

Date	January 25, 1996	Court	Tokyo High Court
Case number	1994 (Ne) 1470		
<p>– A case in which the court found that the mark created as a design based on the characters "Asahi" and the mark created as a design based on the characters "AsaX" are not similar to each other.</p> <p>– A case in which the court denied the copyrightability of the logo marks consisting of the characters "Asahi."</p>			

References: Article 2, paragraph (1), item (i) of the Unfair Competition Prevention Act, Article 2, paragraph (1), item (i) of the Copyright Act
Number of related rights, etc.: Trademark Registration No. 2055143, etc.

Summary of the Judgment

1. The appellant is engaged in the business of manufacturing and selling beer and other alcohol beverages by using the following marks 1 and 2 ("Appellant's Marks") and has received a trademark registration with respect to the following mark 1 (Trademark Registration No. 2055143, etc.; "Appellant's Trademark"). The Appellant's Marks are widely known to consumers and traders as business indications of the appellant.



The appellee is engaged in the business of selling rice by using the following mark ("Appellee's Mark").



The appellant claimed prohibition of the use of the Appellee's Mark based on the Unfair Competition Prevention Act and the trademark right by alleging that the Appellant's Marks or the Appellant's Trademark and the Appellee's Mark are similar to each other and also claimed prohibition of the use of the

Appellee's Mark based on copyrights by alleging that the font of each character used in the Appellant's Trademark is a work.

In this judgment, the court made the following findings and determinations and found that all of the appellant's claims lack legal basis as in the judgment in prior instance.

2. Claims based on the Unfair Competition Prevention Act

(1) A comparison between the appearances of the Appellant's Marks and those of the Appellee's Mark shows that the first three characters "Asa" are extremely similar in terms of the shape and position of each character. However, the part of the fourth and fifth characters of the Appellant's Marks, "hi", and the part of the fourth character of the Appellee's Mark, "X", cause a great difference in impression and thus the Appellee's Mark is not similar to the Appellant's Marks in terms of overall external appearance even if the similarity of the first three characters is taken into consideration.

(2) The Appellant's Marks are associated with the pronunciation "asahi," whereas the Appellee's Mark is associated with the pronunciation "asakkusu." It is found that the two pronunciations may be considered to give different impressions as a whole. Therefore, the pronunciation of the Appellee's Mark may not be considered to be similar to that of the Appellant's Marks.

(3) While the Appellant's Marks may be associated with the concept "朝日" (asahi), "旭" (asahi), etc., both of which mean the morning sun, the Appellee's Mark may be considered to be a coined word that is not associated with any particular concept. Therefore, the Appellee's Mark may not be considered to be similar to the Appellant's Marks in terms of concept.

(4) As described above, the Appellant's Marks and the Appellee's Mark are not similar to each other in terms of appearance, pronunciation, and concept and should therefore be considered to be dissimilar.

3. The claims based on the appellant's trademark right also lack legal basis for the same reasons mentioned above.

4. Claim based on copyrights

Characters are signs used as a linguistic means of expression. Each character has a distinctive shape in order to differentiate itself from other characters. A font is a means of expressing characters with a certain style, characteristics, etc. based on characters' original shapes. What is generally called a designed font also expresses characters as designs created based on the relevant characters' original shapes. In view of the facts that characters are a sort of cultural heritage of all human beings and that characters

originally have a practical function, i.e., transmission of information, it is generally impossible to find the copyrightability in a designed font as a manner of expression. A designed font could be found copyrightable only if the font has a design that is so artistically creative that it may be considered to be equivalent to an artistic work.

With respect to the appellant's logo marks, it may be found that each logo mark has a design that is distinctive in the following respects: The characters "A," "a," "h," and "i" have their vertical lines expressed in bold lines with their top and bottom lines going upwards from left to right at an angle of 44 degree. The oblique lines of "A," "s," "a," and "h" are expressed in thin lines going upwards from left to right at an angle of 44 degree. Each of the thin oblique lines of "A" and "s" ends with a triangle-shape flick, which goes upwards from left to right at an angle of 44 degree. However, the addition of the aforementioned design features may not be considered to have enabled viewers to perceive aesthetic creativeness. Thus, the aforementioned logo marks may not be considered to be copyrightable works.

