

Trial Decision

Revocation No.2020-300733

Demandant	Barracuda S. R. L.
Patent Attorney	ISHIHARA, Shinsuke
Patent Attorney	ISHIHARA, Shoji
Demandee	EURODIRECT Inc.
Patent Attorney	MATSUMOTO, Ryutaro

A trial decision for revocation of registration of the trademark with Registration No. 6167843 shall be made as follows.

Conclusion

The trademark registration No. 6167843 is cancelled.

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

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 6167843 (hereinafter, referred to as "the Trademark") is consists of the standard characters "Barracudamoto", the application for its registration was filed on January 16, 2019, and the trademark was registered on August 2, 2019 with "two-wheeled motor vehicles, bicycles and their parts and fittings" of Class 12 as its designated goods, which is actually remaining in effect.

No. 2 Cited Trademark

The trademark presented by the Demandant to prove that he has the right to the trademark in a country party to the Paris Convention, a member of the World Trade Organization, or a Contracting Party to the Trademark Law Treaty are as follows (hereinafter, collectively referred to as the "cited trademark").

1. European Union Trademark Registration No. 7023534 (A No. 10, A No. 29 to A No. 31) Mode of the trademark: as attachment 1

Designated goods: as attachment 2

Filing date: June 30, 2008

Registered date: January 30, 2011

2. UK Trademark Registration No.907023534 (A No. 11)

Mode of the trademark: as attachment 1

Designated goods: as attachment 2

Filing date: June 30, 2008

Registered date: January 30, 2011

No. 3 The Demandant's allegation

The Demandant requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request and rebuttal against a reply, and answer against a inquiry dated June 8,2021 as follows, and submitted Evidences A

1.Reasons of the demand

This Trademark must be invalidated in accordance with Article 53(2) of the Trademark Act.

(1) The Demandant is an Italian company that has been selling motorcycle-related products since 2002. Products are sold with the brand names “Barracuda” and “Barracudamoto” (A No. 2). In 2014, the Demandant started selling in Japan with the Demandee represented by Mr.Kazuto Nishijima (hereinafter referred to as "Mr. Nishijima") as an exclusive sales agent, and continued until 2019.

(2) On July 7, 2014, the Demandant informed the Demandee that he would like to include Japan in the list of "Official Barracuda Distributors in the World" in the new 2014/2015 edition catalog. However, the next day, the Demandee requested that the Demandee be listed in the Demandants catalog as an official distributor (A No. 3). In addition, from the fact that from August 6, 2014 to November 10, 2014, Mr. Nishijima stated that the Demandee would operate the website and stores related to barracudamoto.jp (A No. 4 to A No. 6), it can be found that the Demandee was the official distributor of the Demandant as of 2014.

(3) In 2019, the Demandant changed the position of the Demandee from an exclusive distributor to a distributor because the Demandee was not making as much commercial profit as the Demandant expected. Then, Mr. Nishijima told Demandant that he has the trademark registration of Barracudamoto, to give the domain name “Barracudamoto.jp” to the Demandee, and to stop using the trademark Barracudamoto in Japan unless the

Demandant returns the Demandee's position to exclusive distributor as before (A No. 7).

On February 6, 2020, Mr. Nishijima notified that the Trademark was registered as a Japanese trademark of the Demandee, and then notified that 1) immediately before taking legal action, pass the domain "barracudamoto.jp" to him, 2) he will use the trademark BARRACUDAMOTO to sell the Demandee's products in Japan and around the world, 3) he will promote the Demandee's products on the Demandee's Facebook named barracudamotojapan, 4) if he finds a Japanese company using BARRACUDAMOTO or BARRACUDA, the Demandee's lawyer will immediately suspend it (A No. 9).

(4) As is clear from the above, the trademark in question was applied for and registered in Japan by the Demandee, who was the Demandant's sales agent in Japan, without the Demandant's permission. The trademark in question is "a trademark related to the right of the Demandant who has the right to the trademark in Italy, which is a country party to the Paris Convention, or a trademark similar thereto, and the product related to the right or a similar product is designated as a designated product", and "the trademark registration was applied by an agent or representative without the consent of the Demandant who has the right to the trademark, or by the agent or by the Demandee who was the representative within one year before the date of the trademark registration application".

2. Reasons for the request

(1) Whether or not the Demandant is "a person who has a trademark right (limited to a right equivalent to a trademark right) in a country party to the Paris Convention, a member of the World Trade Organization, or a Contracting Party to the Trademark Law Treaty".

