

Appeal decision

Appeal No. 2017-9488

Aichi, Japan

Appellant

Pasco Shikishima Corporation

Patent Attorney

ONDA, Makoto

Patent Attorney

ONDA, Hironori

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2015-50303 has resulted in the following appeal decision:

Conclusion

The appeal of the case was groundless.

Reason

1 The trademark in the Application

The trademark in the Application is a color trademark as indicated in Attachment 1 and consists solely of mazarine (combination of RGB: R0, G26, B104). The registration application was filed on May 27, 2015 by setting Class 30 "Bread and buns" as the designated goods. Thereafter, the designated goods of the present application were amended to Class 30 "Bread" by the written amendment dated on June 28, 2017 in the body.

2 Reasons for refusal stated in the examiner's decision (gist)

The examiner's decision acknowledged and determined that "The color, including combination of various colors, used for packages of products, decoration for advertisements of the products, or the like is selected to enhance charming features and the like of the products in many cases, and cannot be recognized as a mark for displays the source of goods and distinguishing relevant products from others. Therefore, even when the trademark in the Application consisting of mazarine is used for the designated goods (package thereof), it is natural for a consumer coming into contact with the trademark to only recognize the trademark in the Application as a color which is normally used or may be used for the product (package thereof). Accordingly, the trademark in the Application consists solely of a mark indicating, in a common manner, in the goods features and falls under Article 3(1)(iii) of the Trademark Act. Furthermore, according to use states and use forms of the color, which is estimated to be the same as the trademark in the Application, indicated in the submitted evidences, it cannot be said that the trademark in the Application which is a color trademark independently has distinctiveness. Therefore, it cannot be acknowledged that the trademark in the Application meets the requirement stipulated in Article 3(2) of the Trademark Act". The examiner's decision refused the application.

3 Judgment by the body

(1) Applicability of Article 3(1)(iii) of the Trademark Act

As described in the above 1, the trademark in the Application is a color trademark and consists solely of mazarine (combination of RGB: R0, G26, B104), and the designated goods are Class 30 "Bread".

Usually, in the industry for handling "Bread" which is the designated goods of the present application, as the features of the products, various colors are used for decorations and patterns for the packages of the products. In fact, mazarine and a color close to the color forming the trademark in the Application are widely used in general as the decorations, the patterns, and the like of the packages of the products including products manufactured and sold by "Yamazaki Baking Co., Ltd.", "ITO-PAN", and "FIRST BAKING CO., LTD." indicated in the examiner's decision as indicated in the Attachment 2.

Then, it is reasonable that even when the trademark in the Application solely consisting of the color of mazarine is used for the designated goods of the trademark in the Application, a consumer coming into contact with the trademark only recognizes that the trademark indicates a color which is usually used or may be used for the package of the product and does not recognize the trademark as a mark for indicating the source of goods or a mark for distinguishing relevant products from others.

Therefore, the trademark in the Application consists solely of a mark indicating, in a common manner, in the goods features and falls under Article 3(1)(iii) of the Trademark Act.

(2) Whether or not requirement stipulated in Article 3(2) of the Trademark Act is met

The Appellant alleges that "since the trademark in the Application has acquired so-called distinctiveness acquired through use, the trademark can be naturally registered by applying Article 3(2) of the Trademark Act notwithstanding the provision of Article 3(1)(iii) of the Trademark Act". The Appellant submitted Evidences No. 1 to No. 62 as the evidences of the allegation (in this case of trial, hereinafter, "A" is added to the evidences submitted by the Appellant (Evidences No. 1 to No. 62), and, for example, Evidence No. 1 is read as "Evidence A No. 1").

In consideration of the content of the evidences submitted by the Appellant, whether or not a consumer can recognize a manufacturer of the product as a result of the use of the trademark in the Application will be examined as follows.

A The Appellant launched the bread referred to as "Choujuku" (hereinafter, referred to as "bread in this case") in 1998 (Evidences A No. 12, A No. 14, A No. 43, and A No. 45). In a form which is recognized as the decoration, the pattern, and the like of the package of the product such as the color which is used for a part of the characters of "Choujuku" written on the package, a ground color of the characters of "Pasco", and the like, mazarine which can be recognized as the same color as mazarine forming the trademark in the Application is used. Thereafter, although the detailed description has been changed, similar packages have been basically and continuously used by the Appellant (Evidences A No. 11 to A No. 40, A No. 43, A No. 49 to A No. 51, A No. 54 to A No. 57, A No. 59, and A No. 61).

