Trial decision

Invalidation No. 2010-890092

Italy

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The decision of the case of trial for invalidation of trademark registration for Trademark Registration No. 5256629 between the parties above made on August 24, 2011 came with a court decision of revocation of the trial decision (2011 (Gyo-Ke) 10426, rendition of decision on May 31, 2012) at the Intellectual Property High Court. Therefore, the case was proceeded further, and another trial decision was handed down as follows:

Conclusion

Trademark Registration No. 5256629 is invalidated

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

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. 8 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 Statement of the demand

(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 on the 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 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 allege 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 "la" 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

The demandant alleged that the Trademark falls under Articles 4(1)(vii), 4(1)(x), 4(1)(xv), and 4(1)(xix) of Trademark Act and submitted the evidences A. This point will be examined below.

1 Finding

(1) Use state of Cited Trademark, transaction state, and the like of the demandant

The demandant is an automobile company established in 1962 in Italy and a prominent world-famous company which mainly manufactures and sells luxury sports cars. The import of the automobiles manufactured by the demandant to Japan has been started since about 1968, and "Countach" has been called as a supercar and has become popular in 1970's. Cited Trademark of "LAMBORGHINI" which is a part of the name of the demandant was pronounced as "lanborugiini" as a mark indicating the demandant or the goods "Automobiles (supercar)" relating to the business of the demandant and has been widely recognized by dealers and fans of automobiles in Japan. The demandant has a number of registered trademarks for the automobiles and the like as the designated goods in equal to or more than 103 countries and regions including Japan regarding "LAMBORGHINI" which is Cited Trademark, "AUTOMOBILI LAMBORGHINI", "characters of "LAMBORGHINI" and the figure of the bull" (A No. 2 trademark and the like), and "characters of "AUTOMOBILI LAMBORGHINI" and the figure of the bull". From among the above, the A No. 2 trademark is characterized by the character part of "LAMBORGHINI" written in an upward arc shape. Furthermore, the figure of the bull characterized by a unique shape of a tail which is extended upward to be thin and long in an S-shape and a top end part drawn to be rounded and swollen (thin notch is provided in the lower right part) (Evidence A No. 2, A No. 4, and A No. 5).

(2) Use state of the Trademark, transaction state, and the like of the demandee

The demandee has advertised and sold the custom buggy formed by imitating the automobile manufactured and sold by the demandant by using the trademarks of "Lambormini" and "ランボルミーニ". Furthermore, the demandee indicates in the homepage that "Ultimate custom buggy, eleven LAMBORGHINI lovers thought through"/ Lambormini appears!", "Released on June 1, 2009", "Dreamy custom machine by "Liberty Walk" famous in the supercar industry such as Ferrari and LAMBORGHINI finally appears! Stuck and stuck to the shape to completely reproduce LAMBORGHINI!", "Lambormini !? Not LAMBORGHINI!?", "Lambormini /LB custom buggy that you cannot find it anywhere!", and "Lambormini formed by well-deforming the body line of Murciélago".

In addition, on YouTube which is an internet video sharing service, a video is uploaded in which the automobile manufactured and sold by the demandant and the custom buggy manufactured and sold by the demandee are arranged side by side. The demandee manufactures a custom buggy to which a trademark having Alphabetic characters "Lamborghini" (initial character L is capital, and other characters are lower-case letters) written in script (italic) is attached (Evidence A No. 3, A No. 6, and A No. 7).

(3) Appearance, pronunciation, meaning, and the like of Cited Trademark

Cited Trademark consists of Alphabetic characters "LAMBORGHINI" which are horizontally written, and the appearance of "LAMBORGHINI" which is the Alphabetic character can be visually perceived. Also, Cited Trademark may give rise to the pronunciations of "lanborugiini" and "lanboruguhini". However, since Cited Trademark has been widely recognized by the dealers and fans of the automobiles in Japan as a mark indicating the demandant or the goods "Automobiles (supercar)" relating to the business of the demandant as described above, it is understood that the pronunciation of "lanborugiini" is caused by the consumers.

In addition, Cited Trademark is expressed by Alphabetic characters and does not cause a specific meaning for normal Japanese people.

(4) Appearance, pronunciation, meaning, and the like of the Trademark

The configuration of the Trademark is as indicated in the Attachment (1).

The Trademark is a trademark including a character part in which Alphabetic characters "Lambormini" (initial character L is capital, and other characters are lower-case letters) are horizontally written in script (italic) with shadow to be sterically seen and in an upward arc shape and a figure part, drawn as a tail of an animal as a whole, which is extended upward to be thin and long in an S-shape from an upper part of the character "o" at the center of "Lambormini", and in addition, has the top end part which is rounded and swollen (thin notch is provided in the lower right part). In view of that the character part of the Trademark is larger than the figure part, it can be said that a part which gives strong impression to the viewers can be the character part.

It can be acknowledged that the character part of the Trademark gives rise to the pronunciation of "lanborumiini" in addition to the pronunciation of "lanborumini" since the demandee uses both of the Alphabetic characters of "Lambormini" and "ランボルミーニ" in Katakana characters in the homepage.

