

Trial decision

Invalidation No. 2014-890081

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The case of trial regarding the invalidation of trademark registration for Trademark Registration No. 5,689,311 between the parties above has resulted in the following trial decision

Conclusion

The trial of the case was groundless.

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

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5689311 (hereinafter referred to as "the Trademark") consists of two-tiered character strings, where one is "Delico" in

Alphabetic characters and the other one is "デリコ (Delico)" written in katakana, its registration application was filed on February 14, 2014, the decision for registration was rendered on June 26 of the same year, and the trademark was registered on July 25 of the same year with "display stands; furniture; screens; benches" of Class 20" as its designated goods.

No. 2 Cited Trademark

Two registered trademarks cited by a demandant are as follows. The trademark rights are currently still valid.

1 Cited Trademark 1

Registration Number: Trademark Registration No. 2093408

Trademark: consisting of two-tiered character strings, where one is "デリカ (Delica)" written in katakana and the other one is "Delica" in Alphabetic characters

Designated goods: "fittings of metal; safes" of Class 6, "jewelry cases" of Class 14, "fittings (not of metal)" of Class 19, "furniture; screens; folding screens; benches" of Class 20, and other goods belonging to Classes 6, 11, 14, 16, 17, 19, 20, 21, 22, 24, 26, 27 and 31 described in Trademark Register

Date on which an application for registration was filed: June 1, 1982

Registration date: November 30, 1988

2 Cited Trademark 2

Registration Number: Trademark Registration No. 5503822

Trademark: consisting of the standard characters of "Delica" in Alphabetic characters.

Designated goods and services: "fittings of metal;safes" of Class 6, "furniture; screens; folding screens; benches" of Class 20, "retail services or wholesale services for furniture , retail services or wholesale services for joinery fittings" of Class 35, and other goods or services belonging to Classes 1, 6, 8, 16, 20, 28 and 35 described in Trademark Register.

Date on which an application for registration was filed: November 21, 2011

Registration date: June 29, 2012

3 Cited Trademark 1 and Cited Trademark 2 may be hereinafter collectively referred to as "Cited Trademarks."

No. 3 The demandant's allegation

1 Purpose of demand

A demandant requested the trial decision, "The Trademark shall be invalidated. The costs in connection with the trial shall be borne by the demandee" and submits Evidences A No. 1 to No. 44 (including branch numbers) as the demandant's means of proof.

2 Reasons for demand

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

A Similarity of designated goods

The designated goods by the Trademark, "display counters, furniture, partitions, and benches" are identical or similar to those by the Cited trademarks, "furniture, partitions, and benches."

B Similarity of trademarks

(A) Appearance

The Trademark consists of two-tiered character strings in horizontal writing, where one is "デリコ (Delico)" written in katakana and the other one is "Delico" in Alphabetic characters.

On the other hand, Cited Trademark 1 consists of two-tiered character strings in horizontal writing, where one is "デリカ" (Katakana characters of "Delica") and the other one is "Delica" in Alphabetic characters. Cited Trademark 2 consists of the standard characters of "Delica" in Alphabetic characters.

Comparing Alphabetic characters of the Trademark, "Delico" with Alphabetic characters of Cited trademarks, "Delica," they are common in configuration of six letters, and the first to fifth letters "Delic" are the same. For this reason, the Trademark and Cited Trademark are substantially common in appearance. Additionally, the difference between the two trademarks lies in the last letters: "o" and "a"; while the letters "o" and "a" have circular shapes, which are similar and the difference has a very small influence on the respective trademarks as a whole considering that only the last letter is different.

Accordingly, letters "Delic" at the head strongly attract attention of traders and consumers who observe the Trademark and Cited trademarks remotely in different times and places and they are likely to cause confusion and false recognition to them; therefore, the two trademarks have a confusing appearance of the Alphabetic characters.

(B) Pronunciation

The Trademark gives rise to the pronunciation of "deriko." On the other hand, Cited Trademarks give rise to the pronunciation of "derika."

In this case, comparing the pronunciation "deriko" of the Trademark with the pronunciation "derika" of Cited Trademarks, the two pronunciations consist of the same number of sounds, 3 syllables and the pronunciations of the first and second sounds "deri" are the same. Also in sound tone, the two pronunciations are common in the first dull sound "de" that is accentuated and pronounced for a comparatively high sound, and pronunciation gradually becomes weaker toward the third syllable. On the other hand, the two pronunciations are different in the last sounds "ko" and "ka," but "ko" and "ka" have voiceless velar plosive consonant [k] and are similar sounds. The pronunciations [ko] and [ka] are pronunciations at the end of both pronunciations and are additionally pronounced at the lowest sounds in both pronunciations, and consequently are pronounced very weakly. For this reason, the pronunciations of the Trademark and Cited Trademarks are easily left in memories and impression of listeners and strongly impress them, while the degree of the different part is small and its impression is thin and reflects the entire trademarks only a little.

