

Decision on Opposition

Opposition No. 2018-685017

Right Holder Badischer Winzerkeller eG

Patent Attorney R&C IP Law Firm

Opponent William Grant & Sons Ltd

Patent Attorney KOTANI, Takeshi

Decision on the opposition to the grant of international trademark registration No. 1353061 is concluded as follows.

Conclusion

International trademark registration No. 1353061 is cancelled.

Reason

No. 1 The Trademark

International trademark registration No. 1353061 (hereinafter, referred to as "the Trademark") is configured as indicated in Attachment 1 and claims priority under the Paris Convention Article 4 on the basis of the trademark registration application filed on January 25, 2017 in Germany. The international trademark registration application was filed on May 12, 2017, and a decision for registration was issued on June 6, 2018. The trademark was registered on October 5, 2018 with "Wines and sparkling wines; all the above goods made in Germany" of Class 33 as its designated goods.

No. 2 Cited Trademark

The trademarks cited by the opponent (hereinafter, referred to as "the Opponent") are as in the following 1 to 3, and the trademark rights thereof are currently still valid (hereinafter, these are collectively referred to as "Cited Trademark").

1 Trademark Registration No. 4633051 (hereinafter, referred to as "Cited Trademark 1")

Constitution of trademark as indicated in Attachment 2

Designated goods Class 33 "Whisky made in Scotland"

Filing date March 20, 2002

Date of registration of establishment December 27, 2002

2 International Trademark Registration No. 919341 (hereinafter, referred to as "Cited Trademark 2")

Constitution of trademark as indicated in Attachment 3

Designated goods Class 33 "Alcoholic beverages [except beer], but insofar as whisky and whisky based liqueurs are concerned, only scotch whisky and scotch whisky bases liqueurs produced in Scotland."

International filing date March 1, 2007

Date of registration of establishment May 22, 2009

3 International Trademark Registration No. 919342 (hereinafter, referred to as "Cited Trademark 3")

Constitution of trademark as indicated in Attachment 4

Designated goods Class 33 "Alcoholic beverages [except beer], but insofar as whisky and whisky based liqueurs are concerned, only scotch whisky and scotch whisky based liqueurs produced in Scotland."

International filing date March 1, 2007

Date of registration of establishment September 19, 2008

No. 3 Grounds of the opposition to registration

The Opponent petitioned that, because the Trademark falls under Articles 4(1)(xi), 4(1)(xv), 4(1)(xix), and 4(1)(vii) of the Trademark Act, its registration should be cancelled according to Article 43-2(1) of the same Act, summarized and mentioned reasons for the petition as follows, and submitted Evidence A No. 1 to A No. 35 as means of evidence.

1 Regarding Article 4(1)(xi) of the Trademark Act

Because the meaning and the size of Alphabetic characters in the lowest line are acknowledged as additional display, the Trademark is a trademark mainly consisting of a deer figure in the upper line as a main portion and Alphabetic characters of "BLACK FOREST" below. Then, because the characters of "BLACK FOREST", which mean "black forest" in English, are not integrated with the deer figure in terms of meaning and are displayed as being separated from the figure, these are not in a form that should be always recognized as an integrated part. Furthermore, it can be said that the figure portion that can be intuitively recognized as a deer alone is more memorable than "BLACK FOREST", which is not a familiar expression in Japan.

Therefore, only the deer figure in the Trademark functions as an independent identification mark, and consumers often carry out transactions as focusing on the deer figure in the Trademark.

Next, in Cited Trademark 1, a deer figure similar to that in the Trademark is illustrated alone. This figure is expressed in an outlined form. However, this only simply indicates that the background is black, and black/white inversion with respect to the Trademark does not particularly affect recognition of the figure. In Cited Trademarks 2 and 3, a deer figure and characters of "Glenfiddich" are illustrated in two lines as in the Trademark. However, "Glenfiddich" means "valley of deer" in Gaelic (Evidence A No. 5) and does not necessarily mean the deer figure itself, and in addition, the characters are separately illustrated from the figure in the configuration. Therefore, it can be said that there is a situation where only the deer figure in Cited Trademarks 2 and 3 functions as an independent identification mark. Moreover, in a case where a person does not know the meaning of "Glenfiddich", the person is strongly impressed by the figure portion that can be intuitively recognized as a deer and remembers the figure portion alone.

