

Appeal decision

Appeal No. 2018-7529

Appellant KIKUCHI, Ken

Attorney TAKAMATSU, Kaoru

The case of appeal against the examiner's decision of refusal of Trademark Application No. 2017-69467 has resulted in the following appeal decision:

Conclusion

The appeal of the case was groundless.

Reason

1 The trademark in the Application

The trademark in the Application is configured as indicated in Attachment, and the application for its registration was filed on May 23, 2017 by setting as designated goods Class 14 "Figurines of precious metal; key rings; personal ornaments, other than cuff links; pendants; bangles; rings [trinket]; brooches [jewelry]; necklaces [jewelry]; chains [jewelry]; bracelets [jewelry]; pierced earrings; belt ornaments of precious metal; cuff links; personal ornaments agraffe; clocks and watches; charms for jewelry.", Class 18 "Handbag frames; purse frames; horseshoes; bags; pouches; wallets; card cases [notecases]; belts for bags; vanity cases, not fitted; umbrellas and their parts; walking sticks; canes; metal parts of canes and walking-sticks; handles of canes and walking-sticks; leather straps.", and Class 25 "Clothing for men, women, and children; cuffs; garters; sock suspenders; suspenders [braces]; waistbands; belts [clothing]; footwear [other than special footwear for sports].".

2 Gist of reasons for refusal stated in the examiner's decision

The trademark in the Application includes characters of "KEN KIKUCHI" in its configuration. However, the characters are acknowledged as the name of another person who lives at the following address (Note for appeal decision: although a large number people whose name is "菊池 健 (Ken Kikuchi)" and the addresses of the people are described as noted, the description is omitted) written in Alphabetic characters, and it is not acknowledged that the other person has given consent.

Therefore, the trademark in the Application falls under Article 4(1)(viii) of the Trademark Act.

3 Judgment by the body

(1) The object of Article 4(1)(viii) of the Trademark Act

The object of Article 4(1)(viii) of the Trademark Act, which provides that a trademark that contains the portrait of another person, or the name, or famous abbreviated names, etc. of another person cannot be registered without an approval from the person concerned, is to protect the moral interests concerning the portrait, name, etc. of a person (including corporations; the same applies hereinafter) or to protect the person's interest that the person's name, etc. will not be used in a trademark without the person's approval (the determination 2003 (Gyo-Hi) 265 on June 8, 2004 by third petty bench of Supreme Court, the determination 2004 (Gyo-Hi) 343 on July 22, 2005 by second petty bench of Supreme Court). Therefore, it is considered that registering another person's name as a trademark without an approval from said person would cause damage to the moral interests of the person who has said name (the determination 2016 (Gyo-Ke) 10065 on August 10, 2016 by Intellectual Property High Court).

(2) Applicability of Article 4(1)(viii) of the Trademark Act

As indicated in Attachment, the trademark in the Application consists of outlined Alphabetic characters of "KENKIKUCHI" in a figure of a black silhouette of a spread eagle or hawk.

The character portion of "KENKIKUCHI" does not have a space, indicating a separation, in the middle. However, a line of the head character "K" extending obliquely downward to the right side extends along the lower portion of the second and third characters "EN", and on the other hand, the horizontal line extending from the end of the final character "I" extends along the lower portion of the fourth to ninth characters "KIKUCH". Therefore, the character portion has an appearance such that the character portion of "KEN" and the character portion of "KIKUCHI" are understood and recognized as being visually divided. The character portion of "KEN" in the first half gives rise to the pronunciation of "ケン (Ken)", and the character portion of "KIKUCHI" in the latter half gives rise to the pronunciation of "キクチ (Kikuchi)". The entire character portion gives rise to the pronunciation of "ケン・キクチ (Ken Kikuchi)".

Incidentally, in Japan, there are many cases where a name is written in Alphabetic characters; for example, the name of the same person is written in Alphabetic characters in passports, credit cards, or the like. In addition, in a case

where the name is written in English, "first name" and "family name" are typically written in this order, and there are many cases where "first name" and "family name" are written in this order on credit cards or the like. It can be said that "first name" and "family name" are written in this order in society in general in a case where the name is written in Alphabetic characters.

