

Date	April 20, 2004	Court	Osaka District Court 21st Civil Division
Case number	2002 (Wa) 13569, 2003 (Wa) 2226		
<p>– A case in which the court found that the trademark consisting of the characters "Career-Japan" is similar to both the mark consisting of the characters "DISCO CAREER JAPAN.JP" and the mark consisting of the characters "DISCO Career Japan.jp".</p> <p>– A case in which the court found that the services of "advertising agency services using a computer communication network and advertising copy writing" are similar to the services of "providing employment information".</p>			

References: Articles 25, 36, and 37 of the Trademark Act

Summary of the Judgment

1. In Case 1, the plaintiff, who is the holder of the trademark right for the trademark consisting of the characters "Career-Japan" (the "plaintiff's trademark"), alleged that the act of the defendant of using the marks including "DISCO CAREER JAPAN.JP" ("defendant's mark 2") and "DISCO Career Japan.jp" ("defendant's mark 3") on its website infringes the plaintiff's trademark right. Based on this allegation, the plaintiff sought against the defendant compensation for damages and an injunction against the use of said marks. There is no dispute between the parties with regard to the facts that the services designated for the plaintiff's trademark are "advertising agency services using a computer network and advertising copy writing" and that the defendant uses defendant's marks 2 and 3 for its services of providing employment information.

In Case 2, the defendant, who is the holder of the trademark right for the trademark consisting of characters "CAREER JAPAN" (the "defendant's trademark"), alleged that the plaintiff's act of using the mark created by arranging the characters "Career-Japan" (the "plaintiff's mark") on its website infringes the defendant's trademark right. Based on this allegation, the defendant sought against the plaintiff compensation for damages and an injunction against the use of said mark.

2. Although the part of "DISCO" in defendant's marks 2 and 3 can be regarded as being distinctive as a word, it cannot be found that consumers of the relevant services, i.e., the provision of such information as job descriptions and the details of business of companies seeking workers, broadly recognized said part as an indication of the defendant. Moreover, as the characters "DISCO" have no connection with the characters "CAREER JAPAN" or "Career Japan" in terms of their meanings, it cannot be said either that the combination of these characters as a whole gives rise to a certain

concept. In addition, it is found that the part of "CAREER JAPAN" or "Career Japan" can be seen as an independent group from the part of "DISCO" in terms of appearance. Furthermore, it is presumed that there is a clear possibility that consumers focus on the words "CAREER JAPAN" or "Career Japan", which suggest the provision of such information as job opportunities and the details of the business of the companies seeking workers, rather than the entirety of the mark consisting of characters "DISCO CAREER JAPAN.JP" or "DISCO Career Japan.jp", which may be a little lengthy to pronounce at one time.

According to the above findings, whether the plaintiff's trademark and defendant's mark 2 or 3 are similar to each other should be determined based on the appearance, pronunciation or concept concerning the plaintiff's trademark "Career-Japan" and the essential feature of defendant's mark 2, "CAREER JAPAN", or that of defendant's mark 3, "Career Japan". Since the only differences between them are whether only initial characters are capitalized or all characters are capitalized and whether a hyphen is inserted in between or not, the defendant's marks 2 and 3 are found to be similar to the Plaintiff's Trademark in all of appearance, pronunciation and concept.

3. Whether services provided by one person and those provided by another person are similar to each other should be determined based on whether there is a risk, when said identical or similar trademarks are used for both services, of misleading traders or consumers of said services to believe that said services are provided by the same service provider. In this process of determining the similarity of services, the actual situation of transactions must be included in the consideration. When examining this case in this regard, it is found that the defendant compiles and edits job information, including the name of companies seeking employees, their location, salary, working hours and job descriptions, and other information, such as companies' corporate philosophy and the purpose of their activities, vision for the future, and employment trends conforming thereto, into a structure that may attract interest and attention of viewers. The defendant provides such information using a computer communication network called the Internet by putting said information in a situation where anyone can browse it. In addition, there are cases where a single company engages in such businesses as the provision of employment information, advertising and advertising agency services. The defendant itself is also providing advertising agency services as part of its business.

Accordingly, the services that the defendant provides on the defendant's website are found to be identical or similar to advertising agency services in terms of the methods, purposes or places of the provision of services, articles related to the

provision of services, the scope of consumers, and the category of business.
(In Case 2, the court found that the plaintiff holds a prior user's right for the plaintiff's mark (Article 32 of the Trademark Act) and dismissed the defendant's claim.)