The Appellant mentioned that "two-tone color including "mazarine" × "white" (Evidence A No. 12) and "the color including "mazarine" × "white" is derived from these concepts" (Evidence A No. 40) as the features of the color of the package of the bread in this case. Furthermore, it shows that the lightness (brightness) of mazarine was slightly changed in 2006 (Evidence A No. 12).

B The Appellant sells the bread in this case in supermarkets, convenience stores, and the like across Japan and sells the bread in this case through online shopping sites managed by the Appellant or another person (Evidences A No. 15, A No. 27 to A No. 39).

Note that it shows that the same color as mazarine forming the trademark in the Application or a color close to mazarine is used as the ground color of the characters of "Choujuku" and the color of the characters of "Pasco" in a product display stand, a point-of-purchase advertisement, and the like when the bread in this case is sold in the supermarkets. However, the specific period of the sale is unknown (Evidences A No. 19 to A No. 26).

C In the introduction of the bread in this case in the home page of the Appellant, the Appellant uses mazarine, which can be recognized as the same color as mazarine forming the trademark in the Application, for the color of the characters of "Choujuku", a part of the background color, and the like (Evidences A No. 16 to A No. 18).

Furthermore, the Appellant has continuously advertised the bread in this case through TV commercials from the spring in 1999 to the autumn in 2016 while changing the content of the TV commercial once every half year. The TV commercials were broadcast by 64 broadcast stations in Kanto, Chubu, Kansai, and Shikoku. However, details of expression regarding the bread in this case in the TV commercials are unknown, and the specific period and the specific number of times of broadcast TV commercial are unknown (Evidences A No. 59 and A No. 60).

Moreover, the Appellant insists that the bread in this case was introduced in TV programs. However, the content of the program is only an introduction together with products of other companies at the time of introduction of bread industry and only an introduction as one of the breads manufactured and sold by the Appellant (Evidences A No. 61 and A No. 62).

In addition, the Appellant insists that advertisement regarding the bread in this case was placed in magazines. However, the content of the advertisement introduces that bread in "Choujuku series" including the bread in this case is used as ingredients in an article regarding recipes of baby foods in a magazine called "Hiyoko club" (October 2012, May 2013, June 2015, and June 2016) (Evidences A No. 54 to A No. 57).

D The bread in this case gained the top brand share (in value terms) in the "Bread" market in Japan from April 2010 to August 2016 (Evidence A No. 41), and it is estimated that the sales around the end of 2014 had reached about fifty-six billion yen (Evidence A No. 44).

E In comprehensive consideration of the above A to D described above, it can be said that the Appellant has continuously used mazarine which can be recognized as the same color as mazarine forming the trademark in the Application for the package of the product, bread in this case since 1998 when the bread in this case was started to be sold. However, the use form is that mazarine is only recognized as the decoration, the pattern, and the like of the package of the product such as the color used for a part of the characters of "Choujuku" written on the package, the ground color of the characters of "Pasco", and the like.

Furthermore, it can be said that there is a case where the Appellant uses mazarine which can be recognized as the same color as mazarine forming the trademark in the Application in the advertisement and the like regarding the bread in this case. However, the use form is that mazarine is used as the color of the characters of

"Choujuku" or "Pasco", the ground color of the characters, and the like. Since it is reasonable that a consumer coming into contact with the trademark recognizes that mazarine is always used integrally with the characters of "Choujuku" or "Pasco", it is hard to say that only the color of mazarine in use is separately observed and gives a strong impression.

Then, even though the bread in this case has been continuously manufactured and sold since the launching of the product about 20 years ago and has acquired the top share in the "Bread" market for a reasonable period of time, it cannot be acknowledged that a consumer can recognize the bread as the product relating to the business of the Appellant only by the color of mazarine which is used without the characters of "Choujuku" and "Pasco" that are used for the bread in this case.

