

Trademark Right	Date	August 5, 2024	Court	Intellectual Property High Court, Fourth Division
	Case number	2024 (Gyo-Ke) 10007		
<p>- A case in which the court determined that the Trademark in the Application consisting of the alphabetic characters "Jimny Fan" and katakana "ジムニーファン" in two tiers does not fall under Article 4, paragraph (1), item (xi) and item (xv) of the Trademark Act, and rescinded the decision of the JPO which determined that the appeal against the examiner's decision of refusal is groundless.</p>				

Case type: Rescission of Appeal Decision of Refusal

Result: Granted

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

Decision of the JPO: Appeal against Examiner's Decision of Refusal 2023-12344

Summary of the Judgment

1. This is a litigation rescinding a trial decision to the effect that an appeal against the examiner's decision of refusal is groundless with regard to a trademark (hereinafter referred to as the Trademark in the Application) that consists of the alphabetic characters "Jimny Fan" and katakana "ジムニーファン" in two tiers and for which the designated goods are Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles" (hereinafter referred to as the "Amended Goods in the Application").

The JPO determined as follows: [i] the Trademark in the Application has the alphabetic characters "Jimny" and katakana "ジムニー" in its configuration that give a strong and dominant impression; when making a determination of the similarity of the trademarks by extracting these letters as the main part of the Trademark in the Application, it is a trademark similar to cited trademark 1 (the appearance of "Jimny," the pronunciation of "Jimunii," and the concept of "the name of Suzuki's off-road vehicle") and cited trademark 2 (the appearance of the alphabetic characters of "JIMNY" and katakana "ジムニー (Jimny)," the pronunciation of "Jimunii," and the concept of "the name of Suzuki's off-road vehicle"), and therefore, it falls under Article 4, paragraph (1), item (xi) of the Trademark Act; and [ii] even if the Trademark in the Application does not fall under said item, it is similar to the well-known Jimny Trademark (the one indicating the name of Suzuki's off-road vehicle) in its appearance, and the pronunciation of "Jimunii" and the concept of "the name of Suzuki's off-road vehicle" are the same; therefore, they are mutually confusing trademarks and traders

and consumers are likely to confuse the source as if the goods are related to the business of Suzuki or of a person who has an economic or organizational relationship with Suzuki; consequently the Trademark in the Application falls under item (xv) of said paragraph. Thus, the JPO determined that the appeal by the Plaintiff (demandant) was groundless.

2. In this judgment, the court found the actual transaction conditions concerning the Amended Goods in the Application through examination of the representative of the Plaintiff, determined that the Trademark in the Application did not fall under Article 4, paragraph (1), item (xi) and item (xv) of the Trademark Act, upheld the appeal by the Plaintiff, and rescinded the JPO decision.

(1) From the appearance of the Trademark in the Application, there is no basis to observe the part of "Jimny" and "ジムニー" and the part of "Fan" and "ファン" separately. Even if the Jimny Trademark is widely known as an indication of the name of an off-road vehicle manufactured and sold by Suzuki, in light of the actual transaction conditions of the Amended Goods in the Application, it is difficult to deem that traders and consumers who come into contact with the Amended Goods in the Application using the Trademark in the Application recognize that Suzuki or any of other automobile manufacturers or their affiliated car dealers, etc. is (or might be) the publishers of the relevant magazine. Comparing the Trademark in the Application with the cited trademarks on the premise of the observation of the Trademark in the Application as a whole, both cited trademark 1 and cited trademark 2 lack the configuration corresponding to "Fan" and "ファン," which are constituent parts of the Trademark in the Application. The Trademark in the Application and cited trademark 1 and cited trademark 2 are different in the appearance as a trademark as a whole, as well as in terms of the pronunciation and the concept. Therefore, their similarity cannot be affirmed and the Trademark in the Application does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act.

(2) The Amended Goods in the Application are extremely niche goods, Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles." There are no facts found that Suzuki and other automobile manufacturers have published "magazines related to parts and accessories used for the modification of off-road vehicles" by themselves or through their affiliated car dealers, etc. It is difficult to consider that traders and consumers who come into contact with the Amended Goods in the Application using the Trademark in the Application recognize that Suzuki or any of other automobile manufacturers or their affiliated car dealers, etc. is (or might be) its publishers. Even if the Trademark in the Application is used with the Amended

Goods in the Application, there is no possibility of causing confusion with the goods and services relating to the Jimny Trademark of Suzuki. Therefore, the Trademark in the Application does not fall under Article 4, paragraph (1), item (xv) of the Trademark Act.

