

## Trial decision

Revocation No. 2016-300038

USA

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The case of trial regarding the revocation of the Trademark Registration No. 5532429 between the parties above has resulted in the following trial decision.

### Conclusion

The demand for trial 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. 5532429 (hereinafter referred to as the "Trademark") consists of "SIMS" written in Alphabetic characters, its registration application was filed on May 24, 2012, the trademark was registered on November 2, 2012 with "bags; pouches; handbag frames; purse frames; umbrellas; walking sticks; canes; metal parts of canes and walking sticks; handles for canes and walking sticks" of Class 18 as its designated goods, and they are still valid as of now.

The date of the registration of the demand for trial was February 4, 2016.

#### No. 2 The demandant's allegation

The demandant demands the decision, "The registration of the Trademark shall be cancelled, and the costs in connection with the trial shall be borne by the demandee," alleges that since there had been no fact that none of the owner of trademark right,

exclusive right to use, or non-exclusive right to use has used the Trademark in Japan in connection with the designated goods concerned for three consecutive years or longer, the trademark's registration must be invalidated in accordance with Article 50(1) of the Trademark Act, and submits Evidence A No. 1 as means of evidence.

The demandant does not mention any rebuttal against the demandee's reply.

### No. 3 The demandee's allegation

The demandee replies with a demand for a trial decision whose content is the same as the conclusion, summarizes and mentions the reasons as follows, and submits Evidence B No. 1 to B No. 11 as means of evidence.

#### 1 Evidence indicating use of the Trademark

(1) Evidence B No. 1 indicates technical specifications of a "passport protector" prepared by the holder of trademark right and the person in charge of Nishitani Co., Ltd. whose location is Kaishu, Nishikawa-machi, Nishimurayama-gun, Yamagata, Japan (hereinafter referred to as "Nishitani Co., Ltd.," ) which is the trader of the holder of trademark right, at the beginning of September, 2015, and in the technical specifications, the attachment position of the label in which the Trademark appears is indicated.

Evidence B No. 2 is a picture showing a finished product of a "passport protector" manufactured in China based on the technical specifications of Evidence B No. 1, in which the label in which the Trademark is indicated is attached at a designated position of the "passport protector."

Evidence B No. 2 was prepared by the person in charge of the holder of trademark right after the date on which the copy of written demand for trial was transmitted from the Japan Patent Office.

(2) Evidence B No. 3 is a delivery slip for the holder of trademark right issued by Nishitani Co., Ltd. on December 11, 2015, and in the delivery slip, it is proved that 169 items of "PASSPORT CASE SIMS," which is a trade name, were delivered to the holder of trademark right.

Evidence B No. 4 is a billing statement on the same day as the delivery slip regarding Evidence B No. 3.

(3) Evidence B No. 5 is a delivery slip to JUICE Ltd. whose location is Ogawa-machi, Kanda, Chiyoda-ku, Tokyo, Japan (hereinafter referred to as "JUICE Ltd."), which is the trader of the holder of trademark right, on December 16, 2015, by which it is proven that 10 items of "SIMS PASSPORT CASE" were assigned or delivered by the holder of trademark right to JUICE Ltd.

Evidence B No. 6 is a billing statement on the same day as the delivery slip

regarding Evidence B No. 5.

(4) Evidence B No. 7 is a delivery slip for Sunoman Ltd. whose location is Honcho, Funabashi-shi, Chiba, Japan (hereinafter referred to as "Sunoman Ltd."), which is the trader of the holder of trademark right, on January 5, 2016, by it is proven that 8 items of "SIMS PASSPORT CASE" were assigned or delivered by the holder of trademark right to Sunoman Ltd.

Evidence B No. 8 is a billing statement on the same day as the delivery slip regarding Evidence B No. 7.

(5) Evidence B No. 9 is a statement from the President of Nishitani Co., Ltd., from which it is clear that the passport protectors in which the Trademark is indicated were delivered to the holder of trademark right on December 13, 2015 at the latest.

Further, it is proven that the Trademark was used in the passport protector, and the passport protector is indicated in Evidence B No. 2.

(6) Evidence B No. 10 is a statement from the President of JUICE Ltd., which is the trader of the holder of trademark right, from which it is clear that the passport protectors in which the Trademark is indicated were assigned or delivered to the trader on December 18, 2015 at the latest.

Further, it is proven that the Trademark was used in the passport protector, and the passport protector is indicated in Evidence B No. 2.

