

Trial decision

Revocation No. 2015-300085

Tokyo, Japan

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The case of trial regarding the revocation of the Trademark Registration No. 4008198 between the parties above has resulted in the following trial decision.

Conclusion

The demand for trial of the case was groundless.

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

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 4008198 (hereinafter referred to as the "Trademark") consists of two-tiered character strings, where one is "スフィーダ" (SFIDA) written in Katakana and the other one is "SFIDA" written in Alphabetic characters, its registration application was filed on August 10, 1995, the trademark was registered on June 6, 1997 with "Footwear" of Class 25 as its designated good, and it is still valid as of now.

Then, the demand for trial of the case was registered on February 23, 2015.

No. 2 The demandant's allegation

The demandant requested a decision which states that the registration of the Trademark shall be cancelled pursuant to Article 50(1) of the Trademark Act and the costs in connection with the trial shall be borne by the demandee, summarized and mentioned reasons for request and rebuttal against a reply as well as the demandant's allegation during an oral proceeding as follows, and submitted Exhibits A No. 1 and A No. 2 as means of Exhibit.

1 Statement of the demand

In the Trademark, since there had been no fact that any of the owner of trademark right, exclusive right to use, or non-exclusive right to use has used the

registered trademark in Japan in connection with the designated goods concerned for three consecutive years or longer, its registration should be cancelled under the provisions of Article 50 of the Trademark Act.

2 Rebuttal against a reply and the demandant's allegation during an oral proceeding

(1) Trademark deemed identical with the Trademark from generally accepted perspective

The Trademark consists of the configuration as described in section No. 1 above.

On the other hand, Alphabetic characters "SFIDA" is indicated on three parts in Exhibit B No. 1; i.e., a tongue part, a toe part, and a heel part, of the good "shoes," and the characters "スフイーダ K" is indicated in a label to be affixed on a box of "shoes." Exhibit B No. 2 is a catalogue of shoes in which the characters "アサヒ G スフイーダ K" appear as the name of goods. Exhibits B No. 3-1 and B No. 3-3 are documents titles "Sales Slip (1)," and the part of "G. スフイーダ K" in the column of "Product Code: Product Name" is recognized to be the representation of the goods name.

Thus, the trademarks argued by the demandee are "SFIDA," "スフイーダ K," "アサヒ G スフイーダ K," and "G. スフイーダ K"; however, none of them are the trademark identical with the Trademark.

Next, since Article 50(1) of the Trademark Act provides for that if "a trademark consisting of characters identical with the registered trademark but in different fonts, a trademark that is written in different characters, Hiragana characters, Katakana characters, or Latin Alphabetic characters, from the registered trademark but identical with the registered trademark in terms of pronunciation and meaning, a trademark consisting of figures that are considered identical in terms of appearance as those of the registered trademark, or otherwise a trademark deemed identical from generally accepted perspective with the registered trademark" is used, it shall be regarded as if the registered trademark were used, we will examine whether or not the use by the demandee falls under the use of "a trademark deemed identical from generally accepted perspective" described above.

First, Alphabetic characters of "SFIDA" do not refer to an idiomatic expression even in light of English that has been familiar in our country. Therefore, it is not recognized that the Alphabetic characters make traders and consumers coming into contact with only the Alphabetic characters concerned evoke a specific meaning, but rather they understand it to be a coined term. Furthermore, the pronunciation thereof gives rise to a pronunciation "スファイダ" in accordance with reading in English or reading in Latin Alphabetic characters which has been familiar.

On the other hand, in the Trademark, the pronunciation of "SFIDA" on the upper section evokes the lower section as being "スフイーダ." Furthermore, traders and consumers can find from the pronunciation of "sufiida" that Alphabetic characters of "SFIDA" mean "challenge" in Italian, although this expression is not familiar in our country. Considering this, the Trademark gives rise to a pronunciation of "sufiida" and a meaning "challenge." Therefore, the used trademark in which only "SFIDA" is written is not identical with the Trademark in terms of pronunciation and meaning, and thus it cannot be said that they are identical with each other from generally accepted perspective.

