

Trademark Right	Date	July 20, 2021	Court	Intellectual Property High Court, Fourth Division
	Case number	2021 (Gyo-Ke) 10013		
<p>- A case in which, with regard to a trademark, which consists of the characters, "Lingua' Franca'," and patterns, registered for the designated services of "educational and instruction services relating to language," etc., the court dismissed a claim to seek rescission of the trial decision that rescinded the trademark registration based on Article 50, paragraph (1) of the Trademark Act.</p>				

Case type: Rescission of Trial Decision of Rescission

Conclusion: Dismissed (JPO decision upheld)

References: Article 2 and Article 50, paragraph (1) of the Trademark Act

Related rights, etc.: Registration No. 5488946

Trial decision: Rescission 2019-300171

Summary of the Judgment

1. This is a case seeking rescission of the trial decision rendered by the JPO that rescinded the registration of the following trademark, which consists of the characters, "Lingua' Franca'," and patterns, with regard to part of its designated services (hereinafter referred to as the "Designated Services"), based on Article 50, paragraph (1) of the Trademark Act.

[Trademark]



Lingua' Franca'

2. The major issues in this case are as follows: [i] whether the SNS services (hereinafter referred to as the "Services") to enable members to transfer and exchange information by using a type of international English called Globish were provided during the period for which proof is required, and if they were provided, whether it is possible to say that the use of the Trademark in the Services falls under the use of the registered trademark in connection with the services of "educational and instruction services relating to

language," etc.; and [ii] whether the videos (Videos [i] through [iv]) related to advertisements and publication, etc. of the business of Lingua' Franca' (a dissolved company which is the former trademark holder of the Trademark Right) were made available to the public during the period for which proof is required, and if they were made available to the public, whether it is possible to say that the use of the Trademark in those Videos falls under the use of the registered trademark in connection with the services of "educational and instruction services relating to language," etc.

3. In this judgment, the court determined that the fact cannot be found that the Services were provided during the period for which proof is required, but determined that the fact can be found that the Videos were made available to the public during the period for which proof is required, and then held as outlined below. In conclusion, the court dismissed the Plaintiff's claim on the grounds that the use of the registered trademark in connection with the services of "educational and instruction services relating to language," etc. cannot be found.

(1) Even if the Trademark is indicated on the member authentication page related to the Services during the period for which proof is required, it cannot be said that the Trademark is used for the services included in the range of the Designated Services.

In other words, among the Designated Services, "educational and instruction services relating to language," "educational and instruction services relating to international cultures," or "provision of facilities for educational training" are services for educating people or developing their knowledge. However, the Services in question are those used for the transfer and exchange of information among members using SNS. The words that can be used for the services are limited to 1500 basic words of Globish and their derivatives, but in fact, the Services merely provide the opportunity for exchange among individuals. Therefore, it cannot be said that the Services play a central role in educational and instruction services, and educational training. Even if one's ability in Globish increases by using the Services, it is just a secondary action and effect.

As such, provision of the Services does not fall under any of the "educational and instruction services relating to language," "educational and instruction services relating to international cultures," or "provision of facilities for educational training."

(2) Provision of the Services does not fall under the services of "educational and instruction services relating to language," etc. Therefore, even if Videos [i] through [iv] introduce the Services, there is no room for them to be considered as "advertisements" related to the aforementioned designated services (Article 2, paragraph (3), item (viii) of the Trademark Act).

In addition, it cannot be said that a relationship with a specific service is clearly

defined in Videos [i] and [ii]. In this regard, it is difficult to say that they are "advertisements related to a service" (Article 2, paragraph (3), item (viii) of the Trademark Act). Therefore, it is not found that the use of the Trademark in Videos [i] and [ii] falls under the "use" provided for by Article 2, paragraph (3) of the Trademark Act.

Furthermore, Videos [iii] and [iv] introduce the services of the dissolved company. However, the dissolved company discontinued the services, and the Plaintiff did not succeed to the operation of the services. Therefore, Videos [iii] and [iv] are not used for the services that are performed on a regular basis and it cannot be construed that the Trademark is used as a trademark.

Judgment rendered on July 20, 2021

2021 (Gyo-Ke) 10013, Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: May 27, 2021

Judgment

Plaintiff: Triumph Corporation Ltd.

