

Decision on opposition

Opposition No. 2014-900179

Osaka, Japan

Trademark Right Holder KAISHIN BOEKI CO., LTD.

Chiba, Japan

Trademark Opponent ORIGINAL PLANT CO., LTD.

Tokyo, Japan

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Decision on the opposition to the grant of the trademark registration No. 5667116 has resulted in the following decision.

Conclusion

The trademark registration No. 5667116 is cancelled.

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5667116 (referred to as "the Trademark" below) is configured as indicated in Attachment (1), and the application for

its registration was filed on May 25, 2013. Decision of registration was made on October 30, 2013 by setting Class No. 18 "Clothing for domestic pets; bags and the like; pouches and the like; vanity cases; umbrellas and their parts." and Class No. 25 "Garters; sock suspenders; suspenders; waistbands; belts for clothing." as the designated goods. The Trademark was registered on May 9, 2014.

No. 2 Cited Trademark

A mark, which is attached to tags and seals of goods manufactured and sold by the opponent (referred to as "the opponents" below), cited by the opponent is configured as indicated in Attachments (2) to (12). Also, the registered trademarks owned by Original Plant Ltd. (referred to as "Original Plant"), which is the opponent, are configured as respectively indicated in Attachments (13) to (15). The registered trademarks of Original Plant are Trademark Registration No. 5167977 (Attachment (13)), Trademark Registration No. 5324656 (Attachment (14)), Trademark Registration No. 5561880 (Attachment (15)), and Trademark Registration No. 5607847 (Attachment (14)) (the marks and registered trademarks may be collectively referred to as "Cited Trademark").

No. 3 The grounds of the opposition to registration (gist)

The opponents summarized and mentioned the grounds of the opposition to registration and submitted Evidence A No.1 to A No.48 (including their branch numbers) as means of proof.

1 Applicability to Article 4(1)(x) and Article 4(1)(xv) of the Trademark Act

The Trademark is the same as or similar to Cited Trademark (Evidences A Nos. 5, and 11 to 34) which has been widely recognized by consumers.

Also, the goods of Class No. 18 "Bags and the like; pouches and the like; vanity cases; umbrellas and their parts" and Class No. 25 "Garters; sock suspenders; suspenders; waistbands; belts for clothing" in series goods based on Cited Trademark by the opponents (referred to as "opponent's goods" below) conflict with those in the designated goods of the Trademark (Evidence A No. 5).

Regarding the designated goods other than the above, the opponent's goods have characteristics of character goods, and the designated goods other than the above have certain similarity to the opponent's goods, and Cited Trademark has been widely recognized by the consumers. Accordingly, when the Trademark similar to Cited Trademark is used for the designated goods, this may cause confusion about the source of the goods.

2. Applicability to Article 4(1)(xix) of the Trademark Act

As described above, Cited Trademark has been widely recognized by the consumers, and the Trademark is similar to Cited Trademark. Also, the owner of the trademark right submitted the application of the Trademark for unfair purposes such as sale of counterfeit products.

3. Applicability to Article 4(1)(vii) of the Trademark Act

The owner of the trademark right submitted the application for trademark registration for the unfair purposes such as the sale of the counterfeit products while recognizing the known character of the opponent, and the case is more than a minor business trouble between the opponents and the owner of the trademark right. Therefore, there had been matters which lacked social appropriateness in the process of application for registration of the Trademark in question, and approval of its registration violates the order intended by the Trademark Act.

4. Closing

As apparent from the evidences (Evidences A No. 1 to No. 48), the registration of the Trademark falls under Article 4(1)(vii), Article 4(1)(x), Article 4(1)(xv), and Article 4(1)(xix) of the Trademark Act, and therefore, its registration should be cancelled under Article 43-2(1) of the Trademark Act.

No. 4 Reasons for rescission by the body

Reasons for revocation of the Trademark which was noticed in the notice of reasons for revocation dated on August 19, 2015 to the owner of the trademark right by the body is summarized and mentioned as follows.

1. According to the evidences submitted by the opponents and the objects of the grounds of the opposition, the following is acknowledged.

