

Latest Court Decisions

2009:
(July)

PE'Z Case (Cancellation Case of Trial Decision)

IP High Court 2009.7.21 H21(Gyo-Ke)10048

An Invalidation Trial was filed against the registered trademark "PE'Z" (right upper mark) specifying the goods in Class 25 on the basis of the prior registered trademark "PEZ"(right lower mark). The Patent Office Trial Decision dismissed the Petition for Trial because these trademarks are dissimilar. Then, the Cancellation suit was filed.



The IP High Court also decided these trademarks as dissimilar. The reasons therefor are as follows.

- (1) Although these trademarks consist of the identical three letters "P · E · Z", the pronunciations are different like "pe-zu" and "pe-ttsu".
- (2) The appearances are also different. While the one can be seen as planar because it is handwritten, the other can be seen as stereoscopic because it consists of many bricks.
- (3) The meanings of the two marks are also different having considered the derivations of these marks and the use in the market. The trademark "PE'Z" is "PE'Z as a jazz band" while the trademark "PEZ" is "candies in dispensers with cartoon character figures on the top".

Recently, we can see many court decisions and trial decisions that trademarks are decided as dissimilar from the differences of the appearances and/or meanings even the pronunciations are identical or almost identical.

LOVE COSMETIC Case (Cancellation Case of Trial Decision)

IP High Court 2009.7.16 H21(Gyo-Ke)10021

The Patent Office rejected the application for the trademark "LOVE COSMETIC" in Katakana letters by the prior trademarks "LOVE" and its cancellation was demanded.

However, the IP High Court also decided the two trademarks as similar saying that since the word "COSMETICS" in the applied-for trademark is lack of distinctiveness for the goods "cosmetics", the two trademarks are similar in the distinctive parts "LOVE".

There is a related case in the court decisions rendered in April, 2009.

PREMIUM Case (Injunction Case on Trademark Infringement)

Osaka District Court 2009.7.16 H20(wa)4733

The word "PREMIUM" is now widely used for indicating the quality of goods for some business fields such as food and drink industries while it was registered as trademarks in the past.

Even if the trademark "PREMIUM" is registered for some goods, if it has become descriptive of goods after the trademark registration, anybody can use it for describing the nature of goods under **Article 26** of the Trademark Law. However, in case that it is unclear whether the "PREMIUM" has become descriptive or not for the goods concerned after the registration, a license to use the trademark "PREMIUM" has to be obtained from the proprietor of the trademark registration to safely use the word "PREMIUM".

The plaintiff of this case also obtained the exclusive license to use "PREMIUM" for clothing and he is using the trademark "**PREMIUM / BY VICKY**". It is thinkable that the plaintiff paid an amount of royalties to the trademark proprietor and thus he wished to exclusively use the trademark "PREMIUM". Then, the plaintiff sued the defendant demanding stop using the trademark "**Premium by LAST SCENE**" as an infringement of the exclusive right.

However, the Osaka District Court dismissed the case saying that the defendant's trademark "Premium by LAST SCENE" is not confusingly similar to the plaintiff's trademark "PREMIUM" with the following reasons.

The word "PREMIUM" is widely used in the beer industry, and the words "Premium Down" and "Premium Denim" are used by UNIQLO in the apparel industry. There are other uses such as "Yahoo! PREMIUM", "Premium Class" by All Nippon Airways, and "Premium Outlets" for outlet malls.

The JPO refused trademark applications for PREMIUM as lack of distinctiveness.

Thus, the word "PREMIUM" had become descriptive of goods and services in about August, 2007 when the defendant started using its trademark.

It seems from this court decision that the word "PREMIUM" may be freely used for any goods and services. However, there may be effective registered trademarks "PREMIUM" for some goods or services. Therefore, it should be verified before start using as to whether or not the word "PREMIUM" has become descriptive of the specific goods or services.