

Date	April 17, 2018	Court	Intellectual Property High Court, First Division
Case Number	2017(Gyo-Ke)10078		
<p>- A case in which the court held, based on the premise that "other person", as stipulated in Article 4, paragraph(1), items(x), (xv), and (xix) of the Trademark Act, applies when said other person is different from the person whose source is shown in a trademark, and the premise that "other person," as stipulated in Article 4, paragraph(1), item(viii) of the same Act, applies when said other person is different from the person who is shown in a trademark, that in the present case, the "other person" as claimed by the plaintiff cannot be acknowledged as being different from the person whose source is shown in the Trademark.</p>			

References: Article 4, paragraph(1), items(viii), (x), (xv), and (xix) of the Trademark Act

Number of related rights, etc.: Trademark Registration No. 5714462, Invalidation Trial No. 2016-890023

Summary of the Judgment

The defendant (individual) was granted registration for a trademark consisting of the standard characters, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)" (hereinafter referred to as the "Trademark"). The plaintiff (individual) filed a demand for trial for invalidation of the Trademark by claiming that the registration of the Trademark falls under Article 4, paragraph(1), items(viii), (x), (xv), and (xix) of the Trademark Act, but the JPO rendered a decision not to complete the demand for trial. In the present case, the plaintiff requested for revocation of the above the JPO decision. The court rendered a judgment to the effect that the above the JPO decision is appropriate as per the conclusion, and dismissed, with prejudice, the plaintiffs claim as described below.

(1) For purposes of preventing confusion as to the source of goods or services, and of protecting a trademark from having its source-identifying function diluted, among other purposes, Article 4, paragraph(1), items(x), (xv), and (xix) of the Trademark Act provide for trademarks for which registration cannot be granted. In that case, it is appropriate to understand that "other person," as stipulated in the above items of Article 4, paragraph(1), is different from the person whose source is shown in the trademark concerned. This is because, if the person whose source is shown in the trademark concerned is the same as the "other person," then even if such trademark is used, there is no room for said use to create confusion as to the source or to cause the source-identifying function to be diluted.

Furthermore, for the purpose of protection of moral interests, according to which

no individual or corporation or any other group shall have its name or the like used in a trademark without the consent of said individual or the like, Article 4, paragraph(1), item(viii) of the Trademark Act provides for trademarks for which registration cannot be granted. Given that use of the name or the like of "other person" is considered a problem under Article 4, paragraph(1), item(viii), it is natural to understand the existence of the premise that said other person is different from the person who is shown in a trademark.

(2) It is acknowledged that, at the time of filing of the application for registration of the Trademark and at the time of the decision for registration, what the Trademark showed as the source is one of the schools of classical martial arts, or Toda-ha Buko-ryu Naginatajutsu (hereinafter referred to as the "School") itself, and that both the plaintiff and the defendant belong to this school. Since the Trademark, according to the way it is written, causes traders and consumers to conjure images of the School, it is acknowledged that how consumers recognize the Trademark, based on how the Trademark is written objectively, is congruent with the person of the source, based on the details leading to the filing of the application for registration.

Meanwhile, of the reasons for invalidation, as claimed by the plaintiff in the trial, the "other person" as claimed by the plaintiff in connection with Article 4, paragraph(1), item(viii) of the Trademark Act is the School itself because it is "an association which has had a head as the representative since 1935 if not earlier, and which teaches, among other activities, the art of naginata (Japanese halberd) under the name of 'Toda-ha Buko-ryu Naginatajutsu'." The trademark of "other person," as claimed by the plaintiff in connection with Article 4, paragraph(1), item(x) of the Trademark Act, is "a trademark which is widely recognized among consumers as indicating services, including the teaching of 'Toda-ha Buko-ryu Naginatajutsu'," or a trademark which indicates the School as the source. The "other person," as claimed by the plaintiff in connection with Article 4, paragraph(1), item(xv), is described as "the School in which the plaintiff serves as the deputy head," but in fact, the plaintiff's claim can be interpreted as such that said "other person" is not restricted to the School, in the sense of the School in which the plaintiff serves as the deputy head, but that it means the School, in the sense of the School which has taught "Toda-ha Buko-ryu Naginatajutsu," among other activities, with a head as the representative, since 1935 if not earlier. The "other person" as claimed by the plaintiff in connection with Article 4, paragraph(1), item(xix) is the School itself because the School is "'Toda-ha Buko-ryu Naginatajutsu,' which is famous among consumers."

