Trial Decision

Revocation No. 2012-300403

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The case of trial regarding the revocation of the Trademark Registration No. 2523496 between the parties above has resulted in the following trial decision

Conclusion

The demand for trial of the case was groundless.

The costs in connection with the trial shall be borne by the demandant.

Reason

No. 1 The Trademark

The trademark registration No. 2523496 (hereinafter referred to as "the trademark of this case"), is composed of "PEARL" in Alphabetic characters and "パール (pearl)" in Katakana characters provided in two stages. The trademark application was filed on June 15, 1990, and the registration of the creation for class 27 "tobacco" as designated goods was effected on April 28, 1993. Then, the renewal of duration of the trademark right was registered on April 1, 2003, and the reclassification of designated goods was registered on May 7, 2003 to reclassify the designated goods into class 34 "tobacco", which is actually remaining in force.

In addition, the demand for the trial was registered on June 4, 2012.

No. 2 Argument of Demandant

The demandant has filed a demand for the revocation of registration of the trademark of this case under the provision of Article 50(1) of the Trademarks Act, and the costs in connection with the trial borne by the demandee. The demandant has stated the reasons therefor and rebutted the answer as follows, and has adduced Evidence A No. 1 to Evidence A No. 4 as means of evidence.

1 Reasons for Trial

The trademark of this case should be cancelled under the provision of Article 50(1) of the Trademarks Act because there had been no fact that any of the owner of trademark right, exclusive right to use or non-exclusive right to use has used the registered trademark in Japan in connection with the designated goods concerned for three consecutive years or longer.

2 First Rebuttal

The term "パール (pearl)" in "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is nothing more than a modifier which expresses "filter" (filter tip paper, to be exact) that is a part of a cigarette, similar to "キラキラきらめく (glittering and sparkling)".

The term "filter" in "... きらめくパールフィルター (sparkling pearl filter)" used herein of course refers to a filter (filter tip paper) which is a part of a cigarette, and does not mean "filter-tipped cigarette".

(1) The term "パール (pearl)" is nothing more than a modifier of a filter.

a. The term "パール (pearl)" that the demandee has asserted as the use of the trademark of this case is used in the phrase "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)", and thus is a modifier (the modifier playing the same role as an adjective) which expresses the "filter" indicating that the filter is shiny like pearl.

b. More specifically, "パール (pearl)" is used to indicate the image of coloration thereof, i.e., pearly color (silver), and is generally used as a modifier for expressing the status of being "shiny" or "glossy" like pearl, or for expressing the status of being pearly color (or having a touch of pearl). Considering that the term "パール (pearl)" is used immediately after two terms ("キラキラ (glittering)" and "きらめく (sparkling)") which play the role as modifiers of the term "filter" in the similar way, there is no room for doubt that the term "パール (pearl)" is a modifier for expressing the "filter".

"ピアニッシモ・スーパースリム (Pianissimo Super Slim)" is a product whose filter portion employs "きらきら光るチップペーパー (glittering and sparkling tip paper)" (Evidence A No. 4). The phrase "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is the phrase which expresses with an emphasis "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" as being the product which uses a glittering filter tip paper having a shine like a glossy pearl. The term "パール (pearl)" is used as a modifier for expressing a filter in the same way as the expression by a modifier such as "キラキラ (glittering)" and "きらめく (sparkling)".

In fact, in the advertisement of this case, there is the text of "だから、手元・口元にも優しくキレイ (so it is tender and attractive to hand and lips)" subsequent to the phrase "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)". It is understood that the text concerned points out that the glittering filter, which is a portion of a cigarette held by a hand and also serves as a mouthpiece, makes hand and lips seem tender and attractive when a user holds a cigarette by hand or smokes a cigarette. Therefore, considering that the text "だから、手元・口元にも優しくキレイ (so it is tender and attractive to hand and lips)" subsequent thereto, it is obvious that the term "フィルター (filter)" in "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is used as the modifier referring to filter tip paper, while "パール (pearl)" being used along with modifiers such as "キラキラ (glittering)" and "きらめく (sparkling)" as the modifier indicating that the filter tip paper glitters.

Therefore, the term pearl is nothing more than a modifier, and thus is not used as a trademark capable of distinguishing the goods of one enterprise from those of other enterprises (i.e., distinctive mark).

