

Part 9: Article 4(1) (xi) (Another Person's Registered Trademark Applied for Prior to the Filing Date of the Trademark Application Concerned)

is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (refers to goods or services designated in accordance with Article 6 (1) (including cases where it is applied mutatis mutandis pursuant to Article 68 (1)), hereinafter the same), or goods or services similar thereto;

1. In judging the similarity of a trademark, decisive elements of the trademark, including its appearance, sound and concept need to be comprehensively taken into consideration.

2. A judgment on the similarity of a trademark needs to, with consideration given to a class of main users (for example, professionals, senior people, children, women, etc.) of goods or services on which the trademark is used, be made based on attentiveness usually possessed by the user, with consideration given to the state of transaction of the goods or the provision of the services.

3. Cases where the applicant submits a written explanation and evidence describing the trade condition by the trademark owner whose registered trademark has been cited in the reason for refusal contained in this paragraph shall be handled as follows.

(1) During examination with respect to this paragraph, the explanation and evidence submitted by the applicant will be taken into consideration as part of the information to help grasp the actual state of transaction activity.

However the following cases will be excluded;

(i) Where the trademark in the application is identical or obviously similar (Note1) to the cited trademark, and the designated goods or designated services in the application are identical or obviously similar (Note2) to those of the cited trademark;

(ii) Where the submitted documents describe not an objective explanation or evidence of the actual status of transaction but an approval by the owner of the cited trademark concerning the registration of the trademark related to the application for trademark registration.

(Note 1) Trademarks "identical or obviously similar" here include, for

example, trademarks regarded to be generally accepted as identical as provided for in Article 50 of the Trademark Act; trademarks of which one of the constituent features is judged to be identical where the trademark has more than one constituent feature indicating a trade source independently; and trademarks judged to be so similar as to be pursuant to those above.

(Note 2) Designated goods or designated services “identical or obviously similar” here include those judged to be highly probable to fall under all of the criteria concerning similarity of goods and services mentioned later in Items 10 and 12.

(2) The following will be the only cases that can be considered not to fall under this paragraph as a result of examination in consideration of the submitted explanation and evidence mentioned in (1) above.

(i) Where the applicant submits an explanation and evidence describing the trade condition with respect to the designated goods or designated services which are regarded as similar to those of the cited trademark according to the Examination Standards for Similarity of Goods or Services, and as a result of comprehensive consideration given to the submitted document, the respective trademarks and their designated goods or designated services are judged as not being similar to each other.

(ii) Where, if the right of exclusive use or non-exclusive use has been established in regard to the cited trademark, the applicant submits an explanation and evidence describing the trade condition with respect to the owners of the trademark right, the right of exclusive use, and the right of non-exclusive use, and as a result of comprehensive consideration given to the submitted document, the respective trademarks and their designated goods or designated services are judged as not being similar to each other.

(Note) The guideline in Item 3 above will come into force on or after April 1, 2007.

4. The sound of a trademark composed of written words with phonetic kana letters combined needs to be determined as follows:

(a) A trademark composed of Chinese characters such as, for example, “紅梅” is judged to produce a natural sound [KOBAI] even if it is combined with phonetic kana [BENIUME].

(b) A trademark composed of Chinese characters such as, for example, “白梅” which produce two or more natural sounds like [HAKUBAI] and [SHIRAUME] is judged to produce, if it is combined with only one of their sounds, the other

natural sounds in addition.

(c) A trademark composed of Chinese characters such as, for example, “竜田川” if combined with a natural sound [TATSUTAGAWA] is judged not to produce an unnatural sound like [RYUDENSEN].

5. Concerning the similarity of a composite trademark composed of two or more elements, a judgment needs to be made based on the following among other things, with consideration given to the strength of a combination between its elements. However, this does not apply where such a trademark is judged clearly to produce a remarkably different appearance, sound and concept.

(1) A composite trademark having characters representing an adjective (characters indicating the quality, raw materials, etc. of goods or characters indicating the quality of services, the location of its provision, quality, etc.) is judged as similar to a trademark without the adjective as a general rule.

