

## Trial Decision

Invalidation No. 2014-890050

Tokyo, Japan

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The case of trial for invalidation of trademark registration of Trademark Registration No. 5244936 between the parties above has resulted in the following trial decision:

### Conclusion

Of the demands for trial of the case, the demand regarding the designated goods in Class 25 among the designated goods of the Trademark on the grounds of Article 4(1)(xi) of the Trademark Act is dismissed. The other demands are groundless.

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

## Reason

### No. 1 The Trademark

The trademark of Trademark Registration No. 5244936 (hereinafter referred to as "the Trademark") has the structure shown in Attachment 1. On November 28, 2008, the application of the Trademark was filed for registration. On May 22, 2009, decision of registration was made, and on July 3, 2009, registration of the trademark right was established for the designated goods in Class 14 "Personal ornaments; keyrings; jewelry cases; semi-wrought precious stones and their imitations; shoe ornaments of precious metal; clocks and watches.", Class 18 "Handbag frames; purse frames; industrial packaging containers of leather; bags and the like; pouches and the like; vanity cases (not fitted); umbrellas and their parts; leather straps; fur.", and Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear; clothes for sports; special footwear for sports."

### No. 2 Cited Trademark

The trademark of Trademark Registration No. 4997944 (hereinafter referred to as "Cited Trademark 1") cited by the demandant in the grounds for invalidation of registration has the structure shown in Attachment 2. On March 9, 2006, the application of Cited Trademark 1 was filed for registration, and on October 20, 2006, registration of the trademark right was established for the designated goods in Class 25 "Non-Japanese style outerclothing; coats; sweaters and the like; shirts and the like; nightwear; underwear; swimwear; swimming caps; Japanese traditional clothing; aprons; collar protectors; socks and stockings other than special sportswear; puttees and gaiters; fur stoles; shawls; scarves; Japanese style socks; Japanese style socks covers; gloves and mittens; fabric diapers for infants; neckties; neckerchieves; bandanas; thermal supporters; mufflers; ear muffs; hoods; straw hats; nightcaps; helmets; headgear for wear; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear; masquerade costumes; horse-riding boots."

Similarly, the trademark of Trademark Registration No. 5155384 (hereinafter referred to as "Cited Trademark 2") has the structure shown in Attachment 3. On October 30, 2006, the application of Cited Trademark 2 was filed for registration, and on August 1, 2008, registration of the trademark right was established for the designated goods in Class 14 "Precious metals; keyrings; personal ornaments (other than cuff links); purses and wallets of precious metal; semi-wrought precious stones and their imitations; unwrought precious stones; clocks and watches.", Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; rawhides;

raw skins; tanned leather; fur.", and Class 25 "Non-Japanese style outerclotthing; coats; sweaters and the like; shirts and the like; nightwear; underwear; swimwear; swimming caps; Japanese traditional clothing; aprons; collar protectors; socks and stockings other than special sportswear; puttees and gaiters; fur stoles; shawls; scarves; Japanese style socks; Japanese style socks covers; gloves and mittens; fabric diapers for infants; neckties; neckerchieves; bandanas; thermal supporters; mufflers; ear muffs; hoods; straw hats; nightcaps; helmets; headgear for wear; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear; masquerade costumes; horse-riding boots.", and is still valid as of now. (Hereinafter, these will be collectively referred to as "Cited Trademarks".)

No. 3 The demand for invalidation trial of August 6, 2012 by the demandant

1 The history of the invalidation trial

On August 6, 2012, the demandant filed the demand for invalidation trial (the case of Invalidation No. 2012-890066. Hereinafter referred to as the "previous trial"), arguing that the Trademark falls under Article 4(1)(xi) of the Trademark Act (the demandant also argues that the Trademark falls under Article 4(1)(x), as the grounds for invalidation).

On December 26, 2012, the trial decision that "the demand for trial of the case was groundless" was made in the previous trial (hereinafter referred to as the "previous trial decision"), and on January 9, 2013, a copy of the decision was sent to the demandant. On February 8, 2013, the previous trial decision was made final and binding, and registration of the trial decision was established (Evidence A No. 1 and Evidence B No. 2).

2 The argument by the demandant regarding applicability to Article 4(1)(xi) of the Trademark Act in the previous trial

The Trademark and Cited Trademark 2 are identical in appearance in that they are composed of a skull head portion and crossed bone fragments, and they are similar in that the skull head portion as a principal part has an elongated head portion, cuts in the right and left sides of the middle head portion, right and left drooping eyes angled downward, a cut in the nose portion, etc.

