

Appeal Decision

Appeal No. 2015-14700

Tokyo, Japan

Appellant

KIRIN COMPANY, LIMITED

Tokyo, Japan

Patent Attorney

IIJIMA, Nobuyuki

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2013-91335 has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reasons

No. 1 The mark in the application

The mark in the application is configured as indicated in Attachment, and the application for its registration was filed on November 21, 2013 by setting the goods as described in the application which belong to Class Nos. 29, 30, 32, and 33 as the designated goods, as a defensive mark of Trademark Registration No. 5600157 (hereinafter referred to as "original registered trademark"). The designated goods were then amended by the written amendment received on August 24, 2015 in the body to Class No. 29 "Edible oils and fats (other than 'cottonseed oil and canola oil'); milk products; meat for human consumption; eggs; fresh, chilled or frozen edible aquatic animals (not live); frozen vegetables; frozen fruits; processed meat products; processed fisheries products; processed vegetables and fruits; fried tofu pieces (abura-age); freeze-dried tofu pieces (kohri-dofu); jelly made from devils' tongue root (konnyaku); soya milk (milk substitute);tofu ; fermented soybeans (Natto); processed eggs; pre-cooked curry stew, stew and soup mixes; dried flakes of laver for sprinkling on rice in hot water (ochazuke-nori); seasoned powder for sprinkling on rice (furi-kake); side-dish made of fermented soybean (Name-mono); preserved pulses; protein for human consumption.", Class 30 "Binding agents for ice cream; meat tenderizers for household purposes; preparations for stiffening whipped cream; aromatic preparations for food (not from

'Essential oils'); tea; black tea (English tea); coffee; cocoa; ice; confectionery; bread and buns; sandwiches; steamed buns stuffed with minced meat (Chinese-manjuh); hamburgers (sandwiches); pizzas; hot dogs (sandwiches); meat pies; seasonings (other than 'soya bean paste, Chinese noodle soup'); spices; ice cream mixes; sherbet mixes; unroasted coffee beans; rice porridge; cereal preparations; Chinese stuffed dumplings (gyoza); Chinese steamed dumplings (shumai); sushi; fried balls of batter mix with small pieces of octopus (takoyaki); box lunches; ravioli; yeast powder; fermenting malted rice (koji); yeast; baking powder; instant confectionery mixes; pasta sauce; by-product of rice for food (Sake lees); husked rice; husked oats; husked barley; gluten for food; flour.", Class 32 "Carbonated drinks (refreshing beverages); fruit juices; vegetable juices (beverage); extracts of hops for making beer; whey beverages.", and Class 33 "Chinese liquors; flavored tonic liquors."

No. 2 Original registered trademark

The original registered trademark consists of the form identical with the mark in the application, its application was filed on February 16, 2012, the trademark was registered on July 19, 2013 with "beer-flavored malt foam liquor" of Class 32 as its designated good, and it remains valid as of now.

No. 3 Reasons for refusal of the examiner's decision

The examiner's decision has found and judged that "with regard to the mark in the application, while the original registered trademark can be recognized to be known among consumers with respect to the product 'beer-flavored malt foam liquor', it cannot be recognized that it is well-known to the extent that confusion about the source of goods is caused in the designated goods of the application. Therefore, the mark in the application does not fulfill the requirement stipulated in Article 64 of the Trademark Act.", and rejected the application.

No. 4 Judgment by the body

1. Regarding Article 64(1) of the Trademark Act

Regarding Article 64(1) of the Trademark Act relates to the defensive mark registration system, and stipulates that "Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or

goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists."

Then, it is determined that "Where the original registered trademark has become well known among consumers, even the use of the original registered trademark by a third party in dissimilar product or services to which the intrinsic effects of a trademark right (Articles 36 and 37 of the Trademark Act) does not extend is likely to cause confusion about the source, and thus the capability to distinguish the source and/or trust may be insured. Therefore, the stipulation in the Article in question is provided for the purpose of preventing such a confusion in a broad sense so as to extend the effect of the trademark which is 'well known among consumers' with respect to dissimilar products or services. Then, with regard to the defensive mark registration, comprehensively allowing for the circumstances, i.e., 1) unlike regular Trademark registrations, Articles 3 and 4 of the Trademark Act are not included in the reasons for rejection; 2) rescission shall not be made for the reason of no-use; and 3) the effect thereof is extended compared to that of regular trademark registration, and thus is likely to restrict selection and use of Trademark by a third party, it should be understood that the requirement of 'registered trademark ... is well known among consumers' which is stipulated in Article 64(1) of the Trademark Act does not mean that only the registered trademark in question being well known is required, but means that, even in the case where goods or services are dissimilar, the capability to distinguish the source is provided to the extent that confusion about the source of goods is caused; i.e., prominence which leads to such an extent is possessed" (2009 (Gyo-Ke) 10198 by Intellectual Property High Court)

2. Regarding similarity between the mark in the application and the original registered trademark

As described in No. 1 and No. 2, the mark in the application is configured by the constitution identical with that of the original registered trademark. Then, it can be recognized that the appellant is identical with the holder of original registered trademark.

