

IP High Court Decision Super Summary

【 Case No. 】 2013(Gyou Ke)101064

【 Date of decision 】 December 25, 2013

【 Kind of the case 】 An appeal against the JPO's decision on non-use cancellation

【Summary】 In the non-use cancellation appeal, the JPO ruled that the registered trademark “PEARAL/パール” is, from common sense perspective, the same as “PEARL FILTER”.

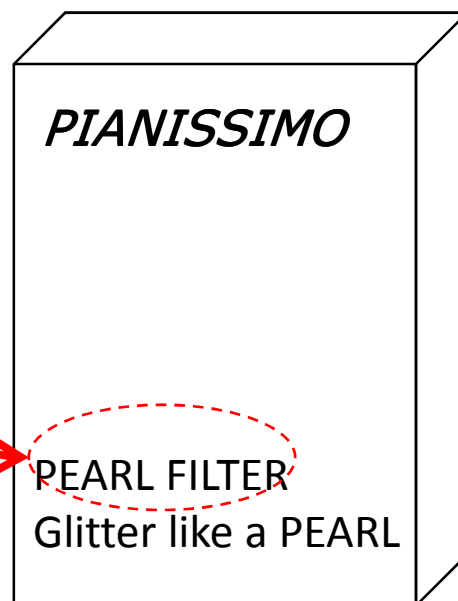
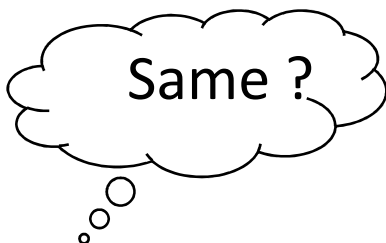
But the IP High Court overturned the JPO's decision.



Outline of facts

1. Registration No.2523496
Trademark: PEARL/パール
Designated goods: Class34 Tobacco or
cigarette
Owner (Defendant) : Japan Tobacco Inc.
2. Plaintiff: Philip Morris Brands Sarl

Registered
Trademark:
PEARL/パール



The JPO's decision

Registered
Trademark

PEARL
パール



Trademark
in use

PEARL
FILTER

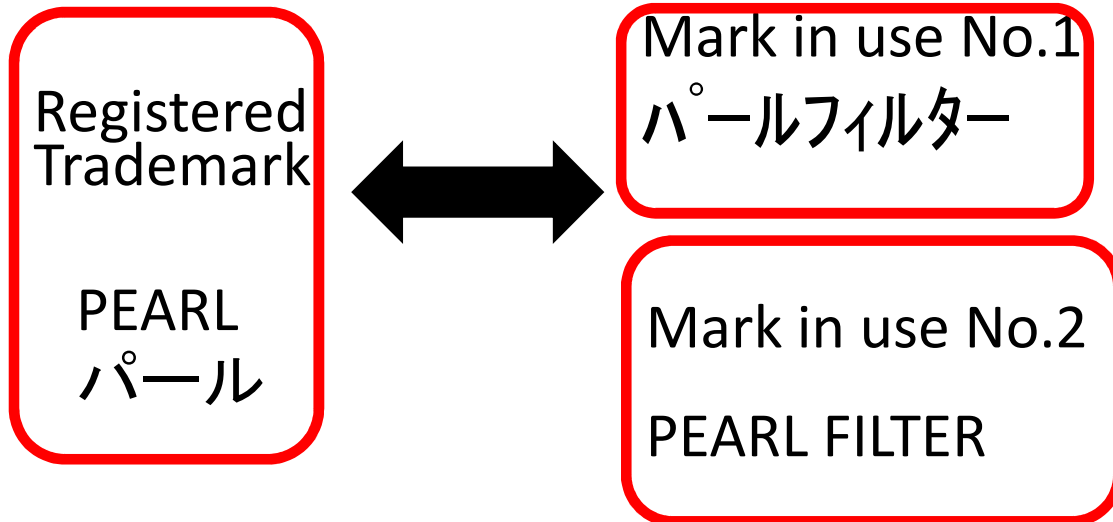


Based on the Common sense perspective, they are the same.

The Reasons are:

- Trade trademark in use can be divided into "PEARL" and "FILTER".
- "FILTER" does not have a distinctiveness.
- "Pearl" has a distinctiveness.³

IP High Court's decision



They are not the same

The Reasons are :

- "パールフィルター" and "PEARL FILTER" are being used as a whole, they can not be divided.



Remark1: The Trademark Owner took out a new Mark in use No.2 and related evidence at the IP High Court.

Remark2: "パール" is a pronunciation of "PEARL". But the advantage of such a double decker trademark is arguable.

Study 1



- The case law of the supreme court is that the combined trademark ,such as “PEARL” and “FILTER”, can not be divided basically.
- But the JPO divided “PEARL FILTER” into two parts without enough ground, and ruled that “PEARL” has the distinctive portion, then, judged that “PEARL FILTER” is the same as the Registered Trademark.
- The IP High Court decision is conforming to the above case law.

Study 2



- In practice, the JPO tends to divide a combined trademarks easily.
- For example, as for the filed trademark “TV Protector”, the JPO divided into “TV” and “Protector”, and ruled that it is similar to prior registered trademark “PROTECTOR”. But the IP High Court overturned the JPO’s decision.(H23(Gyou Ke)10085)
- Therefore, we would be able to understand that the IP High Court may overturn the JPO’s decision when JPO divided a combined trademark.

General comment



- Goods such as a package of cigarette may have a major trademark which shows the name of the cigarette itself, and at the same time, secondary brand which shows the uniqueness of the cigarette. Both are considered as a trademark. “PEARL FILTER” is the secondary brand.
- It is preferable to use a distinctive expression for the secondary brand so that the Court can judge that it is not simply a explanation of goods.
- Double decker trademark such as “PEARL/パール”, you can use “PEARL” or “パール” to respond against the non-use cancellation appeal.
- During lawsuits against the JPO’s decision on trademark, you can make a new assertion and provide a new evidence, of which situation is different from technical patent.

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