

Date	February 24, 1976	Court	Osaka District Court, 21st Civil Division
Case number	1974 (Wa) 393		
– A case in which the court denied that the trademark right in question was infringed on the grounds that the act of using a mark which is identical with a registered trademark in terms of pronunciation and concept is not a use of a genuine trademark (trademark as a sign to distinguish goods).			

Reference: Article 2, Article 25, Article 36 and Article 37 of the Trademark Act

Number of related rights, etc.: Registration No. 536992

Summary of the Judgment

1. Background, etc.

The plaintiff holds a trademark right for the registered trademark in question ("Registered Trademark") by designating goods such as clothing.

The defendant manufactured and sold children's shirts carrying, in the central area of the chest part, the marks that are identical with the Registered Trademark in terms of pronunciation and concept (the "Defendant's Marks").

The structures of the Registered Mark and the Defendant's Marks are as follows.

Registered Trademark



Defendant's Mark
(Mark Y)



Defendant's Mark
(Mark Z)



The plaintiff sought an injunction against the manufacture and sale, etc. of the undershirts carrying the Defendant's Marks based on the trademark right in question ("Trademark Right").

2. Summary of the court decision

The court mainly held as follows and dismissed the plaintiff's claims.

- (1) A comparison of Mark Y and Mark Z with the Registered Trademark has revealed the following facts. The figure part is an essential feature of each mark or trademark,

which allows viewers to directly perceive that it is a picture of "POPEYE" or "ポパイ" known as the main character of a cartoon. However, since the posture and scene depicted in each picture is different, these marks and trademark cannot be considered to be similar in terms of appearance. In consideration of the facts that the Registered Trademark includes the horizontally written characters "POPEYE" in its upper part and the horizontally written characters "ポパイ" in its lower part, that Mark Y includes "POPEYE" in its upper part, while Mark Z includes "ポパイ" in the lower part, these features of the marks and the trademark can be considered to be associated with the pronunciation of "POPEYE" and "ポパイ" and with the concept of the "main character of a cartoon, Popeye." Therefore, Mark Y and Mark Z can be considered to be identical with the Registered Trademark in terms of pronunciation and concept.

- (2) The Trademark Act contains provisions stating that if a third party infringes or commits an act that is likely to infringe the trademark right, the holder of the trademark right, etc. may demand against such third party discontinuation or prevention of the act of infringement or make any other claim. The purpose of such provisions is to provide legal protection for the economic functions of the registered trademarks. A "genuine trademark" is a sign to distinguish the goods pertaining to its own business from any other goods. In other words, a "genuine trademark" is affixed to goods primarily for the purpose of distinguishing one's goods from those of others. Thus, trademark protection is provided under the Trademark Act in order to legally protect the source-identifying function, etc. of a "genuine trademark" affixed to the designated goods from any unlawful interference.

Therefore, it should be interpreted that Article 37 of the Trademark Act would be applied to the cases where the acts set forth in said Article can substantially be considered to be the use of a trademark as a "genuine trademark."

- (3) The Defendant's Marks are colored, enlarged, and printed in almost the entire central area in the chest part of the undershirts. The purpose of this manner of use is to motivate consumers to purchase the goods by giving them such impressions as "interesting," "pleasant," and "cute," which are formed solely as a result of using those marks as a decoration or design. General consumers are expected to purchase goods based on the aforementioned impressions generated by the use of the marks as a decoration or design. It cannot be interpreted that general consumers consider the aforementioned marks as signs useful to check and confirm the manufacturer or source of the goods bearing said marks. From an objective perspective, it should be found that the defendant's act of using the Defendant's Marks did not aim to use the

fundamental trademark functions, i.e., the source-identifying function and the product quality guarantee function. From the perspective of subjective intention, it should also be found that the defendant did not intend to indicate the source of the goods with these marks.

Judgment rendered on February 24, 1976

1974 (Wa) 393

Judgment

Indication of the parties: omitted.

Main text

The principal and alternative claims of the plaintiff shall be dismissed.