3. Regarding prominence of the original registered trademark

As stated in Attachment, the original registered trademark consists of characters of "淡麗 (Tanrei)" in standard letters in horizontal writing. When used in its designated good "beer-flavored malt foam liquor", this only provides the recognition of "clean and

smooth beer-flavored malt foam liquor having no pronounced flavor or taste", which only refers to the quality of product. Therefore, the original registered trademark has been rejected due to the reasons under the provision of Article 3(1)(iii) of the Trademark Act. However, as a result of using the characters "淡麗", this is the trademark by which consumers are able to recognize the goods as being connected with a business of the appellant, and thus the trademark was registered as fulfilling the requirements under Article 3(2) of the same Act.

Then, it can be said that the original registered trademark is a trademark which is well known among consumers as indicating the product handled by the appellant when used in the product "Beer-flavored malt foam liquor".

4. Regarding confusion about the source

As stated in 1 above, it is necessary for the mark to which a defensive mark registration is granted to include the matter which "does not mean that only the registered trademark in question being well known is required, but means that, even in the case where goods or services are dissimilar, the capability to distinguish the source is provided to the extent that confusion about the source of goods is caused; i.e., prominence which leads to such an extent is possessed." In light of this, the consideration will be made below.

(1) Regarding the term "淡麗"

In relation to the good "Sake", the term "淡麗" means "no pronounced flavor or taste in Sake, and clean and smooth" ("*Kojien*, sixth edition," Iwanami Shoten, Publishers), and the it is recognized that term in question is used in the following cases, for example.

a. On the website "*Niigata tanrei*: Niigata Sake Brewers Association Official Website", under the heading of "What's *Niigata tanrei* Club", there is an explanation of "Birth of *Niigata tanrei*" in the section "Key point 1: What's *Niigata tanrei* Club" which states that "This is the creation of opportunity of the birth of '*Niigata tanrei*'. In the modern world in which peoples' lives became rich, liquors with lighter taste are preferred, resulting in the tendency of taste of *tanrei*".

(<http://niigata-Sake.or.jp/about/index01.html#key01>)

b. On the website "*Hakushika*", under the heading of "Hospitality in seasons: *Hakushika* in seasons", there is an explanation of products in the section of "*Hakushika ... tanrei karakuchi*" which states "*Tanrei karakuchi* Japanese Sake with lighter and dry taste but full of flavor, which is brewed by *Hakushika*'s traditional *mushigome jikomi* (preparation by steamed rice), carefully steamed white rice".

(<http://www.hakushika.co.jp/lineup/standard/0717.php>)

c. On the website "Belluna: Gourmet shopping", under the heading of "*Tanrei Karakuchi Junmaishu* (Japanese Sake made without added alcohol or sugar) of Hamada, Yamagata", there is a description, "Junmaishu that is *tanrei* but robust while drawing the flavor and lusciousness of rice itself at maximum".

(http://belluna-gourmet.com/01/012101/d/NE163/2001174/goods_detail/)

d. On the website "PINTORU", under the heading of "Niigata's Japanese Liquors Recommendation Ranking", there is a description, "They say Niigata's Japanese liquors gain a firm footing of *tanrei* and *karakuchi*, and Japanese liquors produced in rice producing regions are good! Many people associate Niigata with Japanese liquors".

(<http://food-drink.pintoru.com/Sake/Sake-of-niigata/>)

e. On the website "OENON Group", under the heading of "*Tanrei Karakuchi Fuki*", there is a description, "This is *tanrei* and has a sharp drinking feeling and tastes very clear and dry. You never get tired of drinking it, either warmed or cooled".