(1) Original Plant was established on October 24, 1991 for the purposes of "1. Planning, manufacturing, selling, and exporting/importing clothing and miscellaneous goods, interior ornaments, and ceramics 2. Planning, manufacturing, selling, and exporting/importing stationery, toys, and dolls 3. Planning, manufacturing, selling, and exporting/importing men's wear, ladies' wear, children's wear, accessories, and pouches 4. Publication of picture books 5. Planning and developing character goods (to which images of person and animals having unique names and characteristics are attached)" (Evidence A No. 2). Also, SANTAN Co., Ltd. (referred to as "SANTAN" below) who

is the opponent, was established on March 1, 1971 for the purposes of "1.

Manufacturing and selling smoking tools 2. Manufacturing and selling accessories" (Evidence A No. 3). Original Plant licenses SANTAN to commercialize the character goods.

(2) The opponent works on a rabbit character which was created by A, who is the director of Original Plant (referred to as "the Character" below), and goods based on the design formed of characters of "le Sucre" (referred to as "goods used by the opponent" below). The goods include dolls, stationery, bags and pouches, and the like, baby goods, kitchen goods, towels and handkerchiefs, interior goods, car goods, and miscellaneous goods such as cosmetics including bath agent. SANTAN or a sublicensee manufactures and sells these goods (Evidences A Nos. 2, 4, and 5).

(3) Introduction and advertisements of goods used by the opponent and Cited Trademark in newspapers, magazines, and mail shopping catalogs, exhibition of goods used by the opponent to various trade shows, and the like

A In an information magazine "fancy shop" for retail stores of which about 20,000 copies were published in Japan (published on November 25, 2005), an article such that SANTAN exhibited miscellaneous goods "le Sucre" series to the 4th "Tokyo Fashion Goods Trade Show" was posted together with a photograph of the rabbit doll (Evidences A Nos. 11 and 12).

B The goods used by the opponent and Cited Trademark are posted in the mail shopping catalog "MY-SELECT" (2006 Spring & Summer), "Shin-Seikatsukan" by SENSHUKAI CO., LTD. (2006 Spring & Summer, 2006 Summer, 2007 Spring & Summer: three million copies of each magazine were published three times per year), "Kurashi to Seikyo" (2007 Spring), and "heart diary" (2009 Autumn & Winter). In addition, a method for making a bag using clothing with the characters of "le Sucre" and the Character was introduced in a book entitled "Let's make first preschool and school goods" with a mail shopping catalog (published on February 7, 2010), "Together with you every day! Handmade school bags" (published on February 17, 2012), and "First preschool and school bags and goods" (published on January 23, 2013) (Evidences A Nos. 13 to 23).

C SANTAN exhibited the goods used by the opponent to "Tokyo Fashion Goods Trade Show" from 2005 to 2007 (Evidences A Nos. 11 and 24). Also, SANTAN and the sublicensee (IZAWA Corporation) displayed the goods used by the opponent to "Tokyo Zakka Collection" 2011 Spring, 2011 Autumn & Winter, 2012 Spring & Summer, and 2012 Autumn & Winter (Evidence A No. 25). In addition, the opponents displayed and sold the goods used by the opponent in "Usagi no pyon-pyon exhibition" in 2010 and

2011 at Hanshin Department Store Umeda Main Building (Evidence A No. 26) and ""Umeda Usa Park 2011" presented by KIDDY LAND" held at Hankyu Sanbangai from December 26, 2010 to January 6, 2011 (Evidence A No. 27). The advertisement on "Usagi no pyon-pyon exhibition" in 2010 was posted in the evening edition of Yomiuri Shimbun dated June 22, 2010, and the characters of ""ル・シュクル(le Sucre)" appears" are posted with the photograph of the rabbit doll (Evidence A No. 28).

D The characters of "le sucre" were introduced as a word having a meaning of "sugar" in French (Evidences A Nos. 5, 13, 17, and 20).

