

Date	May 21, 2014	Court	Tokyo District Court, 40th Civil Division
Case number	2013 (Wa) 31446		
– A case in which the court upheld an injunction against the import, etc. of a handbag imported and sold by the defendant (the "defendant's product"), and compensation for damages, holding that the defendant's product is found to be similar to plaintiff's three-dimensional trademark and that this case falls under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act.			

In this case, the plaintiff alleged that a handbag imported and sold by the defendant (the "defendant's product") infringes plaintiff's trademark right (three-dimensional trademark) and that it is similar to the configuration of the "Birkin," a plaintiff's product that is well-known or famous as an indication of goods or business of the plaintiff, and is likely to mislead or cause confusion among consumers. Based on this allegation, the plaintiff sought an injunction against the import, etc. of the defendant's product under Article 36, paragraph (1) of the Trademark Act or Article 2, paragraph (1), items (i) and (ii), and paragraph (3), item (i) of the Unfair Competition Prevention Act, as well as the payment of a total of 3,823,000 yen, , with delay damages accrued thereon. Said total is broken down as follows: 823,000 yen as damages suffered by the plaintiff, which is equivalent to the profits gained by the defendant, under Article 38, paragraph (2) of the Trademark Act or Article 4, and Article 5, paragraph (2) of the Unfair Competition Prevention Act; 2,000,000 yen as intangible damage caused by the damage to credit under Article 709 of the Civil Code; and 1,000,000 yen of legal fees. The defendant submitted a written answer but was absent on the meeting day for oral argument.

The issues of the case are: [i] whether the defendant's product is found to be similar to the plaintiff's three-dimensional trademark; [ii] whether the case falls under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act; and [iii] the amount of damages sustained by the plaintiff, among other things.

In this judgment, the court held as follows. Although the same interpretation is applied in both the cases of a three-dimensional trademark and other types of trademarks, this case should be considered in light of the uniqueness of a three-dimensional trademark. In this case, the plaintiff holds a trademark right for the plaintiff's mark, which is a three-dimensional configuration of the plaintiff's product. Since a three-dimensional trademark is composed of a three-dimensional configuration or a combination of a three-dimensional configuration and a flat mark, it is distinct from other types of trademark in the sense that it presents a different visual depending on the direction it is seen from. Therefore, a three-dimensional trademark should be

generally interpreted as a trademark that allows those who see it to identify the source of goods or services by the characteristics of a visual image it provides when seen from one or two specific directions (predetermined directions) from which those who see it are supposed to mainly look when they observe the trademark. When a visual image seen from a predetermined direction is identical or closely similar to a specific flat mark, it should be, in principle, concluded that the three-dimensional trademark in question and the flat mark in question are similar in appearance. The direction to be used as a predetermined direction should be determined individually and objectively based on the structural details of the three-dimensional trademark in question.

In this case, the front part (the wide, trapezoidal face where the top flap and fixing parts are present) is at least one of the predetermined directions. When seen from the front, which is a predetermined direction, the visual images of the two products are at least highly similar and thus it should be concluded that their appearance is similar. Furthermore, while the plaintiff's mark has a three-dimensional structure consisting of a top flap, a pair of belts and a pair of supporting fixing parts to fix said belts, the defendant's mark has a flat structure instead where a printed photograph, which three-dimensionally expresses the quality of said three-dimensional structure, is attached. When seen from the front, visual features concerning the common appearance can be perceived. If the defendant's mark is observed from the above or side directions, it is possible to perceive that said top flap, etc., which were originally expressed three-dimensionally in the plaintiff's mark, are not three dimensional; however, they have no influence on determining whether the appearance of the two marks are similar when observed from a predetermined direction, since neither the above nor side directions are considered as predetermined directions.

In addition, the court found that there is a grounds for the claim under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act since the configuration of the plaintiff's product is well-known and famous.

In conclusion, the court upheld an injunction against the import, etc. of the defendant's product, determined the amount of damages to be 658,400 yen (an amount equivalent to defendant's profits to be compensated by the defendant), and ordered the defendant to pay a total of 2,358,400 yen, which includes 1,500,000 yen for damages due for credit of the plaintiff and 200,000 yen as legal fees, in addition to said damages.

Judgment rendered on May 21, 2014

2013 (Wa) 31446, Case of Seeking Injunction against Trademark Infringement, etc.

