

Date	June 18, 1998	Court	Tokyo High Court
Case number	1997 (Ne) 404		
– A case in which the court presented the criterion for determining whether or not the registered design and other designs are similar to each other.			

Reference: Article 24, paragraph (2) of the Design Act

Number of related rights, etc.:

Summary of the Judgment

In determining the similarity of designs, the designs must be observed as a whole. In such case, it is necessary to understand the part which attracts the attention of the traders and consumers the most as the feature of the design by taking into consideration the nature, intended use and mode of use of the article to the design and the fact as to whether or not there are any new creative parts that could not be found in publicly known designs, and to observe whether or not the registered design and the design of the other party share the constitution in such feature of the design.

Judgment rendered on June 18, 1998
1997 (Ne) 404, etc.

Judgment

Indication of the parties: Omitted

Main text

1. The appeal in question ("Appeal") filed by the appellant (appellee in the incidental appeal) shall be dismissed.

2. Paragraphs 3 and 4 of the judgment in prior instance shall be modified as follows based on the incidental appeal and expansion of claims made by the appellee (appellant in the incidental appeal).

(1) The appellant (appellee in the incidental appeal) shall pay to the appellee (appellant in the incidental appeal) 451,170,000 yen, and money accrued on 142,560,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1993 until the date of completion of the payment, money accrued on 100,980,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1994 until the date of completion of the payment, money accrued on 106,650,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1995 until the date of completion of the payment, money accrued on 96,660,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1996 until the date of completion of the payment and money accrued on 4,320,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from August 1, 1996 until the date of completion of the payment.

(2) The other claims (including the part expanding the claims) made by the appellee (appellant in the incidental appeal) shall be dismissed.

3. The court costs shall be divided into three portions for both the first and second instances (including the incidental appeal), one-third of which shall be borne by the appellee (appellant in the incidental appeal) while the remaining portion shall be borne by the appellant (appellee in the incidental appeal).

4. This judgment may be provisionally executed as far as paragraph 2(1) of the main text is concerned.

Facts

(omitted)

No. 2 Allegations of the parties

(omitted)

Accordingly, the appellee claims against the appellant an injunction against the manufacture and sale of the Subject Item as well as the destruction thereof pursuant to Article 37, paragraphs (1) and (2) of the Design Act or Article 2, paragraph (1), item (i) and Article 3, paragraphs (1) and (2) of the Unfair Competition Prevention Act on the grounds of infringement of the design right or violation of the Unfair Competition Prevention Act and payment of 1,203,120,000 yen in total (including the 142,560,000 yen upheld in the judgment in prior instance) as the damages equivalent to royalties based on Article 39, paragraph (2) of the Design Act or Article 5, paragraph (2) of the Unfair Competition Prevention Act, delay damages accrued on 269,280,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1994 until the date of completion of the payment, delay damages accrued on 284,400,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1995 until the date of completion of the payment, delay damages accrued on 257,760,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from January 1, 1996 until the date of completion of the payment and delay damages accrued on 11,520,000 yen among the first-mentioned amount at the rate of 5% per annum for the period from August 1, 1996 until the date of completion of the payment."

(omitted)

Reasons

No. 1 Court decision

(omitted)

"4. Feature of the design in question ("Design")

In determining the similarity of designs, the designs must be observed as a whole. In this case, it is necessary to understand the part which attracts the attention of the traders and consumers the most as the feature of the design by taking into consideration the nature, intended use and mode of use of the article to the design and the fact as to whether or not there are any new creative parts that could not be found in publicly known designs, and to observe whether or not the registered design and the design of the other party share the constitution in the feature of

the design.