Accordingly, the pronunciation of the Trademark and the pronunciation of Cited Trademarks are similar to each other in sense and tone of words as a whole and confusingly heard, and therefore the Trademark and Cited trademarks are similar in pronunciation.

(C) Meaning

Both the Trademark and Cited Trademarks are coined words not listed in dictionaries, etc., and do not thus give rise to any specific meaning. Accordingly, the Trademark and Cited Trademarks cannot be compared in terms of meaning.

C Summary

Accordingly, the Trademark and Cited trademarks are similar in appearance and pronunciation and are used for identical or similar goods, and are likely to cause confusion and false recognition of source of goods, taking actual circumstances of trade into consideration, and therefore, fall under Article 4(1)(xi) of the Trademark Act.

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

A Introduction

The demandant has been manufacturing and selling goods "folding tables" (hereinafter referred to as "demandant's goods") and using Cited Trademarks since 1962 for 50 years and consequently, Cited Trademarks have been well-known and prominent around Japan. The Trademark is likely to cause confusion about goods relating to the business of the demandant in the connection with Cited Trademarks.

B Degree of similarity of trademarks

Similarity of the Trademark and Cited Trademarks is as described in the

aforementioned (1).

C Well-known and prominence of Cited Trademarks

The demandant started business of manufacturing pen and ink in 1792 and widely manufactures and sells office equipment and supplies, stationery, office furniture, furniture and fixture, information processing machines, etc. at present (Evidence A No. 7).

The demandant developed and released "Delica Tables" that were unprecedented and novel in those days and could be folded in an upright state (Evidences A No. 8 to No. 10). The demandant has been manufacturing and selling "Delica Tables" to date and developed a series of "Delica Flap Tables" that can be folded in the folding direction that had never before been seen to expand the lineup of folding tables, and has been producing and selling them since 1981 (Showa 56) to this date (Evidence No. 11). During this period, the demandant posted ads of demandant's goods using Cited Trademarks in newspapers and magazines in the decade from 1965 (Evidence No. 12 and No. 13). Recently, the demandant's goods "Delica Flap Tables" were posted on a product information magazine issued by the Research Institute of Economy, Trade and Industry (Evidence A No. 14), and an article for introducing the demandant's goods "Delica Flap Tables" or their ads were posted in the magazine "Monthly Modern Furniture" (Evidence A No. 15), and an article for introducing "Delica Flap Tables Qlooo" was also posted in an office furniture newspaper (Evidence A No. 16).

Meanwhile, the demandant developed and sold a ping-pong table, "Delica Ping-Pong Table" (Evidences A No. 8 and No. 9) using a folding mechanism of the "Delica Tables" and further developed and sold goods, household tables "Delica Family Desks," and household chairs "Delica Family Chairs" (Evidence A No. 11) using Cited Trademarks whose publicity had been acquired through the "Delica Tables" and "Delica Ping-Pong Tables."

In this way, Cited Trademarks have been long used since 1962 for more than 50 years mainly for the demandant's goods, including several types of goods produced and sold by the demandant and as a result, sales figures, and sales amount of furniture-related goods bearing Cited Trademarks exceed about 150,000 and 4 billion yen, respectively only over the last 10 years (Evidence A No. 17). On a website "Personal History traced by Products" and "Made in Japan Database" of "Product Illustrated Dictionary which changed Japan / Nippon Style" (Evidence A No. 18) presented by Shogakukan Publishing Service Co. Ltd., as one of products which changed Japan, the demandant's goods are introduced.

As described above, in view that the Cited Trademarks has been used for more

than 50 years to date; and sales figures, sales amount of the demandant's goods bearing Cited Trademarks, and continuous promotional activities, Cited Trademarks were obviously well-known and prominent nationwide as trademarks used for the demandant's goods as of February 14, 2014 which is the filing date of the Trademark and at this time.

D Originality of Cited Trademarks

Idiomatic expressions "Delica (デリカ)/Delica" and "Delica" which are Cited Trademarks do not exist, and each of Cited Trademarks is a coined word (Evidence A No. 19). For this reason, Cited Trademarks have high originality.

E Attention normally paid by customers

The designated goods of the Trademark and the demandant's goods are used in organizations such as companies, and it is obvious in view of an empirical rule that not all their consumers carefully observe marks attached to the goods.

