SPC Guiding Case No. 85: Grohe AG v. Zhejiang Jianlong Sanitary Ware Co., Ltd. (Design Patent Infringement Dispute)

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SPC Guiding Case No. 85

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Keywords

Civil; infringement of design patent; design feature; functional feature; overall visual effect

Holding

1. The design features of an authorized design embody its innovative content that differs from the prior design, and also embody the designer's creative contribution to the prior design. If the alleged infringing design does not include all of the design features by which the authorized design differs from the prior design, it may generally be presumed that the alleged infringing design is not similar to the authorized design.

2. With respect to the determination of design features, the patentee shall bear the burden of proving the design features it asserts. The people's court, on the basis of hearing the cross-examination opinions of the parties, shall fully examine the evidence and determine the design features of the authorized design in accordance with the law.

3. The determination of a functional design feature depends on whether, in the view of the general consumer of the design product, the design is determined solely by a specific function, and it is unnecessary to consider whether the design has aesthetic appeal. A functional design feature does not have a significant impact on the overall visual effect of the design. With respect to a design feature that is both functional and decorative, the impact on the overall visual effect requires consideration of the strength of its decorative nature; the stronger the decorative nature, the greater the impact on the overall visual effect, and vice versa.

Basic Facts

Grohe AG (hereinafter "Grohe Company") was the holder of the design patent for "Handheld Shower Head (No. A4284410X2)," and the design patent was lawful and valid. In November 2012, Grohe Company sued on the ground that the Liya series and other sanitary products produced, sold, and offered for sale by Zhejiang Jianlong Sanitary Ware Co., Ltd. (hereinafter "Jianlong Company") infringed its design patent right in the "Handheld Shower Head," requesting the court to order Jianlong Company to immediately cease the alleged infringing acts, destroy the stock of infringing products and the molds specially used to produce the infringing products, and compensate Grohe Company for economic losses of RMB 200,000. Upon comparison in the first-instance trial, the similarities between Jianlong Company's alleged infringing product and Grohe Company's design patent in question were: the two belong to the same category of products; viewed as a whole, both consist of a spray head and a handle; the shape of the water outlet surface of the alleged infringing product's head is the same as that of the patent in question, with water outlet holes distributed radially in a region that is round at both ends and rectangular in the middle, and with arc-shaped edges. The differences between the two were: 1. the periphery of the spray head of the alleged infringing product is an inclined surface, sloping from the back toward the water outlet, whereas the periphery of the spray head shown in the front view and left view of the patent in question is an arc surface; 2. the water outlet surface and the panel of the alleged infringing product's head are separated by only one line, whereas the water outlet surface and the panel of the patent in question's head are separated by a band formed by

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two lines; 3. the distribution of the water outlet holes on the head's water outlet surface of the alleged infringing product differs slightly from that of the patent in question; 4. the handle of the patent in question has a long oval switch design, which the alleged infringing product lacks; 5. although there is a certain oblique angle in the connection between the head and the handle of the patent in question, the angle is very small, almost a straight-line connection, whereas the oblique angle produced by the connection between the head and the handle of the alleged infringing product is relatively large; 6. from the bottom view of the patent in question, the bottom of the handle is circular, whereas the bottom of the alleged infringing product in bottom view is a curved-surface sector; the lower end of the handle of the patent in question is cylindrical, gradually contracting and flattening toward the connection with the head into a flat oval, whereas the lower end of the handle of the alleged infringing product is a sector-shaped column, and the transition toward the connection with the spray head is all sector-shaped column, with an arced protrusion in the middle section of the handle during the transition; 7. there is an arc-shaped decorative line at the bottom end of the handle of the alleged infringing product, connecting the bottom end of the handle with the back of the product, whereas the bottom end of the handle of the patent in question has no such design; and 8. the length ratio between the head and the handle of the patent in question differs somewhat from that of the alleged infringing product, and the arc surfaces at the connection between the head and the handle of the two also differ.

