

Determination of Similarity Criteria in Design Infringement

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MAPED v. Yangjiang Bonly Industries Ltd. et al. (Civil Ruling (2013) Min Shen Zi No.29 by the Supreme People's Court on September 22, 2013)

The similarity criteria is always a focus of attention in determination of design infringement. Conventionally, people often discuss whether two designs are alike in determining design infringement without objective analysis standards. The scissors case at issue presents several important issues regarding similarity criteria that we will discuss in detail. Further, we will discuss some considerations, such as freedom to design, prior designs, influence of feature on the overall visual effect etc., that should be taken into account in similarity determination.

The patentee, MAPED, has a scissors design 200430002915.3 ('915 design), as shown in figure 1. MAPED filed a lawsuit before Guangzhou intermediate court, alleging that Yangjiang Bonly Industries Ltd. et al. (hereinafter "Bonly et al.") made and sold scissors (as shown in figure 2) that infringed the '915 design. The patentee said, except that the accused infringing scissors has a color pattern on the blades and a larger pivoting pin with curved ridge, the rest components of the accused infringing scissors are identical to the '915 design.



Figure 1

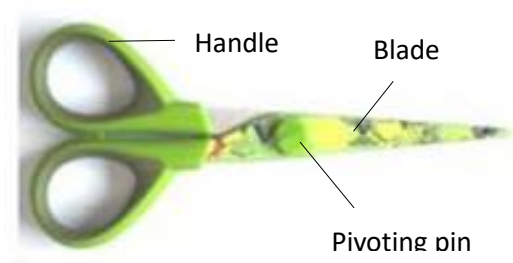


Figure 2

The first instance court and the second instance court both held that, "*the color pattern on the blade is the major distinguishing feature between the accused infringing scissors and the*

‘915 design due to the dominant position of the blade in the scissors. The appearance of the accused infringing scissors is substantially different from the ‘915 design due to the feature above, causing the both are not similar to each other.’ Accordingly, the courts rejected the request for infringement.¹

The patentee was unsatisfied with the decision and filed a request for retrial before the Supreme People’s Court. The patentee argued that because the ‘915 design is a design only related to the shape of the scissors, the accused infringing scissors falls within the scope of the ‘915 design if the former has the same shape as the latter, without considering the pattern and the color of the accused infringing scissors.

The Supreme People’s Court held that the focus issue is whether the accused infringing scissors infringed the ‘915 design. Comparing the accused infringing scissors with the ‘915 design, they both include the three major components of handle, blades, and pivoting pin positioned in the middle of the scissors. The same features between them are the identical shape of the handle and blade, concentric ring composed of outer light ring and inner dark ring of the handle, and the teardrop-shaped through-hole in the center of the handle. The main differences are as follows. The first distinguishing feature is the shape of the pivoting pin. More specifically, the pivoting pin on the two sides of the accused infringing scissors is a large cylindrical boss with wavy ridge thereon, and the pivoting pin on one side of the scissors of the ‘915 design is a little metal pin with linear groove thereon. The second distinguishing feature is the color pattern on the blade of the accused infringing scissors. Regarding the first distinguishing feature, the position of the pivoting pin and the obvious differences in shape and size between them are sufficient to make the appearance of the accused infringing scissors substantially differ from the ‘915 design. Regarding the second distinguishing feature, because the ‘915 design does not protect color element and the blade has no pattern, the second distinguishing feature is additional design element added to the accused infringing scissors, which should not have essential influence on the determination

¹ Refer to Civil Decision (2010) *Hui Zhong Fa Min San Chu Zi* No.165 by Guangzhou Intermediate Court and Civil Decision (2011) *Yue Gao Fa Min San Zhong Zi* No. 164 by Guangdong Province High People's Court.

of design infringement. Finally, the Supreme People's Court rejected the patentee's request for retrial.

Interpretation and Analysis

There are two typical issues relevant to similarity judgment in design infringement in present case. One is how to exactly define the protection scope of a design. The other is how to evaluate the degree of influence of each design feature on the overall visual effect of a product.

I. The Determination of Protect Scope

In this case, the first instance and the second instance court hold that "*the color pattern on the blade*" of the accused infringing scissors is a major feature which causes the accused infringing scissor to be not similar to the '915 design. However, the Supreme People's Court holds that the feature above is an additional design element added to the accused infringing scissors, which should not have essential influence on the determination of design infringement. How then to determine the protection scope of the '915 design?

First, the protection scope of a design does not include color element unless a specific declaration is made in the brief explanation. Generally, the scope of a design which may include the three elements of shape, pattern and color is defined by the design shown in the drawings or photographs.² Color alone cannot be protected without shape or pattern in design. If someone wants to protect the color of a design, he or she must write it down in the brief explanation of the design application. Without such declaration, even though the design as shown in the drawings or photographs contains color, the color will be excluded from the protection scope of the design when enforcing the right. In this case, despite that '915 design does not contain color element, the color element in the accused infringing scissors should still not be taken into consideration in similarity comparison.

² Article 59, paragraph 2 of the Chinese Patent Law provides that, "The extent of protection of the patent right for design shall be determined by the design of the product as shown in the drawings or photographs. The brief explanation may be used to interpret the design of the product as shown in the drawings or photographs."

