

## 42.107.04

### **Approach to Application Filed for Registering a Trademark Created after the Name of a Historical Person or Name of a Well-Known or Famous Deceased Person**

**1. In the process of examining an application filed for registering a trademark, examiners should pay special attention to the application for a trademark created after the name of a historical person since using or registering such application may cause damage to social and public interest, irrespective the unobjectionable composition of the trademark, or generally-accepted sense of morality, which may fall under Article 4(1)(vii) of the Trademark Act. Specifically, they should analyze such application if it would fall under the provision, comprehensively taking the following backgrounds into consideration:**

- 1) Popularity of the well-known or famous historical person;**
- 2) Acceptance of the name of the historical person among the nation or region;**
- 3) Availability of the name of the historical person;**
- 4) Relationship between the availability of the name of the historical person and the designated goods or services;**
- 5) Circumstance, purpose, or reason of the application; and**
- 6) Relationship between the historical person and the applicant.**

**2. In the process of the examination said above, especially when examiners recognize the application as “an application for registering the trademark filed by the applicant who takes advantage of the measures for public interest using the name of a historical person, who hinders the execution of the measures, and who intends to monopolize the interest while he/she knows that the application would result in damaging public interest,” the application falls under Article 4(1)(vii) of the Trademark Act based on the idea that the application may disrupt the order of fair competition and cause damage to social and public interest.**

#### **Details**

##### **A. Current approach for analyzing the name of a historical person**

###### **a. Background surrounding the name of a historical person**

The name of a well-known or famous historical person could be a dynamo to strongly attract customers due to such person’s reputation. Especially, people living in the home town or areas related to the historical person would love, respect, and feel familiarity with him/her because of his/her greatness. For example, public organizations in such areas, such as local governments or the chambers of commerce and industry, often run memorial halls praising the achievements of a historical person or use the name of a historical person as a trademark for revitalizing the areas or sightseeing business using the name as a local symbol, which shows that the name would strongly attract customers in such areas even if the association between the

historical person and goods or services is weak. Considering this situation, many people would like to use the name of a well-known or famous historical person by registering it as a trademark, while it is undeniable that such registration may offend people in the nation or areas as a whole who respect the historical person.

Based on this background, it is a concern that registering the name of a well-known or famous historical person as a trademark may disrupt the order of fair competition and cause damage to public policy.

#### **b. Current process of examining the application**

An application filed for registering the name of a historical person is refused when it falls into the provision providing a reason for refusal based on a specific background.

However, the current Trademark Act does not provide any express provision for excluding a trademark registration of the name of a person other than those who actually exist. For example, Article 4(1)(viii) of the Trademark Act stipulates the requirement for registering the name or the like of a person but it is a provision to protect personal rights and its scope of protection is limited to a living person.<sup>1</sup> In addition, Article 4(1)(x) and (xix) of the Trademark Act provide for the protection of a well-known or famous trademark of another person, but this provides protection of a well-known or famous “trademark” which represents a source of the goods or services of another person, and thus, it would be difficult to refuse a trademark created after the name of a historical person who is not well-known or famous as a “trademark” based on these provisions. It would also be difficult to refuse such trademark based on Article 4(1)(xv) of the Trademark Act, which stipulates refusing the application due to the confusion of sources of the goods or services, when some factors, such as the relationship between the name of a historical person and goods or services, are taken into consideration. Furthermore, if many business owners substantially and customarily use the trademark in question in connection with the goods or services, the application would fall under Article 3(1)(ii) of the Trademark Act, but such case is very rare.

