

judgedate:

June 8, 2004

caseid:

2003 (Gyo-Hi) 265

casename:

A case of seeking rescission of the JPO decision

casetitle:

Judgment related to the reference time to determine presence/absence of approval of another person concerned required for trademark registration for a trademark containing the portrait of another person, the name of another person, and the like

summary\_judge:

Regarding the trademark containing the portrait of another person, the name of another person, the well-known abbreviation thereof, and the like, the reference time to determine presence/absence of approval of another person concerned required for the trademark registration is the time of decision of the trademark registration or the time of decision of refusal (when an appeal against the decision of refusal is requested, the time of decision to that).

court second:

Tokyo High Court, Judgment of July 15, 2003

references:

Article 4, paragraph (1), item (viii) of the Trademark Act, Article 4, paragraph (3) of the Trademark Act

### Main text

The present final appeal shall be dismissed.

Appellant shall bear the cost of the final appeal.

### Reasons

Reasons of petition for a final appeal by the attorney of the final appeal, ●●●●

1. Outline of factual relations legally finalized in the court of prior instance is as follows.

(1) Appellant of final appeal filed an application of trademark registration (hereinafter, referred to as the "present application") on October 22, 1998, with the goods in Class 14, Class 18, and Class 25 in No. 1 of the attachment of the Ordinance of the Trademark Act (before revision by Ordinance No. 265 of 2001) described in the decision attached to the judgment in prior instance as the designated goods for the trademark constituted of laterally written European characters "LEONARD KAMHOUT" (hereinafter, referred to as the "trademark of the present application").

(2) The present application trademark is a trademark made of the name D, who is an embosser in the U.S. and a designer of silver accessories (hereinafter, referred to as "D").

At the time of filing of this case, a document indicating D's approval was not submitted, but Appellant submitted the written amendment of procedures with the contents of the amendment that "the written consent and the translation thereof shall be submitted as attached" to the Japan Patent Office on January 26, 1999. The written consent prepared by D as of December 1, 1998 attached to that has recitation that the consent was given to registration of the trademark by Appellant on the ground of the present application.

D submitted the written submission of publication and the like stating the submitted publication as "the copy of the notice of withdrawal of the written consent and the translation thereof" to the Japan Patent Office on May 25, 2000. This document has recitation that D sent the notice of withdrawal as of the 24th day of the same month to Appellant and withdrew the consent by the aforementioned written consent, and the copy of the notice of withdrawal is attached.

(3) Regarding the present application, the examiner's decision of refusal was made on the ground that the trademark of the present application falls under Article 4, paragraph (1), item (viii) of the Trademark Act (hereinafter, referred to simply as "item (viii)"). Appellant made a request for an Appeal against the Examiner's Decision of Refusal, and as the result of examination of this request for an appeal as

the Appeal against Examiner's Decision No. 2000-20761 of the Japan Patent Office, the decision was made that Appellant's request for an appeal is dismissed, on March 14, 2003.

2. This case is a lawsuit that Appellant asserted that the aforementioned JPO decision has errors in interpretation application of the item (viii) and Article 4, paragraph (3) of the Trademark Act (hereinafter, referred to simply as the "paragraph (3)") and sought rescission thereof.

3. Item (viii) is the provision that no trademark may be registered if the trademark contains the portrait of another person, or the name of another person, or a well-known abbreviation thereof listed in the part other than those in the parentheses (hereinafter, referred to as the "main text of the item (viii)" for convenience), except those the registration of which has been approved by the person concerned as stipulated in the parentheses. The purpose thereof is interpreted to protect personal interests of another person related to the portrait, name, and the like. Therefore, those who desire to have a trademark to be registered for the trademark applicable to the main text of the item (viii) should ensure the approval by another person concerned by taking their own responsibility so as not to harm personal interests of the other person.

Moreover, paragraph (3) prescribes that, even in the case of the trademark applicable to the item (viii), those not applicable to the item (viii) at the time of filing of the trademark registration (hereinafter, referred to as the "time of filing"), the provisions in the item (viii) shall not be applied. This is considered to be because, on the premise that a reference time to determine whether it falls under a trademark that may not be registered prescribed in Article 4, paragraph (1), each item of the Trademark Act is the time of decision of trademark registration or decision of refusal in principle (in the case where an appeal against the decision of refusal is requested, at the time of the decision to that; hereinafter, collectively referred to as the "time of decision"), regarding the trademark which did not fall under the trademark containing the portrait of another person, the name of another person, a well-known abbreviation thereof, and the like and was not applicable to the main text of the item (viii), if the trademark is found to become applicable to the main text of the item (viii), since objective circumstances that the applicant cannot be involved such that another person with the identical name as the filed trademark appeared or the abbreviation of the name of another person became well-known by the time of decision after that, it is not reasonable that the applicant may not have the trademark registered and thus, the trademark registration should be approved in such a case as the purpose of the

provision.

In view of the purposes of the item (viii) and the paragraph (3), the trademark not applicable to the item (viii) at the time of filing referred to in the paragraph (3) should be interpreted to refer to the trademark not applicable to the main text of item (viii) at the time of filing, and regarding the trademark which is applicable to the main text of item (viii) at the time of filing but is deemed not to be applicable to item (viii) since there is approval in the parenthesis in item (viii) should be considered not to be applicable to the provisions in paragraph (3). Therefore, [gist] in order to register the trademark for the trademark applicable to the main text of item (viii) at the time of filing, approval in the parentheses of item (viii) is required at the time of decision, and even if there was the aforementioned approval at the time of filing, in the case of lack of it at the time of decision, it is reasonable to interpret that the trademark may not be registered.

By examining this for the present case, according to the aforementioned factual relationships, the trademark of the present application is applicable to the main text of item (viii) at the time of filing, and it is obvious that Appellant did not have D's approval for the trademark registration for the trademark of the present application at the time of decision and thus, the present application should be refused on the ground that the trademark of the present application is applicable to item (viii).

4. According to the above, the judgment of the court of prior instance can be accepted as reasonable. The gist cannot be employed.

Therefore, the judgment shall be rendered as in the main text unanimously by all the judges.

(Presiding judge; UEDA Toyozo, Judge: KANATANI Toshihiro, Judge: HAMADA Kunio, judge: FUJITA Tokiyasu)