

## Trial decision

Invalidation No. 2015-890057

Australia  
Demandant

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The case of trial regarding the invalidation of trademark registration for Trademark Registration No. 5,608,420 between the parties above has resulted in the following trial decision.

### Conclusion

The registration for Trademark Registration No. 5,608,420 is invalidated.  
The costs in connection with the trial shall be borne by the demandee.

### Reason

#### No. 1 The Trademark

The trademark with Trademark Registration No. 5,608,420 (hereinafter referred to as the "Trademark") consists of the standard characters of "EXINLIGHT" written in Alphabetic characters, and the application for its registration was filed on April 12, 2013 by setting Class No. 11 "Lighting apparatus" as the designated goods, the decision for registration was made on July 23, 2013, and the trademark was registered on August 16, 2013.

#### No. 2 Cited Trademark

The trademark with International Registration No. 1,191,751 which the demandant cites as a reason to invalidate the Trademark's registration (hereinafter referred to as the "Cited Trademark") is configured as indicated in Attachment, its international application was registered on June 14, 2013 claiming priority under the

Paris Convention Article 4 based on the application for trademark registration filed in Australia on December 17, 2012, the establishment of the trademark right was registered on August 28, 2015 with designated goods or designated services of Class 11 "Lighting apparatus and installations, including lighting apparatus and installations incorporating light-emitting diodes; parts and accessories for the aforesaid goods", Class 35 "Retailing, wholesaling and online retail services of lighting apparatus and installations including lighting apparatus and installations incorporating light-emitting diodes, light-emitting diodes and other light-emitting devices, electrical regulating apparatus, telecommunication apparatus, computers and their peripheral devices, display apparatus incorporating light-emitting diodes and other light-emitting devices, remote control apparatus for lighting apparatus and parts and accessories for the aforesaid goods", and Class 9 which are as specified in the Trademark Registry relating to the trademark right based on the international registration, and it is still valid as of now.

### No. 3 The demandant's allegation

The demandant requested a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request as follows, and submitted Evidences A No. 1 to A No. 6 as means of proof.

#### 1. Identicalness of goods

The designated goods of the Trademark are Class 11 "Lighting apparatus", which is identical or similar to the designated goods and designated services of the Cited Trademark

#### 2 Regarding similarity of trademark

The Trademark consists of the standard characters of "EXINLIGHT", and it is thus obvious that the Trademark gives rise to the natural pronunciation of "ikushinraitō" or "ekushinraitō".

On the other hand, the Cited Trademark consists of a gray earth-like figure that is drawn in a black horizontally long rectangular form, and the characters of "EXINLIGHT" written widely and remarkably thereabove, the characters concerned consisting of "EXIN" in red and "LIGHT" in gray, and the extremely small characters "Ex & Industrial Lighting" in gray are arranged below the character concerned. In the configuration in question, the character part of "EXINLIGHT" can give the strongest visual impression to the observer in the overall configuration by the size or way to express the letters.

Considering this, it is obvious that the Trademark and the Cited Trademark are similar trademarks which give rise to the common pronunciation of "ikushinraitō" or "ekushinraitō".

When the Trademark and the Cited Trademark are compared to each other in terms of the overall configuration thereof, they closely resemble each other in terms of appearance in the character part of "EXINLIGHT" which may serve independently as a mark for distinguishing relevant products from others.

The Trademark and the Cited Trademark consist of the configurations as stated in sections 1. and 2. above. Therefore, when comparing the Trademark with the character part of "EXINLIGHT" of the Cited Trademark which may serve independently as a mark for distinguishing relevant products from others, it can be said

that they are identical to each other in terms of meaning.

Accordingly, the Trademark and the Cited Trademark resemble each other in terms of appearance, and are common in their pronunciation and meaning. It thus should be said that they are similar trademarks which may be confused with each other.

### 3. Article 8(1) of the Trademark Act

Article 8(1) of the Trademark Act provides that where two or more applications for trademark registration relating to identical or similar trademarks which are to be used in connection with identical or similar goods have been filed on different dates, only the applicant who filed the application for trademark registration on the earlier date shall be entitled to register the trademark in question.