Therefore, when the deer figure in the Trademark is compared with the deer figure in the Cited Trademark, the figures resemble each other in terms of appearance. First, the deer figure in the Trademark is a portion above the chest drawn in a silhouette-like manner. Regarding the form of the deer, the body faces the front, the head has impressive antlers, and the face turns to the right as looking into the far distance. The description of the form as a whole gives a still and elegant impression that is suitable for a male deer. On the other hand, the deer figure in the Cited Trademark commonly has points that a portion above the chest is drawn in a silhouette-like manner, that impressive antlers are grown, and that the face is turned to the right, and also gives an impression of an elegant male deer as a whole.

The deer figures of the two trademarks are common in such a basic mode including an outline and have many common points in how fine portions are drawn. Regarding the antlers that are features of a male deer, impressive and large antlers are drawn in both figures. Both are largely spread antlers to the left, right, and upper sides, and the shape and the number of the antlers in the middle or the small branched antlers are substantially the same in both trademarks. In particular, in comparison with Cited Trademarks 2 and 3, the description of the antlers in the Trademark is confusingly similar to these. The thicknesses, angles, number, and growing manners of the small antlers are substantially the same. Furthermore, the two trademarks are common in that the face turns to the right and the appearance is in a mode in which the face turns to a direction of about three-

quarters to the right. The angle of the face is not directed upward and faces sideways in a substantially horizontal direction, and this is also a common point.

Regarding the description, the figure is drawn well in a silhouette-like manner using lines and shades so that the deer is recognized at first glance. In particular, in the comparison with Cited Trademarks 2 and 3, the shapes of the black shadows in the left and right portions of the chest, the shape of the jaw portion, and the shapes of the eyes, ears, noses, and antlers are common, and these portions including the line thickness and the outline of the entire shape are substantially the same.

Although there is a general form of a deer, there is no need to purposely represent a deer as in the Trademark using the method and mode as described above. When a deer is represented as a figure, there is a large number of alternative drawing methods. There is no need for the Trademark to purposely adopt the mode of the deer that resembles the Cited Trademark such as the entire outline, the orientation and angle of the face, arrangement of the black shadows, the shapes and the line thickness of the antlers and other portions, or the like.

Due to such commonality, consumers inevitably confuse the deer figures in the two trademarks with each other, and these trademarks are similar to each other in appearance. In addition, consumers who remember each trademark as a deer figure that is easily and visually recognized, not the character portion that may be unmemorable as described above, increasingly confuse the two trademarks due to the strong impression of the deer figures in a different time or a place. For example, although it cannot be said that a person who happens to see and recognize a bottle (label) of "Glenfiddich" in a bar or the like is familiar with "Glenfiddich" before, the person rather intuitively remembers this as a liquor with the deer label and confuses the Trademark having this portion in common with "Glenfiddich".

In addition to the above, the deer in both trademarks are commonly drawn in the form in which the deer has impressive and large antlers suitable for a male deer and peacefully stands as turning to the side and looking into the far distance. This is drawn in a silhouette-like manner so that an extra impression is excluded, and both deer shapes have a distinguished and elegant atmosphere.

Accordingly, both trademarks invoke concept of "silhouette-like deer having elegant antlers and standing as turning to the side", and the two trademarks are similar to each other as trademarks having the same concept. Even if specific and detailed concept is not necessarily invoked, the appearances resemble each other as described above, and the concepts invoked from the appearance naturally becomes identical to each other. Therefore, the two trademarks are similar trademarks having the same concept in any case.

Note that, even when whether or not the entire trademarks including the character portions are similar to each other is discussed, at least, the Trademark is similar to Cited Trademarks 2 and 3.

When the entire label as a combination of the figure and the characters is considered, the sizes, arrangement, and the balance of the figures and the characters of the Trademark are common to those of Cited Trademarks 2 and 3. Therefore, the Trademark and Cited Trademarks 2 and 3 have a common entire impression. In consideration that the figure portion is intuitively and visually recognized and gives a strong impression, it can be said that the two trademarks in which the figure portions resemble each other are similar to each other so as to be confused with each other as a whole.

Therefore, the Trademark is similar to the Cited Trademark in appearance and concept and falls under Article 4(1)(xi) of the Trademark Act.

