

Decision on opposition

Opposition No. 2015-900269

USA

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Decision on the opposition to the grant of trademark registration No. 5,766,317 has resulted in the following decision..

Conclusion

With regard to the designated goods of the trademark with Registration No. 5,766,317, the registration of "all designated goods" in Class No. 20, "Kitchen equipment (other than "gas water heaters, non-electric cooking heaters, kitchen

worktops, and kitchen sinks); household paper towel dispensers; soap and lotion dispensers; soap holders and boxes; toothbrush holders; waste baskets" in Class No. 21, "all designated goods" in Class No. 24, and "all designated goods" in Class No. 25 shall be cancelled.

Reason

No. 1 The Trademark

The trademark with Registration No. 5,766,317 (hereinafter referred to as "the Trademark") is configured as indicated in Attachment, its registration application was filed on July 29, 2014, the decision for registration was made on May 1, 2015, and the trademark was registered on May 22, 2015 with "Pillows; pillows for ornament; cushions; furniture; mirrors; picture frames; clothing hangers; dividers for drawers" of Class No. 20, "Kitchen equipment (other than "gas water heaters, non-electric cooking heaters, kitchen worktops, and kitchen sinks); household paper towel dispensers; soap and lotion dispensers; soap holders and boxes; ceramic tissue box cases; toothbrush holders; waste baskets" of Class No. 21, "Bedsheets; futon quilts; futon and quilts cases (linen); futon ticks (unstuffed futon); pillowcases (pillow slips); blankets; personal articles of woven textile (not for wear); table linen (not of paper); shower curtains; dish cloths; table cloth" of Class No. 24, and "Clothing; belts for clothing" of Class No. 25 as its designated goods.

No. 2 Cited Trademark

Five trademarks cited by the opponent of objection to registration (hereinafter referred to as "the opponent") are listed below (hereinafter collectively referred to as "the Cited Trademark"), and they are still valid as of now. In addition, goods and services explicitly indicated below are the designated goods and services of the Cited Trademarks similar to the designated goods of the Trademark.

(1) The trademark with Trademark Registration No. 4,711,266 consists of "ARTISAN" written in Alphabetic characters, its registration application was filed on September 18, 2002, the trademark was registered on September 19, 2003 with designated goods of Classes No. 9, 14, 20, 21, 25, 26, 28, 34, and 35 which are as specified in the Trademark Registry, including "Tableware of precious metal; nutcrackers, pepper pots, sugar bowls, salt shakers, egg cups, napkin holders, napkin rings, trays, and toothpick holders of precious metal" of Class No. 14, "Cushions (furniture); Japanese floor cushions (Zabuton); pillows; mattresses; drinking straws; trays (not of metal); towel dispensers (not of metal); picture frames" of Class No. 20, "Cooking pots and pans (non-electric);

coffee-pots (non-electric or not of precious metal); Japanese cast iron kettles, non-electric (Tetsubin); kettles (non-electric); tableware (not of precious metal); portable coldboxes (non-electric); rice chests; food preserving jars of glass; drinking flasks (for travelers); vacuum bottles (insulated flasks); ice pails; whisks (non-electric); cooking strainers; pepper pots, sugar bowls, and salt shakers (not of precious metal); egg cups (not of precious metal); napkin holders and napkin rings (not of precious metal); trays (not of precious metal); toothpick holders (not of precious metal); colanders; shakers; Japanese style cooked rice scoops (shamoji); hand-operated coffee grinders and pepper mills; cooking funnels; Japanese style wooden pestles (surikogi); Japanese style earthenware mortars (suribachi); Japanese style personal dining trays or stands (zen); bottle openers; cooking graters; tart scoops; pan-mats; chopsticks; chopstick cases; ladles and dippers; cooking sieves and sifters; chopping boards for kitchen use; rolling pins (for cooking purposes); grills (cooking utensils); toothpicks; lemon squeezers (citrus juicers); waffle irons (non-electric); cleaning tools and washing utensils; stirrers for hot bathtub water (Yukakibo); bathroom stools; bathroom pails; boxes of metal for dispensing paper towels; boot jacks; soap dispensers" of Class No. 21, "Clothing; garters; sock suspenders; suspenders (braces); waistbands; belts for clothing" of Class No. 25, and "Armbands" of Class No. 26, the renewal of the term of a trademark right except for Class No. 35 was then registered on September 10, 2013, the trial decision to cancel the trademark registration in connection with "Fishing tackle" of Class No. 28 among the designated goods was given by a trial decision for revocation of the trademark with Registration, and the decision became final and registration was made on July 2, 2015.

