Trial decision

Invalidation No. 2015-890061

Switzerland
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The case of Invalidation of the Trademark Registration No. 5614931 between the parties above has resulted in the following trial decision

Conclusion

The trial l 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. 5614931 (hereinafter referred to as the "Trademark") consists of the standard characters "Gold Skin," and the application for its registration was filed on May 17, 2013 by setting Class No. 14 "Precious metals; unwrought and semi-wrought precious stones and their imitations; keyrings; jewelry cases; personal ornaments; shoe ornaments of precious metal; clocks and watches" as the designated goods, the decision for registration was issued on August 20, 2013, and the establishment of the trademark was registered on September 13, 2013.

No. 2 The Cited Trademark

The Trademark Registration No. 5532858 (hereinafter referred to as the "Cited Trademark") cited by the demandant as the reason for invalidation of registration of the Trademark consists of the standard characters of "SKIN"; its registration application was filed on April 26, 2012, the establishment of the trademark was registered on

November 2, 2012 by setting Class No. 14 "Precious metals; unwrought and semi-wrought precious stones and their imitations; keyrings; jewelry cases; personal ornaments; shoe ornaments of precious metal; clocks and watches" as the designated goods, and it is still valid as of now.

No. 3 The demandant's allegation

The demandant requested a trial decision in which "With regard to the designated goods of the Trademark, the registration of 'Personal ornaments; clocks and watches' in Class 14 shall be invalidated, 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 follows, and submitted Exhibits A No. 1 to A No. 36 as means of evidence.

1. Interest

The Trademark is a trademark which is identical with, or similar to, the Cited Trademark owned by the demandant, and the designated goods "Personal ornaments; clocks and watches" are in conflict with the designated goods "Personal ornaments; clocks and watches" of the Cited Trademark.

Therefore, the demandant has an interest in requesting invalidation of registration with respect to the designated goods "Personal ornaments; clocks and watches."

2. Statement of the demand

The Trademark was registered while violating Article 4(1)(xvi), Article 4(1)(xi), and Article 4(1)(xv) of the Trademark Act because of the following statements, and therefore the registration should be invalidated under the provisions of Article 46(1) of the same Act.

(1) Regarding the designated goods pertaining to the request

Gold (color) clocks and watches are commonly found in the market, and are becoming commonplace (Exhibits A No. 5 and A No. 6). The same holds for personal ornaments (Exhibits A No. 10 and A No. 11). Personal ornaments made of brass or made of gilding metal are gold (color), although gold (precious metal) is not used. Furthermore, clocks and watches as well as personal ornaments using gold (precious metal) are also widely found in the market (Exhibits A No. 7, A No. 8, A No. 10, and A No. 12). With regard to clocks and watches, even the term "*KINDOKEI* (gold watch)" is given in a Japanese-language dictionary (Exhibit A No. 9).

(2) Regarding the Trademark

A. In the Trademark, the word "Gold" in the former half part is an English word meaning "gold, golden, made of gold, gold color, gold-colored," etc. This is taught in junior high school and the education therein is compulsory in our country. Consumers and traders in our country are thus familiar with the word concerned (Exhibit A No. 13). Furthermore, the word "Skin" in the latter half part is an English word meaning "dermis, skin" (Exhibit A No. 13). This also is taught in junior high school and the education therein is compulsory in our country. There are a lot of words which are used on a daily basis as Katakana words, such as "skin care (taking care of skin)," "skin-ship (skin contact)," etc. (Exhibit A No. 9).

B. The Trademark has a space for one character between "Gold" and "Skin," and thus the words concerned are understood separately from each other. Moreover, each of "Gold" and "Skin" begins with a capital letter and the rest thereof consists of lower-case

letters, and thus they are understood to be separate words.

Consequently, the Trademark is supposed to be understood as "Gold" and "Skin" separately from each other by the configuration of its appearance.

C. There are some English idioms consisting of two words and having a meaning, such as "gold medalist (a winner who was awarded a gold medal in sports events, particularly at the Olympics)." However, there is no English idiom of "Gold Skin" consisting of two words and having a meaning. The meaning of the Trademark as a whole may be "gold (precious metal) skin, gold (color) skin" if interpreted in a farfetched way. However, such humans, animals, and plants do not exist at all, and thus it does not make sense.

Therefore, the Trademark is understood as "Gold" and "Skin" separately from each other also in terms of meaning.

(3) Regarding Article 4(1)(xvi) of the Trademark Act

A. As discussed in the section (1) above, gold (color) clocks and watches, and personal ornaments, clocks and watches using gold (precious metal), and personal ornaments are commonly found in the market. Therefore, when the Trademark is used in the designated goods thereof; i.e., "Clocks and watches; personal ornaments," traders and consumers understand the part of character "Gold" as "color of goods" or "a noble metal material used in goods."

Considering this, if the Trademark is used in "Clocks and watches; personal ornaments" which are not gold (color) in color and in which gold (precious metal) is not used, it is abundantly obvious that it may be misleading in terms of quality of goods (color of goods, raw materials of goods).

