



# Newsletter

21COE-WIN-CLS RCLIP

## ❖ RCLIP Workshop Series No.22 (2008/1/28) “The Notional Person Who Judges the Similarity of Designs”

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At the RCLIP Workshop Series No.22 on January 28, 2008, a report was made on “the notional person who judges the similarity of designs”. The revision of Design law in 2007 stipulates that “consumer” takes the role of the person who judges similarity between registered design and other designs (Article 24(2)). However the concept is not entirely clear because no specific definitive provision was made. The report examined how the consumer should be defined by considering the trends of court decisions on design infringement as well as the notion of “informed user” presented in a judicial decision in Europe.

The lecturer indicated the direction of the report at the beginning: “presenting an interpretation to protect design as design” and “presenting an interpretation which does not use such keywords as confusion or creation as much as possible”. Similarity judgment is the work to decide which is important, common points or different points of the subject. Therefore, it is necessary to examine the method of deciding the importance of common points and different points in considering its criteria of similarity judgment. First of all, in general, when a person judges the subject is similar,

he/she compares “unique attribute” of the subject. In apprehending such “unique attribute”, the processes includes (i) identifying the “unique form” in contrast with other subject of the same kind, (ii) “weighting” of the observation points based on the “relations” between the observer and the subject, and (iii) the “unique form” tends to be recognized as “unique attribute” when it is at the stronger part of “weighting”, based on the two foregoing valuations. The process of judging similarity of contrasting designs is also the same as these processes. This conforms to the criteria for similarity judgment which has been consistently presented by the Intellectual Property High Court , Tokyo District Court, Osaka High Court and Osaka District Court on infringement cases (for example, the IP High Court Decision on March 27 of 2008 at the Supreme Court Website). That is, the recent judicial decisions recognize the “most attention-drawing part” for consumers as the “main feature” of the design and the design must be observed by especially focusing on such feature. They were judged considering “nature, purpose, and usage of the design” and “whether each part of the design is similar to prior designs”. The former is the criteria of “weighing based on the relations” and the latter means identifying a unique form in contrast with the others of the same kind.

Next, the lecturer pointed out this criterion of “contrast plus relations” had a risk to have the dual criterion in which it is impossible to decide which is much important if both common and different points of the subject are valued as important respectively from each of views of “contrast” and “relations”. The lecturer pointed out this kind of risk also exists in the EU and U.S. criteria of judging infringement. However, in the interpretation of the EU design regulation, all considering factors of defining the scope of

protection are united as knowledge and awareness of “informed user”. In such interpretation, the criteria should be theoretically unifying. So the interpretation is natural and reasonable in that sense. It is necessary to interpret “the consumer is informed” also in Japan’s Design law and by doing so, developing the dual criterion should be avoided. More concretely, the consumer has knowledge about designs enough to understand the “nature, purpose, and usage of the design” and to consider “whether each part of the design is similar to a prior design”.

Based on the conclusions above, the report further examined the content and quality of the information informed to the consumer speculated in the Article 24(2).

First, for the issue of the “nature, purpose and usage of the design” which the consumer understands, the lecturer examined the judicial decision of the Osaka District Court on August 30 of 2007, Hanrei-Jiho 1965.147, or the EU design court decisions such as THE PROCTER & GAMBLE v RECKITT BENCKISER (UK) [2006] EWHC 3154. The design (product design) is formed by adjusting and integrating “mechanical”, “cultural”, “technical”, and “economic” factors as well as “safety” or “environmentality”. The consumer who receives that design also gets involved with the design through those factors and nature. It is appropriate that the criteria for the “nature, purpose and usage of the design”, which is the criteria for “the relations”, should consider “mechanical”, “cultural”, “technical”, and “economic” factors as well as “safety” or “environmentality” in a more concrete manner.

