

## Latest Court Decisions

2018:

[February]

• SHOEI Case (Injunction Suit)

Tokyo District Court 2018.2.28 H29(WA)39594

### **[SUMMARY/INTRODUCTION]**

The trademark "SHOEI" (right upper) is well known for motor sports helmets and is registered for "protective helmets for sports, etc." in Class 9 under No. 1780508 dated June 25, 1985.



Since the trademark "SHOEI" is well known, it is also registered as a **Defensive Mark** under Article 67 of the Japanese Trademark Law for "labels, stickers, seals" in Class 16 under No. 1780508-1 on August 15, 1997.

A Japanese corporation, Kabushiki Kaisha SHOEI, the owner of the registered trademark and the defensive mark "SHOEI" filed an injunction suit against the Defendant, a Japanese individual, who sold 4 stickers on one paper sheet bearing the "SHOEI" mark (right lower) at the Yahoo Auction at 1800 Yen among 20 stickers obtained by the internet shopping.



In addition, the Plaintiff also demanded the Defendant payment of 500,000 Yen as their damages that were equivalent to the attorney fees for this suit.

What was the Court decision ?

### **[Court Decision]**

- (1) The Defendant should not assign, deliver, display for the purpose of assignment or delivery, export or import goods to which the mark is affixed.
- (2) The Defendant should pay to the Plaintiff 100,000 Yen as the compensation of the damages.

### **[COMMENTS]**

The Defensive mark registration system to protect a well-known trademark for goods or services other than those for which the trademark is well known, would be one of the unique trademark system among various trademark systems in the world.

It has been rather difficult to register a trademark as a defensive mark since extremely high recognition degree is required. As of June 30, 2018 the number of 1,120 defensive marks are registered.

The Articles relating to the Defensive mark are as follows.

**【Article 64: Requirements for defensive mark registration】**

1. Where a registered trademark pertaining to goods is **well known** among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods **other than the designated goods** pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods **is likely to cause confusion** between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.

**【Article 67: Acts deemed to constitute infringement】**

The following acts shall be deemed to constitute **infringement of a trademark right** or an exclusive right to use:

(1) the use of the registered defensive mark in connection with the designated goods or designated services;

Article 67-(1) means that if a registered Defensive mark is infringed for its specified goods or services, it will be regarded as an infringement of the basic well-known trademark to be protected.

In the subject SHOEI case, the registered Defensive mark was infringed for the goods "stickers" in Class 16, it was regarded as the infringement of the basic trademark "SHOEI" for "protective helmets for sports, etc." in Class 9.

It should be noted that use of a similar trademark to a registered Defensive mark does not constitute an infringement. Also, use of an identical trademark to a registered Defensive mark for similar goods or services to the registered goods or services for a Defensive mark does not constitute an infringement.

If a similar trademark to a Defensive trademark is used for similar goods or services to those of a Defensive mark, the owner of the Defensive mark (=the owner of the well-known trademark) will take legal actions according to the Unfair Competition Prevention Law.

A Defensive mark is not subject to a cancellation trial for non-use because a defensive mark has no legal obligations to use for its specified goods as registered as a defensive mark. A Defensive mark is registered only to protect the basic well-known trademark.