

Trademark Right	Date	March 26, 2019	Court	Intellectual Property High Court, Second Division
	Case number	2017(Gyo-Ke) 10206		
- A case in which the court held that a trademark consisting of an animal figure falls under Article 4, paragraph (1), item (xv) of the Trademark Act.				

Case type: Rescission of Trial Decision to Maintain

Result: Granted

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

Number of related rights, etc.: Trademark Registration No. 5392943, Trademark Registration No. 4637003

Summary of the Judgment

1. The defendant is the trademark holder of the following trademark (Trademark Registration No. 5392943; the "Trademark").

The plaintiff demanded for invalidation trial of registration of the Trademark (Invalidation Trial No. 2016-890014), and the JPO made the trial decision dismissing the request for invalidation trial.



2. While the Trademark and the following trademark (Trademark Registration No. 4637003; the "Cited Trademark") are different in silhouette, and because of the presence or lack of a design that is outlined by a white line inside, and other features, the two trademarks are similar in the entire silhouette. In the Trademark, the area covered by the features; namely, the design that is outlined in white and shaped like teeth, the decorative design around the neck, the decoration (or the design of curly hair) around the joints of the foreleg and hind leg, and the white line generally outlining the contour, is relatively small in the entire silhouette of the Trademark.

Accordingly, while it can be acknowledged that the Trademark and the Cited Trademark are different in appearance, it can be said that the impression given by

the entire appearance is considerably similar.



In addition, when the Trademark and the Cited Trademark are compared, the Trademark generates the concept of some kind of four-legged animal and does not generate any particular sound, and the Cited Trademark is different from the Trademark in that the Cited Trademark generates the concept of the brand, "PUMA", and the sound of "*poo-ma*". Given the foregoing, it cannot be said that the difference between the two trademarks would be more distinct as compared with the case in which the Trademark were to generate a specific concept of something more than a four-legged animal or to generate a specific sound, and if the concept and sound were not similar to those of the Cited Trademark upon comparison.

3. The Cited Trademark has become a well-known trademark that is widely recognized by traders and consumers in Japan as a trademark indicating clothing, caps, hats, and the like of the brand, "PUMA", pertaining to the plaintiff's business.

While the designated goods of the Trademark are "tee-shirts; headgear for wear", the brand, "PUMA", also covers products of T-shirts, caps, and hats, and products bearing the figure shaped like the Cited Trademark have existed from before. As such, it can be said that the designated goods of the Trademark are related to the products pertaining to the plaintiff's business in terms of nature, use, and purpose, and it can be acknowledged that the traders and consumers of the two trademarks are in common.

Furthermore, the "tee-shirts; headgear for wear," which are designated goods of the Trademark, are products which are purchased by the consumer public.

4. When the circumstances described above are comprehensively taken into account, it is acknowledged that, if the Trademark is used for the designated goods based on the attention normally paid by traders and consumers of T-shirts, caps, and hats, which are designated goods of the Trademark, there is a risk of causing the misunderstanding that said goods pertain to the business of the plaintiff, or to

the business of a business operator who has a certain close business relationship with the plaintiff, or of a business operator who belongs to the group which operates the business of commoditizing products using the same indication as the plaintiff.

Accordingly, it can be said that the Trademark "is likely to cause confusion," as stipulated in Article 4, paragraph (1), item (xv) of the Trademark Act.

5. Based on the above, the registration of the Trademark is in violation of Article 4, paragraph (1), item (xv) of the Trademark Act.

Judgment rendered on March 26, 2019

2017 (Gyo-Ke) 10206 A case of seeking rescission of the JPO decision

Date of conclusion of oral argument: December 17, 2018

Judgment

Plaintiff: Puma SE

Defendant: Y

Main text

1. The decision made by the JPO on July 7, 2017 for Invalidation Trial No. 2016-890014 shall be rescinded.
2. Defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

The same gist as the main text.

No. 2 Outline of the case

The present case is a suit against the JPO's decision which rejected the demand for a trial for trademark invalidation. The point at issue concerns applicability of Article 4, paragraph (1), items (xi), (xv), and (vii) of the Trademark Act.

