

Latest Court Decisions

2010:
[July]

● MIZUHO.NET Case (Cancellation Case of Trial Decision)

IP High Court 2010.7.7 H22(Gyo-Ke)10052

A trademark application for "**MIZUHO.NET**" in Classes 35, 37, 38, 39, 40, 41 and 42 was rejected by the cited trademarks "**MIZUHO**". "MIZUHO" means "fresh ears of rice" and is known as a name of one of the leading financial groups in Japan.

The IP High Court sustained the Trial Decision by the JPO saying that "NET" in the applied-for trademark meant "internet" and ".NET" was understood as a top level domain of domain names and thus they did not have distinctiveness as a trademark. Therefore, the trademarks "MIZUHO.NET" and "MIZUHO" were confusingly similar.

● PUMA Parody Trademark "SHI-SA" Device Mark Case

(Cancellation Case of Opposition Decision)

IP High Court 2010.7.12 H21(Gyo-Ke)10404

A trademark registration for "SHI-SA" and jumping cat device mark (right upper) was registered for the goods in Class 25 by an Okinawan citizen.



Puma AG filed an opposition on the basis of the well-known PUMA trademark (right lower) because;

- ① the two trademarks are similar (§4-1-11),
- ② the SHI-SA mark was liable to cause confusion regarding the origin of goods (§4-1-15), and
- ③ the SHI-SA trademark was a parody of the well-known trademark PUMA by taking free-ride on its goodwill (§4-1-19).



We, FUJIMarks JAPAN, acted for Puma AG as their trademark.

The JPO firstly cancelled the SHI-SA trademark registration on the basis of Article 4-1-11. However, on February 11, 2010 the IP High Court cancelled the opposition decision by the JPO saying that the two trademarks were not similar in any points of the appearances, pronunciations and meanings.

Then, the opposition was re-examined and the JPO again cancelled the SHI-SA trademark registration on the basis of Articles 4-1-15 and 4-1-19. Then, the trademark proprietor filed the cancellation suit before the IP High court.

However, the IP High Court again cancelled the JPO's opposition decision. The reasons therefor are as follows.

(1) Similarity

The two trademarks are not similar in their appearances because the subject trademark depicted an Okinawan traditional lion "shiisa" while the PUMA trademark depicted a real wild cat animal.

(2) Goods

The trademarks were being used for T-shirts and caps in common. However, the "SHI-SA" goods were merely sold in a shop in Okinawa and through the internet and the amount of the goods was small while the PUMA goods were sold all over Japan and the amount thereof was very large.

(3) Confusion

In view of the differences of the trademarks, the sales scales and the marketing methods, consumers did not confuse goods bearing the "SHI-SA" trademark with the PUMA goods as those belonging to the same marketing group.

(4) Parody

There was no legal notion of "parody" under the Japanese Trademark Law and it was a mere academic issue. Therefore, the case should be settled only within the Japanese Trademark Law.

The plaintiff (=the trademark proprietor) said during the court procedures that although he knew the PUMA trademark, he originally created the "SHI-SA" trademark irrespective of the PUMA trademark.

Therefore, the "SHI-SA" trademark is not a parody of the PUMA trademark nor it did not take free ride on the goodwill of the PUMA trademark.

【Comments】

It is quite incredible that the "SHI-SA" trademark was created irrespective of the PUMA trademark. There will be no one who does not imagine the PUMA trademark from the "SHI-SA" trademark.

People who see the "SHI-SA" trademark image the PUMA trademark and buy the "SHI-SA" products for fun with knowing they are not the genuine PUMA products. This means that the "SHI-SA" trademark takes free ride on the PUMA's goodwill. In other words, the "SHI-SA" trademark did not exist if the PUMA trademark did not exist. In fact, the trademark proprietor sold his goods saying the words "PUMA" and "parody" in his catchwords and we can see so many web-sites selling the "SHI-SA" product via internet.

There are many parody products sold in Japan and the applications for the following trademarks were filed for examples.



Some of these trademarks were opposed and rejected by the JPO. However, there has been no court decision regarding parody trademarks prior to the "SHI-SA" trademark case. Once this IP Court Decision issued, people consider that parody trademarks are not illegal and as the result, many well-known brands will be victimized by parody trademarks.

● **POLO Case (Cancellation Case of Trial Decision)**

IP High Court 2010.7.14 H22(Gyo-Ke)10027

A cancellation trial for non-use was filed against the registered trademark "POLO/BRITISH COUNTRY SPIRIT" (right upper).

The image shows the registered trademark logo for "POLO BRITISH COUNTRY SPIRIT". The word "POLO" is written in a large, bold, serif font. Below it, the words "BRITISH COUNTRY SPIRIT" are written in a smaller, bold, sans-serif font.

The trademark in use that was submitted as a proof of use was shown on the right lower side. The words "BRITISH COUNTRY SPIRIT" in the trademark in use were so small in comparison with the registered trademark.



However, the IP High Court as well as the JPO judged that the trademark in use was deemed as identical to the registered trademark from common sense because the composition of the words was not changed.

You can see many trial decisions regarding the **identity between the registered trademark and the trademark in use** in "**Board Decision at TTAB in Japan**" in our web-site.