Judgment rendered on January 25, 1996

1994 (Ne) 1470

Indication of the parties is omitted

Main text

1. This appeal shall be dismissed.
2. The claims newly made by the appellant in this instance (the claims based on the appellant's copyrights) shall be dismissed.
3. The costs of this appeal shall be borne by the appellant.

Facts

No. 1 Judicial decision sought by the parties

I. Purpose of this appeal

1. The judgment in prior instance shall be revoked.
2. The appellee shall not use the indications (alphabetic characters) presented in [1] to [3] of Attachment 2 as its indications of business.
3. The appellee shall remove indications (alphabetic characters) affixed to the following items.
 - (1) The indication shown in the photograph presented in [1] of Attachment 2 affixed to the window glass of the second floor of the building in which the appellee's headquarters are located.
 - (2) The indication presented in [2] of Attachment 2 affixed to the office envelopes.
 - (3) The indication presented in [3] of Attachment 2 affixed to the business cards used by the appellee's employees.
4. As far as the following goods are concerned: [i] alcoholic beverages (excluding medicinal liquor), [ii] soft drinks, [iii] edible fisheries products, vegetables, fruits, [iv] grain (rice and millet), and [v] livestock feed, the appellee shall not affix the marks having the shapes and configurations presented in Attachment 2 to the [a] surface of the window glass of the second floor of the building in which the appellee's headquarters are located, [b] brochures for marketing purposes, [c] business envelopes, [d] employees' business cards, and [e] wrapping paper for any of the aforementioned goods.
5. The appellee shall remove the indications of the aforementioned marks and destroy the wrapping paper bearing the indications.
6. The appellee shall bear the court costs for the first and second instances.
7. Declaration of provisional execution

II. Answers concerning the purpose of this appeal

The same as the main text of the judgment.

No. 2 Allegations of the parties concerned

I. Grounds for the claims

1. Claims based on the Unfair Competition Prevention Act

(1) The appellant has been engaged in manufacturing and sale of beer and other alcoholic beverages, soft drinks and other drinks, fertilizer, etc. as a business and used the marks presented in [1] and [2] of Attachment 1 since 1986 (hereinafter respectively referred to as "Appellant's Mark 1" and "Appellant's Mark 2) " which are collectively referred to as "Appellant's Marks").

The Appellant's Marks became widely known to consumers and traders as business indications of the appellant within several years after the aforementioned commencement of the use of the Appellant's Marks.

(2) The appellee was engaged in the sale of rice and millet. On July 20, 1991, the appellee changed its trade name from Bussan Kokkusu Kabushiki Kaisha to the current name, Asakkusu Kabushiki Kaisha, and started using the marks presented in [1] to [3] of Attachment 2 (hereinafter collectively referred to as the "Appellee's Marks") and, as a part of its business activities, affixing them to its business facilities (the window glass of the second floor of the building in which the appellee's headquarters are located) or to the items to be given or distributed to business partners such as leaflets, envelopes, business cards, and wrapping paper as its indications of business.

In view of the fact that the appellee conducted the aforementioned acts, the appellee is likely to use the Appellee's Marks as its indications of business not only for its business activities related to the sale of rice and millet but also alcoholic beverages (excluding medicinal liquor), soft drinks, edible fisheries products, vegetables, fruits, and livestock feed, which are covered by the purpose of the foundation of the company.

(Omitted)

Reasons

I. Claims based on the Unfair Competition Prevention Act

1. According to the undisputed evidence, i.e., Exhibit Ko No. 1, Exhibits Ko No. 4-1-1, No. 4-1-2, No. 4-2-1 and No. 4-2-2, Exhibits Ko No. 4-3 and No. 4-4, Exhibit Ko No. 11, and Exhibits Ko No. 12-1 to No. 12-3, and also to Exhibits Ko No. 3-1 and No. 3-2, Exhibit Ko No. 6, and Exhibit Ko No. 10, which may be considered to have been authentically established based on the entire import of oral argument, it may be found that the appellant, which engaged in manufacturing and selling beer and other alcoholic beverages, soft drinks and other drinks, fertilizers, etc. as a business, stopped using its conventional indications of business and started using the Appellant's Marks from

around January 1986. Since then, the appellant may be considered to have been using the Appellant's Marks as its indications of business. It is obvious to this court that the Appellant's Marks have become widely known to consumers and traders throughout Japan as indications of the appellant's business.

