

Trademark Right	Date	March 7, 2023	Court	Intellectual Property High Court, Fourth Division
	Case number	2022 (Gyo-Ke) 10101		
<p>- The trademark of this application has elements identical to the mark related to designation of signs or hallmarks indicating control and warranty by Malaysia designated and publicly notified by the Minister of Economy, Trade and Industry, and the designated goods are identical or similar to the goods for which the signs or hallmarks designated by the Minister are used and thus, the trademark falls under Article 4, paragraph (1), item [v] of the Trademark Act.</p> <p>- The Plaintiff asserted that the official translation in Japanese of Article 6-3(1)(a) of the Paris Convention has errors, but it cannot be considered to be erroneous grammatically, and in view of the drafting process of the provisions described above, it cannot be determined to be erroneous translation, and even if it has an error, our country is not obliged to withhold refusal of a registration application with the "permission of the competent authority" on the grounds of the Article, or it should not be construed, either, that the "registration should be made" by narrowing the application range of Article 4, paragraph (1), item (v) of the Trademark Act on the grounds of the Article.</p>				

Case type: Rescission of Appeal Decision

Result: Dismissed

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

Related rights, etc.: Appeal against Examiner's Decision of 2021-008337, Trademark Application No. 2019-117766

Summary of the Judgment

No. 1 Outline of the case

1 Outline of procedures at the JPO and the like

(1) The Plaintiff filed an application for trademark registration (Trademark Application No. 2019-117766, hereinafter, referred to as "the Application") for the trademark, which has the elements in attachment 1-1 to the judgment (hereinafter, referred to as "the Trademark") with the goods and services described in the Application belonging to Class 5, Class 10, Class 29, Class 30, Class 32, Class 42, and Class 43 as the designated goods and the designated services on September 4, 2019, but received a notice of reasons for refusal as of October 9, 2020. The Plaintiff submitted a written amendment as of January 21, 2021, but received the examiner's decision of refusal as of March 22 of the same year and thus, submitted a written amendment on June 24 of the same year (hereinafter referred to as "the Amendment") and filed the appeal against the examiner's decision of refusal.

(2) The Japan Patent Office examined the appeal as case of Appeal against Examiner's Decision of 2021-008337, rendered the decision (the JPO decision) that "the

appeal against the decision is dismissed" on May 18, 2022, and a certified copy thereof was delivered to the Plaintiff on June 1 of the same year.

(3) The Plaintiff filed a lawsuit against the JPO decision on September 29, 2022.

2 Outline of the JPO decision

The Trademark has elements identical to the mark related to the "designation of signs or hallmarks indicating control or warranty by Malaysia" (Ministry of Economy, Trade and Industry Public Notice No. 196, September 26, 2014) notified from the International Bureau of the World Intellectual Property Organization (WIPO) by Article 6-3(3) of the Paris Convention and specified and publicly notified by the Minister of Economy, Trade and Industry on the grounds of the provisions in Article 4, paragraph (1), item (v) of the Trademark Act, and the designated goods after the Amendment of the Trademark are identical or similar to the goods and services for which the signs or hallmarks designated by the Minister of Economy, Trade and Industry are used.

Therefore, since the Trademark is used for goods identical or similar to the goods for which the signs or hallmarks indicating control by the Malaysian government or the local government are used, it falls under Article 4, paragraph (1), item (v) of the Trademark Act.

No. 2 Summary of determination

1 Elements of the Trademark are as described in attachment 1-1 to the judgment and are identical to the elements designated by the Minister of Economy, Trade and Industry as signs and hallmarks indicating control and warranty by Malaysia. Moreover, the designated goods or the designated services of the Trademark are designated goods which are identical or similar to "Meat. Fish. Poultry and game. Meat extracts. Preserved, dried, and cooked fruits and vegetables. Jellies. Jams. Compotes. Eggs. Milk and other milk products. Oils and fats for food. Processed marine products. Rice. Soybeans. Mineral water. Aerated water and other non-alcoholic beverages. Fruit beverages and fruit juices." in the goods and services for which the signs and hallmarks indicating control and warranty by Malaysia designated by the Minister of Economy, Trade and Industry are used.

