

Decision on opposition

Opposition No. 2016-900037

Tokyo, Japan

Trademark Right Holder ULTRA CEEP INC.

The United Kingdom

Trademark Opponent PENGUIN BOOKS LIMITED

Tokyo, Japan

Patent Attorney SOGA, Michiharu

Tokyo, Japan

Patent Attorney OKADA, Minoru

Tokyo, Japan

Patent Attorney SAKANOUE, Masaaki

Tokyo, Japan

Patent Attorney SUZUKI, Noboru

Decision on the opposition to the grant of the Trademark Registration No. 5806136 has resulted in the following decision.

Conclusion

The Trademark Registration No. 5806136 is maintained.

Reason

1 The Trademark

The trademark with Trademark Registration No. 5806136 (hereinafter referred to as the "Trademark") consists of the Alphabetic characters "PENGUINRESEARCH" as indicated in the Attachment, and the application for its registration was filed on June 2, 2015. Designated goods and/or designated services are set to be goods and services

in Class No. 9 "Cell phone straps and neck pieces; Telecommunication machines and apparatus; Downloadable electronic publications; Other electronic publications; Computer programs for converting downloadable sound into text; Recording media such as electronic circuits, IC cards, magnetic tapes, magnetic discs, optical discs, magneto-optical discs, CD-ROMs, and DVDs storing a computer program to perform processing on character data, music, sounds, videos, and images (including moving images and still images); Downloadable computer programs and Recording media such as electronic circuits, IC cards, magnetic tapes, magnetic discs, optical discs, magneto-optical discs, CD-ROMs, and DVDs storing downloadable computer programs; Other electronic machines, apparatus and their parts; Recording media such as electronic circuits, magnetic discs, magnetic tapes, IC cards, optical discs, magneto-optical discs, and CD-ROMs that have recorded sound data, sound sources, and music; Recording media such as sound-recorded electronic circuits, sound-recorded magnetic tapes, sound-recorded IC cards, sound-recorded magnetic discs, sound-recorded optical discs, sound-recorded magneto-optical discs, sound-recorded DVDs, and sound-recorded CD-ROMs; Records; Metronomes; Electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; Music files allowed to receive and save by using an internet; Downloadable programs for home video game machines and Recording media such as electronic circuits, magnetic discs, magnetic tapes, IC cards, optical discs, magneto-optical discs, DVDs, and CD-ROMs storing the programs; Electronic circuits and CD-ROMs storing programs for hand-held games with liquid crystal displays; Exposed cinematographic films; Exposed slide films; Slide film mounts; Recording media such as recorded magnetic tapes, recorded IC cards, recorded magnetic discs, recorded optical discs, recorded magneto-optical discs, recorded DVDs, and recorded CD-ROMs; Recorded video discs and video tapes; Image files allowed to receive and save by using the internet; Downloadable music; Downloadable sounds; Computer programs for reproducing downloadable sound sources and music; Downloadable character data; Downloadable images (including moving images and still images) and videos including shows and plays; Still images, moving images with sounds, other images (including moving images and still images), and videos of downloadable characters and the like; Electronic publications, character data, music, sounds, and videos that can be reproduced by IDs or encryption key provided through communication via the Internet or by other computer terminals, and recording media such as electronic circuits, IC cards, magnetic tapes, magnetic discs, optical discs, magneto-optical discs, CD-ROMs, and DVDs storing computer programs to perform

processing on those; Game programs for home video game machines; Game programs for arcade video game machines;" and Class No. 41 "Providing electronic publications and information on these; Services of reference libraries for literature and documentary records and providing information on these; Training singers; Education for scouting, training, and managing actors, singers, other performers, songwriters, and composers; Training and instructions for talents and models; Instruction by talent agency; Educational and instruction services relating to arts, crafts, sports, or general knowledge in talent schools; Providing music or videos (including both moving images and still images) from a website obtained by displaying the website regarding a predetermined artist by clicking a banner displayed on the website on the Internet and providing information on these; Providing music, sounds, videos, images (including both moving images and still images), and character data by using the other Internet, communication by mobile telephones, or other communication methods and providing information on these; Presentation of plays and shows by using the Internet, communication by movable telephones, or other communication methods and providing information on these; Planning or arranging of movies, shows, plays, or musical performances; Providing information on movies, shows, plays, or musical performances; Movie showing, movie film production, or movie film distribution; Presentation of live show performances; Direction or presentation of plays; Presentation of musical performances; Production of radio or television programs; Organization regarding production of radio or television programs; Organization of live videos and concert videos, organization or production of other radio or television programs, and providing information on these; Providing information on concerts and music performances by using the Internet, communication by movable telephones, or other communication methods; Providing information on other concerts and music performances; Providing information on presentations of shows and plays and music performances to fan club members; Organization, arranging, or conduct of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races, and auto races and providing information on these; Organization, arrangement, and conduct of auditions regarding actors, performers including singers, songwriters, and composers, and providing information on these; Organization, arranging, or conducting of music and talent contests; Providing amusement information; Providing amusement facility and providing information on these; Providing kara-oke by using communication by computer terminals and providing information on these; Providing network-compatible personal computer games, Internet games, on-line games, games by using game on-demand and other communications by using computer terminals and providing

