

Date	March 26, 2014	Court	Intellectual Property High Court, Second Division
Case number	2013 (Gyo-Ke) 10233		
– A case in which the court found that the registered trademark consisting of a personal name created based on a person who existed in history is not a trademark that is contrary to public policy.			

Reference: Article 4, paragraph (1), item (vii) of the Trademark Act

Number of related rights, etc.: Registration No. 4700298, Invalidation Trial No. 2012-890075

Summary of the Judgment

The defendant holds a registered trademark which consists of standard characters "遠山の金さん" (Tōyama no Kin-san) and which is registered by designating goods such as toys, amusement apparatus, cinematographic machines and apparatus (the "Trademark"). The plaintiffs filed a request for invalidation trial alleging that the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act. However, the JPO rendered a trial decision ("JPO Decision") to dismiss such request. In this case, the plaintiffs instituted an action seeking rescission of the JPO Decision.

The issue is whether or not the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act.

In this judgment, the court found that the Trademark does not fall under Article 4, paragraph (1), item (vii) of the Trademark Act and maintained the JPO Decision which dismissed the plaintiff's request. The reasons are as follows.

1. Facts found

"Tōyama no Kin-san" was not a historical figure per se, although he cannot be considered to be a completely fictitious person in consideration of the facts that the name "Tōyama no Kin-san" has been used as the titles of TV programs featuring a character created based on "Tōyama Kagemoto" who held prominent positions including the Edomachi magistrate in the late Edo era or as the name of the leading character in such TV programs and that "Tōyama no Kin-san" was the leading character created based on a real person.

The name "Tōyama no Kin-san" became associated with the titles of the TV programs produced by the defendant or with the name of the leading character in those programs at least by the time when the JPO decision to register the Trademark was made (June 2003).

2. Applicability of Article 4, paragraph (1), item (vii) of the Trademark Act

Although the defendant is not a company related to a descendent of Tōyama

Kagemoto or an organization related to his birth place, the defendant's act of filing an application for the Trademark cannot be considered to constitute an act of plagiarism.

In light of the fact that "Tōyama no Kin-san" is nothing more than a phrase included in the titles of some TV dramas or the name of the leading character in some of those dramas, the use of the Trademark for the designated goods in question ("Designated Goods") is not likely to cause any social problem that would damage public interest, i.e., the monopolization of the name of a historical figure, "Tōyama Kagemoto." Therefore, it is impossible to presume that the use of the Trademark would harm the public interest. In consideration of the current use of the name "Tōyama no Kin-san," it is impossible to presume that the filing of an application for the Trademark and the use thereof would harm the public interest.

The conclusion that the filing of an application for the Trademark and the use thereof for the Designated Goods would not harm the public interest suggests that the purpose of the defendant's act of filing an application for the Trademark was not to unreasonably restrict public projects. The defendant's act of filing an application for trademark registration of the words "Tōyama no Kin-san" in order to protect the reputation and customer appeal built by said words cannot be criticized because it is in line with the nature of the trademark system.

The Trademark "Tōyama no Kin-san" is merely the name of the leading character created based on Tōyama Kagemoto. Therefore, it is not necessary to examine its influence on the sense of honor of the bereaved family of "Toyama Kagemoto" and the national sentiment.

Regarding the legal and social influence of the defendant's registration of the Trademark, it cannot be said that the use of the Trademark would cause problems for public projects because the use of "Tōyama no Kin-san" as a nickname of a historical figure, Tōyama Kagemoto, for the purpose of introducing the latter as a part of public projects falls outside the scope of the Designated Goods and also cannot be considered to be similar goods or services. Therefore, it should be said that the influence of the Trademark on public projects, etc. is limited.

It is clear that the Trademark does not contain any characters or figures that could be considered to be provocative, obscene, or discriminatory, or give an unpleasant impression to others, that the Trademark is not prohibited by any other law, and that the Trademark does not insult any specific country or people.

As mentioned above, even based on a comprehensive evaluation of the factors mentioned by the plaintiffs in this case, the Trademark cannot be found to have harmed the public interest as of the time of the JPO decision to register the Trademark.

Judgment rendered on March 26, 2014

2013 (Gyo-Ke) 10233 Case of Seeking Rescission of JPO Decision

Date of conclusion of oral argument: January 22, 2014

Judgment

Plaintiff: Sansei R&D

Plaintiff: Dai-Ichi Tsushinsha Inc.

Defendant: TOEI COMPANY, LTD.

Main text

1. All of the plaintiffs' claims shall be dismissed.
2. The plaintiffs shall bear the court costs.

Facts and reasons

No. 1 Judicial decision sought by the plaintiffs

The court shall rescind the JPO decision dated July 5, 2013, concerning the case Invalidation Trial No. 2012-890075.

No. 2 Outline of the case

This is a case where the plaintiffs sought rescission of the JPO decision that dismissed the plaintiffs' request for a trial for invalidation of the defendant's registered trademark (Trademark Registration No. 4700298, the "Trademark"). The issue in this case is the applicability of Article 4, paragraph (1), item (vii) of the Trademark Act.

1. Trademark (Trademark Registration No. 4700298)

The Trademark consists of standard characters "遠山の金さん" (Tōyama no Kin-san). An application for the Trademark was filed on November 12, 2002. The JPO made a decision to register the Trademark on June 20, 2003, and registered it on August 15, 2003 (Exhibit Otsu 28-1), for the following designated goods: Class 9 "Ear plugs, processed glass [not for building], electric arc welding apparatus, electric metal cutting machines, electric welding machines, ozonisers, electrolyzers, egg-candlers, cash registers, coin counting or sorting machines, electric sign boards for displaying target figures, current outputs or the like, photo-copying machines, manual calculators, drawing or drafting instruments and apparatus, time and date stamping machines, time clocks, punched card office machines, voting machines, billing machines, postage stamp checking apparatus, vending machines, gasoline station equipment, coin-operated gates for car parking facilities, lifesaving apparatus and equipment, fire extinguishers, fire

hydrants, fire hose nozzles, sprinkler systems for fire protection, fire alarms, gas alarms, anti-theft warning apparatus, protective helmets, railway signal apparatus, vehicle breakdown warning triangles, luminous or mechanical road signs, divers' apparatus, arcade video game machines, electric door openers, simulators for the steering and control of vehicles, sports training simulators, laboratory apparatus and instruments, photographic machines and apparatus, cinematographic machines and apparatus, optical machines and apparatus, measuring or testing machines and instruments, power distribution or control machines and apparatus, rotary converters, phase modifiers, batteries, electric or magnetic meters and testers, electric wires and cables, electric flat irons, electric hair curlers, electric buzzers, telecommunication machines and apparatus, electronic machines, apparatus and their parts, magnetic cores, resistance wires, electrodes, fire boats, rockets, fire engines, cigarette lighters for automobiles, gloves for protection against accidents, dust masks, gas masks, welding masks, fireproof garments, spectacles, home video game machines, electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays, pachinko slot machines, other slot machines, weight belts, wet suits, buoys, protective helmets for sports, air tanks, swimming board, regulators, metronomes, electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments, slide rules" and Class 28 "Wax for skis, amusement machines and apparatus for use in amusement parks (excluding arcade video game machines), toys for domestic pets, toys, dolls, Go games, Japanese poem cards, Japanese chess, dice, Japanese dice games, Chinese checkers, chess games, checkers, conjuring apparatus, dominoes, playing cards, Japanese playing cards, mah-jongg equipment, amusement apparatus, billiard equipment, sports equipment, fishing tackle, insect collecting implements."