The court costs shall be borne by the plaintiff.

Facts

No. 1 Judicial decision sought by the parties

1. Plaintiff

(Regarding the principal claim)

A court judgment as follows and a declaration of provisional execution:

(1) The defendant shall not manufacture, sell, or distribute undershirts carrying the marks presented in the attached Lists 2 and 3.

(2) The court costs shall be borne by the defendant.

(Alternative claim)

The defendant shall not manufacture, sell, or distribute undershirts carrying the characters "POPEYE" included in the mark presented in attached List 2 and "ポパイ" included in the mark presented in attached List 3.

2. Defendant

A court judgment that is the same as stated in the main text above.

No. 2 Allegations of the parties

1. Grounds for the principal claim

(1) The plaintiff holds the following trademark right (the "Trademark Right").

Trademark registration No.: 536992

Registered trademark: As presented in the attached List 1

Application date: June 26, 1958 (Trademark Application No. 1958-17957)

Publication of application: October 20, 1958 (Publication of Trademark Application No. 1958-16696)

Registration date: June 12, 1959

Designated goods: Class 36 "Clothing, handkerchiefs, buttons, and pins used as accessories and the like"

(2) The structure of the registered trademark is as follows.

The registered trademark consists of the horizontally-written characters "POPEYE"

in the upper part of the trademark and the horizontally-written characters "ポパイ" in the lower part of the trademark as well as a picture of Popeye placed in between. Popeye is expressed as a person with a matroos pipe in his mouth, turning his face slightly leftward, standing with both legs stretched and spread, wearing a sailor hat and a sailor uniform, while holding the anchor-tattooed left arm close to his chest and holding his right hand upward to flex his arm muscles. In this way, the registered trademark is a combination of characters and a figure.

(3) The defendant has been manufacturing, selling, and distributing undershirts carrying a mark ("Mark Y") consisting of the colored figure and characters presented in List 2 as shown in the photograph presented in List 4 and undershirts carrying a mark ("Mark Z") consisting of the colored figure and characters presented in List 3 as shown in the photograph presented in List 5.

(4) Mark Y includes the characters "POPEYE" horizontally written in large letters in the upper part, from the last letter of which, i.e., "E," a sandbag with a painful facial expression looking rightward is hung by a string. On the left of the sandbag, below the aforementioned characters "POPEYE," there is a picture of Popeye with a matroos pipe in his mouth, wearing a sailor hat and a sailor uniform, with both hands and forearms enlarged, showing an anchor tattoo on the left forearm, with the right eye closed, both knees meeting together and twisted, in such way that expresses the body movement after having hit the sandbag. In this way, Mark Y is a combination of characters and a figure.

Mark Z consists of a picture of a toy steam locomotive on tracks with the characters "POPEYE" horizontally written on the face of the locomotive, a picture of Popeye straddling the top of said locomotive, wearing a sailor hat and a sailor uniform, with a matroos pipe in his mouth, with both hands and forearm enlarged, spreading the left hand and holding it upward and showing an anchor tattoo on the right forearm, a picture of a boy behind Popeye reaching out the right hand, fingers spread, toward a girl on the left side of the land, who is talking to them. Behind Popeye, two trees are shown. On the lower right side of the locomotive, the characters "ポパイ" are horizontally written. In this way, Mark Z is a combination of characters and a figure.

(omitted)

(6) Therefore, based on the Trademark Right, the plaintiff filed a lawsuit against the defendant to seek a judgment to the effect that the defendant shall not manufacture, sell, or distribute undershirts carrying the marks presented in the attached Lists 2 and 3.

2. Grounds for the alternative claim

(1) In the work "THE THIMBLE THEATRE" presented in the attached List 6, only the artworks or the picture part and the text part are copyrightable. The name of a character "POPEYE" is not a work per se. Furthermore, the aforementioned characters "POPEYE" were merely stated as "Character: Popeye" in the second line in the blank space in the margin of said work. The Katakana characters "ポパイ" were not stated in any part of said work. Thus, these names should be considered to be not included in said work.

