

Trademark	Date	April 24, 2025	Court	Intellectual Property High Court, Second Division
	Case number	2024 (Gyo-Ke) 10095		
<p>- A case in which, regarding the decision made by the Japan Patent Office (JPO) to the effect that a request for a trial for invalidation of the registration of the trademark in question, which consists of the standard characters, "日本食育防災士" (the "Trademark"), is groundless, this court rescinded the JPO's decision based on the ground that the Trademark is likely to cause confusion in a broad sense with the services relating to the Plaintiff's business using the trademark, "防災士", and that it falls under Article 4, paragraph (1), item (xv) of the Trademark Act, while ruling that the JPO's determination that the Trademark does not fall under either item (xi) or (x) of the same paragraph is not erroneous.</p>				

Case type: Rescission of trial decision to maintain

Result: Granted

Reference: Article 4, paragraph (1), items (x), (xi) and (xv) of the Trademark Act

Related rights, etc.: Trademark Registration Nos. 6521920 and 4833713

Decision of the JPO: Invalidation Trial No. 2023-890093

Summary of the Judgment

1. The Plaintiff is a trademark right holder of the Cited Trademark consisting of the characters, "防災士" (Trademark Registration No. 4833713), and has been conducting various activities, including a business of certifying "Bousaishi," a private qualification relating to disaster prevention, a business of improving the quality of Bousaishi, and activities for awareness raising of disaster prevention, by using the Cited Trademark and other trademark consisting of the characters, "防災士" (the Used Trademarks).

The Defendant is a trademark right holder of the Trademark consisting of the standard characters, "日本食育防災士" (Trademark Registration No. 6521920), whose designated services are "Class 41 Educational and instruction services relating to arts, crafts, sports or general knowledge, educational examination," etc.

Regarding the Trademark, the Plaintiff filed a request for a trial for invalidation of the registration of the trademark. In response, the JPO made a decision to the effect that the request is groundless as the Trademark does not fall under any of items (vi), (vii), (x), (xi), (xv), and (xix) of Article 4, paragraph (1) of the Trademark Act (the "JPO Decision").

The Plaintiff filed this action to seek rescission of the JPO Decision, alleging the error in the JPO's determination on the applicability of these items above as a ground for

rescission.

2. In this judgment, as summarized below, the court rescinded the JPO Decision based on the following reasons.

(1) Applicability of Article 4, paragraph (1), item (xi) of the Trademark Act (not applicable)

The Trademark and the Cited Trademark are different in appearance and pronunciation.

The Trademark evokes the concept of "a certain qualification relating to food and eating education and disaster prevention in Japan and those who have that qualification," while the Cited Trademark evokes the concept of "a certain qualification relating to disaster prevention and those who have that qualification." Thus, they are different in concept as well.

The Plaintiff argues that the word "Bousaishi" has been a famous, well-known word among consumers as a word that indicates the private qualification that the Plaintiff certifies, and those who have that qualification, as well as the Plaintiff's business of fostering and disseminating "Bousaishi," etc., and therefore that it is permissible to separate and observe the character part, "防災士", of the Trademark alone.

However, the word "Bousaishi" cannot be said to be highly well known among consumers, including consumers other than "those who are interested in disaster prevention or qualifications relating to disaster prevention." In addition, the configuration of the Trademark and the combination of the words should have a unique function of distinctiveness, and it is not reasonable to observe the Trademark separately.

Then, the Trademark and the Cited Trademark are different in appearance, pronunciation, and concept. Even if the Trademark and the Cited Trademark can be said to be common in part of these elements, the Trademark should be considered as a trademark integrally formed as a whole, and the difference between the Trademark and the Cited Trademark is significant and easily distinguishable. Accordingly, comprehensively examining the impression, memory, suggestion, etc. that the Trademark and the Cited Trademark give to consumers as well as considering the similarity between the Trademark and the Cited Trademark as a whole, the Trademark is not a trademark falling under Article 4, paragraph (1), item (xi) of the Trademark Act.

(2) Applicability of Article 4, paragraph (1), item (x) of the Trademark Act (not applicable)

As the trademark consisting of the characters, "防災士", which indicates the services relating to the Plaintiff's business, is substantially identical to the Cited Trademark, the trademark is not similar to the Trademark based on the same reason mentioned in (1)

above.

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

Looking at the level of the similarity between the Trademark and the Used Trademarks, they are common in part of the appearance, pronunciation, and concept, and the Used Trademarks, "防災士", are well known among those who are consumers of the designated services relating to the Trademark and also "are interested in disaster prevention or qualifications relating to disaster prevention." Based on this, the Trademark may evoke among these consumers who see the Trademark a thought that it may be a qualification that has some kind of relationship with "Bousaishi."

The well-knownness of the Used Trademarks is as mentioned above, and it cannot be said that the level of its originality is high.

It should be said that the level of relationship in nature, use, or purpose between the designated services relating to the Trademark and the services relating to the Plaintiff's business is high, and the commonality among consumers of the services is also found.

Comprehensively considering the circumstances above, it can be said that when the Trademark is used in association with its designated services, the services may be likely to cause confusion that the services relate to the qualification relating to disaster prevention that has some kind of relationship with the Plaintiff's "Bousaishi" and that they are the services relating to the business operated and managed by the Plaintiff or related organizations that have been certified by the Plaintiff (confusion in a broad sense) even if the attention ordinarily paid by consumers of the designated services is taken as criteria.

(4) Conclusion

Consequently, without the need to examine the other issues, the JPO Decision should be rescinded.

