Trial decision

Invalidation No. 2010-890092

Italy

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The case of trial for invalidation of trademark registration for Trademark Registration No. 5256629 between the parties above has resulted in the following trial decision.

Conclusion

The trial of the case was groundless.

The costs in connection with the trial shall be borne by the demandant.

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5256629 (referred to as "the Trademark" below) is configured as indicated in the Attachment (1), and the application for its registration was filed on March 30, 2009. The decision for registration was made on July 8, 2009 by setting Class No. 12 "Automobiles and their parts and fittings" and Class No. 35 "Retail services or wholesale services for automobiles and their parts and accessories" as the designated goods and the designated services, and the trademark was registered on August 14, 2009. The trademark right is still valid as of now.

No. 2 The demandant's allegation

The demandant requested a trial decision such that "The Trademark is invalidated. The costs in connection with the trial shall be borne by the demandee". The demandant summarized and mentioned reasons as follows and submitted Evidence A No. 1 to A No. 5 as means of evidence. In addition, the demandant referred to Evidence A No. 5 to A No. 30 (referred to as "Evidence A No. X in the Opposition" below) submitted in the case of the

opposition to registration by the demandant relative to the Trademark (Opposition No. 2009-900423, referred to as "Opposition of this case" below).

1 Grounds for the request

(1) Prominence of Cited Trademark and the like

The trademark "LAMBORGHINI" owned by the demandant (referred to as "Cited Trademark" below) has been well-known and prominent worldwide as the abbreviation of the name of the demandant and has been a representative of a supercar fad in which supercars have gained worldwide popularity and took the world by storm from 1970 to 1980s. Regardless of its price of tens of millions of yen, the supercar manufactured and sold by the demandant was an object of envy by mania because of its excellent design and performance.

In addition, the demandant has a number of registered trademarks for not only the designated goods in Class No. 12 "Automobiles and their parts and fittings" but also other goods and services in the other classes regarding Cited Trademark, "AUTOMOBILI LAMBORGHINI", "LAMBORGHINI and a figure of a bull", and "AUTOMOBILI LAMBORGHINI and the figure of the bull" in Italy which is the home country and equal to or more than 103 countries and regions including Japan (Evidence A No. 5 in the Opposition to A No. 30 in the Opposition).

As described above, the demandant has continuously used Cited Trademark, "AUTOMOBILI LAMBORGHINI", "LAMBORGHINI and the figure of the bull", and "AUTOMOBILI LAMBORGHINI and the figure of the bull" since before the filing date of the Trademark (March 30, 2009) to the present regarding the goods "Automobiles" and has used them in a number of advertisements in the Internet, catalogs, magazines, and motor race competitions. As a result, Cited Trademark has been well-known and prominent between general consumers and traders in addition to manias as a trademark indicating the supercar of the demandant at the present as well as before the filing data of the Trademark.

(2) Applicability of Article 4(1)(vii) and Article 4(1)(xix) of the Trademark Act

The Trademark consists of designed Alphabetic characters of "Lambormini" which are horizontally written and a figure of "a tail of a bull" arranged on the upper side of the Alphabetic characters. Therefore, it can be easily assumed that the Trademark is made by combining the prominent Cited Trademark and an English word "MINI" having the

meaning of "compact". In addition, it can be easily assumed that the Trademark was conceived in consideration of the prominent trademark owned by the demandant based on the figure in which the tail part of the bull that can be recognized as a symbol of the demandant is arranged.

In fact, the holder of the trademark right of the Trademark (referred to as "the holder of the trademark right" below) advertises and sells a custom buggy (microcar) which is made by deforming the models of the worldwide prominent supercar of the demandant under the Trademark "Lambormini" in the homepage (Evidence A No. 3).

Furthermore, the holder of trademark right indicates in the homepage that "Ultimate custom buggy, eleven LAMBORGHINI lovers thought through" or "Lambormini!? Not LAMBORGHINI!?".

