

42.108.02

**Handling of the Examination of a
"Name that is Well Known
among Consumers in the Field of Goods and Services for which the Trademark is Used" in Article 4(1)(viii) of the Trademark Act**

Under Article 4(1)(viii) (hereinafter referred to as "this item"), the specific treatment in the judgment of a "name that is well known among consumers in the field of goods and services for which the trademark is used" is as follows.

1. Regarding the expression "field of goods and services for which the trademark is used"

In order to reconcile the interest of the applicant entitled to register the trademark with the moral interest pertaining to the name of another person, in setting the requirement of a certain level of recognition for the "name of another person" in this item, the scope of consumers that will be used as a basis for judgment should not be strictly limited to consumers of the designated goods or designated services, but should cover a certain range of consumers centered on the designated goods or designated services. If another person is evoked or associated with the name by the consumer, the trademark should not be registered without the consent of the other person from the perspective of protecting moral rights.

Therefore, in determining the "field of goods and services for which the trademark is used," in addition to the designated goods or designated services of the trademark, any goods or services related to the other person, as well as the activities of the other person, including but not limited to the goods manufactured and sold or services provided by the other person, shall be taken into consideration from the perspective of protecting moral rights.

In such cases, the relationship between the designated goods or designated services of the trademark and the goods or services that are related to the other person, on such as the line of business, nature, and scope of consumers, shall also be taken into consideration.

2. Regarding the expression "name well known among consumers"

"Name well known among consumers" means the "name that is well known among consumers" in the "field" of 1. In making this determination, when the name is used in the goods or services, whether the other person may be evoked or associated with the name shall be taken into account from the perspective of protecting moral rights, with due consideration of the geographical and business scope in which the other person's name is recognized.

Here, in determining the degree of being well known in this item, the scope in which the

other person's name is recognized should be well considered first, and if the name is used in the goods or services, whether the other person may be evoked or associated with the name by a significant number of consumers shall be taken into account. This item shall apply even if the person is not known nationally or to all consumers in the field.

3. Examples of cases that fall under a "name that is well known among consumers in the field of goods and services for which the trademark is used"

(Example 1)

As for fashion designer Shohyo Taro, the apparel brand "Shohyo Taro" for which he serves as the designer has storefronts in major cities across the country and is recognized for having tenants in several department stores selling "clothing." His new products have also been presented at a collection of the fashion brand overseas.

Here, the following trademark has been applied for by a person not related to Mr. Shohyo and without his consent.

Trademark "Shohyo Taro," Designated Goods "Footwear, Bags"

In this case, it is recognized that Shohyo Taro is known to a significant number of consumers in relation to "clothing" goods. In addition, if the goods in question are closely related to the above designated goods, even if Mr. Shohyo does not manufacture or sell etc., the goods "footwear, bags," the above filed trademark falls under this item because he may be evoked or associated with the name by a significant number of consumers in the field of the designated goods when the name is used on the goods.

(Example 2)

As for Chinese chef Shohyo Jiro, there are several "Shohyo Jiro" Chinese restaurants operated by him in a certain region, and he is recognized for providing the service of "offering Chinese cuisine," which has been reported several times in national newspapers and featured on local television. Here, the following trademark has been applied for by a person not related to Mr. Shohyo and without his consent.

Trademark "Shohyo Jiro," Designated Goods "Fried Rice Seasoning"

In this case, it is recognized that Shohyo Jiro is known to a significant number of consumers in a certain region in relation to the service of "providing Chinese cuisine." In addition, if the service in question is closely related to the above designated goods, even if Mr. Shohyo does not manufacture or sell etc., the goods "Fried Rice Seasoning," the above filed trademark falls under this item because he may be evoked or associated with the name by a significant number of consumers in the field of the designated goods when the name is used on the goods.

References

[Examination Guidelines for Trademarks:](#)

Article 4(1)(viii) (Name of another person)