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Case Study : Design of Cigarette Package

Towa Institute of Intellectual Property

Director

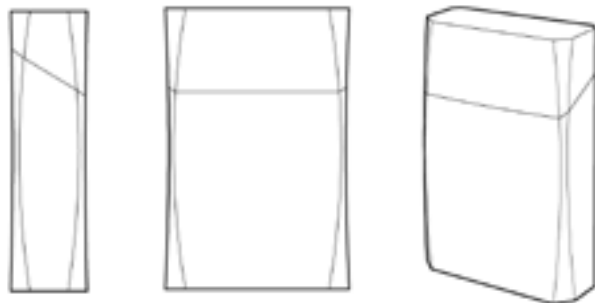
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This paper introduces a successful case of getting a design patent by demanding an appeal against examiner's decision of refusal. Here, Towa International Patent Firm, TIPF, made use of the academic achievements in Towa Institute of Intellectual Property, TIP, to elaborate the logic with collaboration from rapid mocking-up by an oversea patent attorney.

1. Background

JT International S.A., or JTI, applied for the design patent on a cigarette package in Japan on Oct. 20th, 2011, basing on the claim of priority in the U.K. on Apr. 20th, 2011, etc. (Fig.1).

Fig.1 Design of JTI's cigarette package

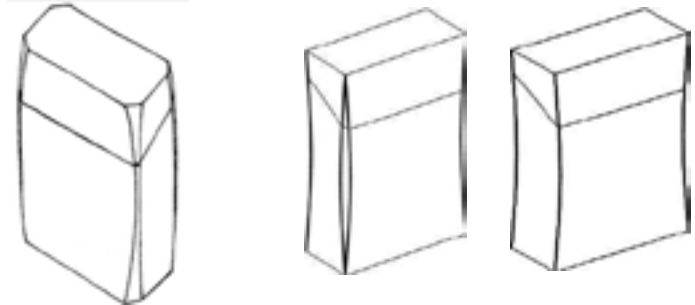


Japan Patent Office, JPO, notified the reasons of rejecting this application on account of the similarity with prior design, quoting the design of the cigarette package,

International Design Patent Registration No.DM/057942 (Fig.2), which had published on Dec. 31st, 2010.

Fig. 2 International Design Patent Registration No. DM/057942 (left)

Fig.3 Examples of a container with its middle narrowed (middle and right)



TIPF had discussed the issue with the applicant through Gill Jennings& Every, LLP, GJ & E, and submitted the opinion to JPO. JPO had rejected it on the following account :

"Compared on the whole, the two designs are common in that they are both the designs of cigarette packages. Both of their figures of rectangular parallelepiped have the four corners cut vertically and when seen from the front side, both of their vertical sections have wider top and bottom edge and are narrowed in the middle. These points are characteristic of their designs. Moreover, their appearance of mouths are also in common in the sense that they are designed to be aslant toward the front. Thus, major parts of design are in common.

Although there lies a difference in that the entire appearance of JTI's is narrowed in the middle while the other is just square, this narrowed design is not original among this kind of article (Fig.3). Besides, the narrowed part of JTI's is too modest in its entire figure to be a distinctive point from the other design.

Therefore, the two designs should be regarded as similar and JTI's design cannot be registered in accordance with Article 3, paragraph (1), item (iii) of Design Act."

2. How to answer

Since JTI was dissatisfied with this rejection, TIPF proceeded to demand an appeal against examiner's decision of refusal. Making use of TIP's studies, TIPF followed these steps and contemplated reasons of an appeal :

- 1) Clarifying the image of consumers
- 2) Understanding the features of actions by ethnography
- 3) Constructing logic by the Toulmin Model

Let me explain the outline of each step.

3. Clarifying the image of consumers

Article 24, paragraph (2) of Design Act says, "Whether a registered design is identical with or similar to another design shall be determined based upon the aesthetic impression that the designs would create through the eye of their consumers". Accordingly, Design Examination Guideline, which JPO offers, considers "a consumer (including a business)" to be the agent who judges novelty, one of the requirements for registration (Article 3, paragraph (1), item (iii) of Design Act). According to the Guideline, thus, the aesthetic impressions that a consumer feels as selecting, buying and using the article are taken into account.

After that, the similarity and difference in the forms of the two designs are recognized, following which the two aspects are evaluated : (1) whether and how much those compared parts are distinctive, (2) how much they are distinctive when compared with preceding designs. The former aspect has two viewpoints, (a) how large the parts are in the design and (b) whether the parts have a visual impact according to the feature of the article. The viewpoint of (b) should involve, the Guideline argues, the judgment on whether the parts are easy to observe and should take into account (i) whether the parts are easy to observe when the article is being selected and bought and (ii) whether the parts are observed by an interested consumer, including a business.