Judgment rendered on April 24, 2025

2024 (Gyo-Ke) 10095

Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: March 18, 2025

Judgment

Plaintiff: Japan Bousaishi Organization (Corporation Engaging in Specified Non-profit Activities)

Defendant: Nihon Shokuiku HED College (General Incorporated Association)

Main text

1. The decision made by the Japan Patent Office (JPO) on September 19, 2024, for the case of Invalidation Trial No. 2023-890093 shall be rescinded.
2. The court costs shall be borne by the Defendant.

Facts and reasons

(Note) Beyond what is specified separately, the definitions of the abbreviated words used in the text of this judgment are as follows.

The Trademark: Trademark stated in 1. of the Attachment, "List of Trademarks," whose trademark right holder is the Defendant (Exhibit Ko 1)

The Cited Trademark: Trademark stated in 2. of the Attachment, "List of Trademarks," whose trademark right holder is the Plaintiff (Exhibit Ko 4)

The Cited Used Trademark: Trademark consisting of the characters, "防災士" (Bousaishi); This trademark and the Cited Trademark are collectively referred to below as the "Used Trademarks."

Date of the examiner's decision of registration of the Trademark: December 28, 2021, when a decision to grant the trademark registration was made for the Trademark.

No. 1 Claim

Same as the main text.

No. 2 Outline of the case

This case is a lawsuit to seek rescission of a JPO decision to the effect that a request for a trial for invalidation of a trademark registration is groundless. The issue is whether the Trademark, "日本食育防災士" (Nihon Shokuiku Bousaishi), falls under Article 4, paragraph (1), items (vi), (vii), (x), (xi), (xv), or (xix) of the Trademark Act.

1. Basic facts (facts not disputed between the parties and facts found from the evidence shown below and the entire import of oral arguments)

(1) Parties

A. The Plaintiff is a corporation engaging in specified non-profit activities, which aims to contribute to disaster prevention and crisis management in Japan by fostering, securing, utilizing, etc. human resources with a certain level of expertise knowledge on disaster prevention called "Bousaishi" that are expected to play a leading role in activities for disaster mitigation and improving society's capability of disaster prevention (Article 3 of the Articles of Incorporation) and which provides the following types of business: a business of certifying Bousaishi, granting the qualification and title of Bousaishi, and keeping the register for recording Bousaishi (Article 5, item (i) of the Articles of Incorporation); a business of further improving the quality of Bousaishi (item (ii) of the same Article); a business of promoting utilization of Bousaishi at public organizations, voluntary disaster management organizations, companies, etc. (item (iv) of the same Article); a business of facilitating collaboration with associations and individuals sharing the aims of disaster prevention, crisis management, disaster rescue volunteering work, medical services, etc. (item (v) of the same Article); a business of conveying information on disaster prevention and crisis management, and a business of raising people's awareness through seminars, symposiums, etc. (item (vi) of the same Article); and others (Exhibit Ko 111).

B. The Defendant is a general incorporated association, which aims to conduct sustainable business, etc. for disseminating the importance of "food and eating education," "health," "the environment," and "disaster prevention" among all people and contribute to the improvement of welfare and the realization of prosperous life of the people, and also aims to conduct a business of granting certification of a private qualification and an educational business related thereto, etc. (Qualification Certification, and Exhibit Ko 41).

(2) The Trademark and the Cited Trademark

A. The Plaintiff filed an application for registration of the Cited Trademark consisting of the characters, "防災士", on April 22, 2003, and obtained a registration of establishment thereof on January 21, 2005 (Exhibit Ko 4).

B. Clever Enterprise, Inc. filed an application for registration of the Trademark consisting of the characters (standard characters), "日本食育防災士", on November 2, 2021, received a decision of registration thereof on December 28, 2021, and obtained a registration of establishment thereof on March 3, 2022 (Exhibits Ko 70 and 71).

C. The trademark right relating to the Trademark was transferred to the Defendant on March 12, 2024, through specific succession (Exhibit Ko 70).

(3) Background to the procedures for the trial of the present case, etc.

The Plaintiff filed a request for trial for seeking the invalidation of the trademark

registration of the Trademark on December 26, 2023.

The JPO examined this request as a case of Invalidation Trial No. 2023-890093 and made a decision to the effect that "the request for a trial of this case is groundless" on September 19, 2024 (the "JPO Decision"). A certified copy of the decision was served upon the Plaintiff on September 27, 2024.

On October 25, 2024, the date within the limitation of action, the Plaintiff filed this lawsuit to seek rescission of the JPO Decision.

2. Summary of the reasons for the JPO Decision

In the JPO Decision, the JPO determined that the Trademark does not fall under any of items (vi), (vii), (x), (xi), (xv), and (xix) of Article 4, paragraph (1) of the Trademark Act based on the following reasons.

(1) Well-knownness of the Used Trademarks

In light of the expertise field, the special nature of the business field, and the limited scale of business, it is found that the Used Trademarks, "防災士", had gained a certain level of well-knownness among, at least, persons in the disaster prevention field, mainly firefighters and police officers, at the time when the application for registration of the Trademark was filed and a decision to grant the trademark registration was made, although this qualification cannot be said to be one of the famous private qualifications widely familiar among general consumers in Japan.

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

A. When comparing the Trademark and the Cited Trademark, the overall constituent characters represent different words (names of the qualifications), and thus, they are easily distinguishable in appearance.

Regarding their pronunciations, they are different in tone and connotation when they are pronounced entirely in sequence, and thus, they are easily distinguishable in sound.

