

Appeal Decision

Appeal No. 2017-8819

Appellant GUNZE LIMITED

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The case of appeal against the examiner's decision of refusal of Trademark Application No. 2014-99711 has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reason

No. 1 The mark in the application

The mark in the application, as indicated in Attachment, consists of characters of "Tuche" (in the configuration, an acute accent is written above the character "e", the same will apply hereinafter) in horizontal writing, and the application for its registration was filed on November 26, 2014 by setting the goods and services as described in the application which belong to Class 5, Class 18, Class 24, and Class 35 as the designated goods and the designated services, as a defensive mark of Trademark Registration No. 45009260 (hereinafter referred to as "the original registered trademark"). Thereafter, the designated goods and the designated services of the present application were finally corrected to Class 5 "Sanitary panties; sanitary shorts," based on the written amendment dated March 24, 2015 in the examination process and the written amendment dated on June 16, 2017 in the appeal process.

No. 2 The original registered trademark

The original registered trademark has the same configuration as the mark in the application indicated in Attachment, and the application for its registration was filed on July 15, 1999, the trademark was registered on September 28, 2001 with designated goods of Class 25 "Clothing; footwear; clothes for sports; special footwear for sports." After that, the renewal of duration of the trademark right was registered on April 26, 2011, and the trademark right is still valid as of now.

No. 3 Reasons for refusal stated in the examiner's decision

The examiner's decision recognized and determined that "it is not recognized that the mark in the application has been widely recognized among consumers to the extent that if another person uses it for the designated goods and services of the present application, it may cause confusion about the sources of the goods and the services. Therefore, the mark in the application does not fulfill the requirement stipulated in Article 64 of the Trademark Act," and rejected the present application.

No. 4 Inquiry by the body

In the body, the chief administrative judge, in the inquiry dated September 4, 2018, gave the Appellant a tentative opinion that "by the evidence submitted, it is not possible to estimate how well the original registered trademark is known as an indication of the designated goods, so that it is not recognized that the original registered trademark has come to be widely recognized among consumers as an indication of designated goods relating to the business of the Appellant," and required a response to this within a designated period.

No. 5 Response to inquiry from the Appellant

The Appellant, in response to the inquiry described in No. 4 above, submitted the written reply dated October 22, 2018 and the written statement dated February 13, 2019, summarized and alleged as follows, and submitted Evidence No. 12 to Evidence No. 22 (including branch numbers).

1 A product catalog (Evidence No. 1-1 to Evidence No. 1-56, Evidence No. 1-58, and Evidence No. 1-59) is a catalog selecting products to be handled at the store, and its distribution destination is a person in charge of a mass retailer, a department store, a specialty store, a wholesaler, a sales agent, etc. that handles products relating to the business of the Appellant.

Further, the Appellant submitted a similar catalog created after 2015 and indicated the circulation of the catalog (Evidence No. 13-1 to Evidence No. 13-13, and Appendix 1 of Evidence No. 14).

2 Among the goods relating to the use of the original registered trademark, products with particularly high sales are stockings, women's socks (socks and tights for ladies), and women's underwear (underwear for ladies, lingerie), and the Appellant has a high market share for stockings and women's socks (socks and tights for ladies) (Appendix 2 and Appendix 3 of Evidence No. 14).

3 Various products relating to the use of the original registered trademark are sold

at stores such as mass retailers, department stores, specialty stores, etc., as well as through catalog mail order and online shopping. Stockings, and most of clothing for ladies such as stockings, women's socks, and women's underwear are sold at stores such as major mass retailers, department stores, and small retail stores nationwide (Appendix 4 of Evidence No. 14).

Further, although the number of catalogs issued for catalog mail order is as described in Appendix 5 of Evidence No. 14, with regard to online shopping, it is difficult to provide evidence to support specific distribution facts, because products are sold directly to general consumers.

4 Advertising expenses for each product group after 2013 are as described in Appendix 6 of Evidence No. 14, and the increase in the amount of innerwear (women's underwear) is due to sales being on the rise due to the introduction of new products.

