

Decision on opposition

Opposition No. 2017-900179

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Decision on the opposition to the grant of the trademark registration No. 5929242 has resulted in the following decision.

Conclusion

With regard to the designated goods of the trademark registration No. 5929242, the registration of "Printed matter" in Class No. 16 shall be cancelled.

Reason

No. 1 The Trademark

The trademark with Trademark Registration No. 5929242 (referred to as "the Trademark" below) consists of standard characters of katakana of "チバニアン (Chibanian)". The application for its registration was filed on August 25, 2016, and the decision for registration was made on January 10, 2017. The trademark was registered on March 3, 2017 with designated goods of Class No. 16 "Paper and cardboard; stationery; printed matter; paintings and calligraphic works." and the designated goods of Classes No. 14 and No. 28 which are as specified in the Trademark Registry.

No. 2 The grounds of the opposition to registration

The opponent for opposition to the registration (referred to as "the opponent" below) asserted that, with regard to the designated goods of the Trademark, "Printed matter" in Class No. 16 should be invalidated under the provisions of Article 43-2(i) of the Trademark Act, because it falls under Article 3(1)(iii), Article 3(1)(vi), Article 4(1)(vii) of the Trademark Act and therefore summarized and mentioned reasons as follows, and submitted Evidence A No. 1 to A No. 57 (including their branch numbers) as means of evidence.

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

(1) Geological age and "Global Boundary Stratotype Section and Point"

The geological age indicates a time from when geological strata were formed in the earth to the present (Kojien, the sixth edition published by Iwanami Shoten). The most excellent and typical geological stratum for observation and research in the geological condition is selected as the "Global Boundary Stratotype Section and Point" (referred to as "GSSP" below).

(2) "Chiba section" as GSSP candidate section

As a GSSP candidate section, a geological stratum which has been found along a Yoro River in Ichihara-city, Chiba (referred to as "Chiba section" below) is suggested.

The research of "Chiba section" has been jointly developed by National Institute of Polar Research belonging to Inter-University Research Institute Corporation Research Organization of Information and Systems which is the opponent, Ibaraki University, Chiba University, National Museum of Nature and Science, Shimane University, Kobe University, National Institute of Advanced Industrial Science and Technology, Japan Agency for Marine-Earth Science and Technology, Tokyo Gakugei University, Natural History Museum and institute, Chiba, Lake Biwa Museum, Kyushu University, and Shinshu University (referred to as "joint research team" below). On June 7, 2017, the joint research team submitted an application regarding "Chiba section" in the advisory commission of the International Union of Geological Sciences (IUGS) (Evidence A No. 2 and A No. 4).

(3) History of naming of "チバニアン(Chibanian)"

When a section is selected as the GSSP, the geological time division is named in Latin, and the official name of the "Chiba section" is determined as "チバニアン(Chibanian)" by the joint research team (Evidence A No. 5 and A No. 7), and the official name has been familiar in the world.

(4) Distinctiveness of "チバニアン(Chibanian)"

According to the above, it is obvious that consumers only recognize that "the printed matter relates to Chibanian" even when the characters of "チバニアン(Chibanian)" are attached on the printed matter and the characters only make the consumers recognize the content of the work. Therefore, it should be said that the characters of "Chibanian" do not have a function for distinguishing relevant products from others as the one indicating the quality of the product and the like.

(5) Exclusive adaptivity of "チバニアン(Chibanian)"

When "チバニアン(Chibanian)" is selected as the GSSP, researchers around the world write about "チバニアン(Chibanian)". Particularly, it is inferred that the description of "チバニアン(Chibanian)" often appears in the literatures written in Japanese.

Therefore, it should be said that the Trademark does not have the exclusive

adaptivity regarding the designated goods of "Printed matter".

#### (6) Summary

According to the above, with regard to the designated goods of "Printed matter", the Trademark falls under the Article 3(1)(iii) of the Trademark Act.

#### 2 Regarding Article 3(1)(vi) of the Trademark Act

As described above, the Trademark does not have the exclusive adaptivity. If journals have to be published while considering a risk of infringement of trademark right regarding whether to use the word of "チバニアン(Chibanian)" in the title or to describe the word of "チバニアン(Chibanian)" in the content, it can be easily imagined that this extremely preventing fair trade.

Therefore, even when the Trademark does not fall under Article 3(1)(iii) of the Trademark Act with regard to the designated goods of "journals", the Trademark falls under Article 3(1)(vi) of the same Act.

#### 3 Regarding Article 4(1)(vii) of the Trademark Act

In consideration of the timing of the registration application of the Trademark, it can be easily assumed that the application is made for the purpose of monopolization of the profit by applying and registering the word of "チバニアン(Chibanian)", which was mentioned in the news, in advance.

Regarding the designated goods of "Printed matter", due to the monopolization of the word of "チバニアン(Chibanian)" by a private person, a person who publishes journals and academic journals regarding "チバニアン(Chibanian)" needs to publish the journals while considering whether this is commercial use of the word of "チバニアン(Chibanian)" or this infringes the trademark right of the Trademark.

The process of the registration application of the Trademark which has been made for the purpose of the monopolization of the profit by a single person regarding the word mentioned in the news and the like in advance lacks social appropriateness. In view of the public interest of the word included in the Trademark, it can be said that approval of its registration violates the order intended by the Trademark Act and cannot be accepted.

