O/0924/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

INTERNATIONAL APPLICATION NO WO0000001727990
IN THE NAME OF SHIN-EI ANIMATION CO., LTD.
AND OPPOSITION NO. 442005
BY JAPAN GREEN HEARTS CO., LTD

AND

UK REGISTRATION NO. 3827800
IN THE NAME OF JAPAN GREEN HEARTS CO., LTD.
AND AN APPLICATION FOR DECLARATIONS OF INVALIDITY
THERETO UNDER NO. 506846
BY SHIN-EI ANIMATION CO LTD AND TOMOKI MISATO

BACKGROUND AND PLEADINGS

1. This decision deals with two cross-consolidated actions between Shin-ei Animation Co Ltd (Shin) and JAPAN GREEN HEARTS CO., LTD. (Japan). The actions include (i) an opposition (no. 442005) filed by Japan against an application by Shein to obtain protection in the UK for its International Registration ("IR") no. WO0000001727990, and (ii) an application for a declaration of invalidity (no. 506846) filed by Shin and Mr Tomoki Misato against the UK trade mark registration no. 3827800 which is relied upon by Japan in the opposition.

2. I will set out initially the background to each of the proceedings.

THE OPPOSITION NO. 442005 AGAINST SHIN'S INTERNATIONAL APPLICATION NO. WO0000001727990.

3. International trade mark no. WO0000001727990 ("the IR") consists of the sign shown below:

PUIPUI MOLCAR

4. Although the IR is shown as a figurative mark, it is a word-only mark. It derived from a Japanese mark that is a word-only mark.[1] The applicant is Shin. The IR is registered with effect from 30 September 2022. With effect from the same date, Shin designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. Shin seeks protection for the IR in relation to a long list of goods and services in class 2, 8, 9, 11, 12, 14, 15, 15, 18, 20, 21, 24, 25, 26, 28, 29, 30, 32, 35, 41 and 42 (as set out in Annex 1). The request to protect the IR was published on 19 May 2023. On 19 July 2023, Japan filed an opposition against the protection of the IR in the UK based upon Sections 5(1) and 5(2)(a) of the Trade Marks

[1] On 15 August 2023 Japan filed copy of the Japanese registration 6555523 from which the IR derives showing that it is recorded as a word mark and upon review of the marks, the Registry accepted that the IR is identical to Japan's mark which is a word-only mark allowing the opposition to proceed on the grounds of 5(1) and 5(2)(a).

Act 1994 ("the Act")[2]. The opposition is limited to all the goods and services in class 28 and 41, namely:[3]

> **Class 28:** *Amusement machines and apparatus for use in amusement parks; arcade video game machines; toys for domestic pets; toys; stuffed toy animals; plush toys; toy figurines; novelty toys; sporting equipment (balls); infant toys; tesselation toys; construction toys; fidget toys; clockwork toys; water toys; pet toys; inflatable toys; stuffed toys; plush toys; musical toys; talking toys; sketching toys; printing toys; pull toys; bendable toys; drawing toys; mechanical toys; bathtub toys; sandbox toys; bath toys; push toys; stacking toys; knitted toys; sand toys; squeeze toys; vending machine toys; action figure toys; music box toys; electronic action toys; mechanical action toys; spinning fidget toys; electric action toys; inflatable pool toys; lever action toys; tossing disc toys; flying saucers [toys]; rubber character toys; ride-on toys; squeezable squeaking toys; infant development toys; plastic character toys; transforming robotic toys; soft sculpture toys; pop up toys; disc toss toys; wind-up toys; water squirting toys; interlocking construction toys; helical spring toys; soft knitted toys; smart plush toys; smart robot toys; non-riding transportation toys; stress relief exercise toys; construction toys incorporating magnets; stands for rideable toys; scale model kits [toys]; stuffed and plush toys; wind-up walking toys; magnetic putty being toys; magnetic levitating desk toys; inflatable ride-on toys; pop tube fidget toys; soft sculpture plush toys; inflatable thin rubber toys; battery operated action toys; rideable toys and accessories therefor; toys, namely, bean bag animals; articles of clothing for toys; plush toys in a gift basket; children's multiple activity toys; inflatable toys showing decorative pictures; novelty plush toys for parties; toy aircraft; toy models; toy jewelry; toy brooches; toy tools; toy animals; toy cars; toy whistles; toy balloons; toy mailboxes; toy glockenspiels; toy pianos; toy masks; toy houses; toy airplanes; toy glowsticks; toy stamps; toy figures; toy noisemakers; toy gliders; toy banks; toy harmonicas; toy xylophones; toy helicopters; toy boats; toy pinwheels; toy microscopes; toy cookware; toy cameras; toy vehicles; toy robots; toy drones;*

[2] Japan initially pleaded Section 5(3) but later withdrew it

[3] Initially the opposition contained an additional ground under Section 5(3) which was directed against the entire specification, however, that ground was subsequently withdrawn on 20 December 2023.

toy watches; toy telescopes; toy scooters; toy strollers; toy rockets; toy looms; toy putty; toy mobiles; toy building structures and toy vehicle tracks; pvc toy figures; model toy vehicles; rideable toy vehicles; plastic toy hoops; electronic toy vehicles; molded toy figures; collectable toy figures; toy modelling dough; luminous toy putty; toy building blocks; toy insect cages; toy insect nets; toy modeling compounds; toy building structures; toy vehicle tracks; miniature toy helmets; toy butterfly nets; toy music boxes; stuffed toy bears; toy prism glasses; toy model cars; toy zip guns; toy construction blocks; toy cap pistols; positionable toy figures; toy hoop sets; toy air pistols; toy glow sticks; toy beanbags [otedama]; toy prism spectacles; toy stuffed animals; cases for toy vehicles; caps for toy pistols; interchangeable magnetic toy vehicles, non-electronic toy vehicles; model toy steam engines; toy clocks and watches; radio-controlled toy vehicles; remote-controlled toy planes; remote-controlled toy vehicles; toy LED light sticks; toy model kit cars; modeled plastic toy figurines; transforming robotic toy vehicles; wheels for toy vehicles; cases for toy structures; visors for toy helmets; electronically operated toy motor vehicles; toy scooters and accessories therefor; toy figures and attachable, wearable or magnetic accessories therefore; toy vehicles, namely, caster boards; talking electronic press-down toy; toy buildings and accessories therefor; toy animals and accessories therefor; toy vehicles and accessories therefor; toy vehicles with transforming parts; self-erasing toy drawing boards; cases for toy of cars; cases for toy of airplanes; cases for toy of boats; play houses and toy accessories therefor; hand-powered non-mechanical flying toy; model toy steam operated traction engines; toy building blocks capable of interconnection; toy projectile shooters and accessories therefor; toy glow stick bracelets for parties; toy action figures and accessories therefor; toy hand buzzers for playing jokes; play mats for use with toy vehicles; positionable printed toy figures for use in puzzles; positionable printed toy figures for use in games; novelty toy items in the nature of artificial plush animal tails; racks and stands specifically designed to hold toy vehicles; racks and stands specifically designed to hold toy scooters; toy vehicle track sets and roadways and accessories therefor; toy model vehicles and related accessories sold as units; clockwork toys of metal; paper toys; karuta playing cards [Japanese card game]; plush toys; stuffed toys; plastic toys; clockwork toys of plastics; rubber

toys; rubber balls; toy musical boxes; toy sets; toy construction sets; toy sets of carpenters' tools; marbles; toy pistols; toy fireworks; home video game machines; toy christmas trees; hand-held games with liquid crystal displays; four-wheeled toy vehicles; soap bubbles [toys]; kites; menashi-daruma [bodhidharma dolls without pupils]; rocking horses; tricycles for infants [toys]; inflatable swimming pools [play articles]; ring games; japanese traditional dolls; osuwari dolls [dolls in sitting position]; kokeshi dolls; sakura dolls; clothes for Japanese traditional dolls; european style dolls; clothes for European dolls; traditionally dressed western dolls; dolls; go board games; travel games - checkers; go games; go stones; goke pots [pots for stone pieces used in go games]; go boards; japanese chess [shogi games]; wooden pieces for shogi game [koma]; shogi boards; japanese playing cards [utagaruta]; japanese dice games [sugoroku]; chinese checkers [games]; checkers [checker sets]; japanese playing cards [hanafuda]; dice; sugoroku board games; cups for dice; chess games; checkers games; conjuring apparatus; apparatus for performing magic tricks; dominoes; playing cards; mah-jong; game machines and apparatus; billiard equipment; sports equipment; sports equipment, other than for climbing, surfing, water-skiing and scuba diving; climbers' harness; fishing tackle; butterfly nets; jigsaw puzzles; golf bag carts; golf bag trolleys; confetti.

Class 41: *Lottery services; arranging of donation of human corpses for medical education; arranging, conducting and organization of seminars; animal training; plant exhibitions; animal exhibitions; providing electronic publications; providing electronic publications of animation film; reference libraries of literature and documentary records; book rental; art exhibition services; gardens for public admission; caves for public admission; publication of books; arranging and planning of movies, shows, plays or musical performances; theatrical release of animation film; providing videos from the internet, not downloadable; providing films, not downloadable, via video-on-demand transmission services; movie theatre presentations or movie film production and distribution; production and theatrical release of animation film; providing digital music from the Internet, not downloadable; providing television programs in the fields of animation and music via a global computer network; providing television programmes, not downloadable, via video-on-demand transmission services;*

production of music; music composition services; organization of fashion shows for entertainment purposes; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; directing of radio and television programs; production of radio and television programmes; operation of video and audio equipment for the production of radio and television programs; organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; organization, arranging and conducting of horse races; organization, arranging and conducting of bicycle races; organization, arranging and conducting of boat races; providing audio or video studio services; providing sports facilities; providing amusement facilities; providing facilities for movies, shows, plays, music or educational training; booking of seats for shows; rental of cinematographic apparatus; rental of cine-films; rental of musical instruments; rental of television sets; rental of radio sets; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; rental of film negatives; rental of reversal film; toy rental; rental of amusement machines and apparatus; rental of game machines and apparatus; rental of paintings and calligraphic works; photography; language interpretation; translation; rental of cameras; animation production services; animation movie theatre presentations or animation movie film production and distribution; production, distribution, and theatrical release of animation film; entertainment in the nature of animated and live action television series; entertainment services; providing animation images and videos via the Internet; providing online information to members in the fields of animation, movies, and music via a global computer network; providing entertainment information via a web site; entertainment services, namely, providing online, non-downloadable videos in the fields of animation and music; providing information in the field of entertainment; game services provided online from a computer network; online distribution of a computer game; video editing services for events; videotape editing; dubbing; layout services, other than for advertising purposes; rental of indoor aquaria; rental of lighting apparatus for theatrical sets or television studios; rental of

show scenery; modelling for artists; face painting; photographic reporting; news reporters services.

5. Under both Sections 5(1) and 5(2)(a), the opponent relies upon the single earlier mark shown below and the goods and services covered by it:

UK00003827800
PUIPUI MOLCAR
Filing date: 08 September 2022
Date of entry in register: 02 December 2022

Class 28: *Amusement machines and apparatus for use in amusement parks; toys for domestic pets; toys; dolls; Go games; Japanese chess [Shogi games]; Japanese playing cards [Utagaruta]; dice; Japanese dice games [Sugoroku]; cups for dice; Chinese checkers [games]; chess games; checkers [checker sets]; conjuring apparatus; dominoes; playing cards; Japanese playing cards [Hanafuda]; mah-jong; game machines and apparatus; billiard equipment; sports equipment; fishing tackle; butterfly nets.*

Class 41: *Operating lotteries; educational and instruction services relating to arts, crafts, sports or general knowledge; arranging, conducting and organization of seminars; animal training; plant exhibitions; animal exhibitions; providing electronic publications; services of reference libraries for literature and documentary records; book rental; art exhibitions; gardens for public admission; caves for public admission; publication of books; arranging and planning of movies, shows, plays or musical performances; providing videos from the internet, not downloadable; providing image data from the internet, not downloadable; movie theatre presentations or movie film production and distribution; providing digital music from the Internet, not downloadable; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; directing of radio and television programs; operation of video and audio*

equipment for production of radio and television programs; organization, arranging and conducting of sports competitions; organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; organization, arranging and conducting of horse races; organization, arranging and conducting of bicycle races; organization, arranging and conducting of boat races; organization, arranging and conducting of auto races; providing audio or video studio services; providing sports facilities; providing amusement facilities; providing facilities for movies, shows, plays, music or educational training; booking of seats for shows; rental of cinematographic machines and apparatus; rental of cine-films; rental of musical instruments; rental of sports equipment; rental of television sets; rental of radio sets; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; rental of film negatives; rental of reversal film; toy rental; rental of amusement machines and apparatus; rental of game machines and apparatus; rental of paintings and calligraphic works; photography; language interpretation; translation; rental of cameras; rental of optical machines and apparatus; animated cartoon production service; theatre presentations or production and distribution of animated cartoons movies; entertainment in the nature of animated and live action television series; providing animated cartoons from the internet, not downloadable; game services provided online from a computer network.

6. Under the section 5(1) ground, Japan claims that the marks are identical and that the goods and services are identical. Alternatively, Japan relies on the section 5(2)(a) ground and claims that the marks are identical, and the goods and services are similar, giving rise to a likelihood of confusion.

7. Shin filed a counterstatement in which it denies the validity of the earlier mark referring to the reasons set out in the invalidity action (see below). It also denies that the average consumer will be confused as to the commercial origin of the goods (and services) on the basis that Shin *"is the genuine originator of such goods and services".*[4] Notably, Shin did not deny the identity or similarity of the goods and services in its pleadings. I shall return to this point, if it becomes necessary.

[4] See Paragraph 7 of the counterstatement

THE INVALIDITY NO. 506846 AGAINST JAPAN'S TRADE MARK REGISTRATION NO. UK00003827800.

8. In response to Japan's opposition, Shin and Mr Tomoki Misato applied jointly to invalidate Japan's earlier trade mark no. UK00003827800 in full. The application for invalidity was filed on 27 December 2023 and is based upon Sections 5(4)(a), 3(6), 5(4)(b) and 5(6) of the Act. The invalidity based on Section 5(4)(a) was subsequently narrowed down to some of the goods and services in class 28 and 41 as set out in Annex 2, however, under the other grounds the invalidity continues to be directed against the entire specification.

9. Under Section 5(4)(a) Shin and Mr Misato claim to have used the sign **'PUI PUI MOLCAR'** since **March 2021** throughout the UK in relation to *Children toys, stuffed toys, video games, music soundtracks*. On 22 October 2025 (less than two weeks before the hearing took place), Shin and Mr Misato requested to amend these pleadings to add also reliance on *animated TV series*, which I allowed for the reasons I gave at the hearing (and are properly reported in the transcript). The claim is that Shin has made extensive use of the mark 'PUI PUI MOLCAR' throughout the UK in relation to an animated television series and a range of associated merchandise. Shin and Mr Misato claim that the series has been available for viewing in the UK on Netflix since at least as early as 2021 and that the registration is contrary to the law of passing off. In particular, Shin and Mr Misato claim that the show currently has two series, each consisting of 12 episodes. The first series was added to Netflix UK on 25 March 2021, whilst the second series has been available in the UK exclusively via Netflix since 17 March 2023 (i.e. after the filing date of 08 September 2022 for Japan's registration, which is the subject of the invalidity action).

10. Under Section 3(6), Shin and Mr Misato claims that Shin is a Japanese animation studio which has been creating, producing and distributing animated television series since 1976. Shin is the animation studio behind Doraemon and Crayon Shin-Chan which, it is said, are both popular anime series which have aired around the world for decades. There are three main actors in this dispute which revolves around the creation of a TV series that has been broadcast by Netflix; these are (1) Shin, who,

filed the cancellation jointly with Mr Misato, (2) Japan, who is the owner of the registered mark, and (3) Mr Misato who is allegedly the creator of the series. Shin and Mr Misato say that (i) Mr Misato conceived the idea for an animated stop-motion movie featuring plush guinea pigs and cars which, at the time, was called ‘MOLCAR’; (ii) Japan acted as a talent broker/agent for Mr Misato and introduced him to Shin; (iii) Mr Misato presented his concept to Shin in March 2019; (iv) Shin subsequently asked Mr Misato to create a full anime series entitled "Pui Pui Molcar" based on the original characters and storylines presented by Mr Misato to Shin. Shin and Mr Misato’s pleadings also refer to a contract in which Japan allegedly acknowledged that Shin and Mr Misato are the owners of all the intellectual property rights in the series. The pleadings also allege that the relationship between Japan and Mr Misato broke down after the former forced the latter to sign a contract relating to the second series under duress. Shin and Mr Misato say that the contract was dated 30 January 2021 and was later cancelled due to the improper way in which Mr Misato's agreement was obtained.

