Latest Court Decisions

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● Berry Mobile Case (Cancellation Case of Trial Decision)

IP High Court 2010.3.17 H21(Gyo-Ke)10328

An Invalidation Trial was filed by Research In Motion Limited against the registered trademark "**berry mobile**" specifying "mobile telephone communication" in Class 38 on the basis of their prior trademarks "**BlackBerry**". Since the Petition for Trial was dismissed by the JPO because the two trademarks were not confusingly similar, Research In Motion filed the cancellation suit before the IP High Court.

"Blackberry" means a kind of fruits. However, it is widely known in the IT field as the smart phones developed by a Canadian company, Research In Motion Limited, in 1997. In Japan, it was reported by the newspapers from around 2000 to 2006. In June 2006, NTT DoCoMo announced to introduce them in Japan and actual sales begun since July 2007.

The Court cancelled the JPO's Trial Decision accepting that "BlackBerry" was well-known in Japan at the time of filing the application. The reasons for the Decision were as follows.

(1) The "mobile" part in the trademark "berry mobile" was not distinctive because it meant "mobile phones" as well as the specified services "mobile telephone communication". The main part of the trademark was "berry" and it had a pronunciation "berry" and a meaning of a berry fruit.

(2) The "Black" part in the cited trademarks "BlackBerry" was also descriptive of goods. Therefore, the main part of the trademark was "Berry".

(3) As the result, the two trademarks were confusingly similar in the pronunciation "berry" and the meaning "a berry fruit" and they were used for the identical or similar services. Therefore, the subject registration should be invalidated under Article 4-1-11 of the Trademark Law.

We agree to the conclusion of the court decision. However, we disagree to its reasons. We believe that "BlackBerry" appeared and became well-known in the market as the revolutionary mobile phones with the fantastic trademark "BlackBerry" suggesting fruits that deeply impacted the consumers. Therefore, if similar trademarks with the word "Berry" such as STRAWBERRY, RASBERRY or CRANBERRY were used for mobile phones by a third party, the consumer will cause confusion as if such mobile phones were the series products of BlackBerry by Research In Motion.

Therefore, the subject trademark registration should have been invalidated under Article 4-1-15 of the Trademark Law rather than Article 4-1-11.

● SIDAMO & YIRGACHEFFE Case (Cancellation Case of Trial Decision)

IP High Court 2010.3.29 H21(Gyo-Ke)10226/10227/10228/10229

These are the cases regarding the place of origin of coffee beans and coffee made in Ethiopia. **Federal Democratic Republic of Ethiopia** registered the trademarks "**SIDAMO**" and "**YIRGACHEFFE**" in English and Katakana letters for "**coffee beans and coffee**" in Class 30.

SIDAMO

YIRGACHEFFE

All Japan Coffee Association filed the Invalidation Trials against these registrations insisting that "**SIDAMO**" and "**YIRGACHEFFE**" merely meant the places of origin of coffee beans and therefore these registrations should be invalidated under Article 3-1-3 of the Trademark Law.

The JPO issued the Trial Decisions to invalidate the registrations according to Article 3-1-1. Then, the Ethiopian government filed the cancellation suits of the Trial Decisions before the IP High Court. As the result, the IP High Court cancelled the Trial Decisions by the following reasons.

(1) The "SIDAMO" and "YIRGACHEFFE" were recognized as the brands of the high quality coffee beans made in Yirgacheffe in the Sidamo area, Ethiopia and the coffee made thereby, in large number of books, newspapers and web-sites regarding coffee while in some of them, these names were used as the places of origin. Therefore, these trademarks had the distinctiveness enough for trademark registration.

(2) The "SIDAMO" and "YIRGACHEFFE" had been widely used by the traders in the coffee industry. However, the coffee for which these names were used were the high quality coffee beans manufactured in Yirgacheffe in the Sidamo area, Ethiopia and the coffee made thereby. All these names were used for the coffee beans, the quality of which was strictly controlled by the Ethiopian government and exported out of the state.

Therefore, as long as the proprietor of these trademark registrations was the plaintiff, the Ethiopian government, they would not be contrary to the public interest even if the registrations allowed the Ethiopian government to exclusively use the trademarks.

