

Decision on Opposition

Opposition No. 2015-900053

Osaka, Japan

Trademark Right Holder MIZUNO CORPORATION

USA

Trademark Opponent WOLVERINE OUTDOORS INC

Tokyo, Japan

Patent Attorney TANAKA, Katsuro

Tokyo, Japan

Patent Attorney INABA, Yoshiyuki

Tokyo, Japan

Attorney MIYAGAWA, Mitsuko

Tokyo, Japan

Patent Attorney KOBAYASHI, Shoji

Tokyo, Japan

Patent Attorney HARUTA, Mariko

Decision on the opposition to the grant of the trademark registration No. 5716285 has resulted in the following decision.

Conclusion

Trademark registration for Trademark Registration No. 5716285 shall be maintained.

Reason

No. 1 The trademark

The trademark with Trademark Registration No. 5716285 (hereinafter referred to as the "Trademark") is configured as indicated in Attachment 1, the application for its

registration was filed on July 9, 2014, the decision for registration of the Trademark was issued on October 21, 2014, and the Trademark was registered on November 7, 2014 with designated goods of Class 25 "Clothing; garters; supporters;suspenders; bands; belts; footwear; masquerade costumes; specialized clothes for exercise;specialized shoes for exercise; wet suits for water sports."

No. 2 Cited trademarks

The person who is in opposition to the registration of the Trademark (hereinafter referred to as "opponent") cited the three trademarks listed below as reasons for opposition to the registration. The term of each of the trademarks has been extended once, and the trademarks are still valid as of now.

1. The trademark with Trademark Registration No. 4435662 (hereinafter referred to as the "Cited Trademark 1") is configured as indicated in Attachment 2, the application for its registration was filed on June 13, 2000, claiming priority under the Paris Convention Article 4 based on the application for registration of the trademark which was filed on February 11, 2000 in the United States of America, and it was registered on November 24, 2000 with designated goods of Class 25 which are as specified in the Trademark Registry.

2. The trademark with Trademark Registration No. 4615786 (hereinafter referred to as the "Cited Trademark 2") is configured as indicated in Attachment 2, the application for its registration was filed on February 5, 2002, and it was registered on October 25, 2002 with designated goods of Classes 18 and 25 which are as specified in the Trademark Registry.

3. The trademark with Trademark Registration No. 4664724 (hereinafter referred to as the "Cited Trademark 3") is configured as indicated in Attachment 3, the application for its registration was filed on April 10, 2001, and it was registered on April 18, 2003 with designated goods of Class 25 which are as specified in the Trademark Registry.

Hereinafter Cited Trademarks 1 to 3 are collectively referred to as "Cited Trademarks".

No 3. Reasons for opposition against the registration

The opponent asserted that the registration of the Trademark should be cancelled according to Article 43-2(1) of the Trademark Act, summarized and mentioned reasons for opposition as follows, and submitted Evidence A No. 1 to A No. 57 (including their branch numbers) as means of evidence.

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

(1) Similarity between the Trademark and the Cited Trademarks

The Trademark and the Cited Trademarks both have an Alphabetic character "M" as a motif, present an "M"-like shape colored in white and slanted to the right, and take the same line in configuration such as conception and composition. The coincidence of motif between those trademarks eliminates their minor differences in the impression caused by them.

Comparing the Trademark with the Cited Trademarks 1 and 2, they only differ in that the base color of the Trademark is white (rather than black) and the Trademark uses a "small lacing-like pattern" rather than a "small chain line with white gaps along the line", which is nothing but a minor difference in terms of "impression, recollection, and association occurring in consumers". The Cited Trademarks 1 and 2 each have a white "M"-like shape in a non-white circle shape, and thus differ in this point from the Trademark having no background color. However, in the Cited Trademarks 1 and 2, the "M"-like shape is emphasized since it is represented by a white shape having a non-white background. In addition, the background circle is an ordinary shape and thus the Cited Trademarks 1 and 2 would not be recognized distinct from the Trademark due to this circle.

Therefore, even if there are some differences between the Trademark and the Cited Trademarks in the "M"-like shapes in terms of boldness of lines and inclination of shapes, it should be said that traders and consumers will have the same impression on them or recognize them as similar trademarks due to their common configurations.

(2) Actual state of transactions

The goods sold by the opponent includes shoes, windbreakers, T-shirts, and socks (Evidence A Nos. 46 to 48), which are in conflict with most of the designated goods of the Trademark and which have the same category of consumers and traders as the Trademark.

In addition, shoes of the opponent each have a tongue portion and a toe side portion at each of which one of the Cited Trademarks is presented as a one point mark (Evidence A No. 51). Such a representation can be said as of a general trend (Evidence A Nos. 52 to 54). In the light of the actual state of transactions in which it is practiced to present a trademark in a small size format as a one point mark, it is likely that consumers and traders overlook the minor differences between the Trademark and the Cited Trademarks, and thus confuse the source of the goods having respective trademarks, or mistakenly recognize that the goods with the Trademark are a new series of the goods of the opponent.