Judgment

On March 5, 2013, the Taizhou Intermediate People's Court of Zhejiang Province rendered Civil Judgment No. (2012) Zhe Tai Zhi Min Chu Zi No. 573, rejecting Grohe Company's claims. Grohe Company, dissatisfied, appealed. On September 27, 2013, the Zhejiang Higher People's Court rendered Civil Judgment No. (2013) Zhe Zhi Zhong Zi No. 255, ordering: 1. revocation of Civil Judgment No. (2012) Zhe Tai Zhi Min Chu Zi No. 573 of the Taizhou Intermediate People's Court of Zhejiang Province; 2. Jianlong Company shall immediately cease the acts of manufacturing, offering to sell, and selling products infringing Grohe Company's design patent right in the "Handheld Shower Head," and destroy the stock of infringing products; 3. Jianlong Company shall compensate Grohe Company for economic losses (including the reasonable expenses incurred by Grohe Company to stop the infringement) of RMB 100,000; and 4. rejection of Grohe Company's other claims. Jianlong Company, dissatisfied, filed a retrial application. On August 11, 2015, the Supreme People's Court rendered Civil Judgment No. (2015) Min Ti Zi No. 23, ordering: 1. revocation of the second-instance judgment; and 2. affirmance of the first-instance judgment.

Reasoning

The court in its effective judgment held that the focal issue of this case was whether the design of the alleged infringing product fell within the protection scope of the design patent right in question.

Article 59(2) of the Patent Law provides: "The protection scope of a design patent right shall be based on the design of the product shown in the drawings or photographs, and the brief description may be used to explain the design of the product shown in the drawings or photographs." Article 8 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Patent Infringement Dispute Cases (hereinafter the "Interpretation on Patent Infringement Dispute Cases") provides: "Where a design identical or similar to the authorized design is adopted on a product identical or similar in kind to the design patent product, the people's court shall determine that the alleged infringing design falls within the protection scope of the design patent right under Article 59(2) of the Patent Law"; and Article 10 provides: "The people's court shall judge whether designs are identical or similar based on the knowledge level and cognitive ability of the general consumer of the design patent product." In this case, the alleged infringing product and the design patent product in question were identical, both being shower head products. Therefore, the key issue of this case was whether, for the general consumer, the design of the alleged infringing product was identical or similar to the authorized design in question, which specifically involved the following four issues.

I. On the design features of the authorized design in question

The legislative purpose of the design patent system is to protect innovative industrial designs with aesthetic appeal. A design must have an identifiable innovative design that differs from the prior design in order to be granted patent authorization, and that innovative design is the design feature of the authorized design. Usually, the designer of a design innovates on the basis of the prior design. For an existing product, the design for which a patent is obtained will generally contain part of the content of the prior design while also containing design content that is neither identical nor similar to the prior design. It is this part of the design content that gives the authorized design its innovative character, thereby satisfying the substantive authorization condition under Article 23 of the Patent Law: it neither belongs to the prior design nor has a conflicting application, and is clearly distinguishable from the prior design or a combination of prior design features. The description of this part of the design content constitutes the design features of the authorized design, which embody the innovative content of the authorized design that differs from the prior design and also embody the designer's creative contribution to the prior design. Because of the existence of the design features, the general consumer can easily distinguish the authorized design from the prior design. Therefore, they have a significant impact on the overall visual effect of the design product. If the alleged infringing design does not include all of the design features by which the authorized design differs from the prior design, it may generally be presumed that the alleged infringing design is not similar to the authorized design.

With respect to the determination of design features, generally speaking, the patentee may record the design features in the brief description, or may make corresponding statements on the design features during the patent authorization, confirmation, or infringement procedures. Under the evidence rule of "he who asserts bears the burden of proof," the patentee shall bear the burden of proving the design features it asserts. In addition, the purpose of the authorization and confirmation procedures is to examine whether the design has patentability, and therefore the relevant records in the examination documents during that process are of important reference significance for determining the design features. Ideally, the authorization and confirmation of a design patent should determine the comparative design on the basis of a search of the entire prior design to evaluate its patentability. However, due to the limitations of search databases and the limited search capabilities of invalidation petitioners, the design features determined by the relevant examination documents during the authorization and confirmation procedures may not be derived on the basis of an exhaustive search of the entire prior design. Therefore, whether design features are proved by the patentee or determined through the records in the examination documents relevant to authorization and confirmation, if a third party raises an objection, it should be permitted to provide counter-evidence to overturn them. The people's court, on the basis of hearing the cross-examination opinions of the parties, shall fully examine the evidence and determine the design features of the authorized design in accordance with the law.