Regarding their concepts, the Trademark does not create any specific concept, or it evokes a unique private qualification consisting of a coined word, and therefore the Trademark is unlikely to be confused with the Cited Trademark.

Accordingly, as the Trademark and the Cited Trademark are easily distinguishable in appearance, pronunciation, and sound and they are unlikely to be confused with each other in concept, they are unlikely to mislead or cause confusion as to the source of services by comprehensively and entirely examining the impression, memory, suggestion, etc. that these trademarks give to consumers. Therefore, it cannot be said that they are similar to each other.

B. As the Trademark is well-organized in configuration and it can be perceived to represent a coined word integrally formed as a whole, it is unnatural in transactions to

observe these words separately.

Moreover, the character part, "防災士", could evoke a name of a qualification relating to disaster prevention, but it is a mere combination of words that describe the expertise field and the contents of business. It cannot be said to be the key part to give to consumers and traders a strong and dominant impression as a sign to distinguish the source of the trademark holder's services from that of others.

Accordingly, it is not appropriate to determine the similarity with the Cited Trademark just by extracting the character part, "防災士", from the Trademark.

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

Based on the same reason as that in (2) above, as the Trademark is not a trademark identical or similar to the Cited Used Trademark, "防災士", it does not fall under Article 4, paragraph (1), item (x) of the Trademark Act.

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

Even if the Cited Used Trademark has gained a certain level of well-knownness among persons in the disaster prevention field, it is not a famous private qualification widely familiar among general consumers in Japan. Moreover, its level of creativity is low as a name of the qualification relating to disaster prevention.

Furthermore, as mentioned above, the level of similarity between the Trademark and the Cited Used Trademark is low.

Consequently, even if the Trademark is used in association with its designated services, consumers who see it may associate the Trademark with a unique, private qualification different from the Cited Used Trademark, but the Trademark is unlikely to cause confusion as to the source of the services in a manner that it would have those consumers associate it with or recall the Cited Used Trademark or the Plaintiff or have them consider the relevant services to be goods or services relating to a business of the Plaintiff or a person who has any economic or organizational relationship with the Plaintiff.

(5) Applicability of Article 4, paragraph (1), item (vi) of the Trademark Act

Even if the Cited Used Trademark has gained a certain level of well-knownness among persons in the disaster prevention field, it is not a famous private qualification widely familiar among general consumers in Japan. Accordingly, it cannot be said that the Cited Used Trademark is a famous one even if it is a trademark for a non-profit, public interest business.

Moreover, as mentioned above, the Trademark and the Cited Used Trademark are not similar trademarks.

(6) Applicability of Article 4, paragraph (1), item (vii) of the Trademark Act

As mentioned above, even if the Trademark is used in association with its designated

services, the Trademark is unlikely to cause confusion as to the source of the services among consumers who see it by having them associate it with or recall the Cited Used trademark or the Plaintiff. Accordingly, such use does not damage the credibility of "Bousaishi" or disrupt fair competition order, or become contrary to the public interest in society, such as making it difficult to secure safety of the people in times of disaster.

In addition, the configuration of the Trademark per se does not consist of characters that are scandalous, vulgar, or discriminatory or that have an offensive impact on others, and no evidence is presented to show that the purpose and process of application for registration of the Trademark contain any wrongfulness.

Therefore, the Trademark is not a trademark whose continued registration would violate the order intended by the Trademark Act or is likely to cause damage to public order.

(7) Applicability of Article 4, paragraph (1), item (xix) of the Trademark Act

The Cited Used Trademark is not a trademark which is well known among consumers in Japan, is not identical or similar to the Trademark, or is not used for wrongful purposes.

3. Grounds for rescission of the JPO Decision argued by the Plaintiff

(1) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (xi) of the Trademark Act (Ground for Rescission 1)

(2) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (x) of the Trademark Act (Ground for Rescission 2)

(3) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (xv) of the Trademark Act (Ground for Rescission 3)

(4) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (vi) of the Trademark Act (Ground for Rescission 4)

(5) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (vii) of the Trademark Act (Ground for Rescission 5)

(6) Error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (xix) of the Trademark Act (Ground for Rescission 6)

No. 4 Judgment of this court

It is not reasonable to extract the part, "防災士", alone from the Trademark and observe it separately. When the Trademark is observed entirely, its similarity to the Used Trademarks would be denied, and thus, the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), items (xi) and (x) of the Trademark Act is not erroneous, but its finding and determination regarding the applicability of item (xv) of the same paragraph is erroneous. Based on this, this court determines that the JPO's

determination should be rescinded. The reasons are as below.

1. Regarding Ground for Rescission 1 (the error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (xi) of the Trademark Act)

(1) Regarding the Trademark

A. The Trademark consists of standard characters, "日本食育防災士", which are entirely indicated in a single line in a well-organized manner.

The Trademark is pronounced as "Nihon Shokuiku Bousaishi."

It is found that "日本食育防災士" is a coined word. Looking at the constituent characters, "日本" (Nihon) refers to our country name, Japan, "食育" (Shokuiku) refers to "food and eating education, including ingredients, eating habits, nutrition, etc.," "防災" (Bousai) refers to "prevention of disasters," and "士" (Shi) refers to "those who have certain qualifications and roles," which is a word often used for the names of certain national qualifications of Japan, such as "弁護士" (lawyers) and "栄養士" (dietitians), as well as for the names of many private qualifications (Exhibits Ko 37, 38, and 98, and the entire import of oral arguments). Thus, the Trademark may evoke the concept of "a certain qualification relating to food and eating education and disaster prevention in Japan and those who have that qualification."

