



Conflict of Composite Marks

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Agenda

1. Method of determining the similarity of composite marks
2. Court case review
 - (1) Reebok ROYAL FLAG case
 - (2) GINZA CLEAR case
 - (3) EMPIRE STEAK HOUSE case

Agenda

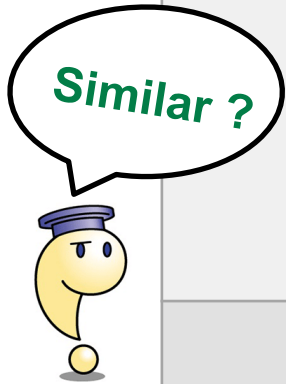
1. Method of determining the similarity of composite marks
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1. Method of determining the similarity of composite marks

Composite mark:

A trademark comprising a combination of **two or more** elements

1. Method of determining the similarity of composite marks



VS



VS

clear



VS

EMPIRE

1. Method of determining similarity of composite marks

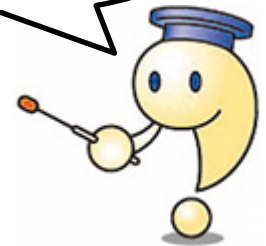
Basic principle: **Anti-Dissection Rule**

Consider **the entirety of the mark** rather than dissecting it into individual elements.

Under **certain circumstances**:

Can be dissected into individual elements.

Three types of circumstances!


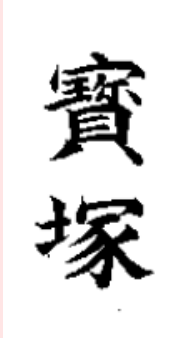


1. Method of determining similarity of composite marks

Criteria

1. In a case where each element is **not combined strongly enough** to consider that **it is unnatural to observe them separately**.

** LYRATAKARAZUKA v. TAKARAZUKA, Supreme Court, 1962 (O) 953, (December 5, 1963).*

Applied Mark	Cited Mark
	 <p data-bbox="1282 932 1638 1093">Read as "TAKARAZUKA" in Japanese</p>
Supreme Court: Similar (Refused to register)	

1. Method of determining similarity of composite marks

Factors to consider

- Differences in font, size, and color
- Difference in types of characters, such as Japanese characters and English
- Each element is placed separately
- The overall sound is redundant
- No conceptual connection between the elements

1. Method of determining similarity of composite marks

Criteria

In a case

2. where the particular element is found to **give a strong and dominant impression** to traders and consumers for distinguishing the origin of goods and services

(Dominant feature),

or

3. where the remaining elements **do not generate sound or concept as a source identification** of goods and services.

1. Method of determining similarity of composite marks

Basic principle: [Anti-Dissection Rule](#)

Can be [dissected into](#) individual elements in cases where:

1. Each element is [not combined strongly enough](#) to consider that it is [unnatural to observe them separately](#).
2. The particular element gives [a strong and dominant impression](#) to traders and consumers for distinguishing the origin of goods and services.
3. The remaining elements [do not generate sound or concept as a source identification](#) of goods and services.



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2. Court case review

2-1. Reebok ROYAL FLAG case

**Reebok ROYAL FLAG v. ROYAL FLAG, IP High Court, 2015 (Gyoke) 10159, (January 20, 2016)*

Appeal case against the JPO decision

Applied Mark



Cited Mark

ROYAL FLAG

Class 25: Footwear; Special footwear for sports; etc.

JPO Decision: **Similar (Refused to register)**

IP High Court: **Dissimilar (Registered)**

2. Court case review

2-1. Reebok ROYAL FLAG case

IP High Court reversed the JPO Trial decision, finding as follows:

- The term “REEBOK” is **famous** among Japanese traders and consumers. The “REEBOK” portion provides **a strong and dominant impression** as a source identification because of its fame.

The REEBOK portion can **function as a source identification independently**.

2. Court case review

2-1. Reebok ROYAL FLAG case

- The applied mark places a flag image prominently in the center of the mark.
 - The term “Reebok,” written in a stylized distinctive font, is indicated above the flag image.
 - The term “ROYAL FLAG” is written in a much smaller font than the flag image and the “Reebok” portion.
- ⇒ It cannot be said that the “ROYAL FLAG” portion draws the consumer’s attention independently.



2. Court case review

2-1. Reebok ROYAL FLAG case

IP High Court reversed the JPO Trial decision, finding as follows:

- The term “ROYAL FLAG” is not listed in dictionaries. But it is a combination of easy English words. **It does not make a strong impression** as a source identification **in comparison to the term “Reebok.”**

2. Court case review

2-1. Reebok ROYAL FLAG case

IP High Court Decision

Conclusion:

It is **inappropriate to extract only the “ROYAL FLAG” portion** to be compared with the cited mark. The applied mark is **dissimilar** to the cited mark.



