

Date	November 14, 2017	Court	Intellectual Property High Court, Fourth Division
Case number	2017 (Gyo-Ke) 10109		
– A case in which the court found that the registered trademark "MEN'S CLUB" owned by the defendant falls under Article 4, paragraph (1), item (xv) of the Trademark Act on the grounds that said trademark is likely to cause confusion with the goods pertaining to the business of the plaintiff.			

References: Article 4, paragraph (1), item (xv) of the Trademark Act

Numbers of related rights, etc.: Trademark Registration No. 5858891

### Summary of the Judgment

The plaintiff filed a request with the JPO for an invalidation trial for the trademark owned by the defendant (the "Trademark") (consisting of alphabetic characters "MEN'S CLUB" written in standard letters; Designated goods: Class 3 "Cosmetics for men"). The JPO made a decision to the effect that said request is unacceptable. The plaintiff filed this lawsuit to seek rescission of the aforementioned JPO decision.

In this judgment, the court found the following facts: [i] the Trademark is extremely similar to the cited trademark (consisting of alphabetic characters "MEN'S CLUB"), which is used by the plaintiff for a magazine (men's fashion magazine) (the "Magazine"); [ii] while the cited trademark cannot be considered to be highly creative, it has been widely known among consumers for several decades; and [iii] the designated goods (men's cosmetics) of the Trademark can be considered to be considerably related to the Magazine (men's fashion magazine) that pertains to the business of the plaintiff and the consumers of the Magazine overlap with the consumers of the designated goods of the Trademark. Based on a comprehensive evaluation of these facts and in view of other factors such as the level of attention paid by consumers, the court found that the use of the Trademark for the designated goods could cause consumers to associate it with the cited trademark and mislead them into believing that those goods pertain to the business of the plaintiff or a company that has a close business relationship with the plaintiff or to the business of a company that belongs to a group conducting a product development project by using the same indication as the one used by the plaintiff, and could consequently cause confusion about the source of goods. On these grounds, the court rescinded the JPO decision by holding that the Trademark can be regarded as a trademark that "is likely to cause confusion" as specified in Article 4, paragraph (1), item (xv) of the Trademark Act.

Judgment rendered on November 14, 2017, the original received on the same date, court clerk

2017 (Gyo-Ke) 10109 Case of Seeking Rescission of JPO Decision

Date of conclusion of oral argument: October 17, 2017

#### Judgment

Plaintiff: Hearst Fujingaho Co., Ltd.

Defendant: Nakayama Taiyodo Co., Ltd.

#### Main text

1. The JPO decision made on April 5, 2017, concerning Invalidation Trial No. 2016-890063 shall be rescinded.
2. The defendant shall bear the court costs.

#### Facts and reasons

##### No. 1 Claims

The same as stated in the main text.

##### No. 2 Outline of the case

###### 1. Developments in procedures, etc. at the JPO

(1) The defendant is the holder of a trademark right for the following trademark (Registration No. 5858891; the "Trademark") (Exhibits Ko 1-1 and 1-2).

Registered trademark: "MEN'S CLUB" consisting of alphabetic characters written in standard letters

Filing date: January 7, 2016

Decision of registration: June 1, 2016

Registration date: June 17, 2016

Designated goods: Class 3 "Cosmetics for men"

(2) On October 28, 2016, the plaintiff requested a trial to seek invalidation of the Trademark (Exhibit Ko 20).

(3) The JPO examined this case as Invalidation Trial No. 2016-890063 and made a decision on April 5, 2017, to the effect that "the request for a trial is unacceptable" as stated in the attached JPO Decision (copy) (the "JPO Decision"). On April 17, 2017, a certified copy thereof was served on the plaintiff.

(4) On May 10, 2017, the plaintiff filed this lawsuit to seek rescission of the JPO Decision.

###### 2. Summary of the grounds for the JPO Decision

The grounds for the JPO Decision are as stated in the attached JPO Decision (copy). In summary, in connection with the following trademark used by the plaintiff (the "cited trademark"; Exhibits Ko 3-1 and 3-2), the registration of the Trademark can be considered to violate neither Article 4, paragraph (1), item (xv) nor item (xix) of the Trademark Act and therefore should not be invalidated under Article 46, paragraph (1) of said Act.