2. There is a consensus among the parties concerned about the facts that the appellee has been selling rice, that the appellee changed its trade name from Bussan Cokkusu Kabushiki Kaisha to the current name, Asax Kabushiki Kaisha, on July 20, 1991 and that, after the aforementioned change in its trade name, the appellee started affixing the Appellee's Marks to its business facilities (the window glass of the second floor of the building in which the appellee's headquarters are located) or to the items to be given or distributed to business partners such as leaflets, envelopes, business cards, and wrapping paper as its indications of business for selling rice.

3. In the following section, the court examines whether the Appellee's Marks are similar to the Appellant's Marks.

(1) The Appellant's Marks have the configurations presented in [1] and [2] of Attachment 1 and have been created as a design based on the alphabetic characters "Asahi."

The Appellee's Marks have the configurations presented in [1] to [3] of Attachment 2 and have been created by making a distinctive design based on the alphabetic characters "AsaX."

(2) (i) A comparison between the appearances of the Appellant's Marks and those of the Appellee's Marks shows that the first three characters "Asa" are extremely similar in terms of the shape and position of each character. The Appellee's Marks are only different from the Appellant's Marks in that the Appellee's Marks have each character enclosed with a thin line, whereas the Appellant's Mark 1 does not have such line. However, it is a common design technique to enclose each character with a thin line. Since this technique would not make much difference to the image of the character, the aforementioned difference would not provide sufficient grounds to deny the similarity of the aforementioned characters.

However, in view of the facts that the Appellant's Marks consist of five characters, while the Appellee's Marks consist of four characters, that, regarding the fourth and fifth characters of the Appellant's Marks, the "hi" part is different from the fourth character of the Appellee's Marks, "X," given that the former consists of one character and the latter two characters, that there is a difference in size of characters in relation to the preceding part "sa," and also that the "hi" part of the Appellant's Marks has three distinctive parallel vertical lines with top and bottom lines going upwards from left to

right, whereas the "X" part of the Appellee's Marks has a distinctive crossing of a bold diagonal line going from upper left to lower right and a thin diagonal line going from upper right to lower left, all of which cause a great difference in impression, the Appellee's Marks are not similar to the Appellant's Marks in terms of overall external appearance even if the similarity of the first three characters is taken into consideration.

(ii) The Appellant's Marks are associated with the pronunciation "asahi," whereas the Appellee's Marks are associated with the pronunciation "asakkusu."

As described above, while the two pronunciations are the same in terms of the first part "asa," the pronunciation "asahi" consists of three syllables, whereas the pronunciation "asakkusu" consists of five syllables (counting the double consonant as one syllable). These two short pronunciations are different from each other in terms of the latter-part pronunciation thereof, i.e., the "hi" part and "kkusu" part. Since the latter-part pronunciation of the Appellee's Marks "kkusu" contains the double consonant and gives a strong impression, the two pronunciations may be considered to give different impressions as a whole. Therefore, the pronunciation of the Appellee's Marks may not be considered to be similar to that of the Appellant's Marks.

(iii) While the Appellant's Marks may be associated with the concept "朝日" (asahi), "旭" (asahi), etc., both of which mean the morning sun, the Appellee's Marks may be considered to be a coined word that is not associated with any particular concept. Therefore, the Appellee's Marks may not be considered to be similar to the Appellant's Marks in terms of concept.

(iv) As described above, the Appellant's Marks and the Appellee's Marks are not similar to each other in terms of appearance, pronunciation, and concept and should therefore be considered to be dissimilar.