2 Regarding Article 4(1)(xv) of the Trademark Act

(1) Prominence of the Cited Trademark

The opponent is a distillery established in 1887 in Scotland, and "Glenfiddich" in the Cited Trademark is the name of the distillery. At the same time, this became the world's first brand of single-malt whisky, and its world-wide sales started in 1963 (Evidence A No. 5). Thereafter, "Glenfiddich" became a popular brand that has been continuously manufactured and sold to the present, and its high quality has been evaluated and given a large number of awards. "Glenfiddich" acquired a share of 35% of the single-malt whisky market and has become the most-taken single-malt whisky in the world.

For example, the history of "Glenfiddich" and the product portfolio are introduced in the Japanese version of the opponent's HP. In addition, in the English version, specific awards are introduced such as "won eight gold medals (acquired eight gold medals) in 'International Spirits Challenge' involving many countries in 2013" (Evidence A No. 5 and A No. 6). During this time, advertisement was placed in a whisky-specialized website in 2010, which attempted to advertise "Glenfiddich" to countries such as "UK (England)", "France", "Germany", and "US (the United States of America)" in the world (Evidence A No. 7).

Regarding the received awards, a large number of awards were further acquired in various fairs from 2010 to 2014 (Evidence A No. 8), and a famous general life information site in Japan introduces that "Glenfiddich" acquired the largest number of awards as a single-malt whisky in various liquor contests in the world (Evidence A No. 9).

In addition, on the website of the magazine "the drinks business", fifty thousand copies of which are internationally issued to persons related to the drinks business, "Glenfiddich" is introduced as "Scotch Whisky Brand Champion" (Evidence A No. 10).

At the same time, on the scotch whisky specialized site "SCOTCHWHISKY. com", in the latest article on September 28, 2018, "Glenfiddich" is introduced as the number one "BEST-SELLING SCOTCH MALT WHISKIES (best-selling scotch malt whiskies)" in 2017 (Evidence A No. 11). Furthermore, websites and personal blogs related to whiskies in Japan introduce that "Glenfiddich" is the best-selling single-malt whisky in the world (Evidence A No. 12 and A No. 13), has a share of 35%, and received gold awards and silver awards in fairs such as the International Spirits Challenge, the International wine and spirits competition, and the Scotch whisky masters (Evidence A No. 12).

According to the aggregate calculation by the opponent, the sales results of "Glenfiddich" in the world from 2001 to August 2018 are 604,434 cases in 2001, 690,030 cases in 2002, 695,439 cases in 2003, 744,161 cases in 2004, 790,537 cases in 2005, 831,298 cases in 2006, 870,636 cases in 2007, 827,458 cases in 2008, 818,664 cases in 2009, 941,596 cases in 2010, 999,351 cases in 2011, 1,036,696 cases in 2012, 1,129,043 cases in 2013, 1,110,899 cases in 2014, 1,105,188 cases in 2015, 1,217,139 cases in 2016, 1,258,931 cases in 2017, and 827,733 cases in 2018 (January to August) (nine liter = 12 bottles are included in one case. The same applies hereinafter).

Furthermore, the sales results in Japan in the same period are 5,995 cases in 2001, 9,046 cases in 2002, 8,496 cases in 2003, 10,277 cases in 2004, 11,579 cases in 2005, 15,207 cases in 2006, 15,808 cases in 2007, 13,611 cases in 2008, 13,772 cases in 2009, 11,727 cases in 2010, 12,065 cases in 2011, 13,349 cases in 2012, 14,251 cases in 2013, 17,208 cases in 2014 (aggregation calculation is not completed for this year), 26,545 cases in 2015, 21,006 cases in 2016, 19,873 cases in 2017, and 20,324 cases in 2018 (January to August).

On the background of such a history and world-wide reputation, the Opponent's "Glenfiddich" that has large sales results has already acquired prominence in the liquor business field as a famous scotch whisky brand.

Then, in the label of "Glenfiddich, the deer figure is always symbolically drawn, and the prominence of "Glenfiddich" concurrently means prominence of the deer figure.

Although the deer figure was slightly modified, a design substantially the same as the current design was adopted in 1990s at the latest. For example, "The Encyclopedia of Wines and Spirits" 1994 version introduces "Glenfiddich" with the label in which the deer figure is drawn. An article in this book also describes that the figure of the deer is

used as a symbol mark (Evidence A No. 14). The version indicated in Evidence A No. 15 was adopted and its trademark was registered in Europe in 1998, and the version indicated in Evidence A No. 16 and the version indicated in Evidence A No. 17 were registered as trademarks or international trademarks (Australia and six other countries) in Europe and seven countries respectively in 2007 and 2014 (Evidence A No. 18 to A No. 25). Furthermore, in China, copyrights of two versions are registered (Evidence A No. 26 and A No. 27), and the Opponent protects the deer figure alone in the world in this way. Then, in Japan, the Cited Trademark is currently registered (Evidence A No. 2 to A No. 4).