(Example)

Similarity recognized between:

“スーパーライオン” [SUPER LION] and “ライオン” [LION]

“銀座小判” [GINZA KOBAN] and “小判” [KOBAN]

“レディグリーン” [LADY GREEN] and “レディ” [LADY]

(2) A trademark composed of letters different in size is judged with respect to a group of letters identical in size as a general rule.

(Example)

Similarity recognized between:

“富士白鳥” and “富士” or “白鳥”

“サンムーン ” and “ サン” or “ムーン ”

(3) A trademark composed of letters conspicuously separate apart from each other is judged with respect to a group of letters separate from others as a general rule.

(Example)

Similarity recognized between:

“鶴亀 万寿” and “鶴亀” or “万寿”

(4) A trademark which, because of its long sound or its particularly conspicuous portion, may be simplified with a certain portion thereof is compared with other trademarks, in principle, with its portion picked up in its simplified form.

(Example)

Similarity recognized between:

“cherryblossomboy” and “チェリーブLOSSAM” [cherryblossom]

“chrysanthemumbluesky” and “クリサンシマム” [kurisanshimamu] or “ブル

ースカイ” [blue-sky]

(5) A trademark combining letters customarily used for the designated goods or designated services with other letters is compared with other trademarks with the customarily-used letters removed.

(Example)

Similarity recognized between:

“男山富士” and “富士” for sake

“菊正宗” and “菊” for sake

“プレイガイドシャトル” and “シャトル” for arrangements for seats of entertainment facilities

“黒潮観光ホテル” and “黒潮” for providing lodging accommodations

(6) A trademark combining another person’s registered trademark that is widely recognized in respect of the designated goods or designated services with other letters or figures, including one whose appearance in totality is well formed or one having a connection in concept, is judged as similar to that another person’s trademark, in principle, excluding however cases where the part of another person’s trademark has become an established word.

(Example)

Similarity recognized between:

“SONYLINE,” “SONY LINE” or “SONY/LINE” and “SONY” in respect of tape recorders

“ラブロリアル” [LOVE L ‘OREAL] and “L ‘OREAL” in respect of cosmetics

“PAOLOGUCCHI” and “GUCCI” in respect of bags

“JALFLOWER” and “JAL” in respect of air transportation services

“東宝白梅” [TOHO HAKUBAI] and “東宝” [TOHO] in respect of film making

Similarity not recognized between:

“TOSHIHIKO” and “IHI” in respect of metal working machinery and tools

“アルバイト” [ARUBAITO] and “ALBA / アルバ” [ARUBA] in respect of watches and clocks

“せがれ” [SEGARE] and “セガ” [SEGA] in respect of playing machines and tools

Note: Item 7, Part 8: Article 4(1) (x), Chapter III of the Guidelines shall apply mutatis mutandis to judgments as to whether the trademark is widely recognized or not to the relevant consumers.

(7) A trademark composed of a trade name (including a trademark composed of an abbreviation of a trade name, as hereinafter applicable) having such characters as

“Co.,” “K.K.” “Ltd.,” etc. customarily used as part of a trade name is judged with those characters removed as a general rule, irrespective of their position respective to the primary part of the trademark, either at its head or end.

6. (1) A trademark having a distinctive part conspicuously small compared with its indistinctive part is judged to produce a sound or concept from that distinctive part.

(2) A trademark composed of a colored part can be judged to produce a sound or concept from that part.

(3) A trademark with its primary part not distinctive itself and lacking in its function to distinguish an applicant’s goods or services from those of others but having come to gain its distinctiveness through use is judged to produce a sound and concept from that part.

7. In case where the similarity of a sound of a trademark is judged simply by the factors and methods judging sound which is inherent in a sound, for example, the followings such as item (I) and (II) shall be adopted.