Trademark: "MEN'S CLUB" consisting of alphabetic characters

Product: Magazines (Men's fashion magazines)

### 3. Grounds for rescission

- (1) Error in the JPO's determination concerning the applicability of Article 4, paragraph (1), item (xv) of the Trademark Act (Grounds for Rescission 1)
- (2) Error in the JPO's determination concerning the applicability of Article 4, paragraph (1), item (xix) of the Trademark Act (Grounds for Rescission 2)

(omitted)

### No. 4 Court decision

#### 1. Grounds for Rescission 1 (error in the JPO's determination concerning the applicability of Article 4, paragraph (1), item (xv) of the Trademark Act)

(1) According to the evidence presented below, the following facts can be found.

A. The plaintiff is a stock company engaging in publishing multiple magazines, etc. including "Fujingaho," "25 ans," "MEN'S CLUB" (the "Magazine") (Exhibit Ko 4).

B. The Magazine is a fashion magazine for men, which was originally published under the title "Fujingaho zōkan Otoko no fukushoku dokuhon" (special issue of women's magazine 'Fujingaho'; Men's fashion magazine) in 1954 by Kabushiki Kaisha Fujingahosha ("Fujingahosha"). The logo "MEN'S CLUB" was used in 1956 for the first time. In 1957, it became independent from the special number of Fujingaho and started to be published under the title "Otoko no fukushoku MEN'S CLUB," which was subsequently changed to "MEN'S CLUB" in 1959. Since 1965, the Magazine has been published as a monthly magazine for more than 60 years (Exhibits Ko 5, and 7 to 16).

The plaintiff succeeded to the right to publish the Magazine and also to the right to use the cited trademark and has continued using it until now (Exhibits Ko 3-1, 3-2, and 4).

The number of copies of the Magazine printed in 2015 was about 60,000 (Exhibit Ko 4). The issue of December 2015 was the 658th issue (Exhibit Ko 15-12).

C. At least from the January 2007 issue, almost every issue of the magazine contains an

article about cosmetics. From 2009, the Magazine runs an about 15 to 30-page feature article on beauty care once a year (the July issue or August issue) (Exhibits Ko 7 to 16).

D. The plaintiff opened a special shop and used the cited trademark for goods other than magazines in a special project (Exhibit Ko 6). However, its business scale, etc. is unclear.

E. The plaintiff conducted so-called collaboration events several times, which are jointly carried out with cosmetics companies, etc. (Exhibits Ko 21 to 24).

F. Other companies selling competing magazines of the Magazine also diversified their businesses such as establishing websites under the names of respective magazines and selling cosmetics in addition to clothes and other apparel products (Exhibits Ko 33 to 35).

(2) It is reasonable to interpret that a trademark that "is likely to cause confusion in connection with the goods or services pertaining to a business of another person" as specified in Article 4, paragraph (1), item (xv) of the Trademark Act includes not only a trademark that could mislead consumers, when used for its designated goods or services, into believing that the goods, etc. bearing the trademark pertain to the goods or services of another person, but also a trademark that could mislead consumers into believing that the goods, etc. bearing the trademark pertain to the business of a company that has a close business relationship such as a parent-subsidiary relationship or an affiliation relationship with such another person, or the business of a company that belongs to a group conducting a product development project by using the same indication of goods, etc. as the one used by such another person (a trademark that could cause confusion in a broad sense). A determination as to whether the trademark is "likely to cause confusion" should be made based on a comprehensive evaluation of the degree of similarity between the disputed trademark and another person's indication, the level of well-knownness and creativeness of another person's indication, the degree of relatedness between the designated goods, etc. of the disputed trademark and the goods, etc. that pertain to the business of such another person in terms of their nature, use or objective, the level of commonality in traders and consumers of the goods, and other transactional practices, and in light of the amount of attention ordinarily paid by the traders and consumers of the designated goods, etc. of the disputed trademark (see 1998 (Gyo-Hi) 85, Judgment of the Third Petty Bench of the Supreme Court of July 11, 2000, Minshu Vol. 54, No. 6, at 1848).

A. Degree of similarity between the Trademark and the cited trademark

While the Trademark consists of the alphabetic characters "MEN'S CLUB" written in standard letters, the cited trademark consists of the alphabetic characters "MEN'S

CLUB."

The Trademark and the cited trademark are extremely similar in terms of appearance and identical in that both trademarks are associated with the concept of "group or club of men" and also in terms of the pronunciation "menzu kurabu."