B. Meanwhile, even after the examination of the arguments and evidence made and submitted by the Defendant (Exhibits Otsu 5 to 22) and the achievements, etc. of the business and activities conducted by the Defendant and the representative of the Defendant (Exhibits Ko 41 to 43, 45 to 64, and 69), it is not found that as of the date of the examiner's decision of registration of the Trademark, the word "Shokuiku Bousai" had been generally used or the Trademark had become well known among consumers of the designated services relating to the Trademark ((3), D., below), although it is found that certain words, such as "防災食育センター" (Bousai Shokuiku Center) and "食育防災センター" (Shokuiku Bousai Center), are being used (Exhibit Ko 69).

(2) Regarding the Cited Trademark

The Cited Trademark consists of characters, "防災士", which are indicated in a single line. It is pronounced as "Bousaishi," and evokes the concept of "a certain qualification relating to disaster prevention and those who have that qualification," deriving from the meanings of the words, "防災" and "士", mentioned above.

(3) Whether the Trademark can be observed separately

Regarding the word, "防災士", the Plaintiff argues as follows: The word indicates the private qualification that the Plaintiff certifies and those who have that qualification, and has been a famous, well-known word among consumers as a word that indicates the Plaintiff's business, etc. of fostering and disseminating "Bousaishi"; Accordingly, the

character part, "防災士", of the Trademark is a key part thereof which functions as a sign to distinguish the Trademark from another person's trademark, and thus, it is permissible to observe the Trademark by separating a part therefrom. Therefore, we will examine this point.

A. As a composite trademark, which is a combination of multiple constituent parts, is to be designed to become distinguishable from another person's trademark by these constituent parts as a whole, it is basically not permissible to extract part of the constituent parts and compare that part alone with another person's trademark to determine the similarity of the trademark per se. However, in the cases where the constituent parts of a trademark are not found to be inseparably combined with each other to an extent that it seems to be unnatural in transactions to observe them separately, such as the case where one of the constituent parts of a trademark in question is found to give to traders and consumers of the designated goods or services relating to the trademark a strong and dominant impression as a sign to distinguish the source of goods or services or the case where parts other than said part are found to produce no pronunciation or concept as a sign to distinguish the source of goods or services, it should be said to be permissible to extract part of the constituent parts of the trademark and compare that part alone with another person's trademark, thereby determining the similarity between the two (see 1962 (O) 953, the judgment of the First Petty Bench of the Supreme Court of December 5, 1963, Minshu Vol. 17, No. 12, at 1621; 1991 (Gyo-Tsu) 103, the judgment of the Second Petty Bench of the Supreme Court of September 10, 1993, Minshu Vol. 47, No. 7, at 5009; and 2007 (Gyo-Hi) 223, the judgment of the Second Petty Bench of the Supreme Court of September 8, 2008, Shumin No. 228, at 561).

B. The Plaintiff has been conducting various types of business, etc., including a business of certifying Bousaishi, which is a private qualification, granting the qualification and title of Bousaishi, and a business of improving the quality of Bousaishi ((1), A. of the basic facts section). According to the evidence (indicated at each paragraph below) and the entire import of oral arguments, the following facts are found for "Bousaishi."

(A) Regarding "Bousaishi," like-minded persons in the disaster prevention field started a campaign to establish a system of a qualification for experts who have basic expertise and skills relating to disaster prevention. In March 2002, a general meeting was held to establish the Plaintiff, and Mr. A, the former Governor of Hyogo Prefecture, took office as chairman of the Plaintiff. In July 2002, the Plaintiff obtained a certification of a corporation engaging in specified non-profit activities (Exhibit Ko 112). The current representative and chairman of the Plaintiff is the former Vice-Commissioner of the Fire and Disaster Management Agency (Exhibits Ko 3, 12, 14 to 16, 22, 68, and 112).

(B) On January 5, 2018, the Plaintiff obtained approval from the Governor of Tokyo as a corporation engaging in specified non-profit activities whose operational structure and business activities are appropriate and which contributes to enhancing public interest (Article 44, paragraph (1) of the Act on Promotion of Specified Non-profit Activities), and on June 20, 2023, obtained the renewal of the approval (Exhibits Ko 113 and 114).

(C) The Plaintiff has been conducting a series of qualification examinations of "Bousaishi" and the business of certifying the qualification since 2003. The number of certified persons has come to over 210,000 in total as of April 2021 (Exhibits Ko 12 and 23). Incidentally, the number of registered certified Bousaishi is 259,063 as of June 2023 (Exhibit Ko 11), and according to the list prepared by the Plaintiff (Exhibit Ko 93), the number of registered certified Bousaishi amounted to 296,214 as of the end of August 2024, which shows that the relevant number has been increasing year after year. The locations of these registered certified Bousaishi cover all prefectures across Japan (Exhibits Ko 3, 11, 12, 17 to 23, and 93).

Although the Defendant disputes the credibility of these figures, it is found that in view of the Plaintiff's achievements in activities, etc. ((A), (B), (D), and (E)), the figures stated at least in the published documents have a certain level of grounds and accuracy, and no other sufficient evidence that makes impact on this finding is presented.

