

## Trial decision

Revocation No. 2015-300013

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The case of trial regarding the revocation of Trademark Registration No. 4247863 between the parties above has resulted in the following trial decision.

### Conclusion

The trademark registration of Trademark Registration No. 4247863 shall be cancelled.

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

### Reason

No. 1 The Trademark

The Trademark Registration No. 4247863 (referred to as "the Trademark" below) is configured as indicated in the Attachment (1), and the application for its registration was filed on March 26, 1997. Decision of registration was made on March 12, 1999 by setting Class No. 41 "Providing infant education information" as designated services, and the renewal of duration of the trademark right was registered on October 21, 2008.

The request for the trial was registered on January 21, 2015.

## No. 2 Argument of demandant

The demandant requested a trial decision whose content is the same as the conclusion and summarized and mentioned reasons for request and rebuttal against a reply (including Oral proceedings statement brief dated on August 17, 2015 and Written statement dated on October 15, 2015) as follows.

### 1 Statement of the demand

According to the investigation by the demandant, the fact cannot be found that the Trademark has been continuously used for more than three years in Japan by the holder of trademark right.

Also, the right of exclusive use and the right of non-exclusive use of the Trademark have not been registered. Therefore, there has been no fact that the holders of the above rights have used the Trademark.

Therefore, the registration of the Trademark must be invalidated in accordance with Article 50(1) of the Trademark Act.

### 2 Rebuttal against a reply

#### (1) Non-use of the Trademark

In the marks used by the demandee indicated in Evidence B No. 39, upper parts of "Used mark 1" (Attachment (2)-1), "Used mark 2" (Attachment (2)-2), and "Used mark 3" (Attachment (2)-3) are common to that of the Trademark. However, in lower parts of Used marks, the characters of "Child's Intelligence Media BOOKLOAn" are written. With this configuration, it cannot be understood that Used marks are formed of "CHiME" and "BOOKLOAn". Therefore, "Used marks 1, 2, and 3" cannot be deemed identical to the Trademark from a generally accepted perspective.

As mentioned by the demandee, "Used mark 4" (Attachment (2)-4) and "Used mark 5" (Attachment (2)-5) are formed of the upper part of the Trademark. Therefore, the Used marks 4 and 5 are obviously different from the Trademark.

Although an upper part of "Used mark 6" (Attachment (2)-6) is common to that of the Trademark, a lower part is written as "ブックローン". Therefore, Used mark 6

is different from the Trademark. In addition, "Used mark 6" is displayed only in a housetop advertising tower (sign). The trademark is a mark for distinguishing relevant services from others and is registered as the trademark when it is used as the mark for distinguishing relevant services from others. Therefore, it cannot be said that a mark in which "CHiME" and "ブックローン" are simply written in two lines in a housetop advertising tower (sign) is used as the mark for distinguishing relevant services from others. It is obvious that the above mark is not used as a mark for distinguishing relevant services from others regarding the designated services of "providing infant education information" of the Trademark (may be referred to as "the service" below).

In addition, it is deduced that Evidence B No. 37 was placed around 1997 according to the statement of delivery, and it is deduced that Evidence B No. 38 was placed around 1995 according to the statement of delivery. Therefore, it cannot be considered that the housetop advertising tower (sign) has been placed within the period of requiring proof from January 22, 2012 to January 21, 2015.

## (2) Non-use as designated services

The designated service of the Trademark is only "providing the infant education information". "Providing the infant education information" does not mean to provide "infant education" and means to provide information regarding "infant education"; for example, to widely informing the reader of a person, a cooperation, and a facility for providing "infant education".

However, Evidences B Nos. 3 and 4 are only advertisement materials of the product sold by the demandee, and it has not been proven that Evidences B Nos. 3 and 4 were used within the period of requiring proof of the trial.

Evidences B Nos. 5 to 8 are photographs of a permanent space in a shop. However, Evidences B Nos. 5 to 8 do not prove that "the infant education information is provided".

Evidences B Nos. 9, 10, 12 to 16, 20, and 21 relate to events held by the demandee. However, the Evidences do not prove that the demandee has "provided the infant education information". In addition, although the event is named "a class for infants", it can be found that the event was an activity for advertising the product sold by the demandee, according to the facts that an item of "sales amount" is included in the list and the description in the event result report. Seminars for collecting customers to sell products are frequently held in business, and the events held by the demandee are examples of such events. According to this, it can be said that the demandee has not performed "the infant education".

Evidence B No. 16 is a copy of a photograph of a lecture, and Evidences B Nos.

18 and 19 relate to sales and introduction of books. Therefore, Evidences B Nos. 16, 18, and 19 do not relate to the use of the Trademark for the designated services at all.

Evidences B Nos. 11, and 22 to 24 are photographs of products, and Evidences B Nos. 17, and 25 to 36 are advertisement materials such as brochures of the product, leaflets, catalogs, and DVDs for advertisement, and copies of bills of the advertisement materials. These evidences do not prove that the demandee has "provided the infant education information".

### (3) Summary

As described above, the means of proof submitted by the demandant does not prove the use of the Trademark for the designated services within three years before the registration of the trial of the case (referred to as "within the period required to prove trademark use" below).

