Trial decision

Revocation No. 2015-300384

Spain
Demandant BLANCO ALDOMAR S.L.

Osaka, Japan
Patent Attorney YOSHIKAWA, Toshio

Tokyo, Japan
Demandee MUGEN INC.

The case of trial regarding the revocation of trademark registration for Trademark Registration No. 5,486,110 between the parties above has resulted in the following trial decision.

Conclusion

The trademark registration for Trademark Registration No. 5,486,110 is cancelled.

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

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5,486,110 (hereinafter referred to as the "Trademark") consists of the standard Alphabetic characters of "magnani", and its registration application was filed on October 31, 2011, the trademark was registered on April 13, 2012 with Class No. 18 "Bags; wallets; pouches; vanity cases; umbrellas" as its designated goods.

In addition, the registration date of the request for the trial of this case is June 15, 2015.

No. 2 The demandant's allegation

The demandant requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request in the written demand for trial as follows, and submitted Evidence A No. 1.

1. Statement of the demand

There had been no fact that any of the holder of trademark right, exclusive right to use, or non-exclusive right to use has used the Trademark in Japan in connection with the designated goods concerned for three consecutive years or longer, and therefore the Trademark must be cancelled.

2. Rebuttal against a reply

The demandee alleges that the account payable payment details (hereinafter referred to as "Evidence A No. 1") is submitted as evidence, which accordingly proves that the holder of trademark right had used the Trademark in Japan within three years prior to the registration of the demand for the trial (hereinafter referred to as "within the period required to prove trademark use") in connection with the designated goods

concerned.

However, as discussed below, the time of use, the product relating to use, and the trademark relating to use are not demonstrated, and any of "use" provided in the respective items of Article 2(3) of the Trademark Act is not proved.

(1) The date of issue of Evidence A No. 1 is "January 15, 2014"; however, it is unclear when the product was transferred.

(2) Evidence A No. 1 merely contains "General merchandise for men", and the product relating to use is unclear.

(3) Evidence A No. 1 does not show the Trademark, and thus the trademark relating to use is unclear.

(4) Any of "use" provided in the respective items of Article 2(3) of the Trademark Act is not proved.

Therefore, the evidence submitted by the demandee does not prove that the holder of trademark right had used the Trademark in connection with the designated goods within the period required to prove trademark use.

No. 3 The demandee's allegation

The demandee replied that the demandee requests the trial decision in which the demand for trial of the case was groundless, and the costs in connection with the trial shall be borne by the demandant, summarized and mentioned reasons for request in the written demand for trial as follows, and submitted Evidence A No. 1.

The latest time of use is December 2013 in preparation demonstrating sales.

The product in question had already been sold before then.

No. 4 Inquiry by the body

The summary of the contents of inquiry dispatched from the body dated February 16, 2016 is as follows.

1. Regarding provisional opinion of the panel in regard to the written reply for the trial case

(1) Article 50(2) of the Trademark Act stipulates that where a request for a trial under item (1) in the same Article is filed, unless the demandee proves that any of the holder of trademark right, exclusive right to use, or non-exclusive right to use (hereinafter referred to as "the holders of trademark right.") has used the registered trademark in Japan in connection with any of the designated goods or designated services pertaining to the request within three years prior to the registration of the request for the trial (in this case, June 15, 2012 to June 14, 2015), or the demandee did not give any legitimate reasons why the registered trademark had not been used, the holder of trademark right may not prevent the rescission of the trademark registration.

Then, the demandee alleges in the written reply for the trial case that "The Trademark was used in December 2013 in preparation demonstration sales, and the product in question had already been sold before then", and submitted Evidence A No. 1.

However, Evidence A No. 1 submitted by the demandee cannot prove, due to the reasons stated in A. to E. listed below, that it is acknowledged that the holders of trademark right., has used the Trademark in Japan in connection with any of the designated goods of the case within the period required to prove trademark use, and thus it cannot be said that the demandee proved the use of the registered trademark provided in Article 50(2) of the Trademark Act.

