

Advisory opinion

Advisory opinion No. 2016-600046

Kyoto, Japan

Demandant BUSINESS RALLIART INC.

Osaka, Japan

Patent Attorney YANAGINO, Takao

Osaka, Japan

Patent Attorney ONISHI, Hiroto

Osaka, Japan

Attorney KIMURA, Keijiro

Osaka, Japan

Attorney MATSUI, Akiyuki

Osaka, Japan

Demandee LOCKON CO. LTD.

The case of requesting the advisory opinion on the trademark registration No. 5704605 between the parties above is stated and concluded as follows.

Conclusion

The mark A which is used by the demandee for the goods "Computer programs" and the service "Providing computer programs by application service providers" falls within the scope of the effects of the trademark registration No. 5704605.

Reason

1 The Trademark

The trademark registration No. 5704605 (referred to as "The Trademark" below) consists of two lines of character strings, i.e., "Lockon" written in Alphabetic characters and "ロックオン (lockon)" written in katakana as indicated in the Attachment 1. The application for its registration was filed on March 10, 2014. The trademark was

registered on September 26, 2014 with designated goods and services of Classes No. 9, No. 16, No. 35, No. 37, No. 38, and No. 42 which are as specified in the Trademark Registry including "Electronic machines, apparatus and their parts" in Class No. 9 and "Providing computer programs" in Class No. 42, and it is still valid as of now.

2 Mark A

The mark A which has been indicated by the demandant as a mark used by the demandee for the goods "Computer programs" and the services "Providing computer programs by application service provider" consists of red characters of "株式会社ロックオン(LOCKON CO., LTD.)" which are horizontally written as indicated in the Attachment 2.

3 The demandant's allegation

The demandant requests the advisory opinion to be the same as the conclusion. The demandant summarized and mentioned reasons as follows and submitted Evidence A No. 1 to A No. 28 (including their branch numbers) as means of proof.

(1) Summary of reasons for requesting the advisory opinion

The Trademark consists of two lines of character strings, i.e., Alphabetic characters of "Lockon" in the upper line and katakana of "ロックオン(lockon)" in the lower line. The Trademark has the pronunciation of "rokkuon" and the meaning of "aiming at a target" corresponding to the constituent characters.

Whereas, the mark A consists of dark red gothic-like characters of "株式会社ロックオン(LOCKON CO., LTD.)" which are horizontally written. The mark has not only the pronunciation of "kabushikigaisharokkuon" but also the pronunciation of "rokkuon" which is derived from the primary part of "ロックオン(lockon)". Furthermore, the mark A has the meaning of "aiming at a target" corresponding to the character part of "ロックオン(lockon)" which is the primary part of the mark.

Therefore, both marks have the pronunciation of "rokkuon" and the meaning of "aiming at a target" in common, and both marks are similar to each other.

"Electronic machines, apparatus and their parts" in Class No. 9 and "Providing computer programs" in Class No. 42 in the designated goods and services of The Trademark are the same as or similar to the goods for using the mark "Computer programs" and the services for using the mark "Providing computer programs by application service providers" of the mark A

(2) Necessity of request for advisory opinion

The demandant is the holder of trademark right of The Trademark and the

registered trademark No. 4839624 (Evidence A No. 1 and A No. 2). The demandant has sent a written warning dated on October 1, 2014 and a notice dated November 27, 2014 to the demandee. The written warning and the notice indicate that the use of the mark A by the demandee for the service "Providing computer programs by application service providers" and the like violates the trademark right of the registered trademark. However, the demandee has continued to use the mark A without stopping the use of the mark A. Therefore, after that, the demandant filed a suit to require the injunction of the mark A and the like for the goods and the services used by the demandee by reason of the violation of the trademark right of The Trademark and the like dated on June 27, 2016 (Osaka district court, 2016, (Wa) No. 6268). The demandee submitted the written reply dated on July 20, 2016.

Therefore, the demandant demands the Patent Office to issue the advisory opinion regarding the scope of the effect of the trademark right of the trademark registration that is determined from a neutral stand with expert knowledge.

