

Latest Court Decisions

2011:

[September]

● **Blue Note Case (Cancellation Suit of Trial Decision)**

IP High Court 2011.9.14 H23(Gyo-Ke)10086

The trademark "**Blue Note**" with a musical note device was registered by a leading trading company in Japan, **ITOCHU Corporation**, for the retail services in Class 35.



The registration covers the retail services of a variety of goods in the filed of **clothing, foods and beverages, and living ware, carrying all goods together ("total retail services")**. The total retail services are for department stores and super markets.

The registered trademark also specifies the retail services of specific goods such as **bags, bedding, clothing, confectionery and bread, soft drinks, tea and coffee, automobiles, motorcycles, furniture, kitchen utensils, tobacco and smoker's articles, precious stones** and so on. However, the registration did not cover the retail services of **music records and CDs**.

A US company, **Capitol Records LLC**, filed an Invalidation Trial against the registered trademark because the registered trademark was liable to cause confusion with the goods/services provided by the well known jazz label, BLUE NOTE (Article 4-1-15 and 4-1-19 of the Trademark Law).

The JPO dismissed the Capitol Records' petition and then, they filed a cancellation suit of the Trial Decision before the IP High Court.

The registered trademark did not cover "retail services of music records and CDs" for which jazz label, BLUE NOTE, was well known. Moreover, the retail services of specific goods of the registered trademark were not similar to the goods of the music records and CDs provided by Capitol Records.

Therefore, the point at issue of the law suit was whether or not the total retail services of the registered trademark were confusingly similar to the goods "the music records and CDs" by Capitol Records.

The IP High Court also dismissed Capital Records' petition because the total retail services of the registered trademark did not include the retail services of music records and CDs and Capitol Records' BLUE NOTE jazz labels was well known only among the music industry and the music lovers. Therefore, there was no fear of confusion between the registered trademark "Blue Note" with music note device and the BLUE NOTE jazz label of Capitol Records.

You should bear in mind that the protection of retail service trademarks in Class 35 is rather restricted in Japan.

● **TV PROTECTOR Case (Cancellation Suit of Trial Decision)**

IP High Court 2011.9.20 H23(Gyo-Ke)10085

The trademark application for "**TV PROTECTOR**" for telecommunication apparatus and instruments, etc. in Class 9 was rejected by the cited registered trademark "**PROTECTOR**" in Class 9 by the JPO because the word "TV" in the applied-for trademark "TV PROTECTOR" described the goods "televisions" and that was lack of distinctiveness.

Then, the applicant filed the cancellation suit of the Trial Decision before the IP High Court.

The IP High Court cancelled the Trial Decision saying that the applied-for trademark "TV PROTECTOR" should be considered as a whole since the trademark "TV PROTECTOR" was a coined mark with no specific meaning.

● **MONTE ROSA CAFE Case (Cancellation Suit of Trial Decision)**

IP High Court 2011.9.27 H23(Gyo-Ke)10081

The registered trademark "**MONTE ROSA CAFE**" for "providing of foods and beverages" in Class 43 was invalidated by the trial proceedings filed by a proprietor of the prior registered trademark "**MONTE ROSA**" also for "providing foods and beverages".

Then, the cancellation suit was filed demanding the cancellation of the Trial Decision before the IP High Court.

The IP High Court dismissed the case because the word "CAFE" in the subject trademark "MONTE ROSA CAFE" meant "coffee houses, tearooms" and therefore, the distinctive part of the trademark was "MONTE ROSA" that was similar to the cited trademark "MONTE ROSA".