

(Reference)

How to Protect Reputed and Famous Marks in Japan

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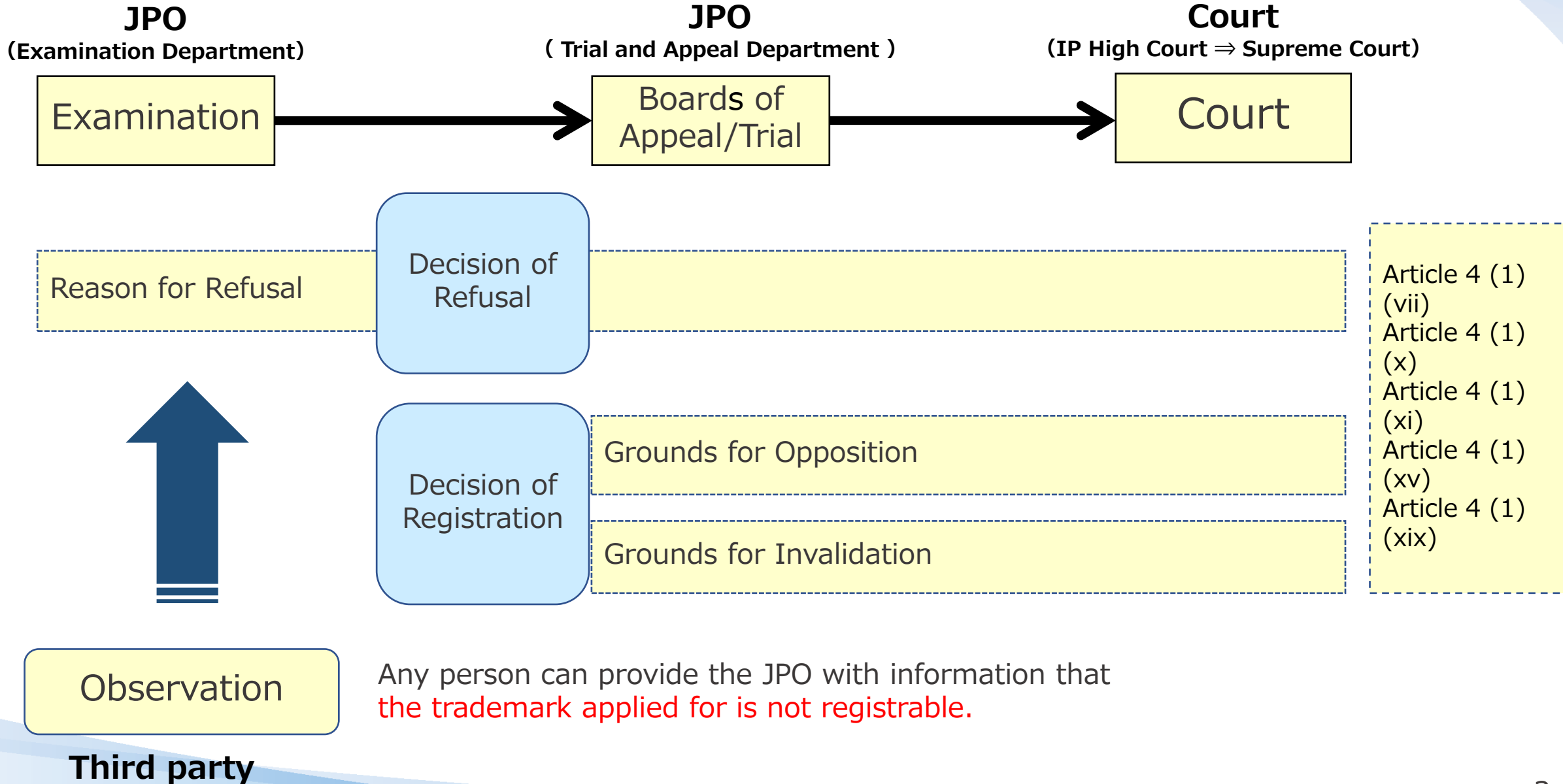
Trial and Appeal Division, Trial and Appeal Department (TAD)

Japan Patent Office (JPO)



Legal Framework to Protect Reputed and Famous Marks

Legal Framework to Protect Reputed and Famous Marks



Grounds for Refusal to Protect Reputed and Famous Marks

Grounds for Refusal to Protect Reputed and Famous Marks

Japanese Trademark Act

(Registered)