Judgment rendered on August 5, 2024

2024 (Gyo-Ke) 10007 Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: June 10, 2024

Judgment

Plaintiff: SSC Shuppan Yugengaisha

Defendant: Commissioner of the Japan Patent Office

Main text

1. The decision made by the Japan Patent Office (JPO) on December 26, 2023, concerning the case of Appeal against Examiner's Decision of Refusal No. 2023-12344 shall be rescinded.
2. The Defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

Same as the main text.

No. 2 Outline of the case

1. Outline of procedures at the JPO (There are no disputes between the parties.)
 - (1) The Plaintiff filed an application for registration of the trademark (hereinafter referred to as the "Trademark in the Application") as described in Attachment "Trademarks in the Application," comprised of the alphabetic characters "Jimny Fan" and katakana "ジムニーファン" in two tiers, with designated goods set as Class 16 "printed matter" on January 17, 2023.
 - (2) Since a notice of grounds for refusal was given as of March 14, 2023, the Plaintiff submitted a written amendment dated April 14, 2023, and amended the designated goods in the application in question to Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles" (hereinafter referred to as the "Amended Goods in the Application"). However, on June 20, 2023, the amendment was refused and the Plaintiff filed an appeal against the examiner's decision of refusal on July 24, 2023.

The JPO examined the appeal as a case of Appeal against Examiner's Decision of Refusal No. 2023-12344 and made the decision that "the examiner's decision of refusal is maintained" (hereinafter referred to as the "JPO Decision") on December 26, 2023. A certified copy of the decision was served upon the Plaintiff on January 10, 2024.

- (3) On February 5, 2024, the Plaintiff filed this lawsuit to seek rescission of the JPO

Decision.

2. Summary of the grounds for the JPO Decision

(1) The outline of the grounds for the JPO Decision is that the Trademark in the Application falls under Article 4, paragraph (1), item (xi) of the Trademark Act; even if it does not fall under said item, it falls under item (xv) of said paragraph; therefore, it cannot be registered.

(2) Outline of the determination on whether the Trademark in the Application falls under Article 4, paragraph (1), item (xi) of the Trademark Act

A. The alphabetic characters "Jimny Fan" in the configuration of the Trademark in the Application have a space for a single letter between the characters "Jimny" and the characters "Fan." Therefore, there are cases where the characters "Jimny" and the characters "Fan" are observed separately.

On the other hand, it was found that "Jimny" (hereinafter referred to as the "Jimny Trademark"), which is the name of an off-road vehicle of Suzuki Motor Corporation (hereinafter referred to as "Suzuki"), has been known among consumers across a broad range of age groups that use automobiles in Japan as an indication of the name of an off-road vehicle related to Suzuki's business, at the latest, since before the application date for registration of the Trademark in the Application until today.

B. It is reasonable to say that consumers who come into contact with the Amended Goods in the Application recognize said magazine as goods related to Suzuki's off-road vehicle, "Jimny."

C. The alphabetic characters "Jimny Fan" and katakana "ジムニーファン" bring to mind "devotees of Suzuki's off-road vehicle, 'Jimny.'" Then, the alphabetic characters "Jimny Fan" and katakana "ジムニーファン" in the configuration of the Trademark in the Application give a strong and dominant impression. When making a determination on the similarity with the cited trademarks, it is allowed to determine the similarity of trademarks by extracting said letters as the main part of the Trademark in the Application and comparing them with the cited trademarks.

D. Both Registration No. 6214256 trademark described in 1 in Attachment "Cited Trademarks" (hereinafter referred to as "cited trademark 1") and Registration No. 6623643 trademark described in 2 in Attachment "Cited Trademarks" (hereinafter referred to as "cited trademark 2"; collectively referred to with cited trademark 1 as the "cited trademarks") generate the same pronunciation "Jimunii" and bring to mind the concept of "the name of Suzuki's off-road vehicle."