3 Oral proceedings statement brief dated on August 17, 2015

#### (1) Similarity between used mark and the Trademark

The characters of "ChiME" combined with a figure of a bell provided at the place of a dot above "i" are largely and noticeably displayed in the upper part of the Trademark, and the above part can be independently recognized as a primary part. The demandee insists that the used marks and the Trademark are deemed identical to each other from generally accepted perspective because the characters of "ChiME" are combined with the figure of the bell provided at the place of the dot above "i" in Used marks 1 to 6.

However, even when the upper part of the Trademark can be independently recognized as the primary part, this only indicates that the Used marks are similar to the Trademark, and it cannot be said that Used marks are identical to the Trademark. The characters of "Child's Intelligence Media BOOKLOAn" are written in the lower part of Used marks 1 to 3, and the characters are not "BOOKLOAn". Therefore, Used marks 1 to 3 are not identical to the Trademark from a generally accepted perspective.

Used marks 4 and 5 which are formed by combining the characters of "ChiME" and the figure of the bell provided at the place of the dot above "i" are obviously not identical to the Trademark.

Since Katakana characters of "ブックローン" are written in the lower part of Used mark 6, and not the characters of "BOOKLOAn", Used mark 6 is not identical to the Trademark from a generally accepted perspective.

In addition, Used mark 6 is not used as a mark for distinguishing relevant services from others. Regarding this point, the demandee also acknowledged in the Oral proceedings statement brief, writing, "any one of Used marks 1 to 5 is used".

As described above, the demandee still does not prove the use of the Trademark.  
(2) Non-use for designated services

The demandee has stated that "The parents experience the infant education by using an intellectual training toy for infants with children so that the parents understand the method of infant education. This is 'providing the infant education information'". Also, the demandee has stated that the infant education information for parents of the infants has been provided in a lecture style in addition to the provision of the "experience-based" infant education information.

However, in consideration of the means of proof submitted by the demandee, it can be said that the above statements only indicate the activity for advertising the intellectual training toy for sales by the demandee. The use of Used marks 1 to 5 regarding the product is proved. However, the use regarding the services is not proved.

Especially, Evidences B Nos. 13 to 16 regarding the lecture do not display any mark.

Therefore, the demandee does not prove that the Trademark is used for the designated services.

4 Written statement dated on October 15, 2015

The demandee insists that the used trademarks (Used mark) are identical to the Trademark from a generally accepted perspective. However, as written in Refutation brief and Oral proceedings statement brief, it cannot be assumed that the used marks are identical to the Trademark from a generally accepted perspective.

Also, the demandee insisted that the used marks are used to "provide the infant education information" which is the designated services of the Trademark. However, the demandee has not submitted any means of proof indicating the fact.

As insisted above, the submitted Evidences B do not prove that the used marks are used for the designated services of the Trademark.

In addition, the demandee insisted that "providing the infant education information" includes providing the infant education information to the parents. However, the demandee has not submitted any means of proof which indicates that the used marks are used to provide the infant education information to the parents.

As described above, in the trial, it is not still proved that the Trademark is used for the designated services.

No. 3 Demandee's reply

The demandee made a reply to request the body to approve that the trial of the case was groundless and that the costs in connection with the trial shall be borne by the

demandant. The reasons (including Oral proceedings statement brief dated August 12, 2015 and Written statement dated October 1, 2015) are summarized and mentioned as follows. The demandee has submitted Evidences B Nos. 1 to 39 as the means of proof.

#### 1 Statement of the reply

##### (1) Use of the Trademark

The demandee (the holder of trademark right) has used the Trademark for the designated services of "providing the infant education information" regarding the trial of the case in Japan within the period required to prove trademark use.

##### (2) Structure of the Trademark

The Trademark is configured of the upper and lower parts. In the upper part, Alphabetic characters of "CHiME" are largely and noticeably combined with the figure of the bell provided at the place of the dot above "i". In the lower part, Alphabetic characters of "BOOKLOAn", which are smaller than the characters in the upper part, are written.

##### (3) Fact of use

A BookLoan Co.Ltd., which is the holder of trademark right (referred to as "BookLoan" below) was established on June 24, 1965 and is a corporation which mainly manufactures and sells intellectual training toys and books and provides intellectual education by using them. The holder of trademark right has started to provide intellectual education and intellectual education information since around 1970 and has provided intellectual education and intellectual education information while using the Trademark since 1993 until the present day. Also, the holder of trademark right educates infants by using an intellectual training toy "Livelock" manufactured by itself and an intellectual training book "Chichro" published by a group company. At the same time, the holder of trademark right provides the infant education information to parents of the infants. That is, the holder of trademark right has provided the service by using the Trademark from January 21, 2012 to January 21, 2015 by using the intellectual training toys and books.

This kind of service such as intellectual education by using an intellectual training toy and the like is also provided by, for example, LEGO Group (registered trademark), and this service is a comparatively popular activity.

