

Trademark Right	Date	December 26, 2023	Court	Intellectual Property High Court, Second Division
	Case number	2023 (Gyo-Ke) 10079		
- A case in which it was determined that a trademark with the designated goods of "Gummi Candy" and configured by indicating the characters of "地球グミ (CHIKYU-GUMI)" in standard characters falls under the trademark listed in Article 4, paragraph (1), item (x) of the Trademark Act.				

Case type: Rescission of Trial Decision to Maintain

Result: Granted

References: Article 4, paragraph (1), item (x), paragraph (3) of the Trademark Act

Related rights, etc.: Trademark Registration No. 6525426

Decision of JPO: Invalidation Trial No. 2022-890049

### Summary of the Judgment

1 The Defendant is a trademark right holder of a trademark (hereinafter, referred to as the "Present Trademark") with the designated goods of class 30 "Gummi Candy" and indicating the characters of the "地球グミ (CHIKYU-GUMI)" in standard characters. The Plaintiff asserts that the Present Trademark falls under the trademark listed in Article 4, paragraph (1), item (x) or item (xix) of the same paragraph in the Trademark Act and requested a trial for invalidation of trademark registration regarding the trademark registration of the Present Trademark. The trademark, asserted by the Plaintiff, which falls under the well-known trademark under item (x) of the same paragraph or the well-known trademark under item (xix) of the same paragraph is a trademark (hereinafter, referred to as the "Cited Mark") and the like configured by writing characters of the "地球グミ (CHIKYU-GUMI)", which is considered to be used for the goods that the Plaintiff imports / sells (hereinafter, referred to as the "Plaintiff's Goods"). The Patent Office did not acknowledge the well-known characteristics of the Cited Mark, proscribed all the aforementioned assertions by the Plaintiff, and made the JPO Decision dismissing the request for a trial. This case is a case in which the Plaintiff made a request for rescission of the JPO Decision.

2 This Judgment approved the well-known characteristics of the Cited Mark and determined that the Present Trademark is similar to the Cited Mark and that the designated goods related to the Present Trademark are identical to the Goods related to the Cited Mark and thus, the Present Trademark falls under the trademark listed in Article 4, paragraph (1), item (x) of the Trademark Act, and rescinded the JPO Decision.

### Well-known characteristics of the Cited Mark

According to the facts found by the evidence, related to the well-known characteristics of the Cited Mark, the following circumstances should be acknowledged.

That is, the Plaintiff's Goods are sweets manufactured by a foreign company and named as "Trolli Planet Gummi", "Planet Gummi", and the like, and the Plaintiff's Goods or the package or individual package thereof do not have characters as "地球グミ (CHIKYU-GUMI)" described in Japanese. However, the Plaintiff's Goods were extremely popular in Korea mainly, among video contributors and their viewers around 2018, and the popularity spilled over to Japan. And the Plaintiff's Goods made a big boom mainly among the video contributors and their viewers also in Japan from around 2020, and by October in the same year at the latest, when the Plaintiff started import / sales of the Plaintiff's Goods, some retailers having shops all over Japan called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" and began advertisement thereof. After the Plaintiff started import / sales of the Plaintiff's Goods, too, the Plaintiff's Goods became very popular, and such a state continued that the Goods were sold out at the retailers' shops immediately after the sales started, and it became extremely difficult to obtain the Goods. Since the Plaintiff started the import / sales of the Plaintiff's Goods, the retailers having shops all over Japan have called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" and repeatedly advertised them. Moreover, the Plaintiff's Goods enjoyed high popularity as the Goods called "地球グミ (CHIKYU-GUMI)" at video contributing websites. The Plaintiff's Goods as above were at last reported in national papers and sub-key TV stations in Osaka as very popular goods called "地球グミ (CHIKYU-GUMI)" in June of 2021, and in the TV reporting, the Goods were ranked in the ranking, chosen by the Generation Z, of foods and drinks which became popular in the first half of the year. The Plaintiff's Goods were in the end reported by the key TV stations in Tokyo as similarly popular goods in July and were introduced as goods that young people in their early 20's all knew (it is to be noted that the Plaintiff called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" in a TV program in June of the same year at the latest and began advertisement of the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" in September of the same year at the latest). Moreover, the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" were introduced in line with a novel by a famous author, a musical piece by a famous singer and song-writer, and the like as examples of works or goods which became famous as the contribution to the video contribution websites as a trigger in November of the same year. Also, the Goods won the second rank in

the "Cafe / Gourmet Section" in the award called "SHIBUYA109 lab. Trend Award 2021", which was the result of research (of 545 women of 15 to 24 years old) by an operating company of a famous commercial facility in Shibuya-Ku. On the basis of the trend of the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" as above until 2021, "Modern Language Basic Knowledge 2022" issued in January in 2022 picked up the term "地球グミ (CHIKYU-GUMI)", which is a colloquial term of the Plaintiff's Goods, as goods which attracted attention in 2021 (big-hit food goods).

