

Design Right	Date	September 5, 2019	Court	Osaka High Court, 8th Civil Division
	Case number	2018 (Ne) 2523		
- A case in which the court maintained the judgment in prior instance which partially approved the claims made against First Instance Defendant by First Instance Plaintiff, who is the holder of a design right for a partial design whose article to the design is an "inspection lighting apparatus", including a claim for an injunction against the sale and manufacture of products.				

Summary of the Judgment

First Instance Plaintiff, who was granted registration for a design for the heat release part of an "inspection lighting apparatus", asserted that the design of the heat release parts of the six types of inspection lighting apparatuses (Defendant's Products) which are manufactured and sold by First Instance Defendant are similar to First Instance Plaintiff's registered design (Partial Design), and demanded against First Instance Defendant for an injunction against the manufacture and sale of Defendant's Products, discarding of products, compensation for damage on the basis of a tort of design right infringement, and for return of unjust enrichment in the amount corresponding to royalties.

In the judgment in prior instance (rendered by Osaka District Court on November 6, 2018 (2016 (Wa) 12791), the court rejected the defense which First Instance Defendant made on the basis of design right invalidation. Next, concerning the similarity between Partial Design and the design of the heat release parts of Appellant's Products, the court, by taking into consideration factors such as that customers would focus on how the heat release part is shaped and positioned from the perspective of heat release efficiency, recognized the important part of the Partial Design accordingly, and by determining that the design of the heat release parts of three old-model types of the six types of Defendant's Products are similar to Partial Design, acknowledged that there was design right infringement, and approved the claim for an injunction against the sale of the products but dismissed the claim for discarding the same because there is no stock (as for the other three new-model types of Defendant's Products, the court held that the design is not similar to Partial Design). As for the amount of damages suffered by First Instance Plaintiff, the court held that many of the same features found in the design of the heat release parts of the old-model types of Defendant's Products and in Partial Design concern the shape that had been well known since even before the application for design registration was filed, so that the similarity with Partial Design is not likely to contribute much to customers'

motivation for purchasing, and thus took into consideration the level of contribution by Partial Design. As such, the court partially approved First Instance Plaintiff's claim for compensation for damage and claim for return of unjust enrichment.

In response, both parties appealed the case in regards to the parts in which the respective parties lost. In the judgment of the present case, the court upheld the judgment in prior instance and dismissed both appeals. Like the judgment in prior instance, the court dismissed the claim of First Instance Defendant's for invalidation of the design right, which was made on the basis of lack of novelty and lack of creative difficulty due to the combination of a known design and a cited design. Concerning the argument on infringement, the court recognized that the important part of Partial Design is that the shapes of the middle fin and the back-end fin, which are members composing the fin structure, have no through-hole in any place other than the part where the support shaft passes through, so that each surface is flat and smooth, and determined that the design of the heat release parts of the old-model types of Defendant's Products is similar to Partial Design (while determining that the design found in the new-model types of Defendant's Products is not similar). As for the argument on damage, the court determined in the same manner as the judgment in prior instance.