B Specifically, the holder of trademark right (a) has provided the infant education information by using the Trademark since March, 1998 until now at the sites of the company and the group companies, and the product "Livelock" manufactured by itself (Evidences B Nos. 3 and 4), (b) has provided the infant education and the infant education information by using the intellectual training toy "Livelock" for the infants

and their parents as using the Trademark since December, 2005 until now by providing a permanent corner for intellectual education in KIKUYA book shops managed by the group company (Evidences B Nos. 5 to 8), (c) has provided the infant education and infant education information by using the intellectual training toy "Livlock" for the infants and their parents as using the Trademark in the events which have irregularly held since November, 2006 until now, mainly in the KIKUYA book shops in large shopping centers (Evidences B Nos. 9 to 21), (d) has used the Trademark in the intellectual training toy, brochures, and leaflets to provide the services of (a) to (c) (Evidences B Nos. 22 to 34). (e) The permanent space described in (b) and the event in each place described in (c) are introduced on the Facebook page and the Google + page of the intellectual training toy (Livlock) of itself. As is obvious in these pages, the infant education (class for infant) and the infant education information have been provided in the permanent space and the events in various places at least since June 6, 2013 to January 20, 2015 (Evidences B Nos. 35 and 36). (f) The Trademark has been displayed on the sign on the building of the own company since December, 1997 at the latest until now (Evidences B Nos. 37 and 38).

#### (4) Use mode of the Trademark

A The infant education information is provided and Used marks 1 to 3 are used at the sites of the holder of trademark right and its group company and the site of Livlock (Evidences B Nos. 3 and 4).

B Used marks 2 and 4 are used at permanent spaces such as KIKUYA book shops for providing the infant education for infants and the infant education information to the parents of the infants managed by the holder of trademark right and (Evidences B Nos. 5 to 8).

C Used marks 1, 2, 4, and 5 are used at event sites where the infant education for the infants and the infant education information for the parents are provided by the holder of trademark right (Evidences B Nos. 9 to 21).

D When the infant education for the infants and the infant education information for the parents are provided by the holder of trademark right, Used marks 1, 2, 4, and 5 are used in Livlock and the booklets of Livlock, leaflets, brochures, DVDs, containers, and boxes provided to the infants and parents (Evidences B Nos. 22 to 34).

E Used mark 6 is used on the sign used for advertising the infant education for the infants and the infant education information for the parents provided by the holder of trademark right (Evidences B Nos. 37 and 38).

The uses above are prescribed in Article 2(3) of the Trademark Act.

The use in A falls under the use prescribed in Article 2(3)(vii) of the Trademark

Act.

The use in B falls under the use prescribed in Article 2(3)(viii) of the Trademark

Act.

The use in C falls under the use prescribed in Article 2(3)(viii) of the Trademark

Act.

The use in D falls under the use prescribed in Article 2(3)(iii), (iv), (v), or (viii) of the Trademark Act. The DVDs fall under the use prescribed in Article 2(3)(vii) of the Trademark Act.

The use in E falls under the use prescribed in Article 2(3)(viii) of the Trademark

Act.

(5) Used marks 1 to 6 are identical to the Trademark from a generally accepted perspective

For example, the registered trademark is normally used by adding a considerable change in the display mode such as a change in a font type and an addition of other characters in actual commercial transactions.

Therefore, even when the appearance of the mark does not resemble that of the registered trademark due to the above change, in a case where the base of the display mode of the registered trademark is not changed and the change does not affect the distinguishability of the registered trademark, the use of the mark should be assumed to be "the use of the registered trademark".

A When the Used marks 1 and 2 are compared with the Trademark, the Used marks 1 and 2 and the Trademark are different from each other in the following points.

(A) A point that the colors of "CHiME" and "bell figure" are red and black and are different from each other

(B) A point whether the small characters of "Child's Intelligence Media" are displayed in the lower part

When considering the difference (A), except for the difference (B), it is obvious that the used mark is assumed to be identical to the Trademark in a case where the rectangular part of the used marks is changed from red to black. Therefore, the similarity between the used marks and the Trademark cannot be denied based on the difference (A).

Also, regarding the difference (B), the words "Child's Intelligence Media" written in the lower part in the small size are recognized to indicate the scheme of the characteristic characters of "CHiME" in the upper part by consumers and traders. Based on the meaning of "Child's Intelligence Media" and the service, it is reasonable to consider that this part is considered and recognized as a part indicating the content of

the service, including the quality and the purpose of the service, such as "media of intellectual education for children". Then, it cannot be considered that the character part of "Child's Intelligence Media" in Used marks 1 and 2 has strong power for distinguishing relevant products from others which attracts observers. It is hard to say that the character part has a particularly impressive impression.

On the other hand, the upper part where the characters of "CHiME" is combined with the bell figure is largely and noticeably displayed and has a characteristic structure. It can be said that the consumers and traders feel special to the part and pay attention to the part.

Therefore, regarding the difference (B), the mark changed to this degree is normally used in actual commercial transactions. It is reasonable to consider that the difference (B) is a change of the display mode which does not affect the distinguishability of the Trademark.

Therefore, it is considered that Used marks 1 and 2 are identical to the Trademark from a generally accepted perspective.

B When Used mark 3 is compared with the Trademark, Used mark 3 is different from the Trademark in the following points.

