

Trial decision

Revocation No. 2016-300586

Ishikawa, Japan

Demandant EIZO CORPORATION

Osaka, Japan

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Demandee METAWATER CO. LTD.

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The case of trial regarding the revocation of the Trademark Registration No. 5608877 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. 5608877 (referred to as "The Trademark" below) is configured as indicated in the Attachment. The application for its registration was filed on April 17, 2013, and the trademark was registered on August 16, 2013 with designated goods and services of Classes No. 9 and No. 42, which are as specified in the Trademark Registry, including "Water quality meter; other measuring or testing machines and instruments; telecommunication machines and apparatus; computer programs; and other electronic machines, apparatus and their parts." in Class No. 9 and "Rental of computers; rental of storage regions of computer servers; providing computer programs." in Class No. 42. It is still valid as of now.

The announcement of registration of the request for trial of the case was on September 5, 2016.

No. 2 The demandant's allegation

The demandant demands the decision, "the registration of "Water quality meter; other measuring or testing machines and instruments; telecommunication machines and apparatus; computer programs; and other electronic machines, apparatus and their parts." in Class No. 9 and "Rental of computers; rental of storage regions of computer servers; providing computer programs." in Class No. 42 in the designated goods and services of The Trademark (referred to as " requested goods and services for revocation" below) is invalidated. The costs in connection with the trial shall be borne by the demandee". The demandant mentioned the reasons as follows and submitted Evidence A No. 1 as means of proof.

There had been no fact that any 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 requested goods and services for revocation in the designated goods and services of The Trademark for three consecutive years or longer. Therefore, The Trademark must be invalidated in accordance with Article 50(1) of the Trademark Act.

The demandant has not mentioned any rebuttal against the demandee's reply.

No. 3 The demandee's reply

The demandee replied that the demandee requests the case's trial decision to be the same as the conclusion, summarized and mentioned the reasons as follows, and submitted Evidences B No. 1 to B No. 9 (including their branch numbers) as means of proof.

In a case where the evidence indicates the evidences with all the branch numbers, the branch numbers are omitted below.

1. The holder of the trademark right has continuously used The Trademark in Japan before the registration date of the demand for trial of the case in connection with "Electronic machines, apparatus" which is the designated goods of The Trademark.
(1) Evidence B No. 1 is a sales leaflet of a product for which The Trademark is used (referred to as "the apparatus of the case" below).

The Trademark is largely indicated in Evidence B No. 1, and The Trademark is indicated in the photograph of the apparatus of the case.

The apparatus of the case is a server computer for collecting, storing, processing, and transferring information such as operation information of a facility (for example, ON/OFF of pump), abnormality information (for example, abnormality in water quality, restoration from abnormality in water quality), measured values (for example, flow rate of water flowing in water purification plant and turbidity of taken raw water) mainly in

water purification plants and sewage plants.

The apparatus of the case is sold and lent to a local government for operating the water purification plant and the sewage plant and a maintenance service company which is entrusted by the local government to manage and check the facility. The number of the apparatus of the case to be sold is limited. Therefore, catalogs and instruction manuals are made by the demandee without ordering the printing to a printing company.

(2) Evidence B No. 2 is an instruction manual of the apparatus of the case.

Functions of the apparatus of the case include a data collecting function, a data storing function, a data transferring function, and a data processing function, and software developed by the holder of trademark right is installed to the apparatus of the case.

(3) Evidence B No. 3 is a certificate, which was made by the manager of R&D center environment technology development department, regarding the fact such that a researcher belonging to R&D center created Evidences B No. 1 and No. 2 in February, 2014.

(4) Evidence B No. 4 is a written estimate regarding manufacturing cost indicated by Fuji IT Co., Ltd when the owner of trademark right entrusted Fuji IT Co., Ltd (refer to as "Fuji IT" below) to manufacture the apparatus of the case.

As indicated in "features" in Evidence B No. 2 that "i-Curator is an apparatus formed by integrating GSA2 with an input/output unit", "GSA2_IO" and "GSA2IO" which are written in Evidence B No. 4 as a subject or a product name mean that the apparatus is an improved product of an existing facility monitoring server computer "GSA2" (IO, which means input/output unit, is added to GSA2).

