

Date	April 14, 2010	Court	Intellectual Property High Court, Fourth Division
Case number	2009 (Gyo-Ke) 10354		
X's act of affixing the indication "kurabuhaisu" (in katakana characters) to its email newsletter and newsletter website in which a number of links are set up so that the readers and viewers can jump directly to the catalogue pages, etc. within X's entire website and so that they can see photographs and descriptions of its goods, can be regarded as the use of its registered trademark consisting of "CLUBHOUSE" (in alphabet characters) and "kurabuhaisu" (in katakana characters) for the designated goods, "processed food," etc.			

References: Article 2, paragraph (3) and Article 50 of the Trademark Act

Summary of the Judgment

1. X holds a trademark right with regard to the trademark consisting of "CLUBHOUSE" (in alphabet characters) and "kurabuhaisu" (in katakana characters) for the designated goods, "processed food," etc. In this suit, X seeks rescission of the trial decision made by the Japan Patent Office (JPO) in response to Y's request for trial, which rescinded X's trademark registration by reason of the trademark not being in use. X displays a mark "kurabuhaisu" (in katakana characters) on its email newsletter and newsletter website in which a number of links are set up so that the readers and viewers can jump directly to the catalogue pages, etc. within X's entire website that provide detailed information on X's goods such as processed food, and so that they can see photographs and descriptions of these goods.

2. In this judgment, the court upheld X's claim, holding as follows.

(1) In order to find a trademark to be in use, the trademark does not necessarily need to be in use in a manner that it is affixed to the designated goods, but it must be in use based on a specific relationship with the designated goods.

(2) X's email newsletter and newsletter website contain such information that is directly related to X's goods, mainly processed food, and advertises X's goods. In this respect, the email newsletter and newsletter website can be deemed to serve to let customers know and understand more about X's goods, and as a kind of electronic leaflet, play a role in advertising X's goods. In light of such system wherein the email newsletter and newsletter website are distributed for the purpose of advertising X's goods, and a number of links are set up so that the readers and viewers can jump directly to the catalogue pages, etc. within X's entire website that provide detailed information on X's goods such as processed food, and so that they can see photographs and descriptions of these goods, the email newsletter and newsletter website can be regarded as an advertisement of X's goods or information on X's goods, and the mark

"kurabuhaisu" (in katakana characters), which is displayed there, can be deemed to be in use based on a specific relationship with X's processed food. Consequently, the mark "kurabuhaisu" (in katakana characters) can be found to be affixed to the advertisement of X's goods or information on X's goods, mainly processed food.

It cannot be denied that the indication "kurabuhaisu" (in katakana characters) is also used as the title of the email newsletter. Unlike the use of a trademark in the meaning set forth in Article 2, paragraph (3), item (i) of the Trademark Act, the use of a trademark in the meaning set forth in item (viii) of said paragraph does not require a trademark to be directly affixed to the designated goods. Meanwhile, X's email newsletter and newsletter website provide a number of links through which the readers and viewers can directly jump to the catalogue pages within X's entire website and can see advertisements of X's goods, categorized as processed food, and such advertisements can be regarded as one of the ordinary types of advertisements placed with the use of the Internet. In consideration of these points, it is inappropriate to deny that the indication of "kurabuhaisu" (in katakana characters) on X's email newsletter and newsletter website is an advertisement on X's goods.

(3) As described above, X, in Japan within three years prior to the registration of the request for trial, affixed a trademark, which is deemed to be identical to its registered trademark from a common sense perspective, to its email newsletter and newsletter website, which serve as advertisements of X's goods or information on X's goods, mainly processed food, and provided such advertisements or information by electromagnetic means. Such act of X constitutes the use of a trademark as set forth in Article 2, paragraph (3), item (viii) of the Trademark Act.

Judgment rendered on April 14, 2010, the original received on the same date, Court Clerk

2009 (Gyo-Ke) 10354 Case of Seeking Rescission of JPO Decision

Date of conclusion of oral argument: March 17, 2010

Judgment

Plaintiff: House Foods Corporation

Defendant: Y

Main text

1. The court rescinds a JPO decision dated September 25, 2009 with regard to Rescission Trial No. 2009-300279.
2. The defendant shall bear the court costs.

