

judgedate:

February 9, 1968

caseid:

1967 (Gyo-Tsu) 32

casename:

A case of seeking rescission of the JPO decision for a trial for cancellation of trademark registration

casetitle:

Judgment regarding the requirements for constituting trademark use

summary_judge:

1. In order to constitute trademark use, it is not always necessary for the trademark to be used by being affixed with the designated goods, but it is necessary for the trademark to be used specifically in relation to those goods.
2. As long as the registered trademark, "(the trademark is attached at the end)", which consists of extremely modified and designed characters of "青星", is not used in its unique shape or at least in a shape which is considered to be the same as said unique shape in transactions, even if marks such as "青星", "アオボシ", "BLUESTAR", and a figure of a blue star are used for sauce and the like of the designated goods for the above registered trademark, and even if these marks are similar to the above registered trademark, these factors cannot provide basis for constituting use of the above registered trademark per se.

court second:

Tokyo High Court, Judgment of January 26, 1967

references:

Article 14 of the former Trademark Act (Act No. 99 of 1921)

Main text

The final appeal shall be dismissed.

Appellant shall bear the cost of the final appeal.

Reasons

Regarding Reason 1 for the final appeal according to Appellant's attorney, ●●●●.

In sum, the gist of the argument is that the judgment in prior instance is illegal due to the failure to conduct an examination sua sponte on whether or not Appellee is an interested party who is able to request for a trial for cancellation of the Registered Trademark.

However, it was acknowledged in the judgment in prior instance that Appellee constitutes an interested party under the former Trademark Act (Act No. 99 of 1921; the same applies hereinafter), and given that it is clear from records that the parties did not argue over this point in the trial of the prior instance, it cannot be considered, although the court of prior instance did not clearly make a judgment regarding the above point, that the court failed to conduct an examination. The gist of the argument cannot be accepted.

Regarding Reason 2 for the final appeal.

The gist of the argument is that, although the evidence clearly indicates that the Registered Trademark is shown on Appellant Company's writing paper and envelopes, the use of the Registered Trademark was not acknowledged as a fact in the trial of the prior instance, and that this is a result of incorrect interpretation about trademark use and is against the empirical rule and the rule of making a determination based on reasonable evaluation of evidence, thereby constituting the illegality of the failure to exercise the authority to ask for explanation.

However, in order to constitute trademark use, while it is not always necessary for the trademark to be used for the designated goods per se by being affixed therewith, it is reasonable to interpret that the trademark must be used specifically in relation to those goods. Next, even with regard to a transaction document which indicates a trademark, there is no empirical rule according to which it is presumed that the document is always used specifically in relation to designated goods as per the asserted opinion, and it must be said that this fact is something with regard to which the relevant party must make an assertion and submit evidence without waiting for the court's exercising of the authority to ask for explanation.

According to the facts having been confirmed in the judgment in prior instance, the writing paper according to the asserted opinion was used only for notifying Appellant Company's directors about the calling of board of directors meetings and

for notifying shareholders about extraordinary general meetings, and the envelopes according to the asserted opinion are unused, and there is no sufficient evidence to otherwise acknowledge that these documents were used specifically in relation to goods such as "Sauce", which is among the designated goods for the Registered Trademark, so that in the end, even with all the evidence shown in the lawsuit of the present case, it cannot be acknowledged as a fact that Appellant used the Registered Trademark after 1953.

In that case, the aforementioned determination made in the prior instance is reasonable and has no illegality in regards to the asserted opinion, so that the gist of the argument is utterly unacceptable.

Regarding Reasons 3 and 4 for the final appeal.

In sum, the gist of the argument is that the judgment in prior instance, which was rendered to the effect that there was no use of the Registered Trademark, is illegal on the grounds of an omission involving a determination, inadequacy of reasons, discrepancy in reasons, breach of the empirical rule, and inexhaustive examination.

However, although the reason for adopting the Registered Trademark for use lies with characters, "青星", these characters have been modified and designed so much so that a person looking at them would agree that there are said characters only after being explained as such and observing the characters in detail, and this is as per the confirmation made in the judgment in prior instance, so that it should be said that the Registered Trademark has particular distinctiveness as a trademark because of this unique shape. Accordingly, upon determining whether or not Registered Trademark was used, the determination should be made based not just on the pronunciation or concept produced from the trademark, but also on the use of the aforementioned unique shape or at least a shape which would be considered the same as the aforementioned unique shape in transactions. In addition, in the case of an "associated trademark" according to the proviso of Article 14, paragraph (1) of the former Trademark Act, it is not enough for the trademark pertaining to the use to be merely similar to the registered trademark to be examined in the trial, but the trademark must have been registered as an associated trademark of the registered trademark, and this is evident in light of the provisions of Article 3 of the same Act. However, according to the facts confirmed in the judgment in prior instance, the trademark pertaining to the use as per the asserted opinion is not the one which was registered as an associated trademark of the Registered Trademark, and this is something which Appellant agrees and does not argue against, and there is no sufficient evidence to acknowledge that the Registered Trademark was used in the

aforementioned unique shape or in a shape which would be considered the same as the aforementioned unique shape in transactions. Accordingly, even if the Registered Trademark produces the pronunciation or concept as per the asserted opinion, and even if the trademark pertaining to the use as per the asserted opinion is similar to the Registered Trademark, these factors should not have any influence on the determination made in the prior instance to the effect that Appellant failed to use the Registered Trademark for three consecutive years following 1953 without just cause, and it also cannot be found that there is illegality as per the asserted opinion with regard to the process of making the determination.

In that case, the gist of the argument is groundless, and reversal of the judgment is unavoidable.

Therefore, the judgment of this court is rendered unanimously by all judges, as per the main text, by application of Articles 401, 95, and 89 of the Code of Civil Procedure.

Supreme Court, Second Petty Bench

Presiding judge:	OKUNO Kenichi
Judge:	KUSAKA Asanosuke
Judge:	KIDO Yoshihiko
Judge:	ISHIDA Kazuto
Judge:	IROKAWA Kotaro