(2) It is unreasonable to assert that "パールフィルター (pearl filter)" is the name (trademark) of the cigarette in question.

a. If comparing with "ピースロングフィルター (Peace Long Filter)", "ウェストン・フィルター (Winston Filter)", and "キャメルフィルター (Camel Filter)", the term in question has to be used as the product name of the cigarette in the same way as those filter names. However, the name of the cigarette in question is not "pearl filter" but "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", and thus it is impossible to discuss those filters ("Peace Long Filter", "Winston Filter", and "Camel Filter") in the same way as "pearl filter". "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" employs "きらきら光るチップペーパー glittering and sparkling tip paper)" in the filter portion thereof. It is thus obvious

that "パール (pearl)" is used along with modifiers such as "きらきら (glittering)" and "きらめく (sparkling)" as the modifier indicating that the filter tip paper thereof glitters, and is not used as a distinctive mark like "Peace", "Winston", and "Camel".

b. In the first place, the phrase "キラキラきらめくパールフィルター (Glitteringglittering and sparkling pearl filter)" is written along with the phrases describing the characteristics of the product "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", such as "きゅっと詰まったメンソール (compactly filled menthol)", "２０本入りなのにコンパクト (20 cigarettes inside but compact)" (Evidence B No. 1 and Evidence B No. 2), "極細スリムサイズ (extra-fine slim size)" (Evidence B No. 3), and "におい・煙が少ない (producing less smell and smoke)". Therefore, the phrase "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is also nothing more than that explaining the characteristic of the product, and is obviously not the words and phrase that serves as a trademark.

c. As discussed above, the demandee takes up the names of "Winston Filter" and the like which obviously cannot be discussed in the same way to expand its view without revealing the name of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" in order to insist that "パール (pearl)" is used as a trademark. However, such an unnatural and incomprehensible assertion itself proves that the demandee does not use the trademark of this case. Accordingly, the assertion by the demandee in which Pearl Filter is the name (trademark) of the cigarette is unnatural and unreasonable, and thus is not acceptable.

(3) As discussed above, "パール (pearl)" (Katakana characters) is not used as a trademark, but merely an adjective which indicates that the filter portion of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" that is a new brand of cigarette from the demandee glitters like pearl. Therefore, the assertion by the demandee is groundless without rebutting other assertions by the demandee (the assertion regarding the user of the advertisement of this case, for example).

3. Second Rebuttal

(1) Counterargument by the demandant

a. In view of the usage of Evidence B No. 1 to Evidence B No. 4, it is obvious that "pearl filter" (i.e., the portion of the "filter" thereof) used by the demandee merely represents a "filter" that is a part of a cigarette.

b. The fact that the term "パール (pearl)" is capable of distinguishing in relation to the designated goods such as tobacco (more specifically, the term can be registered as a trademark) is irrelevant to the discussion in which the registered trademark "パー

ル (pearl)" is used as being capable of distinguishing the goods of one enterprise from those of other enterprises (used as a trademark). The discussion by the demandee confuses the discussion about whether or not the trademark "パール (pearl)" can be registered as a trademark with the discussion about whether or not the use of the registered trademark "パール (pearl)" by the demandee is used as a trademark. We are thus convinced that the theoretical construction is clearly wrong.

As described above, it must be said that the discussion of the matter in question by the demandee is ambiguous and inappropriate. In either way, the evidences adduced before by the demandee and the demandant explicitly prove that the demandee merely uses the term "パール (pearl)" as an adjective (modifier) of "filter" in the context of description, and thus the use in such a manner does not fall under the use as a trademark at all.

c. The problem of this case is whether or not the term "パール (pearl)" used by the demandee is used as being capable of distinguishing the goods of one enterprise from those of other enterprises, and thus the discussion by the demandee is unfounded.

d. Although it can be recognized that there are some cases that one or more trademarks are used for a product, what the demandant intends to assert is eventually to point out that the demandee does not submit any evidences at all which prove that the term "パールフィルター (pearl filter)" is used as an additional trademark with respect to the product in question, i.e., "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" (other than the trademark "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" representing the product name). In either way, there is no ground at all for the discussion by the demandee in this case, i.e., as if "パールフィルター (pearl filter)" is equivalent (similar) to "Peace Long Filter" or the like which is the product name (trademark) if the product name is not "pearl filter" but "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", and thus we are convinced that the assertion thereof is unreasonable.

(2) Conclusion

As stated above, the evidences adduced in this case by the demandee do not prove that the demandee uses the trademark of this case.

No. 3 Gist of Inquiry to the Demandee

Against the trial for revocation of the trademark registration, the demandee has to prove that any of the owner of trademark right, exclusive right to use or non-exclusive right to use has used the registered trademark (including a trademark that is

deemed as identical from common sense) in Japan in connection with the designated goods pertaining to the request within three years prior to the registration of the request for the trial of this case (hereinafter referred to as "within the period of requiring proof").

The demandee has stated in the written answer dated July 17, 2012 that the sales of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" has been started since November 2010, and submitted Evidence B No. 1 to Evidence B No. 12 as means of evidence to indicate that the trademark of this case is used for the product in question.

Considering the evidences, the trademark of this case is composed of "PEARL" in Alphabetic characters and "パール (pearl)" in Katakana characters provided in two stages. It is recognized that the trademark used by the demandee includes the characters of "キラキラきらめく (glittering and sparkling)" and the characters "パールフィルター (pearl filter)" provided in two stages (Evidence B No. 1, Evidence B No. 2, and Evidence B No. 4) and "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" (Evidence B No. 3) (hereinafter collectively referred to as "used trademarks"), while the trademark of this case does not use the characters of "PEARL" and "パール (pearl)" independently. This is the different aspect from the trademark of this case.

