

Latest Court Decisions

2010:

[February]

● Team Le Mans Case (Cancellation Case of Trial Decision)

IP High Court 2010.2.10 H21(Gyo-Ke)10313

The trademark registration for "**Team Le Mans**" (right) for the goods in Classes 12, 35 and 37 in the name of a Japanese company was チームルマン **Team Le Mans** invalidated by a trial filed by **Automobile Club de l'Ouest**. Then, the Japanese company filed a cancellation suit before the IP High Court.

The name "Le Mans" is well-known as a 24-hour automobile race held in Le Mans, France. The movie film was produced regarding the Le Mans racing. The point of issue of the case was as to whether or not the registered trademark "**Team Le Mans**" was liable to cause confusion with the business of the Le Mans automobile race (Article 4-1-15 of the Trademark Law).

The Court admitted the Trial Decision by the JPO saying that the registered trademark "**Le Mans**" was well known in Japan and therefore, it was liable to cause confusion as if it had a business relation with the automobile race belonging to the same group that conducted the merchandizing business together.

● PINOPLUS Case (Cancellation Case of Opposition Decision)

IP High Court 2010.2.16 H21(Gyo-Ke)10236

The trademark registration for "**pino+**" in English and Katakana "PINOPLUS" (right) for "refreshing beverages" in Class 32 was cancelled by an opposition on the basis of a prior trademark registration for "**PINO**" for "confectionery and bread" in Class 30. Then, the trademark proprietor filed the cancellation suit before the IP High Court.

The logo for "pino+" features the word "pino" in a bold, blue, lowercase sans-serif font, followed by a plus sign "+" in the same style. Below this, the Japanese characters "ピノプラス" are written in a smaller, blue, sans-serif font.

The points of issue of the case were;

- ① whether or not the two trademarks are similar, and
- ② whether or not the registered trademark "pino+ / PINOPLUS (katakana)"

for beverages was liable to cause confusion with the prior mark for "PINO" for confectionery.

The Court admitted the opposition decision issued by the JPO with the following reasons.

(1) The "pino+ / PINOPLUS (katakana)" was similar to the prior mark "PINO" because the "PINO" part in the registered trademark was distinctive while the sign "+" and the katakana "PINOPLUS" in the mark were small.

(2) The prior mark "PINO" was well known in Japan for "ice creams" manufactured and distributed by the opponent since they were firstly sold in 1976.

(3) The registered trademark "pino+ / PINOPLUS (katakana)" was used for functional beverages containing pine extracts, lignin, useful for improving immunity and coenzyme Q10s. However, the word "pino" meaning "pine" in Italian and Spanish was not known among the Japanese people.

(4) As to the similarity between functional beverages and ice creams, these goods were very close because now there were many functional goods that were sold together with normal beverages at the same shops. In addition, there was a possibility that the prior trademark "PINO" might be used for other goods than "ice creams".

(5) Therefore, the registered trademark "pino+ / PINOPLUS (katakana)" had a fear of confusion as free-riding and diluting the well-known trademark "PINO" of the opponent company.

However, we disagree to the court reasons regarding "free-ride" and "dilution" because the trademark "pino+ / PINOPLUS (katakana)" was named since the goods contained pine(=pino) extracts and the trademark proprietor would have no intention for free-riding and dilution.

● SEMIE MOSELEY Case (Cancellation Case of Trial Decision)

IP High Court 2010.2.24 H21(Gyo-Ke)10335

The trademark "**SEMIE MOSELEY**" in normal letters was registered for "guitars" in old Class 24 in the name of Mr. Semie Moseley who was known as the MOSRITE electric guitar original manufacturer. The trademark registration was succeeded by Mrs. Loretta Moseley by the death of Mr. Semie Moseley.

Mrs. Moseley started manufacturing in Kyoto the MOSRITE guitars and their guitar head born Mr. Semie Moseley's signature (right), a trademark application for which is pending at the JPO. In addition, it was written in the specification of the guitars that "Head Logo had the signature of SEMIE MOSELEY".



A Japanese company filed a Cancellation Trial for non use against the registered trademark "SEMIE MOSELY" that was dismissed by the JOP. Then, the cancellation suit was filed before the IP High Court.

The Court also admitted that the registered trademark had been used for guitars in the last three years since the trademark was used in the specification of the guitars and the signature of Mr. Semie Moseley could be regarded as use of the registered trademark.

● JOURNAL STANDARD Case (Cancellation Case of Trial Decision)

IP High Court 2010.2.25 H21(Gyo-Ke)10189

A defensive mark application specifying “providing information on clothing sales” in Class 35 was filed as a defensive mark of the registered trademark “**JOURNAL/STANDARD**” (right) for the goods in Classes 3, 9, 25 and 26. However, the defensive mark application was rejected due to lack of fame of the registered trademark, then, the applicant filed the cancellation suit before the IP High Court.

**JOURNAL
STANDARD**

The following two conditions are required for defensive mark registration under Article 64 of the Trademark Law.

- (1) A registered trademark is well-known for the registered goods among the consumers.
- (2) When a third party uses the registered trademark for goods or services dissimilar to those of the registered trademark, it is liable to cause confusion with the goods/services by the trademark proprietor.

The defensive mark has the following features.

- ① Defensive mark applications are not examined regarding Article 3 (distinctiveness) and Article 4 (similarity etc). Therefore, a defensive mark is registered even if other parties’ prior similar trademark registrations exist.
- ② Since there is no use requirement for a defensive mark registration, it is not cancelled by a cancellation trial even if it has not been used for three years.
- ③ Other parties’ applications for trademarks identical to the registered defensive marks are rejected under Article 4-1-12 of the Trademark Law.
- ④ Other parties’ applications for trademarks similar to the registered defensive marks are subject to rejection under Article 4-1-15 of the Trademark Law.

As to the subject case, the IP High Court admitted the JPO’s trial decision saying that although the applied-for trademark “JOURNAL/STANDARD” could be regarded as well-known to some extent, it was not so much famous as the consumers caused confusion if the subject trademark was used for goods and services that were dissimilar to those of the basic registration, in comparison with other select shops such as UNITED ARROWS, BEAMS and SHIPS.

The same applicant also filed defensive mark applications for the trademarks “Spick and Span”, “IÉNA” and “ÉDIFICE” which were also rejected by the Court on the same day. [H21(Gyou-Ke) 10196, 10197 & 10198]

Spick and Span

I É N A É D I F I C E