

## Latest Court Decisions

**2012:**

**[January]**

### ● Chromax Case (Cancellation Suit of Trial Decision)

**IP High Court 2012.1.19 H23(Gyo-Ke)10194**

The Japanese company, IM K.K., (Plaintiff) was the proprietor of the Japanese trademark registration for the word mark "**Chromax**" specifying "golf balls, golf equipment" in Class 28.

On the other hand, the Taiwanese company, Sureway Enterprise Corporation, (Defendant) was the proprietor of the Taiwanese trademark registration for "**Chromax** (design)" (right) for "golf balls, golf clubs, and other golf equipment" in Class 28. Taiwan is a member country of World Trade Organization (WTO)



The Japanese registration "Chromax" was cancelled by a cancellation trial filed by the Taiwanese company under **Article 53-2** of the Trademark Law which is equivalent to **Article 6 septies of the Paris Convention "Registration in the Name of the Agent or Representative of the Proprietor without the Latter's Authorization"**.

Then, the Japanese company filed the law suit before the IP High Court requesting the cancellation of the Trial Decision.

The point at issue of the suit was whether or not the Japanese company (Plaintiff) could be considered as the agent or representative of the Taiwanese company (Defendant).

The Japanese company did not have a sales agent contract directly with the Taiwanese company. The Japanese company merely sold in Japan the golf balls manufactured by the Taiwanese company through its import agent in Japan from April 2007 until March 2008. The Japanese company filed the trademark application on April 8, 2008.

However, the Japanese company mentioned in their product catalogs as "Chromax General Sales Agent, IM Kabushiki Kaisha" and 95% of the imported golf balls of the Taiwanese company between April 2007 and March 2008 were sold to the Japanese company.

In view of these facts, the Court decided that the Japanese company could be regarded as the agent of the Taiwanese company since the Japanese company was integrated into the sales organization of the Taiwanese products due to the continuous transaction.

## ● MERX Case (Cancellation Suit of Trial Decision)

IP High Court 2012.1.30 H23(Gyo-Ke)10190

The German company, Merck KGaA, which is well-known as a worldwide chemical and pharmaceutical company, filed an Invalidation Trial against the registered trademark "MERX" with its Katakana equivalent "me-ru-ku-su" (right) specifying various retail services including pharmaceuticals and chemicals in Class 35.



However, the Petition was dismissed by the JPO and Merck KGaA filed the law suit before the IP High Court requesting the cancellation of the Trial Decision.

However, the Court also dismissed the Merck's petition because the trademarks "MERX" and "Merck" were not confusingly similar in their pronunciations. The pronunciation of "MERX" was 4 syllables of "me-ru-ku-su" and that of "Merck" was 3 syllables of "me-ru-ku". One different sound "su" at the end among these short syllables should give a large impact when distinguishing the two trademarks as a whole.

### 【Comments】

In Japan, the examination on the phonetic similarity of word trademarks even in English is conducted by converting its pronunciation into Katakana syllables. As shown in this case, the pronunciation of the trademark "Merck" is converted into the Katakana "メ(me)ル(ru)ク(ku)" which is 3 syllables.

Usually a 3 Katakana syllable trademark is judged as dissimilar to a 4 Katakana syllable trademark with the difference of one sound. However, Katakana "ス(su)" is a weak sound and therefore, when "su" is placed at the end of the Katakana pronunciation, the trademarks may be decided as similar. For examples;

Sanmac (sa-n-ma-kku) = SUNMAX (sa-n-ma-kku-su) (Trial No. 2009-23683)  
SLIM-TECH (su-ri-mu-te-kku) = SLIMTEX (su-ri-mu-te-kku-su) (Trial No. 2005-6420)  
LiviTY (ri-vi-ti) = LIVITIS (ri-vi-ti-su) (Trial No. 2004-13214)  
ELLEME (e-ru-me) = HERMES (e-ru-me-su) (Trial No. S59-22536)  
Pulco (pu-ru-ko) = PULCOS (pu-ru-ko-su) (Tokyo High Court H05-63)

However, if the pronunciations are short like two or three Katakana syllables, trademarks are usually decided as dissimilar. For examples;

DUCK (da-kku) X DAKS (da-kku-su) (Trial No. 2010-8601)  
iCam (a-i-ka-mu) X ICOMES (a-i-ka-mu-su) (Trial No. 2010-9332)  
SuLaRi (su-ra-ri) X SLARIS (su-ra-ri-su) (Trial No. 2009-20693)  
PEEK (pii-ku) X PEAKS (pii-ku-su) (Trial No. 2004-8505)