

Appeal decision

Invalidation No. 2016-890004

Tokyo, Japan

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The case of trial regarding the invalidation of trademark registration for Trademark Registration No. 5488474 between the parties above has resulted in the following trial decision.

Conclusion

The appeal of the case was groundless.

The costs in connection with the trial shall be borne by the demandant.

Reason

1 The Trademark

The trademark with Trademark Registration No. 5488474 (hereinafter referred to as the "Trademark") consists of standard characters of "SPERRY TOP-SIDER", and the application for its registration was filed on March 30, 2011. The trademark was registered on April 20, 2012 by setting Class No. 35 "Advertising; issue of trading stamps; business management analysis or business consultancy; marketing research; providing information concerning commercial sales; business management of hotels; auctioneering; import-export agencies; providing employment information; retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles" as the designated services.

2 Cited Trademark

The trademark with Trademark Registration No. 1809362 cited by the demandant as the reason for invalidation of registration of the Trademark (hereinafter referred to as "Cited Trademark") consists of characters of "TOP-SIDER" written in the horizontal direction, and the application for its registration was filed on March 28, 1978. The trademark was registered on September 27, 1985 with designated goods of Class No. 17 which are as specified in the Trademark Registry. After that, renewals of duration of the trademark right have been registered twice. The designated goods' reclassification was registered on March 29, 2006 to set the designated goods to "Paper diapers for infants" in Class No. 16, "Cushions; Japanese floor cushions; pillows; mattresses" in Class No. 20, "Gloves for household purposes" in Class No. 21, "Cotton waddings for clothes; hammocks; futon bags; cotton batting for futon" in Class No. 22, "Woven textile goods for personal use; mosquito nets; bedsheets; futon and quilts cases; futon ticks; pillowcases; blankets" in Class No. 24, and "Non-Japanese style outerclathing; coats; sweaters and the like; shirts and the like; nightwear; underwear; swimwear; swimming caps; Japanese traditional clothing; aprons; collar protectors; socks and stockings other than special sportswear; puttees and gaiters; fur stoles; Japanese style socks; shawls; scarves; Japanese style socks covers; gloves and mittens; neckties; neckerchiefs, bandanas; thermal supporters; mufflers; ear muffs; hoods; sedge hats; nightcaps; helmets; headgear for wear" in Class No. 25. Regarding the goods of Class Nos. 16, 21, 24, and 25 in the designated goods, the renewal of duration of the

trademark right was registered on August 11, 2015, and the trademark right is still valid as of now.

3 The demandant's allegation

The demandant requested the decision, "The registration of the Trademark should be invalidated. The costs in connection with the trial shall be borne by the demandee." The demandant mentioned reasons as follows and submitted Evidence A No. 1 to No. 3 (including their branch numbers) as means of evidence.

(1) Reason to invalidate the trademark's registration

The Trademark was registered while violating Article 4(1)(xi) of the Trademark Act. Therefore, its registration must be invalidated under the provisions of Article 46(1)(i) of the Trademark Act.

A Similarities between designated services of the Trademark and designated goods of the Cited Trademark

"Retail services or wholesale services for woven fabrics and beddings (retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles" in the designated services of the Trademark are similar to "Cotton waddings for clothes; non-Japanese style outerclothing; sweaters and the like; shirts and the like; nightwear; underwear; swimwear; swimming caps; Japanese traditional clothing; aprons; collar protectors; socks and stockings other than special sportswear; puttees and gaiters; fur stoles; Japanese style socks; shawls; scarves; Japanese style socks covers; gloves and mittens; neckties; neckerchiefs; bandanas; mufflers; ear muffs; hoods; nightcaps; headgear for wear" in the designated goods of the Cited Trademark.

B Similarity between the Trademark and the Cited Trademark

In the Trademark, a space of a single character is provided between "SPERRY" and "TOP-SIDER", and semantical relation between "SPERRY" and "TOP-SIDER" cannot be found. Therefore, cohesion of the two words is weak, and the Trademark may give rise to the pronunciation of "toppusaidaa".