In addition, in a YouTube video site, the holder of trademark right uses the actual cars manufactured and sold by the demandant arranged side of the custom buggy to advertise the custom buggy made by deforming that model of the supercar.

Therefore, it is obvious that the holder of trademark right has unfair intention to take advantage of popularity of the prominent Cited Trademark. It is obvious that such an act is a free rider (free ride) for taking advantage of popularity of the prominent Cited Trademark and is an unfair act. Furthermore, in such a use mode, there is no need to describe that the consumers and the traders wrongly recognize as if the demandant allows the use of the Cited Trademark.

As described above, it should be said that to maintain the registration of the Trademark which is very similar to the prominent Cited Trademark violates general international trust and violates public order and morality.

Therefore, the Trademark falls under Articles 4(1)(vii) and 4(1)(xix) of the Trademark Act

(3) Applicability of Article 4(1)(x) and Article 4(1)(xv) of the Trademark Act

In a case where the Trademark which has the pronunciation and the meaning similar to those of the prominent Cited Trademark is used for the designated goods, the consumers and the traders would always confuse the source of the goods as if the good relates to the business of the demandant or a person in personnel or capital relation to the demandant.

Therefore, the Trademark also falls under the provision of Article 4(1)(x) and Article 4(1)(xv) of the Trademark Act.

In addition, when the maintenance of the trademark right registration of the Trademark having the pronunciation and the meaning very similar to those of the prominent Cited Trademark is approved, the confusion of the sources of the two trademarks cannot be avoided. Furthermore, to approve the maintenance of the trademark right registration of the Trademark violates the purpose of Trademark Act which protects business reputation integrated with the trademark which is actually used to ensure fair competitive order. There is no need to say that such an act is unfair.

When the registration of the Trademark is maintained and the Trademark is used, the use of the Trademark injures reputation of the demandant and customer attraction, and also damages the property value. Therefore, it is obvious that it is possible to damage the fair competitive order. It is natural that such a situation violates the purposes of Trademark Act and Unfair Competition Prevention Act and should not be allowed as a kind of torts.

(4) Closing

As described above, since the Trademark was registered while violating Articles 4(1)(vii), 4(1)(x), 4(1)(xv), and 4(1)(xix) of Trademark Act, the registration of the Trademark should be invalidated under the provisions of Article 46(1)(i) of the same Act.

2 Rebuttal against a reply

The demandant has not mentioned any rebuttal against the demandee's reply.

No. 3 The demandee's allegation

The demandee replied to request the case's trial decision to be the same as the conclusion, summarized and mentioned reasons for request as follows, and submitted Evidence B No. 1 to B No. 10 as means of evidence.

1 Opposition of this case

The demandant submitted Opposition of this case on November 4, 2009 regarding the Trademark. In the trial of this case, the demandant did not allege Article 4(1)(xi) of the

Trademark Act which has been alleged in Opposition of this case, and the allegations other than that and the means of evidence are the same as those in Opposition of this case.

In the determination in Opposition of this case, it has been recognized that "The Trademark does not fall under Articles 4(1)(vii), 4(1)(x), 4(1)(xi), 4(1)(xv), and 4(1)(xix) of Trademark Act" (Evidence B No. 2). The recognition is quite reasonable. Since the grounds for the request of the trial of this case are almost the same as Opposition of this case as described above, it is believed that the recognition in the determination in Opposition of this case is naturally maintained.

2 Regarding the allegation in the trial of this case, the demandee follows and cites the recognition in the determination in Opposition of this case and further adds the allegation below.

(1) Regarding Article 4(1)(xi) of Trademark Act

The demandant mentioned in the description on the evidences that Evidence A No. 2 proves that the demandant has Cited Trademark which has been registered regarding the goods "Automobiles and their parts and fittings" in Japan. However, although the demandant owns Trademark Registration No. 1507740 indicated in Evidence A No. 2 (trademark configured as indicated in the Attachment (2), referred to as "A No. 2 trademark" below) for Class No. 12 "Automobiles" and the like, the demandant does not alleges Article 4(1)(xi) of Trademark Act in the trial of this case. Although the demandant has alleged Article 4(1)(xi) of Trademark Act by citing A No. 2 trademark in Opposition of this case, it has been proved that the Trademark is not similar to A No. 2 trademark in the determination. Therefore, it is assumed that the request for the trial was made while focusing on the other constituent components to avoid the determination on the similarity of the trademarks to be the main theme in the trial of this case.