Thus, the registrations remain for the specified goods "coffee beans manufactured in the Sidamo area or in the Yirgacheffe area, Ethiopia" and "coffee made by the coffee beans manufactured in the Sidamo area or in the Yirgacheffe area, Ethiopia". In other words, the registrations were invalidated for the goods manufactured in the other places than Sidamo and Yirgacheffe.

You will see that "Sidamo" and "Yirgacheffe" are used as the places of origin in the amended specified goods of the registrations. That may be funny ?

For information, the trademark "SIDAMO" was registered in USA, CTM, Canada and Australia and "YIRGACHEFFE" was registered in USA, CTM and Canada. And, the Ethiopian government grants royalty-free licenses to the traders who recognize all the rights relating to these trademarks.

● BB POWER Case (Cancellation Case of Trial Decision)

IP High Court 2010.3.30 H21(Gyo-Ke)10225

The invalidation trial filed against the registered trademark "**BB POWER**" specifying "fishing tackle" in Class 28 on the basis of the prior trademarks "**POWER**" also specifying "fishing tackle" was dismissed by the JPO. Then, the petitioner of the trial filed the cancellation suit before the IP High Court.

In Japan, one or two English letters can not be registered as a trademark because they simply indicate product numbers, model types, code numbers or specifications of specified goods. One or two English letters in the trademarks will be usually disregarded during the similarity examinations to other trademarks. Please refer to the theme "**Roman Letters**" in the **Board Decisions at the TTAB** in our web-site. You can see that such an examination standard is gradually being changed.

The IP High Court also decided that the subject trademark "BB POWER" was not confusingly similar to the cited trademarks "POWER" with the following reasons.

(1) The English letters "BB" was placed on the front of the trademark.
(2) The letter "B" was reduplicated.
(3) The letter "B" had no special meaning in the trading market or as product numbers, model types, code numbers etc.
(4) Therefore, the trademark "BB POWER" should be regarded as a whole.

We can produce many trademarks including the word "POWER" since we can image various kinds of "POWERs". Therefore, although "BB POWER" has no specific meaning, it should be distinctive as a trademark as a whole.

● Sportec "S" Logo Case (Cancellation Case of Trial Decision)

IP High Court 2010.3.30 H21(Gyo-Ke)10220

The registered trademark for "***S*** (logo)/***DESIGN***" (right upper) specifying "automobiles, parts and fitting thereof, etc." in Class 12 was invalidated by the trial under Article 4-1-19 of the Trademark Law. The trademark proprietor filed the cancellation suit before the IP High Court.

≪Article 4-1-19≫

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) (except those provided for in each of the preceding items);

The petitioner of the Invalidation Trial was **Sportec AG**, a Swiss company, which manufactured and sold automobile remodeling parts under the "***S*** (logo)/***SPORTEC***" trademark (right lower).

The plaintiff (= the trademark proprietor) was a Japanese individual who was the representative of Kabushiki Kaisha Sportec Japan, the Japanese import and sales agent company of Sportec AG.

The IP High Court dismissed the plaintiff's claim by accepting the Trial Decision with the following reasons.

(1) As to whether the cited trademark of defendant Sportec AG was well-known or not, the defendant's remodeling parts built a reputation mainly in Europe, especially for remodeling of prestige cars such as PORSCHE and AUDI. They appeared in many automobile magazines and they had a high popularity at the polling by the reporters.

They also appeared in many Japanese automobile magazines such as MOTOR MAGAZINE and CAR GRAPHIC and the cited trademark was well known in Japan especially among consumers for foreign cars in **November 2003** at the time of filing application.

(2) As to the similarity of the two trademarks, they had the similarities on their appearances regarding the general shape of "S", the slope of the letters and the three-dimensional and gradational shape. They were also similar at the pronunciation of "S".

(3) As to the unfair purposes, K.K. Sportec Japan started the imports and sales of the defendant's products since about **2001**. However, its business performance was bad. Problems caused by Sportec Japan such that they used the cited trademark for remodeling of Japanese cars at the Tokyo Motor Show in **2003** without the defendant's approval.

As the result, the defendant dissolved the business relationship with Sportec Japan in **December 2003**. The time of the plaintiff' filing the subject trademark application, **November 2003**, was when these problems were lasting.

It meant that the plaintiff filed the subject trademark application for the purpose of gaining the unfair profits of his business by utilizing the goodwill of the cited trademark even after the business relation with the defendant terminated.

This is a typical case of applying Article 4-1-19 of the Trademark Law.