

Trademark Right	Date	August 30, 2021	Court	Intellectual Property High Court, First Division
	Case number	2020 (Gyo-Ke) 10126		

- If a sound that composes a trademark consisting of a sound is generally recognized as a sound that indicates the name of a person, the sound trademark cannot be registered as a trademark including "the name of another person" as set forth in Article 4, paragraph (1), item (viii) of the Trademark Act pursuant to said item, except for those sounds for which the registration has been approved by the person concerned. However, in light of the transaction status, if a person who comes across the sound trademark cannot be found to usually associate it with or recall the name of a person based on the sound that composes the sound trademark, it cannot be said that the sound is recognized as one that generally indicates the name of a person. Therefore, the sound trademark does not correspond to a trademark including "the name of another person" as set forth in said item.

- A case in which the court determined that a sound trademark consisting of a musical element written in a staff notation and the linguistic element of lyrics of "マツモトキヨシ" (Matsumotokiyoshi) indicated in katakana does not fall under a trademark including "the name of another person" as set forth in Article 4, paragraph (1), item (viii) of the Trademark Act.

Case type: Rescission of Appeal Decision of Refusal

Results: Granted

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

Related rights, etc.: Trademark Application No. 2017-007811

Decision of the JPO: Appeal against Examiner's Decision of Refusal No. 2018-8451 (Trademark for which registration is sought)



Summary of the Judgment

1. This is a case of a litigation seeking rescission of the decision made by the JPO (the "JPO Decision") concerning a trademark consisting of the aforementioned sound, for

which the Plaintiff filed an application for trademark registration but was refused, and an appeal filed by the Plaintiff was also dismissed.

2. In this judgment, the court held as outlined below and rescinded the JPO Decision on the grounds that there was an error in the decision as to whether the Trademark in the Application falls under Article 4, paragraph (1), item (viii) of the Trademark Act.

(1) The Trademark in the Application

A. A sound trademark is a trademark that is recognized by people's sense of hearing. In cases of obtaining a trademark registration for a sound trademark, that fact must be indicated in the application form, information necessary for identifying the sound for which trademark registration is sought by using letters or staff notation or their combination must be indicated in the "Trademark for which registration is sought" column in the application form, and materials that are specified by the Order of the Ministry of Economy, Trade and Industry ("sound file") must be attached. In cases of indicating a trademark in staff notation, the sound for which trademark registration is sought is to be identified by stating music notes, clefs, time signatures, and tempos or a linguistic element (if lyrics, etc. are included) and rest symbols as necessary in the "Trademark for which registration is sought" column.

B. The Trademark in the Application is a sound trademark consisting of a musical element stated in a staff notation and the linguistic element of lyrics of "マツモトキヨシ" (Matsumotokiyoshi) indicated in katakana. The sound consisting of a linguistic element in the composition of the Trademark in Application is pronounced as "matsumotokiyoshi." In addition, the sound that emits the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in a male voice with a musical element, such as a rhythm, melody, etc., is recorded in the sound file attached to the application form of the Application.

(2) Whether the Trademark in the Application falls under Article 4, paragraph (1), item (viii) of the Trademark Act

A. Article 4, paragraph (1), item (viii) of the Trademark Act stipulates that a trademark containing the portrait of another person, or the name of another person, or well-known abbreviation thereof, etc. may not be registered except for those for which the registration has been approved by the person concerned. The purport of this item is construed to protect the moral interest that a person's name, etc. shall not be used in a trademark without the approval of the person concerned.

In the light of the purport of said item, if the sound composing a sound trademark is generally recognized as indicating the name of a person, the sound trademark is construed as a trademark containing "the name of another person" and cannot be

registered pursuant to said item except for a sound for which the registration has been approved by the person concerned.

In addition, said item is a provision with the intention of balancing the interest of an applicant to receive a trademark registration and the moral interest related to the name, etc. of another person. Even if there is a person whose name is pronounced in the same way as the sound that composes a sound trademark, it cannot be construed that the provision stipulates to always prioritize the moral interest related to the name of another person even in cases where the sound is not generally recognized as one that indicates the name of a person.

Based on the above, even if there is a person with a name identical to the sound composing a sound trademark, if it cannot be found that a person who comes across the sound trademark associates it with or recalls the name of a specific person based on the sound composing the sound trademark, in light of the transaction status, at the time of the application for trademark registration, it cannot be said that the sound is generally recognized as one indicating the name of a person. Therefore, it should be said that it cannot be recognized that the sound trademark falls under the category of a trademark containing "the name of another person" as set forth in said item.