B. With respect to "ゴールドスミス" (Registration No. 4863975: Exhibit A No. 14) and "ゴールドサテライトハウス/GoldSatelliteHouse" (Registration No. 4878670: Exhibit A No. 15), which are earlier registrations in Class 14 of the International Classification of Goods and Services, the designated goods thereof are limited to those using gold (precious metal).

C. Accordingly, the Trademark falls under Article 4(1)(xvi) of the Trademark Act if used in "Clocks and watches; personal ornaments" except "gold (color) clocks and watches, and personal ornaments, as well as clocks and watches, and personal ornaments using gold (precious metal)".

(4) Regarding Article 4(1)(xi) of the Trademark Act

A. Relationship between senior and junior applications

The Cited Trademark was filed prior to the Trademark.

B. Comparison of the designated goods

In the designated goods the Trademark, "Clocks and watches; personal ornaments" is in conflict with the designated goods of The Cited Trademark.

C. Comparison of trademarks

(A) Primary part of the Trademark

As discussed in the section (2) above, with regard to the goods "Personal ornaments; clocks and watches," traders and consumers understand that "Gold" in the Trademark is "color of goods" or "a noble metal material used in goods". Therefore, the primary part of the Trademark is the character part of "Skin."

(B) Both the primary part "Skin" of the Trademark and The Cited Trademark give rise to the meaning of "skin, dermis" and the pronunciation of "sukin," and thus they are identical with each other in terms of meaning and pronunciation.

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

regarding "Personal ornaments; clocks and watches" in the designated goods thereof.
(5) Regarding Article 4(1)(xv) of the Trademark Act
A. Regarding clocks and watches
(A) The demandant has sold a wrist watch using the trademark "SKIN" (The Cited Trademark) in many countries, including our country, since 1997. The Cited Trademark has been widely known not only in our country but also around the world as a brand of the wrist watch of the demandant, which is well known and prominent.

In addition, the demandant had owned the registration in Japan of the trademark consisting of the characters "SKIN" (standard characters) (Exhibit A No. 16). However, the demandant forgot to take the procedure of registration of renewal and thus the registration was lapsed, so that an application was newly filed and then led to registration. That is the Cited Trademark.
(B) Exhibits A No. 17 to A No. 28 are catalogues of the wrist watch using the Cited Trademark which have been distributed and kept by the demandant. (The demandant at first prepared and distributed catalogues dedicated to the wrist watch using the Cited Trademark. After the wrist watch using the Cited Trademark became well known and prominent as products of the demandant, the wrist watch concerned appeared not in the dedicated catalogue but in a general catalogue. The wrist watch using the Cited Trademark is of the model "SFK," "SFM" or "SF*.")

Furthermore, Exhibit A No. 29 indicates the approximate number of sales and the approximate amount of sales of the wrist watch using the Cited Trademark in Japan after 2006.
(C) The wrist watch using the Cited Trademark has been sold in a variety of colors, and "gold (color) SKIN brand wrist watch" has of course been sold from past to present (Exhibit A No. 30).
(D) In light of the fact concerned, considering the Cited Trademark which is well known and prominent, the Trademark is understood as an indication of "the SKIN brand product in gold or made of gold". If it is used in the designated goods "clocks and watches," this may cause false recognition and confusion about the source of the "clocks and watches" in question. The products in question may thus be mistakenly recognized as if they are the products relating to the business of the demandant who is an "unrelated person" for the owner of a right of the Trademark, resulting in false recognition.

Accordingly, the Trademark falls under Article 4(1)(xv) of the Trademark Act regarding "clocks and watches" in the designated goods thereof even if it does not fall under Article 4(1)(xi) of the Trademark Act.
B. Regarding personal ornaments

The demandant also manufactures and sells personal ornaments. However, it is hard to say that the Cited Trademark for use therein is well known and prominent like the wrist watch.

However, in actual transactions, personal ornaments are collectively sold in the same department as clocks and watches, such as "a jewelry, clocks and watches department" and "a jewelry & watch department" (Exhibits A No. 31 to A No. 33). In addition, the Trademark is understood as an indication of "the SKIN brand product in gold or made of gold" as described above. Considering that a lot of "personal ornaments" which are "gold in color or made of gold" exist and are sold, if personal ornaments with the Trademark attached thereon are displayed and sold in the vicinity of the wrist watch using the Cited Trademark, this may cause false recognition and

confusion about the source of personal ornaments with the Trademark provided thereon. The products in question are thus highly likely to be mistakenly recognized as if they are the products relating to the business of the demandant who is an "unrelated person" for the owner of a right of the Trademark, resulting in false recognition.

Accordingly, the Trademark falls under Article 4(1)(xv) of the Trademark Act regarding "personal ornaments" in the designated goods thereof even if it does not fall under Article 4(1)(xi) of the Trademark Act.

3. Rebuttal against reply

(1) Regarding recognition of consumers and traders

Both "Gold" and "Skin" are English words which are commonly familiar and well known to consumers in our country and traders. It is thus totally unnatural that, when there exists an objective fact that catches the notice of consumers and traders, consumers and traders coming into contact with the Trademark "Gold Skin" understand it as mysterious "gold (color) skin" which does not exist in nature in terms any of human, animals, and plants. It is thus obvious that the former half part "Gold" evokes "color of goods" and "raw materials of goods" which is familiar in the market, and the latter half part "Skin" is recognized as an indication of source of goods (mark for distinguishing relevant products from others) which is not particularly relevant to the product itself.