(3) Summary

Considering the Trademark and the Cited Trademarks from an overall viewpoint by taking into account the impression, recollection, and association occurring in traders and consumers all together, each of the trademarks has an Alphabetic character "M" as a motif and takes the same line in configuration in which an "M"-like shape is presented in a white color and slanted to the right; and even if there exist differences between the trademarks in details, those differences are nothing but minor ones, and thus when those trademarks are observed separately in different times and different places, it is likely that those trademarks are indistinguishable from each other in terms of appearance. In particular, shoes and clothing, which are included in the designated goods of the Trademark, are often provided with a trademark represented as a one point mark. Such actual state of transactions should be taken into consideration.

Therefore, the trademark's registration is contrary to Article 4(1)(xi) of the Trademark Act and thus the registration must be cancelled.

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

(1) Regarding well-knownness of the Cited Trademarks

The predecessor of the opponent manufactured order-made hiking boots in the 1970s (Evidence A No. 23), Merrell Boots Company was founded in early 1980s, the goods of the company are spread not only in north America but also in various countries of the world, and, in 1992, sales of the goods started in our country. After that, including years from 1997, the opponent has been using the MERRELL trademark. MERRELL branded goods are currently sold in 160 countries (Evidence A No. 25) and have over 30 years of successful sales records. Seventeen years have already passed since regular sales started in our country (Evidence A No. 24). The goods of the opponent have been widely accepted in the Japanese market and earned high well-knownness, due to the durability and comfortable fitting of the goods since the foundation of the company.

(2) General market recognition

As described above, the goods of the opponent are widely recognized in the market. The opponent is outstandingly well-known in the market of our country, so that miniatures of the goods of the opponent are even sold, which is exceptional for shoes (Evidence A No. 28). A catchphrase of the miniature goods introduces the goods of the opponent as "Shoes of the worldwide leading outdoor brand 'Merrell'". The goods of the opponent have been highly evaluated in general markets and highly well-known (Evidence A No. 29).

(3) Sales record and advertisement activities

As to the sales record of the goods with the Cited Trademarks, 160 to 200 thousands pairs of shoes were sold resulting in approximately 1.1 to 1.3 billion yen in sales every fiscal year from 2012 to 2014. The opponent has contracted a domestic general agency contract with Marubeni Corporation since 1998, and sales operations have been conducted by Marubeni Footwear, an affiliated company of Marubeni Corporation. The goods of the opponent are sold through Internet as well as in directly-managed stores (6 stores; Evidence A No. 35) and shops (652 shops; Evidence A No. 36).

The opponent is conducting advertisement activities such as presenting posters in sales campaigns and trade shows to widely advertise the Cited Trademarks (Evidence A Nos. 37 and 38). Moreover, the opponent is positively conducting advertisement activities through magazines (Evidence A Nos. 39 to 43).

Therefore, as a result of the continuous use of the Cited Trademarks in the sales activities and advertisement activities conducted by the opponent, the Cited Trademarks have been well known to the industry as a matter of course and also to general consumers.

(4) Regarding applicability of Article 4(1)(xv) of the Trademark Act for the Trademark

As described in 1 above, the Trademark and the Cited Trademarks are similar with each other in terms of appearance. The Cited Trademarks have been used for the goods of the opponent for many years, and, as a result, the Cited Trademarks had been well-known at the time of application for the registration of the Trademark. The goods that the opponent is actually selling (shoes such as outdoor shoes and sneakers as well as wind breakers, T-shirts, socks, short pants, and the like) are in conflict with the designated goods of the Trademark and thus have the same category of the consumers as that of the Trademark. Considering the attention normally paid by consumers and the actual state of the transactions in which trademarks are frequently used as one point marks, if the Trademark is used for the designated goods of the Trademark, it is likely that the consumers recall trademarks used by the opponent or associate the Trademark with the trademarks used by the opponent and get confused into thinking as if those goods are goods or a series of goods dealt by the opponent or related companies of the opponent, i.e., confuse the source of the goods.

Therefore, the trademark's registration is contrary to Article 4(1)(xv) of the Trademark Act and thus the registration must be cancelled.

No. 4 Judgment by the body

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

The configuration of the Trademark is as indicated in Attachment 1, and although it can be said that the configuration has been designed using the Alphabetic character "M" as a motif, it is characterized in that the periphery of the character is represented by a lacing pattern. In the first place, as to one Alphabetic character conventionally used in commercial transactions as a sign or symbol for representing the specification or a product number of goods, such Alphabetic character itself cannot serve to distinguish relevant products from others. Taking these into consideration, it is reasonable to consider that, from such representation, the Trademark does not immediately cause recollection of the Alphabetic character "M" but is rather recognized and understood by the impression caused by its appearance, and that that representation does not give rise to specific pronunciation nor cause specific meaning.

