

Decision on opposition

Opposition No. 2014-900232

Hokkaido, Japan

Trademark Right Holder MEDIACOM INC.

USA

Trademark Opponent TWITTER INC.

Tokyo, Japan

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Decision on the opposition to the grant of the trademark registration No. 5671271 is concluded as follows:

Conclusion

The trademark registration No. 5671271 is cancelled.

Reason

1 The Trademark

The trademark with Trademark Registration No. 5671271 (hereinafter referred to as the "Trademark") consists of Alphabetic standard characters of "VOICE TWITTER", the application for its registration was filed on July 26, 2013, the decision for registration of the Trademark was issued on April 8, 2014, and the Trademark was registered on May 23, 2014 with designated services of Class No. 38 "Real-time, bidirectional online communication among users using a computer, a portable computer, or a wired or wireless communication device; Communication for exchanging messages

by electrical mail, instant messaging over Internet, or a website over Internet; Communication by electronic bulletin board of a chat room style; Other communication by electronic bulletin board; Communication utilizing computers, with messages and images; Electronic bulletin board communication over weblog; Communication by cellular phones; Communication by electronic computer terminals utilizing global computer networks; Other electronic communication other than broadcasting; Broadcasting", and Class No. 45 "Provision of personal information such as a profile or a diary via an electronic bulletin board on the Internet; Provision of information to general users for searching for or introducing a friend through a website over the Internet; Introducing a friend to a person who hopes to form a friendship with a person, utilizing a website over the Internet".

2 Cited Trademarks

The trademarks cited by the person who is in opposition to the registration of the Trademark (hereinafter referred to as "opponent") as reasons for opposition to the registration are as listed below, and they are still valid as of now.

(1) Trademark Registration No. 5188811 (hereinafter referred to as "Cited Trademark 1") consists of Alphabetic standard character of "TWITTER", the application for its registration was filed on October 26, 2007, claiming priority under the Paris Convention Article 4 based on the application for registration of the trademark which was filed on April 26, 2007 in the United States of America, and the Trademark was registered on December 12, 2008 with designated services of Class No. 38 "Real-time, bidirectional online communication among users using a computer, a portable computer, or a wired or wireless communication device; Communication for exchanging messages by electrical mail, instant messaging over Internet, or a website over Internet; Communication by electronic bulletin board of a chat room style; Other communication by electronic bulletin board; Communication utilizing computers, with messages and images; Electronic bulletin board communication over weblog; Communication by cellular phones; Communication by electronic computer terminals utilizing global computer networks; Other electronic communication; Broadcasting", Class No. 42 "Rental of storage area of a social networking server with which users interact over the Internet", and Class No. 45 "Provision of personal information such as a profile or a diary via an electronic bulletin board on the Internet; Provision of information to general users for searching for or introducing a friend through a website over the Internet; Introducing a person of an opposite sex to a person who desires marriage or companionship; Introducing a friend to a person who hopes to form a friendship with a

person, utilizing a website over the Internet".

(2) Trademark Registration No. 5278420 (hereinafter referred to as "Cited Trademark 2") consists of standard characters of "ついったー"; the application for its registration was filed on June 9, 2009; and the Trademark was registered on November 6, 2009 with designated services of Class No. 38 "Real-time, bidirectional online communication among users using a computer, a portable computer, or a wired or wireless communication device; Communication for exchanging messages by electrical mail, instant messaging over Internet, or a website over Internet; Communication by electronic bulletin board of a chat room style; Other communication by electronic bulletin board; Communication utilizing computers, with messages and images; Electronic bulletin board communication over weblog; Communication by cellular phones; Communication by electronic computer terminals utilizing global computer networks; Other electronic communication; Broadcasting", Class No. 42 "Rental of storage area of a social networking server with which users interact over the Internet", and Class No. 45 "Provision of personal information such as a profile or a diary via an electronic bulletin board on the Internet; Provision of information to general users for searching for or introducing a friend through a website over the Internet; Introducing a person of an opposite sex to a person who desires marriage or companionship; Introducing a friend to a person who hopes to form a friendship with a person, utilizing a website over the Internet".

Hereinafter those trademarks are collectively referred to as "Cited Trademarks" in some cases.

3 Reasons for opposition against the registration

The opponent asserted that the Trademark fell under Article 4(1)(xi) and Article 4(1)(xv) of the Trademark Act and thus its registration should be cancelled, and summarized and mentioned reasons for opposition as follows and submitted Evidence A Nos. 1 to 35 as means of evidence.

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

The Trademark includes in its configuration a "TWITTER" character string, which is common in appearance, meaning, and pronunciation with the Cited Trademark 1 notably known in our country as representing the services provided by the opponent and which is common in meaning and pronunciation with the Cited Trademark 2.

In addition, the designated services of the Trademark are identical or similar to those of the Cited Trademarks, and the Trademark is similar to the Cited Trademarks.

Therefore, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

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

"TWITTER" is widely known to consumers in our country as representing the services provided by the opponent.

The Trademark causes consumers coming into contact with it to easily recall the opponent or the notable trademark "TWITTER" of the opponent. Thus, if the Trademark is used for its designated services, it is likely to cause confusion about the source with the services provided by the opponent.

Therefore, the Trademark falls under Article 4(1)(xv) of the Trademark Act.

4. Reasons for rescission by the body

The content of the notice of reasons for rescission notified by the body on February 12, 2015 to the holder of trademark right is as indicated in the Attachment.

5. Opinion of the holder of the trademark right

The holder of the trademark right has submitted no opinion in response to the reasons for rescission mentioned in 4 above.

