

## Appeal decision

Appeal No. 2018-570

Osaka, Japan

Appellant

DAINIHON JOCHUGIKU CO. LTD.

Patent Attorney

Hanabusa Patent & Trademark Office

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2015-30320 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 has a configuration as indicated in the Attachment and sets the goods in Class 5 described in the application as designated goods. The registration application of the trademark in the Application was filed on April 1, 2015 as a sound trademark, and subsequently, the designated goods of the present application were corrected to Class 5 "Mosquito-repellent incenses" by a written amendment dated March 11, 2016 in the original examination.

#### 2 Gist of reasons for refusal stated in the Examiner's Decision

The Examiner's Decision acknowledged and determined that "the trademark in the Application has the configuration as indicated in the Attachment. Since various sounds are generally used in actual practice to enhance attractiveness of the product, to attract consumers' attention in advertisements and the like, to impress the consumers, or as sound effects, it is acknowledged that the consumer only recognizes the trademark in the Application as a kind of sound used to enhance the attractiveness of the product or as a presentation effect of the advertisement, not as a mark for distinguishing relevant products from others. Furthermore, in consideration of the usage condition of the trademark in the Application by the applicant, when sounds that are estimated as the same sound as in the trademark in the Application are used, the sounds are used together with a video of set fireworks having shapes of characters of "金鳥 (Kincho)" or "KINCHO" subsequent to a voice saying "金鳥の夏、日本の夏 (Kincho no natsu, nihon no natsu)". Therefore, even though the trademark in the Application has been used as described above, it cannot be said that the consumer immediately recognizes the trademark in the Application that does not include the sound recognized as "金鳥の夏、日本の夏 (Kincho no natsu, nihon no natsu)", "金鳥 (Kincho)", or "KINCHO" (lyrics and narration) as indicating goods relating to the business of the applicant. Therefore, even in consideration of the usage condition of the sounds estimated as the same sounds as in the trademark in the Application, it cannot be said that as a result of the use of the trademark in the Application, consumers recognize the goods as those pertaining to a business of a particular person. Accordingly, the trademark in the Application falls under Article 3(1)(vi) of the Trademark Act," and refused the present application.

### 3 Judgment by the body

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

A As indicated in the Attachment, the trademark in the Application has a configuration in which the sounds of the set fireworks are continuously heard as "pan, para, para, para" and is a sound trademark whose entire length is three seconds. The designated goods of the trademark in the Application are Class 5 "Mosquito-repellent incenses".

In advertisements of products through TV, radio, the Internet, or the like, various kinds of sounds including sound similar to the sounds of the set fireworks in the trademark in the Application are widely used in general to aurally appeal the attractiveness of the product and attract the attention of consumers. Therefore, for example, except for a case where the sound consists of words and the like that serve as a mark for distinguishing relevant products from others or a case where the sound includes such words, it is reasonable to understand that the sound is not normally heard and recognized as indicating the source of the goods or a mark for distinguishing relevant products from others. No reason is found in the circumstances in the industry dealing in the designated goods of the present application "mosquito-repellent incenses" that are different from the above circumstances.

In addition, as described above, the trademark in the Application is a sound trademark in which the sounds of the set fireworks are continuously heard as "pan, para, para, para". The sounds are only heard as the sounds of the set fireworks that are one of the sounds widely used in general, and the sounds themselves do not consist of words and the like that serve as a mark for distinguishing relevant products from others and do not include such words.

Then, even when the trademark in the Application is used for its designated goods, it should be said that consumers coming into contact with the trademark only hear and grasp the trademark as one kind of the sounds of the set fireworks widely used in general in advertisement of the product and the like and do not recognize the sounds as indicating the goods relating to the business of a specific person (Appellant).

Therefore, the trademark in the Application is a trademark by which consumers are not able to recognize the goods as those pertaining to a business of a particular person.

B The Appellant alleges that, as a result of an active effort in advertising so as to attract the consumers by videos and sounds such as TV commercials and radio commercials since 1965, "the sounds of set fireworks that are continuously heard as "pan, para, para, para" in the trademark in the Application subsequent to the voice saying "金鳥の夏、日本の夏 (Kincho no natsu, nihon no natsu)"" are heard and recognized independently from the sentence and the voice of "金鳥の夏、日本の夏 (Kincho no natsu, nihon no natsu)", and therefore, traders and consumers coming into contact with the trademark in the Application can recognize the trademark in the Application as the sound heard in the commercial of "mosquito-repellent incenses" of the Appellant; that is, can recognize that the trademark in the Application indicates the goods relating to the business of the Appellant. The Appellant submitted Evidence A No. 1 to A No. 22 as evidences supporting this allegation.

Therefore, the allegation of the Appellant and the evidences submitted by the Appellant will be examined as follows.

(A) The Appellant is a company established in 1919 whose main business is "the manufacture and sale of household insecticides, insect repellents for cloths, household cleaning agents, and insecticides for epidemic prevention". The typical product "mosquito-repellent incense" is sold throughout Japan, and it is found that its annual sales from 2015 to 2017 stayed at around ten billion yen (Evidence A No. 1 and A No. 2).

