Date	April 11, 2018	Court	Intellectual Property High Court, Fourth Division
Case Number	2017(Gyo-Ke)10208		

- A case in which the court found that the mark, "マイナンバー(my number)," falls under "a famous mark indicating a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest" according to Article 4, paragraph(1), item(vi) of the Trademark Act.
- In regards to the present trademark application of "マイナンバー実務検定(my number jitsumu kentei; proficiency test on My Number)", while the constituent part, "マイナンバー (my number)," gives a strong and dominant impression as an identifier of source for services, the constituent part, "実務検定(jitsumu kentei; proficiency test)," does not produce any sound or concept as a source-identifying mark of services in terms of its relationship with designated services. Accordingly, it is permissible to determine the similarity of trademarks by extracting the constituent part, "マイナンバー(my number)," of the present trademark application for comparison of only said constituent part with the cited mark.

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

Number of related rights, etc.: Trademark Application No. 2015-33387 (the present trademark application), Appeal against Examiner's Decision No. 2017-332, Trademark Registration No. 5756402 (cited mark)

Summary of the Judgment

In the present case, the plaintiff sought revocation of the decision by the JPO on appeal not to complete the demand for trial (the "Trial Decision"), which the plaintiff filed in response to the decision of rejection for the present trademark application (the "Trademark Application"), which consists of the characters, "マイナンバー実務検定 (my number jitsumu kentei; proficiency test on My Number)," in standard letters, with "Organization or conducting of proficiency tests as well as provision of relevant information; (omitted) Holding of seminars for persons taking proficiency tests as well as provision of relevant information" in Class 41 as designated services, among others.

In summary, the Trial Decision held that the Trademark Application cannot be granted registration because [i] the Trademark Application is similar to the cited mark, which consists of the characters, "マイナンバー(my number)," and which is "a famous mark indicating a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest," and thus Article 4, paragraph(1), item(vi) of the Trademark Act is applicable, and because [ii] Article 4, paragraph(1), item(xi) of the Trademark Act is also applicable since the Trademark Application is similar to the cited mark, which consists of the characters, "

マイナンバー(my number)." Based on these reasons, the court stated, as reasons for revocation, that there was error in the judgment of applicability under Article 4, paragraph(1), item(vi) of the Trademark Act as well as error in the judgment of applicability under Article 4, paragraph(1), item(xi) of the Trademark Act.

The court dismissed the plaintiff's claims by holding as per the outline below.

(1) Erroneous judgment of applicability under Article 4, paragraph(1), item(vi) of the Trademark Act

A The cited mark consists of the characters that are used in the My Number System, which has become widely known to the general public in Japan. It can be said that the term, "マイナンバー(my number)," is widely known among traders and consumers of designated services for the Trademark Application as a word referring to the social security and tax number or the individual number under the My Number Act, or the My Number System, which is a social security and tax number system. As such, it can be said that the cited mark is "a famous mark indicating a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest."

B The constituent part, "マイナンバー(my number)," of the Trademark Application is the same as the letters comprising the famous mark, "マイナンバー(my number)." As such, while said constituent part gives a strong and dominant impression as an identifier of source for services, the constituent part, "実務検定(jitsumu kentei; proficiency test)," merely indicates, in terms of how it is related to designated services, that the mark is for "kentei (test)" of "jitsumu (proficiency)," to the general public. Said constituent part does not produce any sound or concept as an identifier of source for services. Accordingly, the Trademark Application can produce not only the sound, "my number jitsumu kentei," and the concept of "proficiency test on My Number," but also the sound, "my number," and the concept of the "social security and tax number or the individual number under the My Number Act, or the My Number System, which is a social security and tax number system." As such, it is permissible to determine the similarity of trademarks by extracting the constituent part, "マイナンバー (my number)," from the Trademark Application for comparison of only said constituent part with the cited mark.