Therefore, even if the defendant is entitled to legally reproduce said "THE THIMBLE THEATRE," the characters "POPEYE" in Mark Y and the characters "ポパイ" in Mark Z can be considered to be used as a trademark. Since said characters are identical with "POPEYE" and "ポパイ," which are essential features of the registered trademark, the defendant may not use those characters.

(2) Thus, based on the Trademark Right, the plaintiff seeks a court judgment to the effect that the defendant shall not manufacture, sell, or distribute undershirts carrying the characters "POPEYE" included in the mark presented in the attached List 2 and the characters "ポパイ" included in the mark presented in the attached List 3.

(omitted)

Reasons

1. There is a consensus between the parties that the plaintiff holds the right for the trademark (Registration No.: 536992; Application date: June 26, 1958; Publication of application: October 20, 1958; Registration date: June 12, 1959; Registered for the designated goods: Class 36 "Clothing, handkerchiefs, buttons, and pins used as accessories and the like"), that said trademark has the structure shown in the attached List 1, that the defendant affixed, to the chest part of undershirts, the following marks in large size: Mark Y presented in the attached List 2 and Mark Z presented in the attached List 3, and that the defendant has been manufacturing, selling, and distributing undershirts carrying said marks.

2. The plaintiff alleged that, in view of the facts that Mark Y and Mark Z are similar to the registered trademark and that undershirts are included in the designated goods, the defendant's act of affixing Mark Y and Mark Z to said goods and manufacturing and selling undershirts carrying said marks constitute infringement of the Trademark Right. On the other hand, the defendant alleged that the defendant did not infringe the Trademark Right because the figures and characters shown in the chest part of the

undershirts can be considered to be reproductions of the cartoon version of Popeye used merely as a decoration and design and not as a trademark in light of common sense. This dispute is examined below.

(1) Article 2 of the Trademark Act defines the terms "trademark," "mark," and "use of a mark" used in said Act.

According to said provision, the term "mark" used in the Trademark Act means "any character(s), figure(s), sign(s) or any combination thereof, or any combination thereof with colors." The "above-defined mark used in connection with the goods of a person who produces, processes, certifies or assigns the goods as a business" can be regarded as a "trademark" defined in the Trademark Act regardless of what kind of mark it is, for what purpose and where it is expressed, and how ordinary people usually perceive the expression. Based on the aforementioned definition of "mark," Article 2, paragraph (3) defines "use of a mark."

Needless to say, the concepts of "mark" and "trademark" defined as above are different from the "concepts of 'mark' and 'trademark' actually used in transactions and observed in society or the concepts of 'mark' and 'trademark' widely accepted as social norms" ("genuine trademark"). Said Article defines the terms "mark" and "trademark" differently from social norms solely for the purpose of legislative convenience.

Based on the aforementioned definitions, it is undeniable that the defendant's act of affixing Mark Y and Mark Z to children's undershirts and selling or otherwise handling the goods carrying said marks as a business can be considered to be the "use of a mark" and "use of a trademark" specified in the Trademark Act.

(2) Furthermore, Article 37 of said Act specifies that a third party's act of using a trademark similar to a registered trademark for the designated goods of the registered trademark would constitute infringement of the trademark right.

The following section examines whether the defendant's act of affixing Mark Y and Mark Z to undershirts falls under said provision.

A comparison of Mark Y and Mark Z with the registered trademark has revealed the following fact. The figure part is an essential feature of each mark or trademark, which allows viewers to directly perceive that it is a picture of "POPEYE" or "ポパイ" known as the main character of a cartoon. However, since the posture and scene depicted in each picture is different, these marks and trademark cannot be considered to be similar in terms of appearance. In consideration of the facts that the registered trademark includes the horizontally written characters "POPEYE" in its upper part and the horizontally written characters "ポパイ" in its lower part, that Mark Y includes "POPEYE" in its upper part, while Mark Z includes "ポパイ" in the lower part, these

features of the marks and the trademark can be considered to be associated with the pronunciation of "POPEYE" and "ポパイ" and with the concept of the "main character of a cartoon, Popeye." Therefore, Mark Y and Mark Z can be considered to be identical with the registered trademark in terms of pronunciation and concept.