11. Shin and Mr Misato’s case under Section 3(6) is that Japan filed the mark in bad faith because it goes against a contract that recognised that the rights in the series belong to Shin and Mr Misato. Further, the relationship between the parties broke down in January 2021 when Japan was excluded from working on the second series of the show, 9 months before Japan applied for the marks subject to invalidity. Shin and Mr Misato claim that at the time of filing, it would have been clear to Japan that a second series of the show was being produced without its involvement and that it no longer acted as a broker for Mr Misato. Accordingly, Shin and Mr Misato claim that Japan’s registration was filed in bad faith.

12. Under Section 5(4)(b), Shin and Mr Misato claim that they are the owners of copyright in all aspects of the show, including the name **‘PUI PUI MOLCAR’**. They state as follows:

> *“The Invalidity Applicants are the owners of copyright in all aspects of the Show, as provided for under the Contract. It is submitted that the title of the show, PUI PUI MOLCAR is itself an original work which was a product of the author's intellectual creation and, as a result, is protected by copyright.*

The Contested Registration, is identical to the work protected by copyright (or at least a substantial part of it) and which has been copied by the Registrant. Any use of the Contested Registration could be prevented by the Invalidity Applicants as an infringement of this copyright pursuant to s.16 of the Copyright, Designs and Patents Act 1988. The Contested Registration should therefore be declared. invalid as it was registered contrary to s.5(4)(b) of the Act".

13. Under Section 5(6), Shin and Mr Misato claim that (i) Japan acted as an agent for Mr Misato and filed the contested mark in its own name without the consent of Mr Misato (ii) Japan knew that, as provided for in the contract and in any event, Shin and Misato were the rightful owners of all intellectual property rights associated with the show and (iii) Japan knew that the registration of the contested mark in the name of Shin and Mr Misato was without Mr Misato's consent. Accordingly, Shin and Mr Misato claim that the registration was liable to be refused pursuant to both Sections 5(6) and 3(6) of the Act. If Section 5(6) is successful, Shin and Mr Misato wish to apply for rectification under Section 10B(2)(b).

14. Japan filed a counterstatement denying the claim made and stating as follows:

- Japan accepts that Shin is a Japanese animation studio, but denies that it is well-known, or that it has been operating since 1976.

- Japan denies that Mr Misato "conceived" the basic concept behind 'PUIPUI MOLCAR', in other words, the combination of guinea pigs and cars. Mr Akiyoshi in his capacity as the director (president) of Japan was the person who conceived the idea of the combination of guinea pigs and cars and who subsequently presented his idea to Mr Misato. After Mr Akiyoshi conceived the said idea, Mr Akiyoshi was involved in leading Mr Misato in the creation and development of many central components of the 'MOLCAR' animation including but not limited to: the creation of the universe, the key concept, the characters and their construction as plush guinea pigs characters that are also cars, and the underlying narrative of 'MOLCAR'. Without Mr Akiyoshi's core idea to

combine guinea pigs with cars, ‘MOLCAR’ would not have come into the world. Together, Mr Akiyoshi for Japan leading Mr Misato, developed the plan for the ‘MOLCAR’ animation and Mr Akiyoshi proposed it to Shin, who subsequently requested that Japan be responsible for the creation of the ‘MOLCAR’ animation. This arrangement was made under contract. Japan is the party of the contact with Shin. Japan led and instructed Mr Misato and Mr Misato followed Japan’s lead and instructions during the creation of the animation. Therefore, it is denied that Japan acted as a broker or agent for Mr Misato.

- Japan denies that Japan entered into an agreement which stated that Shin and Mr Misato were the owners of all intellectual property rights in the animation series. Rather, and on the understanding that Japan and Mr Misato would be co-authors and co-creators of the animation series, **Japan agreed that the copyright in the work belonged to Shin and Mr Misato,** and did so as a gesture of goodwill and with high hopes for its business dealings with Shin and Shin fulfilling its role as a promoter of the ‘MOLCAR’ animation business and other obligations under the contract. No agreement was reached insofar as the trade mark rights are concerned, and any contention made by Shin and Mr Misato to the opposite is expressly denied.

- Any allegations as to the underlying cause of the relationship breakdown between Japan and Shin and Mr Misato are expressly denied, and this is especially true in the case of the concerning allegation that Japan placed Mr Misato under any form of duress. The real cause for the relationship breakdown resulted from Mr Misato betraying Japan’s trust and goodwill, who had, up until that point, shown great kindness and support to Mr Misato, a recent master's graduate needing assistance in commencing his career. This support was given on the understanding that Mr Misato continued his work as a freelance – it became difficult for Japan to continue this support because Japan discovered that Mr Misato had broken his promise and covertly accepted allegiance to another animation entity.

- In response to the claim made under Section 5(4)(a), it is denied that Shin is the sole entity to have made use of the mark, because the anime series and the creation and distribution of the related goods or activities relating to the marks are derived from a certain type of joint venture between Japan and Shin, as evidenced by a contract jointly entered into by both parties. Further, it is denied that the ownership of the mark rests solely with Shin and Mr Misato because Shin and Japan are party of the said joint venture. Japan received its rightful share of profits, duly paid to it by Shin, though Japan has noted that Shin has deliberately and wilfully neglected to pay shared profit to Japan as it is contractually obligated to do. In view of Japan's role as the originator of the plan for 'MOLCAR' animation and as creator and producer, and being an indispensable part of the said joint venture and the contract not stipulating the ownership of the mark, it is factually incorrect that Japan can claim no ownership rights to the trade mark.

- In response to the claim made under Section 3(6) and 5(6), Japan denied that entitlement to the trade mark was conferred to Shin and Mr Misato by virtue of the contract. Conversely, the contract dealt with the matter of the copyright contained within the animation work only, and no agreement as to entitlement to the trade mark was made within the contract. It is therefore denied that Japan had no right to file its trade mark registration. In addition, Japan denied that it was a mere broker for Mr Misato as it led the planning, production and creation of the 'MOLCAR' animation and Mr Misato followed Japan's lead. Japan is a co-author and co-creator of the animation and an indispensable constituent to the joint venture, since Japan has the right to consent whether to create subsequent series of the animation under the contract between Japan and Shin. Japan had every entitlement to be involved in the production of the second series of the animation, and therefore the assertion that Japan applied for its mark in bad faith upon being wrongfully excluded from the production of the second series is factually incorrect and baseless. In reality, the second series of the animation was created without Japan's consent. Shin intentionally breached its obligation to obtain Japan's consent required under the contract. Shin has shown dishonest behaviour by wilfully breaching the contract with

Japan by proceeding with the second sequel of the series absent the consent from Japan and by withholding Japan's rightful share of any profits made from the series. The fact that Shin and Mr Misato have turned now to the invalidation process reveals a blatant attempt to punish Japan further, abusing the trade mark system as a means to exert undue pressure on Japan, who is a comparatively smaller business than Shin, to settle the dispute over the trade marks and other related matters. Lastly, Japan denied that it acted in the capacity of a broker in regard to Mr Misato, instead, Japan acted as a mentor to Mr Misato. Japan is the primary originator and co-author and co-creator of the 'MOLCAR' animation and an indispensable part of the said joint venture, and the allegation made under Section 5(6) of the Act is therefore denied.

- In response to the claim made under Section 5(4)(b), Japan denied that copyright subsists in the title of the series.

15. On 04 April 2024, the proceedings were consolidated under Rule 62(1)(g) of the Trade Marks Rules 2008.

HEARING AND REPRESENTATION

16. Shin is represented by Venner Shipley LLP, and Japan is represented by Stevens Hewlett & Perkins. A hearing took place before me, by video conference, on 4 November 2025. Mr Jamie Muir Wood of counsel (instructed by Venner Shipley LLP) appeared for Shin and Mr Misato. Ms Beth Collett of counsel (instructed by Stevens Hewlett & Perkins) appeared for Japan.

Relevance of EU Law

17. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

18. Both parties filed evidence in these consolidated proceedings.

19. Shein and Mr Misato's evidence came in the form of four witness statements from the following individuals:

- Takehiko Irie - Mr Irie is the Executive Managing Director at Shin. His witness statement is dated 3 June 2024 and is accompanied by 14 exhibits being those labelled TI1 – TI14.

- Tomoki Misato – Mr Misato filed two witness statement, one dated 4 June 2024 (with exhibits TM1 – TM4), and another dated 16 October 2024 (with exhibits TM5 – TM8)

- Michihiko Umezawa – Mr Umezawa is Shin's president. His witness statement is dated 11 October 2024 and is accompanied by four exhibits being those labelled MU1 – MU4.

20. Japan's evidence came in the form of two witness statements from Akira Akiyoshi, one dated 2 August 2024 (with exhibits JGH1 – JGH14), and another dated 25 September 2024. Mr Akiyoshi is the director of Japan.

21. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

22. The ability of Japan to rely on its earlier trade mark in the opposition against Shin's trade mark application depends on the outcome of Shein and Mr Misato's application to invalidate Japan's earlier mark. Hence, I shall start with the application to invalidate Japan's earlier mark which is based on Sections 5(4)(a), 3(6), 5(4)(b) and 5(6) of the Act.

ADMISSIONS MADE AT THE HEARING

Section 5(4)(a) of the invalidity

23. At the hearing, Mr Muir Wood conceded that there are a handful of exhibits from Amazon showing merchandise being offered, but there are no sale figures in relation to merchandising and said that the stronger evidence about goodwill is in relation to the TV series. Accordingly, he accepted that there is no sufficient evidence to show goodwill in respect of merchandise, and I will say no more about this limb of the passing off case.

Section 5(4)(b) of the invalidity

24. At the hearing, Mr Muir Wood withdrew the claim that Shin and Mr Misato owns artistic copyright, having recognised the point made by Ms Collett that Japan's mark is a word-only mark. Nevertheless, he maintained that in respect of the made-up word 'MOLCAR', the made-up word 'PUIPUI' and their combination, they are free and creative choices that took place such that it is possible for copyright to subsist. However, I note that the pleadings refer to copyright in the title 'PUI PUI MOLCAR' as opposed to 'MOLCAR' and no request to amend the pleadings has been filed.

Section 5(1) and 5(2)(a) of the opposition

25. At the hearing, Mr Muir Wood conceded that, save for the following goods and services in Shin's application, the class 28 and class 41 gods and services of the application are at least identical or similar to some of the earlier goods and services:

> **Class 28:** *Stands for rideable toys; (rideable toys) and accessories therefor; articles of clothing for toys; cases for toy vehicles; caps for toy pistols; wheels for toy vehicles; cases for toy structures; visors for toy helmets; (toy scooters) and accessories therefor; (toy figures) and attachable, wearable or magnetic accessories therefore [sic]; (toy buildings) and accessories therefor; [toy animals] and accessories therefor; (toy vehicles) and accessories therefor;*

cases for toy of cars [sic]; cases for toy of airplanes [sic]; cases for toy of boats [sic]; play houses; (toy projectile shooters) and accessories therefor; play mats for use with toy vehicles; racks and stands specifically designed to hold toy vehicles; racks and stands specifically designed to hold toy scooters; (toy vehicle track sets and roadways) and accessories therefor; (toy model vehicles) and related accessories sold as units; inflatable swimming pools [play articles]; ring games; clothes for Japanese traditional dolls; clothes for European dolls; climbers' harness; jigsaw puzzles; golf bag carts; golf bag trolleys; confetti.

Class 41: *Arranging of donation of human corpses for medical education; providing television programmes in the fields of…music via a global computer network; production of music; music composition services; organization of fashion shows for entertainment purposes; providing online information to members in the fields of animation, movies, and music via a global computer network; providing entertainment information via a web site; providing information in the field of entertainment; video editing services for events; videotape editing; dubbing; layout services, other than for advertising purposes; rental of indoor aquaria; rental of lighting apparatus for theatrical sets or television studios; rental of show scenery; modelling for artists; face painting; photographic reporting; news reporters services.*

26. Accordingly, subject to Japan's earlier mark surviving the invalidity action, Mr Muir Wood conceded that the opposition under Section 5(1) and 5(2)(a) of the Act should succeed, save for the goods and services set out above.

27. Ms Collett, on her part, accepted that *arranging of donation of human corpses for medical education* are dissimilar and dropped the opposition in relation to these services.

28. Consequently, regardless of the outcome of these proceedings, Shin's IR will proceed to registration for the unopposed goods and services in classes 2, 8, 9, 11, 12, 14, 15, 15, 18, 20, 21, 24, 25, 26, 29, 30, 32, 35, and 42 as well as for *arranging of donation of human corpses for medical education* in class 41.

DECISION

THE INVALIDITY NO. 506846 AGAINST JAPAN'S TRADE MARK REGISTRATION NO. UK00003827800.

29. Sections 5(4)(a), 3(6), 5(4)(b) and 5(6) of the Act have application in invalidation proceedings by virtue of Section 47 of the Act, which states as follows:

30. The relevant parts of Section 47 state:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) […]
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
> >
> > unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> (2ZA)The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).
>
> […]
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

31. As Mr Muir Wood correctly pointed out at the hearing, this is a case whereby it is the factual matrix, the background behind it, which is perhaps more important to consider before one turns to the legal grounds of invalidation. Further, as Ms Collett very helpfully put it, in short, the key questions to be determined in the present case are as follows:

1. Does the contract provide that all intellectual property rights in the sign 'PUIPUI MOLCAR' accrue to Shin and Mr Misato?

2. Are Shin and Mr Misato the owners of the relevant goodwill in the claimed goods and services?

3. Was Japan acting as Shin and Mr Misato's agent when applying for the contested registration?

4. If the answer to any of the first three questions is yes, did Japan apply for the mark in bad faith?

32. Accordingly, with these questions in mind, I turn to the background and the evidence.

The Evidence

33. I will address the evidence of Shin and Mr Misato along with that of Japan insofar as it is relevant to the various factual points I need to determine under each ground.

The contract

34. The question I need to resolve in relation to the contract is whether it definitively determines the ownership of rights.

35. The evidence about the contract was filed by Mr Irie at Exhibit TI5. The contract is in Japanese and is accompanied by a non-certified translation. Mr Irie introduces the contract as follows:

> *"Following the presentation from Mr Misato in March 2019, [Shin] entered into a contract with Mr Misato and [Japan] instructing Mr Misato to create the Show. A copy of the Production Service Agreement entered into on 1 June 2019 is enclosed in Exhibit TI5, together with a copy of a Memorandum of Understanding entered into on the same date, English translations of both contracts are also included. Mr Misato was engaged by [Shin] as a freelance writer and director for the Show. [Japan] acted as an agent for Mr Misato in the negotiation of the Production Service Agreement and [Japan]'s role as an agent is reflected in the Production Service Agreement".*

36. The contract is headed "*Production Service Agreement for Stop Motion Animation "MOLCAR"* and is dated 1 June 2019. This is prior to the relevant date, which, in this case, is the filing date of Japan's registration, namely 08 September 2022.

37. The contract is between Shin and Japan and states that under the agreement Shin "*contracts out to Japan the production of the title specified in Article 1 ("Title") for the purpose described in Article 2 ("Purpose")"* (Article 1). Mr Misato is not part of the agreement however the contract (Article 2) states that Shin intends to execute the agreement with Japan *"as a representative for Mr Misato to contract out the Services to Misato".*

38. The propositions in the contract being relied upon by Mr Muir Wood are articles 1, 2, 3, 4, 5 and 8, 10, 17. Articles 1 and 2 are as follows:

Article 1 (Title)

1. The Title shall be as outlined in the table below.

Item	Particulars
Title	"MOLCAR" (working title)
Form	Stop motion animation
Running time/ Number of episodes	2 minutes and 40 seconds per episode 12 episodes
The scope of the Primary use	Broadcasting program title: *Kindah terebi* (Kinder TV) Broadcasting corporations: (i) Terrestrial television broadcasting: TV Tokyo network with local affiliates (TV Tokyo, TV Osaka, TV Aichi, TVQ Kyushu, TV Setouchi, and TV Hokkaido) (ii) Communication satellites (CS) broadcasting: Kids Station Broadcast period (Schedule): As of the execution of the Agreement, the broadcast periods for the Title are scheduled as below. Shin-ei shall promptly notify JGH of a change in those periods. (i) Two years starting from the day following the first airing of the Title's last episode on terrestrial television broadcasting. (ii) Two years starting from the day following the first airing of the Title's last episode on the Kids Station. Times of broadcasting: (i) 3 (three) times; (ii) 20 (twenty) times Broadcasting area: In the country of Japan Exploitations of the Title in any means or manner (mode) exceeding the scope of the Primary use shall be deemed "Secondary use," and the Primary use and the Secondary use shall be collectively referred to as "Exploitations."

2. Shin and Japan agree that Shin, who bears the production costs of the Title, has the exclusive authority of the Secondary use of the Title on behalf of both parties. The details of the Secondary use shall be provided in writing and executed between both parties separately.

In that case, Shin may, at its sole discretion, determine the details of exercising that right, the manner (mode) of such use, and other terms and conditions (collectively "Terms and Conditions") and exercise that right. However, Shin does not ensure Japan that such an exercise of the right will produce a profit.

