Date	July 20, 2016	Court	Intellectual Property High Court,
Case number	2016 (Gyo-ke) 10062		Fourth Division

- A case in which the court held that one pronunciation and concept pair from among those that the trademark in the application in question (the "Trademark") produces is identical to that of the cited trademark and thus these two trademarks are similar; the court also held that, even though the essential features of the Trademark and cited trademark have some difference in their appearance, such difference is not significant enough to dispel the effects of the identicalness of their pronunciation and concept and to reverse the determination of said similarity.

References: Article 4, paragraph (1), item (xi) of the Trademark Act

Number of related rights, etc.: Trademark Application No. 2014-067553, Trial against Examiner's Decision of Refusal No. 2015-12355, Trademark Registration No. 2701839 (the "Cited Trademark")

Summary of the Judgment

[Trademark]



Designated goods (after the amendment of February 26, 2015)

: Class 9 "Electric switches, cell switches [for electricity], control panels [for electricity], branch boxes, electric connections, chargers for electric batteries, battery chargers, etc."

[Cited Trademark]



Designated goods

: Class 9 "Power distribution or control machines and apparatus, rotary converters, phase modifiers, batteries and cells, electric or magnetic meters and testers, electric wires and cables, electric flat irons, electric hair-curlers, etc.

1. With regard to a request for a trial against an examiner's decision of refusal pertaining to the Trademark, the JPO determined that the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act based on the grounds that the letter

part in the Trademark, "FIT," and the Cited Trademark have similar appearance, identical pronunciation and a common concept and therefore that these two trademarks are found to be similar to each other.

2. In this judgment, as mentioned below, the court also determined that the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act and that the JPO decision contains no error in its determination to the same effect.

(1) Regarding pronunciation and concept

(2) Whether the Trademark and the Cited Trademark are similar

Among the pronunciations and concepts that the Trademark produces, the pronunciation "フィット" (fitto) and the concepts representing "suitable" and "to fit" are identical to the pronunciation and concept of the Cited Trademark. If a trademark subject to comparison produces more than one pronunciation and concept, as seen in this case, and if one pair of those pronunciations and concepts is identical to that of the other trademark, these two trademarks should be determined to be similar (1962 (O) 953, judgment of the First Petty Bench of the Supreme Court on December 5, 1963, Minshu Vol. 17, No. 12, at 1621).

Although the appearance of the letter part, "FIT," in the Trademark and the Cited Trademark are different in terms of the font color and font type, these differences are not significant enough to dispel the effects of the identicalness of their pronunciation and concept and to reverse the determination of said similarity.

According to the findings above, the Trademark and the Cited Trademark may mislead consumers or cause confusion as to the source, and these trademarks can be considered to be similar to each other.

(3) Regarding designated goods

The designated goods of the Trademark are identical or similar to the "power distribution or control machines and apparatus; rotary converters; phase modifiers; batteries and cells; electric wires and cables; telecommunication devices and apparatus (excluding digital cameras and their parts); electronic machines, apparatus and their parts; magnetic cores; resistance wires; and electrodes" among the designated goods of the Cited Trademark.

(4) Conclusion

Based on the above findings, the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

Judgment rendered on July 20, 2016

The original received on the same day Court Clerk 2016 (Gyo-Ke) 10062 Case of Seeking Rescission of JPO Decision Date of conclusion of oral argument: June 29, 2016

Judgment

Plaintiff: Foxconn Interconnect Technology Limited

Defendant: Commissioner of the Japan Patent Office

Main text

- 1. Plaintiff's claim is dismissed.
- 2. Plaintiff shall bear court costs.
- 3. The additional period for filing a final appeal and a petition for acceptance of final appeal against this judgment shall be 30 days.

Facts and Reasons

I. Claim

The JPO decision made by the JPO on October 28, 2015 with respect to Appeal against Examiner's Decision No. 2015-12355 should be rescinded.