However, it should be noted that, if a registrable trademark (please refer to Article 3) undergoes the prescribed procedure and gets registered, the Trademark Act would recognize the establishment of a trademark right for the registered goods (Article 18), and permit the holder of the trademark right (if an exclusive license is granted for the trademark right, the exclusive licensee) to exclusively use the registered trademark for the designated goods, and, if a third party infringes or commits an act that is likely to infringe the trademark right, permit the holder of the trademark right, etc. to demand against such third party discontinuation or prevention of the act of infringement or to make any other claim. The purpose of the Trademark Act is to provide legal protection for the economic functions of the registered trademarks.

A "genuine trademark" is a sign to distinguish the goods pertaining to its own business from any other goods. In other words, a "genuine trademark" is affixed to goods primarily for the purpose of distinguishing one's goods from others. It is widely recognized that the economic functions of a "genuine trademark" include not only the function of indicating the source but also the function of quality guarantee and the function of advertisement.

Thus, trademark protection is provided under the Trademark Act in order to legally protect the source-identifying function, etc. of a "genuine trademark" affixed to the designated goods from any unlawful interference. The holder of a trademark right is entitled to exclusively use the registered trademark for the designated goods. Unlawful interference could be carried out through the use of a trademark identical or similar to the registered trademark for the goods identical or similar to the designated goods. The aforementioned Article 37 was established on the grounds that the acts listed under said Article would usually interfere with the legitimate exercise of the right for a registered trademark, i.e., the performance of the functions of a registered trademark. In other words, it was found that said acts must be prohibited in order to allow the holder of the right for a registered trademark to exercise their legitimate rights. Therefore, it should be interpreted that the aforementioned Article 37 would be applied to the cases where the following requirements are satisfied: the formality requirement that the trademark specified in said Article is used for the goods specified in said Article, as well as the substantive requirement that the use can be considered to be the use as a "genuine trademark." Any use of a registered trademark not related to the functions thereof is

interpreted to have no negative effect on the exercise of the legitimate rights that arise from the registered trademark, in other words, the economic functions as a genuine trademark such as the source-identifying function, advertisement function, quality guarantee function, etc. unless there are any special circumstances. If even such use of a registered trademark not related to the functions thereof is considered to be infringement of the trademark right, it would result in an undesirable situation where the holder of the trademark right is given unnecessary protection without any substantive reason and where the general public is unreasonably deprived of freedom, making it impossible to maintain a fair competitive environment.

(3) Article 26 of said Act specifies that a trademark right would have no effect on certain types of trademarks. This Article was established to eliminate any inconveniences caused by Article 2, which defines the term "trademark" used in said Act as mentioned above, without paying attention to any specific details such as what the trademark consists of and what is the purpose of use, and as a result, gives an impression that the term "trademark" includes any trademarks even if they are not used as a "genuine trademark." There are no theoretical grounds to limit the types of trademarks on which a trademark right would have no effect only to such types of trademarks strictly falling under those listed in said Article. In consideration of the legislative purpose of said Article, it would be reasonable to interpret a similar "trademark under the Trademark Act" in the same manner as above.

(4) According to Exhibits Ko 5 to 7, which have been established as agreed by the parties, Object of Observation Otsu 2, which is a "Popeye" comic book published by King Features Syndicate Inc. in 1955 as agreed by the parties, Object of Observation Otsu 3, which is a comic titled "Popai Waei Daisenpū" as agreed by the parties, Object of Observation Otsu 4, which is a comic titled "Popai 1 Orību Ganbaru no Maki" as agreed by the parties, and Object of Observation Otsu 5, which is a comic titled "Popai 2 Onna wa Kowaine Popai no Maki" as agreed by the parties, a cartoon character Popeye first appeared in 1929 as the main character in the comic "THE THIMBLE THEATRE" authored by [A] (released in 1919) and subsequently appeared in comics, TV programs, films, etc. as a one-eyed sailor with a cheap matroos pipe in his mouth, who has little education but generates a heroic power after eating spinach and beats all opponents, and became popular nationwide and worldwide.

