

**PATENT COURT
THE THIRD DEPARTMENT
DECISION**

Case No. 98Heo9604 Scope Confirmation(Design)

Plaintiff: Chasoon KIM
Counsel for the Plaintiff: Seok Hwan KIM, Patent Attorney

Defendant: Gilseon JIN

Closure of Hearing: February 25, 1999

Order

1. The decision of the Intellectual Property Tribunal ("IPT") issued on September 30, 1998 in Case No. 98Dang535 shall be cancelled.
2. The trial costs shall be borne by the Defendant.

Tenor of Claim

It is the same as the order.

Reasoning

1. Background facts

Considering the totality of Plaintiff's Exhibit Nos. 1 to 5 and overall pleadings, the following facts are acknowledged and no evidence to the contrary has been presented:

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A. Procedural history

The Plaintiff is the owner of the design registration No. 163408 for a combined shape and pattern of an “electronic desk lamp body” (application date is November 12, 1993 and registration date is April 26, 1995) as described in Drawing 1 attached hereto (“Registered Design”).

The Defendant filed a trial seeking confirmation of scope of rights, arguing that the design described in Drawing 2 attached hereto (“Subject Design”) does not fall under the scope of rights of the Registered Design on the ground that the Subject Design is not similar to the Registered Design in terms of composition and conjures a different sense of aesthetic impression as a whole.

The IPT examined this case under No. 98 Dang 535 and rendered a decision on September 30, 1998 ruling that the Subject Design does not fall under the scope of rights of the Registered Design for the reasons set forth in Section B below (“IPT Decision”).

B. Summary of IPT Decision

Upon review of the front views and right side views of the compared designs, they conjure different sense of aesthetic impressions from each other due to the existence/non-existence of a lampshade, lamp support and support stand. Even if the comparison is limited to the body itself, the designs are not similar as the Subject Design has a support stand in the bottom of the body which is larger than the body case to fulfil the function of supporting the lamp. Therefore, the Subject Design does not fall under the scope of rights of the Registered Design.

2. Parties' Arguments

A. Summary of grounds for appeal proffered by Plaintiff

In a trial confirming scope of rights of a registered design, the comparison should be made between the Registered design and a product having the same shape and pattern as the Registered design. However, the IPT concluded that the Registered Design and the Subject Design are dissimilar based on a comparison of the designs as a whole, which amounts to legal error. In addition, the shape and pattern of the bodies of the compared designs are identical, except the Subject Design's support stand, which adds support to the body and does not exist in the Registered Design. However, the support stand is nothing more than a simple commercial modification that anyone can easily make. Therefore, the compared designs are confusingly similar to each other.

B. Defendant's arguments

Defendant has failed to attend the hearing or submit any briefs, and has made no assertions to date.

3. Judgment

Based on the evidence referred to above, the Registered Design is a design for an electronic desk lamp body and the Subject Design is a design for an electronic desk lamp; that is, the Registered Design is a design for a part and the Subject Design is a design for a finished product containing the part, so the compared designs cover different articles, respectively.

However, if the Registered Design pertains to a part and the compared Subject Design relates to a finished product containing the part and use of the Subject Design is inevitably pre-conditioned upon

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the use of the part covered by the Registered Design, that is, the Subject Design has to use the Registered Design, in light of the legislative intent of Article 45(1) of the old Design Act (before amended by Law No. 5354 dated August 22, 1997) which stipulates that if a design uses a third party's registered design (which was filed earlier) or any similar design, the design may not be used for commercial purposes without obtaining the design owner's consent or being granted a non-exclusive license through a trial for the grant of a non-exclusive license, the Subject Design should be deemed to fall under the scope of rights of the Registered Design insofar as the Subject Design's design for the part corresponding to the Registered Design is acknowledged to be identical or similar to the Registered Design.

Whether the Subject Design's counterpart portion is similar to the Registered Design is reviewed below. The Registered Design and the body portion of the Subject Design are completely identical in terms of the following factors: the front side is semi-circle shaped; the rear side is a case whose top and bottom parts are connected with rounded corners; the top middle of the upper case has a curve in the form of an egg; there are several symmetrical slots on the left and right sides of the middle point of the curve; a power button is formed in the front surface of the front side; and the rear side is a design for a lamp body showing a shape and pattern combined with a circular tube shape, which becomes narrower at the top, installed to enable the lamp support to be fixed. The sole difference between the Subject Design and the Registered Design is that there is an additional support stand on the bottom of the lamp body, which is larger than the body itself and whose front side is semi-circle shaped and rear side is in the form of a thin plank with angled corners. However, for a design of a an electronic lamp body, like the Registered Design, the shape and pattern of the front side of the body can be viewed as an essential portion well observed by consumers, and the support stand in the form of a thin plank added to the body is not as conspicuous, so the existence or

non-existence of such support stand does not make much difference to the sense of aesthetic impression. Furthermore, the addition of a support stand on the bottom of the body of the lamp is merely a functional and commercial modification that can be made by any skilled persons in the art. Based on the foregoing, despite the difference in the existence/non-existence of a support stand, the compared designs are similar in terms of the sense of aesthetic impression.

Accordingly, the Subject Design uses the Registered Design and falls under the scope of rights of the Registered Design, and the IPT Decision reaching the opposite conclusion is illegal.

4. Conclusion

Therefore, since the IPT decision should be cancelled and the Plaintiff's claim seeking cancellation thereof is grounded, the Court accepts the claim and issues the decision stated in the Order.