As described above, the "other person" according to Article 4, paragraph(1), items(viii), (x), (xv), and (xix) of the Trademark Act, as claimed by the plaintiff as reasons for invalidation, refers to the School, and since the Trademark also indicates the School itself as the source, it can be said that the "other person" and the School are the same. In that case, since it cannot be acknowledged that the "other person" as claimed by the plaintiff in connection with the above items of Article 4, paragraph(1) is different from the person whose source is shown in the Trademark, the court cannot acknowledge, based on Article 4, paragraph(1), items(viii), (x), (xv), and (xix) of the Trademark Act, that the Trademark is a trademark for which registration cannot be granted, and thus it must be said that the plaintiff's claims are groundless.

Judgment rendered on April 17, 2018

2017 (Gyo-Ke) 10078 The case of seeking rescission of JPO decision

Date of conclusion of oral argument: March 20, 2018

Judgment

Plaintiff: X

Defendant: Y

Main Text

- 1 The plaintiff's claim is dismissed.
- 2 The plaintiff shall bear the court costs.

Facts and Reasons

No. 1 Judicial decision sought by the plaintiff

The court shall rescind the decision made by the JPO on March 9, 2017, with regard to the case seeking invalidation of patent No. 2016-890023.

No. 2 Outline of the case

The present case is an action for cancellation of the trial decision of invalidation rendered in a demand for invalidation of a trademark registration. The case concerns the issue of whether or not there is error in the judgment of applicability concerning Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act.

1 The Trademark and details of procedures taken at JPO, etc.

(1) The defendant is the holder of the trademark right for the following trademark (hereinafter referred to as the "Trademark") (Exhibits Ko 1, Ko 95, and Ko 96).

Registration number: 5714462

Trademark configuration: 戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu) (standard characters)

Filing date: January 22, 2014

Date of decision for registration: October 31, 2014

Designated services: Class 41 "Conducting martial arts classes; Arranging, conducting, or holding seminars on martial arts; Arranging, conducting, or holding martial arts conventions; Provision of teaching facilities for martial arts; Production of broadcast programs on martial arts; Production of videos on education, culture, entertainment,

and sports of martial arts (other than such videos for use in films, broadcast, and advertising)"

(2) On March 24, 2016, the plaintiff filed a demand for trial for invalidation of trademark registration to the JPO by claiming that the registration of the Trademark falls under Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act and should therefore be invalidated pursuant to the provisions of Article 46, paragraph(1), item(i) of the same Act (Invalidation Trial No. 2016-890023).

On March 9, 2017, the JPO rendered a trial decision to the effect that the "plaintiff's claims are groundless," and a copy of the decision was sent to the plaintiff on the 21st of the same month.

2 Gist of reasons for the trial decision

(1) Reasons for invalidation

A Use of "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)" and acquisition of publicity

戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu) (hereinafter sometimes referred to as the "School") is one of the schools of naginata (Japanese halberd), having been passed down since the Sengoku period. By 1935, if not earlier, the name, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," was also used in publications and the like. During the Showa period, the School participated annually in Nihon Kobudo Taikai, and as the School's activities were reported by media, the name became known nationwide by the early Showa period, if not earlier.

Accordingly, it is evident that, at least by the time when the application for registration of the Trademark was filed, the name, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," was widely known among consumers, who are interested in martial arts and classical martial arts, as representing services such as the teaching of martial arts and the arranging, conducting, or holding martial arts conventions.

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

Ever since 1935, if not earlier, the School has had a head as the representative and taught the art of naginata (Japanese halberd) under the name, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," among other activities, thereby

engaging in its own social activities as an association. As such, the School falls under an association that lacks the legal capacity to hold rights, and thus the "name of other person" under Article 4, paragraph(1), item(viii) of the Trademark Act is applicable.

Accordingly, the Trademark is the same as, and includes, the name, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," and thus the Trademark falls under Article 4, paragraph(1), item(viii) of the Trademark Act.

C Violation of Article 4, paragraph(1), item(x) of the Trademark Act

The Trademark is widely known among consumers as representing services such as the teaching of "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," and since the Trademark is used for said services, the Trademark falls under Article 4, paragraph(1), item(x) of the Trademark Act.

