Trademark Right	Date	October 9, 2019	Court	Intellectual Property High Court, First Division
	Case number	2019 (Gyo-Ke) 10062		
- A case which concerns the trademark of "らくらく" and in which the court denied applicability to Article 4, paragraph (1), item (x) of the Trademark Act by holding that the container and ads for Plaintiff's Product do not use the characters, "らくらく", by themselves, and that "らくらく" cannot be extracted from the mark of "らくらく正座椅子" as the essential part thereof.				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

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

Number of related rights, etc.: Trademark Registration No. 5614453, Invalidation Trial No. 2018-890044

Summary of the Judgment

1. The present case is a suit against the JPO decision in which, concerning the trial on the invalidation of trademark registration for the Trademark consisting of the standard characters, "らくらく", and whose designated goods are Class 20 "Furniture; Desks and the like", the JPO rendered a decision to maintain the Trademark.

   Plaintiff asserted as the grounds for rescission that the JPO made an incorrect determination as to applicability to Article 4, paragraph (1), item (x) of the Trademark Act.

2. In the judgment of the present case, the court rendered a judgment as outlined below, and dismissed Plaintiff's claim.

   (1) Similarity between trademarks should be determined on whether or not there is a risk that the trademarks, which are to be compared, may create the misleading or confusion as to the source or origin of the products when both trademarks are used on identical or similar products. Such determination should be made by examining the trademarks holistically, by comprehensively taking into consideration the impression, recollection, and association given to the persons involved in the transaction based on the appearance, concept, and pronunciation of the trademarks when used on said products, and furthermore, as long as the actual circumstances of transaction for the products can be clarified, it is reasonable to make the determination based on the specific circumstances of transaction.

(2) It seems that Plaintiff began selling Plaintiff's Product (stool for sitting in seiza style) from around 1988, and has continued selling the product for more than 30 years. It is acknowledged that the number of the product sold was approximately 750,000 during the 12 years consisting of 2000, and 2003 to 2013, and ads for Plaintiff's Product appeared in newspapers 75 times from 2002 until 2006, and ads for Plaintiff's Product appeared in various catalogues, leaflets, and websites as well.

However, while the container for Plaintiff's Product bears marks such as "らくらく正座椅子", there is no use of the characters, "らくらく", by themselves, and while many of the ads for Plaintiff's Product bear the mark, "らくらく正座椅子", there is no use of the characters, "らくらく", by themselves. As such, it cannot be acknowledged that the cited mark of "らくらく", as asserted by Plaintiff, was well known among consumers, when an application for registration of the Trademark was filed and when a decision to grant registration was issued, as an indication of Plaintiff's Product.

The part, "らくらく", refers to a function of Plaintiff's Product which alleviates the numbness in legs and the pain in knee caps, allowing the person to comfortably sit in seiza style, and the part, "正座椅子", refers to the usage of Plaintiff's Product or to the product type itself, so that neither of the character parts has a function as an indicator that identifies the source or origin by the respective character part alone, and furthermore, it is impossible to extract only the character part, "らくらく", from the indication of Plaintiff's Product as the essential part thereof, and, it also cannot be acknowledged that the actual circumstances of transaction involve extraction of the "らくらく" part.

Accordingly, the court held that the Trademark does not fall under Article 4, paragraph (1), item (x) of the Trademark Act.

Judgment rendered on October 9, 2019
2019 (Gyo-Ke) 10062 A case of seeking rescission of the JPO decision
Date of conclusion of oral argument: August 21, 2019

Judgment

Plaintiff: X

Defendant: Yugen Kaisha Technom

Main text

1. Plaintiff's claims shall be dismissed.
2. Plaintiff shall bear the court costs.

Facts and reasons

No. 1 Claim

The trial decision rendered by the JPO on March 26, 2019 for Invalidation Trial No. 2018-890044 shall be rescinded.