If this is the case, the Trademark Application and the cited mark have the same sound and concept. As such, while it cannot be said that the two marks are the same or similar in appearance, if the Trademark Application and the cited mark are used for designated services of the Trademark Application, there is a risk of creating misunderstanding or confusion as to the source of services, and thus the two marks are

similar.

C As described above, the Trademark Application falls under Article 4, paragraph(1), item(vi) of the Trademark Act.

(2) The error in judgment of applicability of Article 4, paragraph(1), item(xi) of the Trademark Act

The cited mark is the same as the famous mark, "マイナンバー(my number)" (cited mark). As described above, it is permissible to determine the similarity of trademarks by extracting the constituent part, "マイナンバー(my number)," from the Trademark Application for comparison of only said constituent part with the cited mark. Accordingly, it should be said that the cited mark is similar to the Trademark Application.

As for the designated services of the Trademark Application, they are the same as or similar to the designated services of the cited mark.

As described above, the Trademark Application falls under Article 4, paragraph(1), item(xi) of the Trademark Act.

Judgment rendered on April 11, 2018
2017 (Gyo-Ke) 10208 The case of seeking rescission of JPO decision
Date of conclusion of oral argument: March 5, 2018

Judgment

Plaintiff General incorporated foundation
Zennihon Joho Gakushu Shinkokai

Defendant Commissioner of the Japan Patent Office

Main text

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

Facts and reasons

I Claim

The decision made by the JPO on October 2, 2017 with respect to case of Appeal against Examiner's Decision (of Refusal) No. 2017-332 should be rescinded.

II Outline of the case

1 Outline of procedures at the JPO

(1) On April 9, 2015 Plaintiff filed an application for registration of a trademark (Japanese Trademark Application No. 2015-33387) which consists of characters "マイナンバー実務検定 (mai nambah jitsumu kentei; proficiency test on the Individual Number System)" in standard characters for the designated services of Class 41 "educational and instruction services relating to arts, crafts, sports, or general knowledge, arranging, conducting or giving certification examinations and providing information thereon, arranging, conducting, and organization of seminars, organization of seminars for the examinees of certification examinations and providing information thereon, providing electronic publications, services of reference libraries for literature and documentary records, book rental, publication of books, publication of teaching material books, production of videotape film in the field of education, culture, entertainment, or sports [not for movies or television programs and not for advertising or publicity], production of teaching material video/DVD film [not for movies or television programs and not for advertising or publicity], providing facilities for movies, shows, plays, music, or educational training, rental of records or sound-

recorded magnetic tapes, rental of image-recorded magnetic tapes" (Exhibit Ko 103. Hereinafter referred to as "the trademark in the application").

(2) Since Plaintiff received a decision of rejection on October 5, 2016 (Exhibit Ko 107), on January 11, 2017 Plaintiff demanded an appeal against the decision of rejection (Exhibit Ko 108).

(3) The JPO examined this case as Appeal No. 2017-332 and on October 2 of the same year the JPO rendered a decision (hereinafter referred to as "the appeal decision") set out in the attached written appeal decision (copy) to the effect that "the demand for an appeal shall be dismissed." On the 17th day of the same month, its transcript was served to Plaintiff.

(4) On November 15 of the same year Plaintiff instituted the lawsuit seeking rescission of the appeal decision.

2 Gist of the reasons given in the appeal decision

The reasons given in the appeal decision are described in the attached written appeal decision (copy). In short, the trademark in the application should not be granted registration since (i) the trademark in the application is similar to a well-known mark comprised of the characters "マイナンバー (mai nambah; individual number)" and indicating a non-profit enterprise undertaking business for public interest (hereinafter referred to as "the cited mark") and therefore it falls under Article 4, paragraph (1), item (vi) of the Trademark Act and (ii) the trademark in the application is similar to a trademark shown in an attached indication of the cited trademark (Exhibit Ko 105, hereinafter referred to as "the cited trademark") and therefore it falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

3 Grounds for rescission

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

(2) Error in the determination that the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act (ground for rescission 2)

(omitted)

IV Court decision

1 Regarding the ground for rescission 1 (error in the determination that the trademark in the application falls under Article 4, paragraph (1), item (vi) of the Trademark Act)

(1) Purport of Article 4, paragraph (1), item (vi) of the Trademark Act

Article 4, paragraph (1), item (vi) of the Trademark Act is understood to be a ground for non-registration since allowing one private person to monopolize the mark set out in the item mars the trust and authority of the predetermined organizations in the item and is contrary to international good faith.