2. Developments in procedures at the JPO

(1) Developments that led to the JPO decision and the grounds for invalidation of the Trademark alleged by the plaintiffs

The plaintiffs alleged that it is not reasonable to permit the defendant, a private company, to register the Trademark, which is easily associated with Toyama Kagemoto (known by the nickname, Kinshiro), who is a famous, historical figure in Japan, as a trademark to be used for business transactions. The plaintiffs further alleged that the use of the Trademark should be considered to be an act of free-riding the well-knownness of Toyama Kagemoto and damaging the public interest or an act of using a trademark that is likely to violate the general social norms. By alleging that the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act, the plaintiffs filed a request for trial for invalidation on September 7, 2012 (Exhibit Otsu 28-1, Invalidation Trial No.

2012-890075). On July 5, 2013, the JPO made a decision that "the request for a trial shall be dismissed." This JPO decision (certified copy) was served on the defendant on July 16, 2013.

(2) JPO decision

A. It is obvious that any trademark containing, in its configuration, any characters or figures that could be considered to be immoral, obscene, discriminatory, or provocative, or give an unpleasant impression to others would fall under a "trademark that is likely to cause damage to public policy" as specified in Article 4, paragraph (1), item (vii) of the Trademark Act. Even if a trademark does not contain such characters or figures in its configuration, the trademark could be interpreted to fall under Article 4, paragraph (1), item (vii) of the Trademark Act, if [a] it is prohibited by law, [b] it violates the public interest or the general social norms, or [c] it insults a specific country or its people or goes against the international good faith. However, in light of the facts that [a] in addition to Article 4, paragraph (1), item (vii), the Trademark Act has other provisions that specifically and comprehensively list unregistrable trademarks from various political perspectives such as a balance with the public interest and a balance with the interests of the existing trademark holder or a person who has been using an identical or similar trademark, [b] since whether any trademark would damage the public order or good morals varies depending on social norms and it is difficult to make an objective determination, if the use of a trademark, even if not the trademark per se, can be considered to go against the public order and morals and fall under said provision, it is obvious that a narrow interpretation of Article 4, paragraph (1), item (vii) of the Trademark Act should be adopted.

B. According to information in dictionaries, etc., historic sites and his grave, books, scripts, films, TV dramas, and returns thereof related to "Tōyama no Kin-san" and "Toyama (Kinshiro) Kagemoto," "Tōyama no Kin-san" is a fictitious person who had been created based on "Toyama (Kinshiro) Kagemoto" after his death from the end of the Meiji era at the latest through Kōdan performances, Kabuki plays, books, etc. From the beginning of the Showa era until 1965, Tōyama no Kin-san became widely known mainly as the name of a leading character in samurai films. After that period, his name became widely known as the title and the name of a leading character in samurai TV dramas, especially those produced by the defendant. The public recognition of his name has remained high up until now since the time of the JPO decision to register the Trademark, or even earlier since the time of the filing of the application for registration of the Trademark.

On the other hand, "Toyama (Kinshiro) Kagemoto" was the name of a real person

who, as a direct retainer of the shogun, served as a magistrate in Kitamachi and subsequently, Minamimachi in Edo from 1830 to 1844. The websites, etc. concerning his grave (Toshima-ku, Tokyo), the sites where his houses used to exist (Sumida-ku and Minato-ku, Tokyo), and the site where the Kitamachi magistrate's office used to exist (Chuo-ku, Tokyo), and the areas that have a strong connection with him such as "Nihon Taisho Mura" (Gifu prefecture) and "Shinshū Tōyamagō" (Nagano prefecture) introduce him by presenting his brief personal history and also making statements as follows: "His name is well-known thanks to the novels and TV dramas titled 'Tōyama no Kin-san.'"; "'Kitamachi magistrate Toyama Kinshiro' known as 'Tōyama no Kin-san' featured in TV dramas and films"; and "'Tōyama no Kin-san,' a famous magistrate featured in TV dramas and films." In this way, in order to make Toyama (Kinshiro) Kagemoto easily understandable by viewers, it is actually common to cite the name of a fictitious person "Tōyama no Kin-san," who was created based on Toyama (Kinshiro) Kagemoto and has become widely known through TV dramas, etc.

Therefore, it is reasonable to consider that, if the Trademark consisting of the characters "遠山の金さん" (Tōyama no Kin-san), any traders and consumers who come across the Trademark would perceive and understand it not as the name of a real person, "Toyama (Kinshiro) Kagemoto," but as the title of samurai TV dramas, especially TV dramas produced by the defendant, or the name of the leading character in those dramas.

C. The Trademark will be recognized by traders and consumers as the title of samurai TV dramas, especially TV dramas produced by the defendant, or the name of the leading character of those dramas.

In light of the defendant's achievement in the production of samurai dramas featuring Tōyama no Kin-san as the leading character, it can be said that the defendant chose and registered the Trademark in order to protect the reputation and customer appeal of the words "遠山の金さん" (Tōyama no Kin-san) used in samurai dramas produced by the defendant.

Thus the Trademark would not be associated with the famous historical figure in Japan, "Toyama (Kinshiro) Kagemoto." The reasons for the defendant's act of filing an application for the Trademark cannot be considered to be socially unacceptable. The registration of the Trademark would not constitute an act that could be regarded to be totally unreasonable and against the order premised by the Trademark Act.

It is clear that, in light of its configuration, the Trademark does not consist of provocative, obscene, or discriminatory characters or figures. Furthermore, the use of the Trademark for the designated goods would not go against the public interest or

general social morals.

Therefore, the Trademark cannot be considered to be a trademark that is likely to damage the public order or good morals and cannot be considered to have been registered in violation of Article 4, paragraph (1), item (vii) of the Trademark Act.

(omitted)

No. 5 Court decision

1. Facts found by the court

According to the evidence and the entire import of the oral argument, the following facts can be found. The historical figure, "Toyama Saemonnojo Kagemoto (Nickname: Kinshiro)," will be hereinafter referred to as "Toyama Kagemoto," while the characters representing him in Kabuki plays, films, etc. will be hereinafter referred to by the names of those characters. If there are multiple names to refer to him, the most appropriate name would be chosen on a case-by-case basis.

(1) Personal history and nicknames of Toyama Kagemoto

Toyama Kagemoto (Nickname: Kinshiro) is a person who held prominent positions including the Edomachi magistrate in the late Edo era (Exhibits Ko 1 [including the branch numbers], 4-3, 4-4, 20-3, 56-4, 57-11, and 61-2), although reliable objective historical data is very limited (Exhibit Ko 61-2).

