

Judgments of Intellectual Property High Court, First Division

Date of the Judgment: 2005.10.31

Case Number: 2005 (Ne) No.10079

Title (Case):

A case wherein the court, in a lawsuit to seek injunctive relief, etc., held as follows: Since the statements in the ‘Explanation of the Article to Which the Design Is Applied’ section of the request for the application for design registration are intended to help understand an article such as that stated in the ‘Article to Which the Design Is Applied’ section, the scope of articles to which the registered design is applied should be defined by the class of article as stated in the ‘Article to Which the Design Is Applied’ section; From the perspective of similarity of articles, the product sold by the appellee (defendant in the first instance) is significantly different from the article to which the registered design is applied, in terms of the purpose and manner of use, and would not be confused with the latter. Therefore, the appellee’s products cannot be deemed to be included within the scope of rights for the registered design and shall not be subject to the effects of the design right.

References: Articles 2, 3, 7, and 23 of the Design Act

Summary of the Judgment:

In this case, the appellant (plaintiff in the first instance) who holds a design right for the design applied to “carabiner,” alleging that the design right is infringed by the appellee (defendant in the first instance) who has sold heart-shaped accessories made of aluminum, requested the appellee to stop sales, destroy the infringing products, and pay damages for infringement. The court of the first instance dismissed the appellant’s claim, holding that the appellee’s products cannot be included within the scope of rights for the registered design. This appeal was filed against the judgment of the first instance. The court dismissed the appeal, holding as follows.

In the request for the application for design registration, the “Article to Which the Design Is Applied” section states “carabiner,” and the “Explanation of the Article to Which the Design Is Applied” section states “the article to which the design relating to the application is applied is used as a mountaineering tool or general tag, and also as a decorative part of a key ring or key chain.” The court held that the term “carabiner” had already become a general noun referring to a rock-climbing tool or mountaineering tool. Based on the construction of Article 7 (one application for one design) of the Design Act and the appended table for the Regulations under the said Act, the court also held as follows: “The scope of articles to which the registered design is applied should be defined by the class of article as stated in the ‘Article to

Which the Design Is Applied’ section, and the statements in the ‘Explanation of the Article to Which the Design Is Applied’ section are intended to help understand an article such as that stated in the ‘Article to Which the Design Is Applied’ section. Therefore, in principle, the statements on the article in the request shall be defined by the class of article as stated in the Article to Which the Design Is Applied’ section of the request, and the class of article shall not be affected by any statements in the ‘Explanation of the Article to Which the Design Is Applied’ section.” Based on such conclusions, the court rejected the appellant’s argument that based on the statements in the “Explanation of the Article to Which the Design Is Applied” section, the scope of articles to which the registered design is applied should include a carabiner used as a key ring, which corresponds to the appellee’s product.

The court further examined, from the perspective of similarity of articles, whether or not the appellee’s products were included within the scope of rights for the registered design. On this issue, the court held as follows. “Since a design relates to the appearance of an ‘article’, a design cannot exist without an article. In other words, an ‘article’ is inseparable from its ‘shape, pattern or color or any combination thereof.’ ” “ The concept of ‘similarity’ of articles can be deemed to be the same as that of ‘similarity’ of designs prescribed in Article 3(1) (i) of the Design Act. Therefore, the main clause of Article 23 of the said Act should be construed to provide that the effects of a design right shall extend to ‘articles that are identical or similar to the article to which the registered design is applied’ with respect to the ‘registered design and other designs similar thereto.’ In this context, ‘articles that are similar to the article to which the registered design is applied’ mean such articles that would cause, if the registered design or other similar designs are applied thereto, confusion with the article sold by the design right holder among the consumers of such articles.” “The article to which the registered design is applied is a ‘carabiner’ that is used as a rock-climbing tool or mountaineering tool, whereas the appellee’s product is a heart-shaped accessory made of aluminum or metal. Considering this, it is obvious that the appellee’s product is significantly different from the article to which the registered design is applied in terms of the purpose and manner of use, and even if the configuration of the appellee’s product is similar to the composition of the article to which the registered design is applied, it is difficult to conclude that consumers of the appellee’s products are likely to confuse, on the occasion of actual transactions, the appellee’s products with the ‘carabiners’ to which the registered design is applied. Therefore, from the perspective of similarity of articles, the appellee’s products cannot be deemed to be included within the scope of rights for the registered design and shall therefore not be subject to the effects of the design right.”

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