Judgment rendered on July 22, 2005
2004 (Gyo-Hi) 343
Indication of parties Omitted

Main text

The prior instance judgment shall be reversed.
This case shall be remanded to the Intellectual Property High Court.

Reasons

Concerning Reason 2-4 of the reasons for Petition for Acceptance of Final Appeal, as presented by the attorneys for the appeal; namely, NAKAMURA Minoru, et al.

1. In this case, the appellant filed a suit seeking revocation of the trial decision which was rendered by the Japan Patent Office (JPO) to the effect that the trademark registration, which is described later and for which the appellee is the holder of trademark right, is not in violation of the provision of Article 4, paragraph (1), item (viii) of the Trademark Act (hereinafter simply referred to as "Item (viii)".

2. The outline of the facts which were confirmed in the original examination is as follows.

(1) The appellee is the holder of trademark right for the registered trademark, Trademark Registration No. 4153893 (application for trademark registration filed on April 26, 1996 and the trademark right registered on June 5, 1998; hereinafter this trademark is referred to as "Trademark", and the trademark registration as "Trademark Registration"), which consists of the letters, "国際自由学園"(Koku-sai-ji-yu-gaku-en (in kanji)), written horizontally, with the designated services of "Educational and instruction services relating to arts, crafts, sports, or general knowledge; Provision of information on teaching materials for research, and mediation services thereof; Arranging, conducting and organization of seminars" in Class 41 of Table 1 of the Enforcement Order of the Trademark Act (prior to the revision by Cabinet Order No. 265 of 2001).

The appellee is an incorporated education institution having its principal office in Kobe City and runs a business professional training college under the name of "Kokusai Jiyu Gakuen" (hereinafter referred to as "School"). The School was designated by the Minister of Education as a technical training school in 1986 and has its main campus in Ashiya City, Hyogo Prefecture. Among other activities, the School has acted as a school that offers classes on

technical training through partnerships with upper secondary correspondence schools, for a school located in Tokyo during the period from the School's opening until 1992, and for a school located in Hokkaido after 1992. Through these partnerships, the School has conducted classes on computers, management, trade relations, and other subjects for students who are enrolled in distance education programs for upper secondary school students.

(2) The appellant was founded in 1921 at A, Tokyo-fu (present B, Toshima Ward, Tokyo) as a lower secondary education institution for girls, and later opened an elementary school. Then, the appellant moved to the current location in Higashikurume City, Tokyo and, after going through developments such as opening of the Boys Department, kindergarten, and college, became an all-through school and remains as such to this day. Since 1921, the appellant has used its abbreviated name, "自由学園"(Jiyu Gakuen (in kanji)) (hereinafter referred to as "Appellant's Abbreviation"), for its name, "Gakkohojin Jiyu Gakuen", in education (educational and instruction services relating to general knowledge) and related services.

Since around its foundation until the time of the filing of an application for registration of the Trademark, the appellant was repeatedly featured in various books, newspapers, magazines, and on television, and in other forms of media. The Appellant's Abbreviation is used in these articles and the like as a name that refers to the appellant. However, many of these articles and the like concern the historical background of the appellant having been established by Motoko HANI, a leading, female thinker who is representative of Japan during its Taisho Era, and her husband, Yoshikazu, who founded the appellant to realize ideal education that is based on the spirit of Christianity and the educational ideas of freedom, as well as the appellant's unique philosophies on education and educational content. Furthermore, these articles and the like mostly target educators and other intellectuals and are not intended for students, pupils, children desiring admission, and their parents (hereinafter referred to as "Students, etc.").

It can be said that because of the historical background to the appellant's foundation and the uniqueness of education, the Appellant's Abbreviation is well-known among educators and other intellectuals. However, in regards to Students, etc., the Appellant's Abbreviation merely had a certain level of name recognition in Tokyo and its surrounding areas at the time of the filing of the application for registration of the Trademark, and it cannot be acknowledged

that the Appellant's Abbreviation had become well-known in a wide area.

(3) On June 2, 2003, the appellant demanded a trial for invalidation of the Trademark by claiming that since the Trademark includes the Appellant's Abbreviation, which is a famous abbreviation of the appellant's name, the Trademark falls under a trademark prescribed in Item (viii) and therefore cannot be granted trademark registration.