(2) Regarding the fact that the cited mark is "a well-known mark indicating a non-profit enterprise undertaking business for public interest"

A According to the exhibits listed below and the entire import of the oral argument, each of the following facts can be found.

(A) "マイナンバー" System (Individual Number System) is based on the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures enacted in May 2013 and was set up to achieve the following objectives: The introduction of multidisciplinary common numbers in the three fields of social security, taxation, and disaster response enables the administrative agencies and local governments to reliably and promptly specify individuals and makes it easier to ascertain their income and receipt of other administrative services. In consequence, the system will prevent improper evasion of payment responsibility and unfair receipt of benefits, and provide fine-tuned assistance to those who really need it (to realize a fairer and more just society). The system will simplify administrative procedures and lessen the burden on residents by reducing the number of accompanying documents, etc., needed for procedures. It will allow residents to check the information on them that administrative organs possess and receive notices on various services from those organizations (to enhance public convenience). The system will greatly save time and labor needed to compare, transcribe, and input various types of information in administrative organs, local governments, etc. It will promote linkage among multiple operations and eliminate waste arising from work overlap (to improve administrative efficiency). Operation of the system has been sequentially started since January 2016 (Exhibits Otsu 1 to 3).

"マイナンバー (mai nambah)" (individual numbers) represent "social security and tax numbers" and are allocated to every individual who has a residence certificate in Japan. Each of the numbers represents a 12-digit individual number required for various administrative procedures. Since October 2015 each municipality has mailed notification cards for "マイナンバー (mai nambah)" (individual numbers) to the addresses of the residence certificates to notify every individual who has a residence certificate in Japan of his individual number (Exhibits Otsu 2 to 4).

(B) The characters "マイナンバー" represent a mark used in "マイナンバー" System (Individual Number System) and are used on the websites of the Cabinet

Office (Exhibits Otsu 1, 2, 5), the Ministry of Internal Affairs and Communications (Exhibit Otsu 3), the Ministry of Health, Labour and Welfare (Exhibit Otsu 6), the Ministry of Education, Culture, Sports, Science and Technology (Exhibit Otsu 7), the National Tax Agency (Exhibit Otsu 8), the Cities of Nagoya, Osaka, and Fukuoka (Exhibits Otsu 9, 10, 11), and the Japan Agency for Local Authority Information Systems (Exhibit Otsu 12).

The above websites use the terms "マイナンバー (mai nambah) (social security and tax number system)" (Exhibits Otsu 2, 5), "マイナンバー (mai nambah) (social security and tax number)" (Exhibit Otsu 7), "social security and tax number system < マイナンバー (mai nambah)>" (Exhibit Otsu 8), "マイナンバー (mai nambah) social security and tax number system" (Exhibits Otsu 9, 10, 12), "social security and tax number (マイナンバー (mai nambah))" (Exhibit Otsu 9), and "マイナンバー (mai nambah) (individual number)" (Exhibits Otsu 2, 3, 7, 11). The goo dictionary defines "<<(in Japanese) マイナンバー [my number] (individual number)>>" as follows: "a common name for the 'individual number' allocated to every individual who has a residence certificate in Japan under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures. A 12-digit unique number that can be obtained by converting a residence certificate code and that is designated and sent by the head of the municipality of an individual address. A common number. A social security and tax number." (Exhibit Otsu 4)

(C) "マイナンバー (mai nambah)" (individual numbers) or "マイナンバー" System (Individual Number System) is covered by a large number of newspaper and magazine articles and internet information and the characters "マイナンバー" are also used in these articles (Exhibits Ko 62 to 65 and Otsu 13 to 23).