(D) When an applicant intends to receive a certification of "Bousaishi" from the Plaintiff, they basically need to complete a "training course for fostering Bousaishi," which is implemented by training organizations certified by the Plaintiff, and then pass the qualification examination administered by the Plaintiff. As of March 2023, 32 prefectures, 74 municipalities, etc. have concluded an agreement with the Plaintiff on the implementation of Bousaishi training courses and 44 universities, national institutes of technology, etc. have been certified as training organizations (Exhibit Ko 12; The list prepared by the Plaintiff (Exhibit Ko 91) shows that 28 organizations in prefectures, etc., 48 organizations in municipalities, etc., 50 universities and national institutes of technology, etc., and 3 private companies held training courses for fostering Bousaishi in FY2024.). Many municipalities have been providing subsidies for the expenses for training courses and those for certification (Exhibits Ko 12, 13, 17 to 23, and 72 to 92).

Incidentally, the numbers of the training organizations for fostering Bousaishi above are those after the date of the examiner's decision of registration of the Trademark (December 28, 2021). However, based on the number of the certified Bousaishi in (C) above and the details of the evidence above, it can be presumed that the numbers of organizations as of the date of the examiner's decision of registration of the Trademark were close to the above.

(E) The Plaintiff has been issuing an annual leaflet titled "Bousaishi REPORT" since 2014 to explain its business relating to Bousaishi and the activities actually conducted by Bousaishi. The leaflet has been distributed at departments in charge of disaster prevention in municipalities, prefectural branches of the Japan Bousaishi Society, which is a corporation engaging in specified non-profit activities established by like-minded Bousaishi (referred to below as the "Japan Bousaishi Society"), and on occasions of various events for disaster prevention. A series of the leaflets that were issued in or before December 2021 explain case examples of efforts for fostering Bousaishi, including the "training courses for fostering Bousaishi" in (D) above which were provided by municipalities and universities, as well as those of various activities for disaster prevention, including support of activities of Bousaishi and follow-up training courses for certified Bousaishi, which are provided by the Plaintiff, municipalities, and various organizations and associations, and instruction to communities, offices, etc. in disaster prevention drills, support in preparing a disaster response manual, and activities for raising awareness of disaster prevention, which are provided by the Japan Bousaishi Society and community Bousaishi (Exhibits Ko 14, 17 to 23, and 115).

(F) "Bousaishi" certified by the Plaintiff was explained in FY2010 White Paper on Disaster Management (Exhibit Ko 24), which was issued by the Cabinet Office, as a case example of the efforts for fostering the leaders in disaster prevention in the private sector. Moreover, taking the opportunity of the "National Conference for Promoting Disaster Risk Reduction (Bousai Kokutai)," an annual event hosted by the Cabinet Office, etc., the Japan Bousaishi Society planned and exhibited displays, held seminars by Bousaishi, and conducted other activities in every year between 2017 and 2021 (Exhibits Ko 119 to 129).

(G) In the "*Chiezo mini*" contemporary dictionary provided by the Asahi Shimbun Company and the "*Digital Daijisen*" dictionary provided by Shogakukan Inc., which are online dictionaries, the word "Bousaishi" is listed and explained as a private qualification certified by the Plaintiff. However, no evidence is provided to show that the word is listed in other general Japanese dictionaries, glossaries, encyclopedias, etc. Incidentally, "*Chiezo mini*," at least, contains a considerable number of words that cannot be said to be well known among general consumers (Exhibits Ko 30 and Otsu 1 and 2).

(H) Some newspapers and online news posted 53 articles about Bousaishi between June 2004 and February 2010 (Exhibit Ko 118), 57 articles in 2013 (Exhibit Ko 31), 63 articles in 2014 (Exhibit Ko 117), and 40 articles in 2020 (Exhibit Ko 34). However, the respective evidence submitted by the Plaintiff does not necessarily clarify the details of these articles other than their headlines, the sizes of the articles in a paper format are unknown, and the number of views of the online news, which accounts for a significant

proportion, is also unknown.

(I) The qualification "Bousaishi" certified by the Plaintiff is covered by six websites that explain qualifications relating to disaster prevention, even by ones that only cover four to five major qualifications (Exhibits Ko 94 to 99).

C. According to the facts found above, the following are found: the number of certified "Bousaishi," which is a private qualification certified by the Plaintiff, exceeded 210,000 as of the date of the examiner's decision of registration of the Trademark (December 28, 2021); many activities relating to disaster prevention have been carried out, including training courses for fostering Bousaishi in preparation for the qualification examination and support for obtaining the qualification, which are provided by many municipalities, universities, etc. across Japan, support for activities of Bousaishi and training courses provided by municipalities and various organizations and associations (including those provided by the Plaintiff), and various other activities relating to disaster prevention provided by the Japan Bousaishi Society and community Bousaishi; and these achievements, etc. have been reported to some extent through newspapers, etc. and the Plaintiff has been explaining its achievements through the distribution of its annual leaflet, "Bousaishi REPORT," and other means.

These achievements, etc. are mainly the result of the measures taken by public organizations involved in disaster prevention, such as ministries and agencies, and municipalities, and the efforts made by persons relevant to various associations, etc. involved in disaster prevention, including Bousaishi. It is found that as a result, not only "Bousaishi" as a private qualification relating to disaster prevention that is certified by the Plaintiff but also the word "Bousaishi" were well known among persons involved in the organizations and associations relating to disaster prevention and those who are interested in disaster prevention and qualifications relating thereto as of the date of the examiner's decision of registration of the Trademark (December 28, 2021). No evidence contrary to this is presented.

