

**"INTELLASSET" case**  
**(The meaning of "containing a name" in a trademark)**  
**IP High Court**  
**Case Hei21(Gyo-ke)No.10074(Oct. 20,2009)**

**FACTS**

"Trademark A"



**INTELLASSET**

The plaintiff, X, was a holder of the trademark registration (No. 465176) for the above "trademark A" in respect of the designated services<sup>(\*\*1)</sup> belonging to class 35. The defendant, Y, "Intel Corporation", filed an appeal for invalidation of the trademark registration with the Japan Patent Office on the grounds that the registered trademark violates Articles 4(1)(vii), 4(1)(viii)<sup>(\*\*2)</sup> and 4(1)(xv) of the Trademark Act.

On Feb.10, 2009 the JPO rendered a decision that the trademark registration should be invalidated on the basis of violation of Article 4(1)(viii), without deciding the issue relating to Articles 4(1)(vii) and 4(1)(xv). The grounds of the decision were as follows: The trademark in question contains the famous abbreviation of the defendant, that is, "Intel", and its trademark registration was not thought to be approved by the defendant at the time of application. X filed a suit for rescission of the JPO decision with the IP High Court.

**ISSUES**

(1) What is the meaning of "contain famous abbreviation" in Article 4(1)(viii)? Is mere physical inclusion sufficient to satisfy the "contain" requirement?

(2) Does the trademark A contain a "famous abbreviation", "Intel" of the defendant Y, within the meaning of Article 4(1)(viii)?

## **HOLDING**

The IP High Court revoked the JPO decision on the grounds that the trademark A does not fall under Article 4(1)(viii), reasoning as follows:

(1) The purpose of Article 4(1)(viii) is "to protect the personal interests of another person's portrait or name etc, namely to protect the interests of another person (including a group such as a juridical person) that his or her name shall not be used in a trademark without his or her consent" (Supreme Court (July 22, 2005)).

"Where the presence of another person's abbreviation, etc. cannot be objectively recognized in the trademark and the trademark cannot call to mind or be associated with him or her, his or her personal interests are thought not likely to be damaged. Therefore, in order to judge whether the trademark is a trademark which contains another person's name or abbreviation, etc., it is not sufficient to judge whether the trademark merely includes it physically. Rather, it should be thought necessary to judge whether the part of another person's name or abbreviation in the trademark should be objectively recognized as his or her name or abbreviation and call to mind or be associated with him or her.

(2) The text part "INTELLASSET" of the trademark A is written in capital letters and the characters are arranged with the same size, font, and space between each other. Taking these characteristics of the text part into consideration, the "INTELLASSET" is naturally perceived or recognized to be indivisible in appearance; also the word "INTELLASSET" is an unfamiliar word in Japan and is understood at a glance as a coined word , and is thought not to have any particular pronunciation or meaning. Hidden or covered in the string of such characters, "INTEL", that is, Y's abbreviation, is reasonably thought neither to be objectively recognized nor to call to mind or be associated with Y.

Consequently, although the trademark A physically includes "INTEL", that is to say, Y's abbreviation, nevertheless it is not a trademark which contains "a famous abbreviation of another person" pursuant to Article 4(1)(viii).

### **(\*1) the designated services**

Business management, Business management consultancy, Business management

analysis or business consultancy, Marketing research, Providing information on commodity sales, Business management of hotels, Advertising and publicity services, Issuance of trading stamps, Drawing up of statements of accounts, Accounting, Employment agencies, Auctioneering, Import-export agencies, Arranging newspaper subscriptions, Shorthand services, Transcription, Document reproduction, handling of clerical matters such as accounting, sales, administration, human resources, public relations, planning, Office functions, namely filing, in particular documents or magnetic tape, Operation of computers, typewriters, telex machines and other similar office machines, Reception for visitors in buildings, Publicity material rental, Rental of typewriters and copying machines, Providing employment information, Rental of vending machines

**(\*2) Article 4 (1)(viii)**

Article 4 (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

...

(viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);

CF. Another INTELLASSET Case

IP High Court

Case Hei19(*gyo-ke*)10113 (Dec. 20, 2007)

"Trademark B"



X had been a holder of the trademark registration for the above "trademark B". On Dec. 20, 2007 the IP High Court had concluded that the trademark B fell under

Article 4(1)(viii) on the ground that the trademark B contains the famous abbreviation, that is, "Intel" of Y, "Intel Corporation" and that the registration of the trademark B should be invalidated.

The court explained the above conclusion as follows;

The characters "I" and "A" in the text part, "Intellasset", of the trademark B are about 1.25 times larger than the other characters, and therefore the text part is perceived to consist of "INTELL" and "ASSET". Accordingly as regards the text part "INTELLASSET", consumers understand the meaning "asset", perceive the famous abbreviation (Intel) of Y, and call to mind Y.