B. According to the facts found in this case related to the business development of the drugstore "Matsumotokiyoshi," the registered trademark of the Plaintiff and the use thereof, TV commercials, etc., it is found, as the transaction status related to the Trademark in the Application, at the time of the application for the Trademark in the Application (application date: January 30, 2017), that the indication "マツモトキヨシ" (Matsumotokiyoshi) was famous throughout Japan as one indicating the name of the drugstore "Matsumotokiyoshi," Matsumotokiyoshi Co., Ltd., the Plaintiff, or group companies of the Plaintiff and that a sound identical to or similar to the Trademark in the Application containing the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) was widely known as an advertisement (a phrase in a commercial song) of the drugstore "Matsumotokiyoshi," as a result of being used in TV commercials and in each retail store of the drugstore "Matsumotokiyoshi."

Under the aforementioned transaction status, at the time of the application for registration of the Trademark in the Application (application date: January 30, 2017), it was usually the name of the drugstore "Matsumotokiyoshi" and the company name of Matsumotokiyoshi Co., Ltd., the Plaintiff, or group companies of the Plaintiff that a person who came across the Trademark in the Application associated it with or recalled from the sound containing the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in the composition of the Trademark in the Application. Ordinarily,

it cannot be found that the sound was associated with or reminded of the name "松本清," "松本潔," "松本清司," etc. that can be read as "matsumoto kiyoshi." Therefore, it cannot be said that the sound was recognized as one generally indicating the name of a person. Consequently, it should be said that the Trademark in the Application cannot be found to fall under a trademark containing "the name of another person" as set forth in Article 4, paragraph (1), item (viii) of the Trademark Act.

Judgment rendered on August 30, 2021

2020 (Gyo-Ke) 10126, Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: August 16, 2021

Judgment

Plaintiff: Matsumotokiyoshi Holdings, Co., Ltd.

Defendant: Commissioner of the Japan Patent Office

Main text

1. The decision made by the Japan Patent Office (JPO) on September 9, 2020, concerning the case of Appeal against Examiner's Decision of Refusal No. 2018-8451 shall be rescinded.
2. The Defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

Same as paragraph 1 of the main text.

No. 2 Outline of the case

1. Outline of procedures at the JPO

(1) On January 30, 2017, concerning a trademark consisting of a sound as stated in 1. of the Attachment (hereinafter referred to as the "Trademark in the Application"), the Plaintiff filed an application for trademark registration (Trademark Application No. 2017-007811; hereinafter referred to as the "Application") for the services stated in the application belonging to Class 35 and Class 44 as designated services (Exhibit Ko 20).

The Plaintiff received a notice of grounds for refusal dated September 20, 2017, (Exhibit Otsu 1) and then made an amendment dated December 1, 2017, to amend the designated services in the Application to the services stated in 2. of the Attachment (Exhibit Ko 21).

(2) The Application was refused dated March 16, 2018, (Exhibit Ko 22), and therefore, the Plaintiff filed an appeal against the examiner's decision of refusal on June 20, 2018 (Exhibit Otsu 3).

The JPO examined the appeal as a case of Appeal against Examiner's Decision of Refusal No. 2018-8451 and made the decision that "the examiner's decision of refusal

is maintained" (hereinafter referred to as the "JPO Decision") on September 9, 2020. A certified copy of the decision was delivered to the Plaintiff on the 29th of the same month.

(3) The Plaintiff filed this lawsuit to seek rescission of the JPO Decision on October 28, 2020.

2. Summary of the grounds for the JPO Decision

Grounds for the JPO Decision are as stated in the Attachment: Decision Form (copy).

The summary of the grounds are as follows: [i] As stated in 1. of the Attachment, the Trademark in the Application is a sound trademark ("a trademark consisting of a sound"; the same applies hereinafter) consisting of a musical element and a linguistic element "マツモトキヨシ" (Matsumotokiyoshi) and, based on the fact that a number of persons' names composed of the last name pronounced as "matsumoto" and the first name pronounced as "kiyoshi" are posted on websites and included in "Hello Pages," phone books issued by NTT East and West Japan, the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) that composes the Trademark in the Application is objectively identified as the name of a person pronounced as "matsumoto kiyoshi." Therefore, the Trademark in the Application is a trademark containing "the name" of another person. [ii] Persons with the name pronounced as "matsumoto kiyoshi" as indicated on the aforementioned websites and "Hello Pages" are found to be different from the Plaintiff (demandant); however, it is not found that the Plaintiff obtained approval from those persons. [iii] Consequently, the Trademark in the Application is a trademark containing "the name of another person" and it is not found that approval from the persons concerned have been obtained, and therefore, it falls under the case set forth in Article 4, paragraph (1), item (viii) of the Trademark Act and cannot be registered. [iv] Even if the Trademark in the Application is famous to an extent as the name indicating the abbreviation of the business name of the Plaintiff or its subsidiary companies and the name of drugstores, supermarkets, and do-it-yourself stores carried out by the subsidiary companies, that fact does not have an impact on determining whether the Trademark in the Application falls under the provisions of said item.

