

Date	April 30, 2014	Court	Tokyo District Court, 29th Civil Division
Case number	2012 (Wa) 964		
– A case wherein the court found infringement of copyright and trademark right with respect to a pachinko machine.			

In this case, Plaintiff 1, who holds the copyrights for the works including the season opener titled "O-oku Jochū Nazo no Shi (Mysterious death of a maid servant of the inner palace)" for the sixth season of "Meibugyō Tōyama no Kinnsan," which is a historical play produced as a television program with actor Hiroki Matsukata playing the lead, ("Plaintiff's Images of Matsukata 6-1") (the first-mentioned works shall be referred to as the "Plaintiff's Works") and a trademark right ("Trademark Right") for a mark consisting of the characters "遠山の金さん (Tōyama no Kinnsan)" written in standard characters ("Plaintiff's Trademark") (Trademark No. 4700298), claimed against the defendants, who manufactured and sold a pachinko machine named "CR Matsukata Hiroki no Meibugyō Kinnsan" ("Defendants' Goods"), an injunction against the replacement or provision of the parts of the Defendants' Goods ("Defendants' Parts") that contain the images newly produced by the defendants, wherein actor Hiroki Matsukata plays the role of Kinshirō Tōyama ("Defendants' Images"). In addition, Plaintiff 1 and two other parties claimed against the defendants to jointly and severally pay 1,980,000,000 yen in total and delay damages accrued thereon based on Article 709 and Article 719 of the Civil Code, Article 114, paragraph (2) of the Copyright Act or Article 38, paragraph (2) of the Trademark Right based on the plaintiffs' joint and several claims.

The issues are [i] whether or not the copyright was infringed (Issue 1), [ii] whether or not the trademark right was infringed (Issue 2), [iii] whether or not the request for injunction may be accepted (Issue 3) and [iv] whether or not claim for damages may be accepted and the amount of damage (Issue 4).

With respect to Issue 1, the court found that the scene showing the shower of cherry blossoms in the Defendants' Images is a reproduction of the scene showing the shower of cherry blossoms in the Plaintiff's Images of Matsukata 6-1 and thus the act of manufacturing the Defendants' Goods containing the Defendants' Images constitutes infringement of the right of reproduction of Plaintiff 1 (Article 21 of the Copyright Act) and the act of selling the Defendants' Goods constitutes infringement of the right of distribution of Plaintiff 1 (Article 26 of said Act).

Next, the court held as follows with respect to Issue 2 (whether or not the trademark right was infringed).

The defendants' mark "C R 松形弘樹の名奉行金さん (CR Matsuka Hiroki no Meibugyō Kinnsan)" is used as a trademark in the Defendants' Goods and is not similar to the Plaintiff's Trademark "遠山の金さん" in terms of appearance and pronunciation but is identical or similar to said Plaintiff's Trademark in terms of the concept. Moreover, even if the actual circumstances of the transaction, etc. are taken into consideration, the defendants' mark is similar to the Plaintiff's Trademark.

The Plaintiff's Trademark "遠山の金さん" is famous as a mark representing "Kinshirō Tōyama who is a historical character" or "Kinshirō Tōyama well-known as a famous bugyō (magistrate)" whose story has often been made into historical plays, etc. With respect to such Plaintiff's Trademark, no grounds for invalidation as prescribed in Article 4, paragraph (1), item (iii) of the Trademark Act can be found at the time when the registration of the Trademark Right was decided or at the time when the oral argument in question was concluded.

With respect to Issue 3 (whether or not the request for injunction may be accepted), the court found that, since the sale of the Defendants' Goods has terminated and the Defendants' Parts have all been disposed of, no necessity was found for injunction.

With respect to Issue 4 (whether or not the claim for damages may be accepted and the amount of damage), the court held that the amount of damage claimable by Plaintiff 1 against the defendants for infringement of copyright is 166,649,166 yen and the amount of damage claimable by the plaintiffs against the defendants for infringement of trademark right (and the monopolistic non-exclusive right to use) is 555,497,220 yen and the amount equivalent to the attorney fee is 30,000,000 yen in total. Based on such holding, the court ordered the defendants to pay 752,146,386 yen in total and delay damages accrued thereon and dismissed the other claims made by the plaintiffs.