1. The trademark of the present case

Defendant is the holder (Exhibits Ko 1-1, 1-2) of the trademark shown below (hereinafter referred to as "Trademark").



[i] Registration No. 5392943

[ii] Date of filing: April 12, 2008

- [iii] Date of decision for registration: January 11, 2011
- [iv] Date of registration: February 25, 2011
- [v] Classification of goods and services, and designated goods or services
Class 25: Tee-shirts; Headgear for wear

2. Outline of procedures at the JPO

On February 25, 2016, Plaintiff requested to the JPO for a trial for invalidation of registration of the Trademark, which, Plaintiff claimed, falls under Article 4, paragraph (1), items (vii), (xi), and (xv) of the Trademark Act (Invalidation Trial No. 2016-890014; hereinafter referred to as "Request for Trial").

On July 7, 2017, the JPO rendered a decision to the effect that "the request for a trial is dismissed" (hereinafter referred to as "JPO Decision"), and a certified copy of the JPO decision was delivered to Plaintiff on the 18th of the same month.

3. Gist of the reasons given in the JPO Decision

(1) Prominence of the cited trademark

A. The cited trademark is as shown below, and it is currently valid.



- [i] Registration No. 4637003
- [ii] Date of filing: April 24, 2002
- [iii] Date of registration: January 17, 2003
- [iv] Classification of goods and services, and designated goods or services

Class 25: Clothing; Garters; Sock suspenders; Suspenders [braces]; Waistbands; Belts for clothing; Footwear [other than special footwear for sports]; Masquerade costumes; Clothes for sports; Special footwear for sports

B. At the time of filing of the application for registration of the Trademark, the cited trademark was widely recognized as a trademark that indicates the sports shoes, clothing, bags, and the like pertaining to Plaintiff's business and was a well-known

and famous trademark among traders and consumers in Japan. This circumstance has continued to this day, including the time of the decision for registration of the Trademark and thereafter.

(2) Applicability of Article 4, paragraph (1), item (xi) of the Trademark Act

A. Comparison between the Trademark and the cited trademark

(A) Appearance

a. Points in common

The Trademark and the cited trademark have the following points in common. First, a four-legged animal is drawn in silhouette, as seen from the side, in the pose of jumping up from the right side to the upper left direction, with the front paws set wide apart from the hind paws. The figures of the animals in the respective trademarks give similar impressions with regard to the direction they face and their basic postures, as well as the angle of their jump, the way the front and hind paws are curled up, the way they stretch out and the angle thereof, and the way in which the chest, back, and paws are drawn with a curved line.

b. Points of difference

The head part of the animal figure of the Trademark is drawn relatively larger than that of the animal of the cited trademark, and the Trademark has a white line drawn along the outline and the like, and furthermore, the animal figure of the Trademark has a teeth-like design near the mouth a collar-like design, as well as decorations or curl-like designs on the joints of front and hind paws, and the tail of the animal figure has an overall round shape, with a sharpened tip, and has decorations or curl-like designs drawn thereon.

On the other hand, the animal figure of the cited trademark does not have anything like a design, and is entirely colored in black like a silhouette, with a tail that is generally slim and that bows high upward in the upper right direction, with only the tip having a slightly round shape.

c. Summary

As described above, while the impressions given by the overall shapes of the Trademark and the cited trademark are similar, the two trademarks are noticeably different in the head part, neck part, leg part, and the tail part, which make up the entire figure, and since these differences are clearly observable, the two trademarks are clearly different in appearance.

(B) Sound and concept

While the Trademark does not generate any specific sound and concept, the cited trademark generates the sound of "poo-ma" or "pyu-ma" and the concept of "a brand

for PUmA", so that the Trademark and the cited trademark are different in sound and concept.

B. Conclusion

As described above, the Trademark and the cited trademark are clearly different in appearance, and it is also unlikely that they would create confusion in sound and concept.

In that case, even if the Trademark and the cited trademark are used for the same or similar goods, it cannot be said that there is likelihood of misleading and causing confusion as to the source of the goods, so the Trademark does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act.

