Appeal decision

Appeal No. 2018-7967

Appellant Haworthia Society of Japan

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2016-143501 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 consists of standard characters of "粉雪 (Konayuki; powder snow)", and the application for its registration was filed on December 22, 2016 by setting goods, described in the application, belonging to Class 31 as the designated goods.

Thereafter, the designated goods in the application were amended to Class 31 "Haworthia, seedlings of Haworthia, and seeds of Haworthia." by a written amendment submitted on December 28, 2017 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 is similar to "コナユキ (Konayuki; powder snow)" (variety registration No. 21865) registered as a variety name of "Solanum tuberosum L." (Solanum tuberosum) based on the Plant Variety Protection and Seed Act and used for goods similar to propagating material of the variety. Therefore, the trademark in the Application falls under Article 4(1)(xiv) of the Trademark Act" and refused the present application.

3 Judgment by the body

(1) Regarding the trademark in the Application

As described in 1, the trademark in the Application consists of the standard characters of "粉雪 (Konayuki; powder snow)". The characters are familiarly known as a word having the meaning of "fine loose snow in the form of powder" ("Kojien 6th edition" (Iwanami Shoten, Publishers)). Therefore, the trademark in the Application

gives rise to the pronunciation of "konayuki" according to the constituent characters and has meaning of "fine loose snow in the form of powder".

(2) Regarding cited mark

A The name of the variety that has been registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act and cited in the reasons for refusal of the present application in the original examination consists of the characters of "コナユキ (Konayuki; powder snow)" and the variety was registered (hereinafter, referred to as "cited mark") as variety registration No. 21865 on July 26, 2012 as the variety name of "Solanum tuberosum L.".

B As described above, the cited mark consists of the characters of "コナユキ (Konayuki; powder snow)", and it can be said that the characters are perceived and understood as the word "粉雪 (Konayuki; powder snow)", written in Katakana, that is familiarly known as the word having the meaning of "fine loose snow in the form of powder". Therefore, the cited mark gives rise to the pronunciation of "konayuki" and has the meaning of "fine loose snow in the form of powder" according to the constituent characters.

(3) Similarity between the trademark in the Application and cited mark

When similarity between the trademark in the Application and the cited mark is examined, the marks written in Chinese characters and Katakana are different in the appearances. However, both marks give rise to the same pronunciation of "konayuki" and have the same meaning of "fine loose snow in the form of powder". Taking these into account generally, it should be said that the trademark in the Application and the cited mark are similar trademarks which may be confused with each other.

(4) Regarding similarity between the designated goods of the present application and the propagating material of the variety that has been registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act

The Plant Variety and Seed Act provides, "The purpose of this Act is to promote the breeding of plant varieties and the rational distribution of propagating material by providing for a system relating to the registration of plant varieties for the protection of new plant varieties and regulations relating to the indication of designated seeds, so as to contribute to the development of agriculture, forestry and fisheries." (refer to Article 1 of the Plant Variety Protection and Seed Act). On the other hand, the Trademark Act provides, "The purpose of this Act is, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and to protect the interests of consumers." (refer to Article 1 of the Trademark Act).

In this way, the Plant Variety Protection and Seed Act is a law established to protect a developer of a new variety of agricultural products and garden plants. On the other hand, the Trademark Act is a law established, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks, thereby to contribute to the development of industry and to protect the interests of consumers. It can be said that the name of the variety in the Plant Variety Protection and Seed Act and the trademark in the Trademark Act have different ranges to be protected. Similar range of the variety is the prohibitive right of the name of the variety in the Plant Variety Protection and Seed Act. Whereas, similar range of the goods or the services is the prohibitive right in the Trademark Act.

Incidentally, the application for registration of the trademark in the Application was filed as a trademark. Therefore, it is to be understood that whether or not the trademark can be registered is determined based on the Trademark Act.