3. Grounds for rescission

Error in the determination of whether the Trademark in the Application falls under Article 4, paragraph (1), item (viii) of the Trademark Act

(omitted)

No. 4 Judgment of this Court

1. The Trademark in the Application

(1) A sound trademark is a trademark that is recognized by people's sense of hearing (main sentence of Article 2, Paragraph (1) of the Trademark Act). In cases of obtaining a trademark registration for a sound trademark, that fact must be indicated in the application form (Article 5, paragraph (2), item (iv) of the Trademark Act), information necessary for identifying the sound for which trademark registration is sought by using letters or staff notation or their combination must be indicated in the "Trademark for which registration is sought" column in the application form (Article 4-5 of the Regulations for Enforcement of the Trademark Act), and materials that are specified by the Order of the Ministry of Economy, Trade and Industry ("sound file") must be attached (Article 5, paragraphs (4) and (5) of the Trademark Act; Article 4-8, paragraph (1), item (v), paragraph (2), item (v), and paragraph (3) of the Regulations for Enforcement of the Trademark Act).

In cases of indicating a trademark in a staff notation, the sound for which trademark registration is sought is to be identified by stating music notes, clefs, time signatures, and tempos or a linguistic element (if lyrics, etc. are included) and rest symbols as necessary in the "Trademark for which registration is sought" column (reference: 55.02-1 of the Trademark Examination Manual).

(2) The Trademark in the Application is a sound trademark consisting of a musical element stated in a staff notation and the linguistic element of lyrics of "マツモトキヨシ" (Matsumotokiyoshi) indicated in katakana as stated in 1. of the Attachment. The sound consisting of a linguistic element in the composition of the Trademark in the Application is pronounced as "matsumotokiyoshi."

In addition, the sound that emits the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in a male voice with a musical element, such as a rhythm, melody, etc., is recorded in the Sound File (Exhibit Ko 40) attached to the application form of the Application.

2. Facts found in this case

According to the evidence (Exhibits Ko 1 through 3, 5, 6, 9 through 19, 27 through 29, and 40 through 51, and Exhibit Otsu 2) and the entire import of oral arguments, the following facts are found.

(1) Business development, etc. of the drugstore "Matsumotokiyoshi"

A. In December 1932, A opened the pharmacy named "Matsumoto Pharmacy" in Matsudo City, Chiba. In April 1951, A changed the name of the pharmacy from "Matsumoto Pharmacy" to "Pharmacy Matsumotokiyoshi."

In January 1954, the aforementioned privately-run pharmacy was reorganized as a

private limited company and Drugstore Matsumotokiyoshi Incorporated was established.

In April 1975, Drugstore Matsumotokiyoshi Incorporated was reorganized as a stock company, Matsumotokiyoshi Co., Ltd.

B. In 1987, Matsumotokiyoshi Co., Ltd. changed its business form from a pharmacy to a "drugstore" with a wide range of products, including cosmetics, everyday sundries, etc., and started the expansion of stores of the drugstore "Matsumotokiyoshi" throughout Japan.

Furthermore, Matsumotokiyoshi Co., Ltd. expanded its business form to start operating suburban-type drugstores by opening the first store of that type in Kashiwa City, Chiba, in 1994. Sales of the drugstore "Matsumotokiyoshi" marked 101.778 billion yen in the fiscal year that ended in March 1995 (the first place in the drugstores) and the number of stores reached 216.

C. The Plaintiff was established on October 1, 2007, with the aim of supervising and managing the business activities of companies, etc. engaging in the businesses of Matsumotokiyoshi Co., Ltd. etc. by holding their shares.

Since January 2008, the Plaintiff has succeeded to the business of managing subsidiary companies of Matsumotokiyoshi Co., Ltd., which is the Plaintiff's subsidiary company, through a company split, and has merged with other companies by absorption. As of March 31, 2017, the Plaintiff has formed a corporate group (group companies of the Plaintiff) consisting of 14 consolidated subsidiary companies and one affiliated company (Exhibit Ko 1) and, subsequently, as of March 31, 2020, the number of the Plaintiff's group companies reached 17 in total (Exhibit Ko 27).

The number of stores of the drugstore "Matsumotokiyoshi" that the Plaintiff or Matsumotokiyoshi Co., Ltd. operated was 1,555 in 45 prefectures in Japan as of March 31, 2017 (Exhibit Ko 3), and it increased to 1,726 in 47 prefectures in Japan as of June 30, 2020 (Exhibit Ko 45). In addition, the number of members who have a member's card (point card) of the Plaintiff's group companies reached approximately 24.4 million as of March 31, 2017 (Exhibit Ko 3), and it increased to approximately 29.0 million as of March 31, 2020 (Exhibit Ko 45).

