

Chapter 13: Article 4(1)(xv) (Confusion over the source of goods and services)

(xv) A trademark being likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in items (x) to (xiv) inclusive);

1. Regarding the expression "likely to cause confusion in connection with the goods or services pertaining to a business of another person"

(1) This item applies not only in the case where the consumers of goods or services (hereinafter referred to as "goods, etc.") are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as those connected with the business of other persons but also in the case where the consumers of the goods, etc. are likely to be confused over the source of the goods, etc. with the goods, etc. concerned mistakenly recognized as connected with the business of a person who has a certain economic or organizational relationship with the other persons.

(Example) Cases that fall under this item

(i) In the case where a trademark $\text{\textcircled{S}}$ used by a business operator X with respect to the service "provision of ramen" connected with its own business has become well known throughout Japan, the use of the trademark $\text{\textcircled{S}}$ by a business operator Y with respect to goods "soba noodles" (although not similar to the service "provision of ramen") connected with its own business leads consumers to mistakenly recognize the goods "soba noodles" as goods connected with another business of business operator X and such consumers would be confused over the source of the goods.

(ii) In the case where a trademark "JPO" used by a business operator P with respect to goods "telecommunication machines and apparatus" connected with its own business has become well known throughout Japan, the use of the trademark "JPO" by a business operator R with respect to goods "toys" (although not similar to the goods "telecommunication machines and apparatus" and having no relationship with the goods in respect of their manufacturer, seller, distribution route, materials, intended purpose, etc.) connected with its own business leads consumers to mistakenly recognize the goods "toys" not as goods connected with the business of the business operator P but as goods connected with the business of an affiliate of business operator P and to be confused over the source of the goods.

(2) Matters to be taken into consideration.

For example, the following facts are taken into consideration in a comprehensive manner in determining whether or not this item is applicable.

- (i) The degree of similarity between the trademark as applied and the other person's mark;
- (ii) The degree to which the other person's trademark is well known;
- (iii) Whether the other person's trademark consists of a coined word or has a distinctive feature in its composition;
- (iv) Whether the other person's trademark is a house mark;
- (v) Whether there is the possibility of multiple management in the company;
- (vi) Whether there is any relationship between goods, services or goods and services;
- (vii) Whether there is any commonality between the consumers of goods, etc. and other actual states of transactions.

In determining the degree of being well-known as prescribed in (ii) above, Part II, Item 2(2) and (3) (Article 3(2)) of the Guidelines applies *mutatis mutandis* but it is not necessarily required that the other person's mark is well known across the country.

(3) Famous marks in foreign countries

When a mark famous in a foreign country is well known by Japanese consumers, determination is made by sufficiently taking into consideration such facts.

2. Trademarks with parts indicating another person's famous trademark

(1) A combination of another person's famous trademark and other characters or figures are, in principle, handled based on the presumption that it may cause confusion over the source of the goods, etc., including those trademarks for which the description of the composition of appearance is well united or conceptually related.

However, exemptions will be made when another person's well-known trademark constitutes part of an established word, or, when it is clear that the source will not be confused in relation to the designated goods or designated services.

(Example) Cases that fall under this item

- (i) The trademark as applied "arenoma/アレノマ" for the goods "clothing" and the famous trademark "renoma" and "レノマ" for the goods "bags"
- (ii) The trademark as applied "パー・ソニー" [PER SONY], "PER SONY" or "PERSONY" for the goods "toys" and the famous trademark "SONY" for the goods "electric machinery and apparatus"

(Example) Cases that do not fall under this item

The trademark as applied "POLAROID" for the goods "cameras" and the famous trademark

"POLA" for the goods "cosmetics"

(Explanation) It will be determined that the two trademarks are unlikely to cause confusion in relation to the designated goods or designated services.

(2) The items of Article 4(1) must be handled in the following manners in relation to a trademark with its part indicating a famous trademark of another person:

(i) Case where the trademark is determined to fall under Article 4(1)(x)

When the relevant trademark is found to be similar to another person's famous unregistered trademark and to be used for goods, etc. identical with or similar to the goods, etc. for which the unregistered trademark is used.

(ii) Case where the trademark is determined to fall under Article 4(1)(xi)

When a trademark is found to be similar to another person's famous registered trademark and to be used for goods or services identical with or similar to the designated goods or designated services pertaining to that registered famous trademark.

(iii) Case where the trademark is determined to fall under Article 4(1)(xv)

When a trademark is recognized as not similar to another person's famous trademark or is similar to another person's famous trademark but goods or services are not similar to each other, the trademark is liable to cause confusion over the source of goods or services.

(iv) Case where the trademark is determined to fall under Article 4(1)(xix)

When a trademark is similar to another person's famous trademark but the goods or services are not similar to each other and the trademark is not liable to cause confusion over the source of goods or services, the trademark is used for unfair purposes.

3. Three-dimensional trademarks indicating the shape of buildings, etc.

(1) If the shape of a building (including the shape of the interior; the same shall apply hereinafter) is well known among Japanese consumers as the shape of another person's building before an application is filed for it, the relevant three-dimensional trademark falls under this item.

(2) The shapes of stores, offices or facilities which do not fall under the category of buildings (including the shapes of the interior) are handled in the same manner as above.

(Examples of stores, offices, or facilities which do not fall under the category of buildings)

Mobile vending vehicles, sightseeing vehicles, passenger airplanes, and passenger ships

4. In determining whether or not the relevant mark is famous, trademarks registered as a defensive

mark or trademarks found to be famous in trial decisions, objections or judgments (note) are handled as famous trademarks according to such registration or finding.

(Note) These trademarks can be searched from the page "Searching Japanese Well-Known Trademarks" on the website "Japan Platform for Patent Information (J-PlatPat)."

(Reference) For other materials related to "trademarks well known among consumers," refer to Examination Manuals for Trademarks.