3. Before Shin contracts out to Japan the production of the Title ("Services"), both parties shall consult and create content equivalent to the original idea or work of the Title (including the Title's worldview and other details) to produce the Title conforming to the Purpose. That creation shall be made in any of the following approaches: combining various elements of the works created by Japan, such as characters and settings ("Various elements"), creating content jointly by Shin and Japan, or in another way. Japan is obliged to perform the Services based on the above-created content.

4. Each element constituting the content equivalent to the original idea or work of the Title in paragraph 3. above (including the story, worldview, and other details, in addition to the Various elements, individually or collectively referred to as "Element(s)") are material elements of the Title. In this regard, Shin and Japan acknowledge and agree as follows: (a) Shin and Japan retain the right to produce an animation using the Elements (including the animation in modes other than a stop motion animation) in priority to any third parties, and (b) where Shin or Japan hopes to produce a work using Elements other than the Title (including sequels, spin-off works, and the like of the Title), the party ensures that it will explain the work content to the other party in advance to obtain the prior written consent.

Article 2 (Purpose)

Shin intends to execute this Agreement with Japan as a representative for Misato identified in Article 3 to contract out the Services to Misato. The Agreement aims to produce the Title conforming to the circumstances of the Exploitations in cooperation between Shin and Misato identified in Article 3, to maximize revenues from the Exploitations, and to appropriately divide the revenues obtained between Shin and Misato (the payments to Misato shall be made through Japan)."

39. Article 3, subparagraph 2, points (3), (4) and (6) are also relevant as they state:

"2. [Japan] warrants to Shin as follows:

(3) …Regardless of whether subcontracting or not, [Japan] is obliged to make [Mr] Misato the sole author of the Work products provided in Article 5 (including the copyright owner, where it is difficult to make [Mr] Misato the sole author under the Copyright Act.)

(4) [Japan] will not allow [Mr] Misato or the third persons to exercise the author's moral rights against Shin or a third party designated by Shin.
(5)….
(6) Excepting the considerations specified in the Terms and Conditions and monies specified in Article 10, [Japan] will not claim against Shin or a third party designated by Shin in connection with any use (including the Exploitations) or non-use of the Title or the Agreement. However, [Japan] may claim against Shin for damage incurred due to an event attributable to Shin."

40. Articles 4 and 5 are also relevant. They state:

"Article 4 (Contracting Services)

1. Shin contracts out the Services to Japan, and Japan is obliged to have [Mr] Misato perform the Services. The Services include all services necessary to complete the Title (including, but not limited to, those regarding musical copyrighted works used for the Title, payments to directors and other persons concerned, and clearance of copyrights and other rights necessary for the Exploitations). However, if any Exploitation contains certain musical copyrighted works, among those used for the Title, managed by music copyrights management societies (including the Japanese Society for Rights of Authors, Composers and Publishers) under the Act on Management Business of Copyright and Neighboring Rights, Shin shall have the person carrying out that Exploitation deal with the rights clearance for and payments of royalties to the relevant music copyrights management societies."

"Article 5 (Work products)

The Work products of the Services mean the particulars listed in Exhibit and the results of the Services, including character design drawings, characters, settings materials, storyboards, or data of the Title recorded in storage media (e.g., HDD, and LTO) specified by Shin and related materials, or all tangible and intangible objects that embody them. The Work products include intermediate products, by-products, or products not finally delivered to Shin".

41. Article 8 is the article upon which both Mr Miur Wood focused during his oral submissions. It is as follows:

"Article 8 (Ownership of Rights, etc.)

1. Shin and Japan agree as follows: At the time of the creation of the Title (including the Work products, the same shall apply in this Article), the copyrights to the Title (including the rights under Articles 27 and 28 of the Copyright Act, the same shall apply hereinafter) shall be shared between Shin and [Mr] Misato at a ratio of Shin to Misato of one to one. However, unless agreed upon between Shin and Japan in writing, neither Shin nor [Mr] Misato may claim the division of the rights.

2. The ownership and other rights to the Title (except for copyrights) shall pass from [Mr] Misato to Shin at the time of the completion of the inspection in Article 6 (or at the time of the creation of the Title for the products not finally delivered).

3. In connection with the rights in the preceding two paragraphs, if a novel or additional right occurs in the Title by the enactment of new laws or future law revisions, the ownership of that right shall be determined as follows: (a) any right related to copyright will be deemed a part of the copyrights to the Title at its occurrence, and Shin and Japan will hold it at their respective holding ratios at that time, and (b) the ownership of any right other than (a) above will belong to Shin at its occurrence. Regarding the holding and ownership of the rights in (a) and (b) above, Shin and Japan acknowledge and agree that no additional obligations to pay or bear expenses or charges will accrue besides the payments in Article 10."

42. Article 10 sets out the payment Shin undertook to make to Japan with the amount to be paid per episode. Subsection 3 of Article 10 is relevant as it states:

> *"10.3. Shin and Japan acknowledge and agree that this Article provides all the considerations hereunder, and the considerations in paragraph 1 above include the production costs and other expenses for the Title (including various expenses necessary for the performance of the Services by JGH) and the consideration for the transfer of the rights under Article 8. However, this Article shall not preclude any separate written agreement between Shin and JGH for the Terms and Conditions*."

43. Article 17 is relevant insofar as the issue of the relationship between the parties is concerned. It is as follows:

> *"Article 17 (Right to Represent)*
>
> *1. If [Japan] loses a part or the whole of its rights to represent Misato in the Agreement (including the case where it is likely to lose the rights, the same shall apply in this Article) ("Right to Represent Misato") through consultation between [Japan] and Misato, [Japan] will be obliged to notify Shin of that fact and details immediately.*
>
> *2. If [Japan] falls under any item listed in Article 14, or if a party violating any item in paragraph 1 of Article 15 is [Japan], regardless of whether the Agreement is terminated or not, [Japan] will forthwith lose the Right to Represent Misato under the Agreement.*
>
> *3. If [Japan] loses a part or the whole of the Right to Represent Misato under the preceding two paragraphs or for another reason, [Japan] shall immediately notify Shin of that fact, and both parties shall consult and determine the details of further measures to take".*

44. I also note that the exhibit annexed to the contract lists the *"work products*" as including the Title, final script, Title logo, character-list data, credits list and still images

of scenes specified by Shin. The Memorandum of Understanding attached to the contract further provides that Japan and Shin are to enter into a separate agreement governing the terms and conditions for secondary use of the Title, either between themselves or with one or more third parties. The categories of secondary use listed in the memorandum include domestic distribution, broadcasting and videotaping; exploitation through distribution, broadcasting and videotaping outside the country; and merchandising both within and outside the country.

45. In relation to this evidence, Ms Collett argued that *"it is deeply concerning that [I am] asked to interpret a Japanese contract, the contract that expressly provides the determination of any conflict therein, to be dealt with in the Japanese courts."* She also pointed out that the translation provided is a non-certified translation without the benefit of expert submissions, any evidence or in fact any type of legal confirmation. She stressed that neither herself not Mr Muir Wood are experts in Japanese law and that we would be looking at it from an English perspective. Further, she argued that even if the translation was accurate, that would not enable me to interpret the contract because it is governed by Japanese law. Lastly, she reiterated that the contract does not have any impact on goodwill or trade mark rights, because there is no reference to trade marks and no reference to goodwill; accordingly, she concluded that were those rights to be determined by the contract, they would expressly be provided for.

46. Having asked Ms Collett, absent reliance on the contract in the UK, on which basis she thought I should resolve the matter, she replied that I should give the benefit of the doubt to Japan.

47. Mr Muir Wood, on his part, pointed out that had Japan's concerns about the meaning of the contract been raised during the evidence rounds, Shin could have put in evidence to deal with the interpretation, however, this was not done. Mr Muir Wood also referred to paragraph 27 of Mr Akiyoshi's witness statement saying that such paragraph suggests that Mr Akiyoshi seems to accept the agreement. That is correct insofar as Mr Akiyoshi relies on the clauses stipulating the distribution of profit for secondary use of the work, and claims that Shin did not pay the appropriate proportion of profit to Japan since March 2022.

48. I do not agree with Ms Collett. In my view, there is nothing which prevents this Tribunal from taking a Japanese contract into account in order to resolve copyright, trade mark, or passing off matters. However, the important distinction is between using the contract as evidence of facts/rights and deciding what the contract means under Japanese law. In other words, the provisions in the contract can be highly relevant insofar as the agreement establishes a contractual relationship or rights between the parties. However, if there is a dispute about what a particular clause legally means under Japanese law, I would need evidence of Japanese law, i.e. expert evidence from a qualified Japanese lawyer, which, I accept, we do not have in the present case. As regards the translation, I was not taken to any specific part of the contract that it is alleged was inaccurate; further, this point was not raised earlier in the proceedings and it would be unfair to Shin and Mr Misato to dismiss that evidence outright when they did not have the opportunity to re-file a certified translation of the contract during the evidence rounds because the criticism was not put forward until the hearing.

49. Both parties acknowledged that there is nothing express in the agreement about trade marks or goodwill. Ms Collett further contended that it is not possible to know whether under Japanese law, parties to a contract are required to expressly refer to trade marks (or goodwill) for the agreement to cover it.

50. Mr Muir Wood submitted that it is unfortunate that in the translation the word "title" has been used to refer not just to the name ‘MOLCAR’ (in which Shin and Mr Misato say rights subsist) but also to the whole first series. Mr Muir Wood also pointed out that Article 8(1) refers to copyright in the title, including the work products, and that such a reference is plainly a reference to the series. Hence, Mr Miur Wood described the contract as being *“about copyright in the series, the first series as a whole rather than to the title as in just the name MOLCAR in some way”*. Whilst he agreed that there is no reference to trade marks, he argued that there were no trade marks at the date of the contract because they had not been filed, hence the reason why it was not included.

51. Nevertheless, Mr Muir Wood maintained the submission that (1) the contract covers trade mark rights; (2) alternatively, it covers copyright in the name of the series;

(3) alternatively, it covers the rights to the creation of the name, whether or not I decide that there is copyright in the name 'PUIPUI MOLCAR', because Mr Misato coined it.

52. It is common ground between the parties that the main rights governed by the contract relate to copyright in the first series. In this connection, in the pleadings Japan agreed that the copyright in the work belonged to Shin and Mr Misato. It is also sufficiently clear that the reference to the 'Title' is a reference to the "*Stop Motion Animation "MOLCAR"* which is contained in the name of the agreement *"Production Service Agreement for Stop Motion Animation "MOLCAR".* The series (i.e. the Title) itself is most certainly a copyright work according to Japanese copyright law as it is the subject of Article 8 which states that "*Shin and Japan agree as follows: At the time of the creation of the Title (including the Work products, the same shall apply in this Article), the copyrights to the Title (including the rights under Articles 27 and 28 of the Copyright Act, the same shall apply hereinafter) shall be shared between Shin and [Mr] Misato at a ratio of Shin to Misato of one to one*". However, the parties disagree on whether copyright applies to the title or name of the series 'MOLCAR' in its own right. This is the specific point I need to resolve for the purpose of the Section 5(4)(b) ground (but I will also look at the question of whether copyright subsist in the whole series as it was pleaded). In addition, the existence of copyright in the series (or in the name/title of the series) is relevant for the purpose of the Section 3(6) ground (see below).

53. Regardless of whether there is copyright in the name/title of the series, the other question I need to resolve is whether Article 8 (or any other provisions of the contract) gives some sort of exclusive rights to Shin over Japan in relation to the registration of the name/title of the series as a trade mark. This would be relevant under Section 3(6), although there is a further mental leap from the contract giving Shin the right to register 'MOLCAR' as a trade mark to the registration of 'PUIPUI MOLCAR' by Japan being made in bad faith. Likewise, there is a similar mental leap from the contract giving Shin and Mr Misato copyright in the name/title 'MOLCAR' to Shin holding copyright in the pleaded name/title 'PUI PUI MOLCAR'.

54. As regard goodwill, the onus is on Shin and Mr Misato to prove first, that the broadcasting of the relevant TV animated series in the UK generated sufficient

goodwill in the name/title of the series (i.e. the pleaded sign is 'PUIPUI MOLCAR') to be actionable, and second, that they own the goodwill associated with that name/title. Again, it is common ground that the contract does not expressly assign the goodwill (or the right to it, given that no goodwill existed before production). Further, copyright ownership and goodwill ownership are not necessarily the same thing. Nevertheless, the answer to the question of whether Article 8 (or any other provisions of the contract) gives some sort of exclusive rights to Shin and Mr Misato over Japan in relation to goodwill generated in the UK is relevant for the purpose of both the Section 3(6) and the Section 5(4)(a) grounds.

55. I now turn to these questions.

Does copyright apply to the name/title of the series 'MOLCAR' in its own right? In other words, does the single word 'MOLCAR' meet the requirement for protection of copyright work?

56. I have formulated the relevant questions in the above terms because this is how Mr Muir Wood put them before me. However, I am not convinced that the issues I need to resolve are in these terms.

57. First, I think it is important to start from the fact that whilst the Japanese contract says that the parties are dealing with copyright in the whole animated series (including, potentially, the name/title 'MOLCAR'), this does not, by itself, establish that copyright subsists in the series or in the name/title of the series under UK law – this is the test I must apply when dealing with the Section 5(4)(b) ground (see below).

58. Insofar as it is relevant for the purpose of dealing with the Section 5(4)(b) ground, I think it is clear that the Japanese contract assigns the copyright in the whole animated TV series to Shin and Mr Misato. For an animated TV series there are several copyright works embedded in the overall production, some of which are listed in the contract at Article 5 and Article 8 as '*work products'* and are then specified in the exhibit; for example, character design drawings, characters, settings materials, storyboards, or data of the series recorded in storage media. Article 5 states that *"Regardless of whether subcontracting or not, [Japan] is obliged to make Misato the*

sole author of the Work products provided in Article 5 (including the copyright owner, where it is difficult to make Misato the sole author under the Copyright Act)". The name/title 'MOLCAR' is, indeed, part of the series, but it is not listed as a single copyright work (neither in the contract nor in the exhibit).

59. Bearing in mind this background, the question appears to me to be whether both the series and the word 'MOLCAR' as Japanese works qualify for UK copyright protection; to decide this, I do not need to determine Japanese copyright law first. This is because the UK has specific rules for protection of foreign work. The UK`s international treaty obligations on copyright require the UK to protect foreign works and performances. The level of protection varies depending on the country of origin of a work or performance.[5] Japan and the UK are both parties to the Berne Convention for the Protection of Literary and Artistic Works[6] which means that work originating in Japan can receive protection in the UK under the UK law. In this connection, the Berne national treatment does not mean that Japanese copyright law is imported into the UK; the principle is that the foreign work receives protection under the law of the country where protection is claimed. WIPO explains this as follows:

> *"The Berne Convention deals with the protection of works and the rights of their authors. It is based on three basic principles and contains a series of provisions determining the minimum protection to be granted, as well as special provisions available to developing countries that want to make use of them.*
>
> *(1) The three basic principles are the following:*
>
> *(a) Works originating in one of the Contracting States (that is, works the author of which is a national of such a State or works first published in such a State) must be given the same protection in each of the other Contracting States* ***as the latter grants to the works of its own nationals (principle of "national treatment")****.*

[5] ttps://www.gov.uk/government/publications/uk-copyright-protection-for-foreign-works-and-nationals
[6] https://www.wipo.int/en/web/treaties/ip/berne/index

(b) Protection must not be conditional upon compliance with any formality (principle of "automatic" protection) [2].

(c) ***Protection is independent of the existence of protection in the country of origin of the work (principle of "independence" of protection)****..."*

60. Accordingly, based on the pleadings, the contract and the submissions made by Mr Muir Wood at the hearing, what I need to establish is whether the title/name of the animated TV series 'MOLCAR' (regardless of whether the title/name is copyrightable under Japanese law – see point (c) of WIPO's guidance above) and the animated TV series as a whole satisfy the requirement for copyright protection in the UK – to do this, as I have explained, I do not need to establish whether Japanese law recognise copyright in the works claimed. I will return to this point when dealing with the Section 5(4)(b) ground. It follows that the Japanese contract is relevant here insofar as it establishes the factual background and the ownership of the copyright – which, it is common ground, was assigned in favour of Shin and Mr Misato. If the work (i.e. the name/tile 'MOLCAR' and the whole series 'MOLCAR') is protectable under UK law, then Shin and Mr Misato are the owners of the copyright by virtue of the Japanese contract.

61. In addition, the ownership of the copyright is relevant for the purpose of the bad faith claim.

Do the clauses governing secondary use give exclusive rights to Shin over Japan in relation to the registration of the name of the series 'MOLCAR' as a trade mark?

62. It is common ground that the Japanese contract makes no express mention of trade marks or goodwill, hence, it does not expressly assign trade mark rights or goodwill to Shin and Mr Misato. Mr Muir Wood said that the reason why these rights are not mentioned in the contract is that there were no registered trade marks and no goodwill at the time the contract was signed.