D Violation of Article 4, paragraph(1), item(xv) of the Trademark Act

The defendant used to be a disciple of the School. As such, if the defendant uses the Trademark for services such as the teaching of martial arts and the arranging, conducting, or holding martial arts conventions, there is a high risk of causing the misunderstanding that said services are the same as the teaching of the art of naginata (Japanese halberd) and other such services being provided by the School, in which the plaintiff serves as the deputy head.

Accordingly, the Trademark falls under Article 4, paragraph(1), item(xv) of the Trademark Act.

E Violation of Article 4, paragraph(1), item(xix) of the Trademark Act

When A, who is the former head of the School (hereinafter referred to as "Former Head"), passed away on August 29, 2012, the defendant tried to illicitly use the publicity gained by the name, "戸田派武甲流薙刀術 (Toda-ha Buko-ryu Naginatajutsu)," which was famous among consumers, and tried to monopolize the publicity at the Buyokan, which the defendant operates, for example by registering himself as the representative of the School and filing the application for registration of the Trademark without the prior consent of the plaintiff, in spite of the fact that only three years had passed since the defendant joined the School, the fact that the plaintiff is the representative whom the Former Head entrusted with the position of the head, and the fact that the

defendant was aware that he did not have the qualification necessary for becoming the head, by taking advantage of the fact that the School cannot be registered in organizations such as the Japan Kobudo Promotion Society if the representative of the School was not changed from the plaintiff, who is a foreign national. It is evident that the defendant had "unfair purposes" as stipulated in Article 4, paragraph(1), item(xix).

Accordingly, the Trademark falls under Article 4, paragraph(1), item(xix) of the Trademark Act.

(2) Gist of reasons for the trial decision

A The Toda-ha Buko-ryu Naginatajutsu

Evidence and claims indicate the findings shown below.

(A) Toda-ha Buko-ryu Naginatajutsu (the School) teaches a heavily-armed martial art which developed by Seigen Toda, who was a vassal of the Asakura family of Echizen Fukui Province during the Sengoku period. The School was called "Toda School" in the beginning, but as the School moved to the Kanto area in Japan, it came to be called "Toda-ha Buko-ryu."

The School has been a member of the Japan Kobudo Promotion Society (founded in 1935; hereinafter simply referred to as the "Promotion Society") since the foundation of the Promotion Society. Between 1935 and 2012, the School participated in Kobudo Kata Hono Taikai (classical martial arts ceremonial convention of forms), which is organized by the Promotion Society, and Nihon Kobudo Taikai (Japanese classical martial arts conventions), which is held at Meiji Shrine, and between 1993 and 2010, the School participated in Nihon Kobudo Enbu Taikai, which is organized by the Japanese Classical Martial Arts Association (hereinafter simply referred to as "Association"), and furthermore, the School has participated in demonstration tournaments which were held nationwide as well as in ceremonies at shrines and the like.

Up until the death of Former Head, the Former Head was named as the representative of the School in the notices submitted to the Promotion Society and the Association, and both external and internal activities were conducted under his instructions.

(B) The plaintiff and the defendant are both disciples of the School. By around February 2002, if not earlier, the plaintiff, who is a foreign national, was in the

position of a grand master, whereas the defendant joined the School around 2009. In November 2011, the Former Head became ill and was hospitalized for surgery.

B Defendant's registration procedures at Promotion Society, etc.

The plaintiff claims as follows: For the period from the training until appointment of a head who is Japanese, the Former Head had entrusted the plaintiff with the training of disciples as well as with the entire operations of the School as the deputy head, and thus, until the time when the plaintiff would appoint the next head, the plaintiff was the representative of the School, both externally and internally, and also had the power to make final decisions, but the defendant named himself as the head of the School and carried out registration procedures at the Promotion Society and the like despite acknowledging that the plaintiff is in the position of the deputy head and without obtaining the prior consent of the plaintiff, who is authorized to decide the next head. The plaintiff's claims above shall be considered.

(A) The court acknowledges the following. In November 2011, the Former Head told the plaintiff about the conditions of the Former Head's illness and about future prospects, among other matters, and requested the plaintiff to fill in for the head of the Buko-ryu if anything happened to the Former Head, and in the event that a Japanese disciple who is suitable to succeed the School should appear as a result of training, to let that disciple succeed the School as the next head, upon consultations with the direct disciples of the head prior to the Former Head. After making said request, the Former Head appointed the plaintiff as the deputy head of the School, and the Former Head requested the defendant to be in charge of preparing external documents and of running the School's Buyukan Dojo as its director. Thereafter, in July and August 2012, the Former Head left a will in the presence of his wife, the plaintiff, and the defendant, among others, and passed away on August 29, 2012 without appointing the next head.