Facts and reasons

No. 1 Claims

The same as stated in the main text above.

No. 2 Outlines of the case

In this case, in the course of the procedure described in 1. below, the plaintiff sought rescission of the JPO decision shown in the attached written JPO decision (copy) (the summary of the reasons are specified in 2. below) by alleging that there are grounds for rescission for said JPO decision as described in 3. below in which the JPO accepted the defendant's request for a trial to seek rescission of the registration of the plaintiff's trademark in question on the grounds of non-use.

1. Procedure at the JPO

(1) Trademark in question (Exhibit Ko 188)

The trademark in question (Registration No. 2230404) (the "Trademark") is horizontally written in two lines. The upper line consists of alphabetic characters "CLUBHOUSE." The lower line consists of katakana characters "クラブハウス." An application for registration of the Trademark was submitted on February 9, 1987 and the Trademark was registered for the designated goods, Class 32 "Processed foods, other goods that belong to this category" on May 31, 1990. The registration was renewed on February 1, 2000 and February 2, 2010 respectively, and still remains to be effective.

(2) Request for a trial and the JPO decision

On March 2, 2009, the defendant requested a trial to seek rescission of the

Trademark on the grounds of non-use, alleging that the Trademark had not been used for three consecutive years in Japan by the holder of the trademark right, the exclusive licensee, or a non-exclusive licensee. Said request was registered on March 17, 2009.

The JPO held a trial, Rescission Trial No. 2009-300279, and handed down a decision on September 25, 2009 that "Trademark Registration No. 2230404 shall be rescinded" and served a certified copy of that decision upon the plaintiff on October 7, 2009.

2. Summary of the Reasons for the JPO decision

The reasons for the JPO decision can be summarized as follows: the plaintiff's act of indicating the mark "クラブハウス" in the plaintiff's e-mail newsletter does not fall under Article 2, paragraph (3), item (viii) of the Trademark Act and does not provide sufficient grounds to recognize that the holder of the trademark right, the exclusive licensee, or a non-exclusive licensee used the Trademark in Japan within three years from the registration of the request for a trial for any of the designated goods mentioned in the request.

3. Grounds for rescission

There was an error in the JPO decision that the plaintiff's act of indicating the mark "クラブハウス" does not fall under Article 2, paragraph (3), item (viii) of the Trademark Act.

(omitted)

No. 4 Court decision

1. Accepted facts

According to the evidence and the entire import of oral argument, the following facts may be found.

(1) Plaintiff

A. The plaintiff is a stock company established for the purpose of food manufacturing, processing, marketing, etc. The plaintiff manufactures and sells a variety of processed foods, such as curry roux, instant curry, stew roux, instant stew, instant confectionery mix, instant soup cubes, ready-made soup, instant noodles, risotto, and health food (Exhibit Ko 3, the entire import of oral argument).

B. The plaintiff registered "ハウス/HOUSE" and "ハウス" with an image as defensive trademarks. "ハウス" and "HOUSE" are famous as indications of the plaintiff (Exhibits Ko 174 to 176, the entire import of oral argument).

(2) E-mail newsletter

A. The plaintiff started distribution of "House Foods E-mail Newsletter [クラブハウス]" to all of the registered members on April 17, 2005 and, since then, has been distributing said e-mail newsletter twice a month during the three years prior to the preliminary registration of the request for a trial.