(3) On the grounds specified in the section, I. "Grounds for claims," 3, (1) (i) and (ii) above, the appellant alleged that the essential features of the Appellant's Marks and the Appellee's Marks are "Asa" and "A."

However, the height of "h" of the Appellant's Marks is the same as that of the first character "A." While the left vertical line of "h" is bold (although it is not particularly bold in comparison with the vertical lines of any other character), this does not mean that the left vertical line of "h" has the visual effect of dividing the first part "Asa" and the second part "hi." In the case of the Appellant's Mark 1, the space between "a" and "h" is slightly wider than the space between "A" and "s" or between "s" and "a." In the case of the Appellant's Mark 2, while the thin enclosing lines of "A," "s," and "a" overlap with each other at the point where one character touches the nearby character, the thin enclosing lines of "a" and "h" have some space in between. However, this does

not have the effect of making the first part "Asa" look separate from the second part "hi" in terms of appearance. Moreover, generally speaking, there is no evidence to support the assumption that the first part of a mark generally plays a more important role than the second part in terms of appearance. The Appellant's Marks as a whole may be presumed to be widely recognized by traders and consumers as the appellant's indications of business. The first part "Asa" may not be considered to be particularly more influential than the second part "hi" in the formation of traders' and consumers' impression and memory. While "A" of the Appellant's Marks may be considered to have a more elaborate design than other characters, this does not mean that the "Asa" part of the Appellant's Marks may be considered to be separate from the "hi" part. Similarly, in the case of the Appellee's Marks, the first part "Asa" may not be considered to be particularly more influential than the second part "X" in the formation of traders' and consumers' impression and memory. On these grounds, the appellant's allegation that "Asa" is the essential feature of the Appellant's Marks and the Appellee's Marks is unacceptable.

In the case of the Appellant's Marks, the size of the first character is relatively large, while the size of the second to fifth characters is relatively small. In the case of the Appellee's Marks, the size of the first character is relatively large, while the size of the second and third characters is relatively small. The first character "A" may be considered to have a more elaborate design in comparison with other characters. However, as mentioned above, in consideration of the facts that the Appellant's Marks as a whole may be considered to be widely recognized by traders and consumers as the appellant's indications of business and that the Appellee's Marks contain "X" written in a large character, the Appellant's Marks may not be considered to have two separate parts, i.e., "A" and "sahi." Similarly, the Appellee's Marks may not be considered to have two separate parts, i.e., "A" and "saX." Thus, the appellant's allegation that the essential feature of the Appellant's Marks and the Appellee's Marks is "A" is unacceptable.

Exhibit Ko No. 23 states that the Appellee's Marks should be considered to be similar to the Appellant's Marks on the grounds, among other things, that the similarity requirement for indications under the Unfair Competition Prevention Act is, in a sense, secondary to the confusion requirement. However, this statement is unacceptable.

4. Thus, it is reasonable to conclude that the claim made based on the Unfair Competition Prevention Act may be considered to be groundless without needing to examine any other factors.

II. Claim based on the Appellant's Trademark Right 1

1. There is a consensus among the parties concerned that the appellant has the Appellant's Trademark Right 1 and that the appellee has been affixing the Appellee's Marks to its business facilities or to the items to be given or distributed to business partners such as leaflets, envelopes, business cards, and wrapping paper as its indications of business for selling rice.

2. (1) Since the configuration of Appellant's Trademark 1 is identical with that of Appellant's Mark 1, a judgment on similarity between Appellant's Trademark 1 and Appellee's Marks is the same as the judgment described in I, 3, (2) above, i.e., the judgment that the two may not be considered to be similar.

(2) The appellant alleged that the essential feature of Appellant's Trademark 1 and the Appellee's Marks is the first part, i.e., "Asa." However, this appellant's allegation is unacceptable as described in I, 3, (3) above.

3. Therefore, it is reasonable to conclude that the claim made based on the Appellant's Trademark Right 1 may be considered to be groundless without needing to examine any other factors.