F Likelihood to cause a risk of confusion

In view of prominence and originality of Cited Trademarks, the degree of similarities between Cited Trademarks and the Trademark, strong relevance to nature, usage, or purpose of goods for both trademarks, and commonality of traders and consumers, if the Trademark is used for the designated goods, on the basis of attention normally paid by traders and customers, it is likely to cause confusion in connection with the goods connected with the business of the demandant or a company having capital ties or business ties with the demandant, or one of a series of goods of "Delica" which the demandant or a company having such relation with the demandant newly released or novel goods that are any improvement thereof.

G Summary

The Trademark is "a trademark which is likely to cause confusion in connection with the goods or services connected with another person's business," and therefore, falls under Article 4(1)(x) and (xv) of the Trademark Act.

(3) Applicability of Article 4(1)(x) of the Trademark Act

As described in the aforementioned (2), Cited Trademarks are prominent in connection with "office furniture" which are goods connected with a demandant's business. Further as described in the aforementioned (1), the Trademark is similar to Cited Trademarks in appearance and pronunciation, and is used for the goods identical or similar to the goods connected with the demandant's business, and therefore, falls under Article 4(1)(x) of the Trademark Act.

(4) Applicability of Article 4(1)(xix) of the Trademark Act

In view of prominence of Cited Trademarks, consumers coming into contact

with the Trademark evoke Cited Trademarks and the demandee obviously uses the Trademark for the purpose of taking advantage of customer attraction of Cited Trademarks. Such unfair purpose is evident from the fact that the Trademark consists of a configuration similar to that of the prominent Cited Trademarks, and therefore, the Trademark falls under Article 4(1)(xix) of the Trademark Act.

(5) Conclusion

The Trademark falls under Article 4(1)(xi), (xv), (x), and (xix) of the Trademark Act, and therefore its registration should be invalidated under the provisions of Article 46(1) of the same Act

3 Rebuttal against reply

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

A Actual circumstances of trade

The designated goods of the Trademark, particularly office furniture, are actually transacted mainly by receiving written orders over the Internet, via facsimile, etc.

This is because office furniture is like goods which consumers purchase by necessary quantity, confirming their certain quantity, which necessitates trade in writing in order to prevent incorrect orders or to maintain records.

In view of such actual circumstances of trade of office furniture, it is not reasonable to determine, putting the weight only on pronunciation among three determination elements for the determination of the similarity of trademarks: appearance, pronunciation, and meaning when determining the similarity of the Trademark and Cited Trademarks, but rather determination, putting the weight only on similarity of appearance is based on trading conditions.

B Meaning

Cited Trademarks are coined words created using "Delicacy" or "Delicate" meaning "elaborate" or "grace, modesty" as their roots (Evidence A No. 19).

As the demandee alleges, even if Cited Trademarks in the form of letters "デリカ" in katakana are used as abbreviation of delicatessen in the present status, it is reasonable to think that consumers of office furniture coming into contact with Cited Trademarks do not evoke meaning of "everyday dishes" or "delicatessen" which is irrelevant to office furniture but recognize them as one sort of "coined words" and understand that they do not give rise to any specific meaning. Hence, the Trademark which does not give rise to any specific meaning and Cited Trademarks cannot be compared in meaning.

C Regarding the demandee's allegation

The demandee alleges in a written reply that "there is no dispute that "pronunciation" is emphasized as determination elements for the similarity of trademarks," and develops its allegation about the similarity of trademarks while laying disproportionate emphasis on pronunciation.

However, the determination of the similarity of trademarks shall be studied wholly by summing up impression, memory, association etc. given to traders by appearance, meaning, pronunciation etc., and so long as actual circumstances of goods can be made clear, it is reasonable to determine the similarity based on the specific trading conditions, in view of which the demandee's allegation about the similarity is unreasonable (Evidence A No. 32).

D Summary

The Trademark is similar to Cited Trademarks in appearance and pronunciation, but cannot be compared in meaning, and is used for identical or similar goods. In the field of office furniture, today, in the present status most trades are done in writing over the Internet, via facsimile, etc., rather than oral trades by telephone, direct trade, etc. In view of such actual trading conditions, the Trademark, which is obviously similar to Cited Trademarks in appearance and similar also in pronunciation, is likely to cause a risk of confusion about the source with the goods. Accordingly, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

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

A Similarity of trademarks

The demandant uses Cited Trademarks combined with common names of goods "table," "flap table," etc.

In this case, common names of goods do not generally perform the function of distinguishing a source. For this reason, even if Cited Trademarks are used in combination with common names of goods, consumers and traders recognize only "Delica/デリカ" as a mark distinguishing a source.