Further, although regarding the advertising materials relating to Evidence No. 5 to Evidence No. 8, it is difficult to confirm the details due to the period being old, it can be fully proved by the questionnaire result of Evidence No. 12 that such advertising activities have made the brand relating to the original registered trademark very well known among general consumers, and the details of the content of the advertisement are not an essential element of the prominence proof of the original registered trademark.

5 The Appellant newly submits Evidence No. 15 to Evidence A No. 18 as evidence supporting the allegation in 2 above. According to these, it can be seen that the brand relating to the original registered trademark is one of the core brands of the Appellant.

Also, the Appellant newly submits Evidence No. 19 to Evidence No. 21 as evidence supporting that various products of the brand relating to the original registered trademark are sold all over Japan, with respect to the allegation in 3 above.

Furthermore, the Appellant newly submits Evidence No. 22 as evidence indicating the content of the recent advertisement, with respect to the allegation in 4 above.

No. 6 Judgment by the body

1 Regarding requirement for defensive mark registration (Article 64(1) of Trademark Act)

Article 64(1) of the Trademark Act relating to the defensive mark registration system stipulates that "Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection

with services other than those similar to the designated goods is likely to cause confusion between said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists". Regarding the stipulation, it is determined that "Where the original registered trademark has become well known among consumers, even the use of the original registered trademark by a third party in dissimilar product or services to which the intrinsic effects of a trademark right (Articles 36 and 37 of the Trademark Act) does not extend is likely to cause confusion about the source, and thus the capability to distinguish the source and/or trust may be insured. Therefore, the stipulation in the Article in question is provided for the purpose of preventing such a confusion in a broad sense so as to extend the effect of the trademark which is 'well known among consumers' with respect to dissimilar products or services. Then, with regard to the defensive mark registration, it should be understood as 1. unlike regular Trademark registrations, Articles 3 and 4 of the Trademark Act are not included in the reasons for rejection; 2. rescission shall not be made for the reason of no-use; and 3. the effect thereof is extended compared to that of regular trademark registration, and thus is likely to restrict selection and use of Trademark by a third party, it should be understood that the requirement of 'registered trademark ... is well known among consumers' which is stipulated in Article 64(1) of the Trademark Act does not mean that the only requirement is the registered trademark in question being well known, but means that, even in the case where goods or services are dissimilar, the capability to distinguish the source is provided to the extent that confusion about the source of goods is caused; i.e., prominence which leads to such an extent is possessed" (2009 (Gyo-Ke) 10189 by Intellectual Property High Court, rendition of decision on February 25, 2010)

2 Regarding whether or not the mark in the application fulfills the requirement stipulated in Article 64(1) of the Trademark Act.

(1) Similarity of the mark in the application and the original registered trademark and similarity of the Appellant and the holder of trademark right of the original registered trademark

As described in No. 1 and No. 2 above, the mark in the application is configured by the constitution identical with that of the original registered trademark.

Further, it is recognized that the Appellant and the holder of trademark right of the original registered trademark are identical, in light of the description of the application in the application relating to the mark in the application and the description of the holder of trademark right in the Trademark Registry relating to the original registered trademark.

(2) Regarding whether or not the original registered trademark is widely recognized among consumers as representing the designated goods relating to the business of the Appellant

The Appellant alleges that the mark in the application fulfills the requirement stipulated in Article 64(1) of the Trademark Act, and submitted Evidence No. 1 to Evidence No. 22 (including branch numbers) as means of proof. (In the appeal decision, hereinafter, Evidence No. 1 to Evidence No. 22 (including branch numbers) are sequentially replaced with Evidence A No. 1 to Evidence A No. 22 (including branch numbers). Also, when citing all branch numbers, it is described while omitting the branch numbers.).

Then, the Appellant's allegation and respective items of Evidence A submitted by the Appellant will be examined as follows.

In the respective items of Evidence A relating to the submission of the Appellant, although there are those having different typefaces and those that omit the acute accent when compared with the original registered trademark, among these, those that can be recognized as substantially the same as the original registered trademark from the contents shall be treated as the original registered trademark in the following examination.