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<sup>1</sup> The Examination Guidelines for Trademarks says the term “another person” in Article 4(1)(viii) of the Trademark Act means “any person who actually exists” ([http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/pdf/tt1303-061\\_25.pdf](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1303-061_25.pdf)). The court decision also ruled that “Article 4(1)(viii) of the Trademark Act stipulates that a trademark which “contains the portrait of another person...except those for which registration has been approved by the person concerned” is not allowed to be registered. According to these requirements, it is natural to understand that the term “another person” in the provision is considered to be limited to any person who actually exists, ... and that personal rights are the personal nature of the moral rights (<http://www.japaneselawtranslation.go.jp/kwic/?re=01>) which would lapse by his/her death, excluding such cases that are covered by the specific provision of Article 60 of the Copyright Act. Consequently, the term “another person” in the provision does not include the deceased even though the purpose of creating the provision is to protect personal rights. (Excerpts from the Decision by the Intellectual Property High Court, 2005 (Gyo Ke) No. 10336.)

## **B. Recent trends of court decisions**

The Examination Guidelines for Trademarks says that the expression “[the trademark] is likely to cause damage to public order or morality” of Article 4(1)(vii) of the Trademark Act includes “trademarks which are, irrespective their unobjectionable composition, liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality.” Recently, a court decided that when the application in question was severely inappropriate to society considering the process or purpose of filing the application, and deciding that the registration of the trademark would disrupt social order which the Trademark Act aims to protect, the application fell under Article 4(1)(vii) of the Trademark Act, even though the trademark in question per se did not contravene public policy. The court also mentioned that balancing the interests between persons and settling personal disputes was not a problem that the provision deals with. Especially, as another court decision made along this trend and from a public viewpoint, a court ruled that the application could disrupt the order of fair competition and contravene public policy because the applicant took advantage of the measures for public interest, hinders the execution of the measures, intended to monopolize the interest while knowing that the application would result in damaging public interest. (“Horohata” case, Decision by the Tokyo High Court, November 29, 1999 [1998 (Gyo Ke) No. 18].)

## **C. Specific application procedures**

### **a. Name of a historical person to be registered**

In this process, a historical person does not include a person who actually exists but includes a well-known or famous deceased person, including a non-Japanese person. Such “name of a historical person” could include a full-name (formal name), abbreviation, nick name, or professional name, any of which should be a famous name distinctive to a specific person.

### **b. Steps of examining the application**

In this approach, examiners do not analyze the applications which would be included in such cases as those mentioned in b. above but analyze the applications which would not fall under other provisions. The Examination Guidelines for Trademarks says that the trademark stipulated in Article 4(1)(vii) of the Trademark Act includes “trademarks which are, irrespective their unobjectionable composition, liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality.” For item 1. of this approach, examines should pay special attention to the purpose of the application for registering a trademark created after the name of a historical person, and comprehensively check backgrounds 1) through 6) to determine if Article 4(1)(vii) of the Trademark Act should be applied to the application.

For item 2. of this approach, after taking the step above, examines consider the trend of the recent court decisions, and especially when they analyze the “application for registering the trademark filed by the applicant who takes advantage of measures for public interest using

the name of a historical person, who hinders the measures from being executed, and who intends to monopolize the interest while knowing that the application would result in damaging the public interest,” they regard the application as one that may disrupt the order of fair competition and cause damage to the social and public interest, which results in falling under Article 4(1)(vii) of the Trademark Act.

### **1) Popularity of the well-known or famous historical person**

Examiners consider this background to analyze the name of a well-known or famous historical person, which is precious information based on which examiners determine the reputation, admiration, or attractiveness of the name of a historical person to the customers. Examiners also determine how much information on the historical person the applicant already knows, such as his/her reputation, or if the applicant has intended to take advantage of measures for public interest.

### **2) Acceptance of the name of the historical person among the nation or region**

Examiners consider this background to analyze the acceptance of the name of the historical person not by a single person but widely among the nation or region. When people in the nation or community related to the historical person know much about the person, they would feel that such person is a kind of common property, because the nation or community shares a certain background, to such an extent that people in the nation widely love and respect the historical person and that people in the home town or the areas related to the historical person feel familiarity with him/her, and hence, they would feel uncomfortable with or offended by the trademark registering the name. To deal with this concern, examiners should consider the image they conceive about the name of a historical person, which would be critical information based on which examiners analyze the application if the application contravenes public interest or the generally-accepted sense of morality. This information could be more specific after analyzing the availability of the name of the historical person, which is mentioned in the next section.