However, the determination on the similarity between the Trademark and A No. 2 trademark is still important in the trial of this case. "Non-similarity" between the Trademark and A No. 2 trademark can deny the application of Articles 4(1)(vii), 4(1)(x), 4(1)(xv), and 4(1)(xix) of Trademark Act without examining other requirements.

(2) Non-similarity between the trademarks

Regarding the non-similarity between the Trademark and the trademark "LAMBORGHINI (including the figure)" owned by the demandant

(According to the following demandee's allegation, it is not certain whether "LAMBORGHINI (including the figure)" owned by the demandant, which is described by the demandee" indicates "A No. 2 trademark" or "Cited Trademark". However, since the demandee did not mention the figure part at all in the allegation, "LAMBORGHINI (including the figure)" is expressed to as "Cited Trademark".)

A The Trademark is pronounced as "lanborumini" and is not pronounced as "lanborumiini" as insisted by the demandant. The characters of "mini" in the latter half and the pronunciation of "mini" are continuously connected in series to other Katakana words as a suffix and a prefix (Evidence B No. 3 and B No. 4).

In the examination practices in the Patent Office, it is assumed that the words of "mini" and "ミニ (mini in Katakana characters)" are connected to other word to from an integrated coined-word-like composite trademark (Evidence B No. 5 to B No. 7).

B Cited Trademark is pronounced as "lanborugiini" or "lanboruguhini" in series.

Incidentally, as indicated in each of Evidences A (Evidence A No. 2, A No. 4, A No. 5, and A No. 5 in the Opposition to A No. 30 in the Opposition), Cited Trademark is expressed in series as "LAMBORGHINI" without being abbreviated as "LAMBOR". Furthermore, "LAMBORGHINI" is derived from the name of the person "Ferruccio Lamborghini" (Evidence A No. 4) and is integrally used in Italy without being separated into "LAMBOR" and "GHINI".

C The pronunciation of the Trademark "lanborumini" and the pronunciations of Cited Trademark "lanborugiini" and "lanboruguhini" are pronounced in series because the number of sounds is six (seven) which is not so long and the pronunciations are pleasing to the ear.

In "lanborumini", "lanborugiini" and "lanboruguhini" pronounced in series in this way, the former half starts with "ra" which is an emphatic initial sound to be clearly pronounced with a largely opened mouth in the intonation, and weak sounds "nboru" to be ambiguously pronounced with a small opened mouth follow. Therefore, as in the Trademark and Cited Trademark, when emphatic sounds including a group of short sounds such as "mini", "giini", and "guhini" come in the latter half, the initial sound and the latter

half attract attention of viewers and give a strong impact.

The emphatic sound with strong impact in the latter half of the Trademark is "mini". Whereas, the emphatic sound with strong impact in the latter half of Cited Trademark is "giini" and "guhini". When sound qualities of both sounds are compared with each other, both sounds belong to lines different from each other in the Japanese syllabary. The sound of "mi" is an unvoiced sound including a bilabial and a nasal. Whereas, the sounds of "gi" and "gu" are voiced sounds each including a velar and a plosive. The sound qualities are remarkably different from each other. In addition, the sounds of "gi" and "gu" are emphasized by the following strong sound "ii" and weak sound "hi" and are strongly aurally perceived.

In this way, the Trademark and Cited Trademark are clearly distinguished from each other by a difference between the sound qualities of "mi" and "gi" and "gu" in "mini" and "giini" and "guhini" in the latter half having strong impact on intonation. This difference largely affects on the entire pronunciations of both trademarks which are relatively short, and both trademarks are not similar to each other and are not confused with each other.