(5) As indicated in Evidence B No. 5, the holder of trademark right ordered Fuji IT to manufacture 100 apparatus of the case. As indicated in Evidence B No. 6, the apparatuses of the case were delivered on May 20, 2013, and a debit note was issued.

(6) Evidence B No. 7 is a request for written estimate dated on April 7, 2016 from Stem Corporation. "One I-curator" is written as a subject. In the estimate specifications, the fact was written such that an estimate of a purchase cost of one I-curator to be provided in a manhole pump was required as a "wide area monitoring content".

(7) Evidence B No. 8 is a written estimate sent to Stem Corporation as a response to the estimate request in Evidence B No. 7.

"For manhole pump in N-city, wide area monitoring service apparatus (existing apparatus is purchased), apparatus cost, one I-Curator" is written as a product name.

(8) Evidence B No. 9 is a reference photograph of the apparatus of the case.

Although the photograph was photographed after the registration of the demand

for trial of the case, the fact that The Trademark which is directly indicated on the apparatus of the case can be confirmed.

2 Conclusion

According to the above evidences, the demandee succeeded in proving the fact such that the holder of trademark right has used The Trademark in connection with "Electronic machines, apparatus" in Japan within three years before the registration date of the demand for trial of the case.

No. 4 Judgment by the body

1 The allegation of the demandee and the submitted evidences indicate as follows.

(1) In the upper left part of Evidence B No. 1-1, it is described that "By connecting remote control facility monitoring/ i-Curator to the Internet, you can monitor the facility at a place apart from the facility/value of collected signals is../When an abnormality occurs in the facility, i-Curator can send an email, and condition of the facility can be immediately notified." under the headline of "i-Curator use scene". In the lower left part, the name and the address of the holder of trademark right are written. In the lower right part, "Built on GSA2 Technology" is written. On the upper side of the above characters, the trademark deemed identical with The Trademark from generally accepted perspective is indicated, and on the upper side of the trademark, it is described "recommended retail price open price". Therefore, it can be said that Evidence B No. 1 is a sales catalog (leaflet) of the holder of trademark right regarding the apparatus of the case "i-Curator".

On the surface of the photograph of the apparatus of the case published in the catalog, the trademark deemed identical with The Trademark from generally accepted perspective is indicated.

(2) In Evidence B No. 2, under the headline of "SPECIFICATIONS SHEET" and "i-Curator", it is described that "Summary/i-Curator is a unit apparatus which can collect field information and easily and clearly use site information. I-Curator can be used to manage facilities and apparatuses. The integration of an input/output unit with GSA2 reduces a total engineering cost". In page 2 and subsequent pages, "Specifications of controller", "Specifications of digital pulse input", "Specifications of analog input", "Specifications of AC adapter", and the like are written. According to the above descriptions, it can be said that Evidence B No. 2 is an instruction manual of the apparatus of the case "i-Curator" including eight pages.

On the surface of the drawing of the apparatus of the case indicated in "Outline" in page 7, the trademark deemed identical with The Trademark from generally accepted

perspective is indicated. In the final page, that is, page 8, it is described that "The Trademark is the registered trademark of METAWATER.", and the name and the address of the holder of trademark right are written in the lower left part. In the lower part of each page, "MWTDJ50020" and "METAWATER Co., Ltd." are written.

(3) Evidence B No. 3 is a certificate dated October 29, 2016 made by the manager of R&D center environment technology development department. The certificate indicates that "the catalog ("i-Curator Built on GSA2 Technology") and SPECIFICATION SHEET (MWTDJ50020) were created in February 2014 to be used to describe the products to customers by a researcher belonging to R&D center of METAWATER Co., Ltd."

(4) Evidence B No. 4 is a written estimate dated on March 30, 2013 from Fuji IT to the holder of trademark right. "GSA2IO/type: FSA3-DA00 [order type: FSA3-DA00 (M)]" is described in the field of the product name, and as a breakdown, such as "main body", "AC power supply adapter", "GSA platform system soft built-in" are written. Furthermore, "100" is written in a field of the number. The "order No." is "P00028393", and the "request No." is "R30006810".