D. According to "Best Japan Brands," which is a Japanese brand appraisal ranking by the branding company Interbrand (Exhibits Ko 5, and 46 through 51), "Matsumotokiyoshi" ranked as the number one "brand" as a drugstore in Japan from fiscal year 2016 through fiscal year 2021.

(2) Registered trademark of the Plaintiff and its use, etc.

The Plaintiff or Matsumotokiyoshi Co., Ltd. filed 35 trademark registrations

concerning a trademark of "マツモトキヨシ" (Matsumotokiyoshi) in katakana, a trademark of "MatsumotoKiyoshi" in alphabet, and trademarks including these characters in their composition for the period from 1989 through 2013 and all of them were registered (Exhibits Ko 6, and 9 through 19).

These registered trademarks have been used continuously on signs and in stores of the drugstore "Matsumotokiyoshi," on the Plaintiff's website, online store, etc. (Exhibits Ko 3, 27 through 29, and 45, and Exhibit Otsu 2).

(3) TV commercial status, etc.

Matsumotokiyoshi, Co., Ltd. began TV commercials for the drugstore "Matsumotokiyoshi" in 1996.

In each TV commercial, the characters of "マツモトキヨシ" (Matsumotokiyoshi) (logo of "マツモトキヨシ" in the form of registered trademark in Exhibits Ko 9 and 15) are written with the characters of "ドラッグストア" (drugstore) and the opening of new stores, goods sold at low prices, and other information were advertised.

In addition, in each TV commercial, in principle, a skit was performed by one or multiple actors that reminds us of the drugstore "Matsumotokiyoshi," and commercial songs with lyrics that contain sounds that are the same as or similar to the Trademark in the Application were played.

For example, in the TV commercials titled "Pretty woman" recorded on September 17, 1997, and "No life no Matsukiyo, student version" and "adult version" recorded on March 23, 1998, a sound that is the same as or similar to the Trademark in the Application was played in a female voice. In addition, in the TV commercials titled "I go to Matsukiyo, male version" and "I go to Matsukiyo, female version" recorded on September 14 1998, and "Material Mami-chan" recorded on March 5, 1999, and "Matured Emi-chan" recorded on September 17, 1999, a sound that is the same as or similar to the Trademark in the Application was played in a male voice.

In the TV commercial titled "A couple" recorded on March 15, 2000, the opening of an Osaka Station store as a new store of the drugstore "Matsumotokiyoshi" was announced through a skit, and a sound that is the same as or similar to the Trademark in the Application was played in a female voice. The same sound was also played in the TV commercials titled "Opening" (Fukuoka Tenjin) recorded on July 19, 2001. In addition, in TV commercials titled "Fateful opening" (Hamamatsu) recorded on November 9, 2002, "Announcement of an opening" (Shinsaibashi store) and "Announcement of an opening sale" (Shinsaibashi store) recorded on November 23, 2002, "The youth" (Kitakyushu) recorded on April 11, 2003, and "Happy opening" (Fukuyama) recorded on April 12, 2003, a sound that is the same as or similar to the

Trademark in the Application was played in a male voice. In the TV commercial titled "A deer, father, and daughter" recorded on April 18, 2003, a sound that is the same as or similar to the Trademark in the Application was played in a chorus of multiple voices.

In the TV commercial titled "Speech and shopping" recorded on May 29, 2005, a sound that is the same as or similar to the Trademark in the Application was played in a female voice. In the TV commercial titled "Cold medicine series, Nagoriyuki" recorded on December 15, 2007, a sound that is the same as or similar to the Trademark in the Application was played in a female voice along with the display of the logo of "マツモトキヨシ" after an advertisement for a cold medicine with an image of a woman playing the guitar and singing in the background.

After these TV commercials were broadcast, a sound that is the same as or similar to the Trademark in the Application was played and used in retail stores of the drugstore "Matsumotokiyoshi."

3. Whether the Trademark in the Application falls under Article 4, paragraph (1), item (viii) of the Trademark Act

The Plaintiff alleged as follows: [i] At the time of filing an application for the Trademark in the Application, the sound consisting of the linguistic element, "Matsumotokiyoshi," in the composition of the Trademark in the Application usually and easily suggests and reminds of "Matsumotokiyoshi" as the name of a drugstore or Matsumotokiyoshi Co., Ltd. and Matsumotokiyoshi Holdings, Co., Ltd. (the Plaintiff) as a company name, but not the name of a person pronounced as "matsumotokiyoshi," and therefore, the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) that composes the Trademark in the Application is not identified objectively as the name of a person pronounced as "matsumoto kiyoshi"; and [ii] therefore, the Trademark in the Application cannot be said to be a trademark containing "the name of another person" and the determination of the JPO Decision to the effect the Trademark in the Application falls under Article 8, paragraph (1), item (viii) of the Trademark Act is incorrect. Therefore, this court makes the following judgment.

