

Latest Court Decisions

2018:

[June]

- **GUZZILLA Case (Cancellation Suit)**

IP High Court 2018.6.12 H29(Gyo-Ke)10214

[SUMMARY/INTRODUCTION]

The trademark "GUZZILLA" (right) was registered on April 27, 2012 specifying "mining machines and apparatus; construction machines and apparatus; loading machines and apparatus, etc." in Class 7 by a Japanese corporation, KK Taguchi Kogyo (hereinafter called as "Taguchi").



Toho KK (hereinafter called as "Toho"), a film production corporation, filed an Invalidation Trial according to Article 4-1-15 of the Trademark Law insisting that the trademark "GUZZILLA" was liable to cause confusion with the origin of goods by Toho since the trademark "GUZZILLA" was confusingly similar to the well-known movie character "GODZILLA".

However, the JPO dismissed the Toho's petition because the trademarks "GUZZILLA" and "GODZILLA" were not confusingly similar and the specified goods such as mining, construction and loading machines and apparatus had no connection with the movie character GODZILLA although "GODZILLA" was well-known to Japanese people.

Then, Toho brought the case before the IP High Court demanding the cancellation of the trial decision by the JPO. What was the Court decision ?

[Court Decision]

The IP High Court issued the cancellation decision of the trial decision saying the trademark "GUZZILLA" and "GODZILLA" were confusingly similar in their appearances and pronunciations because the first letter "G" and the last five letters "ZILLA" were in common and "U" and "O" might be mistaken since "U" in "GUZZILLA" connected to the third letter "Z". Therefore, the appearances of the two trademarks were similar.

In addition, "GUZZILLA" could be pronounced as "ga-zi-la" or "gua-zi-la" while "GODZILLA" could be pronounced as "go-zi-la" or "guo-zi-la", therefore, these pronunciations were similar.

Now then, how did the IP High Court decide about the fear of confusion between the specified goods of the "GUZZILLA" trademark such as "mining machines and apparatus; construction machines and apparatus; loading machines and apparatus, etc." in Class 7 and the well-known movie character "GODZILLA" ?

The specified goods of "GUZZILLA" were mainly for industrial use in Class 7. However, the IP High Court referred to the goods for general consumers among the specified goods of "GUZZILLA" such as "brush cutters, mowing machines, hedge trimmers, branches scissors, electric jacks, winches, electric chain blocks, etc." which were sold at home centers, on-line shops and TV shopping at reasonable prices.

On the other hand, the movie fans were general consumers and the GODZILLA character was licensed for variety of goods for general consumers. Therefore, the customers for GUZZILA and GODZILLA were in common to a certain extent and if the trademark GUZZILLA was used for these consumer goods, it was liable to cause confusion with the GODZILLA goods.

[COMMENTS]

Since the first trial decision was cancelled by the IP High Court, the invalidation petition is being examined again the Trial Board of the JPO. The IP High Court cancelled the first trial decision in view of the consumer goods among the specified goods of the GUZZILLA trademark.

In other words, the IP High Court decision might not be reasonable regarding the goods for industrial use which means the Trial Board may issue a partial invalidation decision only for the general consumer goods other than industrial goods.

In fact, the defendant Taguchi, the owner of the GUZZILA trademark, filed a new application for the identical trademark GUZZILLA specifying "attachments of crushing machines, cutting machines, punching machines of power shovels" in Class 7 soon after the IP High Court decision was issued.

In addition, the defendant Taguchi also filed a new application on the same day a slightly different trademark GUZZLER (right) only for industrial machines such as "mining machines and apparatus; construction machines and apparatus; loading machines and apparatus, etc." in Class 7.



Furthermore, this IP High Court decision showed their tough posture against the defendant Taguchi. This might be because the judges had unfavorable conviction to the defendant Taguchi since they distributed towels, watches, gloves, T-shirts bearing the marks "SUPER GUZZILLA" and "SPACE GUZZILLA" which were similar to the trademarks "SUPER GODZILLA" and "SPACE GODZILLA" used by the plaintiff, Toho. In addition, the defendant Taguchi filed trademark applications for parody trademarks of the other parties' well-known trademarks.

From these facts, the IP High Court judges seemed to feel a bad faith by the defendant Taguchi.