

Decision on opposition

Opposition No. 2016-900116

China

Trademark Right Holder DONGGUAN HELE ELECTRONICS CORPORATION

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Decision on the opposition to the grant of the trademark registration No. 5824306 has resulted in the following decision.

Conclusion

The grant of the trademark registration No. 5824306 is maintained.

Reason

1 The Trademark

The trademark registration No. 5824306 (hereinafter referred to as the "Trademark") is configured as indicated in Attachment, and the application for its registration was filed on September 2, 2015. The decision for registration was made on January 13, 2016, and the establishment of the trademark right was registered on February 5, 2016 by setting Class No. 9 "Computers; computers peripherals; navigation apparatus; loudspeakers; portable telephones; loudspeaker phones; headphones; earphones; battery chargers; data processing apparatus." as the designated goods.

2 Cited Trademark

International Trademark Registration No. 1185056 (hereinafter referred to as "Cited Trademark") cited as the grounds of the opposition to registration of this case by the opponent consists of Alphabetic characters of "JIBO" written in a roman type. The international trademark application was filed on April 21, 2015 (subsequent designation), and the decision of registration was issued on May 11, 2016. The national registration was made on July 8, 2016 with designated services of Classes No. 9 "Personal robots accessories, namely, microphones, audio speakers, video cameras, electric charging cables and battery charging devices, power supply connectors, batteries, power supply adaptors, computer hardware, computer networking hardware, cradles for electronic mobile devices, computer printers, computer screens, computer peripherals therefor, computer hardware in the nature of structural parts for personal robot external appearance customization; carrying cases, holders, and protective cases all specially adapted for the aforementioned goods: personal robots, namely, interactive

social and emotive robots for personal use that provide information, entertainment, education, and communications capabilities; downloadable computer software and computer application software for portable electronic devices; downloadable computer software and computer application software for portable electronic devices, namely, software for controlling, programming, and interfacing with personal robots, software for creating, uploading, downloading, sharing, viewing, and streaming audio, musical, visual, photographic, audiovisual, and literary content, software for social networking, software for communicating via voice, text and video, software for telepresence conferencing and management, software for geolocation and navigation, software for accessing information related to sports, news, weather, science, art, current events, and entertainment, software for task management, scheduling, and organization; software for recording, storing, and retrieving information and data; electronic game software for portable electronic devices." and the services, which are as specified in the Trademark Registry according to the trademark right based on the international registration, belonging to Classes No. 41 and 42. It is still valid as of now.

3 Grounds of the opposition to registration

The opponent insisted that the registration of the Trademark must be invalidated under the provisions of Article 43-3 of the Trademark Act because the Trademark was registered while violating Article 8(1) of the Trademark Act. The opponent summarized and mentioned reasons for opposition as follows, and submitted Evidences A No. 1 to A No. 4 as means of evidence.

(1) The Trademark and Cited Trademark are similar to each other in terms of pronunciation.

Cited Trademark is configured by horizontally writing the Alphabetic characters "JIBO". The product according to Cited Trademark is a First family robot in the world and introduced as "Tough enemy of Pepper? The ability of 499-dollar JIBO" in "Toyo Keizai Online" dated on August 15, 2014 (Evidence A No. 3). Furthermore, the article such that "Shipping of pretty family AI robot "JIBO(ジーボ)" finally starts" was published in "Zaikei Shimbun" dated on June 22, 2016 (Evidence A No. 4). In Evidences A No. 3 and 4, the name of "ジーボ" written Katakana is written together with "JIBO".

In this way, Citer Trademark gives rise to the pronunciation of "jiibo".

Whereas, the Trademark is a coined word trademark. However, in general, in a case where a coined word trademark of Alphabetic characters can be naturally pronounced in English style, the pronunciation is determined as the English

pronunciation which is the most familiar to Japanese.

For example, an English word "jeans" including characters of "jea" in the Trademark is highly familiar in Japan as a word pronounced as "jiinzu".

Therefore, the Trademark gives rise to the pronunciation "jiibo" which is the same as Cited Trademark.

(2) Class No. 9 "Computers; computers peripherals; data processing apparatus." in the designated goods of the Trademark are similar to Class No. 9 "downloadable computer software and computer application software for portable electronic devices" in the designated goods of Cited Trademark.

Furthermore, Class No. 9 "Navigation apparatus; loudspeakers; portable telephones; loudspeaker phones; headphones; earphones." in the designated goods of the Trademark are similar to Class No. 9 "Personal robots accessories, namely, microphones, audio speakers, video cameras" in the designated goods of Cited Trademark.

In addition, Class No. 9 "Battery chargers" in the designated goods of the Trademark is similar to Class No. 9 "Personal robots accessories, namely, ...power supply connectors, ...power supply adaptors" in the designated goods of Cited Trademark.

(3) Conclusion

Therefore, the Trademark was registered while violating Article 8(1) of the Trademark Act.

4 Judgment by the body

(1) Regarding the Trademark

As indicated in Attachment, the Trademark consists of the Alphabetic characters of "jeabo" which are substantially designed. Since the word formed by these characters is not an existing word contained in dictionaries, the word "jeabo" is recognized and understood as a kind of a coined word which does not have specific meaning, and the word "jeabo" does not have a specific idea.

According to the character arrangement, the Trademark gives rise to the pronunciation of "jeabo" or "jiibo" as following the pronunciations of Roman characters and English.

(2) Regarding Cited Trademark

Cited Trademark consists of the Alphabetic characters of "JIBO" and gives rise to the pronunciation of "jiibo" according to the characters.

The characters can be assumed as a kind of a coined word having no specific

meaning. Therefore, Cited Trademark does not have a specific idea.

(3) Regarding similarity between the Trademark and Cited Trademark

As indicated in Attachment, the Trademark consists of the Alphabetic characters of "jeabo" which are substantially designed. Whereas, Cited Trademark consists of the Alphabetic characters of "JIBO". Therefore, the two trademarks are different in the constituent characters and the forms and distinguishable from each other in terms of appearance.

Regarding the pronunciation, both trademarks have the same pronunciation of "jibo". However, since the sound "jea" at the beginning of the word and the sound "jii" are clearly different from each other, the pronunciation of "jeabo" of the Trademark and the pronunciation of "jibo" of Cited Trademark have different tones and sounds of the words and can be sufficiently recognized by sounds.

In addition, regarding the meanings, since both the Trademark and Cited Trademark have no specific meanings, the Trademark and Cited Trademark are not similar to each other in terms of meanings.

Therefore, even though the Trademark and Cited Trademark may have the same pronunciations "jiibo", the Trademark and Cited Trademark are distinguishable from each other in terms of appearance and meanings. Therefore, in light of all the above, both trademarks are not similar to each other and do not cause a risk of confusion about the source with the goods.

In addition, no special circumstances can be found that requires to assume that the Trademark and Cited Trademark are similar to each other.

Therefore, the Trademark and Cited Trademark do not fall under the "trademarks similar to each other" prescribed in Article 8(1) of the Trademark Act.

(4) Summary

As described above, the Trademark was not registered while violating Article 8(1) of the Trademark Act. Therefore, the Trademark shall be maintained under the provisions of Article 43-3(4) of the Trademark Act.

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

November 2, 2016

Chief administrative judge: AOKI, Hirofumi

Administrative judge: TANAKA, Kyoko

Administrative judge: ITAYA, Reiko

Attachment (The Trademark)