(A) A point that the colors of "CHiME" and "bell figure" are red and black and are different from each other

(B) A point whether the small characters of "Child's Intelligence Media" are displayed in the middle and lower parts

When considering the difference (A), except for the difference (B), it is obvious that the used mark is assumed to be identical to the Trademark in a case where the rectangular part of the used marks is changed from red to black. Therefore, the similarity between the used marks and the Trademark cannot be denied based on the difference (A).

Also, regarding the difference (B), the words "Child's Intelligence Media" written in the lower part in the small size are recognized to indicate the scheme of the characteristic characters of "CHiME" in the upper part by consumers and traders. Based on the meaning of "Child's Intelligence Media" and the service, it is reasonable to consider that this part is considered and recognized as a part indicating the content of the service including the quality and the purpose of the service, such as "media of intellectual education for children". Then, it cannot be considered that the character part of "Child's Intelligence Media" in Used mark 3 has a strong power for distinguishing relevant products from others which attracts observers. It is hard to say that the character part has a particularly impressive impression.

On the other hand, the upper part where the characters of "CHiME" are combined with the bell figure is largely and noticeably displayed and has a characteristic structure. It can be said that the consumers and traders feel special to the part and pay attention to the part.

Therefore, regarding the difference (B), the mark changed to this degree is normally used in actual commercial transactions. It is reasonable to consider that the difference (B) is a change of the display mode which does not affect the distinguishability of the Trademark.

Therefore, it is considered that Used mark 3 is identical to the Trademark from a generally accepted perspective.

C When Used mark 4 is compared with the Trademark, Used mark 4 is different from the Trademark in the following points.

(A) A point that the colors of "CHiME" and "bell figure" are red and black and are different from each other

(B) A point whether the small characters of "BOOKLOAn" are displayed in the lower part

When considering the difference (A), except for the difference (B), it is obvious that the used mark is assumed to be identical to the Trademark in a case where the rectangular part of the used mark is changed from red to black. Therefore, the similarity between the used mark and the Trademark cannot be denied based on the difference (A).

Also, regarding the difference (B), the word of "BOOKLOAn" written in the lower part in the small size is simply the name of the company of the holder of trademark right (legal personality is removed). Then, it cannot be considered that the presence of the character part of "BOOKLOAn" in the Trademark has a strong power for distinguishing relevant products from others which attracts observers. It is hard to say that the character part has a particularly impressive impression.

On the other hand, the upper part where the characters of "CHiME" are combined with the bell figure is largely and noticeably displayed and has a characteristic structure. It can be said that the consumers and traders feel special to the part and pay attention to the part.

Therefore, regarding the difference (B), the mark changed to this degree is normally used in actual commercial transactions. It is reasonable to consider that the difference (B) is a change of the display mode which does not affect the distinguishability of the Trademark.

Therefore, it is considered that Used mark 4 is identical to the Trademark from a generally accepted perspective.

D When Used mark 5 is compared with the Trademark, Used mark 5 is different from the Trademark in the following points.

(A) A point that the colors of "CHiME" and "bell figure" are different from each other

(B) A point whether the small characters of "BOOKLOAn" are displayed in the lower part

When considering the difference (A), except for the difference (B), it is obvious that the used mark is assumed to be identical to the Trademark in a case where the rectangular part of the used mark is changed from red to black. Therefore, the similarity between the used mark and the Trademark cannot be denied based on the difference (A).

Also, regarding the difference (B), the word of "BOOKLOAn" written in the lower part in the small size is simply the name of the company of the holder of trademark right (legal personality is removed). Then, it cannot be considered that the presence of the character part of "BOOKLOAn" in the Trademark has a strong power for distinguishing relevant products from others which attracts observers. It is hard to say that the character part has a particularly impressive impression.

On the other hand, the upper part where the characters of "CHiME" are combined with the bell figure is largely and noticeably displayed and has a characteristic structure. It can be said that the consumers and traders feel special to the part and pay attention to the part.

Therefore, regarding the difference (B), the mark changed to this degree is normally used in the actual commercial transactions. It is reasonable to consider that the difference (B) is a change of the display mode which does not affect the distinguishability of the Trademark.

Therefore, it is considered that Used mark 5 is identical to the Trademark from a generally accepted perspective.

E When Used mark 6 is compared with the Trademark, Used mark 6 is different from the Trademark in the following points.

(A) A point that the colors of "CHiME" and "bell figure" are red and black and are different from each other

(B) A point that white KATAKANA characters "ブックローン" and black Alphabetic characters "BOOKLOAn" in the lower parts are different from each other

When considering the difference (A), except for the difference (B), it is obvious that the used mark is assumed to be identical to the Trademark in a case where the rectangular part of the used mark is changed from red to black. Therefore, the similarity between the used mark and the Trademark cannot be denied based on the difference (A).

Also, regarding the difference (B), the words "ブックローン" written in the

lower part are simply changed the sound of "BOOKLOAn" in the lower part of the Trademark into KATAKANA expression. In addition, Used mark 6 and the Trademark both have the same structure in which two lines are vertically arranged.

