

Trial Decision

Revocation No. 2012-300403

Switzerland

Demandant

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The Tokyo High Court has rendered the judgment for cancelling the trial decision (2013 (Gyo-ke) No. 10164 (Judgment: December 25, 2013)) against the trial decision dated on March 19, 2013 on the case a recession of the Trademark Registration No. 2523496 between the parties listed above. Therefore, as a result of further examination, the trial decision shall be rendered as follows.

Conclusion

The trademark registration No. 2523496 shall be cancelled.

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

Reasons

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

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 requested the trial decision same as the conclusion, and stated the following reasons therefor (the summary thereof is as follows) with Evidence A No. 1 to Evidence A No. 4 submitted as means for 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. Rebuttal

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

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 which expresses the "filter" indicating that the filter is shiny like pearl.

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 sparklingtip 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 (Kira Kira)" 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.

(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.

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 "ピアノッシモ・スーパースリム (Pianissimo Super Slim)", and thus it is impossible to discuss those filters in the same way as "pearl filter". "ピアノッシモ・スーパースリム (Pianissimo Super Slim)" employs "きらきら光るチップペーパー (Kira Kira Hikaru Tip Paper; glittering tip paper)" in the filter portion thereof. It is thus obvious that "パール (pearl)" is 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 thereof glitters, and is not used as a distinctive mark like "Peace", "Winston", and "Camel".

In the first place, the phrase "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" is written along with the phrases describing the characteristics of the product "ピアノッシモ・スーパースリム (Pianissimo Super

Slim)", such as "キュッ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.

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 "ピアノッシモ・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)" is not used as a trademark, but merely an adjective which indicates that the filter portion of "ピアノッシモ・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.

(4) Counterargument against Assertion by Demandee

The fact that the term "パール (pearl)" is capable of distinguishing in relation to the designated goods such as tobacco 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. 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.

It must be said that the discussion of the matter in question by the demandee is ambiguous and inappropriate. 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.

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., "ピアノッシモ・スーパースリム (Pianissimo Super Slim)". In either way, there is no ground at all for the discussion of this time by the demandee in this case, i.e., as if "パールフィルター (Pearl Filter)" is equivalent to "Peace Long Filter" or the like which is the product name (trademark) if the product name is not "pearl filter" but "ピアノッシモ・スーパースリム (Pianissimo Super Slim)", and thus we are convinced that the assertion thereof is unreasonable.

No. 3 Gist of Inquiry to the Demandee

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). However, in the case in question, the characters "パール (pearl)" are not used independently, and thus this is the different aspect from the trademark of this case. Therefore, it cannot be said that this is the trademark that is deemed as identical from common sense with the trademark of this 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.

No. 4 Assertion by the Demandee

The demandee has answered so as to demand the trial decision in which the trial of the case was groundless, and the costs in connection with the trial shall be borne by the demandant, and stated in the written answer the reasons therefor as follows with Evidence B No. 1 to Evidence B No. 22 submitted as means for evidence.

1. Answer to Demandant's Allegation

(1) Proof of use

a. The demandee has used the trademark of this case in the designated goods within three years prior to the registration of the request for the request for the trial of

this case (hereinafter referred to as "within the period of requiring proof" in some cases).

The demandee has started the sales of "ピアノッシモ・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 "ピアノッシモ・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.

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 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).

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 "ピアノッシモ・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.

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).

c. The submission of each evidence 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

(a) 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 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 isolatedly recognized which is the essential and distinctive part in the trademark and is put to the sampling tool. This contributes to the business dealing.

(b) The demandee recognizes the term "パール (pearl)" as not being a simple modifier that the demandant alleges. It is deemed that, in the advertisement of a cigarette in which the term "パールフィルター (Pearl Filter)" is used (sampling tool), the term "パール (pearl)" is considered to be that sufficiently acts 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.

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 and suggesting 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 objection to the fact that the product name is "ピアニッシモ・スーパースリム (Pianissimo Super Slim)"; although the trademark "パール (pearl)" does not directly and specifically express the quality of the product "tobacco", it 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.

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, this 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 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.

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. It is thus 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. Answer to Inquiry

(1) 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.

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 fulfill 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 "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)" cannot 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.

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

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.

(3) 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.

No. 5 Judgment on the body

1. Each of evidences adduced by the demandee (the owner of a trademark right) and the assertion thereof reveal the facts as follows.

(1) Evidence B No. 1 is a sticker-type advertising leaflet of the product of this case (hereinafter referred to as an "advertisement A of this case"), Evidence B No. 2 is a double-folded advertising board of the product of this case (hereinafter referred to as an "advertisement B of this case"), and Evidence B No. 3 is a copy of an advertising electronic image (hereinafter referred to as an "advertisement C of this case"). The term "パールフィルター (Pearl Filter)" (hereinafter referred to as "used trademark") is affixed to those advertisements (hereinafter referred to as "respective advertisements of this case" in some cases).

Then, the respective advertisements of this case were produced by Hakuhodo Inc. on October 15, 2010 under the commission from the owner of a trademark right, and distributed or used by the company D during the sales promotion event of the product "ピアノッシモ・スーパースリム (Pianissimo Super Slim)" (the product of this case) that has been performed in Tokyo, Osaka, and Nagoya from October 22 to November 23, 2010 also under the commission from the owner of a trademark right.

