

42.108.03**Specific Treatment of the Examination of "Requirements Provided by Cabinet Order" in Article 4(1)(viii) of the Trademark Act**

Under Article 4(1)(viii), the "requirements specified by Cabinet Order" (hereinafter referred to as "Cabinet Order requirements") in the Order for Enforcement of the Trademark Act fall under both items that "there is a reasonable relationship between the name of another person contained in the trademark and the applicant for the trademark registration" and "the applicant does not seek to register a trademark for unfair purposes," and the specific treatment in the judgment is as follows.

Furthermore, in examining whether Cabinet Order requirements are met, in addition to an ex officio research, the applicant shall not be precluded from stating in the "[Other]" column of the application form that Cabinet Order requirements are met, or from stating to that effect in a petition.

1. Regarding the expression "reasonable relationship"

In determining "reasonable relationship," consideration is given to the degree of connection between the name contained in the trademark applied for and the applicant, or the applicant's business, in light of the fact that the name will be used as a trademark after registration. Cases of "reasonable relationship" include, for example, the following, in addition to the cases listed in the Examination Guidelines for Trademarks, Part III, Chapter 7: Article 4(1)(viii)8. (1). Even if the trademark including the name is not used at the time of filing the application, if there are any circumstances that would be considered equivalent to use of the trademark, such as the applicant making reasonable preparations for use, this may be taken into account.

"Reasonable relationship" requires a relationship with the "name of another person" as a character in the composition of the trademark, not a relationship with an actual other person with the "name cited" in the notification of reasons for refusal, etc. Therefore, a "reasonable relationship" is not immediately recognized by the fact that the consent of another person has been obtained. However, if there is a fact that the consent of all relevant other persons has been obtained, the risk of harming the moral interests of the other persons is considered to be low, and this is taken into account as a factor in determining whether there is a "reasonable relationship."

In cases where the use and intended use are not clear, or there is doubt about this matter, additional materials, etc., may be requested as necessary.

(1) Examples of cases considered to have a "reasonable relationship"

- (i) If the name of another person contained in the trademark is a pseudonym,

professional name, or pen name of the applicant

- (ii) As to the name of another person contained in the trademark, if a professional name created by the applicant, which is an entertainment agency, is used by a person who has a business relationship with the applicant
- (iii) As to the name of another person contained in the trademark, if the applicant has a license agreement with the other person to manufacture and sell goods using the name
- (iv) As to the name of another person contained in the trademark, if there is a fact that the applicant uses the name as a character name to indicate the origin of the goods or services pertaining to the applicant's business

(2) Examples of cases not considered to have a "reasonable relationship"

- (i) If it is clear that the name of another person contained in the trademark is merely an idea of the applicant
- (ii) If it is clear that the name of another person contained in the trademark is the name of an acquaintance of the applicant, etc., and is merely a private relationship

2. Regarding the expression "unfair purposes"

A case is determined as containing "unfair purposes" if, for example, as a result of an ex officio research, the purpose to harass another person or to induce others to preemptively purchase a trademark is recognized from publicly available information or materials obtained by providing information, etc.

Furthermore, if the other person's consent has been obtained, it shall be presumed that there are no "unfair purposes."

References

Order for Enforcement of the Trademark Act (Cabinet Order No. 19 of March 8, 1960)
(Requirements provided by Cabinet Order)

Article 1 The requirements specified by Cabinet Order under Article 4, paragraph (1), item (viii) of the Trademark Act shall fall under both of the following items;

- (i) there is a reasonable relationship between the name of another person contained in the trademark and the applicant for the trademark registration,
- (ii) the applicant for the trademark registration does not seek to register a trademark for unfair purposes.

References

[Examination Guidelines for Trademarks:](#)

Article 4(1)(viii) (Name of another person)