Any person who wants to receive said e-mail newsletter needs to visit the plaintiff's website, etc. and click the button "Subscribe to the e-mail newsletter [クラブハウス]" or the button "Register for subscription to the e-mail newsletter [クラブハウス]" on the webpage for registering for a subscription to the "E-mail newsletter クラブハウス." On the webpage "Subscribe to the E-mail Newsletter [クラブハウス]," a subscriber is required to input his/her mail address and click the button "Confirm your information" and goes to the page "Confirm your registered information to subscribe to the e-mail newsletter 'クラブハウス,'" and click a "Send" button to complete the registration procedure. A notice of completion of the registration procedure for the e-mail newsletter will be sent back to the subscriber. There were 4,850 subscribers as of April 2006, which gradually increased to 15,541 as of March 2009 (Exhibit Ko 186, Exhibits Otsu 4, 5-1 to 5-5).

B. The webpage for membership registration shows messages such as "The House Foods E-mail Newsletter [クラブハウス] is filled with information about food that you will find useful in your daily life, information about gifts & campaigns by House Foods, TV commercials, product information, etc. as well as updates about the House Foods Official Website (twice a month at no charge [irregular])." The e-mail newsletter that is actually distributed to members contains information about gift campaigns for the plaintiff's products, information about new products, information about TV commercials for the plaintiff's products, recipes that use the plaintiff's products, other information related to the plaintiff's products, tips on cooking, etc. The webpage introduces the following processed foods as the plaintiff's products: curry roux, instant curry, stew roux, instant stew, instant confectionery mix, instant soup cubes, ready-made soup, instant noodles, risotto, and health food. The plaintiff's e-mail newsletter provides many links (URLs of websites) so that subscribers can easily visit the plaintiff's websites. Any subscriber can click on a link to get immediate access to a product catalog on the plaintiff's website, which provides detailed information about the plaintiff's products (e.g., processed foods), or to a webpage of recipes that use the plaintiff's products (Exhibits Ko 178 to 185, 190-1 to 190-3, 191), where subscribers can see photographs and obtain relevant information (Exhibits Ko 28 to 99, 178 to 187, 190-1 to 190-3, 191, Exhibits Otsu 2, 3, 5-1).

C. In the e-mail newsletter distributed to the members, an indication "House Foods

E-mail Newsletter" is placed at the top, followed by a conspicuous indication "クラブハウス," each character of which is enclosed in a frame. The greetings section contains the words "House Foods E-mail Newsletter [クラブハウス]." The table of contents contains the expressions "クラブハウス members only" and "Web-version クラブハウス." The main text contains the expressions "the web-version of クラブハウス is a special members-only site of the text-version e-mail newsletter. Please visit the site for more information," and "Web-version クラブハウス." At the bottom of the e-mail newsletter, there are the statements, "House Foods E-mail Newsletter [クラブハウス] Administration and Editorial Office," etc. as well as "new products of House Foods," "Products of House Foods," etc. (Exhibits Ko 28 to 99, Exhibits Otsu 2, 3).

(3) Web version

A. Since March 2006, any member who received an e-mail newsletter from the plaintiff has been allowed to access the web-version クラブハウス by clicking on the URL (<http://housefoods.jp/mailmagazine/latest>) of the "Web-version クラブハウス" written below the message "The web-version クラブハウス is a special members-only site of the text-version e-mail newsletter. Please visit the site for more information." (Exhibits Ko 27 to 100, 186, Exhibit Otsu 3)

B. The web version of the newsletter contains information about gift event campaigns, the plaintiff's notices, easy and fun recipes, etc. Its specific content corresponds to that of the e-mail newsletter and contains information about the plaintiff's products (mostly consisting of processed foods). The web version also introduces various processed foods such as curry roux, instant curry, stew roux, instant stew, instant confectionery mix, instant soup cubes, and ready-made soup with photographs thereof and recipes that use those products. The web version also provides many links to allow subscribers to easily visit the webpages that show the plaintiff's products, etc. on the plaintiff's website. Any subscriber who clicks on a URL can have immediate access to product catalogs available on the plaintiff's website, which provides detailed information about the plaintiff's products, such as processed foods, and also to webpages of recipes that use the plaintiff's products (Exhibits Ko 102 to 172, 178 to 187, 190-1 to 190-3, 191, Exhibits Otsu 6, 8), where subscribers can see photographs and obtain relevant information.