(4) Selling stores and sales of goods used by the opponent

A At May 25, 2013 which is the filing date of the Trademark, the goods used by the opponent were sold by directly-managed stores of "Plus Heart" which operates more than 80 stores across the country and "Aming" which operates about 20 stores in Kanto, Koshinetsu, and Hokuriku (Evidences A Nos. 29 to 31). In addition, the goods used by the opponent were sold by many online shopping sites such as an online shopping site "Little Leaf" (head office, Rakuten Market), and "toy-box bague for general merchandise" (head office, Rakuten Market , Yahoo! Shop. Amazon. co. jp) (Evidences A Nos. 32 and 33). The opponent distributed the catalogs twice a year to business partners including retail stores and wholesalers from 2006 at the latest (Evidence A No. 5).

B The sales of the goods used by the opponent were about 600 million yen to one billion yen at a retail price every year from 2009 to 2013 (Evidence A No. 34).

2. According to the fact recognized in 1, it can be acknowledged that the characters of "le Sucre" and "ル シュクル(le Sucre)" or a figure of an anthropomorphic rabbit and a figure of the head of the rabbit have been already widely recognized by retailers who sell general merchandise in Japan, young women, and mothers having small children such as kindergartener as the mark for displaying the goods used by the opponent at the time of submitting the application for the registration of the Trademark (May 25, 2013). It can be acknowledged that the notoriety continued upon the decision for registration of the Trademark.

Also, it can be assumed that the consumers recognized to a certain degree that the characters of "le sucre(ル シュクル)" indicate the word having the meaning of "sugar" in French.

3. Similarity of the Trademark and Cited Trademarks

(1) Cited Trademark

A Cited Trademark is configured as indicated in Attachments (2) to (13) and (15), and Cited Trademark is roughly divided as follows.

(A) the trademark in which the figure of the head of the rabbit and the characters of "le Sucre" are combined (Attachments (2), (4), (10), (11), and (15), referred to as "Cited Trademark (A)" below)

(B) the trademark having the figure of the anthropomorphic rabbit and the characters of "le Sucre" or "Le Sucre" as the primary part (Attachments (3), (5) to (9), and (12), referred to as "Cited Trademark (B)" below)

(C) the trademark in which the characters of "le Sucre" and the characters of "ル. シュクル(le Sucre)" are horizontally written in two lines (Attachment (13), referred to as "Cited Trademark (C)" below)

B Pronunciation and meaning generated from Cited Trademark

(A) As described in 2, the figure part including the head of the rabbit and the character part of "le Sucre" in Cited Trademark (A) were widely recognized by the retailers who sell general merchandise in Japan, young women, and mothers having small children such as kindergartener as the mark for displaying the goods used by the opponent. Since both parts are basic components (primary part) which characterize Cited Trademark (A), it can be said that the two parts independently have functions for distinguishing relevant products from others.

Therefore, Cited Trademark (A) generates the pronunciation of "ru-syukuru" and the meaning of "le Sucre (as a brand)" or "sugar" from the characters of "le Sucre."

(B) As described in 2, the figure part of the anthropomorphic rabbit and the character part of "le Sucre" or "Le Sucre" in Cited Trademark (B) were widely recognized by the retailers who sell general merchandise in Japan, young women, and mothers having small children such as kindergartener as the mark for displaying the goods used by the opponent. Since both parts are basic components (primary part) which characterize Cited Trademark (B), it can be said that the both parts independently have functions for distinguishing relevant products from others.

Therefore, Cited Trademark (B) generates the pronunciation of "usagi" and the meaning of "the rabbit of le Sucre (as a brand)" or the "rabbit" from the figure part of the rabbit. Also, Cited Trademark (B) generates the pronunciation of "ru-syukuru" and the meaning of "le Sucre (as a brand)" or "sugar" from the character part of "le Sucre" or "Le Sucre."

(C) Cited Trademark (C) generates the pronunciation of "ru-syukuru" and the meaning of "le Sucre (as a brand)" or "sugar" according to the constituent characters.

