

Decided on	November 29, 2007	Court	Intellectual Property High Court, Fourth Division
Case number	2007 (Gyo-Ke) 10107		
- A case, with respect to a trial decision determining that a design for an elastic damper described below for which the registration was requested was similar to the cited design mentioned below, was cancelled on the grounds that they were not deemed similar			

Reference: Article 3, paragraph (1), item (iii) of the Design Act

1. The design as the subject of the application (“the Design”)

(1) Article to the design: An elastic damper

(2) Form of the design: [Overall Form] A near-circular short cylindrical form with top and bottom end planes shaped like flanges, slightly larger in diameter than the cylindrical part, and with joint fitting components at the center of the top and bottom end planes. (The above description refers solely to what the Design has in common with the Cited Design.)

2. The cited design (“the Cited Design”)

(1) Article to the design: A damper for a vibration isolator for machinery and appliances

(2) Form of the design: The overall form is the same as in 1-(2) above.

(The above description refers solely to what the Cited Design has in common with the Design.)

3. Determination in the Japan Patent Office’s trial decision

(1) Article to the design: Identical

(2) Comparison of the form of the design

A. Points in common

(A) Overall form

a. A near-circular short cylindrical form in which the vertical length is slightly smaller than the diameter

b. The top and bottom ends are shaped like flanges with a slightly larger diameter than the cylindrical part.

c. There are joint fitting components at the center of the top and bottom end planes.

(B) Specific conditions

a. Each flange has a vertical lateral surface all around its edge and looks like a thick plate when viewed from the lateral side.

b. Each part where the cylindrical part joins a flange is formed like a spoon blade.

B. Differences in specific conditions

(A) The ratio of the longitudinal length to the diameter in the overall form is nearly 5:3 in the Design whereas it is nearly 5:4 in the Cited Design.

(B) The top and bottom ends each have a flat plane in the Design. In the Cited Design, they appear to be nearly flat, but their detailed conditions are unknown.

(C) In the Design, the joint fitting components have small-diameter screw holes drilled inwards from each of the top and bottom end planes. In the Cited Design, its conditions are unknown.

(3) Determination on similarity in form of the design

A. The above-mentioned points in common in the overall form define the overall fundamental structure and therefore have an influence on determining the similarity in the two designs. The points in common in the specific conditions of the flanges mentioned above – namely the vertical planes on the lateral edge, a form looking like a slightly thick plate when seen from the lateral side, and a spoon blade-like form where the cylindrical part joins each flange – constitute the points in common in the form seen from the lateral side, to which viewers are more likely to pay attention in a state where the damper is attached to a device. In view of this, it should be understood that the design effect generated by the combination of points in common has an influence sufficient to affect the determination on similarity between the designs.

B. Review on individual differences

(A) With regard to Difference (A), it is common in the field of dampers in this category to change the ratio of the longitudinal length to the diameter of the entire form as needed. There is merely a minor difference in the ratio between the Design and the Cited Design. This difference has too limited an impact on determining the similarity in the designs to be evaluated.

(B) In connection with Difference (B), detailed conditions of the form are unknown in the Cited Design, but the top end plane of the damper can be observed to be almost flat even if there may be a disparity in the details. In the state in which dampers are used in a stack manner, this part is relatively unlikely to attract attention. In light of these points, it is difficult to say that this difference has no influence that would affect the whole form. This difference still has such a small impact on determining the similarity in the designs that it cannot be evaluated.

(C) In terms of Difference (C), the screw hole in the Design has a small diameter and is drilled inwards. In the field of an article of this kind, it is difficult to say that

creating inward screw holes at the part where joint fittings are provided is either particularly new or unique to the Design alone. Difference C is therefore a minor disparity in the form of a limited part. It has such a small impact on determining the similarity in the designs that it cannot be evaluated.

(4) Conclusion

The Design and the Cited Design are identical in the article to the design. In terms of the form, the design effect that arises from a combination of the conditions that they have in common has a greater impact on determining their similarity than their differences. It must inevitably be concluded that the two designs are similar as a whole.

4. The Court Judgment

The court cancelled the trial decision as it found partly flawed the determination on the forms of the two designs in the trial decision and pronounced that the trial decision confirming a similarity between them was erroneous, by reasoning as follows:

“(1) Comparison between the Designs in Question

A. Article to the design

Both designs are identical in terms of the article to the design.

B. Form

(A) Points in common

a. Overall form

(a) A near-circular short cylindrical form

(b) The top and bottom end planes are shaped like flanges with a slightly larger diameter than the cylindrical part.

(c) There are joint fitting components at the center of the top and bottom end planes.

b. Specific conditions

(a) Each flange has a vertical lateral surface all around its edge and looks like a thick plate when seen from the lateral side.

(b) Both the upper and lower parts of the cylinder where it joins a flange are formed like a spoon blade.

(B) Differences

a. Ratio of the longitudinal length to the transverse length

The ratio is about 1.35 to 1 in the Design and about 2.00 to 1 in the Cited Design.

b. Conditions on the top and bottom end planes

In the Design, the full plane is flat and coated with an elastic material. In the Cited

Design, the top end plane can be visually recognized as nearly flat but neither end plane is coated with an elastic material and no other detailed conditions are known.

c. Joint fitting components

In the Design, small-diameter screw holes are drilled inwards from the top and bottom end planes. In the Cited Design, the conditions of the joint fitting components are unknown.

