

Infringement cases study (Trademark and copyright)

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訴えの提起 (LITIGATION OF SUIT)

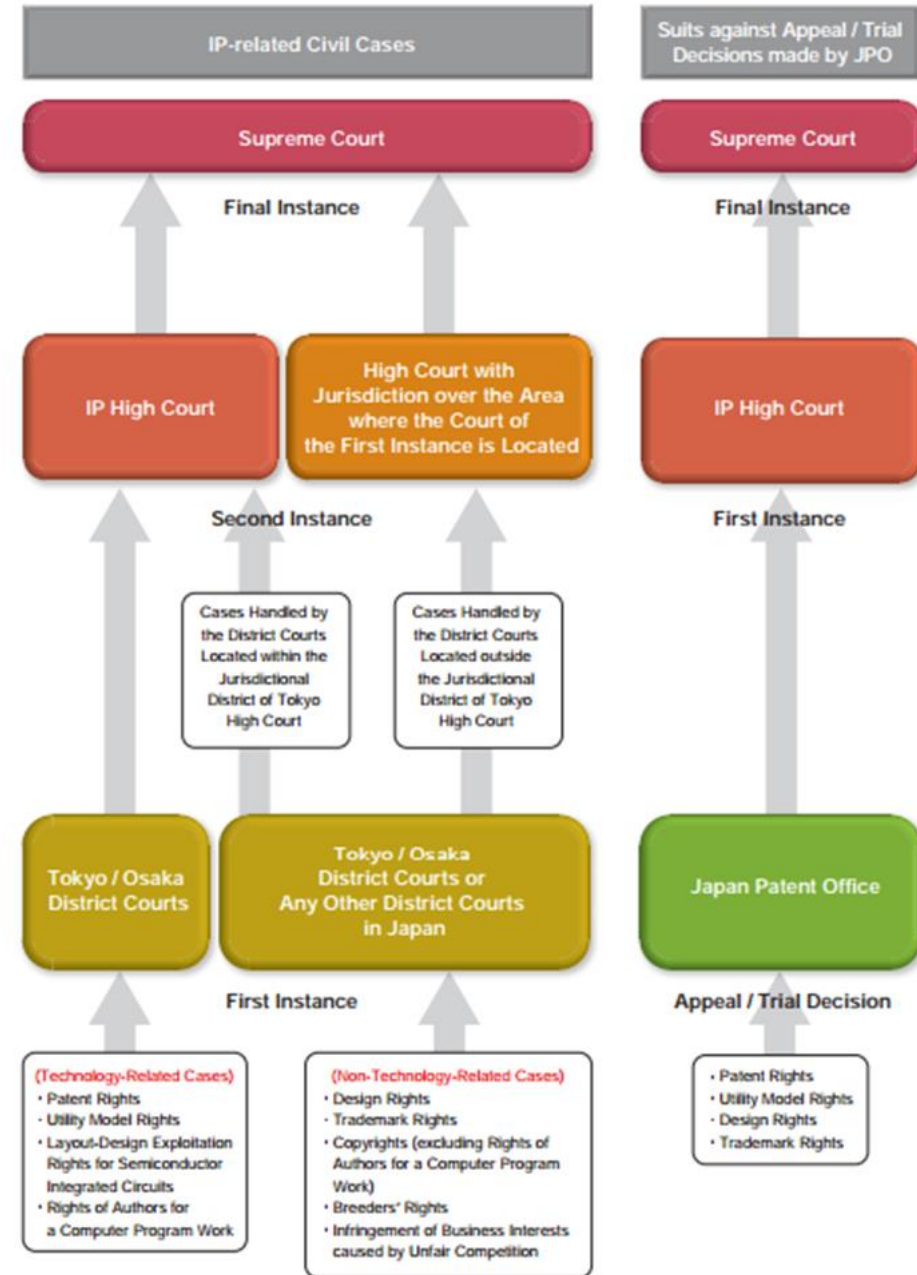
Contents of the documents

- Party's name
- Claim
- Relevant rights
- Reason of the claim
- Official fee

	Official fee	訴えの提起		控訴の提起		上告の提起	
訴額(amount in controversy)		litigation of suit		Second Instance		Final Appeal	
¥100,000	US\$870	¥1,000	US\$9	¥1,500	US\$13	¥2,000	US\$17
¥500,000	US\$4,348	¥5,000	US\$43	¥7,500	US\$65	¥10,000	US\$87
¥800,000	US\$6,957	¥8,000	US\$70	¥12,000	US\$104	¥16,000	US\$139
¥1,000,000	US\$8,696	¥10,000	US\$87	¥15,000	US\$130	¥20,000	US\$174
¥1,200,000	US\$10,435	¥11,000	US\$96	¥16,500	US\$143	¥22,000	US\$191
¥1,600,000	US\$13,913	¥13,000	US\$113	¥19,500	US\$170	¥26,000	US\$226
¥2,000,000	US\$17,391	¥15,000	US\$130	¥22,500	US\$196	¥30,000	US\$261
¥3,000,000	US\$26,087	¥20,000	US\$174	¥30,000	US\$261	¥40,000	US\$348
¥5,000,000	US\$43,478	¥30,000	US\$261	¥45,000	US\$391	¥60,000	US\$522
¥10,000,000	US\$86,957	¥50,000	US\$435	¥75,000	US\$652	¥100,000	US\$870

