



Frank Miura case and related issues

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Judge, IP High Court
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Overview

- ▶ 1. Judgement of IP High Court on “Frank Miura” case
- ▶ 2. “Similar” or “likely to cause confusion” in Trademark Act
- ▶ 3. Dilution issues under Japanese Law

1. Judgment of IP High Court on Frank Miura case

▶ (1) Facts

The registered trademark of DINKS

フランク ミュラー

The registered and used trademarks of FMTM

フランク ミュラー

FRANCK MULLER

FRANCK MULLER REVOLUTION

Judgment of IP High Court on Frank Miura Case

► FMTM's allegations for invalidation

(1) フランク三浦 is similar to **FRANCK MULLER**, which is FMTM's registered trademark. (4-1-11)

(2) フランク三浦 is likely to cause confusion in connection with the goods or services pertaining to a business of FMTM. (4-1-15)

Judgement of IP High Court of Frank Miura case

► JPO's decision (favorable to FMTM)

(1) Pronunciation フランクミヨ = **FRANCK MULLER**

(2) Appearances フランクミヨ ≠ **FRANCK MULLER**

(3) Concept フランクミヨ = **FRANCK MULLER**

DINKS' intention;

“consumers would recall FMTM's luxury watches when they see DINKS' watches.”

from (1), (2) & (3), フランクミヨ = **FRANCK MULLER**

Judgment of IP High Court on Frank Miura case

► Judgment of IP High Court (favorable to FMTM)

(1) Pronunciations フランクミヨウ = FRANCK MULLER

(2) Appearances フランクミヨウ ≠ FRANCK MULLER

(3) Concept フランクミヨウ ≠ FRANCK MULLER

(Japanese person) (foreign luxury brand)

from (1), (2) & (3), フランクミヨウ ≠ FRANCK MULLER

“Similar” or “likely to cause confusion” of Trademark Act

► “Similar” in Trademark Act

appearances, concepts & pronunciations

+ actual state of transaction activity ⇒

mislead or cause confusion on the source of
goods or services

(see “*Hyozan*” case)

“Similar” or “likely to cause confusion” of Trademark Act

► “likely to cause confusion” of Trademark Act

If the trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person, such trademark shall not be registered. (4-1-15)

in broad sense

“Another person” includes parent company, its subsidiary or affiliated company; members of a group of companies carrying out projects under the same indication.
(see “L’Air Du Temps” case)

⇒ confusion on the source of goods or services

“Similar” or “likely to cause confusion” of Trademark Act

► “Puma” vs. “Shi-sa”



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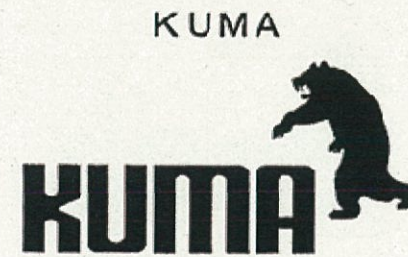


“Similar” or “likely to cause confusion” of Trademark Act

► “Puma” vs. “Kuma”



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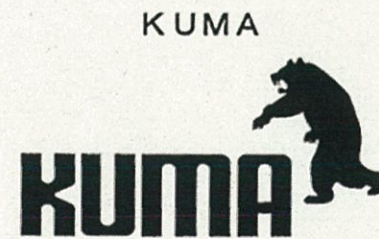
“Similar” or “likely to cause confusion” of Trademark Act



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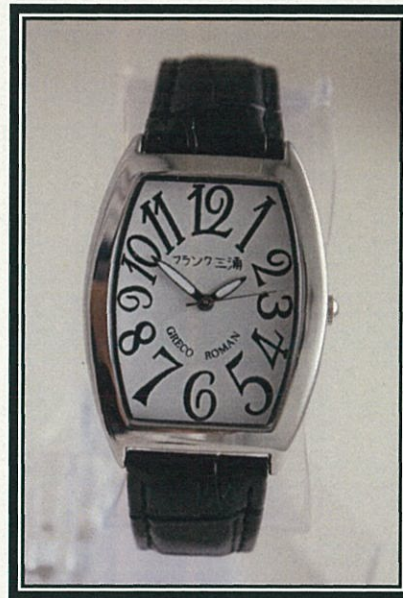


Dilution issues under Japanese Law

FMTM' watch

[NO PHOTO]

DINKS' watch



Dilution issues under Japanese Law

- ▶ Suppose cheap watches' trademark ("C") dilutes luxury watches' trademark ("L") by blurring and by tarnishment.
- ▶ Suppose consumers do not confuse the source of C's watches and L's watches.
- ▶ May company L seek for injunctive order or damage against company C ?

Dilution issues under Japanese Law

► Remedy under Trademark Act

The use of a trademark “C” infringes the registered trademark right “L”

when “C” is similar to “L”.

“similar” = “causing confusion concerning the source of products”

(note: broad interpretation by “L’Air Du Temps” case)

Dilution issues under Japanese Law

► Remedy under Unfair Competition Prevention Act

Article 2-1-1

“the act of creating confusion with another person’s goods or business by using an Indication of Goods or Business that is identical or similar to another person’s indication of Goods or Business that is well-known among consumers as belonging to that person” is an unfair competition.

Article 2-1-2

“the act of using an Indication of Goods or Business that is identical or similar to another person’s famous Indication of Goods or Business” is an unfair competition.

Dilution issues under Japanese Law

► “Similar” of Article 2-1-2 of Unfair Competition Prevention Act

“C” should be similar to “L”, if consumers would be likely to understand “C” and “L” are similar under the total observation, such as image, memory, association and so forth based on the both indications’ appearances, pronunciations and concepts. (See “*Man Power*” case)

⇒ “confusion concerning the source of products” is not necessary ?

Dilution issues under Japanese Law

- Special consideration for “parody” ?

Comparing with Lanham Act

15 USC 1125

Use in “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner” shall not be actionable as dilution by blurring or dilution by tarnishment.

References

“Frank Miura”	IPHC, April 12, 2016 (2015(Gyo Ke)10219) ★
“Hyozan”	Supreme Court, February 27, 1968 (1964 (Gyo Tsu) 110)
“L’Air Du Temps”	Supreme Court, July 11, 2000 (2008 (Gyo Hi) 85) ★
“Shi-sa”	IPHC, May 17, 2019 (2009 (Gyo Ke) 10404)
“Kuma”	IPHC, June 27, 2013 (2012 (Gyo Ke) 10454) ★
“Man Power”	Supreme Court, October 7, 1983 (1982 (o) 658)

English translations for ★cases are available in IPHC’s website.
<http://www.ip.courts.go.jp>

Thank you for your attention.