In light of the aforementioned circumstances, it is reasonable to admit that the term "地球グミ (CHIKYU-GUMI)" (Cited Mark) falls under the trademark which had been widely recognized among consumers (in light of the fact found by the contents and the nature, as well as evidence of the goods for which the Cited Mark was used, it is found to be consumers of gummi candies including young people) as the object indicating the Goods (Plaintiff's Goods) related to the business of the Plaintiff or the manufacturer of the Plaintiff's Goods by the date of decision of this case (February 22, 2022) at the latest.

Judgment rendered on December 26, 2023

2023 (Gyo-Ke) 10079 Case of Seeking Rescission of the JPO decision

Date of conclusion of oral argument: October 26, 2023

### Judgment

Plaintiff: YUTAKA TRADING COMPANY LIMITED

Defendant: SSB Co., Ltd.

### Main Text

1. The JPO Decision made by the Japan Patent Office on June 20, 2023 on the Invalidation Trial No. 2022-890049 shall be rescinded.

2. The Defendant shall bear the court costs.

### Fact and Reason

#### No. 1 Claims

The same as 1, Main Text.

#### No. 2 Background

This case is a lawsuit of seeking rescission of the JPO decision dismissing the request for a trial for invalidation of a trademark registration. Issues are: [i] whether or not the registered trademark (hereinafter, referred to as the "Present Trademark") in Postscript 1 falls under the trademark listed in Article 4, paragraph (1), item (x) of the Trademark Act; and [ii] whether or not the Present Trademark falls under the trademark listed in the item (xix) of the same paragraph.

##### 1. Registered Trademark

The Defendant is a trademark right holder of the following registered trademark (Present Trademark) (Exhibit Ko 1, entire import of oral argument, hereinafter, the trademark registration related to the Present Trademark shall be referred to as the "Present Trademark Registration").

(1) Registration number: Trademark Registration No. 6525426

(2) Date of filing: December 16, 2021 (hereinafter, referred to as the "Date of

Filing")

(3) Date of decision of registration: February 22, 2022 (hereinafter, referred to as the "Date of Decision")

(4) Date of registration: March 9, 2022

(5) Configuration of the trademark: "地球グミ(CHIKYU-GUMI)" (standard characters)

(6) Class of goods and services as well as designated goods: Class 30 "Gummi Candy"

## 2. Outline or procedures and the like at the JPO

The Plaintiff made a request for a trial for invalidation of the Present Trademark Registration on June 23, 2022, and the JPO examined this as Invalidation Trial No. 2022-890049 (no dispute).

The JPO made the decision that "the request for the Trial is dismissed." on June 20, 2023 (hereinafter, referred to as the "JPO Decision"), and the certified copy thereof was serviced to the Plaintiff on the 29th day of the same month (no dispute).

The Plaintiff instituted this lawsuit for rescission of the JPO Decision (Obvious fact to this court) on July 25, 2023.

## 3. Summary of Reasons for the JPO Decision

The reasons for the JPO Decision are as in the JPO Decision in the Attachment. The summary thereof is as follows.

(1) Cited mark and the goods using that (related to the assertion by the Plaintiff)

### A. Cited Mark 1

(a) Configuration of the mark: Mark configured by writing the characters of "地球グミ(CHIKYU-GUMI)"

(b) Goods used therefor: Gummi candy

### B. Cited Mark 2

(a) Configuration of the mark: Mark configured by writing the characters of "プラネットグミ(PURANETTO-GUMI)"

(b) Goods used therefor: Gummi candy

(2) Assertion by the Plaintiff (related to Cited Mark 1)