Regarding the nickname of this person, there are documents stating that he was called "Tōyama no Kin-san" starting from a time during his lifetime (Exhibits Ko 4-4 and 57-11). Kojien (Japanese dictionary) contains similar information, starting from its second edition (issued in May 1969) (Exhibits Ko 1-2-1, 1-2-2 and thereafter). Both Exhibit Ko 4 [including the branch numbers] and Exhibits Ko 57-11 show the statements of the same author, Satoru Fujita, made based solely on a statement made by Ooyagi Jundo, who was a vassal of the shogun at that time, with reference to a book titled "Taisakusoku" that is said to have been authored by Toyama Kagekuni after the death of Kagemoto (while it is not clearly stated in Exhibit 57-11. It can be interpreted that the situation is the same as in the case of Exhibit Ko 4-4). In sum, these interpretations are not supported by objective historical data prepared before Kagemoto's death. Furthermore, the first edition of Kojien published in May 1955 did not contain any information concerning the name "Tōyama no Kin-san" (Exhibits Ko 1-1-1 and 1-1-2). It should be said that it is questionable that said name was widely known in around 1955, except for among people in the Kabuki or writing business. It is difficult to look much further back into the past and tell whether the nickname of

Toyama Kagemoto widely used while he was still alive was "Tōyama no Kin-san." On these grounds, there is no sufficient evidence to prove that the nickname of Toyama Kagemoto while he was still alive was "Tōyama no Kin-san."

It is believable to some extent that Toyama Kagemoto was a famous magistrate who had a good understanding of ordinary people's lives (Exhibits Ko 1 [including the branch numbers], 2, 4-4, 7, 56-5, and 57-11). There is information that he succeeded to the family estate and got married when he was still young (Exhibit Ko 4-4). Regarding the story that he was a dissolute and unruly person (Exhibits Ko 7, 9-1, 56-4, and 56-5), there is a view that such story is about somebody else (see Exhibits Ko 4-4 and 57-11) and a view that such story is unreliable or just a fictitious story (Exhibits Ko 20-3 and 57-7). While it is not so important to examine the reliability of the story that Kagemoto opposed Mizuno Tadataka, who carried out the Tenpō Reform, when Tadataka proposed a relocation of playhouses, and the story that Shogun Tokugawa Ieyoshi praised Kagemoto's performance as a judge (Exhibits Ko 4-4, 6, 7, 56-4, 57-11, and 60-4), there is also a view that the repeatedly used story about his achievement as a magistrate is the one concerning somebody else (Exhibits Ko 56-4 and 57-11). In short, the details about him are not necessarily clear.

There is also a view that Kagemoto had a tattoo from the late Edo era (Exhibits Ko 4-4, 6, and 57-11). However there is no evidence as to whether he really had a tattoo, etc., which would have made him subject to criminal penalty at that time (Exhibits Ko 4-4, 7, 20-3, 56-5, 57-11, 61-2, and 62-2). Regarding the design of his tattoo, there are multiple views stating that it was a tattoo of a decapitated head of a woman or a cherry-blossom shower, etc. Both views have no proof although a former vassal of the shogun, Nakane Kotei, mentioned both of them separately in his books in which he stated that Toyama Kagemoto wore a tattoo (Exhibits Ko 4-4, 7, 61-2, and 64-3).

As mentioned above, there is no sufficient evidence to consider that there is objective historical data to support the repeatedly used story where Toyama Kagemoto, who is known as "Tōyama no Kin-san," disguises himself as a playboy and goes into town and witnesses a crime, and in the end, punishes the bad guys in a court: a white sand-filled yard called "Shirasu", by showing his cherry blossom tattoo to prove that it was he who witnessed the crime.

(2) Kabuki plays, modern plays, etc. featuring Toyama Kagemoto or Toyama Kinshiro

A. Works, etc. mostly produced by any person other than the defendant

(A) Kabuki plays, Kyogen plays

A play titled "Tsugiki Negishinoishizue" and a play titled "Negishinohana Tōyamazakura" were performed in 1877 and 1890, respectively. These plays featured

Toyama Kinshiro. At that time, Toyama Kinshiro was not wearing a tattoo (Exhibit Ko 61-2). In 1893, a Kabuki play titled "Tōyamazakura Tempō Nikki" produced by Takeshiba Kisui was performed in Meijiza Theater. When Actor C played the leading role, Toyama Kinshiro, there was a scene where he showed his tattoo. The design of the tattoo was not a cherry-blossom shower, but a decapitated head of a woman (Exhibits Ko 4-4, 56-3, 57-4, 57-7, 57-11, and 61-2). Subsequently, over the period of the Taisho era (1912-1926), Kabuki plays featuring Kinshiro or Toyama Kinshiro were performed under the titles, "Katakiuchi Gojiingahara," "Tōyamazakura Sekkyo," "Tōyama Seidan," and "Tōyamazakura" (Exhibits Ko 44-1, 44-2, 56-3, and 57-4; While "Tenpō Nikki" is one of the "Tōyamazakura Tempō Nikki," it is considered that no character named Toyama Kinshiro appeared in the story [Exhibit Ko 56-3]). A Kyogen play performed during the same period was "Tōyama no Kin-san to Nezumi Kozō," in which a character named "Toyama Saemonnojo" appeared (Exhibits Ko 19-1 and 19-2). After that, so-called Tōyama Seidan series plays were not performed as Kabuki plays for a while due to the spread of films and TVs. They started to be performed again in 2008 and continued to be performed up to today (Exhibit Ko 57 [including the branch numbers]).

Some of these plays lacked the scene in which Toyama Kinshiro disguises himself as a playboy and goes into town and witnesses a crime and shows his cherry-blossom tattoo, and in the end, punishes the bad guys in a court ("Shirasu") by showing his cherry blossom tattoo to prove that it was he that witnessed the crime. The story was not necessarily established long ago (Exhibits Ko 44-3, 45-2, 45-3, 56-3, 57-9, and 57-10, and Otsu 34).

(B) Films

In 1924, film companies, namely, Shochiku, Teikoku Kinema, and Makinopro showed films featuring Toyama Kinshiro such as "Hana no Haru Tōyamazakura" and "Jōnetsu no Hi" (Exhibits Ko 20-3 to 20-5, and 64-3).