A Start of period of use of the original registered trademark and products relating to use thereof

The Appellant started using the original registered trademark for the products "women's socks" and "tights" relating to its own business in 2000, and in the following year, 2001, started using the products "stockings" relating to its own business (Evidence A No. 1-1 to Evidence A No. 1-3, Evidence A No. 9-1, Evidence A No. 9-2, and Evidence A No. 9-7).

Then, the Appellant has gradually expanded the products relating to the use of the original registered trademark to, for example, women's underwear, room wear, hats, neck warmers, etc., and in June 2017, it seems to have been expanded to inner wear (camisoles, tank tops, short sleeves, long sleeves), brassieres, shorts, stockings, tights, leg items (leggings pants, leggings, stirrup pants, garters, foot covers, socks) and wear (room wear, outer). In addition, at least for stockings and socks, the use of the mark can be seen around the fall and winter of 2017 and around the spring and summer of 2018 (Evidence A No. 1-4 to Evidence A No. 1-56, Evidence A No. 58, Evidence A No. 59, Evidence A No. 3, Evidence A No. 4, Evidence A No. 9-4, Evidence A No. 9-11, Evidence A No. 9-12, Evidence A No. 11, and Evidence A No. 13).

B Situation such as sales of the products relating to the used of the original registered trademark

(A) Store sales

a Evidence A No. 6-1 to Evidence A No. 6-8 are photographs of special sales floors set up in department stores, shopping centers, and supermarkets nationwide. Among them, in Evidence A No. 6-1 to Evidence A No. 6-7, under the descriptions of "HEIWADO AP Takatsuki store," "Daiei Shoppers Fukuoka store," "MYCAL Hiroshima SATY store," "Fukudaya Department Store Utsunomiya," and "Trimp AMO'S STYLE Spain zaka store" (2004), "Orion Keihan Mall Store" (2005), "YOSHIZUYA Meisei Store" (2006), photographs of stockings or tights displayed with a sign displaying the original registered trademark are posted, respectively, and in Evidence A No. 6-8, under the description of "Peacock Senri-chuo Store" (2014), a photograph of the sales floor of some product is posted. However, for all of them, there was no evidence to specifically support that the sales floor was set up at the time and store described, and for Evidence A No. 6-8, it is also unknown what kind of product relating to what kind of mark was handled on the sales floor.

b Appendix 4 of Evidence A No. 14 is a list of "sales results by route" from 2010 to 2017 , and according to the list, at least for each of "innerwear" and "legwear," it can be seen that sales were made at "mass retailers," "department stores," and "specialty stores" during the above period. However, details such as the specific locations of those stores and the number of stores are not clear, and regarding the "innerwear" and "legwear" relating to the sales, it is not clear what kind of product is specifically related to what kind of mark.

Further, Evidence A No. 15 is a list of "sales results by industry route" from 2010 to 2017 , and according to the list, for each of "inner industries" and "leg industries," "Company direct sales," "Convenience store," "Discount store/Home center," "Big 3 (3 major mass sales companies)," "General retail store," "Co-op," "Specialty store," "Representative," "Department store," "Mass retailer," etc. are described as "routes". However, since the individual quantities and amounts are blacked out, the details of the specific sales quantities and amounts for each of those routes are not clear, and the specific sales area and products sold for each of these routes, and the marks used for those products are not clear.

Although the Appellant considers the route with the largest sales to be the store sales of major mass retailers and has submitted Evidence A No. 19 as evidence supporting the existence of transactions with major mass retailers that have a store network all over Japan, according to the contents, it can be seen that the products "women's socks," "tights," "stockings," etc. relating to the use of the original registered trademark are listed on the online shopping site operated by the major mass retailer, but the publication date

is unknown. Also, although it can be seen that there is a transaction with the major mass retailer, it is not clear whether or not store sales are being made based on the transaction.

