

## Appeal decision

Appeal No. 2017-16718

Osaka, Japan

Appellant PiCa Corp.

Attorney CREO Law & Intellectual Property

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2016-140063 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 configured as indicated in Attachment. Its designated goods are "Fences for pets; combs for pets; litter trays for pets; feeding vessels for pets; brushes for pets; bird cages; bird baths; cosmetic utensils; kitchen utensils and containers, not including gas water heaters for household use, non-electric cooking heaters for household purposes, kitchen worktops, and kitchen sinks; cleaning tools and washing utensils." of class 21. The Application was filed on December 14, 2016 as an application for trademark registration of Trademark Application No. 2016-69932 under the provision of Article 10(1) of the Trademark Act. The application for trademark registration of Trademark Application No. 2016-69932 was filed on June 28, 2016.

#### 2 Cited Trademark

The examiner's decision states that the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act and in the reasons for refusal of the Application cites the trademark with Trademark Registration No.4697945 (hereinafter referred to as the "Cited Trademark"). The Cited Trademark consists of two-tiered character strings, where one is "DOGGY" written in alphabetic characters and the other one is "ドギー(DOGGY)" written in *katakana*. Its registration application was filed on September 4, 2002 and the trademark was registered on August 8, 2003 with "Chains for dogs." of class 6, "Clothing for domestic pets." of class 18, "Beds for household pets: dog kennels." of class 20, "Feeding vessels for pets; brushes for pets; chewing goods for pet dogs." of class 21, and "Toys for domestic pets." of class 28, and the goods and services which belong to classes 5, 31, and 41 and are listed in the trademark Registry, as its designated goods and designated services. The Cited Trademark is still valid as of now.

#### 3 Judgment by the body

##### (1) Regarding the trademark in the Application

As shown in the Attachment, the trademark in the Application consists of a well and uniformly integrated configuration of an outline figure (hereinafter referred to

as the "figure portion") which resembles a dog facing toward the right on a black semi-ellipse background, and "OGGY" written in alphabetic characters to the right of the figure portion at about half the height of the figure portion.

With reference to the profile of the figure portion of the trademark in the Application, the upper and lower short portions of the arc slightly project to the left from a left vertical line and the overall profile has the same shape as that of the alphabetic character "D" in the so-called Serif fonts. The profile of the semi-ellipse in the figure portion has the characteristic (the outline picture that resembles a dog on the black background) in common with the hollow alphabet "D." Judging from the foregoing, it can be said that those who see the trademark in the Application would construe and understand that the figure portion of the trademark in the Application is a design of the alphabetic character "D."

In addition, it cannot be said that the alphabetic character portion, "OGGY," of the trademark in the Application is a word that has a specific meaning, but if the figure portion is placed at the beginning of the word, the trademark can be easily recognized as a whole as representing the characters "DOGGY" which mean "like or relating to dogs" (See *Genius English-Japanese Dictionary*, fifth edition, "*Taishukan Shoten*). Consequently, it can be said that the meaning is related to the picture which resembles a "dog" drawn in the figure portion.

In that case, judging from the integrity of the configuration and meaning of the trademark in the Application, the figure portion and the alphabetic character portion "OGGY" are understood and recognized as one piece. Consequently, it should be said that it is not natural to separately observe the figure portion and the alphabetic character portion of the configuration and that the portions are inseparably combined with each other.

Accordingly, the trademark in the Application is considered to consist of the alphabetic characters "DOGGY" with the design of the alphabetic character "D" and the constituent characters giving rise to the pronunciation of "dogii" and the meaning of "like or relating to dogs."

#### (2) Regarding the Cited Trademark

The Cited Trademark consists of two tiered character strings, where one is "DOGGY" written in alphabetic characters and the other is "ドギー (DOGGY)" written in *katakana*. The *katakana* characters in the lower tier can be easily understood to represent the pronunciation of the alphabetic characters in the upper tier. Accordingly, their respective constituent characters give rise to the pronunciation of "dogii" and the meaning of "like or relating to dogs."