Then, it is recognized that the product in question is the product using "キラキラ光るチップペーパー (glittering and sparklingtip paper)" (Evidence A No. 4).

According to Evidence B No. 1 to Evidence B No. 4, there is the text of "だから、手元・口元にも優しく、キレイ (so it is tender and attractive to hand and lips)" subsequent to the used trademark. It is understood that this expresses the character of the product that hand and lips seem attractive because the product in question employs a filter which glitters like pearl. It is thus grasped that the used trademark in its entirety represents the characteristics of the cigarette filter, and thus it cannot be said that the portion of the characters of "パール (pearl)" acts as that capable of distinguishing which indicates the source of the product in question.

More specifically, it cannot be said that the used trademark is a trademark that is deemed as identical from common sense with the trademark of this case.

Then, the trademark of this case or any other trademark that can be deemed as identical from common sense with the trademark of this case cannot be found in the submitted evidences.

Accordingly, it cannot be recognized in the submitted evidences that the trademark of this case (including a trademark that is deemed as identical from common sense) is used in the product of the trial of the case.

Therefore, if there is no other evidence which can verify the fact that the trademark of this case (including a trademark that is deemed as identical from common sense) is used in the designated goods, the registration of the trademark of this case shall be definitely cancelled.

In addition, even new evidences, if it is to be submitted, must be employed within the period of requiring proof (June 4, 2009 to June 3, 2012) when they are submitted.

No. 4 Assertion by the Demandee

The demandee has answered so as to demand the trial decision similar to the conclusion, and stated the reasons therefor, the inquiry dated October 18, 2012, and the answer to the rebuttal dated September 12, 2012 (the gist thereof is as follows), and submitted Evidence B No. 1 to Evidence B No. 22 as means for evidence.

1. First Answer

(1) Proof of use

a. The demandee has used the trademark of this case in the designated goods within the period of requiring proof. The demandee has started the sales of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" as a new cigarette brand from November 2010, and the trademark of this case has been used in the product in question. More specifically, in the advertising activity at the time of starting the sales of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", the trademark of this case is used in a sticker-type advertising leaflet (Evidence B No. 1), an advertising board (Evidence B No. 2), and an advertising electronic image (Evidence B No. 3) (hereinafter, Evidence B No. 1 to Evidence B No. 3 are collectively referred to as "sampling tool").

The trademark "パール (pearl)" is used in the upper right portion of the sticker-type advertising leaflet of Evidence B No. 1 as if it is a trademark in the aspect being capable of distinguishing the goods of one enterprise from those of other enterprises. Furthermore, the trademark "パール (pearl)" is used on the right page inside the advertising board of Evidence B No. 2 in the aspect being capable of distinguishing the goods of one enterprise from those of other enterprises. Furthermore, the advertising electronic image of Evidence B No. 3 is displayed on the screen of a portable electronic terminal, and the trademark "パール (pearl)" is

used in the lower right portion thereon in the aspect being capable of distinguishing the goods of one enterprise from those of other enterprises.

In addition, the terms "キラキラきらめく (glittering and sparkling)" and "フィルター (filter)" are written in conjunction with the characters "パール (pearl)". However, "キラキラきらめく (glittering and sparkling)" is originally a descriptive portion, and "フィルター (filter)" is a portion representing a part of cigarette, and also there is a case where a name such as "XX filter" is used as a name of filter-tipped cigarette. Therefore, it is deemed that the term in question is the trademark referring to the "filter-tipped cigarette", and also acts as adjectives expressing quality and type of a cigarette, which is considered to be not capable of distinguishing in relation to the product. It is thus evaluated that "パール (pearl)" is used independently as a trademark in terms of the aspect of use.

b. The demandee performed the advertising activity described above from October 22 to November 13, 2010. The advertising activity in question has performed by Drive Communications, Co. Ltd. (hereinafter referred to as "the company D") under the direction and supervision by Japan Tobacco Inc. who is the demandee. Furthermore, the sampling tool with the trademark "パール (pearl)" put thereon, which was used and distributed in the advertising activity, was produced by Hakuhodo Inc. according to the order from the demandee (Evidence B No. 4 to Evidence B No. 11).

<Execution of the advertising activity>

Evidence B No. 4 is an excerpt from the material regarding the execution of the advertising activity, whose front cover bears the name and picture of the product corresponding to those appeared in the sampling tool. Furthermore, the sticker-type advertising leaflet (Evidence B No. 1) is listed as the distributed material. This makes it possible to confirm the fact that the demandee has displayed and distributed the designated goods "tobacco" with the trademark of this case put on.

The advertising activity described above was specifically the introduction and giving away of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" which is the product to be advertised in shops such as restaurants under the direction and supervision by the demandee. At the time of introducing the product, the advertising board (Evidence B No. 2) and the advertising electronic image (Evidence B No. 3) are used, and also the sticker-type advertising leaflet (Evidence B No. 1) is distributed together with the product. In addition, we submit the pictures of the advertising activity as evidence (Evidence B No. 5).

