

News

March 2016

**Development of Japanese IP Law**

**1. IP High Court decided “weighing scales (with body fat monitors or body composition monitors) in Class 9 for household purpose” is similar to “body fat monitors and body composition monitors in Class 10 for medical purpose”**

**(Appeal from the JPO’s trial decision regarding the invalidation of trademark registration)**

Japanese IP High Court decided on February 17, 2016 that “weighing scales (with body fat monitors or body composition monitors) in Class 9 for household purpose” (sub-class 10C01) is similar to “body fat monitors and body composition monitors in Class 10 for medical purpose” (sub-class 10D01) in the appeal from the trial decision regarding the invalidation of trademark registration. The Appellant filed the petition to invalidate the trademark registration of Appellee’s trademark registration “Dual Scan” for “weighing scales with body fat monitors, weighing scales with body composition monitors and weighing scales in Class 9” based on its prior trademark registration consisting of two-tiered character strings “Dual Scan and its Katakana Character” for “body fat monitors and body composition monitors in Class 10”. Both parties agreed that the marks were similar and the issue was similarity of goods. IP High Court accepted the argument of the Appellant and decided to invalidate the registration of Appellee.

Upon carefully reviewing the evidences, IP High Court determined that there is a likelihood of confusion and thus goods are similar. IP High Court considered how the goods of each party are used in the market place. Under the Japanese practice, if the sub-class of each good is different, it is generally considered dissimilar. However, IP High Court said that the said presumption would not always control depending on the actual trading of the products.

This case shows the importance how to determine the designated goods for trademark searches and applications. Our trademark searches are conducted based on the sub-classes which are determined by the information provided by the client.

# SHIMIZU & DAIGO

## **2. The Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (“Geneva Act”)**

We can now find several Japanese Design Registrations as a result of designating Japan in international design applications under the Geneva Act on J-PlatPat (Japan Platform for Patent Information) which is an on-line data base of JPO. The following registrations are examples published on March 14, 2016.

Registration No. 1545953 (DM/087396) for “Bag” by GIORGIO ARMANI S.P.A.

Registration No. 1545952 (DM/087143) for “Handbags” by BOTTEGA VENETA SA

Registration No. 1545948 (DM/087085) for “Buckle” by HERMES SELLIER

Registration No. 1545942 (DM/087084) for “Purse” by HERMES SELLIER

Design Applications under the Geneva Act are said to be examined by the current examination standard. We are closely watching if the current examination standard is strictly applied.

If you have any questions concerning the above news, please feel free to contact us.