The Demandant is the right holder of the European Union Trademark No. 7023534 (A No. 10) and the UK Registered Trademark No. 907023534 (A No. 11) derived from the European Union Trademark.

The registered date of both trademarks is January 30, 2011, and as shown in Attachment 1, both trademarks are "BARRACUDAMOTO" (MOTO part is in white letters), and the designated goods includes the Class 12 "fittings of two-wheeled motor vehicles and mopeds".

Therefore, the Demandant is "a person who has a trademark right (limited to a right equivalent to a trademark right) in a country party to the Paris Convention, a member of the World Trade Organization, or a Contracting Party to the Trademark Law Treaty". Then, the trademark in question is a trademark similar to the trademark of a person who

has the right to the trademark (limited to the right equivalent to the trademark right) in the member of the World Trade Organization, and the designated product should be said to be the same or similar product as the product related to the right.

(2) Whether or not the registration of the trademark in question is “applied by its agent or representative or a person who was an agent or representative within one year before the application date of the trademark registration”.

The Demandee and "Euroe-Com Trading GmbH" (hereinafter referred to as "Euroecom") are companies of the same representative (Mr. Nishijima), although they have different legal personalities.

At the time of 2014, there was a relationship of trust between the Demandant and Mr. Nishijima of Euroecom in the practice of trading goods or services related to the trademark in question (A No. 3 to A No. 5).

Furthermore, as of January 10, 2019 (6 days before the application for trademark registration), it is clear that there was some kind of collaborative relationship in the Japanese market between the Demandant and Mr. Nishijima of Euroecom (B No. 1). In addition, on the following day, January 11 and on June 20, 2019, Mr. Nishijima of Euroecom admitted that he was a "sales agent" (A No. 15, B No. 17).

Then, on March 27, 2018 and July 15, 2019, Mr. Nishijima of Euroecom acknowledged the relationship between the Japanese Demandee and himself (A No. 8).

Therefore, it is clear that although the legal personality of the Demandee and Euroecom is different, they are the same representative company and that the registration of the trademark in question is “applied by its agent or representative or a person who was an agent or representative within one year before the application date of the trademark registration”.

(3) As stated in the demand for trial, the trademark registration application was filed "without the consent of the person who has the right to the trademark without justifiable reason".

3. Answer Against a Inquiry

(1) A. Euroecom, represented by Mr. Nishijima, operates the EC site "EuroNetDirect" and has its headquarters in Austria in Central Europe. Euroecom's Japanese companies and service stations are the Demandee (A No. 3, A No. 18, A No. 19).

The representative director of the Demandee is Mr. Nishijima (A No. 21), so the representatives of Euroecom and the Demandee are the same person.

B. From the sales contract in 2019 (B No. 4) between the Demandant and Euroecom, it is clear that the contract period was January 1, 2019 to December 31, 2019. In addition,

it is also clear from business practice that in order to close a sales contract for 2019, which is valid from January 1, 2019, the contract would be signed during 2018. The contract stipulates the terms and conditions of the sales tie-up between the Demandant for the Japanese market and Euroecom in 2019. Such a contract for setting an annual net purchase target amount and that target should not be created in September of the same year (trial decision note: the "description of evidence" submitted by the Demandee, related to B No. 4, includes "The title of the agreement presented by the Demandant in July 2019" and "Date of creation: September 2019", and a description of "creator: Demandant").

Therefore, the contract is a sales contract valid in the period from January 16, 2018 to January 16, 2019, which is included within one year before the filing date of the application for trademark registration. It is a sales contract valid from January 1 to January 16 of 2019.

(2) As of 2017, the Demandee admitted that he was selling the Demandant's products on a regular basis (A No. 22). In addition, within one year before the filing of the application for trademark registration, the Demandee stated and advertised in his blog article that the Demandee sells the Demandant's products, or sold the Demandant's products as a sales office. That is, it can be said that the Demandee was an agent who exclusively sold the Demandant's products (A No. 23 to A No. 27).

(3) Prior to 2019, the Demandant and Euroecom or the Demandee had a verbal sales contract, and admitted that Mr. Nishijima et al. are the exclusive distributors. Then, the representative of the Demandee (Mr. Nishijima) urged the Demandant to continue the exclusive sales by the Demandee in Japan on January 11, 2019, which is within one year before the date of the trademark registration application (A No. 15).

In addition, as described above, the Demandant's products were sold within one year before the date of the application for trademark registration by the Japanese Demandee (representative: Mr. Nishijima) as the sales office. The wholesaler of the Demandant's products is Euroecom, which is headquartered in Austria (represented by Mr. Nishijima) (A No. 18 to A No. 27).