The deer figure is regarded as the symbol of "Glenfiddich". When "Glenfiddich" is introduced, the label in which the deer is illustrated is also introduced in many cases (Evidence A No. 28).

Furthermore, many of books and websites introducing "Glenfiddich" mention that this is the most-taken single-malt whisky in the world and also mention the deer figure (Evidence A No. 14 and A No. 29 to A No. 34). Products of liquor such as whiskies are often introduced or advertised together with entire images of labels and bottles, and this makes consumers easily familiar with the design of the label. A famous liquor brand becomes famous together with its label and a symbolic figure drawn in the label. Regarding "Glenfiddich", many consumers are attached to the deer figure and regard this as the symbol mark of "Glenfiddich".

In this way, the prominence of "Glenfiddich" indicates the prominence of the deer figure that is characteristically and symbolically illustrated in the label, the deer figure that has been used at least for 20 years or more leaves a strong impression to consumers, and consumers have already been familiar with the deer figure as the deer figure of "Glenfiddich". Although there are several versions of the deer figure as described above, the modes are basically the same. Although the design has been modified in line with the times, each one of the deer figures for consumers is the deer figure that is impressed with the same feature described in 1 above.

(2) Possibility of causing confusion

On the background of the prominence of the deer figure above, the Trademark is inevitably confused with "Glenfiddich" of the Opponent.

The deer figure of the Trademark resembles the deer figure of the Cited Trademark as described above, and in this point, the two trademarks may be confused with each other. Even though the character portions are different, the deer figure of "Glenfiddich" that has been widely used for a long time itself is famous as described above, and it is assumed

that the deer figure of "Glenfiddich" be used alone (Evidence A No. 2 and A No. 18 to A No. 25), and there is a case where the deer figure is actually introduced and displayed alone (Evidence A No. 28 and A No. 35). Therefore, the deer figure uniquely functions as an identification mark.

Then, the figures are common as in this case, consumers who already know the deer figure of "Glenfiddich" will wrongly recognize the product to which the Trademark is attached as a product related to the business of the Opponent and confuse them.

Although the designated goods of the Trademark are wines, wines are products similar to whiskies in the examination standards. This difference does not act to deny the confusion.

Originally, it is considered that one reason why these are regarded as similar products is commonality of sales stores and consumers. However, for example, it is not strange that a person who likes whiskies likes wines at the same time, and it is considered that many such consumers exist. In the field of the designated goods of this case, consumers who have already been familiar with the prominent deer figure of "Glenfiddich" have many opportunities to newly have contact with the product to which the Trademark is attached. However, as long as the deer figure directly evokes the Opponent, the Trademark is confused with the product related to the business of the Opponent.

The Trademark resembles the deer figure that cannot be separated from the Opponent, and the product to which the Trademark is attached causes consumers to wrongly recognize that the product is included in the product portfolio of the Opponent. A plurality of types of "Glenfiddich" are manufactured and sold (Evidence A No. 5 or the like), and the entire appearances are not necessarily the same.

Therefore, consumers who focus on the noticeable deer figure wrongly recognize that the product to which the Trademark is attached as a new product group of the Opponent and wrongly believe that the above product is a product of the Opponent or a person related to the Opponent. Therefore, this dilutes the trademark of the Opponent.

In addition, for example, regarding major breweries and liquor manufacturers, the same business operator usually sells different types of liquors. Therefore, although consumers understand that a variety of products are developed from the same source, a possibility that the confusion occurs in this case further increases.

In this way, there is a possibility that the Trademark is confused with the product of the Opponent in various aspects, and in short, the cause is because the figure portions of the two trademarks resemble each other. If there has been a prominent deer figure on the one hand and a figure similar to this is used for similar products, the two figures are

naturally confused with each other.

Therefore, the Trademark falls under Article 4(1)(xv) of the Trademark Act.