Considering this, the Trademark and the Cited Trademark are identical or similar to each other in terms of designated goods or designated services, and also are similar to each other in terms of trademarks. In light of the fact that the filing date of the Trademark is April 12, 2013, and the priority date for the Cited Trademark is December 17, 2012, the registration of the Trademark is apparently contrary to the provision in question.

### 4. Article 4(1)(vii) of the Trademark Act

The demandee started trading of purchase of the demandant's product on December 13, 2011 which is prior to the filing date of the Trademark (Evidence A No. 3). Then, in the document dated November 8, 2012, which is prior to the filing date of the Trademark, the demandee was approved by Smith Light International, which had the trade name of Golight, Inc. at the time, as an agency for providing sales and service in Japan regarding the produce named SMITH LIGHT which is a product of Golight, Inc. (Evidence A No. 4 and A No. 5).

Furthermore, the demandant used e-mail to notify the demandee who was the agency in Japan of the demandant at the time that the name "EXINLIGHT" will be used as a new brand name for the product of Golight, Inc. (Evidence A No. 6). Then, the demandee filed the application for trademark registration two days thereafter, i.e., April 12, 2013. More specifically, the demandee filed the trademark application and obtained the trademark registration while recognizing that the new brand name of the demandant's product will be "EXINLIGHT".

In this manner, the Trademark for which the demandee, who was the agency in Japan of the demandant at the time, filed the application for trademark registration in Japan without permission from the demandant and then obtained the registration therefor is liable to disturb fair trade order, and thus violates international trust to contravene public order (the determination 1998 (Gyo-Ke) 185 by Tokyo High Court on December 22, 1999).

Accordingly, the Trademark falls under Article 4(1)(vii) of the Trademark Act.

### 5. Closing

As described above, the Trademark and the Cited Trademark are trademarks similar to each other, and the Cited Trademark is in relation to the earlier application thereof. Furthermore, the designated goods of the Trademark are identical or similar to the designated goods of the Cited Trademark, and therefore, the Trademark falls under the provision of Article 8(1) of the Trademark Act, and thus should be invalidated under the provision of Article 46(1)(i) of the Trademark Act.

Moreover, the Trademark is liable to disturb fair trade order, and thus violates international trust to contravene public order. Therefore, the Trademark falls under the

provision of Article 4(1)(vii) of the Trademark Act, and thus should be invalidated under the provision of Article 46(1)(i) of the Trademark Act.

No. 4 The demandee's reply

The demandee does not make any reply to the demandant's allegation.

No. 5 Judgment by the body

1. Regarding similarity between the Trademark and the Cited Trademark

(1) Regarding the Trademark

As discussed in section No. 1 above, the Trademark consists of the standard characters of "EXINLIGHT" written in Alphabetic characters, and gives rise to the natural pronunciation of "ekushinraito" or "ikushinraito" according to the constituent characters thereof. It cannot be recognized that the characters constituting the Trademark are an idiomatic expression having a specific meaning, and thus they do not have a specific idea.

(2) Regarding the Cited Trademark

As discussed in section No. 2 above, the Cited Trademark consists, in a black horizontally long rectangular form containing a gray earth-like figure that is drawn therein, of the characters of "EXIN" in red, and the characters of "LIGHT" in gray on the right side thereof with a slight space using the same font of the same size as that of the character, and also the small characters of "Ex & Industrial Lighting" in gray that are arranged at the lower section. In the configuration in question, the characters of "EXIN" and those of "LIGHT" are in red and gray, respectively, and thus the colors are different from each other; however, both the character parts are written widely at the center part in the Cited Trademark with the same font and size at regular intervals. The interval between the characters of "EXIN" and those of "LIGHT" is as small as a half width, and thus it is reasonable to understand that the two character parts are observed by observers as being integral with each other. Furthermore, since the character parts in question are written widely compared to the characters on the lower section, the character part of "EXINLIGHT" in the constitution of the Cited Trademark gives a strong and dominant impression, and thus it can be understood that this is a prominent feature as a mark identifying the source of goods in the Cited Trademark.

