

Part 17: Article 4(1) (xix) (Trademark Identical with or Similar to Another Person's Well-Known Trademark which is Used by the Applicant for an Unfair Intention)

is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding Items);

1. For example, trademarks presented below fall under the provision of this paragraph.

(a) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract

(b) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of goods.

2. Trademarks “well known among consumers” as stipulated in this paragraph not only mean trademarks widely known to final users but include trademarks widely recognized among traders.

3. Trademarks “well known among consumers ... abroad” as stipulated in this paragraph need to be well known in the countries they originate from but not necessarily need to be well known in multiple countries outside those countries. Nor do they in Japan.

4. A judgment on an “unfair purposes” needs to be made with full consideration given to the following materials, if available.

(a) Materials proving a fact that another person's trademark is well known among consumers (the period, scope, frequency of its use)

(b) Materials showing that a well-known trademark is composed of a coined word or particular in composition

(c) Materials proving a fact that the owner of a well-known trademark has a

concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)

(d) Materials proving a fact that the owner of a well-known trademark has a plan to expand its business in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.)

(e) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc.

(f) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark

5. A trademark in correspondence to (1) and (2) is considered to guess what the trademark is used with unfair intention.

(1) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.

(2) The above-mentioned well-known trademark is composed of a coined word or particular in composition.

6. Judgment of whether the trademark is well known or not apply mutatis mutandis Article 3(8) (Article 4(1)(x)) of the guidelines.