

Case Information

Case	IGZO trademark case
Court, case no.	IP High Court 2014 (Gyo-Ke) 10089
Date of judgment	February 25, 2015
Parties	Plaintiff: Sharp Corporation Defendant: Japan Science and Technology Agency (JSTA)

FACTS

The plaintiff, Sharp Corporation, owned a trademark right (the “Trademark Right”) on trademark “IGZO” (the “Trademark”) designating goods “Electric iron; Electric hair curler; Telecommunication machines and apparatus; Electronic machines, apparatus and their parts; Batteries and cells; Electric wires and cables; and Power distribution or control machines and apparatus.”

The defendant, JSTA, filed an invalidation trial against the Trademark right in respect to the designated goods “Telecommunication machines and apparatus; Electronic machines, apparatus and their parts; Batteries and cells; and Power distribution or control machines and apparatus.”

The JPO rendered a decision to invalidate the registration with regard to the designated goods, for which the invalidation trial was sought.

Following the JPO decision, the Plaintiff requested division of the Trademark Right and finally the Trademark Right was divided into nine (9) parts and eight (8) of them were registered for designated goods which fall within the designated goods covered by subject designated goods of the invalidation trial (the “Trademark Rights 1 to 9”).

The Plaintiff filed a suit to seek rescission of the JPO decision.

ISSUE

In respect to the designated goods of the Trademarks, whether the Trademarks fall under a “trademark that consists solely of a mark indicating raw material of goods in a

common manner,” stipulated in Article 3(i)(3) of the Trademark Act (the “Act”).

HOLDING

The Court held that the Trademark, “IGZO,” falls under a “trademark that consists solely of a mark indicating raw material of goods in a common manner” stipulated in Article 3(i)(3) of the Act, for the following reasons and thus affirmed the JPO decision.

First, the Court found that the Trademark(s) lack a source-identifying function in relation to the designated goods. The Court found that as of the time of the registration of the Trademark, the term “IGZO” was widely recognized by businesses such as those belonging to the electronics industry, especially in the field of displays and semiconductors, as a term referring to indium gallium zinc oxide (the “Subject Oxide”). Against this background, regarding the divided Trademarks 4 to 9, the Court stated that assuming that the Trademark “IGZO” be used for the designated goods “liquid crystal display TVs,” “notebook computers,” “computers excluding notebook computers and tablet portable information terminals,” “tablet portable information terminals,” “smartphones,” and “mobile phones,” business operators who are both traders of the designated goods and consumers, would generally recognize that the Subject Oxide is used for the display panels of those designated goods since the performance of the display does have a significant effect on the quality of the products. The Court also reached the conclusion that divided Trademarks 1 and 2 lack source-identifying functions in relation to their designated goods, in an analogous fashion.

Second, the Court found that it would be unreasonable to allow any single person/entity to exclusively use the Trademark, in light of the public interest. In reaching this decision, the court reasoned that considering that the Subject Oxide is a new raw material for semiconductor devices, which are indispensable components of modern electronic devices, and that it has attracted people's attention as having the potential to enhance the performance of a wide range of electronic devices including display panels, anyone would like to use the Trademark as a necessary, appropriate indication to conduct transactions in any of the designated goods of the Trademark Rights.

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Original Document (Japanese):

http://www.ip.courts.go.jp/app/files/hanrei_jp/887/084887_hanrei.pdf

English Translation:

http://www.ip.courts.go.jp/app/files/hanrei_en/825/001825.pdf