

## 42.107.06

### **Examination approach for a trademark consisting of a family crest**

#### 1. Current situation surrounding family crests and examination approach

Family crests are symbols to distinguish family lineages in Japan. They are also called "Mondokoro" or "Mon" and have long been used as marks to represent family lineages, family lines, etc.<sup>1</sup>

Generally speaking, family crests are not registered and managed by any special entity such as a public institution, etc. Consequently, there are no legal restrictions on the use of family crests. Any person can use family crests in his or her own way. It is a common practice for companies to manufacture and sell goods bearing family crests. In some cases, a family crest affixed to goods or services does not function as an identifier to distinguish one's goods or services from others.

On the other hand, some family crests that have been traditionally used in Japan have become well known and famous because they were used as the family crests of historical figures featured in samurai dramas or other historical dramas or they were used in regional festivals or events. As a result, many family crests came to have certain economic value.

Under these circumstances, the examination approach for family crests is as follows.

These days, family crests are sometimes used as traditional family crests (marks to represent family lineages; hereinafter the same), which are affixed to kimonos and hakama worn in ceremonial occasions or affixed to Buddhist altars, Boys' May Festival dolls (Japanese traditional seasonal dolls), ornaments shaped like Japanese traditional helmets, carp streamers, store curtains or signs, etc. Family crests are also sometimes used as a decoration or design affixed to stickers, mugs, T-shirts, etc. In some cases, for some designated goods or services, family crests cannot be considered to function as an identifier to distinguish one's goods from others.

In many cases, family crests are used as marks that represent national agencies, local governments, religious institutions, etc. and have become famous. In these cases, such

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<sup>1</sup> "In Japan, family crests started when aristocrats affixed crests to their carts and palanquins during the mid-Heian era. Since then, family crests became popular. Consequently, samurai families also started using crests and affixed them to their flags, weapons, curtains, etc. As a result, the number of designs of family crests increased. There was a trend among samurai families to adopt the crest of a famous family by saying that they are descendants of that family. In some cases, a family uses more than 10 crests including an official crest, an unofficial crest, a traditional crest, and an alternative crest" ("Encyclopedia My Pedia, electronic dictionary, 2013" Hitachi Solutions Business)

family crests should not be registered by any third parties from the perspective of respecting the authorities and reputation of the public-interest organizations and protecting the public interests, in other words, preventing consumers from misunderstanding that the source of goods is such public-interest organization.

Furthermore, in recent years, it is common that some historical figures are featured in samurai dramas or other historical dramas on TV or films and become popular. Local governments often take advantage of the popularity of those figures and use their customer appeal to hold various events such as festivals or regional revitalization activities on the sites related to those figures. In some of those events, etc., the use of the family crest of the historical figure makes the family crest itself well known and famous, giving certain economic value to the crest. Under these circumstances, the trademark registration of the crest and elusive use of the crest by a third party who has no interest in the family crest would be unreasonable because it is against public interest and social morals.

## 2. Specific examination policy

On these grounds, a trademark consisting of a family crest should be examined as follows.

### (1) Family crests subject to this examination approach

Currently, the number of family crests is said to be more than 10,000 or 20,000. Due to the lack of legal restrictions, etc. against the alteration of existing family crests or the creation of new family crests, the number of new family crests is increasing in practice. Therefore, it is not practical to consider that all family crests should be subject to this examination approach. Some so-called modern family crests, which were created in recent years, can be considered be intrinsically capable of distinguishing one's goods from others.

Thus, the range of family crests subject to this examination approach should be limited to traditional family crests (the family crests of samurai family lineages in the age of provincial wars, the crests of shrines, temples, sects, etc.<sup>2</sup>).

### (2) Applicable provisions

[i] Article 4, paragraph (1), item (vi) of the Trademark Act

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<sup>2</sup> While the crests of shrines, temples, and sects are usually defined differently from family crests, they are treated as a type of family crests that is covered by this examination approach.

If the trademark claimed in an application consists of a crest of a shrine, temple, or sect, or a mark representing a nonprofit public-interest organization such as a school emblem, or a mark that is identical or similar to a famous family crest used for the purpose of protecting a cultural asset or carrying out any other public-interest project, such trademark should be considered to fall under Article 4, paragraph (1), item (vi) of the Trademark Act.

[ii] Article 4, paragraph (1), item (vii) of the Trademark Act

In the case of a well-known or famous family crest, it can be used by a public-interest organization such as a local government using it as a local symbol mark to conduct regional revitalization activities or to promote tourism in the hometown of the relevant family or the historical figure from that family or any other relevant site. For this reason, a well-known or famous family crest might have a strong customer appeal in that particular region. In this case, the trademark registration of such family crest by a third party who has nothing to do with the crest would offend the local residents and trigger a protest from them, which might prevent smooth completion of a project such as regional revitalization activities.

Some family crests have long been exclusively reserved for a particular family or shrine, etc. as their symbols because the use of those crests by any other family lineages have been strictly prohibited. This tradition is widely known in some cases. In this case, if a third party who has nothing to do with the family crest is permitted to register the crest as a trademark, it would allow the third party to free-ride the famousness and customer appeal of the particular family, etc. represented by the family crest.

