Date	October 27, 2005	Court	Intellectual Property High Court, Second Division
Case number	2005 (Ne) 10013		
– A case in which the court ruled that the Indication, "マクロス," may be found to have been widely-known by society in general as part of a title specifying films, but it cannot be found to have further become well-known or famous as an indication of the goods or business of the appellant, who is the relevant business operator, and thus, the Indication does not constitute an indication of the appellant's goods or business.			

References: Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act

Number of related rights, etc.:

Summary of the Judgment

The appellant holds a copyright for a television film titled "超時空要塞マクロス" (Chō Jikū Yōsai Makurosu (The Super Dimension Fortress Macross); hereinafter referred to as the "TV Animation"), and is the co-producer of a theatrical film titled "超時空要塞マクロス 愛・おぼえていますか" (Chō Jikū Yōsai Makurosu Ai Oboete Imasuka (The Super Dimension Fortress Macross; Do You Remember Love?); hereinafter referred to as the "Theatrical Animation"). With respect to the production and sale of the films that contain the term "マクロス" in their titles ("超時空要塞マクロスⅡ" (Chō Jikū Yōsai Makurosu II (The Super Dimension Fortress Macross Part 2)), "マクロスプラス" (Makurosu Purasu (Macross Plus), etc.) mainly conducted by the appellees, the appellant alleged that such act of the appellees constitutes the act of unfair competition as prescribed in Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act. Based on this allegation, the appellant sought against the appellees return of unjust enrichment, among others.

The court of prior instance dismissed all of the appellant's claims on the grounds that the indication of "マクロス" (the "Indication") does not constitute an indication of the appellant's goods or business and that the appellees' act does not constitute the use of the indication of goods or business.

In this judgment, the court dismissed the appellant's appeal, holding as summarized below.

The Indication, "マクロス," may be found to have been widely-known by society in general as part of a title specifying films thanks to the TV Animation and Theatrical Animation, etc. However, it cannot be found that the Indication had further become well-known or famous as an indication of the goods or business of the appellant, who is the relevant business operator, and thus the Indication does not constitute an

indication of the appellant's goods or business. Accordingly, the appellees' act of producing and selling the movies titled " 超時空要塞マクロスⅡ" (Chō Jikū Yōsai Makurosu II (The Super Dimension Fortress Macross Part 2)), "マクロスプラス" (Makurosu Purasu (Macross Plus)), etc. does not fall under Article 2, paragraph (1), item (i) or item (ii) of the Unfair Competition Prevention Act.

Judgment redered on October 27, 2005

2005 (Ne) 10013 Appeal Case of Seeking Return of Unjust Enrichment

(Former Case Number: Tokyo High Court 2004 (Ne) 3992, Court of prior instance: Tokyo District Court 2003 (Wa) 19435)

Date of conclusion of oral argument: September 1, 2005

Judgment

Appellant: Kabushiki Kaisha Tatsunoko Production

Counsel attorney: OHNO Mikinori

Same as above: UCHIDA Hiroshi

Same as above: SAMEJIMA Masahiro

Same as above: TAMAI Mariko

Same as above: GOTO Masakuni

Same as above: NAKAHARA Toshio

Same as above: OKAWARA Noriyuki

Appellee: BIGWEST, INC.

Counsel attorney: SHINBO Katsuyoshi

Same as above: KUNIHIRO Tadashi

Same as above: MURATA Shin'ichi

Same as above: GOMI Yuko

Same as above: AOKI Masayoshi

Same as above: SHIBA Akihiko

Appellee: BANDAI VISUAL CO., LTD.

Counsel attorney: YANASE Koji

Same as above: YAMAMOTO Shohei

Main text

1. The appeal in question shall be dismissed.
2. The costs of the appeal shall be borne by the appellant.

Facts and reasons

No. 1 Object of the appeal

1. The judgment in prior instance shall be revoked.

2. The appellees shall jointly and severally pay the appellant 50,000,000 yen and money accrued thereon at the rate of 5% per annum for the period from September 6, 2003 until the completion of payment.