Therefore, regarding the difference (B), the mark changed to this degree is normally used in actual commercial transactions. It is reasonable to consider that the difference (B) is a change of the display mode which does not affect the distinguishability of the Trademark.

Therefore, it is considered that Used mark 6 is identical to the Trademark from a generally accepted perspective.

F According to the above, Used marks 1 to 6 are identical to the Trademark from a generally accepted perspective. Therefore, the use of Used marks falls under the use of the Trademark.

#### (6) Closing

As described above, the demandee, who is the holder of trademark right (BookLoan Co.Ltd.), has used the Trademark regarding the service pertaining to the request in Japan within the period required to prove trademark use.

#### 2. Oral proceedings statement brief dated August 12, 2015

##### (1) Regarding used marks

It is reasonable that Used marks 1 to 6 are identical to the Trademark from a generally accepted perspective.

The Trademark is designed so that the Alphabetic characters "CHiME" combined with the bell figure at the place of the dot above "i" is largely and noticeably displayed in the upper part, and the Alphabetic characters of "BOOKLOAn" are displayed in the smaller size in the lower part.

In addition, the characters of "BOOKLOAn" are only the abbreviated company name of BookLoan Co.Ltd., which is the holder of trademark right of the Trademark written in English. According to these situations, it is obvious that the part of "CHiME" which is largely designed in the Trademark has the largest function for distinguishing relevant products from others and is independently recognized as the primary part.

Thus, regarding Used marks 1 to 6, the characters of "CHiME" are largely displayed, and the bell mark is designed above "i". The spelling of "CHiME" in this structure is the same as that of the Trademark, and the design and arrangement of the bell mark is the same as that of the Trademark. Therefore, it is reasonable to consider that Used marks 1 to 6 are identical to the Trademark from a generally accepted perspective.

Also, regarding Used marks 1 to 3, the characters of "CHiME," which is the

primary part of the Trademark, are displayed, and in addition, the characters of "BOOKLOAn" are written in the lower part together with the characters of "Child's Intelligence Media". Therefore, it is reasonable to consider that Used marks 1 to 3 are trademarks identical to the Trademark from a generally accepted perspective.

Also, regarding Used mark 6, the designed characters of "CHiME" are largely displayed in the upper part, and in addition, the characters of "ブックローン" are simply written in KATAKANA characters converted from the characters of "BOOKLOAn" in the lower part. Therefore, it is reasonable to consider that Used mark 6 is the trademark identical to the Trademark from a generally accepted perspective. The sign of Used mark 6 has been used since 1997 at the latest until now and still exists now.

## (2) Regarding the service

"Providing the infant education information" is to provide information on "infant education" as insisted by the demandant.

The demandee provides the information on "infant education" by using the intellectual training toy mainly to the parents of the infants. As is obvious from the evidences submitted by the demandee (for example, Evidences B Nos. 4 to 10, 20, and 24), it can be found that not only infants but also the parents (adults) have participated. A purpose of the class is to make the infants and parents experience the infant education by using the intellectual training toys for infants so that the parents understand the infant education method. This is the provision of the infant education information.

In addition, as is understood based on Evidences B Nos. 13 to 16 (evidences regarding the lecture by Kisou KUBOTA), it is obvious that the infant education information is provided to only the parents of the infants in addition to providing the experience-based infant education information to the parents. Also, as indicated by Evidences B No. 3 and 8, it is obvious that the infant education information by Kisou KUBOTA is presented at the sites and shops of the holder of trademark right.

Also, when the infant education information is provided, any one of Used marks 1 to 5 is used. According to this, it is obvious that the demandee uses Used marks 1 to 5 for "providing the infant education information".

## (3) Summary

As described above, it is obvious that the demandee has used Used marks 1 to 6, which are identical to the Trademark from a generally accepted perspective, for "providing the infant education information" within the period required to prove trademark use.

3 Written statement dated October 1, 2015

## (1) Beginning

It is not denied that the holder of trademark right sells block toys and books; however, at the same time, the holder of trademark right has provided the infant education and the infant education information over many years.

The holder of trademark right uses block toys and books as one tool or one textbook to provide the infant education and the infant education information. The holder of trademark right has continuously used the characters of "CHiME", which are used in the used marks and the Trademark in common, until now for 21 years from 1994.

Also, just to be certain, a point is described why the holder of trademark right has registered the service of "providing the infant education information".

If the holder of trademark right sells only toys and child books, trademark registration regarding "selling toys and books" is enough. However, the trademark registration for "providing the infant education information" has special meaning.

It is natural that the holder of trademark right has registered the trademark to use it for providing the infant education and the infant education information. This is described in a book named "Chichro" published and sold by the holder of trademark right. This book looks like a simple child book. However, the configuration of this book actually makes the infant learn various points of knowledge while looking at this book, and guidelines of infant education such as how the parents of the infant teach the knowledge to the children are described. That is, this book is not simply a child book and is one tool which is invented to provide the "infant education information" such as a method for the children to learn the knowledge.

This can be easily understood while considering "KUMON" (registered trademark) as an example. A math workbook of KUMON is a simple math workbook at a glance. However, actually, the education method called "KUMON" is provided through the math workbook. Accordingly, children learn math by using a method which is completely different from the normal school education, and the effect of KUMON is popular in the world. Similarly, "LEGO" (registered trademark) provides education and education information by using block toys, and "LEGO" is registered as a trademark.