B Based on the above facts the ground for rescission 1 is reviewed.

(A) "マイナンバー" System (Individual Number System) is an official system that is used in administrative procedures, such as social security, taxation, and disaster response, by administrative agencies and local governments and falls under a "non-profit enterprise undertaking business for public interest" performed by the administrative agencies and local governments.

(B) "マイナンバー" System (Individual Number System) has been advertised on the websites of the administrative agencies and local governments and covered by newspaper articles a large number of times. A notification card with a "マイナンバー" (an individual number) has been sent to each individual since October 2015. Operation of the "マイナンバー" System (Individual Number System) has been started since January 2016. Considering all of the above, "マイナンバー" System

(Individual Number System) itself is found to be widely known to the general public.

To the above websites and newspaper articles, the characters "マイナンバー" are attached and in them the terms "マイナンバー (mai nambah) (social security and tax number system)", "social security and tax number (マイナンバー (mai nambah))," and "マイナンバー (mai nambah) (individual number)" appear. Considering the above and the definitions indicated in dictionaries, the cited mark is found to be widely used as a mark that indicates social security and tax numbers or individual numbers under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or the "マイナンバー" System (Individual Number System) which is the social security and tax number system.

Based on the above, it can be said that the cited mark is widely known to the traders and consumers of the designated services of the trademark in the application as the characters used in "マイナンバー" System (Individual Number System) that is generally and widely known in Japan and as the term that refers to the social security and tax numbers or individual numbers under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or the "マイナンバー" System (Individual Number System) which is the social security and tax number system. Therefore, the cited mark can be said to be "well-known."

C Regarding Plaintiff's allegations

Plaintiff alleges as follows: The characters "マイナンバー (mai nambah)" represent loan words derived from "my" and "number" and let one realize and understand the meaning of "my number." It is natural for the traders and consumers of the designated services of the trademark in the application to realize and understand that the characters mean "my number." On the other hand, "マイナンバー" System (Individual Number System) cannot necessarily be said to have widely become a part of the life of the public as a whole. Therefore, it cannot be said that the majority of the public including the traders and consumers of the designated services of the trademark in the application immediately associate or relate the cited mark with the mark used in the "マイナンバー" System (Individual Number System) and thus the cited mark cannot be said to be well-known.

However, "マイナンバー (mai nambah)" are the characters used in the "マイナンバー" System (Individual Number System) which represents official business performed by the administrative agencies and local governments and they are the terms that refer to the social security and tax numbers or individual numbers under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or the "マイナンバー" System (Individual Number System) which is the social

security and tax number system and the "マイナンバー" System (Individual Number System) is a system generally and widely known to the public, as described in B above.

Considering the above, it should be said that the consumers and traders of the designated services of the trademark in the application associate or relate the cited mark with the mark used in the "マイナンバー" System (Individual Number System). Plaintiff's allegations cannot be adopted.

D Summary

Hence, the cited mark is found to be a "well-known" "mark indicating a non-profit enterprise undertaking business for public interest."

(3) Similarity between the trademark in the application and the cited mark

A Criteria for determination

Similarity between trademarks should be examined from an overall perspective by comprehensively considering various factors, including impression, memory, or association that the trademarks used for identical or similar goods or services will give to the 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 or services (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 the determination of similarity of a trademark that is understood as a composite trademark made of a combination of one or more components, 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 separate and observe one or more components from the other components, it should be said to be impermissible to extract a part of the components of the trademark and compare only this part of the composite trademark with the trademark of another person so as to determine the similarity between the trademarks, unless (i) the part of the components of the trademark is found to give a strong dominant impression to the traders and consumers as a source identifier of goods or services and (ii) no pronunciation or concept as the source identifier is found to be generated from the other parts (See 1962 (O) 953, judgment by the First Petty Bench of the Supreme Court on December 5, 1963/*Minshu* Vol. 17, No. 12, at 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).