Therefore, the respective advertisements of this case are recognized to be used by the owner of a trademark right for the advertisement of the product to be dealt with.

(Up to here, Evidences B No. 6 to 11)

(2) Regarding Presence or Absence of Use of The Trademark of Respective Advertisements of This Case

a. Regarding the product of this case

The respective advertisements of this case are the advertisements in relation to the new product of cigarette that the demandee started selling from November 2010 (the product of this case).

The product of this case is a brand belonging to the group of products referred to as "Pianissimo Family", in which each product have the product name of "ピアノニッシモ (Pianissimo)".

b. Regarding the package of the product of this case

The respective advertisements of this case contain the picture of the package of the product of this case.

The front surface of the package of the product of this case (the surface that the respective advertisements of this case contain) shows the characters of "PIANISSIMO", "Super Slims", "Menthol", and "ONE" provided in four stages in a vertical manner at the center thereof. Out of these, the characters "PIANISSIMO" are shown in the largest font, and the characters of "Super Slims" are shown in the second largest font. However, the package of the product of this case does not show "パール (pearl)" and "PEARL".

c. Regarding the advertisement A of this case

The advertisement A of this case is a sticker-type advertising leaflet of the product of this case (Evidence B No. 1).

This contains the picture of the package and cigarette of the product of this case largely shown in the approximate center thereof. The characteristics of "キュッと極細スリム。 (. compactly super slim)", "PIANISSIMO", and "「美しさの新・スタイル ピアノニッシモ・スーパースリム (New Style of Beauty, Pianissimo Super Slim)" are provided vertically in three stages in the upper section of the picture in the most prominent aspect. The phrases "キュッと詰まったメンソール (compactly filled menthol)", "キラキラきらめく (Glittering and sparkling)", "パールフィルター (Pearl Filter)" (two stages in vertical manner), and "におい・煙り少ない (producing less smell and smoke)", "20本入りなのに (while 20 pieces contained)", "「コンパクト (Compact)" (two stages in vertical manner) are provided clockwise from the upper left section in a manner that surround the aforesaid picture section. Each of the phrases is shown like headline in the second prominent aspect following a symbol like a star, and a few lines of advertising copy of the product is written in a small font below the phrase.

d. Regarding the advertisement B of this case

The advertisement B of this case is a double-folded advertising board of the product of this case (Evidence B No. 2).

The front cover thereof contains a large picture of a woman wearing gold lipstick at the center thereof, and shows the phrases "キュッと極細スリム。(compactly super slim)", "ピアニッシモ (Pianissimo) ", "スーパースリム (Super Slim)", "2010年11月上旬より全国発売 (on sale in early in November 2010)", "PIANISSIMO", and "Super Slims Menthol ONE" provided in six stages vertically in the lower section thereof. Out of these, the phrases "ピアニッシモ (Pianissimo)" and "スーパースリム (Super Slim)" are shown in the largest font, and the phrases of "PIANISSIMO" are shown in the second largest font. It thus can be recognized that these are the main brand of the product of this case.

Furthermore, the three-dimensional pop-up design is applied to the upper half of the inner surface of the advertising board in question in which the package and cigarette of the product of this case are popped up when the board is opened. The background thereof contains the phrases "ピアニッシモから (From Pianissimo)" and "極細スリムサイズ新登場!! (Ultra-slim size debut!!)" provided on the upper section thereof vertically in two stages in a large font, and the phrases "New! 美しさの新・スタイル (New! New Style of Beauty)" provided on the lower section thereof vertically in two stages in a larger font. The phrases "キュッと詰まったメンソール (compactly filled menthol)", "キラキラきらめく (Glittering and sparkling)", "パールフィルター (Pearl Filter)" (two stages in vertical manner), "におい・煙り少ない (producing less smell and smoke)", "20本入りなのに (20 cigarettes inside but)", "コンパクト (Compact)" (two stages in vertical manner) are provided clockwise from the upper left section in a manner that surround the package and cigarette described above. Each of the phrases is shown like headline in a middle-sized font following a symbol like a star, and a few lines of advertising copy of the product is written in a small font below the phrases.

e. Regarding the advertisement C of this case

The advertisement C of this case is copy of an advertising electronic image of the product of this case (Evidence B No. 3).

This contains the picture of the package and cigarette of the product of this case largely shown on the left section thereof. The phrases "PIANISSIMO" and "Super Slims Menthol ONE" are shown vertically in two stages on the upper right section of the picture. The phrases "極細スリムサイズ (extra-fine slim size)", "キュッと詰まったメンソール (compactly filled menthol)", "キラキラきらめくパ

ールフィルター (glittering and sparkling pearl filter)", and "におい・煙り少ない 1 mg (producing less smell and smoke 1mg)" are shown therebelow like headline in a middle-sized font following a symbol like a star, and a few lines of advertising copy of the product is written in a small font below the phrases.