Date of conclusion of oral argument: March 26, 2014

Judgment

Plaintiff: Hermès International

Defendant: Kabushiki Kaisha DHS corp

Main text

1. The defendant shall not import, assign, deliver, or display for the purpose of assignment or delivery the goods described in Lists of Defendant's Goods 1 to 4 attached to this judgment.
2. The defendant shall pay to the plaintiff 2,358,400 yen and the amount accrued thereon at the rate of 5% per annum for the period from December 14, 2013 to the date of completion of the payment.
3. All the other claims made by the plaintiff shall be dismissed.
4. The court costs shall be divided into eight, and the defendant shall bear five-eighths thereof and the plaintiff shall bear the remaining amount.
5. Only paragraphs 1 and 2 of this judgment may be provisionally executed.
6. For the plaintiff, the additional period for filing the appeal against this judgment shall be specified as 30 days.

Facts and reasons

No. 1 Objects of claims

1. The same effect as paragraph 1 of the main text.
2. The defendant shall pay to the plaintiff 3,823,000 yen and the amount accrued thereon at the rate of 5% per annum for the period from December 14, 2013 to the date of completion of the payment.
3. The defendant shall bear the court costs.
4. Declaration of provisional execution

No. 2 Outline of the case

The plaintiff alleged that the goods described in Lists of Defendant's Goods 1 to 4 attached to this judgment, which are imported and sold by the defendant, (hereinafter, the goods described in these lists are respectively referred to as "Defendant's Goods 1" to "Defendant's Goods 4," and are collectively referred to as the "Defendant's Goods") infringe the plaintiff's trademark right and are likely to mislead or cause confusion because the configurations of the

Defendant's Goods are similar to the configuration of the goods described in the List of Plaintiff's Goods attached to this judgment (hereinafter referred to as the "Plaintiff's Goods"), which is well-known or famous as the plaintiff's indication of goods, etc. Based on this allegation, the plaintiff filed this action against the defendant to seek [i] an injunction against the import, assignment, etc. of the Defendant's Goods under Article 36, paragraph (1) of the Trademark Act or Article 2, paragraph (1), items (i) and (ii) and Article 3, paragraph (1) of the Unfair Competition Prevention Act (paragraph 1 of the objects of claims) and [ii] payment of a total of 3,823,000 yen, which consists of the plaintiff's damages of 823,000 yen that are equivalent to the profits obtained by the defendant under Article 38, paragraph (2) of the Trademark Act or Article 4 and Article 5, paragraph (2) of the Unfair Competition Prevention Act, the intangible damages caused by damages to the credit of the plaintiff of 2,000,000 yen under Article 709 of the Civil Code, and the attorney's fees of 1,000,000 yen, with delay damages accrued thereon at the rate of 5% per annum as prescribed in the Civil Code for the period from December 14, 2013 (the day following the date of service of the complaint) to the date of completion of the payment (paragraph 2 of the objects of claims).

1. Facts on which the decision is premised, etc. (evidence, etc. is briefly indicated at the end of the determined facts)

(1) Parties

The plaintiff is a French corporation engaging in the business of manufacturing and selling bags, prestigious women's wear, accessories, etc. [the entire import of the oral argument]

The defendant is a stock company engaging in the business of selling and exporting and importing, etc. clothing, personal ornaments, footwear, shoes, accessories, precious metals, miscellaneous daily goods, furniture, interior products, and sports gear, and it sells goods on the Internet shopping site. [Exhibit Ko 1 and the entire import of the oral argument]

(2) Plaintiff's trademark right

The plaintiff holds a trademark right for the three-dimensional trademark described in the List of Trademark Right attached to this judgment (hereinafter referred to as the "Plaintiff's Trademark Right," and the relevant trademark is referred to as the "Plaintiff's Trademark") in relation to the shape of the Plaintiff's Goods described in the List of Plaintiff's Goods attached to this judgment (hereinafter, said shape is referred to as the "Plaintiff's Mark"). [Exhibit Ko 2]

(3) Defendant's act of importing and selling the Defendant's Goods

The defendant imported the Defendant's Goods and sold them on the Internet shopping site.

The shapes of all of the Defendant's Goods (hereinafter collectively referred to as the "Defendant's Marks") are recognized to be the same although they differ in size. [Exhibits Ko 1 and 34 to 36 and the entire import of the oral argument]

(4) Issuance of a provisional disposition order

The plaintiff filed a petition for a provisional disposition order (Tokyo District Court, 2013 (Yo) 22055) to seek an injunction against the defendant's act of importing, assigning, delivering, or displaying for the purpose of assignment or delivery, etc. the Defendant's Goods, and the Tokyo District Court rendered a ruling accepting said petition on October 10, 2013. [Exhibit Ko 39]

(5) Filing of this action

The plaintiff filed this action against the defendant on November 28, 2013. [obvious to this court]

(omitted)

No. 3 Court decision

1. According to the evidence (Exhibits Ko 1 to 40 and the result of observation), the following facts are found, and there is no evidence that is sufficient to reverse said findings.