c Evidence A No. 20 includes "Sales slip" with the descriptions of the date of "181214" and "Sapporo Branch" as the delivery address (Evidence A No. 20-1), "Purchase slip" with the descriptions of the delivery date of "181208" and "Takayanagiten" as the store name (Evidence A No. 20-2), "Delivery slip" with the descriptions of the delivery date of "181212" and "Tidabashi" as the store name (Evidence A No. 20-3), and "Delivery note" with the description of the delivery date of "2018/12/19" and "Ueno store 6F" which seems to be the store name (Evidence A No. 20-4), and among them, in "Delivery note" relating to Evidence A No. 20-4, there is a description of "Standard Thuce Shiny Mesh Diamond" for the product, but there is no description of the original registered trademark or any indications that lead to it.

d In addition to a to c above, according to the respective items of Evidence A submitted by the Appellant, regarding the products relating to the used of the original registered trademark, no concrete facts can be found to admit the Appellant's allegation that it is sold at department stores, mass retailers, supermarkets, convenience stores, etc. all over Japan.

(B) Catalog mail order sales

It can be seen that the Appellant published a booklet called "Celestyle" as a mail-order catalog of products relating to its own business at least four times a year (spring, summer, autumn and winter) from at least March 2009 to October 2012, and then published it in October 2013 and May and August 2014. In the catalog, women's underwear and room wear are mainly listed as products relating to the use of the original registered trademark (Evidence A No. 4).

The above catalog is said to be mailed to consumers, most of whom are registered members, and according to a list showing the circulation (Appendix 5 of Evidence A No. 14), 50,000 to 88,800 copies were issued from the spring of 2010 to the summer of 2011 (Evidence A No. 4-5 to Evidence A No. 4-10), and 26,500 and 31,000 copies were issued in the winter of 2013 and the summer and autumn of 2014 (Evidence A No. 4-17 to Evidence A No. 4-19), but no evidence that objectively supports the specific distribution destination or circulation has been submitted.

Further, for those published in the spring, summer, autumn, and winter of 2009 and from the fall of 2011 to the winter of 2012 (Evidence A No. 4-1 to Evidence A No. 4-4, Evidence A No. 1-11 to Evidence A No. 4-16), the circulation is unknown, and no evidence that objectively supports the specific distribution destination has been submitted.

Although the Appellant said that in the spring, summer, and autumn of 2013 , the spring and winter of 2014 , and from spring of 2015 to winter of 2018 , a catalog similar to the above catalog was issued, since the relevant catalogs is not submitted, it is not clear what kinds of products relating to the use of the original registered trademark were listed in the catalogs.

(C) Online shopping sales

It can be seen that the Appellant has set up a web page for online shopping since November 2014 at the latest, and is selling the products relating to the use of the original registered trademark (innerwear (camisoles, tank tops, short sleeves, long sleeves), brassieres, shorts, stockings, tights, leg items (leggings pants, leggings, stirrup pants, garters, foot covers, socks) and room wear, etc.) (Evidence A No. 3, Evidence A No. 11, and Appendix 4 of Evidence A No. 14).

According to Evidence A No. 21, it can be seen that in the online shopping sales through the above-mentioned web page, there were a total of 13,118 "orders with the Tuche bland in the purchased products," at least from 47 prefectures for the six months from May 10 to November 9, 2018 , but it is not clear what kinds of products relating to what kinds of marks the orders were, specifically.

Further, as described in (A) b above, although it can be seen that products related to the use of the original registered trademark, such as "women's socks," "tights," and "stockings," etc. are listed on the online shopping site operated by major mass retailers that have a store network all over Japan, since it is unknown when it was posted, it is not clear when and what kinds of orders were placed for the listed product (Evidence A No. 19).

C Sales amount, etc. of products relating to the use of the original registered trademark

According to Evidence A No. 2, the sales amount of products relating to the use of the original registered trademark was about 261.5 million yen in fiscal year 2000 , but reached about 6.5 billion in fiscal year 2007 at its peak, and then gradually decreased to about 3,647 million yen in fiscal year 2013 . The total amount during that period was approximately 61,590 million yen.

