

8 Foreign Situations of Design Protections

It is indisputable that the design system plays a central role in protecting designs as a result of intellectual creation activities, however due to the multiple aspects of designs, a single design product may also be cumulatively protected under laws and regulations other than the design law. In order to proceed with concrete deliberation on modalities of the design system in Japan, for the purpose of ensuring more appropriate protection for designs, it is indispensable to correctly understand how design products are protected under intellectual property systems including design systems in Japan as well as in foreign countries.

With the objective of contributing towards such an understanding, a working group of experts was established for this study to overview the basic frameworks of design systems, as well as to analyze court cases obtained from local contributors and reference materials, thereby clarifying specific principles, criteria, and methods for determining substantial issues of design protection, such as objects of protection, requirements for protection, and scope of effect, in the European Community, European countries, the United States, and China. Efforts were also made to analyze the situation of the application of various legal systems that may also function as a means for protecting designs, including copyright laws, trademark laws, and unfair competition prevention laws, in accordance with court cases, wherever possible.

Part 1 Design Protection in Europe

I Outline of Design Protection in Europe

With the objective of ensuring the free movement of goods within the European Community, the European Design Directive^{(*)1} was adopted on October 13, 1998, for the harmonization of design systems of the Member States, which have amended national laws in accordance with the Directive. Provisions which are not closely related to the free movement of goods, including criminal penalties and application procedures should be left to each Member State.

Subsequently, the European Design Regulation^{(*)2} was put into force on March 6, 2002 in order to create unitary design rights throughout the Community. This Regulation consists of parts regarding registered Community designs and unregistered Community designs.

Under the European Design Directive, “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation, and “product” includes parts, packaging, get-up, graphic symbols and typographic typefaces, but excludes computer programs.

It is requirements for protection of a design that it is new and has individual character, and in

the case of a component part incorporated into a complex product, it should be visible during normal use of the product. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from that of any design which has been made available to the public before the filing date or the priority date. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

A prior design shall be deemed to have been made available to the public if it has been published before the filing date or the priority date, except where this could not reasonably have become known to the circles specialized in the sector concerned, operating within the Community.

The scope of protection shall be determined under the same criteria for determining the requirements for protection. The term of protection shall be up to 25 years from the filing date.

The extent to which and the conditions under which cumulative protection by a design right and a copyright is conferred shall be determined by each Member State.

Under the Community trade mark system^{(*)3}, three-dimensional shapes can be registered and protected as three-dimensional trade marks. It is requirements for the registration of a three-dimensional trade mark that like ordinary

(*)1 Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

(*)2 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs.

(*)3 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

trade marks, it has a distinctive character, it does not conflict with earlier trade marks, and it is not functional. A distinctive character may be either inherent in the trade mark or acquired by the use of the trade mark. For distinctiveness of three dimensional trade marks, there is a case of a *bottle* for mineral water, in which it was judged to be inherently distinctive.^{(*)4} The scope of effect of a three-dimensional trademark shall, in principle, extend to the fact that there exists a likelihood of confusion by the public because of identity or similarity to the trademark and the identity or similarity to the goods or services covered by the trade mark. However, if the three-dimensional trademark has a reputation, its effect may, under certain conditions, also extend to goods or services not being similar or identical.

There is no unfair competition law that is applicable throughout the Community. Imitating another's design may fall under the scope of acts of unfair competition under unfair competition law, civil code, or common law of each Member State.

Designs may, under certain conditions, be protected as works under copyright law of each Member State.

II European Community

A registered Community design right is a unitary right throughout the Community that comes into existence upon registration based on an application at the Office for Harmonization in the Internal Market (hereinafter called OHIM). The term of protection shall be up to 25 years from the filing date. The definition of a design to be protected and the requirements for protection are the same as provided under the European Design Directive.

A multiple application system is employed, in which several designs belonging to the same classification may be combined in one application. The OHIM shall examine applications with respect to the formality and from the viewpoints of the object of protection and, public policy and morality. An appeal may be filed against a decision of the examiner before the OHIM Board of Appeal.

Other requirements for protection shall be examined by the OHIM Invalidity Divisions upon an application for a declaration of invalidity after registration or by Community design courts (national courts of first and second instance

designated by each Member State) in infringement proceedings. For a declaration of invalidity, it is provided for who may invoke it for the respective grounds. An appeal may be filed against a decision of Invalidity Divisions before the OHIM Board of Appeal.

An action may be brought against a decision of the OHIM Board of Appeal before the Court of First Instance and then before the Court of Justice of the European Communities.

Invalidity of a registered Community design may be claimed by the defendant by way of a plea or a counterclaim in infringement proceedings. However, such a plea shall be admissible in so far as it is claimed on account of an earlier national design right belonging to the defendant.

A design shall be deemed to lack novelty if it is identical to an earlier design or its features differ only in immaterial details (decisions of OHIM Invalidity Divisions: novelty was found in the *ceiling light* case^{(*)5}, the *pastry* case^{(*)6}).

For individual character: in the *chair* case, the Invalidation Division declared invalidity of the registered design due to no individual character, pointing out that the freedom of designer was restricted by the inevitable structure of a chair consisting of the base, the supporting frame, and the seat as required by the function of the chair, and an informed user would not ignore the state of technology (i.e. any chair of this type usually has a foot rest and a back rest) which is known in the normal course of business activities in the environment specialized in the field concerned^{(*)7}; in the *ceiling light* case, the Invalidation Division, pointing out that an informed user would not place much importance on technically conditioned elements essential and common to ceiling lights of this kind when assessing the overall impression, found an individual character in the registered design for other elements; in the *skin antiseptic composition dispenser* case, the Invalidity Division found an individual character, on the grounds that the shape of the head of the dispenser was not required due to its functionality but it produced a different overall impression from that of the cited utility model.^{(*)8}

A Community design shall not be granted for features of appearance of a product, which are solely dictated by its technical function. In the case concerning a trademark for the shape of the rotary head of Philips shaver,^{(*)9} the advocate general of the European Court of Justice

(*)4 Nestlé Waters France v. OHIM, Court of First Instance (Fourth Chamber), December 3, 2003 (Case T-305/02) [2003] ECR 00000; OJ C71, 20. 03. 2004, p. 25 : Community trademark 000922179.

(*)5 Miguel Soriano Sola v. RIDI Leuchten GmbH, June 3, 2004 (ICD 000000032).

(*)6 LENG-D'OR, S.A. v RECOT, INC., Oct. 22, 2004 (ICD 000000149).

(*)7 Eredu, S. Coop v. Armet, S.R.L, Apr. 27, 2004 (ICD000000024).

(*)8 José Mallent Castello v. 3M Innovative Properties Company, June 14, 2004 (ICD 000000057).

(*)9 Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd., ECJ, June 18, 2002, [2002] E.C.R. I-5475 (Case C-299/99).

delivered his opinion that a functional design would be protected if there was an alternative design that would bring about the same technical function.^(*10)

A Community design shall not be granted for features of appearance of a product that must be mechanically connected to another product so that either product may perform its function, e.g. a design for a fit of a plug that connects to a socket (“must-fit” exception).

