

trademark right was registered on November 30, 1978 with designated goods of Class 22 which are as specified in the Trademark Registry. Thereafter, the designated goods' reclassification was registered to set the designated goods to "Umbrellas and their parts; walking sticks; canes; metal parts of canes and walking-sticks; handles for canes and walking-sticks" of Class 18 and "Footwear [other than special footwear for sports]" of Class 25 on January 21, 2009.

2 The trademark registration No. 1895841 (hereinafter, referred to as "Cited Trademark 2") is configured as indicated in the attachment, and the registration application was filed on March 2, 1984. The establishment of the trademark right was registered on September 29, 1986 with designated goods of Class 22 which are as specified in the Trademark Registry. Thereafter, the designated goods' reclassification was registered to set the designated goods to "Shoe ornaments of precious metal" of Class 14, "Walking sticks; canes; metal parts of canes and walking-sticks; handles for canes and walking-sticks; umbrellas and their parts" of Class 18, "Footwear [other than special footwear for sports]" of Class 25, and "Shoe ornaments, not of precious metal; shoe eyelets; shoe laces; metal fasteners for shoes and boots" of Class 26 on August 2, 2006. In addition, the renewal of duration of the trademark right was registered regarding Classes 14, 18, and 25 on August 16, 2016.

3 The trademark registration No. 5214700 (hereinafter, referred to as "Cited Trademark 3") is configured as indicated in the attachment, and the registration application was filed on May 11, 2007. The establishment of the trademark right was registered on March 19, 2009 by setting Class 35 "Retail services or wholesale services for clothing (including hats) and shoes, retail services or wholesale services for wallets, key cases, other bags and pouches; retail services or wholesale services for personal articles; retail services or wholesale services for jewelry and personal ornaments; retail services or wholesale services for perfume and flavour materials, liquid perfumes, and cosmetics" as designated services.

4 The mark, which is cited in the grounds of the opposition to registration of this case by the opponent as indicating that the Trademark falls under Article 4(1)(xv) of the Trademark Act, consists of Alphabetic characters of "Chloe" (accent aigu is applied above "e"; the same applies below unless otherwise noted) in horizontal writing.

Hereinafter, the mark "Chloe" and "CHLOE" (accent aigu is applied above "E", the same applies below unless otherwise noted; however, when the characters in the configuration of the Trademark are indicated, this is not applied) are collectively referred to as the "opponent's trademark".

No. 3 Grounds of the opposition to registration

The opponent insisted that the Trademark should be cancelled in accordance with Article 43-2(1) of the Trademark Act because the Trademark falls under Articles 4(1)(xi), 4(1)(xv), and 4(1)(viii) of the Trademark Act, summarized and mentioned reasons for request as follows, and submitted Evidence A No. 2 to A No. 486 (including their branch numbers) as means of evidence (note that, when indicating all the branch numbers, the branch numbers are omitted; however, Evidence A No. 1 to A No. 403 in Evidence A No. 9 are respectively read as 1 to 403 of Evidence A No. 9).

1 The Trademark gives rise to the pronunciation of "kuroefuransisu" and also gives rise to the pronunciation of "kuroe" in accordance with prominence of the fashion brand "Chloe" of the opponent. In contrast, Cited Trademarks 1 to 3 give rise to the pronunciation of "kuroe".

Therefore, the Trademark and Cited Trademarks 1 to 3 are similar to each other, having the pronunciation of "kuroe" in common. Furthermore, the designated goods "Shoes and boots [other than special footwear for sports]" of the Trademark and the designated goods "Footwear [other than special footwear for sports]" of Cited Trademarks 1 and 2 and the designated service "Retail services or wholesale services for shoes" of Cited Trademark 3 are similar to each other.

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

2 "Chloe" is a mark which is registered as a defensive mark (trademark registration No. 1895840 defensive No. 1) (Evidence A No. 5) and is a prominent trademark which has been widely known in general as the trademark indicating the fashion brand "Chloe" of the opponent (Evidence A No. 6 to A No. 484).

Therefore, the Trademark is a trademark which partially includes the prominent trademark of another person, and there is likely to cause confusion in connection with the goods pertaining to a business of the opponent in a case where the Trademark is used for the designated goods. Therefore, the Trademark falls under Article 4(1)(xv) of the Trademark Act.

3 A person whose name is "CHLOE FRANCIS" exists (Evidence A No. 485 and A No. 486). Therefore, the Trademark is a trademark contains the name of another person.

Accordingly, the Trademark falls under Article 4(1)(viii) of the Trademark Act.

No. 4 Notice of reasons for revocation

The body notified the reasons for revocation dated on February 13, 2019 of the holder of trademark right. The reasons for revocation indicate that "since the Trademark was registered while violating Article 4(1)(xv) of the Trademark Act, the

registration should be canceled in accordance with the provisions of Article 43-3(2) of the Trademark Act".