(<http://www.oenon.jp/product/Sake/normal/tanreikarakuchi-fuki.html>)

(2) Regarding the use of the term "淡麗" in foods and beverages

It is also recognized that the term "淡麗" is used in the following cases of foods and beverages other than those listed in section (1) above.

a. Regarding the use of good "coffee"

(a) On the website of "AGF", under the heading of "(Extraction) Regular coffee top-loading dripping: *tanrei* and bland coffee", there is a description, "this coffee is dedicated to Japanese people, and is made by selected roasting technique that brings out the best in well-selected beans harmonized with water in Japan. Gentle and delicate aroma is distinctive. Please enjoy clear taste like green tea gently brewed using *Kyusu* (a Japanese tea pot)."

(<http://www.agf.co.jp/lineup/sen/10286.html>)

(b) On the website of "Nestle Amuse", under the heading of "Nestle Products Lineup", there is a description in the section of introduction of the product "*Nescafe Komi-Baisen*", "*Nescafe Komi-Baisen*; Eco & System Package, *Maroyaka* and *tanrei*, Middle roast, 60g".

(http://d.nestle.jp/nescafe/koumi/nkb_chuiri_eco_system_60.html)

(c) On the website of "SAWAI COFFEE Beans & Leaf", there is a description in the section of the introduction of the product of "*Bimi Tanrei* Iced Coffee", "Excellent iced coffee, *Bimi Tanrei*; deeper taste attained by gently grinding each and every raw coffee bean to achieve pure and clear taste is very excellent in finishing quality that strikes

coffee connoisseurs deeply".

(<http://www.sawaicoffee.net/item/1286.html>)

b. Regarding the good "*ramen*"

(a) On the website of "NISSIN FOODS", under the heading of "'Myojo; Noodle's Club (Men's Club) R50, *tanrei* Chinese Needle' (sale on October, 14)", there is a description, "'*Tanrei* Chinese Noodle' for adults with clean but condensed deeper taste and palatable lusciousness in a cup as a whole".

(<https://www.nissin.com/jp/news/3251>)

(b) On the website of "KANNOSEIMEN", under the heading of "*Tanrei* Salt-type D", there is a description in the section of "features", "the noodles are made dedicated for *tanrei*-type soup by cutting the dough having improved resistance to oiling elongation using a very thin blade".

(<http://www.kannoseimen.com/products/04tanreisio/04/>)

(c) On the website of "Soukai-Drug", under the heading of "My Friend: easy-to-eat salt ramen with plain chicken soup (single)", there is a description, "salt ramen with selected transparent and *tanrei*-type chicken soup" and "My Friend: easy-to-eat salt ramen with plain chicken soup ()transparent and robust *tanrei*-type chicken soup; ()refreshing chicken soup with flavor of pot herbs fits nicely with chewy noodles".

(<http://www.soukai.com/P8329349/p.html>)

c. Regarding the use in the good "tea"

(a) On the website of "-Sotsuya-: Japanese white liquor (*Shochu*) shop: Kagoshima", under the heading of "Kagoshima Chiran tea: 500 ml PET bottle", there is a description, "product with our confidential finished quality advocating '*tanrei* and *umakuchi*'. Please take an opportunity to enjoy a luxury and excellent product once.

(http://oSakenet.tv/sotsuya/index.php?main_page=product_info&cPath=540_541&products_id=9626)

(b) On the website of "Chabo", under the heading of "● high grade Chinese tea [Chabo] series", there is a description of the characteristic of tea leaf in the section of the product name "White peony (*Shiro-botan*)", "tea with characteristic *tanrei* taste, taste for adult".

(<http://ctrading.co.jp/Shop%20koukyucha.htm>)

(c) On the website of "LUPICIA", under the heading of "*Gyokuro* (Refined green tea) '*Sho-fu*'", there is a description, "[*Gyokuro* '*Sho-fu*'] is mixture of '*Komakage*', which is tea endemic to *Uji*, and *tanrei*-flavored *Yabukita* from Shizuoka".

(<http://www.lupicia.com/shop/g/g12408001/>)

d. Regarding the use in the "soy source"

(a) On the website of "*KIJI*", under the heading of "*Usu-murasaki* 500ml", there is a

description, "*Usu-murasaki* is specially selected reduced-salt and light-colored soy sauce which is made to be *tanrei* and mild".

(<http://kidisyoyu.com/?pid=82556>)

(b) On the website of "FOOD HAMAOKA", under the heading of "*Kanazawa, Ono, Naoppe*, Light-colored soy sauce, 1 liter", there is a description, "'Naoppe' *tanrei* and light-colored soy sauce from Naogen Soysauce Co., Ltd., Ono, Kanazawa".

