

## 47.101.06

### **Determining Similarity between a Filed Trademark and Another Person's Trademark**

#### 1. Approach for determining the similarity between a registered regional collective trademark and a later-filed trademark

Examiners shall apply Article 4(1)(xi) of the Trademark Act to the registered regional collective trademark based on the consideration that examiners have decided to register the trademark because the trademark is well known among consumers as an inseparable and unified trademark on the whole through its use.

Examiners shall always accord [the provisions of Item 1., Part 9: Article 4\(1\)\(xi\), Chapter III of the Examination Guidelines for Trademark](#) to determine the similarity of the later-filed trademark and the registered trademark, eventually based on the comprehensive analysis of components of the appearance, pronunciation, and concept of each trademark.

#### 2. Relationship between the regional collective trademark and the prior or later application filed by another person containing identical or similar characters to the regional collective trademark

##### 1) Relationship between the trademark of the filed application and the trademark of another person's prior application

When examiners analyze a registered regional collective trademark which was filed prior to the filed regional collective trademark and is composed of characters identical or similar to the later-filed trademark and distinctive figures or characters, examiners, in principle, shall not apply Article 4(1)(xi) of the Trademark Act to the later-filed trademark since the main component of the registered trademark consists of the figures or characters, and it is not similar to the filed regional collective trademark.

However, as an exception, when a regional collective trademark of the filed application is composed of well-known characters identical or similar to those of a registered regional collective trademark, which is a prior application to the filed application, examiners consider that the later-filed trademark indicates the source of the right holder of the trademark and apply Article 4(1)(xi) of the Trademark Act to the later application due to the similarity of the later-filed trademark to the registered trademark.


##### 2) Relationship between the trademark of the filed application and the trademark of another person's later application

When a regional collective trademark filed later than a registered regional collective trademark contains characters identical or similar to those in the registered trademark, the later-filed trademark is, in principle, considered to be identical or similar to the registered trademark based on the assumption that the trademark of the prior application has been

registered because of its well-known state among consumers and that the registered trademark might often attract consumers who conduct their business paying attention to the characters of the trademark.

Examples:

1. Trademarks to which Article 4(1)(xi) of the Trademark Act is applied

Designated goods	“東京都産のりんご” or Apples produced in Tokyo	Designated goods	“りんご” or Apples
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“東京リンゴ” or Tokyo Apples
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“とうきょうりんご” or Tokyo Apples
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“本場東京りんご” or Apples from Tokyo, the best place”
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“東京のりんご” or Apples from Tokyo
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“東京産りんご” or Apples produced in Tokyo
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	 or Tokyo Apples

Designated goods	“東京都産のりんご” or Apples produced in Tokyo	Designated goods	“東京都産のりんご” or Apples produced in Tokyo
Regional collective trademark	“東京産りんご” or Apples produced in Tokyo	Trademark of later application	“東京リンゴ” or Tokyo Apples

Designated goods	“東京都産のビール” or Beer produced in Tokyo	Designated goods	“ビール” or Beer
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“TOKYO BEER”
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“東京麦酒” or Tokyo Beer
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“トウキョウビール” or Tokyo Beer
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“東京ビール” or Tokyo Beer

Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“東京ビール” or Tokyo Beer
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“東京ビール倶楽部” or Tokyo Beer Club

2) Trademarks to which Article 4(1)(xi) of the Trademark Act is not applied

<b>Designated goods</b>	<b>“東京都産のりんご” or Apples produced in Tokyo</b>	<b>Designated goods</b>	<b>“みかん” or Oranges</b>
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“東京みかん” or Tokyo Oranges

<b>Designated goods</b>	<b>“東京都産のりんご” or Apples produced in Tokyo</b>	<b>Designated goods</b>	<b>“りんご” or Apples</b>
Regional collective trademark	“東京りんご” or Tokyo Apples	Trademark of later application	“江戸りんご” or Edo Apples

<b>Designated goods</b>	<b>“東京都産のビール” or Beer produced in Tokyo</b>	<b>Designated goods</b>	<b>“ビール” or Beer</b>
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“ビール東京” or Beer Tokyo
Regional collective trademark	“東京ビール” or Tokyo Beer	Trademark of later application	“東京限定ビール” or Beer limited in Tokyo

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

[Article 4\(1\)\(xi\) \(Another Person’s Registered Trademark Applied for Prior to the Filing Date of the Trademark Application Concerned\)](#)

[Article 7-2 \(Regionally based collective trademark\)](#)