(5) Evidences B No. 5 and No. 6 are respectively a written order (copy) dated on April 23, 2013 from the holder of trademark right to Fuji IT and a debit note dated May 20, 2013 from Fuji IT to the holder of trademark right. In each Evidence, "order (sheet) No. P00028393" and "request No. R30006810" are written. In addition, "GSA2IO/FSA3-DA00" is written in a field of the product name and standard size, and "100" is written in the field of the number. The "GSA2IO" was delivered to the holder of trademark right on May 20, 2013.

(6) Evidence B No. 7 is an estimate request sheet dated on April 7, 2016 and attached estimate specifications from Stem Corporation. In the estimate request sheet, "one I-curator" is written as the subject. In "2. Wide area monitoring content" of the estimate specifications in page 3, "I-curator" is written in the fifth line of the field of "monitoring apparatus type", "1" is written in the field of "number of apparatus". "Manhole pump" is written in the field of "installation position", and "purchasing cost" is written in the field of "remarks". Evidence B No. 8 is a written estimate dated on the same day sent from the holder of trademark right to Stem Corporation as a response to the estimate request in Evidence B No. 7. "For manhole pump in N-city, wide area monitoring service (existing apparatus is purchased)", and "apparatus cost, one I-Curator" are written as the product name.

(7) Evidence B No. 9 is a reference photograph indicating the apparatus of the case. The holder of trademark right insists that the photograph was photographed after the

registration of the demand for trial of the case, and a mark deemed identical with The Trademark from generally accepted perspective is indicated on the surface of the apparatus of the case.

2 Judgment

According to the above description, the holder of trademark right entrusted Fuji IT to manufacture the apparatus having the product name of "GSA2IO", and the apparatus was delivered on May 20, 2013 before the period required to prove trademark use. It is recognized that the holder of trademark right created the catalog and the instruction of the apparatus of the case, which is an apparatus formed by integrating the apparatus called "GSA2" with the input/output unit (IO), to use them to describe the products to customers in February 2014.

Accordingly, it can be said that the apparatus having the product name of "GSA2IO", which is manufactured by Fuji IT under the commission of the holder of trademark right is the same as the apparatus of the case. In addition, it can be said that the apparatus of the case is a GSA platform system soft built-in server computer having a data collecting function and a data transferring function.

On the surface of the photographs and the drawings of the apparatus of the case described in the catalog and the instruction of the apparatus of the case, the trademark deemed identical with The Trademark from generally accepted perspective is applied.

In addition, the holder of trademark right received the estimation request from Stem Corporation dated on April 7, 2016 and sent the written estimate regarding "Wide area monitoring service (existing apparatus is purchased) One I-Curator" dated on the same day to Stem Corporation.

Therefore, the holder of trademark right created the catalog and the instruction regarding the apparatus of the case in the period required to prove trademark use (February 2014) of trial of the case and made the estimate of the purchasing cost of the apparatus of the case (April 7, 2016). Therefore, it can be said that the holder of trademark right had the apparatus of the case for sale to which the trademark deemed identical with The Trademark from generally accepted perspective has been applied in the period required to prove trademark use of trial of the case.

3 Summary

In light of all the above, it can be recognized that the holder of trademark right applied the trademark deemed identical with The Trademark from generally accepted perspective to the apparatus of the case (software built-in server computer) in the period required to prove trademark use of trial of the case.

It is recognized that the above use falls under "act to affix a mark to goods" in

Article 2(3)(i) of the Trademark Act.

The "software built-in server computer" which is the apparatus of the case falls under the category of Class No. 9 "Electronic machines, apparatus" in the requested goods and services for revocation of the case.

4 Closing

As described above, it can be said that the demandee proved that the holder of trademark right has used the trademark deemed identical with The Trademark from generally accepted perspective to the "software built-in server computer" included in the requested goods and services for revocation in Japan within three years before the registration of the demand for trial of the case.

Therefore, the registration of The Trademark regarding the goods and the services pertaining to the request for revocation shall not be canceled in accordance with Article 50 of the Trademark Act.

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

Attachment (The Trademark)



March 9, 2017

Chief administrative judge: KONDA, Mitsuo

Administrative judge: TANAKA, Koichi

Administrative judge: OMORI, Tomoko