(2) Regarding precedent trial decision by JPO

In light of the examples of three trial decisions; i.e., "BLACK ACE/ブラックエース" and "英須／エース" (Exhibit A No. 34), "パープルフィニッシュ" and "フィニッシュ" (Exhibit A No. 35), and "BLUE COMME CA/ブルーコムサ" and "COMME CA" (Exhibit A No. 36), in which it was determined that the trademark includes the former half part indicating the color (quality) of the designated goods and thus is not capable of distinguishing relevant products from others, it has to be said that the former half part "Gold" of the Trademark "Gold Skin" is not capable, or only feebly capable, if at all, of distinguishing relevant products from others. The latter half part "Skin" which gives a strong and dominant impression is resultingly a mark for distinguishing relevant products from others.

(3) Regarding precedent example of registration

The demandee listed the examples of trial decisions in Exhibits B No. 1 to B No. 3. However, all of them are the registered trademarks which were examined and registered as "those which are uniform as a whole" as being an abbreviation of the trade name (company name) (that is, the remainder of the trade name (company name) from which "limited company" or "corporation" indicating the type of company is removed). There are the cases different from this case, and thus are not of reference to this case.

(4) Rebuttal against the other allegations

A. On the basis of the fact that a mark of "swatch" is provided on the catalogues submitted by the demandant, the demandee intends to deny the prominence of "SKIN". However, the description of manufacture's name or the abbreviation thereof on a product catalogue is widely performed in the industry of clocks and watches (Exhibits A No. 5 to A No. 8, for example). Therefore, if the prominence can be denied due to manufacture's name or the abbreviation thereof provided in the product catalogue, none of individual brands except company name or the abbreviation thereof resultingly possesses prominence, which is not reasonable.

B. The demandee intends to deny the prominence of "SKIN" by means of the total

number of sales of the wrist watch in Japan. However, this leads to a result in which, even if the product is a limited product and therefore traders and consumers talk much about the product, the prominence is denied for the product which has a lower ratio with respect to the total number of sales of the wrist watch in Japan because it is a limited product. Therefore, it is unreasonable to employ the ratio as a judgment criterion.
C. A yearly number of sales of "SKIN" brand wrist watches of the demandant in our country is 15,000, which means that consumers and traders in our country purchase slightly more than 41 watches per day. Furthermore, of course there are some people who took to purchase the product but did not dare to purchase it. Those people saw and knew "SKIN" brand inscribed on the wrist watch itself, and thus "SKIN" brand of the demandant is well known and prominent.
D. The demandee points out the existence of "shops that deal with only personal ornaments," and denies confusion between the brand of the wrist watch and the brand of personal ornaments. However, as opposed to the case where there is no "shop that deals with both wrist watches and personal ornaments," or the case where there are very small number of "shops that deal with both wrist watches and personal ornaments," there are a significant number of "shops that deal with both wrist watches and personal ornaments." As a result, confusion of the brand of the wrist watch and the brand of personal ornaments is inevitable.

No. 4 Demandee's allegation

The demandee replied that the demandee requests a trial decision whose content is the same as the conclusion, summarized and mentioned reasons for request as follows, and submitted Exhibits B No. 1 to B No. 6 as means of evidence.
1. Regarding Article 4(1)(xi) of the Trademark Act
(1) The Trademark and the Cited Trademark are not identical or similar to each other
A. The Trademark

The Trademark consists of the characters of "Gold" and "Skin" arranged laterally in line in the same font and size, while providing a space for a single letter therebetween. The pronunciation of "goorudosukin" resulting from the overall constituent characters can be pronounced reasonably in series.

Then, in the Trademark, the characters "Gold" in the configuration thereof have been familiar and used in Japan as an English word having a meaning of "gold, , golden, made of gold, gold-colored," and the characters "Skin" have been familiar and used in Japan as an English word having a meaning of "dermis, skin, hide". It is thus reasonable to regard the overall configuration thereof as providing the understanding and recognition of the meaning of "golden skin," and thus it cannot be said that there is a difference in importance between "Gold" and "Skin" of the Trademark.

Considering this, it cannot be said that the part of the character "Skin" in the configuration of the Trademark gives a strong and dominant impression as a mark identifying the source of goods, and therefore it should be said that it cannot be allowed that only the part of the characters "Skin" is separated and extracted to compare with the Cited Trademark so as to determine the identification of the trademark itself.

Accordingly, the Trademark gives rise to only a pronunciation of "goorudosukin" according to the constituent characters, and evokes the meaning of "golden skin."

In addition, the demandant alleges that the meaning of "golden skin" is the

understanding of the meaning of the Trademark in a farfetched way, and there is no English idiom which consists of two words "Gold Skin" and has a meaning; and furthermore, no human, animal, or plant having "golden skin" exists at all, and thus the words make no sense.