A registered Community design is an absolutely exclusive right that may also cover an independent work of creation by a third party.

A “must-match” design such as for spare parts is registrable but the effect of such registered right does not extend to the use of such parts for the purpose of repair.

An unregistered Community design shall come into existence, without formality requirements, on the date when the design was first made available to the public within the Community, and shall be protected for three years from that date. The requirements for protection are the same as those for protection of a registered Community design. Similar to copyright, an unregistered Community design is the right to prohibit imitation, which cannot be exercised in respect of an independent work of creation by a third party.

Infringement proceedings shall be subject to the jurisdiction of Community design courts. Unlike a registered Community design, an unregistered Community design is not presumed to be valid, and therefore the right holder should prove its validity whereas the defendant may contest validity by way of a plea or with a counterclaim.

As infringement cases, there are decisions with respect to provisional injunction in Germany (*three-tiered air bed I and II*, *flat-type computer monitor screen*, and *shoes*)^(*11) and a settlement in the U.K. (*Barbie doll*)^(*12). In the *three-tiered air bed I* case, the validity of the design was admitted on the grounds that considering the freedom of designer, the overall impression produced by the design on an informed user differed from that produced by some prior art, whereas in the

three-tiered air bed II case, the novelty of the design was denied due to some other prior art.

III United Kingdom

In the United Kingdom, designs are protected in a unique scheme by registered designs, unregistered design rights, and copyrights.

The current Registered Design Act 1949 was partially amended in 1988, and then significantly amended in 2001 in accordance with the European Design Directive.

An application for registration of a design shall be filed at the UK Patent Office, and subject to the formality examination as well as the substantive examination regarding some requirements such as the object of protection. The registrar may examine at his/her discretion whether the design is new and has individual character.

Under the 1988 Act, the object of protection was features which in the finished article appeal to the eye, and part designs and “must-match” designs were not regarded as objects of protection. Under the 2001 Act, the *eye-appeal* requirement and the “must-match” exception were deleted and part designs and designs for spare parts became registrable.

For the object of protection: in the *garden chair* case, no infringement was found on the grounds that the grooves on the chair back could not be disregarded when comparing designs for the purpose of infringement^(*13); in the case of *design application for car wheel*, showing a view from one side only in the application was considered to be sufficient for registration^(*14); in the *icon* case, the designs were accepted if they were displayed by an operating system in a computer^(*15); in the *engine cover* case, the design for an engine cover was registered as not being a part of the engine or functional^(*16); in the *nipple* case and the *fuse* case, the registrations were invalidated because the registered designs were mere mechanical devices^(*17) ^(*18); in the *electric terminal* case, the design was judged to lack appeal to the eye and to

(*10) Opinion of Advocate-General RUIZ-JARABO COLOMER of European Court of Justice (AGO) of 23.1.2001, C-299/99, [2001] RPC. 38, 745.

(*11) Landgericht Hamburg 308 O 564/03 Urteil, 26.11.2003 - Luftbett I; Landgericht Hamburg 308 O 591/03 Urteil, 4.12.2003 - Luftbett II; Landgericht Düsseldorf 12 O 123/04 Versäumnisurteil 28.4.2004 - Shuh; Landgericht Hamburg 308 O 457/03 Beschluss 29.8.2003 - Computerfachabbildschirm: all unpublished.

(*12) Mattel Inc. v. Woolbro (Distributors) Ltd, [2004] FSR 12, [2003] EWHC 2412 (Ch D, Oct. 20, 2003).

(*13) Sommer Allibert (U.K.) Ltd. v. Flair Plastics Ltd, [1987] RPC 599 (CA, June 5, 1987).

(*14) Ford Motor Co Ltd's Design Application, [1971] FSR 314, [1972] RPC 320 (RDAT, Apr. 22, 1971).

(*15) Apple Computer Inc. v. Design Registry, [2002] FSR 38 (RDAT, Oct. 24, 2001): UK reg. designs 2094031-2094039.

(*16) UK reg. designs 3000174, 3000314: unpublished.

(<http://www.marks-clerk.com/patentandtrademarkattorneys/publications/pressreleases/pr20030630.html>).

(*17) Tecalemit Ltd. v. Ewatts, Ltd. (No. 2), [1927] 44 RPC 503 (CD, July 29, 1927): UK reg. design 703913.

(*18) Stenor, Ltd. v. Whitesaides (Clitheroe), Ltd. (now, Tewel Industries, Ltd.) [1948] 65 RPC 1 (HL, July 2, 1947).

be a technical function^(*)19); in the *motor vehicle part* case, some of the designs were denied registration as “must-match” designs and some were registered.^(*)20)

As to requirements for protection, the 1949 Act required originality, whereas the 1988 Act only required novelty, abandoning the approach like copyright. The 2001 Act requires novelty and individual character.

For novelty: in the *spoon/fork handle* case, the design of the handle applying the shape of an existing temple was judged to be novel^(*)21); in the *bicycle handlebar* case, the design was not judged to be novel on the grounds that a similar design had been applied to the handle of a knife^(*)22); in the *coffee pot* case, the design was judged to be novel, without demonstration as to whether the differences from the prior art were either immaterial or were common trade variants^(*)23).

For the scope of effect of a registered design: in the *air freshener* case, an interlocutory injunction was granted in light of the freedom of designer^(*)24); in the *garden chair* case mentioned above, similarity due to the shape dictated by the function was disregarded; in the *children’s carriage* case, the court found no infringement, having determined the difference from the accused design while taking the difference from the earlier design into consideration^(*)25); in the *dispenser* case, the court found no infringement because of the substantial difference, pointing out that if the registered design only differed from the prior art by details, an interested customer could be drawn to such the details, whereas if there was radically difference, he/she would concentrate on the general form of the design, and also by applying the “now and later” assumption that the two designs were compared side by side, and thereafter an interested customer would go away and come back later to the infringement.^(*)26) In the *coffee pot* case mentioned above, the court ruled that novelty of a registered design was to be assessed by the court as if through the eye of the

customer for or trader in the relevant goods, pointing out that the design might be valid over the prior art even though individual features were very similar, and vice versa; in the *electric terminal* case mentioned above, the court pointed out that determination should be made from the eye of electricians and those concerned with electric wiring.

Unregistered design rights were created under the 1988 Act as a system for protecting functional designs along with resolving the distorted situation that according to the interpretation of the Copyright Act 1956 purely functional designs were not protected by the Registered Design Act but protected for a long period by the Copyright Act. A design right automatically comes into existence when the design is first recorded in a document or an article is first made to the design. The term of protection shall be, in principle, up to 15 years.

