

L'Air du Temps Case
Possible confusion of famous trademark when used in different field of goods
Supreme Court
Case H10 (Gyo-Hi) No. 85 (July 11, 2000)

Adopting a broad interpretation of “possible confusion”, the Court found that the registered trademark “レールデュタン” (covering personal outfitting, not perfumeries) is considered confusingly similar to the famous trademark “L’Air du Temps” “レール・デュ・タン”, even though the goods designated by the two marks are different.

FACTS

1. The mark “レールデュタン” (the Japanese *katakana* is read [le:rudutan]), covering Japanese Old Class 21: Personal Outfitting etc., was registered under Reg. No. 2,099,693, in December 1988 (“the registered mark”).
2. The owner of the famous trademark “L’Air du Temps” (Reg. No. 661,424, December 1964), Perfumes NINA RICCI, which also uses the *katakana* version thereof, “レール・デュ・タン” (phonetic Japanese *katakana* equivalent of L’Air du Temps), lodged an Invalidation Trial against the above-mentioned registration as Trial No.12,599/1992, based on the fame of the mark in perfumeries in the Japanese market (“the cited mark”).
3. In the Patent Office, the Trial Examiner denied the possibility of confusion of the registered mark and the owner of the cited mark lost the case. The Tokyo High Court also denied the possibility of confusion, noting that although the trademark “L’Air du Temps” has acquired a reputation among persons who deal with such perfumeries and among up-market consumers, it is not well known or familiar to consumers in fields outside perfumes. Thus, the mark “L’Air du Temps” NINA RICCI, although famous in its field, is not commonly known in general. Moreover, the registered mark and the cited French mark are not considered similar in pronunciation.

ISSUE

Can Japanese pronounce an originally French mark properly? Can the use of the registered mark in a field different from the field in which the cited mark has become famous be a possible source of confusion to consumers?

DECISION

The Supreme Court judged that the pronunciation of the registered mark and the cited mark are identical in the Japanese way of pronunciation, which does derive from the French pronunciation, and thus the registered mark is considered to be confusingly similar to the cited mark when it is used on the designated goods such as Personal Outfitting and Toilet Set, in view of the established fame of the cited mark in the perfume market by

extensive use of the mark. Further, even though the goods designated by the two marks are different, the cited trademark can possibly mislead consumers into thinking that the plaintiff and the defendant are related companies or affiliated business partners.