Additionally, in view that the demandant has long used Cited Trademarks in combination with common terms for plural kinds of goods, trademarks compared in determining Article 4(1)(xv) of the Trademark Act shall absolutely be "Delica/デリカ" and the Trademark.

B Attention normally paid by customers

The designated goods of the Trademark and goods used by the demandant, both "folding tables" and "lecture stages," are used in organizations such as companies. Such goods are not like goods which are purchased every year; once they are purchased, they may be continuously used for more than ten years. For this reason, persons in

charge of general affairs in companies which are consumers do not ordinarily accumulate knowledge about the goods. Additionally, the goods have to be purchased within the budget of organizations such as companies, and therefore, the purchasers tend to focus on the possibility of purchase within the budget. Accordingly, consumers do not come into contact with the goods with enough attention for carefully observing the mark attached to the goods to purchase the goods.

C Likely to cause confusion

In view of the fact that Cited Trademarks have been used since 1962 for more than 50 years, as well as the sales figures and sales amount of the demandant's goods bearing Cited Trademarks and the continuous promotional activities for them, it is reasonable to think that Cited Trademarks had acquired prominence. Additionally, in view that Cited Trademarks are similar to the Trademark in appearance and pronunciation, and in view that goods relating to both trademarks have extremely strong relevance and traders and consumers are completely common, the Trademark is likely to cause confusion in connection with the goods connected with the business of the demandant or a company having capital ties or business ties with the demandant, or one of a series of goods of "Delica" which the demandant or a company having such relation with the demandant newly released or novel goods that are any improvement thereof.

D The demandee's allegation

The demandee alleges that the demandant's market share is 1.9% based on the "JOIFA (Japan Office Institutional Furniture Association) Statistics." The demandant's market share, however, actually includes many goods that are not competing and thus are not exact.

Rather, in view that the demandant has used Cited Trademarks since 1962 (Showa 37) for more than 50 years, and in view of the sales figures, sales amount of the demandant's goods bearing Cited Trademarks and continuous promotional activities, etc. their prominence should be affirmed.

E Summary

As described above, the Trademark is likely to cause confusion in connection with the goods connected with the demandant's business, and thus falls under Article 4(1)(xv) of the Trademark Act.

No. 4 The demandee's allegation

1 Purpose of the reply

The demandee requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for reply as follows, and submitted

Evidences B No. 1 to A No. 8 (including their branch numbers) as means of evidence.

2 Reason and summary of the reply

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

A Appearance

The Trademark consists of two-tiered character strings, where the upper section is "Delico" in Alphabetic characters and the lower section is "デリコ (Delico)" written in katakana. Meanwhile, Cited Trademark 1 also consists of two-tiered character strings, where the upper section is "デリカ (Delica)" written in katakana and the lower section is "Delica" in Alphabetic characters. Cited Trademark 2 consists of the standard characters of "Delica" in Alphabetic characters.

Comparing "Delico" of the Trademark and "Delica," "o" and "a" are certainly different. In the form in which six letters are integrated well, the difference in one letter cannot be disregarded in appearance. Further, in case of word marks, their pronunciations and meanings are recognized but only their appearances are not graphically recognized, and the two trademarks can be obviously distinguished if recognizing them with their pronunciations and meaning as described later.

B Pronunciation

The Trademark gives rise to the pronunciation of "deriko" while both Cited Trademarks 1 and 2 give rise to the pronunciation of "derika." The different sounds are "ko" and "ka." Each of the sounds is a plosive, and strongly echoed and clearly pronounced and heard, which therefore largely affects both the entire pronunciations consisting of sounds as short as three syllables, and if the Trademark and Cited Trademarks are pronounced as a series, respectively, they can be clearly distinguished.

C Meaning

Cited Trademark "デリカ / Delica" is widely known in Japan as an abbreviation of a German word "delicatessen" meaning "cooked everyday Western dishes or shops which sell them," and is listed in dictionaries (B No. 5). On the other hand, the Trademark is a coined word which does not give rise to any meaning. Accordingly, both are trademarks that are not confusing in meaning.

D The designated goods

The designated goods of the Trademark are presumed to be identical or similar to the designated goods of Cited Trademarks.

E Summary

As described above, the Trademark and Cited Trademarks are dissimilar in appearance, pronunciation and meaning. Accordingly, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

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

A Degree of similarity of trademarks

As described in the aforementioned (1), the Trademark and Cited Trademarks are dissimilar because determination of Article 4(1)(xv) of the Trademark Act is supposed to prevent a specific confusion about a source. Hence, the demandant mostly uses trademarks of "デリカ" (Katakana characters of "Delica") combined with common names, etc. of goods, which further increases the degree of dissimilarity.