- II. Outline of the case
- 1 Outline of procedures at the JPO
- (1) On August 11, 2014 Plaintiff filed an application for registration (Trademark application No. 2014-067553) of a trademark (hereinafter referred to as the "trademark in the application") shown by the indication of the trademark in the application in Attachment 1 (Exhibit Ko 14).
- (2) On December 1, 2014 Plaintiff received a notice of reasons for refusal (Exhibit Ko 15), and in response Plaintiff changed the designated goods by means of a written amendment dated February 26, 2015 (Exhibit Ko 18). However, since Plaintiff received a decision of rejection (Exhibit Ko 19) on March 30 of the same year, Plaintiff demanded an appeal against the decision of rejection (Exhibit Ko 20) on June 30 of the same year.
- (3) The JPO handled this case as Appeal against Examiner's Decision No. 2015-12355 and rendered a JPO decision (hereinafter the "JPO decision") on October 28,

2015 to the effect that "the request for an appeal is dismissed," which is indicated in the attached written JPO decision (copy). On November 10 of the same year, its certified copy was served on Plaintiff and 90 days were added as a limitation period.

- (4) On March 9, 2016, Plaintiff instituted suits against appeal decisions made by the JPO, which seeks rescission of the JPO decision.
- (5) On March 11, 2016, with reference to the JPO decision, the JPO determined the correction described in an attached written determination of correction (copy).

2 Gist of the reasons given in the JPO decision

The reasons given in the JPO decision are as described in the attached written JPO decision (copy). In a nutshell, the reasons given in the JPO decision are that since the trademark in the application is similar to the trademark shown in the indication of the cited trademark in attachment 2 (hereinafter referred to as the "cited trademark") and the designated goods of the trademark in the application and those of the cited trademark are identical or similar, the trademark in the application should not be registered under Article 4, paragraph (1), item (xi) of the Trademark Act.

3 Grounds for rescission

Error in the determination that the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act

(omitted)

IV Court decision

1 Determination of similarity between trademarks

Similarity between trademarks under Article 4, paragraph (1), item (xi) of the Trademark Act should be examined from an overall perspective by comprehensively considering various factors, including specific impression, memory, or association that the trademarks affixed to identical or similar goods or services will give to traders and consumers by means of their appearances, concepts, and pronunciations, and should also be determined based on the actual conditions of trade of the goods as far as such actual conditions can be clearly defined (See 1964 (Gyo-Tsu) 110, judgment by the Third Petty Bench of the Supreme Court on February 27, 1968/Minshu Vol. 22, No. 2, page 399.).

Regarding this matter, if a composite trademark having a combination of one or more components is found to be combined so inseparably that it is unnatural in trade to observe one or more components separately from the other components, it is not permissible in principle to extract a part of the components and compare only that part of the composite trademark with the trademark of another person to determine the similarity between the trademarks. On the other hand, if a part of the components of the trademark is found to give a strong dominant impression to traders and consumers as a source identifier of goods or services and if no pronunciation or concept as the source identifier is found to be generated from the other parts, it can also be said to be permissible that only a part of the components of the trademark is compared with the trademark of another person and determine the similarity between the trademarks (See 1962 (O) No. 953, judgment by the First Petty Bench of the Supreme Court on December 5, 1963/Minshu Vol. 17, No. 12, page 1621, 1991 (Gyo-Tsu) 103, judgment by the Second Petty Bench of the Supreme Court on September 10, 1993/Minshu Vol. 47, No. 7, page 5009, 2007 (Gyo-Hi) 223, judgment by the Second Petty Bench of the Supreme Court on September 8, 2008/Civil Case Law Reports of the Court No. 228, page 561.).

From the above standpoint, the similarity between the trademark in the application and the cited trademark is reviewed.