(1) Article 4, paragraph (1), item (viii) of the Trademark Act stipulates that a trademark containing the portrait of another person, or the name of another person, or well-known abbreviation thereof, etc. may not be registered except for those for which the registration has been approved by the person concerned. The purport of this item is construed to protect the moral interest that a person's name, etc. shall not be used in a trademark without the approval of the person concerned (see 2003 (Gyo-Hi) 265, the judgment of the Third Petty Bench of the Supreme Court of June 8, 2004, Saibanshu Minji No.214, at 373; 2004 (Gyo-Hi) 343, the judgment of the Second Petty Bench of

the Supreme Court of July 22, 2005, Saibanshu Minji No. 217, at 595).

In light of the purport of said item, if the sound composing a sound trademark is generally recognized as indicating the name of a person, the sound trademark is construed as a trademark containing "the name of another person" and cannot be registered pursuant to said item except for a sound for which the registration has been approved by the person concerned.

In addition, said item is a provision with the intention of balancing the interest of an applicant to receive a trademark registration and the moral interest related to the name, etc. of another person. Even if there is a person whose name is pronounced in the same way as the sound that composes a sound trademark, it cannot be construed that the provision stipulates to always prioritize the moral interest related to the name of another person even in cases where the sound is not generally recognized as one that indicates the name of a person.

Based on the above, even if there is a person with a name identical to the sound composing a sound trademark, if it cannot be found that a person who comes across the sound trademark associates it with or recalls the name of a specific person based on the sound composing the sound trademark, in light of the transaction status, at the time of the application for trademark registration, it cannot be said that the sound is generally recognized as one indicating the name of a person. Therefore, it should be said that it cannot be recognized that the sound trademark falls under the category of a trademark containing "the name of another person" set forth in said item.

(2) A. Considering the above from the perspective of the Trademark in the Application, according to the facts found in this case as stated in 2. above, [i] for over approximately 30 years after Matsumotokiyoshi Co., Ltd. began expansion of stores of the drugstore "Matsumotokiyoshi" in 1987 and until the Application was filed on January 30, 2017, Matsumotokiyoshi Co., Ltd., the Plaintiff, and group companies of the Plaintiff have continuously used the indication "マツモトキヨシ" (Matsumotokiyoshi) as the name of the drugstore or their company name; [ii] as of March 31, 2017, the number of stores of the drugstore "Matsumotokiyoshi" was 1,555 in 45 prefectures in Japan, the number of members who have a member's card (point card) of the Plaintiff's group companies reached approximately 24.4 million, and the brand of "Matsumotokiyoshi" was evaluated as the number one brand in Japan as a drugstore in the brand appraisal ranking in fiscal years 2016 and 2017 by Interbrand; [iii] it is found that, in the TV commercials of the drugstore "Matsumotokiyoshi" that was began in 1996, a considerable number of commercial songs that contain a sound that is the same as or similar to the Trademark in the Application in a female or male voice or in a chorus of multiple voices were used,

and even after the TV commercial was broadcast, a sound that is the same as or similar to the Trademark in the Application was used in retail stores of the drugstore "Matsumotokiyoshi."

According to the facts found in this case, it is found, as the transaction status related to the Trademark in the Application, at the time of the application for the Trademark in the Application (application date: January 30, 2017), that the indication "マツモトキヨシ" (Matsumotokiyoshi) was famous throughout Japan as one indicating the name of the stores of the drugstore "Matsumotokiyoshi," Matsumotokiyoshi Co., Ltd., the Plaintiff, or group companies of the Plaintiff and that a sound identical to or similar to the Trademark in the Application containing the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) was widely known as an advertisement (a phrase in a commercial song) of the drugstore "Matsumotokiyoshi," as a result of being used in TV commercials and in each retail store of the drugstore "Matsumotokiyoshi."

B. Under the aforementioned transaction status as stated in A. above, at the time of the application for registration of the Trademark in the Application (application date: January 30, 2017), it was usually the name of the drugstore "Matsumotokiyoshi" and the company name of Matsumotokiyoshi Co., Ltd., the Plaintiff, or group companies of the Plaintiff that a person who came across the Trademark in the Application associated it with or recalled from the sound containing the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in the composition of the Trademark in the Application. Ordinarily, it cannot be found that the sound was associated with or reminded of the name "松本清," "松本潔," "松本清司," etc. that can be read as "Matsumoto Kiyoshi." Therefore, it cannot be said that the sound was recognized as one generally indicating the name of a person.

Consequently, it should be said that the Trademark in the Application cannot be found to fall under a trademark containing "the name of another person" as set forth in Article 4, paragraph (1), item (viii) of the Trademark Act.