Therefore, the Trademark and the cited trademark can be considered to be extremely similar and likely to mislead or confuse consumers in terms of the source of goods.

#### B. Well-knownness and creativeness of the cited trademark

As stated in (1) B above, the Magazine started to be published in 1954 and continued to be published under the name "MEN'S CLUB" for more than 60 years starting from 1959 until the issuance of the 658th issue in December 2015, which is prior to the application filing date of the Trademark. Thereafter, the publication of the Magazine continued as of the registration date of the Trademark and even until now.

Thus, it is reasonable to find that the cited trademark was well known among consumers even before the application filing date and as of the date of examiner's decision of registration of the Trademark and has been well known among consumers until today.

The cited trademark consists of a combination of generic names, i.e., "MEN'S" and "CLUB." Thus, the cited trademark cannot be considered to be highly creative in comparison with a trademark consisting of coined words.

#### C. Relatedness between goods and commonality in traders and consumers

(A) As stated in (1) C above, at least for the last 10 years or so, almost every issue of the Magazine contained an article on cosmetics. Although men's fashion magazines mostly cover apparel products, cosmetics should be considered to be a part of fashion-related goods and can be considered to be covered by men's fashion magazines.

Therefore, men's cosmetics and men's fashion magazines should be considered to be related to a certain extent in the sense that both are related to fashion.

(B) Consumers of men's cosmetics and those of men's fashion magazines can be considered to be interested in men's fashion and should therefore be considered to overlap. Even though the traders of men's cosmetics are different from the traders of men's fashion magazines, it would not negate the fact that their consumers overlap.

Thus, it can be said that the customers of men's cosmetics overlap with those of men's fashion magazines.

(C) The designated goods of the Trademark are commodities that are consumed on a daily basis. Since consumers of such goods do not have any specialized knowledge and experience, the level of attention paid by consumers at the time of purchase should not be considered to be particularly high.

### (3) Applicability of Article 4, paragraph (1), item (xv) of the Trademark Act

As described above, the following facts are found: [i] since the Trademark and the cited trademark are extremely similar in terms of appearance and identical in terms of concept and pronunciation, the Trademark can be considered to be extremely similar to the cited trademarks; [ii] while the cited trademark cannot be considered to be highly creative, it has been widely known among consumers for several decades; and [iii] the designated goods of the Trademark (men's cosmetics) can be considered to be considerably related to the Magazine (men's fashion magazine) that pertains to the business of the plaintiff and that the consumers of the Magazines overlap with the consumers of the designated goods of the Trademark. Based on a comprehensive evaluation of these facts and other factors such as the level of attention paid by consumers, it can be found that the use of the Trademark for the designated goods could cause consumers to associate it with the cited trademark and mislead them into believing that those designated goods pertain to the business of the plaintiff or a company that has a close business relationship with the plaintiff or the business of a company that belongs to a group conducting a product development project by using the same indication as the one used by the plaintiff, and could consequently cause confusion about the source of goods.

Therefore, it is reasonable to interpret that the Trademark falls under a trademark that "is likely to cause confusion" as specified in Article 4, paragraph (1), item (xv) of the Trademark Act.

### (4) Allegation of the defendant

A. The defendant alleged that, since the cited trademark consists merely of a combination of English words that are well known in Japan and that there are many magazines with a title containing the word "CLUB," the cited trademark is not particularly creative.

It is true that the cited trademark cannot be considered to be highly creative in comparison with a trademark consisting of coined words. However, it can be said that the Trademark is extremely similar to the cited trademark and that the cited trademark is well known. Moreover, the designated goods of the Trademark, i.e., men's cosmetics, are somewhat related to the goods for which the cited trademark is actually used (men's fashion magazine). Furthermore, the consumers of the designated goods of the Trademark overlap with those of the cited trademark. By taking these factors into consideration in a comprehensive manner, it can be said that, even though the cited trademark cannot be considered to be highly creative in comparison with a trademark consisting of coined words, it can be said that the Trademark "is likely to cause

confusion" as specified in item (xv) (see 2000 (Gyo-Hi) 172, Judgment of the Second Petty Bench of the Supreme Court of July 6, 2001, Saibanshu Minji No. 202, at 599).

B. The defendant alleged that the recognition of a strong relationship between the Magazine and the cosmetics covered only by some issues of the Magazine would be the same as recognizing a strong relationship between the Magazine and all of the goods covered by the Magazine and eventually recognizing an unlawfully broad scope of right in connection with the designated goods "magazines" and this would be unreasonable.