Defendant: Y

Main text

1. The claim of the Plaintiff shall be dismissed.
2. The Plaintiff shall bear the court costs.

Facts and reasons

No. 1 Claim

The decision made by the Japan Patent Office (JPO) on December 18, 2020, concerning Rescission 2019-300171 shall be rescinded.

No. 2 Outline of the Case

This is a case seeking rescission of the trial decision rendered by the JPO that rescinded a trademark registration.

1. Outline of procedures at the JPO (There are no disputes between the parties.)

(1) The Plaintiff filed a registration application for the trademark indicated in the Attachment (hereinafter referred to as the "Trademark") on August 9, 2011, and obtained registration for establishment on April 27, 2012 (Registration No. 5488946) (hereinafter the trademark right related to the Trademark is referred to as the "Trademark Right").

(2) On March 4, 2019, the Defendant filed an action to seek rescission of a registered trademark not in use against 'Lingua' Franca' (7-3-4, Nishi-shinjuku, Shinjuku-ku, Tokyo; hereinafter referred to as "Lingua' Franca"), which was the holder of the Trademark Right, as a demandee, with regard to Class 41 "educational and instruction services related to language, educational and instruction services related to international cultures, education or training for the development of teachers involved in language training, organization of courses, seminars, and meetings related to language or international exchange, publication of books, services of reference libraries for literature and documentary records, production of radio or television programs, provision of facilities for educational training, language interpretation, and translation" (hereinafter referred to as the "Designated Services") among the designated goods of the Trademark.

(3) On March 18, 2019, the request for the trial related to this case was registered and the

period from March 18, 2016 through March 17, 2019 fell under the period of "within three years prior to the registration of the request for the trial" (hereinafter referred to as the "Period for Which Proof is Required") as provided for by Article 50, paragraph (2) of the Trademark Act.

(4) The JPO examined the aforementioned request for the trial as Rescission 2019-300171; the transfer of the Trademark Right was registered on October 9, 2019, based on the specified succession from Lingua' Franca' to the Plaintiff, which was accepted as of July 31, 2019; and since the Plaintiff became the holder of the trademark right of the Trademark, the trial procedures continued with the Plaintiff.

The JPO made the decision on December 18, 2020 that "the trademark registration for the Designated Services among the designated goods and designated services for Trademark Registration No. 5488946 shall be rescinded" (hereinafter referred to as the "JPO Decision") and a certified copy thereof was served to the Plaintiffs on December 28, 2020.

(5) The Plaintiff filed this lawsuit to seek rescission of the JPO Decision on January 26, 2021.

2. Summary of the grounds for the JPO Decision

The JPO Decision held that since it cannot be found that any of the holder of the trademark right, holder of an exclusive right to use, or holder of a non-exclusive right to use is proved to have used the Trademark in connection with the Designated Services in Japan during the Period for Which Proof is Required, as described below, the registration of the Trademark should be rescinded.

(1) A trademark that is considered to be identical to the Trademark in light of socially accepted conventions is used in a press release made by the Plaintiff (Exhibit Ko 5), the website of the Plaintiff (Exhibit Ko 8), and videos that have been published on a delivery channel that is established on an open video website, "YouTube" (Exhibits Ko 11 through 14; hereinafter the delivery channel is referred to as the "Channel" and the videos published on the Channel are referred to as the "Videos") . However, the dates of use of the Trademark as indicated in evidence related to the above do not fall within the Period for Which Proof is Required.

(2) It is revealed that Lingua' Franca' started operation of social network services named "Globish Academy" in and around August 2012 (Exhibits Ko 5 and 8; hereinafter referred to as the "Services") and the Plaintiff succeeded to the operation; however, "operation of social network services" does not belong to the range of the Designated Services and it is not clear whether the Services were provided during the Period for Which Proof is Required.

(3) It is revealed that Lingua' Franca' conducted "the provision of a Globish learning program" and "the hosting of an international exchange event" in and around August 2012 and that it distributed videos by indicating a trademark identical to the Trademark in light of socially accepted conventions in and around March 2013; however, it cannot be found that these actions were conducted during the Period for Which Proof is Required.

(omitted)

No. 4 Judgment of this court

1. Facts found in this case

The facts that are found based on the evidence shown below and the entire import of oral arguments are as stated below.

