

Appeal Decision

Appeal NO.2020-2760

Appellant KAWASAKI HEAVY INDUSTRIES, LTD.

Patent Attorney Patent Professional Corporation ARCO Patent Office

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2019-4328 has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reasons

No. 1 The trademark in the application and history of the procedures

The trademark in the application consists of the standard characters "MEGURO" , and application for its registration was filed on January 10, 2019, by setting Class 12 "two-wheeled motor vehicles, bicycles and their parts and fittings" as the designated goods. Thereafter , the designated goods of the trademark in the application were amended to "two-wheeled motor vehicles and their parts and fittings" by a written amendment dated on February 28, 2020.

It should be noted that regarding the present application, a notice of reasons for refusal was issued on July 4, 2019, a written opinion received on August 8, 2019 was submitted, and a decision of refusal was made on November 28, 2019.

In response to the decision of refusal, a request for appeal against the decision of refusal was made on February 28, 2020.

No. 2 Gist of the reasons for refusal stated in the examiner's decision

In the examiner's decision, the present application was rejected based on the recognition and judgment whose gists are as described in 1 and 2 below.

1. The trademark in the application consists of the standard characters "MEGURO", but the characters are obtained by writing "Meguro", which is one of the 23 wards of Tokyo, in alphabetic letters, which makes it easy to understand and recognize the meaning of "products produced and sold in Meguro-ku, Tokyo". Thus, even if the trademark in the

application is used in the "products produced and sold in Meguro-ku, Tokyo" among the designated goods, the trademark in the application is a trademark consisting only of a mark indicating a place of origin or a places of sales of the products (quality) in a common manner, and doesnot have a function for distinguishing relevant products from others.

Therefore, the trademark in the application falls under Article 3(1)(iii) of the Trademark Act is likely to cause false recognition of the product's quality when being used for products other than the above products, the trademark in the application falls under Act Article 4(1)(xvi)of the Trademark Act.

2. The trademark in the application consists of the standard characters "MEGURO", but the characters are obtained by writing "Meguro", which is recognized as a common surname, in alphabetic characters, and therefore, even if the trademark in the application is used for the designated goods, it does not function for distinguishing relevant products from others.

Therefore, the trademark of the present application falls under Article 3(1)(iv) of the Trademark Act.

No. 3 Notice of examination of evidence in the body

Regarding whether the trademark in the application falls under Article 3(1)(iv) of the Trademark Act, as a result of examining the evidence by the official authority, the facts of Attachment 1 were found, and therefore, based on the provision of Patent Act Article 150(5) as applied mutatis mutandis pursuant to Article 56(1) of the Trademark Act, the result was notified to the appellant (in a notification of examination of evidence dated August 21, 2020), and an opportunity to express an opinion thereof within a considerable period of time was given to the appellant.

No. 4 Opinion of the appellant on the notice of examination of evidence

In response to the above-mentioned third notice of examination of evidence, the appellant stated opinions whose, gists are as follows, in a written opinion dated on October 7, 2020 and a written opinion dated on January 29th, 2021.

1. Regarding the applicability to t Article 3(1)(iii) of the Trademark Act and the Trademark Act Article 4(1)(xvi) of the Trademark Act.

The above-mentioned third notice of examination of evidence only mentions the applicability of the present application to Article 3(1)(iv) of the Trademark Act, and therefore, it is considered that the trademark in the application "MEGURO" does not fall under Article 3(1)(iii) of the Trademark Act and Article 4(1)(xvi) of the Trademark

Act.

2. Regarding the Trademark Act Article 3(1)(iv)

In an industry where "two-wheeled motor vehicles" are traded, "MEGURO (Meguro)" has been recognized as a term referring to Meguro Manufacturing Co., Ltd. and the two-wheeled motor vehicles thereof, which have led the Japanese two-wheeled motor vehicle industry from prewar to postwar, and currently, by the announcement of the products "two-wheeled motor vehicles" that use the trademark in the application, which follow the trend of the two-wheeled motor vehicles manufactured by Meguro Manufacturing Co., Ltd., it has been recognized that "MEGURO (メグロ)" refers to products related to the business of the appellant.

In view of the individual circumstances of the industry related to the designated goods of the trademark in the application, it is clear that the trademark in the the application "MEGURO" cannot be uniquely understood as a common surname.

Therefore, the trademark of in the application "MEGURO" does not fall under Article 3(1)(iv) of the Trademark Act.