However, since consumers in our country are those coming into contact with the Trademark, there is no harm in recognizing the uniformity in terms of the meaning only when consumers in our country easily understand and recognize the meaning. It cannot be said that the uniformity in terms of the meaning is caused if the words do not exist in English-speaking countries as an English idiom. Likewise, it should be said that there is no reason that those things understood and recognized by consumers have to exist in nature.

B. The Cited Trademark

The Cited Trademark gives rise to the pronunciation of "sukin" and the meaning of "dermis, skin, hide" according to the constituent characters.

C. Similarity of the Trademark and the Cited Trademark

(A) Appearance

There is a particular difference between the Trademark and the Cited Trademark in the presence or absence of "Gold" in the beginning thereof. Therefore, they may not be confused and thus sufficiently indistinguishable from each other even if observed at different times and places.

(B) Pronunciation

The pronunciation of "goorudosukin" resulting from the Trademark and the pronunciation of "sukin" resulting from the Cited Trademark are different in the presence or absence of the sound "goorudo" in the beginning part that is important in terms of distinguishing the pronunciation. Therefore, they may not be confused in terms of pronunciation.

(C) Meaning

The Trademark and the Cited Trademark give rise to the meaning of "golden skin" and the meaning "dermis, skin, hide," respectively. Therefore, they are distinguishable in terms of meaning.

(D) Actual trade condition

the demandant alleges that clocks and watches in gold, and personal ornaments in gold are commonly found in the market, and thus "Gold" constituting the Trademark is understood to be "color of goods" when used in the designated goods "Clocks and watches; personal ornaments," and it does not act as a mark for distinguishing relevant products from others.

However, as discussed above, the appearance of the Trademark is integrated. Furthermore, the Trademark evokes the meaning of "golden skin". Considering this, "Gold" is understood to be the modification of "Skin," and is not to be understood as an indication of color of goods for which the Trademark is used. Because of this, it cannot be said that "Gold" in the Trademark is excluded from determination of similarity as the part not capable of distinguishing relevant products from others. Furthermore, it cannot be said that the fact that clocks and watches in gold or personal ornaments in gold are commonly found in the market is regarded as an actual trade condition which should be regarded as being likely to cause confusion about the source of goods regarding the Trademark and the Cited Trademark.

(2) According to the discussion above, the Trademark and the Cited Trademark may not

be confused with each other at all in terms of any of appearance, pronunciation, and meaning. Even if they are used in identical or similar goods, and thus it cannot be said that they are the trademarks identical with, or similar to, each other.

Accordingly, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

2. Regarding Article 4(1)(xvi) of the Trademark Act

(1) The appearance of the Trademark is integrated as discussed above, and furthermore, the Trademark gives rise to the meaning "golden skin" as a whole. Accordingly, the characters "Gold" are understood to be merely a modification to "Skin," and are not to be understood as an indication of color of goods.

(2) Although there are a lot of registered trademarks which set "Clocks and watches; personal ornaments" as the designated goods and include "Gold (GOLD)" in the configuration thereof, a substantial majority of them do not limit the designated goods to "clocks and watches in gold," "personal ornaments in gold," etc. (Exhibits B No. 1 to B No. 3). This also proves that the part "Gold" is not an indication of color of goods, but a modification to other components of a composite trademark.

(3) According to the discussion above, it cannot be said that those coming into contact with the Trademark may mistakenly recognize the quality of goods for which the Trademark is used.

Accordingly, the Trademark does not fall under Article 4(1)(xvi) of the Trademark Act.

3 Regarding Article 4(1)(xv) of the Trademark Act

(1) Regarding clocks and watches

A. Prominence of the Cited Trademark

In order to regard the trademark as being prominent, it should be said that the accomplishment for the trademark in question is at least required; i.e., the use thereof for a long time as an indication of a source of goods, widespread advertisement and promotion, and a substantial number of sales of the product.

(A) The number of independent uses of the Cited Trademark is extremely small

According to the catalogue dedicated to clocks and watches using the Cited Trademark, the Cited Trademark appears on the cover page in combination with "swatch" (Exhibits A No. 17 to A No. 23). It can be said that "swatch" is a house mark of the demandant. This is prominent as a brand of clocks and watches, and has significantly high distinctiveness. On the other hand, the Cited Trademark is a word that is easily understood as an English word meaning "dermis, skin," etc. Since clocks and watches are worn in contact with dermis of the arm, the Cited Trademark implicitly indicates the details of clocks and watches, and the distinctiveness thereof is low compared to the part of "swatch."

Considering this, while consumers pay attention rather to the part of "swatch," it cannot be said that only the Cited Trademark has been widely recognized by consumers as a trademark indicating clocks and watches of the demandant.

In addition, description such as "SKIN COLLECTION 1999" can be found on the cover page of the dedicated catalogue. However, the characters are so small that they cannot catch consumers' eyes.

Furthermore, the general catalogue (Exhibits A No. 24 to A No. 28) merely contains the description of models such as SFK. The description of the Cited

Trademark singly can be found merely in a price list in the general catalogue in Spring/Summer of 2009 (Exhibit A No. 26), and few other descriptions can be found.

Accordingly, it cannot be said that the Cited Trademark has been used for a long time as an indication of a source of goods of clocks and watches of the demandant.

