

Trademark Right	Date	March 26, 2019	Court	Intellectual Property High Court, Second Division
	Case number	2017(Gyo-Ke) 10204		
- A case in which the court held that a trademark consisting of features such as the letters, "SHI-SA", and an animal figure does not fall under the case of a trademark as stipulated in Article 4, paragraph (1), items (xi), (xv), and (vii) of the Trademark Act.				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

References: Article 4, paragraph (1), items (xi), (xv), and (vii) of the Trademark Act

Number of related rights, etc.: Trademark Registration No. 5392941, Trademark Registration No. 3324304

### Summary of the Judgment

1. The defendant is the trademark holder of the following trademark (Trademark Registration No. 5392941; the "Trademark").

The plaintiff demanded for invalidation trial of registration of the Trademark (Invalidation Trial No. 2016-890012), and the JPO made the trial decision dismissing the request for invalidation trial.



2. The Trademark and the following trademark (Trademark Registration No. 3324304; the "Cited Trademark") have in common the general shape, which is a combination of the letters, "SHI-SA" or "PUmA", and an animal figure. However, considering that the two trademarks are different in factors such as the number of letters, the letters used, and the presence or lack of a hyphen in the letter part, "SHI-SA" or "PUmA", which is the largest constituent part of the respective trademarks, as well as the presence or lack of the two-tier letter part shown underneath the aforementioned letter part, the difference between the two trademarks in appearance is clearly observable, and there is no risk of causing confusion.



The Trademark generates the concept of a "shisa", a traditional lion-shaped roof ornament of Okinawa, and the Cited Trademark generates the concept of "puma", a feline mammal, or of the brand, "PUMA".

In addition, the Trademark generates the sound of "*shee-sa okinawan original guardian shishi dog*", "*shi sa okinawan original guardian shishi dog*", "*shisa okinawan original guardian shishi dog*", and the like, as well as "*shee-saa*" or "*shee-sa*", and the Cited Trademark generates the sound, "*puma*", or "*poo-ma*".

As described above, the Trademark and the Cited Trademark are different in appearance as well as in concept and sound; thus, even if the Trademark and Cited Trademark are used for identical or similar goods, it cannot be said that there is a risk of misleading any person into misunderstanding as to the source of the goods. As such, the Trademark is not similar to the Cited Trademark.

Therefore, it cannot be acknowledged that the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

3. As described above, the Trademark cannot be deemed to be similar to the Cited Trademark. For the same reason as described above, it cannot be said that the Trademark "is likely to cause confusion in connection with the goods pertaining to a business of another person." Accordingly, it cannot be acknowledged that the Trademark falls under Article 4, paragraph (1), item (xv) of the Trademark Act.
4. The items of paragraph (1), Article 4 of the Trademark Act provide for a considerable number of cases in which a trademark cannot be granted registration. It is interpreted that the stipulation of a trademark that "is likely to negatively affect to public policy" in item (vii) of the same paragraph as one of such types is premised on the possibility that there are certain trademarks that cannot be granted registration even if they do not apply to the cases described in other items, and that a general clause has been placed there to ensure that registration is not granted

for such trademarks. Accordingly, the above item (vii) shall apply only to the cases where anti-social nature is acknowledged, so much so that registration of such trademarks shall not be socially permissible.

As described above, the Trademark and the Cited Trademark are different in appearance as well as in concept and sound. Even if the Trademark and Cited Trademark are used on identical or similar goods, it cannot be said that there is a risk of misleading anyone into confusion as to the source of the goods. Accordingly, it cannot be said that the Trademark has a risk of taking a free ride on the Cited Trademark's power to attract customers, or of diluting the function as a source-identifying indicator, or of damaging the reputation, or that the application for registration of the Trademark was filed with an unfair purpose. As such, it cannot be said that the registration of the Trademark is in violation of commercial ethics, or that it damages Japan's international trust.

Therefore, since it cannot be acknowledged that the Trademark has anti-social nature, so much so that the trademark registration is not socially acceptable, it shall not be acknowledged that the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act.

5. Based on the above, the registration of the Trademark is not in violation of Article 4, paragraph (1), items (xi), (xv), and (vii) of the Trademark Act.

In that case, there is no error with the conclusion of the JPO decision, and the plaintiff's claims are groundless.

Judgment rendered on March 26, 2019

2017 (Gyo-Ke) 10204 A case of seeking rescission of the JPO decision

Date of conclusion of oral argument: December 17, 2018

## Judgment

Plaintiff: Puma SE

Defendant: Y

## Main text

1. Plaintiff's claim shall be dismissed.
2. Plaintiff shall bear the 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

### No. 1 Claim

Plaintiff demanded that the decision made by the JPO on July 7, 2017 for Invalidation Trial No. 2016-890012 be rescinded.

