

Chapter 10: Article 4(1)(xi) (Another person's registered trademark applied for prior to the filing date of the trademark application concerned)

(xi) A trademark being identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark(referring to goods or services designated in accordance with Article 6 (1) (including cases where it is applied mutatis mutandis pursuant to Article 68 (1)); the same shall apply hereinafter), or goods or services similar thereto;

1. Regarding the method to judge the similarity of trademarks

(1) Comprehensive observation in judging similarities

Judgment on the similarity of trademarks is made by observing in whole the trademark as applied and the cited trademark by taking into consideration the impression, memory, association, etc. given to consumers by the appearance, sound or concept, etc. of such marks and then considering whether or not the trademark as applied is likely to cause confusion as to the source of goods or services with respect to the cited trademark when the trademark as applied is used for its designated goods or designated services.

In making the judgment, the general and regular state of transactions of the designated goods or services will be taken into consideration while the state of transactions that is only special or limited with respect to the goods or services for which the trademark is currently used will not be taken into consideration.

(Examples of general and regular state of transactions)

Trade practice of the designated goods or services

(Example of special or limited state of transactions)

- (i) Specific mode and manner of the trademark actually used
- (ii) Difference in the specific goods or services for which the trademark is actually used

(2) Method to observe the trademark

(a) Judgment on the similarity of trademarks is not only made by making an overall observation but also by comparing part of the composition of the trademark with another person's trademark.

(b) Judgment on the similarity of trademarks is made by remote observation based on different times and places.

(3) Standards for the attentiveness used in judging the similarity of trademarks

A judgment on the similarity of a trademark needs to, with consideration given to a class of main users (for example, difference in expertise, age and gender, etc.) of the designated goods or services on which the trademark is used and other actual state of transactions of the designated goods or services, be made based on attentiveness usually possessed by the user.

2. Regarding the identification of the trademark in the judgment on the similarity of trademarks

(1) Identification of the appearance, sound and concept

(a) Identification of the appearance

Appearance means the external form recognized by the consumers who look at the trademark through their eyes.

(b) Identification of the sound

Sound means the pronunciation naturally recognized in the course of trade by the consumers who look at the trademark.

For example, the sound is identified as follows.

(Example)

(i) The trademark "竜田川" only produces the natural sound "Tatsutagawa" but not unnatural sounds such as "Ryudensen."

(ii) A trademark "紅梅" combined with the phonetic kana "BENIUME" also produces a natural sound [KOBAl].

(iii) A trademark composed of Chinese characters such as, for example, trademark "白梅" which produce two or more natural sounds like [HAKUBAl] and [SHIRAUME] produces, if it is combined with only one of their sounds, the other natural sounds in addition.

(iv) A trademark composed of a colored part may produce a sound or concept from that part (for example, a figure of a "white" horse or "red" flag).

(c) Identification of the concept

Concept means the meaning or implications naturally recalled in the course of trade by consumers who look at the trademark. For example, concept is identified as follows.

(Example)

(i) In cases where the meaning of a foreign language constituting the trademark is published in a dictionary, etc. but it is determined that the consumers who look at the trademark would not promptly understand and recognize such meaning, the trademark is considered not to produce the

concept deriving from such meaning.

(ii) A trademark composed of a colored part can be judged to produce a sound or concept from that part (for example, a figure of a "white" horse or "red" flag)

3. Regarding the similarity of appearances, sounds and concepts

(1) Regarding the similarity of appearances

(a) The similarity of the appearances of the trademarks are determined by comparing the appearances of the relevant trademarks that give strong impression to the consumers who look at them and considering whether the overall impressions recognized by the consumers through their eyes from the appearances are confusing.

(Example) Cases where the appearances of the trademarks are similar

(Note) The following example shows the judgment on the similarity of appearance but not the similarity of the overall trademarks.

[1]

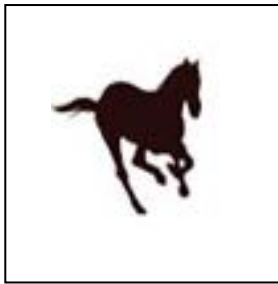
A square box containing the word "Japax" in a serif font. The letter 'x' is lowercase and smaller than the other letters.A square box containing the word "JapaX" in a serif font. The letter 'X' is uppercase and larger than the other letters.

(Explanation) The two trademarks differ in the size of the last character, but since such difference is minor, the two trademarks give similar impressions in terms of the overall appearance.

(Example) Cases where the appearances are not similar

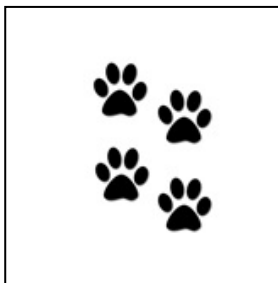
(Note) The following example shows the judgment on the similarity of appearance but not the similarity of the overall trademarks.

[1]



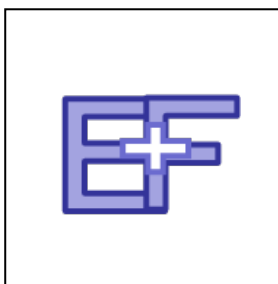
(Explanation) The figures of the horses of the two trademarks have a clear difference in terms of their constitution and thus they give different impressions from the overall appearance.

[2]



(Explanation) While four roundish animal footprints are drawn as if the right and left legs are walking alternately in the left figure, human footprints are drawn in the right figure and thus the two figures give a different impression from the overall appearance.

[3]



(Explanation) Both trademarks are composed of alphabetic characters "E" and "F" but they give a different impression from the overall appearance due to the existence or non-existence of the sign "+" and difference in the font and color.

(2) Regarding the similarity of sounds

In judging the similarity of sounds of trademarks, whether or not common or similar parts are found in each judging factor on the tone quality, volume, tune and syllables of both sounds to be compared, is compared. Then, it is judged depending on whether or not such trademarks are likely to cause confusion with each other, from the overall impression of the sounds that may be given to listeners when both trademarks are pronounced and heard.

(Note) The examples shown in (a) to (e) below show the judgment on the similarity of sounds but not the similarity of the overall trademarks.

