

## Latest Court Decisions

**2012:**

**[February]**

### ● Chupa Chups Case (Injunction Appeal Case)

**IP High Court 2012.2.14 H22(Ne)10076**

The infringing goods were sold at a large internet shopping mall "Rakuten Ichiba". The trademark proprietor of the registered trademark "Chupa Chups", sued the operator of the web-site, Rakuten KK, before the Tokyo District Court demanding an injunction from the sales of the infringing good.



However, in August 2010, the Tokyo District Court dismissed the injunction demand because the infringing party should be the seller of the goods and that Rakuten KK merely lent the sales space at their web-site and therefore, they had no legal responsibilities for the trademark infringement.

Then, Perfetti Van Melle S.p.A. filed an appeal suit before the IP High Court. The IP High Court stated as a general rule that the trademark proprietor has a right to sue an operator of the web-site for an injunction and damages as long as the operator does not delete the web page relating the infringing goods within an appropriate term when knowing the infringement at its web-site since the operator controls the web-pages and collects lending and usage fees from the sellers of the goods.

By applying the above general rule to the subject case, Rakuten KK deleted the web pages on the day when they received a warning letter and within 8 days from receipt of the duplicate copy of the Letter of Complaint filed by Perfetti Van Melle S.p.A. Therefore, Rakuten KK has no legal responsibilities since they deleted all the web pages within the appropriate term.

We believe that the IP Court Decision should be reasonable. However, the Court should have additionally paid an attention from the standpoint of the consumers. This is because that the consumers buy the goods by relying on the trademark of the internet shopping mall, Rakuten Ichiba, believing that the goods sold at such a large shopping mall should have a good quality and never infringe the IP rights of other parties.

**[Article 1 of the Trademark Law]**

**The purpose of this Act is**, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and **to protect the interests of consumers.**

● Sportman.jp Case (Cancellation Suit of Trial Decision)

IP High Court 2012.2.15 H23(Gyo-Ke)10287

A trademark application for "SPORTS LABORATORY/**Sportaman.jp**" specifying the retail services in Class 35 was rejected due to the cited trademarks "**SPORTS MAN**" because the part ".jp" was not distinctive as a trademark because it was understood by the consumers as the indication of the top level domain.



The IP High Court accepted this Trial Decision issued by the JPO. We have a number of trial decisions regarding the trademarks including the IT terms such as ".jp", ".com", "@", "web" and "net".

● BLACK MENTHOL Case (Cancellation Suit of Trial Decision)

IP High Court 2012.2.15 H23(Gyo-Ke)10309

A trademark application for "**BLACK/MENTHOL** (logo)" for cigarettes with menthol flavor, and other tobacco, matches, smokers' articles in Class 34 filed by Phillip Morris was rejected by the JPO due to the cited trademark "**BLACK**" with the seven star devices in the name of Japan Tobacco KK.



You will see that the letters "A" of the words "BALCK" in the two trademarks replaced with a device and the star device. However, funnily enough, the JPO did not read the two trademarks as "BLACK" and they decided the two trademarks as similar in the common pronunciations of the four letters "B·L·C·K".



Then, Phillip Morris filed the cancellation suit before the IP High Court.

The IP High Court decided that although the two trademarks were similar in the pronunciation and the meaning "BLACK", there was no fear of confusion since the applied-for trademark was well-known by the MARLBORO brand tobacco while the cited trademark was also well-known by the SEVEN STAR brand tobacco.

However, the Court said that the two trademarks should be considered as confusingly similar in respect of "matches" among the specified goods of the two trademarks since the two trademarks were not well-known regarding matches.

We believe that the applied-for trademark should be regarded as a whole as "BLACK MENTHOL" because there is no menthol in black color and therefore, "BALCK MENTHOL" is a coined word with some suggestive meanings. In addition, the word "BLACK" is also descriptive of goods and its distinctiveness should not be strong enough as a trademark.

Thus, we believe that the two trademarks are not confusingly similar even in respect to "matches".

Please note that color words are usually rejected as trademarks due to lack of distinctiveness. However, we know the following trial decisions deciding the trademarks were distinctive for registration.

- Trial No. 2008-1174 "BLACK" for computer programs in Class 9
- Trial No. 2006-28211 "BLUE" for medical instruments and apparatus in Class 10
- Trial No. 2005-8446 "GOLD" for fashion information in Class 45
- Trial No. 2005-18633 "GOLD" for golf tournaments in Class 41
- Trial No. 2004-20428 "SILVER" for cigarettes and matches in Class 34

### ● ABBEY ROAD Case (Cancellation Suit of Trial Decision)

IP High Court 2012.2.28 H23(Gyo-Ke)10342

A Cancellation Trial was filed by a British company, EMI (IP) Limited against the registered trademark "ABBEY ROAD" in English and Katakana letters for "bags" in Class 18 in the name of a Japanese company on the basis of Article 51 of the trademark Law.



#### 【Article 51】

Where a holder of trademark right intentionally uses, either a trademark similar to a registered trademark in connection with the designated goods or designated services, or a registered trademark in connection with goods or services similar to the designated goods or designated services or a trademark similar thereto, in a manner that misleads as to the quality of the goods or services or causes confusion in connection with the goods or services pertaining to a business of another person, any person may file a request for a trial for rescission of the trademark registration.

However, the JPO dismissed the EMI's petition saying that there would be no fear of confusion. Then, EMI filed a cancellation suit before the IP High Court. However, the IP High Court also dismissed the EMI's petition.

The Court admitted that "Abbey Road" was well known in Japan in relation to the Beatles and the plaintiff EMI Records. However, no goods bearing the trademark "ABBEY ROAD" were distributed in Japan by EMI other than the record albums "ABBEY ROAD" by the Beatles. The goods bearing "ABBEY ROAD STUDIOS" were only distributed in Japan. In addition, "ABBEY ROAD" was a mere street name before the sales of the record albums "ABBEY ROAD" by the Beatles. Therefore, the Court decided that there was no fear of confusion with the goods by EMI and the Beatles.

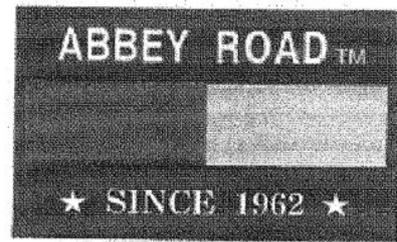
However, the defendant Japanese company displayed on the tags of the carrying cases "SINCE 1962" that was the year of the record debut of the Beatles as well as the sentence <The Beatles saved the world. The only hope for any of us is peace. Live peace and breathe peace..... from "ABBEY ROAD", one of the world's most famous street. >

We believe that these facts show that the Japanese company sold their goods by utilizing the authority of the Beatles and the customers also bought these goods since they were the fans of the Beatles.

This means that the Japanese company got a free ride on the fame of the Beatles as well as ABBEY ROAD and ABBEY ROAD STUDIOS.

However, the IP High Court said that these words were used by the defendant Japanese company in order to merely explain the derivation and the connection of the Abbey Road and The Beatles, and that therefore, there was no fear of confusion with the EMI's goods and the Beatles.

We wonder how foreign people feel this Japanese IP High Court Decision ?



*The Beatles saved the world.  
The only hope for any of us is peace.  
Live peace and breathe peace..... from  
"ABBIEY ROAD", one of the world's most  
famous street.*

No.