The Trademark and Cited Trademark 2 have no specific pronunciation or meaning.

Therefore, because the Trademark and Cited Trademark 2 are similar in appearance, and because among the designated goods of the Trademark, the

designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 2, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

### 3 The previous trial decision

The previous trial decision can be summarized as follows. That is, because the Trademark and Cited Trademark 2 can be distinguished clearly in appearance, and because both trademarks have no specific pronunciation or meaning, and thus cannot be compared in pronunciation and meaning, the two trademarks are dissimilar in terms of any of appearance, pronunciation, and meaning. Accordingly, the trial examiner determined that the Trademark does not fall under Article 4(1)(xi) of the Trademark Act, and made the trial decision rejecting the demand (previous trial decision) on December 26, 2012. The trial examiner also made the decision that the Trademark does not fall under Article 4(1)(x) of the Trademark Act (Evidence B No. 2).

The same trial decision was made final and binding on February 8, 2013 (Evidence A No. 1).

## No. 4 The Demandant's Allegation

### 1 Object of the demand

The demandant requested a trial decision that, among the designated goods of the Trademark, registration of the designated goods in Class 14 "Personal ornaments (other than cuff links); keyrings; semi-wrought precious stones and their imitations; clocks and watches.", Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; fur.", and Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." should be invalidated, and that the costs in connection with the trial shall be borne by the demandee. The demandant also explained the grounds for the demand as below and submitted Evidence A No. 1 to A No. 6 as means of proof.

### 2 Statement of the demand

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

##### A Regarding the Trademark

As shown in Attachment 1, the Trademark is composed of the skull head portion and the crossed bone fragments behind the skull head portion, and the skull head portion has a vertically long head, vertical cuts in the right and left sides of the

approximately middle head portion, right and left drooping eyes angled downward, and a cut in the nose portion. Further, in the teeth in the mouth portion, the right and left teeth protrude downward. The Trademark has such an appearance, in which the bone fragments are crossed behind the skull head portion, and the skull head portion is a principal part.

Because the Trademark has the above-noted appearance, it has no specific pronunciation or meaning.

B Regarding the designated goods in Class 25 among the designated goods of the Trademark

(A) Regarding Cited Trademark 1

As shown in Attachment 2, Cited Trademark 1 is composed of a figure part composed of a skull head portion and crossed bone fragments under the skull head portion and a character part under the figure part in which the words "mastermind" and "JAPAN" are described in two layers. The skull head portion of the figure part of Cited Trademark 1 has a vertically long head, vertical cuts in the right and left sides of the approximately middle head portion, right and left drooping eyes angled downward, and a cut in the nose portion. Further, the teeth in the mouth portion protrude downward, and this skull head portion is a principal part of Cited Trademark 1.

(B) Similarity between the Trademark and Cited Trademark 1

Although the Trademark and Cited Trademark 1 are identical in appearance in that they are composed of the skull head portion and the crossed bone fragments, they differ in the position of the crossed bone fragments and the description of "mastermind" and "JAPAN" under the crossed bone fragments.

However, it must be admitted that the Trademark and Cited Trademark 1 are similar in that the skull head portion, which is the principal part, has an elongated head portion, cuts in the right and left sides of the middle head portion, right and left drooping eyes angled downward, a cut in the nose portion, etc.

In addition, Cited Trademark 1 has a very unique appearance in the shape of the skull head portion.

Further, the demandant filed the demand for invalidation trial of Trademark Registration No. 5244937 (Attachment 4. Hereinafter referred to as a "different trademark registration") (Invalidation No. 2012-890067) regarding the designated goods in Class 25 among the designated goods of Trademark Registration No. 5244937 on the ground of existence of Cited Trademark 2, relying on Article 4(1)(xi)

of the Trademark Act as a reason for invalidation of registration.

The demandant's allegation was accepted, and among the designated goods of the different trademark registration, invalidation of registration of the designated goods in Class 25 was made final (Evidence A No. 5).