Further, according to Appendix 2 of Evidence A No. 14, the sales amount of products relating to the use of the original registered trademark (innerwear (underwear for ladies, lingerie), legwear (stockings, socks/tights, etc. for ladies, socks/tights, etc. for gentlemen)) was estimated to be about 5,664 million yen in fiscal year 2010 (the total of innerwear: about 1,235 million yen, the total of legwear: about 4,429 million yen), then, similarly, it was estimated to be about 4,716 million yen (about 1,162 million yen, about

3,554 million yen) in fiscal year 2011 , about 3,991 million yen (about 946 million yen, about 3,045 million yen) in fiscal year 2012 , about 3,921 million yen (about 590 million yen, about 3,331 million yen) in fiscal year 2013 about 4,005 million yen (about 447 million yen, about 3,558 million yen) in fiscal year 2014 , about 4,641 million yen (about 546 million yen, about 4,094 million yen) in fiscal year 2015 , about 4,701 million yen (about 877 million yen, about 3,824 million yen) in fiscal year 2016 and about 4,847 million yen (about 1,189 million yen, about 3,657 million yen) in fiscal year 2017 .

Further, according to Appendix 3 of Evidence A No. 14, if the market share for each product is calculated based on the above sales amounts, on the premise of the market size published in "2017 White Paper on Innerwear Market" (created by Yano Research Institute Co., Ltd.), Regarding "innerwear," from fiscal year 2012 to fiscal year 2016 , it had been changing sequentially at "0.5%," "0.4%," "0.3%," "0.4%," and "0.6%," and regarding "stockings," "socks and tights for ladies" and "socks and tights for gentlemen" during the same period, similarly, "stockings" had been changing sequentially at "4.4%," "4.0%," "3.9%," "5.2%," and "3.3%," "socks and tights for ladies" had been changing sequentially at "3.0%," "4.2%," "4.8%," "5.4%," and "6.5%," and "socks and tights for gentlemen" had been changing sequentially at "0.3%," "0.6%," "0.8%," "0.7%," and "0.95%".

Also, the ratio of the sales amount of products relating to the use of the original registered trademark to the sales amount of the entire apparel business of the Appellant is said to be a little less than 6% to a little less than 7% from fiscal year 2013 to fiscal year 2017 (Appendix 2 of Evidence A No. 14, Evidence A No. 17, and Evidence A No. 18).

D Advertising, etc. of products relating to the use of the original registered trademark.

(A) Advertisement costs

According to Evidence A No. 2, from fiscal year 2006 to fiscal year 2011 the highest amount of advertising costs for products relating to the use of the original registered trademark was about 333 million yen in fiscal year 2008 , and about 200 million to 300 million yen in the other years. For fiscal year 2012 and fiscal year 2013 , it was about 99 million yen and about 77.5 million yen, respectively.

According to Appendix 6 of Evidence A No. 14 and Evidence A No. 15, advertising costs for products (innerwear, legwear) relating to the use of the original registered trademark were approximately 17.54 million yen (the total amount of legwear) in fiscal year 2013 , and about 61.43 million yen (innerwear: about 29.29 million yen, legwear: about 32.14 million yen). After that, similarly, it was about 90.24 million yen

(about 25.13 million yen, about 65.11 million yen) in fiscal year 2015 , about 120.41 million yen (about 67.01 million yen, about 53.4 million yen) in fiscal year 2016 , and 161.52 million yen (about 118.93 million yen, about 42.59 million yen) in fiscal year 2017.

As mentioned above, there is a large difference in the amount of advertising costs in fiscal year 2013 depending on the content of the evidence, and there is a discrepancy.

(B) Advertising activities

a Product catalog for retailers

It can see that the Appellant published a product catalog (for retailers) containing products relating to the use of the original registered trademark (mainly socks, tights, stockings), approximately twice a year (spring/summer and autumn/winter) from the spring of 2000 (Heisei 12) to the spring of 2018 (Heisei 30) (Evidence A No. 1-1 to Evidence A No. 1-56, Evidence A No. 1-58, Evidence A No. 1-59, and Evidence A No. 13).

