

## Latest Court Decisions

**2013:**

[December]

- **LADY GAGA Case** (Trial Decision Cancellation Suit)

**IP High Court 2013.12.17 H25(Gyo-Ke)10158**

### **[SUMMARY/INTRODUCTION]**

A trademark application for "LADY GAGA" specifying "music files, video files, video discs and video tapes" in Class 9 **was rejected due to lack of distinctiveness** for registration since it merely indicates the contents of the specified goods. The applicant filed the cancellation suit of the Trial Decision with the IP High Court. However, the IP High Court sustained the Trial Decision.

### **[CASE]**

A US company, Ate My Heart Inc. owned and controlled by Lady Gaga, filed a trademark application for "LADY GAGA" for the goods and services in Classes 3, 9, 14, 16, 18, 25, 35 and 41. The application was partially rejected for the goods "music files, video files, video discs and video tapes" in Class 9 because the trademark "LADY GAGA" merely indicates the contents of these goods.

The applicant divided the application into two applications in Class 9 and the other Classes. The original application for the other Class goods and services was registered under No. 5405058 and the divisional application in Class 9 was finally rejected by the JPO and then, the applicant (Plaintiff) filed the cancellation suit of the Trial Decision with the IP High Court.

The Plaintiff alleged that the customers usually distinguish and select music records and CDs with the names of the singers contained therein and therefore, the singers' names are regarded as trademarks. The name "LADY GAGA" had been well-known all over the world and should be registered by acquiring distinctiveness by extensive use. In fact, the singers' name such as MICK JAGGER, BRITNEY SPEARS, BILLY JOEL, JIMI HENDRIX and BEYONCE were registered as a trademark for music records and CDs in Class 9.

However, the IP High Court dismissed the Plaintiff's petition. The Court said that customers of music records and CDs recognize from the name "LADY GAGA" that those records and CDs merely contain Lady Gaga's songs. These situations do not vary with matter who was the trademark applicant.

In fact, Lady Gaga is well known all over the world as a popular singer and not as a trademark of music records and CDs. This meant that the name "LADY GAGA" merely showed the contents of these goods, Lady Gaga's songs. Therefore, it did not work as a trademark and as the result, "LADY GAGA" did not acquire distinctiveness as a trademark even by extensive use.

• **PEARL FILTER Case** (Trial Decision Cancellation Suit)

**IP High Court 2013.12.25 H25(Gyo-Ke)10164**

**[SUMMARY/INTRODUCTION]**

A cancellation trial for non-use against the registered trademark "PEARL" for "tobacco" in Class 34 was dismissed. The Plaintiff, Philip Morris, demanded cancellation of the trial decision. The Defendant, Nippon Tobacco, was using the registered trademark "PEARL" for tobacco with filters under the name "PEARL FILTER".

The IP High Court cancelled the trial decision saying that the use of trademark "PEARL FILTER" could not be regarded as the use of the registered trademark "PEARL".

**[CASE]**

A US company, Philip Morris, filed a cancellation trial for non-use against the registered trademark "PEARL" for tobacco in Class 34 in the name of Nippon Tobacco. Nippon Tobacco submitted the evidence that the registered trademark "PEARL" was used for PIANISSIMO tobacco together with the name "PEARL FILTER".

The JPO accepted the evidence and dismissed Philip Morris's petition because the trademark "PEARL FILTER" in use was substantially identical to the registered trademark "PEARL" since the word "FILTER" in the trademark in use merely described that the tobacco was with filters.

So, Philip Morris filed the cancellation suit of the trial decision. They alleged that the word "PEARL FILTER" was a descriptive word used in the tobacco industry as the meaning of glossy shining filters processed like a pearl. Therefore, "PEARL FILTER" was not used as a trademark.

Nippon Tobacco responded that they used "PEARL FILTER" as a secondary trademark for their PIANISSIMO tobacco brand.

The IP High Court accepted Nippon Tobacco's allegation that "PERAL FILTER" was used as a trademark since there were examples in the tobacco industry such as "WINSTON FILTER" and "CAMEL FILTER" for tobacco with filters.

This meant that "PEARL FILTER" was a trademark as a whole and therefore, the trademark "PEARL FILTER" was not identical to the registered trademark "PEARL" itself. As the result, the registered trademark was not used.

You will see that Nippon Tobacco's registration was cancelled by the reasons that the Plaintiff Philip Morris did not allege at all.