In the case of the demand for revocation of the trial decision of the invalidation trial of the above-described different trademark registration (Invalidation No. 2012-890067)(2013 (Gyo-ke) 10008. Hereinafter, the above case of the demand for revocation of the trial decision is referred to as a "different trademark registration lawsuit", and the trial for invalidation of trademark registration and the case of the demand for revocation of the trial decision are referred to as "different trademark registration lawsuit trial"), it is judged that a difference in the skull head portion (skull bone portion, eye socket portions, temporal bone portions, nostril portions, cheekbone portions, upper jawbone portion, bone fragment portions) is very minor (Evidence A No. 6).

That is, it must be admitted that the skull head portion, which is the principal part, is similar between the Trademark and Cited Trademark 1.

Although the Trademark and Cited Trademark 1 differ in the position of the crossed bone fragments and in the description of "mastermind" and "JAPAN" under the crossed bone fragments, the basic skull head portion of Cited Trademark 1 is similar to that of the Trademark, and it should be admitted that both trademarks have a confusing appearance to the extent that may cause confusion for traders and consumers, in particular, in the industry of clothing.

C Regarding the designated goods in Class 14 and Class 18 among the designated goods of the Trademark

(A) Regarding Cited Trademark 2

Because Cited Trademark 2 is composed of a structure that is similar to the figure part of Cited Trademark 1, the skull head portion is a principal part, as described in Item B(A) above.

Cited Trademark 2 has no specific pronunciation or meaning.

(B) Similarity between the Trademark and Cited Trademark 2

Although Cited Trademark 2 differs from the Trademark in that it has the description "mastermind" and "JAPAN" under the figure part of Cited Trademark 1, the figure part of Cited Trademark 2 is common to that of the Trademark, and it must be admitted that, for the Trademark and Cited Trademark 2, the skull head portion, which is the principal part of both trademarks, is similar, as described in Item B above.

Although the Trademark and Cited Trademark 2 differ in the position of the crossed bone fragments, they are similar in the basic skull head portion, and it should be admitted that both trademarks have a confusing appearance to the extent that may cause confusion among traders and consumers in the industries, such as bags and the like and personal ornaments.

#### D Summary

As described above, the Trademark and Cited Trademarks are extremely similar in appearance of the skull head portion, which is the principal part of each of them.

Then, among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 1.

In addition, among the designated goods of the Trademark, the designated goods in Class 14 "Personal ornaments (other than cuff links); keyrings; semi-wrought precious stones and their imitations; clocks and watches" and Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; fur." are identical or similar to the designated goods of Cited Trademark 2.

Therefore, among the designated goods of the Trademark, the designated goods in Class 14 "Personal ornaments (other than cuff links); keyrings; semi-wrought precious stones and their imitations; clocks and watches.", Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; fur.", and Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." were registered in breach of Article 4(1)(xi) of the Trademark Act.

#### (2) Conclusion

Because the Trademark falls under Article 4(1)(xi) of the Trademark Act, registration of the Trademark should be invalidated under Article 46 of the same Act.

#### 3 Rebuttal against the Reply

(1) Although, in the written reply of September 1, 2014 (hereinafter referred to as the "written reply"), regarding the demand for invalidation concerning Class 25, the demandee argues that it is an attempt to overturn the invalidation rejecting trial decision that was already made final, and that it conflicts with prohibition of double jeopardy, the demandant submitted, as evidences, Evidence A No. 5 (a dismissal of a final trial in the different trademark registration lawsuit, and a determination of refusal of receipt of the final trial) and Evidence A No. 6 (judgment in the different

trademark registration lawsuit), and did not at least file a demand for trial of the case based on the same evidence. Therefore, the demand for invalidation concerning Class 25 does not fall under double jeopardy, which was explained by the demandee.

In addition, although, regarding the demand for invalidation concerning Class 14 and Class 18, the demandee writes, based on the previous trial decision, that there is no reason for making a different determination of similarity from that for the designated goods in Class 25, as described above, the demandant submitted Evidence A No. 5 and Evidence A No. 6 as evidences and did not at least file the demand for trial of the case based on the same evidence. Therefore, the trial of the case is not an attempt to overturn the previous trial decision, unlike the explanation by the demandee.

(2) Next, the demandee argues, in the written reply, that the different trademark registration lawsuit trial has no effect on the trial of the case. In other words, the demandee argues that because it is admitted, in a different trademark registration lawsuit trial, that the composition of the figure of the combination of the skull with the crossed two bone fragments is, in appearance, a principal part of the trademark, the argument by the demandant that the skull portion is regarded as a principal element is completely unreasonable.