(2) The Trademark

The Trademark is configured by displaying the characters of "LE SUCRE" and "ル シュクル(le Sucre)" in two lines as indicated in the Attachment (1). As described in 2, the characters of "le Sucre" were widely recognized by the retailers who sell general merchandise in Japan, young women, and mothers having small children such as kindergartener as the mark for displaying the goods used by the opponent. Therefore, the Trademark generates the pronunciation of "ru-syukuru" and the meaning of "le Sucre (as a brand)" or "sugar."

(3) Comparison between the Trademark and Cited Trademark

A Appearance

(A) When the whole structures of the Trademark and Cited Trademarks (A) and (B) are observed, it cannot be said that they are similar to each other in appearance. However, the character configuration of "LE SUCRE" is the same as that of "le sucre." Therefore, regarding the character parts of "LE SUCRE" and "le sucre," the two trademarks may be confused with each other in appearance.

(B) When the whole structures of the Trademark and Cited Trademark (C) are observed, it cannot be said that their appearances are similar to each other. However, the character configurations of "LE SUCRE" and "le sucre" and the character configurations of "ル シュクル(le Sucre)" and "ル. シュクル(le.Sucre)" are the same as each other. Therefore, the two trademarks may be confused with each other in appearance.

(C) According to (A) and (B) above, the Trademark and Cited Trademarks (A) to (C) may be confused with each other in appearance.

The Trademark and Cited Trademarks (A) to (C) commonly have the pronunciation of "ru-syukuru" and the meaning of "le Sucre (as a brand)" or "sugar."

Therefore, the Trademark and Cited Trademarks (A) to (C) may be confused with each other in appearance and commonly have the same pronunciation and the same meaning. Therefore, it can be concluded that the Trademark and Cited Trademarks (A) to (C) are similar to each other.

4. Regarding unfair purpose

(1) The holder of trademark right

A The holder of trademark right is a stock company located at 2-2-17 Nishimiyahara Yodogawa-ku, Osaka-shi, and the representative of the stock company is B (Evidence A No. 35).

B B was prosecuted by Daegu district prosecutors' office in Korea on September 17, 2013 regarding violations of Copyright Law, laws such as the Unfair Competition

Prevention Act, and the Trademark Act (translation of Evidence A No. 37-2). In response, Daegu District Court pronounced judgment to B on February 20, 2014 (translation of Evidence A No. 39).

C Relation between the opponents and C

According to the judgment pronounced by Daegu District Court to B on February 20, 2014 (translation of Evidence A No. 39), it can be acknowledged that C concluded the le Sucre character goods sale consignment contract with SANTAN on February 1, 2005 and concluded the commercialized contract in Korea on February 13, 2009. After that, C ran a license business in Korea and concluded the le Sucre license contract with many Korean companies from May 1, 2009 to June 1, 2013 and sold stationeries, kitchen tools, clothes for wearing at home such as underwear and socks, bedclothes and the like, umbrellas, swimming wears, towels, footwear, accessories, and the like in online stores and large superstores in Korea. Also, C sold le sucre rabbit dolls imported from Japan (referred to as "the Rabbit doll" below) in many online selling stores and the like. After C received the trademark of "le Sucre" which was owned by the others in Korea, C registered the trademark (Attachment (11)), in which the characters of "le Sucre" and the figure of the head of the rabbit are combined, on January 3, 2013.

D The judgment acknowledged "determination on allegation by accused" as follows.
A In the violation of the Law of Unfair Competition Prevention, "the Rabbit doll is a character doll which has been widely known in Korea, and consumers recognize the Rabbit doll sold in Japan as an official product. Therefore, the Rabbit doll falls under "mark displaying that those are goods of others which have been widely known in Korea" prescribed in Article 2 (1)(B) of the Unfair Competition Prevention and Trade Secret Protection Law. It is reasonable to assume that the accused imported and sold rabbit dolls which are substantially the same as or similar to the Rabbit dolls and committed principal goods confusion."

