

**41.103.02****Handling of Applications for Trademark Registration Filed for Trademarks Using Names of Building Structures, etc.**

<<In relation to Article 3 of the Trademark Act>>

1. In the case of a trademark that consists solely of marks that indicate names and figures (or a combination of both) of existing public building structures (bridges, towers, statues, airports, baseball stadiums and other building structures that are owned or managed by the national government, local public organizations, and other public organizations/legal entities), such trademark will be deemed to indicate the place of origin or sale of the pertinent goods when the name or figure is recognized by general consumers and traders as indicating a sightseeing area (including its location and surrounding areas), and when the goods to be used are recognized by them to have been produced and sold at the pertinent place or the services to be provided are recognized by them to have been provided at the pertinent place and Article 3(1)(iii) of the Trademark Act will be applied.

(Explanation)

(1) This paragraph stipulates the manner in which a trademark will be handled when it consists of a mark indicating a name of a public structure or its figures in view of the fact that names and figures of public building structures have not always been handled in a uniform manner as a mark indicating the place of origin or sale of goods or location of provision of services.

In other words, when a public building structure is recognized by general consumers and traders as indicating a sightseeing area, it is realistic to say that there are many businesses and stores in the region that are producing and selling souvenirs at that location or providing services.

These businesses are in fact either using the names or figures of the structures mentioned above to indicate the goods as being produced and sold in the place or the services as being provided in the place, or even if not using these names, need to be allowed to freely use these names.

Therefore, such trademarks will be handled as prescribed above.

(Note) The term "building structures" as referred to in this paragraph is defined, in general, as an object (a man-made object) that is installed by being fixed to the ground using human labor.

Therefore, the scope of the term will be broader than the concepts represented by the terms "building" and "constructions," and will include bridges and statues that are not covered by a roof.

2. In the case of a trademark that consists solely of a mark that indicates a partially constructed public building structure (a building structure that is owned and managed by the national government, local public entity, or a public corporation), if there is a possibility that after completion of the construction, the construction will have the effect of making the location or the surrounding areas recognized by the general consumer and traders as a sightseeing area, and the goods in use to be recognized as having been produced and sold in the place or the services to be recognized as having been provided in the place, such trademark will be considered to indicate the place of origin and sale of the pertinent goods or the location of provision of services after the construction of the building structure has been completed and Article 3(1)(iii) of the Trademark Act will be applied.

(Explanation)

The reason why this paragraph has included a mark indicating the name or figure of an incomplete public building structure as being applicable to the provisions, is because though the place may not be a sightseeing area at the time when the trademark application was filed, a situation could occur where the trademark or mark could in the future indicate a sightseeing area.

Therefore, for applications that involve the name and figure of the building structures mentioned above, after the public announcement of the construction plan of the pertinent building structure, trademark applications depicting the building structure are handled in the same manner as the preceding item (i) since it has been deemed to have become public knowledge.<sup>1</sup>

3. In the case of a trademark that consists solely of a mark that indicates the names or figures (or a combination of both) of a building structure owned by a private citizen, such trademark will be deemed to indicate the place of origin or sale of the pertinent goods when the name or figure is recognized by general consumers and traders as indicating a sightseeing area (including its location and the surrounding areas), and when the goods to be used are recognized by them to have been produced and sold at the pertinent place or the designated services are recognized by them to have been provided at the pertinent place, Article 3(1)(iii) of the Trademark Act will be applied.

(Explanation)

The reason why the building structures subject to the provisions are defined to be the "building structures owned and managed by the national government, local public organizations, and other public organizations/legal entities" in 1. and 2. above is based on the determination that indications consisting of the names or figures of such

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<sup>1</sup> The situation in foreign countries was surveyed with respect to this point. In response to our inquiries, the German Patent and Trademark Office stated that "with respect to the name or figure of an incomplete building structure or of a building structure that is currently in the construction planning phase, under the condition that the pertinent building structure has received a certain degree of publicity, such trademarks are handled pursuant to Article 4(2) (trademarks that cannot distinguish one's own goods from other goods) of the German trademark law."

building structures have the characteristic of being regarded by many persons as the indications necessary to be used in the process of distributing goods.

Normally, in the case of building structures owned by private citizens, the use of indications thereof belong to the exclusive right of such private citizen and the free use by the general public is not allowed, and thus they are handled in a different manner. However, even if a building structure is owned by a private citizen, if it recognized by consumers as the place of production or sale of goods or the location of provision of service due to circumstances such as being published in many handbooks for travelling or pamphlets for organized tours as mainly indicating the sightseeing area: note that such building structure will be handled in the same manner as that for public building structures. In addition, in this case, even if the owner is the applicant, it goes without saying that this item applies.

4. In the case of a trademark indicating the name or figure of an existing public structure, incomplete public structure or a building structure owned by a private citizen that is recognized by the general consumers or traders as a sightseeing area, if it is recognized as a building structure indicating the shipment place or temporary storage place of the designated goods or the stop-off place when the designated service is provided (ports and airports, etc.), Article 3(1)(vi) of the Trademark Act will be applied.

(Explanation)

While items 1. to 3. above described the manner of handling trademarks that fall under Article 3(1)(iii) of the Trademark Act, this paragraph clearly describes the manner of handling trademarks when the relevant building structure (ports and airports, etc.) are recognized as the building structures indicating the shipment place or temporary storage place of the designated goods or the stop-off place when the designated service is provided, in line with the Examination Guidelines for Trademarks.