However, in the judgment of the different trademark registration lawsuit (Evidence A No. 6), it is admitted that, regarding the description concerning Difference 2 (the positions of the skull and bone fragments), the difference in the positional relationship between the skull and the bone fragments is very minor under remote observation. As this admits that the difference in the skull portion, which is the principal element for the Trademark and Cited Trademarks, is very minor between the trademark and the cited trademark, the different trademark registration lawsuit trial has an effect on the trial of the case.

#### No. 5 The Demandee's Allegation

The demandee submitted the written reply stating that the demandee requests a trial decision that the demand for trial of the case is groundless and that the costs in connection with the trial shall be borne by the demandant, based on the reasons summarized below, along with Evidence B No. 1 to B No. 11 as means of proof.

1 The demandant's allegation as an attempt to overturn the invalidation rejecting trial decision that was already made final.

(1) Application of Article 167 of the Patent Act applied *mutatis mutandis* under Article 56(1) of the Trademark Act



According to Article 167 of the Patent Act applied mutatis mutandis under Article 56(1) of the Trademark Act, when an invalidation rejecting trial decision has been made final, no one may demand a trial for invalidation on the basis of the same facts and the same evidence (prohibition of double jeopardy).

The point of such a definition is that it is unreasonable to revive a dispute based on the same facts and the same evidences after a trial decision was made final, because parties concerned and participants in a previous trial could have provided all assertions and proof in the previous trial (Japan Patent Office "Industrial Property Law (Industrial Property Right Law) commentary (19th Edition)" (2013)).

Here, among the designated goods of the Trademark, for the goods in Class 25, the invalidation rejecting trial decision (previous trial decision) using Cited Trademark 2 as a cited reference was already made final.

Although, among the designated goods of the Trademark, for the goods in Class 25, the demandant recently filed the demand for invalidation trial using Cited Trademark 1 as a cited reference, this is nothing but an attempt to revive the dispute in the above-described meaning.

That is, as is clear from comparison between Cited Trademark 1 and Cited Trademark 2, Cited Trademark 1 is a trademark obtained by adding the character part "mastermind/JAPAN" under Cited Trademark 2.

Because the demandant merely argues that the principal part of Cited Trademark 1 is the skull head portion, and then that this portion is similar to that of the Trademark, their argument is no different from the argument that Cited Trademark 2 is substantially similar to the Trademark, and such an argument is nothing but an attempt to overturn the previous trial decision.

Furthermore, the argument by the demandant is far from "assertion and proof that could have been fully provided in the previous trial", and the argument is identical to that provided in the previous trial and should certainly be prohibited in light of the present Article.

The term "the same evidences" in Article 167 of the Patent Act, which is applied mutatis mutandis under Article 56(1) of the Trademark Act, means "substantially the same evidences that offer proof to substantiate the facts alleged", and it is understood that "using different means of proof cannot directly be a reason for denying the substantial similarity between the proofs" (Intellectual Property Hearing, March 13, 2014, 2013 (Gyo-ke) 10226), non-substantial differences in means of proof between Cited Trademark 1 and Cited Trademark 2 do not interfere application of the same Article.

(2) The different trademark registration lawsuit trial has no effect on the trial of the case

The demandant argues that because, in the text of the judgment in the different trademark registration lawsuit, it is determined that the difference in the skull head portion is very minor, the Trademark and Cited Trademarks are similar in the skull head portion, which is the principal part of each of them, and that both trademarks are thus similar in the principal part.

However, such an argument is inappropriate.

A The Trademark and the trademark of the different trademark registration (Attachment 4) are different trademarks having different basic constitutions (compositions)

As is obvious at a glance, The Trademark differs from the different trademark registration which is the subject of the different trademark registration lawsuit.

For example, because, in the Trademark, the skull head figure is positioned in the center of the crossed bone fragments arranged in a vertically long X shape, it has the impression that it is vertically long as a whole. Meanwhile, because, in the trademark of the different trademark registration, the skull head figure is placed on the bone fragments that are crossed in a flat manner, it has the impression that it is horizontally enlarged as a whole.

In other words, the Trademark and the trademark of the different trademark registration have different basic constitutions (compositions) of the trademarks, and therefore, it is completely inappropriate to apply the determination in the different trademark registration lawsuit to the Trademark.