Furthermore, we submit the certificate that proves the fact that

the company D used to distribute the sampling tool using the trademark "パール (pearl)" in Tokyo, Osaka, and Nagoya from October 22 to November 13, 2010 by request from the demandee (Evidence B No. 11).

All of the dates described above falls within the period of requiring proof.

c. The submission of each evidences proves that the trademark "パール (pearl)" that is deemed as identical from common sense with the trademark of this case has been used in the designated goods in question within the period of requiring proof.

(2) Use of Registered Trademark

a. Registered Trademark and use of Trademark That is Deemed as Identical from Common Sense

As described above, it can be recognized from the sampling tool with the trademark "パール (pearl)" that the trademark "パール (pearl)" has been used. "キラキラきらめく／パールフィルター (glittering and sparkling/pearl filter)" put on the sampling tool described above is written with large-sized characters to give it prominence. This is the aspect of use in a manner of trademark, and thus the phrase is used as a sign capable of distinguishing the goods of one enterprise from those of other enterprises.

Furthermore, the part of "キラキラきらめく (glittering and sparkling)" is a modifier or a descriptive expression, and "パールフィルター (pearl filter)" acts as a sign capable of distinguishing the goods of one enterprise from those of other enterprises.

Furthermore, the product in which a filter is coupled to one side of paper-wrapped cigarette whose both ends are cut away is called "filter cigarette". Therefore, with regard to a "filter", there is a case where a name such as "XX filter" is used as a "filter cigarette", and the trademark is used as a name of "tobacco" itself in the aspect of "XX filter", such as "Peace Long Filter", "Winston Filter", "Camel Filter", etc.

Furthermore, since paper-wrapped cigarettes are classified into "filter-tipped", "untipped", and "filter" depending on the aspect of mouthpiece, it is also understood that a "filter" refers to "a mouthpiece at a part of a filter cigarette" (Evidence B No. 12).

Therefore, "パールフィルター (pearl filter)" of this case is deemed to be the trademark referring to the "filter-tipped cigarette", and the part of "filter" is the term expressing quality, form, and type of "tobacco" as a product, and thus is obviously the portion that should be evaluated as being incapable of distinguishing in relation to the designated goods. In the aspect of use of the trademark of this case in the

sampling tool described above, it is thus possible to evaluate that the part of "パール (pearl)" acts as a sign distinguishing the goods of one enterprise from those of other enterprises so as to be used as a trademark. Furthermore, it is deemed that, even in a business dealing, "filter" referring to "filter cigarette" or "mouthpiece portion of filter-tipped cigarette" is not intentionally extracted and recognized, but rather the part of "パール (pearl)" is independently recognized which is the essential and distinctive part in the trademark and is put to the sampling tool. This contributes to the business dealing.

In addition, as a product separate from "filter cigarette", "mouthpiece filter" (which is a smoking supply to be used by mounting a paper-wrapped cigarette thereon) is distributed for smokers. However, it is unimaginable at all that the name of filter used at that time is used to be referred to as "box filter cigarette", for example. It is deemed that customers and dealers who are in contact with the aspect of use of the trademark of this case in the sampling tool do not envisage the mouthpiece filter "パール (pearl)".

In addition, while the trademark of this case is "PEARL/パール (pearl)", Article 50(1) of the Trademarks Act states that a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and concept falls under the use of a trademark that is deemed as identical from common sense. More specifically, it is deemed that the trademark "パール (pearl)" is the trademark that is deemed as identical from common sense with the trademark of this case "PEARL/パール (pearl)", and thus the demandee uses the trademark of this case and a trademark that is deemed as identical from common sense.

b. Use in Article 2(3)(viii) of the Trademarks Act

The advertising activity by the demandee of distributing or using the sampling tool falls under the act to display or distribute advertisement materials, price lists or transaction documents relating to goods or services to which a mark is affixed, or to provide information on such content, to which a mark is affixed. More specifically, the aspect of use of the trademark "pearl" by the demandee falls under the use of trademark provided in Article 2(3)(viii) of the Trademarks Act.

c. Use by an owner of a right of non-exclusive use, etc.

The advertising activity by the demandee has been done directly by the company D. The advertising activity is rarely performed a business enterprise by itself, but is generally performed by an agent specializing in advertisement. The

advertising activity in question has been performed by the company D who is an entrusted company at the demandee's beck and call under the direction and observation by the demandee. In light of the aspect concerned, the advertising activity in question should be evaluated as being performed by the demandee itself. More specifically, it is deemed that the use of trademark provided in Article 2(3)(viii) of the Trademarks Act is performed in person.

In addition, even if it is not the use of trademark in person, it should be understood that a right of non-exclusive use regarding the trademark "パール (pearl)" has been implicitly agreed upon the demandee outsourcing the advertising activity to the company D.

d. Use within the period of requiring proof

As discussed above, the advertising activity of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" has been conducted from October 22 to November 13, 2010. At that time, since the sampling tool with the trademark "パール (pearl)" put thereon was distributed or used, it is obvious that the trademark of this case has been used within the period of requiring proof.