The block toys of the holder of trademark right are similar to "Chichro", "KUMON", and "LEGO", and these are not simply block toys and are devised so as to improve creativity of children by making the children create something by their hands with various devices. This is a tool to practice "methodology of infant education"; that is, how to improve the creativity of children. This is obvious based on the documents in

which the provision of the infant education information is mentioned for the parents being included in the leaflets and pamphlets in the submitted evidences. That is, the block toys are not simply block toys and are one tool to realize the "infant education" and the "provision of the infant education information".

Thus, the holder of trademark right sells the block toys and the child books as a tool to provide the infant education and the infant education information and uses them to provide the infant education and the infant education information.

(2) Regarding the holder of trademark right

The holder of trademark right sells block toys and books and provides the infant education and the infant education information at the same time. The holder of trademark right uses the block toys as one tool and one educational tool to provide the infant education and the infant education information.

(3) Regarding the Trademark

It is obvious that the designed Alphabetic character part of "CHiME" in the upper part of the Trademark attracts the observers more strongly than the Alphabetic characters which are understood as the abbreviated name of the holder of trademark right written in the lower part in the small size. In Used marks 1 to 6 indicated in Evidence B No. 39, the characters of "CHiME" similar to that in the upper part of the Trademark are written. This has the same configuration as the Alphabetic character part of the Trademark which strongly attracts the observers and is identical to the Trademark from a generally accepted perspective in the sound and the impression given to the observers.

Then, the Trademark and Used marks 1 to 6 have the same configurations as the Alphabetic character part which strongly attracts the observers, and it is reasonable to understand that the Trademark is identical to Used marks 1 to 6 from a generally accepted perspective in the sound and the impression given to the observers.

(4) Designated services

It is not denied that the holder of trademark right uses the Trademark for the block toys. However, the holder of trademark right uses it to provide the infant education and the infant education information.

First, the demandant concludes that "providing the infant education information" is to provide the information on "infant education" such as to widely notify the person, the corporation, and the facility for providing the "infant education". However, this is not reasonable. The designated service "providing the infant education information" of the Trademark belongs to a group similar to "Educational and instruction services relating to arts, crafts, sports or general knowledge" from among a plurality of classified

services belonging to the same section according to Japanese Patent Office. Therefore, it can be said that "providing the infant education information" is a service having a property to teach knowledge similarly to "Educational and instruction services relating to arts, crafts, sports or general knowledge". In addition, in consideration of the words "providing the infant education information", it is reasonable to consider that "providing the infant education information" includes providing the infant education information to the parents of the infants. Then, it is reasonable to understand that the act to use the used mark to provide the infant education for the infants and to provide the infant education information to the parents is understood as an act to provide the infant education information.

Also, the "block" is used to provide the infant education for the infants and to provide the infant education information to the parents. This is the use for a person who receives the "provision of the infant education information" and falls under the use in Article 2(3)(iii) of the Trademark Act.

In addition, the act to use the used mark in the "block" used in the infant education seminar for parents falls under the use in Article 2(3)(v) of the Trademark Act.

Thus, it is reasonable to understand that the act to use the used mark to provide the infant education for infants and to provide the infant education information to their parents is understood as the use to provide the infant education information.

According to the above, it should be understood that the holder of trademark right uses the used mark for the service of "providing the infant education information".

#### (5) Concluding Remarks

As described above, the Trademark is identical to Used marks 1 to 6 from a generally accepted perspective, and the holder of trademark right uses Used marks 1 to 6 for the service. Therefore, the holder of trademark right uses the Trademark for the service.

#### No. 4 Judgment by the body

1 According to the evidences submitted by the demandee, the judgment is as follows.

(1) Evidence B No. 3 is a web site of BookLoan, which is the holder of trademark right and its group company. In the first page of the web site, Used mark 3 is displayed, and Used mark 1 is displayed in the second page. In the second page, under the header of "product group of BookLoan which improves brain power from the age of 0", the content regarding development of the brain of children is introduced in the page of "products of BookLoan recommended by Kisou KUBOTA, who is the world authority of cerebrophysiology". The content includes items of "period before the child walks

determines the future", "real purpose of brain power development?", "Parents make genius! Mother's role is important", and "development of synapses" described by Kisou KUBOTA.

(2) Evidence B No. 4 is the web site of BookLoan, and Used mark 1 is written in the lower left part of it. Under the header of "Blocks recommended by Mr. KUBOTA", "Liveloock," which is the block toys, is introduced by KUBOTA.

Also, in the third page, under the header of "event information", event contents of "◆Liveloock, stamp rally", "◆Liveloock, free corner", "◆Liveloock class", and "◆Liveloock campaign" are introduced.

(3) Evidences B Nos. 5 and 6 are photographs of the permanent space in KIKUYA book shop in Kurashiki. Used mark 4 is displayed in the permanent space. Also, letters of "Liveloock class" written in paper guide sign hung from a display board placed near the ceiling can be seen.