For the object of protection; in the case of the *umbrella case*, infringement was found based on protection for part design^(*)27); in the *tracktop* case, a design right was denied on the grounds that the color scheme was surface decoration and not the object of protection^(*)28); in the *conservatory* case and *kitchen range* case, the respective design were regarded as neither “must-fit” design nor “must-match” design so that respective infringements were found.^(*)29) ^(*)30)

As to requirements for protection, a design right shall subsist in an original design, and a design is not original if it is commonplace at the time of its creation. In the *sash window* case, infringement was not found on the grounds that the design was judged to have been commonplace.^(*)31) In the *conservatory* case mentioned above, the court pointed out that “commonplace” was not to be equated with “well-known”. In the *fertilizer separator* case, a commonplace test was suggested.^(*)32)

Unlike registered designs, the design right is not an absolutely exclusive right, and

(*)19) Amp Inc. v. Utilux Proprietary Ltd., [1971] FSR 572, [1972] RPC 5, 103 (HL, Oct. 27, 1971).

(*)20) Ford Motor Co Ltd.’s Design Applications, [1994] RPC 545 (QBD, Mar 02, 1994); UK reg. design applications 2002303-306, 2004658-659, 2006899-6902, 2006904, 2015376, 2019416, 2019417.

(*)21) Saunders v. Wiel, [1983] RPC 29 (CA, Dec. 16, 1892).

(*)22) Dover Ld. v. Nürnberger Celluloidwaren Fabrik Gebrüder Wolff, [1910] RPC 498 (CA, May 4, 1910).

(*)23) Household Articles Ltd’s Registered Design, [1998] FSR 676 (Ch. D. (Patents Ct, Jan. 22, 1998): UK reg. design 2044802.

(*)24) Reckitt Benckiser (UK) Ltd. v. H & I (Toiletries) Ltd., Patent County Court, Sept. 16, 2002, unpublished: UK reg. design 2080312.

(*)25) Simmons v. Mathieson & Co. Ld. [1911] RPC 113 (Ch. D. Dec. 2, 1910).

(*)26) Gaskell & Chambers Ltd. v. Measure Master Ltd, [1993] RPC 76 (Ch D (Patents Ct), Oct. 22, 1992): UK reg. design 1022410.

(*)27) A Fulton Co Ltd. v. Totes Isotoner (UK) Ltd., [2004] RPC 16, [2003] EWCA Civ 1514 (CA, Nov. 4, 2003).

(*)28) Lambretta Clothing Co. Ltd v. Teddy Smith (UK) Ltd, [2004] EWCA Civ. 886 (CA, July 15, 2004).

(*)29) Ultraframe (UK) Ltd. v. Eurocell Building Plastics Ltd., Eurocell Profiles Ltd., [2004] EWHC 1785 (Ch D, July 22, 2004).

(*)30) Mark Wilkinson Furniture Ltd. v. Woodcraft Designs (Radcliffe) Ltd., [1998] FSR 63 (Ch D, July 30, 1997).

(*)31) Scholes Windows Ltd. v. Magnet Ltd (No.1), [2002] FSR 10, [2001] EWCA Civ 532 (CA, Apr. 11, 2001).

(*)32) Farmers Build Ltd. (In Liquidation) v. Carrier Bulk Materials Handling Ltd., [1999] RPC 461 (Civ Div, Dec. 3, 1998).

infringement is not found unless the design is imitated, like copyright. In the *garment* case, imitation was not found.^(*33)

Eligibility of designs for copyright protection depends on whether they are works of artistic craftsmanship or graphic works (in particular, engravings and sculptures) irrespective of artistic quality. The term of protection shall be, in principle, 70 years from the death of the author, whereas 25 years from the first marketed for copies made by an industrial process.

The first instance in the *garment* case mentioned above found no copyright infringement because of lack of artistic quality.^(*34) In the *cartridge mould* case, the design was not regarded as a work of sculpture.^(*35) In the *rubber floor mat for cars* case, the design was recognized as a work of engraving.^(*36)

Designs may be protected as trademarks if they satisfy requirements including distinctiveness. In the *ice cream dessert product* case, the court determined a distinctive character of the three-dimensional trademark.^(*37)

Designs may also be protected from unfair competition due to passing-off under common law. In the *lemon juice container* case, protection was afforded.^(*38) In the *cushion* case, the likelihood of actual deception was denied from the way of sales and delivery.^(*39)

IV France

In France, the Design Law of 1909 was amended in 1990 and then integrated into the Intellectual Property Code of 1992. Subsequently, it went through amendment in 1994 to mainly tighten criminal penalties, and was amended on July 25, 2001, in accordance with the European Design Directive.

An application for registration of a design

shall be filed at the National Institute of Industrial Property. One application may contain up to 100 reproductions of designs. The design shall be registered after the examination as to the formality and violation of morality or public policy. For industries that frequently change the form and presentation of their goods, the simplified application procedure (*dépôt simplifié*) is provided, in which an application may be filed with plain drawings of the design, without being restricted by ordinary formality requirements, and the publication would be postponed for three years.

The fulfillment of the requirements for protection shall be determined by the court. Invalidity of designs may be claimed in invalidity proceedings or by way of a plea or with a counterclaim in infringement proceedings.

It may be hesitated to regard the effect of a design right as an absolute right like a design right under the Japanese law. There was a case, in which it was found that an alleged infringer had no civil and criminal liabilities, even after the publication of the registered design, if he successfully proved his bona fides, whereas the manufacturer or seller of the allegedly infringing product had civil liability.

In France, designs and works have been protected cumulatively under the theory of unity of art (see the *draining basket for lettuce* case^(*40)).

For the object of protection: in the *hair clip* case, protection was afforded because of the visibility of the design at the time of sales^(*41); in the *socket for car lamp* case, invalidity of the design was declared on the grounds that the socket could not be seen by the public once integrated in a car^(*42); protection was not afforded because of functionality in the *hanger* case^(*43), *athletic shoes* case (the stitching was regarded as functional constraint)^(*44), *ballot box* case^(*45), and *roof tile* case^(*46); in the *candle* case, protection

(*33) Guild v. Eskandar Ltd. (formerly Ambleville Ltd.), [2003] FSR 3, [2002] EWCA Civ 316 (CA (Civ Div), Mar. 14, 2002).

(*34) Guild v. Eskandar Ltd. (formerly Ambleville Ltd), [2001] FSR 38 (Ch D, Feb. 2, 2001).

(*35) Metix (UK) Ltd. v. GH Maughan (Plastics) Ltd., [1997] FSR 718 (Ch D (Patents Ct), Mar. 10, 1997).

(*36) Hi-Tech Autoparts Ltd. v. Towergate Two Ltd. (No.1), [2002] FSR 15 (PCC, July 25, 2001); Hi-Tech Autoparts Ltd. v. Towergate Two Ltd. (No.2), [2002] FSR 16 (PCC, July 26, 2001).

(*37) Société des Produits Nestlé SA v. Unilever plc., [2003] ETMR 53, [2003] RPC 35, [2002] EWHC 2709 (Ch D, December 18, 2002): UK trademark applications 2,000,661及 2,000,662.