B Whether or not the component "マイナンバー" of the trademark in the application should be examined for the determination of similarity

The trademark in the application is "マイナンバー実務検定" and from its entire configuration, the pronunciation "mai nambah jitsumu kentei" and the concept "proficiency test on the Individual Number System" are generated.

The component "マイナンバー" in the trademark in the application is identical to the constituent characters of "マイナンバー" which is a well-known mark. Therefore, the component is found to give a strong dominant impression as the source identifier of the services.

On the other hand, the designated services of the trademark in the application include "arranging, conducting, or giving certification examinations and providing information thereon" and "organization of seminars for the examinees of certification examinations and providing information thereon," but the component "proficiency test" in the trademark in the application only generally indicates being a "test" of "proficiency" in relation to the designated services. It should be said that neither pronunciation nor concept as the source identifier of the services is generated from the component.

The foregoing reveals that from the trademark in the application, not only the pronunciation of "mai nambah jitsumu kentei" and the concept of "proficiency test on the Individual Number System" but also the pronunciation of "マイナンバー (mai nambah)" and a concept identical to "マイナンバー (individual number)" which is a well-known mark; i.e., the concept of "social security and tax number or individual number under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or the Individual Number System which is the social security and tax number system," can be generated.

Hence, it should be said to be permissible to extract the component "マイナンバー" from the trademark in the application, and compare only the component with the cited trademark and determine the similarity between them.

C Similarity between the trademark in the application and the cited mark

The component "マイナンバー" which gives a strong dominant impression as a source identifier, of the trademark in the application, and "マイナンバー" in the cited mark are identical in pronunciation and concept.

Considering this, even though the trademark in the application and the cited mark cannot be said to be identical or similar in appearance, they are likely to mislead and cause confusion as to the source of the services if they are used for the designated services. Therefore, it should be said that the trademark in the application and the cited mark are similar.

D Regarding Plaintiff's allegations

Plaintiff alleges that from the trademark in the application "マイナンバー実務検定", only a series of pronunciations "mai nambah jitsumu kentei" and concepts of "proficiency test on the Individual Number System" are generated.

(i) Plaintiff is a general incorporated foundation whose establishment was authorized on October 15, 1999 as a foundation authorized by the Minister of Education, Culture, Sports, Science and Technology and an organization under the jurisdiction of the Lifelong Learning Policy Bureau of the Ministry of Education, Culture, Sports, Science and Technology (Exhibits Ko 67, 129). Plaintiff gives technical certification examinations on information education and organizes training sessions on information education and conducts research and studies on information learning and produces publications to promote information-related lifelong learning (Exhibit Ko 68). (ii) Plaintiff conducted certification examinations called the "マイナンバー実務検定" twelve times at 138 venues of the nationwide major cities in total from August 2, 2015 to December 17, 2017 with the sponsorship of SANKEI SHIMBUN CO., LTD. and Kadokawa Ascii Research Laboratories, Inc. and the number of applicants for the test reaches as many as 45,968 in total (Exhibits Ko 69 to 71, 82 to 95, 112, 133, and 134). (iii) Plaintiff introduced the website "マイナンバー実務検定" (Exhibits Ko 70, 71) and uploaded an advertisement video of "マイナンバー実務検定" on a major video site, YouTube (Exhibits Ko 72, 74, and 123 to 126) and broadcast TV commercial videos 502 times in total (Exhibits Ko 73, 116, 117-1 to -6, 127, 128, 135, 136-1 to -4, 137 to 143, 144-1/-2) and posted advertisement articles on newspapers (Exhibits Ko 75, 76, 133, and 134). In all cases, the characters "マイナンバー実務検定" appear. (iv) Plaintiff prepared, distributed, or exhibited brochures, flyers, and posters on the "マイナンバー実務検定 (mai nambah jitsumu kentei; proficiency test on the Individual Number System)" (Exhibits Ko 77 to 94 and 118), and in them as well, the characters "マイナンバー実務検定" appear. (v) Plaintiff published textbooks and past exam papers of "マイナンバー実務検定 (proficiency test on the Individual Number System)" (Exhibits Ko 97 to 102, 131, and 132) and the number of print copies reached 30,000 including 7,000 copies to be sold only on the Web in May 2017 (Exhibits Ko 119 and 120) and in all of them the characters "マイナンバー実務検定" appear. In light of the actual conditions of trade described above, the trademark in the application is found to be known to a certain extent.