III. Claim based on the Appellant's Trademark Right 2

1. There is a consensus among the parties concerned that the appellant has the Appellant's Trademark Right 2 and that the appellee has been affixing the Appellee's Marks to its business facilities or to the items to be given or distributed to business partners such as leaflets, envelopes, business cards, and wrapping paper as its indications of business for selling rice.

2. The issue of whether Appellant's Trademark 2 is similar to the Appellee's Marks is examined below.

(1) Appellant's Trademark 2 has the configuration as presented in attached Appellant's Trademark 2.

(2) A comparison between Appellant's Trademark 2 and the Appellee's Marks has revealed that the first characters of Appellant's Trademark 2 and the Appellee's Marks are extremely similar to each other in terms of appearance. However, while all of the Appellee's Marks consist of four characters, Appellant's Trademark 2 consists of one character "A" shaped as a design. This clearly shows that the two are not similar in terms of overall appearance.

While Appellant's Trademark 2 may be associated with such pronunciation as "ē," "ei," or "a," the Appellee's Marks may be associated with the pronunciation "asakkusu." Thus, the two may not be considered to be similar in terms of pronunciation. Furthermore, since the Appellee's Marks may not be associated with any particular concept, the two may not be considered to be similar in terms of concept either.

As described above, since the Appellee's Marks may not be considered to be similar to Appellant's Trademark 2 in all of the three aspects, i.e., appearance, pronunciation, and concept, the two may not be considered to be similar.

(3) While the appellant alleged that the essential feature of the Appellee's Marks is its first part "A," this appellant's allegation is unacceptable as described in I, 3, (3) above.

3. Thus, it is reasonable to conclude that the claim made based on Appellant's Trademark Right 2 may be considered to be groundless without needing to examine any other factors.

IV. Claim based on copyrights

1. The Copyright Act specifies that "work" means "a production in which thoughts or sentiments are expressed in a creative way and which falls within the literary, scientific, artistic or musical domain" (Article 2, paragraph (1), item (i)).

Characters are signs used as a linguistic means of expression. Each character has a distinctive shape in order to differentiate itself from other characters. A font is a means of expressing characters with a certain style, characteristics, etc. based on characters' original shapes. A so-called design font also expresses characters as designs created based on the relevant characters' original shapes. In view of the facts that characters are a sort of cultural asset of all human beings and that characters originally have a practical function, i.e., transmission of information, it is generally impossible to find a designed font copyrightable as a manner of expression. A designed font could be found copyrightable only if the font has a design that is so artistically creative that it may be considered to be equivalent to an artistic work.

2. According to Exhibits Ko No. 3-2 and No. 10, and also to Exhibit Ko No. 21, which may be considered to have been authentically established based on the entire import of oral argument, the appellant may be considered to have commissioned Nippon Design Center, Inc. to create logo marks written in the fonts presented in [1] and [2] of Attachment 1.

Meanwhile, in the case of the aforementioned logo marks, i.e., alphabetic characters "Asahi," it may be found that each logo mark has a design that is distinctive in the following respects. The characters "A," "a," "h," and "i" have their vertical lines expressed in bold lines with their top and bottom lines going upwards from left to right at an angle of 44 degree. The oblique lines of "A," "s," "a," and "h" are expressed in thin lines going upwards from left to right at an angle of 44 degree. Each of the thin oblique lines of "A" and "s" ends with a triangle-shape flick, which goes upwards from left to right at an angle of 44 degree (while each of the characters presented in [2] of Attachment 1 is enclosed with thin lines, this may not be considered to be a design

feature since this is a common technique). While the font of "A" may be considered to have a more elaborate design in comparison with other characters, the addition of the aforementioned design features may not be considered to have enabled viewers to perceive aesthetic creativeness. Thus, the aforementioned logo marks may not be considered to be copyrightable works.

3. On these grounds, it is reasonable to conclude that the claim made based on copyrights may be considered to be groundless without needing to examine any other factors.

V. As described above, it was reasonable for the judgment in prior instance to dismiss the appellant's claim made based on the Unfair Competition Prevention Act and the claim made based on Appellant's Trademark Rights 1 and 2. Therefore, this appeal is groundless. Also, the claim newly made in this instance based on copyrights is groundless.