- 2 Regarding the trademark in the application
- (1) Whether or not the character part, "FIT", can be extracted from the configuration of the trademark in the application
- A Regarding the appearance of the trademark in the application (Exhibit Ko 14)
- (A) The trademark in the application has the appearance as shown in the indication of the trademark in the application in attachment 1 and is a composite trademark that consists of a combination of the character part, "FIT", the character part, "Foxconn Interconnect Technology", and an ellipse slightly inclined to the right.

The character part, "FIT" is located at the center of the trademark in the application and its height exceeds half the height of the entirety of the trademark in the application and its width exceeds 80% of the width of the entirety of the trademark in the application. It consists of three uppercase alphabetic characters, "F", "I", and "T", and each of them is an italic bold character and has a black border around a blue background. The characters are horizontally aligned and adjacent to each other and the characters "F" and "I" are located at the center of the ellipse disposed from a position slightly right of the center to the left end of the trademark in the application and take up about half of the area of the ellipse. As for the character "T", only the left end of its component horizontal bar is located within the ellipse, but the other part is outside the ellipse. No circumferential line is drawn in a portion where the character

"T" and the circumferential line of the ellipse appear to be overlapped.

The entirety of the character part, "Foxconn Interconnect Technology", is within the ellipse and is disposed along a portion of the inner circumferential line. The character part is divided into the three terms, "Foxconn", "Interconnect", and "Technology" and is composed of 29 alphabetic characters in total. The initials of the terms, "F", "I", and "T" are uppercase and the other characters are all lowercase and each of them is displayed in a general font in red. Even the three characters, "F", "I", and "T", displayed in uppercase, are only a fifth of the height and width of each of the component characters of the character part, "FIT", and they are composed of finer lines. The character part, "FIT", is considerably larger than the character part, (B) "Foxconn Interconnect Technology", and in addition, it is displayed in a characteristic font, bold italic with a black border around a blue background. It is located at the center of the trademark in the application and takes up the majority of the entire area of the trademark in the application and provides a three-dimensional impression. Because of the combination of these characteristics of the character part, "FIT", (its above-mentioned impression, its horizontal and adjacent alignment, and its positional relationship with the ellipse), the character part, "FIT", gives anybody seeing the trademark in the application an impression that it divides the ellipse from the center and runs across the entirety of the trademark in the application. On the other hand, the entirety of the character part, "Foxconn Interconnect Technology", is within the ellipse and is displayed in the general font along a portion of the inner circumferential surface of the ellipse and as a whole it is considerably smaller than the character part, "FIT". The red component lines of each of the characters are fine and the character part, "Foxconn Interconnect Technology", clearly does not stand out. components of the ellipse are black lines which are finer than each of the characters of the character part, "Foxconn Interconnect Technology", and the ellipse and the character part, "Foxconn Interconnect Technology", on its inner circumferential surface simply provide an impression that they form a background of the character part, "FIT".

(C) In light of the foregoing, it is clear that in the trademark in the application, the character part, "FIT", more conspicuously stands out in appearance and gives those who see this trademark in the application a far stronger impression and attracts their attention more strongly than other parts of the components. On the other hand, the character part, "Foxconn Interconnect Technology", is obviously less conspicuous than the character part, "FIT", and does not attract so much attention of those who see the trademark in the application as does the character part, "FIT".