(*38) Reckitt & Colman Products Ltd. v. Borden Inc. and Others (No.3), [1990] RPC 341 (HL, Feb. 8, 1990).

(*39) Hodgkinson & Corby Ltd. v. Wards Mobility Services Ltd. (No.1), [1995] FSR 169 (Ch D, July 20, 1994).

(*40) Gautreau et La Matière plastique c. Legros et Interindustrie, Cour de Cassation, 2 mai 1961, *JCP ed.G*, 1961, 12242.

(*41) Robert Revais c. C.S.P. Diffusion et Team Plus et Galeries Lafayette, Cour d'appel de Paris, 22 jan. 1999, *PIBD* 1999, 681-III-334.

(*42) Socop et Socop Industries c. Jos et Man et Mastel Injection, Cour d'appel de Lyon, 12 sep. 1996, *PIBD* 1996, 621-III-600.

(*43) Plastiques Progrès c. Établissements Roybier et Fils, Cour d'appel de Paris, 31 mai 2000, *PIBD* 2000, 705-III-448 : Design No. 881471, 897049, 936759.

(*44) Mephisto et M. Martin Michaeli c. Sanders Distribution Sandis et Calzaturificio Grisport, Cour de Cassation, 26 mars 2002, *PIBD* 2002, 749-III-419 : Design No. 811319.

(*45) Doublet Festitub c. Devianne Duquesnoy, Cour d'appel de Douai, 5 avr. 1990, *PIBD* 1990, 480-III-406.

(*46) Tuilerie de Beauvais c. Établissements Céramiques de Beauvais à Auneuil (ECBA) (Établissements Céramiques de Landrons (ECLA)), Cour de Cassation, 22 jan. 1973, *Ann.propr.ind.* 1973 p.361, *Legifrance*.

was afforded because of non- functionality^(*47); in the *medieval-style pleats* case, the design was recognized as being independent from processing technology.^(*48)

Novelty is a requirement for protection specific to the Design Law. Novelty is regarded to be satisfied by a novel combination of well-known elements. In the *platform sandals* case, the novelty was admitted due to characteristic differences, though the design was partially publicly known.^(*49) On the other hand, in the *Asian-style garment* case, protection was not afforded due to changes only in immaterial details such as the length of a stitch.^(*50) In the *lighter* case, the novelty was denied even if the flint part had been extended.^(*51)

Under the amended law of 2001, individual character is added as a requirement for protection of designs. Whether or not a design has individual character is assessed by the overall visual impression it produces on the informed observer. This requirement has not been seen in case laws since a long time ago, but was introduced in accordance with the European Design Directive. Therefore, theories face some difficulty in dealing with it. This requirement was determined in cases of *Z-shaped table*^(*52), *road sign*^(*53), *Asian-style garment* mentioned above, *Eiffel Tower-shaped chessman*^(*54) and *glass with a handle and a support*^(*55).

Under the principle of cumulation, creativity required for copyright protection is also put in question for protection under the Design Law alone, but not considered as a higher level than novelty. In precedents, creativity was equated

with novelty (e.g. the *lighter* case and the *Asian-style garment* case). In the *fireplace* case, novelty was found but creativity was further required.^(*56)

The criteria for the scope of effect of a design right under the amended law is not seen in the old law and considered as expressed provisions based on the criteria established in case laws. In the *carafe* case, infringement was found on the grounds that even consumers paying average attention could not deny similarity in the impression, despite partial differences, and they could not distinguish the designs unless they compared them closely.^(*57) In the *road sign* case, infringement was found on the grounds that the registered design had individual character because, in light of the freedom of designer, the sign was totally different from signs that the informed observer would usually experience, and the difference from the defendant's sign had no impact on the impression of the identity. In the *Z-shaped table* case, based on the recognition that the informed observer referred to a user with not average attention but particular vigilance, no infringement was found on the grounds that the overall impression of the defendant's furniture would not lead purchasers to believe that it is the plaintiff's furniture. In the *illustration on socks* case, the court determined the difference in the overall impression after demonstrating the difference in elements.^(*58) On the other hand, the following elements were judged to have no impact on the overall impression: the characters written on the ritual tools (*tools for Jewish rites*)^(*59); the length of skirt (*pleated skirt*)^(*60); the thickness of

(*47) Point à la ligne c. Roussel et Epistrof et Mme Dazzan, Cour de Cassation, 18 déc. 1990, Legifrance.

(*48) Maître Nadine Breiron (Plissage Industriel) c. Toupuy et Vetus de blanc, Cour d'appel de Paris, 2 juil. 1999, PIBD 1999, 988-III-550.

(*49) Bee Fly c. Mumiah, GIC Groupement Industriel et Commercial, Crete et Chauss'Europ, Cour d'appel de Paris, 2 avr. 2003, PIBD 2003, 771-III-454 : Design No. 98 0689.

(*50) Madame Barbel Cintius c. Madame Le Thi Dong Thai et Monsieur Dam Queng Minh, TGI Paris, 27 juin 2003, PIBD 2004, 777-III-16 : Design No. 01 1189.

(*51) DuPont c. Établissements Myon, MM. Jeannerot et Desloriaux (administrateurs judiciaires de la Myon), Marie-Claire Guyon (représentant des créanciers), Cheiffel et Franceso Smalto, Cour de Cassation, 13 fév. 1996, PIBD 1996, 612-III-320 : Design No. 122 630, 122 631.

(*52) Zygote et Madame Aude Fabry c. Habitat France, TGI Paris, 15 fév. 2002, PIBD 2002, 748-III-377: Design No. 97 2223.

(*53) Monsieur Jacques Gedeau et Soudure Outillage Protection SOP c. La Voie Express et Sade Compagnie Generale de Travaux D'hydraulique, TGI Paris, 20 mars 2002, PIBD 2002, 752-III-523: Design No. 90 5538.

(*54) Sap Polyne c. Monsieur Matthew Grant, Cour d'appel de Paris, 25 fév. 2004, PIBD 2004, 788-III-369: Design No. 90 0023.

(*55) Durobor (Belgique) c. Verrerie Cristallerie d'Arques J.G. Durand et Cie VCA (nouvellement dénommée Arc International), Cour d'appel de Paris, 28 nov. 2001, PIBD 2002, 741-III-217 : International Design Deposit No. DM/009479.

(*56) Fonte Flamme c. M. Michel Labattu et Turbo Fonte, Cour de Cassation, 3 mai 2000, PIBD 2000, 704-III-418: Design No. 0908253.

(*57) Trilles c. JeanJean, Cour d'appel de Paris, 3 mars 1999, PIBD 1999, 687-III-526 : Design No. 0923318.

(*58) Jules c. Mademoiselle Florence Dostal et Viastael et Breilly, Cour d'appel de Paris, 7 mars 2003, PIBD 2003, 772-III-485 : Design No. 97 1356.

(*59) Produits de Santé Sélectionnés (S.P.S.S) c. Oscar et Lola, Cour d'appel de Paris, 29 mai 2002, PIBD 2003, 758-III-113: Design No. 97 1480.