It is difficult to acknowledge that the gummi candy sold by the Plaintiff (those with the goods name "Trolli Planet Gummi" and the like, hereinafter, referred to as the "Plaintiff's Goods") had been well-known in Japan or in foreign countries before the Date of Filing, and Cited Mark 1, which is a common name of the Plaintiff's Goods, cannot be acknowledged to have been widely recognized among the general

consumers in Japan or in foreign countries as the mark indicating the goods (Plaintiff's Goods) related to the business of the Plaintiff on the Date of Decision since before the Date of Filing. Then, Cited Mark 1 cannot be acknowledged, either, to have been widely recognized among the consumers in Japan (under Article 4, paragraph (1), item (x) of the Trademark Act) or in Japan or in foreign countries (under item (xix) of the same paragraph) as the mark indicating the goods related to the business of the Plaintiff on the Date of Filing and the Date of Decision. Therefore, even if the Present Trademark and Cited Mark 1 are identical or similar and the designated goods of the Present Trademark and the goods used therefor of Cited Mark 1 are identical or similar, the Present Trademark does not fall under the trademark listed in Article 4, paragraph (1), item (x) of the Trademark Act. Moreover, even without determining on the purpose of unfair acts, it does not fall under the trademark listed in the item (xix) in the same paragraph.

(3) Assertion by the Plaintiff (related to Cited Mark 2)

Since it is not acknowledged that the Plaintiff's Goods with the characters of "Planet Gummi" had been well-known in Japan or in foreign countries, even if Cited Mark 2 is assumed to be a cited mark, the Present Trademark does not fall under the trademark listed in Article 4, paragraph (1), item (x) or item (xix) of the same paragraph of the Trademark Act.

(4) Conclusion

As described above, the Present Trademark Registration cannot be considered to be made in violation of the provisions in Article 4, paragraph (1), item (x) or item (xix) of the same paragraph of the Trademark Act and thus, the Present Trademark Registration should not be invalidated on the grounds of the provisions in Article 46, paragraph (1), item (i) of the same Act.

(omitted)

No. 5 Judgment of this court

1. Found Facts

According to the listed evidence and the entire import of oral argument, the following facts are found.

(1) The Plaintiff's Goods are Gummi candy manufactured in Spain by an affiliated company of a German manufacturer (Exhibit Ko 6). The Plaintiff's Goods are sweets in which a strawberry filling with an image of magma is filled in blue gummi candy in a spherical shape resembling the earth, and the package thereof (bag-

shaped one accommodating some pieces of the Plaintiff's Goods, hereinafter, when the "package of the Plaintiff's Goods" or the like is referred to, it refers to this bag-shaped one) has characters of "Trolli" described on an upper state on a front surface and characters of "Planet Gummi" or characters of "Blue Planet" described in the vicinity of a middle stage on the front surface, respectively. And the individual package (spherical shaped one, hereinafter, when the "individual package of the Plaintiff's Goods" or the like is referred to, it refers to this spherical-shaped one) of the Plaintiff's Goods has the characters of "Trolli" described, but the Plaintiff's Goods, the package, and the individual package thereof do not have such description of the characters of "地球グミ (CHIKYU-GUMI)" (Exhibits Ko 2, 27-1).

(2) The Plaintiff first imported the Plaintiff's Goods in October in 2020 and started to sell them in Japan (Exhibit Ko 6). The document titled "Trolli Guide to New Product" prepared by the Plaintiff (Exhibit Ko 2) carries photos of the Plaintiff's Goods, the package, and the individual package thereof and description that the Plaintiff's Goods were scheduled to be sold around autumn in that year, but there was no description of "地球グミ (CHIKYU-GUMI)". Moreover, the document had the description that "Sure to look good on Instagram! Much-talked-about プラネットグミ (PURANETTO-GUMI) on YouTube and SNS!!".

(3) Loft used a hashtag "#地球グミ (CHIKYU-GUMI)" and the like in the official account on Twitter at that time (hereinafter, referred to simply as "Twitter") on September 29, 2020 prior to the start of sales of the Plaintiff's Goods by the Plaintiff and posted "Hot topic #地球グミ (CHIKYU-GUMI) landed on Loft!! ... the name is トローリ (TORORI)#プラネットグミ (PURANETTO-GUMI)!", "On sale at 118 Loft shops all over the country and Loft Net Store, excluding some shops! Limited quantity!" and the like, together with the images of the package of the Plaintiff's Goods and the individual package accommodating the Plaintiff's Goods (Exhibit Ko 31).

