"ARICA" Case

Supreme Court

Case H21 (Gyo-hi) 217, Judgment on December 20, 2011 (H23)

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FACTS

A trial was filed by the appellant for rescission of trademark registration of the appellee's Trademark Registration No. 4548297, pertaining to the designated services in Class 35 such as "provision of information concerning sales of goods", by reason of the non-use of the registered trademark. After a decision was rendered by the Intellectual Property High Court to rescind the decision of rescission made by the Japan Patent Office, the appellant filed an appeal to the Supreme Court.

The appellee is engaged in the business of planning, production, sales, etc. of game software programs. The appellee, in the course of presenting on its own website the game software programs that it had developed independently, indicated the Trademark on the said website. The appellee indicated on the said website the date of release, allowable number of players, price, and other matters regarding the game software programs for which the appellee participated in the development projects and which were put on sale by Company A. The appellee also indicated on the said website the content, specification, price, date of release, method of purchase, and other matters regarding the music CDs, which contained the music works used in the game software programs that the appellee had developed independently, and which were put on sale by Company B.

ISSUE

The issue is whether or not an activity of introducing the goods of its own and the other companies to the consumers through websites fall under the designated services of "provision of information concerning sales of goods", and in relation thereto, how the meanings of services should generally be construed.

HOLDING

It is appropriate to construe the meaning of the goods or services specified in the Appended Table of the Ordinance for Enforcement of the Trademark Act by taking into

account factors such as the heading given to the relevant class in the Appended Table of the Order for Enforcement of the Trademark Act, the content and nature of the goods or services specified as falling within the relevant class in the Appended Table of the Ordinance for Enforcement of the Trademark Act, the description of the goods or services as indicated in the explanatory notes attached to the list of classes which constitute part of the international classification, and the standards for determining identicalness for each similar group under the Examination Guidelines for Similar Good and Services.

Considering that Class 35 of the Appended Table of the Order is under the heading of “advertising, business management or administration, and office functions”, and that the explanatory notes attached to the list of classes which constituted part of the international classification applicable at the time of the application for the Trademark Registration (7th Edition of the Nice Classification) provide that Class 35 includes “mainly services (omitted) principally with the object of help in the working or management of a commercial undertaking, or help in the management of the business affairs or commercial functions of an industrial or commercial enterprise”, the phrase "provision of information concerning sales of goods" can be regarded as referring to a service characterized by the nature of helping a commercial enterprise in its management or administration. Also taking into account the wording of the phrase, it is appropriate to construe that the phrase "provision of information concerning sales of goods," specified in the Appended Table of the Ordinance, refers to the service of providing a commercial enterprise with information for helping its management or administration. Hence, an activity to present goods to consumers, the end users of the goods, cannot be regarded as “provision of information concerning sales of goods”.

According to the facts mentioned above, it was nothing more than such acts wherein the appellee, in the course of presenting on its website the game software programs that it had developed, also presented to consumers on the said website the goods that were sold by other companies. These kinds of acts cannot be regarded as providing a commercial enterprise with information for helping its management or administration. Therefore, there is no such proof that the appellee had used the Trademark in connection with any of the Subject Services.

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Original document (Japanese):
http://www.courts.go.jp/app/files/hanrei_jp/841/081841_hanrei.pdf

English translation:
http://www.courts.go.jp/app/hanrei_en/detail?id=1133