### **3) Availability of the name of the historical person**

Examiners should consider the availability of the name of a historical person to see if Article 4(1)(vii) of the Trademark Act is applicable to the application, such as the availability in such person's home town or related areas. This is critical information for analyzing the application, especially to determine the presence of measures for public interest. For example, this includes holding festivals or events, running museums or pavilions, or promoting sightseeing business by symbolizing the historical person, which are conducted by public organizations, such as local governments or chambers of commerce and industry, and also includes use of the name of the historical person by many local business operators as one of the measures for revitalizing the areas covered by these organizations.

#### **4) Relationship between the availability of the name of the historical person and the designated goods or services**

In the process of considering the relationship between the name of a historical person and its availability, the relationship between goods or services relating to the use of the name and the designated goods or services could also be critical information to analyze the application. For example, when the goods or services provided in the historical person's home town or related areas are identical or similar to the goods or services designated in the application, the availability of the name could be affected by the trademark right, which would have an impact on people using the name in these areas. It is also a concern that some persons may take advantage of the availability of the name relating to the goods or services for sightseers, such as souvenirs or special products in the areas. It is another problem that the extent of the uncomfortable or offended feeling with regard to registering the designated goods or services might vary among people in the nation or communities, depending on the details of the goods or services. For removing these concerns, this background could be critical information to determine if the application may harm the public interest, be one intended to monopolize the interest or disrupt the order of fair competition and cause damage to social and public interest.

#### **5) Circumstances, purpose, or reason of the application**

This background is also critical information for checking the circumstances or purpose of the application or if the application or registration may disrupt the order of fair competition, including the reason why the applicant selected the trademark in question, how the applicant currently uses the trademark in question, or the extent to which the trademark in question is known or famous among people.

#### **6) Relationship between the historical person and the applicant**

The relationship between the historical person, or a person related to the use of the trademark mentioned in 3), and the applicant is also essential information for determining the purpose or circumstances of the application or if the application may damage the social and public interest.

In this step, it is also important to comprehensively consider the period of time passed after the death of the historical person.

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

Examination Guidelines for Trademarks:

[Article 4\(1\)\(vii\) \(Contravention of Public Order or Morality\)](#)

**Excerpts from Court Decisions Concerning Article 4(1)(viii) of the Trademark Act**

**1. “Juventus”**<sup>Note</sup>

**(Decision by the Tokyo High Court, March 24, 1999 [1998 (Gyo Ke) No. 11])**

**The court ruled that the applicant was not entitled to register the trademark since he/she violated public policy as far as it was recognized that he/she exclusively used the reputation of the football team and intended to use the reputation illegally for gaining illegal interest or the like, even if the grounds of unregistrability is not applicable to this case.**

The court says that “[I]t should be understood that the applicant is not entitled to register the trademark according to Article 4(1)(vii). of the Trademark Act, as the applicant is irrelevant to the famous organization abroad and attempts to register the trademark taken after or similar to the name or abbreviation of the organization without having any permission from the organization, because such trademark may disrupt the order of business and be contrary to international good faith, as far as it is recognized that the applicant aims or illegally intends to exclusively use the reputation of the organization for gaining illegal interest, even if this application is not included in the cases covered by Article 4(1)(viii), (xv), etc. of the Trademark Act stipulating a trademark which is not entitled to be registered.”