2. Court case review

2-2. GINZA CLEAR case

*GINZA CLEAR v. clear, IP High Court, 2022 (Gyoke) 10119, (May 18, 2023)



Appeal case against the JPO decision

Applied Mark



Cited Mark

clear

in standard characters

Class 3: Cosmetics; etc.
Class 25: Clothing; etc.

JPO Decision: **Similar (Refused to register)**

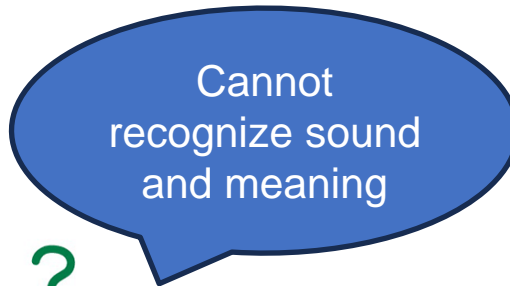
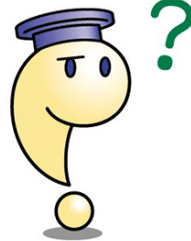
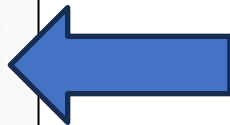
IP High Court: **Similar (Refused to register)**

2. Court case review

2-2. GINZA CLEAR case

IP High Court upheld the JPO Trial decision, finding as follows:

- The figure portion is highly stylized. Consumers would not understand which characters have been designed.
The figure portion does not generate sound and meaning as a source identification.



2. Court case review

2-2. GINZA CLEAR case

IP High Court upheld the JPO Trial decision, finding as follows:

- GINZA is the name of a place. It is often observed that GINZA is used to indicate a place of sale, the location where services are provided, or the place of origin of a brand.

⇒The GINZA portion does not generate sound or meaning as a source identification.

2. Court case review

2-2. GINZA CLEAR case

IP High Court upheld the JPO Trial decision, finding as follows:

- The term CLEAR is an easy English word that is familiar among Japanese consumers.
 - The term CLEAR attracts consumers' attention because it does not indicate the characteristics of the goods and services specifically.
 - The term CLEAR is written in a larger size than the GINZA portion.
 - The image portion is visually divided from the letter portions.
- ⇒ **The CLEAR portion gives a strong and dominant impression** for distinguishing the origin of goods and services.

2. Court case review

2-2. GINZA CLEAR case

IP High Court Decision

Conclusion:

It is permitted to focus on only the “CLEAR” portion for comparison with the cited mark. The applied mark is **similar** to the cited mark.

2. Court case review

2-3. EMPIRE STEAK HOUSE case

**EMPIRE STEAK HOUSE v. EMPIRE, IP High Court, 2022 (Gyoke) 10087, (January 17, 2023)*

Appeal case against the JPO decision

Applied Mark



Cited Mark

EMPIRE
(in standard characters)

Class 43: Steak restaurant services; etc.

JPO Decision: **Similar** (Refused to register)

IP High Court: **Similar** (Refused to register)

2. Court case review

2-3. EMPIRE STEAK HOUSE case

IP High Court upheld the JPO Trial decision, finding as follows:

- The bull image and the term “EMPIRE STEAK HOUSE” are **visually separated**.
- The term “STEAK HOUSE” is commonly used to indicate the characteristics of restaurant services. The “STEAK HOUSE” portion has **no or very little distinctiveness** in relation to “steak restaurant services.”
- The term “EMPIRE” does not describe any characteristics of the designated services. The “EMPIRE” portion is **distinctive and could make a strong impression on consumers**.

2. Court case review

2-3. EMPIRE STEAK HOUSE case

IP High Court Decision

Conclusion:

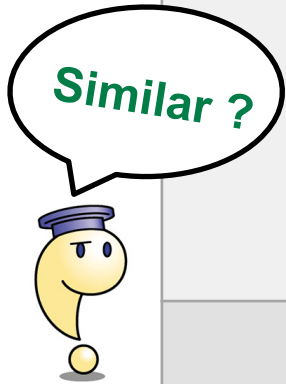
It is appropriate to extract the EMPIRE portion for comparison with the cited mark. The applied mark is **similar** to the cited mark.



Summary

- Basic principle: **Anti-Dissection Rule**.
- Permitted to assess the similarity by **dissecting into individual elements under certain circumstances**.
- If each element can be **visually separated**, the mark is highly likely to be dissected into individual elements.
- If the elements have no conceptual connections, the mark tends to be dissected into individual elements.
- If the mark contains a famous or well-known mark, that part could be extracted (**Dominant feature**).
- If the mark includes **indistinctive or weak distinctiveness** elements, that part could be disregarded.

1. Method of determining the similarity of composite marks



VS



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2. Court case review

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2-3. EMPIRE STEAK HOUSE case

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Thank you for your attention.



Chihiro IJIMA
Trademark Attorney

Any Questions?