### No. 2 Outline of the case

The present case is a suit against the JPO's decision which rejected the demand for a trial for trademark invalidation. The point at issue concerns applicability of Article 4, paragraph (1), items (xi), (xv), and (vii) of the Trademark Act.

#### 1. The trademark of the present case

Defendant is the holder (Exhibits Ko 1-1, 1-2) of the trademark shown below (hereinafter referred to as "Trademark").



- [i] Registration No. 5392941
- [ii] Date of filing: April 12, 2008
- [iii] Date of decision for registration: January 11, 2011
- [iv] Date of registration: February 25, 2011
- [v] Classification of goods and services, and designated goods or services  
Class 25: Tee-shirts; Headgear for wear

2. Outline of procedures at the JPO

On February 25, 2016, Plaintiff requested to the JPO for a trial for invalidation of registration of the Trademark, which, Plaintiff claimed, falls under Article 4, paragraph (1), items (vii), (xi), and (xv) of the Trademark Act (Invalidation Trial No. 2016-890012; hereinafter referred to as "Request for Trial").

On July 7, 2017, the JPO rendered a decision to the effect that "the request for a trial is dismissed" (hereinafter referred to as "JPO Decision"), and a certified copy of the JPO decision was delivered to Plaintiff on the 18th of the same month.

3. Gist of the reasons given in the JPO Decision

(1) Prominence of the cited trademark

A. The cited trademark is as shown below, and it is currently valid.



- [i] Registration No. 3324304
- [ii] Date of filing: December 20, 1994

[iii] Date of registration: June 20, 1997

[iv] Classification of goods and services, and designated goods or services

Class 25: Clothing; Garters; Sock suspenders; Suspenders [braces]; Waistbands; Belts for clothing; Footwear [other than special footwear for sports]; Clothes for sports; Special footwear for sports

B. At the time of filing of the application for registration of the Trademark, the cited trademark was widely recognized as a trademark that indicates sports shoes, clothing, bags, and the like pertaining to Plaintiff's business among traders and consumers in Japan, and was a well-known and famous trademark. This circumstance has continued to this day, including the time of the decision for registration of the Trademark and thereafter.

(2) Applicability of Article 4, paragraph (1), item (xi) of the Trademark Act

A. Comparison between the Trademark and the cited trademark

(A) Appearance

a. Points in common

The Trademark and the cited trademark have the following points in common. First, the alphabet letters, "SHI-SA", and "PUmA", respectively, are written horizontally in a large font, and second, in the upper right corner of each trademark, a four-legged animal is drawn in silhouette, as seen from the side, in the pose of jumping up from the right side toward the upper left direction, with the front paws set wide apart from the hind paws.

Furthermore, the Trademark and the cited trademark have the following points in common. The letters, "SHI-SA", of the Trademark and the letters, "PUmA", of the cited trademark are both written in a bold font and look as if they are inserted in a rectangular frame, with the individual letters being vertically long.

Next, the figures of the animals in the respective trademarks give similar impressions with regard to the direction they face and their basic postures, as well as the angle of their jump, the way the front and hind paws are curled up, the way they stretch out and the angle thereof, and the way in which the chest, back, and paws are drawn with a curved line.

b. Points of difference

The letters which are written in a large font in the Trademark are "SHI-SA", and the letters which are written in a large font in the cited trademark are "PUmA", so that the two trademarks are different in the number of letters of the alphabet used and in the alphabet letters used, except for letter, "A", at the end. The two trademarks are also different in that the Trademark has a hyphen (-) between "SHI" and "SA".

As for the figures of the animals in the two trademarks, the head part of the animal figure in the Trademark is relatively larger than that of the animal in the cited trademark, and furthermore, the animal figure of the Trademark is entirely covered with flower-like designs and is outlined in white, has a teeth-like design near the mouth and a collar-like design, and has decorations or curl-like designs on the joints of front and hind paws, and the tail has an overall round shape, with a sharpened tip, and has decorations or curl-like designs drawn thereon.

On the other hand, the animal figure of the cited trademark does not have any design or outline, and is entirely colored in black like a silhouette, with a tail that is generally slim and that bows high upward in the upper right direction, with only the tip having a slightly round shape.

c. Summary

As described above, while the Trademark and the cited trademark have in common the overall constitution, which is a combination of the letters, "SHI-SA" or "PUmA", and an animal figure, the differences between the two trademarks are clearly observable.

(B) Concept

The Trademark generates the concept of the "Shisa", a lion statue found in Okinawa, whereas the cited trademark generates the concept of a feline mammal, "puma", or of "a brand for PUmA". As such, the two trademarks are different in concept.