B Prominence of Cited Trademarks

(A) Trademarks that are actually used

The demandant mentions that it actually uses trademarks in the form of "Delica Tables" (Evidence A No. 7 to No. 13), "Delica Flap Tables" (Evidence A No. 11, No. 14 to No. 16), "Delica Ping-Pong Table" (Evidence A No. 8 and No. 9), "Delica Portable Safes," "Delica System Furnitures," "Delica Racks," "Delica Lecture Stages," "Delica Mini-Lecture Stages," "Delica Family Desks," "Delica Family Chairs," "Delica Stages," and "Delica Steps" (Evidence A No. 11). In this way, most of the trademarks that are actually used are "デリカ" (Katakana characters of "Delica") combined with names of goods as a series and one block. There are few examples in which "デリカ (Katakana characters of 'Delica') / Delica" of Cited Trademarks is used alone.

(B) Sales figures and sales amount of the demandant's goods

The demandant mentions that the sales performance of furniture-related goods bearing Cited Trademarks for the last 10 years exceeds 4 billion yen (Evidence A No. 17). If such sales performance occupies a considerable market share, Cited Trademarks will possibly be found as well-known. Then, the demandant's data (Evidence A No. 17) are compared with data of "JOIFA Statistics" (Evidence B No. 7) published by the Japan Office Institutional Furniture Association which is a formal sales data in the office furniture industry, which reveals that the sales amount of "tables" which are main goods of Cited Trademarks for the last 10 years is 3,675 million yen in total, while the sales amount of "tables" in the entire industry is 191,500 million yen; therefore, the market share is only 1.9%, or less than 2% (Evidence B No. 7). These figures show that Cited Trademarks do not reach the stage of prominence, let alone even the stage of being well known.

(C) Continuous promotional activities

The demandant presents Evidence A No. 4, Evidence A No. 8 to Evidence A No. 16, and Evidence A No. 18 as showing its continuous promotional activities. These will be classified and reviewed as follows in view of types and nature of the documentary evidences, purpose of proof of the description of evidence, etc. as follows

and contents thereof will be studied.

- Catalogs of the demandant's goods (Evidence A No. 4, Evidence A No. 11)

Although these confirm that trademarks including the term "デリカ" (Katakana characters of "Delica") have long been used, they are used in the form as shown in the aforementioned (A), which does not show that Cited Trademarks leave a strong impression on consumers.

- Company history, etc. (Evidences A No. 8, No. 9, No. 10) do not show any use of the trademarks.
- The collected advertisement works (Evidence A No. 12) do not prove the fact of posting in ads.
- The newspaper ad (Evidence A No. 13) shows the fact of advertisement but only for two years from 1969 to 1970.
- Posted in the guidebook for merchandise purchase (Evidence A No. 14) only once, which is not printed matter distributed to general consumers.
- The magazine (business magazine) advertisement (Evidence A No. 15) is a so-called business magazine from the year of 2002 and from the years after 2012 far from 2002, and the entire trademarks therein are formed so as to embed letters "デリカ" (Katakana characters of 'Delica') / Delica".
- The article which introduces goods in the newspaper (business journal) (Evidence A No. 16) is a so-called business journal, and the entire trademarks therein are formed so as to embed letters "デリカ" (Katakana characters of 'Delica') / Delica."
- The introduction of goods over the Internet (Evidence A No. 18) places only a photograph of "an office desk" of the demandant's goods in a small size (Evidence A No. 18), and the trademarks cannot be accessible until clicking on the photograph. The form is as shown in Evidence A No. 18-4.

In this way, (i) as for the fact of the continuous use of Cited Trademarks, although the fact of the continuous use is found, Cited Trademarks are not mostly used without modification, (ii) numerical values of the sales figures and sales amount of the demandant's goods and their market share are not worth consideration for determining whether the trademark is well known, and (iii) as for the continuous promotional activities, although the fact of activities is found, the activity found as continuous is only the catalogs of the demandant's goods. The recent version of this "Union Catalog" spans more than 900 pages, in which the trademarks are placed only on several pages. Additionally, this is not distributed onerously and general users cannot lightly pick up to see this in nature. Cited Trademarks are hardly advertised continuously through the so-called mass media (general newspapers, magazines, television, radio,

etc.), and it is not reasonable to think that Cited Trademarks had been consequently widely known to consumers as a result of advertisement by issuing and distributing this catalog.