Next, the trading is conducted with each of "スフイーダ K," "アサヒ G スフイーダ K," and "G. スフイーダ K" having the letter "K" as seen in "スフイーダ K."

The characters have the same size, the appearances thereof are always uniform, and thus are not recognized to be able to be separated easily. Considering this, the characters of "スフイーダ K" refer to a coined term as a whole, and give rise to a pronunciation of "sufiidakei" but do not evoke a specific meaning. Therefore, it cannot be concluded that this uses those which are deemed identical with the Trademark from generally accepted perspective.

(2) Regarding Exhibits B No. 2 and B No. 3

Exhibit B No. 2 is a catalog of shoes issued by the demandee which contains the representation "Exclusively for School-Designated Shop" in the lower left section on the cover thereof. Considering this, a person who has no relation with schools may not purchase the product with "SFIDA" or "スフイーダ K" used by the demandee provided thereon.

A registered trademark should be protected only when a product with the registered trademark is put in the distribution process, and the registered trademark serves as the trademark. Consequently, it cannot be said that the registered trademark can serve as the trademark when being used exclusively by school officials, and thus it cannot be said that the use thereof falls under "the use of the registered trademark" stipulated in Article 50 of the Trademark Act.

(3) Oral proceedings statement brief

The demandant does not submit an opinion against the oral proceedings statement brief submitted by the demandee dated October 29 and November 11, 2015.

(4) Statement in the oral proceeding

The demandant withdrew the allegation by the statement in the oral proceeding that the mark of "SFIDA" affixed to the product that appears in the pictures in Exhibits B No. 1 and B No. 5 cannot be deemed identical with the Trademark from generally accepted perspective.

No. 3 The demandee's reply

The demandee replied to make a request that the trial decision must be the same as the conclusion, made statements about the written reply for the trial case and the oral proceedings statement brief as well as the statement in the oral proceeding in which the trademark which is identical with the Trademark from generally accepted perspective has been used in Japan with regard to the designated goods pertaining to the request for revocation within 3 years prior to the registration of the demand for trial of the case, whose summary is as follows, and submitted Exhibits B No. 1 to B No. 9 (including their branch numbers).

1 The fact of the use the Trademark (including the trademark which is identical with the Trademark from generally accepted perspective)

The demandee was established in 1918 and since then has been engaged in production and distribution of rubber footwear and leather shoes. The company has 660 employees and achieved yearly sales of 11600 million yen (the fiscal year that ended in December 2014).

The company produced and sold the product Footwear (sneakers and athletic shoes) with the Trademark provided thereon totaling at least 170,035 pairs and 42,356,622 yen in 2012, 18,327 pairs and 45,586,632 yen in 2013, and 21,485 pairs and 52,554,652 yen in 2014 (Exhibit B No. 4).

(1) Regarding Exhibits B No. 1 and B No. 5

The product appears in "pictures of the product with the Trademark indicated thereon" in Exhibits B No. 1 and B No. 5 is provided with the Trademark "SFIDA" in English characters indicated on each of the upper part of a tongue piece (tongue part), the outer toe part, and the heel part of shoes. Furthermore, the label affixed on the box of the product concerned explicitly shows the name, size, and product number of the product. Among these, the name of the product is explicitly referred to as "スフィーダ K," and "KD72003" and "KD72001" are listed as the product numbers thereof on the lower left end of the label. The product numbers correspond to the product numbers contained in the product catalog in Exhibit B No. 2 and those written on the sales slips in Exhibits B No. 3-3 and B No. 9.

(2) Regarding Exhibit B No. 2

The catalog of "The Shoes of Japan/ASAHI/SCHOOL SHOES COLLECTION" in Exhibit B No. 2 is a catalog issued by the demandee in June 2014, which was produced as giveaway and distributed to customers and the like at the time of business activities and sales promotion. This catalog shows in the vicinity of the middle section of page 5 pictures of samples of the products "アサヒ G スフィーダ K" with the Trademark indicated thereon which are organized by color and product number (KD72001 Red, KD72003 Green, and KD72004 Blue). This reveals that this is the catalog in relation to the product indicated in Exhibit B No. 1.

