

42.107.07**Examination approach for a trademark consisting of a famous painting**

1. Current situation surrounding famous paintings and basic examination approach

Famous paintings, etc. have high cultural value. Those paintings, etc., which were created by well-known painters and are highly valuable as works of art, have strong customer appeal. If a trademark consisting of a famous painting is registered by a third party who has nothing to do with the painting, etc., it would permit the third party to free-ride the reputation and customer appeal of the famous painting, etc. and would objectively be found to be inappropriate because it is against the legal objective of maintaining fair business practices for goods and services.

Many famous paintings, etc. are used by various companies as designs or decorations of goods (e.g., "mugs," "clothes," "smartphone cases," etc.), product packages, or the articles to be used for the provision of the services (e.g., "wrapping paper," "paper bags," etc.).

Thus, in many cases, people who come across those goods, etc. for which famous paintings, etc. are used would merely recognize them as a type of design or decoration of the goods, etc. and would not immediately recognize those paintings, etc. as identifiers of the source of goods, etc. In this case, a trademark consisting of a famous painting, etc. cannot be considered to function as an identifier to distinguish one's goods from others.

2. Specific examination policy

On these grounds, a trademark consisting of a famous painting, etc. should be examined as follows.

(1) "Famous paintings, etc." subject to this examination approach

(A) Paintings, etc.

"Paintings, etc." subject to this examination approach means paintings and illustrations.¹

"Paintings" means "Two-dimensional drawings of the shapes of objects. In particular,

¹ "Paintings, etc." subject to this examination approach do not include the human characters and mascot characters themselves of animation programs, comics, games, etc., but include the paintings or illustrations created by drawing these characters, etc. as objects.

pictures and drawings as works of art" (Kojien, sixth edition). For example, it can be said that consumers could recognize that the paintings subject to this examination approach include fresco paintings, oil paintings, mosaic works, stained-glass works, water-color paintings, sketches, block prints, ink-wash paintings, collage works, etc.²

"Illustrations" means "artworks, graphic explanations. In particular, exaggerated or distorted pictures that are fun to see" (Kojien, sixth edition). For example, "Illustrations" includes artworks used in picture books and children's books to illustrate scenes, etc.

Trademarks consisting of paintings, etc. would include a trademark that does not consist of a painting, etc. itself, but consists of a part of the main portion of a painting, etc.

(B) Famousness

A determination as to whether a painting, etc. is famous or not should be made based on a careful consideration of the reputation, fame, etc. of the work and the creator and whether the work is widely recognized among consumers as a famous painting, etc. This determination would not be affected by whether the creator of the famous painting, etc. is still alive or not.

A determination as to whether a painting, etc. is famous or not should be made based on a comprehensive evaluation of the following factors:³

- [i] Whether the painting, etc. is presented in a book, etc.;
- [ii] Whether the painting, etc. is displayed in an exhibition in a museum, etc.;
- [iii] Whether the painting, etc. is included in a published art book;
- [vi] Whether the painting, etc. is widely known through TV programs, the Internet, etc.;
- [v] Whether the creator of the painting, etc. is well known or famous.

(2) Applicable provisions

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

If the structure of the trademark claimed in an application can be immediately

² Paintings "... (omitted) ... are categorized depending on the means and technique of expression such as fresco, fresco secco, tempera, oil painting, mosaic, stained glass, water color, sketch, block print, collage, and bark painting" (Britannica World Encyclopaedia)

³ In the case of a painting, etc. in which a human character, mascot character, etc. in an animation program, comic, game, etc. is drawn as an object, it should be noted that it is not the famousness of the character, etc. but the famousness of the painting, etc. in which the character, etc. is drawn that should be evaluated.

associated with a famous painting, etc., the trademark cannot be considered to be a mark that is accidentally identical with the famous painting, etc. The trademark can be presumed to have been created by imitating or copying the famous painting, etc. and claimed in a trademark application. If a trademark consisting of a famous painting is registered by a third party who has nothing to do with the painting, etc., it would permit the third party to free-ride the reputation and customer appeal of the famous painting, etc. and would objectively be found to be inappropriate because it is against the principle of maintaining fair business practices for goods and services.

If the fame, reputation, etc. of a famous painting, etc. must be protected and maintained under the principle of international good faith or if the trademark registration of a famous painting, etc. would offend people in Japan or in a regional area and would go against public interests and public morals, a trademark registration made by a person who has nothing to do with the painting, etc. can be considered to be likely to disturb public order or good morals and can be found to fall under Article 4, paragraph (1), item (vii) of the Trademark Act.

The aforementioned determination would not be affected by whether a copyright for the painting, etc. has expired or not.

[ii] Article 4, paragraph (1), items (x), (xv), and (xix) of the Trademark Act

In the case of a trademark consisting of a painting, etc. that has been used for goods or services and has become a well-known or famous mark, the applicability of Article 4, paragraph (1), items (x), (xv), or (xix) of the Trademark Act need to be examined.

The applicability of these provisions should be determined in consideration of various factors such as whether the famous painting, etc. in dispute is used in actual commercial transactions, whether there is a copyright owner or reproduction licensor of the famous painting, etc. or a management organization, etc., in charge of protecting the famous painting, etc., whether any confusion could be caused with any goods or services pertaining to the business of any of those entities, and whether the trademark claimed in an application will be used for unfair purposes.

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

If the trademark claimed in an application merely indicates the content of goods, etc., said trademark should be considered to fall under Article 3, paragraph (1), item (iii) of the Trademark Act.

For example, if the trademark claimed in an application that consist of a famous painting can be found to be associated with the content of goods, etc., when said trademark is used for the designated goods or services (Class 16 "Paintings" and Class 41

"Exhibition of paintings"), said trademark should be considered to indicate the quality of the goods or services.

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

Since famous paintings, etc. are used by many companies as designs or decorations of goods, etc. (e.g., "mugs," "clothes," and "smartphone cases"), any consumers who come across famous paintings, etc. affixed to goods, etc. might merely recognize them as a type of design or decoration selected to enhance the beauty and attractiveness of the goods, etc. and might not recognize those paintings as identifiers to distinguish one's goods from others.

Therefore, in the case where the trademark claimed in an application consists solely of a famous painting, etc., if the trademark is not recognized as a source identifier but is recognized as a type of design or decoration when it is used for the designated goods or services, said trademark should be found to fall under "a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person" (Article 3, paragraph (1), item (vi) of the Trademark Act).

Even in the case of a trademark that falls under [iii] or [iv], if it is a composite trademark consisting of a combination of a painting, etc. and distinctive characters or figures and can be considered to be distinctive as a whole, the aforementioned approach would not apply. Also, the aforementioned approach would not apply to the case where, as a result of use of a painting, etc. for goods, etc., consumers have come to recognize it as the source identifier of the goods, etc.

(Note)

- Trademark Examination Guidelines for Article 3, paragraph (1), item (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)
- 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 (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)