In the field of Class No. 12 "Automobiles" which are the designated goods of the Trademark, the great majority of the trademarks consist of Alphabetic characters and Katakana characters, not Kanji and Hiragana characters. Therefore, the traders and the consumers have high power of observation, comprehension, and attentiveness relative to the Alphabetic characters and Katakana characters. Accordingly, the traders and the consumers can easily distinguish the Trademark and Cited Trademark of which the pronunciations, the meanings, and appearances are not similar to each other.

(3) Articles 4(1)(vii) and 4(1)(xix) of Trademark Act

A It is not clear whether Cited Trademark has achieved the fame and the prominent requested by Article 4(1)(xix) of Trademark Act based on Evidence A No. 4 and A No. 5. There is a question as to whether the fame of the company name is distinguished from the fame of the trademark and whether the fame between particular manias is clearly

distinguished from the fame between the general consumers and traders. In addition, since both the dates of the evidences are after the filing date (March 30, 2009) and the registration date (August 14, 2009) of the Trademark, the evidences are inadmissible (refer to Article 4(3) of Trademark Act).

Furthermore, in the "Searching Japanese Well-Known Trademarks" in the IPDL, Cited Trademark has not been contained (Evidence B No. 8).

B As described in (2), the Trademark is not similar to Cited Trademark. Obviously, there is no need to apply Articles 4(1)(vii) and 4(1)(xix) of Trademark Act.

C In adopting and applying the Trademark, there is no intention to previously apply the Trademark to sell the right, to prevent entry into Japan, to make an agency contract, to dilute a function for indicating the source, and to injure the reputation and the like.

The demandant's allegation such that the purpose of the application was "to make the consumers and the traders wrongly recognize as if the demandant allows the use of the Cited Trademark" cannot be acknowledged. The demandant did not submit any evidences and supporting materials indicating that the demandee had the purpose of gaining unfair profits and the purpose of causing damage to the other person intended by the Trademark Act.

Evidence A No. 3 has a wild leap of logic and is not worth to be evaluated. Further, Evidence A No. 3 is dated on September 30, 2010 which is later than the filing date and the registration date of the Trademark (refer to Article 4(3) and the like of Trademark Act). Therefore, Evidence A No. 3 is inadmissible.

D Therefore, the allegation of "violation of public order and morality" based on the above is groundless.

The demandant made the allegation based on "general international trust to protect prominent trademarks". However, this is a leap of logic, and Article 4(1)(vii) of Trademark Act has not been applied to such a case since the revision of the law in 1996 when Article 4(1)(xix) of Trademark Act has been newly established. Regarding Article 4(1)(vii) of the same act, court precedent indicating that application of Article 4(1)(vii) of the same act should be limited as the original one has been made (refer to Evidence B No. 9).

In this way, the Trademark does not fall under Articles 4(1)(vii) and 4(1)(xix) of

Trademark Act

(4) Articles 4(1)(x) and 4(1)(xv) of Trademark Act

A It is not clear whether Cited Trademark is a prominent trademark and whether Cited Trademark has achieved the fame requested by Articles 4(1)(x) and 4(1)(xv) of Trademark Act.

B Originally, the Trademark is not similar to Cited Trademark. There is no need to apply Articles 4(1)(x) and 4(1)(xv) of Trademark Act.

C Of course, the Trademark is not similar to Cited Trademark. Even when the Trademark is used for the designated goods, there is no reason that the consumers and the traders wrongly believe that the good is a good relating to the business of the demandant. There is no possibility that the consumers and the traders wrongly understand that the good relates to the business of a person in personnel or capital relation to the demandant.

The demandant did not submit any evidence in support indicating a possibility to cause "confusion in the source of the goods" (regarding judgment criteria and verification method, refer to Examination Guidelines in Japan (Evidence B No. 10)).

In this way, the Trademark does not fall under Articles 4(1)(x) and 4(1)(xv) of Trademark Act.