According to Appendix 1 of Evidence A No. 14, although the above product catalog has a period when the number of copies distributed is unknown, the number of copies listing socks, tights, and stockings, which were published from the spring of 2000 to the spring of 2018 , was 660 to 2,100 (there are dozens of separate CDs), and the number of copies mainly listing room wear, which were published from the spring of 2008 to the autumn of 2014 , was 650 to 900. However, no evidence that objectively supports the specific distribution destination or circulation has been submitted.

b Street posters and wrapping cars

Although it can be seen that the Appellant posted a street poster with a female model and executed a wrapping car, covering the car body with an advertisement for stockings relating to the use of the original registered trademark in the fall or winter of 2002 , details such as the period and area where the posting or execution was done are unknown (Evidence A No. 1-9 and Evidence A No. 5).

c Setting-up of special sales floors

Although the Appellant mentions the setting-up of special sales floors for products relating to the use of the original registered trademark in department stores, shopping centers, and supermarkets nationwide as part of advertising activities, as mentioned in B (A) a above, regarding its setting-up, the timing alleged by the Appellant and the fact of setting-up in the stores cannot be acknowledged (Evidence A No. 6).

d Exhibit at a show or event

The Appellant said that products relating to the use of the original registered trademark were exhibited at the fashion show ("Tuche UNO COLLECTION IN 05AW

Kobe Collection") (Evidence A No. 7) and at "Nikkei Woman EXPO" (Evidence A No. 22-2) held on May 19 and 20, 2018 . However, regarding the former, details such as specific products relating to the exhibition, introduction method of the products, number of participants, etc. are unknown, and regarding the latter, although it can be seen that a booth with a sign displaying the original registered trademark was set up in the venue and the brassieres were on display, it is not clear whether or not this is the venue for the "Nikkei Woman EXPO" relating to the Appellant's allegation, and the number of visitors to the booth, etc. are unknown.

e Promotional items

Although it can be seen that the original registered trademark was attached to the items (Evidence A No. 8) submitted by the Appellant as advertising materials (promotional items), it is not shown that it was used for the sales promotion activities relating to what kinds of products, and details such as the distribution time (period), distribution place (region), and number of distributions are unknown.

f Others

On the page of the readers' roundtable discussion (Evidence A No. 22-1) which the Appellant alleges was published in the magazine "saita" (November 2019 issue), although the brassiere relating to the use of the original registered trademark was introduced, no evidence has been submitted to support the source.

Further, the Appellant said that they had held Acti Balance Event at Izumi Youme Town Saga on October 18, 2015 (Evidence A No. 22-3), and according to the content of the evidence, although the situation that some explanation was given in a place that seems to be inside the store can be seen, no evidence has been submitted to support the time and place of the event, and it is not clear that the explanation was given for what kinds of products relating to what kinds of marks specifically.

Also, in the "Medium-term Management Plan CAN20 Phase 2 <FY2017-FY2020>" (Evidence A No. 18), which the Appellant created on May 12, 2017 , as one of the sales floor expansion strategies, there is a description of "ladies' apparel shop/Tuche" (in the configuration of "Tuche", an acute accent is written above the character "e"), and as one of the priority products of innerwear, along with the description of "strengthening the transmission power with Tuche 'zero seams' and 'future bra,'" there is posted a poster-like item relating to innerwear with the indication "Tuche" (in the configuration of "Tuche", an acute accent is written above the character "e"). However, no evidence that specifically indicates how these were executed has been submitted.

E Newspaper and magazine articles about products relating to the use of the original registered trademark

(A) Newspaper

Regarding stockings relating to the used of the original registered trademark, it can be seen that in "Nikkei Marketing Journal" dated August 30, 2001 , along with a photograph of the product packaging with the original registered trademark, an article was posted stating that a new product of patterned stockings using a female model for product development would be released in the fall and would be handled at department stores, specialty stores, convenience stores, etc. nationwide, and in "Nikkei Marketing Journal" dated July 30, 2002 , along with a photograph of the product packaging with the original registered trademark, an article was posted stating that at the end of the same month, the new pattern of the above stockings would be released and the sales record of the above stockings in autumn and winter of the first year was 5 million pairs, and further in "Nikkan Kogyo Shimbun" dated July 30, 2003 , an article was posted stating that the Appellant announced the outline of the above-mentioned pattern stockings in the fall and winter of the same year (Evidence A No. 9-1, Evidence A No. 9-2, and Evidence A No. 9-4).