(B) The court acknowledges the following. It seems that the defendant prompted the Promotion Society to register the plaintiff as the school representative of the School, and that the defendant and the Promotion Society advised the plaintiff to obtain Japanese nationality, but this plan fell through since the plaintiff firmly refused to obtain Japanese nationality. Furthermore, since the Promotion Society and the Association hinted at the possibility of dismissal of the School if it fails to appoint a school representative who is Japanese, the defendant submitted to the Promotion Society a notice of change to the school representative in March 2013

by indicating the defendant as the school representative because, if the School were dismissed from the aforementioned organizations, then the School would probably be no longer able to participate in Kobudo Taikai and other conventions in which the School had continued to participate over the years, and said notice was accepted. Also, in April 2013, the defendant submitted a notice of change to the school representative to the Association as well, and on June 2, 2014, the Association registered the wife of the Former Head as the deputy representative and the defendant as an associate member, and subsequently, the School was able to continuously participate in conventions such as Kobudo Taikai, which is organized by the Promotion Society.

(C) In light of the above, namely that the Former Head appointed the plaintiff as the deputy head, entrusted the plaintiff with the training of a Japanese disciple who would become the next head, and entrusted the plaintiff with the succession of the next head upon consultations with the direct disciples of the head prior to the Former Head, it cannot be understood immediately that the plaintiff is the representative of the School both externally and internally, and that the plaintiff is authorized to make final decisions on the operations of the School.

While appointing the plaintiff as the deputy head, the Former Head entrusted the defendant with the responsibility of writing documents and with the operation of the School's Odawara Buyukan Dojo as its director. As such, it should be understood that the Former Head requested both the plaintiff and the defendant to handle the operation and management of the School, among other matters, after the death of the Former Head.

In that case, it should be said that a series of activities by the defendant, which includes the defendant nominating the plaintiff as the representative of the School to the Promotion Society and the Association at one time, the school representative of the Association and the Promotion Society being restricted to a person with Japanese nationality, the plaintiff firmly refusing the acquisition of Japanese nationality, the plan to make the plaintiff the representative of the School subsequently falling through, the Promotion Society and the Association, with which the School had carried out most activities, hinting that the School may be dismissed if a school representative of Japanese nationality is not appointed, and the defendant subsequently submitting to the Association and the Promotion Society a notice indicating the defendant as the school representative, were necessary responses for maintaining memberships at the two organizations, where

most of the School's activities take place.

C Reasons for invalidation of the Trademark

The School is the name of one of the schools of classical martial arts, which has carried out most of its activities with the Promotion Society and the Association. The defendant had been entrusted, jointly with the plaintiff, by the Former Head with the operation and management of the School, among other matters, after the death of the Former Head, and in view that the Promotion Society and the Association had placed the restriction that the school representative must be a person with Japanese nationality, it cannot be said that the defendant's act of taking the procedure concerning school representative with the purpose of maintaining memberships at the Promotion Society and the Association was based on unfair purposes.

Furthermore, after the defendant was accepted by the Executive Committee of the Promotion Society as the school representative of Toda-ha Buko-ryu Naginatajutsu, the defendant participated in Kobudo Taikai and other such conventions as the representative of the School, and various newspapers and magazines mentioned the defendant as the representative of the School. In light of these circumstances, it cannot be said that the defendant falls under "other person" as stipulated in Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act in terms of its relationship with the School at the time of the filing of the application for registration of the Trademark and at the time of the decision for registration.

Accordingly, it is needless to consider other requirements set forth in Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act, and thus the Trademark does not fall under these items.

(3) Conclusion

As described above, it cannot be said that the registration of the Trademark was in violation of Article 4, paragraph(1), item(viii), (x), (xv), or (xix) of the Trademark Act, and thus the registration shall not be invalidated pursuant to Article 46, paragraph(1) of the same Act.

(omitted)

No. 5 Court decision

1 Findings

Evidences (Exhibits Ko 2, Ko 9 to Ko 62, Ko 64 to 67, Ko 79, Ko 82, Ko 84, Ko 85, Ko 88 to Ko 90, Ko 103, Ko 108 to Ko 111, Ko 113, Ko 115, Ko 118 to Ko 121, Ko 129 to Ko 131, Ko 134 to Ko 136, Ko 138 to Ko 144, including branch numbers; the same applies hereinafter) and the entire import of the oral argument support the findings shown below.