C. The web version of the newsletter that is accessible by members indicates "Web-version クラブハウス/House Foods" on the upper left part of the pages and "House Foods" with a mark. Below that, there is a large image in which "クラブハウス" is written in a large letters and sandwiched between the illustration of a pot lid and the illustration of a pot. Also, "Web 版" (web version) is indicated in the "pot" illustration.

The web version also contains the statement "The web-version クラブハウス is a webpage that provides e-mail newsletter subscribers with even more interesting and wonderful information," etc. At the bottom of the web version, the statement "House Foods E-mail Newsletter [クラブハウス] Administration and Editorial Office," etc. is placed. Also, "ハウス食品" (House Foods) is indicated in several places (Exhibits Ko 102 to 172, Exhibits Otsu 6, 8).

2. Use or non-use of a trademark

(1) Use or non-use of a trademark for the designated goods

A. In order for a trademark to be recognized as having been used, it is not necessarily required to have been affixed to the designated goods. However, the trademark must have been used in a manner that has a specific connection with the designated goods (1967 (Gyo-Tsu) 32, Judgment of the Second Petty Bench of the Supreme Court of February 9, 1968, Minshu Vol. 22, No. 2, at 159).

B. As found in 1. above, the plaintiff used the mark "クラブハウス" in the e-mail newsletter and web version. The e-mail newsletter and web version provide information directly related to the plaintiff's products (mostly consisting of processed foods) and information about advertisements of the plaintiff's products. Therefore, the e-mail newsletter and web version play the role of advertising media for the plaintiff's products, in other words, as electronic leaflets designed to raise awareness and deepen the understanding of customers about the plaintiff's products. In this way, the e-mail newsletter and web version are distributed for the purpose of advertising the plaintiff's products, and a system has been established to allow subscribers to click any of the provided links and gain immediate access to product catalogs available on the plaintiff's website, which provides detailed information about the plaintiff's products such as processed foods, and also to other webpages where subscribers can see photographs and obtain relevant information. In light of this fact, the e-mail newsletter and web version can be considered to be advertisements of the plaintiff's products or information about the plaintiff's products. Thus, the mark "クラブハウス" used therein can be considered to have a specific connection with the plaintiff's processed foods.

Therefore, the mark "クラブハウス" can be considered to have been affixed to an advertisement of the plaintiff's products (mostly consisting of processed foods) or to information about such products of the plaintiff.

C. Regarding this point, the defendant alleged that the plaintiff used the mark "クラブハウス" only as the name and a source identifier of the plaintiff's e-mail newsletter and, therefore, that it does not constitute use of the trademark for the plaintiff's products. From this viewpoint, it cannot be denied that the use of the mark in the manner found in

1.(2) above shows that the indication "クラブハウス" was used as the name of the e-mail newsletter as well. However, unlike the use of a trademark specified in Article 2, paragraph (3), item (i) of the Trademark Act, the use specified in item (viii) of said paragraph does not require a trademark to be directly affixed to the designated goods. Furthermore, in consideration of the facts that subscribers can click a link to move to a product catalog provided on the plaintiff's webpage and see advertisements of the plaintiff's products (mostly consisting of processed foods) and that such advertisements can be considered to be a common form of an online advertisement (Exhibit Ko 189), it cannot be said that the indication "クラブハウス" cannot be considered to be an advertisement of the plaintiff's products.

Also, the defendant alleged that the plaintiff's e-mail newsletter and web version use the trademark "ハウス食品" as an indication for the plaintiff's products as a whole and use a different trademark for each of the plaintiff's products, and, therefore, that the indication of the mark "クラブハウス" does not constitute the use of the mark for the plaintiff's products. However, it is possible to affix two or more trademarks for each product. The use of the trademark "ハウス食品" as an indication of the plaintiff, which is the manufacturer and seller of the plaintiff's products, does not necessarily mean that the use of the mark "クラブハウス" in the e-mail newsletter and web version, which were distributed for the purpose of advertising the plaintiff's products, does not constitute the use of a trademark.