(a) Judging factors related to the quality of the sound (nature of the tone that is produced from qualitative rules on vowels and consonants)

(i) Whether vowels of the different sounds are common or similar

(Example) When both trademarks consist of the same number of sounds, and one of the different sounds has a common vowel.

"ダイラマックス" [Dairamakkusu]	"ダイナマックス" [Dainamakkusu]
"セレニティ" [Sereniti]	"セレリティ" [Sereriti]

(Explanation) For example, in the different sound, in the case where (i) the sound is positioned in the middle or at the end of the word and its vowels are common, or (ii) its consonants are similar in the position and method of the articulation (meaning the case where consonants are in identical or similar intonation positions or in methods in the consonant chart, such that both are labials or frictional sounds. However, it may differ in accordance with the position, intonation or the total number of sounds), and their vowels are in common, etc., the overall impression is often heard as similar.

(ii) Whether consonants of the different sounds are common or similar

(Example) When both trademarks consist of the same number of sounds, and one of the different sounds is on the same line of the table of the Japanese syllabary

"プリロセッティ" [Purirosetti]	"プレロセッティ" [Purerosetti]
"ビスカリン" [Bisukarin]	"ビスコリン" [Bisukorin]

(Explanation) There are differences in sound, where (i) the consonants of the different sounds are in the same line of the table of the Japanese syllabary, and their vowels are similar (for example, a vowel [e] is similar to [a] and [i], and a vowel [o] is similar to [a] and [u] according to how a mouth is opened and the position of a tongue. However, this may vary according to the position or intonation of the different sounds and the total numbers of sounds)

(Example) When both trademarks consist of the same number of sounds, and one of the different sounds is only a difference of a voiceless sound, voiced consonant or Japanese voiceless bilabial

plosive consonant

"ビュープレックス" [Byupurekkusu] "ビューフレックス" [Byufurekkusu]
 "バーテラックス" [Baterakkusu] "バーデラックス" [Baderakkusu]

(Explanation) Such different sounds simply consist of the difference in a voiced consonant (sound of [ga], [za], [da] or [ba] lines), voiceless bilabial plosive consonant (sound of [pa] line) or a voiceless sound (sound of [ka], [sa], [ta] or [ha] lines), etc., in such cases, the overall impression is often heard as similar;

(b) Judging factors relating to the length of a sound (whether the sound is long or short)

(i) When one difference consists of whether or not there is a long sound, and whether or not there is a geminated consonant, or whether or not there is a difference between a long sound and a geminated consonant or a long sound and a weak sound.

(Note) Weak sound refers to sound without auditory clarity such as sounds pronounced without the mouth being widely opened ("i" and "u"), sounds pronounced without the mouth being opened ("mu" and "n") or sounds pronounced without vibrating the vocal chords ("fu" and "su").

(Example) Where a different sound is a long sound or not.

"モガレーマン" [Mogareman] "モガレマン" [Mogareman]

(Example) Where a different sound is a geminated consonant

"コレクシット" [Korekushitto] "コレクシト" [Korekushito]

(Example) Where a different sound is nothing but the difference between a long sound and geminated consonant

"コロネット" [Koroneto] "コロネット" [Koronetto]

"アドポーク" [Adopoku] "アドポック" [Adopokku]

(Example) When the different sound is nothing but the difference between a long sound and weak sound

"タカラハト" [Takahato] "タカラート" [Takarato]

"イースタパック" [Iistapakku] "インスタパック" [Insutapakku]

(Explanation) As to the length of the sound, this relates to the articulation (strength of the sound) since a long sound and a geminated consonant are heard comparatively weakly (the sound preceding a long sound or geminated consonant is generally heard strongly), and it also relates to a judging factor relating to the syllable since a long sound and a geminated consonant, when pronounced, give an impression as being one unit and as constituting one syllable.

(c) Judging factors relating to the articulation (strength of the sound and position of its accents)

(i) Whether different sounds are both weak sounds, whether or not there is nothing more than a

weak sound, or simply whether there is a long sound or a geminated consonant (a weak sound is generally heard weakly, as it is absorbed in its preceding sound);

(Example) When the different sounds are both weak, and whether there is a weak sound or not.

"ダンネル" [Danneru]	"ダイネル" [Daineru]
"シーピーエヌ" [Shipienu]	"シーピーエム" [Shipiemu]

(Example) When the difference is nothing more than the existence or non-existence of a weak sound

"ブリテックス" [Buritekkusu]	"ブリステックス" [Burisutekkusu]
"デントレックス" [Dentorekkusu]	"デントレック" [Dentorekku]

(ii) Whether the different sounds are placed in the middle or end.

(Example) When both trademarks consist of the same numbers of sounds in a relatively long sound, and only one sound is different.

"サイバトロン" [Saibatoron]	"サイモトロン" [Saimotoron]
"パラビタオミン" [Parabitaomin]	"パラビタシミン" [Parabitaashimin]

(Explanation) A sound in the middle or end of a word is generally heard comparatively weakly

(iii) Whether the in-common sounds are the same strong sounds (sounds that sound strongly) in the beginning or end of their respective words

(Example) Where the in-common sounds are the same strong sound in the beginning of their respective words

"アプロトン" [Apuroton]	"アクロトン" [Akuroton]
"バンヴェロル" [Banveroru]	"バンデロル" [Banderoru]

(Explanation) If such are strong sounds, their respective overall auditory feelings are similar, and they are often heard as similar

(iv) In the case where there is a strong accent in the sound of a trademark comprised of Roman characters, whether or not the place of that accent is common

(Example) Case where the place of the strong accent in the sound of the trademarks is common.

"SUNRICHY"	"SUNLICKY"
(Sound of "sunricchi")	(Sound of "sunrikki")
"RISCOAT"	"VISCOAT"
(Sound of "riscoat")	(Sound of "biscoat")

(Explanation) The relative strength of a sound is often heard not only by the sound itself, but also by the respective positions of the different sounds, the total number of sounds, etc. (for example, even if one of the different sounds is a weak sound as above in terms of the sound itself, there are cases where that sound cannot be said to be a weak sound when its preceding and succeeding sounds

are also weak sounds).