(B) Widespread advertisement and promotion of the product in relation to the Cited Trademark cannot be acknowledged

The demandant submitted catalogues as evidence. However, among the catalogues, only the dedicated catalogue containing the Cited Trademark on the cover page thereof can be an evidential matter which corroborates the prominence of the Cited Trademark.

However, the latest one of the dedicated catalogues was issued 11 years ago, in 2004, which has to be acknowledged to be too old. There is uncertainty about this as evidence which corroborates the prominence at the time of filing the Trademark (2013). Furthermore, the number of distribution and geographical coverage of distribution of the dedicated catalogue are also unclear.

Furthermore, no reference is made at all to the fact that the demandant made advertisement and promotion in newspapers, magazines, on television, etc., and the fact that a third party introduced the product using the Cited Trademark in newspapers, magazines, or on television, etc.

Accordingly, it cannot be said that widespread advertisement and promotion of the product in relation to the Cited Trademark can be acknowledged.

(C) It cannot be said that the number and amount of sales of the product in relation to the Cited Trademark are large and high

a. Evidentiary value of Exhibit A No. 29 is low

Regarding a material indicating the approximate number and amount of sales of the product using the Cited Trademark after 2006 in Japan (Exhibit A No. 29), it is unclear who made it and when it was made. A document in principle has an evidentiary value as that describes a thought of a specified person. If a person who made the document is unclear although it is not particularly disadvantageous to clarify the person concerned, the evidentiary value has to be evaluated to be low.

Considering this, it has to be said that it is doubtful whether the number and amount of sales described in Exhibit A No. 29 are actual figures in the first place.

b. It cannot be said that the number and amount of sales of the product in relation to the Cited Trademark are large and high

Even if the number and amount of sales described in Exhibit A No. 29 can be acknowledged, it cannot be said that they are large and high as the number and amount of sales of clocks and watches. More specifically, the number of sales of clocks and watches using the Cited Trademark decreases year after year, and the number of sales in 2013, in which the Trademark was filed, was 15,000. On the other hand, the estimation of the market size of clocks and watches by Japan Clock & Watch Association states that the number of sales of clocks and watches in 2013 in Japan was 42,600,000 if limited to wrist watches (Exhibit B No. 4). The share of the clocks and watches using the Cited Trademark is only 0.035%, and the share of the amount of sales is only 0.031%.

In addition, the number of shipping of the product using the trademark "G-SHOCK" of Casio Computer Co., Ltd. reaches 1,200,000 in 2012 (Exhibit B No. 5). Considering this, it cannot be said that the number of sales of the clocks and watches

using the Cited Trademark, which is only 15,000, is large.

Accordingly, it cannot be said that a substantial number of sales of the product have been accomplished regarding the clocks and watches using the Cited Trademark.

B. Possibility of confusion and false recognition of the Trademark and the Cited Trademark

As discussed above, it cannot be said that the Cited Trademark has been widely recognized by consumers as a trademark indicating the product in relation to business of the demandant. Therefore, it cannot be said that, even if the Trademark is used in "clocks and watches," a person coming into contact with the Trademark recognizes "the product of gold SKIN brand" to immediately imagine and associate the Cited Trademark with the part of "Skin" of the Trademark so as to mistakenly believe as if it is the product in relation to business of the demandant or a person who has an economic or organizational relation with the demandant. Therefore, it cannot be said that it might cause confusion about the source of goods.

(2) Regarding personal ornaments

As discussed above, it cannot be said that the Cited Trademark has been widely recognized by consumers as a trademark indicating the product in relation to business of the demandant.

Furthermore, the demandant alleges that, in the actual state of transaction, personal ornaments are sold along with clocks and watches. However, personal ornaments are sold not only in the department stores pointed out by the demandant, but also in specialized shops who deal with only personal ornaments. Therefore, the sale of personal ornaments along with clocks and watches is not necessarily the actual state of transaction (Exhibit B No. 6).

Considering this, it cannot be said that, even if the Trademark is used in " personal ornaments, " a person coming into contact with the Trademark immediately imagines and associates the Cited Trademark with the part of "Skin" of the Trademark so as to mistakenly believe as if it is a product in relation to business of the demandant or a person who has an economic or organizational relation with the demandant. Therefore, it cannot be said that it might cause confusion about the source of goods.

(3) Accordingly, the Trademark does not fall under Article 4(1)(xv) of the Trademark Act.

4. Closing

As discussed above, the Trademark was registered regarding "Clocks and watches; personal ornaments " in the designated goods thereof while not violating Article 4(1)(xi), Article 4(1)(xvi), and Article 4(1)(xv) of the Trademark Act, and therefore the registration should not be invalidated under the provisions of Article 46(1)(i) of the same Act.

No. 5 Judgment by the body

Since no dispute arises between the parties that the demandant is an interested person in demanding trial of this case, the trial examination shall proceed.