- B Regarding "Foxconn Interconnect Technology"
- (A) According to the exhibits shown below and the entire import of the oral argument, the following features are found. [i] Hon Hai Precision Industry (Hon Hai), which has its base in Taiwan, is an internationally well-known large corporation and is proud of its world's largest scale achievements in the electronics manufacturing service (EMS) mainly for intercompany transactions and takes advantage of a number of group companies to form a corporate group (Hon Hai Group) and also supply a variety of electronic devices and apparatus to the Japanese market in a large amount, including the designated goods of the trademark in the application (Exhibits Ko 2 to 4, 22, 23, 25 to 32, and 34 to 52). [ii] Hon Hai Precision Industry is also commonly known by "Foxconn". Hon Hai Group is called "フォックスコン・グループ (fokkusukon gurupu; Foxconn Group", "フォックスコン・テクノロジー・グループ (fokkusukon tekunoroji gurupu; Foxconn Technology Group", and "フォックスコン (fokkusukon; Foxconn)" and many of the companies belonging to the Group have corporate names that start with "Foxconn" (Exhibits Ko 2 to 4, 25 to 32, 34 to 41, and 43 to 52). [iii] Plaintiff is a company that belongs to Hon Hai Group and was set up on October 1, 2013 and its English name is "Foxconn Interconnect Technology Limited" (Exhibit Ko 1). [iv] On the Facebook page of "Wireless Charging Forum Japan", in the column that indicates the companies that exhibit an "iPhone 6 sleeve case with an A4WP wireless power supplying function", Plaintiff's English name "Foxconn Interconnect Technology Limited" is shown together with the trademark in the application (Exhibit Ko 8). [v] Livedoor News on July 4, 2013 reported "what was adjusted by the first batch of troops was two application projects, NWInG of Foxconn and the name of NWInG after being independent was changed to 'FIT' (フォックスコン・インターコネクト・テクノロジー (Foxconn Interconnect Technology))" (Exhibit Ko 33). [vi] Nikkei Express News dated December 18, 2015 reported that "Hon Hai Precision Industry and its affiliated subsidiary, フォックスコ ン・インターコネクト・テクノロジー (Foxconn Interconnect Technology), are scheduled to be become listed using spin-off" (Exhibit Ko 24). [vii] Nikkei Express news dated March 30, 2016 reported "an air conditioner IR blaster having a built-in temperature and humidity sensor ... from Foxconn ... (Foxconn Interconnect Technology, Limited)" (Exhibit Ko 21).
- (B) According to the facts found above, Foxconn $(\mathcal{I} \neq \mathcal{I} \mathcal{I} \mathcal{I} \mathcal{I})$ represents a brand of Hon Hai Group whose core company is Hon Hai Precision Industry, which is an internationally well-known large corporation and is proud of the world's largest scale achievements in the electronics manufacturing service (EMS), mainly for

intercompany transactions. Many of the companies that belong to the Group have corporate names that start with Foxconn. Plaintiff is also found to be a company that belongs to Hon Hai Group. These facts can be presumed to be well known to the traders/consumers of the designated goods of the trademark in the application.

Hence it can be said that the character part, "Foxconn Interconnect Technology", is associated with Plaintiff or at least a company that belongs to Hon Hai Group.

(C) On the other hand, the initials of the three terms that compose the character part, "Foxconn Interconnect Technology", are "F", "I", and "T", but it cannot be said yet that among the traders/consumers of the designated goods of the trademark in the application in Japan, "FIT" has been recognized as indicating the acronym of Plaintiff or a company that belongs to Hon Hai Group.

C Whether or not the character part, "FIT", can be extracted

It is clear that in the appearance of the trademark in the application, the character part, "FIT", gives much stronger impression to those who see the trademark in the application than do the other components and more strongly attracts attention. On the other hand, the character part, "Foxconn Interconnect Technology", is clearly more inconspicuous than the character part, "FIT", and does not attract so much attention of those who see the trademark in the application as the character part, "FIT".

According to the foregoing, it cannot be said that of the trademark in the application, the character part, "FIT", and the character part, "Foxconn Interconnect Technology", are combined so inseparably that it seems unnatural in trade to separate and observe the character part, "FIT", and the character part, "Foxconn Interconnect Technology". The character part, "FIT", is found to give a strong dominant impression as the source identifier of the designated goods of the trademark in the application to traders and consumers.

Accordingly, for the determination of the similarity between the trademark in the application and the cited trademark, it can be said to be permissible to extract the character part, "FIT", from the configuration of the trademark in the application and compare the trademarks.