(1) Since around 2011, the defendant has imported the Defendant's Goods from another company located in South Korea, and has sold them on the Internet website in Rakuten Ichiba. On said website, the defendant identifies itself as an "official distributor for a unique brand originated in Hong Kong, 'GINGERBAG,'" and describes the Defendant's Goods as follows: "Ginger Bag is a nylon luxury bag that is unique and of practical use. It was born based on witty pop art ideas like Andy Warhol's Campbell's Soup Cans. It is a Hong Kong brand made by twisting a famous signature bag collection in a funny manner, and the image of a classic bag is expressed on the fabric by digital printing. We reveal luxury and enjoyable goods that differ from ordinary nylon bags in assorted colors."; "The pattern of a genuine leather surface is printed on nylon fabric. This is a bag of a realistic unique illusionism design!! A brand originated in Hong Kong that is placed in various fashion magazines and is beloved by many models!!!" [Exhibit Ko 1]

(2) By a content-certified mail dated October 3, 2012, the plaintiff demanded, through its representative attorney, that the defendant suspend the sale of the Defendant's Goods and disclose the period of sale, sales quantity, and sales price, etc. of the Defendant's Goods. Said mail arrived at the defendant's office on the 11th of the same month. [Exhibits Ko 37-1 and 37-2]

In response to this, on the 22nd of the same month, the defendant informed the plaintiff's representative attorney, by phone and through its employee D, only of its intention to discontinue the sale of the Defendant's Goods. However, the defendant did not make any reply, etc. concerning other matters. Therefore, by a content-certified mail dated November 19 of the same year, the plaintiff's representative attorney demanded that the defendant make a reply

again, and also demanded the sending, etc. of copies of delivery slips, etc. from the company from which it purchased the Defendant's Goods. Said mail arrived at the defendant on the 21st of the same month. [Exhibits Ko 38-1 and 38-2]

(3) On December 25, 2012, the defendant gave to the plaintiff's representative attorney the following reply: the period of sale of the Defendant's Goods is a little more than one year; the defendant purchased 330 pieces of the Defendant's Goods in total, of which a little more than 50 were defective; the sales price was 20,800 yen for an extra-large size bag (Defendant's Goods 4), 16,900 yen for a large size bag (Defendant's Goods 3), 15,600 yen for a middle size bag (Defendant's Goods 2), and 14,900 yen for a small size bag (Defendant's Goods 1). Moreover, the defendant sent a document prepared by "SUWA UNITED INC." in South Korea (however, only the breakdown of the products and their import quantity are described in the document, and other matters, such as import price, are not described therein), which is alleged to be equivalent to an invoice dated June 8, 2011 concerning the import of 330 pieces of Defendant's Goods. [Exhibit Ko 34]

(4) On January 17, 2013, the defendant gave to the plaintiff's representative attorney the reply that the sales quantity of the Defendant's Goods is 192 and that their purchase price is 190 dollars for an extra-large size bag (Defendant's Goods 4), 155 dollars for a large size bag (Defendant's Goods 3), 150 dollars for a medium size bag (Defendant's Goods 2), and 140 dollars for a small size bag (Defendant's Goods 1). The defendant also sent an email stating "Even if we try to return defective products and inventory to SUWA in South Korea, SUWA is rather a dishonest trader that does not receive even the return of defective products. Our president is directly bringing the defective products to South Korea in order to bring SUWA to trial, and is supposed to submit them as articles of evidence in court." [Exhibit Ko 35]

Furthermore, on January 28 of the same year, the defendant gave to the plaintiff's representative attorney the following reply concerning the breakdown of the sales quantity of the Defendant's Goods (192 pieces): 17 extra-large size bags (Defendant's Goods 4), 106 large size bags (Defendant's Goods 3), 45 middle size bags (Defendant's Goods 2), and 24 small size bags (Defendant's Goods 1). [Exhibit Ko 36]

2. Regarding the issue of whether the defendant's act of importing and selling the Defendant's Goods violates the Trademark Act