D. Meanwhile, the designated services relating to the Trademark are "educational and instruction services relating to arts, crafts, sports or general knowledge" as well as those stated in 1. of the List of Trademarks described in the Attachment. Taking into account that the Trademark contains the characters, "防災士", and that the Trademark may evoke the concept of "a certain qualification relating to food and eating education and disaster prevention in Japan and those who have that qualification," it is considered that the consumers of the designated services relating to the Trademark inherently include those who are interested in disaster prevention or qualifications relating to disaster prevention. Therefore, it can be said that the word "Bousaishi" was well known at least among the

consumers of these designated services relating to the Trademark.

E. Having said that, it cannot immediately be concluded that it is permissible to extract the "防災士" part in the Trademark as a part that gives the consumers of the designated services a strong and dominant impression as a sign to distinguish the source of the trademark holder's services and to compare that part alone with the Used Trademarks to determine the similarity between the Used Trademarks and the Trademark per se. In other words, although the word "Bousaishi" was well known among those who are interested in disaster prevention or qualifications relating to disaster prevention, it was not well known enough to be listed in general Japanese dictionaries, glossaries, etc.

Meanwhile, the Trademark consists of standard characters, "日本食育防災士", indicated in a single line in an organized manner, and it is not configured in a manner that the character part, "防災士", alone functions independently to attract the attention of consumers who see it. In addition, the characters, "食育", contained in the Trademark have a unique meaning referring to "food and eating education, including ingredients, eating habits, nutrition, etc.," apart from "防災". The combination of "食育" and "防災" is not found to be common based on the evidence, and thus, "食育防災士" should be said to have a unique function of distinctiveness as a new coined word.

Based on the above, it cannot be said that the constituent parts other than the part "防災士" of the Trademark or the combination of the constituent parts never evoke a pronunciation or concept as a sign to distinguish the source of services. Moreover, taking this into account with the level of the well-knownness of the word "防災士" per se, as mentioned above, it is not reasonable to observe the constituent part "防災士" of the Trademark separately, and rather, the Trademark should be perceived to be a trademark integrally formed as a whole. Therefore, the Plaintiff's arguments cannot be adopted.

(4) Comparison of the Trademark and the Cited Trademark

The Trademark and the Cited Trademark are different in appearance, pronunciation, and concept as mentioned in (1) and (2) above. While they can be said to be common in the part "防災士" in appearance, in the part "Bousaishi" in pronunciation, and in part of the details of the concept, the number of common characters are merely three. Given that the Trademark should be considered as a trademark integrally formed as a whole, the difference between the Trademark and the Cited Trademark is significant and easily distinguishable. No evidence is presented enough to find that consumers misunderstand "日本食育防災士" as "防災士" and that this misleads consumers or causes confusion as to the source of services. Comprehensively examining the impression, memory, suggestion, etc. that the Trademark and the Cited Trademark give to consumers as well as considering the similarity between the Trademark and the Cited Trademark as a whole,

it cannot be said that the Trademark per se falls within "a trademark similar to another person's registered trademark" as set forth in Article 4, paragraph (1), item (xi) of the Trademark Act.

(5) Conclusion regarding Ground for Rescission 1

Accordingly, it cannot be said that the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act, and thus, Ground for Rescission 1 is groundless.

2. Regarding Ground for Rescission 2 (the error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (x) of the Trademark Act)

The Cited Used Trademark consists of the characters, "防災士", and it should be said that the Cited Used Trademark is a trademark substantially identical to the Cited Trademark. Therefore, the Trademark cannot be said to be the trademark similar to the Cited Used Trademark based on the same reason described in 1. above.

Accordingly, it cannot be said that the Trademark falls within "a trademark similar to the goods or services in relation to another person's business" as set forth in Article 4, paragraph (1), item (x) of the Trademark Act, and thus, Ground for Rescission 2 is groundless.

3. Regarding Ground for Rescission 3 (the error in the JPO's finding and determination regarding the applicability of Article 4, paragraph (1), item (xv) of the Trademark Act)

(1) Regarding the "likelihood to cause confusion in relation to the goods or services related to a business of another person"

Article 4, paragraph (1), item (xv) of the Trademark Act aims to maintain trademark users' credibility in business and protect the interests of consumers through preventing the free rides and dilution of well-known indications and protecting the trademark's function of distinctiveness from another person's trademark. In line with this, it is reasonable to construe that "the trademark which is likely to cause confusion in relation to the goods or services related to a business of another person" set forth in that item includes not only a trademark that is likely to mislead consumers into believing that the trademark in question pertains to goods or services (referred to below as the "goods, etc.") relating to another person when the trademark in question is used in association with the designated goods or services (referred to below as the "designated goods, etc.") but also a trademark which is likely to mislead consumers into believing that the goods, etc. are those relating to the business of the business owner who is in close business relationship with the other person or in relationship with a group running a marketing business with the indication identical to that of the other person (likelihood to cause confusion in a broad sense).

Then, the issue of whether the "likelihood to cause confusion" as set forth in that item

exists should be determined comprehensively by considering the following elements: the level of similarity between the trademark in question and another person's indication, the level of famousness or well-knownness and originality of another person's indication, the level of relationship in nature, use, or purpose between the designated goods, etc. relating to the trademark in question and the goods, etc. relating to another person's business, the commonality among traders and consumers of the goods, etc., and other actual conditions of transactions, etc. as well as based on the attention ordinarily paid by traders and consumers of the designated goods, etc. relating to the trademark in question as criteria (see 1998 (Gyo-Hi) 85, the judgment of the Third Petty Bench of the Supreme Court of July 11, 2000, Minshu Vol. 54, No. 6, at 1848 [the L'AIR DU TEMPS case]).

