

Date	May 28, 2009	Court	Intellectual Property High Court, Fourth Division
Case number	2008 (Gyo-Ke) 10401		
<p>– A case in which the court denied the similarity between the claimed design as described below, which designated a "fluid pressure cylinder" as the article to the design (the "Claimed Design"), and the cited design (the "Cited Design"), and thereby rescinded a JPO decision that found these two designs to be similar (the "JPO Decision").</p>			

Reference:

Article 3, paragraph (1), item (iii) of the Design Act

#### No.1 Claimed Design

1. Article to the design: Fluid pressure cylinder
2. Configuration of the design: As shown in Appendix 1

#### No. 2 Cited Design

1. Article to the design: Hydraulic cylinder
2. Configuration of the design: As shown in Appendix 2

#### No. 3 Findings by the JPO Decision

1. Common and different features found by the JPO Decision

-Common features

A. Both have a basic structure consisting of a nearly square column cylinder tube, which has [i] a projecting piston rod at its center, [ii] a rod cover installed in the recessed part surrounding said piston rod; and [iii] bolt hole parts at its four corners. (Common Feature 1)

Regarding structural details:

B. On the upper surface of the cylinder tube, a swollen part that has a nearly rectangular section is formed, which has two holes as fluid pressure inlet/outlet ports on its upper side. (Common Feature 2)

C. Seen from the front side of the cylinder (front view), a narrow retaining ring whose bottom part is open is installed in the recessed part on the front side. Both ends of the retaining ring have a nearly semicircular part projecting towards the inside. (Common Feature 3)

D. On the skirts of the bolt hole parts at the four corners, narrow, nearly U-shape grooves are formed on both sides. (Common Feature 4)

-Different features

- A. Regarding the portions of individual parts, the portion of the swollen part that has a nearly rectangular section formed on the upper surface of the cylinder and that of the bolt hole parts at the four corners are relatively small in the Claimed Design, while those in the Cited Design are large. (Different Feature A)
- B. Regarding the both side surfaces and the bottom surface of the cylinder, the Claimed Design has swollen parts that respectively have a nearly trapezoidal section, whereas the Cited Design has a pair of nearly L-shape ribs opposing each other. (Different Feature B)
- C. Regarding the bolt hole parts, their edges have a round shape in the Claimed Design, while those of the Cited Design have an angular shape. (Different Feature C)
- D. Regarding the back surface, a circular end block is formed in the Claimed Design, while it cannot be observed in the Cited Design. (Different Feature D)

## 2. Determination of similarity

Both designs share the article to the design and the common features among the configurations of both designs have a great impact on determining whether or not these two designs are similar, while the impact of the different features on such determinations is so small or insignificant that it cannot surpass that of the common features. Thus, it is inevitable to conclude that the two designs are similar.

## No. 4 Judgment

In this judgment, as a result of examining said Common Features 1 through 4 and Different Features A through C, as well as Different Feature F which was undisputed among the parties (which is stated as follows: inclined parts are formed on both sides of the swollen part that has a nearly rectangular section formed on the upper surface of the cylinder in the Claimed Invention, while the Cited Design lacks such inclined parts), the court found as follows and rescinded the JPO Decision by holding that there was an error in the JPO Decision which found both designs to be similar.

In light of Appendix 1 referring to the Claimed Design and Appendix 2 referring to the Cited Design (simply referred to as "Appendix 1" and "Appendix 2", respectively), which are attached to the JPO Decision, it is obvious that the JPO determined the similarity between the two designs by specifying the configuration of the Cited Invention based on its perspective view only and by comparing it with the Claimed Invention whose configuration is specified by a six-sided view as well as by a perspective view. The plaintiff claims that the methods that the JPO used for finding the Cited Design and for determining the similarity between the two designs were

inappropriate. However, if it were possible to determine the similarity between the two designs by comparing the Cited Design whose configuration is specified by Appendix 2 and the Claimed Design whose configuration is specified by Appendix 1, then the question of whether or not the JPO Decision was appropriate can eventually be translated into the question of the appropriateness of its conclusion which found the two designs were similar.