(2) Evaluation of the differences

A. Ratio of the longitudinal length to the transverse length

(A) In consideration of the difference mentioned above in the longitudinal-transverse ratio based on the measured values as well as visual impressions from the form of the Design portrayed in the attached drawing and the form of the Cited Design shown in a photograph, it is difficult to rate the difference between the two designs in the longitudinal-transverse ratio as negligible, unlike the determination in the trial decision.

(B) For the two designs concerned with this case, the longitudinal-transverse ratio is a factor decisive to the fundamental structure of the whole design. It is a major element to be taken into consideration in determining their similarity.

(C) Moreover, according to the exhibits and the gist of all arguments, consumers of the article to the design (hereinafter referred to as “viewers”) are those intending to add the article to a machine or device that generates vibrations or that they do not want any vibration to reach. They are likely to select the article after checking the longitudinal-transverse ratio, which is linked to the vibration dampening capacity of the article, according to the performance of the device and to the environment where it is placed. The longitudinal-transverse ratio of the article in question is recognized as one of the key elements on which viewers focus their attention not only after installation to a device but also before, or at the time of selection.

(D) This leads to the conclusion that the determination behind the trial decision, according to which the difference in ratio between the Design and the Cited Design is so limited that it has only a minor impact in determining the similarity in the designs and cannot be evaluated, was mistaken.

B. Conditions on the top and bottom end planes

(A) With respect to the conditions of the top and bottom end planes, there is a difference in the existence or absence of a coating with an elastic material between the two designs.

(B) It is clear that the existence of the elastic material on the top and bottom end planes produces the positive effects of preventing slipping and protecting the

machine or device to which the dumper is installed from scratch. Whether or not the coating is provided is rated as an element to which the viewers pay attention.

(C) Whether or not the article in question has the elastic coating is directly related to the difference in the characteristics of the appearance of the two designs. This may not be undervalued as a mere difference in function or material.

(D) Overlooking the difference remarked in (A) above, the trial decision pronounced that Difference (B) still had a limited impact on determining the similarity of the designs and could not be evaluated on the grounds that it is not a difference that would affect the entire form, given that the top end plane of the damper could be visually recognized as almost flat overall, despite some differences in the details, while the Cited Design had unknown detailed conditions of form relating to the Difference and that the difference existed in the portion to which a relatively low level of attention was paid in a state in which the dampers were used in a stack manner. However, in light of the discussions above, this determination in the trial decision should be deemed to be flawed.

C. Conditions of the joint fitting components

(A) According to the exhibits and the gist of all arguments, it is observed that it is common to create inward screw holes at joint fitting components of the article to the designs. It can be presumed, according to the Cited Design presented in the photograph, that inward screw holes are also created in the joint fitting components of the Cited Design.

(B) However, it is evident that the specific characteristics of the screw holes to be created at the joint fitting components, such as the diameters and depths of the screw holes, are significant to the joining strength in the installed status and to the strength of the article. It is recognized that viewers will pay close attention to the conditions of the screw holes related with aforementioned functions at the time of choosing the article. It is impossible to underestimate this as an internal condition that is difficult to observe from outside.

(C) On the other hand, although the detailed conditions of the joint fitting components in the Cited Design were unknown, the trial decision stated that the difference constituted a minor disparity in the conditions of a limited part and that it could not be evaluated due to its negligible impact on determining the similarity of the designs in question. In light of what was demonstrated in (B) above, it must be said that this determination was hastily made and erroneous.

(3) Similarity in form between the designs

In comprehensive consideration of the points the designs share in common in terms

of the form recapitulated in (1)-B above and the individual differences reviewed in (2) above, the following examines the similarity in the form of the designs.

A. Both of the designs have a near-circular cylindrical form as a whole. They have flange-shaped top and bottom end planes, with a slightly larger diameter than the cylindrical part. And they both have joint fitting components at the center of the top and bottom end planes. In terms of these three points, the two designs are identical. They also have some common specific conditions. Specifically, each flange has a vertical edge surface and looks like a thick plate when seen from the lateral side and the parts where the cylinder joins the flanges are formed like the blade of a spoon. However, it is difficult to regard the difference between the two designs in the longitudinal-transverse ratio as trivial. In addition, this ratio is decisive to the overall fundamental structure of the design. In this light, it is impossible to say that the points in common discussed above have a very large impact on determining the similarity in the form of the designs. Rather, it can be confirmed that the difference in the longitudinal-transverse ratio cannot be ignored in evaluating whether the two designs in question are similar in terms of form.

B. The difference between the two designs observed in the top and bottom end planes, specifically whether or not they have an elastic coating, is directly linked with the difference in the characteristics of their exterior appearance. It should be seen that it is a difference to be fully considered in determining the similarity in the form of the two designs.

C. In addition, the difference in the joint fitting components between the design, specifically the point that their specific conditions are unknown in the Cited Design, cannot be undervalued in determining similarity in form between the two designs.

D. In view of what was discussed above, a combination of points in common in terms of form in the designs does not have a significant design effect on the determination on similarity. In the additional consideration of the presence of several differences that need to be taken into account in evaluating similarity when observing the entirety of each of the designs in question, it is appropriate to deny the similarity in design and appearance from the viewers' perspective.

(4) Similarity between the Design and the Cited Design

As reviewed above, the two designs are not similar in form, although the article to these designs is the same. Consequently, the two designs are not similar.”