Next, for the consumer’s knowledge of prior designs as the criteria for “contrast”, the lecturer pointed out that the knowledge of an informed user was considered to be not archival knowledge but general knowledge such as general body of designs. In Japan’s Design law, it is also appropriate that the consumer’s knowledge should be considered to remain general and overall because it is illogical to assume the consumer “knows all prior designs”

and also it is impossible that a person knows “all of the same kinds”. By the “general knowledge” criteria, it can be concluded that the part of the subject design does not constitute the “main feature” of the design when the forms of this part are found in a prior design and perceived as “common” or “popular”. When it is the case that “there existed a design with the same form ten years ago” for instance, that fact would not be a bar for deciding the form of this part constitutes the main feature of the design. In addition, he pointed out that such criteria had been adopted for a long time, referring to the Tokyo District Court decision on March 23, 2003 (the Supreme Court Website) as an example. Then, he concluded that with this criterion, the same results were reached between the similarity judgment in infringement cases and the judgment related to the Article 3 (1) (iii) which is a requirement for registration.

After the report, a QA session actively took place with the audience.

(RA Asuka Gomi)

### ✿RCLIP Special Workshop: India (2008/2/21)

"Tradition and Technology: The Two Faces of Indian Copyright Law"

【Co-Sponsor】 Simul International

【Lecturer】

Professor Dr. Mira Sundara Rajan, University of British Columbia

【Moderator】

Professor Ryu Takabayashi, Waseda University



The RCLIP Special Workshop on February 21, 2008 invited Indian-Canadian Professor Dr. Mira Sundara Rajan from University of British Columbia to have a lecture titled " Tradition and Technology: The Two Faces of Indian Copyright Law". The workshop was held to mark the inclusion of the data from Indian precedents to the RCLIP IP database.

The lecture took up the topics of the outline of copyright policies in India, historical and cultural context of Indian copyright law, the introduction of cases, the issues toward the future and so on.

First, Professor Rajan presented the problematic situation in India; India is a developing country. On the other hand, it has a leading high-tech industry and large movie industry. Such two faces of India require the current policy making to realize two conflicting objectives. That is, India must facilitate innovations and, on the other hand, it must protect new and old domestic cultural industries. Furthermore, as a member of the global society, it must comply with the WIPO's copyright framework.

Professor Rajan stated it was important to establish the framework to promote the IT industry in terms of facilitating innovation. However, referring to the US software industry which had grown without restriction, and then faced the strengthening copyright protection, she pointed out there existed great uncertainty in India in understanding and practicing the impact of copyright law on the IT industry.

On domestic industries related to copyright, Professor Rajan said that the government recognized the necessity of protecting copyright from piracy, especially for the movie industry. Also, she mentioned the uniqueness of "translation" in India. By raising the epic of Ramayana as an example, she illustrated the "translation" as an effort to give birth to creative forms by the historical and cultural context in each region instead of just replacing one word from another among 18 official languages and several thousands of dialects in India. However,

in response to the requests of translating English or other language works as well as having the same and accurate translations among Indian dialects to improve the intellectual level of India, the current Indian copyright law stipulates compulsory license and exercise it widely in practice. But fierce conflicts are occurring between parties with the different interests.

Then, Professor Rajan pointed out the very unique historical and cultural context behind the Indian copyright law, which gives the Western IP researchers a cultural shock. India has a mixed law system including Common law, Civil law, the legal systems of socialism and post-socialism, and the legal system of a developing country. Professor Rajan mentioned Indian history from the view of the legal system of a developing country; there has existed various complex systems of law in each region of India from a long time ago. There also has existed social customs in various aspects of life. A debate over "plagiarism" was already raised in the 9th or 10th century, which is far distant past compared to the West.

Indian traditional copyright model focuses on the protection of ideas as much as expressions. The scope of protection is wider than the Western model in this respect. Especially, in comparison with the US copyright law, there exists no "fixed" concept in wordings of Indian law. Therefore, there is a chance to question the meaning of "fixed" requirements and the nature of valuing intangible such as fame or reputation is suitable for the modern days in the current digital environment. People in India still lack considering monetary rewards to authors. It is said to be one of the factors of infringement. Professor Rajan explained this was the result of the superficial adoption of the British laws in the middle of the 19th century after the long tradition in which authors have depended on patrons for a living and stressed their reputation or fame rather than monetary rewards.