No. 2 Outline of the case

1. Details of the procedures at JPO

(1) Defendant is the trademark holder of the following mark (Trademark Registration No. 5614453; hereinafter referred to as "Trademark") (Exhibits Ko 16, 17).

Trademark: "らくらく" (standard characters)
Application date: April 17, 2013
Date of decision for registration: August 12, 2013
Date of registration: September 13, 2013
Designated goods: Class 20 "Furniture; Desks and the like"

(2) On June 20, 2018, Plaintiff filed a request for a trial for invalidation of trademark registration for the Trademark.

(3) The JPO examined the above request as Invalidation Trial No. 2018-890044 (hereinafter referred to as "Trial"). On March 26, 2019, the JPO rendered a decision as indicated in the attached Decision by the Japan Patent Office (copy) to the effect that "the request for trial of the case is groundless" ("JPO Decision"), and a certified copy of the decision was delivered to Plaintiff on April 4 of the same year.

(4) On April 25, 2019, Plaintiff filed the present suit seeking rescission of the JPO Decision.

2. Summary of the reasons for the JPO Decision

Reasons for the JPO Decision are as per the attached Decision by the Japan Patent Office (copy). The decision is such that, in short, it cannot be acknowledged that the cited trademark that consists of the characters, "らくらく", was well known among consumers when an application for registration of the Trademark was filed and when a decision to grant registration was issued, as an indication of the product pertaining to Plaintiff's business, so that it cannot be said that the Trademark falls under Article 4, paragraph (1), item (x) of the Trademark Act.

3. Reason for rescission of the JPO Decision

Incorrect determination as to applicability to Article 4, paragraph (1), item (x) of the Trademark Act.

(omitted)

No. 4 Judgment of this court

1. Concerning the incorrect determination as to applicability to Article 4, paragraph (1), item (x) of the Trademark Act

(1) Determination on similarity of trademarks

Similarity between trademarks should be determined on whether or not there is a risk that the trademarks, which are to be compared, may create misleading or confusion as to the source or origin of the products when both trademarks are used on identical or similar products. Such determination should be made by examining the trademarks holistically, by comprehensively taking into consideration the impression, recollection, and association given to the persons involved in the transaction based on the appearance, concept, and pronunciation of the trademarks when used on said products, and furthermore, so long as the actual circumstances of transaction for the products can be clarified, it is reasonable to make the determination based on specific circumstances of transaction (Supreme Court decision 1964 (Gyo-Tsu) 110 rendered on February 27, 1968 by the Third Petty Bench; refer to Minshu Vol. 22, No. 2, p. 399).

(2) Findings

By comprehensively taking into consideration the evidence and the

entire import of the oral argument, the following facts are acknowledged.

A. Plaintiff has sold stools for sitting in seiza style under the trade name of "Sumitomo Sangyo", and has manufactured and sold Plaintiff's Product since around 1988, if not earlier (Exhibit Otsu 5-1).

The number of Plaintiff's Product sold is 746,136 in total in the years consisting of 2000, and 2003 to 2013 (Exhibits Ko 1, 2).

Plaintiff's Product is an aid tool for sitting in seiza style, and allows a person to comfortably sit in seiza style when the person places it underneath the buttocks and sits on it, by distributing the body weight and decreasing the load on the knees, and thereby alleviating numbness in legs and pain in knee caps (Exhibit Ko 12-2; entire import of the oral argument). Plaintiff advertises Plaintiff's Product, in ads for Plaintiff's Product described below, by indicating words such as "For numbness in the legs and pain in the knee caps" (Exhibits Ko 3-2 to 3-4) and "For numbness in the legs For persons with pain in the knee caps (Exhibits Ko 4-2 to 4-4), as a stool that allows a person to sit comfortably in seiza style by alleviating numbness in the legs and pain in the knee caps.