On the other hand, the Cited Trademark gives rise to the pronunciation of "toppusaidaa". In addition, the Cited Trademark is an application prior to and received a registration prior to the Trademark.

Therefore, regarding the services indicated in A from among the designated services of the Trademark, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

This is obvious in the reason of the decision of refusal of the trademark (Trademark Application No. 2013-17804, hereinafter referred to as "Other trademark") which consists of characters of "TOP-SIDER" written in the horizontal direction and was filed by the demandant on February 28, 2013. The designated services of the Other trademark are "Retail services or wholesale services for clothing; retail services or wholesale services for personal articles; retail services or wholesale services for printed matter; retail services or wholesale services for paper and stationery; retail services or wholesale services for clocks, watches and spectacles" in Class No. 35. That is, regarding the Other trademark, a notice of reasons for refusal was issued on September 6, 2013, and an examiner's decision of refusal was issued on December 20, 2013. However, in the notice of reasons for refusal, the Trademark was cited as Cited Trademark, and it has been described that the Other trademark falls under Article 4(1)(xi) of the Trademark Act, since the Other trademark is similar to the Trademark. Therefore, it is mentioned that the Other trademark cannot be registered (Evidence A No. 3 (1) to No. (3)). The Other trademark gives rise to the pronunciation of "toppusaidaa", and there is a possibility that the Trademark which is cited in the notice of reasons for refusal gives rise to the pronunciation of "toppusaidaa". Furthermore, the designated services of the Trademark and the Other trademark are partially overlapped or similar to each other. Accordingly, it has been determined that the two trademarks are similar to each other.

Therefore, although forms of the Cited Trademark and the Other trademark are different from each other, spellings are the same, and the pronunciations generated from these characters are "top sider" in both trademarks.

(2) Rebuttal against a reply

The demandee alleged in the written reply that "Retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches" are not similar to the designated goods of the Cited Trademark.

However, the designated goods of the Cited Trademark are similar to "Retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles" from among the designated services of the Trademark. Furthermore, the trademarks are similar to each other. Therefore, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

4 The demandee's allegation

The demandee made a request that the trial decision must be the same as the conclusion, and mentioned the reason as follows.

The demandant alleged that the Trademark falls under Article 4(1)(xi) of the Trademark Act regarding "Retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles" in the designated services, and that the registration should be invalidated under the provisions of Article 46(1)(i) of the Trademark Act.

However, "Retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches" in the designated services are not similar to the designated goods of the Cited Trademark.

Therefore, these designated services do not fall under Article 4(1)(xi) of the Trademark Act.

As described above, it is obvious that the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

5 Judgment by the body

(1) Similarity between the Trademark and the Cited Trademark

A Regarding the Trademark

As described in 1, the Trademark consists of the characters of "SPERRY TOP-SIDER". However, even when a space of a single character is provided between the part of "SPERRY" and the part of "TOP-SIDER", the characters are written in the same font and in the same size well integrally and uniformly in appearance. The character part of "TOP-SIDER" in the configuration does not strongly attract the viewer's attention. Furthermore, it can be said that the pronunciation of "superiitoppusaidaa" resulting from the overall configuration can be smoothly pronounced. In addition, it is hard to say that the character parts "SPERRY" and "TOP-SIDER" included in the Trademark have been known in Japan. Both of the character parts "SPERRY" and "TOP-SIDER" are understood as coined words. From this viewpoint, it is difficult to find which one of the character parts is more important in the meaning.

Therefore, it cannot be acknowledged that the character part of "TOP-SIDER" in the configuration of the Trademark makes a strong and dominant impression to consumers as a mark identifying the source of service. Other special circumstances such that the Trademark should be understood and recognized by separating the Trademark into the character parts of "SPERRY" and "TOP-SIDER" cannot be found.

Therefore, since it can be recognized that the overall configuration of the Trademark represents a uniformly integrated trademark, the pronunciation of "superiitoppusaidaa" in series is generated in correspondence with the characters, and the characters of the Trademark do not have a specific meaning.