(*60) Madame Jeannine Pacherie c. Grandes Surfaces Internationales, Cour d'appel de Paris, 22 jan. 2003, PIBD 2003, 767-III-358.

the sole (*platform sandals*); the fabric (*Asian-style garment*); the seat and the size of the body (*chair*)^(*61); the shape of the grip (*hair clip*); the logo (*handbag*)^(*62).

For act of infringement, in the *model car* case, the design right for an automobile was judged to be excisable on the design for a miniature car kit.^(*63)

Novelty for a design right is determined objectively whereas creativity for a copyright is determined subjectively. However, in most cases, the criteria for both are overlapped, and the criteria for infringement are also close to each other. Copyright differs from design right in the following points: protection without formality; the moral rights of author; the author is the original right holder; the term of protection is 70 years from the death of the author or from the publication of collective works.

Designs may also be protected under trademark law if they have distinctive character. In the *Epi* case, protection was afforded to the patterns embossed on the leather surface^(*64), and in the *dishwashing detergent* case, protection was afforded to the color of detergent in combination with the clear bottle and the label as a trademark^(*65). On the other hand, in the *drop-shaped bottle* case, infringement was not found on the grounds that the object protected by the trademark was not the general shape of the bottle but the shape of the bottle cap.^(*66)

In the event of misappropriation of designs, protection may be afforded against unfair competition under Article 1382 (tort) of the Civil Code even if protection by design rights or copyrights is denied. Dead copy, sales at extremely low prices, and imitating whole product lines are regarded as acts of unfair competition.

V Germany

The German Design Law was first established as the Law Concerning Copyright on

Patterns and Models of January 11, 1876.^(*67) It was, through an amendment in 1986, amended in 2003 for adapting to the European Design Directive. The latest amended law was put into force on June 1, 2004.

A design application shall be filed for registration at the German Patent and Trademark Office. Under the old law, the design shall be registered after examination as to the formality and violation of public policy or morality. Under the new law, the conformity with the definition of a design shall also be examined. Substantive matters as to the eligibility for protection, novelty, and individual character shall be determined by the court.

A product that is new and has individual character (originality under the old law) shall be protected as a design. Typefaces that were previously protected under the special law shall be protected under the new Design Law.

For the object of protection: in the *multi-colored stripes stain case*, the pattern of the registered design was reproduced on a painted paper, and the court ruled that the description that the material was satin could not be relied on^(*68); in the *note blocks* case, ideas were not protectable^(*69); in the *furniture series* case, it was ruled that although only uniform marketable product could be the subject matter of design protection, protection was afforded to the designs for the series as a whole^(*70); in the *fender* case, such parts that would produce the overall impression jointly with the car body were regarded as objects of protection^(*71); in the *Play Family* case, it was ruled that neither motif nor basic materials were protectable^(*72); in the *lighter head* case, protection was afforded to the partial feature of the design on the grounds that the shape that was not dictated exclusively by the technical function and served the technical purpose should be eligible for protection if it maintained its aesthetic feeling.^(*73)

For novelty, opinions were divided between

(*61) AD Concept c. SIF, Cour d'appel de Paris, 15 jan. 1999, PIBD 1999, 674-III-177.

(*62) Stolar c. CCM et Griffes Universelle et MOD International Trading Co-mit Co (JOCKAI) et Etoile de Paris, Cour d'appel de Paris, 15 mars 2000, PIBD 2000, 707-III-528.

(*63) Volkswagen et Bugatti International c. Provence Moulage, TGI Paris, 29 oct. 2002, PIBD 2003, 764-III-276 : International Design Deposit No. DM/051246.

(*64) Stocks Sacs c. Louis Vitton et Louis Vitton Malletier, Cour d'appel de Paris, 7 fév. 1996, PIBD 1996, 613-III-344 : Trademark No. 1 399 708, 1 399 710 to 1 399 713, and 1 451 789.

(*65) Lever c. Colgate Palmolive Company et Colgate Palmolive, Cour de Cassation, 22 fév. 2000, PIBD 2001, 698-III-256: Trademark No. 1 692 480, 1 467 391.

(*66) Château de Cognac c. Union des exportateurs associés Unexpa et M. Denis Charpentier, Cour de Cassation, 15 juin 1999, PIBD 1999, 682-III-349: Trademark No. 1 488 991.

(*67) Gesetz betreffend das Urheberrecht an Mustern und Modellen.

(*68) BGH 14.07.1961 I ZR 44/59 "Buntstreifensatin" GRUR 1962, 144.

(*69) BGH 21.05.1979 I ZR 117/77 "Notizklötze" GRUR 1979, 705.

(*70) BGH 20.09.1974 I ZR 35/73 "Möbelprogramm" GRUR 1975, 383.

(*71) BGH 16.10.1986 I ZR 6/85 "Kotflügel" GRUR 1987, 518.

(*72) BGH 19.12.1979 I ZR 130/77 "Play-family" GRUR 1980, 235.

(*73) BGH 21.05.1965 Ib ZR 121/63 "Zündaufsatz" GRUR 1966, 97.

arguing for absolute novelty and for subjective novelty (a design is deemed as novel if it is unknown to the author at the time of creation), and theories supporting the latter has been dominant. In the *frilled hood* case, the Supreme Court ruled a uniform basis as objective and relative novelty, pointing out that the United States belonged to the cultural circle that the domestic professional circle in the field concerned in Germany should pay attention to.^(*74)

For originality, in the *alarm clock (Chérie)* case, the court ruled that when determining the originality of a design, not comparing the design with the earlier design in respective parts of features, but it would sufficient that there was the difference in the overall impression produced by the respective features.^(*75) It is said that as requirement for originality, a design must have an aesthetic effect as a result of creative activity beyond the routine proficiency that designers in the industry concerned normally achieved or the mere professional routine. In the *triple-combination switch* case, the court denied the originality, ruling that the level of originality should not be too lowered even if the freedom of designer was narrow.^(*76) In the *lighter head* case mentioned above, originality was admitted on the grounds that there were numerous possibilities. In the *chained candle* case, originality was denied on the grounds that it had been known to the relevant professional circle that two or more pieces of candle were tied with a single candlewick at the manufacturing.^(*77) It is said that originality should be determined from the viewpoint of the routine of average designers in the relevant field.

For the effect of a design right, under the old law, a design right was, similarly to a copyright, a relative right to prohibit reproduction. The allegedly infringing design was presumed to be an imitation if it was substantially identical to the registered design, and the alleged infringer should prove that he had had no knowledge of the registered design or that it was his independent work. In the *lighter head* case mentioned above, the design was judged to be an imitation due to the complete agreement of the shape. In the

Chérie case mentioned above, the agreement in the size was a factor of judgment on imitation. In the *furniture series* case mentioned above, the imitation was judged based on the almost same overall impression regardless of separate differences. Under the new law, it has been amended for a design right to be an absolute right.