From the Showa era (from 1926), Nikkatsu, Kawai, Teikoku Kinema, Shochiku, Daito, and Shinko Kinema showed films featuring Toyama Kinshiro such as "Tōyamazakura Kin-san Buggyō," "Irezumi Meibuggyō," "Irezumi Buggyō," "Kinshiro Hanseiki," "Wakasama Buggyō," "Tenpō Irezumi Kidan," "Adauchi Nibanhara," "Horimono Hangan," "Senketsu no Kimen," "Ōedo Harugeshō," "Oshare Hatamoto," "Kagoya Hangan," "Hana no Haru Tōyamazakura," "Tegara no Ginji," "Odoru Hyakumanryō," "Ninjō Hyakumanryō," "Yajikita Dōchūki," "Mazō Hyakumanryō," "Senryō Hangan," "Tenpō Edozakura," "Edonishiki Tōyamazakura," "Uzumaku Ukigumojō," and "Kinou Kieta Otoko." The accurate names of the leading characters in

these films are unclear (Exhibits Ko 20-3 to 20-5, and 64-3, and the entire import of the oral argument). Only two of these films, i.e., "Tōyamazakura Kin-san Bugyō" produced by Nikkatsu in 1929 and "Tōyama no Kin-san" produced by Shochiku in 1932 contain "Tōyama no Kin-san," "Toyama," or "Kin-san" in their titles. However, it is suggested that in those days there were already films featuring a story in which a character, seemingly Toyama Kinshiro, disguises himself as an ordinary citizen and fights with bad guys, and, in the end, punishes the bad guys by showing his cherry blossom tattoo in a court ("Shirasu") to prove that it was he that witnessed the crime (Exhibit Ko 20-4).

After World War II as well, in addition to the defendant, Shin Toho, Shochiku, Toho, Daiei, and Daiei Kyoto showed films with a similar story (Exhibit Ko 20-4) such as "Ōedo no Oni," "Yūkyō no Mure," "Edokko Hangan," "Kin-san Torimonochō Nazo no Ningyōshi," "Kaitō Madaragumo," "Tekka Bugyō," "Jinanbō Hangan," "Otoko Ippiki," "Oyakushakozō Edo Senryōnōbori," "Kaitō to Hangan," "Utamatsuri Edokko Kin-san Torimonochō," "Aozora Kenpō Bentenyasha," "Tōyama no Kin-san Torimonohikae Kage ni Ita Otoko," "Denshichi Torimonochō Dokuro Kyōjo," "Shuzakura Hangan," "Benten Kozō," "Ōabare Tōkaidō," "Denshichi Torimonochō Yūrei Hikyaku," and "Haresugata Seizoroi Kenkyō Gonin Otoko" (Exhibit Ko 20-5 and the entire import of the oral argument).

(C) Kōdan (Storytelling)

Some professional storytellers gave Kōdan performances concerning Toyama Kagemoto. A book titled "Bakusei Hibun/Irezumi Bugyō Tōyama Saemon" (Exhibits Ko 47-1 and 47-3) states that "... He is true to his reputation. He passed away at the age of 64 in 1860. There is still a stone monument in the Honmyoji Temple in Maruyama, Hongo. This is the end of this story titled 'Hana no Haru Tōyamazakura.'" Even though the title itself does not contain the expression "Tōyama no Kin-san," this statement suggests that the name "Tōyama no Kin-san" was already in use at that time to refer to a character in a story, "Toyama Kagemoto."

(D) TV programs

As TV programs, Nippon Television broadcast a series consisting of 29 episodes in total in 1957 under the title "Kinshiro Edozakura" and a one-time drama under the title "Ōedo Ninkiotoko Tōyama no Kin-san." Also, KTV and Fuji Television broadcast a series consisting of 12 episodes in total titled "Tōyama no Kin-san Torimonochō" in 1960. In 1961, NHK broadcast a series consisting of four episodes in total under the title "Kōdan Drama Tōyama no Kin-san." In 1967, Nippon Television broadcast a series consisting of 11 episodes in total under the title "Tōyama no Kin-san." From the second series (1975) to the eighth series (1993) of the "Edo o Kiru" series broadcast by TBS

and CAL from 1975 featured Toyama Kinshiro as the leading character and maintained the rating of about 20% on average. The drama "Edo o Kiru" was a work of Shochiku, while the defendant also supported the production. In this drama, unlike those produced by the defendant, Toyama Kinshiro was referred to not as "Tōyama no Kin-san," but as "Tōyama-sama," "Kinshirō-sama," "Waka-sama," etc. Although the narration in this drama sometimes uses the word "Tōyamazakura," this drama is unique in that Toyama Kinshiro does not always show his tattoo in a place where bad guys get together or in the scene of a court ("Shirasu"). In 1998, NHK broadcast samurai dramas titled "Otokomae!" and "Otokomae! 2," in which Toyama Kinshiro appeared, but not as the leading character (Exhibits Ko 23, 53 to 55, 64-3, 65 to 72, and 75-1, and Otsu 35 and 37).

(E) Plays and other stage performances

Stage performances were given under the title "Tōyamazakura Edokko Bugyō" in 1957 (Exhibit Ko 41) and "Irezumi Hangan Tōyama no Kin-san" in November 1969 (Exhibit Ko 43). Moreover, Actor B, who played the leading role in the drama "Tōyama no Kin-san" broadcast by the defendant from 1975 gave stage performances under the title "Tōyama no Kin-san Edo no Ichibanboshi," etc. from 1976 (Exhibits Ko 73, 77-1, 77-2, and 78 to 80). In addition, Actor D and Actor A, who respectively played the role of "Toyama Kinshiro" in the "Edo o Kiru" series produced by Shochiku and "Tōyama no Kin-san" series broadcast by the defendant gave stage performances (Exhibits Ko 74, 75-1, 75-2, and 76-1 to 76-6).

Among these, in "Tōyamazakura Edokko Bugyō," Toyama Kinshiro disguises himself as an ordinary citizen named "Bunkichi" and is called by other people as "Bun-chan." The story of this play is that the Toyama, who is a magistrate, disguises as an ordinary citizen, punishes bad guys in a court ("Shirasu") by showing his cherry blossom tattoo to prove that it was he that witnessed the crime. In the scene of the Shirasu, Toyama Kinshiro called himself as "Tōyamazakura no Kin-san" (Exhibit Ko 41).

(F) Books and comics

Some books and comics featured Toyama Kagemoto and Toyama Kinshiro. In 1933, Hasegawa Shin authored a serial novel titled "Horimono Hangan," which was made into a film (Exhibits Ko 20-3 and 64-3). A book published in September 20, 1954, "Irezumi Bugyō Tōyama no Kin-san" (Exhibits Ko 22-1 and 22-2) used the name "Tōyama no Kin-san" in its title. A picture of a cherry blossom tattoo was printed on the front cover of the book. A comic titled "Toyama Kinshiro" published on November 3, 1961 (Exhibits Ko 42-1 and 42-2) also contains a scene in which Toyama Kinshiro was called

by other ordinary citizens as "Kin-san" and also a scene in which Toyama Kinshiro punishes bad guys by showing his tattoo as evidence that it was he that witnessed the crime.

B. TV programs, etc. concerning Toyama Kinshiro produced by the defendant

The defendant is a company established in 1949 and is engaged in the production and distribution of films and the planning, production, sale, etc. of radio and TV programs (Exhibit Otsu 1).