According to Exhibits Ko 13 through 16 (which are identical to Exhibits Ko 11-2-7 through 11-2-10, 12-2-7 through 12-2-10, 18-2-2 through 18-2-4 and 18-2-5-1 and Exhibit Otsu 24-7-1 for which there is no dispute regarding the existence of the original and the authenticity of the creation) for which there is no dispute regarding the authenticity of the creation, Exhibit Ko 18-2-5-2 for which there is no dispute regarding the existence of the original and the authenticity of the creation and the entire import of the oral argument, it is found that, prior to the filing of an application for registration of the Design, in the general type of mid-to-large size rough terrain cranes of 20 ton or more capacity, the base end part of the boom is located on the upper side of the rear end part of the base carrier, the boom passes transversely across the lateral of the window of the cabin at a height approximately the same as the ceiling of the cabin and is extended almost horizontally and in a straightforward manner in front while the fore-end part is arranged at a position largely separated from the base carrier by largely protruding in front from the fore-end of the base carrier in a state where the boom is contracted and stored during running. In light of this fact and the publicly known designs of self-propelled cranes shown in Exhibits Ko 11-2-11 through 11-2-15 (which are identical to Exhibits Ko 12-2-11 through 12-2-15), Exhibits Ko 18-2-6 and 18-2-10 and Exhibits Otsu 24-7-2 through 24-7-7 for which there is no dispute regarding the existence of the original and the authenticity of the creation, the structure of the Design wherein the base end part of the boom in a contracted state is pivotally fit into the upper end part of the boom supporting frame projecting from the base of the revolving frame at a slightly rearward position of the lateral of the cabin, i.e. a position more forward and obliquely upward than the engine box (at a position near the center of the base carrier) while the boom is arranged to pass transversely across the lower lateral of the cabin in a state downward to the left (front falling state) and to have the fore-end part of the boom come to an end at a position adjacent to the base carrier by slightly protruding from the fore-end of the base carrier can be found to be a new design which could not be found in publicly known designs. (Although the boom of self-propelled cranes in a contracted and stored state shown in Exhibits Ko 18-2-12-1 and 18-2-12-2 and Exhibit Otsu 17 is front falling, said cranes are crawler-type cranes and their basic structures are different from that of the Design. Moreover, the cabin, engine box and device storage box are integrated to surround and enclose the boom and boom supporting frame and the degree of slope of the front falling of the boom is slight. Thus, the fact that the boom of the abovementioned cranes is front falling would not impede the abovementioned finding) Moreover, in addition to the abovementioned facts and findings, taking into consideration the fact that the schematic constitutions of the cabin, device storage box and boom that form the basic structure of the Design and the mutual arrangement relationship between the base carrier and the cabin, device storage box and boom are considered

to be an important element for the traders and consumers in selecting and purchasing cranes, it is appropriate to find that the feature of the Design exists in the following structure:

(1) The constitution and arrangement relationship between the cabin, device storage box and boom wherein the boom in a contracted and stored state is arranged to pass transversely across the lower lateral of the cabin in a front falling state and to have a part of the central lower part hide behind the device storage box in a front view between the cabin, which is located at a position substantially in the center of the base carrier in a front view, with a length a little shorter than half of the overall length of the base carrier, and is shaped of a horizontally long deformed hexagon whose right (front) lower part is protruding in front in a rear view, and the device storage box shaped like a box long from front to back whose height is substantially one-third the height of the cabin.

(2) The constitution wherein the base end part of the boom in a contracted and stored state is pivotally fit into the upper end part of the substantially right triangle boom supporting frame in a front view projecting from the base of the revolving frame, at a slightly rearward position of the lateral of the cabin and a position more forward and obliquely upward than the engine box mounted on the upper side of the rear end part of the base carrier, while the fore-end part of the boom which passes transversely across the device storage box and cabin in a front falling state is arranged to come to an end at a position adjacent to the base carrier by slightly protruding from the fore-end of the base carrier, as well as the arrangement relationship between the boom supporting frame, boom, the base carrier including the engine box and cabin.

5.(1) The appellant makes the allegations as stated in section 3(1) of the part "Allegations of the parties" with respect to the feature of the Design, but such allegations cannot be accepted as explained below.