- **Article 4 (1) (xi)**
 - Registered mark
 - Trademark & goods (services) are identical or similar

(Unregistered)

- **Article 4 (1) (x)**
 - Well-known (in Japan)
 - Trademark & goods (services) are identical or similar
 - Unregistered mark can be protected
- **Article 4 (1) (xv)**
 - Famous (in Japan)
 - Confusion of source
 - Protected even if trademark or goods (services) are dissimilar
 - Unregistered mark can be protected
- **Article 4 (1) (xix)**
 - Well-known (only in foreign country is okay)
 - Unfair purposes
 - Trademark is identical or similar
 - Unregistered mark can be protected
- **Article 4 (1) (vii)**
 - Violation of public order or morality

Provisions : Article 4 (1) (xi)

Article 4(1)(xi)

A trademark being identical with, or similar to, **another person's registered trademark** that 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 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;

- **Registered mark**
- **Trademark & goods (services) are identical or similar**

Provisions : Article 4 (1) (xi)

Points to be considered

- A combination of another person's well-known registered trademark and other characters or figures, **including those trademarks for which the description of the composition of appearance is well united or conceptually related**, is 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:

"LOVE L'OREAL" and "L'OREAL" and "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"

"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"

Provisions : Article 4 (1) (x)

Article 4 (1) (x)

A trademark identical with, or similar to, another person's trademark **which is well known among consumers** as that indicating goods or services in connection with the person's business, if the trademark is used in connection with the goods or services or goods or services similar thereto

- **Well-known (in Japan)**
- **Trademark & goods (services) are identical or similar**
- **Unregistered mark can be protected**

Judgement on Well-known Mark : Article 4 (1) (x)

Consumer's recognition

- Including a trademark that is well-known not only among end consumers, **but also among traders in the industry.**
- Including not only a trademark that is known throughout the country, **but also a trademark that is well known in a certain area.**

Judgement on Well-known Mark : Article 4 (1) (x)

Points to be considered

- ① The composition and mode of the trademark in an application.
- ② The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use and areas of use of the trademark.
- ③ The method, period, areas and scale of advertising.
- ④ Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, “the applicant or a person other than its members”) and states of its use.
- ⑤ The characteristics of the goods or services and the actual state of their transaction.
- ⑥ The outcome of the questionnaire regarding consumers’ awareness of the trademark.

Judgement on Well-known Mark : Article 4 (1) (x)

Points to be considered

- **Cases of goods or services with a special form of transaction**

(Examples: "medicines and drugs for medical use" and "test, examination or research of drugs.")

→ Due consideration should be given to the fact that the goods or services in question are distributed or provided only in specific markets.

- **Cases of trademarks that are mainly used in foreign countries**

→ Due consideration should be given to the fact that: (i) the trademark in question is well-known in a foreign country; (ii) goods bearing the trademark are exported to several countries; or (iii) services bearing the trademark are provided in several countries.

Judgement on Well-known Mark : Article 4 (1) (x)

Points to be considered

Determination regarding trademarks that have been approved as trademarks well known among consumers in trial decisions, decisions on oppositions, or judgments is made by sufficiently taking into consideration the facts found.

Judgement on Well-known Mark : Article 4 (1) (x)

Evidence to be considered

- ① Photographs, movies, etc. showing the actual state of use of a trademark.
- ② Business documents (order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.).
- ③ Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving her/his past record.
- ④ Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application that is used by persons other than the applicant.
- ⑤ Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (however, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to a person conducting the marketing research, method, and respondents).

Provisions : Article 4 (1) (xv)

Article 4(1)(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).

- **Famous (in Japan)**
- **Confusion of source**
- **Protected even if trademark or goods (services) are dissimilar**
- **Unregistered mark can be protected**

Provisions : Article 4 (1) (xv)

Points to be considered

- Case where the consumers of goods or services (hereinafter "goods, etc.") are likely to be confused over the source of the goods, when these are mistakenly recognized as being connected with the business of other persons.
- Case where the consumers of the goods are likely to be confused over the source of the goods, when these are mistakenly **recognized as being connected with the business of a person who has a certain economic or organizational relationship with the other persons.**

Provisions : Article 4 (1) (xv)

Points to be considered

- ① The degree of similarity between the trademark in the application and the other person's mark.
- ② The degree to which the other person's trademark is well-known.
- ③ Whether the other person's trademark consists of a coined word or has a distinctive feature in its composition.
- ④ Whether the other person's trademark is a house mark.
- ⑤ Whether there is the possibility of diversified management in the company.
- ⑥ Whether there is any relationship between goods, services or goods and services.
- ⑦ Whether there is any commonality between the consumers of goods, etc. and other actual states of transactions.

