

# Parody Trademark

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## ◆ Parody Trademark

- ✓ Frank Muller VS FRANKU MIURA
- ✓ Border of Parody Trademarks

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# “Frank Muller” VS “FRANKU MIURA”

- ✓ “Frank Muller” trademark owner failed to invalidate a parody trademark “FRANKU MIURA” in IP High Court (“2015 (Gyo-Ke) 10219” decided on Apr. 12th, 2016). The Supreme Court dismissed an appeal.
- ✓ The IP High Court decision is with regard to
  - invalidation of the parody trademark,
  - not free riding the genuine trademark.



# Disputed Trademarks

Trade Mark	<b>FRANCK MULLER</b>	フランク三浦
Reg. No.	271710	5517428
Reg. Date	Dec. 22 <sup>nd</sup> ,1994	Aug. 24 <sup>th</sup> , 2012
Type	Composite Trademark	Composite Trademark
Japanese Pronunciations	FURANKU <u>MYURA:</u>	FURANKU <u>MIURA</u>
Goods	Class 14 Watch etc.	Class 14 Watch etc.

NOTE: FRANK MULLER trademark owner has other 43 similar trademarks including standard characters trademark.

# History of FRANK MIURA (フランク三浦)

Aug. 24 <sup>th</sup> ,2012	The JPO registered “FRANK MIURA” (No. 5517428)
Sep. 8 <sup>th</sup> ,2015	The JPO invalidated due to the similarity to “FRANK MULLER”. (Nullification 2015-890035)
Feb. 23 <sup>rd</sup> ,2016	The IP High Court overturned the invalidation by JPO. (2015 (Gyo-Ke) 10219)
Mar.2 <sup>nd</sup> ,2017	The Supreme Court dismissed an appeal. (Overturning the IP High Court decision was fixed)

# Invalidation Trial at the JPO

- ✓ The JPO invalidated “FRANK MIURA” based on Trademark Act §4(1) which defines a requirement for nullification about a registered trademark as followings:
  - (x). similar to another person’s well known trademark.
  - (xi). similar to another person's registered trademark.
  - (xv). causing confusion to another person’s business.
  - (xix). used for unfair purpose.
  
- ✓ The JPO admitted a similarity between FRANK MULLER and FRANKU MIURA.



# IP High Court Decision

Both trademarks are not similar because “Pronunciation” is similar though, “Appearance” and “Concept” are not similar, and “Result of Business Activity” does not incur confusion.

Appearance	<u>Not similar</u> because “Chinese and Japanese letter in handwritten style” and “Alphabet” are <u>distinguishable</u> .
Pronunciation	<u>Similar</u> because “FU-RA-N-KU MI-U-RA” and “Frank Muller” have <u>similar senses or tones of language</u> .
Concept	<u>Not Similar</u> because “FRANK MIURA” <u>incurs a concept of “Japanese related person”</u> .
Business Activity	<u>No confusion</u> because of following: <ul style="list-style-type: none"><li>• Customer’s recognition as a <u>parody watch</u> due to a sign of “Not Completely Water Proof” in the back.</li><li>• The <u>price</u> of parody watches are <u>very cheap</u>.</li></ul>

# Reasoning 1/2

Trademark Act §4(1) Nullification Requirement:

(x). similar to another person's well known trademark.

Not applicable because of unsimilarity to the used trademarks.

(xi). similar to another person's registered trademark.

Not applicable because of unsimilarity to the registered trademarks

(xix). used for unfair purpose.

Unsimilar trademark is never used for unfair purpose.

# Reasoning 2/2

(xv). causing confusion to another person's business.







Not applicable :

- No confusion is incurred by similar “Pronunciation” only, because usual expensive watch customer gives attention to “Appearance” and “Concept” of the mark.
- A purpose of (xv) is to avoid freeriding or dilution of trademark in order to keep a business trust by prohibiting a registration, however, the provision does not aim to prevent registration of a trademark where the act of freeriding is not clear or evident.

## ◆ Parody Trademark

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# Border of Parody Trademark

	Genuine	<u>Fail</u> to Invalidate	<u>Success</u> to Invalidate
Trade Mark			
Registration No. (Date)	3324304 (Jun. 20 <sup>th</sup> , 1997)	5040036 (Apr. 13 <sup>th</sup> , 2007)	4994944 (Apr. 3 <sup>rd</sup> , 2006)
Goods	Class 25 Clothes etc.	Class 25 T-shirts and cap	Class 25 Clothes etc.
Embodied Animal	Puma (Japanese sounds: "PYU:MA") 	OKIAWA local lion stature (Japanese sounds: "SHI:SA:") 	Bear (Japanese Sounds: "KUMA") 

# Reasoning for



- ✓ The IP High Court overturned an invalidation decision by the JPO on Jul. 12th, 2010. (2009 (Gyo-Ke) 10404)
- ✓ Because there is no confusion, Trademark Act §4(1)(xv) is not applicable.
  - “PUMA” is a well-known and famous.
  - No similarity because of following reasons:
    - distinguishable “Pronunciation” and “Concept”
    - “Appearance” is not necessarily similar
    - “Business Activity”: the T-shirts are sold in OKINAWA and online, and sales amounts are small.
- ✓ Additional Comment:
  - There is no specific provision about parody in Trademark Law.
  - No similarity leads to no freeriding and no confusion.

# Reasoning for



- ✓ The IP High Court kept an invalidation decision by the JPO on 12th, Oct 2011. (2012 (Gyo-Ke) 10454)
- ✓ Confusion is a reason for refusal at the Trademark Law §4(1)(xv).
  - “PUMA” is a well-known and famous trademark.
  - No mention about “Pronunciation” and “Concept”
  - Very Similar “Appearance” because of having four big alphabets “KUMA” and an animal in an attacking position facing left.
  - Business Activity: Causing confusion since the T-shirts are sold not only in gift shops, but in a department store selling regular sports wear.

# Summary

- ✓ Invalidation of Parody Trademark requires similarity.
- ✓ There is no specific provision about parody in Trademark Law.
- ✓ Difference between “KUMA” and “SHI-SA” is one example of the fine border in Japanese parody trademark cases.



Thank you!

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