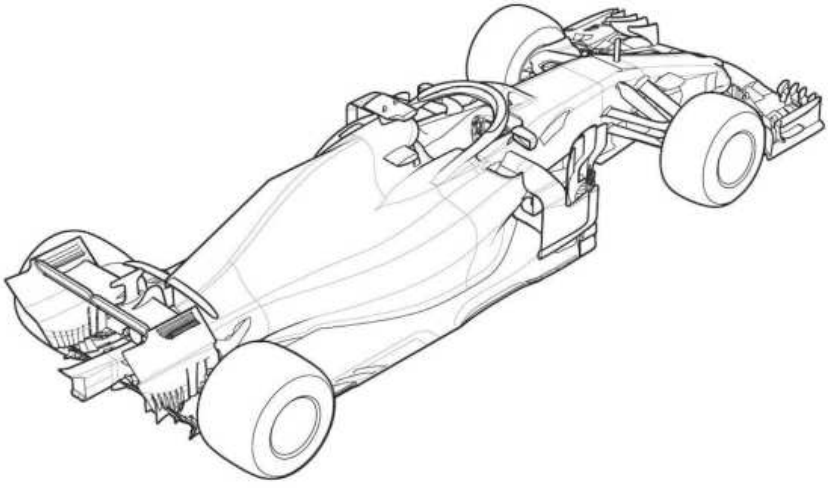
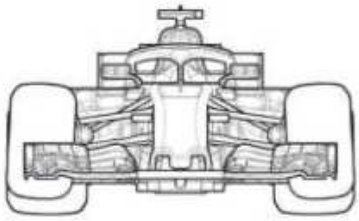
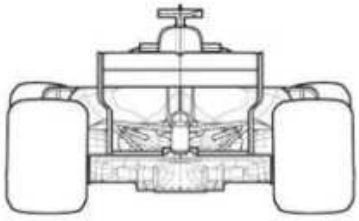


別紙第２　引用意匠　　Appendix 2　The Cited Design

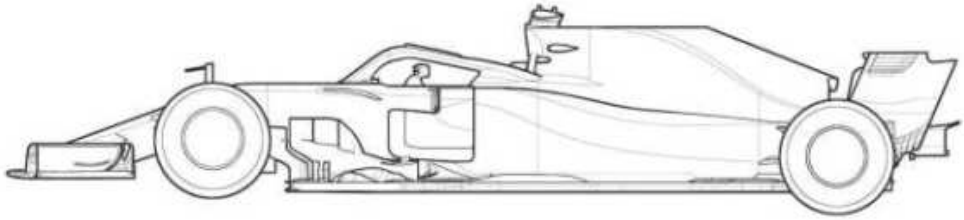
0002. 3



0002. 4



0002. 5



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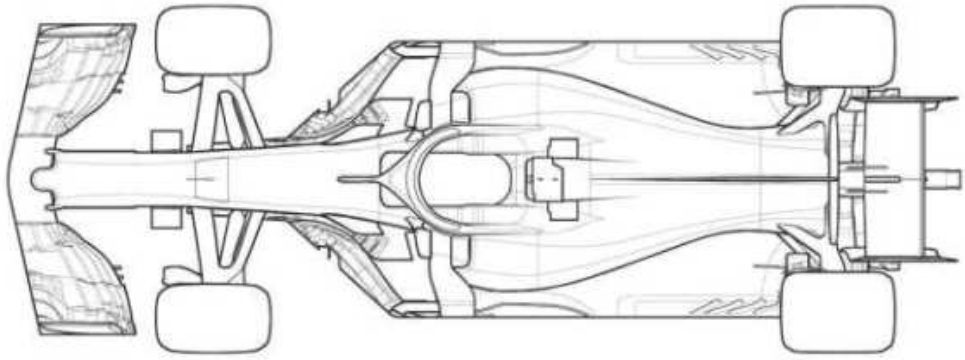

0002. 7