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judgedate

1961.06.27

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caseid

1958(O)1104

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reporter

Minshu Vol. 15, No. 6

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casetitle

Judgment regarding the determination of similarity of the designated goods referred to in Article 2, paragraph (1), item (ix) of the former Trademark Act (Act No. 99 of 1921)

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casename

Case to seek revocation of a trial decision

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caseresult

Judgment of the Third Petty Bench, quashed and decided by the Supreme Court

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court_second

Tokyo High Court, Judgment of October 7, 1958

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summary_judge

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1. Even if two types of goods themselves are not likely to be misconceived as and confused with other types of goods in trading, in the case where these two types of goods are likely to be misconceived as and confused with goods pertaining to the manufacture or selling by one business operator when identical or similar trademarks are used for these two

types of goods, it is appropriate to understand that those two types of goods fall under similar goods referred to in Article 2, paragraph (1), item (ix) of the former Trademark Act (Act No. 99 of 1921).
2. Even if a trademark pertaining to the application is applied as a united trademark of an originally registered trademark, in order to be registered, the trademark pertaining to the application is required to not be similar to another person's registered trademark.

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references

Article 1, Article 2, paragraph (1), item (ix), and Article 3 of the former Trademark Act (Act No. 99 of 1921)

Trademark Act (Act No. 99 of 1921)
Article 1 (1) A person who intends to exclusively use a trademark to indicate that the goods are pertaining to the person's business of production, manufacture, process, selection, certification, handling, or selling may have the trademark registered.
(2) The trademark to be registered must be any character, figure, or sign, or any combination thereof, and be particularly remarkable in nature.
(3) A trademark may be registered with a limitation of color.
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;
Article 3 A trademark that is to be used on identical goods and that is similar to the applicant's trademark or a trademark that is to be used on similar goods and that is identical or similar to the applicant's trademark shall be registered only when the trademark is applied for registration as a united trademark.

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maintext

The judgment in prior instance is quashed.
The claim of the appellee shall be dismissed.
The total cost of the suit shall be borne by the appellee.

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reason

From item I to item III in the reasons for final appeal filed by the counsels designated

by the appellant of final appeal

It is appropriate to understand that the determination of similarity of a trademark should be made based on whether or not misconception and confusion about the place of origin of the goods are likely to arise when the trademark is used on certain goods. Furthermore, the determination of similarity of the designated goods should not be made based on whether or not the goods themselves are likely to be misconceived as and confused with other designated goods in trading as held in the judgment in prior instance. In the case where there are certain circumstances, such as two types of goods generally being manufactured or sold by one business operator, etc., and these two types of goods are likely to be misconceived as goods pertaining to the manufacture or selling of one such business operator when identical or similar trademarks are used on these two types of goods, it is appropriate to understand that those two types of trademarks fall under similar goods referred to in Article 2, item (ix) of the Trademark Act (Act No. 99 of 1921), even if the respective goods themselves are not likely to be misconceived as and confused with other type of goods. In this case, among the trademark "Tachibana Masamune," "Masamune" is construed as a mark that customarily means refined sake, and regarding the trademark "Tachibana Shochu," "Shochu" is a common noun for one type of distilled spirit, which means that the main parts of the above two trademarks are the same. In addition, according to facts that became final and binding in the judgment of prior instance, there are many manufacturers that have obtained manufacturing licenses for both reined sake and shochu. When a business operator manufactures shochu using the trademark "Tachibana Shochu," while on the other hand, a business operator manufactures refined sake using the trademark "Tachibana Masamune," it is obvious that the general public is likely to misconceive that these two types of goods are from a single business operator who manufactures alcoholic liquor using the "Tachibana" mark. Whether or not the trademark "Tachibana Shochu" is well-known does not affect this determination. Therefore, "Tachibana Shochu" and "Tachibana Masamune" should not only be acknowledged to be similar trademarks, but the two types of designated goods for these trademarks should also be acknowledged to be similar goods.

Moreover, even if the trademark pertaining to the application ("Tachibana Masamune") is applied as a united trademark of an originally registered trademark (Registration No. 89,094 "Hanatachibana Masamune"), when the trademark pertaining to the application is similar to a third party's registered trademark that was registered after the registration of the originally registered trademark and that is not similar to the originally registered trademark ("Tachibana Shochu"), it is appropriate to understand that the registration of the trademark pertaining to the application should be refused

based on Article 2 of the Trademark Act. Since the appellant's registered trademark "Hanatachibana Masamune" and "Tachibana Shochu" cannot be acknowledged to be similar, and as mentioned above, "Tachibana Masamune" and "Tachibana Shochu" are similar, it should be said that the appellant's refusal of the application for registration of the trademark of "Tachibana Masamune" is legitimate. Therefore, the arguments of the counsels for the final appeal are well-grounded, and the judgment in prior instance should inevitably be quashed. Furthermore, according to facts that became final and binding in the judgment in prior instance, the trial decision in this case contains no illegality, and the appellee's claim seeking revocation of such trial decision is unreasonable and should be dismissed.

Accordingly, applying Article 408, Article 96, 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 SHIMA Tamotsu

Justice KAWAMURA Matasuke

Justice TARUMI Katsumi

Justice TAKAHASHI Kiyoshi

Justice ISHISAKA Shuichi

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note_other

(This translation is provisional and subject to revision.)