As described above, Cited Trademarks have long been used only on a small scale, and there is no fact that Cited Trademarks left an impression on consumers, and thus obviously do not reach the stage of prominence let alone even the stage of being well known.

D Originality of Cited Trademarks

As described in the aforementioned 2(1)C, Cited Trademarks consist of idiomatic expressions, and their meanings are widely known. In view of the meanings, "Delica Tables" and the like which the demandant mentions to have long used are perhaps used like common names of "dining tables" by third parties without bad faith (Evidence B No. 8). Cited Trademarks are not obviously found to have originality and their distinctiveness is weak.

E Attention normally paid by customers

The demandant alleges that the designated goods of the Trademark and the demandant's goods "folding tables, lecture stages" etc. are used in organizations such as companies, and consumers do not carefully observe them, but rather on the contrary, consumers (such as persons in charge of general affairs in companies) pay their final attention to the quality and brand because tables used in organizations such as companies are expensive and many employees use them.

F Likelihood to cause a risk of confusion

As described in the aforementioned "B" to "D," Cited Trademarks are not obviously found to be well known. Generally, in a case where trademarks are dissimilar like the present case, application of the provision of this item requires a high level of being well known as evident from the purpose of the provision, a theory, court decision examples, etc., and the level of Cited Trademarks does not reach even the hurdle of ordinary degree of being well known. Even if considering the relevance of goods, consumers are not "likely to cause a risk of confusion about the source of goods."

G Summary

As described above, the Trademark does not fall under Article 4(1)(xv) of the Trademark Act.

(3) Applicability of Article 4(1)(x) of the Trademark Act

Cited Trademarks are not well known and the Trademark is not similar to Cited Trademarks. Accordingly, the Trademark does not fall under Article 4(1)(x) of the

Trademark Act.

(4) Applicability of Article 4(1)(xix) of the Trademark Act

Cited Trademarks are not well known and the Trademark and Cited Trademarks are completely separate coined trademarks, and the presence of the unfair purpose cannot be thought of. Accordingly, the Trademark does not fall under Article 4(1)(xix) of the Trademark Act.

(5) Conclusion

Accordingly, the Trademark's registration does not fall under any of Article 41(1)(xi), (xv), (x), and (xix) of the Trademark Act.

No. 5 Judgment by the body

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

(1) The Trademark

The Trademark consists of two-tiered character strings in horizontal writing, where one is "Delico" in Alphabetic characters and the other one is "デリコ (Delico)" written in katakana, neither of which is found to be listed in dictionaries, etc., and is thus recognized as a coined word having no specific meaning. It is reasonable to understand from this configuration that "デリコ" (Katakana characters of "Delico") in the lower section is reasonably recognized to specify how to read "Delico" in Alphabetic characters.

Hence, the Trademark gives rise to the pronunciation "deriko" according to the entire constituent letters, but does not give rise to any specific meaning.

(2) Cited Trademarks

Cited Trademark 1 consists of two-tiered character strings in horizontal writing, where one is "デリカ" (Katakana characters of "Delica") and the other one is "Delica" in Alphabetic characters, neither of which is found to be listed in dictionaries, etc. as an idiomatic expression having a specific meaning, and is thus recognized as a coined word of a kind having no specific meaning.

In this case, the demandee alleges that constituent characters of Cited Trademarks are known as abbreviation of a German word "delicatessen" meaning "cooked everyday Western dishes or shops which sell them," which gives rise to the corresponding meaning.

However, furniture, etc. which are the designated goods of Cited Trademarks have no relevance to the meaning of a German word "delicatessen" alleged by the demandee, and therefore, it is reasonable to understand that traders and consumers coming into contact with Cited Trademarks cannot directly evoke a German word

"delicatessen" from their constituent characters and cannot always recognize it as their abbreviation, and thus the demandant's allegation cannot be adopted.

Hence, it is reasonably recognized from the configuration of Cited Trademark 1 that "デリカ" (Katakana characters of "Delica") in the upper section specifies how to read "Delica" in Alphabetic characters, and therefore, Cited Trademark 1 gives rise to the pronunciation "derika" according to the entire constituent letters, but does not give rise to any specific meaning.

Cited Trademark 2 consists of "Delica" in Alphabetic characters written in horizontal writing, and gives rise to the pronunciation of "derika" corresponding to constituent characters but does not give rise to any specific meaning, similarly to Cited Trademark 1.

(3) Similarity of the Trademark and Cited Trademarks

A Appearance

The Trademark consists of Alphabetic characters arranged in the upper section and Katakana characters arranged in the lower section as shown in the aforementioned (1), while Cited Trademark 1 consists of katakana arranged in the upper section and Alphabetic characters in the lower section as shown in the aforementioned (2), and Cited Trademark 2 consists of only Alphabetic characters.