Then, even if the Plaintiff is a corporation, "which is a governmental organ based on the laws of Malaysia and has authority to dispose of and to manage property", the Trademark is a trademark which is identical to those designated by the Minister of Economy, Trade and Industry among the signs or hallmarks indicating control and warranty by the governments of the union countries of the Paris Convention and member countries of the World Trade Organization and used for goods which are identical or similar to the goods for which the signs or hallmarks are used and thus, it

falls under Article 4, paragraph (1), item (v) of the Trademark Act.

2 The Plaintiff asserted that, on the premise of the provisions (Article 29(1)(c)), in the case of a difference in interpretation of the Paris Convention, French sentences shall be used, "à défaut d'autorisation des pouvoirs compétents," (without authorization by the competent authorities) should be construed to relate not only to ", par des mesures appropriées," (to prohibit by appropriate measures) but also to "de refuser ou d'invalider l'enregistrement et d'interdire," (to refuse or to invalidate the registration), and the official translation of the provisions is erroneous translation, and Article 4, paragraph (1), item (v) of the Trademark Act based on that does not perform the enforcement obligation of the domestic laws in Article 6-3(1)(a) of the Paris Convention, but since the phrase "à défaut d'autorisation des pouvoirs compétents," (without authorization by the competent authorities) is inserted as an adverb phrase connected with "l'utilisation," by "," in the original, and the wording can be grammatically read as "à défaut d'autorisation des pouvoirs compétents," qualifies only "d'interdire ... l'utilisation" (to prohibit use) and also as it qualifies "de refuser ou d'invalider l'enregistrement et d'interdire," (to refuse or to invalidate the registration) and from the drafting process in which the wording "without authorization by the competent authorities" was drafted to qualify only the "d'interdire ... l'utilisation" at the beginning but it was rewritten to the original described above in the proposed convention presented by the Drafting Committee to the General Meeting and was finalized as it is, whereby two ways of grammatical construction were made possible, it cannot be determined that "à défaut d'autorisation des pouvoirs compétents," is erroneous translation of Article 6-3(1)(a) of the Paris Convention even on the premise that "à défaut d'autorisation des pouvoirs compétents," qualifies only "d'interdire ... l'utilisation" as in the official translation in Japanese.

Moreover, even if the construction as pointed out by the Plaintiff; that is, the construction that the registration as trademarks or as elements of trademarks of armorial bearings and the like of the countries of the Union "without authorization by the competent authorities" is refused or invalidated is adopted, the provisions do not prescribe how to handle the registration application with "authorization by the competent authorities" (it cannot be interpreted that, as the opposite construction to "to refuse or to invalidate the registration as trademarks or as elements of trademarks" of these armorial bearings, the allied nations are obliged by the Convention to naturally register the case other than the above) and thus, our country shall not bear the obligation not to refuse the registration application "with authorization by the competent authorities" on the basis of the Article above or shall not be interpreted to grant "the

registration" by narrowing the application range of Article 4, paragraph (1), item (v) of the Trademark Act on the grounds of the Article above.

Rendition of judgment on March 7, 2023

2022 (Gyo-Ke) 10101 Case of seeking rescission of JPO decision

Date of conclusion of oral argument: January 17, 2023

Judgment

Plaintiff: Jabatan Kemajuan Islam Malaysia (JAKIM)

Defendant: Commissioner of JPO

Main text

1. Plaintiff's appeal shall be dismissed.
2. Plaintiff shall bear the court costs.
3. An additional period of 30 days shall be set for filing a final appeal and a petition for acceptance of a final appeal against this judgment.

Facts and reasons

No. 1 Claim

Rescission of the decision made by the JPO on May 18, 2022 for the case of Appeal against Examiner's Decision of 2021-008337.

No. 2 Background

1. History of procedures at JPO (matters over which there is no dispute between the parties)
 - (1) On September 4, 2019, the Plaintiff filed an application for trademark registration (Trademark Application No. 2019-117766; hereinafter referred to as "the Application") for the trademark, which has the elements in Attachment 1-1 (hereinafter referred to as "the Trademark") with the designated goods and services described in the Application being the designated goods in Class 5, Class 10, Class 29, Class 30, Class 32, Class 42, and Class 43, but received a notice of reasons for refusal as of October 9, 2020. The Plaintiff submitted a written amendment as of January 21, 2021, but received the examiner's decision of refusal as of March 22 of the same year and thus, submitted a written amendment on June 24 of the same year (hereinafter referred to as "the Amendment") and filed the appeal against the examiner's decision of refusal (the designated goods after the Amendment are as per Attachment 1-2).