(I) In judging the similarity of sounds of trademarks, at first, whether or not common or similar parts are found in each factor judging on the tone quality, volume, tune and syllables of both sounds to be compared (“Note 1” through “Note 4”), shall be compared. Furthermore, considering whether or not both trademarks are coined words which do not have specific concept (for example, sometimes, they differ in tune, and attention to be paid to sounds becomes different depending on clear difference of concept), it shall be judged depending on whether or not such trademarks are likely to cause confusion with each other, from the overall impression of the appellations (auditory feelings) that may be given to listeners when both trademarks are pronounced and heard to at the different time and in the different places. If both of the trademarks fall under any of the following criteria [Note 5] mentioned in (1) to (8) of (II) [Note 6], such trademarks shall be deemed, in principle, to be similar in sounds [Note 7].

[Note 1] As judging factors related to the quality of the sound (nature of the tone that is produced from qualitative rules on vowels and consonants), the following factors shall be enumerated;

(a) whether vowels of the different sounds are common or similar; [for example, in the different sound, in case where (i) the sound is positioned in the middle or at the end of the word and its vowels are common, or (ii) its consonants are similar in the position and method of the articulation (meaning the case where consonants are in identical or similar intonation positions or in methods in the

consonant chart, such that both are labials or frictional sounds. However, it may differ in accordance with the position, intonation or the total number of sounds), and their vowels are in common, etc., the general auditory feeling is often heard as similar.]

(b) whether consonants of the different sounds are common or similar; [for example, there are differences in sound, where (i) the consonants of the different sounds are in the same line of the table of the Japanese syllabary, and their vowels are similar (for example, a vowel [e] is similar to [a] and [i], and a vowel [o] is similar to [a] and [u] according to how a mouth is opened and the position of a tongue. However, this may vary according to the position or intonation of the different sounds and the total numbers of sounds), or where (ii) such different sounds simply consist of the difference in a voiced consonant (sound of [ga], [za], [da] or [ba] lines), voiceless bilabial plosive consonant (sound of [pa] line) or a voiceless sound (sound of [ka], [sa], [ta] or [ha] lines), etc., in such cases, the general auditory feeling is often heard as similar;

[Note 2] As judging factors relating to the length of a sound (whether the sound is long or short), the following factors shall be enumerated;

- (a) whether a different sound is a long sound of its preceding vowel (simply whether there is a long sound or not).
- (b) whether a different sound is a long sound of its succeeding consonant (simply whether there is a geminated consonant or not).

As to the length of the sound, this relates to the articulation (strength of the sound) since a long sound and a geminated consonant are heard comparatively weakly (the sound preceding a long sound or geminated consonant is generally heard strongly), and it also relates to a judging factor relating to the syllable since a long sound and a geminated consonant, when pronounced, give an impression as being one unit and as constituting one syllable.

[Note 3] As judging factors relating to the articulation (strength of the sound and position of its accents), the following factors shall be enumerated;

- (a) whether different sounds are both weak sounds (weak sound in hearing), whether or not there is nothing more than a weak sound, or simply whether there is a long sound or a geminated consonant (a weak sound is generally heard weakly, as it is absorbed in its preceding sound);
- (b) whether the different sounds are both in the middle or end of their words (a sound in the middle or end of a word is generally heard comparatively weakly).
- (c) whether the in-common sounds are the same strong sounds (sounds that

sound strongly) in the beginning or end of their respective words (if such are strong sounds, their respective overall auditory feelings are similar, and they are often heard as similar);

(d) in the case where there is a strong accent in the sound of a trademark comprised of Roman characters, whether or not the place of that accent is common.

The relative strength of a sound is often heard not only by the sound itself ([i] and [u], sounds pronounced without the mouth being widely opened, [m] and [n], sounds pronounced without the mouth being opened, [f] and [s], sounds pronounced without vibration of the vocal cords, etc., are deemed to be weak sounds due to their lack of auditory clarity), but also by the respective positions of the different sounds, the total number of sounds, etc. (for example, even if one of the different sounds is a weak sound as above in terms of the sound itself, there are cases where that sound cannot be said to be a weak sound when its preceding and succeeding sounds are also weak sounds).