(3) Applicability of Article 4, paragraph (1), item (xv) of the Trademark Act

As described above in (2), the Trademark and the cited trademark are not similar and should be regarded as different trademarks.

In that case, even if the Trademark is used by the trademark holder of the present case for the designated goods, the use will not cause traders and consumers to think of or be reminded of the cited trademark, which pertains to Plaintiff's business, and it should be said that there is no likelihood of causing confusion as to the source of the goods bearing the Trademark as if they pertain to the business of Plaintiff or of a person who is somehow related to Plaintiff, financially or structurally.

Accordingly, it cannot be said that, at the time of the filing of the application for registration, and at the time of the decision for registration, the Trademark was "likely to cause confusion" as prescribed in Article 4, paragraph (1), item (xv) of the Trademark Act, and thus the Trademark does not fall under said item.

(4) Applicability of Article 4, paragraph (1), item (vii)

A. The constitution of the Trademark is not in itself a letter or figure that is unethical, vulgar, discriminatory, or extreme, or that gives an unpleasant impression to others.

B. There does not seem to be any of the following circumstances; namely, that the use and the like of the Trademark are prohibited by any law other than the Trademark Act, or the circumstance according to which use of the Trademark for its designated goods is against the interests of social and public welfare, thereby being against the generally accepted sense of morality of society, or the circumstance according to which the Trademark is insulting to a specific country or its people, or is generally against international fidelity.

C. There does not seem to be any specific circumstance according to which the background to filing the application for registration of the Trademark lacks social

adequacy or according to which granting registration should be deemed to be utterly unacceptable due to violation of the order intended by the Trademark Act, and there also does not seem to be any circumstance according to which the background to filing the application for registration of the Trademark lacks social adequacy, thereby being in violation of the order intended by the Trademark Act.

D. Accordingly, it cannot be said that the Trademark falls under a trademark that "is likely to negatively affect public policy", and since it also cannot be said that the Trademark falls under such trademark once registration is granted, the Trademark does not fall under Article 4, paragraph (1), item (vii) of the Trademark Act.

(omitted)

No. 5 Judgment of this court

1. Concerning Reason 2 for Rescission (applicability of Article 4, paragraph (1), item (xv) of the Trademark Act)

In light of the nature of the case, Reason 2 for Rescission (applicability of Article 4, paragraph (1), item (xv) of the Trademark Act) shall be considered first.

(1) Description of the Trademark

A. Appearance

In the Trademark, the figure of a four-legged animal that has a head part with two ears, no space between the head part and the front paws, and a large tail that is partially curled up, is drawn in silhouette as seen from the side, looking as if to jump upward from the right to the left, with the head part and the front paws positioned so as to be in the upper left position from the hind paws, and with the front paws at the front and the hind paws at the back set wide apart. Inside this figure is a white line drawn basically along the outline, and a teeth-like design is drawn around the mouth, and around the neck is a decorative, jagged design, and on the joints of front and hind paws are decorations or curl-like designs, drawn with white lines. The tail is roundish overall and has a sharpened tip.

B. Concept

One can be reminded of a four-legged animal from the Trademark, but one is not reminded immediately of a specific animal; although the Trademark generates the concept of some kind of a four-legged animal, it does not produce a concept that is any more specific.

C. Sound

One can be reminded of a four-legged animal from the Trademark, but one is not

reminded immediately of a specific animal; thus the Trademark does not generate a specific sound.

D. Concerning Defendant's claim

Defendant claims that Defendant created the Trademark with the intention of having the Trademark generate the concept of the "Shisa" (expressed by Defendant as "シーサ"), Okinawa's traditional lion dog statue.

It is interpreted that the above word, "シーサ", used by Defendant refers to the same thing as the "Shisa" (which may be written as "シーサ" or "シーサー" in Japanese), which means "lion-san" in Okinawa. It is an ordinary pottery statue of a Chinese lion placed on roof tiles and the like, and is a kind of an amulet (Kojien, 7th Edition; Exhibit Ko 5). The "Shisa" may take various forms, and the characteristics which are generally considered to be the characteristics of the "Shisa" include a mane, collar, bared fangs, swirly fur, and a thick and fluffy tail. The head accounts for a considerably large portion of the entire body, and the eye and the mouth are also large. As for the posture, it is often the case that the Shisa has its upper part of the body elevated, with the front paws on the ground, but there are various forms, including the posture of being on all fours, the posture of slouching forward, and the posture of standing upright only on hind legs, and in many cases, the tail stands on end like fire towards the sky, with the tip being narrowed (Exhibit Ko 6).