However, whereas the component "マイナンバー" in the trademark in the application gives a strong impression as the source identifier of the services, the component "proficiency test" does not generate any pronunciation or concept as the

source identifier of the services. Therefore, it is permissible to extract the component "マイナンバー" and compare only this portion with the cited trademark and determine the similarity between the trademarks, as described in B above. Considering this, from the trademark in the application "マイナンバー実務検定", a series of pronunciations "mai nambah jitsumu kentei" and concepts as "proficiency test on the Individual Number System" are generated. In addition, in the case where only the component "マイナンバー" is extracted, the pronunciation of " mai nambah" and the concept of "the social security and tax number or individual number under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or "マイナンバー" System (the Individual Number System) which is the social security and tax number system" are also generated. Therefore, it cannot be said that only a series of pronunciations and concepts as "マイナンバー実務検定" as whole are generated from the trademark in the application.

Hence, Plaintiff's allegations cannot be adopted.

(4) Summary

Based on the foregoing, the trademark in the application falls under Article 4, paragraph (1), item (vi) of the Trademark Act.

2 Regarding the ground for rescission 2 (error in the determination that the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act)

(1) Regarding the cited trademark

The cited trademark consists of "マイナンバー," six *katakana* characters, which are standard characters. These characters are identical to the well-known mark "マイナンバー" (cited mark) found in 1 above. Hence, the cited trademark generates the pronunciation of "マイナンバー (mai nambah)" corresponding to the characters and the concept of "the social security and tax number or individual number under the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures, or "マイナンバー" System (Individual Number System) which is the social security and tax number system."

In addition, the goods and services of the cited trademark are the designated goods and designated services that belong to Class 41 and Classes 9, 16, 25, 35, 36, 38, 42, and 45.

(2) Similarity between the trademarks

It is permissible to extract the component "マイナンバー," which gives a strong dominant impression as a source identifier, from the trademark in the application, and compare only the component with the cited trademark and determine the similarity

between them, as described in 1(3)B above.

In light of the criteria for determination described in 1(3)A above, it should be said that the cited trademark which is an identical mark to the cited mark is also similar to the trademark in the application.

(3) Similarity of the designated services

In the designated services of the trademark in the application, "educational and instruction services relating to arts, crafts, sports, or general knowledge, arranging, conducting, and organization of seminars, organization of seminars for the examinees of certification examinations and providing information thereon, providing electronic publications, services of reference libraries for literature and documentary records, book rental, publication of books, publication of teaching material books, production of videotape film in the field of education, culture, entertainment, or sports [not for movies or television programs and not for advertising or publicity], production of teaching material video/DVD film [not for movies or television programs and not for advertising or publicity], rental of records or sound-recorded magnetic tapes, and rental of image-recorded magnetic tapes" include the identical services to the designated services of the cited trademark. Therefore, it can be said that the designated services of the trademark in the application are identical or similar to those of the cited trademark.