Then, it is reasonable to determine that traders and consumers coming into contact with the trademark in the Application that has the above configuration easily recognize that, in the character portion of "KENKIKUCHI" in the configuration, the name read as "キクチ (Kikuchi) (family name) ケン (Ken) (first name)" is written in the order of "first name" and "family name".

Then, in consideration of the persons having the name "菊池 健 (Kikuchi Ken)" read as "キクチ・ケン (Kikuchi Ken)" being written in "Hello Page (NTT white pages)" of each region at least as indicated by A to I below as described in the original examination, it can be estimated and recognized that all of these persons have existed from the time of the application of the trademark in the Application and up to the present.

A "菊池 健 (Kikuchi Ken)" who lives in Otaru City in Hokkaido is listed in then December 2016 edition (information as of August 24, 2016 is posted) and the December 2018 edition (information as of August 16, 2018 is posted) of "Hello Page (Otaru City edition)".

B "菊池 健 (Kikuchi Ken)" who lives in Rumoi City in Hokkaido is listed in the May 2016 edition (information as of January 28, 2016 is posted) and the May 2018 edition (information as of January 23, 2018 is posted) of "Hello Page (Rumoi region edition)".

C "菊池 健 (Kikuchi Ken)" who lives in Yurihonjo City in Akita is listed in the September 2016 edition (information as of June 13, 2016 is posted) and the September 2018 edition (information as of June 11, 2018 is posted) of "Hello Page (Akita, Yurihonjo, and Nikaho region edition)".

D "菊池 健 (Kikuchi Ken)" who lives in Rokkasho village, Kamikita district in Aomori is listed in the June 2016 edition (information as of March 10, 2016 is posted) and the June 2018 edition (information as of March 8, 2018 is posted) of "Hello Page (Aomori, Aomori, Sotogahama, and Noheji region edition)".

E "菊池 健 (Kikuchi Ken)" who lives in Owani town, Minamitsugaru district in Aomori is listed in the June 2016 edition (information as of March 10, 2016 is posted) and the June 2018 edition (information as of March 8, 2018 is posted) of "Hello Page (Aomori, Hirosaki, and Kuroishi region edition)".

F "菊池 健 (Kikuchi Ken)" who lives in Kamaishi City in Iwate is listed in the January 2016 edition (information as of October 8, 2015 is posted) and the January 2019 edition (information as of October 10, 2018 is posted) of "Hello Page (Iwate, Kamaishi, and Tono region edition)".

G "菊池 健 (Kikuchi Ken)" who lives in Matsushima town, Miyagi district in Miyagi is listed in the October 2016 edition (information as of July 7, 2016 is posted) and the October 2018 edition (information as of July 9, 2018 is posted) of "Hello Page (Miyagi, center (Shiogama, Tagajo, Tomiya, Kurokawa district, and Miyagi district) edition)".

H "菊池 健 (Kikuchi Ken)" who lives in Uwajima City in Ehime is listed in the July 2016 edition (information as of April 1, 2016 is posted) and the July 2018 edition (information as of April 2, 2018 is posted) of "Hello Page (Ehime, Uwajima, and Kitauwa region edition)".

I "菊池 健 (Kikuchi Ken)" who lives in Yawatahama City in Ehime is listed in the July 2016 edition (information as of April 1, 2016 is posted) and the July 2018 edition (information as of April 2, 2018 is posted) of "Hello Page (Ehime, Hassei region edition)".

In addition, it is acknowledged that the Appellant and the above persons are different from each other. Therefore, it should be said that the trademark in the Application includes another person's name in the configuration, and at least, it is not acknowledged that the trademark in the application is approved by the other person.

Accordingly, the trademark in the Application falls under Article 4(1)(viii) of the Trademark Act.