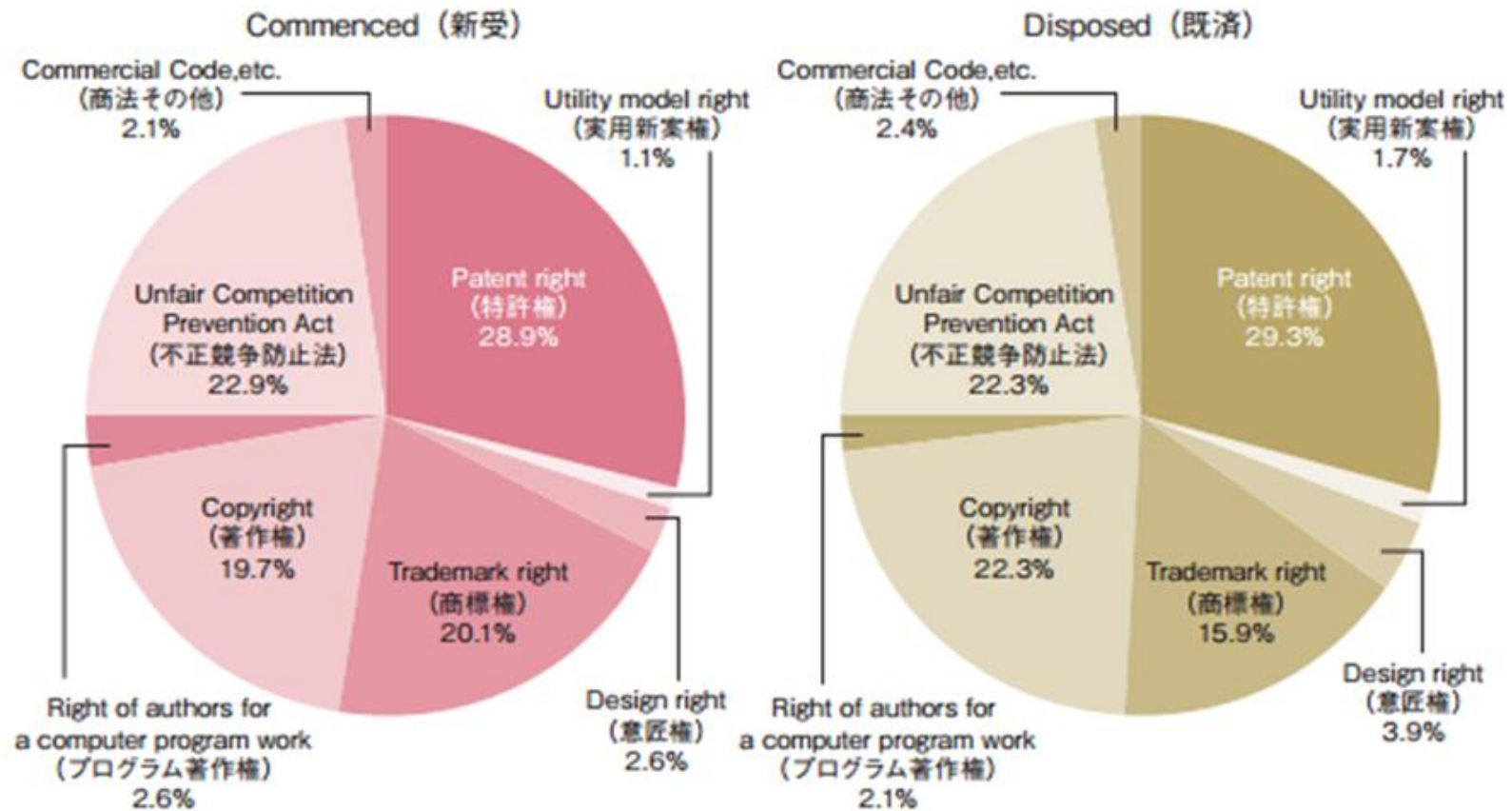
Litigation flow chart

Jurisdiction over IP-related Litigation



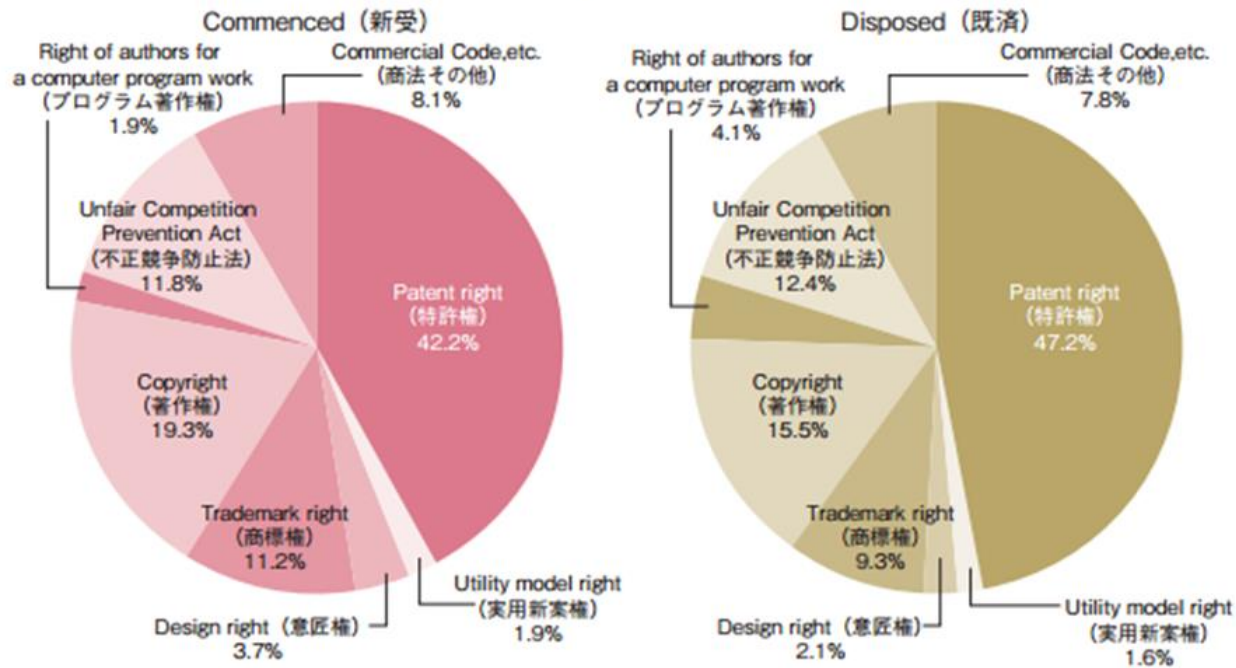
Statistics

— All District Courts (2015) 全国地方裁判所 (平成 27 年) —



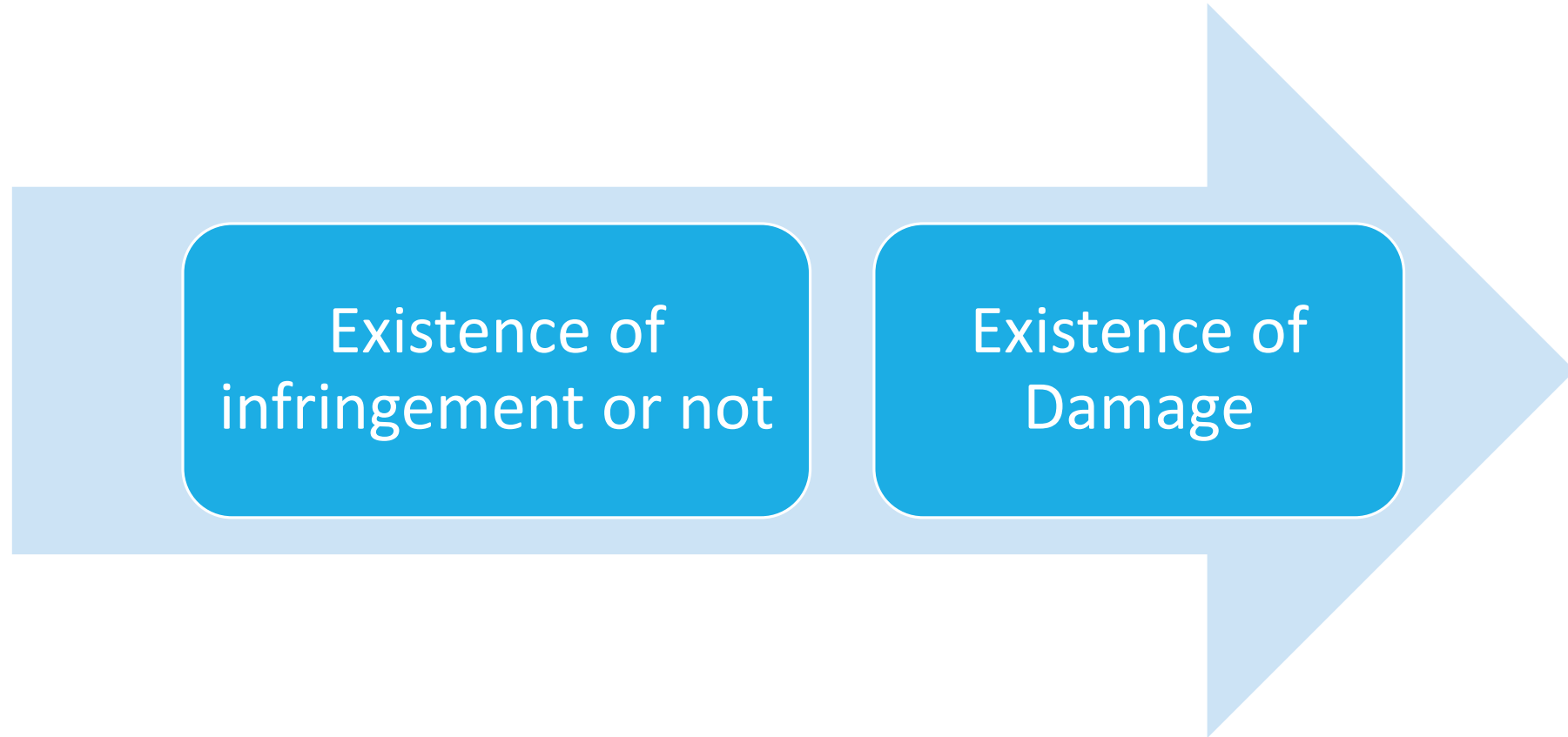
Statistics High Court

—— All High Courts(2015) 全国高等裁判所(平成27年) ——



Since the number is rounded to the nearest tenth, the total might not be 100.
小数点以下第2位を四捨五入している。したがって、合計が100と一致しない場合がある。
Above figures are reported by the Administrative Bureau of Supreme Court of Japan.
(最高裁判所行政局調べ)