(3) Regarding Exhibits B No. 3, B No. 8, and B No. 9 (including their branch numbers)

The "sales slip" and "invoice" in Exhibits B No. 3, B No. 8, and B No. 9 (including their branch numbers) are sales slips and invoices which contain sales details in the case where the demandee received orders from customers and sold (delivered) products including the product with the Trademark "スフィーダ" indicated thereon. These show that the delivery would be conducted on February 6, 2015, September 5, 2014, November 21, 2013, and April 1, 2014. These slips contain a writer, date of preparation, shipping date, and the product number of the case, and thus prove that the Trademark was consecutively used for that intended period.

(4) Regarding Exhibit B No. 6

Exhibit B No. 6 is a copy of the website of the demandee containing the product "アサヒ G スフィーダ K" with the Trademark indicated thereon. This copy is a print-out in accordance with the necessity of this time, but the product concerned has been contained since before the date of registration of the request for the trial of this case. The demandee's website contains specifications, shape, color type of the demandee's product "SFIDA" and "スフィーダ." This reveals that the product concerned is widely sold for the public.

(5) Exhibit B No. 7

Exhibit B No. 7 is a certificate prepared by a representative of a retailer in Tokyo which shows that the retailer concerned purchased stocks of shoes with the Trademark provided thereon from the demandee on September 5, 2014, and sold the shoes to consumers by September 10 in that year. This proves that the Trademark "SFIDA" is indicated on the shoes, the Trademark "スフィーダ" appears on the box, and the product with "スフィーダ" which is listed as the product code and product name in the sales slip is distributed.

(6) Closing

As discussed above, each of Exhibits B No. 1 to B No. 9 (including their branch

numbers) reveals that, with regard to the product Footwear (sneakers and athletic shoes), that the demandee affixed a mark to goods or packages of goods (Article 2(3)(i) of the Trademark Act), displayed and sold the goods concerned (Article 2(3)(ii) of the Trademark Act), displayed or distributed advertisement materials or transaction documents relating to the goods, and provided such content by an electromagnetic device (Article 2(3)(viii) of the Trademark Act) within 3 years prior to the registration of the request for the trial of this case. It is thus obvious that the holder of trademark right has consecutively used the Trademark.

2 Regarding similarity between Trademark the used trademark of the case

The demandant argues that the use of "SFIDA," "スフィーダ K," "アサヒ スフィーダ K," and "G. スフィーダ K" by the demandee is not the use of the Trademark.

However, it is natural even in terms of English that Alphabetic characters "SFIDA" are transliterated as "スフィーダ," and thus transliteration of an Italian word "SFIDA" into "スフィーダ" is of course a natural matter in our country where such a transliteration is recognized in the names of many fitness clubs, companies, and stores. In light of the fact that "SFIDA" is used by the demandee as "スフィーダ" and recognized in such a way, it should be understood that the use of only one of the elements; i.e., "SFIDA" and "スフィーダ" shall be regarded as the use of a trademark identical from generally accepted perspective with the Trademark under the provision of Article 50 of the Trademark Act.

In the first place, not only the Alphabetic characters "SFIDA" described above but Katakana characters "スフィーダ" described above are used, and thus it should be understood that the Trademark is used.

