

Date	January 29, 1991	Court	Tokyo High Court
Case number	1990 (Gyo-Ke) 103		

– A case in which the court maintained the JPO decision that maintained the decision of refusal on the grounds that the trademark in the application concerned "ダイジェスティブ" designating the goods covered in Class 30 "Confectionery, bread" falls under a trademark related to the indication of quality (Article 3, paragraph (1), item (iii) of the Trademark Act) but does not fall under a trademark which has acquired a special distinctive feature as a result of use for a long period of time (Article 3, paragraph (2) of the Trademark Act), by finding that the findings and determinations made in the JPO decision contain no errors.

References: Article 3, paragraph (1), item (iii) and paragraph (2) of the Trademark Act

Number of related rights, etc.: Trademark Application No. 1974-114195, Trial No. 1979-3846

### Summary of the Judgment

1. The trademark in the application concerned ("Trademark") consists of a horizontally written Katakana characters "ダイジェスティブ," designating the goods covered in Class 30 "Confectionery, bread." In the trial decision, the JPO maintained the decision of refusal by finding that the Trademark falls under a trademark related to the indication of quality (Article 3, paragraph (1), item (iii) of the Trademark Act) but does not fall under a trademark which has acquired a special distinctive feature as a result of use for a long period of time (Article 3, paragraph (2) of the Trademark Act).

In this judgment, the court made the following findings and determinations and dismissed the plaintiff's claims by holding that there are no errors in the JPO decision.

2. The Trademark can be recognized by consumers as an indication of the sound of the English word "digestive" in katakana characters and Chinese-style reading. In addition, the following facts are recognized: [i] the English word "digestive" means "relating to digestion; having the digestive ability" as an adjective; and [ii] the word meaning "digesting" is the verb "digest," and the word meaning "easy to digest" is the adjective "digestible," and out of those words, "digest" and "digestive" are deemed to be high-school-level words. Taking into account said facts and the recent conditions of dissemination of English in Japan (including the time when the JPO decision was rendered), it is not difficult to presumptively recognize that the English word "digestive" can be understood by consumers at least as an adjective relating to "digestion." The designated goods pertaining to the Trademark are "confectionery and

bread" in Class 30, which are provided for general consumers' daily use as mentioned above, and are not pharmaceutical healthy food. Taking this into account, it is reasonable to find that when the Trademark is used in connection with its designated goods, many consumers who see the Trademark very naturally and instinctively conclude that the "confectionery and bread" have the quality of being easy to digest or of being digestible. In addition, the Trademark consists of the characters "ダイジェステイブ" written plainly and that its appearance, etc. has no especially distinctive feature.

As such, the Trademark falls under "a trademark that consists solely of a mark indicating, in a common manner, the quality of goods," as mentioned in Article 3, paragraph (1), item (iii) of the Trademark Act.

3. It is reasonable to understand that a trademark is registrable pursuant to the provisions of Article 3, paragraph (2) of the Trademark Act only where the trademark comes to fulfill the requirements prescribed in said paragraph in relation to specific goods and designates said specific goods as its designated goods. In addition, if designated goods pertaining to a trademark in an application include goods that are not registrable due to a failure to fulfill the requirements set forth in said paragraph, the application as a whole should be considered to be unregistrable unless the relevant goods are deleted from the designated goods through amendment or other procedures. The application for trademark registration of the Trademark was filed designating all goods included in "confectionery and bread" in Class 30 as designated goods. Therefore, even if the Trademark is recognized among consumers as a sign that distinguishes biscuits pertaining to the plaintiff's business, as alleged by the plaintiff, the Trademark should be considered not to be registrable in relation to all of the designated goods in the end as long as it is obvious that biscuits are only part of the designated goods pertaining to the Trademark.

Judgment rendered on January 29, 1991

1990 (Gyo-Ke) 103

Plaintiff: United Biscuits (UK) Limited

Defendant: UEMATSU Satoshi, Commissioner of the JPO

#### Main Text

The plaintiff's claim shall be dismissed.

The plaintiff shall bear the court costs.

The additional period for filing the final appeal against this judgment shall be 90 days.

