

Part 8: Article 4(1)(x) (Well-Known Trademark of Another Person)

is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

1. “Trademark which is well known among consumers” as prescribed in this paragraph includes not only a trademark which is widely recognized among end consumers but also a trademark which is widely recognized among traders in the industry and also includes not only a trademark which is known throughout the country but also a trademark which is widely recognized in a certain area.

2. A trademark to be cited for the application of the provision of this paragraph needs to be widely recognized among domestic consumers in Japan at a time when an application for the registration of a trademark is filed (refer to Article 4(3)).

3. To prove a trademark’s being well known under the provision of this paragraph, the provisions of Items 3(1) and (2) of Chapter II (Article 3(2)) of the Guidelines apply *mutatis mutandis*.

4. A combination of another person’s unregistered trademark “well known among consumers” and characters or diagrams are, in principle, considered “similar” to the unregistered trademark including those trademarks which the description of the composition of appearance is well united or conceptually related.

However, cases when portions of the unregistered trademark constitute part of an established word or when it is clear that the unregistered trademark is considerably different in appearance sound or concept, then the unregistered trademark will be excluded.

(Examples) Examples are the same as in Item 5(6), Part 9 (Article 4(1)(xi)), Chapter III of the Guidelines.

5. Concerning a trademark related to goods or services special in the manner of their transaction or provision (for example, goods such as medicines and drugs for medical use which are distributed in a specific market, or services to test and examine medicines or to research medicines which are provided only in a limited market), full consideration needs to be given to, in particular, the actual state of transaction of the goods concerned or the provision of the services concerned with

respect to the above 3 proving method and the recognition based thereon of a trademark's being well known.

6. In judging whether a foreign trademark is well known in Japan, full consideration needs to be given to, if submitted, materials showing that the trademark concerned is well known in a foreign country and goods on which the trademark is used are exported to several countries or services bearing the trademark are rendered in several countries.

7. In judging whether trademarks registered as defensive trademarks or those trademarks which the trial decision or the court decision prescribes to be well known among consumers (Note 1), it shall be assumed from the registration or the approval that the trademark is well known among consumers.

(Note 1) Trademarks may be searched through the Internet under "Japanese well-known trademarks" in the Industrial Property Digital Library provided by the Patent Office.

(Reference) For further details related to the "trademarks well known among consumers," refer to the Trademark Examination Manual.