E. Comparing the main part of the Trademark in the Application and cited trademark 1, the main part of the Trademark in the Application and cited trademark 1 both have the

same spelling "Jimny," and therefore, their appearances are similar. In addition, as both share the pronunciation "Jimunii" arising from said letters and the concept of "the name of Suzuki's off-road vehicle," the Trademark in the Application and cited trademark 1 are mutually confusing similar trademarks.

Furthermore, comparing the main part of the Trademark in the Application and cited trademark 2, the main part of the Trademark in the Application "Jimny" and the alphabetic characters "JIMNY" as used in the configuration of cited trademark 2 both have the letter "J" as the beginning of the term and remainder of the spelling only differs as to whether it is in capital letters or in lower-case letters, and both have the same katakana "ジムニー." Therefore, their appearances are similar, and both share the pronunciation "Jimunii" arising from said letters and the concept of "the name of Suzuki's off-road vehicle." Consequently, the Trademark in the Application and cited trademark 2 are mutually confusing similar trademarks.

F. Class 16 "printed matter" among the designated goods related to the Amended Goods in the Application and cited trademark 1 and Class 9 "electronic publications" and Class 35 "retail services or wholesale services for printed matter" among designated goods and designated services related to cited trademark 2 are identical or similar goods and services.

G. As stated above, the Trademark in the Application is a trademark similar to the cited trademarks and the Amended Goods in the Application are identical and similar to designated goods and designated services related to the cited trademarks. Therefore, the Trademark in the Application falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

(3) Outline of the decision on whether the Trademark in the Application falls under Article 4, paragraph (1), item (xv) of the Trademark Act

Even if the Trademark in the Application does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act, the Jimny Trademark has been known among consumers across a broad range of age groups that use automobiles in Japan as an indication of the name of an off-road vehicle related to Suzuki's business, at the latest, since before the application date for registration of the Trademark in the Application until today. "Jimny" as used in the configuration of the Trademark in the Application and the Jimny Trademark are similar in their appearance and share the pronunciation "Jimunii" and the concept of "the name of Suzuki's off-road vehicle." Therefore, they are mutually confusing trademarks and the degree of similarity is high. Since it is easily presumed that consumers of the Amended Goods in the Application are consumers of Suzuki's off-road vehicle, Jimny, or persons who are interested in said goods, consumers

of these goods are the same. The alphabetic characters "Jimny" and katakana "ジムニー" are not listed in a general dictionary and their degree of creativity is considered to be high. Based on the above, if the Plaintiff (demandant) uses them in the Amended Goods in the Application, traders and consumers may confuse the source of the goods as if the goods are related to the business of Suzuki or of a person who has an economic or organizational relationship with Suzuki.

Therefore, even if the Trademark in the Application does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act, the Trademark in the Application is likely to cause confusion with the goods or services related to another person's business, and therefore, it falls under Article 4, paragraph (1), item (xv) of the Trademark Act.

3. Grounds for rescission

- (1) Error in the determination on the similarity (Article 4, paragraph (1), item (xi) of the Trademark Act) between the Trademark in the Application and the cited trademarks
- (2) Error in the determination on the "possibility of causing confusion" (Article 4, paragraph (1), item (xv) of the Trademark Act) related to the Trademark in the Application

No. 4 Decision of this court

1. Article 4, paragraph (1), item (xi) and item (xv) of the Trademark Act and "actual transaction conditions"

(1) A. In cases where both trademarks to be compared are used with identical or similar goods or services, the similarity of trademarks under Article 4, paragraph (1), item (xi) of the Trademark Act should be determined as to whether it is likely to cause a misunderstanding and confusion concerning the source of the goods or services. The impressions, memories, suggestions, etc. of a trademark used in said goods and services that its appearance, concept, pronunciation, etc. give to customers should be examined as a whole. And it is reasonable to make a determination based on specific transaction conditions as long as the actual transaction conditions of the goods and services can be clarified (the judgment of the third petty bench of the Supreme Court on February 27, 1968; Minshu Vol. 22, No.2, at 399).

(2) The existence of the "possibility of causing confusion" as referred to in Article 4, paragraph (1), item (xv) of the Trademark Act should be determined comprehensively in light of the degree of similarity between the trademark and the indication of another person, the degree of public recognition and creativity of the indication of another person, the degree of relationship between the designated goods and services of the trademark and the designated goods and services relating to the business of another

person, commonality in customers and consumers, and other actual transaction conditions, and based on the attention normally paid by the traders and consumers of the aforementioned designated goods and services (the judgment of the third petty bench of the Supreme Court on July 11, 2000; Minshu Vol. 54, No.6, at 1848).