Judgment rendered on April 20, 2004

2002 (Wa) 13569, Case of Seeking Injunction against Trademark Infringement, etc.
(Case 1)

2003 (Wa) 2226, Case of Seeking Injunction against Trademark Infringement (Case 2)

Date of conclusion of oral argument: March 30, 2004

Judgment

Case 1 Plaintiff and Case 2 Defendant: Gakujo Co., Ltd.

Case 1 Defendant and Case 2 Plaintiff: DISCO Inc.

Main text

1. Case 1 Defendant shall not use the marks described in the Lists of Marks 2 and 3 attached to this judgment for services that Case 1 Defendant provides on its website as described in the List of Website attached to this judgment.

2. Case 1 Defendant shall pay, to Case 1 Plaintiff, 618,318 yen and the amount accrued thereon at the rate of 5% per annum for the period from October 21, 2003, to the date of completion of the payment.

3. All the other claims made by Case 1 Plaintiff shall be dismissed.

4. All the claims made by Case 2 Plaintiff shall be dismissed.

5. The total court costs of Case 1 and Case 2 shall be divided into three, and Case 1 Plaintiff (Case 2 Defendant) shall bear one-third thereof and Case 1 Defendant (Case 2 Plaintiff) shall bear the remaining amount.

6. Only paragraph 2 of this judgment may be provisionally executed.

Facts and reasons

No.1 Claims

1. Case 1

(1) The defendant shall not use the marks described in the Lists of Marks 1 to 3 attached to this judgment for services that the defendant provides on its website as described in the List of Website attached to this judgment.

(2) The defendant shall pay to the plaintiff 2,000,000 yen and the amount accrued thereon at the rate of 5% per annum for the period from October 21, 2003 (the day following the last day of the period of sales calculation), to the date of completion of the payment.

2. Case 2

(1) The defendant shall not use the mark described in the List of Mark 4 attached to this judgment for the services to provide employment information that the defendant provides.

(2) The defendant shall pay to the plaintiff 11,694,375 yen and the amount accrued thereon at the rate of 5% per annum for the period from December 27, 2003 (the day following the date of delivery of the written petition to amend the claim dated December 26, 2003), to the date of completion of the payment.

No. 2 Outline of the case

1. In Case 1, Case 1 Plaintiff (Case 2 Defendant) (hereinafter referred to as the "Plaintiff"), who is the holder of the trademark right described in the List of Trademark 1 attached to this judgment (the "Plaintiff's Trademark Right"), alleged that the act of Case 1 Defendant (Case 2 Plaintiff) (hereinafter referred to as the "Defendant") of using the marks described in the Lists of Marks 1 to 3 attached to this judgment on its website infringes the Plaintiff's Trademark Right. Based on this allegation, the Plaintiff sought against the Defendant compensation for damages and an injunction against the use of said marks based on Article 36, paragraph (1) of the Trademark Act.

In Case 2, the Defendant, who is the holder of the trademark right described in the List of Trademark 2 attached to this judgment (the "Defendant's Trademark Right"), alleged that the Plaintiff's act of using the mark described in the List of Mark 4 attached to this judgment on its website infringes the Defendant's Trademark Right. Based on this allegation, the Defendant sought against the Plaintiff compensation for damages and an injunction against the use of said mark based on Article 36, paragraph (1) of the Trademark Act.

2. Undisputed facts, etc.

(1) Parties

A. The Plaintiff is a stock company engaging in the planning and production of advertisement and promotional items, paid employment placement services, publication of employment information magazines, services to collect and process various kinds of information, undertaking of human resources training on the management or sales activities of companies, planning, implementation, direction and management of various types of events, labor and management consulting services, general worker and specified worker dispatching undertakings under the Act for Securing the Proper

Operation of Worker Dispatching Undertakings and Improved Working Conditions for Dispatched Workers, education and training consulting services for the purpose of developing companies' human resources, job counseling, etc.

B. The Defendant is a stock company engaging in the publication and sale of books, contracted or entrusted book publications, contracted or entrusted industrial education planning, planning and undertaking of domestic and overseas training for the purpose of cultivating students and adults in general, advertising agency services focused on employment information from companies, advertising agency services focused on student recruitment information from higher education institutions, including universities, businesses related to staffing and recruiting, etc.

