

Chapter 17: 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)

(xix) A trademark being identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);

1. Regarding "a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person"

(1) Regarding the recognition of consumers

Part III, Chapter 9, Item 1 (Article 4(1)(x)) of the Guidelines applies *mutatis mutandis* to the determination on whether or not the relevant trademark is well known among consumers.

(2) Regarding "trademarks well known among consumers abroad"

The trademark must be well known in one country other than Japan but is not necessarily required to be well known in several countries. In addition, when the trademark is well known abroad, the fact as to whether or not the trademark is well known in Japan is disregarded.

2. Regarding the expression "a trademark is identical with or similar to"

A combination of another person's trademark "well known among consumers" and other characters or figures are judged to be similar to the unregistered trademark including those trademarks for which the description of the composition of appearance is well united or conceptually related.

However, in cases where it is clear that the other person's trademark constitutes part of an established word or other cases, the 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)) the Guidelines.

3. Regarding "unfair purposes"

(1) Matters to be taken into consideration

A judgment on an "unfair purposes" must be made with full consideration given to the following facts, if materials mentioned in (i) to (vi) below are available.

- (i) Materials proving a fact that another person's trademark is well known among consumers
- (ii) Materials showing that a well-known trademark is composed of a coined word or has a distinctive feature in composition
- (iii) Materials proving a fact that the owner of a well-known trademark has a concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)
- (iv) Materials proving a fact that the owner of a well-known trademark has a plan to expand its business in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.)
- (v) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc. or a fact that the applicant is seeking to prevent foreign right holders from entering the Japanese market
- (vi) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark

(2) Case where the trademark is presumed to be used for unfair purposes

A trademark contained in an application for trademark registration which satisfies the requirements mentioned in (i) and (ii) below is treated by presuming them as those using another person's trademark for unfair purposes.

- (i) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.
- (ii) The above-mentioned well-known trademark is composed of a coined word or has a distinctive feature in composition.

4. Regarding the determination on the applicability of this item

Applicability of this item is determined by taking into consideration in a comprehensive manner the judging factors such as the degree of being well known, the relevant trademark's degree of being identical with or similar to another person's trademark and unfair purposes.

(Example) Case where the trademarks fall under this item

- (i) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract

(ii) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of goods.