No. 5 Judgment by the body

1. Regarding the Trademark Act Article 3(1)(iii) of the Trademark Act and the Trademark Act Article 4(1)(xvi) of the Trademark Act

The trademark in the application consists of standard characters "MEGURO", but even though the characters of "MEGURO" may be understood as being obtained by writing "Meguro", which is one of the 23 wards of Tokyo, in alphabetic characters, it is hard to say that the characters are immediately recognized and understood as a direct indication of the places of origin or the place of sales of the products.

In addition, even by the examination, it is impossible to find facts that the characters "MEGURO" are generally used to indicate the places of origin or the places of sales of the designated goods of the trademark in the application, and it is also impossible to find a situation in which a trader or a consumer after reviewing the trademark in the application should recognize the characters as indicating the places of origin or the places of sales of the products.

Thus, since the trademark in the application cannot be said to indicate the places of origin or the places of sales of the products in relation to the designated goods, it should be said that the trademark in the application have a function for distinguishing relevant products from other s, and since the trademark in the application does not indicate the placesof origin or the places of sales of the products, the trademark of in

the application does not have a risk of causing a misunderstanding of the quality of the products.

Therefore, the trademark in the application does not fall under Article 3(1)(iii) of the Trademark Act and Article 4(1)(xvi) of the Trademark Act.

2. Regarding Article 3(1)(iv) of the Trademark Act

In the trademark in the application consists of standard characters "MEGURO", but it is clear that the trademark in the application gives rise to the name "Meguro" from the configuration of the trademark in the application, and according to book information and Internet information as shown in Attachment 1 shown in the notification of examination of evidence, it is recognized that the term "Meguro", which is obtained by writing the reading of "Meguro" in Chinese characters, indicates a Japanese surname, and it is also recognized that there are a considerable number of people with the surname "Meguro".

In addition, it is also clear that in a case of writing a Japanese surname, it has been widely practiced to write the reading in alphabetic characters.

Since the trademark in the application is represented by standard characters, the trademark of the present application does not have a peculiar aspect.

In view of the above, it is reasonable to say that the trademark in the application is a trademark consisting only of a mark displaying the common surname "Meguro" in a commonly used manner.

Therefore, the trademark in the application falls under Article 3(1)(iv) of the Trademark Act.

3. Regarding the allegations of the appellant

(1) The appellant alleges that "the trademark in the application "MEGURO" originated from the two-wheeled motor vehicle brand of Meguro Manufacturing Co., Ltd., which has been a leading two-wheeled motor vehicle manufacturer in Japan from prewar to postwar, the concept and brand of the two-wheeled motor vehicle of Meguro Manufacturing Co., Ltd. were taken over by the appellant who succeeded the business of Meguro Manufacturing Co., Ltd. and are continued to the present day, and considering matters that "MEGURO" is a two-wheeled motor vehicle brand that was a lead vehicle of the torch relay in the last Tokyo Olympics, a two-wheeled motor vehicle that can be said to be an originator of "W800 STREET" and "W800 CAFE" currently sold by the appellant is named "MEGURO", these facts are widely introduced in magazines and the Internet, and it is clear that the trademark in the application "MEGURO" has gained a certain

degree of recognition even now as a trademark of two-wheeled motor vehicles related to the business of the appellant among consumers and traders of two-wheeled motor vehicles.

However, as the appellant alleges, even though the two-wheeled motor vehicles manufactured by Meguro Manufacturing Co., Ltd., which was established in 1923, were a hot topic from prewar to postwar, the trademark used for the two-wheeled motor vehicles manufactured by Meguro Manufacturing Co., Ltd. is katakana characters for "Meguro" written in red and slightly designed (hereinafter referred to as "Meguro mark"), or an emblem with bold characters "MEGURO" (hereinafter referred to as "emblem"), as shown in Attachment 2, and the mode and the like thereof are clearly different from the trademark in the application.

In addition, if the two-wheeled motor vehicles manufactured by Meguro Manufacturing Co., Ltd. were actually traded or sold at the time of filing the application for registering the trademark in the application, the sales quantity, advertisement facts, etc. thereof cannot be confirmed at all.

Further, according to the evidences submitted by the appellant, the two-wheeled motor vehicle named "MEGURO K3" by the appellant is a product (Evidence A No. 41) that was launched in February 2021, and although it can be surmised that the product is advertised and announced at various events and the like related to two-wheeled motor vehicles, it cannot be confirmed that advertisements, such as TV commercials for consumers, are widely performed to consumers, and the sales quantity and market share of the product are not clear either.

Furthermore, according to Evidence A No. 34 and the like, the trademark used for the product named "MEGURO K3" is an emblem (Attachment 3) or a Meguro mark, which is clearly different from the trademark of the present application.