In addition, as shown in the invoice (A No. 28) from the Demandant to Euroecom during the period from February 3, 2018 to January 14, 2019, which is included within one year before the filing date of the application for trademark registration, numerous Demandant's products are continuously wholesaled from Demandant to Euroecom on a monthly basis, including the cost of maintaining the website in Japan. In this way, from the fact that there are ongoing transactions between the Demandant and Euroecom during the above period and the Demandant eventually sold the Demandant's products to consumers as the sales destination of Euroecom in Japan, it is clear that the Demandant

is the agent who sells the Demandant's products exclusively in Japan. That is why, on January 11, 2019, Mr. Nishijima of Euroecom urged the Demandant to continue the exclusive sales in "Japan" (A No. 15), and on the 16th of the same month, the Demandee (represented by Mr. Nishijima) filed an application for trademark registration, and on June 18 of the same year, Mr. Nishijima of Euroecom stated that he had filed an application for trademark registration and urged the Demandant to continue the exclusive sales by the Demandee in "Japan" (A No. 7).

(4) Then, the sales contract (B No. 4) for 2019 between the Demandant and Euroecom is a sales contract valid from January 1, 2019 to January 16, 2019, with the period one year before the date of the application for trademark registration included. From this, it is clear that prior to the contract, there was an agreement (contract conclusion) regarding exclusive sales in Japan between Mr. Nishijima of Euroecom and the Demandant.

No. 4 The Demandee's allegation

The Demandee replied that he would seek a trial decision that the demand for trial of the case was groundless, and the costs in connection with the trial shall be borne by the Demandant, summarized and mentioned reasons for request as follows, and submitted Evidence B No. 1 to B No. 4 as means of evidence.

The Demandee has not expressed any opinion on the response to the rebuttal and the inquiry dated June 8, 2021.

1. The Demandant proved tentatively that the trademark (A No. 1) is the same as or like the brand of the Demandant, Barracuda and Barracudamoto, which is a company of Italy which is a country party to the Paris Convention. The products of the Demandant's motorcycle-related business are the same as or similar to the designated goods of the trademark in question (A No. 2). However, it is not proved that "the Demandant has the right to the trademark (limited to the right equivalent to the trademark right) in a country party to the Paris Convention, a member of the World Trade Organization, or a Contracting Party to the Trademark Law Treaty".

2. The Demandant is trying to assert / prove that the Demandee is the Demandant's agent (distributor) or a person who was the agent (distributor) within one year before the date of application for trademark registration (January 16, 2019), however, it is not enough to prove the above facts (A No. 3 to A No. 9).

(1) Even if the relationship between the Demandant and the Demandee as of 2014 is proved, the evidence cannot prove that the Demandant was the agent of the Demandee "at that time when the application was filed" and "within one year before the application

date (January 16, 2019)” (A No. 3 to A No. 6)

(2) In 2019, the Demandant made a "change in Austrian partnership” (B No. 1).

Here, to explain the business relationship between the Demandant, the Demande, and Euroecom, the Demandant is a manufacturer whose company manufactures and sells motorcycle-related products in Italy, and the Demande is a retail store which imports and sells motorcycle-related products in Japan. Euroecom is an Austrian corporation whose main business is to procure European products and sell them in Europe including Austria, while exporting them to Japan.

The Demande certainly sells the Demandant’s products in Japan. However, the Demande handles products from many motorcycle-related manufacturers, and the Demande places an order with Euroecom in response to a customer's order, then Euroecom procures those products in Europe and export them to the Demande from Austria (B No. 2, B No. 3).

Euroecom was the Demandant's "exclusive distributor in Austria" until January 2019, but between the Demande and the Demandant, since the Demande started the handling of the Demandant's products in 2014, there has been no direct business relationship such as ordering, receiving, and shipping products, and giving and receiving money such as payment. In addition, the Demande and the Demandant have never exchanged contracts. Due to its business form, the Demande was no more than a general importer/distributor (retail store), and the Demande was not in a close relationship as the Demandant’s agent (distributor).

The Demandant claims that the Demandant was an exclusive distributor, but the Demandant does not submit any documents showing transactions, contracts, etc. between the two, because there are no such documents. Mr. Nishijima, who is the representative of the Demande, and Mr. Nishijima of Euroecom are certainly the same person, but the Demandant does not distinguish or explain between the Demande and Euroecom. He deliberately confuses the two and develops his claim. It is presumed that this is because the Demandant himself/herself recognizes that there is no proxy relationship between the Demandant and the Demande.