(3) Description of mark A

Since May in 2014 at the latest, the demandee has used the mark A in the upper left part of the product and service (service contents) page in the home page of the demandee which introduces the contents of provision of computer programs for advertisement effect measurement and the like by the application service providers (ASP) according to the demandee and the computer programs for EC site construction (refer to as "goods and services used by the demandee" below) as a mark displaying the source of the goods and services used by the demandee together with a red L-shaped figure trademark and a slogan trademark consisting of the characters of "Impact On The World" (Evidence A No. 3). After that, the demandee has used the mark A up to the present date (Evidence A No. 4).

Other individual trademarks such as "AD EBiS" and "THREe", "EC-CUBE", and the like are used for the goods and services used by the demandee (Evidence A No. 4). However, the mark A is recognized by consumers as a mark having a function for indicating the sources of the goods and the services, as a house mark regarding the goods and services used by the demandee. This similarly applies to the following case. For example, in a case where the mark is the goods trademark for a beverage and the like, although a corporation logo of the company is often used as a house mark in the upper part of the package of the beverage in addition to the individual trademark regarding the product, the corporation logo functions and is recognized as a mark indicating the source of the product together with the individual trademark of the product. Especially, it is natural that when consumers who use the service provided

through the Internet such as the ASP service confirm the content of the service, the consumers recognize that the mark displayed in the upper left part of the home page indicates the source of the service at the time when the consumers access the home page of the service provider.

Furthermore, in addition to the page of the service contents in the home page of the demandee, the mark A is similarly used in the upper left part of the page of the news (press release) including the advertisement regarding the goods and services used by the demandee regarding the individual trademarks "AD EBiS" and "THREe", "EC-CUBE", and the like (Evidence A No. 28). In the page of the press release in the home page of the demandee, for example, information of seminars and individual consultations relating to the sales promotion of the goods and the services regarding "EC CUBE" in the goods and the services used by the demandee is written, and the mark A is largely used in the left part of the information (Evidence A No. 28).

Therefore, the mark A is used for an act to provide the information including the advertisement regarding the goods and services used by the demandee by an electromagnetic method while the mark is affixed to the goods and the services, and the use of the mark A falls under "Use" of the mark indicated in Article 2(3)(viii) of the Trademark Act.

(4) Use of The Trademark

The Trademark is a trademark regarding a service for providing computer programs by the ASP service provider, and providing the service has been started by the demandant through the home page of the demandant since about April in 2001. The demandant has continuously provided the service regarding The Trademark up to now (Evidence A No. 5-1 and 2)

(5) Description indicating that the mark A fall within the scope of the effect of the trademark right of The Trademark

A Comparison of marks

The Trademark consists of two lines of character strings, i.e., Alphabetic characters of "Lockon" in the upper line and katakana of "ロックオン (lockon)" in the lower line. The Trademark has the pronunciation of "rokkuon" and the meaning of "aiming at a target" corresponding to the constituent characters.

Whereas the mark A consists of dark red gothic-like characters of "株式会社ロックオン (LOCKON CO., LTD.)" which are horizontally written. The mark has not only the pronunciation of "kabushikikaisharokkuon" but also the pronunciation of "rokkuon" which is derived from the primary part of "ロックオン(lockon)". Furthermore, the mark A has the meaning of "aiming at a target" corresponding to the

character part of "ロックオン(lockon)" which is the primary part of the mark.

Therefore, both marks are similar to each other having the pronunciation of "rokkuon" and the meaning of "aiming at a target" in common.

(A) Presence or absence of characters of "株式会社 (CO., LTD)" and similarity of trademarks

As described above, the mark A consists of the characters of "株式会社ロックオン (LOCKON CO., LTD.)". In this way, regarding the mark including the characters of "Kabushikigaisha (stock company)" in the constituent characters of the mark, the other character part is recognized as the primary part, and the mark A is similar to a trademark having the pronunciation which is the same as or similar to the pronunciation derived from the character part. This has been indicated in many decisions made by the Patent Office relating to the similarity of the trademarks regarding the presence/absence of the characters of "株式会社 CO., LTD)", and it is obvious that The Trademark is similar to the mark A.