(C) Sound

The Trademark generates the sound of "shee-sa" or "shee-sah", and the cited trademark generates the sound of "pyu-ma" or "poo-ma", so that the two trademarks are different in sound.

B. Conclusion

As described above, the Trademark and the cited trademark are different in appearance, concept, and sound, and even if the Trademark and the cited trademark are used for the same or similar goods, it cannot be said that there is any likelihood of misleading and causing confusion as to the source of the goods, so that the Trademark is not similar to the cited trademark, and thus does not fall under Article 4, paragraph (1), item (xi) of the Trademark Act.

(3) Applicability of Article 4, paragraph (1), item (xv) of the Trademark Act

As described above in (2), the Trademark and the cited trademark are not similar and should be deemed to be different. The cited trademark is well-known, famous, and unique as an indication of goods pertaining to Plaintiff's business, including

sports shoes and clothing. The designated goods for the Trademark and the goods pertaining to Plaintiff's business are related in terms of their nature, usage, and purpose, and the two trademarks share the same traders and consumers to a considerable extent. Nevertheless, the Trademark, when used by its holder for the designated goods, does not cause traders and consumers to think of or be reminded of the cited trademark, which pertains to Plaintiff's business, and it should be said that there is no likelihood of causing confusion as to the source of the goods bearing the Trademark as if they pertain to the business of Plaintiff or of a person who is somehow related to Plaintiff, financially or structurally.

Accordingly, it cannot be said that, at the time of the filing of the application for registration, and at the time of the decision for registration, the Trademark was "likely to cause confusion" as prescribed in Article 4, paragraph (1), item (xv) of the Trademark Act, and thus the Trademark does not fall under said item.

(4) Applicability of Article 4, paragraph (1), item (vii)

A. The constitution of the Trademark is not in itself a letter or figure that is unethical, vulgar, discriminatory, or extreme, or that gives an unpleasant impression to others.

B. There does not seem to be any of the following circumstances; namely, that the use and the like of the Trademark are prohibited by any law other than the Trademark Act, or the circumstance according to which use of the Trademark for its designated goods is against the interests of social and public welfare, thereby being against the generally accepted sense of morality of society, or the circumstance according to which the Trademark is insulting to a specific country or its people, or is generally against international fidelity.

C. There does not seem to be any specific circumstance according to which the background to filing the application for registration of the Trademark lacks social adequacy or according to which granting registration should be deemed to be utterly unacceptable due to violation of the order intended by the Trademark Act, and there also does not seem to be any circumstance according to which the background to filing the application for registration of the Trademark lacks social adequacy, thereby being in violation of the order intended by the Trademark Act.

D. Accordingly, it cannot be said that the Trademark falls under a trademark that "is likely to negatively affect public policy", and since it also cannot be said that the Trademark falls under such trademark once registration is granted, the Trademark does not fall under Article 4, paragraph (1), item (vii) of the Trademark Act.



(omitted)

No. 5 Judgment of this court

1. Concerning Reason 1 for Rescission (applicability of Article 4, paragraph (1), item (xi) of the Trademark Act)

(1) Description of the Trademark

A. Appearance

The Trademark has a string of alphabet letters, "SHI-SA", written horizontally in a large font and placed basically at the vertical center, and this is the largest constituent part of the Trademark. Of the letter string, "S" is not written with a curved line; instead, it is written by connecting the vertical and horizontal straight lines with right-angled bends which are roundish only on the external side. "A" is written not in an inverted V-shape but is written by placing a horizontal straight line at the position, which is sandwiched between vertical straight lines, slightly below the vertical center of the figure of an inverted U-shape in which vertical and horizontal straight lines are connected at right-angled bends which are roundish only on the external side. "H" is written by vertical and horizontal straight lines, "I" is written by a vertical straight line, and the hyphen, "-", is written by a horizontal straight line. In addition, the horizontal lines at the vertical ends of "H" and "I" are omitted, and the hyphen, "-", is short, and the letters have not much space thereinbetween. As such, an observer is given the impression that the entire letter string is inserted in a rectangular frame.

The mark, "©", is written on the right side of the "A", which is at the rightmost of "SHI-SA", near the lower end of "A".

Next, on the right side of the aforementioned letter string, "SHI-SA", in the Trademark, there is a silhouette-like figure of a four-legged animal that has a rather big head part and that has a large tail, which is partially curled up, and that has its front paws at the front and the hind paws at the back set wide apart as if to jump upward from the lower right side toward the upper left side, as seen from the side. Inside this figure is a white line drawn basically along the outline, and a teeth-like design is drawn around the mouth, and around the neck is a jagged design like a decoration, and on the joints of front and hind paws are decorations or curl-like designs, drawn in white lines. Also, the inside of the figure is entirely covered with flower-like small designs drawn in white lines that are finer than the lines used above.