(2) The level of similarity between the Trademark and the Used Trademarks

A. According to the descriptions above, it is found that the Trademark is not similar to the Used Trademarks in terms of the application of Article 4, paragraph (1), item (x) or (xi) of the Trademark Act, and that the part "防災士" of the Trademark in appearance and the part "Bousaishi" thereof in pronunciation are identical to the respective corresponding parts of the Used Trademarks and also have commonality in concept of the element "a certain qualification relating to disaster prevention and those who have that qualification."

B. While the Trademark has a similarity to the Used Trademarks to the extent that these trademarks have such commonality, the Used Trademarks are well known among those who are consumers of the designated services relating to the Trademark and also are interested in disaster prevention or qualifications relating to disaster prevention (1., (3), D. above). Based on this, although the Trademark, "日本食育防災士", can be distinctive from the Used Trademarks, "防災士", it may evoke among these consumers, who see the Trademark, a thought that it may not be a qualification that is totally irrelevant to "Bousaishi" but may have some kind of relationship therewith.

(3) The level of famousness or well-knownness and originality of the Used Trademarks

A. As mentioned in 1., (3), D. above, the consumers of the designated services relating to the Trademark include those who are interested in disaster prevention or qualifications relating to disaster prevention, and it is found that the Used Trademarks are well known among these consumers.

B. The Used Trademarks are made merely by adding the word "士," which means "those who have certain qualifications," to the word "防災," and it cannot be said that the level of its originality is high.

(4) The level of relationship in nature, use, or purpose between the designated services relating to the Trademark and the services relating to the Plaintiff's business, the commonality among traders and consumers of the services, and other actual conditions

of transactions

A. It is found that the Plaintiff aims to conduct various activities, including a business of certifying "Bousaishi" and granting a private qualification relating to disaster prevention, a business of improving the quality of Bousaishi, and activities for awareness raising of disaster prevention (Basic fact (1), A.). According to 1., (3), B. above, it is also found that the Plaintiff has actually been conducting these activities itself, that the Plaintiff's services relating to "Bousaishi" have been provided not only through the Plaintiff per se but also through related associations certified by the Plaintiff as a training organization for fostering Bousaishi, as seen in the fact that many municipalities, universities, etc. certified by the Plaintiff have been holding training courses in preparation for taking a qualification examination of Bousaishi, and that Bousaishi certified by the Plaintiff and the Japan Bousaishi Society, which is an association of Bousaishi, have been conducting various activities for disaster prevention, including instruction to communities, offices, etc. in disaster prevention drills, support in preparing a disaster response manual, activities for awareness raising of disaster prevention, e.g., seminars, etc.

Amid this, themes in association with disaster prevention and eating were repeatedly featured in awareness raising activities, etc. for disaster prevention with the participation of Bousaishi as speakers, which were organized by municipalities, etc., even before the date of the examiner's decision of registration of the Trademark (Exhibits Ko 152 to 161). This fact shows that "disaster prevention" and "eating" are closely linked and that the issue of eating relating to disaster prevention is one of the target areas in the services relating to the Plaintiff's business (fostering and utilization of Bousaishi, collaboration with associations and individuals sharing the aim of disaster prevention, etc., awareness raising activities, such as seminars, symposiums, etc., and others).

Meanwhile, when the designated services relating to the Trademark (educational and instruction services relating to arts, crafts, sports or general knowledge, educational examination, arranging, conducting and organization of seminars, providing electronic publications, production of radio or television programs, etc.) are provided as services relating to "the collection of information on products relating to food and tools for disaster prevention and emergency use, and services for the collection, analysis, and provision of information on crisis management" (Exhibit Ko 41; Article 2 of the Articles of Incorporation), which is part of the Defendant's business, the target fields of all these types of business overlap with those in which the Plaintiff operates its business by using the Used Trademarks for awareness raising activities, etc. in terms of focusing on disaster prevention and eating as a theme. The representative of the Defendant has actually been conducting activities, etc. to disseminate food security, stockpiling, distribution, and

eating safety in times of disaster (Exhibits Ko 46 to 62, and 105), and it is found that many articles explaining these activities mention "Nihon Shokuiku Bousaishi" (Exhibits Ko 51 to 53, 55 to 58, and 60).

Based on this, it should be said that the level of relationship in nature, use, or purpose between the designated services relating to the Trademark and the services relating to the Plaintiff's business is high.

B. As both of the consumers of the designated services relating to the Trademark and those of the Plaintiff's business relating to the Used Trademarks include those who are interested in disaster prevention or qualifications relating to disaster prevention, the commonality among these consumers is found.

C. Other actual conditions of transactions

Shizuoka Prefecture is certified by the Plaintiff as a training organization for fostering Bousaishi and it has been fostering "Shizuokaken Fujinokuni Bousaishi" (Shizuoka Prefectural Bousaishi) since 2005 (which was called "Shizuokaken Bousaishi" in or before 2009) as its own unique qualification with the Plaintiff's consent regarding the name. The prefecture has been alerting the public to the fact that this qualification is different from "Bousaishi" certified by the Plaintiff and also has published a notice thereof on its website (Exhibits Ko 12, 92, 133, and 137-6-4, and the entire import of oral arguments). To put it another way, this can be said to show the current recognition that the name "Bousaishi" is generally likely to mislead consumers into believing that it is related to "Bousaishi" certified by the Plaintiff, regardless of the words that are attached before it.

