

Date	September 26, 2013	Court	Osaka District Court, 21st Civil Division
Case number	2011 (Wa) 14336		
<p>– A case in which the court ruled that the plaintiff's design part 1 in question ("Design Part 1") can be easily created based on a publicly known design and therefore its registration should be invalidated, while the court denied that the plaintiff's design part 2 in question ("Design Part 2") can be easily created and upheld the plaintiff's claim for an injunction against manufacture and sale, etc. of the defendant's product and for damages.</p>			

In this case, the plaintiff, who owns design rights 1 and 2 in question ("Design Rights 1 and 2") pertaining to partial designs designating an "indicator light for game machines" as an article to the design, asserted that the defendant's design part 1 and design part 2 of the defendant's product are similar to the plaintiff's partial designs respectively, and claimed an injunction against manufacture and sale, etc. and the disposal of the defendant's product, as well as damages.

The major issues are [i] the similarity of the partial designs, [ii] whether the plaintiff's partial designs can be easily created, and [iii] the amount of damages.

In this judgment, the court ruled as follows. With regard to [ii], the court found that Exhibit Otsu No. 7 Design, which was disclosed in the publication of unexamined patent application, was a publicly known design, and then found that the configuration of Design Part 1 is nothing but one that was made by changing Exhibit Otsu No. 7 Design by common means and could be easily created. Based on this finding, the court ruled that the registration of Design Part 1 should be invalidated. On the other hand, the court found that the difference between Design Part 2 and Exhibit Otsu No. 7 Design cannot be deemed to be a mere replacement by a common means, and denied that Design Part 2 can be easily created.

Next, with regard to [i], the court first identified the essential feature of Design Part 2 while taking into consideration the publicly known design, and then found that the defendant's design part 2 is common with Design Part 2 in its essential feature but their difference does not create different aesthetic impressions. Based on this finding, the court admitted the similarity of both partial designs.

With regard to [iii], although the plaintiff claimed damages calculated based on Article 39, paragraph (1) of the Design Act, the court ruled that consideration should be given to the essential feature of Design Part 2 and its contribution should be taken into account in a limited way to a considerable extent and that a reasonable amount of damages is the amount that remains after deducting 85% of the amount calculated based

on the main clause of Article 39, paragraph (1) of the Design Act.