In addition, with reference to "arranging, conducting, or giving certification examinations and providing information thereon" in the designated services of the trademark in the application, and "educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures (Act No. 27 of 2013), educational and instruction services relating to the social security and tax number system, educational and instruction services relating to administrative services or administrative procedures, and educational and instruction services relating to arts, crafts, sports, or other general knowledge" in the designated services of the cited trademark, it is likely that arranging, conducting of certification examinations, and educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures are performed by the same business operator and it is likely that above services share common consumers, such as those who are given educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures and the examinees of certification examination. When the trademark in the application and the cited trademark are used for these services, they are in a relationship where the services are likely to be mistaken for the services of the same

business owner. Therefore, the trademark in the application and the cited trademark can be said to be similar to each other.

With reference to "providing facilities for movies, shows, plays, music, or educational training" in the designated services of the trademark in the application, and "educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures (Act No. 27 of 2013), educational and instruction services relating to the social security and tax number system, educational and instruction services relating to administrative services or administrative procedures, and educational and instruction services relating to arts, crafts, sports, or other general knowledge" in the designated services of the cited trademark, it is likely that providing facilities for educational training and educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures are performed by the same business operator. When the trademark in the application and the cited trademark are used for these services, they are in a relationship where the services are likely to be mistaken for the services of the same business owner. Therefore, the trademark in the application and the cited trademark can be said to be similar to each other.

Hence it is right to understand that the designated services of the trademark in the application are identical to similar to those of the cited trademark.

(4) Regarding Plaintiff's allegations

A Plaintiff alleges that since the appeal decision does not make a specific determination as to the similarity between the designated services of the trademark in the application and the designated goods and services of the cited trademark, the appeal decision is groundless and a premature decision.

The Trademark Act provides that a decision on an appeal must be rendered in writing, stating "the conclusion of and reasons for the decision on the appeal" (Article 56, paragraph (1) of the Trademark Act and Article 157, paragraph (2), item (iv) of the Patent Act). The Trademark Act specifies appeal procedures in compliance with the civil procedures and stipulates that whether or not there are grounds for rescission of the registration of a trademark should be sufficiently examined and determined in terms of legal and factual points at issue in the appeal procedures. The Trademark Act also provides that assuming that sufficient examination and determination are made with the participation of the interested parties, fact-finding proceedings are omitted and the Tokyo High Court has exclusive jurisdiction over any action against an appeal decision (Article 63, paragraph (1) of the Trademark Act). In light of the foregoing, the purpose of the above provision that obligates the matters of the appeal

decision to be described is to secure the cautiousness and rationality of the determination of an appeal examiner, control his arbitrariness, and guarantee the fairness of the appeal decision, to make things easier for the interested parties to consider whether or not to file a rescission lawsuit against the appeal decision, and to clarify what should be examined by the court regarding the appropriateness of the appeal decision.

Accordingly, it is right to understand that the reason why the above matters should be described in the written appeal decision is that except in special circumstances, as the final determination in the appeal, the basis of the determination needs to be specifically indicated based on the facts found by evidence (See 1979 (Gyo-tsu) No. 134, judgment by the Third Petty Bench of the Supreme Court on March 13, 1984/Civil Case Law Reports of the Court, No. 141, page 339.). If the JPO renders an appeal decision to the effect that the demand for appeal against an examiner's decision shall be dismissed on the grounds that the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act, the JPO must examine and determine in the appeal decision and state in the written appeal decision that the trademark in the application falls under the provision, or more specifically, that the trademark in the application and the cited trademark are identical or similar and the designated goods or designated services of the two trademarks are identical or similar.

However, the appeal decision makes no determination as to whether or not the designated services of the trademark in the application and the designated goods and designated services of the cited trademark are identical or similar. Accordingly, it can be said that the appeal decision does not sufficiently describe the reasons in this respect.