- (2) The Japan Patent Office examined the appeal as case of Appeal against Examiner's Decision of 2021-008337, rendered the decision (the JPO decision) that "the appeal against the decision is dismissed" on May 18, 2022, and a certified copy thereof was delivered to the Plaintiff on June 1 of the same year (the additional period for response was set for 90 days).
- (3) On September 29, 2022, the Plaintiff filed the lawsuit of the present case seeking rescission of the JPO decision.

2. Outline of the JPO decision

The Trademark has elements identical to the mark (Attachment 2-1) related to the "designation of signs or hallmarks indicating control or warranty by Malaysia" (Ministry of Economy, Trade and Industry Public Notice No. 196, September 26, 2014) notified from the International Bureau of the World Intellectual Property Organization (WIPO) by Article 6-3(3) of the Paris Convention and specified and publicly notified by the Minister of Economy, Trade and Industry on the grounds of the provisions in Article 4, paragraph (1), item (v) of the Trademark Act.

Furthermore, the designated goods after the Amendment of the Trademark are identical or similar to the goods and services for which the signs or hallmarks designated by the Minister of Economy, Trade and Industry are used (Attachment 2-2), at least in regard to the goods of "Meat. Fish. Poultry and game. Meat extracts. Preserved, dried, and cooked fruits and vegetables. Jellies. Jams. Compotes. Eggs. Milk and other milk products. Oils and fats for food. Processed marine products. Rice. Soybeans. Mineral water. Carbonated water and other non-alcoholic beverages. Fruit beverages and fruit juices."

In that case, the Trademark is a trademark which is used for goods which are identical or similar to the goods for which the signs or hallmarks indicating control by the Malaysian government or the local government are used and thus, it falls under Article 4, paragraph (1), item (v) of the Trademark Act.

3. Cause for rescission

Erroneous determination as to the applicability of Article 4, paragraph (1), item (v) of the Trademark Act

(omitted)

No. 4 Judgment of this court

1. Applicability of the Trademark to Article 4, paragraph (1), item (v) of the Trademark Act

(1) Article 4, paragraph (1) of the Trademark Act provides for the trademarks which cannot be granted trademark registration. In the same paragraph, item (v) stipulates as follows about a trademark which "comprises a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national government of Japan, a country party to the Paris Convention (Note inserted by the court: It refers to the "Paris Convention for the protection of industrial property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14 1967 (Japanese Treaty of March No. 2, March 1975")), a member of the World Trade Organization, or a Contracting Party to the Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if the trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used".

(2) A Malaysia [1] became a member state, on June 23, 1988, of the Paris Convention which was revised at Stockholm in 1967, effective on January 1, 1989, and remains a member of the same convention (Exhibit Otsu 5), and [2] on January 1, 1995, became a member state of the World Trade Organization, and remains as such (Exhibit Otsu 6).

B Malaysia notified Japan through the International Bureau of the World Intellectual Property Organization concerning the public signs or hallmarks indicating control and warranty by Malaysia, and on September 26, 2014, the Minister of Economy, Trade and Industry designated and publicly notified the signs or hallmarks indicating control or warranty by Malaysia, as indicated in Attachment 2-1 and notified by Malaysia, as the designated goods or designated services of Attachment 2 (Public Notice of the Ministry of Economy, Trade and Industry No. 196 of 2014).

(3) A Elements of the Trademark are as described in Attachment 1-1 and are identical to the elements, as indicated in Attachment 1-2, designated by the Minister of Economy, Trade and Industry as signs and hallmarks indicating control and warranty by Malaysia, as indicated in Attachment 1-2.

B The designated goods or designated services of the Trademark are as indicated in Attachment 1-2, and are identical or similar to the goods or services for which the signs or hallmarks indicating control or warranty by the Malaysian government designated by the Minister of Economy, Trade and Industry are used,

as per Attachment 1-2, with regard to the goods of "Meat. Fish. Poultry and game. Meat extracts. Preserved, dried, and cooked fruits and vegetables. Jellies. Jams. Compotes. Eggs. Milk and other milk products. Oils and fats for food. Processed marine products. Rice. Soybeans. Mineral water. Carbonated water and other non-alcoholic beverages. Fruit beverages and fruit juices."

