

Latest Court Decisions

2012:
[May]

- **Lamborghini Case (Cancellation Suit of Trial Decision)**

IP High Court 2012.5.31 H23(Gyo-Ke)10426

A Japanese company manufactured and sold single passenger custom buggies under the trademark "**Lambormini** (logo)" (right upper) resembling **LAMBORGHINI MURCIELAGO**.



Automobili Lamborghini SpA filed an Invalidation Trial against the Lamborimini trademark registration on the basis of their well-known trademark "**LAMBORGHINI** (logo)" (right lower).



However, the JPO dismissed the Invalidation Trial because the Japanese pronunciations of "Lamborimini" and "LAMBOROGHINI" are not confusingly similar and there was no fear of confusion.

Then, Automobili Lamborghini SpA filed the law suite before the IP High Court demanding the cancellation of the Trial Decision. However, the defendant, the Japanese company, did not file a Counter Statement and did not appear at the hearings. In that case, the allegation by the plaintiff was deemed to have admitted by the defendant.

«Under the Civil Procedure Code Art. 159, defendants who make no attempt to refute claims against them, in effect, are admitting guilt.»

Thus, the IP High Court cancelled the Trial Decision.

- a) The trademark "Lamborimini" was similar to "LAMBORGHINI" in the pronunciations.
- b) "LAMBORIGHINI" was well known in Japan.
- c) The defendant's "Lambormini" was liable to cause confusion with "LAMBORGHINI".
- d) The defendant had an unfair purpose in registering the trademark "Lamboromini".

- **The BRIDGE Case (Cancellation Suit of Trial Decision)**

IP High Court 2012.5.31 H23(Gyo-Ke)10348

The question is whether a mark for textbooks used at training workshops is a trademark for printed matters in Class 16 or a service mark for educations in Class 41.

A Cancellation Trial for non-use was filed against the registration for the trademark "**The BRIDGE**" specifying "education and instruction services relating to arts, crafts, sports and general knowledge" in Class 41.

The respondent, a US corporation, submitted as the proofs of use of the registered trademark by its licensees in USA and in Tokyo:

- ① Use of the trademark on the web-site in English by the licensee in USA.
- ② Books relating to the philosophy of religion as well as posters relating to correspondence study course thereof by the licensee in Tokyo. The trademark in use was “ブリッジ (bridge) ®” in Japanese Katakana letters while the registered trademark was in English.
- ③ Printed publications imported from USA titled “THE BRIDGE TO TOTAL FREEDOM”.

However, the JPO did not accept such materials as the proofs of use of the registered trademark because;

- ① the web-site could be accessed from Japan as well as English speaking countries. However, it did not mean to address to the Japanese consumers.
- ② the trademark “ブリッジ (bridge)” in use in Katakana letters on the books and posters was different from the registered trademark “The BRIDGE” in English.
- ③ the printed publications were delivered to the students in no association with the education of the philosophy of religion in Class 41. Therefore, the publications should be considered as the independent “printed publications” which belong to International Class 16.

However, the IP High Court cancelled the Trial Decision accepting the proof of use ③.

The Court said that the publications were imported as the teaching materials used only by the students and the number of the imported publications was not so much. They were not for the sales to an unspecified number of customers and therefore, they are not “printed matters” belonging to Class 16.

Rather, they should be regarded as “use” provided in Article 2-3-3 of the Trademark Law as “to affix a mark to articles to be used by a person who receives the services in the course of providing of the education services of the philosophy of religion”.

The trademarks appearing on the publications were;

- Ⓐ The title “**THE BRIDGE** TO TOTAL FREEDOM” on the front page.
- Ⓑ The last part “The Bridge®” in the sentence “The following are additional training services that may be done at various points on **the Bridge®**” appearing on the front page.
- Ⓒ The last part “The Bridge” in the sentence “The following are additional processing services that may be done at various points on **the Bridge**” appearing on the front page.

In addition, it was written in the lowest part of the front page that “ ... The Bridge, ... are trademarks and service marks owned by RTC (N.B. the trademark proprietor) and use with its permission”.

We fear that such uses in the book title and in the sentences might not be regarded as the “use” as the trademark without the last explanation regarding the trademarks.