

Plaintiff : MIZUNO Corporation

Defendant : Fujian Hongxin Gerke Sports Goods Co., Ltd.

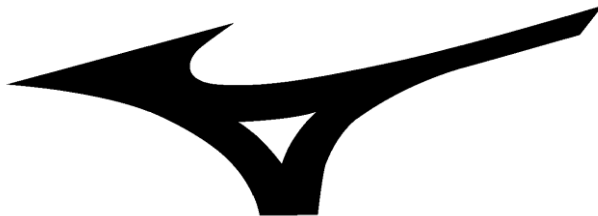
Date of the Decision: September 13, 2017

Case Number: 2016(Gyo-Ke)10262

The Defendant trademark: International registration No. 1119597



The Cited trademark: Japanese trademark registration No.4716649 & No.1703877



Conclusion

The Intellectual Property High Court overturned an invalidation trial decision, Invalidation No. 2015-68001, in which the JPO decided not to invalidate the defendant's mark. In the Intellectual Property High Court's decision the court found that there was a likelihood of confusion between the plaintiff's mark and the defendant's mark.

Reasoning

Whether or not a trademark is likely to cause confusion as referred to in Article 4, paragraph (1), item (xv) of the Trademark Act should be determined comprehensively in light of several factors such as the degree of similarity between the trademark and another person's indication, the degree of well-knownness,, famousness and the creative nature of the other person's indication, the degree of association between the designated goods or services of the trademark and the goods or services pertaining to the other person's business, as well as the commonality in terms of traders and consumers of goods or services and other circumstances related to the transactions. Furthermore, such determinations should be made on the basis of the level of care that traders and consumers of the designated goods or services of the trademark normally have (the Supreme Court Filed on July 11, 2000. (Case Number1998(Gyo-Hi)85).

At the invalidation trial, the board took notice of the differences in both marks' shapes, and compared the marks. Based on this comparison, the board determined that the Defendant's mark did not invoke any particular idea of any specific motifs while the Cited mark invokes the impression that the motif of the mark is a bird; thus, the overall impressions of the marks are different.

However, the plaintiff claimed that the standard by which the board conducted their analysis is faulty, since both marks have many elements in common and the differences the board recognized are very slight differences and do not pertain to the distinguishing features. The plaintiff also argued that when taking into account the circumstances of the actual transactions, these slight differences cannot be said to have no likelihood of confusion.

Intellectual Property High Court Analysis

The Intellectual Property High Court (IP High Court) found that the Defendant mark and the Cited mark are different in visual impression when comparing them directly, and in particular when considering the outline of the inverted triangle on a colored background which was the same finding as the board.

However, when the IP High Court considered the composition of both marks as a whole they found that both of these marks are inclined to the upper-right side with the right end higher than the left end. Moreover, each mark has a straight line inclined to the upper-right side at the upper left part of the mark. Both marks also have a curved line extending sharply from the left end of the inclined straight line to the center bottom. Both marks also have moderate right upward curved lines which forms an arc that starts from the right end of the inclined straight line to the bottom center and have curved lines which arc from the upper right part to the bottom central part.

Also both the inclination angle of the straight line that extends rightward from the upper part of the left end of and the inclination angle of the curve which incline upward from the bottom part of the curved part towards the right end are relatively similar. The ratio of the depth of the curved portion and the degree of inclination are also similar, and the width of the thickest part in the left part of the Defendant's trademark compared to the Cited mark is almost the same. Consequently the IP High Court found that the overall arrangement and contour of the Defendant's trademark shows relatively high similarity

to the Cited trademark especially in the upper part.

Recognizability of the Cited Trademark

The cited trademark has been used for sport shoes since 1983, used for sportswear, apparel products and sport bags since 1987, used as a house mark by the plaintiff since 1998, and put on all of the plaintiff's products since 2007.

Numerous sportswear, apparel products and sport bag products containing the Cited trademark are sold with many reaching more than 100 billion yen in sales each year since 2008.

Over the years the products with the Cited trademark have been used in a variety of sporting events including the Olympic Games and have been introduced by various medium such as through TV campaigns, magazine and newspaper ads, and other forms of advertising.

In addition to the above facts, considering the result of the investigation on the plaintiff's name recognition, the cited trademark was widely recognized among consumers of goods related to sporting goods at the time of registration as well as the registration assessment of this trademark as a trademark that indicates goods such as "sports shoes, sportswear, and sports bags".

Circumstances of the Actual Transactions

Often multiple famous figurative trademarks are included on sportswear, such as sport shirts or training suits, socks, and caps as a one-point mark by being printed or embroidered on the goods.

Therefore, there is a high possibility that the Defendant trademark may also be used as a one-point mark in the field of its goods, such as on clothing, training wear, socks, caps, and sport shoes.

From this perspective, if one considers that the Defendant trademark would be used as a one-point mark, visually recognizing the differences between the marks may be difficult because the one-point marks are relatively small. Moreover, showing one-point marks in detail on such as sport shirt using printing or embroidery is not easy, and conceivably only the whole outline of the figure attracts attention from viewers and the difference found in the inside loses conspicuousness.

Thus, because the overall arrangement and contours of the marks of the Defendant

trademark to the Cited trademark are relatively similar, the Defendant trademark can be deemed to be easily recognized as similar to the Cited trademark if used as one-point trademark.

Likelihood of confusion

The primary consumer for the goods of the Defendant mark is a general consumer which includes people without accurate or detailed knowledge concerning the trademark or brand, and who do not pay close attention when they buy the products.

In addition, when considering that the Cited trademark has a high degree of recognizability in Japan, and especially if the Defendant trademark is used as a one-pointed mark, there is a risk that the consumer might be unaware of the differences between both marks as the consumer would just focus on the similarity of the figure of the whole arrangement or outline with regard to the Cited trademark.

Also, there is a risk that the consumer will misunderstand the Defendant mark, because the Defendant mark may remind the consumer of the famous Cited trademark and may believe that the Defendant has a close business relationship with the Plaintiff or the Defendant belongs the group that carry out product development projects under the same indication.

Based on the above reasons, the Defendant trademark cannot be registered because the mark falls under Article 4, Paragraph (1), Item (xv) of the Trademark Act. Moreover, the trial decision that the trademark does not fall under the above clause is an error.



Full text:

<http://shohyo.hanrei.jp/precedent/View.do?type=tm&id=12043>

English translation from the website of the Supreme Court of Japan

Case number 1998(Gyo-Hi)85

http://www.courts.go.jp/app/hanrei_en/detail?id=1483