No. 5 Opinion of holder of trademark right with respect to the reasons for revocation

Regarding the Trademark, since the characters of "CHLOEFRANCIS" having the same font and size are displayed with no space between the characters, it is obvious that traders and consumers recognize "CHLOEFRANCIS" as a single coined word without particularly separating "CHLOEFRANCIS" into "CHLOE" and "FRANCIS". The opponent does not use "e" and "E" with no accent aigu as in the Trademark and does not use and arrange capital letters with no space therebetween. When the similarity between the Trademark and the opponent's trademark is determined, it is reasonable to compare entire configurations, and it is not allowed to determine the similarity by comparing the character part of "CHLOE" in the configuration of the Trademark with the opponent's trademark. The luxury brand as the brand "Chloe" of the opponent is known only by a person who has relatively high fashion sense, and it cannot be said that the brand "Chloe" of the opponent is widely recognized by traders and consumers regardless of age and sex. There cannot be a case where a person who has high fashion sense confuses the Trademark with the "Chloe" brand of the opponent when looking at the trademark which uses "e" and "E" with no accent aigu and in which the capital letters are arranged with no space therebetween.

No. 6 Judgment by the body

1 Applicability of Article 4(1)(xv) of the Trademark Act

(1) Degree of being well-known and prominent and originality of the opponent's trademark

A According to the evidence, the allegation of the opponent, and the investigation by ex officio, the following facts are acknowledged.

(A) The opponent's trademark is a French fashion brand established by Gaby Aghion in 1952 and became one of symbolic fashion brands in the period as a pioneer in the pret-a-porter market in which ready-made clothes are made by using luxury fabrics in the 1970s. Then, the opponent uses the opponent's trademark for products of "women's clothing, shoes, bags, wallets, and perfumes" and the like (hereinafter, referred to as the "opponent's product") (Evidence A No. 6 to A No. 9).

(B) In Japan, the women's clothing of the opponent was introduced in 1976 at the latest (379 of Evidence A No. 9). The opponent has more than 50 stores including famous department stores and outlet malls across Japan and the store of "SEE BY CHLOE"

insisted by the opponent as a popular version of the brand "Chloe" of the opponent (Evidence A No. 10 and A No. 11, the investigation by ex officio: <http://chloeharbor.seesaa.net/category/10964329-1.html>).

(C) The opponent's trademark and the opponent's product were introduced in a large number of magazines, books, and the like published in Japan. For example, "Picture book of excellent goods in the world", which has introduced excellent brand products sold in Japan (published from June 5, 1976 to April 22, 2004, 379 to 398 of Evidence A No. 9), introduced women's clothing, watches, and performs. Shoes were also introduced in fashion magazines (7 to 9, 24, 29, 32, 33, 73, 74, 145, 209, 216, 217, 259, 287, 302, 303, and 327 of Evidence A No. 9). Then, advertisement of the opponent was placed in the fashion magazines, and it is shown that the opponent performs advertisement activity by using the opponent's trademark (published from December 7, 2006 to September 20, 2012, 4 to 378 of Evidence A No. 9).

(D) An advertisement of the women's bag in which the opponent's trademark is described was placed in Yomiuri Shimbun dated November 7, 14, 21, and 28 and December 5 and 12 in 2015 and June 4, 11, and 18 in 2016 (Evidence A No. 475 and A No. 476).

B According to the facts acknowledged in A, it is acknowledged that the opponent's trademark had already been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark used for the opponent's product at the time of the registration application of the Trademark and that the state had continued at the time of the decision of registration of the Trademark.

C Since the characters of "Chloe" or "CHLOE" (including ones with no accent aigu) according to the opponent's trademark are not described in English, French, German, and Italian dictionaries, it can be said that the degree of the originality is relatively high.

(2) Degree of similarity between the Trademark and the opponent's trademark

A The Trademark

The Trademark consists of Alphabetic characters of "CHLOEFRANCIS" in horizontal writing. The spelling of the characters of "CHLOE" in the first half of the configuration is the same as that of prominent characters of "Chloe", from which accent aigu is removed, as indicated in (1) B, is not described in general dictionaries and the like, and is understood as a coined word which does not have a specific meaning. Furthermore, the characters of "FRANCIS" in the second half has meaning of "a name of a man in English" (Kojien 6th edition).

Then, it is understood that the Trademark consists of the characters (word) of "CHLOE" and the characters (word) of "FRANCIS", and the entire configuration of the Trademark is not known as a trademark having a specific meaning. Therefore, the Trademark does not have a specific idea. Then, from the character part of "CHLOE" in the configuration, the well-known and prominent "Chloe" is easily recognized in relation to the designated goods "Shoes and boots [other than special footwear for sports]". Therefore, although traders and consumers having contact with the Trademark focus attention on the character part of "CHLOE" and are strongly impressed, the Trademark simply gives rise to the pronunciation of "kuroe" from the character part of "CHLOE" in addition to the pronunciation of "kuroefuransisu" caused from the entire constituent characters, and it is reasonable to understand that this causes the idea of "the Chloe brand related to the business of the opponent".