2. Judgment

(1) As recognized in the section 1.(2) above, the product of this case is a cigarette whose product name is "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", and the front cover of the package of the product of this case contains the phrase "PIANISSIMO" shown in the largest font expressing the name of the product of this case in alphabets, whereas not showing the phrases "パール (pearl)" or "PEARL".

Then, the respective advertisements of this case also contain the phrases "PIANISSIMO", "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" (the advertisement A of this case), "ピアニッシモ (Pianissimo)" and "スーパースリム (Super Slim)" (the advertisement B of this case), and "PIANISSIMO" (the advertisement C of this case) in a large font in the most eye-catching section.

In contrast, "パールフィルター (Pearl Filter)" shown in the respective advertisements of this case is shown in a middle-sized font at the subheading-like position, and one or a few lines of advertising copy are written therebelow. Then, "キラキラきらめくパールフィルター (glittering and sparkling pearl filter)" (two stages in vertical manner, or a single line) in the respective advertisements of this case is shown in an aspect like a subheading and in a font whose size is similar to "キュッと詰まったメンソール (compactly filled menthol)", "におい・煙り少ない (producing less smell and smoke)", and "20本入りなのにコンパクト (20 cigarettes inside but compact)" (two stages in vertical manner, or a single line).

Then, it is possible to recognize that there is a case in cigarette industry where "〇〇フィルター (xx filter)" is used as a brand of filter-tipped cigarette, and the existing examples are "Winston Filter", "Camel Filter", etc., which are the brands with a large quantity in worldwide sales; "パールフィルター (Pearl Filter)" in the respective advertisements of this case is shown in a moderately prominent aspect in the respective advertisements of this case as recognized above, though not to the extent of "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" or "PIANISSIMO" which is the main brand of the product of this case; compared to "キュッ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)", and "におい・煙り少ない (producing less smell and smoke)" which are shown in the similar level, the phrase in

question is not only the simple explanation of detail and shape of the product, but the designation of the product of this case, which is a filter-tipped cigarette having the characteristic in that the filter thereof is shiny and glossy like pearl, as "パールフィルター (Pearl Filter)" so as to develop the advertising activity thereof ("キラキラきらめく (Glittering and sparkling)" is shown as a modifier expressing "パールフィルター (Pearl Filter)" figuratively).

Considering the facts discussed above, it is reasonable to recognize that the demandee has given the product of this case the product name "ピアニッシモ・スーパースリム (Pianissimo Super Slim)" as the brand strategy to emphasize the trademark "PIANISSIMO", and also employed the secondary brand "パールフィルター (Pearl Filter)" which may be derived from the characteristic of the product of this case, i.e., the cigarette which is shiny and glossy like pearl.

For reasons described above, it is recognized that the demandee has used "ピアニッシモ・スーパースリム (Pianissimo Super Slim)", "PIANISSIMO", or the like in the respective advertisements of this case in the advertisement as the main brand of the product of this case so as to make and dealers and customers discriminate the product of this case from other products by means of the trademarks in question, while the mark "パールフィルター (Pearl Filter)" has been used in the respective advertisements of this case as the secondary brand expressing the characteristic of the product of this case.

(2) Next, the determination will be made regarding whether or not it can be said that the trademark "パールフィルター (Pearl Filter)" in the respective advertisements of this case is a trademark that is deemed as identical from common sense with the trademark of this case.

As discussed in the section No. 1 above, the trademark of this case is composed of the phrases "PEARL" and "パール (pearl)" provided in two stages.

In contrast, the term "フィルター (filter)" in "パールフィルター (Pearl Filter)" in the respective advertisements of this case denotes a filter of a cigarette that is the designated goods pertaining to the trademark of this case, and the term itself is not capable of distinguishing when used for a filter-tipped cigarette.

Then, since the term "パール (pearl)" has been known to Japanese people as the Katakana notation of the English word meaning pearl, the term in question may be a trademark capable of distinguishing the goods of one enterprise from those of other enterprises, when used in the product of cigarette.

However, as recognized in the section (1) above, in the respective advertisements of this case, "パール (pearl)" is merely used as a part of "パールフ

イルター (Pearl Filter)" which is the secondary brand of the product of this case. Since the trademark "パールフィルター (Pearl Filter)" is used as the secondary brand of the product of this case, dealers and customers recognize and grasp the phrase in question as being inseparable, and do not recognize and grasp merely "パール (pearl)" separately.

Therefore, it cannot be said that the trademark "パールフィルター (Pearl Filter)" used in the respective advertisements of this case is the trademark that is identical from common sense with the trademark of this case.

(3) According to the above, it cannot be recognized that the trademark of this case is used in the respective advertisements of this case.

3. Summary

Considering the discussion above, it cannot be recognized that the demandee has proved 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 pertaining to the request for revocation within three years prior to the registration of the request for the trial of this case, and also has not explicitly show that there is a justifiable reason for the trademark of this case not being used.

Accordingly, the registration of the trademark of this case shall be cancelled under the provision of Article 50 of the Trademarks Act.

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

September 22, 2014

Chief administrative judge: KOBAYASHI, Yumiko

Administrative judge: OMORI, Kenji

Administrative judge: NISHIDA, Yoshiko