Due to “The agreement presented by the Demandant in July 2019”, even after the filing date of the application for the trademark, the Demandant has requested the agreement on the Japanese market from Euroecom, not the Demande (B No. 4).

(3) The Demandant appears to be trying to prove that the Demande was the Demandant's exclusive distributor in the past. However, the affiliated organization shown in the signature of the e-mail "E-mail from the Demande to the Demandant, dated June 18, 2019" (A No. 7) is Euroecom, and "exclusive sales agent” refers to Euroecom's

"partnership in Austria". In addition, it is merely stated that the Demande is the official "Distributor of Euroecom" in Japan for the "BARRACUDAMOTO products" supplied by Euroecom to Japan (A No. 8). Furthermore, the Demandant has not proved any relationship between the Demandant and the Demande "within one year before the application date", which is insufficient to meet the requirements of Article 53(2) of the Trademark Act.

3. As mentioned above, depending on evidences A No. 1 to A No. 9 submitted by the Demandant, the Trial for Cancellation does not prove each requirement for the trademark to be revoked, and the Demandant's allegation that the trademark should be revoked pursuant to the provisions of Article 53(2) of the Trademark Act, is groundless.

No. 5 Judgment by the body

Article 53(2) of the Trademark Act stipulates that "Where a registered trademark is a pertaining to a right to a trademark (limited to a right equivalent to a trademark right) held by a person in a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty or a trademark similar thereto, and the designated goods or designated services thereof are goods or services pertaining to the said right or goods or services similar thereto, and further, the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by his/her agent or representative or by his/her former agent or representative within one year prior to the filing date of the trademark registration, the person who has the right pertaining to the trademark may file a request for a trial for rescission of the trademark registration." And it also stipulates, in order to implement the provisions of Article 6-7 of the Paris Convention, with the aim of strengthening the protection of those who have the right to the trademark in other country parties, etc., If without the approval of the person who has the right to the trademark in other country parties, etc., an agent or representative, etc. applies to Japan for a trademark that is in the same or similar range as the trademark, and if it is registered, the person who has the right pertaining to the trademark may file a request for a trial for revocation of the trademark registration.

Therefore, whether the registration of the trademark meets the requirements of the above clause will be examined below.

1. Whether the trademark in question is a trademark or a trademark similar thereto held by a person in a country party of the Union to the Paris Convention etc., and the designated goods are goods pertaining to those right or goods similar thereto.

(1) Who has the right to the trademark in a country party etc. to the Paris Convention

The Demandant is recognized as a corporation located in Italy, which is a country party of the Paris Convention (A No. 2), and as mentioned in the second item above, in the Office for Harmonization in the Internal Market (Trademarks and Designs), which is an country party etc. of the Paris Convention, (and current European Union Intellectual Property Office)the Demandant has the right to the trademark of European Union Trademark Registration No. 7023534 and UK Trademark Registration No. 907025344, which is a derivative trademark of the European Union Trademark, which was filed on June 30, 2008 and registered on January 30, 2011. The trademark right is still in effect (A No. 10, A No.11, A No. 29 to A No. 31). Then, it is recognized that the Demandant had the right to the trademark in a country party to the Paris Convention etc. on January 16, 2019, which was the time of filing the application for registration of the trademark.

(2) identity or similarity for trademarks and designated goods

A. Regarding the Trademark

As mentioned in the first item above, the trademark consists of the standard characters "Barracudamoto", which is not ready-made words listed in dictionaries and is recognized as a kind of coined word which has no specific meaning.

Therefore, the Trademark generates only the pronunciation of "Barracudamoto" corresponding to the entire configuration of characters, and does not generate a specific meaning.

B. Regarding the Cited Trademark

Cited Trademark has the configuration as shown in Attachment 1, which consists of laterally-written characters "BARRACUDAMOTO" (MOTO part is in white letters), and as same as the item A above, it generates only the pronunciation of "Barracudamoto" corresponding to the entire configuration of characters, and does not generate a specific meaning.

C. Similarity of the Trademark

Although there are differences in typefaces and lowercase/uppercase letters regarding characters other than the beginning of the word, the Trademark and the Cited Trademark have the same spelling of the characters, so they give the impression that they are similar in appearance.

In the pronunciation, both the Trademark and the Cited Trademark have the same pronunciation of "Barracudamoto", and in the meaning, the both do not generate a specific meaning so they cannot be compared.