B The argument by the demandant neglects the basic constitutions (compositions) of the trademarks and is incompatible with recognition by the Court

Although the demandant omits the bone fragments from the Trademark and Cited Trademarks and argues that the Trademark and the cited trademark are similar on the ground that the skull head figure, which is the principal part, is similar between them, such an argument is also inappropriate.

Because the Trademark is merely composed of the basic structure (composition) shown as the black-colored figure including the front-facing skull and the two bones that are crossed in a vertically long X shape behind the skull, the Trademark should not be understood by extracting the skull portion particularly.

In this regard, the judgment in the different trademark registration lawsuit, on which the argument by the demandant is based, asserts that "the trial decision compares the Trademark with Cited Trademarks, and recognizes and determines that

both trademarks provide a strong impression to observers that they have 'a silhouette-like (black-colored) composition of the figure in which the front-facing skull is combined with the two bone fragments crossed in a flat manner', and that the two trademarks provide a common impression in that composition. It can be concluded that in this recognition and determination, the above-described composition is considered to be the principal part of both trademarks in appearance, in which they have a common feature, and that the composition portion has goods source distinction function. The recognition and determination in the trial decision in this regard is agreeable, and it should be considered that it has no error". As it asserts that "the composition of the figure in which the skull is combined with the two crossed bone fragments" is the very principal part of the trademarks in appearance, the argument by the demandant that only the skull portion is the principal element is completely unreasonable and is not compatible with the recognition by the court.

C The different trademark registration lawsuit did not make a direct determination on whether or not the skull portion is similar as a trademark

Further, the demandant argues that, in the judgment of the different trademark registration lawsuit, it is determined that the difference in the skull head portion is very minor.

However, the argument by the demandant distorts that judgment, and such an argument is also inappropriate.

This is because the judgment in the different trademark registration lawsuit recognizes that "it is normal that, if the figures are encountered in a remote manner; that is, in different times and locations, as explained in the trial decision, the details of the figures are not always memorable accurately, and based on this determination, it should be understood that there is no error in recognition and determination in the trial decision that 'each of the Trademark and Cited Trademark as 'the composition that has a silhouette-like (black-colored) composition of the figure in which the front-facing skull is combined with the two bones that are crossed in a flat manner' provides a strong impression to the observer's memory, and that the difference between the two trademarks in structure is very minor in consideration of this common impression". That is, because, in the case of the different trademark registration, the basic constitution is common between the subject trademark and the cited trademark in that case, it is determined that, based on the above presupposition, the difference in the specific form is relatively very minor, and the case does not provide a direct indication regarding determination of similarity in the skull portion only.

Then, as described above, because the basic structures (compositions) of the

Trademark and the different trademark registration completely differ, the determination in the different trademark registration lawsuit does not affect determination of similarity between the Trademark and the cited trademark, and in practice, the previous trial decision is made in full consideration of the difference in the basic structure (composition) regarding the Trademark.

#### D Summary

As described above, it is clear that the different trademark registration lawsuit trial has no effect on the trial of the case.

### 2 Regarding applicability to Article 4(1)(xi) of the Trademark Act

#### (1) Regarding the demand regarding Class 25

Even if Article 167 of the Patent Act which is applied *mutatis mutandis* under Article 56(1) of the Trademark Act is not applied, in the present case where the situation regarding applicability to Article 4(1)(xi) of the Trademark Act, which is claimed by the demandant as the ground for invalidation, is the same as that in the previous trial, a determination that differs from the previous trial should not be made.

More specifically, the previous trial is one of three cases of invalidation trials that were simultaneously filed two years ago by the demandant (Invalidation No. 2012-890066 (the previous trial), Invalidation No. 2012-890067, and Invalidation No. 2012-890068) against the three registered trademarks including the Trademark (Trademark Registration No. 5244936 (the Trademark), Trademark Registration No. 5244937 (the different trademark registration), and Trademark Registration No. 5296696).

In response to these demands for invalidation trial, the Japan Patent Office made the trial decisions rejecting invalidation (maintaining registration) of the two cases including the Trademark (Invalidation No. 2012-890066) (the previous trial) and Invalidation No. 2012-890068), and made the trial decision invalidating the different trademark registration (Invalidation No. 2012-890067).

