

Latest Court Decisions

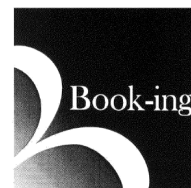
2010:

[December]

● BOOKING.COM Case (Cancellation Case of Trial Decision)

The IP High Court 2010.12.14 H22(Gyo-Ke)10171

International Trademark Registration for "BOOKING.COM" & Device designating Japan (right upper) was rejected by the JPO due to the cited trademark "Book-ing" (right lower). The applicant, Booking.com Limited, filed the law suit before the IP High Court requesting cancellation of the Trial Decision by the JPO.



The JPO decided that the two trademarks were similar in terms of "booking" in their pronunciation and "reservation" in the meaning because the part ".COM" in the International trademark "BOOKING.COM" had little distinctiveness since ".COM" had been widely used in the Internet commerce as a top-level domain.

However, the IP High Court cancelled the Trial Decision saying the two trademarks were not confusingly similar because the part ".COM" in the International trademark "BOOKING.COM" was indispensable to indicate an Internet address. Therefore, the International trademark should be regarded as a whole. The International trademark had the meaning of "Internet address regarding hotel reservation".

In addition, the Court said that the International trademark "BOOKING.COM" had been well known to some extent for the applicant's services "on-line hotel reservation".

However, we do not think that the word mark "BOOKING.COM" could be registered since it merely describes the nature of the specified services in Class 43, i.e. "Internet hotel reservation services" as the Court said. The words "booking.com" should be open to the public to show "Internet reservation services" in view of the trademark registration.

● ECOLUX Case (Cancellation Case of Trial Decision)

The IP High Court 2010.12.15 H22(Gyo-Ke)10012

A Cancellation Trial for non-use against the registered trademark "ECOLUX" for LED lamps in Class 11 was dismissed.

In Japan, when a cancellation for trial for non-use is filed, the petition for the trial is recorded at the Trademark Register Book. Then, the trademark proprietor has to prove the use of a registered trademark within three years prior to the recordal date of the petition (Article 50-2 of TM Law).

In this case, the petition for the cancellation trial was filed on April 14, 2001 and was recorded on April 30, 2001. Therefore, use prior to **April 30, 2009** had to be proved.

The trademark proprietor ordered a design company to prepare the package design bearing the registered trademark on April 6, 2009 and the electronic data of the finished package design was delivered to the trademark proprietor on **April 10, 2009**.

After that, the informational magazines including the package design bearing the registered trademark were delivered by a publishing company to the trademark proprietor on **April 30, 2009**. The informational magazines were forwarded by the trademark proprietor to the retail stores on April 30, 2009 for sale promotion and they reached to the retail store on **May 1, 2009**.

Then, the trademark proprietor started manufacturing the new products in China on **June 11, 2009**.

Under these situations, the JPO admitted that the registered trademark was used even though the promotion activities to the retail stores were conducted after April 30, 2009, the package design bearing the registered trademark was prepared before April 30, 2009.

However, the IP High Court cancelled the JPO's Trial Decision saying that the mere package design without the actual products was not sufficient as use of the registered trademark even if the package design bore the registered trademark.

In addition, the informational magazines including the package design with the registered trademark had to be delivered to the third parties, i.e. the retail stores, before April 30, 2009 so that the registered trademark had been used to others before April 30, 2009.