

Latest Court Decisions

2010:

[September]

● World Case (Cancellation Case of Trial Decision)

IP High Court 2010.9.27 H22(Gyo-Ke)10102

The trademark application for the word mark "WORLD" [A] in Class 14 was rejected due to the cited trademarks [B] and [C] including the word "WORLD".

Then, the cancellation suit was filed before the IP High Court.

The examination practice at the JPO regarding trademarks consisting of two words is as follows.

Trademarks should be divided into two parts when;

- (1) Trademarks are written in two lines.
- (2) Two words are written in different sizes/colors/ fonts/designs.
- (3) Either word is no distinctive or less distinctive.

According to these points, the cited trademarks should be divided into two parts and the pronunciation of "world" could be taken out from the cited trademarks since the "COLLEZIONE" and "ONE" parts are written in smaller size and different and less distinctive.

However, the IP High Court cancelled the Trial Decision saying that the cited trademark should be regarded as inseparable because the cited trademarks are written in unified designs.

Furthermore, the Court said that in the actual marketplace, the cited trademark [B] "WORLD/COLLEZIONE" was used together with "world collezione" in Japanese katakana letters as the accessory shop name and therefore, the cited trademark [B] was always called as "world collezione" as a whole.

Likewise, the cite trademark [C] "WORLD/ONE" was used with the Japanese words "world one series" for cosmetic web-site and therefore, its pronunciation should be "world one".

As the result, the subject trademark "WORLD" should be regarded as dissimilar to the cited trademarks "WORLD/COLLEZIONE" and "WORLD/ONE".

WORLD

[B]



[C]



● **IRS/instant rock star Case (Cancellation Case of Trial Decision)**

IP High Court 2010.9.30 H22(Gyo-Ke)10078

A cancellation trial for non-use was filed against an International trademark registration designating Japan in the name of an Australian company.



After the Japanese registration, the Australian company moved its principal office. However, the change of address was not recorded at the WIPO International Bureau when the cancellation trial for non-use was filed in Japan. Therefore, the copy of the Petition for Trial was dispatched to the old address of the Australian company.

The Cancellation Decision was issued by the JPO without submission of the Counter Statement by the Australian company. After that, the Japanese trademark agent for the Australian company happened to know the Cancellation Decision issued.

Then, the Australian company filed the cancellation suit of the Trial Decision before the IP High Court saying that it should be illegal not to be given a chance to respond to the Petition for Cancellation Trial.

According to Article 192 of the Patent Law, *mutatis mutandis* application by the Trademark Law, when serving documents to a foreign party, it shall be dispatched to a registered Japanese patent agent for the foreign party.

If a foreign party has no such registered Japanese patent agent, documents may be dispatched by registered air mail directly to the foreign party. In this case, the documents shall be deemed to have been served at the time of dispatch.

Therefore, in the subject case, the JPO dispatched the copy of the Petition for Trial directly to the Australian company by a registered airmail. However, the document was not actually served to the Australian company and it lost the chance to respond to the Cancellation Trial.

Thus, the IP High Court decided it as illegal and cancelled the Trial Decision since the Australian company successfully submitted the proof of use of the registered trademark in Japan to the Court.