6. Judgement by the body

It is acknowledged that the reasons for rescission of the Trademark which are described in 4 above are reasonable.

Therefore, the registration of the Trademark is contrary to Article 4(1)(xi) of Trademark Act and thus the registration shall be cancelled in accordance with Article 43(3)(ii) of the Trademark Act.

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

April 16, 2015

Chief administrative judge: KONDA, Mitsuo

Administrative judge: IDE, Eiichiro

Administrative judge: TANAKA, Kyoko

Attachment (reasons for rescission by the body)

1. Regarding well-knownness of the Cited Trademarks of the opponent

The opponent is a company with headquarters in the State of California of the

United States of America. The company has been providing a "real-time short message service" via the website "Twitter" on the Internet since March 2006, which service allows use of several networks and devices (Evidence A No. 7).

The above-described website "Twitter" (ツイッター, ついったー) is a communication tool intermediately positioned between weblog and electronic mail. The tool is characterized in supporting only short messages within 140 characters and is available for use with a personal computer or a cell-phone capable of connecting to the Internet.

In the website "Twitter" (ツイッター, ついったー), a user can post a short message and another user can browse or reply to the posted message (Evidence A No. 8).

In our country, the real-time short message service "Twitter" provided by the opponent was launched on July 16, 2006, and since then the number of the users registered with the website "Twitter" (ツイッター, ついったー) has been steadily increased to exceed five millions in January 2010. The service has been commonly and widely used and has drawn attention from mass-communication such as newspapers and magazines, and the awareness of the service has reached 70.2% (Evidence A Nos. 9 to 12).

The above-described website and the real-time short message service "Twitter" (ツイッター, ついったー) have been introduced many times through media such as magazines and the Internet (Evidence A Nos. 8, 10, 26, and 28 to 35).

In "Awareness of SNS, Twitter and Facebook marked 98%" of "ASCII.jp" dated December 27, 2012, there is an article that reads: "A questionnaire on the awareness of SNS shows that, by evaluating the number of people who have answered with 'have knowledge of the content' or 'have heard of it', 'Twitter' marks the largest percentage (98.7%)" (Evidence A No. 26).

In light of the foregoing, it can be said that "Twitter (ツイッター, ついったー)" had been already widely recognized by traders and consumers in our country as the trademark indicating the website or the real-time short message service related to the operation of the opponent at the time of application for the registration of the Trademark, and it is acknowledged that that status had continued even at the time of the decision for registration of the Trademark.

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

(1) Regarding the Trademark

The Trademark consists of standard characters of "VOICE TWITTER" and is configured by a "VOICE" character string and a "TWITTER" character string with a

space interposed therebetween, and thus it is readily recognized to consist of the words "VOICE" and "TWITTER".

The Alphabetic character "TWITTER" in that configuration has, as described in 1 above, the same spelling as the Alphabetic character "TWITTER" which had been already widely recognized at the time of application for the registration of the Trademark as the trademark indicating the website or the real-time short message service related to the operation of the opponent by traders and consumers in our country. Thus, it is reasonable to say that that Alphabetic character "TWITTER" of the Trademark gives a strong, dominant impression to the traders and consumer as a mark identifying the source of service.

Therefore, it is acknowledged that the character string "TWITTER" in the Trademark gives rise to the pronunciation of "ツイッター(tsuittaa)" and generates the meaning of the "TWITTER (ツイッター, つிட்டー)" as the "real-time short message service" related to the operation of the opponent.

(2) Regarding the Cited Trademarks

The Cited Trademarks 1 and 2 respectively consist of standard characters of "TWITTER" and "つிட்டー", and thus give rise to the pronunciation of "ツイッター(tsuittaa)" from those characters, and generate the meaning of the "TWITTER (ツイッター, つிட்டー)" as the "real-time short message service" related to the operation of the opponent.

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

A. Considering similarity between the Trademark and the Cited Trademark 1, as to appearance, the Trademark includes in its configuration a "TWITTER" Alphabetic character, which performs the function for distinguishing relevant services from others independently, and the Cited Trademark 1 consists of the "TWITTER" Alphabetic character. Thus, both the trademarks are confusing each other in terms of appearance with respect to the "TWITTER" Alphabetic character.

Next, as to pronunciation, the Trademark and the Cited Trademark 1 both give rise to the pronunciation of "ツイッター(tsuittaa)".

As to meaning, the Trademark and the Cited Trademark 1 both generate the meaning of the "Twitter (ツイッター, つிட்டー)" as the "real-time short message service" related to the operation of the opponent.

Therefore, it is acknowledged that the Trademark is similar to the Cited Trademark 1 in terms of appearance, pronunciation, and meaning.

B. Considering similarity between the Trademark and the Cited Trademark 2, they have clear difference in their appearances in light of their configurations, and thus

they are clearly distinguishable in terms of appearance.

Next, as to pronunciation, the Trademark and the Cited Trademark 2 both give rise to the pronunciation of "ツイッター(tsuittaa)" .

As to meaning, the Trademark and the Cited Trademark 2 both generate the meaning of the "Twitter (ツイッター, ついったー)" as the "real-time short message service" related to the operation of the opponent.

Therefore, it is acknowledged that even taking into consideration the difference in appearance, the Trademark and the Cited Trademark 2 are similar trademarks, which are common in pronunciation and meaning.

(4) Regarding similarity in designated services between the Trademark and the Cited Trademarks

The designated services of the Trademark are included in the designated services of the Cited Trademarks, and are identical or similar to the designated services of the Cited Trademarks.

(5) Summary

Therefore, the Trademark falls under Article 4(1)(xi) of the Trademark Act.