(d) Judging factors relating to syllables

(i) With regard to the comparison of the number of syllables (the number of sounds), whether or not both sounds are plural sounds

(Note) One Japanese kana character constitutes one syllable, and a contracted sound (e.g. "kya," "sha" and "pyo") constitutes one syllable by two characters. A long sound (symbol), a geminated consonant ("ttu"), and a syllabic nasal ("n") respectively constitute one syllable each.

(Example) When both trademarks are relatively long, and one is longer in only one sound

"ビプレックス" [Bipurekkusu] ビタプレックス" [Bitapurekkusu]

(Explanation) Even if there is one different sound, the overall impression is often heard as being similar when there are relatively many sounds

(ii) Whether or not there is a commonality in the way the sounds are divided or separated (at the syllabic or breathing-pause stage) when the sounds are each felt in their entirety

(Example) Where the sounds are divided in their entirety

"バーコラルジャックス" "バーコラルデックス"
[Bakorarujakkusu] [Bakorarudekkusu]

(Explanation) In many cases, where there is such a commonality, the sounds are heard similarly with a similar overall impression

(e) Other factors by which the overall impression would be found to be similar

(i) When two sounds are different but factors of (a) through (e) as above are combined.

"コレクシット"[Korekushitto] "コレスキット" [Koresukitto]
"アレジエール"[Arejieru] "アリジエール" [Arijeru]

(ii) When one of the different sounds is only in a contracted sound or an ordinary sound.

"シャボネット" [Shabonetto] "サボネット" [Sabonetto]

(iii) When one of the different sounds is one used in a foreign language which is similar to the other's vowel or consonant.

"TYREX"	"TWYLEX"
(Sound of "tairekkusu")	(Sound of "twyrekkusu")
"FOLIOL"	"HELIOL"
(Sound of "foliol")	(Sound of "heliol")

(iv) When a vowel or consonant of one of the different sounds is similar.

"サリージェ" [Sariju] "サリージー" [Sariji]

"セレラック" [Sererakku]

"セレノック" [Serenokku]

(v) When there are common portions which are strong in terms of their pronunciation and/or auditory impression.

"ハパヤ" [Hapaya]

"パッパヤ" [Pappaya]

(vi) When there are slight differences in the sounds in the anterior half but the overall impression is similar

"ポピスタン" [Popisutan] "

ホスピタン" [Hosupitan]

(f) Even if a case falls under the cases described in (a) through (e) above, factors by which the overall impression would not be found to be similar

(i) The quality or articulation in the beginning of the words are extremely different.

(ii) Although the different sounds are not located at the beginning of their respective words, when the quality (for example, one different sound is in the same line but its vowel is not similar) or intonation (for example, there is a strong accent on different sounds) of the sounds are extremely different.

(iii) Among the judging factors concerning syllables,

[i] when the sounds consist of smaller numbers of sounds

[ii] when the division or separation of the respective words are clearly different (at the syllabic or breathing pause stages).

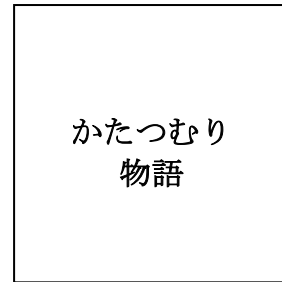
(3) Regarding the similarity of concepts

The similarity of concepts of the two trademarks are determined by considering whether or not the meaning or implications recalled by the consumers from the characters or figures, etc. constituting the trademark are almost identical to each other.

(Example) Case where the concepts are similar

(Note) The following example shows the judgment on the similarity of concept but not the similarity of the overall trademarks.

[1]



(Explanation) Both the terms "でんでんむし" and "かたつむり" are generally understood and recognized as representing the same meaning, "snail."

(Example) Case where the concepts are not similar

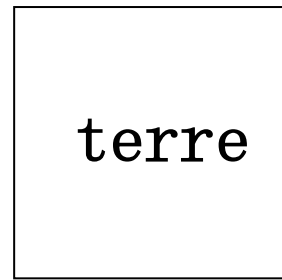
(Note) The following example shows the judgment on the similarity of concept but not the similarity of the overall trademarks.

[1]



Designated goods: Class 9

"TV"

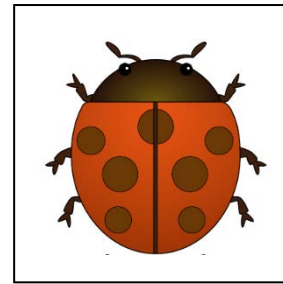
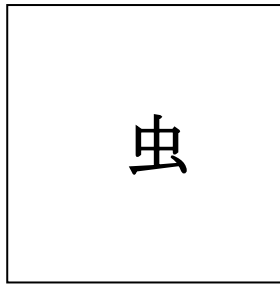


Designated goods: Class 9

"TV"

(Explanation) In light of the domestic consumers' level of understanding of foreign language with respect to the relevant designated goods, the trademark "EARTH" gives rise to the concept of "earth" but the French term "terre" does not give rise to the concept of "earth," and thus the two trademarks differ in terms of the concept. In the field of goods where French is generally used for trade names, etc., such concept may be produced.

[2]



(Explanation) Since the right figure will be recognized as a "ladybug" instead of a "bug," the concepts differ.

[3]



(Explanation) The left figure will be recognized as a "guitar" while the right figure will be recognized as a "violin," and thus the concepts differ.

4. Regarding the identification of the sound and concept of composite trademarks as well as the judgment of the similarity thereof

(1) Regarding the identification of the sound and concept of composite trademarks

(a) With respect to a composite trademark, when each constituent part cannot be found to have been combined strongly enough to consider that it is unnatural to observe them separately by taking into consideration the strength of the combination of each constituent part, only part of the composite trademark gives rise to the sound and concept.

(b) Regarding the factors taken into consideration with respect to the strength of the combination

With respect to trademarks composed solely of characters, judgment is made by taking into consideration the constitutional difference of the trademark such as the difference in the size, color, font, and type of characters (Hiragana or Katakana) as well as other factors such that the trademark is written in an extremely separated manner, the trademark has a long sound or the trademark has no conceptual relationship.

(Example) Case where there is a conceptual difference or the trademark has a long sound.