information on these; Providing information on capturing methods for computer games; Production of videotape film in the field of education, culture, entertainment or sports (except for movies, television programs, and videos for advertisement); Organization, arranging, or conduct of sports competitions; Providing facilities for movies, shows, plays, music or educational training; Booking of seats for shows; Photography." The decision for registration was made on October 26, 2015, and the trademark was registered on November 13, 2015.

2 Cited Trademark

The trademark cited by the opponent for the opposition to registration (hereinafter referred to as the "opponent") is as follows.

(1) Trademark Registration No. 1830621 consists of the characters "PENGUIN" in horizontal writing, and the application for its registration was filed on December 26, 1977. The trademark was registered on December 25, 1985 with "Printed matter" of Class 26 as its designated goods, and after that, the renewals of duration of the trademark right were registered twice. Regarding the designated goods, the designated goods' reclassification was registered on March 22, 2007 to set the designated goods to "Printed matter" of Class 16. After that, the renewal of duration of the trademark right was registered on August 18, 2015.

(2) The trademark of International Registration No. 993811 consists of the characters "PENGUIN" in horizontal writing, and the international application for trademark registration was filed on September 23, 2008. The trademark was registered on April 1, 2011 by setting Class No. 35 "Retail services of books, all provided by way of stores, shops, and retail outlets, by mail order, by telephone sales, by online catalogue, by way of a general interest website or by way of a specialist website; accountancy" and Class No. 41 "Publishing services; publication of magazines, books, and printed matter; electronic publishing services; book club services; advice and assistance in the selection of books; supply services for books; supply services for books to educational establishments, advisory and consultancy services relating to all the aforesaid services" as the designated services.

The registered trademarks are collectively referred to as "Cited Trademark" below.

3 The grounds of the opposition to registration

The opponent insists that the Trademark falls under Article 4(1)(xv) of the Trademark Act and the Trademark must be invalidated according to Article 43-2(1) of the Trademark Act. The opponent summarized and mentioned reasons for the opposition as follows and submitted Evidences A No. 1 to No. 12 (including their branch numbers) as means of evidence.

(1) Applicability of Article 4(1)(xv) of the Trademark Act

A Prominence of Cited Trademark

Cited Trademark has been used for various products including books for many years in Japan and has been widely advertised. As a result, Cited Trademark was well known among traders and consumers in Japan as a trademark indicating books relating to the business of the opponent at the times of the application and the decision for the registration of the Trademark (Evidences A No. 3 to No. 10).

B Similarity of the Trademark to Cited Trademark

The Trademark consists of bold characters "PENGUIN" and thin characters of "RESEARCH" coupled with each other. Meaning of the entire characters of "penguin research" is not familiar in general. There are no special circumstances such that the Trademark should be understood as integral.

Therefore, since the character part of "PENGUIN" in the Trademark has strong impression, the Trademark has the same pronunciation and meaning as those of Cited Trademark and has high similarity to Cited Trademark.

C Relationship of goods

Although being originally used for paperbacks, Cited Trademark is also used for Electronic publications nowadays (Evidence A No. 5).

Therefore, it is reasonable to say that the designated goods and the designated services of the Trademark and the goods relating to the use of Cited Trademark are highly related to each other and often have common purposes, usages, and customers including the same and similar ones.

D Possibility for causing confusion

When the Trademark is used for the designated goods and the designated services, traders and consumers coming into contact with the Trademark may be

confused about the origin of the goods and services as if the goods and the services relate to the business of the opponent or a person relating to the opponent.

Therefore, the Trademark falls under Article 4(1)(xv) of the Trademark Act.

(2) Closing

As described above, since the Trademark falls under Article 4(1)(xv) of the Trademark Act, the Trademark must be invalidated.

4 Judgment by the body

(1) Prominence of Cited Trademark

Based on Evidences A No. 3 to No. 10 and reasons for the opposition, the following points can be acknowledged.

The opponent is a British Publisher established in 1935. In the same year, the opponent published paperbacks having the name of PENGUIN BOOKS. The paperbacks gained popularity by selling good books with low prices by using not only book stores but also sales organization not for books such as news stands, retail chain stores, and department stores, and strong sales were achieved. The paperbacks of the opponent were first imported to Japan in 1937, and after that, the opponent published many series of books relating to PENGUIN BOOKS such as PELICAN BOOKS. The opponent made a great contribution to the promotion and the spread of the worldwide "paperback revolution," and the opponent is assumed to be an original of the paperbacks today (Evidences A No. 3 and No. 4). The opponent sells electronic publications with widespread use of the Internet (Evidence A No. 5). In addition, the opponent sells tote bags, mugs, and tea towels with characters of "PENGUIN/BOOKS" or "PENGUIN/CLASSIC" (both character strings are horizontally written in two lines) and the shapes of penguins via book stores and the like as goods relating to PENGUIN BOOKS (Evidences A No. 5 to No. 10).