Provisions : Article 4 (1) (xv)

Points to be considered

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

Provisions : Article 4 (1) (xv)

Points to be considered

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, decisions on oppositions, or judgments are handled as famous trademarks according to such registration or finding.

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National Center for Industrial Property Information and Training

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Home > Japanese Well-known Trademark Search

Japanese Well-known Trademark Search

You can retrieve trademarks registered as defensive marks and registered in trial decisions, trials, or judgment from, for example, trademark names and trademark publications. For cautions regarding the use of "Japanese Well-known Trademark Search", please refer to the "Notice on Use of Japanese Well-known Trademark Search" on the website.

Search keywords

Search item: Trademark (for search) | Keyword: Ex: 特許庁?特許? 特許?

AND

Search item: Reading (katakana) | Keyword: Ex: トッキョチヨウ

Provisions : Article 4 (1) (xv)

Evidence to be considered ⇒ the same as Article 4 (1) (x)

- ① Photographs, movies, etc. showing the actual state of use of a trademark.
- ② Business documents (order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.).
- ③ Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving her/his past record.
- ④ Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application that is used by persons other than the applicant.
- ⑤ Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (however, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to a person conducting the marketing research, method, and respondents).

Provisions : Article 4 (1) (xix)

Article 4(1)(xix)

A trademark being identical with, or similar to, a trademark that 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 **wrongful purposes** (referring to the purpose of gaining wrongful profits, the purpose of causing damage to the other person, or any other wrongful purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items);

- **Well-known (only in foreign country is enough)**
- **Wrongful purposes**
- **Trademark is identical or similar**
- **Unregistered mark can be protected**

Judgement on Well-known Mark : Article 4 (1) (xix)

Consumer's recognition ⇒ the same as Article 4 (1) (x)

- Including not only a trademark that is well known among end consumers, **but also a trademark that is well known among traders in the industry.**
- Including not only a trademark that is known throughout the country, **but also a trademark that is well known in a certain area.**

Judgement on Well-known Mark : Article 4 (1) (xix)

Points to be considered ⇒ the same as Article 4 (1) (x)

- ① The composition and mode of the trademark in an application.
- ② The mode of use, volume of use (an amount of production and an amount of sales, etc.), period of use and areas of use of the trademark.
- ③ The method, period, areas and scale of advertising.
- ④ Whether a mark identical with or similar to the trademark in an application is used by any person other than the applicant (in case of an application for collective trademark registration, “the applicant or a person other than its members”) and states of its use.
- ⑤ The characteristics of the goods or services and the actual state of their transaction.
- ⑥ The outcome of the questionnaire regarding consumers’ awareness of the trademark.

Judgement on Well-known Mark : Article 4 (1) (xix)

Points to be considered

"Trademark that is 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).
- When the trademark is well-known abroad, the fact of whether or not the trademark is well-known in Japan is disregarded.

Judgement on Well-known Mark : Article 4 (1) (xix)

Evidence to be considered ⇒ the same as Article 4 (1) (x)

- ① Photographs, movies, etc. showing the actual state of use of a trademark.
- ② Business documents (order slips (purchase orders), shipment slips, invoices (delivery slips and certificates of receipt), bills, receipts, account books, etc.).
- ③ Advertisements (newspapers, magazines, catalogues, leaflets, TV commercials, etc.) used by the applicant and proofs proving her/his past record.
- ④ Articles in general newspapers, trade journals, magazines and the Internet presenting the trademark in an application that is used by persons other than the applicant.
- ⑤ Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark (however, due consideration will be given to the objectivity and neutrality of the questionnaire with respect to a person conducting the marketing research, method, and respondents).

Judgement on Wrongful Purpose : Article 4 (1) (xix)

Points to be considered

- ① Another person's trademark is well-known among consumers.
- ② A well-known trademark is composed of a coined word or has a distinctive feature in composition.
- ③ The holder of a well-known trademark has a concrete plan to make a market entry in Japan.
- ④ The holder of a well-known trademark has a plan to expand its business in the near future.
- ⑤ The holder of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of the trademark in the application, the conclusion of an agent contract, etc.
- ⑥ A trademark, if used by its applicant, is liable to damage goodwill, reputation, customer attraction.