(i) In light of the intended use and function of a self-propelled crane, which is the article to the Design, it is undeniable that the winch and the counterweight are the parts which would attract and interest the traders and consumers and may draw their attention. However, the winch and counter weight are both mere elements that form part of the overall structure of the Design and their configurations cannot be found to be especially characteristic. According to Exhibit Ko 11-2-12 mentioned above, it can be found that crane vehicles whose winch is arranged on the upper side of the boom were publicly known prior to the filing of an application for the Design. In the field to which this kind of article belongs, it can be regarded that changes in some degree to the position of the winch as needed, in other words, the decision on whether to attach the winch to the upper end of the boom or to integrate it into the interior of the boom is a matter which can be easily carried out. Based on the abovementioned findings, the position and shape of the winch as well as the existence and shape of the counterweight, which would be necessary in relation to the position of the winch, cannot be found to go far enough to form the feature of

the Design.

According to Exhibit Ko 18-1 for which there is no dispute regarding the authenticity of the creation, the appellant him/herself can be found to have made the following allegation in the case of a request for a trial for invalidation of the registration of the Design: "The shape where 'the hoist winch is arranged on the upper side of the base part of the boom' can be considered to be a configuration with some characteristics, but it falls within the scope wherein a person ordinarily skilled in the art can easily set the position to arrange the winch by design change as needed. Thus, this point cannot be regarded as involving an especially new creativity." (lines 12 through 18 of page 4 of said Exhibit)

Next, according to the bulletin in question ("Bulletin"), it is found that the overall length to overall height ratio is 0.37 while the overall width to overall height ratio is 1.25 in the Design. For example, it is found that the overall length to overall height ratio and the overall width to overall height ratio are 0.33 and 1.35, respectively, in the crane vehicle shown in Exhibit Ko 13 mentioned above, while the overall length to overall height ratio and the overall width to overall height ratio are 0.34 and 1.39, respectively, in the crane vehicle shown in Exhibit Ko 14 mentioned above. Thus, the vehicle height of the self-propelled crane pertaining to the Design cannot be found to be especially low in comparison to those of publicly known cranes.

Moreover, according to the Bulletin, it can be found that there is a space between the front edge part of the engine box mounted on the upper side of the rear end part of the base carrier and the rear end part of the upper revolving structure in the Design. However, even if the Design is compared with the publicly known design shown in Exhibit Ko 14 mentioned above, the abovementioned space cannot be found to be especially large and the characteristic feature of the Design cannot be found to lie in the abovementioned space.

The appellant alleges that the fact that the boom is sloped downward to the left (front falling) in a front view only shows one of the modes (postures) of the boom that turns vertically, which is a common and conventional means in crane design. Thus, it is not a new shape unique to the Design. However, the mere point that the boom is sloped downward to the left (front falling) is not found to be the element structuring the feature of the Design."

3.(1) The phrase "when the Design is compared with the Subject Design based on the facts mentioned in 2. and 4. above" in line 10 of page 86 of the judgment in prior instance shall be modified into "when the Design identified in sections 2. and 3. above is compared with the structures of the Subject Design."

(omitted)

"(3)(i) The Design and the Subject Design are identical in terms of the structures found in

(1) above. The Subject Design has the feature of the Design found in 4. above, and when the two designs are observed in whole, they give a common aesthetic impression to the observers and thus the Subject Design can be found similar to the Design.

Although the Design and the Subject Design differ in the points found in (2) above, all of the differences are those related to the parts that are irrelevant to the feature of the Design or are related to the details and thus, the abovementioned differences cannot be found to give a different aesthetic impression that outstrips the common aesthetic impression mentioned above.

(ii) The appellant makes the allegations as stated in section 3.(2) in the part "Allegations of the parties" on the grounds that the Design and the Subject Design are not similar to each other.