In addition, even if there is still room to evoke "mini", "small", and "compact" from "mini" in the latter half, the character part of the Trademark is written in Alphabetic characters in series, and a word corresponding to the character string does not exist in general. The customers cannot recognize and understand the meaning of the character part. Furthermore, it cannot be necessarily clearly understood what the figure part of the Trademark indicates. Therefore, the Trademark does not cause a specific meaning as a whole.

2 Judgment

(1) Applicability of 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 configuration of 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 or 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 are satisfied. 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 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) Recognition and determination on the similarity between the Trademark and Cited Trademark

The character part of the Trademark gives strong impression to the viewers. When the character part of the Trademark is compared with Cited Trademark, nine characters of ten characters in the character part of the Trademark are the same as those of Cited Trademark (note that the characters other than L is written in lower-case letters), and it can be said that a difference is a point such that "GH" positioned at the middle of Cited Trademark is "m" in the Trademark. The Trademark gives rise to the pronunciation of "lanborumini" or "lanborumiini". Whereas, Cited Trademark gives rise to the pronunciation of "lanborugiini". Only the sound of "mi" or "mii" in the Trademark is different from the sound of "gii" in Cited Trademark, and the different sounds, which have vowels in common, are similar to each other. Therefore, the Trademark and Cited Trademark are similar to each other in terms of the pronunciation.

The Trademark is characterized by the character style, and the figure part has been added. Although, in this point, the Trademark is slightly different from Cited Trademark in terms of appearance, it can be said that both trademarks are similar to each other as a whole.

According to the above, nine characters of ten characters in the character part of the Trademark are common to those of Cited Trademark, the different single sounds have the same vowels and are similar to each other in terms of pronunciation, and although both trademarks are slightly different from each other in terms of appearance, the trademarks are similar to each other as a whole. In addition to the above, when the use states, the transaction states, and the like of the demandant and the demandee are comprehensively determined, it is understood that the Trademark and Cited Trademark are similar to each other.

(3) Applicability of Article 4(1)(x) of Trademark Act

As described above, Cited Trademark has been widely known by the dealers and the fans of the automobiles in Japan as a mark indicating the demandant which is an Italian luxury automobile manufacturer or the goods "Automobiles (supercar)" relating to the business of the demandant since before the application of the Trademark up to the present time. Therefore, it can be acknowledged that Cited Trademark falls under the trademark which has been recognized by the consumers as a mark indicating the goods (automobiles) relating to the business of the other person. Furthermore, as described above, the Trademark is similar to Cited Trademark, and the designated goods of the Trademark include "Automobiles". Therefore, it can be acknowledged that the Trademark is similar to the trademark which has been widely recognized by the consumers as a mark indicating the goods (automobiles) relating to the business of the other person and falls under a mark used for the goods (automobiles).

Therefore, the Trademark falls under Article 4(1)(x) of Trademark Act.

(4) Applicability of Article 4(1)(xv) of Trademark Act

As described above, the demandant manufactures and sells "Automobiles (supercar) by using the trademark such as "LAMBORGHINI" which is Cited Trademark since before the application of the Trademark up to the present time. The Trademark is similar to Cited Trademark, and the designated goods of the Trademark include the same goods (automobile) for which Cited Trademark is used. The demandee manufactures and sells the custom buggy made by imitating the automobiles manufactured and sold by the demandant by using the trademarks of "Lambormini" and "ランボルミーニ (Lambormini written in Katakana characters)". By comprehensively considering the above points, it can be acknowledged that the Trademark falls under the trademark which is likely to cause confusion with the goods relating to the business of the other person.

Therefore, even if the Trademark does not fall under Article 4(1)(x) of Trademark Act, it can be acknowledged that the Trademark falls under Article 4(1)(xv) of Trademark Act.

(5) Applicability of Article 4(1)(xix) of Trademark Act

In addition, as described above, while recognizing that the demandant is the world-wide prominent automobile manufacturer, that Cited Trademark has been widely

recognized by the consumers as a mark indicating the goods (automobiles) relating to the business of the demandant, and that Cited Trademark is similar to the Trademark, the demandee registered the Trademark by setting automobiles and the like as the designated goods and manufactures and sells the custom buggy made by imitating the automobiles manufactured and sold by the demandant as actually using the trademarks "Lambormini" and "ランボルミーニ (Lambormini written in Katakana characters)". Therefore, it can be acknowledged that the Trademark is used by the demandee that had the purpose of gaining unfair profits, the purpose of causing damage to the other person, and other unfair purposes.

Accordingly, even if the Trademark does not fall under Articles 4(1)(x) and 4(1)(xv) of Trademark Act, it can be acknowledged that the Trademark falls under Article 4(1)(xix) of Trademark Act.

3 Closing

As described above, the Trademark was registered while violating Article 4(1)(x) of the Trademark Act. Even if the Trademark does not fall under the same Article, the Trademark was registered while violating Article 4(1)(xv) of the Trademark Act. In addition, even if the Trademark does not fall under Articles 4(1)(x) and 4(1)(xv) of the Trademark Act, the Trademark was registered while violating Article 4(1)(xix) of Trademark Act. Therefore, the registration of the Trademark should be invalidated under the provisions of Article 46(1)(i) of the same Act.

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

September 28, 2012

Chief administrative judge: MIZUGUKI, Wataru

Administrative judge: MAEYAMA, Ruriko

Administrative judge: KOBAYASHI, Masakazu

Attachment

(1) The Trademark

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