3. The court costs shall be borne by the appellees for both the first and second instances.

4. Declaration of provisional execution.

No. 2 Outline of the case

The appellant holds a copyright for a television film titled "超時空要塞マクロス" (Chō Jikū Yōsai Makurosu (The Super Dimension Fortress Macross)) (hereinafter referred to as the "TV Animation") which was mainly broadcasted on Mainichi Broadcasting System during the period from October 1982 until June 1983, and is the coproducer of a theatrical film titled "超時空要塞マクロス　愛・おぼえていますか" (Chō Jikū Yōsai Makurosu Ai Oboete Imasuka (The Super Dimension Fortress Macross; Do You Remember Love?) (hereinafter referred to as the "Theatrical Animation") which was released at theaters throughout the country in 1984. With respect to the production and sale of the films that contain the term "マクロス" in their titles mainly conducted by the appellee, BIGWEST, INC. (hereinafter referred to as the "Appellee Bigwest"), and another appellee, BANDAI VISUAL Co., LTD. (hereinafter referred to as the "Appellee Bandai Visual"), the appellant alleged that the appellees' acts constitute the act of unfair competition as prescribed in Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act. Based on this allegation, the appellant claimed against the appellees to jointly and severally pay 685,000,000 yen and delay damages accrued thereon as a principal claim seeking return of unjust enrichment under Article 703 of the Civil Code and as a preliminary claim seeking compensation for damages under Article 4 of the Unfair Competition Prevention Act.

In the judgment in prior instance, the court dismissed all of the appellant's claims by denying the establishment of the act of unfair competition by the appellees on the grounds that the indication of "マクロス" does not fall under the indication of the appellant's goods, etc. and the appellees' acts do not fall under the use of the indication of goods, etc. Dissatisfied with this, the appellant filed this appeal (the "Appeal"). However, the appellant limited the scope of appeal against the judgment in prior instance to the part seeking payment of 50,000,000 yen and delay damages accrued thereon.

In the preceding civil actions between Kabushiki Kaisha Tatsunoko Production (the appellant) and BIGWEST, INC. (the appellee) and Kabushiki Kaisha P (non-party), it has become final and binding that the copyright for the TV Animation (provided, however, that the moral rights of author shall be excluded) is held by Kabushiki Kaisha Tatsunoko Production while the copyright for the "animation set image" (set image) that serves as the basis for the TV Animation and the "original drawing" and "moving image" (animation clip) based on such set image is jointly held by Kabushiki Kaisha P and BIGWEST, INC.

(omitted)

No. 4 Court decision

(omitted)

3. Court decision on the appellant's allegations in this instance

(1) Existence or absence of errors in the determination on whether or not the indication in question falls under an indication of goods, etc.

A. The appellant alleges that, in the judgment in prior instance, the court of prior instance erroneously determined that the indication in question (the "Indication") does not fall under the indication of goods, etc. as prescribed in Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act by holding that "a title of a film is absolutely used to specify the relevant film, which is a work protected under the Copyright Act, and would not be recognized as an indication to identify the goods or their source or to distinguish the business entity that performs the broadcasting and distribution business" (lines 22 through 24 of page 23) ("holding [1] of the judgment in prior instance").

However, according to the statements made in section No. 5-1 in the judgment in prior instance (Facts of this case), the Indication, "マクロス," may be found to have been widely-known by society in general as part of a title specifying the film thanks to the TV Animation and Theatrical Animation, etc. However, even if the evidence submitted in this case is examined, it cannot be found that the Indication had further become well-known or famous as to be that indicating the goods or business of the appellant who is the relevant business operator and thus, it should be said that the Indication does not fall under an indication of the appellant's goods. Accordingly, the appellant's allegation that the appellees' act of producing and selling the movies titled "超時空要塞マクロスⅡ" (Chō Jikū Yōsai Makurosu II (The Super Dimension Fortress Macross Part 2))" or "マクロスプラス" (Makurosu Purasu (Macross Plus)) falls under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act is groundless.