"アサヒ G スフィーダ K" has a space for one character between "アサヒ G" and "スフィーダ K," and they can be distinguished from each other. Furthermore, in "G. スフィーダ K," the beginning thereof "G. " refers to the initial letter of the product series name "GRIPPER." This is a sign to show that this is one of the products of "GRIPPER" series represented by "G. "

"." of "G. " is a sign applied to distinguish from other products. Furthermore, "BL" is merely a sign indicating a blue-colored (BLUE) product. Also, the last letter "K" of "スフィーダ K" is the initial letter "K" of "KOKINMASTER" which has antimicrobial, antibacterial, and fungusproofing activities, which is nothing more than a sign. Each of "アサヒ G," "G. ," and "K" lacks distinctiveness and a function for indicating source independently even if added to the Trademark. It is thus obvious that the demandee uses the Trademark "スフィーダ/SFIDA" ("SFIDA" or "スフィーダ" which is an form of use deemed identical from generally accepted perspective with the Trademark), even in light of the Examination Guidelines for Trademarks and conventional judicial precedents, etc.

There have been a lot of trial decisions and judicial precedents which established the determination in which, in the case of a trademark consisting of two lines; i.e., Alphabetic characters and Katakana characters expressing the pronunciation of Alphabetic characters, the use of one of them shall be deemed to be identical with that of the trademark concerned if the transliteration thereof is natural from generally accepted perspective.

3 Demandant's allegation

The demandant alleges that the use of the registered trademark is not acknowledged even if there is an example of transaction via a school. However, it is an incomprehensible allegation that it is self-evident that products are sold through a proper distribution channel, but the use of the trademark is not acknowledged depending on the distribution channel.

No. 4 Judgment by the body

1 Regarding the fact of use

According to the Exhibits and the demandee's allegation, the following facts can be acknowledged.

(1) Exhibit B No. 1 is a picture of the demandee's product "shoes" (hereinafter referred to as the "used product") purported to be taken in April 2015 in which outline English characters "SFIDA" (hereinafter referred to as the "used trademark of the case") are indicated on the upper section of a tongue part, an outer toe part, and a heel part of the used product. Furthermore, the descriptions "アサヒ G," "スフィード K," "グリーン" and "KD72003" are found a label on the side surface of the box of the shoes which appears along with the used product.

(2) Exhibit B No. 2 is a catalog of "The Shoes of Japan/ASAHI/SCHOOL SHOES COLLECTION" which was produced by the demandee in June 2014 as giveaway and distributed to customers and the like at the time of business activities and sales promotion. This catalog contains in the vicinity of the middle section of page 5 the representation of "アサヒ G スフィード K," a picture of a sample of the product which is the same in design as the shoes shown in Exhibits B No. 1 and B No. 5, and a description by color and the product numbers "KD72001 Red," "KD72003 Green," and "KD72004 Blue."

(3) Regarding Exhibits B No. 3-3 and B No. 3-4

Exhibit B No. 3-3 is a copy of a sales slip including the description "ASAHI Corporation" in the column of the supplier, whose destination is "--- (masking) shoes shop" having a client code "50308." The slip concerned includes the description "192060" in the column of the slip number, and "September 5, 2014" in the column of the shipping date. Furthermore, there are the descriptions of "G. スフィード K G R" as the product code and product name, "KD72003-1" as "C," "2" as quantity in the third line of the column of the product details, the description of "11450" in the column of the total in the lower section of the slip, and the description of "916" in the column of consumption tax.

Exhibit B No. 3-4 is a copy of an invoice. The invoice includes the description of "ASAHI Corporation" and the address thereof in the upper right section, the description of "--- (masking) shoes shop" in the column of the destination, the description of "50308" in the lower section thereof, the description of "August 26, 2014 to September 25, 2014" in the center upper section, the description of "14," "9," and "5" in the column of year/month/day in the fourth line of the invoice details at the center of the invoice, the description of "192060" in the column of the slip number, the description of "Sales" in the column of the purchase classification, the description of "11450" in the column of the purchase amount, and the description of "916" in the column of consumption tax.

2 Judgment

According to the facts discussed in the section 1 above, the following matters

can be acknowledged.

(1) Regarding the used product and the used trademark of the case

It is recognized that the used product is "shoes" as discussed in section 1(1) above, while the used product concerned is the goods that falls in the category of Class 25 "Footwear" pertaining to the demand for the trial of the case.