Then, even if the Trademark and the Cited Trademark cannot be compared in terms of meaning, they give a similar impression in appearance and are the same in terms of

pronunciation. Therefore, considering these comprehensively, it is reasonable to judge those two trademarks are similar trademarks.

D. Similarity of the Goods

As mentioned in the first item above, the designated goods of the Trademark are the Class 12 "two-wheeled motor vehicles, bicycles and their parts and fittings". On the other hand, the designated goods of the Cited Trademark include Class 12 "Fittings for motorcycles and mopeds". So, it is clear that the Trademark and the Cited Trademark include the same or similar goods in the designated goods.

(3) Summary

As described above, the Trademark in question is "a trademark or a trademark similar thereto held by a person in a country party etc. to the Paris Convention, as stipulated in Article 53(2) of the Trademark Act, and the designated goods are goods pertaining to those right or goods similar thereto".

2. Whether or not the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by their agent or representative or by their former agent or representative within one year prior to the filing date of the trademark registration

(1) According to the evidence submitted by both parties and their allegations, the following facts are found.

A. Regarding the Demandant

The Demandant is a corporation located in Italy and has been manufacturing and selling motorcycle-related Demandant's products since 2002 (A No. 2).

B. Regarding Euroecom

Euroecom is a corporation that operates the EC site "Euronet Direct" and was established in August 2002 with its headquarters in Austria. The representative of Euroecom is Mr. Nishijima (A No. 19).

The above-mentioned EC site claims that users can "purchase cheaply" and that it has "safe Japanese support and domestic service stations" as its features. As a mail-order store specializing in motorcycle supplies and custom parts, they import genuine parts for motorcycles from Europe and sell and ship them directly to customers in Japan via the Internet (A No. 18).

C. Regarding the Demandee

The Demandee is Euroecom's "Japan Domestic Service Station", which was founded in August 2007 and its business is to "import/export and sales of motorcycle parts and supplies". The representative of Demandee is Mr. Nishijima (A No. 19, A No. 21).

The Demandee placed an order with Euroecom in response to a customer's order, then Euroecom procured those products in Europe and exported them to the Demandee from Austria (assertion by the Demandee).

D. Regarding Transactions and such Between the Parties

(A) Before January 15, 2018

a. On July 7, 2014, the Demandant sent an email to Euroecom that said the Demandant wanted to include Japan in the list of "Official Barracuda Distributors in the World" in the Demandant's new catalog (2014/2015 edition). The next day, Euroecom requested the Demandee to be listed in the Demandant's catalog and emailed the Demandee's name, address, email address, etc. (A No. 3). In fact, the Demandee was listed as "Eurodirect Co., Ltd" in the list of "Official Barracuda Distributors in the World" in the Demandant's catalog (2014/2015 edition) (assertion by the Demandee). In addition, Euroecom (Mr. Nishijima) sent an email to the effect that, "My company in Japan: The Demandee operates barracudamoto.jp" (A No. 4) to the Demandant on August 6th of the same year. On October 11th of the same year, he sent a "Barracudamoto.jp price list in JPN (Japanese Yen)" (A No. 5).

b. the Demandee stated in his blog article dated September 26, 2017, that "EuroDirect sells BARRACUDA products as an official retailer" (A No. 22).

(B) In the period within one year before the filing date of the application for trademark registration (from January 16, 2018 to January 16, 2019)

a. The Demandant issued invoices with a billing date of February 3, 2018 to January 14, 2019, which is within one year before the filing date of the application for trademark registration (hereinafter referred to simply as "within the period"), to Euroecom once to six times a month, for a total of 37 times (A No. 28).

For the invoice with the invoice number "403" whose billing date is February 15, 2018, in the "Decisione merce (translation: product description)" column, there is a description "WEB MONTHLY COST-most of February 2018 Japan (translation: web monthly fee February 2018, Japan)" (No 796, 1246, 1530, 1934, 2421, 2695, 2948, 3245, 3507, and 3756 invoices have similar descriptions).

In addition, for the invoice with the invoice number "3157" whose billing date is October 4, 2018, in the "Codice (translation: product code) / Destructione merce (translation: product description)" column, there are descriptions "KTM7119-18 / COPRICATENA (translation: chain cover)", "N1026-XN / MANOPOLA B-LUX NERO (coppia) (translation: handle B-LUX black (pair))", "N1026-XU / MANOPOLA B-LUX BLU (coppia) (translation: handle B-LUX blue (pair))", and in the "Sconti (translation: discount)" column, there is a description of "-50.00" for all products.