(1) About the School, Toda-ha Buko-ryu Naginatajutsu

The School teaches a heavily-armed martial art which was developed by Seigen Toda, who was a vassal of the Asakura family of Echizen Fukui Province during the Sengoku period. The School was called "Toda School" in the beginning, but as the School moved to the Kanto area in Japan, it came to be called "Toda-ha Buko-ryu" (Exhibits Ko 64 to 67, Ko 140).

The School has been a member of the Promotion Society (founded in 1935) since its foundation. Between 1935 and 2012, the School participated in conventions organized by the Promotion Society and in demonstration tournaments at a shrine and the like (Exhibits Ko 9 to Ko 62).

The Former Head of the School became the head of the School in 2008. Up until his death, the Former Head was named as the representative of the School in the notices sent to the Promotion Society and the Association, and both external and internal activities were conducted under the instructions of the Former Head (Exhibits Ko 58 to Ko 61).

(2) Details prior to death of Former Head

A The plaintiff and the defendant are both disciples of the School. The plaintiff, who is a foreign national (Denmark), was in the position of a grand master by around February 2002, if not earlier (Exhibit Ko 50). The defendant joined the School around 2009.

B The Former Head was hospitalized for surgery in November 2011. On the 20th of the same month, the Former Head told the plaintiff, by e-mail, about the conditions of the illness of the Former Head and about future prospects, among other matters, and requested the plaintiff to fill in for the head of the Buko-ryu if anything happened to the Former Head, and in the event that a Japanese disciple who is suitable to succeed the School would appear as a result of training, to let that disciple succeed the School as the next head, upon consultations with

the direct disciples of the head prior to the Former Head (Exhibits Ko 79 and Ko 85).

- C In May 2012, the Former Head told his disciples, including the defendant, at the School's Nakano Dojo, that the next head would be a Japanese, and that the plaintiff had been appointed as the deputy head.
- D The Former Head issued to the defendant a written document dated July 16, 2012, sealed and signed, indicating that "the responsibility for writing documents under the name of Toda-ha Buko-ryu Naginatajutsu / and the running of Buyokan Odawara Dojo / shall be entrusted to Y. / Please work diligently" (the slashes indicate the start of new lines; the same applies hereinafter) (Exhibit Ko 108).
- E In August 2012, at a hospital where he was hospitalized, the Former Head issued to the plaintiff a written document dated May 23, 2012, sealed and signed, indicating that "the post of the deputy head / of Toda-ha Buko-ryu Naginatajutsu / shall be entrusted to X" (Exhibit Ko 2).
- F A detailed error report dated May 1, 2014 (Exhibit Ko 84) which the defendant submitted to the Association states that, on July 7, 2012, at a hospital where the Former Head was hospitalized, his wife, the plaintiff, the defendant, and two other witnesses were present when the Former Head left a will which indicated as follows: (i) The head of the School shall be a Japanese; (ii) The head of the School shall continue to be a member of classical martial arts organizations (the Association and the Promotion Society) and shall broadly exchange with other members; (iii) The plaintiff shall, as the deputy head, provide instructions on the skills of naginata (Japanese halberd) and train a head who is Japanese; and (iv) The defendant shall be in charge of preparing external documents and the like in addition to running the School's Buyokan Dojo as its director, and shall take actions which contribute to the succession of the School's tradition, such as gathering of historical records.

G The Former Head passed away on August 29, 2012 (Exhibit Ko 103). The Former Head did not appoint the next head of the School.

(3) Details leading to the submission of a notice of representative to the Promotion Society and the Association

A After the death of the Former Head, the defendant took actions to register the plaintiff as the school representative of the School by suggesting to the Promotion Society about making the plaintiff the representative. On December 22, 2012, the defendant was given the explanation concerning the next representative (head) of the School to the effect that, in order to be registered as the school representative, the representative must have Japanese nationality (including naturalized Japanese citizens). At that time, a plan in which the plaintiff would acquire Japanese nationality to become the next representative (head) surfaced for consideration, but since the plaintiff firmly refused to acquire Japanese nationality, the plan fell through (Exhibits Ko 82 and Ko 120).