"富士白鳥" (difference in size of the characters)

"**サン**ムーン" (difference in the font)

"鶴亀 万寿" (the characters are written in an extremely separated manner)

"chrysanthemumbluesky" (long sound)

"ダイヤフロンティア" (no connection in terms of concept)

(c) A trademark composed of a trade name (including a trademark composed of an abbreviation of a trade name)

When characters such as "Co.," "K.K." "Ltd.," etc. that are customarily used as part of a trade name are contained in the structure of a trademark, such trademark still produces a sound and concept with such characters being removed.

(d) A three dimensional trademark

(i) A three-dimensional trademark produces a sound and concept in correspondence to not only its whole but also its appearance in a specific angle.

(ii) A three-dimensional mark, which is combined with characters, produces a sound and concept in correspondence to the characters.

(e) A regional collective trademark

In consideration of the situation that trademarks registered as a regional collective trademark are, in consequence of the use, well known among the consumers as carrying inseparable features, the judgment of similarity with respect to a regional collective trademark is made by assuming that the features of the trademark are inseparable.

(2) Judgment of the similarity of a composite trademark

(a) Similarity of composite trademarks must be judged, for example, as follows. However, this does not apply where such a trademark obviously produces a remarkably different appearance, sound and concept.

[i] When the composition of a trademark contains indistinctive characters

A composite trademark having characters normally used or customarily used in relation to the designated goods or designated services, indistinctive characters indicating the quality, raw materials, etc. of goods or indistinctive characters indicating the quality of services, the location of its provision, quality, etc. is judged as similar to a trademark without such characters as a general rule.

(Example) Similarity recognized between

"スーパーライオン" [SUPER LION] and "ライオン" [LION] in respect of the designated service "photography"

(Explanation) "スーパー" [SUPER] indicates the quality of the service.

"銀座小判" [GINZA KOBAN] and "小判" [KOBAN] in respect of the designated goods "rice crackers"

(Explanation) "銀座" [GINZA] indicates the place of origin or place of sale of the goods.

"グリーンジャイス" [GREEN JICE/JAISU] and "ジャイス" [JICE/JAISU] in respect of the designated goods "clothing"

(Explanation) "グリーン" [Green] indicates the quality (color) of the goods.

"男山富士" [OTOKOYAMA FUJI] and "富士" [FUJI] in respect of the designated goods "sake"

(Explanation) "男山" is a customarily used trademark for refined sake.

"黒潮観光ホテル" [KUROSHIO KANKO HOTEL] and "黒潮" [KUROSHIO] in respect of the designated service "providing lodging accommodations."

(Explanation) "観光ホテル" [KANKO HOTEL] is a customarily used trademark for "providing lodging accommodations."

[ii] When the composition of a trademark contains a trademark well known among consumers.

A combination of another person's registered trademark that is well known among consumers in respect of the designated goods or designated services and other characters or figures is, in principle, including those trademarks for which the description of the composition of appearance is well united or conceptually related, judged as similar to said another person's trademark, in principle.

However, cases where a part of another person's trademark has become an established word are excluded.

(Example) Similarity recognized between:

"ラブロリアル" [LOVE L'OREAL] and "L'OREAL" and "ロリアル" [L'OREAL] in respect of the designated goods "cosmetics"

"PAOLOGUCCI" and "GUCCI" in respect of the designated goods "bags"

"JALFLOWER" and "JAL" in respect of the designated service "air transportation service"

"東宝白梅" [TOHO HAKUBAI] and "東宝" [TOHO] in respect of the designated service "film making"

"SONYLINE" or "WALKMAN LINE" and "SONYWALKMAN" in respect of the designated goods "tape recorders"

(Example) Similarity not recognized between:

"TOSHIHIKO" and "IHI" in respect of the designated goods "metal working machinery and tools"

"アルバイト" [ARUBAITO] and "ALBA/アルバ" [ARUBA] in respect of the designated goods "watches and clocks"

"せがれ" [SEGARE] and "セガ" [SEGA] in respect of the designated goods "playing machines and tools"

(Note) Part III, Chapter 9, Item 2 (Article 4(1)(x)) of the Guidelines applies mutatis mutandis to judgments as to whether or not the trademark is well known among consumers.

[iii] A trademark having a distinctive part conspicuously small compared with its indistinctive part is judged to produce a sound or concept from that distinctive part.

[iv] A trademark with its part not distinctive itself and lacking in its function to distinguish an applicant's goods or services from those of others but that has come to gain its distinctiveness through use is judged to produce a sound and concept from that part which has come to gain distinctiveness.

(b) A regional collective trademark

A trademark which includes characters identical with or similar to those of another person's registered regional trademark is deemed as similar to that trademark.

5. A three-dimensional trademark

(1) Because of its special nature of presenting a different appearance when seen from a different angle, a three-dimensional trademark has its similarity judged in the following manner. However, this does not apply in the case where a three-dimensional trademark is not recognized as presenting a specific appearance characterizing the trademark, when viewed from a specific direction.

(a) A three-dimensional trademark is judged, in principle, as similar in appearance to a plain trademark indicating an appearance (including similar one) which it presents when viewed from a specific angle.

(b) Three-dimensional trademarks that are common (or similar) in appearances as viewed from respectively specific angles are judged, in principle, as similar in appearance.

(c) Item 10(2)(b) applies mutatis mutandis to judgments on similarity between a three-dimensional trademark and a position mark.

(2) When a three-dimensional trademark is stated by a method such as drawing the mark in connection with the trademark with solid lines and other parts with broken lines, whether the

trademark is similar to another trademark is to be examined as a whole while excluding those other parts.

6. Similarity of Motion Marks

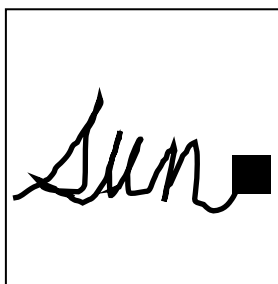
(1) When the similarity of a motion mark is to be examined, marks which constitute the motion mark, as well as each judging factor such as its external appearances, sounds and concepts resulting from changing states of the trademark as time passes are examined together so that the trademark will be examined as a whole.