(B) Non-applicability to Article 26(1)(i) of the Trademark Act

As described above, the mark A is similar to The Trademark. However, a use mode of the mark A does not fall under "a trademark indicating one's own name in a common manner" in Article 26(1)(i) of the Trademark Act as follows.

First, in a case where the name of the company is used for the goods and the services same as/similar to the designated goods and services of the registered trademark having the pronunciation which is the same as a part obtained by deleting "株式会社 (CO., LTD)" from the name of the company as a trademark having a function for distinguishing relevant products and services from others, it is obvious that this naturally causes a confusion by consumers and traders and disturbs maintenance of trade order which is one of the purposes of the Trademark Act. In Article 26(1)(i) of the Trademark Act, it is described that the effect of the trademark right does not extend to "a trademark indicating one's own name in a common manner". In a case where the trademark is "indicated in a common manner", the use of the name of the company as a trademark is permitted as an exception.

In this regard, in the decision of Tokyo High Court (1999 (Ne) No. 1428), it is described that "The use of "a trademark indicating (omitted) one's own name in a common manner" in accordance with Article 26(1)(i) of the Trademark Act is permitted as an exception while it is not appropriate to extend the effect of the trademark right to that. Therefore, it is reasonable to understand that the display method should not especially intend the function for indicating source" (Evidence A No. 21). In this way, the decision similar to the above allegation has been made.

It is now discussed whether the mark A falls under "a trademark indicating one's own name in a common manner" and whether the mark A especially intends the function for indicating the source.

As described above, the mark A is used in the upper left part of the home page of the demandee. However, in general, the upper left part of the home page describing the contents of the goods and services is one of the places which most easily attracts attention of the consumers who access the home page. For the consumers of the service introduced in the home page, it is considered that the trademark displayed in the upper left part is recognized as a house mark of an individual service mark and naturally has the function for indicating the source.

Regarding a point that the mark used in the upper left part of the home page is recognized as the mark indicating the source of the service, in the suit which is other from the above one between the demandee and the demandant (Osaka district court, 2016, (Wa) No. 5249), the demandee who is the plaintiff mentioned in the complaint that "In general, in the upper left part of the home page, the title of the home page and the name of the service are written. When viewing each home page in Appendix 1 of the defendant, ordinary people understand that the name and the source of the service of the defendant provided by the defendant are "Lock on". That is, the defendant uses "Lock on" as the trademark of the service of the defendant". Accordingly, the demandee recognizes the above point.

The upper left part of the home page is not a part where the name of the company is indicated "in a common manner". Rather, the upper left part is a part where the house mark such as the corporation logo of the company is used as intending the function for indicating the source of the goods and the services. The house mark such as the corporation logo is the most typical example which provides the function for indicating the source of the goods and the services without doubt.

In the following description, as the evidence supporting the above allegation, trademarks respectively used in the upper left parts of the home pages of listed companies in the field of information communication are discussed. The home pages of the companies are sent from the demandee to the demandant as attached to the written replay dated on August 27, 2014 as an evidence of the allegation that the use of the mark A is "the trademark indicated in a common manner" in response to the request for stop of the use of the mark A from the demandant (Evidence A No. 22).

However, although the trademarks respectively used in the upper left parts of the home pages of the companies are carefully examined, there is no example in which the name of the company is indicated in a common manner. In many cases, corporation

logos including abbreviated names of the companies are used independently or together with figures. Even when the name of the company is used, the name is not used in a common manner, and the name is used in combination with the corporation logo formed of the abbreviated name of the company and the figure trademark. According to this, the upper left part of the home page which is one of the places which most easily attracts attention of the consumers is a place where each company uses the corporation logo and the like to indicate the sources of the goods and services of the company in general, and it is obvious that the trademark used in the upper left part especially intends the function for indicating the source. Therefore, it is obvious that the mark A used in the upper left part of the home page that is considered as the place where the trademark having the function for indicating the source is indicated does not fall under "a trademark indicating one's own name in a common manner" in Article 26(1)(i) of the Trademark Act. In a case where the name of the company used in the upper left part of the home page, the name should be used after the trademark has been registered regarding the related services and the like. Alternatively, it is considered that, at least, the name of the company is used on the fundamental premise of no-existence of other person's similar registered trademarks regarding the related services.

