

Judgments of Osaka District Court, 21st Civil Division

Date of the Judgment: 2006.12.21

Case Number: 2006 (Wa) No. 7014

Title (Case):

A case wherein the plaintiff company claimed for an injunction and damages based on its registered design for a block mat, asserting that the defendant's design should be regarded as similar to the plaintiff's registered design because the application for design registration filed by the plaintiff for another design, which was identical or similar to the defendant's design, had been rejected by the JPO on the ground that it was similar to the plaintiff's registered design, but the court rejected such assertion, found that the defendant's design was not similar to the plaintiff's registered design, and dismissed both of the plaintiff's claims.

Summary of the Judgment:

In this case, the plaintiff company which holds a registered design right for a block mat, claimed injunction against manufacturing and selling block mats by the defendant company, asserting that the defendant's design infringed its design rights, and also claimed payment of damages for the design rights infringement.

Block mats are construction materials, comprising a mat made of polypropylene fabric or other unflamable fabric or paper and multiple concrete blocks, each of which has openings from the top to the bottom in the middle thereof, fixed on the mat and are mainly used in bank protection and slope protection work. Generally, the size of a block mat is about 7 meters long and about 2 meters wide.

First, the court examined what is the important feature of the registered design.

When choosing a block mat to be used in their work, consumers of the block mat (construction companies) uses catalogues of block mats or look at samples of block mat products. In the catalogues, the front view drawing of block mats is printed. Normally, mats have the shape of a vertically long rectangle, and are provided with margins on the top, the right and the bottom of the edges thereof. These margins do not appear on the surface when the mats are used. On the other hand, blocks can be formed in various shapes by using different moulds. In fact, blocks of various shapes can be found on the market. To provide an opening in a block is, in itself, a commonplace practice, and openings are seen in public known designs of blocks. However, when block mats are used in construction works for covering and sheltering a slope with soils and plants, the shapes of the opening and of the space between each block will play a certain role in outflow prevention of soils and seeds and thus may be observed with great attention by the consumers. Accordingly, when construction companies observe a block mat, they pay particular attention to how blocks appear to be arranged on the block mat in its front view when the block mat is laid on a bank or slope and to the shape of each block in its front view.

Further, the court found that, from examination of the publicly known designs, in the configuration of a block mat in which incomplete-square-shaped blocks with their four corners cut off in an arc shape are arranged in a vertically-long rectangle grid-like fashion, or shape of a block in which a concave center is formed in an inverted cone shape that appears as two concentric

circles drawn by its arrises in its front view, are commonplace on the market. The court concluded that since the construction companies, which are consumers of block mats, have relevant technical knowledge and also have information on block mats marketed in the past, these commonplace configurations or shapes cannot be deemed as those that draw the attention of the construction companies.

Then, the court examined the plaintiff's registered design and found as follows. The shape of the blocks pertaining to the plaintiff's registered design can be regarded as being novel in that the concave center and the opening of each block appear in their front view as two concentric circles and two incomplete squares drawn by its arrises and in that each block appears in its side view as a horizontally-long rectangle. Moreover, as a result of the shapes of pyramidal planes of each block and the manner in which the blocks are arranged, the spaces between blocks form parallel lines except for the spaces between the corners of blocks, and in its front view, it appears as if the blocks are divided by boundary lines. This is a novel feature that cannot be found in the publicly known designs. Owing to these features, despite the circle shape of the concave centers of each block, the plaintiff's design in its entirety accentuates orderly-arranged incomplete squares drawn by arrises of the outer edges and openings of the blocks and thereby provides viewers with an inimitable aesthetic impression. These features should be regarded as the important features of the plaintiff's registered design.

Based on the aforementioned findings, the court rejected the plaintiff's assertion that the important feature of the registered design lies in the point that the whole of the mat was covered by blocks except for margins on three sides of the mat, by stating that such feature is nothing more than a commonplace feature. In conclusion, the court found that the design of the defendant's products could not be regarded as being similar to the registered design.

The plaintiff also asserted that the defendant's design should be regarded as similar to the plaintiff's registered design because the application for design registration filed by the plaintiff for another design, which was identical or similar to the defendant's design, had been rejected by the JPO on the ground that it was similar to the plaintiff's registered design. The court rejected this assertion by holding that the reasons for the decision of refusal made by the JPO had no binding effect to the court and that comparison between the registered design and the defendant's design alone would be sufficient for deciding whether the two designs are similar or not.

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