

Trademark Right	Date	December 14, 2023	Court	Osaka District Court, 21st Civil Division
	Case number	2020 (Wa) 7918		
- A case in which, with regard to the registered trademark consisting of the characters "Robot Shop", the court partially upheld the claims for an injunction and compensation for damage based on the trademark right.				

Summary of the Judgment

This is a case in which the Plaintiff, a holder of a trademark right for a trademark consisting of the standard characters "Robot Shop" (the "Trademark Right" and the "Trademark"), filed an action against the Defendant, alleging that the Defendant exhibits images of robots and provides advertisement, etc. on the Defendant's Goods with the Defendant's Mark (a mark in which the alphabetic characters "RobotShop" are arranged with no space between the adjoining characters, and a design like a gear is applied to each point where the characters adjoin and to each "o", and a design like screw holes is applied to "R", "b", "h", and "p") on the website, etc. managed by the Defendant, and that such acts of the Defendant constitute infringement of the Trademark Right. Based on this allegation, the Plaintiff seeks an injunction under Article 36, paragraphs (1) and (2) of the Trademark Act against the Defendant's act of using the Defendant's Mark when providing the service relevant to the exhibition of robots and act of providing advertisement and other information on the Defendant's Goods with the Defendant's Mark on the abovementioned website, etc., and also seeks compensation for damage under Article 709 of the Civil Code and return of unjust enrichment, etc. under Articles 703 and 704 of the same Code. In the course of the prosecution of the application relating to the Trademark, the Plaintiff received a notification from the Japan Patent Office (JPO) that the application shall be refused for reasons including that the use of the Trademark for the designated services in Class 35, such as retail sale of industrial robots, falls under Article 3, paragraph (1), item (iii) of the Trademark Act. Therefore, the Plaintiff excluded the relevant services from the scope of designated goods and services, and obtained the registration of the Trademark.

The issues of the case are as follows: [i] whether the Defendant's acts constitute the use of the Defendant's Mark for the designated goods and services; [ii] whether the Defendant's Mark is similar to the Trademark; [iii] whether the Trademark has an effect on the Defendant's Mark (applicability of the doctrine of estoppel); [iv] whether the Defendant's Mark falls under Article 26, paragraph (1), item (ii) of the Trademark Act;

[v] whether any damage occurred to the Plaintiff, and the amount of damage; and [vi] whether an injunction is necessary.

Regarding Issue [i], the court pointed out that: goods that cannot be regarded as robots or as goods similar to robots are included in the scope of the Defendant's Goods; and in light of the prosecution history of the application for the Trademark, it is against the doctrine of estoppel and therefore impermissible for the Plaintiff to allege infringement of the Trademark Right by reason of the use of the Defendant's Mark for the service of retail sale of goods similar to robots. Then, the court held that the Defendant cannot be deemed to use the Defendant's Mark for the service of "exhibition of robots," while holding that the Defendant provides advertisement, etc. on the Defendant's Goods with the Defendant's Mark. Regarding Issue [ii], the court found that the Trademark and the Defendant's Mark are similar to each other but denied the similarity between some of the Defendant's Goods and the designated goods of the Trademark. Regarding Issue [iii], the court held that in light of the prosecution history of the application for the Trademark, it is against the doctrine of estoppel and therefore impermissible for the Plaintiff to allege infringement of the Trademark Right by reason of the use of the Defendant's Mark for goods that are identical with or similar to robots among the Defendant's Goods. Regarding Issue [iv], the court held that the use of the Defendant's Mark does not fall under Article 26, paragraph (1), item (ii) of the Trademark Act and the Trademark Right has an effect on the Defendant's Mark. Based on the above, regarding Issues [v] and [vi], the court partially upheld the Plaintiff's claims against the Defendant for an injunction and compensation for damage.