- (4) Then, even if the Plaintiff is a corporation, "which is a governmental organ based on the laws of Malaysia and has authority to dispose of and to manage property" (Exhibit Otsu 1), the Trademark is a trademark which is identical to those designated by the Minister of Economy, Trade and Industry among the signs or hallmarks indicating control or warranty by the governments of the union countries of the Paris Convention and member countries of the World Trade Organization and is used for goods which are identical or similar to the goods for which the signs or hallmarks are used and thus, it falls under Article 4, paragraph (1), item (v) of the Trademark Act.
2. As described above in 1 (1), the Plaintiff asserted that, on the premise of the provisions (Article 29(1)(c)), in the case of a difference in interpretation of the Paris Convention, French sentences shall be used, "à défaut d'autorisation des pouvoirs compétents," (without authorization by the competent authorities) in Article 6-3(1)(a) of the Paris Convention should be construed to relate not only to ", par des mesures appropriées," (to prohibit by appropriate measures) but also to "de refuser ou d'invalider l'enregistrement et d'interdire," (to refuse or to invalidate the registration), and the official translation of the provisions is erroneous translation, and Article 4, paragraph (1), item (v) of the Trademark Act based on that does not perform the enforcement obligation of the domestic laws in Article 6-3(1)(a) of the Paris Convention.

However, the phrase "à défaut d'autorisation des pouvoirs compétents," (without authorization by the competent authorities), as pointed out by the Plaintiff, is inserted as an adverbial phrase connected with "l'utilisation," by "," in the original, and the wording can be grammatically read such that "à défaut d'autorisation des pouvoirs compétents," qualifies only "d'interdire ... l'utilisation" (to prohibit use) and also as it qualifies "de refuser ou d'invalider l'enregistrement et d'interdire," (to refuse or to invalidate the registration) and from the drafting process in which the wording "without authorization by the competent authorities" was drafted to qualify only the "d'interdire ... l'utilisation" at the beginning but it was rewritten to the original described above in the proposed convention presented by the Drafting

Committee to the General Meeting and was finalized as it is, whereby two ways of grammatical construction were made possible, as pointed out in Written Opinion [A]. As such, it cannot be determined that "à défaut d'autorisation des pouvoirs compétents," is erroneous translation of Article 6-3(1)(a) of the Paris Convention even on the premise that "à défaut d'autorisation des pouvoirs compétents," qualifies only "d'interdire ... l'utilisation" as in the official translation in Japanese.

Moreover, even if the construction as pointed out by the Plaintiff; that is, the construction that the registration as trademarks or as elements of trademarks of armorial bearings and the like of the countries of the Union "without authorization by the competent authorities" is refused or invalidated is adopted, the provisions do not prescribe how to handle the registration application with "authorization by the competent authorities" (it cannot be interpreted that, as the opposite construction to "to refuse or to invalidate the registration as trademarks or as elements of trademarks" of these armorial bearings, the allied nations are obliged by the Convention to naturally register the case other than the above) and thus, our country shall not bear the obligation not to refuse the registration application "with authorization by the competent authorities" on the basis of the Article above or shall not be interpreted to grant "the registration" by narrowing the application range of Article 4, paragraph (1), item (v) of the Trademark Act on the grounds of the Article above.

3. Even when various other arguments made by the Plaintiff are closely examined, there are no grounds to support the obligation to grant registration when competent authorities or a person authorized by the competent authorities file an application for registration of a sign or hallmark indicating control and warranty as stipulated in Article 6-3(1)(a) of the Paris Convention. Accordingly, it must be said that the Plaintiff's argument that is made on the grounds of default under the same Article is unreasonable in any case.
4. In view of the above, there is no need to determine other matters, and the cause for rescission as asserted by the Plaintiff is groundless, and the Plaintiff's appeal shall be dismissed.

Therefore, the court renders a judgment as per the main text.

