

Chapter XIII: Article 64  
(Registrability of Defensive Marks)

Article 64

(1) Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.

(2) Where a registered trademark pertaining to services is well known among consumers as that indicating the designated services in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with services other than the designated services pertaining to the registered trademark or services similar thereto or in connection with goods other than those similar to the designated services is likely to cause confusion between the said other person's services or goods and the designated services pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the services or goods for which the likelihood of confusion exists.

(3) For the purpose of the application of the preceding two paragraphs in relation to defensive mark registrations pertaining to a trademark right pertaining to a regionally based collective trademark, the term "his/her own" in the said paragraphs shall be deemed to be replaced with "its own or its members' ."

1. "a registered trademark pertaining to goods is well known among consumers" means "reaching a state of 'famous'."

2. The "famous" degree is judged based on the following criteria:

(1) the start and duration of use of a registered trademark relating to an application for the registration of a defensive mark (hereinafter referred to a principal registered trademark), areas of its use, goods or services connected with its use, etc.;

(2) the degree or dissemination of an advertisement, publication, etc. of the principal registered trademark;

(3) the state of business at the owner of the principal registered trademark, with consideration given to the relationship of the designated goods or designated services its business scale, business activities (state of production or sale, etc.); and

(4) the recognition of the principal registered trademark's being famous by the Patent Office.

3. The likelihood of confusion over the source of goods or services is judged with consideration comprehensively given to the following with respect to the relationship of the designated goods or designated services of the defensive mark with those of the principal registered trademark.

(1) Dissimilar goods need to be generally recognized as stemming from the same company when judged in consideration of their manufacturers, vendors, distribution routes, materials and uses and dissimilar services so judged in consideration of their providers, provided contents, articles provided in the services.

(2) Besides requirements in (1) above, the source of goods or services needs to be generally recognized as closely connected with the owner of the principal registered trademark.

4. A trademark including the common name of a good or service with an application for its registration covering goods or services other than the said goods or services is granted a registration as a defensive mark if it satisfies other requirements.