A. Evidence A No. 1 is "Account payable payment details" that was sent from Sogo & Seibu Co., Ltd. to the demandee, not distributed by the holders of trademark right. Therefore, it cannot be said that Evidence A No. 1 is "transaction documents" in the course of "use" that is provided in Article 2(3)(viii) of the Trademark Act.
B. Evidence A No. 1 does not indicate the trademark used by the holders of trademark right., and thus it is impossible to confirm the use of the Trademark.
C. Evidence A No. 1 contains the description of "General merchandise for men" in the column of "Type of purchase". However, since the specific product cannot be grasped, it is impossible to confirm which of the designated goods of the Trademark the product is recognized to be acknowledged as falling under the use of trademark by the holders of trademark right.
D. Evidence A No. 1 contains the description of "1213" in the column of "Month/Day"; however, it is not clear what sort of date the date in question refers to.
E. Article 2(3) of the Trademark Act stipulates that "use" with respect to a trademark is any of the following acts: to affix a trademark to goods or packages of goods; to assign, deliver, display for the purpose of assignment or delivery goods or packages of goods to which a trademark is affixed; or to display or distribute advertisement materials, price lists, or transaction documents relating to goods or services to which a mark is affixed. However, it is impossible to grasp from Evidence A No. 1 which of the "use" is performed.

2. Regarding the contents of written reply (to the demandee)
(1) If there is any means of proof which proves the sections A. and B. below, please be advised that it should be submitted and an explanation thereof should be provided.
A. Regarding the items A. to E. given in section 1. above as the reason that it is not recognized that the use of registered trademark provided in Article 50(2) of the Trademark Act is proven, it is recommended that new means of proof is submitted to prove.
B. If there are any comments against the provisional opinion stated in section 1. above and the written rebuttal for the trial case submitted by the demandant, it is recommended that the comments be stated along with the means of proof supportive evidence for the comments in question.
(2) If there are any new allegation and means of proof in addition to the allegation in the written reply for the trial case or the means of proof, it is recommended that they be submitted and the explanation therefor be provided.

No. 5 Response to inquiry from the demandee
No response from the demandee has been made to the inquiry described above.

No. 6 Judgment by the body
1. Regarding the evidence submitted by the demandee
Evidence A No. 1 is the "Account payable payment details <the details of purchase of this period>" (copy) from December 1, 2013 ended on December 31, 2013 sent from Sogo & Seibu Co., Ltd. to the demandee, and the issue date thereof is January 15, 2014. This contains the description "This is to inform you of the amount paid and the contents of balance-out", and the descriptions of "January 31, 2014" and "89,775" in "Payment date" and "Amount paid", respectively.

Then, there are the descriptions of "90,090", "315", and "89,775" in "Amount to be paid (a)", "Details of deduction (b)", and "Amount paid (a-b)", respectively.

Furthermore, there are the descriptions of "Digesting accounts payable/General merchandise for men", "1213", and "90,090" in the columns of "Type of purchase", "Month/Day", and "Purchase amounts (tax included)".

This reveals that Sogo & Seibu Co., Ltd. purchased "General merchandise for men" of 90,090 yen including consumption tax from the holder of the Trademark during the period of December 1 to December 31, 2013, and issued the "Account payable payment details <the details of purchase of this period>" relating to the transaction in question on January 15, 2014.

However, as stated in the inquiry mentioned above, Evidence A No. 1 was issued by Sogo & Seibu Co., Ltd., and thus it cannot be said that Evidence A No. 1 is distributed by the holder of the Trademark.

Then, the "transaction documents" falling under "use" stipulated in Article 2(3)(viii) of the Trademark Act refer to, for example, "purchase order", "Statement of delivery", or "letter of transmittal", etc., which is exchanged between interested parties in order to certify the fact and content at the time of commodity transactions. However, it should be said that the "Account payable payment details" in question is a notice of the amount of "89,775" which is to be paid by Sogo & Seibu Co., Ltd., to the holder of the Trademark on January 31, 2014, and thus it cannot be said that the "Account payable payment details" in question is a "transaction document".

Furthermore, Evidence A No. 1 does not contain the trademark relating to use. Although there is the description of "General merchandise for men" in the column of "Type of purchase", it is impossible to grasp the specific product thereof.

Moreover, there is no evidence which shows that the Trademark has been used in connection with the designated goods, which is stipulated in Article 2(3) of the Trademark Act, by the holder of the Trademark, etc.

Considering this, it cannot be said that the evidence submitted by the demandee proves that any of the holder of trademark right, exclusive right to use, or non-exclusive right to use had used the Trademark in Japan within three years prior to the registration of the demand for the trial in connection with any of the designated goods concerned. Furthermore, it is not clear that there is legitimate reason that the Trademark had not been used in connection with the designated goods.

2. Closing

Accordingly, the registration of the Trademark must be cancelled under the provision of Article 50(1) of the Trademark Act.

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

April 27, 2016

Chief administrative judge: DOI, Keiko
Administrative judge: TANAKA, Kyoko
Administrative judge: HIRASAWA, Yoshiyuki