Further, comparing "Delico" in Alphabetic characters in the part of Alphabetic letters of the Trademark with "Delica" in Alphabetic characters of Cited Trademarks, the sixth letters "o" and "a" are different, and comparing "デリコ" (Katakana characters of "Delico") of the Trademark with "デリカ" (Katakana characters of "Delica") of Cited Trademarks, the third letters "ko" and "ka" are different in only 3 short constituent characters, and therefore, when viewed from an overall viewpoint, the Trademark and Cited Trademarks can be obviously distinguished in appearance.

B Pronunciation

Comparing the pronunciation "deriko" from the Trademark with the pronunciation "derika" from Cited Trademarks, both pronunciations consist of sounds as short as three, and are common in the first sound "de" and the second sound "ri," but are different in the last sounds "ko" and "ka." Both of these different sounds are plosives, and are pronounced comparatively strongly, which, therefore, much affects both pronunciations consisting of sounds as short as three, and it is reasonable to understand that if both pronunciations are pronounced as a series, they can be distinguished acoustically.

C Meaning

Neither the Trademark nor the Cited Trademarks give rise to any specific

meaning, and therefore, the Trademark and Cited trademarks cannot be compared in terms of meaning.

(4) Regarding argument of demandant

The demandant alleges that the designated goods of the Trademark, particularly office furniture, are actually transacted mainly by receiving written orders over the Internet, via facsimile, etc., and therefore, when determining the similarity of the Trademark and Cited Trademarks, among determination elements for the determination of the similarity of trademarks: appearance, pronunciation, and meaning, similarity of appearance should be emphasized.

However, although the designated goods of the Trademark are always transacted in a manner such that the trademark is visually recognized, it cannot be categorically concluded that appearance should be more emphasized than pronunciation and meaning and additionally, the trademark in the Trademark and Cited Trademarks are dissimilar also in appearance as described in the aforementioned (3).

Accordingly, the demandant's aforementioned allegation as described above cannot be adopted.

(5) Summary

As described above, the Trademark and Cited Trademarks are not similar in any of appearance and pronunciation and there are no special circumstances where both are confusing also in meaning, and therefore the two are not likely to be confusing and are dissimilar trademarks.

Accordingly, the Trademark shall not fall under Article 4(1)(xi) of the Trademark Act.

2 Degree of being well-known of trademarks used by the demandant

(1) The following fact can be found from respective items of Evidence A submitted by the demandant.

A The demandant is a company which started business in 1792 and handles office supplies, office paper equipment, various furniture, interior goods, etc. as the business line at present (Evidence A No. 7).

B In 1962 the demandant developed and released "Delica Tables" as tables that could be folded in an upright state (Evidences A No. 8 to No. 10).

C In the catalogs of the demandant's goods from 1964 to 2014, there are identified, with photographs, "DELICA tables," "DELICA Flap Tables" (goods: folding tables); "DELICA hand safes" (goods: portable safes); "DELICA fully fireproof safes" (goods: safes); "DELICA system furniture" (goods: furniture); "DELICA RACKS" (goods: racks); "DELICA Lecture Stages" and "DELICA Mini-Lecture Stages"(goods: lecture

stages); "DELICA Family Desks" (goods: household desks); "DELICA Family Chairs" (goods: household chairs); "DELICA STAGES", (goods: folding stages); and "DELICA STEPS" (goods: steps for lifting).

Additionally, catalogs of the goods from 1965 to 1976 describe "DELICA tables," "DELICAFOLDING TABLES" (goods: folding tables); "DELICA hand safe" (goods: portable safes); "DELICA fireproof safe" (goods: safes); "DELICA system furniture" (goods: furniture); "DELICA STAGES," "DELICA FOLDING STAGES" (goods: lecture stages); and "DELICA RACKS" (goods: racks).

On pages following the covers and pages preceding the back covers of the catalogs of the goods from 1964 to 1972, under headings of "Main Trademarks," "Our Trademarks," and "Our Company's Trademarks," a phrase "using for Delica Tables developed as folding tables first in the world" with Alphabetic characters "Delica" and "デリカ" (Katakana characters of "Delica") is identified. Further, on pages following the covers and pages preceding the back covers of the catalogs of the goods from 1973 to 2014, a trademark consisting of two-tiered character strings, where one is "Delica" in Alphabetic characters and the other one is "デリカ" (Katakana characters of "Delica") or a trademark consisting of two-tiered character strings, where one is "デリカ" (Katakana characters of "Delica") and the other one is "Delica" in Alphabetic characters are described as demandant's typical trademarks (Evidence A No. 11).