B. The container for Plaintiff's Product which Plaintiff sells bears the characters, "らくらく椅子" (Exhibits Ko 8-1 to 8-4, 8-6, 8-7), "らくらく正座椅子" (Exhibit Ko 8-5), or "らくらく二段正座椅子" (Exhibit Ko 8-8).

C. Advertisement

(A) From January 2002 until December 2006, ads indicating photographs of Plaintiff's Product appeared along with the marks, "らくらく正座椅子" (Exhibits Ko 3-2 to 3-5, 4-2 to 4-14, 5-1 to 5-15, 6-2 to 6-18, 7-2 to 7-23), "らくらく万能座椅子" (Exhibits Ko 3-1, 6-1, 6-12, 7-1, 7-16), "らくらく万能正座椅子" (Exhibit Ko 6-6), and "らくらく椅子" (Exhibit Ko 7-16), for a total of 75 times in the Seikatsu Sangyo Shimbun (Exhibits Ko 3-1 to 7-23).

(B) Ads indicating photographs of Plaintiff's Product appeared along with the marks, "らくらく正座椅子" (Exhibits Ko 9-1, 9-2, 9-11), "らくらく万能座椅子" (Exhibits Ko 9-2), and "らくらく椅子" (Exhibit Ko 9-2) in "2005 - 2006 Seikatsuyohin Hinmokubetsu Kigyobenran" [2005 - 2006 Livingware by Item Handbook for Companies] issued on June 10, 2005 (Exhibit Ko 9-1), "Seikatsu Sangyo Kigyo Meikan 2011" [2011 Directory for Companies in Living-Related Industries]

issued on November 10, 2010 (Exhibit Ko 9-2), and "50-onbetsu Denwacho Yoshinogawashi-ban 2004-ban Tele & Pal 50" [Phone Number Directory in Japanese Alphabetical Order Yoshinogawa City Version 2004 Issue Tele & Pal 50] issued in April 2004 (Exhibit Ko 11).

(C) Photographs of Plaintiff's Product appear along with the mark of "らくらく正座椅子" in a catalogue created by Plaintiff and titled "Sozosuru Kigyo" [Creative Company] (Exhibit Ko 10).

(D) Photographs of Plaintiff's Product are introduced in the November 2011 issue of "Kyono Kenko" [Today's Health], a textbook for an NHK TV program (Exhibits Ko 12-1, 12-2), and in the text and on the website of NHK Publishing, Inc., ads containing photographs of Plaintiff's Product appeared along with the mark of "らくらく正座いす" (Exhibits Ko 12-3, 12-4).

(E) Ads containing photographs of Plaintiff's Product appeared along with the mark of "らくらく椅子" in a leaflet in a paper issued in July 1999 for Tokyu Department Store (Exhibit Ko 13-1), a leaflet in a paper issued on June 21, 2011 for Nara Coop (Exhibit Ko 13-2), a leaflet in a paper issued in March 2012 for Kintetsu Department Store (Exhibit Ko 13-3), a leaflet in a paper issued in September 2012 for Kintetsu Department Store (Exhibit Ko 13-4), a leaflet in a paper issued in December 2012 for Odakyu Department Store Fujisawa (Exhibit Ko 13-5), and a leaflet in a paper issued in December 2012 for Odakyu Department Store Machida (Exhibit Ko 13-6).

(F) Ads containing photographs of Plaintiff's Product appeared along with the mark of "らくらく正座椅子" on Amazon's website on September 18, 2007, April 21, 2010, and September 19, 2011 (Exhibits Ko 14-1 to 14-4).

Ads containing photographs of Plaintiff's Product appeared along with the mark of "らくらく椅子" in a general catalogue created by Yugen Kaisha Roots in 1994 and issued in the same year (Exhibit Ko 15-1), and along with the mark of "らくらく正座椅子" in the General Catalogue 2011 created by Yamasoro Art Mfg., Ltd. in 2011 (Exhibit Ko 15-2), respectively.