The scope of protection was assessed based on the determination of novelty and originality and in accordance with the degree of advancement of the design. In the *household cutting machine* case, the court pointed out that solely determinative of the creative nature was to what extent the design distinguished itself from designs known in the market concerned, and ruled that the greater the creative accomplishment of the design, the greater the scope of protection^(*78). In the *Play Family* case mentioned above, infringement was denied, ruling that people who were familiar with craftwork should totally observe the separate features of the both designs side by side. In the *dry shaver* case, the court ruled that protection was afforded only to the features displayed in the disclosed representation of the design.^(*79)

Designs shall be cumulatively protected by design rights and copyrights if they have originality, novelty, and aesthetic value. The aesthetic level required for designs is lower than that required for works. In the *Europapost* case, the court ruled the requirement for protection of typefaces under the Design Law and the Copyright Law^(*80). In the cases concerning *steel pipe chair*,^(*81) *vase-shaped candleholder*^(*82), and *armchair*,^(*83) the artistic creativity of the respective designs were affirmed.

Designs may also be protected as trademarks if they are distinctive from products of the others. In this respect, in the *liqueur bottle* case, originality was not required.^(*84)

Article 1 of the old Unfair Competition Law regulated the act of causing confusion in business or to product and the act of imitating the configuration of product of others. In the *new mode* case, protection was afforded only for one season.^(*85) In the *interconnecting blocks* case,

(*74) BGH 08.05.1968 I ZR 67/65 "Rüschenhaube" GRUR 1969, 90.

(*75) BGH 18.12.1959 I ZR 27/58 "Chérie" GRUR 1960, 256.

(*76) BGH 20.05.1974 I ZR 136/72 "Dreifachkombinationsschalter" GRUR 1975, 81.

(*77) BGH 21.01.1977 I ZR 68/75 "Kettenkerze" GRUR 1977, 547.

(*78) BGH 03.06.1977 I ZR 83/76 "Haushaltsschneidemaschine" GRUR 1978, 168.

(*79) BGH 21.01.1977 I ZR 49/75 "Trockenrasierer" GRUR 1977, 602.

(*80) BGH 27.11.1956 I ZR 57/55 "Europapost" GRUR 1957, 291.

(*81) BGH 27.02.1961 I ZR 127/59 "Stahlrohrstuhl" GRUR 1961, 635.

(*82) BGH 21.05.1969 I ZR 42/67 "Vasenleuchter" GRUR 1972, 38.

(*83) BGH 10.10.1973 I ZR 93/72 "Sessel" GRUR 1974, 740.

(*84) BGH Beschluß vom 13.4.2000 I ZB 6/98 "Likörflasche" GRUR 2001, 56.

(*85) BGH 19.01.1973 I ZR 39/71 "Modeneuheit" GRUR 1973, 478.

protection was afforded on the grounds that the design had created specific demand.^(*)86)

VI Other European Countries

[Sweden] In the *automobile* case, the novelty of the design was denied based on the applicant's own published registered trademark.^(*)87) In the *plate holder for cars* case, the court found no design infringement, ruling that the informed user referred to traders who would purchase and install plate holders to cars, rather than car manufacturers or end users, and that the required level of individual character should be set fairly low in light of the freedom of designer.^(*)88)

[Greece] In the *cardboard product* case, no design infringement was found due to lack of novelty.^(*)89)

[Italy] Copyright protection was denied in the *chair* case^(*)90), whereas protection was afforded in the *lamp* case.^(*)91)

Part 2 Design Protection in the United States

In the United States, in addition to the United States Patent and Trademark Office (USPTO) engaging with forming rights, U.S. district courts, U.S. Court of Appeals for the Federal Circuit, and the U.S. Supreme Court are involved in examination on validity of rights and patent infringement proceedings.

Design protection is said to go back to the Patent Act of 1842. Designs shall be protected by design patents under the Patent Act (35 USC). The term of protection shall be 14 years.

The object of protection is an ornamental design for an article of manufacture, including a surface indicia applied to or embodied in the article of manufacture, a design for the shape or configuration of the article of manufacture, or combination thereof. In the *Gorham* case, the object of design protection was defined^(*)92). In the *Avia* case^(*)93) and *L. A. Gear* case,^(*)94) the court

afforded protection, pointing out the ornamental aspect and the functional aspect of the design for athletic shoes, and a similar ruling was made in respect of the simulated stone pathway in the *Hupp* case.^(*)95)

As requirements for protection, a design must be new and original, and also be non-obvious as required for patentable inventions in general. With respect to the factors for evaluation of the latter, the *Graham* factual inquiries were outlined in the *Graham* case^(*)96). The inquiries consist of the following four factors: (A) Determining the scope and contents of the prior art; (B) Ascertaining the differences from the prior art; (C) Resolving the level of ordinary skill in the art; and (D) Evaluating objective evidence of non-obviousness. In the *Litton* case, the court afforded protection by applying the inquiries added with the factor of commercial success to the design for a microwave oven.^(*)97) In the *Avia* case mentioned above, the court ruled with respect to expert opinions. In the *L. A. Gear* case mentioned above, the necessity of some teaching or suggestion of obviousness was pointed out. In the *Hupp* case mentioned above, the court ruled with respect the anticipation.

For the scope of protection: in the *Gorham* case, the court found infringement, ruling that the scope of protection should be determined in the eye of an ordinary observer rather than an expert; in the *Litton* case and *Avia* case, the court found infringement in case of attributing similarity to the novelty, by applying a "point of novelty" approach; in the *Braun* case, the court denied the necessity of empirical data on the grounds that the jury was an ordinary observer^(*)98); in the *OddzOn* case, the court held that there could be no infringement based on the similarity of features if the appearance are dissimilar^(*)99); in accordance with the *Markman* case and the *Elmer* case suggesting to apply the former to design cases, the judge construed the claims of design patent in the *Goodyear Tire* case.^(*)100)

(*)86) BGH 6.11.1963 Ib ZR 37/62 "Klemmbausteine" GRUR 1964, 621.

(*)87) DaimlerChrysler v. PRV, Patentbesvarsratten, April 15, 2002 (01-124).

(*)88) The Golden Frame v. Formac, Våxjö Tingsträtt, T1087-02, June 12, 2003, unpublished.

(*)89) Ziakas Ioannis v. X, 6489/1999 M II P A Θ (273451).

(*)90) Cassina Spa. c. A Studio Srl. e Galliani Host Srl., Tribunale di Monza, 23 aprile 2002, Il diritto de Autore, 2002, p.433; [2002] EIPR N-167.

(*)91) Tekno c. Tecnolumen e Strobel Peter, Tribunale di Firenze, 4.8.2003, Guida Al Diritto, 13.3.2004, No.10, p.71.

(*)92) *Gorham v. White*, 81 U.S. 511 (U.S.N.Y., Dec Term 1871).

(*)93) *Avia Group v. L.A. Gear*, 853 F.2d 1557, 7 U.S.P.Q.2d 1548 (Fed. Cir., Jul 29, 1988): D284,420, D287,301.

