

Latest Court Decisions

2017:

[February]

• **NYLON Case (Cancellation Suit of Trial Decision)**

IP High Court 2017.2.23 H28(Gyo-Ke)10178

[SUMMARY/INTRODUCTION]

A Japanese company filed a trademark application for the word mark "NYLON" requesting registration for the retail services of clothing, footwear and bags in Class 35.

NYLON

The JPO rejected the application because the trademark "NYLON" fell under Article 3-1-6 of the Trademark Law rejecting a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

NYLON is a name of a synthetic fiber that is a material of clothing, footwear and bags. In addition, the applied-for trademark "NYLON" was a title name of a fashion magazine issued by the applicant as a Japanese version of a US magazine.

Should the trademark "NYLON" be registered as a retail shop name of clothing, footwear and bags in Class 35 ? What was the Court decision ?

[Case]

The IP High Court firstly confirmed that the Fiber Product Quality Labeling Regulation issued by the Consumer Affairs Agency provides that the word "NYLON" has to be used for nylon fiber products as the fiber composition of clothing.

Then, the Court admitted that the retail services of clothing, etc. are service activities such as a large selection of goods, display thereof and services to customers to finally obtain profits by sales of a line of goods. The services include those of explanation of materials and other features of goods so that customers may easily select the goods.

Accordingly, if customers see the trademark "NYLON" used for, for instance, clothing at a retail shop, they merely acknowledge that the materials used for the clothing are nylon fabrics and the customers do not understand from the trademark "NYLON" that indicates the origin of the retail services. On these grounds, the Court rejected the registration of the trademark "NYLON" in Class 35.

As to the fact that the trademark "NYLON" is the title name of the plaintiff's fashion magazines, the Court judged that the consumers of the plaintiff's retail shop are various people irrespective of sex and age that include ones who have a deep or limited interest in fashion. It can be easily assumed that the number of people who know the plaintiff's NYLON fashion magazine is less than that of people who did not know the NYLON magazines.

Therefore, the fact of the magazine title did not serve as a useful fact to increase the distinctiveness as a trademark for the retail fashion shop.

For your information, according to the Trademark Examination Standards on Similarity of Goods and Services in Japan, the goods "clothing" in Class 25 are similar to "retail services for clothing" in Class 35. Therefore, an applied-for trademark in Class 35 is to be rejected by a prior similar trademark in Class 25.

That is to say, the specified goods in Classes 1 to 34 are in principle regarded as similar to the retail services for these goods in Class 35. However, the Examination Standards, for instance, does not regard "hamburgers" in Class 30 as similar to hamburger shops in Class 43.

Likewise, "computer programs" in Class 9 are regarded as similar to "providing computer programs" in Class 42, but they are not similar to "computer programing" in Class 42.

Therefore, you should be sufficiently careful to select goods and services when filing new trademark applications.