

Appeal decision

Appeal No. 2014-26122

Osaka, Japan

Appellant

SUZUKI, Hideyuki

Osaka, Japan

Patent Attorney

SATO, Tominori

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2014-28728 has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reason

No. 1 The trademark in the Application

The trademark in the Application is configured as indicated in Attachment 1, and the application for its registration was filed on April 14, 2014 by setting Class No. 18 "Handbag frames; purse frames; horseshoes; clothing for domestic pets; bags and the like; pouches and the like,;vanity cases; umbrellas and their parts; walking sticks;canes; metal parts of canes and walking-sticks; handles of canes and walking-sticks." as the designated goods.

No. 2 Notice of reasons for refusal by the body

Notice of reasons for refusal as described below such that the trademark in the Application falls under Article 4(1)(xix) of the Trademark Act was notified to the appellant on April 30, 2015. The opinion on this was requested within a specified period of time.

1. The trademark in the Application is configured as indicated in Attachment 1. According to the investigation by ex officio in the body indicated in Attachment 2, the trademark which consists of void Alphabetic characters "HOOD," "BY," and "AIR." are horizontally written in three stages in a black horizontally long rectangle, in a slightly vertically long manner, and in bold Gothic script, and start points of the

letters are vertically aligned (letters horizontally written in three stages are referred to as "trademark of Hood By Air" below) ,which has been known by traders and consumers for a certain extent such that "Hood by air licensing limited liability company" (referred to as "Hood By Air" below) displays the origin of goods (Hood by air) such as clothing including a long-sleeved shirt and the like in the United States. Then, the trademark in the Application has many common parts as and resembles trademark of Hood By Air. It cannot be acknowledged that the trademark in the Application just happens to coincide with the trademark of Hood By Air when the appellant employs the trademark in the Application.

2. Therefore, the trademark in the Application takes advantage of the fact that the trademark of Hood By Air has not been registered, and the application of the trademark in the Application is filed as plagiarizing the trademark of Hood By Air for the purpose of registering the trademark. Therefore, it has to be said that the trademark in the Application is used for unfair purposes. The trademark in the Application falls under Article 4(1)(xix) of the Trademark Act.

No. 3 Opinion of appellant on notice of reasons for refusal of body (summary)

1. Regarding Cited trademark, at the time of applying for the registration of the Trademark of the trademark in the Application (on April 14, 2014), evidence materials indicated in the notice of reasons for refusal do not have objective evidence enough for supporting that "the trademark of Hood By Air has been known as the trademark of goods such as a T-shirt and pants at the time of filing the present application in the United States."

2. The appellant has ordered logos of "HOOD BY AIR." to a designer company and has employed the trademark in the Application from among the logos. Since, the appellant has not known of the existence of the trademark of Hood By Air in the United States, the trademark in the Application is not used for unfair purposes.

No. 4 Judgment by the body

1. Regarding the trademark in the Application

The trademark in the Application is configured as indicated in Attachment 1. In the trademark in the Application, the Alphabetic characters "HOOD," "BY," and "AIR." are horizontally written in three stages, in a slightly vertically long manner, and in bold Gothic script, and start points of the letters are vertically aligned. Accordingly, the trademark in the Application gives rise to the pronunciation of "fuudobaiea" or "fuddobaiea"as whole characters. Next, although the Alphabetic

characters "HOOD," "BY," and "AIR" configuring the trademark in the Application respectively have meanings of "頭巾(Zukin;a hood)" "～によって(～Niyotte;by)" and "空気 (Kuuki;air) " or the like as English words, it is not acknowledged that the whole configuration forms a specific meaning as a phrase. Therefore, it is acknowledged that the trademark in the Application is a coined term which does not have a specific idea and the combination of characters has a constitutional distinguished feature.

2. Regarding publicity of the trademark of "Hood By Air"

According to information indicated in Attachment 2 notified in the reasons for refusal by the body as indicated in No. 2, the following facts are recognized.

