

## Latest Court Decisions

2012:

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### ● KDDI/Module/Inside Case (Cancellation Suit of Trial Decision)

IP High Court 2012.3.28 H23(Gyo-Ke)10323

Intel Corporation filed an Invalidation Trial against the registered trademark "KDDI/Module/Inside" specifying "electric communication machines and apparatus, etc." in Class 9 on the basis of the well-known trademark "intel/inside" (the cited trademark) because the "KDDI/Module/Inside" was liable to cause confusion with Intel's goods (Article 4-1-15 of the Trademark Law).



However, the JPO dismissed the petition by Intel Corp and Intel Corp filed the cancellation suit before the IP High Court requesting cancellation of the Trial Decision.



It was clear that the two trademarks were not similar in their appearances and the pronunciations. Hence, Intel Corp. alleged that the well known part of the cited trademark was the expression form of "...inside".

However, the IP High Court also dismissed Intel's petition with the following reasons.

- ① Intel Corp. only registered a trademark "THE JOURNEY INSIDE" as trademarks including the expression "...inside" other than "intel/inside."
- ② Intel Corp. did not use any other trademarks including the expression "...inside" than "intel/inside."
- ③ The trademark "INSIDE" alone had been registered by Hitachi, Ltd. prior to the Intel's trademark registration. Therefore, the trademark "intel/inside" had less originality.
- ④ The part "KDDI" in the subject trademark was also well known in Japan.
- ⑤ Considering all the above facts, there was no fear that the subject trademark got a free ride on the fame of the cited trademark.

The IP High Court added that it could be assumed that KDDI filed the subject application knowing that "intel/inside" was familiar to Japanese customers. However, internal products incorporated in the finished goods could not be seen from outside. For such internal products, the expression "...inside" was rather useful, and accordingly KDDI might have filed the subject trademark application.