

Part XIV: Article 64 (Requirements for defensive mark registration)

Article 64 (1) Where a registered trademark pertaining to goods is well known among consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.

(2) Where a registered trademark pertaining to services is well known among consumers as that indicating the designated services in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with services other than the designated services pertaining to the registered trademark or services similar thereto or in connection with goods other than those similar to the designated services is likely to cause confusion between the said other person's services or goods and the designated services pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the services or goods for which the likelihood of confusion exists.

(3) For the purpose of the application of the preceding two paragraphs in relation to defensive mark registrations pertaining to a trademark right pertaining to a regionally collective trademark, the term "his/her own" in the said paragraphs shall be deemed to be replaced with "its own or its members' ."

1. Regarding the expression "well known among consumers"

(1) The expression "well-known among consumers" means that the trademark is recognized by the consumers of the goods or services across the country as the indication of source of the applicant (holder of the original registered trademark).

(2) The determination on whether or not a trademark is "well known among consumers" is determined in a comprehensive manner by taking into consideration the matters set out in (a) to (d) below.

(a) The start and duration of use of a registered trademark relating to an application for the

registration of a defensive mark (hereinafter referred to the "original registered trademark"), areas of its use, goods or services connected with its use, etc.;

(b) the degree or dissemination of an advertisement, publication, etc. of the original registered trademark;

(c) the scale of business of the holder of the original registered trademark, with consideration given to the relationship of the designated goods or designated services its business scale, business activities (state of production or sale, etc.); and

(d) the recognition of the original registered trademark's being famous by the Patent Office such as the fact of such famousness being found in trial decisions or judgments.

2. Marks contained in the application for registration of defensive marks must be identical with the original registered mark (including those different in size).

3. Determination on the identity of the original registered trademark and trademark as used

Part II, Item 1(1) (Article 3(2)) of the Guidelines applies *mutatis mutandis* to the judgment on identity.

4. Regarding the case when it "is likely to cause confusion" as to the source of goods or services

(1) The abovementioned case not only refers to the case where the consumers of the relevant goods or services (hereinafter referred to as "goods, etc.") are likely to be misled that such goods, etc. are those pertaining to the business of the holder of the original registered trademark and to be confused as to the source of the goods, etc. but also to the case where the consumers are likely to be misled that the goods, etc. are those pertaining to the business of a person who has an economic, organizational or any other relationship with the holder of the original registered trademark and to be confused as to the source of the goods, etc.

(2) Matters to be taken into consideration

The judgment on whether it "is likely to cause confusion" is made, for example, by taking into consideration, in a comprehensive manner, the following facts.

(i) How much the original registered trademark is well known

- (ii) Whether the original registered trademark consists of a coined word or has a distinctive feature in its composition
- (iii) Whether the original registered trademark is a house mark
- (iv) Whether there is any possibility of multiple management in the company
- (v) Whether there is any relationship between goods, services, or goods and services
- (vi) Whether there is any commonality between the consumers of goods, etc. and other actual state of transactions

In determining the state of being well-known as prescribed in (i) above, Part II, Item 2(2) and (3) (Article 3(2)) of the Guidelines applies *mutatis mutandis*.

5. Misleading as to the source of goods or services for which registration of a defensive mark is sought

A trademark including the common name of a good or service with an application for its registration covering goods or services other than the said goods or services is granted a registration as a defensive mark if it satisfies other requirements regardless of whether or not it will cause misleading as to the quality of the goods or services.