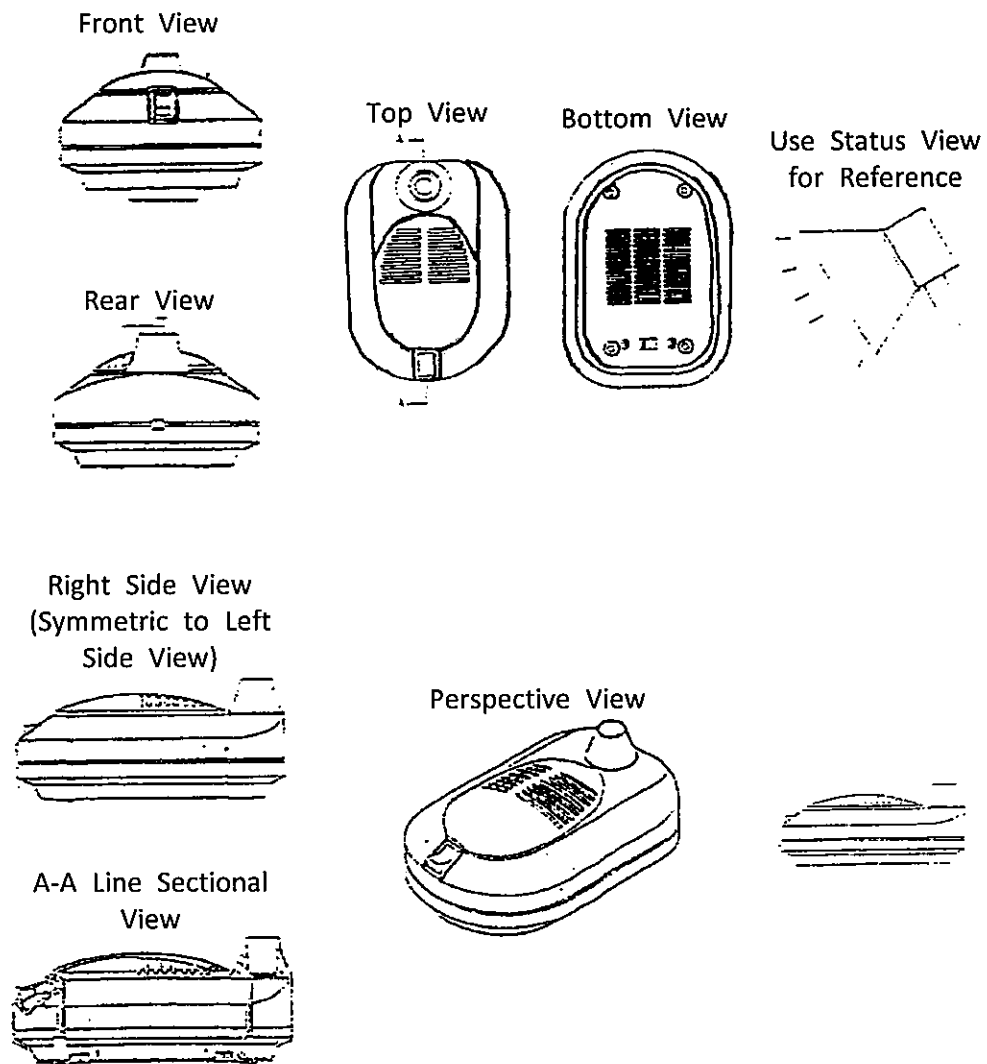
March 11, 1999

Presiding Judge	Ilhwan PARK
Judge	Jangho LEE
Judge	Soowan LEE

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[Annex 1]

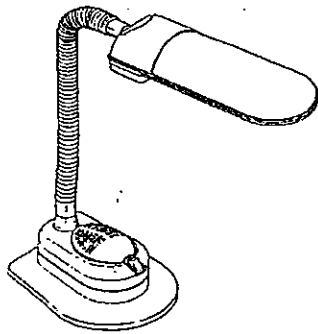
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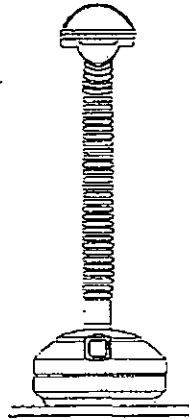
[Annex 2]

Subject Design

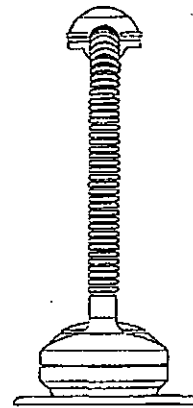
Perspective View



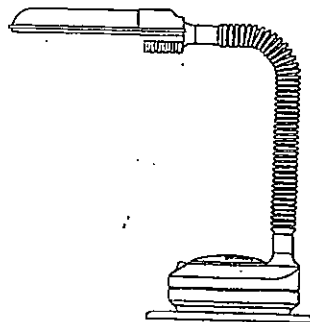
Front View



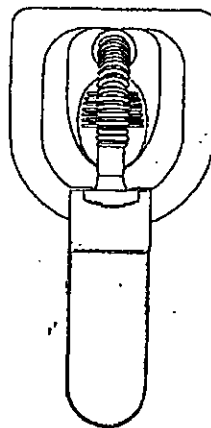
Rear View



Left Side View
(Symmetric to Right Side View)



Top View



Bottom View

