

## Decision on opposition

Opposition No. 2016-900045

Tokyo, Japan

Trademark Right Holder      EDWIN KK

Tokyo, Japan

Trademark Opponent          EVISU JAPAN LIMITED.

Tokyo, Japan

Patent Attorney                ASAHI, Kazuo

Decision on the opposition to the grant of the trademark with registration No. 5807881 has resulted in the following decision.

### Conclusion

With regard to the designated goods of the trademark with registration No. 5807881, the registration of "Night gowns; Negligees; Japanese sleeping robes; bathrobes; other nightwear of which trousers have no back pocket; undershirts; corsets; chemises; slips; brassieres; petticoats; other underwear of which trousers have no back pocket; anoraks; karate suits; sports overuniforms; kendo outfits; judo suits; headhands; wind-jackets; wristbands; other cloths for sports of which trousers have no back pocket." of Class 25 shall be cancelled.

With regard to the other designated goods of the trademark with registration No. 5807881, regarding the opposition to the grant, the registration shall be maintained.

### Reason

#### 1 The Trademark

The trademark registration with No. 5807881 (hereinafter referred to as "the Trademark") is configured as indicated in Attachment 1, its registration application was filed on April 1, 2015 as a trademark in which a position of a mark (limited to characters, figures, symbols or three-dimensional shapes or any combination thereof or any combination thereof with colors) is attached is specified (hereinafter referred to as

the "Position mark"), registration of the Trademark was decided on October 26, 2015 with "Trousers; long trousers; short trousers; jogging pants; sweat pants; ski pants; nightwear; pajamas; Japanese sleeping robes; underwear; drawers and underpants; panties, shorts and briefs; clothes for sports" of Class 25 as its designated goods, and the Trademark was registered on November 20, 2015.

## 2 Reasons for opposition against the registration

The opponent for opposition to the registration (hereinafter referred to as the "Opponent") petitions that the Trademark falls under Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act, and its registration shall be cancelled, and a summary of the reason is described as follows. The opponent submitted Evidence A No. 1 to A No. 35 as a means of proof.

(1) The Trademark is the Position mark of which a red tab figure is affixed to a position located in the upper left part of a right back pocket of trousers, with "Trousers; long trousers; short trousers; jogging pants; sweat pants; ski pants; nightwear; pajamas; Japanese sleeping robes; underwear; drawers and underpants; panties, shorts and briefs; clothes for sports" of Class 25 as its designated goods.

(2) Jeans with a trademark of which red tab is affixed to the position located in the upper left part of a right back pocket of trousers, similar to trousers with the Trademark, had been sold by the Opponent (Evidence A No. 1 to A No. 11), Levi Strauss & Co. (Evidence A No. 12 to A No. 23) and WAREHOUSE & Co. (Evidence A No. 24 to A No. 34) at least since the application of the Trademark was filed, and consumers have recognized these facts. Namely, the Trademark is the Position mark peculiar to jeans. Thus, with regard to "jeans" of the designated goods, the Trademark is a trademark by which consumers are not able to recognize the goods as those pertaining to a business of a particular person, and falls under Article 3(1)(vi) of the Trademark Act.

(3) As described above, since the Trademark is the Position mark peculiar to "jeans having a right back pocket", the Trademark is the trademark misleading as to the quality of the goods when used in goods other than "jeans having a right back pocket" of the designated goods, and falls under Article 4(1)(xvi) of the Trademark Act.

## 3 Notice of reasons for rescission

As the result of the examination by ex officio in the body in accordance with Article 43-9(1) of the Trademark Act, the summary of reasons for rescission notified by the body on May 26, 2016 to the holder of trademark right is as follows.

The Trademark is specified by Attachment 1(1) and (2), and according to each

description, it is recognized that the Trademark is the Position mark in which the position to which red rectangular tab figure in which Alphabetic characters of "EDWIN" are indicated (hereinafter referred to as the "Mark") is specified in "the upper left part of a back pocket of trousers".

Further, of designated goods of the Trademark, for example, it can hardly said that there is "a back pocket of trousers" which is a position to which the Mark is affixed in "Night gowns; negligees; Japanese sleeping robes; bathrobes" included in "nightwear", "Undershirts; corsets; chemises; slips; brassieres; petticoats" included in "underwear" and "Anoraks; karate suits; sports overuniforms; kendo outfits; judo suits; headbands; wind-jackets; wristbands" included in "clothes for sports" (see the column of Class 25 of the affixed table of Regulations under the Trademark Act), taking the general shape and use into consideration.

