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Dongguan City Huahan Children's Goods Co., Ltd. v. Guangdong Province Intellectual Property Office, et al.

Citation: The Guangdong Province Higher People's Court's Administrative Judgment

No. Yuegaofaxingzhongzi 35/2008

Date of judgment: May 12, 2008

Procedural history

The Zhongshan City Longcheng Daily-use Articles Co., Ltd. (Longcheng) filed a request with the Guangdong Province Intellectual Property Office for investigating and handling the act by the Dongguan City Huahan Children's Goods Co., Ltd. (Huahan) of infringement of the design patent ZL 99304614.2. The Guangdong Province Intellectual Property Office made the decision to order Huahan to cease making and marketing the products similar to the patent in suit. Huanhan brought an action in the Guangzhou City Intermediate People's Court. It was decided, in the first-instance judgment, to have upheld the decision made by the Guangdong Province Intellectual Property Office. Huanhan, hence, appealed to the Guangdong Province Higher People's Court.

Issue

1. Whether the title of the design patent and the classification of the product incorporating the design made at the time of patent grant could serve as the basis for the claim construction or for determining the extent of patent protection.
2. Whether it was possible to decide on the similarity of designs on the basis of similar main parts.

Facts

Longcheng was the patentee of design patent ZL 99304614.2. The title of said design patent was “tricycle” and the classification symbol 12-11-T0344 (namely, the class of bicycle and motorcycle).

The Guangdong Province Intellectual Property Office held that the frames of the children’s tricycles of models “9114”, “9178” and “9178TW” Huahan made and marketed were similar to design patent ZL 99304614.2, and fell respectively into the extent of protection of said patent, constituting infringement of said patent right. Accordingly, Huahan should be held legally liable.

The first-instance court held that the patentee Longcheng’s patent was entitled “tricycle”, but what was shown in the drawings in the Patent Gazette was a shape similar to the frame of a tricycle. As the comparison showed that the frames of the alleged infringing products Huahan made and marketed were indeed similar to the drawings of the patent in suit, so it should be determined to have fallen within the extent of patent protection, and constituted infringement. Although the alleged infringing products Huahan made and marketed were different in class from the design patent ZL 99304614.2 for “tricycle”, they were similar in intended use, and should be taken as the products of similar class. Using the technical solution similar to that of the design patent on products in similar class also constituted infringement of the patent right.

Huahan argued in its appeal that: 1) the frame of the allegedly infringing children’s tricycle and the product incorporating the patented design in suit were not products in the same class, so they were incomparable; and 2) the frame of the allegedly infringing product of model 9178TW (tricycle for two children) was not identical with, nor similar to, the patent in suit.

Rule of law

Article 56, paragraph two, the Patent Law *The extent of protection of the patent right for design shall be determined by the product incorporating the patented design as shown in the drawings or photographs.*

Reasoning

1. Although the design patent ZL 99304614.2 was entitled tricycle, and classified in class 12-11-T0344 (the class of bicycle and motorcycle), the patent title and classification of the product incorporating the design patent when granting the design patent could only be used as the reference and ground for determining the extent of patent protection, rather than the only ground. As was shown with the product incorporating the patent design in suit in the drawings, especially with the drawings of the product in use, said product was a frame for children's tricycle. The frame of the allegedly infringing children's tricycle Huahan made and marketed was identical with the product incorporating the patented design in suit in use and function, and should be taken as a product of the same class in their practical use by the average consumers.

2. Comparison of the frame of the allegedly infringing 9178TW model children's tricycle with the product incorporating the design patent ZL 99304614.2 shown in the patent drawings showed that, while the frames were different in width, the major parts in the design were similar, so were their design style, which did not produce much difference in overall visual effect; the designs were similar.

Holding

1. The title of the design patent and classification of the product incorporating the design patent when granting the design patent could only be used as the reference and ground for determining the extent of patent protection, rather than the only ground.

2. The allegedly infringing product was similar to the product incorporating the patented design in the major parts of the design elements, which was likely to create confusion on the part of average consumers; hence the designs were similar.