(2) Trademark rights

A. The Plaintiff holds the trademark right described in the List of Trademark 1 attached to this judgment (hereinafter referred to as the "Plaintiff's Trademark Right"; the registered trademark pertaining thereto is referred to as the "Plaintiff's Trademark" hereinafter).

B. The Defendant holds the trademark right described in the List of Trademark 2 attached to this judgment (hereinafter referred to as the "Defendant's Trademark Right"; the registered trademark pertaining thereto is referred to as the "Defendant's Trademark" hereinafter).

(3) Similarity of trademarks

The mark described in the List of Mark 1 attached to this judgment (hereinafter referred to as the "Defendant's Mark 1") is similar to the Plaintiff's Trademark. In addition, the mark described in the List of Mark 4 attached to this judgment (hereinafter referred to as the "Plaintiff's Mark") is similar to the Defendant's Trademark.

(4) Manners of acts

A. Plaintiff's acts

The Plaintiff registered a URL with the domain name "CAREER-JAPAN.CO.JP" on January 25, 1999 (Exhibit Ko 28-1) and filed an application for trademark registration regarding the Plaintiff's Trademark on March 19, 1999. The Plaintiff launched the employment information website "Career-Japan" (<http://www.career-japan.co.jp>) (hereinafter referred to as the "Plaintiff's Website") in April 1999 and has since then been providing employment information on it. The Plaintiff has been using the Plaintiff's Mark on the Plaintiff's Website.

B. Defendant's acts

The Defendant launched the information website "DISCO CAREER JAPAN.JP" (<https://www.disco-careerjapan.jp>) (hereinafter referred to as the "Defendant's Website") in May 2002. On the Defendant's Website, the Defendant used the Defendant's Mark 1 until March 2003 (however, the Defendant asserts that it was not used as a trademark) and has been using the mark described in the List of Mark 2 attached to this judgment (hereinafter referred to as the "Defendant's Mark 2") since July 2002 and also the mark described in the List of Mark 3 attached to this judgment (hereinafter referred to as the "Defendant's Mark 3") since March 5, 2003 (the Defendant's Marks 1 to 3 are collectively referred to as the "Defendant's Marks" hereinafter).

3. Issues

(1) Regarding Case 1

- A. Whether the Defendant was using the Defendant's Mark 1 as a trademark
- B. Whether the Defendant's Marks 2 and 3 are similar to the Plaintiff's Trademark
- C. Whether the acts the Defendant conducts on the Defendant's Website are similar to the designated services of the Plaintiff's Trademark
- D. Damages to the Plaintiff

(2) Regarding Case 2

- A. Whether the Defendant's Trademark Right has any ground for invalidation
 - (A) Article 4, paragraph (1), item (xi) of the Trademark Act
 - (B) Article 4, paragraph (1), item (x) of the Trademark Act
- B. Whether the exercise of rights based on the Defendant's Trademark Right constitutes an abuse of rights on the grounds that it was conducted by a holder of trademark right for a registered trademark in bad faith or with malice against a prior user
- C. Whether a prior user's right can be recognized with respect to the Plaintiff
- D. Damages to the Defendant

(omitted)

No. 4 Court decisions on the issues

- 1. Regarding Issue (1)A (whether the Defendant was using the Defendant's Mark 1 as a trademark)

(1) As stated in No. 2-2(4)B above, the Defendant launched the Defendant's Website in May 2002 and since then had been using the Defendant's Mark 1 until March 2003 on said website. The Defendant asserts that the Defendant's Mark 1 was used as a domain name and it was not used as a trademark. However, according to the evidence (Exhibit Ko 3) and the entire import of the oral argument, it is found that the Defendant posted a statement saying, "Careerjapan.jp supports foreigners wanting to work in Japan", on the Defendant's Website. It is also found that the Defendant's Website has provided services targeted mainly at foreign students, including the provision of such information as job information, and activities, vision for the future and employment trends of the companies seeking workers. Accordingly, with respect to the manner of use of the Defendant's Mark 1 as explained above, it is found that said mark was not only used as a domain name, but it was also used as a sign to distinguish the Defendant's services from those of others. Therefore, it should be said that the Defendant was using the Defendant's Mark 1 as a trademark on the Defendant's Website.

(2) There is a consensus between the parties about the fact that the Defendant has not used the Defendant's Mark 1 since April 2003 and neither party made any allegation or proof for any fact that shows that there is a risk that the Defendant may use the Defendant's Mark 1 again in the future.