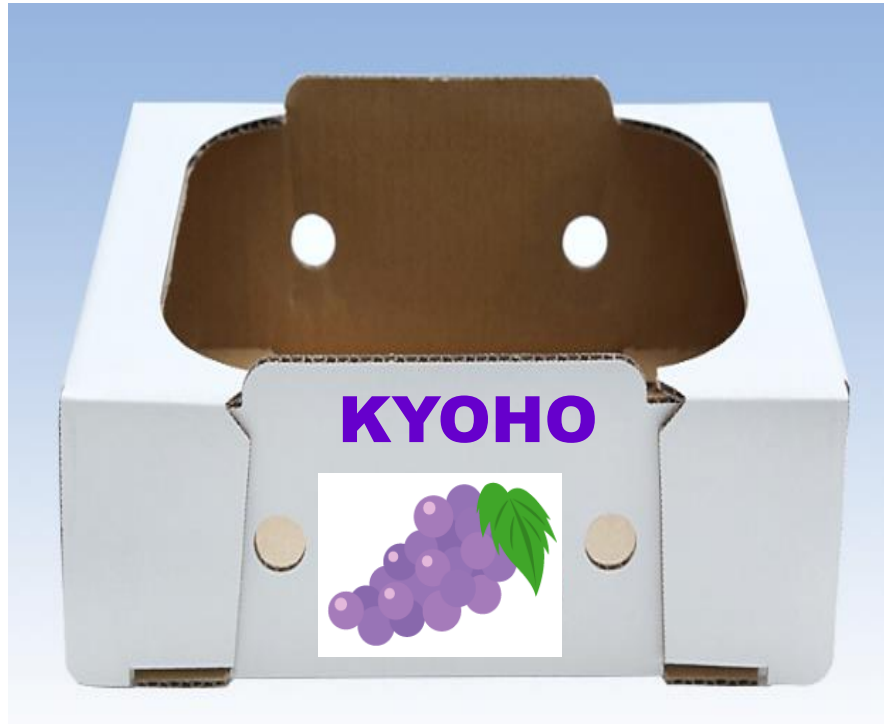
Process of infringement case



包装容器に付された商標の使用①

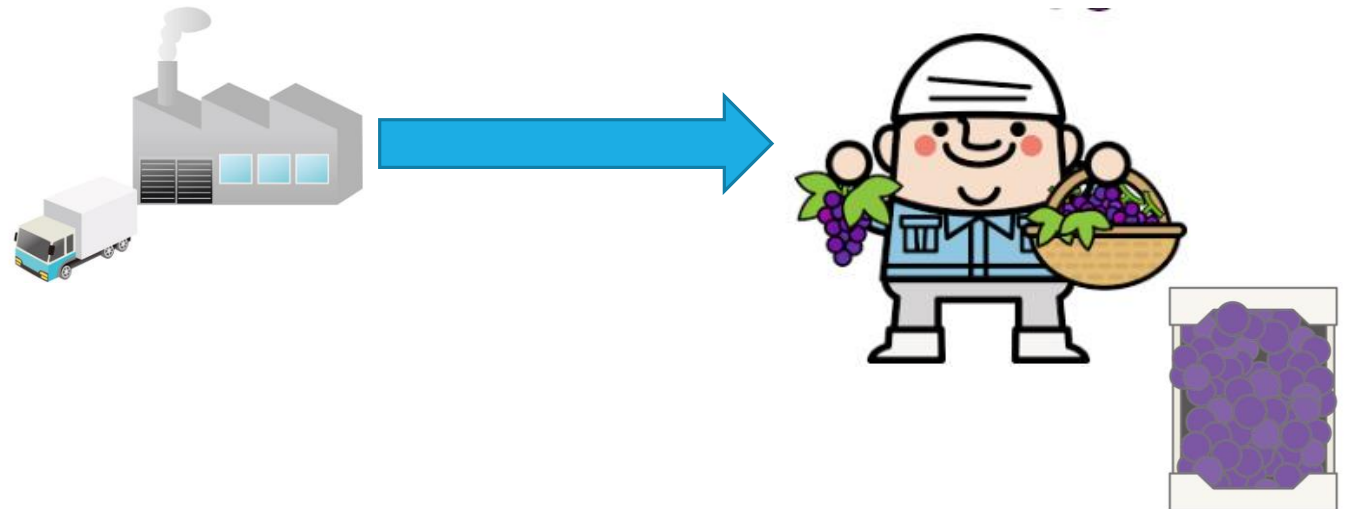
(Use on the Packaging containers of paper)

KYOHO case (1971 (yo)41)



Plaintiff: Trademark owner
TM “KYOHO” (goods/ Packaging
containers of paper)

Defendant: manufacture of container of paper



包装容器に付された商標の使用①

(Use on the Packaging containers of paper)

Definition of “trademark” : word, device, etc.

Definition of “use”:

Defendant’s act:

Use of the mark “KYOHO” on the designated goods “containers of paper”

Conclusion:

Mark “KYOHO” attached on the container is indicating the goods in the containers, not indicating the containers. Then Defendant’s act shall not be deemed as use of the mark for the goods, packaging containers of paper.

特定機種との適合性を示すための使用 (Use a mark for showing compatibility)

“brother” case 2003(wa)29488



Plaintiff: trademark owner “brother” for ink ribbon

Defendant: Manufacture of replacement ink ribbon



Use the mark “brother” for indicating it can be useful for facsimile machine of Brother.

商標的使用か否か (use of the mark or not?)

Whether Defendant's act is infringement of the trademark right or not is examined based on whether the mark is demonstrating the trademark function or not.

Elements: purpose of trademark act “Why we need to protect trademark?”

What are trademark functions?

- Distinguish one from the other
- Guarantee of quality of goods,
- Showing source of origin
- Advertisement

登録商標が付されたインクボトルの詰め替え (Refilling ink to ink bottle)

RISO Ink bottle case 2003(ne)899



Plaintiff: Trademark owner for ink

Defendant: Providing services of refilling ink to the bottle

YのYインクの販売行為が市場における取引者、需要者の間に「本件登録商標が付されたインクボトルに充填されたインクがXを出所とするものである」との誤認混同のおおれを生じさせていることは明らか。

権利者から購入した商品の小分け (subdivision of the goods bought)

MagAmp K case 1992(wa) 11250



Plaintiff: trademark owner

Defendant's act:

Purchased the genuine goods, subdivision of the goods, selling to other.

