

Latest Court Decisions

2012:
[July]

- **COOL BOSS Case (Cancellation Suit of Trial Decision)**

IP High Court 2012.7.18 H23(Gyo-Ke)10436

An Invalidation Trial filed by Hugo Boss Trademark Management GmbH & KG against the registered trademark "COOL BOSS" in Katakana letters specifying "working wear with the ventilation function, non-Japanese style outer clothing, and coats" in Class 25 was dismissed by the JPO because the trademark "COOL BOSS" was not confusingly similar to the cited trademarks "BOSS/HUGO BOSS" and "BOSS". Then, Hugo Boss filed the cancellation suit against the Trial Decision before the IP High Court.



The IP High Court also decided that the trademarks "COOL BOSS" and "BOSS/HUGO BOSS" were not similar (§4-1-11 of the TM Law). However, the IP High Court cancelled the Trial Decision because the trademark "COOL BOSS" was liable to cause confusion with the goods manufactured by Hugo Boss since the cited trademark "BOSS" was well known in Japan for men's clothing and men's articles (§4-1-15 of the TM Law).

On the other hand, the trademark "COOL BOSS" was used for the working wear with the small fan for ventilation and therefore, the word "COOL" in the trademark "COOL BOSS" was descriptive of goods and the word "BOSS" of the trademark was functioning as the trademark indicating the place of origin.

As the result, the trademark "COOL BOSS" was liable to cause confusion with the goods by Hugo Boss.

We disagree with this Court Decision because the men's wear by Hugo Boss is highly-sophisticated and expensive in comparison with the working wear. In addition, Hugo Boss goods are sold at the famous department stores in the big cities in Japan while the working wear is sold at home centers in local towns at the lower prices.

Therefore, we believe that there will be almost no confusion between the trademark "BOSS" by Hugo Boss and the trademark "COOL BOSS" as far as the goods "working wear".

- **POWERWEB Case (Cancellation Suit of Trial Decision)**

IP High Court 2012.7.19 H23(Gyo-Ke)10375

An application for the trademark "POWERWEB" filed by Adidas International Marketing BV for "special sport clothing, special sport footwear" in Class 25 was rejected by the JPO on the basis of the cited trademark "POWERWAVE" in English and Katakana. Then, Adidas filed the cancellation suit of the Trial Decision before the IP High Court.

POWERWAVE
パワーウェーブ

The IP High Court cancelled the Trial Decision saying that the trademark "POWERWEB" would not be confused with the cited trademark "POWERWAVE" in their appearances and meanings although their pronunciations might be somewhat similar. The Court said that the word "POWER" in the two trademarks was being widely used for sporting articles and that the two words "WEB" and "WAVE" are familiar to the Japanese consumers.

• **3MS Cases (Cancellation Suit of Trial Decision)**

IP High Court 2012.7.26 H23(Gyo-Ke)10403, 10404

3M Company filed Invalidation Trials against the trademark "SAN M's" with its equivalent Katakana letters and the trademark "3MS" both specifying "treatment or processing of cloth, clothing or fur (including drying); tailoring or dressing; wood-working; food processing; printing, etc" in Class 40 in the name of a Japanese company, SAN M's Kabushiki Kaisha.



The logo consists of the text "SAN M's" in a stylized font, with "サンエムズ" (San Emuzu) written in Katakana below it.



The logo consists of the letters "3MS" in a bold, italicized, sans-serif font.



The logo consists of the letters "3M" in a bold, sans-serif font.

The Japanese pronunciation "sa-n" means the numeral "3". Therefore, 3M Company considered the trademark "SAN M's" as confusingly similar to "3M" since "3M" could be also pronounced as "sa-n-M".

The JPO dismissed 3M's petitions and then, 3M Company filed the cancellation suits before the IP High Court.

The IP High Court also dismissed 3M's petition against the trademark "SAN M's" with its equivalent Katakana letters because "3M" of 3M Company was always pronounced as "Three M" and it was never called as "sa-n-M".

However, the IP High Court cancelled the Trial Decision on the trademark "3MS" because the trademark "3MS" without Katakana letters could be pronounced variously such as "three Ms", "three M-S", "sa-n Ms", and "sa-n-M-S". The pronunciation "three-Ms" among them was confusingly similar to the pronunciation "three-M" of "3M".

Furthermore, "3M" was well known in Japan for its products "Post-it" and "Scotch Tape" for stationery, "Scotchgard" for water-proof sprays, "Thinsulate" for insulation materials and other goods. Since the "water-proof sprays" and "insulation materials" among these 3M products closely related to "treatment or processing of cloth, clothing or fur" in the specified services of the defendant's trademark "3MS", if the defendant's trademark was used for said specified services, it would cause confusion as if these goods were manufactured by a company that had any relationship with 3M Company in the systematic or economic collaboration.

However, we disagree with this Court Decision because the both trademarks "SAN M's" with its equivalent Katakana letters and "3MS" were used by the same Japanese company "SAN M's Kabushiki Kaisha" and therefore, the trademark "3MS" would be also always called by the consumers as "sa-n-Ms" which was the same pronunciation to the other trademark "SAN M's" and the main part of the company name. In addition, the appearance of "3MS" is quite different from "3M" and therefore, there will be no consumers who misunderstand the defendant's goods as 3M Company's goods.