(3) A. On the other hand, the Defendant made the following allegations: [i] "マツモトキヨシ" (Matsumotokiyoshi) in katakana is indicated as one of the indications of the name of a person different from the Plaintiff, such as "松本清," "松本潔," and "松本清司," etc., and these persons are presumed to exist; the name of a person different from the Plaintiff, such as "松本清," "松本潔," etc., is indicated as the name of a person pronounced as "matsumoto kiyoshi" in the Hello Page of each region (Exhibits Otsu 8 through 19) and all of these persons are presumed to be persons who have existed since the time of the application for registration of the Trademark in the Application until today; and according to the fact that indicating the name in katakana is implemented by

society in general in various kinds of commercial transactions (Exhibits Otsu 20 through 28), the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in the composition of the Trademark in the Application easily suggests and reminds of the name of a person pronounced as "matsumoto kiyoshi," such as "松本清," "松本潔," and "松本清司," etc., and it is objectively identified as the name of a person read as "matsumoto kiyoshi"; and [ii] based on the evidence related to the TV commercials submitted by the Plaintiff, the coverage of the TV commercials is not clear, and broadcasting in 2007 and after cannot be confirmed, the impact of the TV commercials on the recognition of a person who heard the sound of the Trademark in the Application is limited; since it can be said that a person who viewed the TV commercials could hear, identify, and memorize the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) as well as the visual element, the TV commercials cannot serve as evidence to prove that a person who comes across the Trademark in the Application recognizes the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) only as the name of the store or the company without recognizing it as the name of a person whose last name is Matsumoto and first name is Kiyoshi; it is difficult to say that the brand appraisal ranking indicated by the Plaintiff directly reflects the recognition of persons who heard the sound of the Trademark in the Application; and there is no other evidence supporting that the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) is recognized only as the name of the drugstore or the company. Based on these allegations, the Defendant alleged that, as indicated in [i] above, it cannot be denied that the sound consisting of the linguistic element is objectively identified as the name of a person read as "matsumoto kiyoshi," such as "松本清," "松本潔," and "松本清司," etc., and therefore, the Trademark in the Application falls under a trademark containing "the name of another person" as set forth in Article 4, paragraph (1), item (viii) of the Trademark Act.

However, as found in (2) A. above, in consideration of the transaction status that at the time of filing an application for the Trademark in the Application, the indication of "マツモトキヨシ" (Matsumotokiyoshi) was famous throughout Japan as one indicating the name of the drugstore "Matsumotokiyoshi," Matsumotokiyoshi Co., Ltd., the Plaintiff, or group companies of the Plaintiff and that a sound that is the same as or similar to the Trademark in the Application containing the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) was widely known as an advertisement (a phrase in a commercial song) of the drugstore "Matsumotokiyoshi" as a result of being used in TV commercials and in each retail store of the drugstore "Matsumotokiyoshi," a person

who comes across the Trademark in the Application usually and easily associates it with or is reminded of "Matsumotokiyoshi" as the name of a drugstore and Matsumotokiyoshi, Co., Ltd. or the Plaintiff's group companies as a company name from the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in the composition of the Trademark in the Application, but it is not found that the person usually associates it with or is reminded of the name of a person read as "matsumoto kiyoshi," such as "松本清," "松本潔," and "松本清司," etc.

In addition, according to Exhibit Ko 43, it is found that the TV commercials were aired throughout Japan mainly in the capital area, where retail stores of the drugstore "Matsumotokiyoshi" are located, and it is also found that, even after broadcasting the TV commercials, the sound that was used in the TV commercials and that is the same as or similar to the Trademark in the Application is used in retail stores of the drugstore "Matsumotokiyoshi." Therefore, it cannot be said that the impact of the TV commercials on the recognition of a person who heard the Trademark in the Application is limited, and the fact that the TV commercials have the visual element does not have any impact on this finding.

In addition, as explained in (1) above, in consideration of the fact that said item is a provision with the intention of balancing the interest of an applicant to receive a trademark registration and the moral interest related to the name, etc. of another person and that it cannot be construed that the provision stipulates to always prioritize the moral interest related to the name of another person even in cases where the sound is not generally recognized as one that indicates the name of a person, it is inappropriate for the Defendant to consider that the Trademark in the Application falls under the trademark containing "the name of another person" as set forth in said item as long as a person who comes across the Trademark in the Application does not necessarily recognize the sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) only as the name of the drugstore or the company.

Consequently, the aforementioned allegation of the Defendant cannot be adopted.

B. Next, the Defendant alleged that as long as a sound consisting of the linguistic element of "マツモトキヨシ" (Matsumotokiyoshi) in the composition of the Trademark in the Application is objectively identified as the name of a person read as "matsumoto kiyoshi," such as "松本清," "松本潔," and "松本清司," etc., and the Trademark in the Application is a trademark containing "the name of another person," in light of the purport of Article 4, paragraph (1), item (viii) of the Trademark Act, the facts that the sound consisting of the linguistic element is known to an extent as one that indicates the drugstore operated by the Plaintiff or Matsumotokiyoshi Co., Ltd. and

that the sound is known as an abbreviation of a specific person to an extent do not have an impact on whether the Trademark in the Application falls under said item.