Building structures covered by this provision are "building structures owned and managed by the national government, local public entity, or a public corporation." However, even in the case of a building structure owned by a private citizen, if the building structure is recognized by consumers as indicating the shipment place and temporary storage place of the designated goods or the stop-off place when the designated service is provided due to circumstances such that many businesses are using such building structure as the shipment place or temporary storage place for the goods handled or the stop-off place for the designated services to be provided, note that such a building structure shall be handled in the same manner as that for public building structures.

<<In relation to Article 4 of the Trademark Act>>

5. When a person other than the owner of a famous non-public and privately-owned building structure files a trademark application for a mark that indicates or comprises the name or figure of a famous non-public and privately-owned building, and when there is a concern that the trademark will be confused with goods or services pertaining to the business of another person, Article 4(1)(xv) of the Trademark Act will be applied.

(Explanation)

Marks that indicate the name or figure of a famous privately-owned structure (for example the Tokyo Dome) and that do not fall under the items mentioned in 3. and 4. above will not cause the issue of confusion as to the source of goods or services when the trademark application has been filed by the owner of the privately-owned structure (for example Tokyo Dome Corporation). When the trademark application is filed by a person other than the owner, since presumably there is a potential for the goods to be confused with goods pertaining to the business of another person, a statement has been added to this paragraph to the effect that, in such a case, the provisions of Article 4(1)(xv) of the Trademark Act will be applied.<sup>2</sup>

6. When a trademark includes a mark that falls under the conditions stipulated in the preceding items 1. to 4., and it is used for goods that are produced and sold in an area other than the pertinent region or place, and there is a possibility that it could mislead consumers about the quality of the goods, Article 4(1)(xvi) of the Trademark Act will be applied.

(Explanation)

When a trademark claimed in a trademark application comprises a mark which is generally recognized as indicating a sightseeing area as defined in the previous items 1. to 4., and thereby obviously and substantially misleads the consumers as to the quality of goods or services, Article 4(1)(xvi) of the Trademark Act will be applied.

However, since the attributes of the mark that comprises the name or figure of a public building structure as defined in the previous items 1. and 2. are inherently different from a name of a country, administrative district, town or village which can be easily acknowledged as the place of origin and sale of the goods or the provision of services, the provisions of this paragraph will not be applied merely on the basis of formality.

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<sup>2</sup> In response to our inquiries about the practical procedures taken in the UK for such cases, the written response stated that "a trademark application filed by a person other than the owner of the pertinent structure will not be accepted when the owner's written approval is not submitted, or even when the owner consents, depending on the type of goods, when it has been deemed that there is a likelihood that confusion could arise regarding the source of the goods."

[Note] This is not the case when it is found that it is not necessarily appropriate to follow this policy after considering each specific application.

### **Trial or Appeal Decision and Judgment Related to Public Structures**

1. Trademark "瀬戸大橋"

(1987 (Yo) 29, Case of Applying for Provisional Disposition such as Injunction Against the Use)

<Judgment (summary)>

"At this time, when Seto Ohashi [bridge] has become widely known among the general public as a sightseeing area, if a trademark is used that indicates or calls to mind Seto Ohashi, it is clear that the general consumer and traders will recognize the goods as being produced or sold in the area surrounding Seto Ohashi. Thus, an association between Seto Ohashi as the place of production and sale will be established. Also, it is not appropriate for an individual to have an exclusive right to the use of the name of a public building structure."

2. Trademark "成田空港・NARITA AIRPORT"/Designated goods Class 30 "Confectionery, bread and buns"

(Trial No. 5242 of 1971)

<Trial decision (summary)>

It is clear that the letters "Narita Airport" are another name used for the New Tokyo International Airport, where many stores sell candy and souvenirs in the airport terminal. The trademark of this trademark application indicates the place where the goods are sold and cannot be understood to be a sign that is used to identify those particular goods against other goods. In addition, such a place is used by people who are related to the airport to indicate the place of sale of their goods, and thus should be open to free use. An individual should not be accorded a monopoly right to use the place through acceptance of the registration of such a trademark. The trademark of this trademark application falls under the provisions of Article 3(1)(iii) of the Trademark Act and cannot be registered."

(Note: At the time when this decision was rendered, the New Tokyo International Airport Public Corporation constructed and managed the Narita Airport.)

3. Trademark "平和台饅頭"/Designated goods: Former Class 43 "Bean-paste bun"  
(1960 (Gyo-Na) 146)

<Judgment (summary)>

The letters "平和台" ["Heiwa-dai"] were adopted from the sports stadium managed by Fukuoka City, which is known nationwide as a sports stadium used for professional baseball games. Therefore, it must be acknowledged that it is generally the case that containers and wrappings/packages used with the goods that are manufactured and sold in the place in question or in Fukuoka City, where the stadium is located, will display the name of Heiwa-dai as an indication of the place where the

goods are manufactured and sold. The manju, which are the designated goods of this trademark application, are goods that are sold in Fukuoka City or in the sports stadium mentioned above in stores that are opened each time a game is held. In addition, the embodiment of the trademark of this trademark application is only displayed in a common manner. Therefore, the trademark of this trademark application is deemed to be insufficiently distinctive."

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

Article 3(1)(iii) (Indication of origin, place of sale, quality and other characteristics of the goods, or indication of location, quality and other characteristics of provision of the services)

Article 3(1)(vi) (Trademarks lacking distinctiveness in addition to those mentioned in each of the preceding items)

Article 4(1)(xv) (Confusion over the source of goods and services)

Article 4(1)(xvi) (Misleading as to the quality of the goods or services)