Next, she outlined the revision of copyright

law in India. Especially the revisions were made respectively such as the protection of video films and a computer programme in 1984, the extension of copyright duration 60 years after the author's death in 1992, and the revision of 1994 when India joined the WTO: the adoption of performers' right, droit de suite, fair use of software, and moral rights related to software.

In addition, two cases were introduced. The case of a famous national poet Bharathi was explained at first. Just after India's independence, the government of Madras State took over the copyright of Bharathi's works and gave it to the people of India although it was still within the protection period. As a result, careless publishing has impaired the uniformity of his work. While publishers had made huge profit, the Baharathi family was unable to benefit anything from the publishing.

The case of Sehgal which continued from 1978 to 2005 was introduced as the case of judicial role for ensuring the effectiveness of copyright law. Indian judiciary is very active and in many cases it conflicts the administrations. Professor Rajan pointed out many judicial decisions were made in favor of individual authors in India.

Last, for the future prospect, she said extreme changes would be going in India for a while. She stated that it was necessary to make the uniqueness of India understood on an international basis and to spread IPR and knowledge as well as to facilitate creation of works in developing countries.

After the lecture reported above, an active QA session took place with the audience.

(RC Noriyuki Shiga)

❖ **RCLIP Workshop Series No.23 (2008/3/6)**  
“Observations about “Products” in Trademark Law”

Masaharu Miyawaki, Associate Professor,  
Ritsumeikan University



The RCLIP Workshop Series No.23 on March 6, 2008, invited Associate Professor Masaharu Miyawaki of Ritsumeikan University to deliver a report titled “Observations about “Products” in Trademark Law”. About 80 participants attended the workshop.

This report reexamines the basic theory that what the “products” in Trademark law mean.

In some cases, identifying the subjects as “products” should be on the ground that those are accompanied with payment. Some judicial decisions ruled that pamphlets or sales promotion goods were not “products” based on that ground. (pamphlet: Tokyo District Court Decision on March 2 of 1961, KaMinSyu 12\*3\*410 (SyuminoKai) and sales promotion goods: Osaka District Court Decision on August 26 of 1987, Mutaisyu 19\*2\*268 [BOSS] )

However, today's discussion indicates it is not a matter of payment, but it is a matter of “use as a trademark” (what the trademark of such goods specifies in identifying the origin of the goods).

It is not fully agreed what nature is necessary to constitute “products”. (for the nature of trade subject, tangible entities, and movable assets: *Overview of Trademark Law*, 2<sup>nd</sup> edit., by Shoen Ono, Yuhikaku, 1999, p.172, for the nature of trade subject and movable assets: *Trademark Law*, new edit., 1<sup>st</sup> vol., by Shoen Ono, Seirinshoin, 2005 p.86-87, for the nature of tangible entities,

movable assets, distribution, and trade subject: *Trademark*, the 1<sup>st</sup> revised vers., by Masaki Hirao, Gakuyoshobo, 2006, p. 20-21, and for the nature of distribution, trade subject, and tangible entities: *Overview of Trademark Law*, 2nd edit., by Yoshiyuki Tamura, Kobundo, 2000, p.26.)

Associate Professor Miyawaki pointed out that it was difficult to require the nature of movable assets since the current Japanese Trademark Law included the act of “providing goods through an electric telecommunication line” in the Article 2(3)-(iii).

At any rate, it is commonly accepted that the nature of distribution or trade object is necessary. But it concerns only the registration and it needs other consideration for the infringement. In other words, in the registration, the question is whether it is appropriate to provide trademark (to maintain trademark in the trial for rescission of trademark registration). So it is deciding the concept of products in terms of the view of determining whether the products which should be protected exist or not. In this respect, it requires the nature of distribution or trade object. In contrast, in the infringement, the question is to protect the right holders in terms of avoiding confuse. Therefore, the concept of products should include everything that has any possibility of confuse (for example, in p.251, Tamura). Judicial precedents seem to presume such way of thinking.

