

Date	November 14, 2017	Court	Intellectual Property High Court, Fourth Division
Case number	2017 (Gyo-Ke)10132		
<p>- Regarding "computer software" which is a designated good of the trademark in the Application and "semiconductor chip and semiconductor element" which are designated goods of Cited Trademark, in view of circumstances such that (1) both are closely related to each other in terms of usage and function, (2) considerable number of business operators manufacture both goods, (3) both goods are sold in not only general shopping sites and electronics retail stores but also considerable number of shops specializing electronic components including the semiconductor element and the like, and (4) consumers of both goods may be the same, when the same or similar trademarks are used for both goods, both goods in question are likely to mistakenly be recognized as goods manufactured or sold by the same person in business, and both goods are "goods similar" stipulated in Article 4, paragraph(1), item(xi) of the Trademark Act.</p>			

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

Number of related rights, etc.: Trademark Application No. 2015-6591 (trademark in the Application), Appeal against Examiner's Decision (of Refusal) No. 2016-1820, Trademark Registration No. 5228470 (Cited Trademark)

Summary of the Judgment

This is a case about the trademark in the Application which consists of the standard characters of Alphabetic characters "UNIFI" with "Computer software for controlling a physical and chemical device used in the field of chromatography and mass spectrometry, computer software for controlling a physical and chemical device which collects, analyzes, manages, stores, and transfers data, monitors the state of the data, creates a report, and enhances compliance with laws and regulations, and other computer software" in Class No. 9 as the designated goods. The application of the trademark was refused by the examiner, and then the plaintiff requested an appeal against the examiner's decision of refusal but the JPO made an appeal decision that the request was not approved. Accordingly, the plaintiff sought the rescission of the JPO's appeal decision.

The reasons given in the JPO's appeal decision of the case indicates that, in short, since the trademark in the Application is a trademark similar to

Cited Trademark which consists of the standard characters of Alphabetic characters "UniFi" with "semiconductor chip and semiconductor element" in Class No. 9 as the designated goods and the designated goods of the trademark in the Application are the same as or similar to the designated goods of Cited Trademark, the trademark in the Application falls under Article 4, paragraph(1), item(xi) of the Trademark Act, and should not be registered. The ground for rescission is that there is an error in the determination regarding the similarity between the designated goods of the trademark in the Application and the designated goods of Cited Trademark.

In the Judgment, the plaintiff's demand is dismissed as described below:

Regarding the "computer software" which is the designated good of the trademark in the Application and the "semiconductor chip and semiconductor element" which are the designated goods of Cited Trademark, there are the following facts: (1) both goods are applications of action of electrons, are necessary for the structures of electronic devices such as computers to operate, and are closely related to each other in terms of usage and function; (2) considerable number of business operators manufacture both goods; (3) both goods are sold in not only general shopping sites and electronics retail stores for selling various goods but also in a considerable number of shops specialized in electronic components including semiconductor elements and the like; and (4) both goods can be used by common consumers, including general individual consumers and manufacturers of electronic devices and the like. In view of these facts, even if it is taken in consideration that materials and qualities of both goods are different from each other and both goods is not in a relationship between a completed good and a component thereof, when the same or similar trademarks are used for both goods, both goods in question are likely to mistakenly be recognized as goods manufactured or sold by the same person in business. It is therefore reasonable to understand that both goods are "goods similar" stipulated in Article 4, paragraph (1), item (xi) of the Trademark Act.