In addition, in all invoices within the period from February 3, 2018 to December 21, 2018, the above "WEB MONTHLY COST", and "-50.00" for all products except shipping cost are entered in the "Sconti (translation: discount)" column. On the other hand, the invoice with invoice number "50" with the billing date of January 14, 2019 has a description of "-40.00" in the "Sconti (translation: discount)" column. By the way, the invoice whose billing year is 2019 is only the invoice number "50".

b. Euroecom issued an invoice to the Demandeé which has descriptions "Order date: October 11, 2018", "BARRACUDA chaine cover KTM 790 DUKE | KTM7119-18", "BARRACUDA B-LUX Grip black | N1026-XN", "BARRACUDA B-LUX Grip blue | N1026-XU" in the "Product Name" column (B No. 2).

c. In the Demandeé's blog articles dated March 7, 2018, September 18, 2018 and September 19, 2018, the Demandeé advertises the Demandant's products and described himself as the "contact information" along with his web address and phone number (A No. 23 to A No. 25). In addition, the Demandeé started handling the Demandant's products on the EC site "Amazon.co.jp" since October 2, 2018 (A No. 26, A No. 27).

d. On March 27, 2018, Euroecom (Mr. Nishijima) sent an e-mail to the effect that "We have built a system to collect all small orders from European countries and send them to the Demandeé in Japan at once" to the Demandant (A No. 16).

e. In 2019, the Demandant did not produce the expected profits, so on January 10, of the same year, the Demandant sent an e-mail to the effect that "From January 1, 2019, Euroecom changed its position from an exclusive distributor in Austria to a distributor. We will offer a special discount of 40% so that Euroecom can continue to sell the Demandant's products. If the Demandant finds another partner to implement the exclusive program in Japan, the Demandant will terminate the partnership with Euroecom. At this time, this option is not available, so for now Euroecom can continue to sell Demandant's products in Japan." to Euroecom (Mr. Nishijima, et al.) (B No. 1, assertion by the Demandant). The next day (11th), Euroecom (Mr. Nishijima) sent an e-mail to the effect that "A new distributor in Japan will not be able to operate the Barracuda business smoothly." and "I can give us the last chance for the Demandant to change his mind and continue the exclusive sale in Japan." to the Demandant (A No. 15).

f. On January 16, 2019, the Demandeé filed an application for registration of the Trademark in question.

(C) After January 17, 2019

a. On June 18, 2019, Euroecom (Mr. Nishijima) sent an e-mail to the effect that "<Regarding the Trademark> The Demandant is not the trademark owner of "Barracuda" or "Barracudamoto" in Japan. Japan follows the principle of first-to-file. I filed the

trademark "Barracudamoto" application to the Japan Patent Office on January 16th.", and "If the Demandant returns us to the exclusive distributor / partner in the Japanese market again and gives a 50% discount, we are ready to promote the brand Barracuda again in Japan" to the Demandant (A No. 7). In addition, on the 20th of the same month, Euroecom (Mr. Nishijima) pointed out to the Demandant that "the Demandant's method of stopping the agency as a distributor in Japan is legally problematic." and recommended "Immediately restore the 50% discount with the agency" via e-mail (A No. 17).

b. A document dated July 15, 2019 from Euroecom (Mr. Nishijima) to the Demandant stated, "The products we purchased from BARRACUDAMOTO in Italy at a 50% distributor discount are for the Japanese market. All goods we receive will be handed over to the Japanese Demande, who is an authorized distributor of BARRACUDAMOTO" (A No. 8).

c. The trademark was approved for registration on July 18, 2019 with "two-wheeled motor vehicles, bicycles and their parts and fittings" of Class 12 as its designated product, then it was registered on August 2, 2019.

d. On February 6, 2020, Euroecom (Mr. Nishijima) sent an e-mail to the effect that "Barracudamoto" is our registered trademark in Japan and the Demandant doesn't have the legal right to request it", and "(a) Please give us the "barracudamoto.jp" domain as soon as possible before we take legal action against the Demandant, (b) We plan to sell our products in Japan and around the world using our trademark BARRACUDAMOTO, (c) Our products will be promoted on our Facebook barracudamoto Japan, (d) If we discover that another Japanese company uses BARRACUDAMOTO or BARRACUDA, our lawyers will immediately stop them", with attaching the certificate of trademark registration, to the Demandant. And Euroecom also notified that "If the Demandant wants us to return to the position of exclusive distributor in Japan as before, we may consider discontinuing our production planning for products using Barracudamoto. This is the last chance for the Demandant to receive my offer. This time, I believe the Demandant is smart enough" (A No. 9).