(1) A. The Plaintiff was established for the purpose of information technology business, education and culture business, etc. on October 19, 1999 (Exhibit Ko 2).

B. On May 13, 2019, a wholly owned subsidiary of the Plaintiff, Lingua' Franca' was established for the business of teaching and studying English and for the interpretation and translation business, etc. The representative *Q* of the Plaintiff served as its representative director (Exhibits Ko 1 and 3).

C. Lingua' Franca' provided the following services under the name of "Globish Learning Center" at the location of the headquarters: [i] service to provide members with opportunities to learn Globish using textbooks, etc. to members in classrooms; [ii] service to provide members with opportunities where staff members and several members hold discussions on a specific theme in Globish in classrooms; and [iii] service to provide members with opportunities for exchanges with foreign staff members through events (Exhibits Ko 22 through 24).

(2) On April 27, 2012, the establishment of the Trademark was registered with Lingua' Franca' as the holder of the trademark right (Exhibits Ko 31 and 32).

(3) On August 8, 2012, Lingua' Franca' started to provide the Services in lieu of services of a Globish learning program, etc. as indicated in (1) C. [i] through [iii] above (Exhibits Ko 4, 5, 8, 15, and 28). The Services are provision of a community site for Globish learners and journal functions, etc. to issue information by using only 1500 basic Globish words and their derivatives (Exhibits Ko 5 and 27).

(4) A. On March 9, 2013, Lingua' Franca' established the Channel (Exhibits Ko 10 and 17). The Trademark was indicated on the Channel where a video was posted (Exhibits Ko 10, 11, and 18; hereinafter the video is referred to as "Video [i]") on that day and there were 10 subscribers to the Channel (Exhibit Ko 10). In addition, Video [i] recorded an

interview of *R*, who wrote a joint book with *P*, who is an advocate of Globish. The Video [i] is about the introduction of Globish and guidance of its study and the Globish Learning Center, the Services, and other information are introduced at the end. The Trademark is indicated at the beginning of the video (Exhibits Ko 11 and 18).

B. On March 12, 2013, Lingua' Franca' posted another video on the Channel (Exhibits Ko 10 and 12; hereinafter the video is referred to as "Video [ii]"). Video [ii] recorded a message from *P*. It is about the introduction of Globish and guidance of its study and the Globish Learning Center, the Services, and other information are introduced at the end. The Trademark is indicated at the beginning of the video (Exhibits Ko 12 and 19).

C. On March 14, 2013, Lingua' Franca' posted another video (Exhibits Ko 10 and 13; hereinafter the video is referred to as "Video [iii]"). Video [iii] is an explanation of the services provided by Lingua' Franca' as indicated in (1) C. [ii] above and the Globish Learning Center, the Services, and other information are introduced at the end. The Trademark is indicated at the beginning of the video (Exhibits Ko 13 and 20).

D. On July 9, 2013, Lingua' Franca' posted another video (Exhibits Ko 10 and 14; hereinafter the video is referred to as "Video [iv]"). Video [iv] is an explanation of services provided by Lingua' Franca' as indicated in (1) C. [iii] above and the Trademark is indicated at the beginning of the video (Exhibits Ko 14 and 21).

(5) On July 1, 2013, Lingua' Franca' wholly renewed the Conversation function of the Services, where information is exchanged with other users using only 1500 basic Globish words and their derivatives (Exhibit Ko 25).

(6) On September 30, 2013, Lingua' Franca' closed the Globish Learning Center and came to resume the Services only from October 1, 2013 (Exhibit Ko 28).

(7) On February 16, 2015, Lingua' Franca' dissolved by the resolution of a shareholders meeting (Exhibit Ko 1) and the representative of the Plaintiff *Q* served as representative liquidator (Exhibit Ko 1). It was determined that the Plaintiff was continuing to provide the Services as "CSR activities" (Exhibit Ko 9) and all remaining properties of Lingua' Franca', including current assets of approximately 11 million yen in savings, the Trademark Right, web domain related to the Services, and other assets, were distributed to the Plaintiff (Exhibit Ko 3). On May 29, 2015, liquidation of Lingua' Franca' was completed (Exhibit Ko 1).