Intellectual Property High Court, Fourth Division

Presiding judge: KANNO Masayuki

Judge: NAKAMURA Kyo

Judge: OKAYAMA Tadahiro

Attachment 1

1. The Trademark



2. Designated goods (after the Amendment)

Class 29 "Meat; Fish; Not live poultry; Not live game; Meat extracts; Charcuterie; Crystallized ginger; Processed vegetables and processed fruit; Jellies for food; Meat jellies; Fruit jelly; Jams; Compotes; Eggs; Milk products; Edible fats; Crackers made of fried, thinly-sliced fish-meat pastes; Edible seafood (except live fish and shellfish); Processed marine products; Desiccated coconut; Coconut butter; Coconut milk; Coconut milk-based beverages; Coconut-based foodstuffs; Dried red pepper; Fish-meat pastes; Meat pastes; Pastes made from not live game; Vegetable-based pastes; Nut-based pastes; Soybeans; Preserved soybeans"

Attachment 2

1. Designation of signs or hallmarks indicating control and warranty by Malaysia



2. Goods and services for which the sign or hallmark is used

Transport. Packaging and storage of goods. Arrangement of travel. Treatment of materials. Scientific and technological services as well as research and design relating thereto. Industrial analysis and research. Design and development of computer hardware and software. Legal services. Services for providing food and drink. Temporary accommodation. Medical services. Veterinary services. Hygienic and beauty care for human beings or animals. Agriculture, horticulture, and forestry services. Chemicals for use in industry, science, and photography, as well as in agriculture, horticulture, and forestry. Unprocessed artificial resins, unprocessed plastics. Fertilizers. Fire extinguishing compositions. Tempering and soldering preparations. Chemical substances for preserving foodstuffs. Tanning substances. Adhesives for industrial purposes. Acids. Food additives. Flavorings. Colorants. Carbon. Gas. Bleaching preparations and other substances for laundry use. Cleaning, polishing, scouring, and abrasive preparations. Soaps. Perfumery, perfumes, cosmetics, hair lotions. Dentifrices. Industrial oils and greases. Lubricants. Dust absorbing, wetting, and binding compositions. Fuels (including fuels for motors and engines) and illuminants. Candles and wicks. Pharmaceuticals, and veterinary preparations. Sanitary preparations for medical purposes. Dietetic food and substances adapted for medical or veterinary use, food for babies. Plasters, materials for dressings. Paste fillers for teeth, dental wax.

Disinfectants. Preparations for destroying vermin. Fungicides. Herbicides. Health products. Dietary supplements, antiseptics. Babies' bottles and pacifiers. Surgical, medical, dental, and veterinary apparatus and instruments, and artificial limbs, eyes, and teeth. Orthopedic articles. Suture materials. Paper and cardboard, and goods that are made of those materials and do not belong to other classes. Printed matters. Photographs. Stationery. Adhesives [glues] for stationery or household purposes. Artists' materials (stationery). Paintbrushes. Typewriters and office requisites (except furniture). Teaching materials (except apparatus). Plastic products for packing (except those belonging to other classes). Playing cards. Letters (type). Printing blocks. Rubber, gutta-percha, gum, asbestos, mica, and goods that are made of those materials and do not belong to other classes. Extruded plastics for use in manufacturing. Materials for stuffing, stopping, and insulating. Flexible hoses, not of metal. Leather and artificial leather as well as goods that are made of those materials and do not belong to other classes. Animal skins. Trunks and traveling bags. Umbrellas, parasols, and walking sticks. Whips, harness traces, and saddlery. Tools and containers for household or kitchen use (not made of or plated with metal). Combs and sponges. Brushes (other than paint brushes). Material for brush-making. Cleaning apparatus. Steel wool for cleaning. Unworked or semi-worked glass, except building glass. Glassware, porcelain, and ceramic products that do not belong to other classes. Clothing, shoes, hats. Meat. Fish. Poultry and game. Meat extracts. Preserved, dried, and cooked fruits and vegetables. Jellies. Jams. Compotes. Eggs. Milk and other milk products. Oils and fats for food. Crackers. Seafood and processed marine products. Coconut and coconut-based foodstuffs. Chili. Paste. Coffee, tea, cocoa, sugar, rice, tapioca, sago, and coffee substitutes. Foodstuffs made from flour and grains. Bread. Pastries (dough) and confectionery. Edible ices. Honey. Molasses. Yeast. Baking powder. Salt. Mustard. Vinegar. Sauces (condiments). Spices. Ice. Food flavorings. Biscuits. Soybeans and products made from soybeans. Chocolate and chocolate-based products. Turmeric. Ginger. Asian flatsedge. Noodles. Food additives. Products from agriculture, horticulture, and forestry, and grains that do not belong to other classes. Live animals. Fresh fruit and vegetables. Seeds, and plants and flowers from nature. Fodder. Malt. Mineral water, carbonated water, and other non-alcoholic beverages. Fruit juice beverages and fruit juices. Syrups and other preparations for making beverages.