Evidence B No. 7 is a photograph of the permanent space in KIKUYA book shop in Abeno.

Evidence B No. 8 is a photograph of the permanent space in Mie children's castle. In the photograph, a panel for introducing Mr. KUBOTA and the product of "Liveloock" is photographed, and Used mark 2 is displayed there.

(4) Evidence B No. 9 is a "list of events in which "CHIME" trademark is used" held by KIKUYA book shop in the period from April 29, 2012 to December 20, 2014.

(5) Evidence B No. 10 is the "event result report" of "SHIMABUN hall" in Nada-ku, Kobe dated February 28, 2013 regarding the events held by BookLoan. In the report, the following descriptions are made as "special notes". The descriptions include "Although the products are not sold at the event site, samples of the products are displayed, and the shop is introduced. Therefore, many consumers were interested in the products." and "The generation of participants is wide from zero year old to elementary school students, and the parents eagerly play with their children. Therefore, it can be shown that the people can play by using the products over generations, and various playing methods can be proposed in addition to the playing method for assembling the parts". Also, the photograph showing the situation of the event is attached.

Evidence B No. 12 is the "event result report" of "Chaimulando" in KIKUYA book shop in Kokura dated June 6, 2013 regarding an event held by BookLoan and KIKUYA book shop. In the report, there is a description as "special notes" such that "All the goods are sold at 30% OFF, since the event is held during new goods release sale period (all the goods are sold at 25% OFF)". Also, a photograph showing the

situation of the event is attached.

Evidence B No. 12 has two sheets of "event business report" dated June 2 and 4, 2013. In these reports, "customer service and sales work" and "customer service and sales" are written as the "business content" of June 1, 2013 that is the date of the event.

Evidence B No. 20 is the "event report" of KIKUYA book shop in Kashiwara dated July 31, 2012 regarding an event held by BookLoan and KIKUYA book shop. In this report, there is a description as "special notes" such that "Although the space was relatively small, the event was held in a stamp rally style (for free). A space where small kids can freely play is provided in a display space so as to introduce the products to parents of infants". Also, a photograph showing the situation of the event is attached.

In addition, Evidence B No. 21 has content such as an "event result report" having the same format as Evidences B Nos. 9, 10, 12, and 20.

(6) Evidence B No. 13 is a photograph of a lecture by Kisou KUBOTA held concurrently with the Livelock event in Kintetsu Department Store Main Store Abeno Harukas on August 14, 2014.

Evidence B No. 14 is a Facebook web page of Livelock which introduces the above lecture.

Evidence B No. 15 is a leaflet titled "Event information Kintetsu Department Store Main Store Abeno Harukas, August". In the second page, there are descriptions such as "Livelock class for improving and training brain" and "lecture by Kisou KUBOTA, a brain scientist".

Evidence B No. 16 is a photograph of Kisou KUBOTA.

(7) Evidence B No. 19 is an excerpt from the book "3, 4, and 5 years-old-children's education for training genius brain" written by Kisou KUBOTA. Used mark 1 is written in the supplement booklet of Livelock.

(8) Evidences B Nos. 11 and 22 are photographs of Livelock. Also, Used mark 5 is written in Livelock in Evidence B No. 22.

(9) Evidence B No. 23 includes a plurality of photographs of a commodity box of Livelock. Used mark 1 or 4 is written in them.

(10) Evidences B Nos. 25 to 30 are "playing guide", "example sheet", and "product brochures (catalog)" and the like of the products of Livelock created by BookLoan from January 2012 to February 2015. Any one of Used marks 1, 2, and 4 is written in them.

(11) Evidences B Nos. 31 and 32 are DVDs created by BookLoan, and characters of "Happy Livelock" and "Complete Work of intellectual block" are written in the DVDs.

Evidence B No. 31 is a DVD played in the permanent space of KIKUYA book shops and event sites in various places. Evidence B No. 32 is a DVD attached to the

material when the material of Livelock is requested. The playing methods of Livelock are recorded in the DVDs, and Used mark 2 is displayed in the video (Evidence B No. 34, screen shot of DVD).

(12) Evidences B Nos. 37 and 38 are appearance photographs of BookLoan Hyogo Building and BookLoan Kobe Building. Used mark 6 is displayed on the sign (advertising tower) placed on the housetop of BookLoan Kobe Building.

2 According to the evidences, the following facts are acknowledged.

(1) Regarding goods in connection with the demandee

The demandee has created the "playing guide", the "example sheet", and the "product brochures (catalog)" of the products of "Livelock" which is a block toy, from January 2012 to February 2015 and has sold the product "block toys" (Evidences B Nos. 25 to 30).

(2) Whether the demandee provides the designated services of the Trademark

According to the evidences submitted by the demandee, it cannot be confirmed that the "provision of the infant education information", which is the designated service of the Trademark, is performed.

"Providing the infant education information" which is the designated service of the Trademark is to provide the information regarding "infant education", which is widely collected, as the service.

However, Evidences B Nos. 3 and 4 are introduction and recommendation of the product "Livelock" by a third party. This kind of content is one of the methods for advertising the products sold by the demandee.