3 Regarding Article 4(1)(xix) of the Trademark Act

The Cited Trademark and the deer figure of "Glenfiddich" of the Opponent are widely recognized in Japan, and "Glenfiddich" is the most-taken single-malt whisky in the world. Therefore, "Glenfiddich" is widely recognized by consumers in various parts and countries in the world including England that is the home country of "Glenfiddich", rather than in Japan.

Then, the Trademark is a trademark similar to the Cited Trademark and the deer figure of the opponent and is used in an attempt to gain unfair profits using the long-established reputation of the Opponent. The holder of the trademark right, as a liquor manufacturer in Europe, would have to know "Glenfiddich", and the unfair purposes are acknowledged regarding this point. Therefore, the Trademark falls under Article 4(1)(xix) of the Trademark Act.

4 Regarding Article 4(1)(vii) of Trademark Act

The similarity between the Trademark and the trademark of the Opponent is as described above. To maintain the registration of the Trademark for the holder of the trademark right who knows the prominent "Glenfiddich" disturbs fair trade order and violates society's general moral sense.

Therefore, the Trademark violates public order and morality and falls under Article 4(1)(vii) of Trademark Act.

No. 4 Notice of reasons for revocation

In the body, the reasons for revocation were notified, on March 25, 2020, to the holder of the trademark right of the Trademark such that the Trademark is a trademark similar to Cited Trademarks 2 and 3 and is used for the goods similar to the designated goods of Cited Trademarks 2 and 3, and accordingly, the Trademark falls under Article 4(1)(xi) of the Trademark Act, and an opportunity was given for submitting a written opinion within a designated period.

No. 5 Opinion of the holder of the trademark right

Against the reasons for revocation in No. 4 above, the holder of the trademark right has submitted no opinion in response.

No. 6 Judgment by the body

1 Regarding applicability to Article 4(1)(xi) of the Trademark Act

(1) Regarding the Trademark

As indicated in Attachment 1, the Trademark consists of the figure in which a head of an animal like a male deer that turns the face to the left and has large antlers of which the front ends are branched into seven parts is drawn in a silhouette-like manner (hereinafter, referred to as "deer figure in this case"), the characters of "BLACK FOREST", and the characters of "FINEST WINE QUALITY FROM GERMANY" (much smaller than the size of the characters of "BLACK FOREST") displayed in three lines. The character portion of "FINEST WINE QUALITY FROM GERMANY" is perceived as a description at first glance, and it should be said that the character portion is recognized and grasped as an additional portion. Therefore, it should be said that the deer figure portion in this case and the character portion of "BLACK FOREST" in the Trademark leave a strong impression to observers.

Then, in the configuration of the Trademark, the deer figure portion in this case and the character portion of "BLACK FOREST" are not acknowledged as portions that are indivisibly connected so that it is considered unnatural to separate and observe these portions in transactions, and it is acknowledged that both portions give a strong and dominant impression to traders and consumers as a mark identifying the source of goods.

Then, regarding the Trademark, it should be said that the deer figure portion in this case can be extracted from the configuration as a main portion, only this portion can be compared with a trademark of another person, and it is possible to determine whether or not the trademarks are similar to each other.

Then, because the deer figure portion in this case is perceived as the head of the animal like a male deer having large antlers, it may be said that the deer figure portion invokes the concept of "male deer". However, it cannot be said that the deer figure portion gives rise to a specific sound.

(2) Regarding Cited Trademarks 2 and 3

A As indicated in Attachment 3, Cited Trademark 2 consists of a figure in which an inner portion of a frame surrounded by a light gray band-like line is painted dark gray and a head of an animal like a male deer having a face turning to the left and having large antlers of which the front ends are branched into eight portions is drawn in the frame in a silhouette-like manner (hereinafter, referred to as "cited deer figure") and the characters of "Glenfiddich" displayed in two lines. The cited deer figure portion and the character portion in the configuration are separated, and a strong connection between the two

portions in terms of concept is not acknowledged. Therefore, it can be said that there is a case where the cited deer figure portion is independently perceived.

Then, it is reasonable to say that there is no small number of cases where only the cited deer figure portion in the configuration of the Cited Trademark 2 is used for trading.

Then, because the cited deer figure portion is perceived as the head of the animal like the male deer having the large antlers, it may be said that the cited deer figure portion invokes the concept of "male deer". However, it cannot be said that the cited deer figure portion gives rise to a specific sound.

