

Appeal Decision

Appeal No. 2019-5954

Appellant Thanks AI Global Pte., Ltd.

Patent Attorney KIMURA, Takashi

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2017-103120 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 is configured as indicated in Attachment 1, and the application for its registration was filed on August 4, 2017 as the trademark application according to the provisions of Article 10(1) of the Trademark Act related to Trademark Application No. 2017-002878 whose application for its registration was filed on January 16, 2017 by setting Class 3 "Cosmetics and toiletries; soaps and detergents; dentifrices; perfume and flavor materials; incenses and fragrances; false nails; false eyelashes; breath freshening preparations; deodorants for animals." as the designated goods.

2 Cited Trademark

The registered trademark cited in the reasons for refusal of the present application in the examiner's decision because the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act is as follows and is still valid as of now.

Trademark Registration No. 5939662 (hereinafter, referred to as "Cited Trademark")

Configuration of trademark As indicated in Attachment 2

Designated goods Class 3 "Soaps and detergents; dentifrices; cosmetics and toiletries; perfume and flavor materials."

Date of registration application June 7, 2016

Date of registration of establishment April 14, 2017

3 Judgment by the body

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

A Regarding the trademark in the Application

As indicated in Attachment 1, the trademark in the Application includes a figure in which two vertically-long loops formed by crossing red lines with different thicknesses at the lower position are laterally arranged in a state where the loops are partially overlapped and ends of the left and right lines of the loops have contact with each other (hereinafter, referred to as "figure part") arranged on the left side, and the Alphabetic characters of "THANKS" ("HANKS" is arranged at slightly lower position than "T"; also, "characters of "N" and "K" share a part of characters; the same applies hereinafter), the red Alphabetic characters of "AI" that are designed to a certain degree, and the small Alphabetic characters of "Related to Heart" above the Alphabetic characters of "HANKS" (hereinafter, "THANKS", "AI", and "Related to Heart" are collectively referred to as "character part") are arranged on the right side of the figure part.

Then, although the figure part and the character part configuring the trademark in the Application are arranged at substantially the same height, the colors of the figure part and the character part are respectively red, and black and red and are different from each other. The figure part and the character part are not obviously and integrally combined. Therefore, the two parts can be visually perceived as separated parts.

Furthermore, the circumstance is not acknowledged such that the figure part is recognized as a part that represents a specific matter or a certain meaning and is familiarly known in Japan. Therefore, the figure part gives rise to no specific sound and causes no specific concept.

On the other hand, the character part consists of the Alphabetic characters of "THANKS", "AI", and "Related to Heart". The part of "THANKS" is a plural of a plain English word "thank" that has meaning of "appreciation" or the like, "AI" is an abbreviation that means "artificial intelligence", "Related to Heart" is an English expression from which meaning of "related to heart" can be perceived, and all of them are English words and an abbreviation that are relatively familiar in Japan. Therefore, these words respectively give rise to the sounds of "sankusu", "ehai", and "rireiteddo tu hahto" corresponding to the Alphabetic characters, and the above meanings are respectively understood from the Alphabetic characters. However, the entire character part causes no specific concept.

Then, in the configuration of the trademark in the Application, the figure part gives

rise to no specific sound and causes no specific concept, and is not associated with the character part in terms of sound and concept.

According to the above, in the trademark in the Application, the figure part and the character part are visually perceived as separated parts and are not associated with each other in terms of sound and concept. Therefore, it cannot be said that these parts are uniformly integrated so that it seems to be unnatural that these parts are separately observed in business.

Then, because both of the figure part and the character part have functions for identifying the source of designated goods of the present application, it is reasonable to say that each of these parts independently functions as a mark for distinguishing relevant products from others.

Then, in the configuration of the trademark in the Application, whereas the character part includes English words that are relatively familiar in Japan, the figure part includes a figure from which nothing is recognized at first sight. Therefore, it can be said that the figure part attracts attention of viewers and strongly gives dominant impression to observers.

Therefore, it can be said that traders and consumers coming into contact with the trademark in the Application remember the figure part in the configuration of the trademark in the Application and do business based on the appearance of the figure part in many cases. Accordingly, it can be said that it is permissible to separate and extract the figure part as a main part from the trademark in the Application and to compare the figure part with another person's trademark.

Note that the Appellant alleges that the trademark in the Application is a logo that is integrally combined as whole and the figure part is a figure for which an appropriate word that expresses the part cannot be found, and accordingly, the figure part gives rise to no sound and causes no concept that have the function for identifying the source and cannot be the main part.

However, because the figure part in the configuration of the trademark in the Application attracts attention of viewers and strongly gives a dominant impression to observers and this can be acknowledged as the main part as described above, the Appellant's allegation cannot be accepted.

B Regarding the Cited Trademark

As indicated in Attachment 2, the Cited Trademark consists of a figure in which two vertically-long loops formed by crossing lines with different thicknesses at the lower position are laterally arranged in a state where the loops are partially overlapped and ends of the left and right lines of the loops have contact with each other. This gives rise to

no specific sound and causes no specific concept.

C Regarding similarity between the trademark in the Application and the Cited Trademark

The trademark in the Application is configured as described in A above, and the Cited Trademark is configured as described in B above. The two trademarks have overall configurations different from each other. However, when the figure part in the configuration of the trademark in the Application is compared with the Cited Trademark, although the colors are different from each other, the trajectories of the configurations are the same. Therefore, it can be said that figure part and the Cited Trademark have a confusing appearance.

Furthermore, because neither the figure part in the configuration of the trademark in the Application nor the Cited Trademark gives rise to any specific sound and causes any specific concept, it is not possible to compare the figure part with the Cited Trademark in terms of sound and concept.

Then, although it is not possible to compare the figure part in the configuration of the trademark in the Application with the Cited Trademark in terms of sound and concept, the figure part and the Cited Trademark have a confusing appearance. Therefore, taking these into account generally, it should be said that the trademark in the Application and the Cited Trademark are similar trademarks which may be confused with each other.

D Similarity between the designated goods of the present application and the designated goods of the Cited Trademark

Class 3 "Cosmetics and toiletries; soaps and detergents; dentifrices; perfume and flavor materials." of the designated goods of the present application are the same or similar to the designated goods of the Cited Trademark Class 3 "Soaps and detergents; dentifrices; cosmetics and toiletries; perfume and flavor materials.".

E Summary

As described in A to D above, because the trademark in the Application is similar to the Cited Trademark and is used for goods the same as or similar to the designated goods of the Cited Trademark, the trademark in the Application falls under Article 4(1)(xi) of the Trademark Act.

(2) Summary

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

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

November 18, 2019

Chief administrative judge: KANEKO, Naohito
Administrative judge: KOMATSU, Satomi
Administrative judge: ARIMIZU, Reiko

Attachment 1

(trademark in the Application) (original color should be referred to)



Attachment 2

(Cited Trademark)