(1) Similarity between a trademark and a mark should be determined based on whether the mark compared with the trademark is likely to mislead or cause confusion as to the source of the goods/services if it is used in connection with goods/services that are identical with or similar to those of the trademark. However, for that purpose, the impression, memory, association, etc. which the mark used in connection with such goods/services gives to traders and consumers through its appearance, concept, pronunciation, etc. should be considered on the whole in a

comprehensive manner. In addition, as long as the actual trading conditions of said goods/services can be made clear, the determination should be made based on the specific trading conditions. Similarity between a trademark and a mark in appearance, concept, or pronunciation is nothing more than a prima facie standard for presuming the likelihood of misleading or causing confusion as to the source of the goods/services for which the trademark is used. Therefore, it should be said that even if a trademark and a mark are similar to each other in any of these three points, the mark cannot be considered to be similar to the trademark if it is hardly recognized as being likely to mislead or cause confusion as to the source of the goods/services in consideration of remarkable differences in other points or other actual trading conditions, etc. (see the judgment of the Third Petty Bench of the Supreme Court, February 27, 1968, 1964 (Gyo-Tsu) 110, Minshu, Vol. 22, No. 2, at 399 and the judgment of the Third Petty Bench of the Supreme Court, March 11, 1997, 1994 (O) 1102, Minshu, Vol. 51, No. 3, at 1055).

The Plaintiff's Trademark is a three-dimensional trademark. The aforementioned determination standard for similarity should be considered to be also applicable to a three-dimensional trademark in the same manner. However, as the Defendant's Marks partially include two-dimensional marks, the method of determining similarity in appearance is considered in consideration of the particularity of three-dimensional trademarks, that is, these trademarks have the function of distinguishing one's own goods from other persons' goods mainly in the three-dimensional shape.

A three-dimensional trademark consists of a three-dimensional shape or a combination of a three-dimensional shape and a two-dimensional mark, and it has the particularity of being different in visual appearance depending on the direction from which it is seen. When a three-dimensional trademark is actually used, its entire shape cannot be seen at one time. Therefore, when devising such a trademark, it is considered ordinary to assume one or more specific directions (prescribed directions) from which a person mainly visually recognizes the trademark in observing it, and to make the trademark be one with which a person can distinguish the source of the goods/services based on the features in the appearance of the trademark he/she visually recognizes when he/she sees the trademark from such prescribed directions. In that case, for a three-dimensional trademark, its appearance (impression) that is visually recognized by a person who sees it from a prescribed direction, as well as the entire shape thereof, functions as signs for distinguishing one's own goods/services from other persons' goods/services. Therefore, if the appearance of a three-dimensional trademark that is visually recognized when being seen from a prescribed direction is identical with or very similar to that of a specific two-dimensional trademark, it should be said that said three-dimensional trademark and said two-dimensional trademark are similar to each other in appearance. In addition, if there are two or more such prescribed directions, the function of distinguishing the

source of the goods/services is given independently to each of the appearances that are visually recognized by a person who sees the three-dimensional trademark from those prescribed directions. Therefore, if the appearance of a three-dimensional trademark that is visually recognized by a person who sees it from one of the prescribed directions is identical with or very similar to that of a specific two-dimensional trademark, it should be said that the three-dimensional trademark and the two-dimensional trademark are similar in appearance in such manner. However, it is reasonable to say that the appearance of a three-dimensional trademark that is visually recognized by a person who sees it from a direction that is not the prescribed direction at all does not serve as an element for determining similarity in appearance.

The issue of which direction is the prescribed direction should be considered to be a matter that should be objectively determined on a case-by-case basis depending on the constitution of the relevant three-dimensional trademark.

(2) Considering this point in relation to this case, both the Plaintiff's Mark and the Defendant's Marks pertain to handbags for storing articles inside which are carried with handles. Therefore, it is obvious that the part of a bag that is at the bottom when the bag is carried with handles is the bottom surface and that the surfaces, which are connected to the short sides of the trapezoidal bottom surface and are of a vertically long isosceles triangle shape to which handles are not attached, are the side surfaces. Of the remaining surfaces, the large trapezoidal surface on which the lid part and the fixture are indicated is the front side part. In addition, the lid part, the belt, and the fixture, which also have decorative elements, are indicated on this front side part, in a manner different from the backside part that is face-to-face with the front side part. When the bag is carried with handles, the front side part faces outward, in a manner different from the backside part that is on the side of the person who carries the bag and is hidden, and it therefore attracts the attention of other persons. Consequently, this front side part is considered to fall under at least one of the prescribed directions.