Of course, in the case, the rejection decision was issued to make it clear that the trademark in the application and the cited trademark are similar and the designated services of the trademark in the application and the designated services of the cited trademark are identical or similar (Exhibit Ko 107), but Plaintiff's sole allegations in the written demand for appeal are entirely focused on the dissimilarity between the trademark in the application and the cited trademark. Plaintiff does not allege that the designated services of the trademark in the application and the designated services of the cited trademark are not similar (Exhibit Ko 108). Plaintiff does not allege, either, in the lawsuit that the designated services of the trademark in the application and those of the cited trademark are not similar. The designated services of the trademark in the application and those of the cited trademark are identical or similar, as described in (3) above. Moreover, the trademark in the application falls under Article 4, paragraph (1),

item (vi) of the Trademark Act, as described in 1 above. Considering this, it cannot be said that it is illegal that the appeal decision affirmed that the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act without making any determination as to the similarity between the designated services, or that failure to make determination as to the similarity affects the conclusion.

B Incidentally, Plaintiff alleges that Defendant's arguments on the similarity between the designated services in the lawsuit are allegations or evidence advanced outside the appropriate time.

However, Defendant's above arguments do not delay the conclusion of the suit. Therefore, Defendant's arguments clearly do not fall under the allegations or evidence advanced outside the appropriate time.

(5) Summary

Based on the foregoing, the trademark in the application falls under Article 4, paragraph (1), item (xi) of the Trademark Act.

3 Conclusion

The appeal decision ruled that the trademark in the application falls under Article 4, paragraph (1), items (vi) and (xi) of the Trademark Act, as described above, and that the trademark in the application could not be registered. In conclusion, the appeal decision is legitimate. Hence, the claim is groundless and shall be dismissed and the decision is rendered as described in the main text.

Intellectual Property High Court, Fourth Division

Presiding Judge TAKABE Makiko

Judge FURUKAWA Kenichi

Judge SEKINE Sumiko

Attachment Indication of the cited trademark

1 Registration number

No. 5756402

2 Registered trademark (standard characters)

マイナンバー,

3 Designated goods and designated services

Class 9 (omitted)

Class 16 (omitted)

Class 25 (omitted)

Class 35 (omitted)

Class 36 (omitted)

Class 38 (omitted)

Class 41 educational and instruction services relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures (Act No. 27 of 2013), educational and instruction services relating to the social security and tax number system, educational and instruction services relating to administrative services or administrative procedures, and educational and instruction services relating to arts, crafts, sports, or other general knowledge, arranging, conducting, and organization of seminars relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures (Act No. 27 of 2013), arranging, conducting, and organization of seminars relating to the social security and tax number system, arranging, conducting, and organization of seminars relating to administrative services or administrative procedures, arranging, conducting, and organization of other seminars, providing electronic publications, services of reference libraries for literature and documentary records, book rental, publication of books, arranging and planning of movies, shows, plays or musical performances, movie theatre presentations or movie film production and distribution, presentation of live show performances, direction or presentation of plays, presentation of musical performances, production of radio or television programs, production of videotape film in the field of education, culture, entertainment, or sports [not for movies or television programs and not for advertising or publicity], organization, arranging, and conducting of sports competitions, organization, arranging, and conducting of events relating to the Act on the Use of Numbers to Identify a Specific Individual in Administrative Procedures (Act No. 27 of 2013), organization, arranging, and conducting of events relating to the social security and tax number system, organization, arranging, and conducting of events relating to

administrative services or administrative procedures, organization, arranging, and conducting of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races, and auto races, organization, arranging, and conducting of horse races, organization, arranging, and conducting of bicycle races, organization, arranging, and conducting of boat races, organization, arranging, and conducting of auto races, rental of records or sound-recorded magnetic tapes, rental of image-recorded magnetic tapes, photography, entertainment services, providing music or sound through communication, providing video or images through communication, arranging, editing, or production of publications (including electronic publications), production of acoustic, musical, and video recordings, acoustic and musical production, arranging, conducting, and organization of awards, arranging, conducting, and organization of awards or providing information relating to their results

Class 42 (omitted)

Class 45 (omitted)