(3) Generally, it is construed to be common that an automobile manufacturer sells goods related to automobiles manufactured and sold by the manufacturer (key rings, T-shirts, caps, etc.) or provides services incidental thereto (vehicle maintenance, provision of information for enjoying life with vehicles, etc.) by themselves or through their affiliated car dealers, etc. (meaning business owners that are in a close relationship in business with the automobile manufacturer, such as those having a parent-subsidiary relationship, affiliated companies, etc., or business owners that are in a relationship of belonging to a group engaging in commercialization business using identical indications; the same shall apply hereinafter).

However, the designated goods of the Trademark in the Application (Amended Goods in the Application) have the characteristics in that they are considered to be distributed in a very narrow market of Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles" (or considered to be niche goods). As to whether the aforementioned generality related to goods and incidental services related to automobiles also applies to the Amended Goods in the Application, it is necessary to first identify actual transaction conditions and then make a determination on the applicability of Article 4, paragraph (1), item (xi) and item (xv) of the Trademark Act based on such actual transaction conditions.

From these perspectives, this court examined the evidence as required, such as adopting the examination of the representative of the Plaintiff by the court's own authority, etc. The results are stated in 2. below.

2. Facts found in this case

Considering the entire import of oral arguments below, the facts stated in (1) and (2) below are found (supplementary explanations are added to the findings in (3) below). (1) Suzuki's off-road vehicle, Jimny (Exhibits Ko 8 and 9, and Exhibits Otsu 1 through 12; the representative of the Plaintiff)

A. Suzuki started the sale of its off-road vehicle "Jimny" (hereinafter simply referred to as "Suzuki Jimny") in 1970. Suzuki Jimny has been mass-produced as a mini-four-wheel-drive vehicle with high rough-road coverage for more than 50 years since the start of the sale until today, and the accumulated number of sales throughout the world exceeded 3 million vehicles in 2020. In 2020, the first-generation Suzuki Jimny was selected as a "Historic Car" by the Japan Automobile Hall of Fame and was described

as "a long-selling model for various uses," "a historic masterpiece of a vehicle that opened up a new direction in light vehicles," etc. In 2018, Suzuki Jimny fully changed its model for the first time in 20 years (current model) and it has become popular, particularly in recent years, for example by receiving the Good Design Gold Award, etc. It is ranked 12th place in the passenger vehicle best 15 by the flash report on new light vehicle sales in November 2023.

B. Suzuki is the trademark right holder of cited trademark 1 (registered on January 8, 2020) and cited trademark 2 (registered on October 5, 2022). Before the registration of these cited trademarks, Suzuki had used the Jimny Trademark with Suzuki Jimny that it manufactured and sold. The Jimny Trademark has been widely known among automobile users, etc. across a broad range of age groups in Japan as one indicating the name of an off-road vehicle manufactured and sold by Suzuki since before filing the application for the Trademark in the Application (January 17, 2023) until today.

(2) Actual transaction conditions relating to the modification of off-road vehicles (Exhibits Ko 1 and 7, the representative of the Plaintiff)

A. Modification of an off-road vehicle

Modification (customization) of an off-road vehicle includes an extreme diversity of purposes and means, such as changing original tires to large-diameter tires, modifying the suspension to increase (or decrease) vehicle height, changing the driving system, such as engine gears, etc., to increase off-road performance, changing the front and rear bumpers to change the appearance, etc.

Suzuki Jimny is particularly popular as an off-road vehicle used as a base for modification since its body price is relatively inexpensive, it has much room for modification despite its simple and robust structure, and there are abundant parts for customization, including parts other than genuine parts, etc. For users of such modified vehicles, it is common to modify vehicles by using up to several million yen, which drastically exceeds the purchase price of the original vehicle. There are a considerable number of shops throughout Japan handling modified vehicles and their parts for those users. In addition, exchanges between modified Suzuki Jimny owners are active and a specific market, which should be called the Suzuki Jimny customization market, has been established (according to the expression of the representative of the Plaintiff, users are widespread and exchanges have been established as a business on a deep level).