(4) PLAZA, on October 2, 2020, used the hashtag "#地球グミ (CHIKYU-GUMI)" and the like in its official account on Twitter and posted "Hot topic in YouTube, 'プラネットグミ (PURANETTO-GUMI)' of 'Trolli (#トローリ (TORORI))' as #地球グミ (CHIKYU-GUMI) hits the scene" together with the images of the Plaintiff's Goods, the package, and the individual package thereof (Exhibit Ko 30-2).

(5) THANKYOUMART, on March 31, 2021 (hereinafter, for dates in 2021, description of the year might be omitted in some cases), used the hashtag "#地球グミ (CHIKYU-GUMI)" and the like in its official account on Twitter and posted "Thank

you for waiting ... hot topic in YouTube, '#地球グミ (CHIKYU-GUMI)' will be finally on sale at THANKYOUMART", "地球グミ (CHIKYU-GUMI) will be on sale at THANKYOUMART all over the country from Friday, April 2 as soon as they arrive" and the like together with the images of the Plaintiff's Goods, the package, the individual package thereof, and the like (Exhibit Ko 39-1).

(6) THANKYOUMART posted in its official account on Twitter on April 3 that "the hot topic, '地球グミ (CHIKYU-GUMI)' will be sequentially on sale from today at shops all over the country... very, very, very popular goods, get them as soon as possible ... !" together with images of the Plaintiff's Goods, the package, the individual package thereof, and the like (Exhibit Ko 29).

(7) On June 24, on the news site of Mainichi Shimbun, a web article (Exhibit Ko 6) titled "Reason why adults do not know that mysterious sweets '地球グミ (CHIKYU-GUMI)' are out of stock everywhere..." was published. The main body of the article had a photo of the package of the Plaintiff's Goods (with the note that "'トローリプラネットグミ (TORORI-PURANETTO-GUMI)' with the nickname of '地球グミ (CHIKYU-GUMI)' made a secret boom provided by YOTAKA TRADING COMPANY") and the like and described [i] the sweets called "地球グミ (CHIKYU-GUMI)" became popular in SNS mainly among children and young people and are sold out everywhere; [ii] "地球グミ (CHIKYU-GUMI)" are out of stock at shops and official online shops, are sold at premium prices at Amazon, and are auctioned at Mercari at high prices; [iii] 地球グミ (CHIKYU-GUMI) is mainly sold at shops of business operators handling import foods such as PLAZA, Don Quijote, Village Vanguard, Kaldi, Loft, and the like, but according to PLAZA, after they started transactions thereof in autumn of 2020, such a state has continued that immediately after shipment of the goods, they were sold out, the next shipment would be in autumn in 2021 and after, and the state continues at shops of the other operators; and [iv] the trigger of the popularity of the Plaintiff's Goods was posting of a video recording a state in which the video contributor in Korea was eating "地球グミ (CHIKYU-GUMI)", to a video contribution site around 2018, and it was spread by many video contributors, spilled over to Japan after that, and those who posted the videos of "地球グミ (CHIKYU-GUMI)" in the video contribution sites have rapidly increased since 2020. The article was also introduced in the account of Mainichi Shimbun on Twitter (Exhibit Ko 9) on the day when the article was published with a photo of the packaged Plaintiff's Goods.

(8) In the program by Kansai TV, aired from 4:45 pm on June 25, "NEWS Runner", the Plaintiff's Goods were introduced as "Ranking of popular foods / drinks



chosen by the Generation Z in the first half of 2021" (Exhibits Ko 12, Ko 13). In the program, the Plaintiff's Goods were called "地球グミ (CHIKYU-GUMI)" and such explanation was made that the goods were difficult to get, and even the Plaintiff, who is the importer, did not have any inventory at all. Moreover, in the program, it was explained that "地球グミ (CHIKYU-GUMI)" became popular when a popular video contributor posted a video recording a state where the contributor bit and opened the individual package of the Plaintiff's Goods, and many people followed the video contributor, which made it difficult to get the goods, as the history of the popularity.

(9) In the Mainichi Shimbun issue of July, 3, an article titled "'地球グミ (CHIKYU-GUMI)' that adults do not know" (Exhibit Ko 7) was published. The main text of the article had substantially the same contents as the article in the aforementioned (7) with a photo of the package of the Plaintiff's Goods.