Judgement on Wrongful Purpose : Article 4 (1) (xix)

■ Case where the trademark is presumed to be used for wrongful purposes

- The trademark is identical or very similar to a well-known trademark.
- The well-known trademark is composed of a coined word or has a distinctive feature in composition.

Judgement on Wrongful Purpose : Article 4 (1) (xix)

Whether the trademark falls under 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 wrongful purposes.

Trademarks that fall under this item

- If an application for registration is filed for a trademark identical with or similar to another person's trademark that is well known in a foreign country, in an attempt to:
 - **Force the holder of the foreign trademark to purchase the trademark in the application at a high price;**
 - **Prevent a market entry of the holder of that foreign trademark; or**
 - **Force the holder of the foreign trademark to conclude an agent contract with the applicant.**
- If an application for registration is filed for a trademark identical with or similar to a trademark that is well-known throughout Japan, in an attempt to:
 - **Dilute the distinctiveness of the well-known trademark as an identifier of the source of goods or damage the reputation, etc. of the trademark holder.**

(Reference) Article 4 (1) (vii) Violation of Public Order and Morality

Article 4(1)(vii)



A trademark that is likely to cause damage to public order or morality.

Trademarks that fall under this item

Trademarks whose registration is contrary to the order predetermined under the Trademark Act, and is utterly unacceptable for lack of social reasonableness with respect to the filing of an application for trademark registration.

Case Study regarding Iconic Marks: Cases of APPLE and PUMA in Japan

Case Study: Trial for Invalidation: Apple Inc. (Invalidation 2020-890049)

Trademark in the application		Cited trademark	
	SHERRY Co., Ltd.		Apple Inc.
	CLASS 9: protective covers for smartphones, cases for smartphones, protective covers for tablet computers, cases for tablet computers, cases for laptops.		CLASS 9: smartphones, tablet computers, laptop computers, etc.



Summary of the Trial Decision

<Issues in the trial for invalidation: whether the trademark falls under Article 4(1)(xi), (xv) and (xix)>

- The cited trademark was well known among traders and consumers as a trademark indicating computers and related goods and services pertaining to the demandant's business. Although the designated goods of the trademark in the application are related to a portion of the computers and related goods and services pertaining to the demandant's business and may share some of the same consumers, the trademark in the application and the cited trademark are dissimilar trademarks; therefore, the degree of similarity between them is low.
- Consequently, even if the holder of the trademark right in the application uses it in connection with the designated goods, there is no likelihood of causing confusion among traders and consumers as to the source of the goods and services, such that traders and consumers coming into contact with the trademark would believe the goods to be associated with the business of another person (demandant) or a person with which the demandant has some economic or organizational relationship.

[Conclusion] The Trademark does not fall under Article 4(1)(xi), (xv) or (xix)

Case Study: Opposition to Registration of Trademark: Apple Inc. (Opposition 2025-900153)

Trademark in the application		Cited trademark	
	APPLE WORLD INC.		Apple Inc.
	CLASS 35: advertising and publicity services, marketing services, consulting on business strategy, etc. CLASS 39: planning, arranging and booking of travel, providing information on vehicle transportation, providing road and traffic information, etc. CLASS 43: providing lodging and related information, preparation and provision of food and drink, providing information on food and beverage services, etc.		CLASS 9: smartphones, tablet computers, laptop computers, etc.



Summary of the Decision

<Issues in the opposition: whether the trademark falls under Article 4(1)(xv)>

- The cited trademark is well-known in relation to the demandant's goods, but it is not well-known in relation to other goods and services. Furthermore, it cannot be said that the trademark in the application bears only a low degree of similarity to the cited trademark, and there is no connection between the designated services subject to the opposition and the demandant's goods.
- Consequently, when the holder of trademark right in the application uses it for its designated goods, it is unlikely that traders or consumers coming into contact with it would recall the cited trademark or associate it with the cited trademark. Therefore, there is no risk that they would mistakenly believe the services to be those of another person (demandant) or of a person with which the demandant has some economic or organizational relationship, nor is there a risk of causing confusion as to the source of the services.