Thus, it cannot be conceived that the Trademark is used in "Night gowns; Negligees; Japanese sleeping robes; bathrobes; other nightwear of which trousers have no back pocket; undershirts; corsets; chemises; slips; brassieres; petticoats; other underwear of which trousers have no back pocket; anoraks; karate suits; sports overuniforms; kendo outfits; judo suits; headbands; wind-jackets; wristbands; other cloths for sports of which trousers have no back pocket", of the designated goods, and it cannot be recognized that the Trademark is a trademark to be used in connection with goods pertaining to the business of the applicant.

Therefore, with regard to the above goods of the designated goods, registration of the Trademark does not meet the requirements of the principal paragraph of Article 3(1) of the Trademark Act.

#### 4 Opinion of the holder of trademark right

The holder of trademark right has submitted no opinion in response to the reasons for rescission described in 3 above.

#### 5 Judgment by the body

##### (1) Principal paragraph of Article 3(1) of the Trademark Act

Against the reasons for rescission by the body described in 3 above, the holder of trademark right has submitted no opinion.

Further, since it is recognized that the reasons for rescission described in 3 above are reasonable, it cannot be conceived that the Trademark is used in "Night gowns; Negligees; Japanese sleeping robes; bathrobes; other nightwear of which trousers have no back pocket; undershirts; corsets; chemises; slips; brassieres;

petticoats; other underwear of which trousers have no back pocket; anoraks; karate suits; sports overuniforms; kendo outfits; judo suits; headbands; wind-jackets; wristbands; other cloths for sports of which trousers have no back pocket", of the designated goods, and it cannot be recognized that the Trademark is a trademark to be used in connection with goods pertaining to the business of the applicant, and hence the Trademark does not meet the requirements of the principal paragraph of Article 3(1) of the Trademark Act.

(2) Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act

A In accordance with Article 5(2)(v) of the Trademark Act, with regard to the trademark for which a registration is sought as the Position mark, the description of the detailed explanation of trademark in accordance with Article 5(4) of the Trademark Act (hereinafter referred to as the "detailed explanation of trademark") should specify the trademark for which registration is sought in accordance with Article 5(1)(ii) of the Trademark Act (hereinafter referred to as "trademark in the column in which the trademark is described") (Article 5(4) and (5) of the Trademark Act), and with regard to the scope of the registered trademark, the meaning of the trademark in the column in which the trademark is described shall be interpreted, taking the description of the detailed explanation of trademark into consideration (Article 27(3) of the Trademark Act). Further, Article 4-6 of the Enforcement Ordinance of the Trademark Act provides that, with regard to the column in which the trademark is described, regarding the Position mark, " the Trademark shall be made by one figure or photograph or two or more different figures or photographs indicating the way in which the mark and the position to which it is attached is specified by drawing the mark with solid lines and other parts with broken lines."

Further, as described in 1 above, in the column in which the trademark is described, regarding the Trademark, a red rectangular tab figure in which Alphabetic characters of "EDWIN" are indicated is described by solid lines (Attachment 1(1)), and in the detailed explanation of trademark, it is described that "the Trademark is the Position mark, is affixed to a position located in the upper left part of a back pocket of trousers and consists of a red rectangular tab figure in which Alphabetic characters of 'EDWIN' are indicated (Attachment 1(2))."

The Opponent alleges that, as described in 2(1) above, the Trademark is a trademark in which "a red tab figure is affixed to a position located in the upper left part of a right back pocket of trousers", and on the basis of the precondition, the Trademark was registered while violating Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act. However, as described above, in the Trademark, a mark affixed to a specific

position (the Mark) is not just a "red tab figure", but a mark in which Alphabetic characters of "EDWIN" are indicated in the figure (Attachment 2).

Thus, it should be said that specific reasons of the opposition to the grant alleged by the Opponent (2(2) and (3) above) are wrong in the precondition.

Preconditioning that the Mark is a "red rectangular tab figure in which Alphabetic characters of 'EDWIN' are indicated", with regard to the Trademark, we will examine the applicability of Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act in the following "B".

B In the column in which the trademark is described, the Trademark is described such that the shape of trousers of which pockets are located in the right and left of the hip part is described by broken lines, and a red rectangle figure in which Alphabetic characters of "EDWIN" are indicated is described in the upper left part of the right pocket by solid lines (Attachment 1(1)), and in the detailed explanation of trademark, it is described that "the Trademark is affixed to 'the upper left part of a back pocket of trousers, and consists of a red rectangular tab figure in which Alphabetic characters of "EDWIN" are indicated", and "broken lines indicate one of the shapes of goods, and are not constituent components consisting of the trademark" (Attachment 1(2)), and it is recognized that the Trademark is the Position mark in which a position to which a red rectangular tab figure in which Alphabetic characters of "EDWIN" are indicated (the Mark) is affixed is specified in the upper left part of the back pocket, described by broken lines, of trousers.