#### Facts

No. 1 Judicial decision sought by the parties

##### I. Plaintiff

Judgment to the effect that "The JPO decision rendered regarding Trial No. 1979-3846 on November 24, 1989 shall be rescinded. The defendant shall bear the court costs."

##### II. Defendant

Judgment to the same effect as paragraphs 1 and 2 of the main text of this judgment.

No. 2 Statement of claim

##### I. JPO proceedings

Applicant: Meiji Seika Kabushiki Kaisha (incidentally, the plaintiff was assigned the right pertaining to the application on March 31, 1977, and completed the notification thereof to the defendant on July 31 of the same year)

Application date: August 27, 1974 (Application for Trademark Registration No. 1974-114195)

Constitution of the trademark pertaining to the application (the trademark in question; the "Trademark"): A trademark consisting of horizontally written katakana characters "ダイジエスティブ"

Designated goods: "Confectionery and bread" in Class 30 of the classification of goods prescribed in the Order for Enforcement of the Trademark Act (hereinafter simply referred to as "Class 30")

Examiner's decision of refusal: January 19, 1979

Request for a trial: April 16, 1979 (Trial No. 1979-3846)

JPO decision dismissing the request for a trial: November 24, 1989

##### II. Essential points of the reasons for the JPO decision

1. The constitution, designated goods, application date, etc. of the Trademark are as described in the preceding paragraph.

2. The Trademark consists of characters "ダイジエスティブ" written plainly. Said characters can be found to be easily recognized as the English word "digestive," which means "can be

digested; having the digestion ability," from the fact that there is an actual example of using said characters by affixing them to goods with said English word. The demandant (plaintiff) alleges as follows: Although said characters mean "having the digestion ability," they do not mean "digestible"; therefore, the characters are not used as a quality indication of food; inclusion of wheat germ enhances the nutritional value, but it is not a fact that it especially has the effect of making food easy to digest; therefore, the Trademark does not fall under Article 3, paragraph (1), item (iii) of the Trademark Act; the well-knownness of the Trademark as a trademark was established as a result of the user's having used it in relation to biscuits in Japan continuously for 15 years and having widely conducted promotional and advertising activities; consequently, the Trademark should be registered as a trademark that has a distinctiveness as a result of use.

3. Considering whether the Trademark functions to distinguish the plaintiff's own goods and other persons' goods, the fact can be found that the characters "ダイジェステイブ" have been used by the affiliate company of the demandant since 1973. However, the word "ダイジェステイブ" leads to the sound of the English word "digestive," which means "can be digested; having the digestion ability," etc. Therefore, when the characters are used in connection with the designated goods (food), they can give general consumers the impression that the goods to which the characters are affixed are digestible food. Though there is a difference between the verb "digest" and the adjective "digestive," these words have a commonality in the part of word, "digest," which can be recognized as the root of these words. Therefore, setting aside the difference in the strict meaning of these words, it must be said that affixing characters that relate to "digestion" of food to food is sufficiently likely to be understood as indicating the quality of the goods. Therefore, it is reasonable to determine that the Trademark cannot function to distinguish the plaintiff's goods and other persons' goods if it is used in connection with the designated goods.

4. Next, considering whether the Trademark is one that has come to function to distinguish the plaintiff's goods and other persons' goods as a result of its use, the following facts can only be found based on the submitted evidence: [i] the affiliate company of the demandant started using the characters "ダイジェステイブ" in connection with biscuits in Japan around August 1973; and [ii] the Trademark consists of the characters "ダイジェステイブビスケット," used as an indication of the sound of the characters "digestiveBiscuits," which are written on the packaging for the goods as an indication of the content. No evidence has been submitted to prove the fact that the characters "ダイジェステイブ," which constitute the Trademark, are used in connection with all of the designated goods, "confectionery and bread," by prominently indicating them, and the specific fact that the plaintiff widely conducted promotional and advertising activities by affixing said characters to said goods. Rather, it is possible to see the fact that a confectionary company other than the demandant uses said characters by prominently

indicating them on its goods, biscuits. In that case, the following allegation of the demandant is unacceptable: The Trademark has come to be able to function to distinguish the plaintiff's goods and other persons' goods as a result of its use because the holder of the right to use the Trademark has widely promoted and advertised the Trademark in connection with the designated goods in Japan for a long period of time.

