

## **Carrefour Case**

**(Criteria for defining “a name of another person” if the other person is a foreign judicial person)**

**Tokyo High Court**

**Case H12 (Gyo Ke ) 257 (July 18, 2001)**

### **FACTS**

S Corporation, the plaintiff, is the holder of a Japanese trademark registration for a trademark “Carrefour / カルフール”, in connection with “accessories” in class 21.

Carrefour, the defendant, is a corporation (*Societe Anonyme*) established and incorporated in France. The defendant filed trademark applications for the trademark “Carrefour” specifying goods included in class 21. The Examiner rejected the defendant’s application, citing the plaintiff’s trademark. As part of the counter measures to the refusal, the defendant filed an invalidation trial against the cited trademark registration based on Trademark Law Article 4(1)(viii), which prevents a trademark containing another person’s name (or famous abbreviation of the name) from being granted registration. The trial body granted the defendant’s claim and invalidated the plaintiff’s trademark registration.

The plaintiff filed this administrative lawsuit at the Tokyo High Court seeking revocation of the trial decision. The grounds of the plaintiff’s claim are: (1) “Carrefour” without an indication of organizational type (*Societe Anonyme*) is not the defendant’s name but is an abbreviation of the defendant’s name, and that the abbreviation is not famous in Japan; (2) the plaintiff adopted the “Carrefour”

trademark without a knowledge of the defendant's "Carrefour"; and (3) possible invalidation would unduly harm the interests of the plaintiff.

### **ISSUE**

- (1) Whether a foreign company's name not containing an indication of company type is a "name of another person" within the meaning of Article 4(1)(viii).
- (2) Whether circumstances of a party whose interest would be harmed by an invalidation of trademark registration shall be considered in applying Article 4(1)(viii).

### **HOLDING**

(1) The meaning of "name of another person" in Article 4(1)(viii), in the case of a person who is a foreign legal person (company), is the name set in accordance with the relevant law of the country where the company was established. If the name without combining the company type is treated as a legal company name in light of the law of the country where the company was established, then the name without combining the company type is construed as the "name of another person" under Article 4(1)(viii).

The reason why Article 4(1)(viii) refuses the registrability of a trademark including the name of another person is to protect personal interests, and the reason why the Article does not require that the name of another person be famous but requires that the abbreviation of the name of another person be famous is to exclude arbitrary selection of an abbreviation of a name by "another person". This reasoning also applies to foreign companies.

According to the Companies Act of Japan, a trade name is the name of a company, [Article 6, main paragraph], and a trade name shall contain an indication of the type of company, such as “limited liability company” in the trade name [Article 6(1)]. As for the French Commercial Company Law, Article 70(1) provides that a joint stock company shall be referred to by its trade name, and that the type of company or the amount of stock shall be indicated before or after the trade name. The registration certificate of the defendant, submitted as evidence, shows “Carrefour” in the column “Trade name”, and “Societe Anonyme” in the column “Type of company”.

(2) Circumstances, such as knowledge by a trademark holder of the name of the other person, and possible damage caused by invalidation of the trademark registration, shall not be taken into consideration in deciding applicability of the Article. The Article does not require knowledge by the holder of the trademark. As for the possible damage suffered by the holder in the event that registration of the trademark is invalidated, Article 4(1), in general, is applied regardless of the degree or circumstances of use of the trademark.

## **DECISION**

The appeal decision invalidating the plaintiff’s trademark registration is upheld and the plaintiff’s claim is dismissed, since “Carrefour” is the “name of another person” within the meaning of Article 4(1)(viii) and fame of the name is not required.

Excerpts from the Trademark Law

Article 4 (1) Notwithstanding Article 3, trademark registration shall not be effected in the case of the following trademarks:

(viii) trademarks containing the portrait of another person or the name, famous pseudonym, professional name or pen name of another person or the famous abbreviation thereof (except where the consent of the person concerned has been obtained), . . . .