(3) Appellant's allegation

The Appellant alleges that (A) the family name and the first name cannot be distinguished from each other because the Alphabetic characters of "KENKIKUCHI" in the trademark in the Application do not have a space between the family name and the first name, and since consumers coming into contact with the Alphabetic characters of "KENKIKUCHI" in the configuration of the trademark in the Application recall the designer "菊池健 (Kikuchi Ken)" and his products, the characters have a meaning as a kind of a coined word, and accordingly, it cannot be said that the Alphabetic characters of "KENKIKUCHI" do not describe the "name", (B) since whether or not to fall under the "name" in Article 4(1)(viii) of the Trademark Act should be comprehensively determined from the viewpoint of whether or not the description is sufficient for making a specific person be recognized or whether or not the trademark in the Application has certain publicity as a brand, even if the Alphabetic characters of "KENKIKUCHI" in the

configuration of the trademark in the Application are understood as a name, whether or not "KENKIKUCHI" is "菊地 健 (Kikuchi Ken)" or "菊池 健(Kikuchi Ken)" cannot be specified and the identity of the specific person cannot be recognized, and accordingly, the Alphabetic characters do not fall under the "name", and it is excessive that a third party having no connection with the trademark or the product or a nameless third party be protected by Article 4(1)(viii) of the Trademark Act, and (C) the trademark in the Application should be handled as in the examination and appeal decision examples, and mentions that the trademark in the Application does not fall under Article 4(1)(viii) of the Trademark Act.

However, regarding (A), as described in (2) above, it is reasonable to determine that traders and consumers coming into contact with the trademark in the Application easily recognize that, in the character portion of "KENKIKUCHI" in the configuration, the name read as "キクチ・ケン (Kikuchi Ken)" is written in Alphabetic characters and in the order of "first name" and "family name".

Regarding (B), the name is written in Alphabetic characters in the order of "first name" and "family name" in society in general in Japan. Even if there are a plurality of kinds of Chinese characters or the like corresponding to the Alphabetic characters of the name, in a case where the names that are read in the same way are written in Alphabetic characters, the names should be written by using the same Alphabetic characters. Unlike pseudonyms, stage names, or pen names, there is no space to arbitrarily select the characters. Moreover, the Alphabetic characters of the name are related to a name of a specific person, and a person coming in to contact with the Alphabetic characters recognizes a person who has the name read in the same way. Furthermore, the person who has the name read in the same way recognizes the Alphabetic characters as the person's own name. Then, even if the name is written in Alphabetic characters, when another person chooses and uses the name as the trademark, it should be said that the choice and the use violate the personal benefit of the person having the name written in Alphabetic characters. According to the object of Article 4(1)(viii) of the Trademark Act, which is the protection of the personal benefit, it should be said that the name written in Alphabetic characters falls under the "name" in the same Article.

Then, regarding the trademark in the Application, as described in (2) above, it is reasonable to determine that traders and consumers coming into contact with the trademark in the Application easily recognize that, in the character portion of "KENKIKUCHI" in the configuration, the name read as "キクチ・ケン (Kikuchi Ken)" is written in the order of "first name" and "family name" in Alphabetic characters.

In addition, it is acknowledged that the Appellant and the above person are different from each other. Therefore, it should be said that the trademark in the Application includes another person's name in its configuration, and at least, it is not acknowledged that the trademark in the Application is approved by the other person.

Note that, according to that it is determined that "a trademark containing the name of another person cannot be registered as a trademark, except those the registration of which has been approved by the person concerned, and there is no need to consider matters such as whether or not the applicant's business and the other person's business are in competition, or which of the applicant's trademark and the other person's trademark is more famous or well-known." (determination 2008 (Gyo-Ke) 10309 on February 26, 2009 by Intellectual Property High Court), and it should be interpreted that it is not necessary to consider the publicity of the trademark in the Application and the relation with the designated goods in the determination on the applicability of Article 4(1)(viii) of the Trademark Act.

Regarding (C), the examination and appeal decision examples indicated by the Appellant have a different form of the trademark and are related to cases different from this case, and a specific case should be determined without being bound by the determinations made in the past. Therefore, the above examples do not affect the determination.

Therefore, the Appellant's allegations cannot be accepted.

(4) Closing

As described above, the trademark in the Application is a trademark including another person's name in its configuration, and it is not acknowledged that the trademark in the Application is approved by the other person. Therefore, the trademark in the Application falls under Article 4(1)(viii) of the Trademark Act and cannot be registered.

Therefore, the appeal decision shall be made as described in the conclusion.

January 30, 2019

Chief administrative judge: HAYAKAWA, Fumihiro
Administrative judge: TAMURA, Masaaki
Administrative judge: SYOJI, Miwa

Attachment (the trademark in the Application)



省略 omitted