As a result of examination of the above demand for trial as Invalidation Trial No. 2003-35230, the JPO rendered a trial decision on March 15, 2004, rejecting the demand for trial.

3. The original examination determined as follows, denying the appellant's demand for revocation of the aforementioned trial decision.

In consideration of the factors; namely, that it cannot be acknowledged that the Appellant's Abbreviation, "自由学園"(Jiyu Gakuen (in kanji)), has become well-known among the Students, etc., who are consumers of the designated services of the Trademark, and that the Trademark, "国際自由学園"(Koku-sai-ji-yu-gaku-en (in kanji)), is read as, and has a meaning as, a uniform and indivisible mark that indicates the name of a school, it cannot be acknowledged that when the Students, etc. come into contact with the Trademark, their attention would be drawn to the "自由学園"(Jiyu Gakuen (in kanji)) part of the Trademark, and that they would recognize the Trademark as a trademark that includes the Appellant's Abbreviation, which has a certain level of name recognition.

Accordingly, the Trademark Registration is not in violation of the provision of Item (viii).

4. However, the above decision by the original examination cannot be accepted, for the following reasons.

Given that it is evident that the Trademark, "国際自由学園"(Koku-sai-ji-yu-gaku-en (in kanji)), is a trademark that includes the Appellant's Abbreviation, "自由学園"(Jiyu Gakuen (in kanji)), and that the appellant did not give its consent to the appellee regarding the use of the abbreviation, if it can be said that the Appellant's Abbreviation is a "famous abbreviation" of the appellant's name, the Trademark falls under a trademark prescribed in Item (viii), and cannot therefore be granted trademark registration.

Article 4, paragraph (1) of the Trademark Act provides, in each of the items, a list of trademarks for which trademark registration cannot be granted. The purport of the provisions of item (x), item (xv), and the like of paragraph (1) of Article 4 is to prevent confusion as to the source of goods or services in terms of its

relationship with a trademark that is widely recognized by consumers. The fact that the provision of Item (viii) exists separately from the aforementioned provisions can be interpreted as follows: The purport of Item (viii), which stipulates that no trademark shall be registered if the trademark contains the portrait of another person, or the name, famous abbreviation thereof, or the like (except those whose registration has been approved by the person concerned), is to protect the moral rights for the portrait, name, or name, or the like of a person (including juridical persons; the same applies hereinafter). In other words, a person's interests are protected to ensure that his/her name or the like shall not be used in a trademark without the person's consent. Even in regards to an abbreviation, if such abbreviation is generally accepted, like the person's name, as referring to the person concerned, it is considered that said abbreviation deserves protection like the person's name.

In that case, it can be said that, in regards to the determination of whether or not the abbreviation of a person's name or the like falls under a "famous abbreviation" according to Item (viii), it is not reasonable to always make the determination based only on the consumers of the designated goods or services of the trademark at issue, but rather, the determination should be made based on whether or not said abbreviation is generally accepted as referring to the person concerned.

In this case, according to the aforementioned facts, the appellant continuously used the Appellant's Abbreviation in education and related services over a long period of time, during which the Appellant's Abbreviation was repeatedly featured in books and newspapers and the like, and the Appellant's Abbreviation became well known among educators and other intellectuals. As such, it can be said that there is also room for the interpretation that the Appellant's Abbreviation was generally accepted as referring to the appellant. In that case, it must be said that the decisions by the original examination determining that the Trademark is not in violation of the provision of Item (viii) based on the primary reason that the Appellant's Abbreviation is not widely recognized among Students, etc., who are consumers of the designated services of the Trademark, is unlawful due to erroneous interpretation of the provision of Item (viii).

5. From what is described above, the aforementioned determination by the original examination contains violation of law which clearly influences the judgment, and thus the prior instance judgment shall be definitely reversed. The appellant's claims are with merit. Accordingly, this case shall be remanded to the Intellectual Property High Court for further proceedings on whether or not the

Trademark violates the provision of Item (viii) based on the perspectives described above.

Therefore, the Justices unanimously render a judgment as per the main text.

Supreme Court, Second Petty Bench

Chief Justice TAKII Shigeo

Justice FUKUDA Hiroshi

Justice TSUNO Osamu

Justice IMAI Isao

Justice NAKAGAWA Ryoji