As stated above, the demandee or the owner of a right of non-exclusive use has been used the trademark of this case for the designated goods within the period of requiring proof.

2. Second Answer

(1) Answer to Interrogation

a. Out of the character elements that the demandee uses in the sampling tool, the part of "パール (pearl)" is the term which is sufficiently distinctive in relation to the product "tobacco", and thus it is deemed that the part of "パール (pearl)" contributes to business dealing with customers and dealers who are in contact with this.

b. The part of "パール (pearl)" acts as a sign capable of distinguishing the goods of one enterprise from those of other enterprises.

It is not deemed that the term "パール (pearl)" in the phrases of "キラキラきらめく／パールフィルター (glittering and sparkling/pearl filter)" and "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is ordinarily used as the term indicating the quality of the product in question in relation to the product "tobacco", and also it is not deemed that the term in question is known familiarly as such a meaning. Even if glittering paper is used for the package of cigarette, the expression thereof by the term "パール (pearl)" results in the indication as a trademark.

More specifically, the term of pearl is never used for the quality of paper for use in the package or the quality of completed cigarette. The same goes for the filter of a cigarette; even if it is a glittering filter, the term "パール (pearl)" cannot be considered to be recognized as the term directly indicating the contents. The term "パール (pearl)" directly and specifically cannot be considered to indicate the quality of the product "tobacco" even if it is a slightly suggestive. It can be deemed that the term "パール (pearl)" may be suggestive of an image of brilliancy like pearl, but nothing beyond this is suggested thereby. The term is thus an excellent trademark which sufficiently acts as a sign capable of distinguishing the goods of one enterprise from those of other enterprises, fulfills a function of indicating the source, and also serves as an advertisement of the trademark.

More specifically, out of the character elements that the demandee uses in the sampling tool, the part of "パール (pearl)" is the term which is sufficiently distinctive in relation to the product "tobacco", and thus it is deemed that the part of "パール (pearl)" is the trademark portion that is conspicuous to customers and dealers.

In this regard, there exists the judicial precedent in which the judgment has been made, i.e., "there is no reason to understand that one sign applied to a product always fulfills a single function. Even if it is possible to understand that the sign indicates the function of the product, it is possible to understand that the indication concerned is also the trademark that is applied for distinguishing the goods of one enterprise from those of other enterprises" (Evidence B No. 19).

When considering this case in a similar way, even if "パールフィルター (pearl filter)" may be suggestive of the designated goods, it is possible to understand that the indication thereof is also the trademark that is applied to distinguish the goods of one enterprise from those of other enterprises. Thus, "パールフィルター (pearl filter)" should be considered to indicate a part of the product "tobacco", and at the same time is the trademark that acts as a sign capable of distinguishing the goods of one enterprise from those of other enterprises. Furthermore, the terms "キラキラきらめく (glittering and sparkling)" and "フィルター (filter)" can be considered not to be distinctive or have extremely low distinctiveness in relation to the designated goods, and thus the trademark "パール (pearl)" should be considered to be used.

c. There is no necessity to combine "パール (pearl)" and other element.

The part of "キラキラきらめく (glittering and sparkling)" in "キラキラきらめく／パールフィルター (glittering and sparkling/pearl filter)" and "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is assumed to be

a term serving as an adjective which produces the effect of reinforcing "an image of brilliancy like pearl" that the trademark "パール (pearl)" implicitly suggests. More specifically, the term "パール (pearl)" alone vaguely suggests the meaning such as "an image of brilliancy like pearl" or "an image of blink". Moreover, the addition of "キラキラきらめく (glittering and sparkling)" intensifies the image in question, and thus customers and dealers who are in contact with this envisage the image of the product "tobacco" in which the trademark of this case is used, which contributes the business dealing. More specifically, it should be considered that the part of "キラキラきらめく (glittering and sparkling)" is an additional part that reinforces the image of the trademark, and the part of "パール (pearl)" is the part of the trademark with distinctiveness which has customer attracting power. While it is possible to regard the phrase as being used adjectively in its entirety, the term "パール (pearl)" does not express directly the quality and contents. Instead, "パールフィルター (pearl filter)" is a separate trademark, and the rest is merely an adjective which expresses "パールフィルター (pearl filter)" figuratively.

Furthermore, the term "フィルター (filter)" indicates a filter of a cigarette. This term refers to a part of a cigarette, and also is used as the designation referring in general to filter-tipped cigarettes. There is a variety of cases of the trademark registrations, and the term in question is accepted as the indication of designated goods (Evidence B No. 20 to Evidence B No. 22).

There are many cases where the designation of "XX filter" is used not as the trademark for a filter of a cigarette, but the name of a cigarette, and thus such cases should be regarded as the indication (abbreviation) of "filter-tipped cigarette". More specifically, this is an adjective expressing quality and type of a cigarette, which is not capable of distinguishing in relation to the product.

