

## Appeal decision

Appeal No. 2017-17053

Tokyo, Japan

Appellant

CAELUM Limited

Patent Attorney

KOBAYASHI, Katsuyuki

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2016-21294 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 1, and the application for its registration was filed on February 28, 2016 by setting the goods and services as described in the application which belong to Classes 9, 16, 35, 41, 42, and 45 as the designated goods and services.

The designated goods and services were amended in the original examination by written amendments submitted on September 13, 2016, April 27, 2017, and July 3, 2017 to Class 9, "Electronic publications." Class 16, "Magazines [publication]; books." Class 35, "Advertising using communication networks such as the Internet for sales promotion for goods, or promotion of providing services; other advertisings; organization and production of advertising; organization and conducting of sales promotion for goods or promotion of providing services using communication networks such as the Internet; providing information concerning sales promotion for goods or promotion of providing services using communication networks such as the Internet; management or operation of business concerning website operation; providing space for advertising on website on communication networks such as the Internet and providing information thereon." Class 41, "Providing on-line electronic magazines; providing on-line electronic publications through the Internet; providing electronic publications concerning fashion, movies, music, arts, makeup, blogs, photographs, games, models, and magazines; providing electronic publications; providing images and text data using

communication networks such as the Internet; publication of books; publication of electronic publications; arranging, conducting, and organization of seminars; organization, arranging, and conducting cultural performances (excluding those related to music) and events (excluding movies, shows, plays, and musical performances); organization, arranging, and conducting of fashion shows; educational and instruction services relating to arts, crafts, sports, or general knowledge." and Class 45, "Information relating to fashion coordination service of individuals using communication networks such as the Internet; information relating to fashion coordination service of individuals; marriage partner introduction or dating services; fortune-telling, non-therapeutic counselling services rendering to meet the needs of individuals."

## 2. Cited Trademark

The registered trademark cited in the reasons for refusal of the examiner's decision against the trademark in the Application, as the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act, the registered trademark No. 5413492 (hereinafter, referred to as "Cited Trademark"), is configured as indicated in Attachment 2, and the application for its registration was filed on September 10, 2010 and the trademark was registered on May 20, 2011 with designated services included in Class 35, including "Retail services or wholesale services for printed matter." which are as specified in the Trademark Registry.

## 3. Judgment by the body

### (1) Applicability of Article 4(1)(xi) of the Trademark Act

#### A Regarding the trademark in the Application

The trademark in the Application consists of slightly stylized Alphabetic characters "Violet" as indicated in Attachment 1, and the characters "Violet" are a well-known English word that has meanings "スミレ (sumire; violet), スミレ色 (sumireiro; pansy)" (TAISHUKAN Publishing Co., Ltd., "BASIC GENIUS English-Japanese Dictionary"), and the characters are also a French word that has a meaning "紫色の (murasakiirono; purple)" (Sanseido Co., Ltd., "CROWN DICTIONNAIRE FRANCAIS-JAPONAIS," 7th edition").

Therefore, if the Alphabetic characters, "Violet" are understood as an English word, the trademark in the Application has the pronunciation of "バイオレット (baioretto)" and the meanings of "スミレ (sumire; violet), and スミレ色 (sumireiro; pansy), and, if the Alphabetic characters "Violet" are understood as a French word, the

trademark in the Application has the pronunciation of "ヴィオレ(viore)" and the meaning of "紫色の (murasakiirono; purple).

#### B Regarding the Cited Trademark

As indicated in Attachment 2, Cited Trademark consists of a configuration in which "ヴィオレ(viore)" in katakana and the Alphabetic characters, "Violet" are written in vertical two strings of characters, and it is understood that "ヴィオレ(viore)" in katakana in the upper line expresses the pronunciation of the Alphabetic characters, "Violet" in the lower line.

Then, the Alphabetic characters, "Violet" in the lower line consist of a configuration written with apparently larger and thicker characters than "ヴィオレ(viore)" in katakana in the upper line, and it can be deemed that there are not a few cases in which traders and consumers who access Cited Trademark conduct the transaction while focusing attention on the characters "Violet" in the lower line.

In addition, if attention is focused on the characters "Violet," since "Violet" is a well-known English word that means "スミレ (sumire; violet), and スミレ色 (sumireiro; pansy)," if it is understood as an English word, it has the pronunciation of "バイオレット(baioretto)," and the meaning of "スミレ (sumire; violet), and スミレ色 (sumireiro; pansy)" as indicated in above A.

