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| Date | July 16, 2010 | Court | Tokyo District Court, 29th Civil Division |
| Case number | 2008 (Wa) 19774 | | |
| <p>– A case wherein the court partially upheld the claim for an injunction against the use of a mark "シルバーヴィラ" based on the Unfair Competition Prevention Act and claim for damages based on infringement of a trademark right made by the plaintiff who holds a trademark right with respect to a registered trademark "シルバーヴィラ" and runs a nursing home named "シルバーヴィラ向山" against the defendant who is engaged in the establishment and operation of facilities related to nursing insurance by using the names such as "シルバーヴィラ揖保川."</p> | | | |

In this case, the plaintiff, who holds a trademark right for a registered trademark "シルバーヴィラ" (shirubāvira) and runs a nursing home named "シルバーヴィラ向山" (shirubāvira kōyama), made the following claims against the defendant, who is engaged in the establishment and management of facilities related to nursing insurance by using names such as "シルバーヴィラ揖保川" (shirubāvira ibogawa; hereinafter referred to as the "Defendant's Marks"): [i] an injunction against the use of the mark "シルバーヴィラ" and payment of damages based on infringement of a trademark right; and [ii] an injunction against the use of the mark "シルバーヴィラ" based on Article 3 of the Unfair Competition Prevention Act based on an allegation that the defendant's acts constitute the act of unfair competition as prescribed in Article 2, paragraph (1), item (i) of said Act. In response to this, the defendant denied that the plaintiff's registered trademark and the Defendant's Marks are similar and alleged prior use of the Defendant's Marks based on Article 32 of the Trademark Act and Article 19, paragraph (1), item (iii) of the Unfair Competition Prevention Act.

In this judgment, the court found that the plaintiff's mark was well known and held that the plaintiff's mark and the plaintiff's registered trademark and the Defendant's Marks are similar and that the designated service of the plaintiff's trademark right, "nursing care of the elderly," and the service provided by the defendant at geriatric health services facilities are similar. Based on these findings, the court held that prior use of the Defendant's Marks could not be found based on Article 32 of the Trademark Act or Article 19, paragraph (1), item (iii) of the Unfair Competition Prevention Act and that the defendant's act of using the Defendant's Marks constituted infringement of the plaintiff's trademark right and the act of unfair competition as prescribed in Article 2, paragraph (1), item (i) of the Unfair Competition Prevention Act. Based on such holdings, the court found, with respect to the plaintiff's claim for an injunction against the defendant's act of affixing the mark "シルバーヴィラ" to the business facilities,

etc. in "providing nursing care for the elderly," that the services provided by the defendant using the Defendant's Marks are limited to those related to nursing insurance and the defendant is not likely to use them beyond the scope of such services and thereby upheld the claim for an injunction based on Article 3, paragraph (1) of the Unfair Competition Prevention Act to the extent of claiming an injunction against the act of affixing the marks such as "シルバーヴィラー揖保川" to the business facilities, etc. upon providing services related to nursing insurance. On the other hand, the court dismissed the plaintiff's claims for an injunction against the provision of services using facilities to which a mark "シルバーヴィラー" is affixed by finding that the act of using such facilities does not fall under the "use" of trademark as prescribed in Article 2, paragraph (3), item (iv) of the Trademark Act nor does it constitute the act prescribed in Article 2, paragraph (1), item (i) of the Unfair Competition Prevention Act and that there is no necessity to allow an injunction against the use of such facilities in addition to allowing an injunction against the use of the Defendant's Marks. With respect to the claims for damages, the court found that the existence of negligence shall be presumed (Article 39 of the Trademark Act and Article 103 of the Patent Act) on or after the date of issuance of the trademark bulletin and that there was negligence on the part of the defendant on and after such date. Moreover, with respect to the amount of damage, the court took into consideration the factors such as the difference in the location of the plaintiff's facility and defendant's facilities and place of residence of the main users of respective facilities and the fact that both the plaintiff's facility and the defendant's facilities are nonprofit facilities and upheld damages for an amount equivalent to 0.5% of the defendant's sales volume (the plaintiff had claimed for an amount equivalent to 1% of the defendant's sales volume) based on Article 38, paragraph (3) of the Trademark Act.