(*)94) *L.A. Gear v. Thom McAn Shoe*, 988 F.2d 1117, 25 U.S.P.Q.2d 1913 (Fed.Cir., Feb 16, 1993): D299,081.

(*)95) *Jack T. Hupp v. Siroflex*, 122 F.3d 1456, 43 U.S.P.Q.2d 1887 (Fed. Cir., Sep 4, 1997): D342,528.

(*)96) *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (U.S., Feb 21, 1966).

(*)97) *Litton Systems v. Whirlpool*, 728 F.2d 1423, 221 U.S.P.Q. 97 (Fed. Cir., Feb 14, 1984): D226,990.

(*)98) *Braun v. Dynamics Corporation of America*, 975 F.2d 815, 24 U.S.P.Q.2d 1121 (Fed. Cir., Sep 8, 1992): D271,176.

(*)99) *OddzOn Products v. Just Toys*, 122 F.3d 1396, 43 U.S.P.Q.2d 1641 (Fed. Cir., Aug 8, 1997): D346,001.

(*)100) *Goodyear Tire & Rubber v. Hercules Tire & Rubber*, 162 F.3d 1113 (Fed. Cir., Nov 10, 1998): D349,080.

A work shall be protected under the United States Copyright Act when it is fixed on a tangible article. To be protected, a work must be original. A design of a useful article shall not be protected unless it is capable of existing independently of, and can be identified separately from, the utilitarian aspects of the article. The Vessel Hull Design Protection Act is a related act to copyright law.^(*101)

For the object of copyright protection: in the *Carol Barnhart* case, copyright protection was denied on the grounds that the artistic features were inseparable from the forms as utilitarian articles^(*102); in the *Brandir* case, copyright protection of the bicycle rack was denied on the grounds that it had been derived in part from a work of art but its features were altered to a utilitarian purpose^(*103); in the *Knitwaves* case, copyrightability of the patterns on sweaters was confirmed.^(*104)

In order to establish copyright infringement, the alleging party must prove that reproduction has taken place. In the *Knitwaves* case mentioned above, the court, having examined the total concept and feel, found agreement with the original contribution and therefore found infringement.

Under the Lanham Act as the United States Trademark Act, the act of causing confusion as to the origin by any false designation of origin shall be prohibited, whereby trade dress is protected. In order to be protected, a product configuration must be non-functional, have inherent distinctiveness or have acquired secondary meaning. In the *Duraco* case, the court ruled that in order to be distinctive, a product configuration must be unusual, memorable, conceptually separable from the product, and to serve as designator of origin of the product.^(*105) In the *Knitwaves* case mentioned above, protection was denied on the grounds that the designs were primarily aesthetic, and were not likely to designate the origin. For the secondary meaning, in the *Two Pesos* case, it was ruled that the exterior and interior appearance of the restaurant should be protected without showing secondary meaning, if it had inherent distinctiveness^(*106); in the *L. A. Gear* case mentioned above, it was found that secondary meaning had been established through mass media promotion; in the *Duraco*

case mentioned above, the court ruled factors relevant to finding of secondary meaning; in the *Wal-Mart* case, the court ruled that a product's design was distinctive only upon a showing of secondary meaning^(*107); in the *Litton* case and *L. A. Gear* case, the court denied the likelihood of confusion, while indicating the elements to prove a violation of the law.

With respect to unfair competition, in the *Sears* case and *Compco* case, the court ruled that it was an encroachment on the patent system to prohibit imitation as unfair competition under state law when unpatentable.^{(*108) (*109)}

Part 3 Design Protection in China

In China, designs shall be protected under the Patent Law. The Patent Law was put into force on April 1, 1985, and the amendment to the law toward the WTO accession was put into force on July 1, 2001. A design application shall be registered and published after going through the preliminary examination (formality, principle of one application for one design, and public order), without substantive examination.

The objects of protection are limited to products that are manufactured by industrial methods, and craftworks that cannot be reproduced are not regarded as products. Part designs shall not be protected.

As to the requirements for protection, a design must not be identical with and similar to any design which has been publicly disclosed in publications within the country or abroad or publicly used within the country, before the date of filing, and must not be in conflict with a prior right of any other person. The first-to-file principle is explicitly provided.

A request for invalidation of a registered design may be filed to the Patent Reexamination Board, and an appeal against the decision of the Board may be filed to the people's court.

A design right shall take effect on the date of publication and shall last for ten years from the date of filing. Right of prior use shall be granted.

For similarity assessment of design, a design shall be deemed to be identical or similar to another design, if the use of the products is identical or similar and the features (shape, pattern, color) of the designs are identical or

(*101) The Vessel Hull Design Protection Act, 17 USC Chapter 13.

(*102) *Carol Barnhart v. Economy Cover*, 773 F.2d 411, 228 U.S.P.Q. 385 (2nd Cir., Sep. 12, 1985).

(*103) *Brandir International v. Cascade Pacific Lumber*, 834 F.2d 1142 (2nd Cir., Dec. 2, 1987).

(*104) *Knitwaves v. Lollytogs*, 71 F.3d 996, 36 U.S.P.Q.2d 1737 (2nd Cir., Nov. 13, 1995).

(*105) *Duraco Products v. Joy Plastic Enterprises*, 40 F.3d 1431, 32 U.S.P.Q.2d 1724 (3rd Cir., Nov. 15, 1994).

(*106) *Two Pesos v. Taco Cabana*, 505 U.S. 763, 23 U.S.P.Q.2d 1081 (U.S., Jun. 26, 1992).

(*107) *Wal-Mart Stores v. Samara Brothers*, 529 U.S. 205, 54 U.S.P.Q.2d 1065 (U.S., Mar. 22, 2000).

(*108) *Sears, Roebuck v. Stiffel*, 376 U.S. 225, 140 U.S.P.Q. 524 (U.S., Mar. 9, 1964).

(*109) *Compco v. Day-Brite Lighting*, 376 U.S. 234, 140 U.S.P.Q. 528, 140 U.S.P.Q. 531 (U.S., Mar. 9, 1964).

similar.

In invalidation decisions, similarity shall be determined by assessment of one on one comparison with a prior design or assessment of the substantial part or the whole part of the design, based on the design trends for the article concerned obtained from ex officio prior art search. On the other hand, in infringement decisions, any new part of the registered design that is not found in the submitted references shall be regarded as a substantial part, and whether or not the registered design would be confused with the allegedly infringing design shall be determined by examining the whole part based on the overall observation.

The Examination Guidelines provides for who should determine similarity of designs in invalidity decisions. With respect to the appeal proceedings against the invalidation decision, in the *minibike* case, the Intermediate People's Court, in accordance with the old Examination Guidelines, defined general consumers who were to determine similarity as hypothetical people who would only take the shape of the motorcycle into consideration.^(*110) The High People's Court of Beijing City changed this definition to consumers who had a common knowledge and education on motorcycles, and the capability to recognize them, and revoked the declaration of invalidation.^(*111) In the *motorcycle* case, the Intermediate People's Court of Beijing City adopted this view and revoked the declaration of invalidation.^(*112) Following the trend of these cases, the definition of general consumers was changed under the Examination Guidelines that were put into force in July 2004.