(7) Evidence B No. 11 is a statement from the President of Sunoman Ltd., which is the trader of the holder of trademark right, from which it is clear that the passport protector in which the Trademark is indicated was assigned or delivered to Sunoman Ltd., which is the trader, on January 7, 2016 at the latest.

Further, it is proven that the Trademark was used in the passport protector.

## 2 Conclusion

As described above, passport protectors in which the Trademark is used were assigned or delivered to the trader from the holder of trademark right on December 18, 2015.

It is clear that the use is the action to assign or deliver goods to which a mark is affixed, in accordance with Article 2(3)(ii).

Thus, since the Trademark had been used in Japan within 3 years prior to Announcement of registration of the demand for trial in connection with the designated goods, there is no reason for invalidating the trademark's registration in accordance with Article 50(1) of the Trademark Act.

No. 4 Judgment by the body

1 Demande's allegation and evidences show followings.

(1) Evidence B No. 7 is a delivery slip to Sunoman Ltd. from the holder of trademark right on January 5, 2016, in which "SIMS PASSPORT CASE" indicating the trade name and "8" indicating the number of goods are described.

Evidence B No. 8 is a billing statement on the same day and same contents as the delivery slip regarding Evidence B No. 7.

(2) Evidence B No. 9 is a statement on March 18, 2016 for the holder of trademark right from the President of Nishitani Co., Ltd. in which it is described that, regarding "PASSPORT CASE SIMS" delivered on December 11, 2015, "1 the technical specifications of passport protectors (PASSPORT CASE SIMS) were prepared by Nishitani Co., Ltd. and the person in charge of the holder of trademark at the beginning of September, 2015 is as described in Appendix 1 attached," "2 Nishitani Co., Ltd. manufactured passport protectors (PASSPORT CASE SIMS) in China based on the technical specifications by request from the holder of trademark right, and Nishitani Co., Ltd. imported the passport protectors into Japan on around October 25, 2015," "3 Nishitani Co., Ltd. delivered passport protectors (PASSPORT CASE SIMS) accompanied by the delivery slip and bill statement as of December 11, 2015, which are indicated in Appendices 2 and 3 attached, for the holder of trademark right asking for Sagawa Global Logistics Co., Ltd.," and "4 the passport protector is indicated as a picture indicated in Appendix 4 attached."

In Appendix 1 attached to Evidence B No. 9, since "GUEST TRIANGLE" is described and the size of the passport protector and the attachment position of the label in which "SIMS" is indicated are indicated, Appendix 1 indicates the technical specifications of the passport protector.

Appendix 2 attached to Evidence B No. 9 is the delivery slip as of December 11, 2015 from Nishitani Co., Ltd. to the holder of trademark right, in which "PASSPORT CASE SIMS" indicating the trade name and "169" indicating the number of goods are described, and Appendix 3 attached to Evidence B No. 9 is a billing statement on the same day and same contents as the delivery slip regarding Appendix 2. Further, Appendix 4 attached to Evidence B No. 9 shows three pictures of the passport protector in which "SIMS" is indicated.

2 As described in 1 above, it is acknowledged as follows.

The holder of trademark right requested manufacture of passport protectors in which "SIMS" is indicated, to Nishitani Co., Ltd. (Appendix 1 of Evidence B No. 9), and received 169 items of passport protectors delivered on December 11, 2015 (Appendices 2 to 4 of Evidence B No. 9).

Further, the holder of trademark right assigned 8 items of "passport protectors" which are included in the designated goods pertaining to the demand for the revocation, in which "SIMS" deemed identical from common sense perspective with the Trademark is indicated, to Sunoman Ltd. on January 5, 2016 within 3 years prior to the registration of the demand for the trial (Evidence B No. 7).

It is acknowledged that this action by the holder of trademark right, regarding "passport protectors" included in the designated goods pertaining to the demand for the trial, is the action to assign or deliver goods to which a mark is affixed, in accordance with Article 2(3)(ii).

### 3 Summary

As described above, it is acknowledged that the holder of trademark right had used a trademark deemed identical from common sense perspective with the Trademark in Japan within 3 years prior to the registration of the demand for the trial in connection with "passport protector" in the designated goods pertaining to the demand for the trial.

Therefore, the registration of the Trademark cannot be cancelled under the provision of Article 50 of the Trademarks Act.

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

September 28, 2016

Chief administrative judge: DOI, Keiko  
Administrative judge: TANAKA, Kyoko  
Administrative judge: HARADA, Nobuhiko