(10) During the program "HIRUNANDESU" by Nippon Television aired from 11:55 in the morning on July 5, an entertainer A introduced the Plaintiff's Goods as "地球グミ (CHIKYU-GUMI)" in a corner reporting "goods that young people in their early 20's all know" (Exhibits Ko 15, Ko 16). Moreover, in a web article (Exhibit Ko 16) as of the same date of Tokyo Chunichi Sports of Chunichi Sports reporting the program, it was described that the Plaintiff's Goods were called "地球グミ (CHIKYU-GUMI)" with the shape imitating the blue globe and attracted popularity of SNS influencers. On the same day, in the account of "B" on Twitter, a post (Exhibit Ko 17) describing "Found the 地球グミ (CHIKYU-GUMI) aired in HIRUNANDESU at Rakuten EC site! So curious" was posted with the hashtag of "#地球グミ (CHIKYU-GUMI)" and an image of the package of the Plaintiff's Goods (noted as "a set of three pieces of 地球グミ (CHIKYU-GUMI)").

(11) During the program "Viking MORE" by FUJI TELEVISION from 11:55 in the morning on August 12, a state in which an SNS contributor called "C" introduced the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" and the like was aired. In an upper right part in the image of the scene in the aired program in which the person named "C" introduces the Plaintiff's Goods, subtitles that "Thorough Search on the Reason of Hits, Ranking GO of Curious Things, Popular among Generation Z ... Top 5 of Foods / Drinks" were placed, and in the scene introducing the photo of the Plaintiff's Goods accommodated in the individual package, a subtitle which reads "Big hit in Korea before Japan" was given, and in the scene in which the person called "C" made explanation, the subtitle that "Pay attention to the 'taste' of 地球グミ (CHIKYU-GUMI)" was given (Exhibits Ko 19, 21-1 to 5). The person called "C" posted, with the still image of the program including the image of the Plaintiff's

Goods accommodated in the individual package, that "I talked about 地球グミ (CHIKYU-GUMI) which became a hit in the first half of 2021 in Viking MORE by FUJI-affiliated TV. The popularity of the 地球グミ (CHIKYU-GUMI) is fabulous!" in the account of the same person on Twitter on the same day (Exhibit Ko 21-1).

(12) Village Vanguard posted on Twitter on August 22 in their official account that, with the hashtag of "#地球グミ (CHIKYU-GUMI)", "Does Village Vanguard have '地球グミ (CHIKYU-GUMI) ...' which is said to be inquired about 500 times a day in the city? Do they? Did they? What is the price? When will they arrive next? We will answer all the questions from the customers here!!" with an image of the package of the Plaintiff's Goods (Exhibit Ko 27-1).

(13) The Plaintiff posted on September 13 in the Plaintiff's account on Instagram (hereinafter, referred to as the "Plaintiff's Account") that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like, "On sale again in the beginning of October! プラネットグミ (PURANETTO-GUMI) which made a topic will be in stock again." and the like with an image of the Plaintiff's Goods and the package and the individual package thereof (Exhibit Ko 3-1).

(14) PLAZA posted on September 21 in its official account on the Twitter that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like, "The 'big hit #トローリ (TORORI) #プラネットグミ (PURANETTO-GUMI)' will be in stock again in 'the beginning of October' ... The popular item which will be sold out soon at each arrival in many shops ... Please get them at this opportunity! They will be handled at PLAZA / MINiPLA, PLAZA ONLINE STORE all over Japan" and the like together with images of the package of the Plaintiff's Goods and the individual package accommodating the Plaintiff's Goods (Exhibit Ko 30-1).

(15) The Plaintiff posted on September 22 on the Plaintiff's account that, with the hashtag of "#Muchu To 地球グミ (CHIKYU-GUMI)!" and the like, photos of the individual package accommodating the Plaintiff's Goods and the package of the Plaintiff's Goods, an image describing characters such as "Muchu to 地球グミ (CHIKYU-GUMI)!? Get 地球グミ (CHIKYU-GUMI) at Villa-Van!", and "Present Campaign is being held for プラネットグミ (PURANETTO-GUMI) (地球グミ (CHIKYU-GUMI)) in the account of Village Vanguard!!" and the like (Exhibit Ko 3-2).

