

Latest Court Decisions

2010:

(January)

Tongue Device Mark Case (Cancellation Case of Trial Decision)

IP High Court 2010.1.13 H21(Gyo-Ke)10274

An opposition was filed against the registered trademark (right upper) in Class 9 which was known as a mark of a Japanese rock band, **Acid Black Cherry**.

The opposition was based on **Article 4-1-15** of the Trademark Law since the registered trademark was liable to cause confusion with the trademark (right lower) which was well known as the mark of a British rock band, **Rolling Stones**.

The JPO's Opposition Decision partially cancelled the registration for music related goods in Class 9. Then, the trademark proprietor filed the cancellation suit demanding the cancellation of the Opposition Decision.

The IP High Court decided to cancel the opposition decision saying that although there were some points in common between the two marks, they could be distinguished from their appearances among the consumers who were music fans for rock music. Especially, Rolling Stone's mark was well known to their fans.

We agree to the court decision. However, we feel that the two marks may be confusingly similar among consumers excepting rock music fans.

GABOR Case (Cancellation Case of Trial Decision)

IP High Court 2010.1.26 H20(Gyo-Ke)10303

An Invalidation Trial was filed by a US company, **CDM Exchange Inc.** against the trademark registration for "**GABOR**" in Class 14 in the name of **Mrs. Maria Nagy**, the widow of Mr. **Gabor Nagy**, a famous silver jewelry designer.

However, the JPO dismissed the petition for Invalidation Trial, and then the US company, CDM, filed the cancellation suit before the IP High Court.

The trademark "GABOR" is a brand from Mr. Gabor Nagy who died at 44 years old in 1999. Mr. Gabor established **Gaboratory Inc.** in 1994 for marketing GABOR brand accessories by transferring all the rights and business relating thereto to Gaboratory Inc. Now, Mrs. Nagy is marketing GABOR brand accessories in Japan through Gaboratory Inc.

On the other hand, a person **B** who worked for Gaboratory Inc. established **Gaboratory International Inc.** ("International") in 2001 after he left Gaboratory Inc. International was dissolved in 2005 and transferred all rights and business relating to GABOR brand goods to the plaintiff, CDM.



Then, CDM filed the Invalidation Trial against the Mrs. Nagy's Japanese trademark registration for GABOR, insisting that CDM obtained all the rights relating to the GABOR brand. Therefore, the point of issue of the suit was as to who was the true title holder of the GABOR brand.

CDM submitted as evidence copies of Mr. Gabor Nagy's Testament, the Business Transfer Contract, and the Bill of Receipt showing the payment of USD 200,000.- as the consideration for the business transfer.

The IP High Court dismissed the CDM's claims saying that the evidence materials could not be incredible in view of the successive fact situation and the handwriting analysis of Mr. Gabor.

On the other hand, Gaboratory Inc., the manager thereof is Mrs. Nagy, the defendant, has been continuously conducting the GABOR business after Mr. Nagy's death, and it had been well known in Japan until 1999 that the trademark GABOR showed the goods by Mr. Gabor Nagy or Gaboratory Inc. Therefore, the true title of the GABOR trademark was the defendant, Mrs. Nagy.

There were two other cases between the parties regarding the following GABOR device marks before the IP High Court. (20(Gyo-Ke)10409/10091). The Court decisions were the same.



BOUTIQUE 9 Case (Injunction Case)

IP High Court 2010.1.27 H21(Gyo-Ke)10207

An application for the trademark "BOUTIQUE 9" specifying goods in Classes 14, 18 and 25 filed by a US company was rejected due to lack of distinctiveness. The applicant filed the cancellation suit before the IP High Court.

However, the IP High Court also dismissed the applicant's claim because the trademark "BOUTIQUE 9" meant "prêt-a-porter shop" and the figure "9" was also non-distinctive, and therefore, the trademark "BOUTIQUE 9" could not be regarded as a coined word as a whole.

However, we think that the trademark "BOUTIQUE 9" should be regarded as distinctive enough for registration as like it was registered in USA because it is unique as a boutique shop name. The applicant is using the trademark in special logo which will be registrable if an application is filed.