[Conclusion] The Trademark does not fall under Article 4(1)(xv)

Case Study: Opposition to Registration of Trademark: Apple Inc. (Opposition 2024-900008)

Trademark in the application		Cited trademark	
 Apple GYM	REXIV Inc. CLASS 41: provision of facilities for sports, health club services [health and fitness training], educational and instruction services relating to arts, crafts, sports or general knowledge, personal trainer services [fitness training], conducting fitness classes, etc.	(No. 1, 2, 4, 5) (No. 6, 8) APPLE  (No. 9) APPLE FITNESS+	Apple Inc. CLASS 9: smartphones, tablet computers, laptop computers, etc.

Summary of the Decision



<Issues in the opposition: whether the trademark falls under Article 4(1)(xi) and (xv)>

- The cited trademark is well-known in relation to the demandant's goods, but it is not well-known in relation to other goods and services. Furthermore, it cannot be said that the trademark in the application bears only a low degree of similarity to the cited trademark, and there is no connection between the designated services subject to the opposition and the demandant's goods.
- Consequently, when the holder of trademark right in the application uses it for its designated goods, it is unlikely that traders or consumers coming into contact with it would recall the cited trademark or associate it with the cited trademark. Therefore, there is no risk that they would mistakenly believe the services to be those of another person (demandant) or of a person with which the demandant has some economic or organizational relationship, nor is there a risk of causing confusion as to the source of the services.

[Conclusion] The Trademark does not fall under Article 4(1)(xi) and (xv)

Case Study: Revocation Action against a Trial Decision : PUMA (1)

(Judgment of the Intellectual Property High Court, June 27, 2013 (2012(Gyo-Ke)10454))

Disputed trademark		Cited trademark	
	Hokkaido Design Kabushiki Kaisha		Puma AG Rudolf Dassler Sport
	CLASS 25: clothes, coats, sweaters and similar items, shirts, nightwear, underwear, bathing suits, bathing caps, traditional Japanese clothing, aprons, socks, scarves, gloves, neckties, mufflers [clothing], hats, belts, special clothing for sports, special footwear for sports (other than horse-riding boots).		Widely used in a variety of products, including sports shoes, hats, polo shirts, T-shirts, shorts, socks, and watches.




Summary of the Judgment

<Issues in the revocation action against the trial decision: whether the trademark falls under Article 4(1)(xii) and (xv)>

- “The use of the Trademark for the designated goods could cause confusion with regard to the source of the goods because traders and consumers would ... associate it with the Cited Trademark, which has become well-known and famous among consumers, and mistakenly believe that the goods pertain to the business of the defendant or the business of a company that has an economic or any other relationship with the defendant.”
- “It may be recognized that the plaintiff, which was aware that the Cited Trademark is famous, created the Trademark consisting of four alphabetic characters intentionally written in almost the same manner as the Cited Trademark and a figure of a bear as a replacement of the puma used for the Cited Trademark in order to ensure that the overall configuration of the Trademark looks extremely similar to that of the Cited Trademark so that traders and consumers who come across the Trademark would associate the Trademark with the Cited Trademark. The plaintiff created the Trademark, filed an applications for registration of the Trademark, and had it registered for the wrongful purposes of free-riding the goodwill, reputation, and customer attraction embodied by the Cited Trademark. The plaintiff may be recognized to have had the Trademark assigned from plaintiff with the awareness of the circumstances described above.”
- “The use of the Trademark for the designated goods could dilute the source-indicating function of the Cited Trademark and damage the goodwill, reputation, and customer attraction embodied by the Cited Trademark and eventually the defendant's goodwill.”

[Conclusion] The Trademark falls under Article 4(1)(vii) and (xv).

Case Study: Appeal against an Examiner's Decision of Refusal: PUMA (Appeal 2008-010902, Appeal 2008-010900)

Trademark in the application		Cited trademark	
(No. 1)	(No. 2)		Puma AG Rudolf Dassler Sport Widely used in a variety of products, including sports shoes, hats, polo shirts, T-shirts, shorts, socks, and watches.
			
		NIPPON KANKO SHOJI CO., LTD. CLASS 25: clothes, coats, sweaters and similar items, shirts, nightwear, underwear, bathing suits, bathing caps, traditional Japanese clothing, aprons, socks, scarves, gloves, neckties, mufflers [clothing], hats, belts, special clothing for sports, special footwear for sports (other than horse-riding boots).	