The following facts can also be considered to confirm that the front side part is a prescribed direction: a photograph including this front side part is indicated in all the Internet shopping sites operated by the defendant; this front side part is the only part that is always indicated in the introduction of the goods. [Exhibit Ko 1]

When being observed from the direction of the front side part, the Plaintiff's Mark and the Defendant's Marks have commonality in the following points: [i] the front side of the body is of a trapezoidal shape whose base is slightly longer, there are cuts on both sides of the upper part to form approximately convex shapes, and the lid part having two vertical keyhole-shaped cuts in a manner such that the cuts approximately laterally trisect the lid is indicated; [ii] a matched pair of belts, which extend from said cuts on both sides that form approximately convex shapes to the center of the front side of the body, are indicated on said lid part; [iii] a fixture with a ring

shape formed at the tip is indicated at the position where the convex parts of said lid part and said matched pair of belts can be fixed at the same time at the upper center on the front side of the body; [iv] a matched pair of auxiliary fixtures, which function to fix the convex parts of said lid part and said belts at the same time, are indicated at the outward positions from said keyhole-shaped cuts; and [v] a pair of arc-like handles are indicated in the upper part, and said handle on the front side is indicated in a manner such that it goes through said keyhole-shaped cuts. Therefore, the Plaintiff's Mark and the Defendant's Marks should be considered to be very similar at least in the appearance that is visually recognized when being seen from the front side, which is the prescribed direction. Therefore, said marks can be considered to be similar in appearance.

In the Defendant's Marks, the lid part, the matched pair of belts, the matched pair of auxiliary fixtures to fix the belts, fixture with a ring shape formed at the tip, and the lower part of the handle (part that overlaps with the front side part and extends to the vicinity of the belts) are two-dimensional structures that are made by printing photographs that express the texture of those parts in three dimensions and attaching them to the surfaces while those parts are three-dimensional structures in the Plaintiff's Mark. It should be said that a person can recognize visual features pertaining to the aforementioned common points when he/she sees the Defendant's Marks from the front side.

On the other hand, in the case of observing the Defendant's Marks from the top and the side, a person can recognize that said lid part, etc., which are expressed in three dimensions in the Plaintiff's Mark, are not in three dimensions. However, both the top and side are not the prescribed directions, and therefore, this difference does not affect similarity in appearance when observing the marks from the aforementioned prescribed direction.

(3) It is also not recognized that the Plaintiff's Trademark or the Defendant's Marks are significantly different from each other on the grounds that either of them produces any concept or pronunciation.

(4) On these bases, the Defendant's Marks can be considered to be similar to the Plaintiff's Trademark, and there are no circumstances that are sufficient to reverse the presumption of negligence in relation to the defendant (Article 39 of the Trademark Act and Article 103 of the Patent Act).

(5) In this regard, the defendant alleges that the Defendant's Goods can be clearly distinguished based on the materials and prices, etc. though their designs are similar to the Plaintiff's Goods in [terms of] photographs. However, even in light of all evidence in this case, there is no fact that is sufficient to reverse the determination that the Defendant's Marks are similar to the Plaintiff's Mark when being observed from the front side, which is the prescribed direction. The Defendant's Marks are also not recognized as being unlikely to mislead or cause confusion as to

the source of goods.

Therefore, the aforementioned allegation of the defendant is unacceptable.

3. Regarding whether the defendant's act of importing and selling the Defendant's Goods falls under Article 2, paragraph (1), items (i) and (ii) of the Unfair Competition Prevention Act

(1) Regarding the famousness of the Plaintiff's Mark, its similarity to the Defendant's Marks, and the issue of whether the defendant used the Defendant's Marks as an indication of its own goods, etc.