B The Cited Trademark

As described in 2, the Cited Trademark consists of the characters of "TOP-SIDER" written in the horizontal direction. It is reasonable to understand that the Cited Trademark gives rise to the pronunciation of "toppusaidaa" and represents a coined word which does not have a special meaning.

C Comparison between the Trademark and the Cited Trademark

As described in A, since it is reasonable that it can be recognized that the overall configuration of the Trademark represents a uniformly integrated trademark, the Trademark is obviously different from the Cited Trademark in appearance.

Furthermore, the pronunciation of "superiitoppusaidaa" derived from the Trademark and the pronunciation of "toppusaidaa" derived from the Cited Trademark are different in presence/non-presence of the sound of "superii" in the head parts of the words which are important elements in the pronunciation in the point of identification. Therefore, even in a case where both pronunciations are used as a whole, tones and senses of the words are significantly different from each other, and there is no possibility of their being confused with each other.

In addition, since both the Trademark and the Cited Trademark do not have special meaning, the meaning of the two trademarks cannot be compared with each other.

Therefore, the meaning of the Trademark and the Cited Trademark cannot be compared with each other. However, it can be said that the Trademark and the Cited Trademark are not similar to each other and are not confused with each other in the points of the appearance and the pronunciation.

Therefore, the Trademark does not fall under Article 4(1)(xi) of the Trademark Act.

(2) Demandant's allegation

The demandant alleges that the Trademark is similar to the Cited Trademark since the Other trademark consisting of the characters of "TOP-SIDER" written in the horizontal direction was not registered based on the reason for the refusal in which the Trademark has been cited in the procedure of the examination. The demandant submits Evidence A Nos. 3(1) to (3).

According to Evidence A Nos. 3(1) to (3), the demandant filed an application for

the trademark (Other trademark) (Trademark Application No. 2013-17804) consisting of the handwriting-like characters of "TOP-SIDER" written in the horizontal direction on February 28, 2013 by setting the services described in the trademark registration application belonging to Class No. 35 as the designated services. However, regarding the application, a notice of reasons for refusal was issued on August 19, 2013 indicating that (a) the application does not meet the requirement of Article 3(1) main paragraph of the Trademark Act and (b) the application falls under Article 4(1)(xi) of the Trademark Act.

Then, since the demandant (applicant) did not submit a written opinion, the examiner's decision of refusal was issued. After elapse of the period to apply appeals against the examiner's decision of refusal, the decision became final and binding.

Other than the Trademark, another registered trademark was cited in the notice of reasons for refusal (b) indicating that the trademark falls under Article 4(1)(xi) of the Trademark Act. It can be acknowledged that the description such that the application was rejected according to the reasons (a) and (b) issued on August 19, 2013 is made in the examiner's decision of refusal.

According to the above, the demandant did not conduct necessary procedures to overcome the reason for refusal (a). In addition, regarding the similarity between the Other trademark and the cited registered trademark in the reason for refusal (b), the demandant did not submit a written opinion even though the demandant had a chance to submit a written opinion on and make arguments whether the decision by the examiner is correct or not. Furthermore, it should be said that the demandant did not seek for decision by upper instance court regarding the similarity between the Other trademark and the cited registered trademark. It has to be said that the demandant did not make an effort and means to obtain a trademark right of the Other trademark.

Therefore, it cannot be instantly determined that the Other trademark is similar to the Trademark based on the examination procedure described above. Even when the determination can be made that the Other trademark is similar to the Trademark in the examination procedure, it is obvious that the determination does not change the determination on the similarity between the Trademark and the Cited Trademark in this case.

Therefore, the demandant's allegation does not have reasons and cannot be accepted.

(3) Closing

As described above, the Trademark was registered without violating Article 4(1)(xi) of the Trademark Act. Therefore, its registration should not be invalidated

under the provisions of Article 46(1) of the Trademark Act.

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

September 29, 2016

Chief administrative judge: IDE, Eiichiro

Administrative judge: YAMADA, Masaki

Administrative judge: ENOMOTO, Masami