

Latest Court Decisions

2018:

[July]

• PH5 Lamp Shade Case (Cancellation Suit)

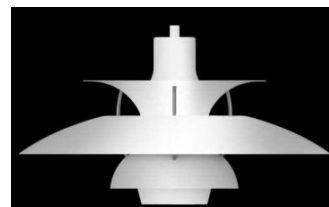
IP High Court 2018.7.25 H30(Gyo-Ke)10004

[SUMMARY / INTRODUCTION]

A Japanese interior shop "K.K. R&M Japan" (the Plaintiff) registered the lamp shade device mark with its store name (right upper) for retail services for electric lamps and other lighting apparatus in Class 35.



A Danish corporation, Louis Poulsen A/S (the Defendant), registered the lamp shade shape as a three-dimensional trademark (right lower) for lamp shades in Class 11. This means that the Defendant's three-dimensional trademark was well-known in Japan called as "PH5".



The Plaintiff R&M's trademark contained the lamp shade device which was quite similar to the Defendant Louis Poulsen's lamp shade shape. In addition, R&M, had been selling replace lamp shade of Louis Poulsen offer the expiration of Louis Poulsen's industrial design patent..

Louis Poulsen filed an Invalidation Trial demanding the invalidation of R&M's trademark registration under Article 4-1-19 of the Trademark Law. The JPO issued the invalidation decision accepting the Louis Poulsen's petition. Then, R&M 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 **Article 4-1-19** of the Trademark Law provides as follows.

No trademark shall be registered:

if the trademark is identical with, or similar to, a trademark which is **well known** among consumers **in Japan** or **abroad** as that indicating goods or services pertaining to a business of another person, if such trademark is used for **unfair purposes** (referring to the purpose of **gaining unfair profits, the purpose of causing damage to the other person**, or any other unfair purposes).

The Article 4-1-19 requires the well-knownness of the trademark to be protected and the unfair purposes of the other party.

The "PH5" lamp shade was designed by **Poul Henningsen** and was announced in 1958. The Plaintiff, R&M, insisted that since the Japanese design patent right expired, the sales of such lamp shades became free as a public domain. However, the IP High Court dismissed R&M's claims and supported the trial decision.

The IP High Court admitted that the "PH5" lamp shade was well-known among traders and consumers of lighting apparatus in Japan at the time of the filing trademark application by the Plaintiff, R&M, as the trademark indicating the origin of the Defendant, Louis Poulsen A/S.

The "PH5" lamp shades were released in 1958 in Japan and their suppliers were approx. 5,000 such as architectural design offices, general contract design offices, house reform makers and furniture interior shops. The "PH5" lamp shade was introduced in many books and magazines with its photographs with a high evaluation. As the result, in 1997 it won a good design award by the Ministry of International Trade and Industry (MITI).

The "PH5" lamp shade was a longtime seller for more than 40 years in Japan and 74,627 lamp shades were sold in total from 1999 to 2014. Although the number of the sales was not so big, it did not interfere to obtain the distinctiveness as a trademark in view of the facts such as the unique and distinctive design of the "PH5" lamp shade, the appearance situation in the books and magazines and the MITI award.

Article 4-1-19 also requires an existence of the unfair purposes of the Plaintiff's trademark registration. The IP High Court admitted the unfair purposes because while the "PH5" lamp shade was well-known, R&M sold the replica products, R&M filed the trademark application after it received a warning letter from Defendant, Louis Poulsen, and R&M took the import suspension procedures at the customs office against the import of the genuine "PH5" lamp shades.

As to the R&M's claims that the design of the "PH5" lamp shade became a public domain, the IP High Court rejected such claims saying the Plaintiff should have known as a trader of interior goods that the well-known shapes such as "PH5" were protected by the Unfair Competition Prevention Law.

There was another case regarding the lamp shade of Louis Poulsen called as "**PH Snowball Case**" issued on the same day by the IP High Court.

R&M's registered trademark was the right upper and Louis Poulsen's Snowball lamp shade was the right lower. The JPO also issued an invalidation decision of the R&M's trademark registration. However, the IP High Court cancelled the JPO's trial decision because the PH Snowball lamp shade did not become well-known in Japan.

This case is now being re-examined by the JPO's Trial Board and its decision has not been issued yet. Louis Poulsen cited another invalidation reason that the R&M's trademark registration was against the public order and moral provided by Article 4-1-7 of the Trademark Law. We will report the second trial decision when it is issued.

On December 27, 2018 the Tokyo District Court issued a decision on the damage suit filed by Louis Poulsen A/S against R&M on the basis of the infringement of the trademark right of Louis Poulsen's registered three-dimensional trademark. This decision will be introduced at our website in the future.