However, as explained in A. above, it cannot be said that the Trademark in the Application is a trademark containing "the name of another person" and therefore, the allegation of the Defendant lacks the assumption and cannot be adopted.

(4) Summary

Consequently, since there was an error in the determination of the JPO Decision in that it determined that the Trademark in the Application falls under Article 4, paragraph (1), item (viii) of the Trademark Act, there are grounds for the rescission alleged by the Plaintiff.

4. Conclusion

As mentioned above, there are grounds for the rescission alleged by the Plaintiff and therefore, the JPO Decision should be rescinded.

Consequently, the judgment shall be rendered as indicated in the main text.

Intellectual Property High Court, First Division

Presiding judge: OTAKA Ichiro

Judge: KOBAYASHI Yasuhiko

Judge: OGAWA Takatoshi

(Attachment)

1. Trademark for which registration is sought



2. Designated services

Class 35 "Retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for footwear, other than special footwear for sports; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles; retail services or wholesale services for foods and beverages; retail services or wholesale services for two-wheeled motor vehicles; retail services or wholesale services for

bicycles; retail services or wholesale services for furniture; retail services or wholesale services for joinery fittings; retail services or wholesale services for tatami mats; retail services or wholesale services for ritual equipment; retail services or wholesale services for electrical machinery and apparatuses; retail services or wholesale services for bladed or pointed hand tools, hand tools and metal hardware; retail services or wholesale services for kitchen equipment, cleaning tools and washing utensils; retail services or wholesale services for pharmaceutical, veterinary, and sanitary preparations and medical supplies; retail services or wholesale services for cosmetics, toiletries, dentifrices, soaps, and detergents; retail services or wholesale services for agricultural machines, implements and supplies; retail services or wholesale services for flowers [natural] and trees; retail services or wholesale services for printed matter; retail services or wholesale services for paper and stationery; retail services or wholesale services for sports goods; retail services or wholesale services for toys, dolls, game machines and apparatus; retail services or wholesale services for musical instruments and records; retail services or wholesale services for photographic machines and apparatus and photographic supplies; retail services or wholesale services for clocks, watches, and spectacles [eyeglasses and goggles]; retail services or wholesale services for tobaccos and smokers' articles; retail services or wholesale services for building materials; retail services or wholesale services for chemicals, Canada balsam, copal, sandarac, shellac, wood turpentine oil, dammar, mordants, mastic, pine gum, wood preservatives, antistatic preparations for household purposes, de-greasing preparations for household purposes, rust removing preparations, stain removing benzine, fabric softeners for laundry use, laundry bleach, solid lubricants, tar, pitch, binding agents for ice cream, meat tenderizers for household purposes, and preparations for stiffening whipped cream; retail services or wholesale services for glue and adhesives for industrial purposes (excluding those for offices or household purposes), adhesives for affixing false hair, adhesives for affixing false eyelashes, starch for laundry purposes, seaweed gelatin for laundry use [Funori], and pastes and other adhesives for stationery or household purposes; retail services or wholesale services for dyestuffs; retail services or wholesale services for priming putty, paints, and paint stripping preparations; retail services or wholesale services for printing ink; retail services or wholesale services for shoe cream, shoe black [shoe polish], and grease for shoes and boots; retail services or wholesale services for shoe polish and leather preserving oil and grease; retail services or wholesale services for anti-rust greases and mineral oils and greases for industrial purposes [not for fuel]; retail services or wholesale services for sewing machines; retail services or wholesale services for adhesive tape dispensing machines, automatic