Moreover, the defendant alleged that the subscribers of the e-mail newsletter cannot be simply interpreted as general purchasers of foods. Those subscribers are limited to the members of the e-mail newsletter "クラブハウス." However, in light of the fact that any person can become a member of said e-mail newsletter for free, it cannot be said that the e-mail newsletter cannot be regarded as an advertisement.

D. Thus, the mark "クラブハウス" can be considered to have been affixed to an advertisement of the plaintiff's products (mostly consisting of processed foods) or to information about the plaintiff's products, and has been used in specific connection with the processed foods manufactured and sold by the plaintiff.

(2) Identicalness with the registered trademark

A. If the holder of a trademark right proves that he/she has been using a trademark that is considered to be identical, from a common sense perspective, with the registered trademark for the designated goods, the holder of the trademark right may be able to prevent the rescission of the registered trademark under Article 50 of the Trademark Act (Article 50, paragraph (2) of the Trademark Act). It is defined that "a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin

alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and concept" can be considered to be "a trademark deemed identical, from a common sense perspective, with the registered trademark" (paragraph (1) of said Article).

B. The mark "クラブハウス" affixed to the plaintiff's e-mail newsletter is identical with the lower line of the two horizontal lines comprising the Trademark. The mark can be considered to be identical with the Trademark in terms of pronunciation and concept. Thus, the aforementioned mark "クラブハウス" is a trademark that can be recognized as identical with the Trademark from a common sense perspective.

The indication "クラブハウス" with an image affixed to the plaintiff's web version of the newsletter consists of "クラブハウス" written in large characters in the image of a pot with "Web版" (web version) written in small letters in the illustration of a pot. The "クラブハウス" part can be associated with a certain pronunciation and concept. Consequently, it can be said that the indication "クラブハウス" is identical to the Trademark in terms of pronunciation and concept. Therefore, the indication "クラブハウス" with an image can be considered to be a trademark that is identical with the Trademark from a common sense perspective.

C. Regarding this point, the defendant alleged that the indication "クラブハウス" with an image affixed to the web version should be recognized in its entirety. However, from its appearance, it is clear that the "クラブハウス" part written in large characters can also be associated with a certain pronunciation and concept.

The defendant also alleged that "Web版クラブハウス," consisting only of characters affixed to the top of the web version of the newsletter should be recognized in its entirety. However, even if it is recognized in its entirety and is considered to have the possibility of being associated with a pronunciation, appearance, or concept that is different from that of the Trademark, the defendant's allegation is unacceptable because another indication "クラブハウス" with an image affixed to the web version of the newsletter can be considered to be identical with the Trademark from a common sense perspective as described above.

D. Thus, the mark "クラブハウス" affixed to the plaintiff's e-mail newsletter and the indication "クラブハウス" with an image affixed to the web version of the newsletter can be considered to be identical with the Trademark from a common sense perspective.

(3) Summary

As described above, the plaintiff affixed a trademark that can be considered to be identical with the Trademark from a common sense perspective to its e-mail newsletter and the web version containing advertisements of the plaintiff's products (mostly

consisting of processed foods) or containing information about the plaintiff's products; and the plaintiff provided them electronically in Japan within three years from the registration of the request for a trial. This act by the plaintiff falls under Article 2, paragraph (3), item (viii) of the Trademark Act.

Therefore, there was an error in the JPO decision that the plaintiff's act of using the mark "クラブハウス" does not fall under Article 2, paragraph (3), item (viii) of the Trademark Act and that there was no sufficient evidence to prove that, within three years from the registration of the request for a trial, the holder of the trademark right, the exclusive licensee, or a non-exclusive licensee used the Trademark in Japan for any of the designated goods mentioned in the request.

3. Conclusion

As described above, there are legitimate grounds for rescission alleged by the plaintiff. Therefore, the JPO decision shall be rescinded.

Intellectual Property High Court, Fourth Division

Presiding judge: TAKIZAWA Takaomi

Judge: TAKABE Makiko

Judge: HONDA Tomonari