Presumption of amount of damage

損害額計算容易規定(商標法38条)

Article 38 Where a holder of trademark right or of exclusive right to use claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, and the infringer assigned the goods that composed the act of infringement, the amount of damage sustained by the holder of trademark right or of exclusive right to use may be presumed to be the amount of profit per unit of goods which would have been sold by the holder of trademark right or of exclusive right to use if there had been no such act of infringement, multiplied by the quantity of goods assigned by the infringer (hereinafter referred to as the “Assigned Quantity”), the maximum of which shall be the amount attainable by the holder of trademark right or of exclusive right to use in light of the capability of the holder of trademark right or of exclusive right to use to use such goods; provided, however, that if any circumstances exist under which the holder of trademark right or of exclusive right to use would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of goods not able to be sold due to such circumstances shall be deducted.

Damage = “Assigned Quantity (by infringer)” * the amount of profit per unit of goods (on holder’s side)

Presumption of amount of damage

損害額計算容易規定(商標法38条)

(EX) 38(1)

Infringer's sales amount: 1,000 unit

Infringer's goods price: 500 US\$

Holder's sales amount before the infringer started infringing: 2000 Unit

Holder's sales amount after the infringer started selling goods: 1500 Unit

Holder's profit per unit of goods: 50US\$

Damage based on Section 38 (1) = 1,000 * 50US\$

“Assigned number ” * the amount of profit per unit of goods

Presumption of amount of damage

損害額計算容易規定(商標法38条)

(EX)

Infringer's sales amount: 10,000 unit

Infringer's goods price: 500 US\$

Holder's sales amount before the infringer started infringing: 2000 Unit

Holder's sales amount after the infringer started selling goods: 1500 Unit

Holder's profit per unit of goods: 50US\$

Maximum amount on holder's side: 3,000

Damage = $10,000 - (10,000 - 3,000) * 50US\$$

however, that if any circumstances exist under which the holder of trademark right or of exclusive right to use would have been unable to sell the assigned quantity in whole or in part, the amount calculated as the number of goods not able to be sold due to such circumstances shall be deducted.

Presumption of amount of damage

損害額計算容易規定(商標法38条)

Article 38 (2) Where the holder of trademark right or of exclusive right to use claims against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, and the infringer earned profits from the act of infringement, the amount of profits earned by the infringer shall be presumed to be the amount of damage sustained by the holder of trademark right or of exclusive right to use.

(3) The holder of trademark right or of exclusive right to use may claim against an infringer compensation for damage sustained as a result of the intentional or negligent infringement of the trademark right or the exclusive right to use, by regarding the amount the holder of trademark right or of exclusive right to use would have been entitled to receive for the use of the registered trademark as the amount of damage sustained.

(4) The preceding paragraph shall not prevent any relevant party from claiming compensation for damage in an amount exceeding the amount provided therein. In this case, where the infringer committed the infringement of the trademark right or the exclusive right to use without intent or gross negligence, the court may take these circumstances into consideration in determining the amount of damages to be awarded.

Presumption of amount of damage

損害額計算容易規定(商標法38条)

- (1) Damage= assigned quantity * the amount of profit per unit of goods
- (2) Damage= the amount of profits earned by the infringer
- (3) Damage= amount the License fee which would have been entitled to receive

calculation of estimated lost earnings

(損害額の算定)

2001(wa)2574 Kyoto District Court

Plaintiff: Trademark holder for blanket

Defendants: Imported blankets attaching the plaintiff's mark

Blankets A (original design by the right holder) =2193 qty. Blanket B=3645 qty.

Calculation 38(1)

Holder's profit per unit of blanket A:

=3,317 yen (sales price) -2,210 yen(purchase price)-100 yen(logistic price)=1,007 yen

Holder's profit per unit of blanket B:

=1,676 yen (sales price) -1,159 yen(purchase price)-100 yen(logistic price)=417 yen

Damage based on Section 38 (1) = 2193*1,007 yen+3645*417 yen =3,728,316 JP yen.

Court decision about “How to calc the profit ?”

Gross profit- (cost of production +cost of purchase + minimum miscellaneous fee

calculation of estimated lost earnings

(損害額の算定)

2001(wa)1776 Tokyo District Court

Section 38 (1) Where a holder of trademark right claims against an infringer compensation for damage sustained as a result of the infringement of the trademark right ,
the amount of damage sustained by the holder of trademark right may be presumed to be *the amount of profit per unit of goods which would have been sold by the holder of trademark right if there had been no such act of infringement, multiplied by “Assigned Quantity”*,

POL:

Whether “the holder of the trademark right would have been sold if there had been no such act of infringement” or not ?