Incidentally, the Opponent alleges that in the trade handling designated goods of the Trademark, it is usual that a red tab is affixed to the upper left part of a back pocket of trousers. Although only the tab independently cannot function for distinguishing relevant products from others, it can be said that if characters capable of functioning for distinguishing relevant products from others are indicated in the tab, the tab represents the source with the goods to traders and consumers in contact with this, from the characters.

Further, the Mark is a mark in which Alphabetic characters of "EDWIN" are remarkably indicated in a red rectangular tab figure (Attachment 2), Alphabetic characters of "EDWIN" are not an existing word in a dictionary and are not used as a word representing quality of goods with regard to designated goods of the Trademark, and the Alphabetic characters of "EDWIN" are capable of sufficiently functioning for distinguishing relevant products from others.

Thus, in the Trademark, the Mark configuring the Trademark can function for distinguishing relevant products from others with Alphabetic characters of "EDWIN",

and in a case where the Mark is affixed to a position of the upper left part of a back pocket of trousers, it can be recognized that the Mark is used as a mark to distinguish relevant goods from others. Taking these into consideration, it cannot be said that the Trademark is a trademark by which consumers are not able to recognize the goods as those pertaining to a business of a particular person, and since Alphabetic characters of "EDWIN" do not lead as to the specific quality of the goods, it cannot be said that the Trademark is a trademark misleading as to the quality of the goods when used in any designated goods.

Incidentally, the Opponent alleges that the Trademark is a trademark misleading as to the quality of the goods when used in goods other than "jeans having a right back pocket" of the designated goods, and falls under Article 4(1)(xvi) of the Trademark Act; however, it should be said that with regard to goods of which "a back pocket of trousers" being a position to which the Mark is affixed, of designated goods of the Trademark, using the Trademark cannot be conceived as described in (1) above, and the Trademark does not meet the requirements of the principal paragraph of Article 3(1) of the Trademark Act.

Therefore, the Trademark does not fall under Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act.

### (3) Summary

As described above, with regard to designated goods described in Conclusion above, of the designated goods, it has to be said that registration of the Trademark violated the principal paragraph of Article 3(1) of the Trademark Act, and shall be cancelled in accordance with Article 43-3(2) of the Trademark Act.

However, with regard to the other designated goods of the trademark regarding the opposition to the grant, the registration was not registered while violating any of the principal paragraph of Article 3(1), Article 3(1)(vi) and Article 4(1)(xvi) of the Trademark Act, there is no other reasons for cancellation, and the registration shall be maintained in accordance with Article 43-3(4) of the Trademark Act.

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

August 22, 2016

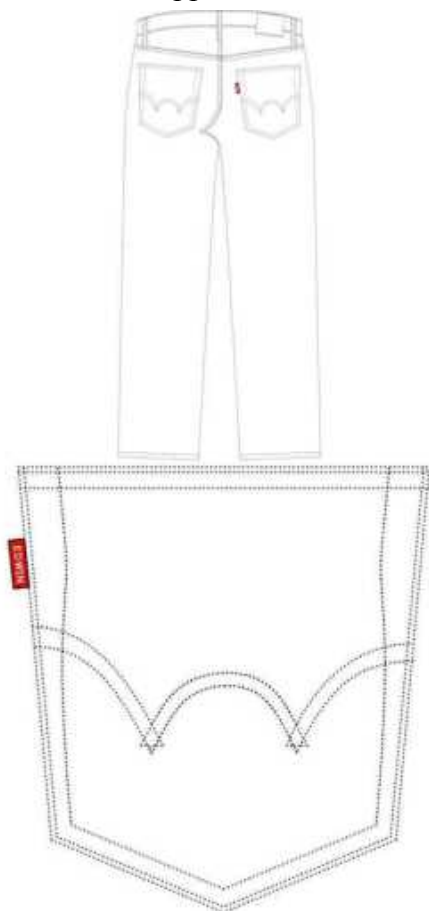
Chief administrative judge: AOKI, Hirofumi  
Administrative judge: KONDA, Mitsuo

Administrative judge: NEGISHI, Katsuhiro

## Attachment

### 1 The Trademark

(1) Description in the column in which a trademark for which registration is sought described in the application is described (with regard to color, see the original copy)



### (2) Detailed explanation of trademark

The trademark for which registration is sought (hereinafter referred to as the "trademark") is a Position mark in which a position affixed to the trademark is specified, the trademark is affixed to the upper left part of a back pocket of trousers, and consists of a red rectangular tab figure in which Alphabetic characters of "EDWIN" are indicated. Incidentally, description of only a pocket and a tab figure is an enlarged drawing of a portion for obviously describing a mark affixed to the position. Further, broken lines represent one of the shapes of goods, and do not represent a component constituting the trademark.

2 Part of the Mark in Attachment 1(1) enlarged by the body