Therefore, the appropriateness of the determination of similarity in the JPO Decision will be examined by comparing the Cited Design specified by Appendix 2 and the Claimed Design specified by Appendix 1 from the viewpoints stated above.

#### 1. Facts that serve as premises for the determination of similarity

##### -Commonalities of the article to the design

The JPO determined the articles to the designs as a "fluid pressure cylinder" and a "hydraulic cylinder" for the Claimed Design and Cited Design, respectively. The plaintiff does not dispute this point, and it can be said that the two designs share the article to the design.

##### -Common and different features between the two designs

Firstly, the both parties have no dispute over the fact that the configurations of the two designs have commonalities in terms of Common Features 1 through 4.

Secondly, both parties have no dispute over the fact that the configurations of the two designs are different in terms of Different Features A through D.

#### 2. Whether or not the two designs are similar

##### -Examination on the common features

Both parties have no dispute over the fact that Common Features 1 through 4 are ordinary features as a configuration of a fluid pressure (or hydraulic) cylinder. In other words, both designs share a basic structure for a cylinder in that they use a nearly square column cylinder tube, with a piston rod provided at the center, and they have bolt hole parts at the four corners of the cylinder tube.

The defendant alleges that, since the configurations of both of the two designs are "ordinary configurations" for cylinders as stated above, Common Features 1 through 4 are the parts that attract the most attention of the consumers (i.e., the essential features).

However, it is construed that ordinary configurations can attract the most attention of the consumer only when the aesthetic appearance of the configurations other than said ordinary configurations does not surpass that of said ordinary configurations. Therefore, contrary to the defendant's claim, similarity between the two designs cannot

be easily determined by merely considering the aesthetic appearance gained from Common Features 1 through 4; instead, the aesthetic appearances of other configurations also need to be taken into consideration in making such determination. In this case, there is no choice but to determine the similarity by taking into consideration the aesthetic appearance gained from Different Features A through D. Furthermore, regarding the aesthetic appearances gained from Different Features E through G, which the plaintiff alleges that the JPO overlooked, the JPO should have also examined them as needed after determining them as different features.

-Examination on the different features

To this effect, a further examination will be given to the different features between the configurations of the both designs.

#### A. Different Feature A

Different Feature A regards the difference in the portion of the swollen part that has a nearly rectangular section and that of the bolt hole parts in the whole cylinder. While both designs use a cylinder consisting of a nearly square column tube, to reduce the size of the swollen part that has a nearly rectangular section and that of the bolt hole parts means to extend the space (the part recessed from the outer frame of the nearly square column cylinder tube) on both ends thereof. As a result, it is found that the Claimed Design accentuates the appearance of the circular piston part and gives an impression that the bolt hole parts are projecting from the cylinder. As the plaintiff claimed, it can be found that the Claimed Design generally emphasizes the curved lines and achieves a soft appearance.

With this regard, the defendant alleges that such difference between the two designs is insignificant in terms of the ratio between the inner diameter of the bolt hole part and the maximum width of the cylinder tube in the Claimed Design. However, even if the defendant's allegation is taken into account, it cannot be denied that the Claimed Design gives an aesthetic appearance that is more similar to that of a circular cylinder as a result of accentuating the curved lines, while it can be said that the Cited Design retains an ordinary configuration as a nearly square column cylinder, when the perspective view in Appendix 1 is compared with Appendix 2.

Based on above, it is found that, when the two designs are compared, the Claimed Design as a whole has an effect to offset the impression that it was originally a nearly square column by making the appearance of the cylinder more similar to that of a circular cylinder by reducing the size of the swollen part that has a nearly rectangular section and that of the bolt hole parts. Therefore, it must be said that there was an error in the JPO Decision which determined that the design effect gained from the

configuration of the Claimed Design in relation to Different Feature A had only an insignificant impact on the determination of similarity, and it should be concluded that said design effect is not negligible.