(16) The Plaintiff posted on October 1 on the Plaintiff's account, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like, images of the package of the Plaintiff's Goods with the characters of "Trolli" and the like, "Thank you for waiting so long! Sales of the very popular 地球グミ (CHIKYU-GUMI) and Pop Eye of the

new product will start soon!! When you see them at the shop, get them as soon as possible!!" and the like (Exhibit Ko 3-3).

(17) THANKYOUMART posted on October 1 in their official account on Twitter that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like together with images of the Plaintiff's Goods as well as the package, the individual package thereof, and the like, "That Gummy is back!" In addition to the resale of "#地球グミ (CHIKYU-GUMI)", "#Pop Eye Gummy" has arrived... will be on sale at THANKYOUMART all over Japan from Saturday, October 2 at the shops with the stock!" and the like (Exhibit Ko 39-2).

(18) WEGO Canal City Hakata shop posted on October 3 in the shop account on Twitter that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like, "地球グミ (CHIKYU-GUMI) which has been very popular and frequently inquired about are in stock again" and the like (Exhibit Ko 26-2).

(19) Village Vanguard posted on October 14 in their official account on Twitter that, with the hashtag of "#Muchu to 地球グミ (CHIKYU-GUMI)" and the like together with images of the Plaintiff's Goods as well as the package, the individual package thereof, and the like, "Soon sold out after the sales started ... 地球グミ (CHIKYU-GUMI) ... Has arrived again! And resale has started at some shops!! Please follow Twitter of the Villa-Van shop nearby and get the latest information!!" (Exhibit Ko 27-2).

(20) WEGO LALAPORT Izumi Shop posted on November 3 in the official account of the shop on Twitter that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like together with images of the package of the Plaintiff's Goods and the like, "Super popular!! 地球グミ (CHIKYU-GUMI) is on sale again today ... Since the stock is limited, please come to the shop as soon as possible" and the like (Exhibit Ko 26-5).

(21) A person called "WEGO HIROSHIMA Area" posted on November 3 in their account on Twitter that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like together with images of the package of the Plaintiff's Goods and the like, "Super popular in SNS ... 地球グミ (CHIKYU-GUMI) has arrived again today ... November 3 ... Super! Super! Super popular goods, come to the shop and check it out" (Exhibit Ko 26-3).

(22) On November 4, on the website of BABYDOT, an article titled "I got the long-cherished 地球グミ (CHIKYU-GUMI)! プラネットグミ (PURANETTO-GUMI), sold out at every Kaldi shop. The next arrival is... !?" was published (Exhibit Ko 28). The main text of the article had photos of the Plaintiff's Goods as

well as the package, the individual package thereof, and the like and the description that "Could buy it at last after having waited for resale for several months but sold out immediately! The next arrival would be early in the New Year!!! Such popular goods! I could get it miraculously and tried it", "When I went to Kaldi the other day, there was an announcement that 'Very popular 地球グミ (CHIKYU-GUMI) on Sale, limited to three pieces for one customer' and I just bought them at once. There were many boxes piled up but they were already gone yesterday", "The so-called '地球グミ (CHIKYU-GUMI)', which is popular in SNS ... our child has wanted them for long but could not get them at all ... I heard that there were some in Kaldi before summer and I ran to the shop soon, but they were already sold out ... It was said that the next arrival would be in October. Waited for three months or more, not yet? Soon? ... I went to the shop again and again and at last encountered them! ... I visited Kaldi again the other day, but "The next arrival will be early in the New Year'!!!", "In SNS, what has gone viral is that you put it with the package into the mouth and softly chew it and then, the gummi is squeezed out in a slithering manner ...", "I caught the recent? Trend! Or I could catch it at last!" and the like.

(23) A person called "WEGO SAPPORO Area" posted on November 5 in his / her account on ex-Twitter that, together with the image of the package of the Plaintiff's Goods and the like, "Thank you for waiting!! The popular 地球グミ (CHIKYU-GUMI) and Pop Eye Gummy are in stock again ... They are wildly sold only in some hours from the arrival! They are so popular. Please get them soon" and the like (Exhibit Ko 26-4)

(24) WEGO KOORIYAMA Shop posted on November 5 in the shop account on Twitter that, together with an image of the package of the Plaintiff's Goods and the like, "Thank you for waiting for the very popular!! 地球グミ (CHIKYU-GUMI) and Pop Eye Gummi are in stock now" and the like (Exhibit Ko 26-1).

