

Chapter 9: Article 4(1)(x) (Well-known trademark of another person)

(x) A trademark being identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

1. Regarding the expression "trademark which is well known among consumers as that indicating goods or services in connection with the person's business"

(1) Regarding the consumer's recognition

"A trademark which is well known among consumers" includes not only a trademark which is well known among end consumers but also a trademark which is well known among traders in the industry and also includes not only a trademark which is known throughout the country but also a trademark which is well known in a certain area.

(2) Regarding the determination on the degree of being well known

Part II, Items 2(2) and (3) (Article 3(2)) of the Guidelines apply mutatis mutandis to the judgment on whether or not the trademark "is well known among consumers." For example, the judgment is made by sufficiently taking into consideration the following circumstances.

(a) Cases of goods or services with special form of transaction

For example, "medicines and drugs for medical use" and "test, examination or research of drugs" are goods distributed or services provided only in specific markets.

(b) Cases of trademarks that are mainly used in foreign countries

Trademarks that are mainly used in foreign countries refers to (i) those that are well known in a foreign country, (ii) goods on which the relevant trademark is used that are exported to several countries or (iii) services bearing the trademark that are provided in several countries.

2. Regarding the approval of a "trademark which is well known among consumers"

Determination regarding trademarks that have been approved as trademarks well known among consumers in trial decisions and decision on objections or judgments is made by sufficiently taking into consideration the facts found.

3. Regarding the expression "a trademark which is similar to"

(1) Part III, Chapter 10, Items 1 to 10 (Article 4(1)(xi)) of the Guidelines apply mutatis mutandis

to the judgment on the similarity of trademarks under this item.

(2) A combination of another person's unregistered trademark "well known among consumers" and other characters or figures are considered "similar" to the unregistered trademark including those trademarks whose description of the composition of appearance is well united or conceptually related.

However, in cases where it is clear that the unregistered trademark constitutes part of an established word or other cases, the unregistered trademark will be excluded.

(Example) Examples of trademarks are the same as those mentioned in Part III, Chapter 10, Item 4(2)(a)(ii) (Article 4(1)(xi)) of the Guidelines.

#### 4. Regarding the timing of making determinations

A trademark to be cited for the application of the provision of this item must be well known among domestic consumers in Japan at the time when an application for trademark registration is filed (refer to Article 4(3))

#### 5. Regarding the judgment on the similarity of goods or services

Part III, Chapter 10, Item 11 (Article 4(1)(xi)) of the Guidelines apply *mutatis mutandis* to the judgment on the similarity of goods or services under this item.

#### 6. Treatment in the case where there is a controlling relationship between the applicant and the other person under this item

Part III, Chapter 10, Item 13 (Article 4(1)(xi)) of the Guidelines applies *mutatis mutandis* to the judgment on whether the relevant case fall under this item.