

Appeal decision

Appeal No. 2015-5083

Osaka, Japan

Appellant IKEDA CHIKYU

Osaka, Japan

Patent Attorney AKIYAMA, Shigeo

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2014-27154 has resulted in the following appeal decision:

Conclusion

The appeal of the case was groundless.

Reason

1 The trademark in the Application

The trademark in the Application consists of the Alphabetic characters "ROYAL PRESTIGE NEO" in horizontal writing and the application for its registration was filed on April 8, 2014 with Class No. 18 "Bags and the like; pouches and the like" as the designated goods. However, the designated goods have been amended to Class No. 18 "Schoolchildren's backpacks" by the written amendment dated October 1, 2014 in the original examination.

2 Cited Trademark

The registered trademarks cited in the reasons for refusal of the present application in the examiner's decision because the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act are described in (1) and (2) below. The trademark rights are still effective.

(1) Trademark Registration No. 4062650 (referred to as "Cited Trademark 1" below) has a structure as attached. The application for its registration was filed on May 2, 1996, and the trademark was registered on October 3, 1997 with Class No. 18 "Bags and the

like; pouches and the like; and umbrella." as the designated goods. After that, the renewal of duration of the trademark right was registered on October 2, 2007.

(2) Trademark Registration No. 4073708 (referred to as "Cited Trademark 2" below) consists of the Alphabetic characters "ROYAL PRESTIGE" written in horizontal writing. The application for its registration was filed on May 2, 1996, and the trademark was registered on October 24, 1997 with Class No. 18 "Bags and the like; pouches and the like; and umbrella." as the designated goods. After that, the renewal of duration of the trademark right was registered on October 9, 2007.

(These trademarks may be collectively referred to as "Cited Trademark" below.)

3 Judgment by the body

(1) Regarding the trademark in the Application

A The trademark in the Application consists of the Alphabetic characters "ROYAL PRESTIGE NEO" in horizontal writing as described in 1 above. It has been generally known that the characters of "ROYAL" mean "royal" and the characters of "PRESTIGE" mean "prestige" and the characters of "NEO" mean "new" (referred to "Genius English-Japanese Dictionary" TAISHUKAN Publishing Co., Ltd) together with loan words of "royal," "prestige," and "neo" having the above respective words as etymology.

B The trademark in the Application is a relatively redundant word formed of three words; i.e., "ROYAL," "PRESTIGE," and "NEO." Therefore, it is considered that traders and consumers who have contact with the trademark in the Application observe the trademark in the Application by dividing it by units which respectively have adequate meanings. A problem occurs in terms of whether the three words are recognized as a word in which three words are normally and subsequently connected from the beginning to the next word. In the relation with the designated goods of the trademark in the Application, as described below, it is considered that the traders and the consumers who have contact with the trademark in the Application recognize the part of "ROYAL PRESTIGE" as a group of words and observe the part of "NEO" at the end as being divided from the part of "ROYAL PRESTIGE."

That is, when considering the order and meaning of the words forming the trademark in the Application, "ROYAL PRESTIGE" has a natural implication such as "fame of king." Whereas, it is difficult to consider that "NEO" (new) at the end modifies the "ROYAL" and "PRESTIGE" immediately before that and that the three words are understood as an implication of "new king's(fame)" and "new fame(king's)." Also, "NEO" (new) is a word which generally indicates the quality of goods as

described in the examiner's decision. It is assumed that the "NEO" does not have a function for distinguishing relevant products from others, or is an extremely weak part. In the industry for dealing with Schoolchildren's backpacks, bags, and the like, as described in examples in (A) to (C) below, the word "NEO" is used to indicate that the good is different from traditional ones or that the good is the latest product, by providing the word "NEO" or a phonogram of "ネオ" at the end of the product name and series trade name. When the trademark in the Application is used for the designated goods, the traders and the consumers who have contact with the trademark in the Application should recognize the part of "ROYAL PRESTIGE" as a group of words having the implication of "fame of king" and the part of "NEO" as the quality of goods.

(A) On the website entitled "EDDY LAND RAKUTENSHOP," Schoolchildren's backpacks "アークネオ (ARC NEO)" manufactured by MURASEKABANKO are introduced as an "ARC" which has obtained the name of "NEO" so as to "obtain more beautiful form." On the same homepage, the Schoolchildren's backpack "'ARC' fit-chan model for boys" manufactured by MURASEKABANKO is posted as goods which are not sold now.

(<http://item.rakuten.co.jp/rand-okoku/arc52/>) (ARC NEO)

(<http://item.rakuten.co.jp/rand-okoku/edlc51112b/>) (ARC)

(B) On the website of "LONGCHAMP" on the Internet, the bag "ル・プリアージュ・ネオ (Le Pliage Neo)" sold by LONGCHAMP is introduced as "Le Pliage Neo which is made in more modern form based on Le Pliage Neo" on the page entitled "check Le Pliage Neo" (® is written after the characters of "Le Pliage").

(<http://jp.longchamp.com/pliage/neo>)

(C) On the website of "YOSHIDA&CO., LTD" on the Internet, series goods of "LINER NEO" sold by Yoshida & Co., Ltd. are introduced as that "This is a total casual series produced for the 30th anniversary of the LUGGAGE LABEL brand. The series goods is reconstructed by using newly developed PVC processed fabric based on the "LINER" and "NEW LINER" series which were very popular from the 1980's to 1990's as a series for representing the brand. A new type of bag such as a waist bag which is not included in "LINER" and "NEW LINER" is added, and some types of bags are made in a light form by changing their specifications.