B. Magazines related to Suzuki Jimny modification

There have been magazines that have targeted the aforementioned specific market for quite a long time, including "JIMNY SUPER SUZY" (released in 1998) and the magazine in question ("Jimny Fan," released in 2012), both of which are issued by the

Plaintiff, as well as "ジムニー天国 (Jimny Heaven)" (released in 1997), "jimny plus" (released in 2004), "ジムニー スタイル (Jimny Style)" (released in 2005), "JIMNY REPORT" (released in 2009), "JIMNY CUSTOM BOOK" (released in 2012), and "JIMNY Turning" (released in 2015).

The magazine in question is particularly popular among these magazines. Issues up to No. 13 were published by 2023. For the first three issues, No. 1 to No. 3, 30,000 copies each were printed, of which 28,000 copies were distributed to bookshops and convenience stores throughout Japan. The number of distributed magazines remains around 8,000 to 9,000 at present, while the number of bookshops is decreasing throughout Japan. It can be said that the number of issues is rather high in the relevant industry.

The latest issue of the magazine in question (No. 13, Exhibit Ko 1) has [i] the title of "Jimny Fan" using the same font as cited trademark 1 and the copy of "Because we love Jimny, we want to modify it as a one and only. Full of hints for your desires!!!" in large font on its cover page; and includes [ii] mainly the introduction of shops that handle modified Suzuki Jimnys and goods, the introduction of modified Suzuki Jimnys owned by private owners (with face photos of the owners; approximately 450 private owners in total are introduced), and the introduction of parts for modification, but also articles for off-road vehicle users, such as "Secrets for driving on forest roads," etc. in its main text. In addition, it has [iii] a full-page advertisement for Suzuki Jimny provided by Suzuki on its back cover.

Most of the aforementioned magazines other than the magazine in question have similar content as [ii] above and all of them fall under Amended Goods in the Application. All publishers of these magazines are third parties who have no direct relationship with Suzuki or other automobile manufacturers or with their affiliated car dealers, etc.

C. Involvement of automobile manufacturers, etc. in the Amended Goods in the Application

Suzuki provides genuine parts, such as stripes, sun visors, mats, etc. through its affiliated car dealers, etc. and introduces these genuine parts in the magazine in question in some cases (this is also admitted by the representative of the Plaintiff).

However, there is no fact showing that Suzuki and other automobile manufacturers actually issue "magazines related to parts and accessories used for the modification of off-road vehicles" by themselves or through their affiliated car dealers, etc. or that they are planning to issue such magazines in the near future (in this regard, see supplementary explanations of the findings in (3) below).

Suzuki knew that the Plaintiff had published the magazine in question titled "Jimny Fan" for more than 10 years (for more than 20 years if "JIMNY SUPER SUZY" is included); however, Suzuki has never notified the Plaintiff of any warnings, such as that it was an unauthorized use of the cited trademarks, that it may cause misidentification or confusion in relation to the Jimny Trademark, or other complaints. On the contrary, Suzuki paid advertising fees to the Plaintiff, posted advertisements for Suzuki Jimny in the magazine in question, purchased copies of the magazine (70% of the proper price), and thereby supported the publication of the magazine in question.

(3) Supplementary explanations of the findings

The Defendant submitted Exhibits Otsu 14 through 17 as evidence indicating that automobile manufacturers create and distribute printed material relating to automobiles. However, as stated below, they do not have an impact on the findings in (2) C. above.

A. Exhibits Otsu 14 and 15 are catalogs that are used when selling Suzuki Jimny and that indicate sales points related to Suzuki Jimny's major equipment, major specifications, driving performance, and safety performance. However, it cannot be found that there are actual circumstances where these catalogs are traded as goods and there are no statements regarding "modification." Even if Suzuki or its affiliated car dealers, etc. have distributed these catalogs, no relationship is found with the Amended Goods in the Application.

B. Exhibit Otsu 16 is evidence proving that Suzuki Jimny's catalog issued in February 1988 was being sold for 800 yen at a secondhand bookshop. However, it is obvious that its merchantability is based on the scarcity of being an automobile catalog issued more than 30 years ago. There are no statements regarding "modification" just as mentioned in A. above. No relationship is found either between this catalog and the Amended Goods in the Application.