B The Promotion Society and the Association hinted to the defendant that they could not accept the registration of a non-Japanese as the school head of the School, and that in the event that no school representative who is Japanese is appointed, the School may risk being dismissed from the organizations.

C The defendant received the "Toda-ha Buko-ryu Naginatajutsu Mokuroku" (a full license indicating mastery of the school's teachings) (Exhibit Ko 110) and a naginata (Japanese halberd) (Exhibit Ko 109) from the wife of the Former Head. In addition, on March 13, 2013, the defendant submitted a notice of change to the school representative, indicating the defendant himself as the school representative of the School, to the Promotion Society, and the notice was accepted (Exhibits Ko 111, Ko 118 to 120).

D On April 15, 2013, the defendant submitted to the Association a notice of change to the school representative, indicating the defendant himself as the school representative (Exhibit Ko 113). On June 2, 2014,

the Association registered the wife of the Former Head as the deputy representative with the understanding that that she will, as the deputy head, appoint the head of the School who is Japanese (Exhibit Ko 121).

(4) Activities by the defendant

The defendant provided teaching of the School, among other activities (Exhibits Ko 129, Ko 130, and Ko 134), participated in demonstration tournaments organized by the Promotion Society (Exhibit Ko 131), and even after the decision for registration of the Trademark, participated in Kobudo Taikai and the like as the representative of the School (Exhibits Ko 135, Ko 136, and Ko 138 to 143).

(5) Activities by the plaintiff

Even after the death of the Former Head, the plaintiff continued to provide instructions to disciples at the School's Nakano Dojo and attended conventions, among other activities (Exhibits Ko 88 to 90, Ko 144).

On December 20, 2013, the plaintiff sent a notice to the defendant indicating that the plaintiff, as the deputy head, excommunicates the defendant from the School (Exhibit Ko 115).

2 Grounds for rescission (error in judgment of applicability of Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act)

(1) Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act
Article 4, paragraph(1), item(x), (xv), and (xix) of the Trademark Act (hereinafter collectively referred to as "Relevant Provisions") provide for trademarks, for which registration cannot be granted, with the purpose of preventing confusion as to the source of goods or services or of protecting the source-identifying function from being diluted, among other purposes. In such case, it is appropriate to understand that the "other person" as stipulated in the Relevant Provisions is a different person from the person whose source is shown by said trademark. This is because, if the person whose source is shown by said trademark is the same as the "other person," then there is no room, even when such trademark is used, for said use to create confusion as to the source or to cause dilution of the source-identifying function.

Article 4, paragraph(1), item(viii) of the Trademark Act provides for trademarks,

for which registration cannot be granted, with the purpose of protecting moral rights by stipulating that the name or the like of an individual or judicial person or any other group shall be used in a trademark without the consent personally given by said individual, judicial person, or any other group (Supreme Court Judgment of Third Petty Bench dated June 8, 2004/Civil Case Record, vol. 214, page 373; Supreme Court Judgment of Second Petty Bench dated July 22, 2005/Civil Case Record, vol. 217, page 595). Given that use of the name or the like of "other person" is considered a problem under Article 4, paragraph(1), item(viii), it is naturally understood as a prerequisite that said person and the person who is shown in the trademark are different.

(2) The Trademark, etc.

According to the findings indicated above and the details leading to the filing of the application for registration of the Trademark, what the Trademark shows as the source, at the time of the filing of the application for registration and at the time of the decision for registration, is the School itself, which is one of the schools of classical martial arts, and it is acknowledged that the plaintiff and the defendant belong to the School (the fact that the plaintiff sent to the defendant a notice to excommunicate the defendant from the School does not influence the above finding).

Since the Trademark, by the way it is written, conjures images of the School (Toda-ha Buko-ryu Naginatajutsu) to traders and consumers, it is acknowledged that how consumers recognize the Trademark based on the objective writing of the mark is congruent with the person whose source is identified based on factors such as the details leading to the filing of the application for registration.