A. The Plaintiff's Goods have the following features: They have the configuration described in the List of Plaintiff's Goods attached to this judgment (Plaintiff's Mark); on the front side and backside of the body, the Plaintiff's Goods are of a trapezoidal shape whose base is slightly longer, and the sides of the body are of a vertically extended isosceles triangular shape; there are cuts on both sides of the upper part on the front side of the body to form approximately convex shapes; the lid part, on which two vertical keyhole-shaped cuts are provided in a manner such that they approximately laterally trisect the lid, is located on the upper part on the front side; the edge parts are sewed onto the upper part on the backside of the body; belts that extend from the cuts on both sides of said approximately convex shapes to the upper part on the front side of the body are provided; a fixture with a ring shape formed at the tip, which can fix the convex parts of said lid part and said belts at the same time at the upper center on the front side of the body, is provided; furthermore, a matched pair of auxiliary fixtures, which can fix the convex parts of said lid part and said belts at the same time at the outward positions from said key-hole-shaped cuts, are provided; a pair of arc-like handles are sewed onto the upper part on the front side of the body and the upper part on the backside of the body; and said handle on the front side is provided in a manner such that it goes through said keyhole-shaped cuts. The Plaintiff's Goods have unique features in that they are of a trapezoidal shape, have a gore on the sides, have keyhole-shaped cuts at the lid part, and have a pair of belts that extend from the backside part of the body to the front side part of the body. The Plaintiff's Goods can be considered to have a configuration that gives a special impression to consumers.

B. According to evidence, the Plaintiff's Goods were released by the plaintiff in 1984, and came to be known by the name "Birkin" because it is considered to have been beloved by a French actress, Jane Birkin. Since 1964, the plaintiff, which is a French corporation, has also opened up 15 specialty stores in total across Japan, including those in Shibuya and Ikebukuro, in collaboration with large department stores, and the high quality and fashionable nature of its products have come to be known. Since the establishment of Hermès Japon, which is the plaintiff's subsidiary in Japan, in 1983, the plaintiff has conducted further active sales activities, and at present, it has 45 stores in total in Japan, including directly managed stores and appointed stores. [Exhibit Ko 3]

There are various types of Plaintiff's Goods in terms of color and surface materials. However, most of them are luxury bags that cost over 1,000,000 yen. The Plaintiff's Goods are also introduced as the "most prominent bag that women all over the world adore" in magazines. [Exhibits Ko 11, 12, and 28]

The number of the Plaintiff's Goods sold annually in Japan exceeded 3,000 in 1998, 8,000 in 2003, and 17,000 in 2009, respectively. [Exhibit Ko 4]

The plaintiff has been promoting the sale of the Plaintiff's Goods through many magazines, and advertising expenses which the plaintiff paid for the Plaintiff's Goods for the period from 1985 to 1996 reached 62,000,000 yen. Many magazines covered the Plaintiff's Goods with photographs, including a women's magazine that profiles only the goods of Hermès. The Plaintiff's Goods were introduced with color photographs as goods representing the goods of Hermès in a manner such that people are strongly impressed by the distinguishing configuration of the Plaintiff's Goods as mentioned above, specifically, being of a trapezoidal shape, having a gore on the sides, having keyhole-shaped cuts on the lid part, and having a pair of belts that extend from the backside part of the body to the front side part of the body. [Exhibits Ko 5 to 32]

On these bases, it should be said that the Plaintiff's Mark has independently acquired the ability to distinguish the plaintiff's goods from other persons' goods, as a mark that is famous as the plaintiff's sign for the source, through the plaintiff's sales and advertising activities, by May 2011 at the latest.

C. Then, as considered in 2. above, the Defendant's Marks, which are the configurations of the Defendant's Goods, have the same features as the Plaintiff's Mark in terms of the front side, which is the prescribed direction from which a person mainly sees it when observing it. Even in consideration of observation from the top and side, the entire shapes of the Defendant's Marks should be considered to be similar to that of the aforementioned Plaintiff's Mark. Therefore, the Defendant can be considered to have used the Plaintiff's Mark as an indication of its own goods, etc. (Article 2, paragraph (1), item (ii) of the Unfair Competition Prevention Act).

(2) Regarding the well-knownness of the Plaintiff's Mark and the issue of whether the Defendant's Marks are likely to mislead or cause confusion with the Plaintiff's Mark

A. Regarding well-knownness

According to (1) above, it is recognized that the Plaintiff's Mark pertaining to the configuration of the Plaintiff's Goods had become well-known by May 2011 at the latest.

B. Regarding the likelihood of misleading or causing confusion

As considered in (1)C. above, the Defendant's Marks are similar to the Plaintiff's Mark, and they are recognized as being likely to mislead or cause confusion.

(3) Regarding whether the defendant was intentional or negligent

As considered in 2. Above, the Defendant's Goods have the configuration of the Defendant's Marks, which are similar to the Plaintiff's Mark that is well-known and famous. In consideration of the background regarding the acquisition of well-knownness and famousness of the Plaintiff's Mark in relation to the Plaintiff's Goods, as determined in (1)B. above, the defendant should be recognized as being negligent at least in terms of the violation of the Unfair Competition Prevention Act in relation to the import and sale of the Defendant's Goods.