Accordingly, the Cited Trademark give rise to the natural pronunciation of "ekushinraito" or "ikushinraito" according to the constituent characters from the character part of "EXINLIGHT" in the constitution thereof, and thus does not have a specific idea.

(3) Determination of similarity between the Trademark and the Cited Trademark

In comparison with the Trademark and the Cited Trademark, the Trademark causes no specific meaning when compared with the prominent feature of the Cited Trademark, and thus they have the same configurations of the letters while not being able to be compared with each other in terms of meaning. Furthermore, they are in common with each other in terms of the pronunciation of "ekushinraito" or "ikushinraito". Therefore, taking impression, memory, and association given to traders and customers by the appearances, pronunciations, and meanings of the two trademarks generally into comprehensive account, it should be said that they are similar trademarks which may be confused with each other.

2. Regarding Article 8(1) of the Trademark Act

(1) Regarding similarity between the Trademark and the Cited Trademark

As discussed above, the Trademark is a trademark similar to the Cited Trademark.

(2) Regarding similarity between the designated goods of the Trademark and the designated goods and designated services of the Cited Trademark

The designated goods of the Trademark are Class 11 "Lighting apparatus" as stated in the section No. 1 above, which is identical or similar to the designated goods and designated services of the Cited Trademark in part, i.e., Class 11 "Lighting apparatus and installations, including lighting apparatus and installations incorporating light-emitting diodes; parts and accessories for the aforesaid goods", and Class 35 "Retailing, wholesaling and online retail services of lighting apparatus and installations including lighting apparatus and installations incorporating light-emitting diodes, light-emitting diodes and other light-emitting devices, electrical regulating apparatus, telecommunication apparatus, computers and their peripheral devices, display apparatus incorporating light-emitting diodes and other light-emitting devices, remote control apparatus for lighting apparatus and parts and accessories for the aforesaid goods", as stated in section No. 2 above.

(3) Regarding the applicants relating to the Trademark and the Cited Trademark

The application for the registration of the Trademark was filed on April 12, 2013, as stated in section No. 1 above.

On the other hand, the application for international registration of the Cited Trademark in which Japan is designated was filed on June 14, 2013 claiming priority under the Paris Convention Article 4 based on the application for trademark registration filed in Australia on December 17, 2012 which is prior to the filing date of the application for the registration of the Trademark, as stated in section No. 2 above.

Considering this, the filing date of the application for the registration of the Trademark is later than the filing date of the application for the trademark registration of the Cited Trademark that was made in a country party to the Paris Convention. Therefore, it has to be said that the Cited Trademark is in relation to the earlier application of the Trademark.

Accordingly, it cannot be said that the applicant for the registration of the Trademark is "the applicant who filed the application for trademark registration on the earlier date" provided in Article 8(1) of the Trademark Act, and thus it is recognized that the applicant for the trademark registration in relation to the Cited Trademark is "the applicant who filed the application for trademark registration on the earlier date" provided in Article 8(1) of the Trademark Act.

(4) Summary

Considering this, the Trademark is similar to the Cited Trademark, and the designated goods thereof are identical or similar to the designated goods and designated services of the Cited Trademark. It thus cannot be recognized that the applicant for registration of the Trademark is the "the applicant who filed the application for trademark registration on the earlier date" provided in Article 8(1) of the Trademark Act, and therefore the registration of the Trademark is contrary to Article 8(1) of the Trademark Act.

3. Conclusion

As described above, the registration of the Trademark is contrary to Article 8(1) of the Trademark Act without discussing Article 4(1)(vii) of the Trademark Act, and

thus should be invalidated under the provision of Article 46(1) of the Trademark Act.  
Therefore, the trial decision shall be made as described in the conclusion.

May 11, 2016

Chief administrative judge: KONDA, Mitsuo

Administrative judge: HORIUCHI, Jinko

Administrative judge: KOMATSU, Satomi

Attachment (Cited Trademark) (Refer to the original in regard to color)