(2) In principle, how a moving part of a motion mark moves will not be extracted as a part which can serve the function as a sign to independently distinguish its goods and services from those of others (hereinafter referred to as the "primary part").

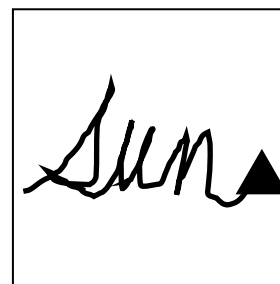
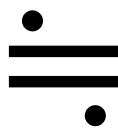
(3) Similarity of Motion Marks

(a) If one motion mark has a moving mark which is not recognized as having the function to distinguish its goods and services from those of others, but its trajectory draws lines and forms a mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other trademark has a mark consisting of a trajectory identical with or similar to one formed by the trajectory of the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other as a whole.

(Example) Trademarks which are similar in principle.



(motion mark ■ its trajectory draws lines of the characters for "sun")

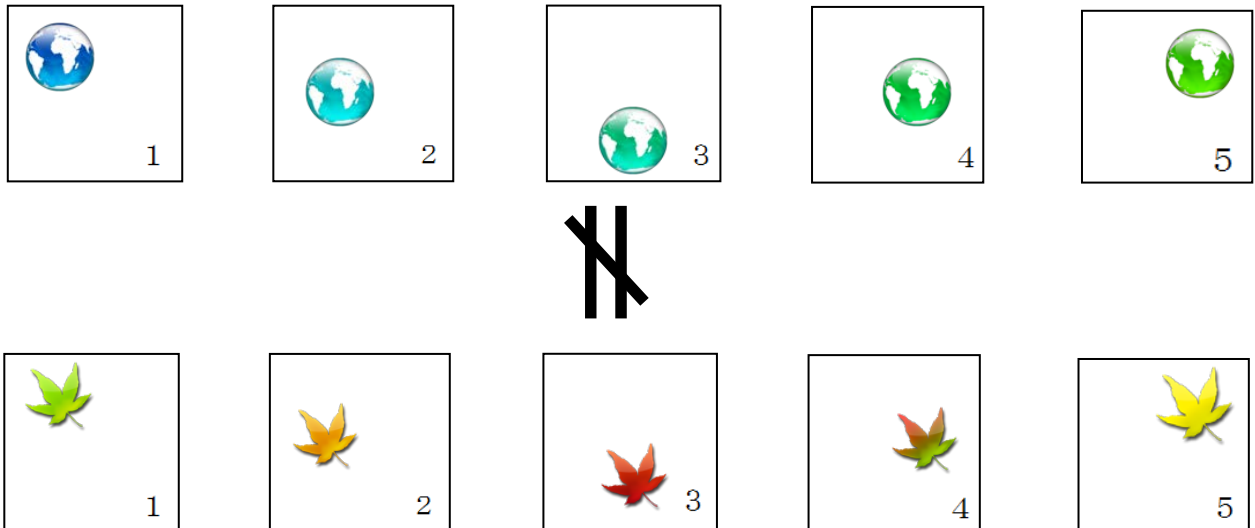


(motion mark ▲ its trajectory draws lines of the characters for "sun")

(b) If trademarks are recognized as having functions which can distinguish their respective goods

and services from those of others, and are not similar to each other, and if they move along trajectories identical with or similar to each other, but the trademarks do not paint any lines, then, in principle, the two trademarks are not regarded as similar to each other as a whole.

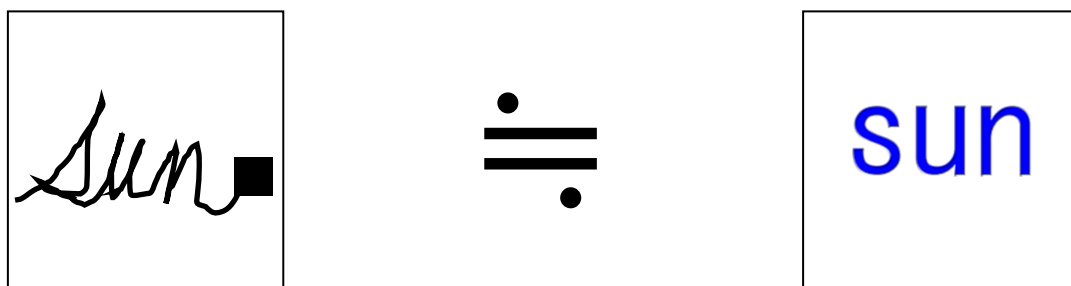
(Example) Trademarks which are not similar in principle



(4) Similarity of motion marks and character marks

(a) If one motion mark has a moving mark whose trajectory draws lines and forms a character or other mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other character or figure trademark is composed of a mark identical with or similar to one formed by the trajectory of the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other as a whole.

(Example) Trademarks which are similar in principle



(Motion mark ■ its trajectory draws lines of characters "sun")

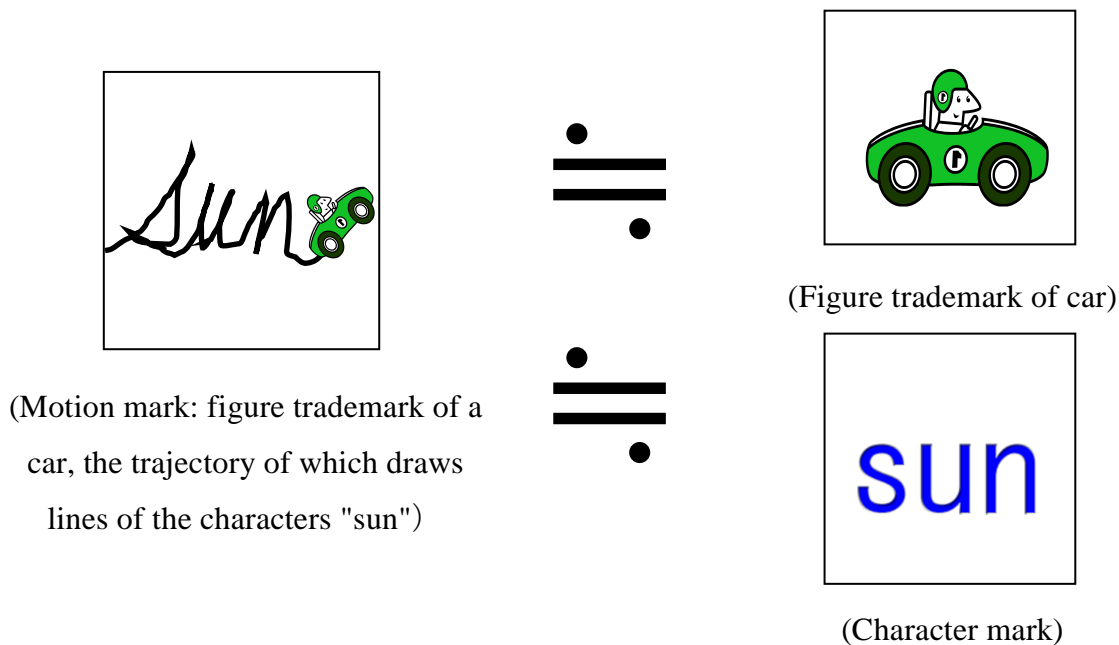
(Character mark)