[Note 4] As judging factors relating to syllables, the following factors shall be enumerated;

(a) the number of syllables (the number of sounds. One Japanese kana character constitutes one syllable, and a contracted sound constitutes one syllable by two letters. A long sound (symbol), a geminated consonant, and a syllabic nasal respectively constitute one syllable each.), whether or not both sounds are plural sounds (even if there is a difference of sound, the general auditory feeling is often heard as being similar when there are relatively many sounds);

(b) whether or not there is a commonness in the way the sounds are divided or separated (at the syllabic or breathing-pause stage) when the sounds are each felt in their entirety (in many cases, where there is such a commonality, the overall auditory feeling is similar, and the sounds sound similar);

[Note 5] These criteria, which constitute main judging factors, in cases where two trademarks were judged as being similar in sound, and which are also common factors in respective cases, are arranged and listed here.

[Note 6] As to the relations between the criteria (1) through (8) (and their examples) and the judging factors mentioned in [Note 1] through [Note 4], the criteria (1) through (3), mainly relate to the quality of the sound, the criterion (4) mainly relates to the articulation, the criterion (5) mainly relates to the length of the sounds, the criteria (6) and (7) mainly relate to the syllable of the sound, and the criterion (8) relates to each of the judging factors, respectively. Take note that there

are also judging factors such as a phenomenon of linguistic corruption (for example, a case where two consecutive sounds are mutually change places and are called) that are not mentioned in [Note 1] through [Note 4], but should be taken into consideration.

[Note 7] Even if a case falls under the criteria (1) through (8), such case may be considered as an exception if the respective general auditory feelings are different owing to any reason in the following (a) through (c).

(a) When the quality or articulation in the beginning of the words are extremely different.

(b) Although the different sounds are not located at the beginning of their respective words, when the quality (for example, one different sound is in the same line but its vowel is not similar) or intonation (for example, there is a strong accent on different sounds) of the sounds are extremely different.

(c) Among the judging factors concerning syllables,

(i) when the sounds consist of smaller numbers of sounds (equal to or less than three sounds).

(ii) when the division or separation of the respective words are clearly different (at the syllabic or breathing pause stages).

It should be noted that the criteria (6) and (7) are to be applied in the case where the criteria (1) through (5) do not apply.

(II) (1) When both trademarks consist of the same number of sounds, and one of the different sounds has a common vowel.

“スチッパー” [SCHIPPER]

“SKiPPER”

“VANCOGIN / バンコシン”

“BUNCOMIN / バンコミン”

“ミギオン” [MIGION]

“ミチオン” [MICHION]

(2) When both trademarks consist of the same number of sounds, and one of the different sounds is on the same line of the table of the Japanese syllabary.

“アスパ” [ASUPA]

“アスベ” [ASUPE]

“アトミン / Atomin”

“ATAMIN / アタミン”

“VULKENE”

“VALCAN”

(3) When both trademarks consist of the same number of sounds, and one of the different sounds is only a difference of a voiceless sound, voiced consonant or Japanese voiceless bilabial plosive consonant.

“HETRON (ヘトロン)”

“PETRON / ペトロン”

“KUREKA / クレカ”

“GLECA / グレカ”

“サンシール” [SANSEAL]

“SANZEEL / サンジール”

(4) When the different sounds are both weak, and whether there is a weak sound or not.

“DANNEL”	“DYNEL”
“山清” [YAMASEI]	“ヤマセ” [YAMASE]
“VINYLA”	“Binilus”

(5) When one difference consists of whether or not there is a long sound, and whether or not there is a geminated consonant, or whether or not there is a difference between a long sound and a geminated consonant or a long sound and a weak sound.

“レーマン” [LEAMAN]	“Léman / レマン”
“コロネート” [CORONATE]	“CORONET”
“たからはと” [TAKARAHATO]	“タカラート” [TAKARAHT]

(6) When both trademarks consist of the same numbers of sounds in a relatively long sound, and only one sound is different.

“サイバトロン” [SAIBATORON]	“サイモトロン” [SAIMOTORON]
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(7) When both trademarks are relatively long, and one is longer in only one sound.

“CAMPBELL”	“Cambell / キャンベル”
“BPLEX / ビプレックス”	“ビタプレックス / VITAPLEX”

(8) Otherwise when the general auditory feeling is similar.

(a) When two sounds are different but factors of (1) through (5) as above are combined.