5. Consequently, the Trademark falls under the provisions of Article 3, paragraph (1), item (iii) of the Trademark Act, and is thus unregistrable.

### III. Grounds for rescission of the JPO decision

The Trademark does not fall under the provisions of Article 3, paragraph (1), item (iii) of the Trademark Act (Ground for Rescission (1)). Even otherwise, the Trademark should be registered pursuant to the provisions of paragraph (2) of said Article (Ground for Rescission (2)). The JPO erred in its determinations concerning these points.

(omitted)

### Reasons

I. The parties agree on I. and II. (JPO proceedings and essential points of the reasons for the JPO decision) in the Statement of Claim.

II. Determinations concerning the grounds for rescission of the JPO decision

#### 1. Regarding Ground for Rescission (1)

The parties agree that the Trademark consists of the horizontally written katakana characters "ダイジェスティブ" and that the designated goods pertaining to the Trademark are "confectionery and bread" in Class 30. Also taking into account <evidence redacted>, it is obvious that the Trademark can be recognized by consumers (including traders; the same shall apply hereinafter) as an indication of the sound of the English word "digestive" in katakana characters. In addition, according to <evidence redacted>, the following facts are recognized: [i] the English word "digestive" means "relating to digestion; having the digestive ability" as an adjective; and [ii] the word meaning "digesting" is the verb "digest," and the word meaning "easy to digest" is the adjective "digestible," and out of those words, "digest" and "digestive" are deemed to be high-school-level words. Taking into account said facts and the recent conditions of dissemination of English in Japan (including the time when the JPO decision was rendered), it is not difficult to presumptively recognize that the English word "digestive" can be understood by consumers at least as an adjective relating to "digestion." The designated goods pertaining to the Trademark are "confectionery and bread" in Class 30, which are provided for general consumers' daily use as mentioned above, and are not pharmaceutical healthy food. Taking this into account, it is reasonable to find that when the Trademark is used in connection with its

designated goods, many consumers who see the Trademark very naturally and instinctively conclude that the "confectionery and bread" have the quality of being easy to digest or of being digestible. In addition, as long as it is obvious in light of the aforementioned constitution of the Trademark, on which the parties agree, that the Trademark consists of the characters "ダイジェステイブ" written plainly and that its appearance, etc. has no especially distinctive feature, as pointed out in the JPO decision, the Trademark should be considered to fall under "trademark that consists solely of a mark indicating, in a common manner, the quality of goods," as mentioned in Article 3, paragraph (1), item (iii) of the Trademark Act.

In this regard, the plaintiff alleges as follows: As the English word "digestive" only means "relating to digestion; having the digestion ability" and does not mean "being easy to digest," the Trademark cannot be one "indicating, in a common manner, the quality of" confectionery and bread, which are the designated goods. However, regarding a trademark that can be recognized as indicating a foreign word in katakana characters, like the Trademark, whether the trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act should be determined based not on the strict meaning of the foreign word but rather on the point of how Japanese consumers understand the foreign word in relation to the goods for which it is used. Although the accurate meaning of the English word "digestive" is "relating to digestion; having the digestion ability" and a word meaning "being easy to digest" is "digestible" as found above, it is hardly considered to be ordinary that the words "digestive" and "digestible," which are adjectives that are derived from the verb "digest," meaning "digesting," and have a common root, are understood in a distinguished manner based on the recognition of the difference between their accurate meanings, taking into account that most consumers of "confectionery and bread" in Class 30, which are the designated goods pertaining to the Trademark, are considered to be general consumers in Japan. Rather, as the English word "digestive" is an adjective relating to "digestion" as with "digestible," it is considered general knowledge that the word means "being easy to digest" or "being digestible" in relation to the designated goods, as found above, without regard to its accurate meaning. Even in light of all evidence in this case, there is no evidence sufficient to reverse the finding and determination above. As long as the appearance, etc. of the Trademark has no especially distinctive feature as found above, the aforementioned allegation of the plaintiff is unacceptable. In addition, the plaintiff alleges as follows: The Trademark is an indication of the word "DIGESTIVE," which has become commonly-used in Japan as a proper noun, etc. indicating the biscuits of McVitie (this is understood as meaning biscuits created by McVitie & Price, Ltd.), in katakana characters, and it was selected irrespective of the adjective "digestive," which is a word derived from the verb "digest" meaning "digesting." However, whether a trademark pertaining to an application falls under a trademark pertaining to an indication of quality should be determined based on the way that the