"パール(Pearl)" is the term that acts as the distinctive trademark, and "フィルター (filter)" is the part of generic name of a filter-tipped cigarette. Therefore, "パール (pearl)" and "フィルター (filter)" are recognized separately, and it is determined that the part of "パール (pearl)" is the trademark which has customer attracting power. It is thus considered that the part of "パール (pearl)" contributes to the business dealing of "filter-tipped cigarette" of customers and dealers who are in contact with this.

Incidentally, in light of the aspect of the sampling tool, it is natural to think that "パール (pearl)" is not the trademark used in the product "filter", but the trademark used in "tobacco" (especially "filter-tipped cigarette").

In view of the aspect of use in Evidence B No. 1 to Evidence B No. 3, it is deemed that the term "パール (pearl)" can be evaluated as being used as the trademark independently. More specifically, it is sufficiently possible to consider that "キラキラきらめく＼パールフィルター (glittering and sparkling/pearl filter)" and "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" reveal that the part of "パール (pearl)" is independently recognized by customers and dealers as the trademark capable of distinguishing the goods of one enterprise from those of other enterprises, and thus contributes to the business dealing.

d. Identity from Common Sense

The scope of identity from common sense in a trial for revocation of a registered trademark not in use has to be determined in conformity with the actual status of business dealing taking the actual status of use of the trademark into consideration.

It is the actual status of business dealing which is conducted in general business dealings that the generic name of the product is added as the actual status of use. In this case, it is an aspect which can be commonly conceived in general that the characters of "フィルター (filter)", which is an abbreviation of "filter-tipped cigarette", are added to the trademark of this case "パール (pearl)" to use "パールフィルター (pearl filter)" as the trademark of a cigarette. This is the natural usage that does not fall under the use of the mark in a modified form.

A lot of other modifiers are applied to the trademark indicated in the evidence of use of this case, however, it can be considered to be the use of the trademark of this case within the scope of identity from common sense.

(2) Answer against Rebuttal

The demandee states in the written answer that the term "パール (pearl)" written in each of evidences submitted as those proving the actual use of the trademark of this case is not merely a modifier that the demandant asserts. Furthermore, in the advertisement of a cigarette in which the term "パールフィルター (pearl filter)" is used (the sampling tool),
the term "パール (pearl)" is considered to sufficiently act as a sign capable of distinguishing the goods of one enterprise from those of other enterprises. "パール (Pearl)" intrinsically cannot be a modifier, and thus is the trademark with sufficient distinctiveness.

a. The term indicating the quality of goods does not act as a sign capable of distinguishing the goods of one enterprise from those of other enterprises without explaining in detail, and thus is not registered as a trademark during the examination

stage. Furthermore, even if the term indicating the quality of goods is used, the term in question does not have distinctiveness, and thus the term is not extracted to contribute to business dealing. The demandant asserts that "パール (pearl)" is a modifier, however, the assertion is unfounded if the demandant understands that the term in question is the term indicating the quality of goods because it is a modifier.

In order to assert that a term indicates the quality of goods, the term in question should be familiarly known as the term indicating the quality and the like of the product concerned, direct and specific, and commonly used. However, "パール (pearl)" merely means "pearl" (Kojien, sixth edition), and thus is not contained in the dictionary as meaning the quality and the like of a cigarette. Furthermore, it can be said that the term is the term indicating the quality of goods when commonly used as a term indicating the quality of the product. However, no case can be found that "パール (pearl)" is commonly used as the term indicating the quality of a cigarette. No case of using the term in question as indicating the quality of goods can be found at all even in web search. Incidentally, there is no case of containing pearl powder, and also there is no circumstance in which the characters of pearl are in common currency as common color presentation.

Considering this, it has to be determined that the trademark "パール (pearl)" is the term with distinctiveness when used in the product "tobacco". If the term "パール (pearl)" is used in the sampling tool, it is definitely possible that customers and dealers who are in contact with this resultingly take note of the portion of the term with distinctiveness, which contributes to the business dealing. Furthermore, experience explicitly shows that the term in question is not regarded as the term to which free use is definitely permitted as being the term indicating the quality of goods.

Furthermore, considering the aspect of use of the trademark "パール (pearl)" by the demandee (Evidence B No. 1 to Evidence B No. 3), the term in question may implicitly suggest the vague meaning of "an image of brilliancy like pearl", but it cannot be considered at all that the quality of the product "tobacco" is indicated directly and specifically. Accordingly, it cannot be said that the term "パール (pearl)" is the term indicating the quality of the product "tobacco".

Considering the matters discussed above, it is natural to think that "パール (pearl)" used in Evidence B No. 1 to Evidence B No. 3 is used by fulfilling the role of double trademark in the aspect acting as a sign capable of distinguishing the goods of one enterprise from those of other enterprises, and thus is not used at least the term indicating the quality of the goods.

b. The demandant asserts that the name of cigarette of this case is not "パールフィルター (pearl filter)" but "ピアニッシモ・スーパースリム (Pianissimo Super Slim)". However, the assertion is false in the first place in that it is built on premises that the "trademark" is single, and the use of other name does not fall under the use of a trademark.

