

Latest Court Decisions

2009;

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ANTHOROPOLOGIE Case (Cancellation Case of Trial Decision)

IP High Court 2009.12.1 H21(Gyo-Ke)10210

The trademark “ANTHOROPOLOGIE” was registered in 2006 by a Japanese company in Classes 3, 9, 14, 16, 20, 21, 26, 28 and 34. A US company filed an Invalidation Trial under **Article 4-1-19** of the Trademark Law because the trademark was filed by unfair purposes.

[Article 4-1-19]

No trademark shall be registered if the trademark is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items).

The JPO dismissed the petition by the US company, and then it filed the cancellation suit before the IP High Court. There are two points of issue, i.e. (1) the trademark “ANTHOROPOLOGIE” was well-known in USA and (2) the Japanese company knew the existence of the US trademark.

The IP High Court cancelled the JPO’s Trial Decision by admitting the above two points. The US company started its business since 1989 by using the trademark “ANTHOROPOLOGIE” for women’s clothing and bags. It distributed approx. 2,4380,000 catalogues until January 2006 and approx. 1,3640,000 new visitors accessed to the US company’s web-site. It had 112 shops in the States in 2008.

As to the unfair purposes, the IP High Court stated that there was a possibility for the Japanese company knowing the US well-known trademark because the Japanese company conducted the license business and it established a New York company to discover new foreign brands.

TEDDY BEAR Case (Cancellation Case of Trial Decision)

IP High Court 2009.12.21 H21(Gyo-Ke)10055

An Invalidation Trial was filed by a Japanese company against the trademark “**TEDDY BEAR**” registered in **1987** for clothing etc. in old Japanese Class 17 also in the name of a Japanese company. The Invalidation trial was based on Article 4-1-7 of the Trademark Law (**Violation of Public Order and Morals**). However, the JPO dismissed the petition for the trial and then, the petitioner filed the cancellation suit before the IP High Court.

The plaintiff (= the petitioner) insisted that the registration of the trademark "TEDDY BEAR" was against the international fidelity because "TEDDY BEAR" connected with the nation's 26th US President, **Theodore Roosevelt**, since there was an anecdote that he saved a bear cub when he was hunting and "TEDDY BEAR" came from such anecdote.

Although the plaintiff submitted a large amount of evidence to prove that the Teddy Bear's anecdote was well known in Japan at the time of filing the application in 1985, the IP High Court dismissed the case because the plaintiff failed to prove it.

The Court stated as the reasons that although "teddy bear" was well known as a name of stuffed bear toys in Japan, it was not known in close connection with USA or US people through Theodore Roosevelt's anecdote. It was also said that "Teddy Bear" toys came from a German toy company, Steiff, or that the Edward 7th of the United Kingdom showed an interest in the bear in the London Zoo. In addition, "Teddy Bear" is registered even in USA by different companies as trademarks for various goods.

Therefore, the registration of the subject trademark was not registered against the international fidelity.

GOYARD Bag Case (Injunction Case)

Tokyo District Court 2009.12.24 H21(Wa)19888

A French company, **Goyard St-Honore**, a proprietor of the trademark (right upper) registered for bags in Class 18, filed an injunction and damage suit against **Adidas Japan** that was using the trademark (right lower) for bags, on the basis of the trademark infringement and the violation of the Unfair Competition Prevention Law.



The Tokyo District Court dismissed the claims by Goyard's because the two trademarks were not confusingly similar. The Court stated that the two trademarks had the common features such as the points that they consisted of three devices in the same size as motifs, and that these motifs were depicted by many small egg-like dots, and that these motifs were in white and brown.



However, the Goyard's motif was herringbones look like a letter "Y" while the Adidas's motif was leaves look like a Japanese fan.

Under the Trademark Examination Standard of the JPO, trademarks of repeated patterns shown on bag's surfaces are not registrable under Article 3-1-6 because they are considered as merely decorative designs of goods, not as a trademark. However, recently, many bag's designs are registered as a trademark. This may be because three dimensional trademarks have been registered in Japan since 1997.