

Latest Court Decisions

2011:

[**November**]

● GENESIS Case (Cancellation Suit of Trial Decision)

IP High Court 2011.11.30 H23(Gyo-Ke)10096

Canon Inc. is the registered owner of the word mark "GENESIS" specifying "telecommunication apparatus and instruments, electronic machines and their parts, etc," in Class 9 which was cancelled for non-use by a Cancellation Trial. Then, Canon filed the cancellation suit before the IP High Court requesting the cancellation of the Trial Decision.

Canon had been using the trademark GENESIS for the image processing system of fax machines for the office use as their functional indication in their web catalogues. GENESIS is an abbreviation of "Generation of New Superior Imaging System".

The JPO canceled Canons' registration saying that Canon did not use the trademark GENESIS as a trademark indicating the origin of the goods.

However, the IP High Court canceled the Trial Decision because the word GENESIS was used as a trademark in the distinctive and same font in the larger size than the other words in the web catalogues for the fax machines.

In regard to the use as the functional indication of the fax machines, the IP High Court said as follows.

Although the web catalogues mentioned GENESIS as "the image processing system", there was no further explanation about what the system was. The catalogues were mainly delivered for advertisements for the sales promotion. Therefore, the word "GENESIS" was used to express that the quality and the performance of the fax machines were very high and superior for the sales promotion, not used as merely functional indication.

We can understand from the Court Decision that words to be used as functional indications of machines should not be regarded as use of trademarks. However, we know many examples that the functional indications are used as trademarks. In this case as well, the GENESIS system was used by Canon as a trademark to express that their fax machines had the superior function.