More specifically, in the current business dealing, there is of course the trademark like a subtitle other than the formal product name which fulfills the function of indicating the product to give customers and dealers an image of the product. Furthermore, experience explicitly shows that it is a common practice in the current business dealing that one product to which a plurality of trademarks is affixed is distributed for business dealing.

In this case, there is absolutely no objections to the fact that the product name is "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", and it is obvious that "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" is appeared in the advertisement (sampling tool) as the trademark in the aspect of fulfilling the function of distinguishing the goods of one enterprise from those of other enterprises, and the function of indicating the source of the product. On the other hand, the trademark "パール (pearl)" does not directly and specifically express the quality of the product "tobacco", but is used along with "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" as the trademark suggestive of the image thereof.

Considering the matters discussed above, the aspect of use in Evidence B No. 1 to Evidence B No. 3 shows that "パール (pearl)" is independently used as the trademark of the product "tobacco".

Furthermore, Evidence B No. 1 to Evidence B No. 3 are obviously the advertisement of a cigarette. It is conversely unnatural that, in the aspect of use of the trademark "パール (pearl)" for the sampling tool of this case, the trademark "パール (pearl)" is regarded to be used for a cigarette filer. More specifically, it have to be considered that, in the sampling tool of this case, the term "パール (pearl)" is used not for the product "filter" but for the product "tobacco" in the aspect of acting as a sign capable of distinguishing the goods of one enterprise from those of other enterprises. The aspect of use of the trademark of this case is thus the use that falls under Article 2(3)(viii) of the Trademarks Act.

No. 5 Judgment on the body

1. Each of Evidences submitted by the demandee (the owner of a trademark right) reveals the facts as follows.

(1) Evidence B No. 2 is "the advertising board". Page 1 thereof includes the logo "JT" in the upper left section, a picture of a woman wearing gold lipstick at the center thereof, and the phrases "キュッと極細スリム。／ピアニッシモ／スーパースリム (extra-fine slim./Pianissimo/Super Slim; compactly super slim./Pianissimo/Super Slim)", "２０１０年１１月上旬より全国販売 (on sale in early in November 2010 in Japan)", "PIANISSIMO", and "Super Slims Menthol ONE" in the lower section thereof.

Gold color is applied to about one-sixth of the upper side of page 2 of Evidence B No. 2. Furthermore, when page 1 of Evidence B No. 2 is turned, there is the three-dimensionally pop-up product sample of a "filter-tipped cigarette" on page 2, and the phrases "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" in gold are applied on the right side of the product sample with relatively-large characters vertically in two stages. Moreover, the phrases "だから、手元・口元にも (so it is ... to hand and lips)" and "優しく、キレイ。 (tender and attractive)" in smaller-sized silver colored characters are applied therebelow vertically in two stages.

(2) Evidence B No. 4 is "the material regarding the execution of the advertising activity". Page 1 thereof includes the logo "JT" in the upper left section, a picture "filter-tipped cigarette" at the center thereof, and the description "2010.10.18" in the lower section thereof.

Page 2 of Evidence B No. 4 includes the text with the headline "Introduction" stating that "in order to successfully perform this promotion activity, it is absolutely necessary for all members of the staff to recognize yourselves during the campaign (sampling activity) as being a member of JT who has developed this new product so as to perform the activity with correct knowledge of the product...".

Page 3 of Evidence B No. 4 includes "distributing material" and "●リーフレット (● leaflet)" in the upper left section, the logo "JT" in the upper right section from the "リーフレット (leaflet)", and the picture of "filter-tipped cigarette" at the center thereof. The phrases "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" in gold are applied on the right side of the picture with relatively-large characters vertically in two stages. Moreover, the phrases "だから、手元・口元にも (so it is ... to hand and lips)" and "優しく、キレイ。 (tender and attractive)." in smaller-sized silver colored characters are applied therebelow vertically in two stages.

(3) According to the assertion by the demandee, Evidence B No. 5 is "the pictures which shows the situation of the advertising activity". In Evidence B No. 5, the

picture on the extreme left in the upper row and the picture on the extreme right in the upper row show that a person who seems to be a member of the staff of the company D shows the customer of restaurant in the store of the restaurant "the advertising board" shown in page 1 of Evidence B No. 2 in which a woman wearing gold lipstick appears at the center.

Furthermore, in Evidence B No. 5, the picture at the center in the upper row and the picture in the lower row shows that a person who seems to be a member of the staff of the company D shows the customer of restaurant in the store of the restaurant "the advertising board" shown in page 2 of Evidence B No. 2 in which gold color is applied to about one-sixth of the upper side and it is possible to visually recognize the sample of a "tobacco" which seems to three-dimensionally pop up.

(4) Evidence B No. 11 is the document titled "certification regarding the use of advertising materials using the trademark 'パール (pearl)'" signed and sealed by a board director of the company D, which includes the description as "certified matter", i.e., "the company D (Address ...) ... under the commission from Japan Tobacco Inc. (Address ...), in Tokyo, Osaka, and Nagoya from October 22 to November 13 in 2010..."

