judgedate:
September 22, 1992

caseid:
1991 (O) 1805

casename:
Case of seeking injunction against trademark right infringement

casetitle:
Judgment regarding the similarity between the registered trademark of "大森林" and the trademark of "木林森".

summary_judge:
The registered trademark of "大森林", which consists of kanji characters written in block style, and the trademark of "木林森", which consists of kanji characters written in semi-cursive style, are, when observed holistically for comparison, confusingly related at least in appearance and concept, and there is room to acknowledge that they are similar trademarks, depending on the circumstances in which the goods are traded.

court second:
Tokyo High Court, Judgment of July 30, 1991

references:
Article 36 of the Trademark Act; Article 37 of the Trademark Act

Main text

The judgment in prior instance shall be reversed.

The present case shall be remanded to the Tokyo High Court.

Reasons

Regarding the reasons for the final appeal according to Appellant's attorneys, ●●●● and ●●●●.

1. The fact situation having been confirmed in the court of prior instance is as follows.

(1) Appellant has the trademark right of Registration No. 1856899 (hereinafter referred to as "Trademark Right", and the registered trademark as "Trademark"), for which an application for trademark registration was filed on December 8, 1983, and registration was established on April 23, 1986, with the designated goods of "Soaps and detergents; Dentifrices; Cosmetics and toiletries; Perfume and flavor materials" in Class 4. The Trademark consists of the kanji characters, "大森林", written horizontally in block style.

(2) Appellee, who engages in the business of manufacture and sale of cosmetics and toiletries, sells hair growth tonic and shampoo for scalp care (hereinafter referred to as "Appellee's Products") by affixing thereto the marks, which are indicated in List of Marks attached to the judgment in the first instance (hereinafter referred to as "Appellee's Mark"), and also uses Appellee's Mark for advertisement. Appellee's Mark consists of the kanji characters, "木林森", written vertically or horizontally in semi-cursive style.

Under the above fact situation, the court of prior instance found and determined that Appellee's Mark is not similar to Trademark in any of appearance, pronunciation, and concept, even when these factors are considered comprehensively. As such, the court of prior instance dismissed the appeal made by Appellant against the judgment in the first instance, which dismissed the principal action made by Appellant seeking an injunction of the manufacture and sale of Appellee's Products and the like on the premise that Appellee's Mark is similar to Trademark.

2. However, the above judgment of the court of prior instance cannot be approved, for the following reasons.

(1) The similarity between trademarks should be judged holistically by comprehensively taking into consideration factors such as the impression, memory, and association which are given to traders from the appearance,

concept, and pronunciation and the like of the trademarks when they are used on identical or similar goods, and furthermore, as long as it is possible to clarify the actual circumstances in which goods are traded, the determination should be made based on the specific circumstances of trading (refer to Supreme Court Judgment 1964 (Gyo-Tsu) 110; the judgment rendered on February 27, 1968 by Third Petty Bench; Minshu Vol. 22, No. 2, page 399), and sometimes the trademarks, which are not similar in regards to the individual factors of appearance, concept, and pronunciation under close observation, may actually be similar depending on the specific circumstances of trading. Accordingly, attention should be paid to the fact that the applicability of similarity, when considered comprehensively in terms of appearance, concept, and pronunciation, is subject to change depending on the specific circumstances of trading.

(2) When the above is considered for the present case, Trademark and Appellee's Mark are identical in two of the characters used; namely, "森" and "林". Considering that the characters, "大" and "木", which are not identical, can be confusingly similar depending on how the characters are written, and that Appellee's Mark is a coined word that has no meaning, and that, given the characters constituting the trademarks, the two trademarks both evoke a tree that is suggestive of producing the effect of hair growth, it is clear that the two trademarks are, upon holistic observation for comparison, confusingly related in terms of appearance and concept at least, so that, depending on the circumstances in which the goods are traded, the likelihood of customers mistaking one for the other cannot be denied, and resultingly, it must be said that there is room for acknowledging that the two trademarks are similar.

(3) Upon explaining as to whether or not there is similarity in terms of concept, the court of prior instance stated that the customers of products such as hair growth tonic for scalp care affixed with Trademark and Appellee's Mark are men who strongly desire hair growth, and made the presumption that such consumers are deeply interested in the marks with which such goods are affixed and pay close attention upon product selection. However, it is clear from the empirical rule that it cannot be concluded that all customers are necessarily as described above. In addition, since Appellant makes the assertion that non-exclusive rights are granted for Trademark Right and that holders of non-exclusive rights affix Trademark to hair growth tonic for scalp care and sell the goods through affiliated companies, the circumstances in

which goods are traded and which may possibly come out of this asserted fact must be taken into account upon determining the similarity between Trademark and Appellee's Mark. Accordingly, it must be said that the presumed fact alone, which was made by the court of prior instance as described above, is not sufficient to constitute grounds for determining that the two trademarks are not similar. The court of prior instance merely concluded, in addition to the above, that it cannot be acknowledged that the two trademarks are similar in concept even when consideration is given to the circumstances of trading, as can be conceived from the designated goods for which Trademark is used, as well as the circumstances of trading that is currently conducted for Appellee's Products by using Appellee's Mark. As such, the court of prior instance found and determined the issue of whether or not Trademark and Appellee's Mark are similar without making specific findings about circumstances of trading such as whether Appellee's Products are sold via door-to-door sales or via over-the-counter sales, and in the case of the latter, how the goods are exhibited. Accordingly, it must be said that the judgment in prior instance has illegality of application of incorrect interpretation of law, or inadequacy of reason, which would clearly have influence on the judgment.

3. Therefore, the gist of the argument which makes the above point is reasonable, reversal of the judgment in prior instance cannot be avoided, the present case shall be remanded to the court of prior instance for further examination, and the judgment of this court is rendered unanimously by all judges, as per the main text, by application of Articles 407, paragraph (1) of the Code of Civil Procedure.

Supreme Court, Third Petty Bench

Presiding judge:	SONOBE Itsuo
Judge:	SAKAUE Toshio
Judge:	TEIKA Katsumi
Judge:	SATO Shoichiro
Judge:	KABE Tsuneo