

Date	September 11, 2008	Court	Osaka District Court, 26th Civil Division
Case number	2007 (Wa) 1411		

1. With regard to a design right for the design to be affixed to an article titled "coupling horn," the court dismissed the plaintiff's claim for damages based on said design right, holding that the defendant's design is not similar to the design covered by the relevant registered design.

2. With regard to a utility model right for the utility model of a device titled "ultrasonic spindle," the court dismissed the plaintiff's claim for damages based on said utility model right, holding that the relevant utility model registration is found to be one that should be invalidated by a trial for invalidation of the utility model registration.

The plaintiff holds a design right for the design to be affixed to an article titled "coupling horn" (the "Design Right"), and also holds a utility model right for the utility model of a device titled "ultrasonic spindle" (the "Utility Model Right"). A coupling horn is one of the components constituting an ultrasonic spindle.

In this case, the plaintiff sought damages in tort against the defendant, alleging that the product manufactured and sold by the defendant infringes the Utility Model Right and its component (the "defendant's horn") infringes the Design Right.

The major issues of the case regarding infringement of the Utility Model Right are: [i] whether the defendant's product falls within the technical scope of the device covered by the Utility Model Right (the "Device"); and [ii] whether the relevant utility model registration should be invalidated by a trial for invalidation of the utility model registration. The major issues of the case regarding infringement of the Design Right are: [iii] whether the defendant's horn is similar to the design covered by the Design Right (the "Registered Design"); and [iv] whether the Registered Design is found to be used in the defendant's product.

As for the claim based on infringement of the Utility Model Right, the court held that it would have been extremely easy for a person ordinarily skilled in the art to create the Device by referring to the documents submitted by the defendant, and concluded that the plaintiff may not exercise its rights based on the Utility Model Right.

As for the claim based on infringement of the Design Right, the court held that: "the article to the registered design is a coupling horn. A coupling horn is connected to an ultrasonic head and conveys the ultrasonic vibration generated by the ultrasonic head to a working tool, and thus it is one of the components constituting an ultrasonic spindle"; "a coupling horn is not distributed independently...rather, the article that is actually traded in the distribution process is the defendant's product which is an ultrasonic

spindle." Holding as such, the court determined that the subject article is different from the article covered by the Design Right. The court further held that: "in the appearance of the defendant's product, only a portion of the defendant's horn which has a shape of a regular hexagon in a cross sectional view (the 'head part') is slightly visible"; "the design for the defendant's horn is remarkably different from the Registered Design due to the shape of the head part that can be recognized from the appearance of the defendant's horn." Accordingly, the court determined that the design of the defendant's horn is not similar to the Registered Design.

As for the use of the Registered Design in the defendant's product, the court held that "the defendant's horn cannot be recognized in its entirety from the appearance of the defendant's product, and only the head part of the defendant's horn is slightly visible from the outside," and concluded that the Registered Design cannot be found to be used or contained in the defendant's product.