stamping machines, blueprint apparatus, cash registers, coin counting or sorting machines, ergograph, photo-copying machines, mathematical instruments, time and date stamping machines, time clocks [time recording devices], punched card office machines, voting machines, postage stamp checking apparatus, addressing machines, ink ribbons, automatic stamp affixing machines, electric staplers for offices, envelope sealing machines for offices, stamp obliterating machines, drawing instruments, typewriters, checkwriters, mimeographs, relief duplicators, paper shredders for office use, franking machines, and rotary duplicators; retail services or wholesale services for power sprayers for disinfecting, insecticides, and deodorants [not for agricultural purposes]; retail services or wholesale services for fire extinguishers, fireplugs, fire hose nozzles, sprinkler systems for fire protection, fire hose, and asbestos safety curtains; retail services or wholesale services for fire alarms, gas alarms, anti-theft warning apparatus, and anti-theft alarms for vehicles; retail services or wholesale services for lawnmowers; retail services or wholesale services for balances, tape measures, and other measuring or testing machines and instruments; retail services or wholesale services for clinical thermometers, body fat monitors, sphygmotensimeters, and other medical apparatus and instruments; retail services or wholesale services for rubber thread and covered rubber yarn, not for textile use, chemical fiber yarn and thread, not for textile use, asbestos thread, and threads; retail services or wholesale services for tapes [haberdashery] and ribbons; retail services or wholesale services for rubber cords and laces, asbestos cords and laces, leather straps, straw plaits, knitted cords, Sanada-himo [Japanese-style cords], starched cords, twisted cords, cordage, and braids; retail services or wholesale services for asbestos net, nets (excluding those made of metals or asbestos), and wire nets and gauzes; retail services or wholesale services for irons [non-electric hand tools], needle-threaders, dressmakers' chalk sharpeners, paper patterns, tailors' chalk, embroidery frames and hoops, ironing boards, tailors' sprayers, ironing boards [Kotedai], Hera-dai [fabric marking boards], knitting sticks, sewing boxes, dressmakers' impressing blades, sewing thimbles, pin and needle cushions, and boxes for needles; retail services or wholesale services for bath fittings, yukakibo [Japanese bath utensils for hot bathtub water], bathroom stools, bathroom pails, shower curtains, and bath mats for wash places; retail services or wholesale services for metal nameplates and door nameplates, and nameplates and door nameplates, not of metal; retail services or wholesale services for banners of paper, flags of paper, flagpoles, and banners and flags, not of paper; retail services or wholesale services for candles; retail services or wholesale services for candle extinguishers and candlesticks; retail services or wholesale services for warming pans,

pocket warmers, pocket warmers ash, and hot water bottles for warming one's feet in bed; retail services or wholesale services for fly catching paper and fly swatters; retail services or wholesale services for mouse and rat traps; retail services or wholesale services for stakes for plants or trees, flower pots, hydroponic plant pots for home gardening, and watering cans; retail services or wholesale services for dog leash, clothing for domestic pets, beds for household pets, dog kennels, nesting boxes for small birds, feeding vessels for pets, brushes for pets, chewing toys for pet dogs, tanks [indoor aquaria] and their fittings, bird cages, bird baths, and toys for domestic pets; retail services or wholesale services for step ladders and ladders; retail services or wholesale services for letter boxes of metal, letter boxes of masonry, and letter boxes [not of metal or masonry]; retail services or wholesale services for clothes brushes; retail services or wholesale services for hygienic hand towels of paper, towels of paper, table napkins of paper, hand towels of paper, and handkerchiefs of paper; retail services or wholesale services for urinals for medical purposes, bed pans, toilet stool units with a washing water squirter, disinfectant dispensers for toilets, toilet bowls, seats for use with Japanese style toilet bowls, chamber pots, toilet paper holders, and toilet seat covers of textile; retail services or wholesale services for shopping baskets for the transport of items; retail services or wholesale services for piggy banks and piggy banks (not of metal); retail services or wholesale services for shipping tags; retail services or wholesale services for garbage incinerators for household purposes; retail services or wholesale services for water tanks of metal for household purposes, water tanks of masonry for household purposes, and water tanks for household purposes, not of metal or masonry; retail services or wholesale services for heating or cooling packs filled with chemical substances ready to react when required; retail services or wholesale services for hanging boards [Japanese style pegboards using positional hooks]; retail services or wholesale services for tool boxes of metal, empty and tool boxes, not of metal; retail services or wholesale services for towel dispensers of metal, insecticide atomizers [hand tools], towel dispensers, not of metal, boxes of metal for dispensing paper towels, boot jacks, and soap dispensers; retail services or wholesale services for tablecloths of paper, indoor window blinds [shade] [furniture], blinds of reed, rattan or bamboo [Sudare], bead curtains for decoration, window shades, seat covers of textile, wall hangings of textile, curtains, table cloths, not of paper, draperies [thick drop curtains], floor coverings, and wall hangings; retail services or wholesale services for flower vases, flower bowls, and wind chimes; retail services or wholesale services for plastic films for agricultural purposes, tarpaulins, not for ships, tents, not for camping, window shades, and reed screen; retail services or wholesale services for benches; retail services

or wholesale services for man-made garden ponds; retail services or wholesale services for artificial turf; retail services or wholesale services for artificial flowers; retail services or wholesale services for insect collectors' tools; retail services or wholesale services for paintings and calligraphic works and picture frames; retail services or wholesale services for image-recorded magnetic tapes, magnetic discs, photographs [printed], and photograph stands; and retail services or wholesale services for matches"

Class 44 "providing medical information; preparation and dispensing of medications; dietary and nutritional guidance; nursing care; rental of medical apparatus and instruments; counseling and provision of information related to aesthetics and beauty; beauty salon services mainly in the nail arts, nail care, and nail massages; beauty salon services in nail salons; provision of information related to nail salons; beauty salon services; and rental of aesthetic equipment."