Date	August 10, 2016	Court	Intellectual Property High Court, Fourth Division
Case number	2016 (Gyo-Ke) 10065		
– A case in which the court held that the trademark consisting of the standard characters "山岸一雄大勝軒" falls under Article 4, paragraph (1), item (viii) of the Trademark Act.			

References: Article 4, paragraph (1), item (viii) of the Trademark Act
Number of related rights, etc.: Trademark Application No. 2013-90519, Trial against Examiner's Decision of Refusal No. 2014-24042

Summary of the Judgment

With respect to the JPO decision that dismissed a request for a trial against the examiner's decision of refusal rendered for the trademark consisting of the standard characters "山岸一雄大勝軒" (Yamagishi Kazuo Taishōken" (the "Trademark")) in the trademark application in question, the court dismissed the plaintiff's claim seeking the rescission of the JPO decision by holding that the Trademark falls under Article 4, paragraph (1), item (viii) of the Trademark Act, making findings as follows in summary.

(1) The purpose of Article 4, paragraph (1), item (viii) of the Trademark Act

The items in Article 4, paragraph (1) of the Trademark Act provide for unregistrable trademarks. In light of the fact that item (viii) of said paragraph is provided independently from such provisions as items (x) and (xv), which are intended for preventing confusion regarding the source of goods or services in relation to trademarks that are well known among consumers, it is understood that the purpose of item (viii), which provides that a trademark that contains the portrait of another person, or the name, or famous abbreviated names, etc. of another person cannot be registered without an approval from the person concerned, is to protect the moral interests concerning the portrait, name, etc. of a person (including corporations; the same applies hereinafter) or to protect the person's interest that the person's name, etc. will not be used in a trademark without the person's approval (see 2003 (Gyo-Hi) 265, judgment of the Third Petty Bench of the Supreme Court on June 8, 2004, Minshu Vol. 214, at 373; and 2004 (Gyo-Hi) 343, judgment of the Second Petty Bench of the Supreme Court on July 22, 2005, Minshu Vol. 217, at 595). Therefore, it is considered that registering another person's name as a trademark without an approval from said person would cause damage to the moral interests of the person who has said name.

(2) Whether the Trademark falls under Article 4, paragraph (1), item (viii) of the Trademark Act

A. The Trademark consists of the standard characters "山岸一雄大勝軒," of which the letter part "山岸一雄" in this structure is, as a whole, recognized by people as a name "山岸一雄," with "山岸" representing a surname and "一雄" a given name, in light of the actual situation of the indication of name in Japan.

[...] According to the above, the Trademark is found to be a trademark containing another person's name.

B. [...] As of the time when the trademark application in question was filed and as of the time when the JPO decision in question was rendered, there were people who have the name "山岸一雄" (Kazuo Yamagishi), other than deceased Yamagishi. However, there is no sufficient evidence for the fact that people who have the name "山岸一雄" other than the deceased Yamagishi approved the registration of the Trademark.

C. According to the above, the Trademark falls under Article 4, paragraph (1), item (viii) of the Trademark Act, and thus it cannot be registered.

(3) The plaintiff argued that it is relevant to interpret that the prohibition of the registration of a trademark containing a person's name based on Article 4, paragraph (1), item (viii) of the Trademark Act is limited to the case when another person's publicity rights are infringed (when at least the name of said person's name is found to be well known), or when rights to the exclusive use of the name, other than the publicity rights, are infringed (when it should be determined that the person who has the name would suffer discomfort as a result of objective and typological analysis of the descriptions in the trademark application). In response, the court dismissed said plaintiff's argument by holding as follows. [i] The purpose of Article 4, paragraph (1), item (viii) of the Trademark Act is [...] to protect the moral interests concerning the name of a person or to protect the person's interest that the person's name, etc. will not be used in a trademark without the person's approval. Furthermore, said item specifies "famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof" and prohibits the registration of trademarks that include any of them. However, with respect to "the portrait of another person, or the name," it does not require them to be famous or well-known, nor does it require registration of a trademark containing "the portrait of another person, or the name" to pose a risk of infringing said person's moral rights. Therefore, it is difficult to interpret that "the name of another person" in said item is limited to famous or well-known names, or to interpret that the application of said item requires evidence of specific reasons based on which it should be concluded that the registration of a trademark containing another person's name has infringed or is likely to infringe the moral right of the person concerned. [ii] Considering that it is difficult to interpret that the provision of Article 4,

paragraph (1), item (viii) of the Trademark Act requires another person's name to be "famous" or it requires evidence of specific reasons based on which it should be concluded that there has been an infringement of the moral right of the person concerned or a risk of such infringement, the plaintiff's argument must be said to have exceeded the scope of the interpretation of context. Moreover, it is not appropriate to determine the need for the protection of moral interests based on the ability to attract consumers (well-knownness and famousness) because said item does not require a risk of confusion regarding the source of goods or business. Furthermore, it is not appropriate either to deem it sufficient to determine whether the registration of a trademark containing a name would cause a person who owns the name to suffer mental distress or discomfort merely based on the descriptions in the trademark application, because such conduct would result in ignoring all individual circumstances even though individual persons who have the name have different circumstances regarding moral interests. [iii] It is not appropriate either to deem it sufficient to determine whether a trademark containing another person's name falls under Article 4, paragraph (1), item (viii) of the Trademark Act only after a person who has said name files an opposition to the registration or a request for a trial for trademark invalidation, not only because it contradicts with the fact that said item is provided as the grounds for unregistrable trademarks, but also because such conduct would pose a burden on a person who has a name contained in a trademark, as such person is compelled to constantly check if there is any registered trademark that contains his/her name in order to protect his/her interest that his/her name, etc. will not be used in a trademark without his/her approval since an opposition to registration must be filed within two months from the date of issuance of the trademark bulletin (Article 43-2 of said Act) and a request for a trial for trademark invalidation based on the ground of the violation of item (viii) of said paragraph may not be filed after a lapse of five years from the date of registration of the establishment of the trademark right (Article 47, paragraph (1) of said Act).