- (1) The trademark of "Hood By Air" is established by Shayne Oliver and Raul Lopez as a fashion brand in New York, U.S. in 2006 (Attachment 2 (1) and (2)).
- (2) After that, although the brand once stopped activity, the brand newly started sales since 2012. On February 10, 2014, fall winter collection 2014 was released in New York fashion week. In the fashion news site for informing the result, the trademark of Hood By Air which is written in the void characters in a black horizontally long rectangle, and goods such as clothing are introduced (Attachment 2 (3) to (5)).
- (3) The goods of the brand were exported to Japan in December, 2013, and round-necked and long-sleeved shirts on which the trademark of Hood By Air is printed have been sold (Attachment 2 (3)).
- (4) In the United States, Hood by air filed the application for the registration of the trademark, in which the trademark of Hood By Air is written in the black vertical long rectangle, on July 29, 2013 before the application of the trademark in the Application (Attachment 2 (6)).
- (5) According to the above, the trademark of "Hood By Air." was established in New York, U.S. in 2006. It can be acknowledged that "the trademark of Hood By Air" and the series of trademarks of "HOOD BY AIR." have been known by traders and consumers to a certain extent as the trademarks indicating the origin (Hood by air company) of the clothing such as long-sleeved shirts in the United States at least in February in 2014 before the filing of the trademark in the Application.

3. Regarding similarity of the trademark in the Application to the trademark of Hood By Air

As indicated in Attachment 1, the trademark in the Application is the trademark in which the Alphabetic characters "HOOD," "BY," and "AIR." are horizontally written in three stages in a slightly vertically long manner and in bold Gothic script

as vertically aligning the start points of the letters. On the other hand, according to Attachment 2, although there is a case where the void characters are used, the trademark of Hood By Air is configured by horizontally writing the Alphabetic characters "HOOD," "BY," and "AIR." in three stages in a slightly vertically long manner and in bold Gothic script as vertically aligning the start points of the respective letters.

Accordingly, the trademark in the Application and the trademark of Hood By Air have the same character structures and are written in three stages as vertically aligning the start points of the letters and are both written in a slightly vertically long manner and in bold Gothic script. It has to be said that the two of them have many common parts and resemble each other in structure.

4. Regarding applicability to Article 4(1)(xix) of the Trademark Act

As described in 2 (5) and 3 above, the trademark in the Application resembles the trademark of Hood By Air which has been widely recognized by traders and consumers in the United States before the filing of the present application.

In addition, in the trademark in the Application is a coined term which does not have a specific idea as indicated in 1 above, and the trademark in the Application has a feature resembling the structure to the trademark of Hood By Air. Therefore, it cannot be acknowledged that the trademark in the Application just happens to coincide with the trademark of Hood By Air when the appellant employs the trademark in the Application.

The designated goods of the present application such as "bags and the like; pouches and the like; umbrellas and their parts; vanity cases" and the clothing and the like which are the goods of "Hood by air" to which the trademark of Hood By Air is attached are both fashion-related goods. Since fashion goods are gathered under a unified brand in recent years, it can be said that these goods have a close relationship with each other and have common traders and consumers. In consideration of these facts, it should be said that the appellant knew well of the existence of the trademark of Hood By Air at the time of filing the application for the registration of the trademark in the Application. It has to be said that the trademark in the Application takes advantage of the fact that the trademark of Hood By Air has not been registered, and the application of the trademark in the Application was filed as plagiarizing the trademark of Hood By Air for the purpose of registering the trademark. Therefore, it has to be said that the trademark in the Application is used for unfair purposes.

Therefore, the trademark in the Application falls under Article 4(1)(xix) of the

Trademark Act.

5 Regarding argument of appellant

The appellant states the opinion as describe in No. 3 relative to the notice of reasons for refusal of the body.

However, it is reasonable to understand that the Article is applied to be one element for determining the existence of "unfair purposes" even when the range of the publicity required in Article 4(1)(xix) of the Trademark Act may determine whether the Article is applied (refer to the determination (Gyo-Ke) No. 97 in 2002 by Tokyo High Court). The trademark of Hood By Air has been recognized as having been known by the traders and the consumers for a certain extent as the trademark displaying the origin (Hood by air) of the clothing such as long-sleeved shirts in the United States as indicated in 2 (5) above.

As described in 1 and 3 above, the trademark in the Application and the trademark of Hood By Air have common letters, and both of them are coined terms which cannot be acknowledged to form a specific meaning as a phrase from the letters. It has to be said that the two trademarks have many common features, and the two trademarks resemble each other. Therefore, it cannot be acknowledged the trademark in the Application just happens to coincide with the trademark of Hood By Air when the appellant employs the trademark in the Application. In addition, the appellant has requested search on the trademark registration to the patent office, FUJISANKAI when the present application was filed. In the prior trademark search results, when words such as "hood by air" were searched for on the Internet, many words used as the trademarks have been found. Therefore, when this falls under the known trademark, it is noted that the appellant has received the report such that there is a possibility that the decision of refusal such that these words conflict with the Trademark is issued. Accordingly, the history in which the appellant has employed the trademark in the Application is not reliable.