Upon comparison of the Trademark with the aforementioned ordinary "Shisa", characteristics such as the collar-like design, the decorations or curl-like designs on the joints of front and hind paws, and the shape of the tail that is roundish overall and has a sharpened tip are all identical to those which are considered to be characteristics of the ordinary "Shisa". However, in the Trademark, the head accounts for a considerably small portion of the entire body, and although a jagged white line is drawn in a place which is equivalent to the mouth, there is nothing visible drawn in a place that is equivalent to the eye, and it cannot be said that the posture of setting the front paws and hind paws wide apart as if to jump upward is a commonly-used shape for the "Shisa".

In that case, while the figure of the Trademark may be observed as a representation of a four-legged animal, it is difficult to observe the figure of the Trademark as a representation of the "Shisa".

Accordingly, it cannot be acknowledged that the Trademark generates the concept of the "Shisa".

(2) Description of the cited trademark

A. Appearance

In the cited trademark, the figure of a four-legged animal that has a head part with two ears, a space between the head part and the front paws, and a tail which is generally slim and which bows high upward in the upper right direction, with the tip having a slightly round shape, is drawn in black like a silhouette, as seen from the side, looking as if to jump upward from the right to the left, with the head part and the front paws positioned so as to be in the upper left position from the hind paws, and with the front paws at the front and the hind paws at the back set wide apart.

B. Concept

The cited trademark was granted registration as a trademark on January 17, 2003. Even prior to the trademark registration, Plaintiff engaged in activities such as selling products of Tee-shirts bearing a figure that is shaped like the cited trademark (Exhibit Ko 8-1), and on the cover of a catalogue featuring headgear, placing a figure that is shaped like the cited trademark, except for said figure being outlined in white, and that has horizontal lines positioned inside (Exhibits Ko 8-3, 8-5), and on the cover of a catalogue featuring Tee-shirts, placing a figure that is shaped like the cited trademark, except for said figure being outlined in white, near the letters, "PUmA" (Exhibit Ko 8-4). After the cited trademark was registered, Plaintiff sold products which are clothes for sports and headgear bearing a figure that is shaped like the cited trademark (Exhibits Ko 9-1, 9-3, 9-4, Exhibits Ko 31-1, 31-3, 31-4, Exhibits Ko 32-1, 32-3, 32-4), and in the ads for the magazines for these products, placed a figure that is shaped like the cited trademark, near the letters, "PUmA" (Exhibits Ko 9-1, 9-4, Exhibits Ko 31-1, 31-3, 31-4, Exhibits Ko 32-1, 32-3, 32-4), among other activities, and when the entire import of the oral argument is taken into consideration along with the foregoing, it is acknowledged that the cited trademark was, at the time of the filing of the application for registration of the Trademark (April 12, 2008) and at the time of the decision for registration (January 11, 2011), widely recognized as one of the trademarks indicating the clothing and headgear and the like for the "PUMA" brand, which pertains to Plaintiff's business, and had become a well-known and famous trademark among traders and consumers of Japan.

Accordingly, the cited trademark generates the concept of the "PUMA" brand.

C. Sound

As described in above in B, the cited trademark generates the sound of "poo-ma".

(3) Comparison between the Trademark and the cited trademark

A. Appearance

(A) Points in common

The Trademark and the cited trademark have the following points in common.

The figure of a four-legged animal that has a head part with two ears is drawn in silhouette, as seen from the side, looking as if to jump upward from the right to the left, with the head part and the front paws positioned so as to be in the upper left position from the hind paws, and with the front paws at the front and the hind paws at the back set wide apart.

Next, the figures of the animals in the respective trademarks give similar impressions with regard to the direction they face and their basic postures, as well as the angle of their jump, the way the front and hind paws are curled up, the way they stretch out and the angle thereof, and the way in which the chest, back, and paws are drawn with a curved line.