(A) From 1950 to 1965, the defendant produced and distributed films for movie theaters featuring Toyama Kinshiro as the leading character under such titles as "Irezumi Hangan Ouka Ranbu no Maki," "Irezumi Hangan Rakka Taiketsu no Maki," "Jozoku to Hangan," "Onajimi Hangan," "Tōyama no Kin-san Tobiccho Hangan," "Suronin Bugyō," "Chizakura Hangan," "Seizoroi Kenka Wakashū," "Kenka Bugyō," "Arajishi Hangan," "Nagadosu Bugyō," "Kaizoku Bugyō," "Hayabusa Bugyō," "Hinotama Bugyō," "Tatsumaki Bugyō," "Edokko Hangan to Furisode Kozō," "Gozonji Irezumi Hangan," "Saikoro Bugyō," "Sakura Hangan," "Hashizō no Yakuza Hangan," and "Irezumi Hangan." From 1970 to 2007, the defendant also produced samurai dramas for TV broadcast consisting of seven series containing more than 750 episodes in total under such titles as "Tōyama no Kin-san Torimonochō," "Gozonji Tōyama no Kin-san," "Tōyama no Kin-san," and "Meibugyō Tōyama no Kin-san" (Exhibits Ko 64-3, and Otsu 9 to 27 and 36, and the entire import of the oral argument). Among these dramas, a total of 218 episodes of "Meibugyō Tōyama no Kin-san," "Tōyama no Kin-san vs. Onna Nezumi," and "Kin-san vs. Onna Nezumi" starring Actor A were broadcast from April 21, 1988 to October 31, 1998. The highest rating was 21.9%, while the average rating for all of the episodes was 14.0% (Exhibit Otsu 27). Most of these films and TV dramas seem to tell the typical story that Toyama Kinshiro, known as Tōyama no Kin-san, disguises himself as a playboy to conceal his true identity of magistrate, witnesses a crime in the town, shows his cherry blossom tattoo to the bad guys, and subsequently punishes the bad guys pretending to be innocent by showing his cherry blossom tattoo as evidence in a court ("Shirasu"). Such a typical story has eventually become established through the films and many TV series produced by the defendant since 1955 based on period novels authored by Jinde Tatsuro (Exhibits Ko 7, 61-2, and 64-3, and Otsu 10 to 26, and 31-1 to 31-5).

(B) Subsequently, from February 1, 2005 to October 18, 2005, CS broadcasting "Toei Channel" rebroadcast "Irezumi Hangan" and "Saikoro Bugyō," "Sakura Hangan" starring Actor E, "Irezumi Hangan" starring Actor F, "Hashizō no Yakuza Hangan" starring Actor G, "Tōyama no Kin-san Torimonochō" starring Actor H, "Gozonji

Tōyama no Kin-san" starring Actor I, "Gozonji Kin-san Torimonochō" starring Actor J, "Tōyama no Kin-san Torimonochō" starring Actor B, "Tōyama no Kin-san" starring Actor K, and "Meibugyō Tōyama no Kin-san" starring Actor A (Exhibit Otsu 27). In addition, from 1975 to 2013, many terrestrial stations and CS stations rebroadcast films and TV dramas produced by the defendant (Exhibit Otsu 27).

(3) Historic sites, cultural assets, etc. concerning Toyama Kagemoto

A. "Image of Toyama Kinshiro Kagemoto," which is a picture of Toyama Kagemoto, is stored as a cultural asset designated by Izumi-shi, Chiba Prefecture (Exhibit Ko 10).

B. The grave of Toyama Kagemoto was preserved as a historic site designated by Tokyo in Honmyoji Temple located in Sugamo, Toshima-ku, Tokyo (Exhibit Ko 11). This grave of Toyama Kagemoto has a monument constructed in 1995, which bears an inscription that "There are many legends about him known as Tōyama no Kin-san, an excellent magistrate in the Edo era who had a good understanding of ordinary people's lives" (Exhibit Ko 11).

C. There is a monument constructed in 1968 on the site in Yaesu, Chuo-ku, Tokyo, where the Kitamachi bugyōsho used to exist, which bears an inscription that "Toyama Saemonnojo Kagemoto (Toyama Kinshiro), who is famous as 'Irezumi Bugyō' served as the Kitamachi bugyō for three years starting from March 1840" (Exhibits Ko 12 and 85-1).

D. There is a monument constructed in 1992 in Iwakuma area, Misaki-cho, Isumi-shi, Chiba, which allegedly was a fief of Toyama Kagemoto. The monument bears an inscription that "Kagemoto is a very talented man and known as a great magistrate, serving as Kobushin bugyō, Sakuji bugyō, Kanjō bugyō, Kitamachi bugyō, Ōmetsuke, and Minamimachi bugyō. In particular, his achievements in the Tempo Reform are well-known" (Exhibit Ko 13).

E. There is a stone monument and information board about Toyama Kagemoto on the site around Kikukawa, Sumida-ku, Tokyo, where a house where Toyama Kinshiro lived used to exist (Exhibits Ko 14, 15, and 85-2). The information board constructed in 2007 (Exhibit 14) displays a statement that "... Toyama Saemonnojo Kagemoto. His nickname was Kinshiro. A well-known Edomachi magistrate who often appears in samurai dramas." This stone monument is used as a design of a stamp for the Kikukawa station of the Toei Shinjuku Line. The design also contains the characters "遠山金四郎" (Toyama Kinshiro) and the pictures of a paper lantern bearing a mark "御用" (Under Arrest) and a *jutte* (a short metal truncheon), which imply his status as bugyō (Exhibit Ko 16).

F. Various local public agencies, tourist agencies, etc. introduce tourist spots related to

Toyama Kinshiro through the Internet in order to promote regional developments. For example, Toshima-ku, etc. of Tokyo introduces the grave of Toyama Kagemoto under the name "Toyama Kinshiro" (Exhibit Ko 27 to 30). In particular, "Tokyo-to Somei Reien MAP" (Tokyo metropolis Somei cemetery map; Second edition published in April 2010) introduces Honmyoji Temple by saying that "Well-known Sakura Hubuki (cherry blossom tattoo) no Kin-san/Toyama Kinshiro Kagemoto/Hatamoto (direct retainer of the shogun) in the Edo era. Served as an Edomachi bugyō. Known as 'Tōyama no Kin-san' in novels and dramas" (Exhibit Ko 28).

G. The website titled "Sugamo sansaku shūhen no meisho tanbō" (Walking and visiting famous sites around Sugamo) of "Sugamo jizou dori shoutengai shinko kumiai" (Sugamojizou-dori Shopping Center Promotion Association) presents a "Sugamo shuhen map" (Map around Sugamo), which contains an indication "Tōyama no Kin-san no haka" (the grave of Tōyama no Kin-san) (Exhibit Ko 30).