(omitted)

5. Conclusion

On these bases, there is a reason for the plaintiff's claims against the defendant to the extent of seeking an injunction against the import, assignment, delivery, or display for the purpose of assignment or delivery of the Defendant's Goods under Article 36, paragraph (1) of the Trademark Act or Article 2, paragraph (1), items (i) and (ii) and Article 3, paragraph (1) of the Unfair Competition Prevention Act (paragraph 1 of the main text) and payment of 2,358,400 yen with delay damages accrued thereon at the rate of 5% per annum as prescribed in the Civil Code for the period from December 14, 2013, which is the day following the date of service of the complaint, to the date of completion of the payment under Article 38, paragraph (2) of the Trademark Act, Article 5, paragraph (2) of the Unfair Competition Prevention Act, and Article 709 of the Civil Code (paragraph 2 of the main text). There is no reason for other claims.

Therefore, the judgment shall be rendered in the form of the main text.

Tokyo District Court, 40th Civil Division

Presiding judge: SHOJI Tamotsu

Judge: IMAI Hiroaki

Judge: SANEMOTO Shigeru

(Attachment)

List of Defendant's Goods 1

A bag priced at 14,900 yen (tax excluded) whose product name is "GINGERBAG: small size" and whose shape is as indicated in Photographs 4 to 6, which is characterized by the following:

[i] the entire shape is a three-dimensional shape wherein the front side of the body is of a trapezoidal shape whose base is slightly longer and each side of the body forms a vertically extended isosceles triangular shape;

[ii] a pair of arc-like real handles are sewed onto the top edge on the front side of the body and the top side on the backside thereof; and

[iii] [a] the lid part having cuts on both sides to form approximately convex shapes and having two vertical keyhole-shaped cuts in a manner such that they approximately laterally trisect the lid is indicated in the upper part on the front side of the body; [b] a matched pair of belts that extend from the cuts on both sides of said approximately convex shapes to the center on the front side of the body are indicated on said lid part; [c] a fixture with a ring shape formed at the tip is indicated at the position where the convex parts of said lid part and said matched pair of belts can be fixed at the same time at the upper center on the front side of the body; [d] a matched pair of auxiliary fixtures that fix the convex parts of said lid part and said belts at the same time are indicated at the outward positions from said keyhole-shaped cuts; and [e] parts of handles that extend to the actual handles sewed onto the top edge on the front side of the body and the top edge on the backside thereof are indicated on the front side of the body so that a pair of arc-like handles can be visually recognized in the upper part on the front side of the body and the upper part on the backside of the body, and said parts of the handle on the front side of the body are indicated so that they go through said keyhole-shaped cuts.

List of Defendant's Goods 2

A bag priced at 15,600 yen (tax excluded) whose product name is "GINGERBAG: medium size" and whose shape is as indicated in Photographs 4 to 6, which is characterized by the following:

[i] the entire shape is a three-dimensional shape wherein the front side of the body is of a trapezoidal shape whose base is slightly longer and each side of the body forms a vertically extended isosceles triangular shape;

[ii] a pair of arc-like real handles are sewed onto the top edge on the front side of the body and the top side on the backside thereof; and

[iii] [a] the lid part having cuts on both sides to form approximately convex shapes and having two vertical keyhole-shaped cuts in a manner such that they approximately laterally trisect the lid is indicated in the upper part on the front side of the body; [b] a matched pair of belts that extend from the cuts on both sides of said approximately convex shapes to the center on the front side of the body are indicated on said lid part; [c] a fixture with a ring shape formed at the tip is indicated at the position where the convex parts of said lid part and said matched pair of belts can be fixed at the same time at the upper center on the front side of the body; [d] a matched pair of auxiliary fixtures that fix the convex parts of said lid part and said belts at the same time are indicated at the outward positions from said keyhole-shaped cuts; and [e] parts of handles that extend to the actual handles sewed onto the top edge on the front side of the body and the top edge on the backside thereof are indicated on the front side of the body so that a pair of arc-like handles can be visually recognized in the upper part on the front side of the body and the upper part on the backside of the body, and said parts of the handle on the front side of the body are indicated so that they go through said keyhole-shaped cuts.

