

## Appeal decision

Appeal No. 2012-422

Ibaraki, Japan

Appellant

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The case of appeal against the examiner's decision of refusal Trademark Application No. 2011-4144 has resulted in the following appeal decision.

### Conclusion

The appeal of the case was groundless.

### Reason

#### 1 The trademark in the application

The trademark in the application configured as shown in Attachment 1 was filed on January 24, 2011 by setting Class No. 21 the designated goods as described in the application, and the designated goods were amended to the following goods in Class No. 21 by the written amendment dated July 20 of the same year during the original examination and the written amendment dated March 2, 2012 during the present examination: "Crystal glass products with cut (kiriko) pattern; glasses with cut (kiriko) pattern; cups with cut (kiriko) pattern; tablewares with cut (kiriko)

pattern; crystal or glass figures with cut (kiriko) pattern; crystal or glass shaped articles with cut (kiriko) pattern; crystal or glass carved ornaments with cut (kiriko) pattern; crystal or glass vases, flower bowl and wind chimes with cut (kiriko) pattern; glass bottles for preserving foods with cut (kiriko) pattern; crystal or glass containers with cut (kiriko) pattern; crystal or glass pepper pots, sugar basin and salt shakers with cut (kiriko) pattern; crystal or glass cruets with cut (kiriko) pattern; crystal or glass coasters with cut (kiriko) pattern; crystal or glass candlesticks with cut (kiriko) pattern; crystal or glass cosmetic utensils with cut (kiriko) pattern; crystal or glass trays for household pets with cut (kiriko) pattern; crystal or glass water baths with cut (kiriko) pattern".

## 2 Gist of reasons for refusal of the examiner's decision

The examiner's decision cited Trademark Registration No. 5085277 (hereinafter referred to as "Cited Trademark"), found and judged as shown below in (1) and (2), and rejected the Application.

Cited Trademark consists of the standard characters of "江戸切子", the application of Cited Trademark for its registration was filed on June 5, 2006 by setting goods or services in Classes No. 14, 21 and 40 as the designated goods or services as described in Attachment 2 as a regional collective trademark under Article 7-2 of the Trademark Act on June 5, 2006, and the trademark was registered on October 19, 2007 of the same year and, and it is still valid as of now.

(1) As the Trademark in the application is identical to, or similar with Cited Trademark and the designated goods (services) by the trademark in the application are identical to, or similar with, those by the Cited Trademark, and thus falls under Article 4(1)(xi) of the Trademark Act.

(2) The Trademark in the application consists of characters "カガミクリスタル" and "江戸切子" written in two lines vertically without aligning their top portions, while characters "江戸切子" had been registered as a regional collective mark (Cited Trademark) under Article 7-2 of the Trademark Act, and if the Trademark in the application is used for the designated goods, traders and consumers coming into contact with the trademark in the application are likely to falsely recognize or confuse the source of goods as if the goods were connected with the business of the trademark right holder or a person who has a certain organizational relationship with the same person. Therefore, the trademark in the application falls under Article 4(1)(xv) of the Trademark Act.

### 3 Judgment on the body

#### (1) Article 4(1)(xi) of the Trademark Act

The trademark in the application, as shown in Attachment 1, consists of the katakana characters of "カガミクリスタル (KAGAMICRYSTAL)" and the Chinese characters "江戸切子" written in two lines vertically, while these characters are katakana and Chinese characters, respectively, and written in two lines with different sizes, and thus viewed separately. The trademark in the application in its entirety is pronounced [kagamikurisutaruedokiriko], which include lengthy 13 sounds, and additionally, there is no special circumstance where the trademark in the application is always viewed as one block, it is thus reasonably judged that traders and consumers coming into contact with this focus attention on characters "江戸切子" which is written in bolder and larger characters than characters "カガミクリスタル" in its structure, and quite often make use of said part for handling.

It is reasonably judged that the trademark in the application gives rise to the pronunciation of "edokiriko" according to the part and evokes the meaning of "江戸切子(Edo Kiriko; cut glassware)".

On the other hand, Cited Trademark consists of the standard characters of "江戸切子", which the pronunciation "edokiriko" and to evoke the meaning of "江戸切子 (Edo Kiriko; cut glassware)".

Accordingly, both trademarks are common in characters "江戸切子", and similar in the pronunciation [edokiriko] and the meaning "江戸切子(Edo Kiriko; cut glassware)".