#### (3) Regarding the similarity between the trademark in the Application and the Cited Trademark

When a comparison is made between the overall configurations of the trademark in the Application and the Cited Trademark, it is found that the two trademarks are different in appearance, since the trademark in the Application has a design of "D" in the character portion, but the other trademark does not. However, both the trademarks have the alphabetic characters "DOGGY," and due to this common feature, their appearances give similar impressions.

Additionally, the two trademarks have the same pronunciation "dogii" and the same meaning "like or relating to dogs."

In that case, it should be said that the trademark in the Application and the Cited Trademark are confusingly similar trademarks in terms of each of the following: appearance, pronunciation, and meaning.

(4) Regarding the similarity of the designated goods between the trademark in the Application and the Cited Trademark

Of the designated goods of the trademark in the Application, "Fences for pets; combs for pets; litter trays for pets; feeding vessels for pets; brushes for pets; bird cages; bird baths." of class 21 include the same designated goods of the Cited Trademark; i.e., "Chains for dogs." of class 6, "Clothing for domestic pets." of class 18, "Beds for household pets; dog kennels." of class 20, "Feeding vessels for pets; brushes for pets; chewing goods for pet dogs." of class 21, and "Toys for domestic pets." of class 28. Furthermore, in general, the other goods are also manufactured and sold respectively by the same business owners involved in the business of pet goods and their use and scope of consumers are also identical. Consequently, there is likelihood to cause confusion about the source of the respective goods and the both designated goods are considered to be similar to each other.

(5) Appellant's allegation

The appellant alleges that the trademark in the Application is not similar to the Cited Trademark and submitted Evidence A Nos. 1 to 6. However, as described below, none of his allegations can be accepted.

A The appellant presents the following allegations:

Since the degree of design of the figure portion of the trademark in the Application is significant, the figure portion of the trademark in the Application is not immediately associated with any particular object and does not perform the function of the character. In consequence, the figure portion of the trademark in the Application does not give rise to particular pronunciation or meaning. Since the outline silhouette of the four-footed animal on the black background is associated with "DOGGY," the pronunciation of the trademark in the Application should not be specified. The appellant cites precedent appeal decisions (A Nos. 1 to 6) that hold that a figure portion of a design of a character does not give rise to any pronunciation and alleges that a similar decision should also be made on the trademark in the Application. For the determination of the similarity between the trademarks, the trademark in the Application and the Cited Trademark should be compared on the premise that the essential part of the trademark in the Application is considered to be the character portion "OGGY."

However, the precedent appeal decisions used by the appellant are those (A Nos. 1 and 2) in which the degree of design is different from that of the trademark in the Application, those in which the overall configuration is found to consist of a kind of figure portion (A Nos. 3 and 6), or a monogram (A No. 4), and they are different in circumstances from the trademark in the Application.

As described above in (1), from the connection of the overall configuration and meaning, the trademark in the Application is easily understood as a connected integral trademark with a design of only the character "D" in the alphabetic characters "DOGGY." Accordingly, for the investigation of the similarity with the Cited Trademark, the figure portion and the character portion should not be observed separately, but the overall configuration should be observed.

B The appellant alleges that the alphabetic characters "DOGGY" and the *katakana* characters "ドギー(DOGGY)," both of which compose the Cited Trademark,

represent an English word which means a "puppy" and in the relationship with the designated goods, "DOGGY" and "ドギー(DOGGY)" are clearly descriptive and have no or extremely little function for distinguishing relevant goods from others.

However, the Cited Trademark is still valid as of now. Consequently, the reasons given by the appellant do not particularly preclude citation of the Cited Trademark and application of Article 4(1)(xi) of the Trademark Act. Moreover, the appellant has not submitted any specific evidence that supports his allegations.

(6) Summary

As described above, the trademark in the Application is a trademark similar to the Cited Trademark, and the designated goods of the trademark in the Application are the same as or similar to those of the Cited Trademark. Therefore, it falls under Article 4(1)(xi) of the Trademark Act, and the trademark in the Application shall not be registered.

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

February 20, 2018

Chief administrative judge: TANAKA, Kyoko  
Administrative judge: HIRASAWA, Yoshiyuki  
Administrative judge: ASO, Hiroki

Attachment (trademark in the Application)

**D** **OGGY**