(5) Furthermore, Exhibit Otsu 7 (a statement of expert opinion [B]), Object of Observation Otsu 6, which is a separate volume of the magazine titled "So-En" as agreed by the parties, Object of Observation Otsu 7, which is the magazine titled "Puchi Puchi" as agreed by the parties, Object of Observation Otsu 8, which is the magazine

titled "Men's Club" as agreed by the parties, Object of Observation Otsu 9, which is the magazine titled "Shufu to Seikatsu" as agreed by the parties, and Object of Observation Otsu 10, which is the magazine titled "An An" as agreed by the parties, it can be found that, due to recent technical advances, the technical difference between companies has almost disappeared, which made consumers more likely to select aesthetically superior goods as long as the quality and functions are the same, and that, consequently, companies have manufactured and sold various T-shirts with a large print on the chest part or the back part thereof, showing designs and characters related to comics, animals, or sports such as rugby and soccer with the hope of enhancing the aesthetic effect of those T-shirts by giving viewers such impressions as "popular," "cool," "interesting," and "cute," and that consumers are attracted to such aesthetic quality and motivated to purchase them.

However, it should be construed that the purpose of printing the designs, characters, etc. related to the aforementioned comics in the central part such as the chest part of undershirts in large size is not to have such designs, characters, etc. strongly fulfil their trademark functions, but to make consumers feel attracted to and comfortable with such printed designs, etc. and motivated to purchase those goods.

(6) In view of these facts, according to Objects of Observation Ko. 1 and 2, which are photographs of the undershirts manufactured and sold by the defendant as agreed by the parties, as shown in the attached Lists 4 and 5 (photographs), that show copies thereof, Mark Y and Mark Z are colored, enlarged, and printed in almost the entire central area in the chest part of the undershirts. The purpose of this manner of use is to motivate consumers to purchase the goods by giving them such impressions as "interesting," "pleasant," and "cute," which are formed solely as a result of using those marks as a decoration or design. General consumers are expected to purchase goods based on the aforementioned impressions generated by the use of the marks as a decoration or design. It cannot be interpreted that general consumers consider the aforementioned marks as signs useful to check and confirm the manufacturer or source of the goods bearing said marks.

Meanwhile, a "genuine trademark," which functions as a sign to identify certain goods, also has the advertisement function and the quality guarantee function. Due to such nature of a "genuine trademark," a genuine trademark is usually affixed to a hanging tape, hang tag, package bag, etc. In some cases, a "genuine trademark" is placed in the chest area or any other prominent area of goods, such as shirts. However, in reality, as far as a trademark is used as a "genuine trademark," even if it is a world-famous trademark, it would not be generally enlarged and placed to cover the

entire front area or back area of the goods.

(7) According to Object of Observation Ko 1, about which there is no dispute about the filming date and the filmed object, Object of Observation Ko 3, which is a shirt manufactured by the defendant as agreed by the parties, and Object of Observation Otsu 1, which is a children's shirt manufactured by the defendant as agreed by the parties, it can be found that the neck part of the undershirts carrying Mark Y manufactured by the defendant is tagged with a label showing a trumpet-shaped figure looking to the right and expressed in a blue outline and a red background in the upper part of the label, the characters "AIRCOTT" written in capital, block letters in the middle part of the label, and the characters "ピッパス" in the lower part of the label. Also, another label is hung from the neck area. That label shows the characters "ダイワボウエアコット" written in black letters in the upper part of the label, the characters "ピッパス" written in red, blue, yellow, and green respectively in the middle part, and a chicken design outlined by a black line against the red, yellow, and green background in the lower part, and the characters "カシミロン" in black letters below the chicken design. It is obvious that these labels are attached as the defendant's trademarks.