(B) Points of difference

In the animal figure of the Trademark, the head part is drawn in a relatively larger size than that of the animal of the cited trademark, and there is no space between the head part and the front paws, and the front paws and the hind paws are relatively thick, and the tail is large. Furthermore, the animal figure of the Trademark has a teeth-like design near the mouth and a decorative, jagged design around the neck, and has decorations or curl-like designs on the joints of front and hind paws, all written with white lines, and has a tail that has an overall round shape, with a sharpened tip, and has decorations or curl-like designs drawn thereon with white lines, and on the inside of the figure is a white line drawn basically along the outline.

On the other hand, in the animal figure of the cited trademark, the head part is drawn in a relatively small size compared to the animal figure of the Trademark, with a space between the head part and the front paws, and the tail is generally slim and bows high upward in the upper right direction, with the tip having a slightly round shape. The figure does not have anything like a design on the inside, and the entire figure is colored in black like a silhouette.

B. Concept

While the Trademark generates the concept of some kind of a four-legged animal, the cited trademark generates the concept of the "PUMA" brand.

C. Sound

While the Trademark does not generate a specific sound, the cited trademark generates the sound of "poo-ma".

D. Review

(A) As described above in A, the Trademark and the cited trademark are different in silhouette and in whether or not there is a design of a white line on the inside, among other points, but the two trademarks are similar in the overall silhouette, and in

the Trademark, the area, which is covered by a teeth-like design drawn in white on the inside, and a decorative design around the neck, decorations or curl-like designs on the joints of front and hind paws, and a white line drawn generally along the outline, is relatively small.

Accordingly, while it can be acknowledged that the Trademark and the cited trademark are different in appearance, it can be said that the impressions of the overall appearances are considerably similar.

In addition, as described above in B and C, the Trademark and the cited trademark are different in that while the Trademark generates the concept of some kind of a four-legged animal and no specific sound, the cited trademark generates the concept of the "PUMA" brand and the sound of "poo-ma". However, it cannot be said that the difference is clearer than the case in which the Trademark generates a concept of something that is more specific than "some kind of a four-legged animal", along with a specific sound, and in which such concept and sound are not similar to the concept and sound of the cited trademark.

(B) As described above in (2)B, the cited trademark had become widely recognized as a trademark that indicates the clothing and headgear and the like of the "PUMA" brand, which pertains to Plaintiff's business, and had become a well-known and famous trademark among traders and consumers of Japan.

In addition, while the designated goods for the Trademark are "Tee-shirts; Headgear for wear", Tee-shirts and headgear are also sold as products of the PUMA brand, as described above in (2)B, and there also existed products bearing a figure shaped like the cited trademark. Accordingly, it can be said that the designated goods for the Trademark are related to the products which pertain to Plaintiff's business in terms of their nature, usage, and purpose, so that the two trademarks share the same traders and consumers.

Furthermore, the "Tee-shirts; Headgear for wear", which are designated goods for the Trademark, are goods which are purchased by the consumer public.

(C) When these circumstances are comprehensively taken into consideration, if the Trademark is used for the designated goods for the Trademark on the basis of the attention normally paid by consumers and traders of Tee-shirts and headgear, which are designated goods for the Trademark, it is acknowledged that there is likelihood of causing the misunderstanding that said goods are the goods which pertain to the business of Plaintiff or the business of a business operator who has certain business ties with Plaintiff or who belongs to a group which operates the commercialization business using the same indication as Plaintiff.

Accordingly, it can be said that the Trademark has the "likelihood of causing confusion" as prescribed in Article 4, paragraph (1), item (xv) of the Trademark Act.

2. Conclusion

Based on the above, registration of the Trademark is in violation of Article 4, paragraph (1), item (xv) of the Trademark Act; thus Rescission Reason 2 is deemed reasonable without having to consider other points, and the JPO Decision shall be rescinded.

Therefore, the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Second Division

Presiding judge: MORI Yoshiyuki

Judge: MORIOKA Ayako

Judge: FURUSHO Ken