Further the designated goods of the trademark in the application, "glasses with cut (kiriko) pattern; cups with cut (kiriko) pattern; tablewares with cut (kiriko) pattern; crystal or glass carved ornaments with cut (kiriko) pattern; crystal or glass vases, flower bowls and wind chimes with cut (kiriko) pattern; glass bottles for preserving foods with cut (kiriko) pattern; crystal or glass containers with cut (kiriko) pattern; crystal or glass pepper pots, sugar basins and salt shakers with cut (kiriko) pattern; crystal or glass cruets with cut (kiriko) pattern; crystal or glass coasters with cut (kiriko) pattern" are identical to, or similar with, those by the Cited Trademark, thus the trademark in the application falls under Article 4(1)(xi) of the Trademark Act.

#### (2) Article 4(1)(xv) of the Trademark Act

The trademark in the application consists of the katakana name of "カガミクリスタル (KAGAMICRYSTAL)" and the characters "江戸切子" written in two

lines vertically as shown in the Attachment 1.

On the other hand, Cited Trademark consists of the standard characters of "江戸切子", and the trademark consisting of said characters had been registered as a right of the applicant by setting goods or services in Classes No. 14, 21 and 40 as the designated goods or services as described in Attachment 2 as regionally-based collective trademark under Article 7-2 of the Trademark Act on October 19, 2007, and said characters have been well-known among consumers as indicating goods and services relating to the business of a trademark right holder or its members since before the filing of the Application.

Any of the designated goods of the trademark in the application is crystal or glass product with cut (kiriko) pattern, and thus closely related to the designated goods or the designated services of Cited Trademark.

Accordingly, the trademark in the applications has characters "江戸切子" consisting of the same spelling as that of Cited Trademark that is well-known among traders and consumers, and the designated goods of the trademark in the Application are also closely related to the designated goods and the designated services of Cited Trademark. It is reasonably judged that if the designated goods are used for the trademark in the application, traders and consumers coming into contact with the trademark in the application will associate and evoke Cited Trademark that has become well-known and prominent, and falsely recognize or confuse the source of goods as if the goods were connected with the business of Cited Trademark right holder or a person who has a certain economic and organizational relationship with the same person, and the trademark in the application falls under Article 4(1)(xv) of the Trademarks Act.

### (3) Argument of appellant

The appellant alleges that as the appellant has been producing and selling crystal glass products including "江戸切子" since the beginning of its foundation, and had been contributing to acquisition of prominence of "江戸切子", and is prominent as a sophisticated crystal glass product maker, consumers coming in contact with the trademark in the application always recognizes the trademark in the application as a trademark indicating "glass cut product made by Kagami Crystal Co., Ltd." as one block, and characters "江戸切子" does not function as a function for distinguishing relevant products from others.

However, Cited Trademark consisting of the characters "江戸切子" has obtained function for distinguishing relevant products and services from others as a result of the trademark right holder or its members' use of Cited Trademark

consisting of the characters "江戸切子" by setting goods and services in as described in Attachment 2 as the designated goods and services, and had been registered as a regional collective trademark as described above, and the trademark in the application may be used for transaction only through the part of characters "江戸切子", and the appellant's allegation cannot be accepted..

The appellant alleges that it is questionable if Cited Trademark meet registration requirements or not, thus the scope of protection should be interpreted narrower, but Cited Trademark was registered in 2007 and is still effective, and it is not found that there has been any change of circumstances, thus said allegation cannot be accepted.

#### (4) Summary

As described above, the examiner's decision made to refuse the application because the trademark in the application falls under Article 4(1)(xi) and Article 4(1)(xv) of the Trademark Act, is reasonable and irrevocable.

Therefore, the appeal decision shall be made as described in the conclusion.

December 28, 2012

Chief administrative judge: WATANABE, Kenji

Administrative judge: MAEYAMA, Ruriko

Administrative judge: MATSUDA, Noriko

Attachment 1 The Trademark in the application



Attachment 2 The designated goods and the designated services of Cited Trademark

Class No. 14 "glass broaches produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass bolo ties produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass pendants produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; and glass clocks produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District"

Class No. 21 "Glass sake bottles produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass flood water bottles produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass liquor bottles produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass large sake cups produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass sake cups produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glasses made of glass produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass dishes produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass small bowls

produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass bowls for sweets produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass sake bottles ("chosi" in Japanese) produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; three-layer glass boxes produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; tea ceremony water jars made of glass produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass bonbonniere produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; tea caddies made of glass produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass water pitchers produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass napkin holders produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass vases produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass decorative dishes produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass carved ornaments for indoor decoration produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass ornamental covered boxes produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass wind chimes produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District; glass incense burners produced in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions using a method originated in Tokyo District"

Class No. 40 "Glass processing that is performed in Koto-ku, Sumida-ku, Katsushika-ku, Edogawa-ku, Tokyo and their neighboring regions and originated in Tokyo District"