In this point, in addition, until the indication by the demandant, the demandee has used the logo of "LOCKON" which is the abbreviated name of the demandee in the part where the mark A is used (Evidence A No. 23). After the demandant has indicated the violation of the trademark right, the demandee started to use the mark A instead of the logo, and the demandee alleges that there is no problem in the use of the mark A according to the provisions of Article 26(1)(i) of the Trademark Act. This indicates that the demandee recognizes that there has been originally no need to use the own name in the upper left part of the home page where the mark A is used.

In general, the home page of the company includes a page of a company profile. When consumers want to know the name of the company which manufactures, sells, or provides the goods and services introduced in the home page, information on the name of the manufacturer, the seller, or the provider of the goods and services can be easily obtained by referring to the page of the company profile. According to this, it can be considered that the purpose of Article 26(1)(i) of the Trademark Act can be sufficiently achieved. Therefore, no necessity is admitted in that the use of the name of the company similar to the registered trademark of the other person in the upper left part of the home page which is one of the places which most easily attracts attention of the consumers is permitted as an exception. It is not possible to admit that the use of the mark A in the part without necessity to use the name of the demandee can be permitted

as an exception while it is not appropriate to extend the effect of the trademark right to such use of the mark A.

In addition, as described above, in a case where the name of the company is used in the upper left part of the home page, the name is used in combination with the corporation logo formed of the abbreviated name of the company or the figure trademark. In this regard, the mark A is similarly used in combination with the red L-shaped figure trademark which is the registered trademark of the demandee (Evidence A No. 24 and A No. 25) and the slogan trademark "Impact On The World" (Evidence A No. 26 and A No. 27), and these registered trademarks must have the function for indicating the source and attract attention of the consumers. Therefore, it can be said that the mark A used in the upper left part of the home page in combination with the registered trademarks naturally have the function for indicating the source.

B Comparison of goods and services

"Electronic machines, apparatus and their parts" in Class No. 9 and "Providing computer programs" in Class No. 42 of the designated goods and services of The Trademark are the same as or similar to the goods using the trademark A "Computer programs" and the service using the trademark A "Providing computer programs by application service providers".

(6) Closing

As described above, the mark A is similar to The Trademark, and the goods and services using the trademark A are the same as or similar to the designated goods and services of The Trademark. Therefore, the mark A used by the demandee for the goods using the trademark A "Computer programs" and the service using the trademark A "Providing computer programs by application service providers" falls within the scope of the effect of the trademark right of The Trademark.

4 The demandee's reply

The demandee does not reply against the advisory opinion request.

5 Judgment by the body

(1) The Trademark

As indicated in the Attachment 1, The Trademark consists of Alphabetic characters of "Lockon" and katakana of "ロックオン (lockon)" written in two lines. The characters of "Lockon" and "ロックオン (lockon)" both mean "automatic tracking of a target with a radar".

Therefore, The Trademark has the pronunciation of "rokkuon" and the meaning

of “automatic tracking of a target with a radar”.

(2) Mark A

The mark A consists of the red characters of "株式会社ロックオン (LOCKON CO., LTD.)" written in the horizontal direction as indicated in the Attachment 2.

In the configuration, the character part of "株式会社 (CO., LTD)" indicates the form of organizing the legal entity. Therefore, the character part cannot have the function as a mark for distinguishing relevant products and services from others.

Accordingly, in the mark A, the main part which can function as the mark for distinguishing relevant products and services from others is the character part of "ロックオン (lockon)", and this character part should be independently recognized as the mark for distinguishing relevant products and services from others and support transactions.

Consequently, the mark A has the pronunciation of "rokkuon" corresponding to the character part of "ロックオン (lockon)" which is the primary part of the mark A and the meaning of “automatic tracking of a target with a radar”.