While the viewpoint of (i) is related to the aesthetic impression from passive seeing, that of (ii) to the impression from active watching. Both viewpoints are subject to how a consumer acts and hence the image of consumers and their activity have great influence upon judgment on similarity in Design Act.

Consequently, TIPF decided to clarify the image of consumers in order to claim dissimilarity in the two designs at issue. The assumed consumer of the JTI's article was "a smoker who is particular about how a cigarette package looks" because the JTI's package was for high-quality cigarettes.

4. Understanding the features of actions by ethnography

In order to evaluate whether the parts of designs are easy to observe when the articles are being selected or bought, it is necessary to examine marketing of them. Meanwhile, we can know whether the parts are observed by an interested consumer, including a business, through investigating the actual situations of choice, purchase and use.

Ethnography is useful for this task. This is a record of people's activity and thought examined in fieldworks etc. in anthropology.

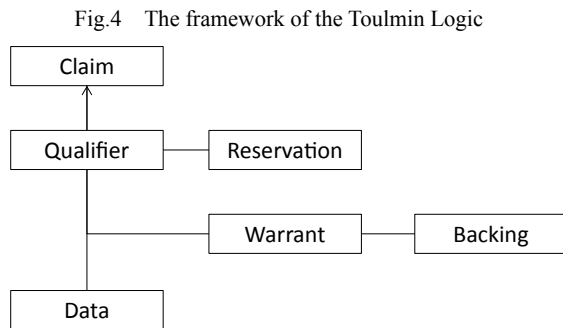
TIP investigated the marketing of packed high-quality cigarettes and observed the activity of consumers of those cigarettes, watching their choices, purchases and uses. Following those records and their implications, TIPF conducted a brainstorming and made claim on the noticeable parts of the cigarette package as follows :

- ① JTI's cigarette package is usually placed in a tobacco store or a convenience store with its front, left and right sides observable. Consequently, the appearances of its front, left and right sides are easy to observe visually and the difference lying there is conspicuous.
- ② When its contents are consumed, i.e., smoked, the cigarette package is held with hands and the appearances of the front, back, top, left and right sides are easily observed and the difference in those sides catch attention. The filleted parts on four corners, which a JPO examiner call "corners cut vertically", are most frequently touched with fingers and affect its handiness, thus attracting attention. Besides, the parts can be seen from every angle. Consequently, they are the parts observed by consumers with interest on the basis of the usage, function and size etc. of the article.
- ③ When it is carried, the cigarette package is inside a breast pocket or a handbag etc. and is observed mainly from top, hence the difference in its upper part attracts attention.

5. Constructing logic by the Toulmin Model

TIPF relied on Toulmin Model to contemplate on the reason for an appeal. The model

is a general structure of logic developed by Stephen Toulmin, an influential figure in the field of rhetorical argument. The main framework is shown in Fig.4.



According to the Toulmin Model, we can put in order an examiner's logic concerning the differences in the two designs as follows. Note that there is no backing in the logic of an examiner and that qualifier and reservation generally do not play an important role in disputes on similarity in design.

Data : The package is narrowed in the middle and is a rectangular parallelepiped.

Warrant 1 : This narrowed design is not original among this kind of article.

Warrant 2 : The narrowed part of JTI's package is too modest in its entire figure.

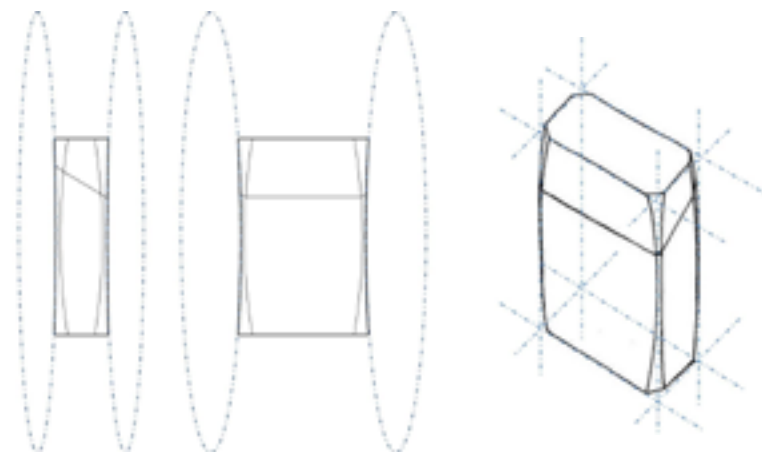
Claim : The part cannot be considered to be a distinctive character in the two designs.