63. I bear in mind that the contract is a production service agreement whereby Shin commissioned to Japan the production of the 'MOLCAR' animated series and

undertook to bear the production costs for its creation, and Japan undertook to provide the services needed to make the series (through Mr Misato) for an agreed fee. The contract covers, *inter alia*, the scope of the services, the payment, the personnel (i.e. Mr Misato), warranties and, significantly, who own the copyright in the resulting series and material – in this case Shin and Mr Misato. However, this does not determine who owns or controls the trade mark rights in the title/name 'MOLCAR' as copyright and trade marks are different rights.

64. As noted by Ms Collett, I have no evidence as to what categories of intellectual property rights are normally included in Japanese production service agreements. Admittedly, the contract exhibited does not say that Shin owns all intellectual property rights arising out or in connection with the series. However, I think there may be an argument that, as contended by Mr Muir Wood, the contractual allocation of intellectual property rights in the series and in the elements identifying the series (e.g. title, characters, logos, names) extends beyond copyright. I say this because the contract deals with secondary use which is defined as covering *"exploitations of the Title in any means or manner (mode) exceeding the scope of the Primary use",* the primary use being limited to broadcasting in Japan. The contract states that Shin *"who bears the production costs of the Title**, has the exclusive authority of the Secondary use of the Title** on behalf of both parties"* and a further document (i.e. the Memorandum of Understanding for Stop Motion Animation "MOLCAR") established that Japan is entitled to a percentage of revenue deriving from secondary use (which include distribution, broadcast, videotaping and merchandising). In addition, Article 12 states that *"if a third party infringes, or is likely to infringe, on any rights under the Title […] unless otherwise provided, Shin shall address such infringement or its likelihood (including, but not limited to, negotiation, legal action, settlement, and other measures) alone, with the consent of Japan*". Those clauses (which make Shin the party who has control over the commercial exploitation of the series, and should address any infringement of rights under the series), might support the conclusion that Shin is also the party who has control over the title/name of the series and the right necessary to exploit and protect it. In particular, I think the clause about secondary use which states that Shin has exclusive authority of secondary use of the series including distribution, broadcasting, videotaping and merchandising indicate that the parties contemplate that the name/title 'MOLCAR' (which identifies the series) would have commercial

significance beyond the copyright in the single episodes. In particular merchandising is potentially very relevant to trade mark rights because the name of a series or title can function as a badge of origin for merchandise, and control over merchandising using the name/title of the series is very different from merely owing copyright in the episodes. Accordingly, I consider that the parties to the contract intended Shin to have exclusive control over the commercial exploitation and protection of the series including exploitation and protection of the title/name 'MOLCAR', and support an inference that the rights necessary to exercise that control (including trade mark rights) were intended to vest in Shin and Mr Misato. The same conclusion applies to Mr Misato. In this connection, Article 5 states that *"Shin contracts out the Services to Japan, and Japan is obliged to have [Mr] Misato perform the Services. The Services include all services necessary to complete the Title (including, but not limited to, those regarding musical copyrighted works used for the Title, payments to directors and other persons concerned,* ***and clearance of copyrights and other rights necessary for the Exploitations****)",* clearly referring to Mr Misato having control over copyright and other rights necessary for the exploitation, which would include trade mark rights which are relevant for merchandising. For the avoidance of doubt, the fact that Japan was entitled to be paid royalties in respect of merchandising does not alter my conclusion about the ownership of those rights.

The creative work behind the series and the origin of the name 'PUIPUI MOLCAR'

65. At the hearing Ms Collett conceded that in summary, both parties agree that Mr Misato (i) was a creative arts student before he met Japan, (ii) had guinea pigs, (iii) was the technically gifted one who was presented as the key artistic brain and (iv) did the stop-motion animation.

66. Further, Ms Collet submitted that Japan's position is that whilst it does not dispute that Mr Misato is the main driver, the main author of the project, it maintains that it was involved. She also said that both parties agree in terms that Japan was involved in the creation of the show.

67. There was a lot of discussion about the evidence relating to who came up with idea about guinea pig characters and the timing of them coming up. In this connection,

quite a lot of Mr Muir Wood's submissions focused on Mr Misato being the originator of the name. However, ideas are not copyrightable *per se*, and the issues about trade mark rights and goodwill in the name/title of the series do not hinge on any question of fact about who the originator of the idea/characters was. Further the issue about the origin of the name is absorbed by the issue of whether the name is copyrightable in its own right, and if that is the case, the contract governs the copyright in the name. Ms Collett appeared to acknowledge the relevance of this aspect of the case in her oral submissions as she stated as follows:

> *"You may say to me madam "why does this matter?" It matters in two regards. First is credibility. Looking at the evidence, whose position is more credible? Secondly, when it comes to all of these assertions of rights and all of these assertions of ownership and so on and so forth, we say my client's heavy involvement is relevant and must be taken into account."*

68. Accordingly, as it seems accepted by Ms Collett's own reference to credibility, the evidence about the origin of the name might be relevant only for the purpose of the bad faith claim, however, even in that context, I do not think it could take the case much further than the contract.

69. For the sake of completeness, I should also say that Ms Collett further argued that whilst Mr Akiyoshi said that he steered Mr Misato towards the idea of guinea pigs, his claim is limited to his contribution being sufficient to justify a plausible claim of joint authorship from a copyright perspective.

70. In support of her submission, Ms Collett referred to the case of *Martin v Kogan* [2019] EWCA Civ 1645, a case concerning the authorship of a screenplay, whereby the judge found that the claimant's contribution to the copyright work was sufficient to render her a joint author; applying that case law, Ms Collett argued that the collaborative creative process with Mr Akiyoshi and the working relationship between Japan and Mr Misato was sufficient to make Mr Akiyoshi or Japan joint authors.

71. I can dismiss Ms Collett's submission very briefly. As Mr Muir Wood correctly pointed out, copyright in the series is governed by the contract and there is nothing in

the contract that gives Mr Akiyoshi or Japan joint authorship, the contract reserving those rights to Shin and Mr Misato. In this connection, it is significant that the contract assigns those rights to Shin and Mr Misato whilst acknowledging Japan's potential contribution to the creative process - see article 2 subparagraph 3 which states that *"Before Shin contracts out to Japan the production of the Title ("Services"), both parties shall consult and create content equivalent to the original idea or work of the Title […]. That creation shall be made in any of the following approaches: combining various elements of the works created by Japan, such as characters and settings ("Various elements"), creating content jointly by Shin and Japan, or in another way […]".* Lastly, as observed by Mr Muir Wood, Article 3 subparagraph 2 states *that "(3) …Regardless of whether subcontracting or not, [Japan] is obliged to make [Mr] Misato the* ***sole author*** *of the Work products provided in Article 5 (including the copyright owner, where it is difficult to make [Mr] Misato the sole author under the Copyright Act.)"*. Hence, even if Japan and Mr Akiyoshi had any right to co-ownership in the series by virtue of their creative contribution, they waived their rights when Mr Akiyoshi signed the contract on behalf of Japan. I therefore agree with Mr Muir Wood that there is no possibility of Mr Akiyoshi having retained any copyright, even if he was the co-author of the work, because the contractual agreement ensure that it all vested in Mr Misato (and Shin).

The relationship between Japan, Mr Misato and Shein

72. As Mr Muir Wood correctly pointed out at the hearing, this aspect of the case is directly relevant for the purpose of the Section 5(6) claim, whilst being also relevant for the purpose of the bad faith claim under Section 3(6).

73. Ms Collett pointed out that the relationship between Japan and Mr Misato ceased in early 2021 referring to what Mr Misato said in his first witness statement at paragraph 20, namely that since 2 February 2022 he had no contact with Japan. Ms Collett argued that given that the relationship between Mr Misato and Japan broke down in February 2022, Japan could not have been an agent as of 8 September 2022 when it filed the contested registration.

74. Mr Collett argued that the *Fittipaldi IP Holdings, LLC v. Corpa Switzerland AG* (O/0374/24) case cited by Mr Muir Wood does not support Shin and Mr Misato's position because the European Courts have said some kind of agreement must exist between the parties and no agreement existed as at the filing date. She argued that it is not a sustainable submission that a once-existing relationship of some kind (which Japan disputed was as an agency relationship) is in perpetuity sufficient to render a party an agent for the purposes of filing a trade mark. In this connection, Ms Collett said that Japan agrees with the wording of Article 2 of the contract which says that Japan is a representative for Mr Misato for the purposes of contracting out services. However, she put forward two arguments, namely (a) Article 17 creates a right to represent; it is not an agency agreement, contrary to how it was qualified by Mr Muir Wood in his oral submissions; and (b) the relevant date for the Section 5(6) ground is the filing date of the contested registration and the question I need to answer is *"at the filing date was [Japan] an agent or representative?"*. Ms Collett said that the answer to such question is 'no', because Mr Misato had not spoken to Japan for 9 months prior to Japan filing the application. Despite accepting that by virtue of the contract Japan acted as representative for Mr Misato, and despite using the words 'representative' and 'agent' interchangeably in her oral submissions, Mr Collett further argued that Japan was not acting as an agent in the sense of Section 5(6) stating that this is clear from Japan's conduct and its role as a producer.

75. Mr Muir Wood, on his part, argued that it cannot be right that an agent or representative can terminate the agreement and file a trade mark on the next day for the rights of the party for whom it is agent or representative, and that not fall foul of the Section 5(6). In this connection, he referred to the case of *Fittipaldi* at §41 where it was stated as follows (my emphasis):

> "In *Mouldpro ApS v EUIPO*, Case T-796/17, the General Court summarised the case law about when a party may be regarded as 'agent' or 'representative' of an opponent or application for invalidation. The court stated that:
>
> > "21. It is apparent from the wording of Article 60(1)(b) of Regulation 2017/1001 that, for an opposition to succeed on that basis, it is necessary, first, for the opposing party to be the proprietor of the earlier

mark; second, for the applicant for the mark **to be or to have been** the agent or representative of the proprietor of the mark; third, for the application to have been filed in the name of the agent or representative without the proprietor's consent and without there being legitimate reasons to justify the agent's or representative's action; and, fourth, for the application to relate in essence to identical or similar signs and goods. Those conditions are cumulative (judgment of 13 April 2011, *Safariland* v *OHIM — DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)*, T-262/09, EU:T:2011:171, paragraph 61).

The European Courts have also given the following guidance:

(a) The terms 'agent' and 'representative' must be interpreted broadly, covering all kinds of relationships based on a contractual agreement where one party represents the interests of the other. It is sufficient that the agreement or commercial cooperation between the parties gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark (*EUIPO v John Mills Ltd & Jerome Alexander Consulting Corp.*, Case C-809/18 P, EU: C:2020:902, paragraph 85);

(b) It does not matter how the contractual relationship between the proprietor or principal, on the one hand, and the applicant for the EU trade mark, on the other, is categorised (*FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64, and *Moonich Produktkonzepte & Realisierung v OHIM — Thermofilm Australia (HEATSTRIP)*, T-184/12, not published, EU:T:2014:621, paragraph 58);

(c) Nevertheless, some kind of agreement must exist between the parties. A mere purchaser or client of the proprietor cannot be regarded as an 'agent' or as a 'representative' (*FIRST DEFENSE*, paragraph 64);

(d) The misuse of the mark may occur both where the earlier mark and the mark applied for by the agent or representative are identical, and where the marks at issue are similar (*EUIPO v John Mills Ltd*, paragraphs 70-73);

(e) The protection also extends to cases where the goods and services are only similar and not identical (*EUIPO v John Mills Ltd*, paragraphs 98-99);

(f) The specific protection afforded by Article 8(3) is not to be assessed on the basis of whether the similarity between the marks results in a likelihood of confusion (*EUIPO v John Mills Ltd*, paragraph 92);

(g) The assessment of similarity between the goods and services should take all relevant factors into account, including, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*EUIPO v John Mills Ltd*, paragraph 100 and *The Tea Board v EUIPO*, C-673/15 P to C-676/15 P, EU:C:2017:702, paragraph 48)."

76. Mr Muir Wood observed that it is precisely because Mr Collett's line of argument could easily provide agents with an escamotage to get away from the consequences of Section 5(6), that the words **"to have been"** are included in the extract from *Mouldpro*. Alternatively, Mr Muir Wood stated that if I decide that the Section 5(6) cannot succeed because Japan was no longer an agent for Mr Misato when it filed the contested application, then we stray in effect into bad faith.

77. In addition to the contract, the other facts set out in the evidence which are relevant for the purpose of establishing the relationship between the parties for the purpose of the Section 5(6) ground, as well as the background for the purpose of the Section 3(6) ground, are as follows:

- Mr Misato is a Japanese movie director and film maker. He met Mr Akiyoshi, President of Japan, at one of his personal exhibitions in 2017. Mr Akiyoshi told Mr Misato that he was interested in his works. After the first meeting, Mr Akiyoshi and Mr Misato met for lunch or dinner several times. Mr Akiyoshi told Mr Misato that he worked in the field of TV media and had connections to TV broadcasting companies and/or studios. He introduced Mr Misato to several media companies which seemed to have an interest in his works. Since Mr Misato was working as a freelance creator, he considered that the relationship with Mr Akiyoshi was a manner of networking.[7]

- Mr Misato was introduced to Shin by Mr Akiyoshi in March 2019, following which the parties entered into the contract dated 1 June 2019. Shin had never previously worked with Japan.[8] In his second witness statement Mr Misato explains that whilst he wanted to sign a contract directly with Shin, being a freelance film director, it was difficult for him to make the payments to the creative staff members who assisted to make the film so he agreed to be represented by Japan.[9]

- When Mr Misato was introduced to Shin by Mr Akiyoshi, he presented a plan of his work which outlined the primary idea of the stop-motion animation, which at the time was called 'MOLCAR'. Mr Akiyoshi mediated the communication between Shin and Mr Misato and attended the meeting. After the presentation, Shin asked Mr Misato to create an animation series work based on his original storylines and concepts he had presented to them.[10] Mr Misato has never had a contract with Japan regardless of the work. This work was created by Mr Misato and a small team of people he trusted to help him make the stop-motion animation. Almost all team members are friends Mr Misato met in university.[11]

- The fees paid by Shin to the creative staff, including Mr Misato, were paid via Japan since Japan received the said fees from Shin. Mr Misato received

[7] Mr Misato's first witness statement
[8] Mr Irie's witness statement
[9] Mr Misato's second witness statement
[10] Mr Misato's first witness statement
[11] Mr Misato's first witness statement

monthly payments until March 2019, however, after April 2019, the payments suddenly stopped and Mr Misato urged Japan to remit the fees received from Shin. After demanding the fees, Mr Misato received the remaining amount of fees in December 2019 from Japan. After Mr Misato started to communicate directly with Shin, he found out that Japan used almost all of the payment from Shin as its income.