However, the ground still remains uncertain in identifying the concept of products differently depending on the situations. Article 50(1) about the trial for rescission of trademark registration requires the use of registered trademark the designated goods. That should be enough to examine if the right holder’s product is included in the designated goods or not. On the other hand, in the infringement, according to Article 37(1), the use of a trademark similar to the registered trademark in connection with the designated goods or services shall be deemed to constitute infringement. That should be enough to examine

if the infringer’s product is within the scope of similarity to the designated products. If that is the case, it is not necessary to identify the concept of products differently depending on the situation such as registration or infringement. Associate Professor Miyawaki pointed out that it should be sufficient to examine if it is included in the designated products in the registration, and to examine if it is included in the scope of similarity to the designated goods in the infringement.

Advantages of taking such a position include facilitation of specifying the designated products in the application, and proper adjustment of the protection scope of trademark.

For example, in the case of the IP High Court Decision on [Tokyo Metro] 1 on September 27 of 2007, the act of posting/distributing a printed matter titled “Tokyo Metro(とうきょうメトロ)” free of charge is deemed to constitute the act of using the registered trademark “Tokyo Metro(東京メトロ)” which specifies “newspapers and magazines” as the designated products. In this case, the similarity scope of the trademark “Tokyo Metro” should be decided based on “newspapers and magazines”. The trademark holder only uses the registered trademark for free paper. To extend the protection to the similarity scope based on “newspapers and magazines” result in discrepancies between the use in reality and the protection scope. Associate Professor Miyawaki pointed out such protection scope of trademark would not be appropriate. “Free papers” and “newspapers” differ in terms of trading conditions. In that sense, even if it is used for “free papers”, it does not mean it is used for “newspapers”. According to Associate Professor Miyawaki, the trial to for rescission of trademark registration should be approved in that case. It is important to establish the reputation by using free paper. However, if that is the case, the right holder should register “free papers” as the

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<http://www.courts.go.jp/hanrei/pdf/20070928144009.pdf>



designated products. By doing so, the applicants for registration specify the “designated products” in accordance with their use in reality. It results in preventing the discrepancies between the use in reality and the protection scope and contributing proper adjustment of the protection scope of trademark.

After the report stated above, a QA session actively took place with the participants. Especially, in terms of the possibility whether to file an application to specify “free papers” as the designated products, a participant from the floor pointed out that there might be room for debate depending on individual concrete cases although the Japan Patent Office does not allow so. However, it was also pointed out that it would be hard for applicants to bear such a burden and that it would also be hard for right holders to register the trademark to specify “free papers” as the designated products when they are entering the “free papers” market in addition to the “newspaper” market although they have already registered their trademark with the designated products “newspapers”.

(RC Taro Hirayama)

### The RCLIP's

#### Asian IP Precedents Database Project

※ The database is available in English, free of use at: <http://www.21coe-win-cls.org/rclip/db/>

#### ❖IP Database Project: China

About 90% of the Chinese cases of FY2007 (including additional 65 cases) were completed. It will be uploaded at the end of March 2008.

(RA Yu Fenglei)

#### ❖IP Database Project: Thailand

Currently 316 Thai precedents have already been placed at the database. More 75 cases will be added this year. We have added the topical

Ultraman Case that Thai Supreme Court hold in February 2008.

(RC Tetsuya Imamura)

#### ❖IP Database Project: Indonesia

Currently we are under negotiation to ask the collaborator to select 30 precedents.

(RA Akiko Ogawa)

#### ❖IP Database Project: Taiwan

60 cases were expected for the FY 2007, but the additional 40 were added, reaching 100 in total.

(RC Akiko Ogawa)

#### ❖IP Database Project: Vietnam

Unfortunately, Vietnam precedents were not uploaded this year. We are continuing the relations with the Vietnam Supreme Court for collecting precedents.

(RA Asuka Gomi)

#### ❖IP Database Project: Korea

In addition to the sixty precedents which were placed last year, new IP precedents were added this year. 15 trademark cases were added on November 6 of 2007 and 14 patent cases were added on January 23 of 2008. Korean cases are 89 in total.

(RA Lea Chang)

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