Second, in determining whether an accused infringing product has infringed a design, it should compare the accused infringing product with the design based on the protected shape, pattern and/or color elements in the design. In this case, the patentee argued that the ‘915 design contains only the shape of the scissors. But the Supreme Court held that “*the pattern constituted of light and/or dark variety should be considered as pattern element, ..., concentric ring composed of outer light ring and inner dark ring of the handle is pattern element.*” Hence, the ‘915 design contains two elements, shape and pattern, the pattern-related features should be taken into consideration in making comparison for establishment of infringement. According to the opinion above, the pattern on the handle and blade of the accused infringing scissors shall be compared with the pattern on the handle of the ‘915 design. However, the Supreme Court held that the pattern on the blade of the accused infringing scissors “*is an additional element in the accused infringing product, which should have no essential influence in the determination of design infringement.*” The Supreme Court’s opinion may be challenged from two points as follows. First, there is no provision in the law regarding the determination of whether a feature being “*additional added design element*”. If similarity comparison relates to element(s) of shape, pattern and/or color, each feature belonging to the corresponding element should be taken into consideration. Second, the concept of “*additional added design element*” lacks applicability in practice. All of the features belonging to the same element, such as shape, usually interweave with each other. Consequently, It is difficult to judge whether a feature belongs to “*additional added*” element, a task that would increase uncertainty in reaching a conclusion. I am of the opinion that, in the case discussed, the conclusion can be arrived at by considering the influence of the blade’s pattern on the appearance of the accused infringing scissors without excluding the feature from consideration.

It is noted that the latest *Draft Amendment of Chinese Patent Law (For Public Comments)* has introduced a provision on partial design.³ The protection of partial design is expected to

³ Article 2, paragraph 4 provides that, design refer to any new design of the shape, pattern, color, or their combination, of a product or a part of it, which creates an aesthetic feeling and is fit for industrial application.

confer strong protected for the innovative part of a product with, thus preventing an infringer from modifying the design as a part of the product to go around a design patent.

II. Considerations in Judgment of Similarity

Following the determination of scope of a design, one should evaluate the degree of influence of a feature on the overall visual effect of a product by considering freedom of design, prior design and visual importance of a feature etc.

First, based on the analysis above, the identical and different features between the ‘915 design and the accused infringing scissors are analyzed as follow. The main identical features are that they both include handle, blade and pivoting pin, the shape of the handle and blade are identical to each other, and the concentric ring on the handle is identical to each other. The main different features are that the pivoting pin of the accused infringing scissors is larger than the ‘915 design, and the accused infringing scissors having pattern on its blade.

Second, to determine the freedom to design of the product. Design of a product is often dictated by its function, technical requirements, etc. The restrictions considered in designing a product is referred as Freedom to Design. In this case, regarding scissors, to obtain cutting function, a scissors often includes handle, blades and pivoting pin. The handle often designed in ring shape to allow use by fingers. The blade often designed in slender shape to save material and labor. From the viewpoint of the freedom to design for the three components of a scissors, handle has more variation in design than the blade and pivoting pin.

Third, to analyze the prior designs of the product. Commonly, the occurrence frequency of a certain design feature in prior designs can change its degree of influence on the overall visual effect of the product. If the occurrence frequency of a certain design feature in prior designs is high, the feature’s degree of influence on the overall visual effect of the product is also high, and vice versa. In this case, the typical scissors in prior designs are shown in figure 3 below.



Figure 3

As shown in figure 3, the occurrence frequency of elongated blade in prior designs is higher. The elongated blade of the '915 design is similar to the blades occurred in prior designs. The teardrop-shaped handle with concentric ring pattern is never found in prior designs. The handle of the '915 design is significantly different from the handles occurred in prior designs. Regarding pivoting pin, small or big pivoting pins both occurred in prior designs

with higher frequency. Hence, from the viewpoint of prior designs of scissors, the handle in this case is more likely to attract attention of the general consumer than the blade and pivoting pin.

Forth, to evaluate the distribution of the influence of the feature to the overall visual effect of the product. The following should be taken into account in determining the influence of a design feature on the overall visual effect.

- (i) The amount of features included in a design. If a design include only a few features, the variation of the feature is more likely to cause the attention of the general consumer, and vice versa.
- (ii) The position of a feature located in a design. The variation of a design feature which located in a position easy to observe in use is more likely to cause the attention of the general consumer, and vice versa.
- (iii) The proportion of a feature in a design. The variation of a feature which accounted for a large proportion in the design is more likely to cause the attention of the general consumer, and vice versa.
- (iv) The importance of a feature in use. The variation of a feature which located in key using portion is more likely to cause the attention of the general consumer, and vice versa.

Finally, considerations, such as freedom to design, prior designs and the degree of influence of a feature on the overall visual effect of a product, should be taken into account in judging similarity in design.

I will then reanalyze on the case based on what has been discussed above. Regarding a pair of scissors, its shape is more likely to attract attention of the general consumer than its pattern. The handle and blade account for a larger proportion in the design than the pivoting pin, leading the variation of them being more likely to attract the attention of the general consumer. Due to use by directly holding the handle, the variation of handle is more likely to have the attention of the general consumer. Accordingly, the handle has more significant

influence on the overall visual effect of product than the blade and pivoting pin. The identical features, including the shape of handle and blade, and the pattern of concentric ring on the handle, is sufficient to cause the ‘915 design and the accused infringing scissors to have similar design. Regarding the different features, the pivoting pin has not significant influence on the overall visual effect due to high occurrence frequency of pivoting pin in prior designs and the its small proportion in the whole design. Although the pattern on blade is obvious due to its being usually independent from the shape of the product, the pattern is easy to copy among different products and the pattern on the blade and the shape of the blade in this case do not cause visual association and give rise to unique visual effect. The difference in pattern has not significant influence on the overall visual effect of the product. Hence, the ‘915 design and the accused infringing scissors are similar design.