- In June 2020, to continue directing and producing "PUI PUI MOLCAR", Mr Misato resent an animation work plan to a third-party company WIT STUDIO, Inc. When the plan was approved, on 30 June 2020, Mr Misato informed Japan that he would become an employee of WIT STUDIO, Inc. after the completion of "PUI PUI MOLCAR". The productive works of "PUI PUI MOLCAR" were finished at the end of October 2020. After "PUI PUI MOLCAR" was broadcast on 5 January 2021, "PUI PUI MOLCAR" became the number one trend on social networking sites within a few days from said date and a great success.[12]

- Mr Misato says that on 25 January 2021 he was invited to a celebration meeting of "PUI PUI MOLCAR" held by Shin and Japan. He said that he was not feeling well and that in front of Mr Umezawa, the president of Shin, Mr Akiyoshi called him and he was forcefully demanded to sign a document stating that he agrees with creating a sequel work of "PUI PUI MOLCAR". Mr Misato said that he rejected such request by asserting that he was an employee of WIT STUDIO, Inc. and was not allowed to do side work and states that even after his refusal he was forced to put his seal on another document to agree with starting a negotiation between Japan and Shin related to "PUI PUI MOLCAR." Mr Misato also says that "*taking into account Japan's mediating work and being in a bad physical condition, he ended up putting his seal on the document".* He also states that after these interactions with Mr Akiyoshi, he received an offer to make a sequel of "PUI PUI MOLCAR" from Mr Umezawa. Nevertheless, he refused his offer for the time being. Mr Misato says that on 30 January 2021, he received a call from Mr Akiyoshi asking him to come to the station close to his house. Since Mr Misato requested Japan to send a copy of the document

[12] Mr Misato's first witness statement

being signed on 25 January 2021, he says, he thought that he would receive a copy of that document; however, according to Mr Misato's narrative evidence, when arriving at the station, Mr Akiyoshi and another employee of Japan took him to their car. Mr Misato subsequently alleges that once in the car he was forced to sign a document agreeing to collaborate with Japan in creating a sequel of work of 'PUI PUI MOLCAR' despite having repeatedly refused to sign it, saying that he was subject to threats and was kept in the car for two hours; eventually, after he signed the document, he was allowed to get out of the car. Mr Misato states that once he got home, he contacted his employer WIT STUDIO; the latter involved their lawyer who contacted Japan on 2 February 2021 asking them to cancel the agreement as it was signed under duress. Mr Misato states that he had no contact with Japan since that date. Mr Misato also said that WIT STUDIO's lawyer contacted Shin who agreed to take actions with Mr Misato against Japan regarding 'PUI PUI MOLCAR' projects and that after this he returned to collaborate with Shin on 'PUI PUI MOLCAR' projects. Lastly, Mr Misato said that he became employed by WIT STUDIO in **July 2020** and that at the date of his witness statement he was making another animation work not related to 'PUI PUI MOLCAR'.[13] Mr Misato provides translated copies of two letters dated 2 and 12 February 2021 respectively, sent by his lawyer to Japan. With the first letter, Japan was informed that Mr Misato cancelled the agreement of 30 January 2021 by way of notification because it was signed as a result of Japan confining Mr Misato in the car and subsequently subjecting him to persistent, prolonged coercion.[14] With the second letter, Japan was informed that Mr Misato cancelled the agreement of 25 January 2021.[15]

In response to Mr Misato's evidence about the events of 25 and 30 January 2021, Mr Akiyoshi gave his own version of the events. Insofar as it is relevant, he denied Mr Misato's allegations and said that it was Mr Misato who chose to hold discussions in the car and that on that day, Mr Misato worked at a workplace (that Japan rented and allowed Mr Misato to use for his work) until around 9 pm to deal with a WIT STUDIO project. Mr Akiyoshi says that they

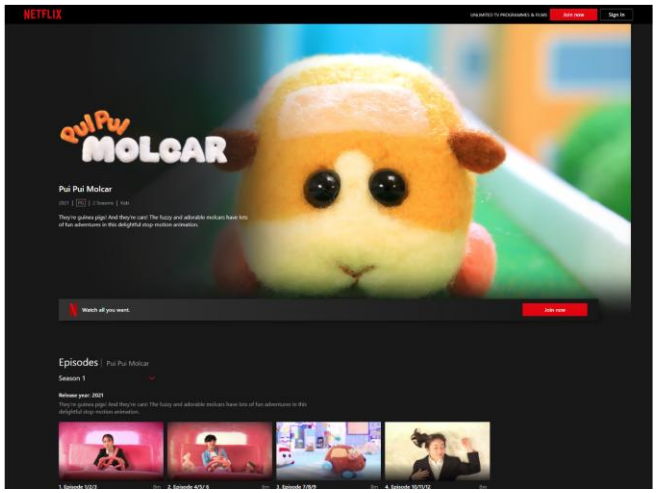
[13] Mr Misato's second witness statement
[14] Exhibit TM6
[15] Exhibit TM8

were supposed to meet up with Mr Misato and held discussions at a cafe near the said workplace, but the café was closed, and although Mr Akiyoshi and his colleague suggested to go somewhere else, Mr Misato wanted to stay in the car which they parked near a police station explaining to a police officer that they were not able to find a suitable place, and the discussion was held with a door open due to COVID. Mr Akiyoshi further says that Mr Misato was presented with several draft agreements and he made the calm decision to sign one of them and denies that he was subject to confinement or duress.[16]

Mr Akiyoshi also alleges that "*Mr Misato had produced PUIPUI MOLCAR under [his] direction and had promised to concentrate on producing a sequel to PUIPUI MOLCAR under Japan's direction after the production of the first phase of PUIPUI MOLCAR was completed. Nevertheless, Mr Misato suddenly stopped being a freelance animator, broke the above promise, and accepted a job offer from WIT STUDIO to become a contract employee of WIT STUDIO".* This, Mr Akiyoshi alleges, is the true reason for the breakdown of the relationship between Mr Misato and Japan.

- On 25 March 2021 the first series of the show was added to Netflix UK. The show could simultaneously be accessed on YouTube by consumers in the UK between 13 January 2021 and 31 December 2021. As of 1 January 2022, the Show is available in the UK exclusively via Netflix. A screenshot showing the Show available via Netflix UK is included in Exhibit Tl6; I have reproduced it below:

[16] Mr Akiyoshi's second witness statement



Notably, this is the first series of the show, and it is shown in the Netflix UK as 'PUI PUI MOLCAR' (but the service production agreement refers only to 'MOLCAR').

- The second series of the Show was first aired on TV in Japan on 8 October 2022 and has been exclusively available in the UK via Netflix since 17 March 2023. Japan had no involvement in the show; this was due to a breakdown in relations between Mr Misato and Japan.[17]

- Shin licensed use of the mark 'PUI PUI MOLCAR' in the UK to MGA Entertainment, Inc and through this licence the mark has been used in relation to a wide variety of goods. Shin has never entered into any agreements with Japan relating to the production, distribution or licensing of 'PUI PUI MOLCAR' merchandise.

- Shin manages a number of 'PUI PUI MOLCAR' social media accounts as well as the official website.[18]

78. Admittedly, the evidence filed by the parties is not consistent, in particular in relation to the reasons for the breaking down of the relationship between Mr Misato and Japan which, Mr Misato attributes to (a) the failure by Japan to pay his fee and

[17] Mr Irie's witness statement
[18] Mr Irie's witness statement

(b) the events of 25 and 30 January 2021, when he alleges, he was forced to sign contracts by which, as I understand it, he undertook to work with Japan in relation to another series of 'PUI PUI MOLCAR'. Conversely, Mr Akiyoshi says that there was no coercion, that Mr Misato chose the contract to sign and that the reasons for the breakdown of the relationship was that Mr Misato accepted a job offer from a third party and broke his promise to work with Japan on another series of 'PUI PUI MOCAR'.

79. However, the parties agree that:

- There was no commercial relationship between the parties as at the filing date.

- The first series which was produced under the Japanese contract was available in the UK from March 2021.

- By June 2020, Mr Misato was intending to enter into his employment contract with WIT STUDIO and in January 2021 there was the unfortunate incident in relation to which Mr Misato and Mr Akiyoshi give different versions and involve the signing of a contract (but, in any event, no copy of the contract has been provided).

- At the filing date of the contested registration Japan knew that the second series was being created with Mr Misato, but it was not involved.

80. I now turn to the grounds.

Section 5(6)

81. Section 5(6) of the Act states as follows:

> "(6) Where an agent or representative ("R") of **the proprietor of a trade mark** applies, without the proprietor's consent, for the registration of the trade mark in R's own name, the application is to be refused unless R justifies that action."

82. The case-law referred to above establishes that one of the conditions of a successful claim of this kind is that the application must have been filed in the name of the agent or representative without the proprietor's consent and without legitimate reasons to justify the action.

83. As it can be seen, the legislation clearly uses the word 'agent' or 'representative' interchangeably. I have already noted that despite attempting to draw a distinction between the contract creating a 'right to represent' as opposed to an 'agency agreement', Mr Collett herself used the words 'agent' or 'representative' interchangeably in her oral submissions. Further, *Mouldpro ApS v EUIPO* makes clear that *"the terms 'agent' and 'representative' must be interpreted broadly, covering all kinds of relationships based on a contractual agreement where one party represents the interests of the other"*. The same case-law also supports Mr Muir Wood's argument that it is not necessary for the applicant to be a representative of the opponent at the time the application was filed, but it will suffice that it has been prior to the application being filed. Based on the clear wording of Article 17 of the Japanese contract which governs Japan's right to **represent** Mr Misato, I am satisfied that Japan had been a representative and/or agent of Mr Misato prior to filing the application and, as such, the first condition is met.

84. The other condition for the present invalidity to succeed under this ground is for Shin and Mr Misato to be the proprietor of the trade mark for which the agent/representative applied for without consent. Admittedly, the case law from *Mouldpro* refers to the proprietor of the earlier mark; however, this adds a requirement that is not reflected in the legislation and is set out in Section 6 which defines an earlier mark (i.e. a registered trade mark or comparable mark or a trade mark application with an earlier filing date).

85. Mr Muir Wood's argument in this connection was that Mr Misato coined the mark 'PUI PUI MOLCAR' and that he either owns it jointly with Shin, on the basis of the copyright subsisting in it, or has transferred it to Shin under Article 8.2 of the Agreement. Ms Collett, on her part, acknowledged that *"the "proprietor of a trade mark" is not defined, but for the purposes of section 5(6) is understood to mean the party alleging that the trade mark was registered for them by the agent/*

representative". Kerly's Law of Trade Marks and Trade Names 17th Ed. provides some guidance on the point as it states:

> "11-144 Section 5(6) is both less clear and potentially more broad in scope than s.60. It is not on its face limited to marks "owned" in any particular country. The wording of art.5(3))(b) of the 2015 Directive (from which s.5(6) derives) provides no further guidance. However, the equivalent provision under the EUTMR is found in art.8(3) and the CJEU has held that it should in the light of its legislative history be construed as applying "within the meaning of article 6septies (1) of the Paris Convention". The nature of the rights in issue were considered by the General Court in *CEDC International v EUIPO*, holding that the provision applied to both **registered and unregistered marks**. The General Court has also held that the protection is:
>
> "[D]esigned to prevent the misuse of a mark by the trade mark proprietor's agent, as the agent may exploit the knowledge and experience acquired during its business relationship with the proprietor and therefore improperly benefit from the effort and investment which the trade mark proprietor himself made."

86. Accordingly, I will proceed on the basis that Section 5(6) does not require the opponent/principal to own a registered (and earlier) trade mark. Further, I consider that the agent/representative protection applies to any owner of a trade mark whether they are based in the UK or abroad. Lastly, I will adopt Ms Collett's interpretation that "*the "proprietor of a trade mark" is not defined, but for the purposes of section 5(6) is understood to mean the party alleging that the trade mark was registered for them by the agent/ representative"* – in this connection Ms Colett stated that Shin and Mr Misato did not own trade mark rights because (a) the contract did not assign trade mark rights and (b) the existence of Japan's earlier registration. However, as regards to point (a) I found that the contract supports an inference that the rights necessary to exercise the control over the commercial exploitation and protection of the series (including registered and unregistered trade mark rights) were intended to vest in Shin and Mr Misato and (b) the legislative reference to the proprietor of a trade mark, is not a reference to a registered (or earlier) mark. Accordingly, this requirement is also met.

87. The last requirement is that the application must relate in essence to identical or similar signs, and goods and services. I find that the contested mark 'PUI PUI MOLCAR' is sufficiently close to the original name of the series 'MOLCAR' for the requirement of similarity of the signs to be met. Likewise, I find that the goods and services for which the contested mark is registered are essentially games and toys in class 28 and services relating to production, entertainment and production of entertainment in class 41 which are identical or similar to the goods and services in relation to which the mark 'MOLCAR' would be exploited (i.e. merchandising and entertainment); in any event, Japan did not deny the identity and/or similarity of the goods and services in its pleadings under this ground.

88. Accordingly, all the requirements having been met, this ground is successful in its entirety.

Section 3(6)

89. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

90. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker*

(C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).
(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the

objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the

application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

91. The essence of bad faith objection is that applicant's intended conduct is a departure from accepted principles of ethical behaviour or honest commercial practices. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another.

Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

92. The correct approach to assessing bad faith was set out in *Alexander Trade Mark*, BL O/036/18. The key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
(b) Was that an objective for the purposes of which the contested application could not be properly filed? and
(c) Was it established that the contested application was filed in pursuit of that objective?

93. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

94. Mr Muir Wood argued that Japan has not put forward a positive case about any intention to use a trade mark in the UK, and that the registration was filed in bad faith as a tool to give it leverage over Shin for the exploitation of the name/title of the series. In this connection, Mr Muir Wood relied upon the evidence about the events that occurred in February 2021 in Japan, and Mr Misato's statements that he was forced into signing an agreement and, immediately after such event, Japan filed an application for a trade mark in Japan. Mr Muir Wood commented that this is just continuing that course of behaviour by filing a trade mark in the UK.

95. Mr Muir also argued that when the contract is construed properly, and it is accepted that Japan is not allowed to merchandise because that is only the right of Shin, in those circumstances the burden must reverse and shift, and it is for Japan to prove why it is entitled to file a trade mark in the UK for goods and services which are identical to those for which Shin is entitled to exploit under the contract.

96. Ms Collett, on her part, argued that if Japan were really acting in bad faith, and it wished to stop Shin and Mr Misato from exercising their right to the exploitation of the title/name, it would have applied for identical goods and services including animated TV shows, entertainment and merchandise, which, she contended, it did not do. Conversely, Mr Muir Wood noted that the contested mark clearly includes these goods and services because it covers merchandising goods such as games and toys as well as *movie film production and distribution, production of radio or television programs; directing of radio and television programs*.

97. Another point made by Ms Collett is that Japan's preparations for use in the UK were done entirely legitimate, and its application was made with the sole intention of protecting his own rights and its position; in this connection, she argued that the contract relied upon by Shin and Mr Misato is not clear and "*is certainly not prescriptive"* and that the evidence filed by Shin and Mr Misato contradicts the allegations that have been made.

98. I have already concluded that even if Japan had contributed creatively to the series, it waived any rights in the series by virtue of the contract. Further, Japan had acted as a representative for Mr Misato and had never had a contract with Mr Misato.

Significantly, Japan justifies its action by saying that it was a co-author of the first series. Mr Akiyoshi also alleged that *"Mr Misato had produced PUIPUI MOLCAR under [his] direction and had promised to concentrate on producing a sequel to PUIPUI MOLCAR under Japan's direction after the production of the first phase of PUIPUI MOLCAR was completed"*. He also states that the reason for the breaking down of the relationship between Mr Misato and Japan was that Mr Misato suddenly stopped being a freelance animator, broke the above promise, and accepted a job offer from WIT STUDIO to become a contracted employee of WIT STUDIO, refusing to produce a further series of 'PUI PUI MOLCAR' with Japan. By the time Japan filed its application, Mr Misato's lawyer had notified Japan that Mr Misato had cancelled the contracts he signed on 25 and 30 January 2021 because he felt he had signed them under duress; there is no evidence of Japan subsequently denying these allegations or trying to enforce whatever contracts Mr Misato had signed. Consequently, regardless of whether the contract between Mr Misato and Japan was actually signed under duress (and I do not need to decide this point), Japan knew that the contract of June 2019 assigned the copyright in the series and the right to exploit the series through merchandising to Shin and Mr Misato. Furthermore, whilst Japan had felt that Mr Misato had broken his promise to work with Japan on a second series, there is no evidence of Mr Misato signing a contract with Japan in this respect. Consequently, it is more likely than not Japan applied for the contested mark with the intention of exercising some pressure on Shin and Mr Misato to get involved in the production of the second series, given that it had been excluded by Shin and Mr Misato who are the only owners of the copyright in the series and enjoy the right to exploit the series both in Japan and abroad, including the UK. This is bad faith.

99. Accordingly, this ground is also successful.

Section 5(4)(a)

100. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]
(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

101. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

102. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

103. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
>
> (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.
>
> The question whether deception is likely is one for the court, which will have regard to:
>
> (a) the nature and extent of the reputation relied upon,
>
> (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
>
> (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
>
> (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The relevant date

104. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), sitting as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

105. Japan did not file any evidence that it used the contested mark in the UK. Consequently, the only relevant date I need to consider is the filing date of the contested mark, which is 8 September 2022.

Goodwill

106. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

107. As regards the proof of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

108. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

109. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

110. Ms Collet argued that where a TV show is shown on a broadcaster such as Netflix, there are inevitably licensing agreements, there are inevitably rights agreements which demonstrate what way the rights go from whom, by whom, to whom and so on and so

forth. She pointed out that in the present case the evidence fails to establish the existence of any licensing agreement, and the ownership of any goodwill.

111. The parties agree that the first series of ‘MOLCAR’ was added to Netflix UK on 25 March 2021 (which is prior to the filing date of 08 September 2022).

112. I have already observed that the parties to the contract intended Shin to have exclusive control over the commercial exploitation and protection of the series, including the exploitation and protection of the title/name ‘MOLCAR’; this supports an inference that the rights necessary to exercise that control (including registered and unregistered trade mark rights) were intended to vest in Shin and Mr Misato. However, such inference does not amount to being the owner of registered trade marks or goodwill in the title/name ‘MOLCAR’ .

113. As regards goodwill, there is evidence of the first series of ‘MOLCAR’ being added to Netflix UK on 25 March 2021, and Mr Muir Wood observed that the series was broadcast in the UK for eighteen months, with moderate viewing figures. However, as Ms Collett rightly observed, there is no evidence of any license agreement between Shin/Mr Misato and Netflix and there is no evidence that the UK public associate the title of the series ‘MOLCAR’ with Shin or Mr Misato.