In the "Opinion on Several Issues Concerning the Grant of Patent (Tentative)" published by the High People's Court of Beijing City,^(*113) it is suggested that in infringement decisions, similarity shall be determined on the basis of the aesthetic sense of ordinary consumers rather than experts, and ordinary consumers are defined as purchasers of the products similar to the design patent. This opinion is only applicable in Beijing City, but

important criteria.

As infringement cases: in the *package* case, infringement was found on the grounds that the accused product was misleading general consumers as the shape was identical, the pattern was similar, and the color is close to the patented design^(*114); in the *electric fan* case, infringement was found on the grounds that the differences were not found in visual factors for ordinary consumers, such as the overall external structure, the configuration of the grilles, the layout of the major parts^(*115); in the *door frame member* case, infringement was found on the grounds that while there were some differences, it would be difficult for ordinary consumers to find the differences in sale or use, and therefore confusion would be caused when both were observed together.^(*116) These judgments were handed down five or six years ago. There is such an opinion that ordinary consumers are different from general consumers in the definition and meaning but they are practically difficult to distinguish, and therefore similarity should be determined by creators in the specific field in the invalidation procedure or by ordinary consumers in the infringement proceedings.

It is provided that the scope of protection for the patent right for design shall be determined by the product incorporating the patented design as shown in the drawings or photographs. In accordance with this provision, infringement was found based on the overall observation and the whole part assessment in the *electric hot water pot* case^(*117) and the *door frame member* case mentioned above.

The patent right for design shall be declared invalid if there is any prior design that is identical or similar to the patented design according to the international design classification. On the other hand, in infringement decisions, commercial practices and situations of sales and purchases are also taken into consideration in addition to the classification.

In the *video player* case, the Reexamination Board decided that the design in question belonged to a similar product despite the

(*110) 本田技研工业株式会社 诉 专利复审委员会 (浙江黄岩华日(集团)有限公司、上海飞羚摩托车制造有限公司)、北京市第一中级人民法院2002年9月20日行政判决 (2002)一中行初字第138号: Design patent 93303569.1.

(*111) 本田技研 诉 专利复审委员会、北京市高级人民法院2003年5月30日行政判决 (2003)高行终字第15号.

(*112) 光阳工业股份有限公司 诉 专利复审委员会 (上海嘉陵车业有限公司)、北京市第一中级人民法院2003年12月3日行政判决 (2003)一中行字第314号: Design patent 99314583.3.

(*113) 北京市高级人民法院关于《专利侵权判定若干问题的意见(试行)》的通知 (京高法发[2001]229号).

(*114) 广西黑类食品集团公司 诉 枣庄市劳技经济发展公司食品厂、山东省济南市中级人民法院1999年2月5日民事判决(1998)济知初字第54号: Design patent 94313601.6.

(*115) 珠海格力雅达电器厂 诉 成都彩虹电器(集团)股份有限公司、四川省成都中级人民法院1999年12月16日民事判决(1999)成知初字第43号: Design patent 97330116.3.

(*116) 危五祥 诉 南海市平洲康实业有限公司、广东省佛山市中级人民法院2000年7月27日民事判决 (1999)佛中法知初字第199号: Design patent 98318300.7.

(*117) 南海立昌家用电器有限公司 诉 万宝集团公司家用电器研究所、广东省高级人民法院1996年6月11日民事判决 (1995)粤知终字第10号: Design patent 88301502.1.

difference in the classification, whereas the High People's Court revoked the invalidation decision on the grounds that similarity should be determined based on the drawings and statements in the reference material.^(*118)

Under the amended Examination Guidelines put into force in July 2004, identity or similarity in respect of general products should be concluded by adopting the whole part assessment, but not based on parts or details.

In the *minibike* case mentioned above, the first instance found similarity by the whole part assessment based on the overall observation, whereas the second instance denied similarity by both of first the substantial part assessment and then the whole part assessment.

According to the Examination Guidelines, any part of an article that easily attracts attention when used has a significant impact on the overall visual effect whereas the functional effect, color, and materials have no such impact.

For copyright protection, works of applied art are construed as being included in the category of works of art. In the *Lego block* case, copyright protection was afforded to the design as a work of applied art that was reproducible and original.^(*119)

Well-known products are protected under the Unfair Competition Prevention Law from any act of causing confusion or misleading by applying identical or similar names, packages, or ornaments.

Three-dimensional trademarks are protectable, but protection shall not be afforded to a shape that is solely dictated by the nature of the product per se, or indispensable for achieving the technical effect, or provides the product with substantial value.

Conclusion

The design protection systems in the countries surveyed in this study can be summarized as follows.

As to frameworks of the systems, two-track systems are adopted in such manner as, in addition to the registered design system, to provide design right system in the United Kingdom and unregistered Community design system in the European Community, but the contents of the two systems differ in the requirements for rights to take effect and the objects of protection. In particular, the unregistered design systems, under which validity of rights shall not be presumed, are criticized as putting more burden on right holders

than registered design systems.

For the objects of design protection, the scope of protectable objects is broader in Europe because "products" to which designs are applied include intangibles. The treatment of part designs, graphic symbols, and icons differs between Europe, the United States, and China.

As to the requirements for protection, and in particular, novelty, Europe and China requires relative novelty whereas the United States, like Japan, requires absolute novelty. Unlike the United States and Japan, there is no requirement to be determined from the perspective of designers in Europe and China.

For the scope of effect of a design right, those countries adopt such common approach of determining the scope as not from the perspective of designers or general consumers but from the perspective of those who exist in-between them, though respective specific levels differ. In China, design infringement is found on the premise of similarity in articles. In those countries, consideration is given to the balance with the requirements for protection when determining whether or not a design right is infringed.

Designs may be also protected under other systems than copyright law for directly protecting creative works, including unfair competition law, trademark law, civil code, and common law, but protection of design under such laws is only intended to be complementary. Cumulative protection of designs under design law and copyright law is different between France and other countries. In particular, in connection with moral rights of authors, deliberation is necessary as to protection under copyright law of industrial designs that are frequently required modifications.

In light of such differences in design protection systems in countries, it is necessary to consider what criteria we should adopt to define the objects of protection, requirements for protection, and scope of protection for the purpose of promoting industries in Japan.

(Senior researcher: Takeyuki Iwai)

(*118) 索尼电脑娱乐公司 诉 广东步步高电子工业有限公司、专利复审委员会、北京市高级人民法院2002年12月17日判决 (2002)高民终字第847号: Design patent 99335291.X; Design patent 94311846.8.

(*119) 英特莱格公司 诉 可高天津玩具有限公司 北京市第一中级人民法院2001年12月25日判决、北京市高级人民法院2002年12月18日判决 (2002)高民终字第279号.