(<http://hamaoka-food.com/item/nao-usukuti/>)

(c) On the website of "YOSHINAGAJYOUZOU", under the heading of "clear light-colored soy sauce for *Sashimi* (sliced raw fish); *Tanrei Sashimi* (100ml)", there is a description, "Soy sauce for *Sashimi* based on light-colored soy sauce with clear taste and sweetness as soy source from Kagoshima. Light-colored soy sauce for *Sashimi* is very unusual. You can enjoy light-colored-soy-sauce-specific clear flavor and sweetness with a difference from *strong* soy sauce."

(<http://www.yoshibishi.com/SHOP/tanreisasimi100.html>)

As discussed above, the term "淡麗" is used not only for the good "*Sake*" but also for other foods and beverages, and thus it can be grasped and understood that the use therefor expresses the product "flavor" or "taste".

(3) Summary

Taking (1) and (2) above into consideration, it can be said that the characters of "淡麗" above are generally recognized as having the meaning like "no pronounced flavor or taste, clean and smooth" in relation to the good "*Sake*". Furthermore, as apparent from the fact presented in (2) above, it can be said that the use thereof can be grasped and understood as expressing "flavor" or "taste" even in the other food and beverage products such as coffee, *ramen* soup, tea, and soy source. It is thus reasonable to determine that the characters are generally recognized as having the same meaning as that of the good "*Sake*".

Considering this, it can be said that, regarding the mark in the application, the goods are recognized as those relating to the business of the appellant in relation to "beer-flavored malt foam liquor" which is the designated good of the original registered trademark. However, it is reasonable to determine that the mark in question is often recognized as that expressing "flavor" or "taste" of the product, rather than as that suggesting that it is the product relating to the business of the appellant, in relation to other foods and beverages.

Furthermore, in the fact that the term "淡麗" is used in other foods and beverages, there can be found no circumstance which reveals that confusion about the

source of goods is caused as if the goods in question are those relating to the business of the appellant or a person who has a certain relation with the appellant.

Considering this, it can be said that the original registered trademark is a trademark which is widely recognized among consumers as indicating the good handled by the appellant when used in its designated good "beer-flavored malt foam liquor". However, it cannot be said that the original registered trademark is provided with capability of distinguishing to the extent that confusion about the source about the goods is caused in relation to the designated goods of the present application. Therefore, it cannot be said that the mark in the application is likely to cause confusion about the source of goods as if the goods in question are those relating to the business of the appellant or a person who has a certain relation with the demandant.

5. Appellant's allegation

The appellant alleged that the mark in the application fulfills the requirement stipulated in Article 64 of the Trademark Act, whose summary is as follows, and submitted Exhibit A No. 1 to Exhibit A No. 42 (including their branch numbers) on the evidence thereof.

(1) The term "淡麗" does not refer to the quality of product

The appellant alleges as follows. "Regarding the characters '淡麗', we do not deny the fact stated in '*Kojien*, sixth edition, Iwanami Shoten, Publishers'. However, other major dictionaries and glossaries not contain the term (Exhibit A No. 24 to Exhibit A No. 28), and no other appearance can be found even in glossaries or dictionaries of food in which the term appears as a term expressing taste or relish of a product (Exhibit A No. 29 to Exhibit A No. 33). Furthermore, all the cases of use of the term "淡麗" presented in the original examination create an impression of describing taste or relish, but it is impossible to understand the specific meaning thereof. Furthermore, according to a questionnaire survey concerning the term "淡麗" (Exhibit A No. 42), in response to the questions "What do you associate with '淡麗'?", "What sort of matter about '淡麗' do you know?", "If '淡麗' is used as a product name of food and beverage, do you think it may a product of Kirin Brewery Company or that of Kirin Brewery-related companies?", and "Do you know Kirin's sparkling liquor '淡麗'? And, have you drunk it?", it has been revealed that "Kirin's sparkling liquor '淡麗' is recognized in a large number of answers. Considering this, where the mark in the application is used in its designated goods, even if there may be the case where "淡麗" is envisaged which is the "beer-flavored malt foam liquor" in connection with the business of Kirin Brewery

Company who is a subsidiary of the appellant, no particular meaning can be generally recognized. Therefore, the mark in the application does not refer to the quality of product".

