

Latest Court Decisions

2013:

[April]

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

IP High Court 2013.4.18 H24(Gyo-Ke)10360

A U.S. company, Intel Corp. filed an Invalidation Trial against the registered trademark **"INTELGROW"** in Katakana letters in Classes 19 and 37 in the name of a Japanese company because the subject trademark "INTELGROW" contained the well-known trademark "INTEL" (Art.4-1-8), and was liable to cause confusion with the goods by Intel Corp. (Art. 4-1-11, 15, and 19).



The JPO dismissed the Intel's petition and then, the cancellation suit was filed before the IP High Court.

However, the IP High Court also dismissed the Intel's petition because the trademark "INTELGROW" was a coined word created by the defendant, the name of which was also "K.K. INTELGROW". Therefore, the trademark "INTELGROW" should be considered as a one word as a whole and could not be divided into "INTEL" and "GROW".

Intel Corp. also filed an Opposition against the registered trademark "INTELGROW" for retail services of architectural materials in Class 35 and construction services in Class 37. However, this opposition was also dismissed by the JPO on December 28, 2011.

The first case that Intel Corp. opposed the trademark containing the word "INTEL" was INTELLASSET case on December 20, 2007 regarding the trademark **"INTELLASSET/GROUP"** in Classes 35, 36 and 41. The IP High Court cancelled this registration because the trademark contained the well-known name "INTEL" of INTEL CORPORATION (Art.4-1-8).

However, in the 2nd case on October 20, 2009, the IP High Court dismissed the Intel's petition against the registered trademark "INTELLASSET" in Class 35.

Therefore, this time Court Decision was foreseeable. In fact, the main business of the trademark proprietor, the defendant, KK INTELGROW, was to market and install household equipment instrument that had no relation with semiconductors marketed by Intel Corp.

- **NINA L'ELIXIR Case** (Cancellation Suit of Trial Decision)

IP High Court 2013.4.24 H24(Gyo-Ke)10336

An Invalidation Trial was filed against the International trademark registration for **"NINA L'ELIXIR"** for cosmetics in Class 3 in the name of Puig France.

NINA L'ELIXIR

The demandant was K.K. Shiseido and the cited trademark was **"ELIXIR"** which was the well-known Japanese cosmetic brand.

However, the IP High Court as well as the JPO dismissed Shiseido's petition because the two trademarks were not confusingly similar since there was no reason to divide the trademark "NINA L'ELIXIR" into "NINA" and "L'ELIXIR". Although, this would be a usual common-sense judgment, we would try to criticize the court decision.

First of all, the court admitted that the part of the subject trademark "L'ELIXIR" was a combination of a French definite article "Le" and "ELIXIR". However, the court said that people who were familiar with the French language would not recognize "ELIXIR" as a single word from "L'ELIXIR" separating the definite article "L'".

However, we believe that people who are familiar with the French language can easily recognize the word "ELIXIR" from "L'ELIXIR" because liaisons of the definite articles are rather common.

In addition, Japanese people cannot understand what "ELIXIR" means. However, we suppose that "ELIXIR" has a typical French sound and Japanese consumers understand "ELIXIR" as a French word. Therefore, if people who have studied the French see the word "L'ELIXIR", they can understand that "L'ELIXIR" is a liaison of "Le" and "ELIXIR".

Therefore, it cannot be denied that the subject trademark "NINA L'ELIXIR" contains the other party's well known trademark "ELIXIR".

Secondly, the court said that while NINA L'ELIXIR perfumes were being sold at Internet shopping, there were no justifiable reasons in such web-sites to compare the "L'ELIXIR" part with trademarks of the others.

However, we can see that NINA L'ELIXIR perfumes are being sold with the other perfumes such as "NINA fantasy", "NINA RICCI NINA" and "NINA RICCI/L'Air du Temps". This means that NINA L'ELIXIR is one of the NINA perfume series and the consumers distinguish these perfumes by the other parts such as "fantasy", "L'ELIXIR", "NINA" and "L'Air du Temps" than "NINA" and/or "NINA RICCI."

If that is the case, the "L'ELIXIR" part in the subject trademark can be separately recognized as a trademark.

Furthermore, there might be consumers who misunderstand that NINA L'ELIXIR perfumes are collaborative products by the famous NINA RICCI and the Japanese leading cosmetic brand SHISEIDO.

Thus, there would be not necessarily no risk of confusion between "NINA L'ELIXIR" and Shiseido's "ELIXIR".