2. Regarding Issue (1)B (whether the Defendant's Marks 2 and 3 are similar to the Plaintiff's Trademark)

(1) The Plaintiff's Trademark is a mark consisting of characters "Career-Japan", which is composed of a combination of horizontally written uppercase and lowercase alphabet characters and a hyphen inserted in between. On the other hand, the Defendant's Mark 2 is a mark consisting of horizontally written uppercase alphabet characters "DISCO CAREER JAPAN.JP" and the Defendant's Mark 3 is a mark consisting of characters "DISCO Career Japan.jp", which is composed of a combination of horizontally written uppercase and lowercase alphabet characters.

(2) When the Plaintiff's Trademark is compared to the Defendant's Marks 2 and 3, the Plaintiff's Trademark firstly gives a rise to the pronunciation "kyaria japan". It is construed that they also give rise to a concept that they are coined words created by combining the word "career" meaning "personal background or occupation" and the word "Japan" as a country name. It is found that a person who comes across it would associate them with something related to "personal background or occupation", such as

advertisements concerning employment and job information, based on the relationship between the fact that they use the word "career" and the designated services of the Plaintiff's Trademark Right.

On the other hand, the characters ".jp" included in the Defendant's Marks 2 and 3 are commonly used to indicate a top-level domain and thus they are not distinctive. With these characters excluded for this reason, the Defendant's Mark 2 "DISCO CAREER JAPAN" and Defendant's Mark 3 "DISCO Career Japan" are, when they are respectively examined as a whole, found to be different from the Plaintiff's Trademark in appearance in that they both have the characters "DISCO" at the beginning and that they give rise to the pronunciation "disuko kyaria japan".

(3) Meanwhile, when a trademark consisting of characters, which are a combination of two or more words, is found to be integrated as a whole and said trademark as a whole gives rise to a certain appearance, pronunciation or concept, it is impossible to determine whether said trademark is similar to another trademark by separating said trademark into parts and looking at their essential features. However, when the entire structure of such a trademark does not give rise to any certain appearance, pronunciation or concept, or when there are disparities in the level of distinctiveness among the words or a part of the words gives especially strong impression to consumers, the similarity between trademarks should be determined by separating or extracting a part that should be said to be an essential feature and examining the appearance, pronunciation or concept thereof.

In this regard, not only is it found that "DISCO" indicates the Defendant's company name in alphabet characters, but it is also found that, according to the evidence (Exhibit Ko 6), the Defendant filed an application for trademark registration on April 18, 2001, for a mark consisting of horizontally written uppercase alphabet characters "DISCO" and another mark consisting of horizontally written katakana characters "ディスコ", designating the services "the provision of employment information; personal consultation concerning employment and reemployment; personal consultation for pupils and students concerning their lives, study, examination, career and employment; and implementation and evaluation of vocational aptitude tests", and said marks were registered as trademarks on August 30, 2002. Therefore, it can be said that the part of "DISCO" is distinctive as a word. However, there is no sufficient evidence to find that consumers of the relevant services, i.e., the provision of such information as job

descriptions and the details of business of companies seeking workers, were recognizing the mark consisting of characters "DISCO" as an indication of the Defendant. Moreover, as the characters "DISCO" have no connection with the characters "CAREER JAPAN" or "Career Japan" in terms of their meanings, it cannot be said either that the combination of these characters as a whole gives rise to a certain concept. In addition, while the Defendant's Marks 2 and 3 spell all of the characters "DISCO" in uppercase, in the parts of "CAREER JAPAN" (Defendant's Mark 2) and "Career Japan" (Defendant's Mark 3), larger characters are used for "C" and "J" than for the remaining characters (Defendant's mark 2) or the character "C" of "Career" and the character "J" of "Japan" are written in uppercase and the rest is written in lowercase (Defendant's Mark 3). Based on these facts, it is found that the part of "CAREER JAPAN" or "Career Japan" can be seen as an independent group from the part of "DISCO" in terms of appearance. Furthermore, in the light of the content of the services that the Defendant provides on the Defendant's Website, it is presumed that there is a clear possibility that consumers focus on the words "CAREER JAPAN" or "Career Japan", which suggest the provision of such information as job opportunities and the details of the business of the companies seeking workers, rather than the entirety of the mark consisting of characters "DISCO CAREER JAPAN.JP" or "DISCO Career Japan.jp", which may be a little lengthy to pronounce at one time.