Furthermore, underneath the aforementioned letter string, "SHI-SA", of the Trademark, are the alphabet letters, "OKInAWAn ORIgInAL" and "gUARDIAN ShISHI-DOG", drawn in red, respectively, written in two tiers, top and bottom, in a

font that is smaller than that of the aforementioned letter string, "SHI-SA". The font used for the two-tier letter string is different from that of the aforementioned letter string, "SHI-SA", and uses not just vertical and horizontal straight lines but also diagonal lines as well, but since thickness is reduced in the places where curved lines are used, and fine horizontal lines are drawn in some of the vertical ends of each letter so as to connect the vertical straight lines of the adjoining letters and other letters nearby, an observer is given the impression that the letters are formed by twisting a ribbon.

As described above, the Trademark is a combination of the letter string part, "SHI-SA", the part of "©", the figure part of a jumping animal in silhouette, and the letter string parts, "OKInAWAn ORIgInAL" and "gUARDIAN ShIShI-DOg".

#### B. Concept

While the animal figure part in the Trademark does not immediately remind one of a specific animal, the letter string part, "SHI-SA", placed on the left side of the aforementioned part of the animal figure can produce the sounds of "shee-sa", "she, sa", and "she-sa", and from the letter string part, "OKInAWAn ORIgInAL", placed underneath the aforementioned letter string part, "SHI-SA", the meaning of "Okinawa's original" can be interpreted, and from the letter string part, "gUARDIAN ShIShI-DOg", placed likewise underneath said letter string, the meanings of "guardian" and "lion dog" can be interpreted respectively, and furthermore, the letter strings, "OKInAWAn ORIgInAL" and "gUARDIAN ShIShI-DOg", are in sets of two-tier letter strings as described in the above A. Given the foregoing, when the shape of the aforementioned animal figure part is also taken into consideration, it can be interpreted that the aforementioned animal figure part depicts the "Shisa" (Exhibits Ko 14, 36), which is Okinawa's traditional lion dog statue, jumping up as seen from the side.

Accordingly, it is acknowledged that the Trademark generates the concept of the "Shisa", which is Okinawa's traditional lion dog statue.

#### C. Sound

The Trademark has the letter string part, "SHI-SA", placed at the center, with the letter string parts, "OKInAWAn ORIgInAL" and "gUARDIAN ShIShI-DOg", placed underneath, respectively. Accordingly, the Trademark may produce sounds such as "shee-sa-okinawan-original-guardian-she-she-dog", "she, sa-okinawan-original-guardian-she-she-dog", "she-sa-okinawan-original-guardian-she-she-dog".

Also, as described above in B, the Trademark produces the concept of the "Shisa", which is Okinawa's traditional lion dog statue, so that the Trademark produces the

sound of "shee-sah" or "shee-sa".

D. Concerning Plaintiff's claim

Plaintiff claims that the letters and figures drawn in Okinawan souvenirs so as to remind customers of the "Shisa" merely have the function of giving them the impression that the goods concerned come from Okinawa, and that they cannot perform the function of distinguishing the goods of a specific person from those of others in terms of their relationship to Okinawan souvenirs, so that in the Trademark, which can be called a composite trademark having multiple constituent parts combined, the letter part from among the constituent parts of the Trademark does not produce any sound or concept as an indication that distinguishes the source.

However, as described in the above A, the letter string part, "SHI-SA" of the Trademark is large and comprises a significant part of the area of the Trademark, and the letter string parts, "OKInAWAn ORIgInAL" and "gUARDIAN ShIShI-DOg", underneath are written in an impressive red font for emphasis, and the area covered is not small, so that the combined areas of these letter parts are considerably greater than the area covered by the animal figure part. Furthermore, the designated goods for the Trademark are "Tee-shirts; Headgear for wear", and are not restricted to "Okinawan souvenirs".

Accordingly, it cannot be interpreted that the letter part from among the constituent parts of the Trademark does not produce any sound or concept, and thus the above claim made by Plaintiff cannot be adopted.