B. In this regard, the appellant made the following allegations: [a] holding [1] of the judgment in prior instance is inappropriate in that it failed to clarify what the term "goods" refers to; [b] in the judgment in prior instance, the court of prior instance erroneously made a decision on the premise that the "goods" under the Unfair Competition Prevention Act shall be limited to tangible objects and failed to make

examination on the requirement of "specificity," or, in other words, the requirement that "the indication functions to identify the goods or business of a specific person"; [c] in the judgment in prior instance, the court of prior instance overlooked the fact that a title of a work protected under the Copyright Act has the function to distinguish the goods in which the relevant work is fixed or recorded from goods of others and the function to indicate the source thereof, just as with the case of the name of general goods (goods other than those in which a work is fixed or recorded); [d] the indication of "マクロス" is not the title of a film per se but is instead a name used as an abbreviation or nickname derived from the film and there is no film titled merely "マクロス," and thus there are errors in the facts found in the judgment in prior instance. Moreover, the indication of "マクロ" falls under the "indication of goods, etc." since it has become sufficiently well-known to secure the public interest function and private interest function of the "indication of goods, etc.," which are expected under the Unfair Competition Prevention Act.

However, as explained above, it is found that the Indication, "マクロス," is used to specify the film which is a work protected under the Copyright Act and would not allow the appellant to be promptly recognized as the business entity performing the broadcasting and distribution business for such film. Therefore, it cannot be said that the judgment in prior instance is inappropriate or contains errors in its determination as alleged by the appellant in (A) and (B) above.

The title of the TV Animation is "超時空要塞マクロス" and that of the Theatrical Animation is "超時空要塞マクロス　愛・おぼえていますか," while the titles of the animation films produced and released after the TV Animation and Theatrical Animation are "超時空要塞マクロスⅡ" (a video), "マクロスプラス" (a video and theatrical version), "マクロス７" (Makurosu Sebun (Macross Seven)) (theatrical version, television broadcasting, and video; Exhibits Otsu No. 5-1 and No. 5-2), "マクロスダイナマイト７" (Makurosu Dainamaito Sebun (Macross Dynamite Seven)) (DVD software) and "マクロスゼロ" (Makurosu Zero (Macross Zero)) (DVD software) and there are no films titled merely "マクロス" (parts (1), (3) and (4) of section No. 5-1 of the judgment in prior instance). Nevertheless, in light of the fact that the appellant has also acknowledged that the term "マクロス" is an essential part of the titles of the abovementioned films, it cannot be said that the judgment in prior instance made on the premise that the term "マクロス" is the title of a film contains any erroneous fact findings that may affect the conclusion. Moreover, as explained above, although the Indication which constitutes part of the title of TV Animation and Theatrical Animation was well-known by society in general, the Indication cannot be

found to have become further well-known or famous as to be that indicating the goods or business of the appellant. Therefore, the appellant's allegation mentioned in (D) above may not be accepted either.

(2) Existence or absence of errors in the determination on the use of the indication of goods, etc. by the appellees

The appellant alleges that the appellees' act of producing and selling the abovementioned films falls under the use of an indication of goods, although the judgment in prior instance held as follows: "The accused movies with respect to which the defendants engaged in the production or sale are theatrical films or videos or DVD software on which the films are recorded and the titles containing the term "マクロス" (the "accused's indication") attached to such films are all indicated as the title of the film or the film indicated in the relevant media. Thus, the accused's indication is not used as an indication of goods, etc." (lines 19 through 23 of page 24) ("holding [2] of the judgment in prior instance).

However, as found in the judgment in prior instance, the titles containing the term "マクロス" (the accused's indication) are all indicated as the title of the film or the film recorded on the relevant media and thus it should be said that the Indication is not used as an indication of goods, etc. by the appellees. Accordingly, the abovementioned appellant's allegations may not be accepted.

(omitted)

4. Conclusion

Based on the abovementioned findings, without the need to determine other points, the appellant's claims made in this action on the grounds that the appellees' act falls under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act are groundless.

Therefore, the Appeal shall be dismissed for being groundless and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Second Division

Presiding Judge: NAKANO Tetsuhiro

Judge: OTAKA Ichiro

Judge: HASEGAWA Koji