On the other hand, the characters, "Violet" are also a French word that means "紫色の (murasakiirono; purple" as indicated in above A, and, if it is understood as a French word, it has the pronunciation of "ヴィオレ(viore)," and the meaning of "紫色の (murasakiirono; purple).

#### C. Regarding similarity between the trademark in the Application and the Cited Trademark

Examining now similarity between the trademark in the Application and Cited Trademark, they consist of different configurations in their overall external appearances, but, as described in above A and B, they have the Alphabetic characters, "Violet" in common and are similar to each other.

Next, with respect to the pronunciation, since the trademark in the Application and Cited Trademark have the pronunciation of "バイオレット(baioretto)" and "ヴィオレ(viore)" in common, they have the same pronunciations.

Furthermore, with respect to the meaning, since the trademark in the Application and Cited Trademark have meanings of "スミレ (sumire; violet), and スミレ色 (sumireiro; pansy)" and "紫色の (murasakiirono; purple)," in common, they have the same meaning with each other.

Therefore, the trademark in the Application and Cited Trademark differ from

each other in their overall external appearances but they are similar to each other in common characters "Violet," and have the same pronunciations and meanings. Taking those comprehensively into consideration, they should be deemed similar trademarks.

D. Similarity of the designated goods of the trademark in the Application and the designated services of Cited Trademark

Class 9, "Electronic publications." and Class 16, "Magazines [publication]; books." are the same as or similar to "Printed matters" that are the goods to be handled in Class 35, "Retail services or wholesale services for printed matter." in the designated services of Cited Trademark.

In addition, it is normally observed in commercial transactions that the sale of goods and retail and/or wholesale services that treat the goods are carried out by the same person, and, in such case, it is reasonable that the place of sale and the range of consumers of the goods are the same as the place of providing services and the range of consumers of the service.

Therefore, if a same or similar trademark is used for "Electronic publications and magazines [publication]; books." in the designated goods of the trademark in the Application and "Retail services or wholesale services for printed matter." in the designated services of Cited Trademark, it should be deemed that there is a risk of misleading traders and consumers who assess the trademark to consider that the manufacture and sale of the goods and providing the service are conducted by a same person, and causing confusion concerning the origin.

In view of the above, the designated goods of the trademark in the Application and the designated services of Cited Trademark are similar to each other.

E. Summary

The trademark in the Application and Cited Trademark are similar trademarks that might cause confusion as described in C. and the designated goods of the trademark in the Application are similar to the designated services of Cited Trademark as described in D.

Accordingly, the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act.

(2) Appellant's allegation

A. Appellant alleges that "each magazine carries its specific title and has a publisher. For example, in case of the magazine issued by appellant called 'CYAN,' 'CYAN' is the title and 'CAELUM' is indicated as the publisher and the distribution source. Even if a trader or a consumer enters a bookshop or a website called 'CYAN' looking for magazine 'CYAN,' the trader or the consumer never considers that the bookshop issued

the magazine. Accordingly, it is considered that 'electronic publications, magazines, books' and 'retail services or wholesale services for printed matter' do not have any similarity."

However, even if the publisher is indicated on goods such as magazines, since it is normal practice that traders and consumers conduct transactions by recognizing title or trademark indicated on the goods as a sign for distinguishing from other goods, if a trademark that is the same as or similar to the trademark of the goods is used for retail and/or wholesale services that handle the goods, it is reasonable to consider that traders and consumers who assess such trademark might be misled that the manufacturer or the distribution source is same person as the retail service provider.

Accordingly, since "Electronic publications; magazines [publication]; books" included in the designated goods of the trademark in the Application and "Retail services or wholesale services for printed matter." included in the designated services of Cited Trademark are similar to each other, the Appellant's allegation cannot be accepted.

### (3) Summary

As described above, the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act, and cannot be registered.

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

May 11, 2018

Chief administrative judge:	IDE, Eiichiro
Administrative judge:	ENOMOTO, Masami
Administrative judge:	MANABE, Emi

Attachment 1 (Trademark in the Application)

**Violet**

Attachment 2 (Cited Trademark)

ヴィオレ  
**Violet**