(b) If one motion mark has a moving character, figure or other mark which is recognized as having

the function to distinguish its goods and services from those of others, and if the other figure or other trademark consists of one which is identical with or similar to the former motion mark's moving mark, then, in principle, the two trademarks are regarded as similar to each other.

If one motion mark has a mark whose trajectory draws lines and forms a character or other mark which is recognized as having functions which can distinguish its goods and services from those of others, and if the other character or other trademark consists of a mark which is identical with or similar to one formed by the trajectory of the former motion mark's mark, then, in principle, the two trademarks are regarded as similar to each other.

(Example) Trademarks which are similar in principle



(5) If one motion mark has a changing mark which is recognized as having the function to distinguish its goods and services from those of others, and if the other figure trademark consists of those before and after the former motion mark's changes and the mark itself, then, in principle, the two trademarks are regarded as similar to each other.

7. Similarity of hologram marks

(1) When a hologram mark's similarity is to be judged, marks consisting of characters, figures and other elements as well as changes caused by visual effects based on holography and other means (such as those to show it as three-dimensional, as shiny by the reflection of light, and with different viewing angles) are examined together so that the trademark is examined as a whole.

(2) If a hologram mark has visual effects to decorate a mark consisting of characters, figures and other elements such as those to make it appear to be three-dimensional and those which make it shine by the reflection of light, its similarity is judged based on external appearances, sounds and concepts resulting from characters, figures and other marks shown on a display surface.

(3) If a hologram mark has a visual effect to show marks with different viewing angles, and if it consists of multiple display surfaces, its similarity is judged based on external appearances, sounds and concepts resulting from characters, figures and other marks shown on individual display surfaces.

In this case, the ratio of one of such display surfaces to the trademark's total area, the context under which it is shown and its relation with other display surfaces need to be examined together so that the trademark is examined as a whole.

(4) Similarity of hologram marks and character marks

(a) If marks shown on multiple display surfaces are regarded as inseparably connected because words and idioms are divided and shown on the multiple display surfaces, or because of other reasons, and if a character, figure or other trademark consists of a mark which is identical with or similar to that shown on one of the multiple display surfaces, such as a character mark consisting of a part of the words or the idioms, then, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle



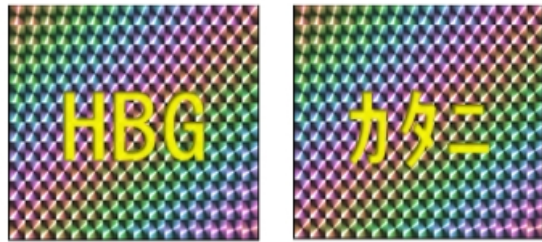
(Hologram marks have a visual effect to show marks with different viewing angles)

(Character marks)

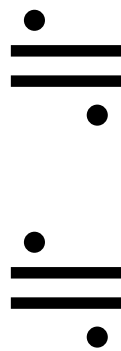
(b) When it is not unnatural as a business practice to separately observe marks shown on multiple display surfaces due to reasons such that coined words or other marks with no specific meanings

are shown on multiple display surfaces and the ratio of each display surface to the trademark's total area is not small, character or figure trademarks consisting of a mark identical with or similar to the mark shown on each display surface are, in principle, regarded as similar to each other.

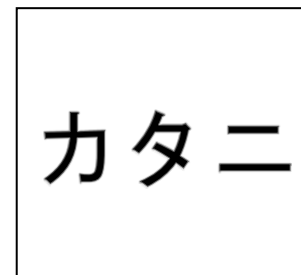
(Example) Trademarks which are similar in principle



(Hologram marks have a visual effect to show marks with different viewing angles)



(Character mark)



(Character mark)

8. Similarity of color marks

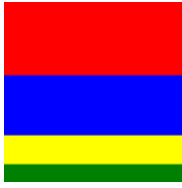
(1) For a color mark, its overall appearance composed of its hue (color shade), chroma (vividness of color), brightness (chromatic luminosity) and colors must be examined comprehensively so that the trademark is examined as a whole.

(2) With respect to color marks composed of a combination of colors, in addition to (1) and overall appearance of the whole constituted by the combination of colors, it is necessary to consider the overall trademark.

(3) Similarity of "single-color mark" and color mark composed of a combination of colors

With regard to examining whether a color mark and a single-color mark are similar to each other, if the single-color mark consists of a single-color mark extracted from the color mark, then, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle



(Color mark composed of a combination of colors)



(Single-color mark)

(4) Regarding the similarity of "single-color mark" and a "trademark with characters and colors combined"

A "single-color mark" and a "trademark with characters and colors combined" are not regarded as similar to each other, in principle.

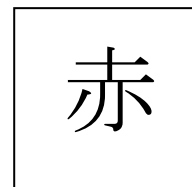
(5) Regarding the similarity of "single-color mark" and "character trademark"

When whether a single-color mark is similar to a character trademark is judged, even if the color mark has sounds and concepts identical with or similar to those of the character trademark, the color mark's color appearance is mainly an important factor to judge its similarity, and therefore, in principle, the two trademarks are not regarded as similar to each other.