Furthermore, according to sections 1(1) and (2) above, the picture in Exhibit B No. 1 shows the box to which the label including the descriptions of "アサヒ G," "スフイーダ K," "グリーン," and "KD72003" is affixed, along with the used product. Also, the demandee's catalog in Exhibit B No. 2, i.e.; "the Shoes of Japan/ASAHI/SCHOOL SHOES COLLECTION" prepared in June 2014 shows shoes which are the same in design as the used product in Exhibit B No. 1 along with the description of "アサヒ G スフイーダ K" and "KD72003 Green" as a picture of a sample of the product. Considering this, it can be recognized that the used product in Exhibit B No. 1 and the shoes in Exhibit B No. 2 whose product number is "KD72003" are substantially identical products, and thus the used product has already existed around June 2014.

Then, as described in section 1(1) above, the used trademark of the case is indicated on the upper section of a tongue piece (tongue part), an outer toe part, and a heel part of the used product.

Considering this, it can be recognized that the used trademark of the case is provided on the used product which are goods that fall in the category of Class 25 "Footwear" pertaining to the demand for the trial of the case had already existed around June 2014.

(2) Regarding the user and the time of use of the used trademark

According to section 1(3) above, the sales slip in Exhibit B No. 3-3 contains the name of "ASAHI Corporation" in the column of the supplier, and the invoice in Exhibit B No. 3-4 contains the name of "ASAHI Corporation" and the address thereof in the upper right section. Since it can be said that both the descriptions are the same as the name and address of the demandee, these slips can be recognized as transaction documents by the demandee.

Then, from these slips reveals, it can be confirmed that the demandee recorded in the sales slip in Exhibit B No. 3-3 whose slip number is "192060" the fact that they shipped two pairs of the products with the product code and product name "G. スフイーダ K GR" and "KD72003-1" indicated thereon to an agent whose client code is "50308" (hereinafter referred to as the "demandee's agent") on September 5, 2014, and billed by the invoice in Exhibit B No. 3-4 the charge for the products "11450" yen and the consumption tax "916" yen together with charges for other transactions conducted between the demandee and the demandee's agent from August 26 to September 25, 2014.

The explanation by the demandee regarding the description contents in the sales slip in Exhibit B No. 3-1 shows that "G. スフイーダ K" refers to "アサヒ G スフイーダ K" from which the part of "アサヒ" is omitted due to limitation on the number of letters of the slip processing system, "GR" refers to an abbreviation for the color of the product, and the part of "KD72003" before "-1" of "KD72003-1" refers to the product serial number, and the same goes for the descriptions "G. スフイーダ K GR" and "KD72003-1" in the sales slip in Exhibit B No. 3-3 which has the same format. Therefore, it is possible to infer that "G. スフイーダ K GR" and "KD72003-1" are the products which are indicated in the sales slip and the invoice in Exhibits B No. 3-3

and B No. 3-4 as being described and transacted are the used product that appears in the picture in Exhibit B No. 1.

Consequently, the demandee shipped the used product appearing in the picture in Exhibit B No. 1 to the customer on September 5, 2014, which is within 3 years prior to the registration of the demand for trial of the case, and billed the charge therefor on or after September 25, 2014. Therefore, since it can be recognized that the assignment of the goods "shoes" and the charge therefor have been conducted between the demandee and a customer around September 2014, it can be recognized that the user of the used trademark of the case is the demandee, and the time of use is around September 2014, which is within 3 years prior to the registration of the demand for trial of the case.

(3) Regarding similarity between the Trademark and the used trademark of the case

The determination will be made regarding whether the Trademark and the used trademark of the case fall under the trademark which is identical with the Trademark from generally accepted perspective.

A. As discussed in the section No. 1 above, the used trademark of the case consists of Katakana characters and Alphabetic characters, and thus can be easily divided in visual terms into the Katakana character part; i.e., "スフィード," and the Alphabetic character part; i.e., "SFIDA."