(8) As of April 16, 2019, a trademark identical to the Trademark is indicated on the member authentication page related to the Services (Exhibit Ko 8). In addition, as of the same date, it can be confirmed that there were postings by one member two years ago, four members three years ago, and one member four years ago from said date (Exhibit Ko 4).

(9) The transfer of the Trademark Right by the specified succession from Lingua' Franca' to the Plaintiff, which was accepted as of July 31, 2019, was registered on October 9, 2019; and the Plaintiff became the holder of a trademark right of the Trademark on said date (No. 2, 1. (4) above).

2. Review

(1) Use of the trademark

In consideration of the characteristics of this case, whether the Trademark is used or not is reviewed and determined first. The Trademark Act stipulates in Article 50 that unless a holder of the trademark right proves that any of "the holders of trademark rights, exclusive rights to use or non-exclusive rights to use" have "used" the registered trademark "in Japan" in connection with any of "the designated services pertaining to the request of a trial for rescission of the registered trademark not in use," the trademark registrations in connection with the relevant designated services are rescinded, and stipulates in Article 2 that a trademark is used "as its business" and "use" thereof is limited to those listed in the items of paragraph (3) of that Article.

Therefore, in this case, the Plaintiff, who is a holder of trademark right, is required to prove that the Trademark in the Services or the Channel is used by the Plaintiff or Lingua' Franca' in Japan in connection with the Designated Services as a mark related to their businesses in the form listed in the items of paragraph (3) of that Article.

(2) Use of the Trademark in the Services

A. As indicated in 1. (8) above, a trademark identical to the Trademark was indicated on the member authentication page related to the Services (Exhibit Ko 8) and, as indicated in 1. (1), C. and (3) above, it is obvious that Japanese nationals in Japan are also targeted by the Services. Therefore, it can be said that the Trademark is used in Japan.

However, the aforementioned page is merely a copy printed out on April 16, 2019, which is after the request for the trial in question was filed and after the Period for Which Proof is Required had elapsed, and therefore it does not immediately show that the Trademark was indicated on said page during the Period for Which Proof is Required; also, as it is easy to change display of one's own website, it is impossible to presume based on this evidence alone that the Trademark was indicated during the Period for Which Proof is Required.

Consequently, it should be said that there is not enough evidence to presume that the Trademark is used in the Services during the Period for Which Proof is Required.

B. Even if the Trademark is indicated on the member authentication page related to the Services during the Period for Which Proof is Required, it cannot be said that the Trademark is used for the services included in the range of the Designated Services.

In other words, among the Designated Services, "educational and instruction services related to language," "educational and instruction services related to international cultures," or "provision of facilities for educational training" are services for educating people or developing their knowledge. The Services in question are those used for the transfer and exchange of information among members using SNS. The words that can be used are limited to 1500 basic words of Globish and their derivatives, but in fact, the Services merely provide the opportunity for exchange among individuals. Therefore, it cannot be said that the Services play a central role in educational and instruction services, and educational training. Even if one's ability in Globish increases by using the Services, it is just a secondary action and effect.

As such, provision of the Services does not fall under any of the "educational and instruction services related to language," "educational and instruction services related to international cultures," or "provision of facilities for educational training."

C. Therefore, without a need to make determinations on the remaining points, it cannot be found that the Trademark was used in the Services in connection with the aforementioned designated services during the Period for Which Proof is Required.

(3) Use of the Trademark in the Channel

A. As indicated in 1. (4) above, a trademark identical to the Trademark is used at the beginning of Videos [i] through [iv], which introduce the Services and the Globish Learning Center, and it is thus obvious that Japanese nationals in Japan are targeted. Therefore, it can be said that the relevant trademark is used in Japan.

In addition, as indicated in 1. (4) above, dates when Videos [i] through [iv] were posted fall within the period from March 9 until July 9, 2013, which is before the start of the Period for Which Proof is Required. However, Videos [i] through [iv] were also viewable as of October 9, 2020, which is after the Period for Which Proof is Required had elapsed. There were 750 views of Video [i], 1125 views of Video [ii], 431 views of Video [iii], and 437 views of Video [iv] as of said date (Exhibit Ko 10). Therefore, it can be fully presumed that Videos [i] through [iv] were viewable during the Period for Which Proof is Required. Consequently, it is found that the Trademark was used on the Channel during the Period for Which Proof is Required (the Defendant alleged that the possibility that the Channel was closed during the Period for Which Proof is Required cannot be denied; however, there is no reason to suspect that the Channel was closed).