D Regarding Plaintiff's allegation

Plaintiff alleges that since the character part, "FIT", represents the acronym of Plaintiff's trade name composed of the initials of the character part, "Foxconn Interconnect Technology", it should always be recognized as an integral part and considering the actual state of trade, it cannot be said that only the character part, "FIT", in the trademark in the application constitutes a significant part of the source identifier of the goods.

Further, as described above in C, it is clear that the character part, "Foxconn Interconnect Technology", is more inconspicuous than the character part, "FIT", and does not attract so much attention of those who see the trademark in the application as the character part, "FIT". The character part, "FIT", is found to give a strong, dominant impression as the source identifier of the designated goods of the trademark in the application to the traders/consumers.

(2) Regarding the pronunciation and concept of the trademark in the application

3 Regarding the cited trademark

The cited trademark has the appearance as shown in the indication of the cited trademark in attachment 2 and is composed of the horizontally aligned three uppercase alphabetic characters, "F", "I", and "T", and each of them is displayed in an ordinary font and is a black bold character (Exhibit Ko 16).

The cited trademark generates the pronunciation of " ± 77777 " (; FIT)" and generates the pronunciation of "fit", which corresponds to the English term "fit" that is composed of the same English characters and is associated with the concepts "apt" and "perfectly fitting" (Exhibits Otsu 1, 2).

- 4 Regarding the similarity between the trademark in the application and the cited trademark
- A comparison between the trademark in the application and the cited trademark (1) reveals that as described above in 2, the trademark in the application generates the pronunciation of "フォックスコン インターコネクト テクノロジー エフ アイ ティー (fokkusukon intākonekuto tekunorojī efu ai tī;; Foxconn Interconnect Technology FIT)" and is associated with a company that belongs to Hon Hai Group, and that the character part, "エフ アイ ティー (efu ai tī)", generates the pronunciation of "FIT" and the pronunciation of "fit" which corresponds to the English term "fit" composed of the same English characters as the component characters and is associated with the concepts of "apt" and "perfectly fitting" (Exhibits Otsu 1, 2). This is also acknowledged by Plaintiff. Of these pronunciations and concepts generated from the trademark in the application, the pronunciation of "フィット (fitto; fit)" and the concepts of "apt" and "perfectly fitting" are identical to the pronunciations and concepts of the cited trademark described in 3 above. As explained so far, if two or more pronunciations and concepts are generated from the trademarks to be compared, and when one of the pronunciations and concepts is similar, the trademarks should be said to be similar (See 1962 (O) No. 953, judgment by the First Petty Bench of the Supreme Court on December 5, 1963/Minshu Vol. 17, No. 12, page 1621).

The character part, "FIT", in the trademark in the application and the cited trademark are different in the color and font of the characters in appearance, but the difference is not sufficiently significant to surpass the identity of the pronunciations and concepts and overthrow the similarity.

Based on the foregoing, the trademark in the application and the cited trademarks are likely to deceive or cause confusion as to the source of the goods and the trademarks can be said to be similar.

(2) Plaintiff alleges that if attention is paid to the facts that the component

characters of the trademark in the application include the characters "Foxconn" which are widely known as Plaintiff's group company brand and include Plaintiff's trade name, "Foxconn Interconnect Technology", and consideration is also given to the transaction reality that attaches importance to the manufacturer of the goods in the transaction of the designated goods of the trademark in the application, in fact, the trademark in the application and the cited trademark cannot cause any confusion as to the source of the goods.

However, as described above in 2, in the trademark in the application, the character part, "Foxconn Interconnect Technology", is clearly more inconspicuous than the character part, "FIT", in appearance and does not attract so much attention of those who see the trademark in the application as the character part, "FIT". It is the character part, "FIT", which gives the traders/consumers a strong, dominant impression as the source identifier of the designated goods of the trademark in the application. Accordingly, even though the actual state of the transaction alleged by Plaintiff is considered, it should be said that the trademark in the application and the cited trademark which is composed of component characters identical to the character part, "FIT", of the trademark in the application and generates the identical pronunciations and concepts are likely to be misled and cause confusion as to the source of the goods.

