

Latest Court Decisions

2009:
(August)

PIZZA COMPANY Case (Cancellation Case of Trial Decision)

IP High Court 2009.8.27 H21(Gyo-Ke)10022

The application for the trademark "The/PIZZA/Company" (right upper mark) specifying "pizza" in Class 30 was rejected due to the cited trademark "PIZZA COMPANY" in English and Japanese (right lower mark) because the pronunciations and the meanings of the two marks are identical. Then, the cancellation of the Trial Decision was demanded by the applicant.



The plaintiff (= the applicant) insisted that the words "PIZZA COMPANY" in the two trademarks are descriptive of the specified goods "pizza" and the cited trademark was registered since the distinctiveness was admitted to its appearance. Therefore, the similarity of the two marks should be judged as a whole.



However, the IP High Court also decided the two marks are similar in their pronunciations and meanings because the words "PIZZA COMPANY" does not mean the specific pizza manufacturer or distributor.

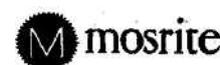
We agree to the IP High Court decision although its reasons seem hard to understand. The Court should have judged on the point whether the word "PIZZA COMPANY" is descriptive of goods or not.

MOSRITE Case (Cancellation Case of Trial Decision)

IP High Court 2009.8.27 H20(Gyo-Ke)10415

The MOSRITE electric guitars are very popular in Japan since a US guitar band, the Ventures, used the MOSRITES when playing. However, the US manufacturer of genuine MOSRITE guitars no longer exists.

A Japanese company, Kurokumo, the defendant of this case, registered the trademark MOSRITE (right upper mark) which was invalidated by a Trial filed by a Japanese company, Fillmore, the plaintiff of this case.



After that, Fillmore registered the trademark MOSRITE (right lower mark) which was also invalidated by a Trial filed by Kurokumo and then, Fillmore demanded the cancellation of the Trial Decision. That is this Case.



The both Invalidation Trials were based on **Article 4-1-10** of the Trademark Law which provides as follows.

< No trademark shall be registered if the trademark is identical with, or similar to, **another person's trademark** which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto. >

You will see that "another person's trademark" in this case stated in Article 4-1-10 is the trademark MOSRITE and the "another person" is the US manufacture that no longer exists. This means that there is no person who should be protected by Article 4-1-10.

However, the IP High Court also invalidated the Fillmore's registration. We can see the detailed reasons in the Court decision on the related MOSRITE case.

- (1) Even if the registration for the well-known trademark expired without renewal, the well-known nature of the trademark does not expire immediately thereby.
- (2) Therefore, if a third party uses a trademark similar to the expired well-known mark, the confusion regarding the origin of the goods occurs among the consumers.
- (3) A confusion regarding the quality of goods also occurs as though the quality is identical to that of the goods bearing the well-known trademark or as though the third party has any relationship with the proprietor of the well-known trademark.

Now, there is no person who has the legitimate right to the trademark MOSRITE and both Fillmore and Kurokumo are lawfully manufacturing electric guitars bearing the trademark MOSRITE.