B In the violation of the Trademark Act, "it is reasonable to assume that to import and to sell the rabbit dolls having the same pattern as that in the figure part of the registered trademark (Decision note: the trademark whose application was submitted and registered by C in Korea, the same is applied below) which is formed as using the figure of the Rabbit doll makes the consumers confused about the origin of the trademark, which is the essential function of the trademark, and violates the trademark right. It cannot be said that the accused had no intention to violate the trademark right although the accused changed the characters to "sucre d'orge" while importing and selling the rabbit dolls having the same pattern as that of the figure part of the registered

trademark."

E The characters "sucre d'orge" are written on the surface of a tag attached to the rabbit doll sold by B. However, a notation method of the characters, the shape, color, pattern, and the like of the whole configuration of the Cited Trademark are very approximate to those of the Attachments (7) to (9). Also, attention, the material, and the like are written on the rear surface of the tag in Japanese, and in addition, the words of "manufactured by KAISHIN TRADING CO., LTD," "sold by SANTAN Co., Ltd.," and "2-2-17 Nishimiyahara Yodogawa-ku, Osaka-shi" are written (Evidence A No. 40).

(2) The holder of the trademark right or B submitted the applications for the registration of the following trademarks in Japan.

A Trademark Application No. 2013-33948 in which the figure of the rabbit and the characters of "sucre d'orge" are combined (filed on April 18, 2013, designated goods: goods of Classes 18, 24, and 28, Evidence A No. 42)

B Trademark Application No. 2013-37347 which is formed of the figures of two rabbits and the characters "le sucre" (filed on May 2, 2013, designated goods: goods of Classes 5 and 12, Trademark Registration No. 5631156 (registered on November 22, 2013), Evidence A No. 43)

C Trademark Application No. 2013-36941 formed of the figure of the rabbit (filed on May 1, 2013, designated goods: goods of Class 5, Trademark Registration No. 5665839 (registered on April 25, 2014), Evidence A No. 44)

D Trademark Application No. 2013-71185 formed of the figures of two rabbits and the characters of "le sucre" and "ru-syukuru" (filed on August 28, 2013, designated goods: goods of Class 3, Trademark Registration No. 5653895 (registered on March 7, 2014), Evidence A No. 45)

E Trademark Application No. 2013-90190 in which the figure of the rabbit and the characters of "sucre d'orge" are combined (filed on April 18, 2013, designated goods: goods of Classes 18 and 24, Evidence A No. 46)

F Trademark Application No. 2013-36942 formed of the figure of the rabbit (filed on May 1, 2013, designated goods: goods of Classes 18, 21, 24, 25, and 28, Evidence A No. 47)

G Trademark Application No. 2013-36970 formed of the characters of "sucre d'orge" (filed on May 1, 2013, designated goods: goods of Class 5, Evidence A No. 48)

(3) According to the facts acknowledged in (1) and (2), the goods used by the opponent were imported and sold in Korea based on a sale consignment contract concluded between SANTAN and C on February 1, 2005. After that, SANTAN and C concluded a license contract on the monopolistic merchandising right of "le sucre" in Korea and the

right to obtain the trademark right of "le Sucre" in Korea on February 13, 2009. Based on this, C accepted the transfer of the trademark of "le sucre" and the like owned by the other person in Korea, and after that, C filed the application of the trademark in which the characters of "le sucre" and the figure of the rabbit are combined and registered it. The rabbit doll in the goods used by the opponent is popular with the consumers in Korea, and the figure of the anthropomorphic rabbit and the characters of "le sucre" written in the tag attached to the rabbit doll were widely recognized by the consumers in Korea in November, 2010 at the latest. In this situation, B who is the representative of the holder of trademark right, imported imitations of the rabbit doll in the goods used by the opponent and sold them in Korea from about November 24, 2010 to June 4, 2012. The pattern resemblant to that of the Attachments (7) to (9) is written on the surface of the tag of the imitation rabbit doll, and attention in Japanese and the characters of "sold by SANTAN Co., Ltd." are written on the rear surface of the tag. These may cause false recognition such that the goods were manufactured in Japan. B was prosecuted in Daegu district prosecutors' office on September 17, 2013 because the act of B violated the Copyright Law, the law regarding the Unfair Competition Prevention Act, and the Trademark Act in Korea. Daegu District Court pronounced the judgment to B on February 20, 2014. The holder of the trademark right and B submitted an application of the trademark similar to Cited Trademark in Japan around May, 2013. These facts can be acknowledged.