According to the above findings, whether the Plaintiff's Trademark and Defendant's Mark 2 or 3 are similar to each other should be determined based on the appearance, pronunciation or concept concerning the Plaintiff's Trademark "Career-Japan" and the essential feature of the Defendant's Mark 2, "CAREER JAPAN", or that of the Defendant's Mark 3, "Career Japan". Since the only differences between them are whether only initial characters are capitalized or all characters are capitalized and whether a hyphen is inserted in between or not, the Defendant's Marks 2 and 3 are found to be similar to the Plaintiff's Trademark in all of appearance, pronunciation and concept.

(4) The Defendant asserts that there is no risk of causing confusion among consumers regarding the source as long as the characters "DISCO", or what is called a house mark, is included. However, there is no evidence to prove that the mark consisting of characters "DISCO" was widely recognized as an indication of the Defendant among consumers of the relevant services, i.e., the provision of such information as job

descriptions and the details of business of companies seeking workers. Therefore, even if the characters "DISCO" are included as the Defendant's house mark, it is not found that this part particularly attracts consumers' attention and thus it cannot be said that there is no risk of causing confusion among consumers regarding the source just because said house mark is included. The Defendant's allegation is not acceptable.

3. Regarding Issue (1)C (whether the acts the Defendant conducts on the Defendant's Website are similar to the designated services of the Plaintiff's Trademark)

(1) There is a consensus between the parties about the fact that the Defendant provides services to provide employment information, using the Defendant's Marks 2 and 3 on the Defendant's Website. In addition, as found in 1 above, the Defendant was using the Defendant's Mark 1 on the Defendant's Website as a trademark until March 2003. The designated services of the Plaintiff's Trademark are "advertising agency services using a computer network and advertising copy writing" (No.2-2(2)A as stated above). In general, advertisement refers to activities to widely announce goods, services, information, etc. to third parties, clarifying their providers, and induce said third parties to acquire said announced matters. Advertising agency services are construed as services where a third party conducts said activities on behalf of an advertiser.

The Plaintiff asserts that the Defendant's business is identical or similar to the designated services of the Plaintiff's Trademark, as the Defendant is engaging not only in the services to provide employment information using the Defendant's Marks on the Defendant's Website, but also in advertising business. The court examines this point as follows.

(2) Based on an comprehensive evaluation of the facts stated in No.2-2 as stated above (undisputed facts, etc.) and the evidence (Exhibits Ko 8 to 10, 15 to 20, 22, 23, 29, 93 and 94, Exhibits Otsu 9, 11 and 19 [when all branch numbers are included, the indication of such numbers is omitted; the same applies hereinafter]).

A. The top page of the Defendant's Website shows such items as "job hunting/career change", "employment" and "about DISCO Inc.".

Job seekers can obtain and use information on the Defendant's Website for free after taking the sign-up procedures, which are also free.

Companies that are seeking employees can post their information on the Defendant's Website by requesting the Defendant to do so.

B. On the "job hunting/career change" page on the Defendant's Website, there is a page

that shows a list of company name, category of business, job title, working place and online application concerning companies that are seeking employees.

From this page, users can move to other pages where information concerning individual companies is posted respectively. On such page, the information of an individual company is provided regarding various items, such as "company name", "category of business", and "introduction to the company" in the "company information" column, "date of foundation", "capital", "address of the main office and branch offices", "number of employees", etc. in the "group information" column, "job type", "working place", "salary", "job description", "screening method", etc. in the "job information" column, and "qualification", "status of candidates", "subject job types", "years of experience", "major field of study", "academic degree", "language skills", etc. in the "employment criteria" column.

Among these items, the item "introduction to the company" in the "company information" column includes descriptions that are beyond the scope of employment criteria, such as the company's vision for the future, goals and employment trends based thereon, saying, for example, "your field of career will broaden wider and wider as we expand our business for the future" and "we aspire to become the world's top MT specialist manufacturer by acquiring the European and developing countries' markets in addition to the domestic and North American markets".

C. On the "employment" page on the Defendant's Website, under a caption saying "Employing foreign workers", names of seven companies are listed under the title of "HR Talk: Interviews with Companies that Employ Foreign Workers".

