

***Theme: Foreign Languages**

(1) In regards to trademarks in English, distinctiveness and similarity are judged based on academic ability of those who completed Japanese compulsory education (usually 15 years old). Other than that, the field that the designated goods or services are used in is also an important factor to this judgment. For example, French words are widely used in the cosmetics and apparel industry and German words are often seen in the medical and pharmaceutical industry.

However, without such special situations, French, German or Italian are not common foreign languages in Japan and are not understandable to the average Japanese. As a result, these foreign words are usually judged as distinctive. Also, the marks including these foreign words are judged dissimilar with the cited marks.

(2) One of the problems that trademarks in foreign languages have is how to pronounce them. Considering the situation mentioned above, it is hard for Japanese people to pronounce French or German words. Accordingly, the JPO identifies their pronunciation by how to pronounce in English first and judge distinctiveness and similarity based on its pronunciation.

In L'AIR DU TEMPS case (Tokyo high court H9 (Gyo-Ke) 164), the court judged that "L'AIR DU TEMPS" is pronounced in English since French pronunciation is difficult. However, the proprietor, *Nina Ricci* complained that they have sold their goods with the name "L'AIR DU TEMPS" in French, so consumers would recognize French pronunciation of "L'AIR DU TEMPS."

Actually, the cosmetic company, "FANCL" or the department store called "Printemps", which are both famous in Japan are recognized with their original names though they are pronounced differently in English. Thus, pronunciation of trademarks in foreign languages should be identified, considering actual business situation.

(1) Italian

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
speciale	30		2008-29428	"speciale" means "special".
Serie Fine	20		2004-3478	"Serie Fine" means "fine set" or "fine series".
ABito	25		H10(1998)-9021	"abito" means "apparel or suit".
LA TAVOLA	Old 19		S59(1984)-6902	"tavola" means "table".
BOTTEGA	Old 29		S59(1984)-21907	"bottega" means "shop" or "store".

Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
1000 MIGLIA	=	MIGLIA	Old 12	H2(1990)-23420	"MIGLIA" means "mile".

(2) English

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
TALISMAN	Old 21		S56(1981) - 24273	
MADONNA LILY	Old 4		H1(1989)-5648	"Madonna lily" is a kind of natural fragrance but it is not so familiar in Japan, so they would recognize the well-known words, "Madonna" and "lily" separately and assume that "Madonna lily" is a coined word.

(3) Spanish

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
DE BELLOTA	29		2002-14781	"bellota" means "acorn".
CAFETÍN	Old 18		S60(1985)-17123	"cafetin" means "small cafe".
PICADOR	Old 26		S57(1982)-7334	

(4) Chinese

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
美磻 BIHATSU	Old 4		H2(1990)-14678	"美磻" means "beautiful hair".
女孩子	Old 22		S57(1982)-23936	"女孩子" means "a girl".
男孩子	Old 22		S57(1982)-12982	"男孩子" means "a boy".

Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
超硬	X	CHANGHONG 长虹	9	2003-16238	Judged as phonetically dissimilar. The Chinese characters in the cited mark are not usually used in Japan, so consumers are not able to pronounce them.

(5) German

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
TOKIO	36		2002-7417	"Tokio" means "Tokyo".
HONIG	Old 30		S59(1984)-16197	"honig" means "honey".

Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
KÜCHEN MEISTER	X	CHEF	Old 19	S56(1981)-571	"KÜCHEN MEISTER" means "kitchen master (= chef)".

(6) French

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
LE CHEVEU	3		2006-15916	"cheveu" means "hair".
Classe d' Or	33		2000-556	"classe d' or" means "gold class".
bleu bleu bleue	18		2002-9251	Both "bleu" and "bleue" mean "blue".
PEAU	Old 4		S63(1988)-18258	"peau" means "skin".
NOIR	Old 4		S59(1984)-22554	"noir" means "black".
AZUR FRAGRANCES	Old 4		S62(1987)-1370	"azur" means "sky-blue".
HUIT	25		2007-900563	"huit" means "eight".

Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
HUIT	X	8 (logo)	25	2007-900563	"huit" means "eight".

(7) Portuguese

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
FAZENDA	Old 29		S55(1980)-5306	"fazenda" means "ranch" or "farm".

(8) Greek

Distinctiveness (: distinctive, X : Non-distinctive)

Trademark	Class	Distinctiveness	Case No.	Memo
-Socket	9		2007-28193	
LAMBDA	Old 11		S60(1985)-6533	
	Old 11	X	S56(1981)-23157	Rejected because the mark is consisted solely of a very simple and commonplace mark (Japanese Trademark Law § 3-1-5). The trademark, " ", " ", " ", " " are also rejected because of the same reason.

Similarity (= : Similar, X : Dissimilar)

Trademark	Similarity	Cited Trademark	Class	Case No.	Memo
μ PD	=	μ PD	Old 11	S63(1988)-19170	" " and " μ PD" are separable because of the size of the letters.
Express	=	EXPRESS	9	2000-10373	" " is described bigger than "Express", so these are separable.
STAGE	X	STAGE	9	2003-19314	
B A B N	X	BABYLONE	14	2002-90300	