1. Regarding the Trademark

As discussed in section No. 1 above, the Trademark consists of the characters of "Gold Skin". While a space for a single letter is provided therebetween, the characters in question are in the same font and size, and are well integrated and uniform in appearance. Furthermore, the pronunciation of "goorudosukin" which is recognized as

resulting from the overall Trademark can be pronounced smoothly. Furthermore, the overall Trademark does not give rise to a familiar idiomatic meaning. However, in Japan, the character part of "Gold" in the constituent characters is commonly well known as an English word meaning "gold, gold coin, gold product, gold color, " etc. (Exhibit A No. 13), and the character part of "Skin" is commonly well known as an English word meaning "(human) dermis or skin, hide or fur (taken from animals)," etc. (Exhibit A No. 13), and each of them is used daily. Therefore, considering that those characters (words) immediately evoke the meanings described above, and the meanings of "Gold" and "Skin" can be easily understood as being integrated with each other in light of the uniformity between the characters in question in terms of appearance and pronunciation thereof, as well as considering the unity of the characters "Gold" and "Skin," it is reasonable that the overall configuration of the Trademark expresses the meaning of "gold or gold-colored skin, gold or gold-colored hide or fur,".

Considering this, it can be said that the Trademark can be understood and recognized as expressing a uniformly integrated trademark by the overall configuration thereof in consideration of appearance, pronunciation, and meaning.

In relation to the discussion above, the demandant alleges that the characters "Gold" and "Skin" in the Trademark do not possess uniformity in terms of appearance and meaning, and the character part of "Gold" is the portion indicating the color and raw material of "Clocks and watches; personal ornaments" which are the designated goods in relation to the demand of the case, so that the primary part of the Trademark is the character part of "Skin". The demandant submitted Exhibits A No. 5 to A No. 8, and Exhibits A No. 10 to A No. 12.

The above-mentioned evidence submitted by the demandant reveals that descriptions such as "華やかなイエローゴールドカラー...(gorgeous yellow gold color)" (Exhibit A No. 5), "金メタリック色 (golden metallic color)" (Exhibit A No. 6), "18Kイエローゴールドケース (18K yellow gold case)" (Exhibit A No. 7), "枠 金属（黄銅）ヘアライン・光沢クリア塗装仕上げ・金メッキ (Frame: metal (brass); Hairline: glossy clear coating finishing, gold plating)" (Exhibit A No. 8), "ゴールドやシルバーのようなスタンダードな素材は... (Standard materials such as gold and silver are ...), " "ゴールド/ゴールドは、ジュエリーと最も関わりの深い貴金属です。(Gold/gold is a precious metal most closely associated with jewelry," "ギルティング・メタルは...黄金色の展延性に富んだ素材です。(Gilding metal is ... a gold-colored material having excellent spreadability)" (Exhibit A No. 10), "18-carat yellow gold" (Exhibit A No. 12), etc., are used as indications of color and raw material of "Clocks and watches; personal ornaments". However, all those characters indicating quality are descriptively contained apart from the description of the trademark as characterizing the product, and thus nothing is described along with the trademark. Then, it can be said that the Trademark can be understood and recognized as expressing a uniformly integrated trademark by the overall configuration thereof in consideration of appearance, pronunciation, and meaning. Accordingly, even if there is a fact that any descriptive indication characterizing the product in question is used as an indication of color and raw material of "Clocks and watches; personal ornaments," it should not be said that the character part of "Gold" in the Trademark consisting of the configuration described above is immediately recognized as the part indicating color and raw material of goods. Therefore, the demandant's allegation in relation to the matter described

above cannot be adopted.

Accordingly, it can be recognized that the Trademark gives rise to only a pronunciation of "goorudosukin" according to the overall constituent characters thereof, and thus evokes the meaning of "gold or gold-colored skin, gold or gold-colored hide or fur,".

2. Regarding Article 4(1)(xvi) of the Trademark Act

As is found in section 1 above, the Trademark is understood and recognized as expressing a uniformly integrated trademark by the overall configuration thereof, and thus only the character part of "Gold" or only the character part of "Skin" is not independently understood and recognized separately from the Trademark. Furthermore, there is no evidence sufficient to find that such an actual trade condition is acknowledged that, in light of the configuration of the Trademark, traders and consumers in the field of dealing with "Clocks and watches; personal ornaments" recognize the character part of "Gold" in the configuration of the Trademark as an indication of the quality of the product.

Considering this, it should be said that the Trademark may not cause false recognition about the quality of product even if the Trademark is used in any of "Clocks and watches; personal ornaments" in the designated goods.

Accordingly, the Trademark does not fall under Article 4(1)(xvi) of the Trademark Act.

3. Regarding Article 4(1)(xi) of the Trademark Act

(1) The Trademark

As is found in the section 1 above, the Trademark is understood and recognized as expressing a uniformly integrated trademark by the overall configuration thereof. It thus can be acknowledged that the Trademark gives rise to only a pronunciation of "goorudosukin" according to the constituent characters thereof, and evokes the meaning of "gold or gold-colored skin, gold or gold-colored hide or fur,"(2) The Cited Trademark

As is found in the section 2 above, the Cited Trademark consists of the standard characters of "SKIN." Therefore, the Cited Trademark gives rise to the pronunciation of "sukin" according to the constituent characters thereof, and evokes the meaning of "(human) dermis or skin, hide or fur (taken from animals)."