Plaintiff, right holder of trademark **“Canadian Maple Syrup”**

Defendant: published picture of maple syrup made in Canada with attaching defendant’s mark on brochure and sold them in Japan.

calculation of estimated lost earnings

(損害額の算定)

2001(wa)1776 Tokyo District Court

POL: Whether “the holder of the trademark right would have been sold if there had been no such act of infringement” or not ?

Plaintiff (food import company b to b):

Right holder of trademark “**Canadian Maple Syrup**”

Main client: Retail shops, such as super market

Defendant : Travel company

Defendant’s act: purchased the goods from Canada, mail order business

Main purchaser: individual travelers

Court:

There is no relationship that plaintiff could sell his goods if no infringement act had been done by the defendant. Therefore we cannot apply Trademark section 38(1) for calculation.

➡ estimated lost earning shall be calculated based on license fee based on section 38(3).

Defendant’s sales amount 25,216,200 JP yen * 0.05 (license rate) =1,260,810 JP yen

(claimed price: 10,216,800 JP yen)

calculation of estimated lost earnings

(損害額の算定)

2005(wa)3126 Osaka District Court

(2)Where the holder of trademark right claims against an infringer compensation for damage sustained as a result of the infringement of the trademark right, and the infringer earned profits by the infringing act, **the amount of profits earned by the infringer shall be presumed to be the amount of damage sustained by the holder of trademark right.**

Plaintiff, right holder of trademark “GUCCI”

Defendant (infringer) : selling counterfeit goods via Internet or to Japanese pinball parlor

Court decision:

Gross profit: 106,775,819 JP yen (960,021USD)

After considering the cost for uploading internet auction site, employee’s wage, transport fee, logistics fee, telecommunication fee, expenses which needed for the defendant’s act (selling counterfeit goods) shall be deemed as 4% of gross profit.

As a result defendant’s profit by infringement: 67,138,962 JP yen

損害論（損害不発生の抗弁）

damage (no damage claim)

Plaintiff: Trademark owner “小僧”

Infringer's mark
(well-known to the public)

The trademark owner does not have to prove claims on the occurrence of damages, it is sufficient to prove the fact of infringement and the amount of money normally to be accepted. On the other hand, The infringer is reasonable to assert that it can escape the damages for damages by proclaiming that it can not be damaged as a defense.

和解 (settlement)

(example)

Defendant shall stop using the mark on the goods (masks). However the Plaintiff shall accept the defendant sells the stocked goods (amount of goods are 86,000) with attaching the mark for 3 years.

The defendant shall pay 4100,000 yen (about 41,000 USD) as settlement fee.

Defendant shall dispose all the stocked goods after three years past.

Plaintiff shall withdraw all the claims.

(example 2)

Defendant shall stop selling the goods (medical apparatus) via Internet with attaching plaintiff's mark.

The defendant shall pay 7800,000 yen (about 78,000 USD) as settlement fee.

祇園祭りポスター写真事件

Poster picture case

Gion matsuri water color painting case
2008 (wa)1126



Plaintiff: amateur photographer

Defendant: Shrine

Defendant: Publication company

Infringement or not?

1. Unauthorized use of pictures taken by amateur photographer
2. Adapting the picture to paint

<http://yaplog.jp/kameichi/image/53/19> より

交通標語類似事件

Similarity of slogan

2001(ne)3427

Plaintiff: ボク安心 ママの膝よりチャイルドシート

(aurally) Bo ku An-shin Mama no hi-za-yo-ri Child sheet
(meaning) I feel safety, prefer child sheet to mom's knees

