

## Latest Court Decisions

**2017:**

**[June]**

- **WENGER CROSS DEVICE TRADEMARK Case**  
**(Cancellation Suit of Trial Decision)**  
**IP High Court 2017.6.8 H29(GYO-KE)10033**

### **[SUMMARY/INTRODUCTION]**

A Swiss corporation famous for army knives, Wenger S.A., is a proprietor of IR No. 1002196 for the Cross device trademark for the goods in Classes 8, 9, 11, 12, 14, 16, 18, 20, 22, 25 and 34 designating Japan.



A Japanese citizen (Defendant) filed a cancellation trial for non-use against the IR trademark partially for the goods in Classes 9 and 18. Since Wenger S.A. did not respond to the cancellation action, the IR trademark was partially cancelled by the JPO.

Then, Wenger S.A. (Plaintiff) filed a cancellation suit before the IP High Court by submitting the leather cases suited for their army knives held with waist belts as evidence of use for the goods in Class 18.

The point of dispute was whether the leather cases were considered as general cases in Class 18 or as exclusive accessories of knives in Class 8.

What was the Court decision ?

### **[Case]**

The General Remarks of International Classification of Goods and Service, Edition 9 provides as follows:

#### **[Goods]**

(f) Cases adapted to the product they are intended to contain are in principle classified in the same class as the product.

According to this remark, "cases for smartphones", "cases for sunglasses" and "DVD cases" belong to Class 9, "Jewelry cases" belong to Class 14, "guitar cases" belong to Class 15, "writing cases" belong to Class 16, "leather cases" belong to Class 18, "toilet cases" belong to Class 21 and "ski cases" belong to Class 28.

Therefore, the Defendant alleged that the leather case suited for army knives should be belonged to Class 8 rather than to Class 18.

However, the IP High Court decided that the leather cases belonged to **Class 18** as “**small personal leather goods**” among the specified goods while admitting the leather cases were suited for army knives and then, the IP High Court cancelled the Trial decision.

The IP High Court presented the following 3 reasons as the Court Decision.

- (1) The leather cases in cubic shapes could hold items other than army knives.
- (2) The leather cases could be purchased without army knives.
- (3) The Swiss army knives held a bottle cap opener, toothpick, scissors and other items in addition to a knife.

We can try to criticize the above 3 reasons.

(1) For instance, guitar cases are exclusively used for storing guitars therein. However, some people use guitar cases for storing clothes when going out. Such uses of guitar cases are exceptional. Likewise, holding items other than army knives in the leather cases for army knives is exceptional uses and is not an essential reason.

(2) According to the Victorinox web-site <[www.victorinox.com/](http://www.victorinox.com/)>, the prices of army knives are 5,200 Yen to 51,000 Yen which are rather expensive while the prices of the leather cases are 2,900 Yen. In addition, some customers do not require the leather cases. Therefore, it is only natural that the leather cases are sold separately from the army knives.

(3) As shown in the photo from the Victorinox web-site, the distinctive feature of the army knives is incorporating various functional tools such as bottle cap opener, toothpick, scissors, screwdriver, file, saw and wine opener in addition to knife. However, these functions are additional accessories to the knife as is called “army knife”. If customers require, for instance, a wine opener among such functions, they will buy a more familiar wine opener itself.



As seen above, the reasons the IP High Court presented are not essential ones for the judgement.

In addition, the Victorinox website construction is “PRODUCT” → “MULTITOOL” (Swiss Army Knives) → “(KNIFE) ACCESSORIES” → “CASES” → “LEATHER CASE”. Therefore, customers will recognize these cases exclusively for the army knives.

Accordingly, we can say that the leather cases at issue should belong to Class 8 as the specified goods "knife holders, cutlery pouches sold empty, knife cases, knife holsters, knife covers" rather than Class 18 as "small personal leather goods".