However, as stated in (2) C above, almost all the issues of the Magazine contain an article about cosmetics. Cosmetics themselves are considerably related to apparel products, which are clearly the theme of the Magazine. In view of the facts that the cited trademark has been well known for a long time and that the plaintiff has been carrying out collaboration projects, etc., it can be said that there is a risk of confusion in a broad sense.

Therefore, it is not unreasonable to find that the Trademark registered for the designated goods, i.e., men's cosmetics, falls under item (xv).

(C) The defendant pointed out the facts that, while bags are sold at the website of the Magazine (Exhibit Otsu 128), the trademark "MEN'S CLUB" was registered by Kento Japan Kabushiki Kaisha for the designated goods, Class 18 "Bags and the like" and Class 25 "Shoes and boots [other than "shoe dowels, shoe pegs, tongue or pull-strap for shoes and boots, protective metal members for shoes and boots"]" (Exhibits Otsu 129 and 130) and the bags and shoes bearing this trademark are sold at the market without being confused with the Magazine (Exhibit Otsu 131) and that the clothes bearing said trademark registered by Kento Japan Kabushiki Kaisha are sold without causing confusion with the Magazine (Exhibits Otsu 4 to 10, 173, and 174), and alleged that consumers would not consider that there is a strong relationship between the cited trademark and the goods covered by the Magazine, but would consider the cited trademark merely as the name of the Magazine.

However, an application for registration of the oldest trademark of Kento Japan Kabushiki Kaisha was filed in 1956, which is the same year that the cited trademark was first used, (Exhibit Otsu 4) and can be considered to have become well known as a trademark of said company.

Thus, it is impossible to say that the Trademark is not "likely to cause confusion" even in consideration of the trademark of Kento Japan Kabushiki Kaisha.

D. The defendant alleged that, in view of the fact that, in the case of some women's fashion magazines, third parties registered the trademarks that are identical with the names of those magazines and sell or otherwise handle goods bearing those trademarks

(Exhibits Otsu 132 to 168), consumers would consider the name of a magazine only as the name of the magazine and would not interpret that there is a strong relationship between the magazine and the relevant goods.

However, the applicability of Article 4, paragraph (1), item (xv) of the Trademark Act should be determined based on a comprehensive evaluation of various factors such as the relatedness between the goods, the level of well-knownness and creativeness of another person's indication, and transactional practices. In the case of women's magazines, which are published in greater varieties than men's magazines, even if a trademark identical with the name of a magazine has been registered by a third party, such case should not be considered to be comparable to the Magazine, which has been published for more than 50 years as one of the few men's magazines.

E. The defendant alleged that, since "men's cosmetics" are not related to "men's fashion magazine" so much, the consumers of the former cannot be considered to overlap with the consumers of the latter.

However, as stated in (2) C above, since men's cosmetics should be considered to be considerably related to men's fashion magazines, it is obvious that the consumers of the former overlap with the consumers of the latter.

F. The defendant alleged that, for any consumers who are highly interested in cosmetics, deciding which cosmetics brand to use is serious business and that, since they would pay a high level of attention, it is extremely unlikely for such consumers to confuse the defendant's goods with the plaintiff's goods.

However, since consumers of men's cosmetics are ordinary consumers without specialized knowledge or experience, they would not pay a high level of attention when purchasing cosmetics, which are commodities to be consumed on a daily basis. Thus, those consumers are highly likely to be misled into believing that the goods bearing the Trademark have some relationship with the well-known cited trademark. The evidence (Exhibits Otsu 171 and 172) would not affect the aforementioned determination.

G. Therefore, all of the aforementioned allegations of the defendant are groundless.

#### (5) Summary

On these grounds, the Trademark should be considered to fall under Article 4, paragraph (1), item (xv) of the Trademark Act. Grounds for Rescission 1 alleged by the plaintiff shall therefore be considered to be well grounded.

#### 2. Conclusion

Therefore, without needing to examine any other factors, the plaintiff's claims shall be found to be well grounded and acceptable. The judgment shall be rendered in the form of the main text.



Intellectual Property High Court, Fourth Division

Presiding judge: TAKABE Makiko

Judge: FURUKAWA Kenichi

Judge: SEKINE Sumiko