(2) Description of the cited trademark

A. Appearance

The cited trademark has the letter string, "PUmA", consisting of alphabet letters and written horizontally in a large font, at the bottom, and this is the largest constituent part of the cited trademark. Of these letters, "P", "U", and "m" are written by connecting the vertical and horizontal straight lines with right-angled bends, most of which are roundish on the internal and external sides. "A" is written not in an inverted V-shape but is written by placing a horizontal straight line at the position, which is sandwiched between vertical straight lines, slightly below the vertical center of the figure of an inverted U-shape in which vertical and horizontal straight lines are connected at right-angled bends, most of which are roundish on the internal and external sides. Furthermore, the horizontal lines at the vertical ends of each letter are omitted, and the vertical straight lines are thicker than horizontal straight lines, and the letters have not much space thereinbetween. As such, an observer is given the impression that the entire letter string is inserted in a rectangular frame.

Also, at the position near the bottom of "A" on the right side of "A" positioned at the right end of "PUmA", the mark, "®", is written.

Furthermore, on the right side of the aforementioned letter string, "PUmA", of the cited trademark, there is a figure, in black silhouette, of a four-legged animal that has a space between the head part and the front paws, and that has a tail which is generally slim and which bows high upward in the upper right direction, with the tip having a slightly round shape, looking as if to jump upward from the lower right side toward the upper left side, with the front paws at the front and the hind paws at the back set wide apart, as seen from the side.

As described above, the cited trademark is a combination of the letter string part, "PUmA", the part of "®", and the figure part of a jumping animal in silhouette.

#### B. Concept

The cited trademark has "PUmA" written in a large font, and along with the figure of an animal that has its front paws and hind paws set wide apart as if to jump upward, reminds one of the concept of a puma, an animal.

A "puma" (in Japan, also written in a writing style that produces the sound of "poo-ma") is a feline mammal that is found in the Americas and is also called by names such as "American lion", "mountain lion", and "cougar". Its body length is approximately 1.5 m, and it is active and has a strong jumping ability, and it feeds on deer and the like (Kojien, 7th Edition).

The cited trademark is also well-known as a trademark for the brand, "PUMA", which represents the business of Puma SE, a German manufacturer of sports shoes and sportswear and the like (Exhibits Ko 12-1 to 12-4, Exhibits Ko 13-1 and 13-2, Exhibits Ko 19-1 and 19-2, Exhibit Ko 20, Exhibits Ko 26-1 to 26-24, Exhibits Ko 27-1 to 27-26, 27-28 to 27-42, Exhibits Ko 28-1 to 28-11, 28-17 to 28-68, 28-70 to 28-76, the entire import of the oral argument), and the cited trademark generates the concept of the brand, "PUMA", as well.

#### C. Sound

The cited trademark produces the sound of "pyu-ma" or "poo-ma" from the letters, "PUmA".

#### (3) Comparison

##### A. Appearance

##### (A) Points in common

The Trademark and the cited trademark have the following points in common. First, the alphabet letters ("SHI-SA" and "PUmA") are written horizontally in a large font, comprising the largest constituent part of each trademark, and second, in the

upper right corner of each trademark, a four-legged animal is drawn in silhouette, as seen from the side, in the pose of jumping up from the right side toward the upper left direction, with the front paws set wide apart from the hind paws.

The letters, "SHI-SA", of the Trademark and the letters, "PUmA", of the cited trademark are both written in a bold font and look as if they have been inserted in a rectangular frame, with the individual letters being vertically long, as if to make the curved line parts resemble the shape that is created by bending a straight line at a right angle.

Next, the figures of the animals in the respective trademarks give similar impressions with regard to the direction they face and their basic postures, as well as the angle of their jump, the way the front and hind paws are curled up, the way they stretch out and the angle thereof, and the way in which the chest, back, and paws are drawn with a curved line.

(B) Points of difference

The letters which are written in a large font in the Trademark are "SHI-SA", and the letters which are written in a large font in the cited trademark are "PUmA", so that the two trademarks are different in the number of letters of the alphabet used and in the alphabet letters used, except for letter, "A", at the end. The two trademarks are also different in that the Trademark has a hyphen (-) between "SHI" and "SA", in the thickness of lines used in the fonts, and in whether or not the lines used for outlining the inside of the parts that are curved at right angle are mostly curved.

Furthermore, in the Trademark, the letters, "OKInAWAn ORIgInAL" and "gUARDIAN ShIShI-DOg", are written in two tiers in a relatively small font underneath "SHI-SA", which is written in a large font, whereas in the cited trademark, there is nothing written underneath the letters, "PUmA", which is written in a large font.

As for the figures of the animals in the two trademarks, the head part of the animal figure in the Trademark is relatively larger than that of the animal in the cited trademark, and furthermore, the animal figure of the Trademark has a teeth-like design near the mouth and a collar-like design on the neck, and has decorations or curl-like designs on the joints of front and hind paws, and the tail has an overall round shape, with a sharpened tip, and has decorations or curl-like designs drawn thereon, and the inside of the animal figure is outlined, and is entirely covered with flower-like designs by a fine white line. On the other hand, the animal figure of the cited trademark does not have any design or outline, and is entirely colored in black like a silhouette, with a tail that is generally slim and that bows high upward in the upper

right direction, with only the tip having a slightly round shape.