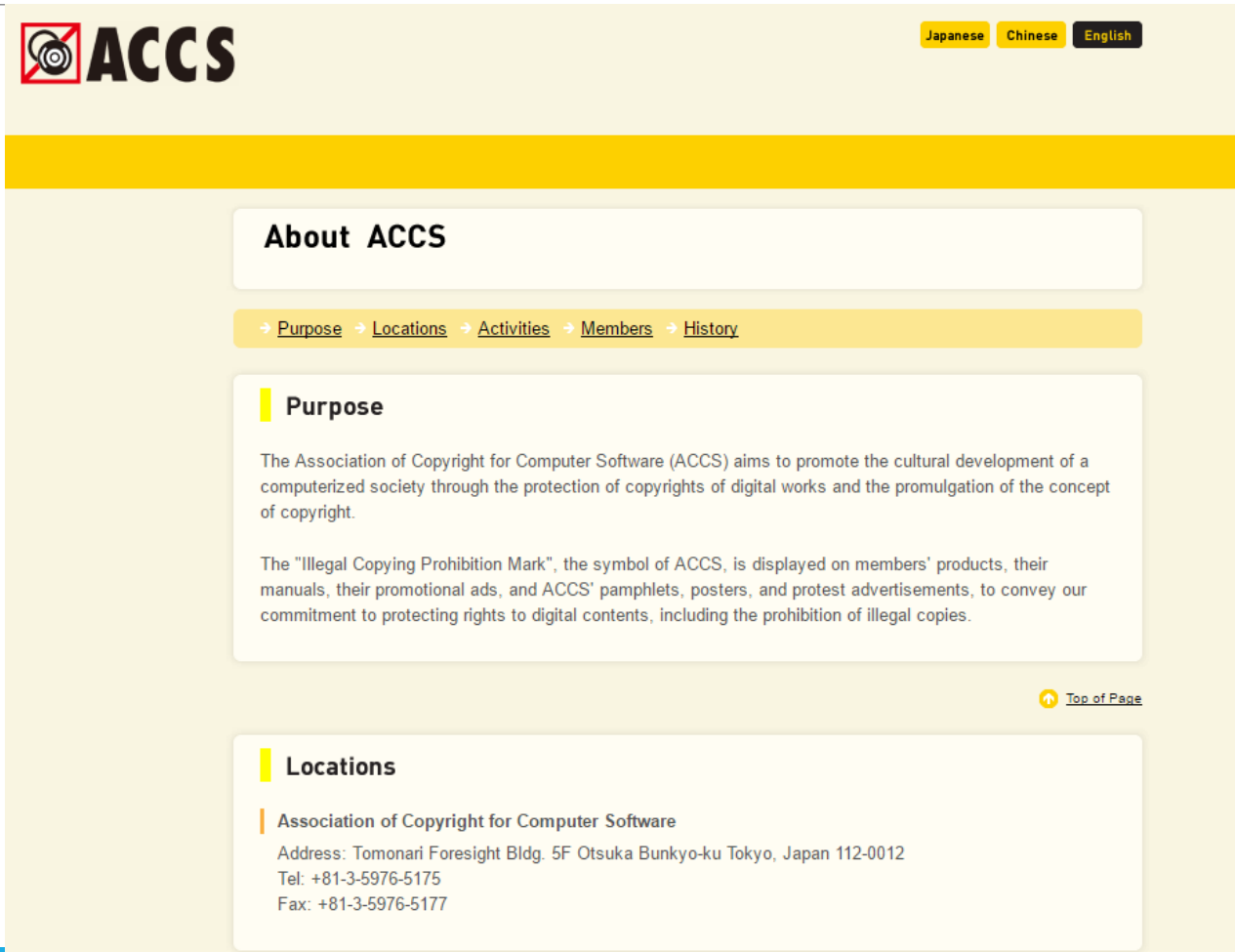
Defendant: ママの胸よりチャイルドシート

(aurally) Mama no mu-ne-yo-ri child sheet
(meaning) prefer child sheet to mom's chests


Does Slogan have copyrightability?

If it has, Defendant's slogan is admitted as adapted the plaintiff's slogan?

Criminal cases of copyright infringement



The screenshot shows the ACCS website with a yellow header and a light beige background. The ACCS logo is in the top left, and language selection buttons for Japanese, Chinese, and English are in the top right. A yellow horizontal bar is below the header. The main content area has a white box for 'About ACCS' with a breadcrumb trail: Purpose → Locations → Activities → Members → History. Below this is a 'Purpose' section with two paragraphs of text. A 'Top of Page' link is at the bottom right of the Purpose section. The 'Locations' section follows, providing the organization's name and contact information.

 **ACCS** Japanese Chinese English

About ACCS

→ [Purpose](#) → [Locations](#) → [Activities](#) → [Members](#) → [History](#)

Purpose

The Association of Copyright for Computer Software (ACCS) aims to promote the cultural development of a computerized society through the protection of copyrights of digital works and the promulgation of the concept of copyright.

The "Illegal Copying Prohibition Mark", the symbol of ACCS, is displayed on members' products, their manuals, their promotional ads, and ACCS' pamphlets, posters, and protest advertisements, to convey our commitment to protecting rights to digital contents, including the prohibition of illegal copies.

[↑ Top of Page](#)

Locations

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