Then, concerning this trial decision of invalidation (Invalidation No. 2012-890067), a non-party to the litigation, R international Ltd. (at that time, Roen Co., Ltd.) who was the trademark owner at that time, filed a suit against the trial decision. While the Intellectual Property High Court maintained the decision by the Japan Patent Office and made the decision final, the demandant took no further actions concerning the trial decisions for maintaining registration of the other two cases (Invalidation No. 2012-890066 (the previous trial) and Invalidation No. 2012-890068), and the trial decisions rejecting invalidation were made final.

In other words, all of the three demands for invalidation trial were eventually

made final as determined in the trial decisions by the Japan Patent Office.

The arguments by the demandant are similar to those made by the demandant in the previous trial, except for the different trademark registration lawsuit trial, and they do not describe other reasons why a different determination from the previous trial should be made.

Although an explanation will be provided below to describe that the different trademark registration lawsuit trial has no effect on determination of the trial of the case, because there is no reason for making a different determination from the previous trial, a trial decision that the demand for the trial of the case is groundless should be made.

## (2) Regarding the demand regarding Class 14 and Class 18

As described in Item (1) above, among the designated goods of the Trademark, for the goods in Class 25, the trial decision rejecting invalidation has already been made final in the previous trial based on Cited Trademark 2, which is a cited reference.

Although, in response to this, the demandant filed the demand for invalidation trial in the trial of the case concerning the goods in Class 14 and Class 18 among the designated goods of the Trademark using Cited Trademark 2 as a cited reference, and the argument is similar to that for the goods in Class 25.

It is certain that major consumer players, actual circumstances of transactions, attention that consumers normally have, etc. differ greatly depending on designated goods, and in such a case, determination of similarity between trademarks may change. However, there are no special circumstances that require different determinations of similarity for the designated goods of the Trademark in Class 14, Class 18, and Class 25.

## C Summary

As described above, in the previous trial decision for the designated goods in Class 25, the determination of similarity between the Trademark and Cited Trademark 2 was already made final, and there are no grounds or special circumstances for making a different determination from the previous trial decision. Then, a determination of similarity for the designated goods in Class 14 and Class 18 should not differ from the previous trial decision, and a trial decision that the demand for trial of the case is groundless should be made, like the previous trial decision.

## 3 Conclusion

Therefore, because the Trademark and Cited Trademarks are dissimilar from each other, all of the demands for trials of the case are groundless.

## No. 6 Judgment by the body

### 1 The demand for trial of the case regarding Class 25

Of the demands for trial of the case, the demand for trial of the case regarding the designated goods in Class 25 among the designated goods of the Trademark, on the grounds that they breach Article 4(1)(xi) of the Trademark Act, is not allowed, as it is against the effect of the previous trial decision that was made final.

#### (1) Regarding the effect of the trial decision which was made final

Article 167 of the Patent Act which is applied *mutatis mutandis* under Article 56(1) of the Trademark Act defines that "when a trial decision of a patent invalidation trial has been made final, parties concerned or participants may not demand a trial on the basis of the same facts and the same evidence". The same Article defines that, when a trial decision that was determined based on the arguments and the evidences submitted by the parties concerned (including participants) has been made final, the parties concerned are not allowed to request a determination that contradicts the trial decision made final by providing arguments and proofs regarding the same matter, and that a panel also cannot make a determination that contradicts with the trial decision which was made final. It is understood that the purpose of making the same Article is to (a) to prevent occurrences of a plurality of contradicting final trial decisions based on arguments and proofs relating to the same matter, (b) to prevent overuse of demands for invalidation trial, etc., (c) to avoid complexity in handling invalidation trial procedures, etc. that a right holder may undergo, and (d) to seek to solve a dispute at a time.

Therefore, in the demand for invalidation trial, it is appropriate to understand that "the same facts" mean facts alleged relating to the same invalidation grounds, and that the "same evidences" mean substantially same evidences that offer proof to substantiate the facts alleged. Then, as long as they are evidences to substantiate the same facts (the same proposition to be proved), it should be understood that different means of proof cannot directly be regarded as a reason for denying the substantial similarity in evidences, and it should be understood that newly submitted evidences must be evidences that are substantially worth to prove a new actual relationship other than circumstances which are the basis of a ground for invalidation so far (the judgment 2013 (Gyo-Ke) 10226, March 13, 2014 by Intellectual Property High Court, and the judgment 2013 (Gyo-ke) 10127, February 5, 2014).