Therefore, since it should be said that the Trademark disturbs fair competitive order and violates the public order and morality, the Trademark falls under Article 4(1)(vii) of the Trademark Act.

#### No. 3 Reasons for rescission by the body

The content of the reasons for rescission notified on August 25, 2017 to the holder of trademark right by the body is summarized as follows.

The Trademark consists of the standard characters of katakana of "チバニアン(Chibanian)". In a case where the Trademark is used for "Printed matter" in Class No. 16 by the holder of trademark right, traders and consumers who see it may falsely recognize as a book and a literature regarding the Chiba section (Global Boundary Stratotype Section and Point) made by public institutions. In addition, this may disturb the order of business transaction and violates public benefit, and it should be said that this may contravene to public order.

Therefore, the Trademark falls under Article 4(1)(vii) of the Trademark Act regarding the designated goods of "Printed matter" in Class No. 16.

#### No. 4 Opinion of the holder of the Trademark

Although the chief administrative judge notified Reasons for rescission in No. 3 and gave a chance to submit the written opinion within a designated period, the holder of the Trademark has submitted no opinion.

#### No. 5 Judgment by the body

1 According to the evidence and reasons submitted by the opponent, the following facts can be acknowledged.

(1) The opponent is an Inter-University Research Institute Corporations, and national universities, national museum and institutes and prefectural museums including National Institute of Polar Research belonging to the opponent (joint research team) have developed the research on the geological stratum which was found along Yoro River in Ichihara-city, Chiba (Chiba section), Chiba section is the geological stratum which indicates the final geomagnetic reversal occurred in the earth about 770000 years ago, this is defined as "チバニアン(Chibanian)" which means "Chiba era", Chiba section is a candidate of "Global Boundary Stratotype Section and Point (GSSP)" as a geological stratum representing a boundary between geological ages, and the application was made to International Union of Geological Sciences on June 7, 2017 (Evidence A No. 2, A No. 4, A No. 7 to A No. 55).

(2) Although the name of "チバニアン(Chibanian)" is a Latin word of "Chiba era", the name of "チバニアン(Chibanian)" is a coined word which was selected from among a plurality of candidates by National Institute of Polar Research which is a member of the joint research team (Evidence A No. 5).

(3) In a case where "Chiba section" is approved as the GSSP by International Union of Geological Sciences, "Chiba section" may be named as "チバニアン(Chibanian)" and may be an academic term which specifies a single era of the geological age (Evidence A No. 2, A No. 4, and A No. 7 to A No. 55).

(4) From October 16, 2015 to the time of the registration application of the Trademark, the facts of (1) and (3) were reported in national newspapers and local newspapers (Evidence A No. 7 to A No. 10, A No. 15 to A No. 19, A No. 23, A No. 24, A No. 33 to A No. 40, A No. 42, A No. 45, and A No. 46) and NHK news on March 28, 2016 (Evidence A No. 28 to A No. 31), were introduced in the websites (Evidence A No. 12 to A No. 14, A No. 20 to A No. 22, A No. 25 to A No. 27, A No. 47, and A No. 48), and were mentioned in the dictionaries on the websites as a current-events term (Evidence A No. 32 and A No. 41). Accordingly, the characters of "チバニアン(Chibanian)" have been generally recognized as the name of "Chiba section" in some degree in Japan.

(5) The registration of the Trademark was filed on August 25, 2016, after the news report in (4), by the holder of the Trademark.

#### 2 Applicability of Article 4(1)(vii) of the Trademark Act

The Trademark consists of the standard characters of katakana of "チバニアン(Chibanian)" as described in No. 1, and the characters which indicate the name of "Chiba section" are a coined word made by the joint research team as described in 1(2). As described in 1(4), before the registration application of the Trademark, many news reports have been made that "Chiba section" was applied to the international institution as a candidate of the geological stratum representing the boundary between the geological ages (Global Boundary Stratotype Section and Point (GSSP)). Therefore, it

can be acknowledged that the facts of 1(1) and (3) have been widely known in general.

"Chiba section" which is the name of "チバニアン(Chibanian)" is applied to the international institute as a candidate of the GSSP by the joint research team including public institutions such as national universities and national museums and institutions and has high public interest. In a case where it is assumed that the word of "チバニアン(Chibanian)" which is the name of "Chiba section" be an academic term for specifying a single era of the geological age in a case where "Chiba section" is approved as the GSSP to the international institutions.

Then, in a case where the holder of the Trademark uses the Trademark for "Printed matter" in Class No. 16, traders and consumers who see it may falsely recognize as a book and a literature regarding the Chiba section (GSSP) made by the joint research team which is the public institution. In addition, this may disturb the order of business transaction and violates public benefit, and it being likely to cause damage to public order.

Therefore, with regard to "Printed matter" in Class No. 16, the Trademark falls under Article 4(1)(vii) of the Trademark Act.

### 3 Closing

As described above, with regard to the designated goods of "Printed matter", the Trademark was registered while violating Article 4(1)(vii) of the Trademark Act. Therefore, the registration of the Trademark should be cancelled under the provision of Article 43(3)(ii) of the same Act without examining other grounds of the opposition to registration.

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

November 1, 2017

Chief administrative judge: TANAKA, Kyoko  
Administrative judge: HAYAKAWA, Fumihiro  
Administrative judge: HIRASAWA, Yoshiyuki