B The opponent's trademark

The opponent's trademark consists of Alphabetic characters of "Chloe" or "CHLOE" in horizontal writing, corresponds to the character part, and gives rise to the pronunciation of "kuroe". Since the opponent's trademark has been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark indicating the opponent's product as described in (1) B, it is reasonable to understand that the opponent's trademark gives rise to the idea of "the Chloe brand related to the business of the opponent".

C Degree of similarity between the Trademark and the opponent's trademark

The Alphabetic character part "CHLOE" that is the main portion of the Trademark and the opponent's trademark have common spelling except for a point of whether or not accent aigu is included. Therefore, since appearances of the trademarks are close to each other and both trademarks have the pronunciation of "kuroe" and the idea of "the Chloe brand related to the business of the opponent", it can be said that the degree of the similarity between both trademarks is high.

(3) Relationship between the designated goods of the Trademark and the opponent's product, commonality of consumers, and other actual trade conditions

The opponent's product includes "shoes", and it is obvious that this is included in the designated goods "Shoes and boots [other than special footwear for sports]" of the Trademark. Therefore, consumers of the two trademarks coincide with each other.

Furthermore, the Trademark consists of the Alphabetic characters of "CHLOEFRANCIS" which are horizontally written in series. However, the holder of the trademark provides a space between "CHLOE" and "FRANCIS" and uses the characters of "CHLOE FRANCIS" (Evidence A No. 484 and A No. 485).

(4) Risk of confusion about the source

As described in (1) B and C, the opponent's trademark had been widely recognized by traders and consumers in the fashion-related field in Japan as the trademark indicating the opponent's product at the time of registration application and the decision of registration of the Trademark, and it can be said that the degree of the originality of the opponent's trademark is relatively high. Furthermore, as described in (2) C, it can be said that the degree of the similarity between the Trademark and the opponent's trademark is high.

Then, the designated goods of the Trademark and the opponent's product include the same goods and have common consumers. In consideration of this, in a case where the Trademark is used for its goods designated at the time of the registration application and the decision of registration of the Trademark, traders and consumers coming into contact with this associate and recall the well-known and prominent opponent's trademark and wrongly recognize the goods as goods relating to the business of a person who has an economic or organizational relation with the opponent, and it should be said that there has been a risk of causing confusion about the source.

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

2 Allegation of holder of trademark right

The holder of trademark right alleges that "The Trademark consists of the characters of "CHLOEFRANCIS" having the same font and the same size with no space between the characters. Therefore, it is obvious that traders and consumers recognize "CHLOEFRANCIS" as a single coined word without particularly separating the characters into "CHLOE" and "FRANCIS". The luxury brand as the brand "Chloe" of the opponent is known only by a person who has relatively high fashion sense, and it cannot be said that the brand "Chloe" of the opponent is widely recognized by traders and consumers regardless of age and sex. There cannot be a case where a person who has high fashion sense confuses the Trademark with the "Chloe" brand of the opponent when looking at the trademark which use "e" and "E" with no accent aigu and in which the capital letters are arranged with no space therebetween".

However, in the reasons for determining that the Trademark falls under Article 4(1)(xv) of the Trademark Act, regarding the degree of the similarity between the Trademark and the opponent's trademark, the prominence of the trademark "Chloe" or "CHLOE" used by the opponent is acknowledged as a premise. Then, it is determined that to determine the similarity of the trademark by extracting a part of the configuration of the Trademark and comparing only the extracted part with the trademark of the other person falls under a case where it is acknowledged that the part gives strong and

dominant impression to traders and consumers as a mark identifying the source of the goods.

Then, the Trademark includes the characters of "CHLOE" that are recognized as the prominent characters of "CHLOE" of the opponent. Therefore, it has been determined that, in a case where the Trademark is used for its designated goods, traders and consumers having contact with this associate and recall the well-known and prominent opponent's trademark, and there has been a risk of causing the confusion about the source as if the goods are goods relating to the business of a person who has an economic or organizational relation with the opponent. It has not been simply determined that the Trademark falls under Article 4(1)(xv) of the Trademark Act based on only the similarity between the Trademark and the opponent's trademark.

Furthermore, consumers of "shoes and boots [other than special footwear for sports]" that are the designated goods of the Trademark are not limited to a person who particularly has a high interest in fashion and can be general consumers, and it should be said that attention normally paid when the goods are purchased is not very high. Therefore, it should be said that consumers do not pay attention to whether or not accent aigu is applied to a single character.

Therefore, the allegation of the holder of trademark right cannot be accepted.

3 Summary

As described above, the Trademark was registered while violating Article 4(1)(xv) of the Trademark Act. Therefore, the registration of the Trademark should be cancelled in accordance with the provisions of Article 43-3(2) of the Trademark Act without mentioning the other grounds of the opposition.

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

May 23, 2019

Chief administrative judge: KOIDE, Hiroko
Administrative judge: HIRASAWA, Yoshiyuki
Administrative judge: YAMADA, Hiroyuki

Attachment Cited Trademarks 2 and 3



省略 omitted