However, it can be said that the characters of "淡麗" are generally recognized to mean the property of "no pronounced flavor or taste, and clean and smooth", and in that sense it is used as indicating "flavor" or "taste" of not only Japanese liquors but any other foods and beverages. Therefore, the characters in question are generally recognized as having such a meaning also in the field of foods and beverages, as stated in 4 above. Then, in the first place, where a term which is generally recognized to express a specific "flavor" or "taste", etc., is used for a product, the "flavor" or "taste" of the product is indicated by the term in question. Therefore, even though there is no description which explains the term in question, the specific meaning of the term can be understood, and the general view of the term in question is not denied. Furthermore, in the questionnaire survey submitted by the appellant, the question items initially contain the term "Kirin Brewery Company" or "Kirin" which evokes the appellant or Kirin Brewery Company who is a subsidiary of the appellant; i.e., "If '淡麗' is used as a product name of food and beverage, do you think it may a product of Kirin Brewery Company or that of Kirin Brewery-related companies?", and "Do you know Kirin's sparkling liquor '淡麗'? And, have you drunk it?". Therefore, it has to be said that this cannot be directly regarded as a questionnaire showing the recognition of general consumers to the characters of "淡麗".

Therefore, the appellant's allegation discussed above cannot be accepted.

(2) Regarding possibility of occurrence of confusion about the source

The appellant alleges as follows. "In light of the fact that the original registered trademark was registered by applying the provision of Article 3(2) of the Trademark Act (Exhibit A No. 1 to Exhibit A No. 14), the original registered trademark and the mark in the application are widely known among consumers as expressing 'beer-flavored malt foam liquor' in connection with the business of Kirin Brewery Company who is a subsidiary of the appellant, and it is obvious that the original registered trademark and the mark in the application involve a strong capability of distinguishing relevant products from others. Then, when it is examined whether or not the mark in the application involves a capability of distinguishing relevant products from others to the extent that confusion about the source is caused to the range of its designated good, it has to be said that the recognition of traders and consumers should be taken into consideration. However, the designated good of the mark in the application and the

designated good of the original registered trademark are relatively inexpensive daily consumption goods, and the traders and consumers thereof widely include general consumers. It is thus impossible to expect to pay careful attention to what sort of meaning the term constituting the trademark used in the goods has. Therefore, with reference to the attention that traders or consumers pay ordinarily in such a manner, even if the term '淡麗' is used in the designated good of the mark in the application, it is natural that a particular meaning cannot be recognized generally although '淡麗' may be suggested and evoked as the mark of distinguishing relevant products from others of "beer-flavored malt foam liquor" relating to the business of companies related to Kirin Brewery-related, who is a subsidiary of the appellant. Then, sale promotion for "beer-flavored malt foam liquor" in which the characters '淡麗' are used has been conducted with some thought so that the related food becomes highly noticeable by general consumers (Exhibit A No. 18), and also, collaboration is performed in which the product is introduced using identical advertising materials (Exhibit A No. 19 to Exhibit A No. 21). As such, there is the circumstance in which only recognition or hearing of the name thereof evokes the beer-flavored malt foam liquor '淡麗' available from companies related to Kirin Brewery, who is a subsidiary of the appellant, even everywhere in the food sales floor beyond the section of the liquor sales floor. Considering this, taking into consideration a strong capability of distinguishing relevant products from others and predominant prominence of the mark in the application, as well as the actual circumstances of trading of the designated good of the mark in the application, the mark in the application involves a strong capability of distinguishing relevant products from others to the extent that confusion about the source is caused to the range of its designated goods".

However, while the original registered trademark falls under Article 3(1)(iii) of the Trademark Act as that refers to the quality of product, as a result of being used thereof, it is recognized that the product relates to the business of the appellant, so that Article 2 of the same Act is exceptionally applied, resulting in the registration. This registration does not lead to negation of the recognition in which the term "淡麗" indicates "flavor" or "taste" of the good. Then, the recognition of the characters expressed in the mark is determined based on the recognition by general consumers in the field of its designated good. However, as discussed 4 above, it is reasonable that the term "淡麗" is often recognized to express "flavor" or "taste" of the good in relation to the designated good of the application. Considering this, it cannot be said that the original registered trademark is capable of distinguishing relevant products from others to the extent that confusion about the source of goods is caused in relation to the

designated goods of the application.

Therefore, the appellant's allegation cannot be accepted.

6. Conclusion

As described above, the original registered trademark involves prominence to the extent that confusion about the source of goods is caused in relation to the designated goods of the application. Therefore, it cannot be said that there is likelihood that confusion about the source may occur in the mark in the application in relation to the designated goods thereof.

Consequently, the mark in the application does not meet the requirement stipulated in Article 64 of the Trademark Act, and thus cannot be registered.

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

February 17, 2016

Chief administrative judge: HAYASHI, Eiji

Administrative judge: HARADA, Nobuhiko

Administrative judge: TAKAHASHI, Koji

Attachment (The mark in the application and the original registered trademark)



淡麗