trademark is understood by consumers, and it should not be determined based on the way that the applicant originally selected the trademark. In addition, there is no sufficient evidence to find that the word "DIGESTIVE" has lost its original meaning as an English word and has become commonly-used only as a proper noun indicating biscuits among general consumers in Japan, as alleged by the plaintiff. Even if it is not a fact that the word "ダイジェステイブ" is generally used as an indication of quality of food in Japan, as alleged by the plaintiff, it is not immediately possible to affirmatively recognize the aforementioned fact. Therefore, the allegation of the plaintiff in this regard is also unacceptable.

In that case, the JPO decision is justifiable and contains no error in terms of its determination that the Trademark falls under Article 3, paragraph (1), item (iii) of the Trademark Act. There is no reason for Ground for Rescission (1) alleged by the plaintiff.

## 2. Regarding Ground for Rescission (2)

It is reasonable to understand that a trademark is registrable pursuant to the provisions of Article 3, paragraph (2) of the Trademark Act only where the trademark comes to fulfill the requirement prescribed in said paragraph in relation to specific goods and designates said specific goods as its designated goods. In addition, if designated goods pertaining to a trademark pertaining to an application include goods that are not registrable due to a failure to fulfill the requirement set forth in said paragraph, the application as a whole should be considered to be unregistrable unless the relevant goods are deleted from the designated goods through amendment or other procedures. As indicated above, the application for trademark registration of the Trademark was filed designating all goods included in "confectionery and bread" in Class 30 as designated goods. Therefore, even if the Trademark is recognized among consumers as a sign that distinguishes biscuits pertaining to the plaintiff's business, as alleged by the plaintiff, the Trademark should be considered not to be registrable in relation to all of the designated goods in the end as long as it is obvious that biscuits are only part of the designated goods pertaining to the Trademark.

In this regard, the plaintiff alleges as follows: The goods that Meiji McVities Kabushiki Kaisha has sold by using the Trademark include various kinds of biscuits, such as those coated with chocolate and those using almond cream; some of them fall into the concept of cookies or chocolate confectionery, etc.; in addition, in the United Kingdom, "biscuit" is a concept that also refers to "scone," which is a kind of pancake; therefore, the goods called "biscuits," which said company has sold by using the Trademark, refer to "confectionery and bread" in general. However, as it is obvious that the concept of "biscuit" in the United Kingdom differs from the concept thereof in Japan, it is not directly related to the determination concerning whether the Trademark fulfills the requirement prescribed in Article 3, paragraph (2) of the Trademark Act. Moreover, even if some of the goods called "biscuits," which Meiji McVities Kabushiki Kaisha

has sold by using the Trademark, accurately fall into the concept of cookies, etc., there is no reason to consider them to refer to "confectionery and bread" in general. At any rate, there is no other choice but to say that there is no change to the point that "biscuits" are only part of the designated goods. Therefore, it is obvious that the point alleged by the plaintiff also does not affect the aforementioned determination.

In that case, the JPO decision is justifiable and contains no error in terms of its determination that the Trademark is also not registrable even pursuant to the provisions of Article 3, paragraph (2) of the Trademark Act. Therefore, there is also no reason for Ground for Rescission (2).

III. As mentioned above, there is no reason for all of the grounds for rescission alleged by the plaintiff. In addition, even based on all evidence in this case, there is no other illegal point on which the JPO decision should be rescinded. Consequently, the plaintiff's claim in the principal action shall be dismissed as an unreasonable one. With regard to the bearing of the court costs and the granting of the additional period for filing the final appeal, the judgment shall be rendered in the form of the main text by applying Article 7 of the Administrative Case Litigation Act and Article 89 and Article 158, paragraph (2) of the Code of Civil Procedure.

Tokyo High Court

Presiding judge: MATSUNO Yoshisada

Judge: FUNABASHI Sadayuki

Judge: ONO Yoichi