

Trademark Right	Date	November 30, 2023	Court	Osaka District Court, 21st Civil Division
	Case number	2022 (Wa) 4903		
- A case in which the court upheld the Plaintiff's claims for an injunction, etc. based on its trademark right, holding that the Defendant has no right of prior use for the Defendant's Mark and that the Plaintiff's claims do not constitute an abuse of the right.				

### Summary of the Judgment

This is a case in which the Plaintiff filed an action against the Defendant, which engages in the funeral business, etc., alleging that the Defendant's acts, including its act of displaying a wall signboard with a mark "久宝殿" (the "Defendant's Mark"), infringe the Plaintiff's trademark right (the "Trademark Right") concerning the trademark "久宝殿" (the "Trademark"). Based on this allegation, the Plaintiff seeks an injunction against the display of the wall signboard, etc. and demands the destruction of the advertisement materials with the Defendant's Mark under Article 36, paragraphs (1) and (2) of the Trademark Act (the "Act").

The issues of the case are as follows: [i] whether the Defendant has the right of prior use for the Defendant's Mark; [ii] whether the Plaintiff's claims based on the Trademark Right constitute an abuse of the right; and [iii] whether an injunction and destruction are necessary (there is no dispute between the parties regarding the fact that the Trademark and the Defendant's Mark are similar to each other).

In this judgment, regarding Issue [i], the court held as follows. In light of the serious restriction that might be imposed on the effect of a trademark right in the case where the right of prior use is acknowledged, there may be room to interpret the geographical scope where the trademark is "well known among consumers" as referred to in the first sentence of Article 32, paragraph (1) of the Act more loosely than that under Article 4, paragraph (1), item (x) of the Act. However, the Defendant's Mark cannot be found to have actually been well known among consumers within the geographical scope where it was used for the Defendant's business (funeral business) at the time when the Plaintiff filed the application for registration of the Trademark. Holding as such, the court denied the Defendant's right of prior use.

Regarding Issue [ii], the court held that in light of the facts at the time when the Plaintiff filed the application for registration of the Trademark, the Plaintiff cannot be found to have had the intention to interfere with the Defendant's right and that the

exercise of the Trademark Right by the Plaintiff against the Defendant cannot be found to constitute an abuse of the right.

Then, regarding Issue [iii], the court also found the necessity of an injunction, etc., and in conclusion, it upheld all of the Plaintiff's claims.