Therefore, the judgment shall be rendered in the form of the main text by applying Articles 384, 95, and 89 of the Code of Civil Procedure.

Tokyo High Court

Judges: ITO Hiroshi, HAMASAKI Koichi, ICHIKAWA Masami

Attachment (1)

[1]

Asahi

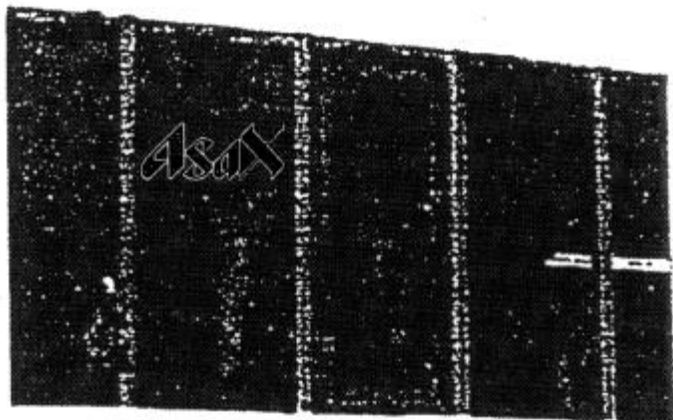
[2]

Asahi

Attachment (2)

Alphabetic characters covered by the claims in this action

[1]



[2]



[3]



Trademark Right List

1. [1] Registration No. 2055143

Application Date: December 4, 1985

Publication Date: November 13, 1987

Registration Date: June 24, 1988

Category of Goods: Class 28 (a category in the attached table related to Article 1 of the Order for Enforcement of the Trademark Act prior to the revision by Cabinet Order No. 299 of 1991; hereinafter the same)

Designated Goods: Beer, Western liquors [in general], alcoholic beverages of fruit, and Chinese liquors [in general]

The configuration is as presented in attached Appellant's Trademark 1

[2] Registration No. 2063837

Application Date: December 4, 1985

Publication Date: November 13, 1987

Registration Date: July 22, 1988

Category of Goods: Class 29

Designated Goods: Carbonated drinks [refreshing beverages], fruit juices, ice

The configuration is as presented in attached Appellant's Trademark 1

2. [1] Registration No. 2045795

Application Date: December 4, 1985

Publication Date: October 9, 1987

Registration Date: May 26, 1988

Category of Goods: Class 28

Designated Goods: Alcoholic beverages (excluding medicinal alcoholic beverages)

The configuration is as presented in attached Appellant's Trademark 2

[2] Registration No. 2063838

Application Date: December 4, 1985

Publication Date: November 13, 1987

Registration Date: July 22, 1988

Category of Goods: Class 29

Designated Goods: Tea, prepared coffee and coffee-based beverages, prepared cocoa and cocoa-based beverages, carbonated drinks [refreshing beverages], fruit juices, ice

The configuration is as presented in attached Appellant's Trademark 2

[3] Registration No. 2032752

Application Date: December 4, 1985

Publication Date: September 1, 1987

Registration Date: March 30, 1988

Category of Goods: Class 32

Designated Goods: Meat for human consumption [fresh, chilled or frozen], eggs, edible fisheries products, vegetables, fruits, processed foods

The configuration is as presented in attached Appellant's Trademark 2

[4] Registration No. 2063841

Application Date: December 6, 1985

Publication Date: November 19, 1987

Registration Date: July 22, 1988

Category of Goods: Class 33

Designated Goods: Grains, beans, flour, animal foodstuffs, seeds and bulbs, and any other plants and animals that do not belong to other classes.

The configuration is as presented in attached Appellant's Trademark 2

Appellant's Trademarks

1

The word "Asahi" is written in a bold, stylized, blackletter-style font. The letters are thick and have a slightly irregular, hand-drawn appearance. The 'A' is particularly prominent, with a sharp, pointed top.

2

A single, stylized letter 'A' in a bold, blackletter-style font. It is thick and has a slightly irregular, hand-drawn appearance, matching the style of the 'Asahi' logo above it.