Then, the designated goods of the present application are Class 31 "Haworthia, seedlings of Haworthia, and seeds of Haworthia.". In the annexed table of the Ordinance for Enforcement of the Trademark Act, "12 seeds and bulbs" and "13 trees, grasses [plants], turf, natural, dried flowers, seedlings, saplings, flowers [natural], pasture grass, and potted dwarfed trees [Bonsai]" are exemplified as the goods belonging to Class 31. The designated goods of the present application are goods that fall in the category of "seeds and bulbs" and "trees, grasses [plants], turf, natural, dried flowers, seedlings, saplings, flowers [natural], pasture grass, and potted dwarfed trees [Bonsai]" exemplified in the annexed table. Furthermore, the term "propagating material" means "entire plants or parts of plants used for propagation" (Article 2(3) of the Plant Variety Protection and Seed Act). Therefore, it can be said that the goods that fall in the category of the goods exemplified in the annexed table fall in the form. This is similarly applied to the propagating material of "Solanum tuberosum L." that is the variety registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act.

Therefore, it should be said that the designated goods of the present application are similar to the propagating material of the variety registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act.

(5) Summary

As described in (3) and (4) above, because the trademark in the Application is a trademark similar to the name of the variety registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act and is used for goods similar to the seeds and seedlings of that variety, the trademark in the Application

falls under Article 4(1)(xiv) of the Trademark Act.

(6) Appellant's allegation

A The application of Article 4(1)(xiv) of the Trademark Act is limited to the seeds and seedlings of the variety registered or goods similar to the seeds and seedlings in the later stage. However, it is clear that the expression "similar goods" here means the "similar seeds and seedlings" on the basis of the expressions immediately after the word "goods similar to". The application targets are limited in the Law because it is assumed that a target which is not excluded from the application exists. The application is limited to the "similar goods" because the law assumes that there are "non-similar goods (seeds and seedlings)". It is natural to interpret that this indicates "the seeds and seedlings that have the same name and belong to different genus and have no likelihood to cause a risk of confusion". The appellant alleges that the Examiner's decision such that all the seeds and seedlings that have the same or similar name to the registered variety and are sold in the same shop are similar goods and cannot be registered is based on erroneous interpretation of Article 4(1)(xiv) of the Trademark Act.

However, it is natural to interpret that the "goods similar thereto" in the "seeds and seedlings of the variety or goods or services similar thereto" as provided in Article 4(1)(xiv) of the Trademark Act as "goods similar to the seeds and seedlings", and there is no reason to interpret the "goods similar thereto" as the "similar seeds and seedlings" as alleged by the appellant. It cannot be said that the appellant's allegation is reasonable on that premise, and the appellant's allegation cannot be accepted.

B The appellant alleges that, since the variety that may be confused with the registered variety is registered as a variety according to the definition of similarity by the Examiner and similarity is synonymous with confusion (possibility thereof), completely opposite provisions in different acts with respect to the same target cause a major contradiction in the legal system in one country using the same language.

However, the Plant Variety Protection and Seed Act and the Trademark Act respectively have ranges to be protected depending on the purposes of acts. The similarity of the goods or the services in the Trademark Act should be determined according to whether or not traders and consumers wrongly recognize and confuse the source of the goods or the services, by comprehensively considering the actual trade condition. Then, as described in (4), the trademark in the Application is determined on the basis of the Trademark Act, and the designated goods of the present application and the propagating material of the variety registered in accordance with the provisions of Article 18(1) of the Plant Variety Protection and Seed Act are similar to each other. Therefore, when the trademark in the Application is used for its designated goods,

traders and consumers may wrongly recognize and confuse the source of the goods with the source of the cited mark.

Therefore, the appellant's allegation cannot be accepted.

(7) Summary

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

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

July 24, 2019

Chief administrative judge: KANEKO, Naohito

Administrative judge: KOMATSU, Satomi

Administrative judge: ARIMIZU, Reiko