TIPF contrived to develop logic to refute this evaluation at least. TIPF intended to object to the recognition of facts as data and insisted the difference at issue gave distinct aesthetic impression on the basis of the features of activity that TIP's ethnography suggested.

Data 1 : While the basic outline of JTI's design is a drum-like square cube (Fig.5), that of the design of No. DM/057942 is a rectangular parallelepiped (Fig.6). In other words, while the front, back, left and right sides of JTI's design is scooped toward inside, forming a concave, all of the sides seen in No. DM/057942 are flat.

Fig.5 The basic outline of JTI's design (left and middle)

Fig.6 The basic outline of the design of No. DM/057942 (right)



Warrant 1 : The difference in the basic outlines is related to the whole form, or dominant constitution, of the article and hence is extremely conspicuous, influencing visual impression remarkably.

Backing 1 : "The evaluation on the ratio in the whole design", in 22.1.3.1.2(4)(i)(a) of the Design Examination Guideline.

Warrant 2 : The examples that an examiner offered cannot be predecessors of a pack with a narrow part in the middle because they are publicly known after the priority date of JTI's design.

JTI's design as a whole is a drum-like square cube, which gives an impression of a clear-cut skyline, with the size of the middle part being smaller than that of the top and bottom parts. This feature is nothing but original and gives a sharp and surprising impression that no other articles of the same kind could achieve before. Consequently, the difference between the two designs is important and the part should be distinctive enough to get attention.

Backing 2 : "The evaluation based on the comparison with preceding designs", in

22.1.3.1.2(4)(ii) of the Design Examination Guideline.

Warrant 3 : A cigarette package is usually displayed in a vending machine, a tobacco store or a convenience store with its front, left and right sides observable and as smoking, it is held with a hand or placed on a table with its front, back, top, left and right sides observable. Consequently, the difference of the basic outline described above is most conspicuous from customers also on the basis of its usage, function and size etc.

Backing 3 : "The evaluation on whether the part is particularly observed on the basis of the feature of the article", in 22.1.3.1.2(4)(i)(c) of the Design Examination Guideline.

6. Other arguments and results

TIPF's appeal also discussed the recognition and evaluation of difference in filleted parts of the two designs (Fig.7 - 9), assuming the clarified consumer, basing upon the activity grasped in the ethnography and constructing logic following the Toulmin Model. The Toulmin Model was also useful to argue the unattractiveness of the common parts with the design publicly known before the application of JTI.

After the demand for an appeal, an appeal examiner in charge of this case required the submission of the actual article. TIPF asked GJ&E for a silver-colored mock-up and GJ&E swiftly provided an ideal one. TIPF explained that the actual package could not be obtained because it had not yet been commercialized and showed the mock-up placed on a checkered pattern, emphasizing a drum-like form characterizing the basic outline of the JTI's design (Fig.10). This mock-up is just a reference for an appeal examiner to check a 3-D form and will not be taken into account when the scope of the registration is determined.

The appeal decision was immediately given and JTI's design was registered. This success is the fruit of perfect logic of TIPF and swift and appropriate action by GJ&E.

We expect this case to be a practical guideline for design protection.

Fig.7 Filleted part of JTI's design (left)

Fig.8 Filleted part of design of No. DM/057942 (right)

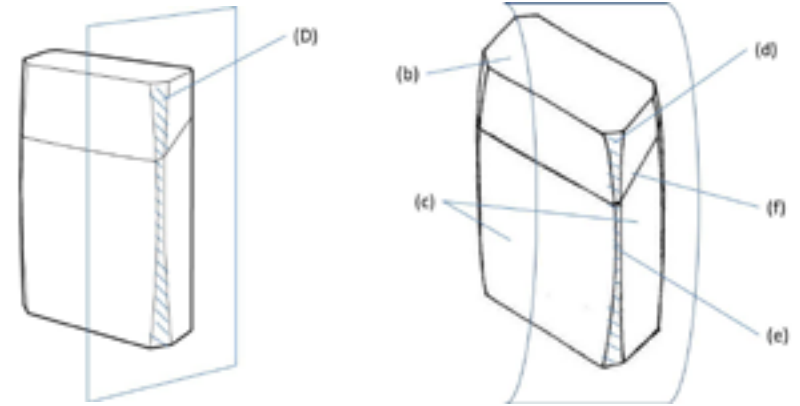


Fig.9 Top of the two designs



Fig.10 The mock-up of JTI's cigarette package