“COREXIT”	“コレスキット” [KORESKIT]
“ビセラジン” [BISERAJIN]	“ビゼラミン” [BIZERAMIN]
“フレーゲン” [FREGEN]	“Frigen / フリゲン / ふりげん”
“天神丸 (テンジンガン)” [TENJINGAN]	“電信丸 (デンシンガン)”
[DENSHINGAN]	
“COMPA / コンパ”	“COMBER / コンバー”

(b) When one of the different sounds is only in a contracted sound or a ordinary sound.

“SAVONET / サボネット”	“シャボネット” [SHABONET]
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(c) When one of the different sounds is one used in a foreign language which is similar to the other's vowel or consonant.

“TYREX”	“TWYLEX”
“FOLIOL”	“HELIOL / ヘリオール”

(d) When a vowel or consonant of one of the different sounds is similar.

“サリージェ / SALIGZE”	“Sally Gee”
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“CERELAC”

“セレノック / SELENOC”

(e) When there are common portions which are strong in terms of their pronunciation and/or auditory impression.

“ハパヤ” [HAPAYA]

“パッパヤ” [PAPPAYA]

(f) Others.

“POPISTAN / ポピスタン”

“HOSPITAN / ホスピタン”

Note: Sounds in parentheses are those which have been confirmed in appeal/trial decisions, etc.

8. (1) Because of its special nature of presenting a different appearance when seen from a different angle, a three-dimensional trademark has its similarity judged in the following manner. However, this does not apply in case where a three-dimensional trademark is not recognized as presenting a specific appearance characterizing the trademark, when viewed from a specific direction.

(a) A three-dimensional trademark is judged, in principle, as similar in appearance to a plain trademark indicating an appearance (including similar one) which it presents when viewed from a specific angle.

(b) Three-dimensional trademarks presenting common (or similar) in appearances as viewed from respectively specific angles are judged, in principle, as similar in appearance.

(c) A three-dimensional trademark produces a sound and concept in correspondence to not only its whole but also its appearance in a specific angle.

(2) A three-dimensional mark, which is combined with letters, produces a sound and concept in correspondence to the letters.

9. (1) In consideration of the situation that trademarks registered as a regional collective trademark are, in consequence of the use, perceived by the consumers as carrying inseparable features, the judgment of similarity with respect to a regional collective trademark shall be made assuming that the features of the trademark are inseparable.

(2) With consideration given to the special circumstances of regional collective trademarks mentioned in (1) above, the trademark of a later application which includes letters identical or similar to those of another person's registered regional trademark shall be deemed as similar to that trademark.

10. To judge the similarity of goods, the following criteria are comprehensively taken into consideration, basically following the Examination Standards for Similarity of Goods or Services.

- (a) Whether they correspond in production stage.
- (b) Whether they correspond in stage of sales.
- (c) Whether they correspond in materials and quality.
- (d) Whether they correspond in intended purpose.
- (e) Whether they correspond in a range of consumers they are targeted at.
- (f) Whether they are in a finished-product-and-parts relationship.

11. To judge the similarity of services, the following criteria are comprehensively taken into consideration, basically following the Examination Standards for Similarity of Goods or Services.

- (a) Whether they correspond in the manner, purpose and place of their provision.
- (b) Whether they correspond in articles connected with their provision.
- (c) Whether they correspond in a range of consumers and customers they are targeted at.
- (d) Whether they correspond in the category of their business.
- (e) Whether they correspond in laws regulating business relating to the services concerned and their business operators.
- (f) Whether they are provided by business operators in the same category of business.

12. In judging the similarity of goods and services, a substantial decision is made on a case-by-case basis with consideration generally given to the following criteria. However, goods and services to be listed in the Examination Standards for Similarity of Goods or Services will follow the relevant standards in principle.

- (a) Whether it is common for the same business operator to engage in the production and sales of goods and in the provision of services.
- (b) Whether the goods and services correspond in intended purpose
- (c) Whether the goods and services correspond in the points of sales of the goods and provision of the services are identical.
- (d) Whether the goods and services correspond in a range of consumers and customers they are targeted at.