

Design Right	Date	March 28, 2019	Court	Osaka District Court, 26th Civil Division
	Case number	2017 (Wa) 849		
- A case in which similarity to the design of Defendant's product was found regarding the design of the article called "ELECTRONIC CIGARETTE CASE" according to the design, but the defense of rights of prior use by Defendant was affirmed, and Plaintiff's claim was dismissed.				

Summary of the Judgment

This case is a case in which Plaintiff having the design right of the design of the article called "ELECTRONIC CIGARETTE CASE" according to the design (Plaintiff's design) claimed compensation for damage on the ground of a tort of design right infringement, and injunction and the like of manufacture/sales of Defendant's product from Defendant selling a cigarette case (Defendant' product) for IQOS, which is an electronic cigarette, by asserting that the design of Defendant's product is similar to Plaintiff's design.

The structural form of Plaintiff's design was such that a small-sized storage portion for storing a package of the electronic cigarette is installed on a front surface side, while a large-sized storing portion for storing a portable charger on a rear surface side is installed by superimposing it, and a belt formed by extending an upper end of the rear surface portion to a center part on the front surface is provided.

The judgment found that, in view of the use form of the electronic cigarette case, consumers are found to pay attention to the design seen mainly from a front view of Plaintiff's design, and by considering publicly-known designs related to the same kind of products sold on the Internet, major essential parts of Plaintiff's design were found such that each of the storing portions has substantially the same size in the width and the height of the cigarette package and the portable charger stored therein, and the belt has its width narrowed but mostly uniform and is smaller in width than the small-sized storing portion and extension comes to the center part on the front surface.

Moreover, it was found that Plaintiff's design and the design of Defendant's product are in common in specific structural forms related to the aforementioned major essential parts in addition to the basic structural forms.

On the other hand, it was found that installation and the like of the bottom part of the small-sized storing portion being disposed on an upper side of the bottom part of the large-sized storing portion is a secondary essential part of Plaintiff's design, and is different from the specific structural form of the design of Defendant's product. However, the major feature of Plaintiff's design is the point that the structural form

according to the aforementioned major essential part gives a smart and simple impression, and it was judged that the difference did not make a sense of beauty of Plaintiff's design different from that of the design of Defendant's product, and similarity was found between the two designs.

Subsequently, whether or not the defense of rights of prior use of Defendant is established was examined, and allegation/statement by Defendant representative on the history of development of Defendant's product was consistent with documentary evidence and determined to be trustworthy and thus, it was found that Defendant created the design of Defendant's product without knowing Plaintiff's design by the date of application of registration of Plaintiff's design and prepared for the business which is working of the design at least in Japan.

In accordance with the above, all of the claims by Plaintiff were dismissed.