C. Exhibit Otsu 17 is "Toyotimes Magazine" issued on February 25, 2021 and it has the description "Toyotimes released its first magazine 'Toyotimes Magazine' on February 25." However, the content is President A's message, etc. related to Toyota's business management and there are no statements regarding the "modification" of automobiles, including off-road vehicles, their parts, and accessories. No relationship is found either between this magazine and the Amended Goods in the Application.

3. Grounds for Rescission 1: Error in the determination on the similarity (Article 4, paragraph (1), item (xi) of the Trademark Act) between the Trademark in the Application and the cited trademarks

(1) The Trademark in the Application

A. The Trademark in the Application is a combined trademark consisting of the

alphabetic characters "Jimny Fan" and katakana "ジムニーファン" in two tiers and the pronunciation "Jimunii Fan" is generated corresponding to the entire configuration of letters.

Among the constituent parts, when focusing only on the part of the alphabetic characters "Jimny" and katakana "ジムニー," they indicate the well-known Suzuki's off-road vehicle, Jimny (2. (1) B. above) and, when focusing on the part of the alphabetic characters "Fan" and katakana "ファン," they are terms referring to "a person who patronizes a specific field, group, or individual in sports, dramas, movies, music, etc." (Exhibit Otsu 13). Based on the above, the Trademark in the Application as a whole generates the concept of "devotees of Suzuki's off-road vehicle, Jimny."

B. The alphabetic characters "Jimny" and "Fan" at the upper tier of the Trademark in the Application are in the same font and same size, and they give an impression of being on the same level. In addition, there is a space of a single letter between these two sets of alphabetic characters but since the first part "Jimny" consists of 5 letters and the latter part "Fan" consists of 3 letters, they are not lengthy as a whole and do not give the impression that both sets of alphabetic characters are separate and independent constituent parts even if there is the space of a single letter between them. Regarding the part of katakana "ジムニーファン," there is no space corresponding to the one between the two sets of alphabetic characters. Based on the above, from the appearance of the Trademark in the Application, there is no basis to observe the part of "Jimny" and "ジムニー" and the part of "Fan" and "ファン" separately.

C. In cases where a part of the configuration of a combined trademark gives a strong and dominant impression to traders and consumers as a mark indicating the source of goods or services, it may sometimes be appropriate to adopt a means to make a determination on the similarity of the trademark itself with the trademark of another person by extracting and comparing the relevant part alone (the judgment of the second petty bench of the Supreme Court on September 10, 1993; Minshu Vol. 47, No. 7, at 5009; the judgment of the second petty bench of the Supreme Court on September 8, 2008; Saibanshu Minji No. 228, at 561).

Applying the above to this case, as stated above, it is true that the Jimny Trademark ("Jimny (ジムニー)") is well-known among automobile users, etc. across a broad range of age groups in Japan as an indication of the name of an off-road vehicle manufactured and sold by Suzuki. Therefore, if the Jimny Trademark is assumed to be used for a "vehicle," there is a sufficient reason to determine that it gives a strong and dominant impression as a mark indicating the source of the goods or services. However, the question in this case is how traders and consumers recognize the Trademark in the

Application as a mark indicating the source of goods or services when it is used with the Amended Goods in the Application.

Considering from these perspectives, first, as an objective fact, it is not found that Suzuki and other automobile manufacturers have issued "magazines relating to parts and accessories used for the modification of off-road vehicles" by themselves or through their affiliated car dealers, etc. In addition, according to the representative of the Plaintiff, Suzuki and other automobile manufacturers may have lent a helping hand to the activities of third parties for business relating to the aforementioned Suzuki Jimny customization market (see 2. (2) A. above) but seem to have avoided being involved in them directly. Under such situation, it is difficult to deem that traders and consumers who come into contact with the Amended Goods in the Application using the Trademark in the Application recognize that Suzuki and other automobile manufacturers or their affiliated car dealers, etc. are (or may be) the publishers of these magazines (no evidence to support such recognition has been submitted).