(2) The trademark with Trademark Registration No. 4,987,909 consists of "ARTISAN" written in Alphabetic characters, its registration application was filed on March 13, 2006, and the trademark was registered on September 15, 2006 with designated goods of Class No. 24 as specified in the Trademark Registry, including "Personal articles of woven textile (not for wear); shower curtains" of Class No. 24.

(3) The trademark with Trademark Registration No. 5,270,647 consists of "ARTISAN" written in Alphabetic characters, its registration application was filed on October 29, 2008, and the trademark was registered on October 2, 2009 with designated goods and services of Classes No. 14, 26, and 35 as specified in the Trademark Registry, including "Jewel cases" of Class No. 14, "Armbands" of Class No. 26, and "Retail services or wholesale services for furniture; retail services or wholesale services for bladed or pointed hand tools, hand tools, hardware" of Class No. 35, and then in accordance with partial abandonment of the trademark rights received on September 20, 2011, the

trademark right registration has been partially canceled with regards to "Retail services or wholesale services for edible oils" of Class No. 35 among the designated goods and services.

(4) The trademark with Trademark Registration No. 5,031,591 consists of "ARTISAN" written in Alphabetic characters, its registration application was filed on March 13, 2006, and the trademark was registered on March 9, 2007 with designated goods of Class No. 24 as specified in the Trademark Registry, including "Mosquito nets; bedsheets; futon and quilts; futon and quilts cases (linen); futon ticks (unstuffed futon); pillowcases (pillow slips); blankets; table napkins of textile; dish cloths; seat covers of textile; wall hangings of textile; curtains; table cloths (not of paper); draperies (thick drop curtains)" of Class No. 24.

(5) The trademark with Trademark Registration No. 5,136,934 consists of "ARTISAN" written in Alphabetic characters, its registration application was filed on April 1, 2007, and the trademark was registered on June 6, 2008 with designated services of Class No. 35 as specified in the Trademark Registry, including "Retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for personal articles of woven textile (not for wear), hand-held flat fans, hand-held folding fans, garters, sock suspenders, suspenders (braces), waistbands, belts for clothing, armbands, personal ornaments (other than "cuff links"), insignias for wear (not of precious metal), badges for wear (not of precious metal), buckles for clothing, brooches for clothing, special sash clips for obi (Obi-dome), bonnet pins (not of precious metal), ornamental stickers for front jackets, brassards, hair ornaments, false nails, false eyelashes, shaving cases, pedicure sets, eyelash curlers, manicure sets, ear picks, vanity cases (not fitted), cosmetic and toilet utensils (other than "electric toothbrushes"), false beards, false moustaches, hair curlers (non-electric), umbrellas and their parts, ferrules of metal for canes and walking-sticks, walking sticks, canes, metal parts of canes and walking-sticks, and handles of canes and walking-sticks" of Class No. 35.

No. 3 Grounds of the opposition to registration

The opponent requested a opposition decision whose content is the same as the conclusion, summarized and mentioned the grounds of the opposition to registration as follows, and submitted Evidences A No. 1 to A No. 57 as means of evidence.

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

(1) Regarding the Trademark

A. Regarding distinctiveness of the characters "NY"

The Trademark consists of Alphabetic characters "ARTISAN" in horizontal writing, a simple figure on the right side thereof consisting of a combination of a plurality of oblique lines, and furthermore Alphabetic characters "NY" in horizontal writing on the right side of the figure.

The characters "NY" in the Trademark may be recognized as a symbol or a sign such as an item number of a product, and thus are obviously not capable of distinguishing relevant products from others.

Furthermore, according to a Japanese-language dictionary, two Alphabetic characters "NY" may be used as an abbreviation or mark expressing New York in the United States (Evidence A No. 8).

Even if traders or consumers coming into contact with the Trademark recall New York in United States associatively with the characters "NY", New York, which is the name of a place which is widely known in Japan similar to Tokyo and Osaka, is recognized as the place of production and place where goods are designed. Therefore, there is no difference in conclusion in which distinctiveness cannot be recognized.