(3) Similarity between The Trademark and mark A

Since The Trademark and the mark A are configured as respectively indicated in (1) and (2), entire configurations of both marks are different from each other in appearance. However, the character part of "ロックオン (lockon)" in the configuration of The Trademark and the character part of "ロックオン (lockon)" which is the primary part of the mark A are similar to each other in appearance since both character parts are configured by writing katakana having the same spelling.

Regarding the pronunciation, both marks have the pronunciation of "rokkuon", and regarding the meaning, both marks have the meaning of “automatic tracking of a target with a radar” in common. Therefore, when the appearance, the pronunciation, and the meaning are totally considered together, both marks are similar to each other.

(4) Use mode of mark A

In the mark A used in the upper left part of the home page of the demandee in Evidence A No. 3 and A No. 4, the characters are written in red which attracts attention of observers. In addition, the small gray Alphabetic characters of "Impact On The World" like a company slogan are written on the lower side of the mark A. On the left side of the mark A, a red and sharp L-shaped figure is written to have the same height as the characters written in two lines. This display method is not only the indicates of one's own name in a common manner but also the use mode as the function for indicating the source of the goods and the services of the own business described in the home page.

(5) Goods and services using the mark A

In Evidence A No. 3 and A No. 4 which are the home page of the demandee, a plurality of products and services provided by the demandee are described. The products and the services referred to as "AD EBiS" are described in Evidence A No. 3 under the title of "advertisement effect measuring system "AD EBiS"". In the description of "AD EBiS", it is described that "The advertisement effect measuring system "AD EBiS" measures the effect to be obtained in accordance with the cost to place advertisements on the Internet. (omitted). Since the release in 2004, "AD EBiS" has been introduced to over 6000 companies (as of July 2013), and the demandee gained the top market share as an advertisement effect measuring tool vendor". Therefore, it is acknowledged that the demandee sells the goods of "Computer programs" to measure the advertisement effect.

Regarding the products and the services referred to as "EC-CUBE", under the title of "EC open platform "EC-CUBE" from Japan" in Evidence A No. 3, it is described that "Open source EC package "EC-CUBE" is provided as a new EC site construction method. Since the provision of "EC-CUBE" has been started in 2006, "EC-CUBE" has been introduced to many sites and established a position as a new EC site construction method". In Evidence A No. 4, on the right side of the item "commercial distribution platform" and under the title of "EC open platform "EC-CUBE" from Japan", it is described that "New EC site construction method having development-type flexibility, in addition to the convenience and low price of the APS type, based on "The third open source software utilization business survey" by Information-technology Promotion Agency". It can be acknowledged that the demandee provides the service of "Providing computer programs by application service providers" to create EC (electronic commerce) web site as the application service provider (ASP).

As described above, the mark A is indicated in the form having the function for indicating the source in the home page of the demandee which advertises the goods and the services. Therefore, it can be said that the goods and the services using the mark A are "Computer programs" and "Providing computer programs by application service providers".

(6) Similarity between the designated goods and services of The Trademark and the goods and the services using the mark A

"Electronic machines, apparatus and their parts" in Class No. 9 and "Providing computer programs" in Class No. 42 in the designated goods and services of The Trademark are the same as or similar to "Computer programs" which is the good using the mark A and "Providing computer programs by application service providers" which

is the service using the mark A.

(7) Summary

As described above, the mark A is similar to The Trademark, and the goods and services using the trademark A are the same as or similar to the designated goods and services of The Trademark. Consequently, the mark A which is used by the demandee for the goods "Computer programs" and the services "Providing computer programs by application service providers" falls within the scope of the effects of the trademark registration No. 5704605.

Therefore, the advisory opinion shall be made as described in the conclusion.

January 10, 2017

Chief administrative judge: SAKAI, Fukuzo

Administrative judge: TANAKA, Koichi

Administrative judge: KOMATSU, Satomi

Attachment 1 The Trademark

Lockon
ロックオン

Attachment 2 Mark A (refer to the original in regard to color)

株式会社ロックオン