3 Closing

As described above, the Trademark does not fall under Articles 4(1)(vii), 4(1)(x), 4(1)(xv), and 4(1)(xix) of Trademark Act.

Accordingly, the registration of the Trademark shall not be invalidated under the provisions of Article 46 of the Trademark Act.

No. 4 Judgment by the body

1 Article 4(1)(vii) of Trademark Act

When it is determined whether the trademark falls under "the trademark which is likely to cause damage to public order or morality" in Article 4(1)(vii) of Trademark Act, in

a case where the trademark does not include letter(s) or a pattern which is(are) immoral, filthy, discriminatory or radical or which has an offensive impact on others, in consideration of the object of each of the provisions of Article 4(1)(xv) and 4(1)(xix) of Trademark Act, when whether the trademark is simply confused with the goods and the services relating to the business of other person, or whether the trademark is the same as or similar to the trademark which has been widely recognized by the consumers in Japan or other countries as a mark indicating the goods and the services relating to the business of the other person and is used for unfair purposes is inquired, the impediment described in Article 4(1) should be examined according to whether the requirements in Articles 4(1)(xv) and 4(1)(xix) of Trademark Act. It is not reasonable to understand that the trademark falls under the impediment in Article 4(1)(vii) based on the presence of the fact" (the determination 2010 (Gyo-Ke) 10040 by Intellectual Property High Court, rendition of decision on November 8, 2010)

When this applies to this case, the demandant alleges that ""LAMBORGHINI" (Cited Trademark) has been well-known and prominent as a mark indicating the goods "Automobiles (supercar)" relating to the business of the demandant since before the registration of the Trademark. Whereas, the Trademark is made by combining Cited Trademark and "mini" which means "compact", and in addition, the tail in "the figure of the bull" which can be a symbol of the demandant is arranged in the Trademark. Therefore, the Trademark is similar to Cited Trademark. The holder of trademark right performs an unfair act for free-riding on the prominent Cited Trademark. Furthermore, the use mode makes the consumers and the traders wrongly recognize as if the demandant allows the use of Cited Trademark. In this way, the maintenance of the trademark right registration of the Trademark which is very similar to the prominent Cited Trademark violates general international trust and the public order and morality".

The demandant's allegation is about the trademark registration impediment whether the requirements as provided in Articles 4(1)(xv) and 4(1)(xix) of Trademark Act are satisfied, and it should be determined whether the impediment of Articles 4(1)(xv) or 4(1)(xix) is satisfied based on whether the requirements have been satisfied. Therefore, it is not reasonable to understand that the Trademark falls under the trademark registration impediment as provided in Article 4(1)(vii) of Trademark Act based on the facts alleged by the demandant.

Accordingly, the demandant's allegation such that the Trademark falls under Article

4(1)(vii) of Trademark Act is not reasonable as a reason for the invalidation and cannot be accepted.

In addition, the Trademark does not include the letter(s) or the pattern which is(are) radical, filthy, discriminatory, or which has an offensive impact on others, and the Trademark does not fall under a case where use of the Trademark for the designated goods or designated services violates public benefit or general social norms, even if the configuration itself of the trademark does not. Furthermore, the Trademark does not fall under the trademark in question of which the use is banned by other laws, the trademark for insulting any particular country or its nation, or the trademark for violating general international trust. Therefore, it cannot be said that the Trademark is a trademark liable to contravene to public order or morality.

Therefore, the Trademark does not fall under Article 4(1)(vii) of Trademark Act.

2 Article 4(1)(xix) of Trademark Act

(1) As described in 1, the demandant alleges that the Trademark is made by combining the prominent Cited Trademark and "mini" which means "compact", and in addition, the tail in "the figure of the bull" which can be a symbol of the demandant is arranged in the Trademark, and accordingly, the Trademark is similar to Cited Trademark. Therefore, the demandant alleges that it is obvious that the holder of trademark right performs an unfair act for free-riding on the popularity of the prominent Cited Trademark and submitted Evidence A No. 3 and the like.