However, as explained above, the position and shape of the winch as well as the existence and shape of the counterweight, which would be necessary in relation to the position of the winch, may attract the attention of the person who looks at them but cannot be found to go far enough to form the feature of the Design. Thus, the difference between the Design and the Subject Design in terms of the existence or absence of the winch and counterweight cannot be found to give a completely different impression to the observers when observing the two designs in whole.

As stated above, while the overall length to overall height ratio and overall width to overall height ratio are 0.37 and 1.25, respectively, in the Design, the overall length to overall height ratio and overall width to overall height ratio are found to be 0.42 and 1.43, respectively, in the Subject Design according to the Attached List of the Subject Design (i) and (ii). When the two designs are compared, the vehicle height of the Subject Design is higher in comparison to that of the Design but a difference of such level cannot be found to be especially remarkable and at least cannot be found to affect the common aesthetic impression given by having the feature of the Design.

The appellant alleges that the Design has the following characteristic features in terms of appearance: [i] the winch and counterweight are established at a high position; [ii] the gravity center is high due to the structure mentioned in [i] above; [iii] the Design presents a complicated shape; and [iv] the Design has a shape that is flat and extends back and forth as a whole. The appellant also alleges that the Subject Design has the following characteristic features in terms of appearance: [a] the winch is stored in the lower box; [b] there is no counterweight; [c] the gravity center is low due to the structures mentioned in [a] and [b] above; [d] the Subject Design has a simple and plain step-shape; and [e] the Subject Design has a vertically short and fat shape shorter in depth as a whole.

However, as explained above, the common aesthetic impression would not be affected by the existence or absence of the winch and counterweight or the difference in the vehicle height between the Design and the Subject Design.

In addition, there are several differences between the Design and the Subject Design such as the width of the space between the rear end part of the upper revolving structure and the front edge part of the engine box and the length of the part wherein the boom is protruding in front of the front edge of the base carrier. However, even if the two designs are observed in whole including the abovementioned points, they cannot be regarded as being dissimilar to each other.

Accordingly, the appellant's allegation mentioned above cannot be accepted."

(omitted)

No. 2 Conclusion

As described above, the appellee's claims made against the appellant (including the part expanding the claim based on the incidental appeal) are well-grounded to the extent of seeking an injunction against the manufacture, sale and display for sale of the Subject Item as well as the destruction thereof and payment of damages in an amount of 451,170,000 yen, and delay damages accrued on 142,560,000 yen among the first-mentioned amount at the rate of 5% per annum as prescribed in the Civil Code for the period from January 1, 1993 (the date on and after the date on which tort was conducted; the same shall apply hereinafter), delay damages accrued on 100,980,000 yen among the first-mentioned amount at the rate of 5% per annum as prescribed in the Civil Code for the period from January 1, 1994 until the date of completion of the payment, delay damages accrued on 106,650,000 yen among the first-mentioned amount at the rate of 5% per annum as prescribed in the Civil Code for the period from January 1, 1995 until the date of completion of the payment, delay damages accrued on 96,660,000 yen among the first-mentioned amount at the rate of 5% per annum as prescribed in the Civil Code for the period from January 1, 1996 until the date of completion of the payment and delay damages accrued on 4,320,000 yen among the first-mentioned amount at the rate of 5% per annum as prescribed in the Civil Code for the period from August 1, 1996 until the date of completion of the payment, and thus should be upheld while the other claims should be dismissed for lacking legitimate reasons.

Accordingly, the Appeal filed by the appellant shall be dismissed for lacking legal basis, and paragraph 3 of the main text of the judgment in prior instance shall be modified as stated in paragraph 2(1) of the main text of this judgment based on the incidental appeal, while the other claims made by the appellee (including the part expanding the claim based on the incidental appeal) shall be dismissed. Articles 67, 64 and 61 of the Code of Civil Procedure shall be applied to the burden of court costs, and Article 259 of said Code shall be applied to the declaration of provisional execution, and the judgment shall be rendered in the form of the main text.

(Tokyo High Court, Judges: NAGAI Toshiaki, HAMAZAKI Kōichi, ICHIKAWA Masami)