

## Latest Court Decisions

**2010:**  
[April]

### ● CLUBHOUSE Case (Cancellation Case of Trial Decision)

**IP High Court 2010.4.14 H21(Gyo-Ke)10354**

The registered trademark “**CLUBHOUSE** / クラブハウス” in English and katakana specifying “processed foods, etc.” in old Class 32 was cancelled by a cancellation trial for non-use. The trademark proprietor filed the cancellation suit before the IP High Court.

The trademark “CLUBHOUSE” in katakana only was used for the title of the mail magazines appearing on the HP of the proprietor. The point of issue was whether or not the title of the mail magazines could be regarded as a kind of advertisements provided by Article 2-3-8 of the Trademark Law.

#### «Article 2-3-8 of Trademark Law»

“Use” with respect to a mark as used in this Law means any of the following acts:

- to display or distribute **advertisement materials**, price lists or transaction documents relating to goods or services to which a mark is affixed, or to provide information on such content, to which a mark is affixed **by an electromagnetic device**.

The JPO issued the Trial Decision that the registered trademark had not been used for the specified goods and that it had been used only as the title of the mail magazines.

However, the Court decided to cancel the Trial Decision because the mail magazines contained the information of the goods such as curry roux, retort stew, instant confectionery mixes and soup mixes that were covered by the registration, as well as the information on the new products and the photographs of the goods. It meant that the registered trademark was used in relation to the specified goods and therefore, the trademark was used for the advertisements provided by an electromagnetic device under Article 2-3-8 of the Trademark Law.

In addition, the Court admitted that the trademark in use written only in katakana was regarded as the use of the registered trademark in English and katakana since they have the same pronunciation and the meaning.

### ● POLO JEANS CO. Case (Cancellation Case of Trial Decision)

**IP High Court 2010.2.27 H21(Gyo-Ke)10152**

The registered trademark “**POLO JEANS CO. / RALPH LAUREN**” (right upper) was partially invalidated by the Invalidation Trial citing the prior trademarks “**POLO**” (right Lower). Then, the trademark proprietor filed the cancellation suit of the Trial Decision before the IP High Court.



**POLO**

The JPO decided that the two trademarks were confusingly similar at the part "POLO" because the words "JEANS" and "CO." in the subject trademark were descriptive, and the parts "POLO JEANS CO." and "RALPH LAUREN" in the subject trademark could not be regarded as a one inseparable trademark.

However, the IP High Court decided that the two trademarks were not confusingly similar with the following reasons.

- a) Although the words "JEANS" and "CO." in the subject trademark were descriptive, the word "POLO" had a strong goodwill as the trademark indicating goods by a famous US designer, Ralph Lauren.
- b) Although the under part "RALPH LAUREN" in the subject trademark was rather small, it was written together with the upper part "POLO JEANS CO." in the same box in red color.
- c) Therefore, the distinctive parts of the subject trademark were the combined parts of "POLO" and "RALPH LAUREN" meaning POLO RALPH LAUREN goods designed by Ralph Lauren which was distinguishable from the cited trademark "POLO" which merely meant a polo sport game.

#### **● ATHLETE LABEL Case (Cancellation Case of Trial Decision)**

**IP High Court 2010.4.28 H21(Gyo-Ke)10411**

The Invalidation Trial against the registered trademark "**ATHLETE LABEL**" in Class 5 on the basis of the prior trademarks "**ATHLETE**" in Class 10 was dismissed by the JPO. Then, the petitioner filed a cancellation suit of the Trial Decision before the IP High Court.

The JPO dismissed the Petition for Trial because the petitioner failed to prove that the cited trademark "ATHLETE" was well known and also because the cited trademarks "ATHLETE" and the subject trademark "ATHLETE LABEL" were not similar while the word "Label" might mean "brand".

However, the IP High Court decided that the two trademarks were confusingly similar admitting that the cited trademark "ATHLETE" was well known for the petitioner's "guide wires for cardiac catheter therapy" among the medical personnel as consumers and the traders in the medical apparatus.

In addition, the Court decided that the goods "bracelets for medical purposes" in Class 5 of the subject trademark and the goods "guide wires" in Class 10 for which the cited trademark had been used were also similar goods both for the medical purposes.