Therefore, it can be said that at the time of the application for the registration of the Trademark (June 2, 2015) the opponent had already been known as the company which has first published the paperbacks called "PENGUIN BOOKS" or that it had been known that "PENGUIN BOOKS" represents the books (paperbacks) published by the opponent to a certain degree among traders and customers in the book relating field in Japan.

However, in the evidences submitted by the opponent, evidence indicating the

advertisement of the paperbacks is limited to Evidence A No. 5. In addition, in the books indicated in Evidence A No. 5, various displays such as "The Penguin Book...", "Penguin Classics," "Penguins," and "Penguin" are made. Also, the evidences indicating the tote bags and mugs including Evidence A No. 5 do not indicate that the opponent provides advertisement activity. It is only indicated that the shop for handling the goods relating to the business of the opponent individually advertises the goods. Therefore, it cannot be recognized that the advertisement activity has been performed in a state where Cited Trademark has been continuously recognized by a large number of consumers for a certain period.

In addition, it is not obvious what sales quantity the sales amount of the books, to which Cited Trademark has been applied, were made before the application for the registration of the Trademark.

Therefore, based on the evidences submitted by the opponent, it cannot be recognized that Cited Trademark consisting of the characters "PENGUIN" was widely recognized among traders and consumers in Japan as a trademark indicating the goods "Books" relating to the business of the opponent at the time of the application for the registration of The trademark.

(2) Similarity of the Trademark to Cited Trademark

A The Trademark

The Trademark is formed as indicated in the Attachment. Although the character part of "PENGUIN" in the configuration is indicated by thicker characters than the character part of "RESEARCH", both character parts are written in Gothic and are integrally written with almost the same sizes and at the same intervals, and the characters integrally come together in appearance. In addition, the pronunciation "penginrisaachi " which is acknowledged to be caused by the configuration of the trademark can be freely used.

Therefore, it is reasonable to determine that it can be recognized that the Trademark indicates the trademark, which cannot be divided, used as a whole in a view of the appearance and the pronunciation. No other special circumstances can be found that the Trademark should be understood and recognized as dividing into the character part of "PENGUIN" and the character part of "RESEARCH."

Therefore, the Trademark causes the continuous pronunciation of "penginrisaachi " corresponding to the characters, and it can be said that the Trademark does not have a specific meaning.

B Cited Trademark

Since Cited Trademark consists of the characters "PENGUIN" in horizontal writing as described in 2, Cited Trademark causes the pronunciation "pengin" and the meaning of "penguin."

C Comparison of the Trademark with Cited Trademark

As described in A, it is reasonable to determine that it can be recognized that the Trademark indicates the trademark, which cannot be divided, used as a whole. Therefore, the appearance of the Trademark is obviously different from that of Cited Trademark.

Also, there is a difference between the pronunciation of "penginrisaachi" caused by the Trademark and the pronunciation of "pengin" caused by Cited Trademark, and the difference is whether the sound of "risaachi" is included. Therefore, even in a case where both trademarks are referred to as a whole, the tones and the feeling of the words are significantly different, and there is no possibility that the pronunciation are confused with each other.

In addition, the Trademark does not have a specific meaning. Therefore, the meanings of the Trademark and Cited Trademark cannot be compared with each other.

Therefore, the Trademark and Cited Trademark cannot be compared with each other regarding the meanings. However, the Trademark and Cited Trademark are not confused with each other in the points of the appearance and the pronunciation and are not similar to each other.

(3) Possibility for causing confusion on origin

As acknowledged in (1), it cannot be recognized that Cited Trademark was widely recognized among traders and consumers in Japan as the trademark indicating the goods "Books" relating to the business of the opponent at the time of the application for the registration of the Trademark. In addition, as acknowledged in (2), the Trademark is not similar to Cited Trademark.

Therefore, it can be said that traders and consumers coming into contact with the Trademark do not recall and associate Cited Trademark. Even when the Trademark is used for the designated goods and the designated services, it cannot be said that the Trademark may cause confusion regarding the origin of the goods and services as if the goods and the services are the goods and the services handled by the opponent or the

person having any business relationship with the opponent.

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

(4) Closing

As described above, since the registration of the Trademark is not in breach of Article 4(1)(xv) of the Trademark Act, the registration should be maintained in accordance with Article 43-3(4) of the Trademark Act.

Therefore, the 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

Attachment (The Trademark)

PENGUINRESEARCH