List of Defendant's Goods 3

A bag priced at 16,900 yen (tax excluded) whose product name is "GINGERBAG: large size" and whose shape is as indicated in Photographs 4 to 6, which is characterized by the following:

[i] the entire shape is a three-dimensional shape wherein the front side of the body is of a trapezoidal shape whose base is slightly longer and each side of the body forms a vertically extended isosceles triangular shape;

[ii] a pair of arc-like real handles are sewed onto the top edge on the front side of the body and the top side on the backside thereof; and

[iii] [a] the lid part having cuts on both sides to form approximately convex shapes and having two vertical keyhole-shaped cuts in a manner such that they approximately laterally trisect the lid is indicated in the upper part on the front side of the body; [b] a matched pair of belts that extend from the cuts on both sides of said approximately convex shapes to the center on the front side of the body are indicated on said lid part; [c] a fixture with a ring shape formed at the tip is indicated at the position where the convex parts of said lid part and said matched pair of belts can be fixed at the same time at the upper center on the front side of the body; [d] a matched pair of auxiliary fixtures that fix the convex part of said lid part and said belts at the same time are indicated at the outward positions from said keyhole-shaped cuts; and [e] parts of handles that extend to the actual handles sewed onto the top edge on the front side of the body and the top edge on the backside thereof are indicated on the front side of the body so that a pair of arc-like handles can be visually recognized in the upper part on the front side of the body and the upper part on the backside of the body, and said parts of the handle on the front side of the body are indicated so that they go through said keyhole-shaped cuts.

List of Defendant's Goods 4

A bag priced at 20,800 yen (tax excluded) whose product name is "GINGERBAG: extra-large size" and whose shape is as indicated in Photographs 4 to 6, which is characterized by the following:

[i] the entire shape is a three-dimensional shape wherein the front side of the body is of a trapezoidal shape whose base is slightly longer and each side of the body forms a vertically extended isosceles triangular shape;

[ii] a pair of arc-like real handles are sewed onto the top edge on the front side of the body and the top side on the backside thereof; and

[iii] [a] the lid part having cuts on both sides to form approximately convex shapes and having two vertical keyhole-shaped cuts in a manner such that they approximately laterally trisect the lid is indicated in the upper part on the front side of the body; [b] a matched pair of belts that extend from the cuts on both sides of said approximately convex shapes to the center on the front side of the body are indicated on said lid part; [c] a fixture with a ring shape formed at the tip is indicated at the position where the convex parts of said lid part and said matched pair of belts can be fixed at the same time at the upper center on the front side of the body; [d] a matched pair of auxiliary fixtures that fix the convex parts of said lid part and said belts at the same time are indicated at the outward positions from said keyhole-shaped cuts, and [e] parts of handles that extend to the actual handles sewed onto the top edge on the front side of the body and the top edge on the backside thereof are indicated on the front side of the body so that a pair of arc-like handles can be visually recognized in the upper part on the front side of the body and the upper part on the backside of the body, and said parts of the handle on the front side of the body are indicated so that they go through said keyhole-shaped cuts.

Photograph 4
(omitted)

Photograph 5
(omitted)

Photograph 6
(omitted)

(Attachment)

List of Plaintiff's Goods

A bag of a shape indicated in Photographs 1 to 3, which is characterized by the following: [i] the front side and backside of the body are of a trapezoidal shape whose base is slightly longer and each side of the body forms a vertically extended isosceles triangular shape; [ii] the lid part having cuts on both sides to form approximately convex shapes and having two vertical keyhole-shaped cuts in a manner such that they approximately laterally trisect the lid exists in the upper part on the front side of the body; [iii] a belt, whose edge parts are sewed onto the upper part on the backside of the body and which extends from the cuts on both sides of said approximately convex shapes to the upper part on the front side of the body, is provided; [iv] a fixture with a ring shape formed at the tip, which can fix the convex parts of said lid part and said belt at the same time at the upper center on the front side of the body, is provided, and a matched pair of auxiliary fixtures, which can fix the convex parts of said lid part and said belt at the same time at the outward positions from said keyhole-shaped cuts, are provided; and [v] a pair of arc-like handles are sewed onto the upper part on the front side of the body and the upper part on the backside thereof, and said handle on the front side is provided in a manner such that it goes through said keyhole-shaped cuts.

Photograph 1 (front view)

(omitted)

Photograph 2 (back view)

(omitted)

Photograph 3 (side view)

(omitted)

(Attachment)

List of Trademark Right

Registration number: No. 5438059

Filing date: March 6, 2008

Registration date: September 9, 2011

Class of goods: Class 18

Designated goods: Handbags

Registered trademark:

(omitted)