

Latest Court Decisions

2013:

[January]

- **Cache Case (Injunction Demand)**

Osaka District Court 2013.1.24 H24(Wa)6896

The plaintiff is a proprietor of a registered trademark "Cache" in standard characters for "beauty salons, hairdressing salons" in Class 44.

The defendant used the trademarks "cache" (right upper: Mark 1) and "aisé /cache" (right lower: Mark 2) for beauty salons. The plaintiff demanded an injunction and damage compensation from the defendant as an trademark infringement.



The Osaka District Court found that the defendant's Mark 1 "cache" infringed the plaintiff's trademark right while the Court denied an infringement regarding the defendant's Mark 2 "aisé /cache" because the "aisé" part in the Mark 2 gave a prevailing impression to the customers as a trademark, and therefore, the pronunciation of the Mark 2 was "aisé cache" or "aisé".

We have a Supreme Court Decision in 2008 regarding the combined trademark of two words on how to decide the pronunciation of such a trademark. That is as follows.

It is not allowed to judge a similarity between a trademark (A) and a combined trademark (A+B) by diving one part (A) from the combined trademark (A+B) excepting the following cases.

- Said part (A) gives consumers a prevailing impression as a trademark for the specified goods and/or services.
- The remaining part (B) does not have a pronunciation and meaning as a trademark like the cases that part (B) is descriptive of nature of the goods and/or services, or the part (B) does not have distinctiveness as a trademark like common words.

According to these guide lines, we agree that the "aisé" part in the Mark 2 gives consumers a prevailing impression as a trademark. However, we do not agree that "cache" part in the Mark 2 describes nature of the services, or it does not have any distinctiveness for the services as a trademark. Therefore, we believe that the Mark 2 "aisé /cache" is liable to cause confusion with the plaintiff's registered trademark "Cache".

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

IP High Court 2013.1.31 H24(Gyo-Ke)10334

An Invalidation Trial was filed against the registered trademark (right) on the basis of the cited trademarks "BEAMS" in English and Katakana letters.



The JPO decided that the two trademarks were not confusingly similar because the subject trademark could not be recognized as "Beams" since the left device in the subject trademark looked like leaves.

Then, the petitioner filed the cancellation suit of the trial decision.

The IP High Court stated that the left device could be looked like the leaves when we saw the device alone. However, we knew that the initial letters of proper nouns were uppercases. In the subject trademark, alphabetical letters were written in the lower-cases. The device and the letters were in the same blue color and they could be seen as one word "Beams". Therefore, the subject trademark "Beams" was similar to the cited trademarks "BEAMS".

The IP High Court as well as the TTAB examined the subject trademark as to whether it could be seen as a word or not, only from the constitution of the subject trademark. However, the subject trademark was used by the proprietor, KK Beams Design Consultant. We can easily assume that the subject trademark should be their house mark. If that is the case, their clients will see the subject trademark with the name of "Beams".

Therefore, the plaintiff should have proven that the defendant's trademark was their house mark and it was called as "Beams" in the actual trade. Then, the IP High Court would decide that the defendant's trademark was similar to the cited trademarks "BEAMS".