(3) Use of the cited trademark by Plaintiff

According to the above findings (2) (A) and (C), it seems that Plaintiff

began selling Plaintiff's Product from around 1988, and has continued the sales for more than 30 years. It is acknowledged that the number of the product sold was approximately 750,000 during the 12 years consisting of 2000, and 2003 to 2013, and ads for Plaintiff's Product appeared in the Seikatsu Sangyo Shimbun for 75 times from 2002 until 2006, and ads for Plaintiff's Product appeared in various catalogues, leaflets, and on Amazon's website as well.

However, the container for Plaintiff's Product sold by Plaintiff bears the mark of "らくらく椅子", "らくらく正座椅子", or "らくらく二段正座椅子", and there is no use of the characters, "らくらく", by themselves (above finding (2) (B)).

Furthermore, many of the ads for Plaintiff's Product bear the mark, "らくらく正座椅子", and while there are ads bearing the marks of "らくらく万能座椅子", "らくらく万能正座椅子", "らくらく正座いす", and "らくらく椅子", there is no use of the characters, "らくらく", by themselves (above finding (2) (C)).

In that case, it should be said that it cannot be acknowledged that the cited trademark, "らくらく", as asserted by Plaintiff, was well known among consumers, when an application for registration of the Trademark was filed and when a decision to grant registration was issued, as an indication of Plaintiff's Product.

(4) Concerning Plaintiff's claim

A. Plaintiff asserts that while "らくらく正座椅子" is a composite trademark consisting of joining together the part, "らくらく", and the part, "正座椅子", the character part of "らくらく" alone is what gives a strong and dominant impression as an indicator that identifies the source or origin of the product, so that this character part alone should be extracted as the trademark that is in use by Plaintiff.

However, the part, "らくらく", is a word meaning "comfortable", and indicates a function of Plaintiff's Product which alleviates numbness in the legs and the pain in the knee caps, allowing the person to comfortably sit in seiza style. Furthermore, the part, "正座椅子" is a word meaning a stool for sitting in seiza style, so that it indicates the usage of Plaintiff's Product or the product type itself. As such, it cannot be said that neither of the character parts, by the respective character part alone, has a function as an indicator that identifies the source or origin.

In that case, it cannot be said that the character part of "らくらく"

alone, from among the indication of Plaintiff's Product, gives a strong and dominant impression as an indicator that identifies the source or origin of the product, and thus it is impossible to extract only the character part of "らくらく" as the essential part. Accordingly, Plaintiff's assertion cannot be accepted.

B. Furthermore, Plaintiff asserts that, when the actual circumstance of transaction in which "らくらく" is extracted from "らくらく正座椅子" is also taken into consideration, the character part of "らくらく" alone should be extracted as the mark in use by Plaintiff.

However, there is no evidence to sufficiently acknowledge the circumstance in which "らくらく" is extracted from "らくらく正座椅子", for example a fact that Plaintiff's Product is called by the abbreviation of "らくらく". Plaintiff also asserts that Plaintiff and Defendant, who are parties in a transaction, carried out negotiations for the trial of the present case as well as the earlier negotiations on the premise that "らくらく" is extracted from "らくらく正座椅子", so that there is an actual circumstance of transaction in which "らくらく" is extracted. However, the extraction of "らくらく" from "らくらく正座椅子" cannot be acknowledged as an actual circumstance of transaction on the basis of the assertions made by the parties in the procedures for the trial of the present case, and thus Plaintiff's assertion cannot be accepted.

(5) Summary

Based on what is described above, the Trademark does not fall under Article 4, paragraph (1), item (x) of the Trademark Act.

2. Conclusion

Accordingly, Plaintiff's claim shall be dismissed for being unreasonable, and the judgment of this court shall be rendered in the form of the main text.

Intellectual Property High Court, First Division

Presiding judge: TAKABE Makiko
Judge: KOBAYASHI Yasuhiko
Judge: SEKINE Sumiko