#### (2) Fact finding (the history until the demand for trial of the case)

##### A Regarding the previous trial

The arguments by the demandant regarding applicability to Article 4(1)(xi) of the Trademark Act in the previous trial are as described in Item 3-2 above.

In short, the demandant submitted the evidences and argued that the Trademark falls under Article 4(1)(xi) of the Trademark Act because the Trademark and Cited Trademark 2 are similar in appearance as they are identical in appearance in that they are composed of the skull head portion and the crossed bone fragments, and because, among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 2.

In response to this, in the previous trial decision, it is determined that because, as described in Item 3-3 above, the trademark is not similar to Cited Trademark 2 in terms of any of appearance, pronunciation, and meaning, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act. The trial decision rejecting the demand was made on December 26, 2012, and the same trial decision was made final on February 8, 2013.

#### B Regarding the trial of the case

In the trial of the case, the argument by the demandant regarding applicability of the goods in Class 25 to Article 4(1)(xi) of the Trademark Act is as described in Item 4-2(1) above.

In short, because, as shown in Attachment 2, Cited Trademark 1 is composed of the figure part composed of the skull head portion and the crossed bone fragments under the skull head portion and the character part under the figure part in which the words "mastermind" and "JAPAN" are described in two layers, this skull head portion is the principal part of Cited Trademark 1. Because Cited Trademark 2 is composed of a structure that is similar to the figure part of Cited Trademark 1, the skull head portion is the principal part, like Cited Trademark 1. Then, according to the judgment in the different trademark registration lawsuit, it is determined that the difference in the skull head portion between the trademark of the different trademark registration and Cited Trademark 2 is very minor, the skull head portion, which is the principal part of the Trademark and Cited Trademark 1, is similar between them. Further, among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 1. Therefore, the demandant argued that the Trademark falls under Article 4(1)(xi) of the Trademark Act, and submitted the evidences.

#### (3) Judgment

#### A Regarding the same facts

In the trial of the case, the facts alleged by the demandant regarding the designated goods in Class 25 in terms of applicability to Article 4(1)(xi) of the Trademark Act are that the Trademark is similar to Cited Trademark 1, and that among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 1.

Meanwhile, in the previous trial, the facts alleged by the demandant in terms of applicability to Article 4(1)(xi) of the Trademark Act are that the Trademark is similar to Cited Trademark 2, and that among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 2.

Cited Trademarks 1 and 2 are composed of the structures as shown in Attachments 2 and 3, respectively, and thus they differ only in the presence of the character part of "mastermind" and "JAPAN" and are identical in the figure part.

Then, as it is admitted that, in the determination of similarity between the Trademark and Cited Trademark 1, the above difference is not taken into consideration from the viewpoint that the two both trademarks are similar, the demandant merely argues that the two trademarks are similar based on the understanding that the principal parts of both trademarks are the skull head portions. Thus, the above argument by the demandant substantially claims similarity in the figure part, and this is identical to claiming that the Trademark is similar to Cited Trademark 2.

In light of the above, it can be evaluated that, in the previous trial and the trial of the case concerning Class 25, the trials are substantially identical in the fact argued by the demandant that, among the designated goods of the Trademark, the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." are identical or similar to the designated goods of Cited Trademark 1.

#### B Regarding the same evidences

In the trial of the case, the demandant submitted, as evidences, Evidence A No. 5 (a dismissal of the final trial in the different trademark registration lawsuit, and a determination of refusal of receipt of the final trial) and Evidence A No. 6 (judgment in the different trademark registration lawsuit) in addition to the gazette, etc. of Cited Trademark 2 submitted in the previous trial, and argued that they did not file the



demand for trial of the case at least based on the same evidence.

However, these additional evidences are merely used as references in consideration of similarity between the Trademark and the figure part of Cited Trademark 1 (identical to Cited Trademark 2). That is, the judgment in the different trademark registration lawsuit is a mere reference from which elements to be considered important can be read out for consideration of similarity between the different trademark registration and Cited Trademark 2, and the judgment cannot be regarded as the "evidence that is worth to prove a new actual relationship other than the circumstances which are the basis of a ground for invalidation so far".

In light of the above, the above-described additional evidences submitted in the trial of the case are not beyond the range of the evidences that were submitted in order to overcome the determination that rejected the argument submitted by the demandant in the previous trial decision.

