

Standard for determining infringement of design right in Japan

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1. Introduction

This paper was prepared for the Meeting of the American Intellectual Property Law Association(AIPLA) IP Practice in Japan Committee and Japan Trademark Association, which was held on April 12, 2005 in Tokyo.

Mr. Anthony P. Venturino of Stevens Davis Miller & Mosher reported on “Design Patent Infringement in U.S.A.” Comparing the Japanese and US systems, the essential criteria for determining infringement of design right are almost the same.

However, under the Japanese Design Law, it is not possible to describe several articles (products) such as “vehicle and toy vehicle” in an application, and the range of the protection of a design right is limited to similar or identical articles. The design right for a vehicle does not extend to a toy vehicle. In the U.S.A. it is possible to describe several articles as “vehicle and toy vehicle”(e.g. USA D497327) in an application, and such a design right extends to “vehicle and toy vehicle”.

2. Requirements of Registrations

The following requirements are reason for rejection and Invalidation Trial.

2.1 Definition of design

“Design” under the Design Law means the shape, pattern, color or any combination thereof in an article (including a portion of article) which produces an aesthetic impression (Article 2. Para. 1 of the Design Law).

2.2 Novelty

■ Publicly known

If a design is publicly known anywhere in the world prior to its application date or priority date, it is not registrable(Art. 3, Para. 1, Item 1 of Design Law).

■ **Prior publication**

If a design is described in a publication distributed anywhere in the world prior to its application date, it is not registrable(Art. 3, Para. 1, Item 2 of Design Law).

■ **Similar designs**

If a design is similar to a design which is publicly known anywhere in the world prior to its application date or is described in a publication distributed anywhere in the world prior to its application date, it is not registrable(Art. 3, Para. 1, Item 3 of Design Law).

Art. 3, Para.1 of Design Law (Novelty) corresponds with Art. 23 of the Design Law(effect of registration) .

2.3 Creativity(unobviousness)

Where a design could easily have been created, prior to filing of the design application (Priority Date), by a person with ordinary skill in the art to which the design pertains, on the basis of a shape, pattern, color or combination thereof publicly known anywhere in the world a design application shall be rejected (Art. 3, Para. 2).

2.4 Non-functionality

A design simply consisting of a shape which is indispensable for securing the function of the article shall not be registrable(Art. 5, Item 3 of the Design Law).

3. Effect of Registration

The owner of a design right shall have an exclusive right to commercially work the registered design and designs similar thereto (Art. 23 of Design Law). More specifically the owner of a design right shall be able to exclusively manufacture, use, assign, lease, display for the purpose of assignment or lease, or export articles to which a design or designs similar thereto have been applied commercially (Art. 2, Para. 1 of Design Law).

The scope of a registered design shall be decided on the basis of a statement included in the application and the design represented in the drawings attached to the application or shown in a photograph, model or sample attached to the

application (Art. 24 of Design Law).

When deciding the scope of a registered design, a description of a characteristic feature should not be considered (Article 6 of Rule for Design Law).

4. Standard for determining infringement of design right

In a design infringement case, “Similarity of designs” is a key term. There is no Supreme Court decision stating how to determine the “similarity of designs” in a design infringement case. However, there is a Supreme Court decision(March 19, 1974, Minshû Vol.28-2, P.308) stating how to determine the “similarity of designs” in a novelty case (Art. 3, Para. 1, Item 3 of Design Law). As we mentioned before, Art. 3, Para. 1 of Design Law (novelty) corresponds with Art. 23, of the Design Law (effect of registration).

■ The Supreme Court stated as follows:

“As the design is united with an article, identity or similarity of articles of both designs is necessary when applying Article 3, Para. 1(Novelty) of the Design Law. As the design right is expanded to designs which are similar to the registered design (Art. 23 of Design Law), namely, designs which give a similar aesthetic impression to ordinary customer with respect to identical or similar articles, Article 3, Para. 1, Item 3 of the Design Law should be judged on the basis of similarity of aesthetic impression from the view of an ordinary customer with respect to identical or similar articles.”

Under the foregoing Supreme Court decision, the design infringement should be judged on the basis of the following standard.

- (1) Whether articles are identical or similar ,
- (2) In view of ordinary customer(not designers),
- (3) Similarity of aesthetic impression

■ Pattern of Infringement

	Articles	Shape, pattern, color or any combination thereof
1	Identical	Identical
2	Identical	Similar
3	Similar	Identical
4	Similar	Similar

■ Pattern of Non infringement

	Articles	Shape, pattern, color or any combination thereof
1	Identical	dissimilar
2	Similar	dissimilar
3	dissimilar	identical
4	dissimilar	Similar
5	dissimilar	dissimilar

■ Similarity of Articles

Similarity of articles will be judged on the basis of their usage and functions(Osaka High Court, September 28, 1981, Mutaishû Vol.13-2, P.630). If the usage is the same and functions are different, articles are similar to each other (e.g. fountain pen and ballpoint pen). If the usage and functions are different, articles are dissimilar to each other (e.g. motor vehicles and toy motor vehicles). Thus, some Japanese motor vehicles companies file two separate design applications for “motor vehicles” and “motor vehicles toy” under the one design for one application principle.

■ Lower Courts Standard

The lower courts also take into account one of the following standards because Supreme Court standard is very simple. The following standards are not against Supreme Court standard, but are included in Supreme Court standards.

- (1) Whether ordinary customer mistakes Design A (accused design) for Registered Design B (Tokyo High Court, April 13, 1995, Hanrei Jihô 1536-10). This standard is similar to Ordinary Observer Test in the U.S.A (Gorham Mfg. Co. v. White, 81 U.S. 511, 20L.Ed. 731, 14 Wall, 511, U.S.N.Y., Dec Term 1871).
- (2) Whether the accused design has the characteristic features of the registered design and both designs give ordinary customers the same overall aesthetic impression (Tokyo High Court, June 18, 1998, Chizaishû Vol.30-2, P. 342). This standard is similar to Point of Novelty Test in the U.S.A.(Litton Systems, Inc. v. Whirlpool Corporation, 728 F.2d 1423, 221 U.S.P.Q. 97, Fed. Cir., Feb. 14, 1984, No. 83-1004).If the common parts of the registered design and accused design overcome the different parts of both designs, the same overall aesthetic impression is affirmed. When determining the characteristic features, the court considers function, prior art and which parts attract attention of ordinary consumers. Parts which are not functional, which do not exist in the prior art and attract attention of ordinary customers can be characteristic features.