Therefore, it cannot be acknowledged that a result of the use of the trademark in the Application, consumers are able to recognize the goods as those pertaining to a business of a particular person. Accordingly, the trademark in the Application does not meet the requirement stipulated in Article 3(2) of the Trademark Act.

(3) Appellant's allegation

The Appellant insists that it is arbitrary to acknowledge that the trademark in the Application does not meet the requirement stipulated in Article 3(2) of the Trademark Act based on the fact that a hue and the like which is obviously different from the hue and the like of the trademark in the Application is used as in the products manufactured and sold by another person indicated in the examiner's decision, and whether or not the requirement in the above Article is met should be determined based on whether or not the color independently obtain the function for distinguishing relevant products from others as eliminating such arbitrariness.

However, in the examiner's decision, while it is acknowledged that the color which is estimated as the same as the trademark in the Application is used for the package of the product, the background color when the product is introduced, and the like in consideration of the content of the written opinion, it cannot be said that the trademark in the Application independently has distinctiveness from the use state and use form, and a use example of the similar color by another person is exemplified. It is obvious that the determination regarding the requirement stipulated in Article 3(2) of the Trademark Act is made not only based on such examples.

Furthermore, in a use example indicated in the Attachment 2 including the use example of the similar color by another person indicated in the examiner's decision, even if the hue of the color in the use example is different from the hue of the color forming the trademark in the Application as described in Evidence A No. 10 submitted by the Appellant, the color in the use example can be visually recognized as a color similar to mazarine and the color forming the trademark in the Application.

However, it is reasonable to understand that a consumer of the designated goods "Bread" of the present application does not recognize the color in the use as a different color which can be distinguished from the color forming the trademark in the Application.

Then, according to the content of the evidences submitted by the Appellant indicating that the trademark in the Application meets the requirement stipulated in Article 3(2) of the Trademark Act by the body, as acknowledged and determined in (2), although the Appellant uses mazarine which can be recognized as the same color as mazarine forming the trademark in the Application for the bread in this case, it cannot

be acknowledged that a result of the use of the trademark in the Application, consumers are able to recognize the goods as those pertaining to a business of a particular person only by mazarine yet.

Therefore, the allegation by the Appellant cannot be adopted.

(4) Summary

As described above, the trademark in the Application falls under Article 3(1)(iii) of the Trademark Act and does not meet the requirement stipulated in Article 3(2) of the same act. Accordingly, the trademark in the Application cannot be registered.

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

August 14, 2018

Chief administrative judge:	TANAKA, Takanori
Administrative judge:	KANEKO, Naohito
Administrative judge:	KOMATSU, Satomi

Attachment 1 The trademark in the Application (regarding actual color, refer to the original)



Attachment 2 (regarding actual color, refer to web sites of companies)

(1) Web site of "Yamazaki Baking Co., Ltd."

"Royal Bread" (https://www.yamazakipan.co.jp/brand/01_12.html)



ロイヤルブレッド山型 (5枚) スライス round top Royal Bread (five slices)
sliced

ロイヤルブレッド (6枚) スライス Royal Bread (six slices) sliced



(2) Web site of "ITO-PAN"

"HOTEL BREAD four slices" (<http://ito-pan.jp/hotelbread/62/>)



(3) Web site of "FIRST BAKING CO., LTD."

"Morning selection eight slices"

(<http://www.daiichipan.co.jp/?product=%e3%83%a2%e3%83%bc%e3%83%8b%e3%83%b3%e3%82%b0%e3%82%bb%e3%83%ac%e3%82%af%e3%82%b7%e3%83%a7%e3%83%b3%e3%80%808%e6%9e%9a>)



(4) Web site of "FIRST BAKING CO., LTD."

"Ao (six slices)"

(<http://www.daiichipan.co.jp/?product=%E8%92%BC%E3%81%82%E3%81%8A%E3%83%BB%E6%9E%9A>)



(5) Web site of "Nichiryō Baking Co., LTD."

"Kinutsuya" (<http://www.nichiryō-pan.co.jp/kinutsuya/>)



(6) Web site of "RYOYU Co. Ltd.

"LOW SALT BREAD half"

(http://www.ryoyupan.co.jp/products/syokupan/kosyoku_halfgenensyokupan/)