#### C Summary

In light of the above, it can be evaluated that the previous trial and the trial of the case are substantially identical in the facts alleged as the grounds for breach of Article 4(1)(xi) of the Trademark Act, and that the evidences submitted to substantiate them are also substantially identical.

Therefore, for the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." among the designated goods of the Trademark in the trial of the case, it can be concluded that the demand for invalidation trial based on the grounds that the Trademark falls under Article 4(1)(xi) of the Trademark Act is not allowed as it is against the effect of the previous trial decision that was made final.

#### 2 Regarding the demand for trial of the case regarding Class 14 and Class 18

As described in Item 3-3 above, the previous trial decision compares the Trademark with Cited Trademark 2 and determines that, for the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." among the designated goods of the Trademark, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

Then, there is no reason for limiting the determination that the Trademark is not similar to Cited Trademark 2 in the previous trial decision only to the designated goods in Class 25 relating to the demand for the previous trial. Therefore, it is also determined that the Trademark does not fall under Article 4(1)(xi) of the Trademark Act regarding the demand for trial of the case for the designated goods in Class 14 "Personal ornaments (other than cuff links); keyrings; semi-wrought precious stones

and their imitations; clocks and watches." and Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; fur." The reason is as described below.

(1) Regarding the Trademark

As shown in Attachment 1, in summary, the Trademark is composed of the black-colored figure in which the front-facing skull is combined with the two crossed bones arranged in a vertically long X shape behind the skull, and this figure does not have specific pronunciation or meaning.

(2) Regarding Cited Trademark 2

As shown in Attachment 3, in summary, Cited Trademark 2 is generally composed of the black-colored figure in which the front-facing skull is combined with the two crossed bones arranged in a flat manner under the skull, and this figure does not have specific pronunciation or meaning.

(3) Regarding similarity between the Trademark and Cited Trademark 2

Although, when the Trademark is compared with Cited Trademark 2, the trademarks are composed of the structure as described in (1) and (2) above, respectively, and they are in common, for example, in having the skull and two crossed bones as a motif, they differ remarkably in that: while the Trademark has a vertically long impression as a whole as it has the two bones crossed in a vertically long X shape, Cited Trademark 2 does not have a vertically long impression as it has the two bones crossed in a flat manner; while the Trademark has the impression that the skull and the crossed two bones are combined and inseparable as the two bones are crossed behind the skull, Cited Trademark 2 has the impression that the skull and the two bones are separate as the crossed two bones are under the skull with a space therebetween; and while the Trademark has a three-dimensional impression as the two bones are behind the skull, Cited Trademark 2 has a flat impression as the two bones are under the skull. Thus, their entire impressions differ, and therefore, if the two trademarks are observed in comparison with each other, and also even if they are observed remotely in different times and locations, they can be clearly distinguished in appearance.

In addition, because the Trademark and Cited Trademark 2 do not have specific pronunciation or meaning, they cannot be compared in pronunciation and meaning.

As such, the Trademark and Cited Trademark 2 are dissimilar in terms of any appearance, pronunciation, and meaning.

Therefore, because the Trademark is not similar to Cited Trademark 2, it does not fall under Article 4(1)(xi) of the Trademark Act even without a determination of

similarity of the designated goods between the two trademarks.

### 3 Closing

In light of the above, of the demands for trial of the case, the demand regarding the designated goods in Class 25 "Clothing; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear." among the designated goods of the Trademark based on Article 4(1)(xi) of the Trademark Act is dismissed, as it breaches Article 167 of the Patent Act applied mutatis mutandis under Article 56(1) of the Trademark Act.

Because, of the demands for trial of the case, the designated goods in Class 14 "Personal ornaments (other than cuff links); keyrings; semi-wrought precious stones and their imitations; clocks and watches." and Class 18 "Bags and the like; pouches and the like; umbrellas and their parts; leather straps; and fur." among the designated goods of the Trademark are not registered in breach of Article 4(1)(xi) of the Trademark Act, and therefore the Trademark should not be invalidated based on Article 46(1)(i) of the same Act.

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

September 15, 2015

Chief administrative judge:	TANAKA, Koichi
Administrative judge:	HAYAKAWA, Fumihiro
Administrative judge:	TAMURA, Masaaki

Attachment 1 The Trademark



2 Cited Trademark 1



3 Cited Trademark 2



4 Different Trademark Registration (Trademark Registration No. 5244937)

