

judgedate:

July 11, 2005

caseid:

2003 (Gyo-Hi) 353

casename:

A case of seeking rescission of the JPO decision

casetitle:

Judgment related to observance of the period of exclusion of the request for invalidation trial of the trademark registration on the ground of violation of Article 4, paragraph (1), item (xv) of the Trademark Act (before revision by Act No. 65 of 1991) and the description of the grounds for the request in the written request for trial

summary_judge:

In order to assert that the request for invalidation trial of the trademark registration on the ground of violation of Article 4, paragraph (1), item (xv) of the Trademark Act (before revision by Act No. 65 of 1991) observes the period of exclusion prescribed in Article 47 of the Trademark Act (before revision by Act No. 68 of 1996), it is only necessary that the written request for trial submitted within the period of exclusion has the description that the trademark registration concerned violates the provisions of the item (xv) as the grounds for the request.

court second:

Tokyo High Court, Judgment of September 29, 2003

references:

Article 4, paragraph (1), item (xv) of the Trademark Act (before revision by Act No. 65 of 1991), Article 46, paragraph (1) of the Trademark Act (before revision by Act No. 68 of 1996), Article 47 of the Trademark Act (before revision by Act No. 68 of 1996), Article 56, paragraph (1) of the Trademark Act (before revision by Act No. 68 of 1996), Article 131, paragraph (1) of the Patent Act (before revision by Act No. 68 of 1996)

Main text

The present final appeal shall be dismissed.

Appellant shall bear the cost of the final appeal.

Reasons

Reason of the second petition for acceptance of final appeal by the attorneys of the final appeal, ●●●● and ●●●●

1. The outline of factual relations legally finalized in the court of prior instance is as follows.

(1) Appellant of final appeal is the holder of a trademark right of the registered trademark with Registration No. 2357409 (trademark registration filed on July 31, 1978, establishment of the trademark right registered on November 29, 1991, hereinafter, the trademark shall be referred to as the "present trademark", and the trademark registration as the "present trademark registration") consisting of laterally written European characters of "RUDOLPH VALENTINO" with the designated goods in Class 17 "clothes (excluding special clothes for exercise), fabric belongings (excluding those belonging to the other classes), bedclothes (excluding beds)" in the attachment to the Ordinance of the Trademark Act (before revision by Ordinance No. 299 of 1991).

(2) Appellee made a request for an invalidation trial of the present trademark registration on November 28, 1996 (hereinafter, this request is referred to as the "present request for trial"). The written request for trial submitted by Appellee on the same date (hereinafter, referred to as the "present written request") described as the grounds for the request that the present trademark registration was made in violation of the provisions of Article 4, paragraph (1), item (xv) (hereinafter, referred to simply as "item (xv)") of the Trademark Act (before revision by Act No. 65 of 1991) and thus, it should be invalidated pursuant to the provisions in Article 46, paragraph (1) of the same Act, and the detailed grounds would be supplemented later. The present request for trial was made immediately before expiration of the period of exclusion prescribed in Article 47 (hereinafter, referred to simply as "Article 47") of the Trademark Act (before revision by Act No. 68 of 1996) of the present trademark registration.

The present request for trial was examined at the Japan Patent Office as the case of Trial No. 20103 of 1996. The chief administrative judge in charge of this case ordered Appellee to submit a document describing the grounds for the request within 30 days from the date of dispatch by the "written order of procedural amendment

(format)" dispatched on January 24, 1997.

Appellee submitted the document on February 18 of the same year, describing as the grounds for the request that each of the trademarks "VALENTINO GARAVANI" and "VALENTINO" used by Appellee for clothes for men and women had become well-known before the date of filing the trademark registration of the present trademark and thus, if Appellant uses the present trademark for the designated goods, it would misleadingly indicate the goods as those relating to the business operation of Appellee and there is a concern that a place of origin of the goods would be confused.

Appellant asserted that, as the grounds for the request in the written request for trial submitted before lapse of the period of exclusion, if only the applicable provisions are described, even if the document describing the specific grounds for the request is submitted after the lapse thereof, it does not mean that the request for trial was made before lapse of the period of exclusion and thus, the present request for trial should be dismissed as unlawful.

(3) Regarding the present request for trial, the decision that the present trademark registration should be invalidated (hereinafter, referred to as the "present JPO decision") was made on June 14, 2002. Regarding the aforementioned assertion by Appellant related to the period of exclusion, on the grounds that the applicable provisions are explicitly indicated as the reasons for invalidation in the present written request and also, that the document describing the specific grounds was submitted within the period for which the amendment was ordered, it was judged that the present request for trial is not an unlawful one which did not observe the period of exclusion.

2. This case is a lawsuit in which Appellant asserts that the present JPO decision has an error in interpretation and application of the provisions of Article 47 and the like and seeks rescission thereof.

3. The court of prior instance judged that the present written request has only description that the present trademark registration violates the provisions in item (xv) and does not describe assertion of the facts constituting the specific invalidation reasons, but in view of the circumstances that the indications such as "VALENTINO", "barentino (Japanese)" used by Appellee for the goods relating to the business operation thereof are well-known to the dealers and consumers in the fashion-related field of our country, that the word "barentino" is included in the name of the demandant (Appellee) described in the present written request and the like, it can be deemed that the present written request has description of the invalidation reasons that the present trademark is a trademark which is likely to cause confusion in relation

with the aforementioned indication by Appellee and thus, it was judged that the present request for trial is not an unlawful one that did not observe the period of exclusion.

4. Article 47 prescribes that the invalidation trial of the trademark registration on the ground of violation of the item (xv) should be requested within the period of exclusion of 5 years from the date of registration of establishment of the trademark right. The purpose thereof is interpreted such that the trademark registration violating the provisions in the item (xv) should be invalidated, but if the period of exclusion has elapsed without request for the invalidation trial of the trademark registration, validity of the trademark registration is made undisputable in order to protect an existing continuous state generated by the trademark registration. In view of the purpose of the provisions described above, such trademark may not have been granted trademark registration and thus, there is no strong demand for protection of the holder of a trademark right by ensuring the validity thereof at an early stage. And it can be considered that the existing continuous state is overcome as long as the invalidation trial of the trademark registration was requested within the period of exclusion, and the written request for trial has description that the trademark registration violates the provisions in item (xv).

Then, in order to assert that the request for invalidation trial of the trademark registration on the ground of violation of item (xv) observes the period of exclusion, it is only necessary that the written request for trial submitted within the period of exclusion has the description as the grounds for the request that the trademark registration concerned violates the provisions of the item (xv), and it is reasonable to interpret that description of the assertion relating to the specific factual relations which should be applicable to the provisions of the item (xv) is not required.

By examining this for this case, according to the aforementioned factual relations, it is obvious that the present request for trial observes the period of exclusion, and there are no errors in interpretation and application of Article 47 in the present JPO decision. The aforementioned judgment of the court of prior instance that the present request for trial is not unlawful can be accepted as a conclusion. The gist cannot be employed.

Therefore, the judgment shall be rendered as in the main text unanimously by all the judges.

(Presiding Judge: NAKAGAWA Ryoji, Judge: FUKUDA Hiroshi, Judge: TAKII Shigeo, Judge: TSUNO Osamu, Judge: IMAI Isao)