Each page for individual companies begins with a phrase excerpted from the interview, saying, for example, "Aspiring to be No. 1 in East Asia", which is followed by a brief introduction to the company, saying, for example, "the company has launched a series of chemical products onto the market" and an introductory part, saying as follows for example: "As some products are maturing in overseas markets, China - a developing billion-people market- can be a trigger to explosive product sales. Under the slogan, 'a company that conquers this market will conquer the 21st century,' the company has been steadily recruiting talented foreign workers. Workers specialized in marketing are exactly what they are looking for. The aim of the personnel manager is also very clear and logical". After this part, the details and records of recruitment, company performance, business goals, trends in recruitment of foreign workers, etc. are

described in the form of an interview article between a personnel manager and an interviewer.

D. The Defendant's business includes the handling of advertisements of mid-career employment and various agency services (Exhibit Ko 15). In addition, the Defendant is categorized in the "advertising agencies", among the categories in the ranking of declared income of juridical persons, which include "advertising agencies", "promotional production services", "information processing and software", and "information services and others" (Exhibits Ko 19 and 20).

E. It is sometimes pointed out that it is important to conduct public relations activities that create companies' images and improve job seekers' understanding of companies in order to secure human resources in an efficient manner, especially when recruiting students. It is stated that such public relations activities refer to the ones that clarify the purpose of the company's current activities, vision for the future, contributions to society and corporate philosophy, while specifying the types of workers the company is looking for. It is also stated that, in the preparation of such public relations tools, "there are many advantages in having a good relationship with a competent employment information company that has ideas and expertise" and that employment information companies "can see a company objectively and discover new attractive aspects of the company with a fresh eye" and they "are able to develop recruitment tools based on the values of modern students, as they have various expression techniques" (Exhibit Ko 29).

F. Conventionally, newspapers have columns called "recruitment advertising" or "job advertising", which describe the name of recruiting companies, contact points, job titles, working conditions, etc., sometimes all written in the same characters, sometimes with some parts stressed by changing the size or thickness of characters or with phrases to solicit consumers (Exhibits Ko 9 and 10).

G. There are cases where a single company undertakes both advertising or advertising agency services and services to provide employment information (a publicly-known fact).

(3) In order to say that the use of a trademark for certain services constitutes an infringement of a trademark right, said trademark needs to be used for services that are identical or similar to the designated services of a registered trademark (see Article 25 and Article 37, item (i) of the Trademark Act). It is relevant to construe that whether services are similar to each other should be determined based on whether there is a risk,

when said identical or similar trademarks are used for both services, of misleading traders or consumers of said services to understand said services are provided by the same service provider. In this process of determining the similarity of services, the actual situation of transactions must be included in consideration. More specifically, a comprehensive evaluation must be conducted regarding such matters as whether these services are identical in terms of the methods, purposes or places of the provision of services, articles related to the provision of services, the scope of consumers, and the category of business.

Meanwhile, when filing an application for trademark registration, an applicant must submit a written application stating the designated goods or designated services and the class of goods or services prescribed in Cabinet Order (Article 5, paragraph (1) of the Trademark Act). In addition, an application for trademark registration must be filed for each trademark and designate one or more goods or services in connection with which the trademark is to be used (Article 6, paragraph (1) of the same Act). Said designation must be made in accordance with the class of goods and services prescribed in Cabinet Order (Article 6, paragraph (2) of the same Act). Pursuant to the above provisions of the Trademark Act, the Order for Enforcement of the Trademark Act stipulates the class of goods and services (Article 1 and the Appended Table of the same Order) and the Ordinance for Enforcement of the Trademark Act stipulates the goods and services that fall under the class of goods and services prescribed in the same Order (Article 6 and the Appended Table of the same Ordinance). The class of goods and services prescribed in the Order for Enforcement of the Trademark Act and allotment of goods and services to individual classes prescribed in the Ordinance for Enforcement of the Trademark Act should be referred to when determining the similarity between goods and services, but they should not be perceived as prescribing the scope of similarities of goods or services (Article 6, paragraph (3) of the same Act).

