

Part 13: Article 4(1)(xv) (Confusion over the Source of Goods and Services)

is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);

1. "... likely to cause confusion in connection with the goods or services pertaining to a business of another person" applies not only in case where the users of goods or services are likely to be confused over the source of the goods or services with the goods or services concerned mistakenly recognized as those connected with the business of other persons but also in case where the user of the goods or services are likely to be confused over the source of the goods or services with the goods or services concerned mistakenly recognized as connected with the business of a person who has a certain economic or organizational relationship with other persons.

The following are examples of conceivable cases.

(1) In case where a trademark used by a business operator A with respect to goods G connected with its own business has become well known throughout Japan, the use of the trademark by a business operator B with respect to goods X (although not similar to the goods G and having no relationship with the goods G in respect of its manufacturer, seller, distribution route, materials, intended purpose, etc.) connected with its own business leads consumers to see the goods X not as goods connected with the business of the business operator A but as goods connected with the business of another business operator A' having affiliated or other business relationship with the business operator A with confusion caused over the source of the goods (on the assumption of the presence of the business operator A' which does not actually exist).

(Note) The above case (1) applies to services with the word "goods" and "its manufacturer, seller, distribution route, materials, intended purpose, etc." altered to read "services" and "the provider of the service and its provision means and purpose, articles for use for the provision of the service, etc."

(2) In case where a trademark is used by a business operator A with respect to services connected with its own business has become known well throughout Japan, the use of the trademark by a business operator B with respect to goods (although not similar to the services of the business operator A) connected with its own business leads consumers to mistakenly recognize the goods as connected with another business of the business operator A with confusion caused over the source of the goods.

(Note) The above case (2) applies in case where the business of the business operator A relates to goods and the business of the business operator B relates to services.

2. To judge the liability of a trademark “likely to cause confusion in connection with the goods or services pertaining to a business of another person” the following factors are comprehensively taken into consideration.

- (a) How much the other person’s trademark is known (the degree or dissemination of advertisement, publicity, etc.).
- (b) Whether the other person’s trademark is a creative mark.
- (c) Whether the other person’s trademark is a house mark.
- (d) Whether there is the possibility of multiple businesses.
- (e) Whether there is any relationship between goods, services or goods and services.

However, the judgment of above (a) may not be well known throughout the country.

3. To prove a trademark’s being well known as in Item 2(a) above, the provisions of Items 3(1) and (2) of Chapter II (Article 3(2)) of the Guidelines apply *mutatis mutandis*.

4. A trademark with its part indicating a famous trademark of another person needs to be handled in the following manners:

- (1) A trademark judged as similar to a registered famous trademark of another person and used for goods or services identical with or similar to the designated goods or designated services of that registered famous trademark falls under the provision of Article 4(1)(xi).
- (2) A trademark liable to cause confusion over the source of a good or service, however it is recognized as not similar to a famous trademark of another person or is similar to a famous trademark of another person but used for different goods or services, falls under the provision of this paragraph, in principle.
- (3) A trademark similar to a famous trademark of another person but not liable to cause confusion over the source of goods or services, if used for an unfair intention, falls under the provision of Article 4(1)(xix).

5. A combination of another person's registered trademark “well known among consumers” and other characters or diagrams are, in principle, handled so as that it may cause confusion in the source of the goods or services, including those trademarks which the description of the composition of appearance is well united or

conceptually related.

However, exemptions will be made when a part of the well known trademark of another party consists of a segment of an established word, or, when it is clear that the source will not be confused in relation to the designated goods or designated services.

(Example)

Examples of trademarks which may cause confusion:

- “arenoma / アレノマ” for clothing with “renoma” (bags etc.)
- “PER · SONY,” “PER SONY,” or “PERSONY” for toys with “SONY” (electrical machinery and apparatus)

Examples of trademarks which will not cause confusion:

- “POLAROID” for cameras with “POLA” (cosmetics)

6. A trademark application with respect to a trademark which is liable to, if used by the applicant, cause confusion over the source of its goods or services with those of a trademark well known as a famous trademark overseas among consumers in Japan (not necessarily to final consumers) at the time of its filing (refer to Article 4(3)) is liable to be refused under the provision of this paragraph with that famous trademark cited as a reason for refusal.

7. To judge the liability of a trademark to cause confusion with goods or services connected with another person’s business, full consideration is given to the actual state of their transaction.

8. A three-dimensional trademark indicating the shape of a building, if this shape of a building is widely recognized in Japan as the shape of another person’s building before an application is filed for it, fall under the provision of this paragraph.

9. Judgment of whether the trademark is famous or not apply mutatis mutandis Item 7, Part8: Article 4(1)(x), Chapter III of the Guidelines.