Thus, it cannot be recognized that the trademark in the application "MEGURO" has gained a certain degree of recognition even now as a trademark of two-wheeled motor vehicles related to the business of the appellant among consumers and traders of two-wheeled motor vehicles.

(2) The appellant alleges that "in an industry where 'two-wheeled motor vehicles' are traded, 'MEGURO (メグロ)' has been recognized as a term referring to Meguro Manufacturing Co., Ltd. and the two-wheeled motor vehicles thereof, which have led the Japanese two-wheeled motor vehicle industry from prewar to postwar, and currently, by the announcement of the products descended from the two-wheeled motor vehicles manufactured by Meguro Manufacturing Co., Ltd., it has been recognized that 'MEGURO

(メグロ)' refers to products related to the business of the appellant. In view of the individual circumstances of the industry related to the designated goods of the trademark in the application, it is clear that the trademark in the application cannot be uniquely understood as a common surname."

However, as described in (1) above, it cannot be recognized that the trademark of the present application "MEGURO" has gained a certain degree of recognition even now as a trademark of two-wheeled motor vehicles related to the business of the appellant.

In addition, as described in 2 above, it is reasonable to say that the trademark in the application is a trademark consisting only of a mark displaying the common surname "Meguro" in a commonly used manner. (3) Therefore, none of the above-mentioned allegations of the appellant can be adopted.

4 Conclusion

As described above, even if the trademark in the application does not fall under Article 3(1)(iii) of the Trademark Act and the Trademark Act Article 4(1)(xvi) of the Trademark Act, it falls under the Trademark Act Article 3(1)(iv) of the Trademark Act, and thus cannot be registered.

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

August 19, 2021

Chief administrative judge: ENOMOTO, Masami

Administrative judge: TOYODA, Junichi

Administrative judge: OGINO, Mizuki

Attachment 1 (evidence presented in the notification of examination of evidence)

"Meguro" is a common family name in Japan

(1) Book Information

A. "779", "meguro" and "25,000" are respectively described in the columns [Ranking], [Last Name] and [Estimated Population] on page 265 of "Dictionary of Last Names" (Shonan Co., Ltd.).

B. "Nationwide = 700th place" is described in the section [Meguro] on page 701 of the "Dictionary of National Family Names" (Tokyodo Shuppan Co. Ltd.).

C. "519", "Meguro" and "about 35,000" are respectively described in the columns [Ranking], [Family Name] and [Number of Persons] on page 174 of "Japanese Family Names" (Rikugei Shobo).

D. "Personal Names Classified by Japanese Alphabet in Hello Pages (telephone directory) of All 23 Wards of Tokyo Last Volume" (2005.3-2006.2) published by "NTT East Japan Co., Ltd." describes that a large number (316) of persons have the family name of "Meguro".

(2) Internet Information

A. On a website of "Name Distribution & Name Ranking syarokkuhomuzu (Software)/First Name Last Name Family Name", under the heading "Search Conditions Family Name: Meguro", "Nationwide", "756" and "4,828" are respectively described in the columns [Region], [Ranking] and [Number of Cases]. (<https://www2.nipponsoft.co.jp/bldoko/index.asp>)

B. On a website of "Same Name Dictionary (Same Name Search Last Name Ranking First Name Ranking)", under the heading "National Last Name Ranking (701-800th)", "774", "Meguro" and "5810" are respectively described in the columns [Rank Order], [Last Name] and [Number of Cases]. (<http://www.douseidoumei.net/00/sei08.html>)

C. On a website of "Family Name Origin net", under the heading "Ranking of Meguro in Prefectures", "780th" and "Approximately 24,900" are respectively described in the columns [Ranking in Whole Country] and [Number of Persons in Whole Country]. ([https://myoji-](https://myoji-yurai.net/myojiPrefectureRanking.htm?myojiKanji=%E7%9B%AE%E9%BB%92)

[yurai.net/myojiPrefectureRanking.htm?myojiKanji=%E7%9B%AE%E9%BB%92](https://myoji-yurai.net/myojiPrefectureRanking.htm?myojiKanji=%E7%9B%AE%E9%BB%92))

D. On a website of "110,000 Kinds of Last Names (Family Names) in Whole Country", under the headings "7. Last Name Ranking" and "0001-5,000th", "772", "Meguro" and "6186" are respectively described in the columns [Ranking], [Last Name] and [Number of Households]. (<http://www2s.biglobe.ne.jp/~suzakihp/index40.html>)

Attachment 2 (trademark used by Meguro Manufacturing Co., Ltd.)



Attachment 3 (emblem used in "MEGURO K3")