114. Even assuming that a more than trivial goodwill was generated in the UK through the exploitation of the series, I am inclined to think that Netflix would have goodwill in its own streaming business, although that does not mean that when consumers encounter ‘MOLCAR’ they necessarily regard Netflix as the source of the series. Still, there is no evidence that UK viewers associated the Netflix series with the holders of the copyright in the series, i.e. Shin and Mr Misato, that is to say there is no evidence that ‘MOLCAR’ is understood as an animated series originating from the Japanese company Shin or from Mr Misato (who are the producer and creator of the series, respectively). In other words, even if Shin and Mr Misato had the authority to exploit the title ‘MOLCAR’ by virtue of the contract, that does not necessarily result in the ownership of the goodwill in the UK.

115. The Section 5(4)(a) ground fails.

Section 5(4)(b)

116. Section 5(4)(b)

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—
>
> (a)….
>
> (b) by virtue of an earlier right other than those referred to in subsections (1) to
>
> (3) […], in particular by virtue of the law of copyright […]."

117. As it will be recalled, I have concluded that the first question I need to answer under this ground is whether the works claimed, namely the animated TV series and the title/name of the series 'MOLCAR', qualify for copyright protection in the UK under UK law. If they do, copyright in the works claimed belong to Shin ad Mr Misato by virtue of the Japanese contract. The second question I need to answer is whether, if copyright subsist in the series 'MOLCAR' or in the title/name 'MOLCAR' that would be sufficient for Shin and Mr Misato to own copyright in the sign pleaded 'PUI PUI MOLCAR' under Section 5(4)(b).

118. Ms Collett argued that the authorities support Japan's position in that short word marks and titles are not protectable by copyright. In this connection, she cited the decision in *Infopaq International A/S v. Danske Daglades Forening* (C-5/08) EU:C:2009:465; [2010] F.S.R. 20, which requires the author to be able to express their creative abilities in the production of the work by making free and creative choices so as to stamp the work created with their personal touch. She commented that the law does not support copyright subsisting in a two-word title and the title claimed. i.e. 'PUIPUI MOLCAR' is far too short and therefore insufficient to benefit from protection. Further she argued that the copyright claim is not sufficiently pleaded as demonstrated by the fact that Mr Muir Wood gave a rough creation date coinciding with the

presentation and it is not clear at what point ‘PUIPUI MOLCAR’ was created. Further, Ms Collett argued that ‘PUIPUI MOLCAR’ is at best a derivative work and whilst there is evidence on ‘MOLCAR’, there is no evidence on ‘PUIPUI MOLCAR’.

119. Alternatively, Ms Collett argued that the only copyright that could be protected by virtue of the contract is in the show as a whole, i.e. the episodes, the provision of the show, not the title/name *solus* and contended that ‘PUIPUI MOLCAR’ is not the taking of a substantial part.

120. The relevant provision of the Copyright, Designs and Patents Act 1988 (“the CDPA”) are as follows:

> **“1 Copyright and copyright works.**
>
> (1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work
>
> (a) original literary, dramatic, musical or artistic works
> (b) sound recordings, **films** or broadcasts, and
> (c) the typographical arrangement of published editions.
>
> (2)….

121. Section 3 is also relevant:

> **“3 Literary, dramatic and musical works.**
>
> (1) In this Part—
> “literary work” means any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes—
>
> (a) a table or compilation other than a database.
> (b) a computer program,
> (c) preparatory design material for a computer program and

(d) a database;

"dramatic work" includes a work of dance or mime; and
"musical work" means a work consisting of music, exclusive of any words or action intended to be sung, spoken or performed with the music.

(2) Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise; and references in this Part to the time at which such a work is made are to the time at which it is so recorded."

122. Section 16 and 17 are relevant as they states:

"16. The acts restricted by copyright in a work.
(1)The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom—

(a) to copy the work (see section 17);

…
(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it—

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright."

"**17 Infringement of copyright by copying.**

(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies shall be construed as follows.

(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form.

This includes storing the work in any medium by electronic means."

123. I consider that the single episodes of the series are protected by copyright in the UK as films under Section 1(1)(b). Section 5B(1) defines a film *"as a recording on any medium from which a moving image may by any means be produced".* This would cover an animated TV episode and there is no requirement of originality – this applies to original literary, dramatic, musical or artistic works but not films. Whilst the script, artwork and music of the episodes can have their own copyright protection as original literary, dramatic, musical or artistic works, I am not convinced that the title of the single episodes (and of the series) is protectable as copyright work. In this connection, Ms Collett commented that there has been a general reluctance to confer copyright to title of newspapers, magazines, books and similar works mentioning a number of cases. For example, she referred to copyright not being found to exist in the title of a game show "Opportunity Knocks" (*Green v Broadcasting Corp of New Zealand* [1989] R.P.C. 469 at [475]), and in the title of a song "Nellie the Elephant" (*Animated Music Ltd's Trade Mark* [2004] E.C.D.R. 27). Further, in *Tavener Rutledge Ltd v Trexapalm Ltd* [1975] F.S.R. 479, at [483], there was no copyright or other property in the invented name "Kojak" by itself. Conversely, Mr Muir Wood referred to the case of *Courtenay-Smith v. Notting Hill Shopping Bag Co Ltd* [2025] EWHC 1793 (IPEC); [2025] E.C.C. CD22, where the Court found that artistic copyright subsisted in the simple sign:



124. However, as I noted earlier, Mr Muir Wood dropped the claim relating to copyright in artistic work.

125. The only case left in relation to the title of the series is that of "literary work" which is defined as "*any work, other than a dramatic or musical work, which is written, spoken or sung".* However, I do not consider that one word, i.e. the word 'MOLCAR' in which copyright was assigned to Shin and Mr Misato, represents original literary work in itself. Further, even if I am wrong, and the copyright in the title 'MOLCAR' existed by virtue of the contract, that would be different from the sign pleaded (which is 'PUI PUI MOLCAR') and there is no evidence of Shin and Mr Misato holding copyright in the sign pleaded.

126. Finally, even if I have found that there is copyright in the single episodes, there would be no protection against Japan's registration because: (a) the sign applied for is 'PUI PUI MOCAR' whilst the series identified in the contract in respect of which copyright is assigned is 'MOLCAR' and (b) there would be no infringement because registering a sign which is similar to the title of the episodes does not constitute "copying" the single episodes (as films); neither does it constitute copying the script, artwork and music of the episodes (which I have said can have their own copyright protection as original literary, dramatic, musical or artistic work). The copyright claim fails in its entirety.

OUTCOME

127. As the invalidity has been entirely successful under Section 3(6) and 5(6), Japan's trade mark no. UK00003827800 will be cancelled *ab initio*, i.e. from its filing date of 8 September 2002.

128. It follows that the only right relied upon by Japan in the opposition is cancelled, the opposition falls away and Shin's IR application no. WO0000001727990 will proceed to registration.

COSTS

129. Shin has been successful in the opposition, whilst Shin and Mr Misato have been jointly successful in the invalidity. Shin and Mr Misato are, therefore, entitled to a

contribution towards their costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the following sums:

Opposition:
Preparing the counterstatement
And considering the opposition: £350

Invalidity
Filing the invalidity application: £500
Filing evidence and considering Japan's evidence: 1,200

Attending the hearing: £1,000
Official fees: £200

130. I therefore order JAPAN GREEN HEARTS CO., LTD. to pay (a) Shin-ei Animation Co Ltd the sum of £350 (b) Shin-ei Animation Co Ltd and Mr Tomoki Misato jointly the sum of £2,900. These sums are to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of October 2026

TERESA PINTO
For the Registrar

ANNEX 1

Class 2: *Canada balsam; copal; sandarac; shellac; dammar; pine gum; wood preservatives; dyestuffs; pigments; coatings [paints]; printing ink; printing ink, other than mimeographing inks; mimeographing inks; colors for painting pictures; intaglio ink; typographic ink; planographic ink; conductive inks; engraving ink; oil colors; water-colors; oil paints for use in art; watercolor paints for use in art; fixatives for watercolors; anti-rust greases; non-ferrous metals in foil or powder form for use in painting, decorating, printing and art; precious metals in foil or powder form for use in painting, decorating, printing and art; colorants for the restoration of furniture in the form of markers; colorants; edible inks; ink for printers and photocopiers; ink cartridges, filled, for printers and photocopiers; toner cartridges, filled, for printers and photocopiers; edible ink cartridges, filled, for printers; paper for dyeing Easter eggs.*

Class 8: *Tweezers; hoes [hand tools]; digging forks [spading forks]; rakes [hand tools]; electric flat irons; electric razors and electric hair clippers; edge tools [hand tools]; egg slicers, non-electric; can openers, non-electric; spoons; cheese slicers, non-electric; pizza cutters, non-electric; forks [cutlery]; dressmakers' chalk sharpeners; fireplace shovels; hand tools, hand operated, other than bladed or pointed hand tools; bushhammers [stone hammers]; mallets; hammers [hand-operated]; spanners; screwdrivers, non-electric; adjustable spanners; masons' trowels; branding irons; vices; carpenters' pincers [nail pullers]; nippers; pliers; cutting pliers; tongs; picks; pickaxes and mattocks; spades; gardening trowels; shovels; snow shovels; fire tongs; bludgeons; shaving cases; pedicure sets; eyelash curlers; manicure sets; ice axes; diving knives; diving knife holders; palette knives; forks that can also be used as chopsticks; syringes for spraying insecticides; hand pumps; laser hair removal apparatus, other than for medical purposes; depilation appliances, electric and non-electric; squares [hand tools]; apparatus for tattooing; tattoo needles; ear-piercing apparatus; sterile body piercing instruments; air pumps, hand-operated; guns, hand-operated, for the extrusion of mastics; scrapers for skis.*

Class 9: *Ear plugs for swimming; ear plugs for divers; ozonisers [ozonators]; electrolysers; egg-candlers; blueprint apparatus; cash registers; coin counting or sorting machines; photocopying apparatus; mathematical instruments; time and date stamping machines; time clocks [time recording devices]; punched card office machines; voting machines; life-saving apparatus and equipment; fire extinguishers; fire hoses; fire hose nozzles; sprinkler systems for fire protection; fire alarms; gas alarms; burglar alarms; crash helmets; railway signals; vehicle breakdown warning triangles; road signs, luminous or mechanical; game programs for arcade video game machines; simulators for the steering and control of vehicles; sports training simulators; photographic apparatus and instruments; cinematographic machines and apparatus; measuring or testing machines and instruments; rotary converters; phase modifiers; solar batteries; electrical cells and batteries; conductors, electric; telecommunication machines and apparatus; cell phone cases; personal digital assistants; cases adapted for computers; computer peripheral devices; computer mouse; battery chargers for tablet computers; computer keyboards; covers for computer keyboards; USB flash drives; USB adapters; geiger counters; cyclotrons; industrial X-ray apparatus; industrial betatrons; magnetic prospecting machines; magnetic object detectors; seismic exploration machines and apparatus; echo sounders; ultrasonic flaw detectors; ultrasonic sensors; electron microscopes; magnetic cores; resistance wires; electrodes; fire boats; satellites for scientific purposes; fire engines; respirators for filtering air; gas masks; welding masks; fireproof garments; disaster prevention hoods; gloves for protection against accidents; eyeglasses; consumer video game programs; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; protective helmets for sports; sports whistles; weight belts for scuba diving; air tanks [for scuba diving]; snorkels; regulators for scuba diving; metronomes; electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; electric and electronic phasers [effects units] for electric or electronic musical instruments; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; electronic publications; exposed cinematographic films; exposed slide films; slide film mounts; downloadable electronic publications in the nature of coloring books, children's activity books and magazines in the field of entertainment; downloadable avatars*

(video characters); downloadable image files and digital stamp; computer programs; computer software, recorded; computer software applications, downloadable; pre-recorded CD-ROMs; pre-recorded DVDs; computer software platforms, recorded or downloadable; decorative magnets; nets for protection against accidents; electrified fences; optical glass; screens for photoengraving; automated teller machines [ATM]; ink cartridges, unfilled, for printers and photocopiers; accumulator boxes; mechanisms for coin-operated apparatus; ticket dispensers; teaching robots; humanoid robots with artificial intelligence; telepresence robots; signalling whistles; signal bells; flashing lights [luminous signals]; signs, luminous; signals, luminous or mechanical; signalling panels, luminous or mechanical; fog signals, non-explosive; railway traffic safety appliances; beacons, luminous; signalling buoys; marking buoys; resuscitation training simulators; locks, electric; padlocks, electronic; encoded key cards; acoustic conduits; urinometers; stage lighting regulators; igniting apparatus, electric, for igniting at a distance; electric apparatus for remote ignition; electric door bells; buzzers; egg timers [sandglasses]; hourglasses; sandglasses; dog whistles; animal signalling rattles for directing livestock; electronic collars to train animals; neon signs; shoes for protection against accidents, irradiation and fire; circular slide rules; slide-rules.

Class 11: *Water closets; prefabricated bath installations sold as a unit; drying apparatus for chemical processing; recuperators for chemical processing; steamers for chemical processing; evaporators for chemical processing; distillers for chemical processing; heat exchangers for chemical processing; milk sterilizers; industrial furnaces; nuclear reactors; forage drying apparatus; boilers, other than parts of non-electric prime movers or engines; towel steamers [for hairdressing purposes]; hair drying machines for beauty salon use; hair steamers for beauty salon use; dish disinfectant apparatus for industrial purposes; tap water faucets; garbage incinerators; garbage incinerators for industrial purposes; garbage incinerators for household purposes; solar water heaters; water purifying apparatus; electric lamps and other lighting apparatus; lava lamps; lamps; wall lights; household electrothermic appliances; household electrothermic appliances, other than for beauty or sanitary purposes; household electrothermic appliances for beauty or sanitary purposes; washers for water taps; washers for water faucets; gas-fired*

water heaters; non-electric cooking heaters for household purposes; kitchen sinks incorporating integrated worktops for household purposes; kitchen sinks for household purposes; household tap-water filters, non-electric; standing paper lanterns [andon]; chinese lanterns; gas lamps; oil lamps; lamp chimneys; warming pans, non-electric; pocket warmers; hot water bottles; toilet stool units with a washing water squirter; disinfectant dispensers for toilets; toilet bowls; bath fittings; stoves [space heaters] for household purposes, non-electric; disposable pocket warmers; chimney flues; water-pipes for sanitary installations; structural framework for ovens; kiln furniture [supports]; oven fittings made of fireclay; sanitary apparatus and installations; shower cubicles; acetylene burners; ash conveyor installations, automatic; refrigerating containers; aquarium heaters; aquarium filtration apparatus; sterilisers; coils [parts of distilling, heating or cooling installations]; heat guns; chimney blowers; fountains; ornamental fountains; glue-heating appliances; refrigerators, cooling apparatus and freezers for medical storage purposes; whirlpool-jet apparatus; book sterilisation apparatus; hand drying apparatus for washrooms; regulating accessories for water or gas apparatus and pipes; water softening apparatus and installations; apparatus for dehydrating food waste; fog machines; microbubble generators for baths; laboratory burners; disinfectant apparatus for medical purposes; dental ovens; sockets for electric lights; heaters for heating irons; bed warmers; vehicle reflectors; luminous house numbers; bidets; ice-cooling refrigerators for household purposes.

