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judgedate

1968.02.27

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caseid

1964(Gyo-Tsu)110

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reporter

Minshu Vol. 22, No. 2

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casetitle

Judgment regarding a case where a trademark was acknowledged to be not similar to another trademark even though their terms of address were relatively similar

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casename

Case to seek revocation of a trial decision in a trial for an appeal against an examiner's decision of refusal of an application for trademark registration

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caseresult

Judgment of the Third Petty Bench, dismissed

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court_second

Tokyo High Court, Judgment of September 29, 1964

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summary_judge

With regard to a trademark that designated general thread as its designated goods and has the term of address of “Shiyouzan” and a trademark that designated only glass-fiber thread as its designated goods and has the term of address of “Hiyouzan” if their

appearance and concepts differ significantly, and if, in the real trading situation of glass-fiber thread, it is a rare case that a trademark is identified only by its term of address and thereby the place of origin of goods and their quality are recognized, it is appropriate to acknowledge that the two trademarks are not similar.

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references

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

Article 2 (1) Trademarks set forth in the following items cannot be registered.
(ix) Trademark that is identical with, or similar to, another person's registered trademark and that is used for identical or similar goods;

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maintext

The final appeal is dismissed.
The cost of the final appeal shall be borne by the appellant of final appeal.

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reason

Item I of the reasons for final appeal filed by the counsels for the final appeal

Whether two trademarks are similar or not should be determined by whether there is a risk of misidentification or confusion of place of origin of goods when the two trademarks to be compared are used for identical or similar goods. In making this determination, the impression, memory, suggestion, etc. given by the appearance, concept, term of address, etc. of a trademark used for such goods to persons involved in trading should be examined comprehensively and integrally. Therefore, it is appropriate to make the above determination based on the specific trading conditions of such goods to the extent that the real trading situation of such goods can be identified.

Meanwhile, the applied trademark in this case designates only glass-fiber thread as its designated goods, and it is apparent from the composition of the trademark that the trademark is not to be used for goods other than glass-fiber thread. In determining whether the trademark is similar to another trademark or not, the judgment in prior instance found that, in the real trading situation of glass-fiber thread, it is a rare case

that a trademark is identified only by its term of address and thereby the place of origin of goods and their quality are recognized, and held that, with regard to a trademark pertaining to such designated goods, there is no risk of misidentification or confusion of place of origin of goods even if the comparison and examination of terms of address are conducted in a relatively lenient way. Such judgment in prior instance cannot be said to be inappropriate. On the other hand, the argument of the counsels for the final appeal condemns the judgment in prior instance by arguing that the judgment made a mistake by applying a rule of thumb in general trade-name trading to the determination of similarity of trademarks. However, the judgment in prior instance did not ignore the fact that trademarks have a function of defining place of origin of goods in trading of glass-fiber thread. What the judgment in prior instance intended to hold is that it is difficult to apply a rule of thumb in general trading, in which similarity in terms of address of trademarks causes confusion of place of origin of goods, directly to trading of glass-fiber thread, and that when persons involved in trading are to identify place of origin of goods, terms of address of trademarks in trading of glass-fiber thread are not as important as they are in general trading. It should be said that the argument of the counsels for the final appeal misunderstands the judgment in prior instance.

Furthermore, with regard to the holding stated in the judgment in prior instance on the real trading situation of glass-fiber thread, the argument of the counsels for the final appeal alleges that such real situation is not as universal or stable as it can be said to be a rule of thumb but is merely a temporary and irregular trading condition in the past that was based on special circumstances at the time of development of new products. However, according to adopted evidence and all arguments, the judgment in the prior instance duly identified the trading conditions of glass-fiber thread at the time of and after the application of the applied trademark in this case. There is no evidence sufficient enough to acknowledge that such trading conditions are a regional or temporary phenomenon as alleged in the argument of the counsels for the final appeal. It should be said that the registration of the applied trademark in this case cannot be rejected by the argument of the counsels for the final appeal.