Summary of the Appeal Decision



<Issues in the appeal: whether the trademark falls under Article 4(1)(vii)

- It must be concluded that the demandant (applicant) filed the application for the trademark with the intent to obtain registration by imitating the characteristics of the cited trademark, with full knowledge that it is a trademark used by Puma for many years on sports shoes and other products and well known among traders and consumers, and without the consent of the holder of the cited trademark, for the purpose of free-riding on the goodwill, reputation, and customer attraction embodied in the cited trademark and obtaining unjust profits. It must be also concluded that such conduct risks diluting or damaging the goodwill, reputation, and customer attraction embodied in the cited trademark itself.
- As stated above, the registration of the trademark in the application would constitute a case that is utterly unacceptable as it violates the spirit of the Trademark Act—which ensures that “the business of a person who uses a trademark can maintain credibility, as a result, contributing to industry development and protecting the interests of consumers, through the protection of trademarks.” (Article 1)—and is contrary to the order of commercial transactions; it must therefore be deemed contrary to business ethics and the public interest.

[Conclusion] The Trademark falls under Article 4(1)(vii).

Case Study: Revocation Action against a Trial Decision : PUMA (2)

(Judgment of the Intellectual Property High Court, July 12, 2010 (2009(Gyo-Ke)10404)

Disputed trademark		Cited trademark	
	UEHARA Shunichi		Puma AG Rudolf Dassler Sport
	CLASS 25: T-shirts, hats.		CLASS 25: clothing, garters, sock holders, suspenders, bands, belts, footwear, special clothing for sports, special footwear for sports.

Summary of the Judgment



<Issues in the revocation action against the decision: whether the trademark falls under Article 4(1)(xi), (xv) and (xix)>

- “Their appearances significantly differ from each other, and in particular, a large difference is that in the Trademark, character string "SHI-SA," which is arranged at the center, is emphasized and the animal figure part is arranged in silhouette on the right side thereof while Cited Trademark A does not have such appearance.”
- It should be said that ... the designated goods are not likely to be erroneously believed as the goods pertaining to the business of ... a business owner who is in ... the relationship of being the members of a group engaging in commercialization business by the same indication as the holder of the cited trademark
- The Trademark and Cited Trademark ... differ in pronunciation and concept and are not necessarily considered as similar in appearance. Therefore, the trademarks should be considered as not being similar to each other.

[Conclusion] The Trademark does not fall under any of the following: Article 4(1)(xi), (xv) or (xix).

Case Study: Revocation Action against a Trial Decision : PUMA (3)

(Judgment of the Intellectual Property High Court, March 26, 2019(2017 (Gyo-Ke) 10206)

Trademark in the application		Cited trademark	
	UEHARA Shunichi		Puma AG Rudolf Dassler Sport
	CLASS 25: T-shirts, hats.		CLASS 25: clothing, garters, sock holders, suspenders, bands, belts, footwear, masquerade costumes, special clothing for sports, special footwear for sports, etc.

Summary of the Judgment

<Issues in the revocation action against the decision: whether the trademark falls under Article 4(1)(xv)>

- Although the trademark and the cited trademark differ in terms of their silhouettes and the presence of white-line patterns within them, their overall silhouettes are similar. In the trademark, the tooth-like patterns formed by the white lines inside, the ornament-like patterns around the neck, the ornament-like or curly-haired patterns at the joints of the front and hind legs, and the white lines generally arranged along the profile line account for a relatively small portion of the overall silhouette; therefore, it can be said that the overall appearance impression of the two is quite similar.
- Since the designated goods for the trademark are “T-shirts and hats,” and since T-shirts and hats are also available under the “PUMA” brand — including goods affixed with a figure similar to that of the cited trademark — it can be said that the designated goods for the trademark are related to the goods related to the demandant’s business in terms of their nature, intended purpose, and purpose; and a commonality is found among traders and consumers.
- Taking all these circumstances into account, based on the level of attention typically exercised by traders and consumers of the designated goods — namely, T-shirts and hats — it is found that, when the trademark is used on the designated goods, the designated goods are likely to be erroneously believed as the goods related to the business of the demandant or a business owner who has a close business relationship with the demandant or is a member of a group engaging in commercialization business by the same indication as the demandant.

[Conclusion] The Trademark falls under Article 4(1)(xv).

Thank you

Trial and Appeal Division, Trial and Appeal Department (TAD)
Japan Patent Office