(C) In light of the above (A) and (B), while the Trademark and the cited trademark have in common the overall shape, which is a combination of "SHI-SA" or "PUmA" with an animal figure, the two trademarks are different in regards to the largest constituent parts, in the number of letters used in the letter part, "SHI-SA" or "PUmA", in the letters used, in the presence or lack of a hyphen, and in the presence or lack of the two-tier letter part found underneath the aforementioned letter part, among other points; thus the differences in the appearance of the two trademarks are clearly observable, and there is no likelihood of creating confusion.

#### B. Concept

The Trademark generates the concept of the "Shisa", a traditional lion statue found in Okinawa, whereas the cited trademark generates the concept of a feline mammal, "puma", or of a brand for "PUMA".

#### C. Sound

The Trademark generates sounds such as "shee-sa-okinawan-original-guardian-she-she-dog", "she, sa-okinawan-original-guardian-she-she-dog", "she-sa-okinawan-original-guardian-she-she-dog" and "shee-sah" or "shee-sa", and the cited trademark generates the sound of "pyu-ma" or "poo-ma"

#### D. Review

As described above, the Trademark and the cited trademark are different in appearance, concept, and sound, and, even if the Trademark and the cited trademark are used for the same or similar goods, it cannot be said that there is any likelihood of misleading and causing confusion as to the source of the goods, so that the Trademark is not similar to the cited trademark.

#### (4) Concerning Plaintiff's claim

A. Plaintiff claims that the cited trademark had become globally well-known and famous, and that the consumer public who are consumers of the designated goods often identify the source of goods based on the impression they get upon first looking at the trademark placed on the designated goods, and that the consumers intent on purchasing clothing and the like often select products by placing much value on designability and fashionability, so that if, in a composite trademark consisting of a combination of a figure and a letter mark, the figure part has some designability and fashionability, consumers would identify the product by focusing on the figure, so that if a figure is similar to another figure in appearance, the difference in the letter parts does not significantly affect the similarity between the Trademark and the cited trademark, and thus there is likelihood of causing confusion among consumers and the

like who focus on the alphabet letters and the animal figure, which are shown in a large size, or on the combination thereof, thereby being reminded of a specific source.

However, in the Trademark, the letter parts, "SHI-SA" and "OKInAWAn ORIgInAL gUARDIAN ShIShI-DOg", comprise a large part of the entire area, and it is difficult to believe that consumers would focus only on the animal figure, which comprises a relatively small area of the entire trademark, and since it cannot be said that this determination would be influenced by the circumstances claimed by Plaintiff, including the fact that the cited trademark is a globally well-known trademark, the above claim by Plaintiff cannot be adopted.

It should be noted that this determination shall not be influenced by the Rule of Examination Guidelines.

B. Plaintiff claims that the Trademark and the cited trademark are often shown as one-point marks and the like, so that the probability of consumers, who look at the Trademark, not noticing the differences and thinking of the cited trademark, which is a famous trademark, cannot be denied.

If the Trademark is used as a one-point mark and the like, the entire trademark would be reduced in size. In that case, since the large part of the entire area consists of the letter part, the animal figure part becomes very small, and it is acknowledged that the letter part, especially the part of "SHI-SA", is likely to leave a stronger impression on consumers than the animal figure part. The possibility of the Trademark being reduced in size and placed on goods shall not influence the above finding.

C. Plaintiff claims that Plaintiff's claims can be confirmed by the research results of the present case. However, the trademark which is subject of research is greatly different from the Trademark in that said trademark is a mark consisting only of an animal figure and not containing any letter part. Accordingly, the research results of the present case shall not influence the above finding concerning the Trademark.

(5) Accordingly, it cannot be acknowledged that the Trademark falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

2. Reason 2 for rescission (applicability of Article 4, paragraph (1), item (xv) of the Trademark Act)

(1) As described in the above 1, it cannot be said that the Trademark is similar to the cited trademark, and for the same reasons as those indicated in the above 1, it cannot be said that the Trademark "is likely to cause confusion in connection with the goods pertaining to a business of another person", so that it cannot be acknowledged that the Trademark falls under Article 4, paragraph (1), item (xv) of the Trademark

Act.

(2) A. Plaintiff claims that the differences in the letter parts do not significantly influence the determination as to there being the "likelihood of causing confusion". However, as described in the above 1 (4) A and B, the above claim by Plaintiff cannot be adopted. This determination shall not be influenced by the Rule of Examination Guidelines.