In this case, the patentee Grohe Company asserted that the track-shaped water outlet surface was a design feature of the authorized design in question, which Jianlong Company did not recognize. In this regard, the court in its effective judgment held: First, the authorized design in question had no brief description recording its design features. Grohe Company submitted 12 design patent documents for shower head products in the second-instance proceedings, of which 7 recorded publication dates earlier than the filing date of the patent in question, and the designs shown in their attached drawings all did not adopt a track-shaped water outlet surface. In the examination procedure for the invalidation request against the authorized design in question, the Patent Reexamination Board made Decision No. 17086, determining that the authorized design in question, compared with the closest comparative design evidence 1: "viewed from the overall shape, compared with the previously disclosed design, the shape of the spray head and the transitions of its surfaces, the design of the front water outlet area of the spray head, and the ratio of the spray head width to the handle diameter of the present patent have considerable differences, all of which are design contents that the general consumer easily pays attention to." That is, the decision determined that the design of the shape of the spray head's water outlet surface was one of the design features of the authorized design in

question. Second, although Jianlong Company did not recognize that the track-shaped water outlet surface was a design feature of the authorized design in question, it did not submit corresponding evidence in the first- and second-instance proceedings to prove that the track-shaped water outlet surface was a prior design. At the retrial review stage, Jianlong Company submitted the drawings of shower head design patent No. 200630113512.5 to prove that the track-shaped water outlet surface had already been disclosed by the prior design. Upon review, the publication date of that design patent was earlier than the filing date of the authorized design in question, and it could serve as a prior design of the authorized design in question. However, the water outlet surface shown in its front view and the reference view of the state of use was rectangular rather than arc-shaped at both ends, and its water outlet surface was not track-shaped. Therefore, Jianlong Company's retrial ground that the track-shaped water outlet surface was not a design feature of the authorized design in question was not supported by this court.

II. On the parts of the authorized design product in question that are easily directly observed in normal use

The determination of the parts of an authorized design product that are easily directly observed in normal use shall be made from the perspective of the general consumer, based on the use of the product, and by comprehensively considering the various states of use of the product. In this case, first, the authorized design in question was a design for a shower head product. A shower head product consists of a spray head and a handle, and the two occupy similar proportions of space in the overall product structure. A shower head product may be hand-held or hung on a wall for use. In its normal state of use, for the general consumer, the spray head, the handle, and their connection are all parts that are easily directly observed. Second, Decision No. 17086 determined that design evidence 2 of the earlier application adopted the same track-shaped water outlet surface as the authorized design in question, but based on the fact that the authorized design in question had an "integrated spray head and handle, with all surfaces of the spray head and its connection with the handle being arc surfaces and the spray head leaning forward, which differs considerably from the design of the earlier application, and the above differences are all design contents that the general consumer easily pays attention to," determined that the two were designs that were neither identical nor similar. It can thus be seen that the parts of a shower head product that are easily directly observed are not limited to the water outlet surface of its spray head head. When making a comprehensive judgment of the overall visual effect of a shower head product design, its spray head, handle, and their connection should all be considered as parts that are easily directly observed.

III. On whether the push button on the handle of the authorized design in question is a functional design feature

A functional design feature of a design refers to a feature that, in the view of the general consumer of the design product, is determined solely by the specific function that the product is intended to achieve, without considering aesthetic factors. Usually, when designing a product's appearance, the designer will simultaneously consider functional factors and aesthetic factors. On the premise of realizing the product's function, the product's appearance is improved in accordance with humanistic rules and principles; that is, the product must first realize its function, and then it must also have visual aesthetic appeal. As applied to a particular feature of a design, in most cases it is both functional and decorative, and the designer will choose, from among the various designs capable of realizing a specific function, the one it considers the most aesthetic. A design determined solely by a specific function exists only in a few special circumstances. Therefore, functional design features of a design include two types: one is the sole design for realizing a specific function; the other is one of several designs for realizing a specific function, but that design is determined solely by the specific function to be realized and is unrelated to the consideration of aesthetic factors. The determination of a functional design feature does not lie in whether the design lacks selectivity due to functional or technical constraints, but in whether, in the view of the general consumer of the design product, the design is determined solely by a specific function, without the need to consider whether the design has aesthetic appeal. Generally, a functional design feature does not have a significant impact on the

overall visual effect of the design; whereas the impact of a design feature that is both functional and decorative on the overall visual effect requires consideration of the strength of its decorative nature — the stronger the decorative nature, the relatively greater the impact on the overall visual effect, and vice versa.