Class 12: *Traction engine; non-electric prime movers for land vehicles, not including their parts; parachutes; anti-theft alarms for vehicles; wheelchairs; vessels and their parts and fittings; vessels and their parts and fittings, other than air cushion vehicles; air cushion vehicles; aircraft and their parts and fittings; railway rolling stock and their parts and fittings; automobiles and their parts and fittings; two-wheeled motor vehicles, bicycles and their parts and fittings; rickshaws; sleighs and sleds [vehicles]; trolleys; carts; horse-drawn carriages; riyakah [two-wheeled carts]; adhesive rubber patches for repairing tubes or tires; baby carriages; tricycles; tyres for snow ploughs; diving bells; space vehicles; lug nuts for vehicle wheels; ashtrays for automobiles.*

Class 14: *Precious metals; unwrought and semi-wrought precious stones and their imitations; gemstones; semi-wrought precious stones and their imitations; key rings; jewelry boxes; prize cups of precious metals; commemorative shields of precious metal; personal ornaments [jewellery, jewelry (Am.)]; precious metals, unwrought or semi-wrought; key chains comprised of split rings with trinket or decorative fob; key rings comprised of split rings with trinket or decorative fob; charms for key chains; charms for jewelry as personal ornaments; necklaces; bracelets; wristwatches; clocks; alarm clocks; badges of precious metal; brooches; earrings; medals; pins being jewelry; rings; chains, namely, neck chains, jewelry chains and watch chains; personal ornaments, other than cuff links, in the nature of jewellery; insignias of precious metal; tie clips; tie pins; pendants; rings [trinket]; lockets; bracelets made of embroidered textile [jewelry]; ornamental pins; pins [jewelry]; chains [jewelry]; chaplets; necklaces [jewelry]; bracelets [jewelry]; brooches [jewelry]; hat jewelry; crucifixes as jewelry; jewelry hatpins; amulets [jewelry]; misbaha [prayer beads]; rings [jewelry]; lockets [jewelry]; rosaries; cuff links; shoe ornaments of precious metal; shoe jewelry; watches; busts of precious metal; crucifixes of precious metal, other than jewelry; statuettes of precious metal; statues of precious metal; works of art of precious metal; coins; jewelry rolls; bonnet pins, not of precious metal.*

Class 15: *Tuners for musical instruments; musical instruments; music stands; conductors' batons; tuning forks; rosin for stringed musical instruments.*

Class 16: *Desktop document stands; paper shopping bags; postcards; coloring books; office requisites, except furniture; stapler; paper scissors (stationery); office scissors; rulers; erasers; pencils; pens; ballpoint pens; colored pencils; colored pens; marker pens; highlighting markers; notebooks; notepads; self-adhesive paper or note; correction fluids; glue; gummed tape [stationery]; adhesive tapes for stationery or household purposes; masking tape; bookbinding tape; files; folders; binders; photo albums; collectible trading cards; pencil lead holders; desk mats; folders for papers; writing instruments; pen cases; document files; fountain pens; stationery folders; stationery; printed matter; catalogues; books; diaries; table napkins of paper; handkerchiefs of paper; bookmarkers; calendars; posters; comic magazines; comic books; cartoon prints; graphic prints; stickers; trading cards other*

than for games; photographs; picture postcards; sheet music; song books; printed timetables; newspapers; geographical maps; newsletters; pamphlets; paper and cardboard; paintings and calligraphic works; photographs [printed]; photograph stands; printed paper for lot, other than toy; shipping tags; hygienic hand towels of paper; towels of paper; hand towels of paper; banners of paper; flags of paper; paper patterns; tailors' chalk; garbage bags of paper for household purposes; garbage bags of plastic; food wrapping plastic film for household use; bags [pouches] of plastics, for packaging; industrial packaging containers of paper; decorators' paintbrushes; marking templates; addressing machines; ink ribbons; electric staplers for offices; envelope sealing machines for offices; typewriters; checkwriters; mimeographs; relief duplicators; paper shredders for office use; franking machines for office use; rotary duplicators; printers' reglets; printing type; sealing wax; pastes and other adhesives for stationery or household purposes; histological sections for teaching purposes; paper bags for use in the sterilization of medical instruments; dental tray covers of paper; pencil sharpening machines, electric or non-electric; pencil sharpeners, electric or non-electric; bookbinding material; fabrics for bookbinding; bookbinding cloth; bibs, sleeved, of paper; bibs of paper; bookbinding cords; elastic bands for offices; table linen of paper; covers of paper for flower pots; drawer liners of paper, perfumed or not; bookends; tablecloths of paper; table runners of paper; paper mache figurines; portraits; signboards of paper or cardboard; placards of paper or cardboard; holders for checkbooks; money clips; passport holders; architects' models; plastics for modelling; cigar bands; omikuji [printed strips of paper used for fortune telling]; coloring pictures.

Class 18: *Make-up bags; bags; backpacks; attache cases; bags for climbers; rucksacks; leather bags; bags for campers; school bags; handbags; bags for sports; shoulder bags; beach bags; slings for carrying infants; briefcases; suitcases; traveling trunks; traveling bags; net bags for shopping; vanity cases, not fitted; pocket wallets; purses; wheeled shopping bags; folding briefcases; carry-on bags; tote bags; trunks; boston bags; schoolchildren's backpacks; pouches; small pouch cases; card cases [notecases]; change purses; key cases; wallets; business card cases; clothing for domestic pets; umbrellas; walking sticks; canes; metal parts of canes and walking-sticks; walking cane handles; saddlery; leather and fur, unworked*

or semi-worked; industrial packaging containers of leather; fur; rawhides; raw skins; curried skins; leather cord; leathercloth; frames for bags [structural parts for bags]; purse frames; horseshoes; casings, of leather, for springs; valves of leather; sling bags for carrying infants; boxes of vulcanized fiber; leather trimmings for furniture; reins for guiding children; straps for skates; alpenstocks; mountaineering sticks; trekking sticks; hiking sticks; labels of leather.

Class 20: *Acrylic partition for preventing droplet infection; single panel standing partition for preventing droplet infection; industrial packaging cases of plastics, wood, or bamboo; oriental single panel standing partition (tsuitate); furniture; towel dispensers, not of metal; cushions; Japanese floor cushions [zabuton]; pillows; mattresses; industrial packaging containers of wood, bamboo or plastics; wooden boxes for industrial packaging purposes; nameplates and door nameplates, not of metal; hand-held flat fans; hand-held folding fans; dog kennels; nesting boxes for small birds; beds for household pets; hand-held supermarket shopping baskets, not of metal; wind chimes; inflatable publicity objects; upright signboards of wood or plastics; door openers, not of metal, non-electric; clothes hangers; removable covers for sinks; mats, removable, for sinks; keyboards for hanging keys; bumper guards for cots, other than bed linen; bumper guards for cribs, other than bed linen; freestanding partitions [furniture]; valet stands; chests for toys; jigsaw puzzle frame; mannequins; costume display stands; picture frames; plaster sculptures; plastic sculptures; wooden sculptures; meerschaum; yellow amber; loading pallets, not of metal; beehives [hive boxes or honeycombs]; hairdresser's chairs; barbers' chairs; valves of plastic being other than machine parts; liquid storage tanks or reservoirs, not of metal or masonry; liquefied gas storage tanks, not of metal or masonry; gas storage tanks, not of metal or masonry; containers for transport, not of metal; curtain fittings; metal-substitute plastic fasteners; washers, not of metal, not of rubber or vulcanized fiber; locks, non-electric, not of metal; industrial packaging containers of wood [not including "corks nor wooden stoppers, lids and covers"]; industrial packaging containers of bamboo; industrial packaging containers of plastics [not including "plastic stoppers, lids, covers and bottles"]; embroidery frames; corks, plastics and wooden stoppers for industrial packaging containers; plastic and wooden lid and covers for industrial packaging containers; hand-held flagpoles, not*

of metal; stakes, not of metal, for plants or trees; step ladders and ladders, not of metal; letter boxes [not of metal or masonry]; hat hooks, not of metal; water tanks for household purposes, not of metal or masonry; hanging boards [Japanese style pegboards using positional hooks]; tool boxes, not of metal, empty; tool chests, not of metal, empty; indoor blinds; blinds of reed, rattan or bamboo [sudare]; bead curtains for decoration; window shades; benches; pocket mirrors; pocket mirror bags; shoe dowels, not of metal; shoe pegs, not of metal; cradles; infant walkers; bamboo, unworked or semi-worked; coral; wheat, barley or oat straw; rice straw; artificial horns; animal horns; animal teeth; door handles, not of metal; door knockers, not of metal; door bells, not of metal, non-electric; knobs, not of metal; sash pulleys, not of metal; door closers, not of metal, non-electric; door springs, not of metal, non-electric; runners, not of metal, for sliding doors; window pulleys, not of metal; gun racks; bakers' bread baskets; troughs, not of metal, for mixing mortar; drafting tables; plastic ramps for use with vehicles; collars, not of metal, for fastening pipes; winding spools, not of metal, non-mechanical, for flexible hoses; reels, not of metal, non-mechanical, for flexible hoses; mooring buoys, not of metal; loading gauge rods, not of metal, for railway wagons; identification bracelets, not of metal; brush mountings; shoulder poles [yokes]; poles, not of metal; door stops, not of metal or rubber; tent pegs, not of metal; straw plaits; plaited straw, except matting; straw edgings; shower chairs; bath seats for babies; bathtub grab bars, not of metal; garment covers [storage]; screens for fireplaces [furniture]; edgings of plastic for furniture; stuffed animals; stuffed birds; busts of wood, wax, plaster or plastic; crucifixes of wood, wax, plaster or plastic, other than jewellery; statuettes of wood, wax, plaster or plastic; statues of wood, wax, plaster or plastic; works of art made of wood, wax, plaster or plastic; mobile boarding stairs, not of metal, for passengers; bathroom stools; toy boxes.

Class 21: *Lunch boxes; portable chopsticks; cosmetic utensils; kitchen utensils and containers, not including gas water heaters for household use, non-electric cooking heaters for household purposes, kitchen sinks incorporating integrated worktops for household purpose and kitchen sinks for household purpose; rice cooking pots, non-electric; cooking pans, non-electric; mess-tins for cooking rice; frying pans, non-electric; cooking steamers, non-electric; japanese style tea-serving pots [kyusu];*

drinking cups; sake cups; dishes and plates; salad bowls; Japanese nests of food boxes [jubako]; Japanese rice bowls [chawan]; dish covers; decanters; sake serving bottles [tokkuri]; serving bowls [hachi]; beer mugs; jugs; teacups [yunomi]; japanese style soup serving bowls [wan]; tea canisters; bread bins; drinking flasks for travellers; vacuum bottles [insulated flasks]; japanese style cooked rice scoops [shamoji]; cooking funnels; Japanese style personal dining trays or stands [zen]; cooking sieves and sifters; whisks, non-electric; cooking skewers; cooking strainers; hand-operated coffee grinders and pepper mills; suribachi [articles of earthenware for household use]; cooking graters; chopping boards for kitchen use; rolling pins for cooking purposes; lemon squeezers; waffle irons, non-electric; dishware; non-electric ice chests for household purposes; food preserving jars of glass; water bottles sold empty; vacuum bottles; cookware; ice pails; sugar tongs; nutcrackers; pepper pots; sugar bowls; colanders; salt shakers; funnels; drinking straws; bottle openers, non-electric; egg cups; tart scoops; napkin holders; napkin rings; hot pads [trivets]; chopsticks; chopstick cases; ladles and dippers for kitchen use; sieves [household utensils]; cabarets [trays]; toothpicks; toothpick holders; cooking pots and pans, non-electric; coffee-makers, non-electric; non-electric tetsubin [Japanese cast iron kettles]; kettles, non-electric; cleaning tools and washing utensils; bird cages; feeding vessels for pets; brushes for pets; piggy banks; boxes of metal, for dispensing paper towels; soap dispensers; floss for dental purposes; unworked or semi-worked glass, not for building; mangers for animals; poultry rings; toothbrushes, electric; cosmetic utensils, other than "toothbrushes, electric"; tub brushes; metal brushes; brushes for pipes; ship-scrubbing brushes; gloves for household purposes; industrial packaging containers of glass or porcelain; industrial packaging containers of glass, not including glass stoppers, lids and covers; industrial packaging containers of ceramics; glass stoppers; glass lids for industrial packaging containers; plastic bottles for packaging; ironing boards; tailors' sprayers; ironing boards (kotedai); hera-dai [fabric marking boards]; yukakibo [Japanese bath utensils for hot bathtub water]; bathroom pails; candle extinguishers; candlesticks; cinder sifters for household purposes; coal scuttles; fly swatters; flower pots; hydroponic plant pots for home gardening; watering cans; clothes brushes; chamber pots; chemically activated packs for heating food and beverages; chemically activated packs for cooling food and beverages; toilet paper holders; vases; flower

bowls; upright signboards of glass or ceramic; incense burners; shoe brushes; shoe horns; shoe shine cloths; shoe shine sponges and cloths; shoe trees; portable cooking kits for outdoor use; cattle hair for brushes, raccoon dog hair for brushes, pig bristles for brushes and horsehair for brushes; crystal [glassware]; painted glassware; aromatic oil diffusers, other than reed diffusers, electric and non-electric; make-up removing appliances; plug-in diffusers for mosquito repellents; electric devices for attracting and killing insects; corkscrews, electric and non-electric; bottle openers, electric and non-electric; lint removers, electric or non-electric; tie presses; trouser presses; glass wool, other than for insulation; vitreous silica fibers, other than for textile use; fiberglass, other than for insulation or textile use; fiberglass thread, other than for textile use; porcelain ware; earthenware; crockery; majolica; epergnes; currycombs; horse brushes; combs for animals; smoke absorbers for household purposes; plates for diffusing aromatic oil; towel rails and rings; glove stretchers; candle warmers, electric and non-electric; toothpaste tube squeezers; clothing stretchers; stretchers for clothing; buttonhooks; glue-pots; decorative glass spheres; china ornaments; busts of porcelain, ceramic, earthenware, terra-cotta or glass; figurines of porcelain, ceramic, earthenware, terra-cotta or glass; statues of porcelain, ceramic, earthenware, terra-cotta or glass; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; material for brush-making; cotton waste for cleaning; insect collectors' boxes; insect collecting boxes in the form of a flattened cylindrical metal case.

Class 24: *Woven fabrics; woven fabrics, other than edging ribbons for tatami mats; cloth for tatami mat edging ribbons; knitted fabrics; felt and non-woven textile fabrics; oilcloth; gummed waterproof cloth; vinyl coated cloth; rubberized cloth; woven textile goods for personal use; mosquito nets; bedsheets; futon quilts; futon quilt covers; futon ticks [unstuffed futon]; pillowcases; blankets; table napkins of textile; dish towels; shower curtains; banners and flags, not of paper; fitted toilet seat covers of textile; seat covers of textile; wall hangings of textile; curtains of textile or plastic; door curtains; table cloths, not of paper; draperies [thick drop curtains]; shrouds; billiard cloth; sleeping bags; printers' blankets of textile; baby buntings; blankets for household pets; cloths for removing make-up; bath mitts; labels of textile; knitted raschel lace fabrics.*

Class 25: *Clothing; t-shirts; sweatshirts; pants; shorts; pyjamas; ready-made clothing; coats; dresses; furs being clothing; kimonos; knitwear; paper clothing; petticoats; pinafore dresses; shirts; skirts; sweaters; swimsuits; trousers; underwear; vests; bandanas for use as neckerchiefs; belts being clothing; berets; caps being headwear; fur stoles; garters; leg warmers; neckties; scarfs; shawls; socks; sleep masks; suspenders; tights; non-Japanese style outerclothing; evening dresses; school uniforms; children's wear; jogging pants; sweat pants; suits; ski jackets; ski pants; smocks; formalwear; overcoats; topcoats; mantles; raincoats; cardigans; vests and waistcoats; open-necked shirts; cuffs; sport shirts; blouses; polo shirts; shirts for suits; overalls; stuff jackets [clothing]; outerclothing; togas; liveries; saris; sarongs; shirt fronts; shirt yokes; jumper dresses; skorts; wristbands [clothing]; chasubles; fishing vests; detachable collars; parkas; breeches for wear; collars [clothing]; pullovers; jumpers [pullovers]; waistcoats; pelisses; ponchos; leggings [trousers]; nightwear; swimwear [bathing suits]; swimming caps [bathing caps]; night gowns; negligees; japanese sleeping robes [nemaki]; pajamas; bath robes; undershirts; corsets [underclothing]; combinations [clothing]; chemises; slips; brassieres; camisoles; tank-tops; beach clothes; knickers; short-sleeve shirts; leotards; japanese traditional clothing; sash bands for kimono [obi]; bustle holder bands for obi [obiage]; bustles for obi-knots [obiage-shin]; waist strings for kimonos [koshihimo]; undershirts for kimonos [koshimaki]; undershirts for kimonos [juban]; tightening-up strings for kimonos [datejime]; wrap belts for kimonos [datemaki]; full-length kimonos [nagagi]; short overcoat for kimono [haori]; string fasteners for haori [haori-himo]; pleated skirts for formal kimonos [hakama]; detachable neckpieces for kimonos [haneri]; aprons [clothing]; neck scarves; puttees and gaiters; japanese style socks [tabi]; gloves and mittens [clothing]; neckerchieves; mufflers [clothing]; ear muffs [clothing]; nightcaps; headgear for wear; sock suspenders; braces [suspenders] for clothing; waistbands; belts [clothing]; footwear [other than special footwear for sports]; running shoes; sandals; hiking boots; inner soles; ladies' boots; pumps being footwear; shoes for children; sneakers; training shoes; women's shoes; work boots; rain boots; leather shoes; winter boots; infants' shoes and boots; inner soles for shoes and boots; insoles for shoes and boots; tongue or pullstrap for shoes and boots; rubber soles for jikatabi; footwear uppers; tips for footwear; shoe*

soles for repair; japanese style wooden clogs [geta]; japanese style sandals [zori]; high rain clogs [ashida]; sandal-clogs; low wooden clogs [koma-geta]; low wooden clogs [hiyori-geta]; metal fittings for Japanese style wooden clogs; wooden bodies for Japanese-style clogs; toe straps for Japanese style wooden clogs; japanese toe-strap sandals [asaura-zori]; japanese style sandals of leather; slippers; japanese style sandals of felt; japanese footwear of rice straw [waraji]; slipper soles; uppers for Japanese style sandals; soles for Japanese style sandals; toe straps for Japanese style sandals [zori]; uppers of woven rattan for Japanese style sandals; masquerade costumes; boots for sport; clothing for sports; non-slipping devices for footwear; protective members, not of metal, for shoes and boots.