In addition, if traders and consumers of Amended Goods in the Application who may be interested in the modification of off-road vehicles come into contact with the Trademark in the Application, it is easy to imagine that the part of "Jimny" and "ジムニー" in the Trademark in the Application gives a strong and dominant impression as a vehicle serving as a base for modification (actually, it is obvious that the magazine in question has that intention). However, it is a completely different problem from that of "a mark indicating the source of goods or services" and does not serve as a basis for extracting the part of "Jimny" and "ジムニー" as the main part of a combined trademark.

The JPO Decision determined as follows: "The alphabetic characters 'Jimny' and katakana 'ジムニー' in the configuration of the Trademark in the Application give a strong and dominant impression. When making a determination on the similarity of trademarks, it is allowed to extract said letters as the main part of the Trademark in the Application and compare them with the cited trademarks." However, it must be said that this determination of the JPO does not correctly understand the purport of the aforementioned precedents of the Supreme Court, which allowed to find the main part of a combined trademark "in cases where the relevant part gives a strong and dominant impression as a mark indicating the source of the goods or services."

(2) Similarity between the Trademark in the Application and the cited trademarks

As determined in (1) above, the means of the JPO Decision that made a determination on the similarity of the trademarks by extracting the alphabetic characters "Jimny" and katakana "ジムニー" in the configuration of the Trademark in the Application and comparing them with the cited trademarks is incorrect and there is no

other basis to extract the part of the alphabetic characters "Jimny" and katakana "ジムニー" in the Trademark in the Application as the main part. Based on the above, the comparison with the cited trademarks should be made on the premise of the observation of the Trademark in the Application as a whole, but both cited trademark 1 and cited trademark 2 lack the configuration corresponding to "Fan" and "ファン," which are constituent parts of the Trademark in the Application. As a result, the Trademark in the Application, cited trademark 1, and cited trademark 2 are different in the appearance as a trademark as a whole. As shown in the following table, they are also different in terms of pronunciation and concept. Therefore, the similarity between the Trademark in the Application and cited trademark 1 and cited trademark 2 cannot be affirmed.

	Pronunciation	Concept
Trademark in the Application	Jimunii Fan	Devotees of Suzuki's off-road vehicle, Jimny
Cited trademark 1	Jimunii	Name of Suzuki's off-road vehicle
Cited trademark 2	Jimunii	Name of Suzuki's off-road vehicle

(3) Conclusion

Based on the above, the Trademark in the Application does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act, and there are grounds for Rescission 1.

4. Grounds for Rescission 2: Error in the determination on the "possibility of causing confusion" (Article 4, paragraph (1), item (xv) of the Trademark Act) related to the Trademark in the Application

(1) Making a determination in accordance with the framework in 1. (2) above, first, as stated above, the Jimny Trademark has been widely known among automobile users across a broad range of age groups in Japan as one indicating the name of an off-road vehicle manufactured and sold by Suzuki and it is construed that "Jimny (ジムニー)" is a coined word not derived from a common name. Therefore, both the degree of public recognition and creativity of the Jimny Trademark are considered to be high.

(2) Then, the relationship between the designated goods of the Trademark in the Application (Amended Goods in the Application) and the goods and services relating to the business of Suzuki is examined next.

A. As stated in 1. (3) above, it is construed to be common for automobile manufacturers to sell automobile-related goods and provide incidental services by themselves or through their affiliated car dealers, etc. It is highly likely that Suzuki also develops a business that should be called Suzuki Jimny-related business by using the trust

associated with the well-known Jimny Trademark for specific goods and services beyond the off-road vehicle (Suzuki Jimny) itself.

B. However, the designated goods of the Trademark in the Application (Amended Goods in the Application) are extremely niche goods, Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles." As it is found earlier as actual transaction conditions, there are no facts that Suzuki and other automobile manufacturers have published "magazines related to parts and accessories used for the modification of off-road vehicles" by themselves or through their affiliated car dealers, etc. It is difficult to consider that traders and consumers who come into contact with the Amended Goods in the Application using the Trademark in the Application recognize that Suzuki or any of other automobile manufacturers or their affiliated car dealers, etc. is (or might be) its publishers.

In addition, Suzuki knew that the Plaintiff had published the magazine in question with the same title as the configuration of the Trademark in the Application for more than 10 years, but Suzuki has never notified the Plaintiff of any warnings, such as that it may cause misidentification or confusion in relation to the Jimny Trademark, etc., or other complaints. Furthermore, as stated above, Suzuki supported the publication of the magazine in question by posting advertisements for the Suzuki Jimny, etc.