(3) Comparison of the Trademark and the Cited Trademark

A. Appearance

Since the Trademark and the Cited Trademark consist of the configurations described above, they are obviously different in appearance from each other.

B. Pronunciation

The pronunciation of "goorudosukin" resulting from the Trademark and the pronunciation of "sukin" resulting from the Cited Trademark are different from each other in the presence or absence of the sound "goorudo" in the forward part thereof. Therefore, tone and sense offered by the pronunciation are significantly different from each other when they are pronounced as a whole, and thus they can be clearly distinguished from each other.

C. Meaning

The Trademark evokes the meaning of "gold or gold-colored skin, gold or gold-colored hide or fur,", whereas the Cited Trademark evokes the meaning of "(human) dermis or skin, hide or fur (taken from animals)." Therefore, the meanings thereof may

not be confused.
D. In light of the facts described above, it should be said that the Trademark is distinguishable from and non-similar to the Cited Trademark in terms any of appearance, pronunciation, and meaning.
(4) Accordingly, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.
4. Regarding Article 4(1)(xv) of the Trademark Act
(1) Prominence of the Cited Trademark
A. Exhibits A No. 17 to A No. 29 reveal the following facts.
(A) The demandant made the catalogues titled "SKIN COLLECTION 1999" (Exhibit A No. 17), "SKIN COLLECTION SPRING-SUMMER 2000" (Exhibit A No. 18), "skin collection fall/winter 2000" (Exhibit A No. 19), "SKIN COLLECTION 2001" (Exhibit A No. 20), "Fall/Winter Collection 2003" (Exhibit A No. 21), "SPRING-SUMMER COLLECTION 2004" (Exhibit A No. 22), and "Fall-Winter Collection 2004" (Exhibit A No. 23). All those catalogues contain on the cover page thereof the trademark consisting of the characters of "swatch" and the characters of "SKIN" arranged laterally in two lines. In addition, wrist watches contained in the catalogues in question are provided with a variety of trademarks, but no wrist watch is provided with the Cited Trademark solely.
(B) The demandant made the catalogues titled "SUMMER-SPORT COLLECTION 2006" (Exhibit A No. 24), "FALL-WINTER COLLECTION 2008" (Exhibit A No. 25), "SPRING-SUMMER COLLECTION 2009" (Exhibit A No. 26), "SPRING-SUMMER COLLECTION 2013" (Exhibit A No. 27), "FALL-WINTER COLLECTION 2014" (Exhibit A No. 28; provided that this catalogue seems to have been issued after the date of registration application for the Trademark (May 17, 2013)). All those catalogues contain on the cover page thereof the trademark consisting of the characters of "swatch". In addition, wrist watches contained in the catalogues in question are provided with a variety of trademarks and symbols such as model number, but no wrist watch is provided with the Cited Trademark (in addition, in Exhibit A No. 26, "2009 CORE COLLECTION PRICE LIST" in the last page thereof shows the characters "SKIN" and the list of trademark, model number, and price of clocks and watches belonging thereto).
(C) The number and amount of sales in Japan of the wrist watch with the Cited Trademark attached thereon are as follows (Exhibit A No. 29; in addition, CHF 1 is converted into yen at 130 yen).

In fiscal 2006: 40,000 pieces, the amount of sales is about 325,000,000 yen
In fiscal 2007: 40,000 pieces, the amount of sales is about 390,000,000 yen
In fiscal 2008: 35,000 pieces, the amount of sales is about 325,000,000 yen
In fiscal 2009: 25,000 pieces, the amount of sales is about 260,000,000 yen
In fiscal 2010: 18,000 pieces, the amount of sales is about 260,000,000 yen
In fiscal 2011: 16,000 pieces, the amount of sales is about 195,000,000 yen
In fiscal 2012: 16,000 pieces, the amount of sales is about 260,000,000 yen
In fiscal 2013: 15,000 pieces, the amount of sales is about 195,000,000 yen

B. According to the fact acknowledged in section A. above, it is possible to infer that the demandant made the catalogues of the wrist watches in relation to the business thereof from 1999 to 2014, and distributed them. However, the number of issues of the catalogues in question and the geographical coverage of distribution in Japan are not clarified. Furthermore, in the catalogue containing only the wrist watch with the Cited

Trademark attached thereon (Exhibits A No. 17 to A No. 23), the Cited Trademark can be recognized on the cover page thereof along with the trademark consisting of "swatch" which can be regarded as a house mark of the demandant. However, those catalogues do not contain those using the Cited Trademark solely, and furthermore even the newest catalogue among those catalogues was issued in 2004, which is too old. Furthermore, almost no Cited Trademark can be found in a so-called general catalogue (Exhibits A No. 24 to A No. 28), and there can be found only the model numbers. Considering this, it should be said that the fact that the demandant made the catalogues described above and distributed them is not sufficient to establish the prominence of the Cited Trademark. In addition, thereto, no evidence has been submitted which is sufficient to find that the demandant made advertisement and promotion of the wrist watch with the Cited Trademark attached thereon before the date of registration application of the Trademark.