(Example) Trademarks which are not similar in principle



(Single-color mark)

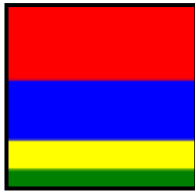


(Character mark)

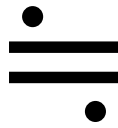
(6) Regarding the similarity of "mark with figures and colors combined" and "registered color mark composed of a combination of colors"

If a "mark with figures and colors combined" and a "registered color mark composed of a combination of colors" have color arrangements and ratios identical with or similar to each other, then, in principle, the two trademarks are regarded as similar to each other.

(Example) Trademarks which are similar in principle



(Figure mark)



(Registered color mark composed of a combination of colors)

9. Regarding the similarity of sound marks

(1) When whether a sound mark is similar to another one is examined, sound elements (such as its melody, harmony, rhythm, tempo, instrument played, and varying sound color and other natural sounds based on the range of voice and other factors) and linguistic elements (such as lyrics), of which the sound mark is composed, are examined together so that the trademark is examined as a whole.

(2) If sound and linguistic elements contained in a sound mark are not connected so indispensably that it seems unnatural as a business practice to separately observe them, each element is observed separately, and extracted as a primary part.

(3) When whether separate observations should be conducted and whether a primary part should be extracted are to be decided, the sound and linguistic elements and the level of functions of the elements' parts to distinguish its goods and services from those of others are considered.

(4) Regarding the similarity of sound marks consisting of only sound elements

(a) If a sound mark's part does not have the function to distinguish its goods and services from those of others, it is not extracted as a primary part, and is not used for comparison when whether the sound mark is similar to another is examined.

(b) If a sound mark's part has functions to distinguish its goods and services from those of others, and the part is extracted as a primary part, it is necessary that another sound mark's melody is identical with or similar to the sound mark's when whether the another sound mark is similar to the sound mark is examined.

(5) Regarding the similarity of sound marks containing linguistic elements


(a) If a sound mark's part does not have the function to distinguish its goods and services from those

of others, it is not extracted as a primary part, and is not used for comparison when whether the sound mark is similar to another is examined.

(b) If both sound and linguistic elements of a sound mark can be regarded as having the function to distinguish its goods and services from those of others, the level of the elements' functions to distinguish its goods and services from those of others is taken into consideration.

(c) If the linguistic element of a sound mark is coined words, the names of famous companies or others, and has very strong functions to distinguish its goods and services from those of others, and if its sound element has weak functions to distinguish its goods and services from those of others when compared with the linguistic element, only the linguistic element may be extracted as a primary part.

(Example): Cases where the two trademarks are not similar to each other, in principle (Sound marks whose linguistic elements are dissimilar and whose sound elements are similar to each other)

<p>(音商標 A)</p> <p>言語的要素：ジェーピーオー</p> <p>音楽的要素：自他商品・役務の</p> <p style="text-align: right;">識別機能が非常に弱い</p>		<p>(音商標 B)</p> <p>言語的要素：エイビイシー</p> <p>音楽的要素：自他商品・役務の</p> <p style="text-align: right;">識別機能が非常に弱い</p>
<p>linguistic elements : JPO</p> <p>sounds elements : weak functions to distinguish its goods and services</p>		<p>linguistic elements : ABC</p> <p>sounds elements : weak functions to distinguish its goods and services</p>

(Note) The sound elements of both trademarks are assumed to be the same.

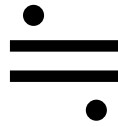
(d) If the sound element of a sound mark is famous and has very strong functions to distinguish its goods and services from those of others, and if its linguistic element has considerably weak functions to distinguish its goods and services from those of others when compared with the sound element, only the sound element may be extracted as a primary part.

(6) Regarding the similarity between sound mark with linguistic element and character trademark

If a sound mark has a linguistic elements, and the linguistic element is to be extracted as a primary part, whether the linguistic element is similar to a character trademark is also be examined.

(Example) Trademarks which are similar in principle

(音商標)
 言語的要素：ジェーピーオー
 音楽的要素：自他商品・役務の識別機能が非常に弱い



linguistic elements : JPO
 sounds elements : weak functions to distinguish
 its goods and services

(Character mark)

10. Similarity of position marks

(1) When whether a position mark is similar to another trademark is to be judged, the characters, figures, three-dimensional shapes, and other marks of the position mark, and positions to which those marks are attached must be examined together so that the trademark is examined as a whole.

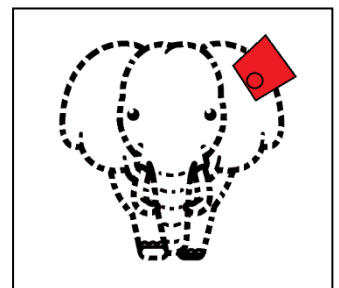
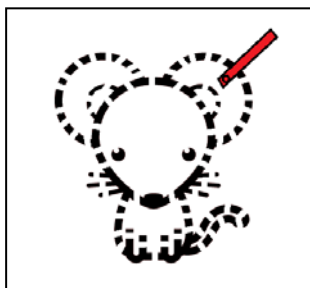
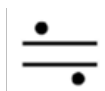
(2) In principle, the positions themselves are not extracted as a primary part to judge whether the position mark is similar to another trademark.

(a) Regarding the similarity of position marks

(i) Mark not regarded as having the function to distinguish its goods and services from those of others

Impressions, memories, associations and other factors given to consumers and traders by the positions in its goods to which the mark is attached must be comprehensively examined together so that the trademark is examined as a whole.

(Example) Trademarks which are similar in principle (designated good class 28 of "stuffed animals")



(Position Mark)

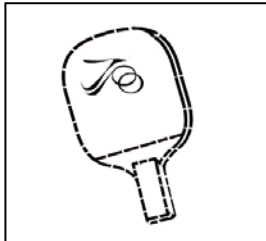
(Position Mark)

(Position Mark)

(ii) Mark regarded as having the function to distinguish its goods and services from those of others

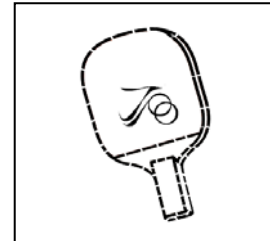
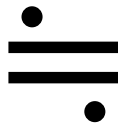
If the mark is identical with or similar to that of another mark, then, in principle, the trademark is regarded as similar to said another mark as a whole, regardless of whether the mark's position is different from that of said another mark.