(25) The Plaintiff posted on November 9 in the Plaintiff's account that, with the hashtag of "#地球グミ (CHIKYU-GUMI)" and the like together with photos of the individual package accommodating the Plaintiff's Goods and the package of the Plaintiff's Goods and the image with the characters of "'地球グミ (CHIKYU-GUMI)' was nominated for the TikTok Buzzwords Contest 2021!!" and the like, "'地球グミ (CHIKYU-GUMI)' was nominated for the TikTok Buzzwords Contest 2021!!" and the like (Exhibit Ko 3-4).

(26) In NIKKEI MJ as of November 12, the article titled "TikTok used conveniently by adults" and the like (Exhibit Ko 8-1) was published. The article describes that the video posting application "TikTok" has had a presence among a

wide variety of generations, many goods and services have gained popularity one after another with the post to TikTok as a trigger, TikTok has attracted attention as media which gives birth to hit items and the like. And as "examples of works / goods 'sold by TikTok'", "'トローリプラネットグミ (TORORI-PURANETTO-GUMI)' (地球グミ (CHIKYU-GUMI)) by MEDERER in Germany" is listed together with D's novel "Lipstick to afterimage", E's musical piece "Perfume", Earth Corporation's product "RAKU-HAPI-MACH-AWA-BABLOON", and Otsuka Pharmaceutical's product "Fibe-Mini".

(27) In the NIKKEI MJ in the aforementioned (26), articles titled "This year's trend for women of 15 to 24 years old", "'To-Reve', '地球グミ (CHIKYU-GUMI)', and the like were published (Exhibit Ko 8-2). The article describes, as the result of research by a research institute of the operating company of SHIBUYA109 of 545 women of 15 to 24 years old, the "SHIBUYA109 lab. TREND AWARD 2021" was released, "地球グミ (CHIKYU-GUMI)" won the second rank in the "Cafe / Gourmet Section", and that, since the scene of biting the individual package of the "地球グミ (CHIKYU-GUMI)" to open it seemed attractive as a video, many imitated the action, and the like.

(28) On January 1, 2022, after the date of filing, "Modern Language Basic Knowledge 2022" (Exhibit Ko 36) was issued, and the "Food trend" column in "Things / Goods which attracted attention this year" in this book has the description that "In the hit goods field, 'トローリプラネットグミ (TORORI-PURANETTO-GUMI)' made in Germany made a topic with its colloquial term of '地球グミ (CHIKYU-GUMI)' from its appearance." (The characters of "地球グミ (CHIKYU-GUMI)" in the description are written in highlighted Gothic script similarly to the cases of other terms ("Non-Alcoholic Drink", "Non-Al", and the like) in the same column).

2. Grounds for Rescission 1 (Erroneous determination on applicability of Article 4, paragraph (1), item (x) of the Trademark Act)

(1) Well-known characteristics of Cited Mark 1

A. According to the facts found in the aforementioned 1, regarding the well-known characteristics of Cited Mark 1, the following circumstances should be acknowledged.

That is, the Plaintiff's Goods are sweets manufactured by a foreign company with the name "Trolli Planet Gummi", "Planet Gummi" and the like, and the characters of "地球グミ (CHIKYU-GUMI)" in Japanese are not described on the Plaintiff's Goods, the package, or the individual package thereof. However, the