H. Sumida-ku of Tokyo and other related associations introduce the site where a house used by Toyama Kagemoto used to exist by using the name "Toyama Kinshiro" (Exhibits Ko 31 to 33). Under the heading for "Honjo, Ryogoku, Kinshicho Course" of "Sumida Sansaku Tour" (Sumida walking tour) on the official website "Sumida," the following statement was presented as information about "Hasegawa Heizo jūkyoato, Toyama Kinshiro jūkyoato (aruku jikan no meyarū: 10 pun ijo)" (the sites where the houses of Hasegawa Heizo and Toyama Kinshiro used to exist (Walking time: 10 min. or more)): "Forty years later, in the same place, 'Kitamachi bugyō Toyama Kinshiro' known by the nickname 'Tōyama no Kin-san,' a well-known figure in dramas and plays, built a house... While the cherry blossom tattoo on his back is said to be a fiction, Toyama Kinshiro was also said to be a great officer" (Exhibit Ko 31). Also, a website titled "Edo Tokyo shoutengai, kaimono hitori annai funemeguri machiaruki" (Edo Tokyo shopping street information exploring the city by boat) presents information about the site where the house of Hasegawa Heizo used to exist, stating that "The site was later used for a suburban residence of Toyama Kinshiro, known as Tōyama no Kin-san " (Exhibit Ko 33).

I. Minato-ku of Tokyo introduces the site where house used by Toyama Kinshiro used to exist (Second Toyo Kaiji Building) under the title "'Tōyama no Kin-san' no Yashiki o motomete" (Looking for a house used by Tōyama no Kin-san) under the heading "Minato-ku Edo kochizu meguri" (Minato-ku Edo old map exploration) on the website of "MINATO arakaruto" (Minato a la carte) of "Minato-ku sangyo chiiki shinkou shienbu sangyo shinkouka" (Industrial Promotion Division, Industrial and Regional Promotion Support Department, Minato-ku (tentative translation)). This webpage

presents a statement that "A house used by Kinshiro Kagemoto, known as Toyama Saemonnojo, used to exist here. 'Tōyama no Kin-san,' a great magistrate often featured in TV dramas and films is famous for the 'cherry blossom tattoo' (Tōyamazakura) on his back. Actually, it is said that Kinshiro used to be a dissolute young man and got a tattoo" (Exhibit Ko 34).

J. The website titled "Chuo-ku no machizukuri" (Urban development of Chuo-ku) of Tokyo Chuo Net introduces "Meibugyō Tōyama no Kin-san (Kitamachi bugyōsho ato)" (Great magistrate Tōyama no Kin-san (Site where the Kitamachi magistrate's office used to exist)) under the heading "Yaesu kaiwai" (Around Yaesu). This webpage contains a statement that "In the Kitamachi magistrate's office, Toyama Saemonnojo Kagemoto, known as Tōyama no Kin-san, a well-known figure famous for his cherry blossom tattoo, used to work... In reality, there is no evidence that he had a tattoo. His cherry blossom tattoo was probably a fiction made up by TV dramas and films" (Exhibit Ko 35).

K. The website of Akechi-cho, Ena-shi, Gifu (Japan Taisho Village) introduces "the graves of the Toyama family" and "Tōyamazakura" (Cherry blossom tattoo of Toyama) by stating that "it is said that a great magistrate, Tōyama no Kin-san, was also enshrined here" under the heading "Hatamoto ryōshu/Toyama-ke ruidai no bosho" (Direct retainer of the shogun/local lord, Graves of Toyama family) and stating that "Local people referred to this as 'Tōyamazakura,' which reminds people of the 'Tōyamazakura' of Toyama Kinshiro (Toyama Saemonnojo Kagemoto), known as 'Tōyama no Kin-san,' a famous figure in samurai dramas and plays" on webpages titled "Tōyamazakura" (Exhibits Ko 36 and 37).

L. A website titled "Shinshū Tōyamagō" of the Toyamagō Kankō Kyōkai (Toyamagō Tourist Association (tentative translation)) provides information about an event under the heading "Tōyama no Kin-san to tōyama/tōyama tsunagaride sakura fubuki ni ayakarou! Tōyama Kinshirō Project" (Let's enjoy a cherry blossom shower with Tōyama no Kin-san through a Toyama/Toyama connection! Toyama Kinshiro Project), stating that "Toyama Saemonnojo Kagemoto became a hero in samurai dramas as a great magistrate with a tattoo through his achievement in the Tempo Reform, in which he saved playhouses that were scheduled to be destroyed. (omitted) In consideration of the fact that the Family of Shinshu Toyama is originally from Mino, we can understand the connection between Shinshu Toyama and Kin-san" (Exhibit Ko 38).

(4) Contribution to the establishment of the nickname and image of "Tōyama no Kin-san"

A. Establishment of the nickname "Tōyama no Kin-san" over time

The first edition of Kojien published in 1955 did not contain any information about the nickname "Tōyama no Kin-san" (Exhibits Ko 1-1-1 and 1-1-2). Thus, the nickname "Tōyama no Kin-san" can be presumed to have spread among Japanese people after that time.

The webpage about "Toyama Kagemoto" on Wikipedia, a free online encyclopedia, states that "Known as a model for TV dramas (samurai dramas), 'Tōyama no Kin-san'" (Exhibit Ko 7). This statement and other statements on the webpages introducing historic sites and cultural assets related to him (Exhibits Ko 28, 34, and 35) are considered to have been posted after the spread of the Internet. These can be presumed to have been posted relatively recently. As mentioned in (3) above, monuments and information boards about him were constructed relatively recently as well. Therefore, the online information, monuments, etc. do not necessarily prove that "Toyama Kagemoto" has long been called by the nickname of "Tōyama no Kin-san."

The webpage about "Tōyama no Kin-san" of Wikipedia, a free online encyclopedia, (Exhibit Ko 55) list, under the heading "Toei samurai films starring Actor E," "Irezumi Hangan (Toei) ," "Chizakura Hangan (Toei)," "Hayabusa Bugyō (Toei)," "Hinotama Bugyō (Toei)," "Tatsumaki Bugyō (Toei)," and "Sakura Hangan (Toei)." As TV dramas, the following programs are listed: "Tōyama no Kin-san Torimonochō (Fuji Television)," "Tōyama no Kin-san (Nippon Television)," "Tōyama no Kin-san Torimonochō (NET) (MBS in Kansai)," "Gozonji Tōyama no Kin-san (NET) (MBS in Kansai)," "Gozonji Kin-san Torimonochō (NET) (MBS in Kansai)," "Tōyama no Kin-san (NET renamed TV Asahi) (ABC in Kansai from this program)," "Meibugyō Tōyama no Kin-san (TV Asahi)," and "Tōyama no Kin-san (TV Asahi/2007 version)". In this way, this webpage lists many works other than those produced by the defendant.

The past Kabuki plays and modern plays, etc. concerning Toyama Kinshiro are as mentioned in (2) above. Since 1970, there have been samurai TV series produced by the defendant in particular that were continuously broadcast for a long period of time. Since those TV series contain a large number of episodes and were distributed through TV, which is a means to provide mass entertainment to the public, it cannot be denied that those TV series have had a greater influence on Japanese people than Kabuki plays and modern plays, etc.