(8) As described above, from an objective perspective, it should be found that the defendant's act of using Mark Y and Mark Z did not aim to use the fundamental trademark functions, i.e., the source-identifying function and the product quality guarantee function. From the perspective of subjective intention, it should also be found that the defendant did not intend to indicate the source of the goods with these marks.

Exhibit Ko 8-1 (a statement of expert opinion [C]), which has been established as agreed by the parties and which is not in line with the aforementioned court determination, is unacceptable.

(9) On these grounds, the defendant's act of using Mark Y and Mark Z cannot be considered to constitute infringement of the plaintiff's registered trademark right. Therefore, the principal claim of the plaintiff, which takes an opposite stance, is unacceptable.

3. Alternative claim

The plaintiff alleged that the characters "POPEYE" and "ポパイ" are the essential features of the registered trademark and that the defendant's act of manufacturing, selling, and distributing undershirts carrying Mark Y, which includes the characters "POPEYE," and Mark Z, which includes the characters "ポパイ," constitutes infringement of the registered trademark.

However, as shown in the attached Lists 2 and 3 and Lists 4 and 5, Mark Y and Mark Z are expressed in such way that the character parts and the figures (the picture

parts) are integrated with each other. It is natural to consider that the character parts are explanatory notes attached to the respective figure parts. It would be unnatural to separate the character parts from the figure parts.

Even if only the character parts are examined, since those characters are written in a normal font and are not presented as a design or pattern, it cannot be found that the character parts independently perform a function as a design or decoration. Also, it cannot be found that the aforementioned character parts expressed in the aforementioned manner indicate the source and perform the source-identifying function as a "genuine trademark" either independently or supplementarily.

Thus, since the character parts "POPEYE" in Mark Y and "ポパイ" in Mark Z cannot be considered to be a "genuine trademark," on the same grounds as those based on which a court determination was made for the principal claim of the plaintiff, it is reasonable to find the alternative claim of the plaintiff that the defendant's act of using the aforementioned characters for shirts constitutes infringement of the Trademark Right to be unacceptable.

It is impossible to adopt the interpretation presented in Exhibit Ko 8-2 (a statement of supplementary expert opinion [C]), which has been established as agreed by the parties and which is not in line with the aforementioned court determination.

4. Therefore, this court dismisses the principal and alternative claims of the plaintiff against the defendant. The judgment shall be rendered in the form of the main text with regard to the payment of court costs under Article 89 of the Code of Civil Procedure.

(Osaka District Court, Judges: OE Kenjiro, WATANABE Akira, KITAYAMA Motoaki)

POPEYE



ポパイ

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公 告

公告 昭33. 10. 20 出願 昭33. 6. 26

商願 昭33—17957

連合商標登録番号 326206

指定商品 36

被服、手巾、釦鈕及び装身用ピンの類

出願人 松本善治 大阪市天王寺区椎寺町87

代理人弁理士 繁益清一

POPEYE

第二目錄

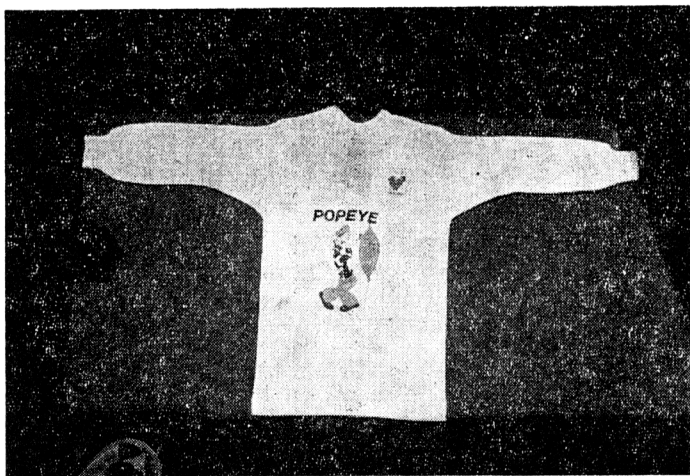


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