Plaintiff's Goods became very popular in Korea mainly among video contributors and their viewers around 2018, but this popularity spilled over to Japan. And the Plaintiff's Goods became very popular in Japan, too, mainly among video contributors and their viewers, and by October of the same year, when the Plaintiff started import / sales of the Plaintiff's Goods, some retailers having shops all over Japan called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" and began advertisement thereof. Even after the Plaintiff started import / sales of the Plaintiff's Goods, the Plaintiff's Goods boasted big popularity, and such a state continued that the Goods were sold out at the retailers' shops immediately after the sales started, and it became extremely difficult to obtain the Goods. Since the Plaintiff started the import / sales of the Plaintiff's Goods, the retailers having shops all over Japan called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" and repeatedly advertised them. Moreover, the Plaintiff's Goods enjoyed high popularity as the Goods called "地球グミ (CHIKYU-GUMI)" on video contribution websites, too. The Plaintiff's Goods as above were at last reported in national papers and sub-key TV stations in Osaka as very popular goods called "地球グミ (CHIKYU-GUMI)" in June of 2021, and in the TV reporting, the Goods ranked in the ranking, chosen by the Generation Z, of foods and drinks which became popular in the first half of the year. The Plaintiff's Goods were in the end reported by the key TV stations in Tokyo as similarly popular goods in July and were introduced as goods that young people in their early 20's all knew (the Plaintiff called the Plaintiff's Goods "地球グミ (CHIKYU-GUMI)" in a TV program in June of the same year at the latest and began advertisement of the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" in September of the same year at the latest). Moreover, the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" were introduced in line with a novel by a famous author, a musical piece by a famous singer and song-writer, and the like as examples of works or goods which became famous with the contribution to the video contribution websites as a trigger. Also, the Goods won the second rank in the "Cafe / Gourmet Section" in the award called "SHIBUYA109 lab. Trend Award 2021", which was the result of research (of 545 women of 15 to 24 years old) by an operating company of a famous commercial facility in Shibuya-Ku. On the basis of the trend of the Plaintiff's Goods called "地球グミ (CHIKYU-GUMI)" as above until 2021, "Modern Language Basic Knowledge 2022" issued in January in 2022 picked up the term "地球グミ (CHIKYU-GUMI)", which is a colloquial term of the Plaintiff's Goods, as goods which attracted attention in 2021 (big-hit food goods).

In light of the aforementioned circumstances, it is reasonable to admit that the term "地球グミ (CHIKYU-GUMI) (Cited Mark 1) falls under the trademark which

had been widely recognized among consumers (in light of the fact found by the contents, the nature and facts in the aforementioned 1 of the goods for which Cited Mark 1 was used, they are found to be consumers of gummi candies including young people) as the one indicating the Goods (Plaintiff's Goods) related to the business of the Plaintiff or the manufacturer of the Plaintiff's Goods by the Date of Decision (February 22, 2022) at the latest.

B. The Defendant asserts that Cited Mark 1 had not been used as the trademark, but according to the aforementioned 1(13), (15), (16), and (25), the Plaintiff is found to have provided the information with the advertisement related to the Plaintiff's Goods as contents with Cited Mark 1 added by an electromagnetic method, the Defendant's assertion cannot be employed.

#### (2) Similarity between the Present Trademark and Cited Mark 1

As described in No. 2, 1(5), the Present Trademark is configured by indicating the characters of the "地球グミ (CHIKYU-GUMI)" in standard characters. On the other hand, as described in No. 2, 3(1)A(a), Cited Mark 1 is configured by writing the characters of the "地球グミ (CHIKYU-GUMI)".

As described above, the Present Trademark and Cited Mark 1 are extremely ambiguous in their appearances.

Moreover, since the pronunciation of "Earth Gummi" is generated from both the Present Trademark and Cited Mark 1, they share the name.

Furthermore, in light of those taught in the aforementioned (1)A, the "地球グミ (CHIKYU-GUMI)" is considered to be recognized as a word referring to the Plaintiff's Goods among the consumers and thus, in addition to the conception such as "Gummi candy of the earth", the conception of the "Plaintiff's Goods" (Gummi candy with the goods name of "Trolli Planet Gummi", "Planet Gummi", and the like) can be generated from the Present Trademark and Cited Mark 1, and they have the same conception.

According to the above, the Present Trademark has the same pronunciation and conception as those of Cited Mark 1 and is extremely ambiguous in appearance and thus, it is reasonable to acknowledge to be a trademark similar to Cited Mark 1.

#### (3) Similarity of Goods

As described in the aforementioned No. 2, 1(6) and 3(1)A(b), the designated goods related to the Present Trademark and the goods in use related to Cited Mark 1 are both "Gummi candy" and thus, the designated goods of the Present Trademark are identical with the goods in use related to Cited Mark 1.

#### (4) Summary

As described above, the Present Trademark falls under the trademark listed in Article 4, paragraph (1), item (x) of the Trademark Act (there is no assertion verification (Article 4, paragraph (3) of the Trademark Act) that the Present Trademark did not fall under the trademark listed in the same item on the Date of Filing), and the determination in this JPO Decision different from that is erroneous, and Grounds for Rescission 1 is grounded.

### 3. Conclusion

As described above, even without determining on Grounds for Rescission 2, the Plaintiff's claims are grounded.

Intellectual Property High Court, Second Division

Presiding Judge: SHIMIZU Hibiku

Judge: ASAI Ken

Judge: KATSUMATA Kumiko