

Design Right, Unfair Competition	Date	August 29, 2019	Court	Osaka District Court, 26th Civil Division
	Case number	2017 (Wa) 8272		
- A case in which the court approved a claim for an injunction against the sale, etc. of Defendant's Product and a claim for compensation for damage by holding that the design of a flowing somen noodle machine sold by Defendant (Defendant's Product) is similar to Plaintiff's design (the article to the design being a flowing somen noodle machine; Registered Design).				

Summary of the Judgment

The present case is one in which, concerning the sale, etc. by Defendant of Defendant's Product, which is a flowing somen noodle machine, Plaintiff [i] asserted that the design is similar to Registered Design and made a claim for an injunction and a claim for discarding of the Defendant's Product on the basis of a design right as well as a claim for compensation for damage on the basis of design right infringement, [ii] asserted that since Defendant's Product uses a shape that is similar to the shape of a flowing somen noodle machine sold by Plaintiff (Plaintiff's New Product), which is a well-known indication of goods or business, the above act by Defendant falls under unfair competition as stipulated in Article 2, paragraph (1), item (i) of the Unfair Competition Prevention Act, and sought for an injunction and for discarding of Defendant's Product, and for compensation for damage pursuant to the same Act, and [iii] since Defendant's Product is an imitation of the shape of Plaintiff's New Product, the above act by Defendant falls under unfair competition as stipulated in Article 2, paragraph (1), item (i) of the same Act, and sought for compensation for damage pursuant to the same Act.

Concerning the claims pertaining to a design right, Defendant also asserted the defense of invalidation. However, since it can be said that the grounds for invalidation as asserted in the present case are based on the "same facts and evidences" which were used as the grounds for invalidation as asserted in the trial for invalidation of design registration, with respect to which a decision to dismiss the request for a trial had become final, the actual issue was only whether or not the two designs are similar.

In the judgment of the present case, the court recognized that the shape of the slide part in the Registered Design has the configuration that is found in the shape of the slide part in the design of Plaintiff's Old Product, and the shape of the pool part

that is formed by a circumferential side surface and a rotator inside the tray part of the Registered Design has the configuration that is found in the designs of lazy-river-type flowing somen noodle machines which were publicly known from before the filing of the application for registration of the Registered Design. Nevertheless, the court held that, in a design, what eventually has significance is the entirety of the visual information consisting of various factors combined, so that even if visual information contains a publicly-known design in part, such publicly-known design may, when combined with other factors, constitute a different design as a whole. Accordingly, while it is necessary to refer to publicly-known designs when recognizing the important part of a design, the fact that a publicly-known design is included does not immediately mean that the part of the publicly-known design should be eliminated from the important part of the design. On that premise, the court held that [i] none of the water-slider-type flowing somen noodle machines which have existed from before the filing of the application for registration of the Registered Design has a tray part that is shaped like the configuration of a lazy-river-type flowing somen noodle machine, and the part where people can enjoy scooping up flowing noodles is the slide part only, and [ii] the lazy-river-type flowing somen noodle machine which existed from before filing of the application for registration of the Registered Design is complete in itself as a design, and this type of machine was not equipped with a slide part, so that the only place for enjoying the scooping up of flowing noodles was the tray part. As such, the Registered Design, which is equipped with both the slide part and the tray part as the configuration for enjoying flowing noodles, is unique because of its combination of the configuration of a water-slider-type flowing somen noodle machine and the configuration of a lazy-river-type flowing somen noodle machine, which had existed from before the filing of the applications for registration of the respective designs, and it can be said that this new feature is not found in a publicly-known design. The court held that even when referring to the existence of publicly-known designs, it is reasonable to consider that customers will regard the important part of the Registered Design to be the shape that is created by combining the slide part, which is the water pathway, and the tray part, which includes the rotator.

On that premise, the court held that, given that Defendant's Design also consists of the combination of a slide part, which is a water pathway, and a tray part, which includes the rotator, Defendant's Design is similar to the Registered Design.