

## Latest Court Decisions

**2012:**

**[September]**

- **SURF'S UP Case (Injunction Demand)**

**Tokyo District Court 2012.7.18 H23(Wa)23260**

A trademark "SURF'S UP" in plain letters in English and Katakana for clothing in Class 25 is registered by a Japanese company (plaintiff).

The defendant was using the mark consisting of the words "SURF'S UP", "GOTCHA" and the device with 78 on the front of T-shirts.

The plaintiff demanded the defendant to stop using of the mark for the T-shirts.

The issue was whether the defendant's mark was regarded as use of the trademark or not.

The Tokyo District Court decided that the defendant's mark was not regarded as use of the trademark with the following reasons.



- a) The word "SURF'S UP" means "SURF IS UP" which is used for surfing when the good wave is coming.
- b) "SURF'S UP" was used in relation to the surfing such as an album title by the Beach Boys 1970's, as the title of an animation movie film in which a penguin was surfing, and an on-line game title regarding surfing as well as in a radio program regarding surfing.
- c) Therefore, the words "SURF'S UP" was not a coined words created by the plaintiff, rather it was a popular expression regarding the surfing.
- d) "SURF'S UP" was used on the front or the back of T-shirts and shirts by at least 20 companies in addition to the plaintiff and the defendant.
- e) The plaintiff's "SURF'S UP" goods were not well known to the consumers.
- f) "GOTCHA" was the surf brand launched by the famous professional surfers in USA in 1978.
- g) The defendant officially sponsored the Japan Surfing Confederation in order to advertise the "GOTCHA" brand and hosted the surf cups naming "GOTCH" every year since 2007 that were broadcasted on TV.
- h) As the result, the trademark "GOTCHA" became well known among the consumers in 20s and 30s.

- i) The trademark "GOTCHA" as well as the following marks was born on the neck labels and the tags of the defendant's T-shirts.

The logo for "GOTCHA" is written in a bold, stylized, black font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The word "GOTCHA" is followed by a small registered trademark symbol (®).

- j) However, the word "SURF'S UP" was not used on these neck labels and the tag while it was only used on the front of the T-shirts.
- k) Under the circumstances, the consumers distinguished the defendant' goods by the GOTCHA trademarks rather than the word "SURF'S UP" which was not regarded as a trademark accordingly.