

Date	November 11, 2015	Court	Tokyo District Court, 29th Civil Division
Case number	2014 (Wa) 25645		
– A case in which the court dismissed the plaintiff's claim, holding that the defendant's disaster kit roller bag is not an imitation in configuration of the plaintiff's goods and it does not create confusion.			

### Summary of the Judgment

In this case, the plaintiff alleged against the defendant: [i] primarily that the disaster kit roller bag sold by the defendant (the "defendant's goods") is an imitation in configuration of the disaster kit roller bag sold by the plaintiff (product name: EX. 48 Survival Roller Bag Power Grand; the "plaintiff's goods") and the sale of the defendant's goods by the defendant constitutes an act of unfair competition under Article 2, paragraph (1), item (iii) of the Unfair Competition Prevention Act; and [ii] alternatively, that while the configuration of the plaintiff's goods had become well-known among consumers as an indication of goods or business of the plaintiff by around November 2013, at the latest, the configuration of the defendant's goods is similar to the configuration of the plaintiff's goods and creates confusion with the plaintiff's goods, and hence the sale of the defendant's goods constitutes an act of unfair competition under item (i) of said paragraph. Based on these allegations, the plaintiff sought against the defendant payment of damages with delay damages accrued thereon under Article 5, paragraph (2) of said Act with regard to the sale of the defendant's goods during the eight-month period from November 2013 to June 2014. The plaintiff also alleged that assigning and otherwise handling the defendant's goods constitutes an act of unfair competition under Article 2, paragraph (1), item (i) of said Act and sought an injunction against such acts and demanded the destruction of the defendant's goods under Article 3 of said Act.

The court held as follows. Whether the configuration of goods is "substantially identical" to the configuration of other goods, as referred to in Article 2, paragraph (1), items (iii), (iv) and (v) of said Act, "should be determined in consideration of the comparison in terms of the field of the same kind of goods or the characteristics in shape of the same kind of goods that consumers of the goods in question can perceive when using the goods in a normal way." The commonality in configuration between the plaintiff's goods and the defendant's goods can be regarded as a commonplace configuration or a configuration indispensable for the function of a disaster kit bag. As long as there is a distinctive difference between them in terms of the size, material and sewing condition of the container part of the bag, which are the characteristics in shape

that consumers can perceive when using the goods in a normal way, the configuration of the plaintiff's goods and that of the defendant's goods cannot be deemed to be substantially identical to each other, even if they have a commonality in terms of all the other features when combined together. Furthermore, the court stated as follows. It is appropriate to construe that the configuration of the goods itself would acquire a secondary meaning to indicate a specific source and be regarded as an "indication of goods or business" as referred to in Article 2, paragraph (1), item (i) of said Act if the following two conditions are met: "[i] the configuration of the goods has distinctive features that are objectively different from that of other goods of the same kind (special distinctiveness), and [ii] the configuration of the goods has become well-known among consumers as an indication meaning that the goods carrying the configuration are produced by a specific business operator, as a result of being used exclusively by the specific business operator for a long period of time or being advertised very intensively or enjoying great sales." Even if the parts of the plaintiff's goods that are claimed to be the characteristic configuration of the goods have a commonality with the configuration of the defendant's goods, these parts are components necessary for a disaster kit bag or components that are found in other goods of the same kind or a combination of these components. Thus, the configuration of the plaintiff's goods cannot be deemed to be a distinctive feature that is objectively different from that of other goods of the same kind, and hence it cannot be regarded as an "indication of goods or business." Even if there is room to recognize special distinctiveness, it is difficult to accept the plaintiff's allegation that the configuration of the plaintiff's goods has become well-known. Finally, the court concluded that the plaintiff's claim cannot be upheld based on any of its allegations.