(2) Therefore, first, the similarity between the Trademark and Cited Trademark is examined.

A The Trademark

As indicated in the Attachment (1), the Trademark consists of the designed characters of "Lambormini" written in a unique letter in series in a shape of an arc. On the upper part of "o" in the characters, a figure is arranged which can be seen as a tail of an animal or a claw of a crab and cannot be understood as a specific subject. Since the entire character part of "Lambormini" in the configuration is understood as an integrated part in appearance, this gives rise to the pronunciation of "lanborumini". The character part does not evoke a familiar specific word directly. In addition, the word of "Lambormini" cannot be found in foreign languages which have been widely known in Japan. Therefore, it is reasonable to say that the character part is recognized as a kind of a coined word and does

not have a specific idea. Furthermore, since the figure written on the upper part of "o" in the Trademark cannot be understood as a specific subject as described above, the figure does not give rise to a specific pronunciation and meaning.

Therefore, it should be said that the Trademark gives rise to only the pronunciation of "lanborumini" corresponding to the character part of "Lambormini" in the configuration and does not have a specific meaning.

B Cited Trademark

Cited Trademark consists of the characters of "LAMBORGHINI". It can be acknowledged that Cited Trademark is pronounced as "lanborugiini" and has been widely recognized by the consumers in Japan as a mark displaying the goods "Automobiles (supercar)" relating to the business of the demandant.

Therefore, Cited Trademark gives rise to the pronunciation of "lanborugiini" corresponding to the characters, and it is reasonable to say that Cited Trademark evokes the name of the supercar "LAMBORGHINI" which is the good relating to the business of the demandant.

C Comparison between the Trademark and Cited Trademark

(A) Appearance

Based on the configurations described above, the Trademark is obviously different from Cited Trademark in appearance.

(B) Pronunciation

The pronunciation of "lanborumini" derived from the Trademark and the pronunciation of "lanborugiini" derived from Cited Trademark have the same sounds of "lanboru" and "ni" at the end. However, in the latter halves, the sound of "mi" is different from the sound of "gii". The sound of "mi" of the different sounds is a syllable in which a nasal consonant "m" which is pronounced by closing the lips and generating voiced breathing through a nasal cavity is combined with a vowel "i". The sound of "mi" is a soft sound. Whereas, the sound of "gi" is a syllable in which a voiced consonant pronounced by bringing the back of tongue into contact with the soft palate and releasing it is combined with the vowel "i". The sound of "gi" integrated with a long is the strongest sound in the pronunciation of "lanborugiini". Therefore, the different sounds are significantly different

not only in an articulation method but also in the sound quality and sound feeling. Accordingly, the different sounds largely affect on both entire pronunciations. When the pronunciations are pronounced in series, the tones and feelings of the words are different from each other, and it should be said that there is no possibility to mishear the pronunciations.

Therefore, it cannot be said that the Trademark and Cited Trademark are similar to each other regarding the pronunciation.

(C) Meaning

Since the entire configuration of the Trademark does not have a specific meaning, the Trademark cannot be compared with Cited Trademark in terms of the meaning.

D According to the above, it should be said that the Trademark and Cited Trademark are distinguishable from and non-similar to each other in terms of any of the appearance, the pronunciation, and the meaning.

(3) Unfair purposes

A Evidence A No. 3 is a homepage of the holder of trademark right (printed on September 30, 2010, that is, after the registration application filing date and the date of the decision of the Trademark), and the following descriptions were made in the homepage.

(A) "Ultimate custom buggy, eleven LAMBORGHINI lovers thought through/ Lambormini appears!", "Released on June 1, 2009", "Highly praised by Takeshi and Tokoro!", and "Dreamy custom machine by "Liberty Walk" famous for Ferrari and LAMBORGHINI in the supercar industry finally appears! Stuck and stuck to the shape to completely reproduce LAMBORGHINI!" (page 1).