(4) The Defendant alleges that advertisement materials as prescribed in the Trademark Act refer to the materials provided by a third party on behalf of an advertiser, while clarifying the advertiser, for the purpose of announcing or appealing the advertiser's goods, services, ideas, etc. to consumers, without involving any other party in between; on the other hand, the provision of employment information is intended for conducting activities for another person, that is, a company seeking employees, without involving any other party in between, to announce that said company is recruiting employees to

job seekers and solicit them, while clarifying the company seeking employees. Based on the above, the Defendant further alleged that advertising and provision of employment information target completely different groups of consumers. According to Japanese dictionaries, the word "advertising" is defined as "to announce widely to the public; especially, to inform many people of a product or industrial goods with an aim to solicit customers" (Kojien [fifth edition]) and as "[i] to announce widely to the public; [ii] to promote a product using paid media in order to attract people's attention and convince them to buy it; also, documents and articles used for this purpose". In light of the fact that this word is generally used with the meaning of promoting goods for the purpose of soliciting consumers to buy them, it cannot be denied that there is a difference from the "provision of employment information" as alleged by the Defendant. It is considered that it was a result of taking this point into consideration that the Defendant's Trademark Right was registered despite the existence of the Plaintiff's Trademark Right, for which an application was filed at an earlier date.

However, when determining the similarity between services in connection with whether there was an infringement of a trademark right, the actual situation of specific transactions should be taken into account. When examining this case in this regard, according to the facts recognized in (2) above, it is found that the Defendant compiles and edits job information, including the name of companies seeking employees, their location, salary, working hours and job descriptions, and other information, such as companies' corporate philosophy and the purpose of their activities, vision for the future, and employment trends conforming thereto, into a structure that may attract interest and attention. It is also found that the Defendant provides such information using a computer communication network called the Internet by putting said information in a situation where anyone can browse it. In addition, there are cases where a single company engages in such businesses as the provision of employment information, advertising and advertising agency services. The Defendant itself is also providing advertising agency services as part of its business (under the class of services prescribed in the Order for Enforcement of the Trademark Act and the Ordinance for Enforcement of the Trademark Act, the "provision of employment information" used to be categorized into Class 42, along with the provision of meteorological information, but then it was moved to Class 35, to which "advertising" also belongs, as a result of the amendment in 2001; it is found that this also reflects that these two are in a close

relationship today).

Accordingly, the services that the Defendant provides on the Defendant's Website are found to be identical or similar to advertising agency services in terms of the methods, purposes or places of the provision of services, articles related to the provision of services (information, in this case), the scope of consumers, and the category of business.

As stated above, the Defendant had the Defendant's Trademark Right registered. However, since its designated services are "the provision of employment information and employment agencies" etc. and they do not include "advertising agency services using a computer network", the fact that the Defendant's Trademark Right was registered as stated above cannot be an obstacle to the determination that said services that the Defendant provides are similar to the designated services of the Plaintiff's Trademark Right.

(omitted)

7. Therefore, the court upholds the claims made by the Plaintiff regarding Case 1 as they fall within the limit of the descriptions of paragraphs 1 and 2 of the main text, while dismissing the rest of the claims as they lack a ground. With respect to Case 2, the court dismisses all of the claims made by the Defendant (the plaintiff in Case 2) as they lack a ground. Applying Articles 61 and 64 of the Code of Civil Procedure with respect to court costs and Article 259, paragraph (1) of the same Code with respect to declaration of provisional execution, respectively (however, the declaration of provisional execution is not applied to paragraph 1 of the main text as it is not found to be appropriate), the judgment shall be rendered in the form of the main text.

Osaka District Court, 21st Civil Division

Presiding judge: KOMATSU Kazuo

Judge: NAKADAIRA Ken

Judge: OHAMA Kazumi

(Attachment) List of Website

<https://www.disco-careerjapan.jp>

(Attachment) List of Mark 1

Careerjapan.jp

(Attachment) List of Mark 2

DISCO CAREER JAPAN.JP

(Attachment) List of Mark 3

DISCO CareerJapan.jp

(Attachment) List of Mark 4

Career-Japan

(Attachment) List of Trademark 1

Registration number: No. 4409084

Filing date: March 19, 1999

Registration date: August 18, 2000

Class of goods: Class 35

Designated goods: Advertising agency services using a computer network; advertising copy writing

Registered trademark:

Career-Japan

(Attachment) List of Trademark 2

Registration number: No. 4641861

Filing date: July 2, 2002

Registration date: January 31, 2003

Class of goods: Classes 16 and 35

Designated goods: Magazines (Class 16)

Provision of employment information; employment agency services; provision of employment information and employment agency services using a computer network (Class 35)

Registered trademark:

CAREER JAPAN