

Latest Court Decisions

2017:

[March]

- ["WYNN" Domain Name Case \(Unfair Competition Suit Decision\)](#)
Tokyo District Court 2017.3.14 H28(Wa)11379

[SUMMARY/INTRODUCTION]

A hostess bar in Yokohama (Plaintiff) registered "**WYNN.CO.JP**" as its domain name on February 23, 2012. A well-known American resort facility management company, **Wynn Resorts** (Defendant), made a request to Japan IP Arbitration Center (JIPAC) demanding an assignment of the domain name "WYNN.CO.JP". On March 25, 2016, JIPAC issued the decision in favor of Wynn Resorts.

Then, the Plaintiff brought the case before the Tokyo District Court requesting the confirmation decision that the Defendant, Wynn Resorts, had no right to demand injunction against the Plaintiff under Article 2-1-13 of the Unfair Competition Prevention Law.

What was the Court decision ?

[Case]

Article 2-1-13 of the Unfair Competition Prevention Law provides as follows:

[Acts of Unfair Competitions]

Article 2-1-13: acts of acquiring or holding a right to use a **domain name(s)** that is identical or similar to another person's specific indication of goods or services (which means a name, trade name, trademark, mark, or any other indication of a person's goods or services), or the acts of using any such domain name(s), for the purpose of **acquiring an illicit gain** or causing injury to another person;

You will see that the point of issue of the case was as to whether or not the Plaintiff registered the domain name with the purpose of acquiring an illicit gain.

The Defendant, Wynn Resorts, filed on October 12, 2010 and registered on June 29, 2012 the trademarks in Japan for "**WYNN**" (in standard characters) and "**Wynn** (logo)" (right) in many classes. Their trademarks "WYNN RESORTS", "WYNN MACAU", "WYNN LAS VAGAS" were also registered before the Plaintiff's domain name registration.



Wynn Resorts also has the domain name registrations for "WynnJapan.com", "WynnResorts.com", "WynnLasVegas.com", "WynnMacau.com", "Wynn.asia" and "Wynn.tokyo".

Wynn Las Vegas Hotel established in 1989 is a luxury resort facility having approx. 2700 rooms, casinos, restaurants and spas. Wynn Macau Hotel established in 2005 also has approx. 1000 rooms.

Although there is no Wynn hotels in Japan, Wynn Las Vegas was introduced by many travel magazines and as the result, Wynn Las Vegas is now a longing travel destination by Japanese travelers.

Under these situations, the Tokyo District Court confirmed that the Defendant, Wynn Resorts, had a right to demand injunction against the Plaintiff since the Plaintiff registered the domain name "WYNN.CO.JP" with a purpose of acquiring an illicit gain as the reasons mentioned below.

- 1) Wynn Resorts brands were well known to Japanese people at the time of the Plaintiff's trademark being used, i.e. November, 2010.
- 2) The name "Wynn" was not a familiar name to Japanese people and there was no justifiable reason why the Plaintiff adopted such an unfamiliar name as the trademark and the domain name for the hostess bar.
- 3) The trademark logo used for the Plaintiff's hostess bar was quite similar to the Defendant's "Wynn" logo trademark. Especially, the both trademarks were used in gold color.
- 4) While the WYNN brands were world-widely renowned, the Plaintiff's business was a hostess bar that had no relation to the Wynn Resorts' business.
- 5) In view of the above facts, it should be said that the Plaintiff had the purposes to obtain the illicit gain utilizing the publicity of the Wynn brands and to injure and dilute the brand equity of Wynn Resorts.