

Appeal decision

Appeal No. 2016-1536

Tokyo, Japan

Appellant

JAPAN INSTITUTE OF MIDWIFERY EVALUATION

Tokyo, Japan

Attorney

NARUKAWA, Hiroki

The decision on the case of appeal against the examiner's decision of refusal of Trademark Application No. 2014-108031 dated January 11, 2017 came with a court decision of revocation of the trial decision (2017 (Gyo-Ke) 10049, rendition of decision on September 14, 2017) at the Intellectual Property High Court, the case was proceeded further, and another trial decision was handed down as follows:

Conclusion

The examiner's decision is revoked.

The trademark in the application shall be registered.

Reason

1 The trademark in the Application

The trademark in the Application consists of characters of "Advanced Midwife アドバンス助産師 (adobansu zynosanshi; advanced midwife)" which are horizontally written, and the application for its registration was filed on December 9, 2014 by setting the services of Class No. 35, No. 41, No. 44, and No. 45 as stated in the application as the designated services. Thereafter, the designated services were amended by the written amendment dated on July 8, 2015 in the original examination to Class No. 35 "Marketing research or analysis; midwife referral; providing employment information for midwife.", Class No. 41 "Arranging, conducting and organization of seminars; providing electronic publications; services of reference libraries for literature and documentary records; book rental; publication of books; production of videotape film in the fields of education, culture, entertainment or sports (not for movies or television programs and not for advertising or publicity); organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; providing facilities for movies, shows, plays, music or educational training.", and Class No. 44 "Midwife services; medical practice; providing medical information; physical examination; preparation and dispensing of medications; dietary and nutritional guidance; nursing care; nursing, medical and other medical practice".

2 Gist of reasons for refusal stated in the examiner's decision

In the Examiner's decision, it was acknowledged and determined that "the trademark in the Application consists of characters of "Advanced" which mean "high grade", the characters of "アドバンス" acknowledged as "advanced" and the characters of "助産師" and "Midwife" corresponding to "助産師" which are written in series as

"Advanced Midwife アドバンス助産師". Meanings such as "high grade midwife" is acknowledged from the entire trademark in the Application. The characters of "助産師" in the configuration indicate "a person who assists birthing or provides health guidance for pregnant women, puerperants, and newborns and who passed the national examination and licensed by Minister of Health, Labour and Welfare". In Article 3(3) of the Medical Service Law, it is described that "A facility which is not a birthing center shall not bear a name that includes the term "birthing center" or any other name that may cause it to be mistaken for a place where midwives perform services". Then, since the trademark in the Application may be mistaken as a kind of midwives or a person who has similar national license by consumers and traders, it is acknowledged that registration and use of the trademark in the Application as a trademark may disturb trade order and violate public benefit. Therefore, the trademark in the Application falls under Article 4(1)(vii) of the Trademark Act", and the present application was refused.

3 Judgment by the body

(1) Regarding the trademark in the Application

The trademark in the Application consists of the characters of "Advanced Midwife アドバンス助産師" which are horizontally written. The Alphabetic characters of "Advanced" in the configuration form an English word having the meaning of "high grade", and the Alphabetic characters of "Midwife" form an English word having the meaning of "midwife" (Basic Genius English-Japanese dictionary, TAISHUKAN Publishing Co., Ltd.). Therefore, it is understood that the Alphabetic character part of "Advanced Midwife" in the first half of the configuration has the meanings of "high grade midwife".

Furthermore, katakana of "アドバンス" in the configuration is a relatively easy loan word which is familiar in Japan as a word having the meaning of "high grade". Therefore, it is understood that the characters of "アドバンス助産師" in the latter half of the configuration of the trademark in the Application have the meanings of "high grade midwife".

Then, the trademark in the Application consists of English words and Japanese words having the meaning of "high grade midwife" which are horizontally written in series, and the entire trademark in the Application is understood to have the meaning of "high grade midwife".

(2) Regarding applicant

The applicant was established on November 25, 2014 for the purpose such that "by providing a business regarding third-party evaluation and certification of birthing practice and education for general citizens centering on mothers and babies, quality of birthing education and birthing practice is improved, and convenience of selection of users is enhanced. Furthermore, information on the outcome is disclosed for birthing education institutions, birthing centers, midwives, and general citizens to further improve the quality of birthing services in the society and to contribute to improve health and welfare for mothers and babies". The applicant provides businesses such as "third-party evaluation business regarding birthing education and birthing practice, evaluation criteria creating and maintaining business regarding birthing education and birthing practice, birthing education evaluator developing and training business, and

public awareness business regarding birthing education and birthing evaluation" (Evidence A No. 2).

