

Latest Court Decisions

2011:
[July]

● POLYMER GUARD Case (Injunction Case)

Osaka District Court 2011.7.21 H21(wa)16490

The proprietor of a registration for the trademark "**POLYMER GUARD**" specifying "polymer paints" in Class 2 sued for a trademark infringement against the use of the trademark "**Polymer Guard**" (right) using for the goods "coating agents for surface paint protection of automobiles".

The logo for "Polymer Guard" features the words "Polymer Guard" in a white, cursive script font, set against a green rectangular background with a subtle gradient.

The point at issue was as to whether or not the plaintiff's goods "polymer paints" were similar to the defendant's goods "coating agents for surface paint protection of automobiles".

The defendant alleged for a rebuttal that its goods are a kind of chemical agents belonging to International Class 1 and therefore, qualities, uses, manufacturers, customers were different from those of the plaintiff's goods.

The Court admitted the infringement saying the both parties' goods as similar because the defendant's goods were mainly sold to paint companies that conducted civil engineering and construction. Therefore, if the identical or similar trademarks were used for identical or similar goods, consumers would cause confusion regarding the origins of the goods.

However, it should be noted that the Court denied the damages to the plaintiff since there was no conflict in the markets between the plaintiff's goods "architectural paints" and the defendant's goods "coating agents for surface paint protection of automobiles".

Thus, the Court ordered the defendant to pay to the plaintiff only 410,000 Yen as 1% of the defendant's sales amount by the infringement that was equivalent to usual royalty payment.

● Elegance HIMIKO Case (Damages Case)

Tokyo District Court 2011.7.22 H21(wa)24540

The defendant manufactured and sold to the plaintiff the women's shoes bearing the plaintiff's registered trademark "**elegance/HIMIKO**" in English and Kanji (right) under the OEM contract.

The logo for "elegance HIMIKO" features the word "elegance" in a large, black, serif font, with "HIMIKO" in a smaller, black, sans-serif font below it. To the right of "HIMIKO" is the Japanese characters "卑弥呼" in a black, sans-serif font.

A part of the shoes delivered to the plaintiff was returned to the defendant due to the defects. The defendant re-sold to the general consumer the returned shoes bearing the trademark on the insole that was veiled by the sole inserts by the defendant.

The OEM contract between the parties provided that any returned goods will not be re-sold unless the trademarks were wholly removed. Therefore, the plaintiff alleged that these re-sold shoes infringed the plaintiff's trademark right.

However, the IP High Court dismissed the plaintiff's claims because the trademarks could not be seen since they were entirely veiled by the sole inserts. The Court said that it was unusual that consumer checked the trademarks by removing the sole inserts before buying the shoes. It was no influence to the court decision that the defendant violated the OEM contract.