B. Regarding separately observation of the characters "ARTISAN"

The term "ARTISAN" in the Trademark has the meaning such as "a craftsman, a workman, a technician" (Evidence A No. 10). The characters "ARTISAN" and "NY" in the Trademark are visually differentiated clearly by the figure illustrated therebetween. Then, no special circumstances can be found to conclude that the pronunciation of the characters "ARTISAN" and "NY" has to be made always integrally with each other. Considering this, in the Trademark, the characters "ARTISAN" are observed separately from the characters "NY".

Furthermore, since it is deemed that the figure in the Trademark causes no specifically definite meaning, no reasons can be found to conclude that the figure in question and the characters "ARTISAN" are definitely observed integrally with each other.

Accordingly, in the Trademark, only the characters "ARTISAN" can be separately observed.

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

A. Examination on the similarity in appearance

As indicated in the Attachment, the Trademark consists of a combination of Alphabet characters in the general Gothic font and a figure, and as discussed in (1) above, it is deemed that only the characters "ARTISAN" may be separately observed.

On the other hand, the Cited Trademark is a trademark consisting of Alphabet characters "ARTISAN" written in Gothic font. Therefore, definite similarity is

recognized in terms of appearance.

B. Examination on similarity of pronunciation

In the Trademark, the characters "ARTISAN" separately observed give rise to the pronunciation of "aruchizan" or "ahthizan".

Meanwhile, the Cited Trademark consisting of the characters "ARTISAN" naturally gives rise to the pronunciation of "aruchizan" or "ahthizan".

Accordingly, the Trademark and the Cited Trademark are in common with each other in terms of the pronunciation of "aruchizan" (ahthizan), and thus they are trademarks similar to each other in terms of pronunciation.

C. Examination of similarity in meaning

In the Trademark, the characters "ARTISAN" evoke the meaning of "craftsman", and the Cited Trademark also naturally evokes the meaning of "craftsman" according to the constituent characters.

Accordingly, the Trademark and the Cited Trademark are in common with each other in terms of the meaning of "craftsman", and thus they are the trademarks similar to each other also in terms of meaning.

D. Similarity of trademarks

For the reasons discussed above, definite similarity between the Trademark and the Cited Trademark is recognized in terms of appearance, and they are trademarks similar to each other in terms of the pronunciation of "aruchizan" (ahthizan) and the meaning of "craftsman".

E. Summary

As discussed above, the Trademark and the Cited Trademark are trademarks similar to each other, and therefore the Trademark falls under Article 4(1)(xi) of the Trademark Act.

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

The opponent is a major apparel company who deals mainly in apparel products such as clothing, bags, shoes, etc., as well as widely in foods and beverages, and livingware and sundry goods.

The opponent has already filed a number of national and foreign applications for trademark registration of "ARTISAN" and a number of registrations therefor have been granted (Evidence A No. 33 to No. 35).

The opponent opened the first retail store using the Cited Trademark "ARTISAN" as its store name in Odakyu Department Store (1st floor of the main building of the Shinjuku store) on March 1, 2003, and has 75 stores in total throughout Japan (Evidence A No. 36 to No. 49).

Furthermore, the trademarks of "ARTISAN" series have been used in direct mail advertisements, poster advertisements, catalogues, newspaper advertisements, and magazine advertisements. The Cited Trademark has been continuously used for more than 12 years from December 2002 up to the present (September 2015) together with the sub-brand name of "ARTISAN COMMECA", etc.

The opponent achieved sales of about 3.1 billion yen in fiscal 2014 under the "ARTISAN" brand, which was about 2 billion yen in fiscal 2005.

As discussed above, the Cited Trademark is widely known in general as the trademark of the opponent.

Accordingly, if the Trademark is used in the designated goods thereof, there is obviously likelihood to cause a risk of confusion about the source as if it is a product of "ARTISAN" brand of the opponent.

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

3 Conclusion

For the reasons discussed above, the Trademark falls under the provisions of Article 4(1)(xi) and (xv) of the Trademark Act.

No. 4 Reasons for revocation of the Trademark

1. The appeal Examiner-in-chief notified the owner of the Trademark right as of December 25, 2015 that the Trademark shall be cancelled for the reasons indicated. The gist of reasons for opposition is as follows.

2 Regarding applicability to Article 4(1)(xi) of the Trademark Act

(1) The Trademark

The Trademark is configured as indicated in Attachment, and it cannot be said that, in terms of appearance, the linkage between the figure and the characters "ARTISAN" and "NY", and the linkage between both the characters are inseparable to the extent that it is deemed to be unnatural in trading to separately observe them.