Evidences B Nos. 5 to 8 are photographs of the permanent space in KIKUYA book shops. However, Evidences B Nos. 5 to 8 do not prove that the service for "providing the infant education information" is performed.

Evidences B Nos. 9, 10, 12 to 14, 20, and 21 relate to events regarding the product "Livelock" held by the demandee, and these evidences do not prove that the "infant education information has been provided".

According to the contents of "event result report", it can be found that these events are planned, managed, and held to sell the product "Livelock".

Evidences B Nos. 15 and 16 relate to the lecture by Kisou KUBOTA, and Evidences B Nos. 18 and 19 relate to the sales and introduction of the books. Therefore, these evidences do not relate to the designated services of the Trademark.

Evidences B Nos. 11, and 22 to 24 are photographs of the product "Livelock". Also, Evidences B Nos. 25 to 30 are the "playing guide", the "example sheet", and the "product brochures (catalog)" of the products of "Livelock" and do not prove that the

"infant education information has been provided".

No other evidences prove that "the infant education information has been provided".

Therefore, the demandee introduces the block toys "Livlock" in the web site and holds the events regarding "Livlock". These acts are performed to sell the product "Livlock", which is the business of the demandee. The contents of the acts promote the sales of the products by using a method for advertising that "Livlock" is a product which develops the brain, and this can be understood according to the evidences above.

Then, the acts that the demandee "plans, manages, and holds events" relating to the products and informs the parents of the children of the infant education method through the event relating to the product are not the services of "providing the infant education information".

The demandee insisted that the evidences prove the "provision of the infant education information". However, the allegation of the demandee is not reasonable, and the evidences should be assumed to be advertisement of the products.

### (3) Demandee's allegation

The demandee insists that it is reasonable to consider that "providing the infant education information" includes to provide the infant education information to the parents of the infants. Then, it is reasonable to understand the act for using the used marks to provide the infant education for the infants and the infant education information to their parents as the use to provide the infant education information. Also, the "block" is used to provide the infant education for the infants and the infant education information to the parents of the infants. This is the use by a person who receives the "provision of the infant education information" and falls under the use of Article 2(3)(iii) of the Trademark Act. In addition, the act for using the used mark to the "block" used in the infant education seminar for the parents falls under the use of Article 2(3)(v) of the Trademark Act. Then, it is reasonable to understand the act for using the used mark to provide the infant education for the infants and the infant education information to the parents as the use to provide the infant education information. According to this, the holder of trademark right insists that "it should be understood that the used marks are used for the service to 'provide the infant education information'".

However, even when "providing the infant education information" includes to provide the infant education information to the parents, the act of the demandee is "planning, managing, and holding events" relating to the products of "block" as described in (2). It cannot be said that the act of the demandee is the service of

"providing the infant education information".

Also, the "block" is substantially a toy and cannot be assumed to be articles for use in the services of "providing the infant education information". Therefore, the use in the "block" does not fall under the use of Article 2(3)(iii) of the Trademark Act. In addition, since the "block" cannot be assumed as articles for use in the services of "providing the infant education information", the use in the "block" does not fall under the use of Article 2(3)(v) of the Trademark Act.

#### (4) Others

No evidences have been submitted which prove that the Trademark is used for the designated services "for providing the infant education information" pertaining to the request by the holder of trademark right, the exclusive user, and the non-exclusive user within the period required to prove trademark use.

(5) Therefore, according the Evidences B submitted by the demandee, even when any one of the used marks are used identically with the Trademark from a generally accepted perspective, it cannot be said that any one of the holder of trademark right, the exclusive user, and the non-exclusive user uses the Trademark for the designated services pertaining to the request within three years before the registration of the trial of the case in Japan.

The demandee does not give any legitimate reasons why the Trademark had not been used in connection with any of the designated services pertaining to the request.

#### 3 Closing

As described above, it cannot be said that the demandee has proved that any one of the holder of trademark right, the exclusive user, and the non-exclusive user has used the Trademark for the designated services pertaining to the request within three years before the registration of the trial of the case in Japan. Also, the demandee does not give any legitimate reasons why the Trademark had not been used.

Therefore, the registration of the Trademark shall be cancelled under the provisions of Article 50 of the Trademark Act.

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

November 17, 2015

Chief administrative judge: KANEKO, Naohito

Administrative judge: IDE, Eiichiro

Administrative judge: ENOMOTO, Masami

Attachment (1) (the Trademark)



Attachment (2)-1 (Used mark 1)



Attachment (2)-2 (Used mark 2)



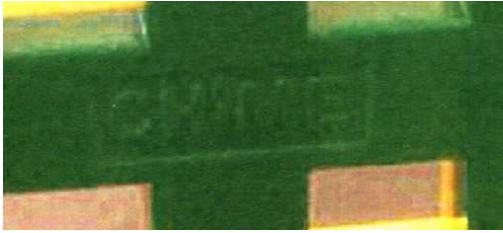
Attachment (2)-3 (Used mark 3)



Attachment (2)-4 (Used mark)



Attachment (2)-5 (Used mark 5)



Attachment (2)-6 (Used mark 6)



(refer to Evidences B. regarding Used marks 1 to 6)