(5) Determination on the likelihood to cause confusion

The aforementioned circumstances are found not only as of the date of the examiner's decision of registration of the Trademark but also as of the filing date of the application for registration of the Trademark, which was about two months before the former date (Article 4, paragraph (3) of the Trademark Act). Comprehensively considering these circumstances, it can be said that when the Trademark is used in association with its designated services, it may be likely to cause confusion that the services are the qualification relating to disaster prevention that has some kind of relationship with the Plaintiff's "Bousaishi" and that they are the services relating to the business operated and managed by the Plaintiff or related organizations that have been certified by the Plaintiff (confusion in a broad sense) even if the attention ordinarily paid by consumers of the designated services is taken as criteria.

(6) Regarding the Defendant's arguments

A. The level of similarity between the Trademark and the Used Trademarks and the well-

knownness and originality of the Used Trademarks can be found to the extent mentioned above respectively, and among the Defendant's arguments, the part contrary to this finding cannot be adopted.

B. The Defendant argues to the effect that as the business operated by the Plaintiff targets Bousaishi or those who intend to become Bousaishi, the Trademark does not mislead consumers as to the source of services if these consumers pay ordinary attention.

However, the business operated by the Plaintiff includes awareness raising activities and information conveyance relating to disaster prevention, and consumers are not limited to Bousaishi or those who intend to become Bousaishi but are those who are interested in disaster prevention. Moreover, as those who intend to obtain the qualification of Bousaishi are not always familiar with the qualification system, consumers may not necessarily be able to distinguish the source of the services when the Trademark, which has the same constituent part "防災士" as that of the Cited Trademarks, is used in association with the services similar to the Plaintiff's business. Accordingly, the Defendant's arguments above cannot be adopted.

C. The Defendant argues to the effect that the designated service "educational and instruction services relating to arts, crafts, sports or general knowledge," etc. among those services relating to the Trademark do not particularly limit consumers and that the business that the Defendant has been operating by using the Trademark focuses on particular fields, such as the importance of eating, cooking methods, and nutritional management in times of disaster, among other fields for disaster prevention. The Defendant continues that accordingly, the business operated by the Plaintiff and that by the Defendant are different in the scope of consumers and further that they may not be likely to cause confusion in the specific conditions of transactions as well.

Regarding the designated services "educational and instruction services relating to arts, crafts, sports or general knowledge," etc. relating to the Trademark, even if consumers are not limited in the literal meaning of the trademark registration, when examining the present case based on, for example, the business operated by the Defendant, those who are interested in disaster prevention or qualifications relating to disaster prevention are included in the consumers of the designated services and thus a commonality lies in the services and consumers relating to the business operated by the Plaintiff using the Used Trademarks, as stated above. Moreover, generally examining the designated services based on these points, it is also found, as stated above, that the Trademark may be likely to cause confusion in a broad sense in relation to the Plaintiff's services relating to its business when it is used in association with the designated services. Accordingly, the Defendant's arguments cannot be adopted.

(7) Conclusion regarding Ground for Rescission 3

According to the above, the Trademark is the trademark that falls under Article 4, paragraph (1), item (xv) of the Trademark Act, and therefore, there is an error in the determination presented in the JPO Decision that denied the applicability, and hence, Ground for Rescission 3 is well-grounded.

4. Conclusion

Consequently, without the need to examine the other issues, the JPO Decision should be rescinded and the court renders a judgment as stated in the main text.

Intellectual Property High Court, Second Division

Presiding judge: SHIMIZU Hibiku

Judge: KIKUCHI Eri

Judge: RAI Shinichi

(Attachment)

List of Trademarks

1. Trademark Registration No. 6521920

[Configuration of the trademark]

日本食育防災士 (standard characters)

[Class of services and designated services]

Class 41 Educational and instruction services relating to arts, crafts, sports or general knowledge; educational examination; providing information in the field of education; practical training; tutoring; educational and instruction services relating to general knowledge, arts, or crafts; arranging, conducting and organization of seminars; providing electronic publications; providing online electronic publications (limited to those not downloadable); services of reference libraries for literature and documentary records; book rental; publication of books; online publication of electronic books and journals; electronic desktop publishing; publication of texts (other than publicity texts); providing videos from the internet; production of radio or television programs; production of videotape film in the field of education, culture, entertainment or sports (not for movies or television programs and not for advertising or publicity); and providing facilities for movies, shows, plays, music or educational training

[Registration date] March 3, 2022

[Filing date] November 2, 2021

[Date of the examiner's decision of registration] December 28, 2021

2. Trademark Registration No. 4833713

[Configuration of the trademark]

防 災 士

[Class of services and designated services]

Class 41 Educational and instruction services relating to arts, crafts, sports or general knowledge (including: qualification examination of: expert knowledge and skills relating to disaster prevention,

knowledge and skills relating to the publication of information on disaster prevention or disasters, knowledge and skills relating to emergency medical treatment, and knowledge and skills relating to evacuation guidance; education and instruction of: expert knowledge and skills relating to disaster prevention, knowledge and skills relating to the publication of information on disaster prevention or disasters, knowledge and skills relating to emergency medical treatment, and knowledge and skills relating to evacuation guidance; and certification of the quality of expert knowledge and skills relating to disaster prevention, knowledge and skills relating to the publication of information on disaster prevention or disasters, knowledge and skills relating to emergency medical treatment, and knowledge and skills relating to evacuation guidance); animal training; services of reference libraries for literature and documentary records; arranging and planning of movies, shows, plays or musical performances; movie theater presentations or movie film production and distribution; presentation of live performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; rental of cine-films; rental of television sets; rental of radio sets; book rental; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; and rental of recorded video discs

[Registration date] January 21, 2005

[Filing date] April 22, 2003