(D) Miscellaneous

In "2019 PURCHASE AND SALE AGREEMENT" (2019 sales contract) (B No. 4) which is presented by the Demandant, there is a description to the effect that "This contract stipulates a transaction relationship regarding a business alliance between the Demandant and Euroecom in the Japanese market," and as a condition of 2019, there are descriptions to the effect that "If the following conditions are met, Euroecom may be supplied the Demandant's goods at a special discount of 50% for 2019", and annual net purchase target as of December 31, 2019.

In addition, it describes to the effect that “the 2019 contract is a prior agreement for preparation for 2020”, “as of December 31, 2019, if Euroecom has not met its 2019 minimum net purchase target, the Demandant will exceptionally perform 40% discount to Euroecom in Japan for 2020. The Demandant is free to make sales partnerships with other importers for the Japanese market”, and “as of December 31, 2019, if Euroecom reaches the minimum net purchase target for 2019, they can continue to sell at a 50% discount for the Japanese market by concluding a new sales contract for 2020”. The contract has a stamp and a signature showing the name and address of the Demandant, but does not have the contract date or the signature of the contractor.

(2) According to the facts found in (1) above, it is appropriate to make the following judgments.

a. "A person who was an agent or a representative within one year prior to the filing date of the trademark registration"

The following facts are found: Euroecom has been the Demandant's official distributor since 2014, and in 2018, as the Demandant's exclusive distributor in Austria, continued to purchase Demandant's products at a 50% discount.

Euroecom sold genuine parts for motorcycles on its own EC site "Euronet Direct", while specified the Demandee as a "service station in Japan". In March 2018, Euroecom has built a system to collect all orders from European countries and send them to Japanese Demandee at once, and in October of the same year, the Demandant's products, such as "KTM7119-18 / COPRICATENA (translation: chain cover)" purchased at 50% discount, was exported from Euroecom to the Demandee as "BARRACUDA chaine cover KTM 790 DUKE | KTM7119-18". In addition, the Demandee also advertised various Demandant's products on the Demandee's blog in 2018, describing himself as the "contact information".

Then, although it is unclear how the products sold on the EC site "Euronet Direct" are shipped to customers, there is an ongoing transaction between the Demandant and his exclusive distributor, Euroecom during the period from January to December 2018. From March of the same year, all demandant's products exported from Euroecom to Japan was delivered to the Demandee, and in Japan, it can be said that the Demandant was the distributor of the Demandant's products as the "service station in Japan" of Euroecom. However, although we cannot confirm the fact that the Demandant and Euroecom or the Demandee had concluded a contract for an exclusive sales agent in Japan in writing, if the Demandee was in the position of the Demandant's exclusive sales agent, the Demandee could purchase the Demandant's products at a 50% discount. Considering the facts that Euroecom actually purchased the Demandant's products at the discount rate

during the period from January to December 2018, the Demande is positioned as a "service station in Japan" of Euroecom, the representative of Euroecom and the representative director of the Demande are the same person, as well as in the list of "Official Barracuda Distributors in the World" in the Demandant's catalog (2014/2015 edition), the name of the Demande was listed as a Japanese distributor. In the Demande's blog that introduces the Demandant's products in September 2017, there is a statement that the Demande is an authorized retailer of the Demandant's products, and in the document sent by Euroecom to the Demandant in July 2019, there is a statement that the Demande is an authorized distributor of the Demandant's products, a customary relationship of trust was formed between the Demandant and Euroecom and the Demande through continuous transactions, and it can be considered that the Demande was in a position to be incorporated into the sales system of the Demandant's products in Japan. And it can be inferred that the relationship continued until at least the end of 2018.

The "agent or representative of the person who has the right pertaining to the trademark", referred to in Article 53(2) of the Trademark Law, is not necessarily limited to the person who have a special contractual relationship such as a person who has concluded an agency contract with a trademark owner of another country party or who have a legal relationship, it should be interpreted that it also refers the person whose customary relationship of trust has been formed through continuous transactions and is incorporated into the sales system of foreign trademark owner's products in Japan, such as the person who continuously imports and sells, or has sold the products of trademark owners of other country party.