Class 26: *Shuttles for making fishing nets; hosiery loom needles; needles; eyelets for clothing; tapes [haberdashery]; ribbons; embroidery lace fabrics; tufts and tassels [semi-finished]; braids; needle-threaders; sewing boxes; sewing thimbles; pin cushions; boxes for needles; insignias for wear, not of precious metal; buckles for clothing [clothing buckles]; badges for wear, not of precious metal; brooches for clothing; ornamental adhesive patches for jackets; brassards; hair ornaments; buttons; false beards; false moustaches; shoe ornaments not of precious metal; shoe eyelets; shoe laces; metal fasteners for shoes and boots; human hair; ornamental novelty badges [buttons]; ornamental novelty buttons; appliques [haberdashery]; prize ribbons; heat adhesive patches for repairing textile articles; heat adhesive patches for decoration of textile articles [haberdashery]; buckles [clothing accessories]; hat bands; hat pins, other than jewellery; pins, other than jewellery; brooches [clothing accessories]; hat trimmings; monogram tabs for marking linen; charms, other than for jewellery, key rings or key chains; sewing kits; cords for clothing; breast lift tapes; shoulder pads for clothing; tapes for curtain headings; artificial garlands; artificial Christmas garlands incorporating lights; artificial Christmas garlands; competitors' numbers; omamori [lucky charms]; buckles for bags; clasps for bags.*

Class 28: *Amusement machines and apparatus for use in amusement parks; arcade video game machines; toys for domestic pets; toys; stuffed toy animals; plush toys; toy figurines; novelty toys; sporting equipment (balls); infant toys;*

tesselation toys; construction toys; fidget toys; clockwork toys; water toys; pet toys; inflatable toys; stuffed toys; plush toys; musical toys; talking toys; sketching toys; printing toys; pull toys; bendable toys; drawing toys; mechanical toys; bathtub toys; sandbox toys; bath toys; push toys; stacking toys; knitted toys; sand toys; squeeze toys; vending machine toys; action figure toys; music box toys; electronic action toys; mechanical action toys; spinning fidget toys; electric action toys; inflatable pool toys; lever action toys; tossing disc toys; flying saucers [toys]; rubber character toys; ride-on toys; squeezable squeaking toys; infant development toys; plastic character toys; transforming robotic toys; soft sculpture toys; pop up toys; disc toss toys; wind-up toys; water squirting toys; interlocking construction toys; helical spring toys; soft knitted toys; smart plush toys; smart robot toys; non-riding transportation toys; stress relief exercise toys; construction toys incorporating magnets; stands for rideable toys; scale model kits [toys]; stuffed and plush toys; wind-up walking toys; magnetic putty being toys; magnetic levitating desk toys; inflatable ride-on toys; pop tube fidget toys; soft sculpture plush toys; inflatable thin rubber toys; battery operated action toys; rideable toys and accessories therefor; toys, namely, bean bag animals; articles of clothing for toys; plush toys in a gift basket; children's multiple activity toys; inflatable toys showing decorative pictures; novelty plush toys for parties; toy aircraft; toy models; toy jewelry; toy brooches; toy tools; toy animals; toy cars; toy whistles; toy balloons; toy mailboxes; toy glockenspiels; toy pianos; toy masks; toy houses; toy airplanes; toy glowsticks; toy stamps; toy figures; toy noisemakers; toy gliders; toy banks; toy harmonicas; toy xylophones; toy helicopters; toy boats; toy pinwheels; toy microscopes; toy cookware; toy cameras; toy vehicles; toy robots; toy drones; toy watches; toy telescopes; toy scooters; toy strollers; toy rockets; toy looms; toy putty; toy mobiles; toy building structures and toy vehicle tracks; pvc toy figures; model toy vehicles; rideable toy vehicles; plastic toy hoops; electronic toy vehicles; molded toy figures; collectable toy figures; toy modelling dough; luminous toy putty; toy building blocks; toy insect cages; toy insect nets; toy modeling compounds; toy building structures; toy vehicle tracks; miniature toy helmets; toy butterfly nets; toy music boxes; stuffed toy bears; toy prism glasses; toy model cars; toy zip guns; toy construction blocks; toy cap pistols; positionable toy figures; toy hoop sets; toy air pistols; toy glow sticks; toy beanbags [otedama]; toy prism spectacles; toy stuffed animals; cases for toy vehicles; caps for toy pistols;

interchangeable magnetic toy vehicles, non-electronic toy vehicles; model toy steam engines; toy clocks and watches; radio-controlled toy vehicles; remote-controlled toy planes; remote-controlled toy vehicles; toy LED light sticks; toy model kit cars; modeled plastic toy figurines; transforming robotic toy vehicles; wheels for toy vehicles; cases for toy structures; visors for toy helmets; electronically operated toy motor vehicles; toy scooters and accessories therefor; toy figures and attachable, wearable or magnetic accessories therefore; toy vehicles, namely, caster boards; talking electronic press-down toy; toy buildings and accessories therefor; toy animals and accessories therefor; toy vehicles and accessories therefor; toy vehicles with transforming parts; self-erasing toy drawing boards; cases for toy of cars; cases for toy of airplanes; cases for toy of boats; play houses and toy accessories therefor; hand-powered non-mechanical flying toy; model toy steam operated traction engines; toy building blocks capable of interconnection; toy projectile shooters and accessories therefor; toy glow stick bracelets for parties; toy action figures and accessories therefor; toy hand buzzers for playing jokes; play mats for use with toy vehicles; positionable printed toy figures for use in puzzles; positionable printed toy figures for use in games; novelty toy items in the nature of artificial plush animal tails; racks and stands specifically designed to hold toy vehicles; racks and stands specifically designed to hold toy scooters; toy vehicle track sets and roadways and accessories therefor; toy model vehicles and related accessories sold as units; clockwork toys of metal; paper toys; karuta playing cards [Japanese card game]; plush toys; stuffed toys; plastic toys; clockwork toys of plastics; rubber toys; rubber balls; toy musical boxes; toy sets; toy construction sets; toy sets of carpenters' tools; marbles; toy pistols; toy fireworks; home video game machines; toy christmas trees; hand-held games with liquid crystal displays; four-wheeled toy vehicles; soap bubbles [toys]; kites; menashi-daruma [bodhidharma dolls without pupils]; rocking horses; tricycles for infants [toys]; inflatable swimming pools [play articles]; ring games; japanese traditional dolls; osuwari dolls [dolls in sitting position]; kokeshi dolls; sakura dolls; clothes for Japanese traditional dolls; european style dolls; clothes for European dolls; traditionally dressed western dolls; dolls; go board games; travel games - checkers; go games; go stones; goke pots [pots for stone pieces used in go games]; go boards; japanese chess [shogi games]; wooden pieces for shogi game [koma]; shogi boards; japanese playing cards

[utagaruta]; japanese dice games [sugoroku]; chinese checkers [games]; checkers [checker sets]; japanese playing cards [hanafuda]; dice; sugoroku board games; cups for dice; chess games; checkers games; conjuring apparatus; apparatus for performing magic tricks; dominoes; playing cards; mah-jong; game machines and apparatus; billiard equipment; sports equipment; sports equipment, other than for climbing, surfing, water-skiing and scuba diving; climbers' harness; fishing tackle; butterfly nets; jigsaw puzzles; golf bag carts; golf bag trolleys; confetti.

Class 29: *Fruit-based, vegetable-based, bean-based or nut-based snacks; roasted chestnuts; preserved pulses; edible oils and fats; milk products; meat; eggs; seafood, not live; frozen vegetables; frozen fruits; charcuterie; processed seafood; fishmeal for human consumption; processed vegetables and fruits; soya milk; tofu; processed eggs; pre-cooked curry stew, stew and soup mixes; protein foodstuffs for human consumption; alginates for culinary purposes; pectin for culinary purposes; lecithin for culinary purposes; rennet; sausage casings, natural or artificial; almond milk-based beverages; coconut milk-based beverages; peanut milk-based beverages; milk shakes; fatty substances for the manufacture of edible fats; cottage cheese fritters; fish-based foodstuffs; jellies for food; corn dogs; sausages in batter; bulgogi; potato-based dumplings; potato fritters; ratatouille; cassoulet; choucroute garnie; cabbage rolls stuffed with meat; omelets; milk ferments for culinary purposes; pollen prepared as foodstuff; edible ant larvae, prepared; silkworm chrysalis for human consumption; edible insects, not live.*

Class 30: *Meat tenderizers for household purposes; preparations for stiffening whipped cream; tea; coffee; cocoa; ice; sweets, desserts and snacks other than fruit-based, vegetable-based, bean-based or nut-based; cereal based snack food; cereal based snack food [confectionery]; cookies; chocolate; cakes; cereal bars; starch-based candies [ame]; pellet-shaped rice crackers [arare]; rice dumplings dressed with sweet bean jam [ankoro]; cakes of sugar-bounded millet or popped rice [okoshi]; fried dough cookies [karintoh]; soft pin-rolled cakes of pounded rice [gyuhi]; crystal sugar pieces [confectionery]; sweet dumplings [dango]; nerikiri [Japanese confectionery]; mitsumame [confectionery consisting of boiled beans, agar gel cubes and fruits with syrup]; Japanese style steamed cakes [mushi-gashi]; sweet*

pounded rice cakes [mochi-gashi]; bean-jam filled wafers [monaka]; pastry shells for monaka; bars of sweet jellied bean paste [yohkan]; dried sugared cakes of rice flour [rakugan]; ice candies; ice cream; wafers; caramels; candies [sweets]; crackers; ice cream cones; sherbets [sorbets]; cream puffs; sponge cakes; chewing gum; doughnuts; fruit drops [candies]; nougat; pies; biscuits; fruit jellies [confectionery]; frozen yoghurt [confectionery ices]; pancakes; popcorn; marshmallows; rusks; waffles; bread and buns; bean jam buns; cream buns; jam buns; buns; hamburgers [sandwiches]; bread; sandwiches; steamed buns stuffed with minced meat [chuka-manjuh]; hamburger sandwiches; pizzas; hot dog sandwiches; meat pies; seasonings [other than spices]; miso; worcestershire sauce; meat gravies; ketchup; soy sauce [soya sauce]; vinegar; salad dressings; white sauce; mayonnaise; sauces for barbecued meat; cube sugar; fructose for food; crystal sugar [not confectionery]; sugar; maltose; honey; glucose for culinary purposes; powdered starch syrup for culinary purposes; starch syrup for culinary purposes; table salt mixed with sesame seeds; cooking salt; roasted and ground sesame seeds; celery salt; umami seasonings; spices; ice cream mixes; sherbet mixes; unroasted coffee; processed grains; chocolate spread; chinese stuffed dumplings (gyoza, cooked); chinese steamed dumplings (shumai, cooked); sushi; pre-packaged lunches consisting primarily of rice, and also including meat, fish or vegetables; ravioli; yeast powder; yeast; baking powder; instant confectionery mixes; pasta sauce; rice; husked oats; husked barley; gluten for food; flour; cakes; malt extract for food; cake powder; propolis; royal jelly; edible paper.

Class 32: *Beer; soft drinks; fruit juice; vegetable juices [beverages]; carbonated drinks [refreshing beverages]; isotonic beverages; guarana drinks; cola drinks; soda pops; sherbets [beverages]; syrups for beverages; ginger ale; aerated water [soda water]; mineral water [beverages]; ramune [Japanese soda pops]; lemonades; lemon squash; fruit juices; orange juice beverages; grape juice beverages; tomato juice [beverage]; pineapple juice beverages; apple juice beverages; extracts of hops for making beer; whey beverages; non-alcoholic essences for making beverages; non-alcoholic beverages; cocktails, non-alcoholic.*

Class 35: *Advertising and publicity services; promoting the goods and services of others through the administration of sales and promotional incentive schemes involving trading stamps; business management; providing information concerning commercial sales; employment agency services; auctioneering; import-export agency services; arranging newspaper subscriptions for others; copying of documents; filing of documents or magnetic tapes [office functions]; compilation of information into computer databases; publicity material rental; rental of typewriters and copying machines; providing commercial information and advice for consumers in the choice of products and services; providing employment information; rental of vending machines; retail services or wholesale services for woven fabrics and bedding; retail services or wholesale services for clothing; retail services or wholesale services for diapers; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles; retail services or wholesale services for food and beverages; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for confectionery, bread and buns; retail or wholesale services for cereals; retail services or wholesale services for milk; retail services or wholesale services for carbonated drinks [refreshing beverages] and non-alcoholic fruit juice beverages; retail services or wholesale services for tea, coffee and cocoa; retail services or wholesale services for processed food; retail services or wholesale services for automobiles; retail services or wholesale services for two-wheeled motor vehicles; retail services or wholesale services for bicycles; retail services or wholesale services for furniture; retail services or wholesale services for joinery fittings; retail services or wholesale services for tatami mats; retail services or wholesale services for electrical machinery and apparatus; wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; online retail services for downloadable and pre-recorded music and movies; online retail services for downloadable digital music; online retail services for downloadable ring tones; retail services relating to bakery products; providing user rankings for commercial or advertising purposes; providing user reviews for*

commercial or advertising purposes; search engine optimisation for sales promotion; arranging subscriptions to telecommunication services for others; writing of curriculum vitae for others.

Class 41: *Lottery services; arranging of donation of human corpses for medical education; arranging, conducting and organization of seminars; animal training; plant exhibitions; animal exhibitions; providing electronic publications; providing electronic publications of animation film; reference libraries of literature and documentary records; book rental; art exhibition services; gardens for public admission; caves for public admission; publication of books; arranging and planning of movies, shows, plays or musical performances; theatrical release of animation film; providing videos from the internet, not downloadable; providing films, not downloadable, via video-on-demand transmission services; movie theatre presentations or movie film production and distribution; production and theatrical release of animation film; providing digital music from the Internet, not downloadable; providing television programs in the fields of animation and music via a global computer network; providing television programmes, not downloadable, via video-on-demand transmission services; production of music; music composition services; organization of fashion shows for entertainment purposes; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; directing of radio and television programs; production of radio and television programmes; operation of video and audio equipment for the production of radio and television programs; organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; organization, arranging and conducting of horse races; organization, arranging and conducting of bicycle races; organization, arranging and conducting of boat races; providing audio or video studio services; providing sports facilities; providing amusement facilities; providing facilities for movies, shows, plays, music or educational training; booking of seats for shows; rental of cinematographic apparatus; rental of cine-films; rental of musical instruments; rental of television sets;*

rental of radio sets; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; rental of film negatives; rental of reversal film; toy rental; rental of amusement machines and apparatus; rental of game machines and apparatus; rental of paintings and calligraphic works; photography; language interpretation; translation; rental of cameras; animation production services; animation movie theatre presentations or animation movie film production and distribution; production, distribution, and theatrical release of animation film; entertainment in the nature of animated and live action television series; entertainment services; providing animation images and videos via the Internet; providing online information to members in the fields of animation, movies, and music via a global computer network; providing entertainment information via a web site; entertainment services, namely, providing online, non-downloadable videos in the fields of animation and music; providing information in the field of entertainment; game services provided online from a computer network; online distribution of a computer game; video editing services for events; videotape editing; dubbing; layout services, other than for advertising purposes; rental of indoor aquaria; rental of lighting apparatus for theatrical sets or television studios; rental of show scenery; modelling for artists; face painting; photographic reporting; news reporters services.

Class 42: *Meteorological information; architectural services; surveying; geological research; design services; computer programming; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing, inspection or research on agriculture, livestock breeding or fisheries; rental of measuring apparatus; rental of computers; providing computer programs on data networks; rental of laboratory apparatus and instruments; rental of technical drawing instruments; maintenance of computer software; installation of computer software; cloud computing; software as a service [SaaS]; hosting computer web sites; platform as a service [PaaS]; computer technology consultancy; computer system analysis; electronic data storage; providing search engines for the internet; cloud seeding.*

Annex 2

Class 28 goods for which challenge under section 5(4)(a) of the 1994 Act should succeed: *toys for domestic pets; toys; dolls; Go games; Japanese chess [Shogi games]; Japanese playing cards [Utagaruta]; dice; Japanese dice games [Sugoroku]; cups for dice; Chinese checkers [games]; chess games; checkers [checker sets]; dominoes; playing cards; Japanese playing cards [Hanafuda]; mah-jong.*

Class 41 services for which challenge under section 5(4)(a) of the 1994 Act should succeed: *Providing electronic publications; publication of books; arranging and planning of movies, shows, plays or musical performances; providing videos from the internet, not downloadable; providing image data from the internet, not downloadable; movie theatre presentations or movie film production and distribution; providing digital music from the Internet, not downloadable; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; directing of radio and television programs; operation of video and audio equipment for production of radio and television programs; organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races; providing audio or video studio services; providing facilities for movies, shows, plays, music or educational training; booking of seats for shows; rental of cinematographic machines and apparatus; rental of cine-films; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; rental of film negatives; rental of reversal film; toy rental; animated cartoon production service; theatre presentations or production and distribution of animated cartoons movies; entertainment in the nature of animated and live action television series; providing animated cartoons from the internet, not downloadable; game services provided online from a computer network.*