

42.119.02

Handling Concerning Protection of Foreign Marks etc.

1. A portrait or the name of a famous deceased person, or a famous pseudonym, stage name, pen name or famous abbreviation of any of such names of a famous deceased person (hereinafter referred to as "name, etc. of a deceased person") In cases where the spouse of the deceased is still alive, and the applicant has not gained approval from the spouse, the name, etc. of a deceased person shall be refused pursuant to Article 4(1)(vii) of the Trademark Act. (Reference: Trademark "MARC CHAGALL" Appeal No. 15651 of 1987)

2. Well-known or famous characters

Characters that are used for goods or services and that have already become well-known or famous as marks shall be refused pursuant to Article 4(1)(x) or Article 4(1)(xv) of the Trademark Act.

<Reference> Characters

A character is a personality formed from a combination of the name, the appearance and the role of a person appearing in an original work. It is an abstract concept that was formed within the original work or emerged from the original work, which has become independent from the original work. The character itself cannot be copyrighted as a creative expression of an emotion.

(Popeye case: 1983 (Wa) 27, Judgment of the Osaka District Court, February 28, 1984)

3. Trademarks that are well-known and famous only overseas

A trademark claimed in an application for trademark registration that satisfies the following requirements shall be deemed to fall under Article 4(1)(xix) of the Trademark Act, because it is difficult to acknowledge that the trademark was identical to another party's trademark by accident, and it can be assumed that the applicant reproduced the other party's well-known or famous trademark without authorization to use it for unfair purposes (see "The Trademark Examination Manual 42.119.03: Examination concerning Article 4(1)(xix) of the Trademark Act").

(i) The trademark must be identical to or highly resemble a trademark that is well-known or famous in one or more countries overseas.

(ii) The well-known or famous trademark must comprise a coined word or have an outstandingly characteristic constituent.

In cases where the government, etc. of the country using that well-known or

famous trademark has made any comments, for example, that the application for trademark registration concerned is contrary to international faith, such comments shall sufficiently be taken into consideration.

The gist of this policy was conventionally provided under Article 4(1)(vii) of the Trademark Act, but came to be provided under Article 4(1)(xix) of the Act for Partial Revision of the Trademark Act, etc. (Act No. 68 of 1996) when that Act came into effect.

(Reference)

- Trademark "LILLYWHITES": Appeal No. 3232 of 1983 (Article 4(1)(vii) of the Trademark Act was judged as applicable.)
- Trademark "DROTTEE-BIS": 1978 (Wa) 1264, Judgment of the Kobe District Court, February 21, 1982
- "Protection of well-known or famous foreign trademarks that are yet to be registered in Japan and the names of non-Japanese persons" (Notice) ... See Annex 1
- "Protection of foreign trademarks, etc." (Notice) ... See Annex 2

4. Application by the owner of a well-known or famous trademark (concerning the application of Article 4(1)(xi) of the Trademark Act)

It is particularly important that the determination of similarity between the trademark claimed in an application and a cited trademark with regard to the application of Article 4(1)(xi) of the Trademark Act is not made based only on one of the factors of appearance, sound and concept of each trademark. Therefore, among the various actual states of transactions of the designated goods or services, the examiner shall pay particular attention to the extent to which the trademark is well-known or famous, and make a determination by comprehensively examining the appearance, sound and concept of both trademarks. Even if the examiner finds the two trademarks similar concerning one of the above-mentioned three factors, Article 4(1)(xi) of the Trademark Act shall not be applicable to the application for trademark registration if the two trademarks are regarded as distinguishable after a comprehensive examination.

(Reference)

- Filed trademark "ランバン" vs. cited trademark "ラーバン": 1991 (Gyo Ke) 77, Judgment of the Tokyo High Court, October 15, 1991
- Filed trademark "Dodgers" vs. cited trademark "ロジャース": 1991 (Gyo Ke) 198, Judgment of the Tokyo High Court, March 10, 1992
- Filed trademark "LANCEL" vs. cited trademark "ラッセル": 1992 (Gyo Ke) 147, Judgment of the Tokyo High Court, June 29, 1993

(Note) Click to see the Examination Guidelines for Trademarks

Examinations for Trademarks:

Article 4(1)(vii) (Contravention of public order or morality)

Article 4(1)(x) (Well-known trademark of another person)

Article 4(1)(xi) (Another person's registered trademark applied for prior to the filing date of the trademark application concerned)

Article 4(1)(xv) (Confusion over the source of goods and services)

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)