In addition, the argument of the counsels for the final appeal alleges that the judgment in prior instance contains illegality of determining the real trading situation of glass-fiber thread based on the appellee's allegations and evidence that were recanted. However, even though the records of this case were examined in detail, the allegations and evidence cannot be found to have been recanted.

The arguments of the counsels for the appeal cannot be accepted.

Item II and III of the reasons for final appeal filed by the counsels for the final appeal

Similarity of the appearance, concepts, or terms of address of trademarks are not more than tentative standards based on which people infer a risk of misidentification or confusion of place of origin of goods for which such trademarks are used. Therefore, even if a trademark has one aspect among the above three aspects that is similar to another trademark, if the trademark's other two aspects differ significantly from those of the compared trademark or there is another real trading situation, etc. that makes the trademark difficult to acknowledge as having a risk of misidentification or confusion of place of origin of goods, such trademark should not be construed as a similar trademark.

This Court will examine this case from the above point of view. The applied trademark contains the figure of an iceberg and also the words "garasu-sen-i (glass-fiber)," "hyozan-jirushi (iceberg mark)" and "Nitto Boseki," and on the other hand, the cited registered trademark is composed only of the word "Shiyouzan." The two trademarks have an apparently different appearance, and there is no doubt that the latter trademark never conveys a concept that might mean an iceberg. The appellant also did not dispute the non-similarity in terms of this aspect in the court of prior instance. Therefore, it can be acknowledged that the judgment in prior instance held that, even if a term of address generated from the composition of the former trademark, which is "Hiyouzan-jirushi" or "Hiyouzan" and a term of address generated from the latter trademark, which is "Shiyouzan-jirushi" or "Shiyouzan" are relatively similar, similarity of terms of address that is determined simply by comparing sounds extracted from two trademarks should not be treated as sufficient to determine similarity of trademarks because difference between their appearance and concepts should also be taken into consideration. And, it can be understood that the judgment in prior instance construed the two trademarks as not similar because even if the terms of address of the two trademarks are closely alike, the difference between the terms of address can be recognized easily, and even though various circumstances, such as the fact that there are some regions where the pronunciations of "hi" and "shi" are not distinguished clearly, etc., are taken into consideration, in the real trading situation that is unique to glass-fiber thread as aforementioned, since the two trademarks have a significantly different appearance and concepts, and their terms of address can be distinguished to the above extent, there is

no risk of misidentification or confusion of place of origin of goods caused by the two trademarks being mixed up. The argument of the counsels for the final appeal condemns the holding in the judgment in prior instance, which held that the terms of address of the two trademarks are not similar. However, as aforementioned, given the real trading situation of glass-fiber thread, the comparison and examination of terms of address can be conducted in a relatively lenient way. It can be acknowledged that the judgment in prior instance examined the difference between the terms of address at the above level from this point of view and construed the two trademarks as not similar. Such judgment in prior instance should not be said to be completely inappropriate.

The argument of the counsels for the final appeal alleges that the finding in the judgment in prior instance regarding the fact that glass-fiber thread is rarely traded only by the term of address of a trademark, and the holding in the judgment in prior instance that comparison of sounds extracted from the applied trademark in this case and the cited registered trademark is not sufficient to determine similarity of the two trademarks cannot become reasons for supporting a determination that the terms of address of the two trademarks themselves are not similar, and more likely, the finding and the holding are conflicting and contradictory. However, the points of the judgment in prior instance with regard to the argument are all stated as aforementioned, and needless to say, there cannot be found any illegality of inappropriate reasons.

The arguments of the counsels for the appeal have no grounds.

Accordingly, pursuant to Article 401, Article 95, and Article 89 of the Code of Civil Procedure, the judgment has been rendered as set forth in the main text by the unanimous consent of the justices.

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presiding

Justice YOKOTA Masatoshi
Justice TANAKA Jiro
Justice SHIMOMURA Kazuo
Justice MATSUMOTO Masao
Justice IIMURA Yoshimi

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note_other

(This translation is provisional and subject to revision.)