As described above, the Demande falls under "a person who was an agent or a representative within one year before the date of the application for trademark registration" specified in Article 53(2) of the Trademark Law.

b. Regarding "the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by the Demande"

The "just cause" stipulated in Article 53(2) of the Trademark Law is understood that there are cases where, for example, a person who has the right to a trademark has abandoned the trademark in that country to its agent, etc., or the person make them believe that the person is not interested in acquiring the rights to the trademark. So, it cannot be found that the application for registration of the trademark and the acquisition of rights are justified by the Demandant's allegations and their evidence. In addition, there is no evidence in the e-mail or document exchanged between the Demandant and Euroecom that the Demandant has consented to the Demande's application for registration of the

Trademark in Japan.

Rather, the Demandant changed the status of Euroecom on January 10, 2019 (a distributor who can purchase the Demandant's products at a 40% discount from an exclusive distributor who can purchase the Demandant's products at a 50% discount). 6 days after the change, on 16th of the same month, the application for registration of the trademark was filed by the Demandee. After that, from the fact that Euroecom told the Demandant that the trademark in question is "our registered trademark in Japan" and the Demandee requested to return the Demandee's position to an exclusive sales agent, it is acknowledged that Euroecom and the Demandee intended to file the trademark registration application and secure an advantageous position in the transaction in order to develop a transaction that is advantageous to them.

As described above, it can be said that the application for trademark registration was filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by the Demandee.

(3) Summary

As described above, the application for trademark registration is "filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by his/her agent or representative or by his/her former agent or representative within one year prior to the filing date of the trademark registration", as stipulated in Article 53(2) of the Trademark Law.

3. Regarding the Demandee's allegation

The Demandee alleges that since the Demandee started handling the Demandant's products in 2014, the Demandee has consistently had no direct business relationship between the Demandant, and has never exchanged contracts, as well as due to its business form, the Demandee insists that he is no more than a general importer / distributor (retailer).

However, as found above, there was an ongoing transaction between the Demandant and its exclusive distributor, Euroecom, during at least from January to December 2018, and all the Demandant's products exported to Japan from Euroecom were delivered to the Demandee, and the Demandee was the distributor of the Demandant's products in Japan as the "Japan Domestic Service Station" of Euroecom. Based on those facts, it should be regarded that a customary relationship of trust is formed between the Demandant and Euroecom / Demandee through continuous transactions, and the Demandee was in a position to be incorporated into the sales system of the Demandant's products in Japan.

Therefore, it should be said that the Demandeé falls under "a person who was an agent or a representative within one year prior to the filing date of the trademark registration" specified in Article 53(2) of the Trademark Law, then the above Demandeé's allegations cannot be adopted.

4. Conclusion

As described above, the trademark is recognized as a trademark or a trademark similar thereto held by a person in a country party to the Paris Convention etc., and the designated goods are goods pertaining to those right or goods similar thereto, and, the application for trademark registration is filed without the approval of the person who has the right pertaining to the trademark, without a just cause, by their agent within one year prior to the filing date of the trademark registration.

Consequently, the Trademark must be invalidated because it is recognized that all the requirements stipulated in Article 53(2) of the Trademark Law are satisfied.

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

November 17, 2021

Chief administrative judge: SATO, Matsue

Administrative judge: OMORI, Tomoko

Administrative judge: ISHIZUKA, Rie

Attachment

1 Cited Trademark

BARRACUDAMOTO

2 Designated Goods of Cited Trademark

Class 9

Goggles and masks for motorcyclists, parts and fittings therefor; protective helmets for motorcyclists, parts and accessories therefor; gloves, suits, footwear and special clothing for protection against accidents and fire for motorcyclists; anti-theft devices for motorcycles; protective reinforcements for shoulders, elbows, knees and back; electric components for motorcycles, anti-theft warning devices, electric batteries for motorcycles and mopeds, electric cables and electric cable junction boxes for motorcycles and mopeds, transmitters of luminous signals, revolution counters, speed indicators for motorcycles and mopeds.

Class 12

Fittings for motorcycles and mopeds; panniers adapted for motorcycles and mopeds, fairing, windscreens, visors, frames, hoods, shock absorbers, chains and chain pinions, brake pads, mudguards, chain covers, radiator covers and tyres for motorcycles and mopeds; frame and underside bumpers for motorcycles; adhesive protectors for motorcycle undersides and tanks; foot rests for motorcycles; plastic shields for motorcycles; luggage racks for motorcycles; saddle covers and tank covers for motorcycles; handlebars, handlebar grips, fastenings and stabilisers for motorcycle and moped handlebars; rearview mirrors for motorcycles and mopeds; tips and fairing for motorcycles; direction indicators for motorcycles and mopeds; licence plate holders for motorcycles and mopeds.