D From 1966 to 1970, letters "Delica Tables" written in katakana (including letters consisting of two-tiered character strings, where one is "Delica" in katakana and the other one is "Table" in katakana) are posted in newspapers and magazines as ads of goods "folding tables" (Evidences A No. 12 and No. 13).

E In 2002, 2012, and 2014, letters "DELICA Flap Tables" are posted in magazines as ads of goods "folding tables" (Evidence A No. 15).

F It is described that total sales figures and sales amount of goods "Delica Flap Tables," "Delica Tables," "Delica Stages," and "Delica Flaps" are about 150,000 and about 4 billion yen as annual sales of the demandant's goods from 2004 to 2013 (Evidence A No. 17).

(2) Summary

As found by the fact in the aforementioned (1), the demandant is a company handling office supplies, office paper articles, various furniture, interior goods, etc., and has been using marks consisting of combination of letters "Delica" or "デリカ" (Katakana characters of "Delica") and common names etc. of goods for goods "folding tables" etc., since 1964 before the time of application for the registration of the Trademark to this date and a considerable number of goods "folding tables" bearing

"Delica Flap Tables" in katakana or "Delica Tables" in katakana have been sold.

It is found that marks "Delica" and "デリカ" (Katakana characters of "Delica") are introduced as demandant's trademarks on catalogs of demandant's goods which introduce goods such as "folding tables."

It is, therefore, concluded that Cited Trademarks consisting of letters "Delica" and "デリカ" (Katakana characters of "Delica") used by the demandant had been widely recognized among consumers as indicating goods connected with the demandant's business for at least goods, office furniture such as "folding tables" to a certain degree at the time of application for the registration of the Trademark and upon the decision for registration of the Trademark.

3 Applicability of Article 4(1)(x) of the Trademark Act

As described in the aforementioned paragraph "1," the Trademark and Cited Trademarks are not confusing with each other in any of appearance, pronunciation, and meaning, and are dissimilar trademarks.

Accordingly, the Trademark and Cited Trademarks are dissimilar taking the Cited Trademarks' degree of being well known into consideration, thus the Trademark does not fall under Article 4(1)(x) of the Trademark Act.

4 Applicability of Article 4(1)(xv) of the Trademark Act

As described in the aforementioned paragraph "3," the Trademark and Cited Trademarks are dissimilar even if taking Cited Trademarks' degree of being well known into consideration, and even the entire evidence submitted by the demandant is not enough for finding that traders and consumers are likely to cause a risk of specific confusion about the source of goods between the Trademark and Cited Trademarks.

Accordingly, it is not found that if the Trademark is used for the designated goods, consumers coming into contact with this evoke and associate with Cited Trademarks and are misled into believing that the goods pertain to goods relating to a business of the demandant or goods relating to a business of a person having any economic or organizational relationship with the same person, and it is not found that consumers are likely to cause a risk of confusion about the source with the goods at the time of application for the registration of the Trademark and upon the decision for registration of the Trademark.

Accordingly, the Trademark shall not fall under Article 4(i)(xv) of the Trademark Act.

Additionally, the demandant alleges that goods used by the demandant, "folding tables and lecture stages" etc. are used in organizations such as companies, and the goods will have been continuously used for more than several years, and thus

consumers such as persons in charge of general affairs in companies tend to focus on the possibility of purchasing within the budgets but do not come into contact with a mark attached to the goods with attention enough for carefully observing the mark to purchase the goods.

However, the demandant does not submit any evidence supporting this, and in case of goods purchased by organizations such as companies, persons in charge in companies rather ordinarily confirm makers, trademarks, product numbers, the number of products, amount, etc. to conduct purchase procedure, and therefore, the allegation described above cannot be accepted.

5 Applicability of Article 4(1)(xix) of the Trademark Act

The Trademark, Cited Trademarks and a mark used by a demandant are dissimilar trademarks as described in the aforementioned "3." Any evidence for supporting that they are used for unfair purposes cannot be found. Accordingly, the Trademark shall not fall under Article 4(1)(xix) of the Trademark Act.

6 Conclusion

As described above, it cannot be concluded that the Trademark's registration is in breach of any of Article 4(1)(xi),(x), (xv), and (xix) of the Trademark Act, and therefore its registration should not be invalidated under the provisions of Article 46(1) of the same Act.

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

May 19, 2015

Chief administrative judge:	TANAKA, Koichi
Administrative judge:	HAYAKAWA, Fumihiko
Administrative judge:	MAEYAMA, Ruriko