Then, it can be seen that in "Nikkei MJ (Marketing Journal)" dated December 3, 2010 , along with a photograph that seems to be a sales floor with a sign displaying the original registered trademark, an article was posted stating that as a new series of women's underwear brand "Tuche", the Appellant would sell women's underwear that allows you to freely choose ornaments at general merchandise stores (GMS), etc. around February to April of 2011 , and in the article (source unknown) relating to the heading "Information Disc," it was posted and introduced that men's foot covers relating to the business of the Appellant called "Tuche HOMME" (in the configuration of "Tuche", an acute accent is written above the character "e") was sold at mass retailers, etc. nationwide (Evidence A No. 9-11 and Evidence A No. 9-12).

(B) Magazine

In "Weekly Toyo Keizei" dated February 3, 2007 , as an interview with the planning and sales promotion staff of the Appellant, regarding the pattern stockings mentioned in (A) above, it can be seen that the article was posted stating that it was release in August, 2001 and became a hit with 5 million pairs in the fall and winter of the same year, the sales that had fallen in 2005 recovered in the following year, and the brand had grown to an average of 15 million pairs annually (Evidence A No. 9-7).

F Questionnaire

Evidence A No. 10 and Evidence A No. 12 are "consumer awareness and actual purchasing situations of 'stockings': results of consumer surveys via the Internet" posted in the report called "2012 White Paper on Innerwear Market" created by Yano Research

Institute Co., Ltd. In order to verify consumer awareness and actual purchasing situations of "stockings," at the end of August in 2012, for 100 women in their 20s and 50s in the Tokyo metropolitan area (Tokyo, Kanagawa, Chiba, Saitama) who purchase "stockings" at least once a year and wear them at least once a week, the actual purchase situation was surveyed.

Then, of the above survey results, regarding "the awareness of stocking brands," it took a format in which by naming "MANZOKU," "SABRINA," "MIRACARAT," "Tuche," "ASTIGU/skin, charm, shine...(total 11 kinds)," "Relish," "f-ing," and "Mirica," as brands to be surveyed, for each, respondents answer from the choices of "I don't know," "I know but never bought," "I want to buy" or "I have bought". On average, the awareness and purchasing experience of "MANZOKU" (I don't know: 27.5%, I have bought: 53.8%) and "SABRINA" (I don't know: 36.0%, I have bought: 40.5%) were high, and regarding "Tuche," the response of "I don't know" exceeded 52.8% and the response of "I have bought" remains at 24.8%.

Also, of the brands to be surveyed, "SABRINA" is about the products relating to the business of the Appellant, and it can be seen that it was posted at least in the catalog relating to stockings in the spring and summer of 2004 (Evidence A No. 1-14) or the catalog relating to tights and stockings in the spring and summer of 2015 (Heisei 27) (Evidence A No. 13-1), and since 2015 at the latest, it has been regarded as the main brand of legwear relating to the business of the Appellant (Evidence A No. 17).

G Summary

According to A to F above, the Appellant released women's socks and tights relating to its own business using the original registered trademark in 2000, and since then has continuously used the original registered trademark while gradually expanding the products relating to the use of the original registered trademark to, for example, stockings, women's underwear, room wear, etc. Further, the products relating to the use have been sold through the web page for online shopping opened by the Appellant since November in 2014, and it can be said that there were orders from all over the country at least from May to November 2018. However, even summarizing the respective items of Evidence A submitted by the Appellant, it cannot be acknowledged that various products using the above-mentioned original registered trademark have been continuously sold nationwide through stores such as department stores, mass retailers, supermarkets, convenience stores, etc., and catalogs issued by the Appellant.