#### B. Different Feature B

Different Feature B regards the difference in the swollen parts that respectively have a nearly trapezoidal section formed on the both side surfaces and the bottom surface of the cylinder tube. When the two designs are compared, the Claimed Design gives an impression that the thickness of the parts around the four corners is comparatively small, since forming swollen parts that respectively have a nearly trapezoidal section means to create parts which are depressed compared to the edge surface of said swollen parts (the upper side of the trapezoidal shape) on the both ends of said surfaces, whereas the thickness of said parts become usually thick as a matter of course since the shape of the cylinder tube's inner surface is a circle and its outer surface is nearly square. In addition, the inclined parts of the trapezoidal shape of the swollen parts give an impression that the side surfaces and the bottom surface of the cylinder are not straight. Therefore, as with Different Feature A, it is found that the cylinder tube in the Claimed Invention as a whole has an effect to offset the appearance of a nearly square column shape. Furthermore, in relation to a pair of the "nearly L-shape ribs" opposing each other on both side surfaces of the cylinder in Cited Invention, which the Claimed Invention lacks, it cannot be completely denied that the Cited Design emphasizes the appearance of the straight lines by adopting these parts, as contrary to the Claimed Design, according to Appendix 2. At least, it has to be said that it is unreasonable to conclude that these ribs "do not deserve any particular attention," as stated in the JPO Decision. Therefore, it must be said that there was an error in the JPO Decision which determined the design effect gained from the configuration of the Claimed Design in relation to Different Feature B had only an insignificant impact on the determination of similarity, and it should be concluded that said design effect is not negligible.

With this regard, the defendant alleges that such difference between the two designs is insignificant in terms of the ratio between the thickness of the swollen parts that respectively have a nearly trapezoidal section and the maximum width of the cylinder tube in the Claimed Design. However, in light of the explanation above, it has no influence on the above conclusion regarding the design effect gained from the configuration of the Claimed Design in relation to Different Feature B even if the gap between the values of said ratio is small.

In addition, the defendant also alleges that the swollen parts that respectively have

a nearly trapezoidal section in the Claimed Design are generally wide and thus they do not create any significant difference from the Cited Design that has roughly flat side and bottom surfaces. However, it is obvious that there is a non-negligible difference between the two designs due to the aesthetic appearance gained from the recessed part on both sides of said swollen parts. Therefore, the defendant's claim cannot be accepted.

#### C. Different Feature C

Different Feature C regards the difference in the shape of the edges of the bolt hole parts. When the two designs are compared, it is obvious that the Claimed Design has an effect to offset the appearance of the angular shape of the corners of the cylinder tube (the bolt hole parts) since said parts have a round shape, according to Appendix 1. Meanwhile, the Cited Design gives an impression that said parts are unified and integrated to the outer frame of the nearly square column cylinder tube, according to Appendix 2. Therefore, it is found that there was an error in the JPO Decision which determined the design effect gained from the configuration of the Claimed Design concerning Different Feature C had only an insignificant impact on the determination of similarity, and it should be concluded that said design effect is not negligible.

With this regard, the defendant alleges that such difference is limited to a very small area, since the edges of the bolt hole parts in the Cited Design are also formed in a nearly trapezoidal shape and are not significantly different from the configuration of the same parts of the Claimed Design. However, when the two designs are compared, it is found that the appearance of the rounded shape gained from the edges of the bolt hole parts in the Claimed Design and the appearance of the angular shape of the same parts in the Cited Design apparently achieve a different aesthetic appearance. Therefore, said defendant's allegation is not appropriate.

The defendant also alleges that rounding the corner parts is a common practice which is applied to goods of various categories. However, this does not have any direct influence on the above conclusion regarding the design effect gained from the configuration of the Claimed Design in relation to Different Feature C.

#### D. Different Feature F

The plaintiff alleges that the JPO Decision overlooked Different Feature F. Said different feature refers to the difference in the swollen part that has a nearly rectangular section formed on the upper surface of the cylinder. Said part in the Claimed Design has inclined parts on both sides while the Cited Design does not have any such inclined parts.