Therefore, the argument of the appellant in No. 3 cannot be employed.

6. Summary

Therefore, since the trademark in the Application falls under Article 4(1)(xix) of the Trademark Act, the trademark in the Application shall not be registered.

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

July 23, 2015

Chief administrative judge: TANAKA, Koichi

Administrative judge: HAYAKAWA, Fumihiro
Administrative judge: MAEYAMA, Ruriko

Attachment 1 The trademark in the Application



Attachment 2 Regarding publicity of "HOOD BY AIR"

(1) On the website of "FukuDB," under the caption of "Hood By Air," it is described that "'Hood By Air' is a street fashion brand from NY in the U.S. In 2006, the brand was established by Shayne Oliver and Raul Lopez. Although they initially made original T-shirts for their friends, the brand gradually became popular. The goods of the brand were sold in the select shop 'OPENING CEREMONY' (Manhattan) and 'Colette' (Paris) which are known all over the world".
(<http://www.fukudb.jp/node/26733>)

(2) On the website of "DeepInsideinc.comStore", under the caption of "HOOD BY AIR.," it is described that "the brand from New York is established by the designer 'SHAYNE OLIVER' in 2006. The feature of this premium brand is an original and bold design with an impact, and it is difficult to get the goods of this brand in the world now. The members of 'A\$AP MOB' led by A\$AP ROCKY, RIHANNA, KANYE WEST, and the like regularly use the brand, and worldwide fashion icons use this attracting brand." Also, photographs of T-shirts and pants on which the trademark of Hood By Air is printed are attached.

(http://www.deepinsideinc.com/brand.php?brd_id=542&utm_source=y)

(3) On the website of "NUBIAN," under the captures of "NUBIAN HARAJUKU 150-0001 Shibuya-ku, Tokyo" and "HOOD BY AIR.," void letters "HOOD BY AIR.," "OFFICIAL RELEASE," "12.21 SAT," and "nUBIAN" are displayed in a black square. Under that, the following descriptions are written such that "'HOOD BY AIR.' 2013 FALL WINTER COLLECTION," "December 21, 2013 (Sat) 11:00," "Official sale starts at NUBIAN Harajuku shop!," and "'HOOD BY AIR.' was born in New York by the designer 'SHAYNE OLIVER' in 2006. At that time, NUBIAN was one of two official shops in the world. After that, the brand once stopped its activity and newly restarted the activity since 2012, and this created a big topic all over the world. For the customers who knew NUBIAN at that time, it had been a long time to introduce the brand. The feature of this premium brand, HOOD BY AIR., is an original and bold design with an impact, and it is difficult to get the goods of the brand in the world now." Also, a photograph of the round-necked and long-sleeve shirt, to which the trademark of Hood By Air is printed with yellow or grey letters on a black background, is attached.

(<http://gentslab.nubian-ave.com/2013/12/hood-by-air/>)

(4) In the website of "FABmedia," under the captures of "Hood By Air 2014 FW collection" and "Fashion Posted by staff 2014/02/10," it is described that "Fall winter collection 2014 of the fashion brand Hood By Air (HBA) was released in the New York fashion week. Although the HBA has a strong image of black and white, a new attractive side is shown such as a set-up using denim and suede material in this season. The collection in which the detail to the silhouette of the item such as jeans using many zippers and an over-sized leather jacket are further updated has been shown for the top for combining an over-knee lace-up boots and a gold sneaker shown in the Pre-Fall collection which has been previously released."

(<http://fab-media.net/fashion/12088.html>)

(5) On the website of "Urban Alley," under the captures of "HOOD BY AIR SPRING/SUMMER 2014 COLLECTION," "D.J. MALONE," and "SEPTEMBER 10, 2013," the trademark of Hood By Air with void letters is displayed in a black horizontally long rectangle. Under that, it is described that "Hood By Air recently presented its Spring/Summer 2014 offerings at NewYork Fashion Week."

(<http://urbanalleyblog.com/2013/09/hood-by-air-springsummer-2014-collection/>)

(6) According to the trademark retrieval site of the USPTO (TESS), it is described that "the trademark in which the trademark of Hood By Air is written in void letters in a black vertically long rectangle was applied for on July 29, 2013, as having

the serial No. 86022443, and the designated goods of the trademark have been Class No. 25 "Pants for sports and Shorts for sports and the like." The applicant has been Hood By Air." (This trademark has been already invalidated.)
(<http://www.uspto.gov/trademarks-application-process/search-trademark-database>)