

Latest Court Decisions

2014:

[January]

- **DNA Case** (Injunction & Damage Suit)

Osaka District Court 2014.1.21 H25(Wa)12386

[SUMMARY/INTRODUCTION]

The Plaintiff, a trademark proprietor of the registered trademark **DNA** (right) for bags in Class 18 and socks, gloves, headgear, belts etc. in Class 25, demanded the Defendant, K.K. YOKOHAMA DeNA BAYSTARS, a professional baseball team, to stop using the team logos as well as to pay the damages of 110,000,000 Yen. However, the Osaka District Court dismissed the Plaintiff's demand.

DNA

[CASE]

Yokohama DeNA Baystars sold bags, gloves, towels, caps and other goods bearing 19 trademarks in all containing the word "DeNA" including the following team logos.



You may see that the word "DeNA" in the Defendant's trademarks is written in different font design and font size from the other words "YOKOHAMA" and "BAYSTARS". In addition, the owner company of the baseball team was K.K. DeNA, an internet information processing company. Therefore, the Plaintiff alleged that the pronunciation of "dna" could be perceived solely from the Defendant's trademark which was confusingly similar to the Plaintiff's registered trademark "DNA".

However, the Court decided against the Plaintiff saying that the Plaintiff's trademark "DNA" was known as "deoxyribonucleic acid" which transmit genetic information. On the other hand, the Defendant's trademarks were understood as the logos of a professional baseball team locating in Yokohama city called as "Baystars", "Yokohama Baystars" or "Yokohama DeNA Baystars."

In addition, the Defendant's registered trademark "DeNA BAYSTARS"(word) was co-existing with the Plaintiff's trademark for the goods in Classes 18 and 25 and therefore, the Defendant's trademarks were not similar to the Plaintiff's trademark.

We have many trial decisions issued by the JPO regarding the sports teams' logos which were decided as dissimilar to the word marks.

TRADEMARK	SIMILARITY	TRADEMARK	CLASS	TRIAL NO.
	≠		3,14, 16,18	2006-22218
	≠		25	2005-24038
	≠	ORIOLE	25	2006-24042
	≠	REDS	16	H11-90903
	≠	WESTERN	16	H10-4108

• [Pierarejeunne Case](#) (Damage Suit)

Tokyo District Court 2014.1.31 H24(Wa)24872

[SUMMARY/INTRODUCTION]

The Plaintiff sold cosmetics bearing the trademark "**Pierarejeunne**" to the Defendant. Since the Defendant did not pay for the cosmetics, the Plaintiff registered the Defendant's trademark "**Pierarejeunne**" and demanded the Defendant payment of 103,950,000 Yen as the damages due to the trademark infringement.

[CASE]

The Plaintiff developed and manufactured Pierarejeunne cosmetics in accordance with the request by the Defendant since 2007. The Defendant paid to the Plaintiff 6 million yen as an advanced payment and the Plaintiff delivered the manufactured cosmetics to the Defendant. However, the Defendant did not make the remaining payment of 21,450,000 Yen and as the result, the Plaintiff was obliged to withdraw the goods from the markets and to hold them in stock.

If the Defendant registered the trademark Pierarejeunne, the Plaintiff could not sell the cosmetics in stock to others. Therefore, the Plaintiff registered the trademark Pierarejeunne by himself.

On the other hand, the Defendant continued selling the Pierarejeunne cosmetics even after they received a warning letter from the Plaintiff. Then, the Plaintiff sued the Defendant for the trademark right infringement and demanded the payment of 103,950,000 Yen as the royalty of 1.5% on the Defendant's sales amount of 6,300,000,000 Yen.

The Court recognized the Defendant's sales amount as 5,380,511,839 Yen and ordered the Defendant to pay 80,707,677 Yen corresponding to the royalty of 1.5% on the sales amount.

If the Defendant had registered the trademark Pierarejeunne, the Plaintiff could have demanded only the payment of the unpaid money for the goods.