B As indicated in Attachment 4, Cited Trademark 3 consists of a cited deer figure and the characters of "Glenfiddich" displayed in two lines in a dark-gray horizontally-long rectangle. The cited deer figure portion and the character portion in the configuration are separated from each other, and a strong connection between the two portions in terms of concept is not acknowledged. Therefore, it can be said that there is a case where the cited deer figure portion is independently perceived.

Then, it is reasonable to say that there is no small number of cases where only the cited deer figure portion in the configuration of Cited Trademark 3 is used for trading. As in A above, the cited deer figure portion invokes the concept of "male deer" and does not give rise to a specific sound.

(3) Similarity between the Trademark and Cited Trademarks 2 and 3

When the Trademark is compared with Cited Trademarks 2 and 3, those trademarks are respectively configured as indicated in Attachments 1, 3, and 4, and the entire configurations are different from each other. However, as described in (1) and (2) above, when the similarity between the Trademark and Cited Trademarks 2 and 3 is determined, it is possible to determine similarity between the trademarks by comparing only the figure portion of each trademark with a trademark of another person.

Then, when the deer figure portion in this case and the cited deer figure portion are observed in detail, although the number of branches of the front end of the antlers and the directions of the branches are different, the portions have a common mode of framework in a point such that both portions are figures of the head of a male deer turning to the left drawn in a silhouette-like manner and are figures in which the male deer has a large antler specific for a male deer and components such as eyes, nose, mouth, ears, and pattern in a neck portion are drawn at the substantially same positions and in the same mode. Therefore, appearances of the two portions give similar impressions.

Furthermore, because the deer figure portion in this case and the cited deer figure portion do not give rise to a specific sound, the sounds cannot be compared. However,

because both portions cause the concept of "male deer", they have common concept.

Therefore, in the Trademark and Cited Trademarks 2 and 3, although the deer figure portion in this case and the cited deer figure portion cannot be compared with each other in terms of sound, the appearances of both portions give similar impressions and have common concept. Therefore, taking these into account generally, it is reasonable to say that, in a case where the Trademark and Cited Trademarks 2 and 3 are used for the same or similar goods, consumers may confuse the source of the goods.

Therefore, the Trademark and Cited Trademarks 2 and 3 are similar trademarks which may be confused with each other.

(4) Similarity between the designated goods of the Trademark and the designated goods of Cited Trademarks 2 and 3

It is acknowledged that the designated goods of the Trademark are the same or similar to the designated goods of Cited Trademarks 2 and 3.

(5) Summary

As described above, the Trademark is a trademark similar to Cited Trademarks 2 and 3 and is used for goods same as or similar to the designated goods of Cited Trademarks 2 and 3. Therefore, the Trademark falls under Article 4(1)(xi) of the Trademark Act.

2 Summary

As described above, the Trademark was registered while violating Article 4(1)(xi) of the Trademark Act, and therefore the registration should be revoked under the provisions of Article 43-3(2) of the same Act.

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

August 5, 2020

Chief administrative judge: SAITO, Takahiro
Administrative judge: KOMATSU, Satomi
Administrative judge: YAMANE, Mariko

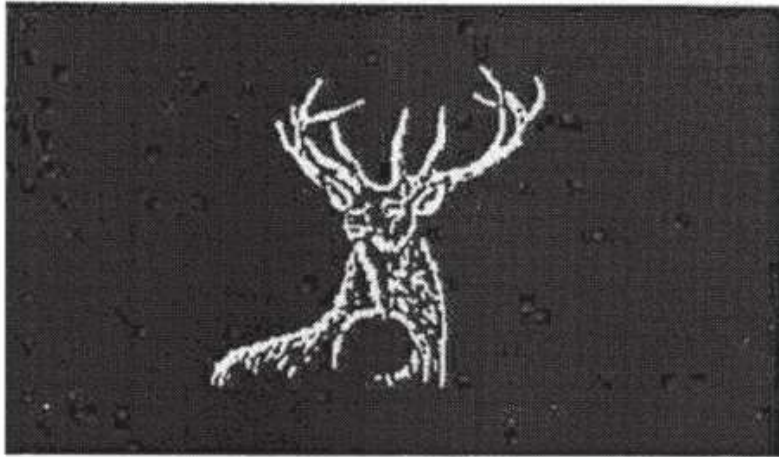
Attachment

(本件商標)



(The Trademark)

(引用商標 1)



(Cited Trademark 1)

(引用商標 2)



(Cited Trademark 2)

(引用商標 3)



(Cited Trademark 3)