Further, according to the fact that of the products relating to the use of the original registered trademark, for stockings, 5 million pairs were sold in the fall and winter of 2001 when they were released to be a hit product and then, around 2007, an average of

15 million pairs per year was sold, it is presumed that it occupied a certain share among similar products at that time. However, it is not clear how much it was, and although the share of the Appellant from fiscal year 2012 to fiscal year 2016 has been around 4%, no evidence to evaluate the amount has been submitted. In addition, for socks and tights for ladies, although the Appellant estimates that the market share was 6.5% in fiscal year 2016, no evidence to evaluate the amount has been submitted for that, and for innerwear and socks and tights for gentlemen, the share of fiscal year 2012 to fiscal year 2016 calculated by the Appellant was less than 1%.

Furthermore, although the Appellant alleges that they spent tens of millions to hundreds of millions of yen for advertising activities from fiscal year 2006 to fiscal year 2017 for the products relating to the use of the original registered trademark, the details of the activities are not clear, and although it can be seen that in addition, as advertising activities, for example, a street poster about stockings was posted in the fall or winter of 2002, and exhibition was made at a fashion show held in Kobe in 2005, it is unclear when and what kinds of advertising activities were carried out for various products (women's socks, tights, women's underwear, room wear, etc.) relating to the use of the original registered trademark.

In addition, regarding the stockings relating to the use of the original registered trademark, according to the results of the questionnaire conducted in August 2012, which is about 10 years after its release, the response of "I don't know" as a brand of stockings occupied more than half, its awareness is low compared to other brands of stockings relating to the business of the Appellant.

Therefore, although it can be said that the original registered trademark has been used for women's socks, tights, stockings, women's underwear, room wear, etc. relating to the business of the Appellant since 2000, it cannot be acknowledged that it has come to be widely recognized among consumers as a sign displaying the designated goods relating to the business of the Appellant.

Consequently, it cannot be said that the original registered trademark has been widely recognized among consumers as a sign displaying the designated goods relating to the business of the Appellant.

(3) Regarding the relationship with the requirement stipulated in Article 64(1) of the Trademark Act.

According to (1) and (2) above, the mark in the application is configured by the constitution identical with that of the original registered trademark and it can be recognized that the Appellant and the holder of trademark right of the original registered trademark are identical. However, even if another person uses the original registered

trademark for the designated goods of the present application that are not similar to the designated goods relating to it, it cannot be said that it may cause confusion about the sources of the products and the designated goods relating to the business of the Appellant.

Therefore, the mark in the application does not fulfill the requirement stipulated in Article 64(1) of the Trademark Act.

3 Appellant's allegation

The Appellant alleges that in recent years in which the tendency of diversification of corporate activities has become remarkable, the Appellant sells various variations of textile and fashion related products such as underwear, the original registered trademark is recognized by consumers as a trademark used in a wide range of products, the degree of prominence of the original registered trademark is high, and regarding the fact that the designated goods of this application, "sanitary panties and sanitary shorts," are closely related to women's underwear and have a common sales floor, it can be said that if the mark in the present application is used for the designated goods of the present application which are textile and fashion related products, without the permission of the Appellant, there is a great risk of misunderstanding that a new product under the "Tuche" brand has been released.

However, even if the original registered trademark is used for women's socks, tights, stockings, women's underwear, room wear, etc. for a certain period of time, according to the evidence submitted, it cannot be said that the original registered trademark has been widely recognized as a trademark displaying the designated good relating to the business of the Appellant, and even if another person uses the original registered trademark for the designated goods of the present application that are not similar to the designated goods relating to it, it cannot be said that it may cause confusion about the sources of the products and the designated goods relating to the business of the Appellant, as described in 2(3) above.

Therefore, the Appellant's allegation above cannot be accepted.

4 Closing

As described above, the mark in the application does not fulfill the requirement stipulated in Article 64(1) of the Trademark Act, and thus shall not be registered as a defensive mark registration.

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

October 29, 2019

Chief administrative judge: TANAKA, Takanori
Administrative judge: NAKATSUKA, Toshie
Administrative judge: ISHIZUKA, Rie

Attachment

The mark in the application

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