B. Contribution of the defendant

It cannot be said that "Toyama Kagemoto" and "Tōyama no Kin-san" came to be associated with each other solely because of the TV dramas and films produced by the defendant. However, it can be said, at least, that the influence of the TV dramas and films produced by the defendant has been great especially since 1970. Those dramas

and films have greatly contributed to increasing the public recognition of the nickname "Tōyama no Kin-san" and establishing the image associated with the name in recent years. Under these circumstances, the JPO decision to register the Trademark was made.

(5) Relationships between Plaintiff Sansei R&D and the defendant, etc.

A. The defendant filed a request for a trial for invalidation of the trademark "名奉行金さん" (Meibugyō Kin-san (Great magistrate Kin-san)) registered by Plaintiff Sansei R&D (standard characters, designated goods: Class 28 "Amusement apparatus"). On April 5, 2010, the defendant received a JPO decision to invalidate the trademark on the grounds of similarity (Exhibit Otsu 28-2). Dissatisfied with this JPO decision, Plaintiff Sansei R&D filed a lawsuit to rescind said JPO decision. On February 28, 2011, the Intellectual Property High Court handed down a judgment to dismiss the plaintiff's claim (Exhibit Ko 3). Consequently, the JPO decision was finalized on February 9, 2012 (Exhibit Otsu 28-2).

B. The defendant filed a lawsuit (Exhibit Ko 49-1) with the Tokyo District Court to demand payment of damages, etc. against the plaintiffs on the grounds of infringement of the defendant's copyright and trademark right caused by the plaintiffs' act of manufacturing and selling Pachinko slot machines named "CRA の名奉行金さん XX" (CRA no meibugyō Kin-san XX (Great magistrate Kin-san of CRA XX)) (Exhibit Otsu 38). This lawsuit is still pending.

C. Incidentally, DAIICHI SHOKAI Co., Ltd. has been licensed by the defendant and uses the Trademark for pachinko slot machines (Exhibit Otsu 32-1, 32-2, and 33).

2. Grounds for Rescission 1

(1) A. Identicalness between "Toyama Kagemoto" and "Tōyama no Kin-san"

According to the facts found above, it can be recognized that Toyama Kagemoto, who really existed in the late Edo era, held prominent positions such as Edomachi bugyō and was respected as a great magistrate. However, the details about him such as the nickname and job performance has been unclear. The real story about him would not necessarily match the legendary story currently associated with "Tōyama no Kin-san," more specifically, the story that Toyama Kinshiro, who is a great magistrate with the cherry blossom tattoo on his shoulder, disguises himself as a playboy called "Kin-san" in the town of Edo and shows his tattoo when he witnesses a crime, and, in the end, punishes the bad guys in a trial held in "Shirasu" by showing his tattoo as conclusive evidence that it was he that witnessed the crime. As mentioned above, some of the stories of Kabuki plays, etc. featuring Toyama Kinshiro were initially different from the currently well-known story about "Tōyama no Kin-san." This suggests that the aforementioned story, which was just recently established, was not the accurate

description of the work performance of the real person, Toyama Kagemoto, but was closer to an entertaining creation containing fictitious information.

Therefore, the aforementioned JPO decision was correct in determining that "Tōyama no Kin-san" was not a historical figure per se, although he cannot be considered to be a completely fictitious person in consideration of the facts that the name "Tōyama no Kin-san" has been used as the title of TV programs featuring a character created based on "Toyama Kagemoto" and that "Tōyama no Kin-san" was the leading character created based on a real person.

As mentioned above, some historic sites related to Toyama Kagemoto bear an inscription introducing Toyama Kagemoto as "Tōyama no Kin-san" on the premise that the two are the same person. However, in view of the facts that some historic sites introduce Toyama Kagemoto without referring to "Tōyama no Kin-san" and that all statements about "Tōyama no Kin-san" were written relatively recently and can be considered to have been written not based on the actual historical facts about "Toyama Kagemoto" but merely for the purpose of making the statements easily understandable and appealing, these statements do not affect the aforementioned JPO's determination.

B. What the name "Tōyama no Kin-san" refers to

It can be found that, from the beginning of the Showa era at the latest, in some Kabuki plays, modern plays, etc. the name "Tōyama no Kin-san" was used to refer to the character "Toyama Kagemoto." This is attributable to the fact that "Tōyama no Kin-san" has become well known as the name of the leading character in films, etc., and thus, "Tōyama no Kin-san" cannot be automatically considered to be referring to a historical figure.

Furthermore, since the commencement of the TV programs, the name "Tōyama no Kin-san" can be considered to have been used as the titles of or the name of the leading character in the relevant samurai TV dramas. Since TV has great influence, it can be found that any traders and consumers who come across the Trademark consisting of the characters "遠山の金さん" (Tōyama no Kin-san) have come to recognize it as the title of a samurai drama or the name of the leading character in a drama. In consideration of the facts that many of the TV programs produced by the defendant contain the name "Tōyama no Kin-san" itself in their titles and that the presence of the defendant's dramas was overwhelming in terms of the length of each series and the number of episodes, even if it is also taken into consideration that rival companies have also produced TV programs featuring "Tōyama no Kin-san" or "Toyama Kinshiro," the name "Tōyama no Kin-san" became associated with the titles of the TV programs produced by the defendant or with the name of the leading character in those programs at least by the

time when the JPO decision to register the Trademark was made (June 2003).

C. Summary

Therefore, the determination of the JPO decision contains no error.

(2) Determination concerning the allegation of the plaintiffs

A. The plaintiffs alleged at great length that there is an error in the determination of the JPO decision in this respect. However, the premise of the plaintiffs' allegation is mistaken because the plaintiffs fail to distinguish "Toyama Kagemoto," who is a historical figure, from "Tōyama no Kin-san," which is the title of samurai dramas, etc. produced based on "Toyama Kagemoto" or the leading character in those dramas, and consider the two as being the same person. As alleged by the plaintiffs, the defendant is not the only one who used the name "Tōyama no Kin-san" and established the relevant image. However, as mentioned above, the defendant frequently used the name "Tōyama no Kin-san" and contributed to establishing the image of "Tōyama no Kin-san," which can be associated with the repeatedly used morality tale. The plaintiffs' allegation is unacceptable because it should be said that the plaintiffs underestimated the effort and achievements of the defendant.

B. The plaintiffs alleged that, in the case of a novel featuring a character created based on a real person, the character in such novel should not be considered as a creation of the author that is completely different from the real person who is used as the model for the novel. However, even in the case of such type of novel, the degree of the identicalness of the character in the novel and the real person varies depending on to what extent the author relied on the historical facts to write the novel. Therefore, the degree of identicalness would differ from one novel to another. In this court case, in consideration of the facts mentioned above, there is not sufficient objective historical data about the actual nickname and job performance of Toyama Kagemoto, who really existed in the past. Thus, it is difficult to depict him as the leading character based on historical facts. Consequently, it has to be said that there is a large gap between "Tōyama no Kin-san" and the real person "Toyama Kagemoto." Thus, the image of "Tōyama no Kin-san" is not identical with the image of the real person "Toyama Kagemoto." It has to be said that the image of "Tōyama no Kin-san" was later established based partially on the information not supported by historical facts.

