

Wrap Film Case

(Interpretation of article of design in determining similarity as to article and part thereof)

Case No. 17501 (wa) of 2004

Tokyo District Court October 29, 2004 decision

FACTS

Plaintiff, X, manufactured and distributed a wrap film product (article). Defendant, Y, warned that the wrap film product infringed Y's design right for a grip tab component of a wrap film product (i.e., a part of the article).

In response, X filed a suit seeking a declaratory judgment that X's wrap film product did not fall within Y's design right.

ISSUE

Whether a design right for a part of an article implicates the finished article as well?

HOLDING

"Design" in the Design Act means shape, pattern, color, or any combination thereof, of an article, which creates a visually aesthetic impression except for a design registered as a part design (see Design Act Article 2(1)). Therefore, a design is inseparable from the article expressed based on the design.

In order to determine similarity between the registered design and X's design, it is required not only that the "shape, pattern or color, or any combination thereof" of the registered design be similar to that of design in question, but also that the registered design article and the article in question be similar. In this case, the article in question is not merely a part of an article but is itself placed in the stream of commerce and can be bought and sold as an independent article.

In the present case, whereas the article for Y's design is a grip tab component of a wrap film product, the article that X manufactures and sells is a wrap film product. Therefore, both the use and function of the two articles are different, and there is no identity or similarity.

Y argues that both articles are similar to each other when comparing the specific part of X's wrap film to the article of Y's design. However, the

separation is arbitrary and the part in question is not an economically independent unit in the stream of commerce. Accordingly, it is not necessary to consider whether that part is similar to Y's design in the present case.

In addition, if a part of X's wrap film, which corresponds to Y's design, is clearly distinguishable from Y's design, it may be held that X's design uses Y's design. However, because the grip tab part of X's film is not an economically independent unit, X's design does not use Y's design.

In view of the above, it is held that X's manufacturing and distributing the finished film product do not infringe Y's design.