judgedate
June 27, 1961

caseid
1958 (O) 1104

casename
A case of seeking rescission of the JPO decision

casetitle
Judgment regarding the determination on similarity of so-called designated goods according to Article 2, paragraph (1), item (ix) of the former Trademark Act (Act No. 99 of 1921)

summary_judge
1. In the case where identical or similar trademarks are used for different goods, even if the goods per se have no risk of being misleading or causing confusion with each other in transactions, if there is a risk of such goods being misleading or causing confusion as to having been manufactured or sold by the same business operator, it is reasonable to interpret that the goods fall under similar goods as stipulated in Article 2, paragraph (1), item (ix) of the former Trademark Act (Act No. 99 of 1921).
2. Even in the case where an application for a trademark is filed as an associated trademark of an original registered trademark, in order to be granted registration for the associated trademark, the trademark must not be similar to another person's registered trademark.

court second
Tokyo High Court, Judgment of October 7, 1958

references
Article 1 of the former Trademark Act (Act No. 99 of 1921), Article 2, paragraph (1), item (ix) of the former Trademark Act (Act No. 99 of 1921), Article 3 of the former Trademark Act (Act No. 99 of 1921)

Main text

The judgment of prior instance shall be reversed.

Appellee's claim shall be dismissed.

Appellee shall bear the court costs for the respective instances.

Reasons

Regarding Reasons 1 through 3 for the final appeal according to the attorneys representing Appellant, namely; ●●●●, one by the name of ●●●●, and ●●●●.

It is reasonable to interpret that the similarity of trademarks should be determined by whether or not it can be acknowledged that, when a trademark is used for certain goods, there is a risk of being misleading or causing confusion as to the source of the goods. Next, the similarity of designated goods should not be determined based on whether or not there is a risk of the goods per se being misleading or causing confusion in transactions, as per the ruling by the court of prior instance. Instead, in the case where identical or similar trademarks are used for different goods, if, due to circumstances such as those different goods usually being manufactured or sold by the same business operator, it can be acknowledged that those different goods are related in such a way as to pose a risk of misleading others into believing that the goods pertain to the manufacture or sale by the same business operator, it is reasonable to interpret that, in regards to these trademarks, the goods fall under similar goods as stipulated in Article 2, item (ix) of the Trademark Act (Act No. 99 of 1921) even if the goods per se have no risk of being misleading or causing confusion with each other. In the present case, the part, "正宗", from among the trademark of "橘正宗", is interpreted as being a customarily used mark that represents seishu [refined sake], whereas the part, "焼酎" [which means "shochu", or distilled spirit], from among the trademark of "橘焼酎", is a common noun, so that the two trademarks share the same principal part. In addition, according to the facts having been confirmed in the prior instance, oftentimes a sake-manufacturing business operator acquires licenses to produce both seishu and shochu, so that in the case where there is currently a business operator producing shochu by using the trademark of "橘焼酎", if there is also a business operator producing seishu by using the trademark of "橘正宗", it is clear that these products have a risk of misleading the general public into believing that both products came from the same business operator who produces liquor by using the trademarks containing the mark of "橘", and this determination is not affected by whether or not the trademark of "橘焼酎" is famous. Accordingly, it should be acknowledged that the trademark of "橘焼酎" and the trademark of "橘正宗" are

similar trademarks, and furthermore, it should also be acknowledged that the designated goods of the two trademarks are similar goods.

Next, even if an application for the applied trademark ("橘正宗") was filed as an associated trademark of the original registered trademark (Registration No. 89094, "花橘正宗"), if the applied trademark is similar to a third party's registered trademark ("橘焼酎") which was registered after the registration of the original registered trademark and which is not similar to the original registered trademark, it is reasonable to interpret that the registration of the applied trademark should be refused pursuant to Article 2 of the Trademark Act. On that note, given that it cannot be acknowledged that Appellant's registered trademark, "花橘正宗", is similar to the trademark of "橘焼酎", and furthermore, that the trademark of "橘正宗" is similar to the trademark of "橘焼酎" as described above, it must be said that Appellant's refusal of the application for registration of the trademark of "橘正宗" is reasonable. In that case, the gist of the argument made in this regard is reasonable, and thus the judgment of prior instance must be reversed. Next, according to the fact situation having been confirmed in the prior instance, the judgment rendered by the court of prior instance has no illegality, and the claim by Appellee seeking rescission of the judgment should be dismissed as being unreasonable.

Therefore, the judgment of this court is rendered unanimously by all judges, as per the main text, by application of Articles 408, 96, and 89 of the Code of Civil Procedure.

Supreme Court, Third Petty Bench

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| Presiding judge: | SHIMA Tamotsu |
| Judge: | KAWAMURA Matasuke |
| Judge: | TARUMI Katsumi |
| Judge: | TAKAHASHI Kiyoshi |
| Judge: | ISHISAKA Shuichi |