In this case, one of the differences between the authorized design in question and the design of the alleged infringing product was that the latter lacked a track-shaped push button design that the former had at the handle position. The function of the push button is to control the water flow switch. Whether to provide a push button component is determined by whether the function of controlling the water flow switch needs to be realized on the shower head product. However, so long as a push button is provided at the handle position of the shower head, the shape of the push button can have multiple designs. When the general consumer sees the push button on the handle of the shower head, he or she will naturally pay attention to its decorative nature and consider whether the push button design is aesthetic, rather than merely considering whether the push button can realize the function of controlling the water flow switch. The designer of the authorized design in question chose to design the push button at the handle position in a track-like shape, the purpose of which was also to coordinate with the track-shaped water outlet surface and increase the overall aesthetic appeal of the product. Therefore, the second-instance judgment's determination that the push button in the authorized design in question was a functional design feature applied the law erroneously, and this court corrected it.

IV. On whether the design of the alleged infringing product and the authorized design in question are identical or similar

Article 11 of the Interpretation on Patent Infringement Dispute Cases provides that, when determining whether designs are identical or similar, a comprehensive judgment shall be made based on the design features of the authorized design and the alleged infringing design and the overall visual effect of the designs; design features determined mainly by technical function shall not be considered. Parts that are easily directly observed in normal use of the product, relative to other parts, and the design features by which the authorized design differs from the prior design, relative to other design features of the authorized design, generally have a greater impact on the overall visual effect of the design.

In this case, compared with the authorized design in question, the water outlet holes of the alleged infringing product's design were distributed in the track-shaped region on the front of the spray head. Although the number of water outlet holes and their distribution at both ends of the water outlet surface differed slightly from the authorized design in question, on the whole, the alleged infringing product adopted a track-shaped water outlet surface design highly similar to the authorized design in question. With respect to the differing design features between the two, the court of first instance summarized eight aspects, which neither party disputed. As to these differing design features, first, as described above, Decision No. 17086 determined that the design features of the design patent in question were threefold: first, the shape of the spray head and the transitions of its surfaces; second, the shape of the spray head's water outlet surface; and third, the ratio of the spray head width to the handle diameter. Apart from the design feature of the shape of the spray head's water outlet surface, the design features of the shape of the spray head and the transitions of its surfaces, and the ratio of the spray head width to the handle diameter, also have a significant impact on the overall visual effect of the product. Although the alleged infringing product's design adopted a track-shaped water outlet surface highly similar to the authorized design in question, with respect to the design feature of the shape of the spray head and the transitions of its surfaces, the spray head, handle, and their connecting surfaces of the authorized design in question all have arc transitions, whereas the spray head, handle, and their connecting surfaces of the alleged infringing product's design all have inclined-surface transitions, thus giving the two an obvious difference in overall design style. In addition, with respect to the differing design features of the alleged infringing product's design compared with the authorized design in question that are outside the design features, they shall also be considered so long as they are sufficient to produce an obvious difference in the overall visual effect of the two. Second, the spray head, handle, and their

connection of a shower head product are all parts that are easily directly observed in normal use, and when making a comprehensive judgment of the overall visual effect, the designs at those parts shall be examined with emphasis. Specifically, the handle of the authorized design in question has a track-shaped push button, whereas the alleged infringing product has no such design; because the push button is not a functional design feature, the presence or absence of the push button, as a differing design feature, will affect the overall visual effect of the product. The oblique angle produced by the connection between the spray head and the handle of the authorized design in question is relatively small, whereas the oblique angle produced by the connection between the spray head and the handle of the alleged infringing product is relatively large, thus making the two present an obvious difference in the left view. It was precisely because the alleged infringing product's design did not include all of the design features of the authorized design in question, and because of the differing design features between the alleged infringing product's design and the authorized design in question at the handle and the connection between the spray head and the handle, that the two presented an obvious difference in overall visual effect; the two were neither identical nor similar, and the alleged infringing product's design did not fall within the protection scope of the design patent right in question. The second-instance judgment considered only, with emphasis, the design feature of the track-shaped water outlet surface of the authorized design in question, but did not consider the other design features of the authorized design in question, or the differing design features between the alleged infringing product's design and the design patent in question at other parts of the shower head product that are easily directly observed in normal use, and determined that the two were similar, which applied the law erroneously; this court corrected it.

In summary, the design of the alleged infringing product produced, offered for sale, and sold by Jianlong Company and the authorized design in question owned by Grohe Company were neither identical nor similar, and did not fall within the protection scope of the design patent right in question. Jianlong Company's acts of producing, offering for sale, and selling the alleged infringing product did not constitute infringement of Grohe Company's patent right in question. The second-instance judgment applied the law erroneously, and this court corrected it in accordance with the law.

(Judges of the effective judgment: Zhou Xiang, Wu Rong, Song Shuhua)

Relevant Legal Provisions

Article 59(2) of the Patent Law of the People's Republic of China

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