The predecessor of the applicant is "Specified nonprofit corporation Japan Institute of Midwifery Evaluation", and the corporation is licensed by Minister of Education, Culture, Sports, Science and Technology as a certification and evaluation organization which evaluates the field of birthing in the professional graduate school on April 8, 2008 under the provisions of Article 110 of the School Education Law. The applicant continuously provides the birthing professional graduate school certification and evaluation business (Evidence A No. 4 and A No. 5).

(3) Regarding "advanced midwife certification system"

Five birthing related organizations (Japanese Nursing Association, Japanese Midwives Association, Japan Academy of Midwifery, Japan Society Midwifery Education, and the applicant) established the system for certifying a midwife who reaches level III of "Competencies for Midwifery Practice (Clinical Ladder)" developed by Japanese Nursing Association as "advanced midwife" for the purpose such that midwives continuously perform self-development and improve professional ability so as to provide safe and secure birthing care relative to pregnant women, puerperants, and newborns and that the system allows the society and organizations to objectively check the birthing ability. The certification is made by the applicant, and the application for certification of level III was received by the applicant since August 1, 2015 (through web site) (Evidence A No. 1).

Level III certification of "Competencies for Midwifery Practice (Clinical Ladder)" is a system for certifying a midwife who "can practice birthing care for pregnant women, puerperants, and newborns with responsibility through the period of hospitalization", "can autonomously provide care in consideration of individuality in the midwife outpatient department", "can play a leading role in the midwife outpatient department", "can autonomously provide care in birthing in the hospital", and "can find transition to high risk at an early stage and cope with the case" as the "advanced midwife" (Evidence A No. 1).

The applicant released the result of the certification system on December 25, 2015 for the first time and certificated 5562 "advanced midwives" (Evidence A No. 13 and A No. 14).

Furthermore, Ministry of Health, Labour and Welfare introduced the certification system of the "advanced midwife" in "Second meeting of committee regarding perinatal care" on October 15, 2015 (Evidence A No. 15).

In addition, the "advanced midwife certification system" has been covered in various newspapers and web sites handling medical information (Evidence A No. 6 to A No. 14).

(4) Regarding "advanced midwife"

According to "News Release" (http://www.nurse.or.jp/up_pdf/20161226093959_f.pdf) dated on December 26, 2016 in the web side of Japanese Nursing Association, the applicant has certificated 11002 midwives, including 5562 midwives in 2015 and 5440 midwives in 2016, as the "advanced midwives". This means that proportion of "advanced midwives" to all the engaged midwives is 32.4%, and one out of about three midwives receive the certification of the "advanced midwives" in the current situation.

There are a large number of examples of hospitals which write that the midwives

having the certification of the "advanced midwife" are employed in the web site of the hospital and publicizes that sufficient birthing care can be provided (Evidence A No. 17 to A No. 27).

(5) Applicability of Article 4(1)(vii) of the Trademark Act

According to (2) to (4) described above, the "advanced midwife certification system" is a system for certifying the "advanced midwife" by the applicant who has been licensed by Minister of Education, Culture, Sports, Science and Technology as a certification and evaluation organization for evaluating the birthing field of the professional graduate school and provides "third-party evaluation business regarding birthing education and birthing practice".

Since the certification system uses an index based on expert knowledge developed by Japanese Nursing Association, it can be said that the ability of the midwife can be appropriately evaluated by the certification system. Furthermore, it can be said that the certification system has been known in medical related fields and by general consumers as a system for appropriately certifying a midwife having a high level of birthing practice ability.

Then, it is reasonable to say that the "advanced midwife" is substantially known in Japan as the midwife who has a high level of birthing practice ability of the midwives who have the national license.

Therefore, when the applicant which is the organization for certifying the "advanced midwife" uses the trademark in the Application consisting of the characters of "Advanced Midwife アドバンス助産師" for the designated services, traders and consumers coming into contact with the trademark recognize that the services are provided by a "high grade midwife" or a "person who has a high level of birthing ability of the midwives having the national license". However, in any case, it is reasonable to say that the service is recognized as a service provided by the "midwife having the national license". Therefore, the trademark in the Application does not violate systems such as the national license and the object of laws related to the midwives and does not disturb trade order and violate public benefit. Therefore, it cannot be said that the trademark in the Application is a "trademark is likely to cause damage to public policy".

Accordingly, the trademark in the Application does not fall under Article 4(1)(vii) of the Trademark Act.

(6) Summary

As described above, since the trademark in the Application does not fall under Article 4(1)(vii) of the Trademark Act, the examiner's decision made to refuse the application because of the Article 4(1)(vii) of the Trademark Act shall be definitely cancelled.

No reason for refusal about the application is found.

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

February 14, 2018

Chief administrative judge: IDE, Eiichiro
Administrative judge: ENOMOTO, Masami
Administrative judge: MANABE, Emi