

Latest Court Decisions

2019:

[May]

- **REBOOTER Case (Cancellation Suit)**

IP High Court 2019.5.30 H30(Gyo-Ke)10176

[SUMMARY/INTRODUCTION]

The trademark “**REBOOTER**” in Katakana letters was registered for “power distribution or control machines and apparatus, etc.” in Class 9 by a Japanese corporation (the Defendant).

The Plaintiff filed a partial invalidation trial against the registered trademark “REBOOTER” in Katakana with respect to the goods “power control devices including restarters” with the reasons that the subject trademark “REBOOTER” in Katakana was a generic term for the power control devices (Article 3-1-1 of TM Law) or a descriptive word for goods relating re-starts (Article 3-1-3 of TM Law) because the trademark “REBOOTER” in Katakana corresponded to the English word “REBOOTER” which consisted of the word “reboot” meaning “re-start” like “re-start computers” combined with “er” meaning people or things at the end of the word “reboot”.

This invalidation petition was dismissed by the JPO because the subject trademark “REBOOTER” should be regarded as a coined word with no specific meaning which did not appear in dictionaries. Therefore, the subject trademark did not fall under Articles 3-1-1 or 3-1-3 of the Trademark Law.

Then, the Plaintiff brought the case before the IP High Court demanding cancellation of the JPO’s trial decision. What was the Court decision ?

[Court Decision]

The IP High Court firstly deliberated on the matter as to whether the subject trademark “REBOOTER” should be descriptive or not under Article 3-1-3 of the TM Law and decided to cancel the JPO’s trial decision because the subject trademark fell under Article 3-1-3 of the TM Law.

However, the “REBOOTER” in Katakana was not listed in Japanese dictionaries and an English word “REBOOTER” was not also listed in English dictionaries. Hence, the IP High Court made the following approach.

The IP High Court confirmed that the original prototype "reboot" in Katakana of "rebooter" could be seen in various dictionaries and encyclopedias such as Business Technical Term Dictionary, IT Term Encyclopedia, Nikkei BP Digital Encyclopedia, Nikkei PC Term Dictionary, IT Term Katakana·Abbreviation Dictionary. These books explained "reboot" as "re-starting computers". The word "reboot" was used in laid-open disclosure public patent bulletin (Pat. Appln. No. 2013-16911) as a generic technical term. The Defendant said in its web-site that "remote reboot" was possible.

Next, the IP High Court confirmed that the word "rebooter" in Katakana was widely used in various literatures and websites. It was explained in the New English-Japanese Dictionary that "-er" at the end of a word is a word that makes a noun from a verb or noun with the meaning of things, devices or equipment to do something. Such samples were listed in the Easy Computer Glossary like encoder, counter, computer, decoder, printer, reader and loader.

Taking the above into consideration, the IP High Court considered that people in the IT and telecommunication technical fields could easily remember from "rebooter" in Katakana the word "rebooter" in English which composed of "reboot" and "-er", the meaning of which was "re-starter". As the result, the subject trademark "REBOOTER" in Katakana was a descriptive word meaning "re-starter" and it should be invalidated by Article 3-1-3 of the Trademark Law.

This court decision shows that a trademark consisting of even a coined word which was not listed in dictionaries could be regarded as non-distinctive and might be rejected for registration.