(B) "Lambormini!? Not LAMBORGHINI!?/LB custom buggy that you cannot find it anywhere!", "First in Japan! First in the world? Full cowl four-wheeled ATV buggy", "Ultimately deformed special buggy/You can drive it on public roads without wearing a helmet", and "Special feature in the magazine Daytona! ..." (page 2).

(C) "Lambormini/ LB custom buggy that you cannot find it anywhere!", "Lambormini with well-deformed outline of MURCIELAGO. The remarkable details include aero parts, wings, a muffler, and the like of the LB performance which are completely reproduced....", and "Unique style of MURCIELAGO is realized by embedding

fog lamps for vehicle as headlights" (page 3).

B Evidence A No. 4 is an item of "LAMBORGHINI" in "a free encyclopedia "Wikipedia"" (printed on October 28, 2010 that is after the registration application filing date and the date of the decision of the Trademark), and the history of the demandant and the sales and models of the automobiles relating to the business of the demandant are described. In "Current model" in "model list", "MURCIELAGO/Gallardo/Reventón" are described.

C According to A and B, it can be acknowledged that the holder of trademark right has manufactured buggy cars having the body line, the headlights, the aero parts, the wings, the muffler, and the like which imitate those of "MURCIELAGO" that is one of the goods "Automobiles (supercar)" relating to the business of the demandant, and has sold the buggy cars since June 1, 2009 and that the characters of "Lambormini" and "ランボルミーニ (Lambormini in Katakana characters) have been displayed in the advertisement of the buggy cars in the homepage of the holder of trademark right.

Therefore, even if the shape of the buggy car manufactured and sold by the holder of trademark right is very similar to the shape of the model of "MURCIELAGO" of the goods "Automobiles (supercar)" relating to the business of the demandant, the Trademark is not similar to Cited Trademark as acknowledged in (2). Therefore, even if the holder of trademark right uses the Trademark for the buggy cars manufactured and sold by the holder of trademark right, it cannot be said that the act is performed with "unfair purposes" as set forth in Article 4(1)(xix) of Trademark Act.

Other evidence which indicates that the Trademark is used for the unfair purposes was not submitted.

(4) According to the above, it should be said that the Trademark does not fall under Article 4(1)(xix) of Trademark Act.

3 Articles 4(1)(x) and 4(1)(xv) of Trademark Act

As acknowledged in 2(2), the Trademark is obviously different from Cited Trademark in terms of the appearance, and the pronunciations of the Trademark and Cited Trademark are not similar to each other. In addition, commonality in the meanings cannot be found. It should be said that the Trademark is not similar to Cited Trademark.

Therefore, even when Cited Trademark has been widely recognized by the consumers in Japan before the application for the registration of the Trademark as a mark displaying the goods "Automobiles (supercar)" relating to the business of the demandant, in consideration of the size, content (manufacture and sale of imitated goods), and the like of the holder of trademark right, it is difficult to acknowledge that the holder of trademark right may be wrongly recognized by the consumers as a person having business, organizational or economical relation with the prominent demandant as a company for manufacturing and selling the Italian supercars. Therefore, even when the Trademark is used for the designated goods or the designated services, it cannot be acknowledged that the Trademark is a trademark which may cause confusion about the source of the goods and the services as if the goods and the services relate to the business of the demandant or a person in relation to the demandant.

Accordingly, the Trademark does not fall under Articles 4(1)(x) and 4(1)(xv) of Trademark Act.

4 Closing

As described above, the registration of the Trademark is not in breach of Articles 4(1)(vii), 4(1)(x), 4(1)(xv), and 4(1)(xix) of Trademark Act. Therefore, the registration of the Trademark cannot be invalidated under the provisions of Article 46 (1)(i) of Trademark Act.

Therefore, the trial decision shall be made as described in the conclusion.

August 24, 2011

Chief administrative judge: ASHIBA, Matsumi

Administrative judge: WATANABE, Kenji

Administrative judge: IDE, Eiichiro

Attachments

(1) The Trademark

(2) Registered trademark indicated in Evidence A No. 2 (A No. 2 trademark)