B. Plaintiff claims, on the grounds of the research results of the present case, that it is acknowledged that the Trademark is "likely to cause confusion", but as described in the above 1 (4) C, the above claim by Plaintiff cannot be adopted.

C. Plaintiff claims that Defendant indicated the letters, "SHI-SA", and the like along with the animal figure in an attempt to cover up the aim for resembling the figure of PUMA, but the above claim focuses mostly on Defendant's subjective view, and it shall not influence the above determination as to Article 4, paragraph (1), item (xv) of the Trademark Act.

D. Plaintiff claims that the letter part of the Trademark cannot perform the function of distinguishing the goods of a specific person from those of others in terms of how they are related to Okinawan souvenirs. However, as described in the above 1 (1) D, the above claim by Plaintiff cannot be adopted.

3. Reason 3 for rescission (applicability of Article 4, paragraph (1), item (vii) of the Trademark Act)

(1) Each of the items of Article 4, paragraph (1) of the Trademark Act provides for a considerable number of types of trademarks which cannot be granted registration. Accordingly, it is interpreted that the fact that item (vii) of the same paragraph stipulates that one of such types is a trademark that "is likely to negatively affect public policy" is premised on the presence of a trademark which, although it does not fall under other items, should still not be granted registration, thereby providing a general clause which stipulates that registration shall not be granted for such trademark. As such, application of the same item shall be limited to the cases in which it is acknowledged that the trademark is deemed to be antisocial, so much so that the society should not grant registration for such trademark.

(2) As described in the above 1 and 2, the Trademark and the cited trademark are different in appearance as well as in concept and sound, so that even if the Trademark and the cited trademark are used for the same or similar goods, it cannot be said that there is any likelihood of misleading and causing confusion as to the source of the goods. Accordingly, it cannot be said that the Trademark is likely to take free ride on the goodwill of the cited trademark, thereby diluting the cited trademark's function



of indicating the source or damaging the fame of the cited trademark, or that the application for the Trademark was filed with such intentions. As such, it cannot be said that the registration of the Trademark is against commercial ethics, or that it is damaging to the international credibility of Japan.

(3) A. Plaintiff claims that the Trademark is used in a manner that, at a first glance, reminds one of Plaintiff's famous trademark as per the Examples of Use 1 to 5 pertaining to Plaintiff's claim, and that this manner of use is a result of Defendant's intention to take free ride on the goodwill of Plaintiff's famous trademark.

However, the examples of use as listed by Plaintiff all contain the letter part, "SHI-SA", but do not contain the letter part, "OKInAWAn ORIgInAL gUARDIAN ShIShI-DOg", and is different from the Trademark in the following respects; namely, the ratio of the size of the animal figure part and the size of the letter part of "SHI-SA" being clearly different from that in the Trademark (Examples of Use 1, 2, 4, 5), the presence of a letter part that does not exist in the Trademark (Example of Use 2), the presence of a figure part that does not exist in the Trademark, and a design consisting of a straight line being written inside the outline of the animal figure part and the letter part, "SHI-SA" (Example of Use 3), among others. The above Examples of Use 1 to 5 cannot be evaluated as examples of use for the Trademark. Accordingly, Plaintiff's claim that the Trademark causes damage to public policy, which is premised on the argument that the Examples of Use are examples of use for the Trademark, that the Trademark is used by being altered into a form that is closer to the appearance of the cited trademark, lacks its premise and cannot be adopted.

B. Plaintiff claims as follows, namely, [i] Defendant was familiar with the circumstances related to clothing at the time of the filing of the application for the Trademark, and knew, or was able to acquire the knowledge, that Plaintiff's cited trademark is famous, so that, based on the uniqueness of Plaintiff's cited trademark, it cannot be considered that the Trademark was selected without any association with the cited trademark, [ii] the "Shisa" is usually drawn as the guardian deity, in a sitting position, that has a huge head part with large eyes and an open mouth placed thereon, and with a body that is generally stocky and has a short and thick torso. In many cases, its posture is such that the upper part of the body is elevated, with the front paws on the ground, and ordinary people recognize the Shisa based on these characteristics. However, in the figure of the Shisa in the Trademark, the aforementioned inherent characteristics of the Shisa are hardly observable; instead, many of the characteristics of the figure of a puma, which is represented in the cited trademark in the "image of a puma which quickly hunts down and always catches its

prey", are observable, and the Trademark is drawn in such a way as to intentionally deviate from the inherent characteristics of the Shisa in an attempt to more closely resemble the cited trademark, and [iii] Defendant selected the Trademark with the unfair purpose of taking free ride on the goodwill of the famous cited trademark by altering the appearance while intentionally leaving some of the characteristics of the famous cited trademark to such extent so as to make them recognizable at a first glance.

