

Tsu-tsu-mi-no-o-hi-na-kko-ya Case
Similarity of a compound word mark
Supreme Court
Case H19 (Gyo-Hi) No. 223 (September 9, 2008)

The registered trademark "つつみのおひなっこや [tsu-tsu-mi-no-o-hi-na-kko-ya] " which includes another trademark, is not considered similar to prior registered trademark "堤 [tsu-tsu-mi] ", which acquired distinctiveness through continuous use.

FACTS

1. The mark "つつみのおひなっこや, pronounced "tsu-tsu-mi-no-o-hi-na-kko-ya", was registered under Reg. No. 4,798,358 in October 2004, whereupon the owner of the trademark "堤", which is read "tsu-tsu-mi" (Reg. No. 2,365,147, December 1999), lodged an Invalidation Trial against the above-mentioned registration. Both marks designate dolls,
2. In the Patent Office, the Trial Examiner denied the possibility of confusion of the marks and the owner of the prior-registered mark lost the case. However, the Tokyo High Court found a possibility of confusion, noting that the pronunciation "tsu-tsu-mi" separately derives from the prior-registered trademark, and thus "tsu-tsu-mi-no-o-hi-na-kko-ya" is considered similar to "tsu-tsu-mi" in pronunciation.

In Japanese, "no" is equivalent to "of", and thus "tsu-tsu-mi-no-o-hi-na-kko-ya" is interpreted to mean "o-hi-na-kko-ya" of "tsu-tsu-mi". Japanese Old Class 28. In addition, there was a history that the prior-registered trademark, "堤"("tsu-tsu-mi)", had been judged by the JPO to be qualified for registration due to its distinctiveness acquired through continued use pursuant to Trademark Law Art.3(2).

ISSUE

Whether a compound word mark, that is, a trademark consisting of a combination of words one of which is a registered mark, is confusingly similar to that registered word mark that is one the words of the combination.

DECISION

The Supreme Court followed precedent and vacated the judgment of the IP High Court. The Supreme Court found that the marks in question are not considered similar, based on its finding that the "tsu-tsu-mi" part does not give a strong impression as an indication of the source of the goods and that the remaining part "no-o-hi-na-kko-ya" (once a common noun but now archaic) is distinctive, even though the word "tsu-tsu-mi" constitutes a part of the mark in question.

The point is this: In principle, the trademark as a whole shall be compared with

another. However, in a case in which (a) one part of the trademark gives a strong impression as an indication of the source of the goods or services AND (b) the remaining part is not distinctive, the parts can be separately compared.