C. Considering the aforementioned facts and the statement of the representative of the Plaintiff together, the business developed by Suzuki under the Jimny Trademark may include relevant goods and incidental services beyond the off-road vehicle (Suzuki Jimny) itself. However, the business related to "magazines related to parts and accessories used for the modification of off-road vehicles" is actually provided by a third party who has no direct relationship with Suzuki or its affiliated car dealers, etc. and it is found that a "segregation" that does not conflict with Suzuki has been established.

(3) Based on the above, even if the Trademark in the Application is used with the Amended Goods in the Application, there is no possibility of causing confusion with goods and services relating to the Jimny Trademark of Suzuki. Therefore, the Trademark in the Application does not fall under Article 4, paragraph (1), item (xv) of the Trademark Act.

Traders and consumers of goods (off-road vehicles) relating to the Jimny Trademark and the designated goods of the Trademark in the Application (Amended Goods in the Application) are presumed to be common to a considerable degree. Even so, however, it does not affect the aforementioned determination.

5. Conclusion

Based on the above, there are errors in the determination of the JPO Decision to the effect that the Trademark in the Application falls under Article 4, paragraph (1), item (xi) or item (xv) of the Trademark Act, and there are grounds for the appeal by the Plaintiff. Consequently, the JPO Decision shall be rescinded and the judgment is rendered as indicated in the main text.

Intellectual Property High Court, Fourth Division

Presiding judge: MIYASAKA Masatoshi

Judge: MOTOYOSHI Hiroyuki

Judge: IWAI Naoyuki

Attachment

Trademark in the Application

Jimny Fan
ジムニーファン

Designated goods (Amended Goods in the Application): Class 16 "magazines related to parts and accessories used for the modification of off-road vehicles"

Attachment

Cited Trademarks

1 Cited trademark 1 (Exhibit Ko 8)



Registration No. 6214256 Trademark

[Registration of establishment] January 8, 2020 (remaining in effect)

[Designated goods]

Class 12 "vessels and their parts and fittings; automobiles and their parts and fittings; two-wheeled motor vehicles, bicycles and their parts and fittings; electric four-wheeled motor vehicles and their parts and fittings; wheelchairs; non-electric prime movers for land vehicles, not including their parts; machine elements for land vehicles; AC motors or DC motors for land vehicles, not including their parts"

Class 14 "key rings; prize cups; commemorative shields; personal ornaments; clocks and watches"

Class 16 "containers of paper, for packaging; food wrapping plastic film for household purposes; printed matter; paintings and calligraphic works; photographs [printed]; photograph stands"

Class 18 "clothing for domestic pets; bags; pouches; vanity cases, not fitted; umbrellas and their parts"

Class 21 "cosmetic utensils; industrial packaging bottles of plastics; kitchen implements and containers, not including gas water heaters for household use, non-electric cooking heaters for household purpose, kitchen sinks incorporating integrated worktops for household purpose and kitchen sinks for household purpose; dinnerware, other than knives, forks and spoons; cleaning tools and washing utensils; piggy banks; charms"

Class 24 "woven fabrics; woven textile goods for personal use"

Class 25 "clothing; footwear [other than special footwear for sports]; headgear for wear"

Class 28 "toys for domestic pets; toys; dolls; sports equipment"

[Trademark right holder] Suzuki

2 Cited trademark 2

JIMNY
ジムニー

Registration No. 6623643 Trademark

[Registration of establishment] October 5, 2022 (remaining in effect)

[Designated goods]

Class 9 "anti-theft warning apparatus; game programs for arcade video game machines; simulators for the steering and control of vehicles; telecommunication machines and apparatus; computer programs; eyeglasses; protective helmets for sports; downloadable image files; recorded video discs and video tapes; electronic publications"

Class 35 "retail services or wholesale services for automobiles; retail services or wholesale services for printed matter"

Class 41 "educational and instruction services relating to arts, crafts, sports or general knowledge; arranging, conducting and organization of seminars; providing electronic publications; services of reference libraries for literature and documentary records; book rental; providing videos from the Internet, not downloadable; providing online images, not downloadable; organization, arranging and conducting of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; organization, arranging and conducting of auto races"

[Trademark right holder] Suzuki