When the two designs are compared, while taking into account such difference, the

inclined parts formed on both sides of the swollen part that has a nearly rectangular section offsets the impression that the upper surface of the cylinder tube is straight, and it is found that the Claimed Design thereby achieves an effect to offset the impression that the cylinder tube as a whole is a nearly square column shape. Therefore, the design effect gained from the configuration of the Claimed Design in relation to Different Feature F should not be neglected either. It has to be said that it was an error that the JPO Decision did not consider this point in determining the similarity between the two designs.

With this regard, the defendant alleges that the configuration of the Claimed Design in relation to Different Feature F has only limited influence on the determination of similarity between the two designs, since said inclined parts in the Claimed Design are extremely narrow and are just slightly inclined, and the existence of said inclined parts is an insignificant difference since it affects only a very small portion of the whole design.

However, when the two designs are compared, both sides of the swollen part that has a nearly rectangular section established on the upper surface of the cylinder tube in the Cited Design enhance the straight and flat appearance as it lacks said inclined parts, whereas in the Claimed Design it is found that said inclined parts offset the straight and flat appearance in the Cited Design. Therefore, the defendant's allegation cannot be accepted.

#### E. Conclusion

According to the above explanation, with respect to Different Features A through C among the different features, which the JPO Decision took into consideration in determination of similarity, and the Different Feature F, which was overlooked in the JPO Decision but should have been taken into consideration in determining the similarity of the two designs, the design effects gained from the configurations of the individual parts in the Claimed Design are as stated in A. through D. above. As for the design effects gained from the configuration of the Claimed Design in relation to Different Features A, B and F, among others stated above, it was found that: although both the Claimed Design and the Cited Design consist of a nearly square column cylinder tube, the Claimed Design offsets, to a considerable extent, the impression that the whole cylinder including the bolt hole parts has a nearly square column shape when compared to the Cited Design; and that it gives an impression as if the cylinder tube except for the bolt hole parts has a round shape and said bolt hole parts were attached to it in a way that they are slightly projecting from the cylinder tube. When taking into consideration, in addition to the matters stated above, the design effect

gained from the configuration of the Claimed Design in relation to Different Feature C (i.e., the round shape of the edges of the bolt hole parts), it is reasonable to find that the configurations of the Claimed Design in relation to Different Features A through C and F together produce a design effect that creates an aesthetic appearance considerably different from the Cited Design in Appendix 2.

Furthermore, when taking into account the content and significance of said design effect that Different Features A through C and F together produce, as well as the fact that the configurations in relation to Common Features 1 through 4 are ordinary configurations, the design effect that said configurations of the Claimed Design in relation to said different features together produce does fairly surpass an ordinary aesthetic appearance that the common features among the two designs produce.

According to these findings, it has to be said that there was an error in the determination in the JPO Decision, which stated that "it is inevitable to conclude that the Claimed Design, as a design as a whole, fails to achieve particular features that are not seen in the Cited Design, even if the effect that said different features together produce is taken into consideration."

The defendant alleges that the configuration of the outer surface of the cylinder tube in the Claimed Design does not drastically reverse the impression that it is a nearly square column shape. However, in light of the explanation above, it is obvious that such allegation cannot be accepted.

-Whether or not the determination of similarity in the JPO Decision was appropriate

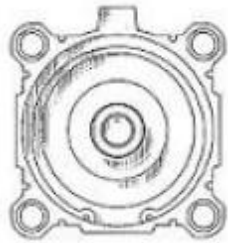
As discussed above, even if a consideration is given to the fact that the Claimed Design and Cited Design share the article to the design and that they have common configurations in terms of Common Features 1 through 4, it is found that the two designs are not similar in terms of Different Features A through C and F. Thus, it has to be concluded that the JPO Decision which found the two designs are similar was erroneous.



Appendix 1: Claimed Design

Article to the design: Fluid pressure cylinder

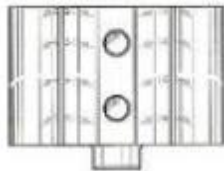
Front view



Back view



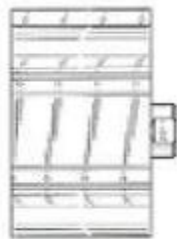
Top view



Bottom view



Left side view



Right side view



Perspective view



Appendix 2: Cited Design