In particular, it would be against fair business practices and public interests if any person plans to wrongfully exploit a public-interest project that uses a well-known or famous family crest and files a trademark application to register the family crest for the purpose of monopolizing the profits despite the awareness that the trademark registration of the family crest would interfere with the smooth completion of the project and damage the public interests or if any third party files a trademark application to register a famous family crest representing a particular family or in any other case where the trademark application filing process or the reasons for choosing a particular crest as a trademark can be considered to be extremely inappropriate in terms of social validity.

Thus, in the case mentioned above, the family crest should be considered to fall under Article 4, paragraph (1), item (vii) of the Trademark Act.

The aforementioned determination should be made based on a comprehensive evaluation of the level of well-knownness and famousness of the family crest or the name

of the famous figure related to the family crest, the level of public recognition of the family crest or the name of the famous figure related to the family crest in Japan or in the relevant region, the process, purpose, reasons for the filing of the application, and the relationship of the applicant with the family crest or the famous figure related to the family crest. In this case, even if the details such as the use of the family crest are unclear, such data as the use of the name of the famous figure related to the family crest could be used as information about the use of the family crest in some cases.

[iii] Article 4, paragraph (1), item (x) of the Trademark Act

In the case where the trademark claimed in an application consists of a family crest, if the trademark is similar or identical to a family crest that is widely known among consumers as an indication of goods, etc. pertaining to the business of another person, said trademark should be considered to fall under Article 4, paragraph (1), item (x) of the Trademark Act as long as the designated goods, etc. of said trademark are identical or similar to another person's goods, etc.

[iv] Article 4, paragraph (1), item (xv) of the Trademark Act

In the case where the trademark claimed in an application consists of a family crest, if the applicant's use of the trademark is considered to be likely to cause confusion about the source of goods, etc. for some reasons such as the well-knownness of said trademark among consumers as an indication of the goods, etc. pertaining to the business of another person, said trademark should be considered to fall under Article 4, paragraph (1), item (xv) of the Trademark Act.

[v] Article 4, paragraph (1), item (xix) of the Trademark Act

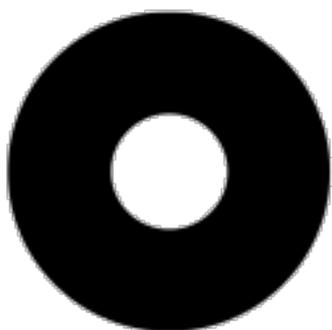
In the case where the trademark claimed in an application consists of a family crest, if the trademark is similar or identical to a family crest that is widely known among consumers as an indication of goods, etc. pertaining to the business of another person, said trademark should be considered to fall under Article 4, paragraph (1), item (xix) of the Trademark Act as long as said trademark is considered to be used for unfair purposes.

[vi] Article 3, paragraph (1), item (v) of the Trademark Act

In the case where the trademark claimed in an application consists of a family crest, if the trademark is considered to be an extremely simple, commonplace mark consisting of a plain figure such as "○" or "×" as shown below, said trademark should be considered to fall under Article 3, paragraph (1), item (v) of the Trademark Act.



Examples that fall under this provision



Crest of "Eye of the Snake" of Kiyomasa Kato      Crest of "Sujikai" of Nagahide Niwa

[vii] Article 3, paragraph (1), item (vi) of the Trademark Act

Family crests are sometimes affixed to goods such as "kimonos and hakama," "Boys' May Festival dolls," "ornaments shaped like Japanese traditional helmets," "carp streamers," and "Buddhist altars" not as source identifiers but as traditional family crests. Family crests are also sometimes affixed to goods, etc. such as "stickers," "mugs," "T-shirts," etc. as a decoration or design. Thus, in many cases, consumers who come across these goods, etc. bearing a family crest would merely recognize those goods as bearing a family crest or a decoration or design created based on a family crest as a mark of family lineage and would not recognize the family crest, etc. as an identifier to distinguish one's goods from others.

Therefore, in the case where the trademark claimed in an application consists of a family crest, if the trademark is merely recognized as a traditional family crest when it is affixed to the designated goods or services or as a family crest used as a decoration or design, the trademark should be considered to fall under Article 3, paragraph (1), item (vi) of the Trademark Act.

The aforementioned determination should be made based on a comprehensive evaluation of various factors such as the level of public recognition of the family crest and transactional practices for the designated goods, etc.

(Note) Please click the following links to see the Trademark Examination Guidelines.

- Trademark Examination Guidelines for Article 3, paragraph (1), item (v) (Very simple and common marks)
- Trademark Examination Guidelines for Article 3, paragraph (1), item (vi) (Trademarks lacking distinctiveness in addition to those mentioned in each of the preceding items)

- Trademark Examination Guidelines for Article 4, paragraph (1), item (vi) (Famous mark indicating a state or a local government)
- Trademark Examination Guidelines for Article 4, paragraph (1), item (vii) (Contravention of public order or morality)
- Trademark Examination Guidelines for Article 4, paragraph (1), item (x) (Well-known trademark of another person)
- Trademark Examination Guidelines for Article 4, paragraph (1), item (xv) (Confusion over the source of goods and services)
- Trademark Examination Guidelines for Article 4, paragraph (1), item (xix) (Trademark identical with or similar to another person's well-known trademark which is used by the applicant for an unfair intention)