

## Latest Court Decisions

**2017:**

[September]

- [MIZUNO RUNBIRD DEVICE Case \(Cancellation Suit of Trial Decision\)](#)  
**IP High Court 2017.9.13 H28(Gyo-KE)10262**

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

A Chinese company, Fujian Hongxing Erke Sports Goods Co., Ltd., is a proprietor of International Reg. No. 1119597 for the line device mark in Classes 18, 25 and 28 (Right-upper).



A Japanese leading sporting goods company, MIZUNO Corporation, being the proprietor of the device mark called as "RUN BIRD" under No. 4716649 in many classes including Classes 18, 25 and 28 (Right-lower), filed an



Invalidation Trial against Int'l No. 1119597 saying the International trademark was liable to cause confusion with MIZUNO's registered trademark since MIZUNO's trademark was well-known in Japan.

However, the Trial Board of the JPO dismissed the MIZUNO's petition because the two trademarks were not confusingly similar. Then, MIZUNO brought the case before the IP High Court.

What was the Court decision?

### **[Case]**

MIZUNO started using the RUNBIRD device mark for sporting shoes since 1983. The device mark was named as "RUNBIRD" since it looked like a running bird. Then, MIZUNO has been using the RUNBIRD mark for sporting wear and bags, and that mark has been used also as their house mark since 1998.

MIZUNO alleged that the RUNBIRD mark became a well-known trademark and the Trial Board of the JPO admitted it in their Trial decision.

However, the JPO dismissed the MIZUNO's petition because the two trademarks were not confusingly similar.

The IP High Court also admitted the differences between the two trademarks, especially the difference of the heights of the two marks and the presence of a central white inverted triangular device in the RUNBIRD mark.

However, the IP High Court decided that the International trademark was liable to cause confusion with the RUNBIRD trademark since the overall compositions of the two marks were similar, especially, the upper half of the RUNBIRD mark was almost identical to the International trademark.

In addition, the Court said as the actual state of trade that the RUNBIRD trademark was being used as a one-point mark for sport wear, socks and caps, and that since a size of a one-point mark was rather small, the detail of such a one-point mark, for example, the inverted triangular device in the RUNBIRD trademark on the shirts, sometimes could not be clearly seen.

Thus, the IP High Court cancelled the Trial Decision issued by the JPO under Article 4-1-15 because the consumers might misunderstand that the goods bearing the International trademark were related with MIZUNO since the International trademark reminded the consumers of the MIZUNO's RUNBIRD trademark.

There were two articles of the Japanese Trademark Law that MIZUNO insisted as the invalidation reasons, i.e. Article 4-1-11 and Article 4-1-15 as follows.

**【Article 4-1-11】**

A trademark is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark, or goods or services similar thereto.

**【Article 4-1-15】**

A trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in Articles 10 to 14 inclusive).

The JPO's decision denied the application of these articles. However, the IP High Court examined only about the application of Article 4-1-15 and admitted it. Since the trademarks themselves were not similar, application of Article 4-1-11 would not be admitted.

Now, let us see the one-point marks of the both parties' shirts. We can see uses of the two trademarks from their web-sites, "<https://erke.en.alibaba.com/>" and "<http://www.mizunoshop.net/f/dsg-598776>".



As you see, we have to agree with the Court's opinion regarding the use of the two marks as one-point marks. In fact, they look very similar.

On the other hand, the two marks on the shoes look quite different.



Since the use of their trademarks for these shoes are not as one-point marks, there will be no likelihood of confusion. If the defendant could show these facts, the IP High Court might not cancel the Trial Decision only with respect to shoes.