(Example) Trademarks which are similar in principle



(Position Mark)

Goods of Class 28 "table tennis racket"



(Position Mark)

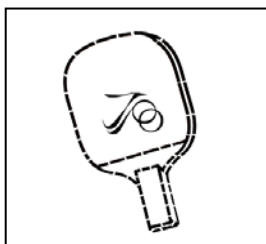
Goods of Class 28" table tennis racket"

(b) Regarding the similarity between a position mark and a figure trademark, three-dimensional trademark, etc.

(i) If a position mark is composed of a mark, and if the mark is not extracted as a primary part, the same applies as provided for in (a)(i) above.

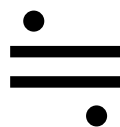
(ii) If a position mark is composed of a mark, and if the mark is extracted as a primary part, then, in principle, the position mark as a whole is similar to a figure trademark, three-dimensional trademark, etc. which has the same or similar mark.

(Example) Trademarks which are similar in principle



(Position Mark)

Goods of Class 28 "table tennis racket"



(Figure Trademark)

Goods of Class 28 " table tennis racket"

11. Regarding the judgment of the similarity of goods or services

Similarity of goods or services is judged based on whether or not the relevant goods or services are likely to cause confusion as if they are goods manufactured and sold or services provided by

the same business entity, when an identical or similar trademark is used for the designated goods or designated services of the trademark as applied and the cited trademark due to circumstances such that normally the goods are manufactured and sold or services are provided by the same business entity.

(1) Similarity of goods

To judge the similarity of goods, the following criteria are comprehensively taken into consideration. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether they correspond in production stage.
- (ii) Whether they correspond in stage of sales.
- (iii) Whether they correspond in materials and quality.
- (iv) Whether they correspond in intended purpose.
- (v) Whether they correspond in a range of consumers they are targeted at.
- (vi) Whether they are in a finished-product-and-parts relationship.

(2) Regarding the similarity of services

To judge the similarity of services, the following criteria are comprehensively taken into consideration. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether they correspond in the manner, purpose and place of their provision.
- (ii) Whether they correspond in articles connected with their provision.
- (iii) Whether they correspond in the range of consumers and customers they are targeted at.
- (iv) Whether they correspond in the category of their business.
- (v) Whether they correspond in laws regulating business relating to the services concerned and their business operators.
- (vi) Whether they are provided by business operators in the same category of business.

(3) Regarding the similarity of goods and services

In judging the similarity of goods and services, a substantial decision is made on a case-by-case basis with consideration generally given to the following criteria. In this case, judgment is based on the Examination Guidelines for Similar Goods and Services, in principle.

- (i) Whether it is common for the same business operator to engage in the production and sales of goods and in the provision of services.

- (ii) Whether the goods and services correspond in intended purpose
- (iii) Whether the goods and services correspond in the points of sales of the goods and provision of the services.
- (iv) Whether the goods and services correspond in a range of consumers and customers they are targeted at.

(4) Consideration of the actual state of transactions in judging the similarity of goods or services

When the holder of a registered trademark cited in the notice of reasons for refusal stating that this item is applicable (hereinafter referred to as the "holder of cited registered trademark") makes a statement to the effect that the designated goods or designated services of the cited trademark are not similar to the designated goods or designated service of the trademark as applied, the similarity of goods or services may be judged by taking into consideration the actual state of transactions of the goods or services as alleged by the applicant (provided that this will be limited to the circumstances listed in (1) to (3) above) notwithstanding the Examination Guidelines for Similar Goods and Services.

In the following cases, the actual state of transactions cannot be taken into consideration.

- (i) When the holder of a cited trademark has only approved the registration of the trademark for which an application for trademark registration has been filed.
- (ii) When the holder of a cited trademark has only made a statement to the effect that only part of the designated goods or designated services presumed to be similar under the Examination Guidelines for Similar Goods and Services is not similar.
- (iii) In the case where the establishment of an exclusive license or non-exclusive license is registered with respect to the trademark right of a cited trademark, when the holder of the exclusive license or non-exclusive license has failed to make a statement to the effect that the goods or services are not similar.

12. Treatment of cited trademarks after the duration has expired

(1) Treatment until six months pass from the expiration of the duration

(a) When the cited trademark is a registered trademark based on a national application

The six-month period after the expiration of the duration of a trademark right or the six-month period after the passage of the time limit by which the later-installment registration fee must be paid in the case where the registration fee is to be paid in installments is determined to fall under this item (refer to Article 20 (3) and Article 41-2(5) and (8)).

(b) Case where the cited trademark is a registered trademark based on international registration

The six-month period after the expiration of the duration of the international registration is determined to fall under this item (refer to Article 7(4) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks)

(2) Treatment after the passage of the six-month period mentioned in (1)(a) and (b) above

When the expiration of the duration has become final in the trademark registry, etc. after the passage of the six-month period mentioned in (1)(a) and (b) above, this item does not apply.

However, when the holder of the relevant trademark has confirmed by the trademark registry as to whether or not the duration of the trademark right of the cited trademark has been renewed and an application for registration of renewal has been filed based on the provisions of Article 21(1), this item is determined to be applicable.

13. Treatment in the case where there is a controlling relationship between the applicant and the holder of a cited trademark

When the applicant has submitted the evidence mentioned in (3) below in addition to alleging that the applicant and the holder of the cited trademark are in a relationship mentioned in (1) or (2) below, the applicant will be treated as not falling under this item.

(1) The holder of the cited trademark is under the control of the applicant;

(2) The applicant is under the control of the holder of the cited trademark;

(3) Evidence showing that the holder of the cited trademark has approved the registration of the trademark as applied.

(Example of cases that fall under (1) or (2) above)

(a) When the applicant holds a majority of the voting rights of the holder of the cited trademark;

(b) When the requirement mentioned in (a) above is not satisfied but there is a capital cooperation relationship between the applicant and the holder of the cited trademark, and the business activities of the company of the holder of the cited trademark are, in effect, under the control of the applicant.