B. However, as ruled in (2) B. above, it should be said that the provision of the Services does not fall under any of the "educational and instruction services related to language," "educational and instruction services related to international cultures," or "education or training for the development of teachers involved in language education." Therefore, even

if Videos [i] through [iv] introduce the Services, there is no room for them to be considered as "advertisements" related to the aforementioned designated services (Article 2, paragraph (3), item (viii) of the Trademark Act).

In addition, Videos [i] and [ii] are identified as exclusively introducing Globish and it cannot be said that a relationship with a specific service is clearly defined. This also suggests that it is difficult to say that they are "advertisements related to a service" (Article 2, paragraph (3), item (viii) of the Trademark Act). Therefore, it is not found that the use of the Trademark in Videos [i] and [ii] falls under the "use" provided for by Article 2, paragraph (3) of the Trademark Act.

Furthermore, Video [iii] is identified to exclusively introduce services of Lingua' Franca' as indicated in 1. (1) C. [ii] above and Video [iv] is identified as exclusively introducing services as indicated in 1. (1) C. [iii] above respectively. As indicated in 1. (6) and (7) above, Lingua' Franca' discontinued both of the aforementioned services on September 30, 2013, which is before the Period for Which Proof is Required, and the Plaintiff did not succeed to the operation of these services. Therefore, even if Videos [iii] and [iv] are considered as "advertisements related to services" (Article 2, paragraph (3), item (viii) of the Trademark Act), the details are only related to services that are not provided as a business. Then, Videos [iii] and [iv] are not used for services that are provided as its business. Therefore, even if the Trademark is indicated in those videos, it cannot be construed that the Trademark is used as a trademark.

C. Based on the above, the use of the Videos [i] through [iv], which are videos published on the Channel, cannot be considered as the "use" as set forth in Article 2, paragraph (3) of the Trademark Act or the use as a trademark in any case.

(4) Summary

Based on the above, it cannot be found that the Trademark was used for services of "educational and instruction services related to language," "educational and instruction services related to international cultures," "provision of facilities for educational training," or "education or training for the development of teachers involved in language training," among the Designated Services, during the Period for Which Proof is Required. The Plaintiff did not concretely allege or prove that the Trademark was used for services except for the aforementioned services, among the Designated Services, during the Period for Which Proof is Required, and the use cannot be found based on the Evidence.

Therefore, it should be said that there is no evidence that the Trademark was used in connection with the Designated Services during the Period for Which Proof is Required, and that there are no errors in the judgment of the JPO Decision without a need to make determinations on points related to users of the Trademark.

3. Conclusion

Consequently, there are no grounds for the rescission and the Plaintiff's claim is dismissed and the judgment is rendered as indicated in the main text.

Intellectual Property High Court, Fourth Division

Presiding judge: KANNO Masayuki

Judge: MOTOYOSHI Hiroyuki

Judge: NAKAMURA Kyo

(Attachment)

Trademark



Lingua' Franca'

Registration number: Trademark Registration No. 5488946

Application date: August 9, 2011

Registration date: April 27, 2012

Classification of goods and services and designated goods or designated services

Class 9 "Electronic books; data media recorded with audio, music, image, and character information; data media recorded with computer program; other electronic machines, apparatus and their parts"

Class 16 "Books, dictionaries, encyclopedia, reference books, newspapers, magazines, printed matters for learning materials, other printed matters"

Class 35 "Advertising; issuing, balancing, and managing coupons or points for advertising and for promoting commercial sales or for promoting the provision of services or providing information related thereto; providing information concerning commercial sales; intermediation services for sales contracts for goods; referral of teachers or educational institutions involved in language education and providing information related thereto; business management analysis or business consultancy; marketing research; publicity material rental; rental of vending machines"

Class 41 "Educational and instruction services relating to language; educational and instruction services relating to international cultures; education or training for the development of teachers involved in language education; organization of courses, seminars, and meetings related to language and international exchange; publication of books; services of reference libraries for literature and documentary records; production of radio or television programs; provision of facilities for educational training; language interpretation; translation"