(A) Of what is described above, concerning the above [i], it cannot be acknowledged, based on the fact that Defendant knew, or was able to acquire the knowledge that Plaintiff's cited trademark was famous at the time of the filing of the application for registration of the Trademark, that Defendant selected the Trademark with the unfair purpose of taking free ride on the goodwill of Plaintiff's cited trademark because, as described above, the Trademark is not similar to the cited trademark.

(B) The court determines as follows concerning the above [ii] and [iii].

a. The word, "Shisa", means "lion-san" in Okinawa. The Shisa is an ordinary pottery statue of a Chinese lion and is a kind of an amulet (Exhibit Ko 14). The "Shisa" may take various forms, and the features which are generally considered to be the characteristics of the Shisa include a mane, collar, showing fangs, swirly fur, and a thick and fluffy tail. As for the posture, it is often the case that the Shisa has its upper part of the body elevated, with the front paws on the ground, but there are various forms, including the posture of being on all fours, the posture of slouching forward, and the posture of standing upright on hind legs, and in many cases, the tail stands on end like fire towards the sky, with the tip being narrowed (Exhibits Ko 15, 36 to 41).

b. Upon comparison of the animal figure of the Trademark with the aforementioned ordinary "Shisa", it cannot be said that the posture of the animal drawn in the Trademark of setting the front paws and hind paws wide apart as if to jump upward is a commonly-used shape for the "Shisa". As such, upon looking at this point alone, it can be said that the posture is close to the impression given by the figure of the cited trademark. On the other hand, the collar-like design, the decorations or curl-like designs on the joints of front and hind paws, and the shape of the tail that is roundish overall and has a sharpened tip, which are drawn in the Trademark, are all same as the commonly-used characteristics of the "Shisa", so that it can be said that the animal figure of the Trademark has some of the features which are considered to be characteristics of the "Shisa".

c. In light of the above, while the figure of the Trademark has some features which are different from the inherent characteristics of the "Shisa" and is, regarding this point, close to the impression given by the figure of the cited trademark, it also has many features which are inherent characteristics of the "Shisa", so that, by taking into consideration that the Trademark and the cited trademark are not similar in their entirety, as described above, it cannot be acknowledged that Defendant selected the Trademark with the unfair purpose of taking free ride on the goodwill of the cited trademark.

(4) Accordingly, since it cannot be acknowledged that the Trademark is antisocial, so much so that the society should not grant registration for such trademark, it cannot be acknowledged that the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act.

(5) A. Plaintiff claims that the research results of the present case support the claim made by Defendant.

However, since the subject of the research concerns a mark which consists only of an animal figure and does not contain any letter part, the research results of the present case shall not influence the above finding concerning the Trademark.

B. Plaintiff claims as follows. A famous trademark not only has value as an indicator showing the source of a specific business operator, but it also influences industrial policies and public interest of Japan as a result of its social impact brought about by its fame, credibility, and goodwill, so that, from the perspective of public interest, the request for protection should be accepted. Accordingly, permission in the name of "parody" should be given only in the cases where there is no likelihood of causing confusion as to the source and where it is acknowledged that the distinctiveness or creditworthiness of a famous trademark is not damaged; even in the case where it is difficult for Plaintiff to prove that Defendant has an unfair purpose, if it is possible to presume that Defendant took free ride on the awareness of customers or on the current conditions of the industry pertaining to the designated goods, the disadvantages suffered by Defendant, resulting from the prevention and removal of registration of the Trademark, and the request for protection of a famous trademark from the perspective of public interest should be compared with and weighed against each other, and in the absence of evidence that overturns the argument that the Trademark was created with an unfair purpose based upon social convention, application of Article 4, paragraph (1), item (vii) of the Trademark Act should be approved.

However, it cannot be considered reasonable to approve the shift of the

responsibility to prove an unfair purpose, on the grounds of a trademark being famous, because such approval is not given in the case of a trademark that is not famous. Accordingly, the above claim by Plaintiff cannot be adopted.

C. In addition to the above, it is clear from what is already stated that the Plaintiff's claim shall not influence the determination of the above (4).

#### No. 6 Conclusion

Based on the above, registration of the Trademark is not in violation of Article 4, paragraph (1), item (xi), (xv), or (vii) of the Trademark Act; thus the conclusion of the decision by the JPO cannot be acknowledged as erroneous, and the claim made by Plaintiff in the present suit is without grounds and shall therefore be dismissed. The judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Second Division

Presiding judge: MORI Yoshiyuki

Judge: MORIOKA Ayako

Judge: FURUSHO Ken