B. The word "SFIDA" is an Italian word meaning "challenge," and it may not be said that Italian language is so popular in our country. However, when conducting search of the characters of "SFIDA" on the Internet, it is possible to find "スフィード世田谷FC (Sfida Setagaya FC)" which is a football team belonging to *NADESHIKO* League (Japan Women's Football League), as well as a large number of fitness clubs, companies, and stores who use the word concerned as their names or a part of their names. Therefore, it can be said that the word concerned is much more likely to be seen in our country than one would otherwise suppose.

Considering this, since it can be recognized that the word concerned may be naturally pronounced "sufiida" even though the meaning thereof has not been known, it is acknowledged that the used trademark of the case gives rise to the pronunciation of "sufiida" but no specific meaning is evoked.

C. On the other hand, in the configuration of the Trademark, the Alphabetic character part "SFIDA" consists of characters which are the same as those of the used trademark of the case in the section B above, the used trademark of the case, and thus gives rise to the pronunciation "sufiida" and no specific meaning is evoked in a similar way as the used trademark of the case. Furthermore, it is obvious that the Katakana character part "スフィード" gives rise to the pronunciation of "sufiida," and no commonly known word is evoked by the pronunciation. Therefore, it should be said that no specific meaning is evoked. Then, since the Trademark does not give rise to other pronunciation and meaning, it is acknowledged that the Trademark gives rise to the pronunciation "sufiida," but no specific meaning is evoked.

D. Considering this, the used trademark of the case "SFIDA" is in common in spelling with the Alphabetic character part constituting the Trademark, and is written in different characters, Katakana characters or Latin alphabetic characters, from the Katakana character part but identical therewith in terms of pronunciation, and there is no difference in meaning. Therefore, it can be said that the used trademark of the case and the Trademark are identical with each other from generally accepted perspective.

(4) Summary

As discussed above, it is reasonable to determine that the demandee has affixed the used trademark of the case, which is deemed identical with the Trademark from generally accepted perspective, on the goods "shoes" included in the designated goods "Footwear" in connection with the demand of this case, and made an assignment of the goods concerned in Japan around September 2014, which is within 3 years prior to the registration of the demand for trial of the case.

Then, the use of the trademark by the trademark right holder falls under Article 2(3)(ii) of the Trademark Act.

3 Demandant's allegation

In light of the fact that the catalog of shoes issued by the demandee (Exhibit B No. 2) contains the representation of "Exclusively for School-Designated Shop," the demandant alleges that a person who has no relation with schools may not purchase the product with "SFIDA" or "スフイーダ K" used by the demandee indicated thereon, and thus the use of the registered trademark exclusively for school officials cannot be regarded as being capable of serving as a trademark, and therefore it cannot be said that the use in question falls under "the use of the registered trademark" stipulated in Article 50 of the Trademark Act.

However, the expression of "Exclusively for School-Designated Shop" in the catalog issued by the demandee (Exhibit B No. 2) is nothing more than an indication of the application of the catalog concerned. Even if it is a transaction conducted through a school-designated shop, it is obvious that "shoes" contained in the catalog concerned are the goods having distribution capability provided in the Trademark Act.

Then, as in section 2(2) above, the demandee has conducted commerce transactions of the used product including the assignment to customers along with the charges for payment within 3 years prior to the registration of the demand for trial of the case. Therefore, the act of assignment of the used product with the trademark which is identical with the Trademark from generally accepted perspective, the trademark affixed thereon is nothing more than the use of a registered trademark stipulated in Article 50 of the Trademark Act.

Therefore, the allegation of the demandant discussed above cannot be accepted.

4. Conclusion

As discussed above, it can be determined that the demandee proved that the trademark which is identical with the Trademark from generally accepted perspective has been used in Japan with regard to the product "shoes" included in the designated goods "Footwear" within 3 years prior to the registration of the demand for trial of the case.

Therefore, the registration of the Trademark cannot be cancelled under the provision of Article 50 of the Trademark Act.

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

December 21, 2015

Chief administrative judge: HAYAKAWA, Fumihiro
Administrative judge: TANAKA, Koichi
Administrative judge: MAEYAMA, Ruriko