Next, in the sales in Japan of the wrist watch with the Cited Trademark provided thereon, Exhibit A No. 29 indicates the number and amount of annually sales from fiscal 2006 to fiscal 2013; however, no evidence corroborating the figures in question has been submitted. Furthermore, it is not necessarily clear from Exhibit A No. 29 whether or not the number and amount of annually sales from fiscal 2006 to fiscal 2013 is sufficient in the sales quantity for consumers of the wrist watch to recognize the Cited Trademark as an indication of the product in relation to the business of the demandant. In this regard, "The Japanese Watch & Clock Industry in 2013 (estimate)" (Exhibit B No. 4) prepared on March 12, 2014 by Japan Clock & Watch Association reveals that the number of sales of "watches" in our country in 2013 was 42,600,000 pieces including those supplied by domestic manufacturers and import products, and the amount of sales was 640,500,000,000 yen. When this is compared with the amount of sales (15000 pieces) and the amount of sales (about 195,000,000 yen) of wrist watches that are achieved in 2013 by the demandant, it has to be said that the number and amount of sales of the wrist watch with the Cited Trademark attached thereon were considerably low. Furthermore, "カシオ『Ｇショック』が迎えた“第２次ブーム”('G-SHOCK' of CASIO Enjoys Boom Again) posted on "TOYO KEIZAI ONLINE" (Exhibit B No. 5) states regarding the wrist watch with the trademark consisting of the characters of "G ショック" in relation to the business of Casio Computer Co., Ltd. that "the number of sales in Japan has fallen to half compared to its peak ... the breakdown of shipping in the last fiscal 2012 is 1,200,000 pieces in Japan." This also denies that the sales in Japan of the wrist watch with the Cited Trademark attached thereon were large and high, or rather extremely low. Considering this, it cannot be acknowledged that the number and amount of sales of the wrist watch with the Cited Trademark attached thereon are enough to establish the prominence of the Cited Trademark.

According to the matters described above, it cannot be acknowledged that the Cited Trademark has been widely recognized by traders and consumers as an indication of the wrist watch in relation to the business of the demandant on the date of registration application of the Trademark (May 17, 2013), as well as also on the date of the decision for registration of the Trademark (August 20, 2013).

Furthermore, the demandant does not submit evidence to clarify the fact that the Cited Trademark has been widely recognized by traders and consumers as an indication of personal ornaments in relation to the business of the demandant as of the date of registration application of the Trademark and the date of the decision for registration

thereof. Therefore, the fact in question cannot be accepted.

(2) Confusion of source

As discussed in the section 4(1) above, it cannot be acknowledged that the Cited Trademark has been widely recognized by traders and consumers as an indication of the wrist watches and personal ornaments in relation to the business of the demandant as of the date of registration application of the Trademark and the date of the decision for registration thereof.

Furthermore, as discussed in section 3. above, the Trademark is distinguishable from and non-similar to the Cited Trademark in terms any of appearance, pronunciation, and meaning.

Considering this, it should be said that traders and consumers coming into contact with the Trademark cannot imagine and associate the Cited Trademark with the Trademark. Therefore, it has to be said that, if the Trademark is used in "Personal ornaments; clocks and watches" in the designated goods, it may not cause confusion about the source of goods as if it is a product in relation to business of the demandant or a person who has a certain relation with the demandant.

In addition, the demandant alleges that, when the Trademark is used in "personal ornaments" in the designated goods, those products are sold at the same selling place as clocks and watches with the Cited Trademark attached thereon, so that confusion about the source may occur with respect to the clocks and watches with the Cited Trademark attached thereon. However, in actual, even if clocks and watches, and personal ornaments are sold as fashion-related products on the same floor in a department store and the like, a variety of products; i.e., expensive and cheap products, regarding both the goods are distributed in the market, and thus it cannot be necessarily said that they are sold in the same selling place or in selling places close to each other. Moreover, as discussed above, it cannot be acknowledged that the Cited Trademark has been widely recognized by traders and consumers as an indication of the wrist watches in relation to the business of the demandant as of the date of registration application of the Trademark and the date of the decision for registration thereof. Therefore, even if the personal ornaments with the Trademark attached thereon and the clocks and watches with the Cited Trademark attached thereon are sold in the same selling place or in selling places close to each other, it should be said that this may not make traders and consumers thereof cause confusion about the source of goods. In addition, thereto, no evidence can be found which is sufficient to acknowledge that confusion about the source may occur between the personal ornaments with the Trademark attached thereon and the clocks and watches, and personal ornaments with the Cited Trademark attached thereon. Accordingly, the demandant's allegation regarding the matters discussed above lacks the precondition, and thus is unfounded.

(3) Considering this, it cannot be accepted that the Trademark falls under Article 4(1)(xv) of the Trademark Act.

5. Closing

As discussed above, it cannot be recognized that, regarding "clocks and watches; personal ornaments" in the designated goods thereof, the Trademark was registered while violating any of Article 4(1)(xvi), Article 4(1)(xi), and Article 4(1)(xv) of the Trademark Act because of the foregoing reasons, and therefore the registration shall not be invalidated under the provisions of Article 46(1)(i) of the same Act.

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

February 19, 2016

Chief administrative judge: KONDA, Mitsuo
Administrative judge: MAEYAMA, Ruriko
Administrative judge: NAKATSUKA, Toshie