**Note: “Juventus” is a professional football team in Italy.**

**2) “CARNEGIE SPECIAL”**

**(Decision by the Tokyo High Court, August 29, 2002 [2001 (Gyo Ke) No. 545])**

**The court ruled that the registered trademark as a whole was invalidated due to violation of public policy because it was recognized that the plaintiff had illegally intended to use the achievement of Dale Carnegie<sup>Note</sup> (1888 - 1955), famous writer, for his/her own business.**

The court says that “[I]t is acknowledged that the fame of Dale Carnegie as a writer and lecturer relies on his/her lectures and know-how, and courses for promoting human capability or fostering human resources which are named after his/her name were already well known in many countries, including Japan, at the time when the trademark in question was registered...., [I]t is easily recognized that when the trademark was decided to be registered, the plaintiff fully knew that the courses Dale Carnegie managed had a long history, were famous, and were admired by people and that, based on these facts, the plaintiff filed the application for the trademark, which was finally registered, with an intention to use the admiration for his/her main business, which is grounds showing that the plaintiff uses the trademark for an illegal

purpose . . . . As it was said, the plaintiff registered the trademark in question having an intention to use the fame of Dale Carnegie exclusively for his/her main business while being fully aware that the business which the defendant and the licensees manage around the world was highly admired by people and famous. As far as this is true, it should be considered that the trademark in question as a whole is invalidated due to its violation of public policy.”

**Note: Dale Carnegie was a writer and lecturer. His/her international best-selling book is “How to Win Friends and Influence People.”**

**3) “Anne of Green Gables”**

**(Decision by the Intellectual Property High Court, September 20, 2006 [2005 (Gyo Ke) No. 10349])**

**The court ruled that the trademark in question fell under the category of a “trademark likely to cause damage to the public policy,” which would undermine the value, fame or reputation of the Work itself or its author or protagonist.”**

The court says that “Article 4(1)(vii) of the Trademark Act stipulates a ‘[trademark] likely to cause damage to public policy or morality’ is not to be entitled to be registered. The expression ‘[trademark] likely to cause damage to public policy or morality’ includes trademarks: i. ‘which are letters or diagrams, in composition per se, outrageous, obscene, discriminative or unpleasant to people,’ ii. ‘which are, irrespective their unobjectionable composition, liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for designated goods or designated services,’ iii. whose ‘use is prohibited by other laws,’ iv. which are ‘liable to dishonor a specific country or its people or trademarks generally considered contrary to international good faith,’ and v. ‘whose background to the application lacks social appropriateness and whose registration is hardly acceptable due to its being contrary to public policy stipulated in the Trademark Act’ . . . .

By comprehensively considering the following facts, the trademark in question falls under the category of ‘trademark liable to contravene public policy’ prescribed in Article 4(1)(vii) of the Trademark Act, and is therefore ineligible for registration:

i. The trademark consists of the original title of a Work with worldwide fame and cultural value, and if it were used with respect to the goods designated in the trademark application, such use would undermine the value, fame or reputation of the Work itself or its author or leading characters;

ii. The Work is an important cultural heritage of Canada, and it has also been popular widely in Japan and played an important role in developing friendship between Japan and Canada;

iii. If Japan allows the trademark to be registered despite the possibility of undermining the value, fame or reputation of the Work itself, its author or protagonist, it would contravene international good faith between Canada and Japan, and the harm public interest of both countries;

- iv. Due consideration should be given to the fact that Canada prohibits private entities from using the mark consisting of the alphabetical characters ‘ANNE OF GREEN GABLES,’ which represent the original title of the Work, thereby protecting it as an official mark;
- v. In light of the Work’s strong power to attract consumers, it would be inappropriate to allow the plaintiff, which is a private company with no relation to the Work, to obtain a registration of the trademark that stands for the title of the Work and exclusively use the trademark; and
- vi. In the written agreement between the plaintiff and the party related to the plaintiff and the author’s heir, it is not deniable that the background to the application lacks social appropriateness.”