Then, there are some actual situations in general in which a mark consisting of two Alphabetical characters is typologically used as a symbol or a sign (hereinafter referred to as "symbols") indicating an item number or grade of a product, and furthermore, the term of "NY" is known as an abbreviation meaning "New York State in the United States" (Evidence A No. 8). Considering this, traders or consumers coming into contact with Alphabetic characters "NY" in the configuration thereof merely grasp the term as a type of symbols, or recognize the term as a word indicating the place of production and place of sale of goods. It thus can be said that the Alphabetic characters "NY" do not perform, or hardly perform, a function for distinguishing relevant products

from others.

Considering this, it can be said that the Alphabetic character "NY" in the configuration of the Trademark do not perform, or hardly perform, a function for identifying the source of goods. Therefore, it should be said that the Alphabetic characters "ARTISAN" in the configuration of the Trademark give traders and customers a strong and dominant impression as a mark identifying the source of goods.

Accordingly, it is permitted to extract the Alphabetic character "ARTISAN" in the Trademark so as to be compared with a trademark of another person.

Accordingly, in the Trademark, the Alphabetic characters "ARTISAN" in the configuration thereof may be independently focused on, and the Alphabetic characters give rise to the pronunciation of "aruchizan" and evoke the meaning of "a craftsman, a workman, a technician" (Evidence A No. 11).

(2) Cited Trademark

The Cited Trademark consists of the Alphabetic characters "ARITISAN", respectively, and thus gives rise to the pronunciation of "aruchizan" according to the constituent characters, and causes the meaning of "a craftsman, a workman, a technician" (Evidence A No. 11).

(3) Similarity between the Trademark and the Cited Trademark

The similarity between the Trademark and the Cited Trademark will be considered. In terms of appearance, the Trademark has in the configuration thereof the Alphabetic characters "ARITISAN" which independently perform a function for distinguishing relevant services from others, and the Cited Trademark consists of the Alphabetic characters "ARITISAN". Therefore, the two trademarks have a confusing appearance in regard to the Alphabetic characters "ARITISAN".

Next, in regard to the pronunciation and meaning, they are trademarks similar to each other in terms of the common pronunciation of "aruchizan" and the common meaning of "a craftsman, a workman, a technician".

Considering this, it can be recognized that the Trademark and the Cited Trademark are similar to each other in terms of appearance, pronunciation, and meaning.

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

Among the designated goods of the Trademark, "Pillows; pillows for ornament; cushions; furniture; mirrors; picture frames; clothing hangers; dividers for drawers" of Class No. 20, "Kitchen equipment (other than "gas water heaters, non-electric cooking heaters, kitchen worktops and kitchen sinks); household paper towel dispensers; soap and lotion dispensers; soap holders and boxes; toothbrush holders; waste baskets" of

Class No. 21, "Bedsheets; futon and quilts; futon and quilts cases (linen); futon ticks (unstuffed futon); pillowcases (pillow slips); blankets; personal articles of woven textile (not for wear); table linen (not of paper); shower curtains; dish cloths; table cloth" of Class No. 24, and "Clothing; belts for clothing" of Class No. 25 are identical or similar to the designated goods and services of the Cited Trademark including the goods and services which are explicitly and specifically listed in section 2 above.

3 Summary

Accordingly, the Trademark falls under Article 4(1)(xi) of the Trademark Act in regard to the designated goods described above, and therefore it has to be said that the registration therefor is in breach thereof.

No. 5 Opinion of the holder of the trademark right

For the reasons for revocation of the Trademark discussed in section No. 4 above, the appeal Examiner-in-chief gave the owner of the trademark right an opportunity for filing a written opinion within a designated period; however, the owner of the trademark right has submitted no opinion in response at all.

No. 6 Judgment by the body

It is recognized that the reasons for revocation of the Trademark discussed in section No. 4 above in regard to the Trademark are reasonable.

Accordingly, the Trademark was registered while violating Article 4(1)(xi) of the Trademark Act in connection with the "designated goods cited in the conclusion" excluding other designated goods, and therefore the registration should be invalidated under the provisions of Article 46-3(2) of the same Act without examining other reasons of the opposition to registration.

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

May 30, 2016

Chief administrative judge: TANAKA, Koichi
Administrative judge: HAYAKAWA, Fumihiro
Administrative judge: TAMURA, Masaaki

Attachment of the Trademark

ARTISAN  NY