2. The decision shall be made based on the findings above.

(1) Regarding User, Used product and Period of Use

"The advertising board" in Evidence B No. 2 (pages 1 and 2), "the material regarding the execution of the advertising activity" in Evidence B No. 4 (paged 1 to 3), "the picture of the advertising activity" Evidence B No. 5, and "certification regarding the use of advertising materials using the trademark 'パール (pearl)'" in Evidence B No. 11 reveal that, under the commission from the owner of a trademark right, all members of the staff of the company D has realized themselves as being a member of the owner of a trademark right who had developed the new product in question, so as to display or distribute (give away) the advertisement in relation to the product "tobacco" stating "on sale in early in November 2010 in Japan", on which the sign of the laterally-written phrases "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" written horizontally and provided vertically in two stages are affixed, in Tokyo, Osaka, and Nagoya from October 22 to November 13 in 2010.

The company D has performed the act of use under the commission from the owner of a trademark right, upon all members of the staff realizing themselves as being a member of the owner of a trademark right who had developed the new product in question. Therefore, even if an agreement regarding a right of non-

exclusive use of the trademark of this case is not clearly specified in the agreement or the like, it is reasonable to understood that the owner of the trademark of this case has implicitly agreed to a right of non-exclusive use regarding a right of non-exclusive use with respect to the company D.

Accordingly, the company D is recognized to be the owner of a right of non-exclusive use of the trademark of this case.

(2) Regarding Used Trademark

In "the advertising board" in Evidence B No. 2 (page 2) and "the material regarding the execution of the advertising activity" in Evidence B No. 4 (page 3), the phrases "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" written with relatively large-sized gold-colored characters are provided vertically in two stages. Moreover, the phrases "だから、手元・口元にも (so it is ... to hand and lips)" and "優しく、キレイ。 (tender and attractive)" written with smaller-sized silver-colored characters are provided therebelow.

It is understood that the parts of the characters "だから、手元・口元にも (so it is ... to hand and lips)" and "優しく、キレイ。 (tender and attractive)" applied with smaller-sized silver-colored characters express the characteristic of the product "tobacco" in which hand and lips seems to be tender and attractive. It thus can be said that the parts in question do not acts as a sign capable of distinguishing the products of one enterprise from those of other enterprises.

Furthermore, the parts of the characters "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" are provided vertically in two stages, and thus may be visually recognized in a separated fashion.

Then, there cannot be found any special circumstances in which the parts of the characters "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)" should be regarded as expressing familiarized established concept by the entire configuration thereof.

Furthermore, the demandant has stated in the written rebuttal that, for example, "two phrases serving as modifiers ('キラキラ (glittering)' and 'きらめく (sparkling)')" and "modifier such as 'キラキラ (Glittering)' and 'きらめく (sparkling)' are expressed figuratively" so as to agree that the parts of the characters "キラキラ (glittering)" and "きらめく (Sparkling)" are the wordings (terms) acting as modifiers.

Considering this, with regard to the parts of the characters "キラキラきらめく (glittering and sparkling)" and "パールフィルター (pearl filter)", it cannot be said that a viewer always recognizes the parts of the characters "キラキラきらめく

(glittering and sparkling)" and "パールフィルター (pearl filter)" are integral with each other. It thus can be said that the part of the characters "パールフィルター (pearl filter)" is visually recognized and grasped independently, and thus acts as a sign capable of distinguishing the products of one enterprise from those of other enterprises.

Furthermore, in the part of the characters "パールフィルター (pearl filter)", the part of the characters "filter" indicates in relation to the product "tobacco" to be used that the cigarette in question is the product with a filter tip, and does not act as a sign capable of distinguishing the products of one enterprise from those of other enterprises. It thus can be said that the part of the characters "パール (pearl)" has the function of a sign capable of distinguishing the products of one enterprise from those of other enterprises.

Therefore, the part of the characters "パール (pearl)" in the part of the characters "パールフィルター (pearl filter)" is the trademark that yields the pronunciation of "paaru" and the concept of "pearl", which is identical with the trademark of this case, and thus is a trademark that is deemed as identical from common sense with the trademark of this case.

3. Interim Summary

Based on the discussion above, the company D who is the owner of a right of non-exclusive use has displayed or distributed the advertisement in Japan relating to the product "tobacco" with a trademark that is deemed as identical from common sense with the trademark of this case put thereon from October 22 to November 13, 2010, which is within the period of requiring proof. This is thus recognized as display or distribution of the advertisement to which a registered trademark is affixed provided in the Article 2(3)(viii) of the Trademarks Act.

4. Summary

Considering the discussion above, it should be said that the demandee has proved that the owner of a right of non-exclusive use has used the trademark in this case in Japan in connection with the designated goods pertaining to the request within three years prior to the registration of the request for the trial of this case.

Accordingly, the registration of the trademark of this case cannot be cancelled under the provision of Article 50 of the Trademarks Act.

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

March 19, 2013

Chief administrative judge: WATANABE, Kenji

Administrative judge: MAEYAMA, Ruriko

Administrative judge: YAMADA, Hiroyuki