Then, in consideration of the series of acts by B, who is the representative of the holder of the trademark right in Korea, and the application and registration state of the trademark similar to Cited Trademark by the holder of the trademark right and B in Japan, regarding the application and the registration of the Trademark by the holder of the trademark right, it should be acknowledged that B takes the application and the registration of the Trademark in advance with the intention (unfair purposes) to exclusively use the Trademark for the business of B while recognizing the presence and the notoriety of Cited Trademark attached to the goods of the opponent, since the opponent did not register Cited Trademark with the goods of Classes 18 and 25. The unfair purposes include free ride on the notoriety of Cited Trademark

Therefore, it should be said that the Trademark is used for unfair purposes.

5 Closing

As described above, Cited Trademark was widely recognized by retailers who sell general merchandise in Japan, young women, and mothers having small children such as kindergartener and consumers in Korea as the mark for displaying the goods

used by the opponent on the filing date of the Trademark (May 25, 2013) and the date of the decision of registration (October 30, 2013). It can be acknowledged that the Trademark is similar to Cited Trademarks (A) to (C) and that the holder of the trademark right registered the Trademark with unfair purposes such as the free ride on the notoriety of Cited Trademarks (A) to (C).

Accordingly, the trademark's registration is in breach of Article 4(1)(xix) of the Trademark Act.

No. 5 Opinion of the holder of the trademark right

The owner of the trademark right has submitted no opinion in response to the notice of reasons for revocation described in No. 4 above, although the specified period of time has passed.

No. 6 Judgment by the body

The Trademark is as indicated in No. 1.

It is acknowledged that the notice of reasons for revocation described in No. 4 for the Trademark is reasonable.

Therefore, since the registration of the Trademark is in breach of Article 4(1)(xix) of the Trademark Act, the registration of the Trademark should be canceled under the provisions of Article 43-3(2) without determining the other grounds of the opposition.

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

November 27, 2015

Chief administrative judge: DOI, Keiko

Administrative judge: OMORI, Kenji

Administrative judge: HARADA, Nobuhiko

Attachments (regarding colors, refer to the original)

(1) The Trademark

LE SUCRE

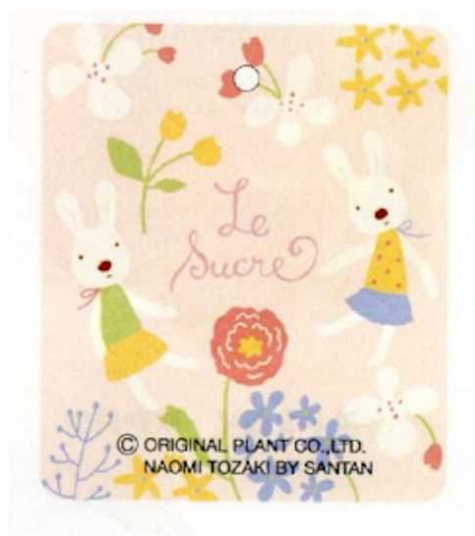
ル シュクル

The followings are Cited Trademarks

(2)



(3)



(4)



(5)



(6)



(7)



(8)



(9)



(10)



(11)



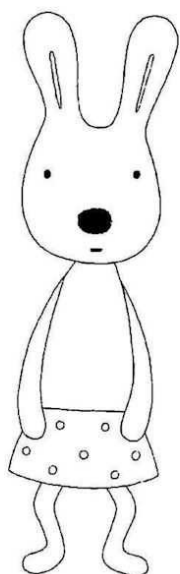
(12)



(13) Trademark Registration No. 5167977

le sucre
ル.シュクル

(14) Trademark Registration Nos. 5324656 and 5607847



(15) Trademark Registration No. 5561880