(http://www.yoshidakaban.com/product/103285.html?p=s&p_series=971&p_lisize=30&p_lisort=)

C Then, the part of "ROYAL PRESTIGE" of the trademark in the Application should give strong dominant impression to the traders and the consumers as a mark for distinguishing relevant products from others. Therefore, this part is extracted as a

primary part, and the similarity between the trademarks can be determined by comparing this part with the other person's trademark (Cited Trademark).

Accordingly, the trademark in the Application includes the pronunciation of "roiyarupuresuteijineo" which is generated from the whole configuration. In addition to this, the trademark in the Application includes the pronunciation of "roiyarupuresuteiji" and the meaning of "fame of king" corresponding to the characters of "ROYAL PRESTIGE" which can be the primary part.

(2) Regarding the Cited Trademark

Cited Trademark 1 is a composite trademark obtained by combining a figure resembling a crest with the Alphabetic characters of "ROYAL PRESTIGE" as attached. The figure part does not generate a specific pronunciation and meaning. Whereas, the character part generates the pronunciation of "roiyarupuresuteiji" and the meaning of "fame of king." Therefore, the figure and the characters do not have any connections regarding the pronunciation and the meaning, and it cannot be said that the figure and the characters are inseparably integrated with each other so as to be considered that it is not natural to observe the figure and the characters by dividing them in business. Then, it is reasonable to acknowledge that the character part of Cited Trademark 1 can be recognized as the mark for distinguishing the relevant product source from others to be independent from the figure part.

Accordingly, Cited Trademark 1 generates the pronunciation of "roiyarupuresuteiji" and the meaning of "fame of king" corresponding to the character part of "ROYAL PRESTIGE" which can be the primary part.

As described in 2(2), Cited Trademark 2 is formed of the Alphabetic characters "ROYAL PRESTIGE." Therefore, Cited Trademark 2 generates the pronunciation of "roiyarupuresuteiji" and the meaning of "fame of king" corresponding to the characters.

(3) Similarity between the trademark in the Application and Cited Trademark

When the similarity between the trademark in the Application and Cited Trademark is considered, the primary parts of the two are compared with each other. In the comparison, since they have a spelling of "ROYAL PRESTIGE" in common and have the pronunciation of "roiyarupuresuteiji" and the meaning of "fame of king" in common, the trademark in the Application and the Cited Trademark are similar trademarks which should be confused with each other.

Also, the designated goods of the trademark in the Application are the same as or similar to those of Cited Trademark.

(4) Appellant's allegation

The appellant insisted that since the word "ROYAL" is used as a word which

has meaning such as the highest grade in the Schoolchildren's backpacks industry, the trademark in the Application should be compared with the other trademarks as assuming the part of "PRESTIGE NEO" of the trademark in the Application for generating the meaning of "new fame" as the primary part.

However, as described in (1)B, in consideration of the order and meaning of the words forming the trademark in the Application, "ROYAL PRESTIGE" is recognized as the natural implication such as "fame of king." Whereas, it is difficult to consider that "NEO" (new) at the end modifies "ROYAL" and "PRESTIGE" immediately before that and that the three words are understood as an implication of "new king's(fame)" and "new fame (king's)" Also, "NEO" (new) is the word which generally indicates the quality of goods, and it is assumed that "NEO" does not have the function for distinguishing relevant products from others or be an extremely weak part. In the industry for dealing with Schoolchildren's backpacks, bags, and the like, the word "NEO" is used to indicate that the good is different from traditional ones or that the good is the latest product, by providing the word "NEO" or the phonogram of "ネオ (NEO)" at the end of the product name and series trade name. According to this, when the trademark in the Application is used for the designated goods, the traders and the consumers who have contact with the trademark in the Application should recognize the part of "ROYAL PRESTIGE" as a group of words having the implication of "fame of king" and the part of "NEO" as only indicating the quality of goods.

In the Schoolchildren's backpacks industry, even when there is a case where "ROYAL" is recognized as a quality word, it is difficult to consider that "ROYAL" is the quality word indicating the highest grade in the relation with the order and meaning of the words in the trademark in the Application. The appellant's allegation cannot be accepted.

In addition, the appellant insists that the trademark in the Application should be registered similarly to the registered examples in the past. However, the similarity of the trademark should be specifically and individually determined by considering the configuration and the aspect of the trademark and the actual state of transaction of the goods and comparing the trademark in the Application and Cited Trademark in this case at the time of the decision or appeal decision of the present trademark. The trademark in the Application should not be bound by the determination of the registered example in the past and the like.

Accordingly, any of the appellant's allegations cannot be accepted.

(5) Closing

As described above, the trademark in the Application is similar to Cited

Trademark, and the designated goods of the trademark in the Application are the same as or similar to those of Cited Trademark. Therefore, it falls under Article 4(1)(xi) of the Trademark Act, and the trademark in the Application shall not be registered.

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

October 26, 2015

Chief administrative judge: TANAKA, Koichi

Administrative judge: TAMURA, Masaaki

Administrative judge: TOMISAWA, Takeshi

Attachment Cited Trademark 1 (Trademark Registration No. 4062650)