5 Regarding the similarity between the designated goods

Whereas the designated goods of the trademark in the application are as described in the indication of the trademark in the application in attachment 1 (Exhibits Ko 14, 18), the designated goods of the cited trademark are as described in the indication of the cited trademark in attachment 2 (Exhibit Ko 16). The designated goods of the trademark in the application are identical or similar to "power distribution or control machines and apparatus, rotary converters, phase modifiers, batteries and cells, electric wires and cables, telecommunication machines and apparatus (not including digital cameras and their parts), electronic machines, apparatus and their parts, magnetic cores, resistance wires, welding electrodes or medical electrodes" in the designated goods of the cited trademark.

6 Conclusion

Based on the foregoing, the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act and the determination in the JPO decision to the same effect is not erroneous. Hence, the grounds for rescission alleged by Plaintiff are groundless, and therefore, Plaintiff's claim shall be dismissed

and the determination as described in the main text shall be made.

Intellectual Property High Court, Fourth Division

Presiding Judge: TAKABE Makiko

Judge: FURUKAWA Kenichi

Judge: SUZUKI Wakana

(Attachment 1)

Indication of the trademark in the application

Configuration of the trademark:



Designated goods (after amendment dated February 26, 2015): Class 9 "Electric switches; Cell switches [electricity]; Control panels [electricity]; Branch boxes [electricity]; electric connections; Chargers for electric batteries; Battery chargers; Transformers [electricity]; Converters, electric; Voltage surge protectors; Connectors [electricity]; Plugs, sockets and other contacts [electric connections]; Other power distribution or control machines and apparatus; Rotary converters; Phase modifiers; Antennas [aerials]; Masts for wireless aerials; Intercommunication apparatus; Transponders; Diaphragms [acoustics]; Cabinets for loudspeakers; Audio- and videoreceivers; Loudspeakers; Horns for loudspeakers; Microphones; Sound transmitting apparatus; Acoustic couplers; Headphones; Holders for electric coils; Electromagnetic coils; Acoustic coupling apparatus; Other telecommunication machines and apparatus; Antenna filters; Radio apparatus: Communication apparatus; Image transmitter; Multifunction digital transmitters; Amplifiers; Graphic equalizers; Impedance chalk coils; Inductors [electricity]; Mouse [computer peripheral devices]; Printed circuit boards; Light-emitting diodes [LED]; Interfaces for computers; Computer network servers; Computer software for firewalls; Computer workstations [hardware]; Other electronic machines, apparatus and their parts; Anti-interference devices [electricity]; Magnetic data media without record; Couplers [data processing equipment]; Interface apparatus for computer networks; Communication apparatus having an internet connection function, Solar batteries; Photovoltaic batteries; Identification threads for electric wires; Materials for electricity mains [wires, cables]; Copper wires, insulated; Telephone wires; Filtered coaxial cables; Other coaxial cables; Cables, electric; Junction boxes [electricity]; Optical fibers [fibres] [light conducting filaments]; Junction sleeves for electric cables; Fibre [fiber (Am.)] optic cables; Other conductors, electric; Terminals [electricity]."

(Attachment 2)

Indication of the cited trademark

Trademark registration number: No. 2701839

Configuration of the trademark:



Filing date: August 7, 1985

Registration date: December 22, 1994 Expiration date: December 22, 2024

Designated goods: Class 9 "power distribution or control machines and apparatus, rotary converters, phase modifiers, batteries and cells, electric or magnetic meters and testers, electric wires and cables, electric irons, electric hair-curlers, electric buzzers, telecommunication machines and apparatus (not including digital cameras and their parts), electronic machines, apparatus and their parts, magnetic cores, resistance wires, welding electrodes or medical electrodes"

The holder of a trademark: Fujitsu Isotec Limited

End