Meanwhile, of the reasons for invalidation as claimed by the plaintiff in a trial, the "other person" as claimed in connection with Article 4, paragraph(1), item(viii) of the Trademark Act refers to an "association which carries out, among other things, the teaching of classical martial arts under the name, 'Toda-ha Buko-ryu Naginatajutsu,' ever since 1935, if not earlier, with the head acting as the representative." As such, it refers to the School itself. The trademark of "other person" as claimed in connection with Article 4, paragraph(1), item(x) is a "trademark which is widely recognized among consumers as indicating services such as the teaching of classical martial arts under the name, 'Toda-ha Buko-ryu Naginatajutsu,' or the trademark the source of which is the School." The "other person" as claimed in connection with Article 4, paragraph(1), item(xv) is

described as "the School in which the plaintiff serves as the deputy head." In fact, however, the plaintiff's claim can be interpreted as such that said "other person" is not restricted to the School, in the sense of the School in which the plaintiff serves as the deputy head, but that it means the School, in the sense of the School which has taught "Toda-ha Buko-ryu Naginatajutsu," among other activities, with a head as the representative, since 1935 if not earlier. The "other person" as claimed in connection with Article 4, paragraph(1), item(xix) is "'Toda-ha Buko-ryu Naginatajutsu', which is famous among consumers," and thus it refers to the School itself.

As described above, while the "other person" under Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act as claimed by the plaintiff as reasons for invalidation all refer to the Trademark, what the Trademark shows as its source is also the School itself, and thus it can be said that the two marks are the same. In that case, since it cannot be acknowledged that the "other person" as claimed by the plaintiff in connection with the above items is different from the person whose source is shown by the Trademark, it cannot be acknowledged, as per the above (1) and pursuant to Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act, that the Trademark is a trademark for which registration cannot be granted, and thus it must be said that the plaintiff's claims are groundless.

In this regard, the trial decision held as follows: It cannot be said that the action by the defendant, who was requested to handle the operation and management and the like of the School jointly with the plaintiff, of taking the procedures concerning school representative, is unlawful, and in light of circumstances such as that the defendant, who, after having been accepted by the Executive Committee of the Promotion Society, participated in Kobudo Taikai and the like as the School's representative and that the defendant is mentioned in various newspapers and magazines as the School's representative, it cannot be said that the defendant falls under "other person" as stipulated in Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act in terms of its relationship with the School at the time of the filing of the application for the Trademark and at the time of the decision for registration.

However, as described above, the Trademark shows as its source one of the schools of classical martial arts, or the School itself. As such, whether or not the defendant, as an individual, falls under the above "other person" in terms of the relationship between the Trademark and the School does not immediately

influence the judgment of applicability under Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act (the plaintiff's claim can be interpreted as such that there are reasons for invalidation of the Trademark, for which registration has been granted to the defendant, in terms of the relationship between the Trademark and the School, which is "other person").

Accordingly, it must be said that the fact that, in the trial decision, the judgment of applicability of Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act was rendered based on the reason that the defendant as an individual does not fall under the above "other person" in terms of its relationship with the School, without taking into consideration the source and the like of the Trademark, was erroneous. However, it can be said that the judgment in the trial decision to the effect that Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act do not apply to the Trademark was not erroneous as per the conclusion.

(3) Claims by the plaintiff

Claims by the plaintiff include the following: Without the consent of the plaintiff, who is in the position of the deputy head of the School and has the authority to decide the next head, the defendant called himself the head of the School and took registration procedures at the Promotion Society and the like, attended demonstration tournaments, and filed the application for registration of the Trademark without consulting the plaintiff about the matter.

However, as described above, the Trademark shows, as the person of the source, one of the schools of classical martial arts, or the School, which is the same as the organization which the plaintiff claims is other person. As such, matters such as the details leading to the filing of the application for the Trademark and whether or not the representative of the School is the plaintiff do not influence the above judgment of applicability of Article 4, paragraph(1), item(viii), (x), (xv), and (xix) of the Trademark Act, which the plaintiff claims constitute reasons for invalidation of the Trademark.

Accordingly, the plaintiff's claims, as above, cannot be accepted.

3 Summary

As described above, there is no need to determine the remaining matters, and there is no error in the trial decision to the effect that Article 4, paragraph(1), item(viii), (x),

(xv), and (xix) of the Trademark Act do not apply to the Trademark. As such, the reason for cancellation, as claimed by the plaintiff, is groundless.

No. 6 Conclusion

Therefore, the plaintiffs' claims shall be dismissed as there is no reason, and the Judgment renders as in the form of the main text.

Intellectual Property High Court, First Division

Presiding judge SHIMIZU Misao

Judges NAKASHIMA Motoyuki and OKADA Shingo cannot affix their seals and signatures hereon due to change of posts.

Presiding judge SHIMIZU Misao