#### **4) “HYPER HOTEL”**

**(Decision by the Tokyo High Court, May 8, 2003 [2002 (Gyo Ke) No. 616])**

**The court ruled that adjusting the interests between persons, in principle, was not involved in Article 4(1)(vii) of the Trademark Act’s stipulation of observance of the public policy since trademarks per se which do not contravene public policy and are covered by Article 4(1)(vii) of the Trademark Act are limited to those which considerably lack social appropriateness in the circumstances of the application and whose registration is hardly acceptable due to their being contrary to public policy stipulated in the Trademark Act.”**

The court says that “[I]t is generally understood that when the application of the trademark contravenes the appropriate business moral and lacks social appropriateness, and also when registering the trademark is contrary to the purpose of the Trademark Act, the trademark could be deemed to be the trademark stipulated in Article 4(1)(vii) of the Trademark Act. However, trademarks per se which are not contrary to public policy and are covered by Article 4(1)(vii) of the Trademark Act are limited to those which considerably lack social appropriateness in the circumstances of the application and those whose registration is hardly acceptable due to their being contrary to public policy expected in the Trademark Act. Such conclusion is reached upon considering the following facts: that the expression of the provision “[a trademark] likely to cause damage to public policy” focuses on the character of the trademark per se; that Article 4(1)(i) - (xix) of the Trademark Act respectively stipulates the grounds of unregistrability of a trademark considered to be contrary to the purpose of the Trademark Act, and; that Japan adopts the first-to-file system under the Trademark Act, in which the application filed earliest among other applications is allowed to be registered, considering the freedom to choose the trademark ... Creating a rule for use of the trademark ‘HYPER HOTEL’ in question between the plaintiff and the group of the defendants is included in adjusting the interests between them. Such adjustment, in principle, is not involved in Article 4(1)(vii) of the Trademark Act stipulating observance of public policy.”

#### **5) “CONMER”**



**(Decision by the Intellectual Property High Court, June 26, 2008 [2007 (Gyo Ke) No. 10391])**

**The court ruled that it was not allowed to exclude the application of the trademark by expanding the interpretation of the provision “[a trademark] is likely to cause damage to public policy” of Article 4(1)(vii) of the Trademark Act to the private sphere unless there were any special circumstances and that an issue concerning ownership of the trademark right had to be dealt with as a personal matter between parties and it was not appropriate to understand that such issue was to be included in any special circumstances which “cause damage to public policy.”**

The court says that when examiners determine if the application of the trademark is entitled to be registered, considering the purpose of the Trademark Act system in Japan, which adopts the first-to-file system, and the purpose of Article 4(1)(xix) of the Trademark Act, which was created for harmonization with other countries, and excluding the application due to its illegal purpose, it should not be allowed to exclude the application by expanding the interpretation of the provision “[a trademark] is likely to cause damage to public policy” of Article 4(1)(vii) of the Trademark Act to the private sphere, being deviated from these purposes, unless there are any special circumstances, because this approach may seriously damage the predictability and legal stability of entitlement of the trademark registration. When examiners determine if the application involves any special circumstances, they should consider the relationship between the applicant and a person who insists on holding the right of the trademark, such as a legal party abroad which already uses a trademark abroad which is identical to the trademark in question. An issue concerning ownership of the trademark right between the applicant and the person who insists on holding the right of the trademark should be dealt with as a personal matter between the parties and it is not appropriate to deem that such issue should be included in exceptional cases with any special circumstances which “cause damage to public policy,” such as cases where a person who insists on holding the entitlement of the trademark fails to file the application even though he/she had an opportunity to file the application smoothly or where a person fails to take an appropriate measure against the application filed by other person through any contract, etc. even though he/she had an opportunity to take such measure.

**6) “Horohata”**

**(Decision by the Tokyo High Court, November 29, 1999 [1998 (Gyo Ke) No. 18])**

**The court ruled that the applicant who had filed the trademark in question took advantage of measures for public interest that people in the town took to promote the economy of the town, and intended to monopolize the interest of the name “Horohata” while knowing that the application would result in damaging the promotion of the economy.**

The court says that “the plaintiff takes advantage of measures for public interest based on the political purpose of the local government to promote the economy of the town, and he/she prevents the measures from being executed while knowing that the application would result in damaging public interest. It is undeniable that the plaintiff intends to monopolize the interest derived from the name “Horohata,” which is the core of the measure even though the plaintiff limits the registration to the designated goods. Consequently, the trademark in question may disrupt the order of fair competition and contravene public policy.”