

Latest Court Decisions

2009:

(October)

TAFLOTAN Case (Cancellation Case of Trial Decision)

IP High Court 2009.10.22 H21(Gyo-Ke)10216, 10217

A Cancellation Trial for non-use was filed against the registered trademark “**TAFLOTAN**” specifying “pharmaceuticals” in Class 5. The respondent, the trademark proprietor, submitted as the proof of use the labels and packages of the eye-drops bearing the trademark TAFLOTAN. The respondent’s TAFLOTAN eye-drops were all **exported** to the Finnish subsidiary for the sales to the Danish market.

Both the JPO and the IP High Court dismissed the Petition for Cancellation because the “**export**” of goods was regarded as use of the trademark under the present Japanese Trademark Law amended in 2006. Until then, “export” was not regarded as use of the trademark since “export” of goods did not make any influence to the Japanese market. However, in 2006 “export” was included as a kind of uses in order to prevent counterfeit goods from being exported outside Japan.

INTELLASSET Case (Cancellation Case of Trial Decision)

IP High Court 2009.10.20 H21(Gyo-Ke)10074

Intel Corporation filed an Invalidation Trial against the registered trademark “**INTELLASSET**” specifying “business management” in Class 35 because “INTELLASSET” contained the famous abbreviation “INTEL” of Intel Corporation under Article 4-1-8 of the TM Law.

The JPO issued a Trial Decision invalidating the INTELLASSET registration accepting Intel Corporation’s petition. However, the IP High Court cancelled this Trial Decision with the following reasons.

- (1) The purport of Article 4-1-8 is the protection of personal privilege rights.
- (2) It is required that a fear of violation of personal privilege rights exists in addition to containing other’s name, to apply Article 4-1-8.
- (3) In the subject case, although “INTELLASSET” contained the famous name “INTEL”, nobody thinks of Intel Corporation from the trademark “INTELLASSET” because “INTELLASSET” is an unfamiliar coined word with no meaning.

Since the trademark “INTELLASSET” comes from the combination of “intellectual asset”, the Court Decision will be acceptable. The Japanese name of the proprietor is “K.K. Intellasset” and is not “K.K. Intell-Asset”.

DEEPSEA Case (Cancellation Case of Trial Decision)

IP High Court 2009.10.8 H21(Gyo-Ke)10141

Rolex SA filed a Cancellation Trial for non-use against the registered trademark "**DEEP SEA**" specifying "watches" etc. in Class 14. The respondent submitted as proof of use the catalogs and other materials of the diver watches.

The main trademark "ELGIN/INTERNATIONAL" in a large size appeared on the upper middle of the watch face. On the below of the watch face, the words "WATER RESISTANT", "AUTOMATIC DEEPSEA", "660ft=200M" and "DATE" appeared in four lines in a rather small size. Only the part "DEEPSEA" was written in red.

The JPO issued a Trial Decision canceling the registration because the word "DEEPSEA" merely described the nature of the diver watches meaning that they could be used in the 200 meters deep sea and therefore, "DEEPSEA" was not used as a trademark.

However, the IP High Court cancelled the Trial Decision. Although the Court basically admitted the reason of the Trial Decision, it judged that "DEEPSEA" was used as a trademark as well. Confirming that there was no objection between the two parties that "DEEPSEA" was not used as describing the nature of diver watches, the Court stated that "DEEPSEA" gave consumers a mysterious image of the deep sea which functioned to distinguish one from other as a trademark.

According to the IPDL, Rolex SA filed an application for the trademark "**ROLEX DEEPSEA**" in standard characters on April 7, 2008 under No. 2008-26474 while the subject Cancellation Trial for non-use was filed on March 12, 2008. A provisional rejection was issued on October 24, 2008 and the application is still pending.

According to the Rolex's web-site, ROLEX SEA-DWELLER DEEPSEA watches are being sold. We can see that "DEEPSEA" is being used as a trademark by Rolex SA as well. Therefore, it seems difficult to deny the fact that "DEEPSEA" is a trademark.