On the other hand, the Cited Trademarks 1 and 2 are configured as indicated in Attachment 2. They each consist of an especial, perspective shape configured such that a white-colored shape into which an Alphabetic character "M" is designed as a motif is arranged within a circle shape painted in black. It is reasonable to consider that the Cited Trademarks are understood by impression caused by their whole appearances and that their appearances give rise to no specific pronunciation and cause no specific meaning.

In addition, the Cited Trademark 3 is configured as indicated in Attachment 3. The Cited Trademark 3 consists of an especial, perspective shape into which an Alphabetic character "M" is designed as a motif. It is reasonable to consider that the trademark is understood by impression caused by its appearance and that its appearance gives rise to no specific pronunciation and causes no specific meaning.

Comparing the Trademark with the Cited Trademarks, although they both have a shape in which an Alphabetic character "M" is designed as a motif in appearance, the periphery of the Trademark's shape is formed by a lacing pattern and the left and right mount-shaped portions of the Trademark have different degrees of inclination and different orientations, and thus the Trademark has an unsteady configuration lacking a left-right balance.

In contrast, in the Cited Trademarks, the portion with a motif of "M" has a configuration in which the Alphabetic character "M" is designed using a perspective representation from a left portion to a right portion by representing the circumference of the character with straight lines and by arranging a left and a right vertical lines of the character with the left vertical line being bolder and higher than the right vertical line. Thus, the portion with a motif of "M" has a configuration which causes a steady impression.

Considering this, it is reasonable to consider that the Trademark and the Cited Trademarks cause an impression that they have explicitly different aspects and are remembered as such, because they have different configuration in appearance in their shapes configured with "M" as a motif. Moreover, the Trademark and the Cited Trademarks 1 and 2 have significant structural difference in that whether the shape of M is drawn inside a circle shape, and thus it should be said that, even when they are observed in different times and different places, those trademarks are distinguishable from each other in terms of appearance.

In conclusion, the Trademark and the Cited Trademarks both give rise to no specific pronunciation and cause no specific meaning, they are distinguishable from each other in terms of appearance, and therefore the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

Even when the Trademark and the Cited Trademarks are presented in a small size format as one point marks, as described above, it cannot be said that they are indistinguishable from each other in terms of appearance, and thus the allegation of the opponent regarding this point cannot be accepted.

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

(1) Regarding well-knownness of the Cited Trademarks

The predecessor of the opponent is a manufacturer of order-made hiking boots. Merrell Boots Company was founded in early 1980. The goods of the company are spread over countries of the world, and, in 1992, sales of the goods started in our country. After that, the opponent acquired that company in 1997, and the use of the MERRELL trademark was continued at that time and has been continued since then (Evidence A No. 23). "MERRELL-branded" goods have been sold for more than thirty years, and are currently selling in 160 countries (Evidence A No. 25). The goods have been sold even in our country for seventeen years (Evidence A No. 24). The goods of the opponent are sold through the Internet as well as in directly-managed stores (6 stores) and shops (652 shops) (Evidence A Nos. 35 and 36). The opponent is conducting advertisement activities related to the "MERRELL brand", to advertise the goods via sales campaign posters, magazines, and the like (Evidence A Nos. 37 to 43).

However, in "MERRELL-branded" goods such as shoes which are related to the opponent's operation and in advertising medium for promoting those goods, the Cited Trademarks 1 and 2 are practically used with (located adjacent to) the characters of "MERRELL".

A sample in which the Cited Trademark 1 or 2 is independently used is not found except Evidence A No. 26 (including its branch numbers).

Thus, it is reasonable to say that it cannot be acknowledged that the Cited Trademarks 1 and 2 were solely used for goods of "shoes category", and, as a result, they had been widely recognized and prominent in our country among traders and consumers as ones representing the goods relating to opponent's operation at the time of application for the registration of the Trademark and at the time of the decision for registration of the Trademark.

As described in 1 above, the Trademark and the Cited Trademarks are not similar to each other, and thus it should be said that the Trademark is a different, clearly distinguishable trademark.

Therefore, even when the holder of trademark right of the Trademark uses the Trademark for its designated goods, it cannot be said that traders and consumers coming into contact with the Trademark would recall the Cited Trademarks or associate the Trademark with the Cited trademarks. It is unlikely that the Trademark makes confusion about the source of the goods as if the goods are related to the operation of the opponent or person who has an economic or organizational relation with the opponent.

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

3 Summary

As described above, the registration of the Trademark is not in breach of Article 4(1)(xi) and Article 4(1)(xv) of the Trademark Act, and thus the Trademark shall be maintained under the provisions of Article 43(3)(iv) of the Trademark Act.

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

August 27, 2015

Chief administrative judge: SAKAI, Fukuzo
Administrative judge: HORIUCHI, Jinko
Administrative judge: TANAKA, Kyoko

Attachment 1 The Trademark



Attachment 2 Cited Trademark 1 and Cited Trademark 2



Attachment 3 Cited Trademark 3