3. Grounds for Rescission 2

(1) In order to determine the applicability of Article 4, paragraph (1), item (vii) of the Trademark Act to the Trademark, this section mainly examines the deciding factors alleged by the plaintiffs.

A. Whether the defendant's act of filing an application for the Trademark constitutes an

act of plagiarism or not

In view of the facts mentioned above, although the defendant cannot be considered to be a person who used the name "Tōyama no Kin-san" for the first time as the title of a drama, etc., or the name of the leading character, the defendant can be considered to have produced many films featuring "Tōyama no Kin-san" as the leading character since 1950 and also produced many TV programs under the title "Tōyama no Kin-san" over a long period of time since 1970. Therefore, it can be said that the defendant has greatly contributed to raising the public awareness of the name "Tōyama no Kin-san" and establishing its image.

Thus, although the defendant is not a company related to a descendent of Toyama Kagemoto or an organization related to his birth place, the defendant's act of filing an application for the Trademark cannot be considered to constitute an act of plagiarism.

B. Use of the name "Tōyama no Kin-san" and the influence of the Trademark

As found above, the name "Tōyama no Kin-san" itself was used in the titles of TV dramas produced by companies other than the defendant as well and in some of the lines in those dramas and also in some of the lines, etc. in Kabuki plays and Kōdan performances, etc. Local agencies also use the name "Tōyama no Kin-san" when they introduce Toyama Kagemoto in connection with the historic sites and cultural assets related to him.

However, in light of the fact that "Tōyama no Kin-san" is nothing more than a phrase included in the titles of some TV dramas or the name of the leading character in some of those dramas, the use of the Trademark for the designated goods is not likely to cause any social problem that would damage public interest, i.e., the monopolization of the name of a historical figure, "Toyama Kagemoto." Therefore, it is impossible to presume that the use of the Trademark would harm the public interest.

Regarding the relationships with the rival companies, the production and broadcasting of any new samurai dramas fall outside the scope of the designated goods (see Class 38 and Class 41 of the Attached Table to the Ordinance for Enforcement of the Trademark Act) and would not be regarded as similar goods or services. Therefore, the Trademark would have almost no direct influence. The restrictions on the sale, etc. of goods that fall under the scope of the designated goods in relation to production of works can be considered to be merely affecting the economic activities of rival companies. Thus, it should be said that the Trademark will exert influence merely on private companies' activities. Furthermore, regarding the influence on Kabuki plays, etc., it is impossible to interpret that performances of Toyama Seidanmono (Toyama series) should be prohibited simply because of its relation with the designated goods (see Class

41 of said Attached Table).

In relation to the plaintiffs, although there was a dispute as to whether or not the Trademark was used for Pachinko slot machines, this dispute obviously falls under the private sphere and did not harm the public interest.

As described above, in consideration of the current use of the name "Tōyama no Kin-san," it is impossible to presume that the filing of an application for the Trademark and the use thereof would harm the public interest.

C. Background, purpose, and reasons for the filing of an application for the Trademark

As mentioned in B above, the conclusion that the filing of an application for the Trademark and the use thereof for the designated goods would not harm the public interest suggests that the purpose of the defendant's act of filing an application for the Trademark was not to unreasonably restrict public projects.

As found above, the defendant has been producing and distributing films and TV programs of "Tōyama no Kin-san" series. The defendant's act of filing an application for trademark registration of the words "Tōyama no Kin-san" in order to protect the reputation and customer appeal built by said words cannot be criticized because it is in line with the nature of the trademark system.

Since rival companies of the defendant also produced samurai dramas under the title "Tōyama no Kin-san," they can be considered to be in the same position as the plaintiffs and could have filed an application for registration of a trademark consisting of the characters "Tōyama no Kin-san." In this respect, it is impossible to find that it was extremely unreasonable for the defendant to file an application for registration of the Trademark in light of the first-to-file principle and the principle of fair competition.

D. Sense of honor of the bereaved family and the national sentiment

As repeatedly mentioned above, the Trademark "Tōyama no Kin-san" is merely the name of the leading character created based on Toyama Kagemoto. Therefore, it is not necessary to examine its influence on the sense of honor of the bereaved family and the national sentiment (Even if it is necessary to consider the issue of the sense of honor of the bereaved family of Toyama Kagemoto, it has not been examined in this case whether any bereaved family member of Toyama Kagemoto exists or not. Furthermore, no evidence concerning the sense of honor of the bereaved family has been submitted to this case. Moreover, even if the image of "Tōyama no Kin-san" among Japanese people is a hero always supporting ordinary people, it does not necessarily mean that Japanese people are opposed to the defendant's act of filing an application for registration of the Trademark. No evidence concerning the national sentiment concerning the defendant's ownership of the Trademark has been submitted to this case.).

E. Scope of the right of prohibition of the Trademark

Regarding the legal and social influence of the defendant's registration of the Trademark, it cannot be said that the use of the Trademark would cause problems for public projects because the use of "Tōyama no Kin-san" as a nickname of a historical figure, Toyama Kagemoto, for the purpose of introducing the latter as a part of public projects falls outside the scope of the designated goods and also cannot be considered to be similar goods or services. In consideration of the simple configuration of the Trademark consisting solely of standard characters and the types of the designated goods, it cannot be denied that some problem might arise if a public agency or organization related to Toyama Kagemoto produce souvenirs such as toys and dolls and other goods for tourists bearing a mark "Tōyama no Kin-san." However, business activities conducted in connection with public projects are not necessarily public in nature. As mentioned above, the use of the Trademark to introduce Toyama Kagemoto in historic sites is excluded from the designated goods. Moreover, the use of a historical figure "Toyama Kagemoto" for any souvenirs or other goods for tourists, which are included in the designated goods, is not prohibited. Therefore, it can be said that the influence of the Trademark on public projects, etc. is limited.

F. Other factors

It is clear that the Trademark does not contain any characters or figures that could be considered to be provocative, obscene, or discriminatory, or give an unpleasant impression to others, that the Trademark is not prohibited by any other law, and that the Trademark does not insult any specific country or people.

(2) Summary

As mentioned above, without having to interpret Article 4, paragraph (1), item (vii) of the Trademark Act in a limited manner, even based on a comprehensive evaluation of the factors mentioned by the plaintiffs in this case, the Trademark cannot be found to have harmed the public interest as of the time of the JPO decision to register the Trademark.

No. 6 Conclusion

On these grounds, the plaintiffs' claims can be considered to be groundless.

Therefore, this court dismisses all of the claims of the plaintiffs and renders a judgment in the form of the main text.

Intellectual Property High Court, Second Division

Presiding judge: SHIMIZU Misao

Judge: IKESHITA Akira

Judge: SHINTANI Takaaki