Furthermore, in the market of the "mosquito-repellent incense", it is found that the percentage (market share) of the products manufactured and sold by the Appellant stayed at around 76% from 1987 to 1994 and stayed at around 80% from 1996 to 2003 (Evidence A No. 7 to A No. 22).

(B) It is found that the Appellant produced TV commercials using actors, singers, and the like regarding the product "mosquito-repellent incense" every year at least from 1969 to 2017 and broadcasted the commercials throughout Japan approximately from May to August according to a period in which the product is in demand. However, only a part of the TV commercials has specific content that is obvious, and details of the region, the date, and the number of times of the broadcasting of the TV commercials are not obvious (Evidence A No. 3 and A No. 5).

Furthermore, it is acknowledged that the "mosquito-repellent incense" is displayed in the TV commercials whose specific content is obvious from among the TV commercials (1970, 1971, 1976, 1987, 1988, 1991, 1994, 2000, 2003, 2004, 2006, 2008, 2010, and 2012 to 2017). In addition, it is acknowledged that the set fireworks having the shape of the characters of "金鳥 (Kincho)" or "KINCHO" are displayed after the voice saying "金鳥の夏、日本の夏 (Kincho no natsu, nihon no natsu)" in the final part of the TV commercial (however, display appears at the same time the as voice in TV commercials broadcasted in 1970 and 1971) and a sound that can be recognized as the same as the sound configuring the trademark in the Application (hereinafter referred to as "the firework sound of the case") is emitted in association with the video of the set fireworks. However, from the fact that the firework sound of the case is only emitted in association with the video of the set fireworks, it is reasonable to understand that the audience of the TV commercial hears, recognizes, and remembers the firework sound of the case as sound emitted when the set fireworks ignite; that is, sound in association with the video of the set fireworks.

The Appellant alleges that the radio commercials have been broadcasted for a long time similarly to the TV commercials. However, according to the evidences submitted by the Appellant, the specific content of the radio commercial is not obvious, and details of the region, the date, and the number of times of broadcasting of the radio commercials are not obvious.

(C) The Appellant alleges that a huge number of advertisements regarding the product "mosquito-repellent incense" have been made for a long time not only in the TV commercials and radio commercials but also in newspapers, magazines, and posters. However, these advertisements are normally made by using paper as a medium, and it cannot be assumed that the firework sound of the case is used in the above advertisements. Even if Evidence A No. 4 submitted by the Appellant as the evidence regarding the above allegation was considered, no fact that is sufficient to reverse the above is found.

(D) According to (A) to (C) above, the "mosquito-repellent incense" manufactured and sold by the Appellant has held a large share in the product field for a

long time. In addition, it is estimated and acknowledged that the Appellant produced the TV commercials using the firework sound of the case every year at least from 1969 to 2017 regarding the "mosquito-repellent incense" and broadcasted the TV commercials throughout Japan, although the period is substantially limited to the summer.

However, the firework sound of the case is only used in a form that is heard, recognized, and remembered by the audience as the sound associated with the video of the set fireworks having the shapes of the characters of "金鳥 (Kincho)" or "KINCHO" that are displayed in the final part of the TV commercial. Therefore, it is hard to say that the firework sound itself of the case is recognized by the consumers as indicating the source of the goods or a mark for distinguishing relevant products from others according to broadcasting of the TV commercials.

Moreover, in comprehensive consideration of the allegation of the Appellant and the respective items of Evidence A submitted by the Appellant, a fact cannot be found that is sufficient to acknowledge that the firework sound of the case is recognized by consumers as indicating the goods relating to the business of the Appellant as a result of the use of the firework sound of the case.

(2) Summary

According to the above, the trademark in the Application is a trademark by which consumers are not able to recognize the goods as those pertaining to a business of a particular person and falls under Article 3(1)(vi) of the Trademark Act. Accordingly, the trademark in the Application cannot be registered.

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

December 17, 2018

Chief administrative judge: KANEKO, Naohito  
Administrative judge: TANAKA, Takanori  
Administrative judge: ISHIZUKA, Rie

Attachment

The trademark in the Application

(1) trademark for which registration is sought

本商標は、仕掛け花火の音が「パン、パラ、パラ、パラ」と連続して聞こえる構成からなり、全体で3秒の長さである。

本商標は、仕掛け花火の音が「パン、パラ、パラ、パラ」と連続して聞こえる構成からなり、全体で3秒の長さである。 This trademark has a configuration in which the sounds of the set fireworks are continuously heard as "pan, para, para, para", and the entire length of the trademark is three seconds.

(2) Evidence in accordance with Article 4-8(3) of the Regulations under the Trademark Act under the provisions of Article 5(4) of the Trademark Act according to the trademark in the Application

As in the optical disk submitted with Supplemental statement of proceedings dated April 1, 2015