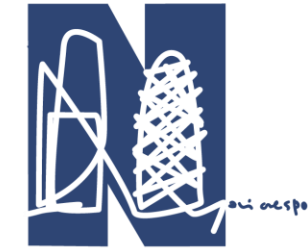


INTA ANNUAL MEETING

London, England | May 2-6, 2026



Comparison of composite marks in a likelihood of confusion analysis in Japan

MUNAKATA Saho
Specialist for Trademark Planning
Trademark Division
Japan Patent Office (JPO)

Table of Contents



1. Criteria for Assessing Trade Mark Similarity

- Statute & Examination Guidelines
- Limited Circumstances Where Focus May Be Placed on a Particular Component of a Composite Mark

2. Key Case Law on Composite Marks

- Empire Steak House case
- Reebok Royal Flag case
- Keyaki case

3. Practical Takeaways



1. Criteria for Assessing Trade Mark Similarity

1. Criteria for Assessing Trade Mark Similarity



What is “composite mark” ?

Ovation Stem

UNITED GOLD



1. Criteria for Assessing Trade Mark Similarity



Trademark Act

Article 4(1)(xi)

A trademark being identical with, or similar to, another person's registered trademark which 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 designated services relating to the said registered trademark or goods or services similar thereto;

1. Criteria for Assessing Trade Mark Similarity



Examination Guidelines

<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/0310.pdf> (in English)

- The trade mark similarity is assessed by determining whether use of the applied-for mark on the goods or services at issue would be likely to cause confusion with the cited mark as to the source, base on **the overall impression created by the mark as a whole** in the perception of the relevant public taking into account its:
 - ✓ Appearance (visual aspect)
 - ✓ Sound (phonetic aspect)
 - ✓ Concept (conceptual aspect)

- Consideration should be given to:
 - trade practice relevant to the goods or services at issue; and
 - the level of attentiveness of the relevant public.

1. Criteria for Assessing Trade Mark Similarity



A component of a composite mark may be focused on as a dominant element in assessing similarity where:


1. the constituent elements are **not so closely integrated** that it would be **unnatural** for the relevant public to **perceive them separately**;
 - ✓ difference in the font size, color, font, and type of characters
 - ✓ the trademark is written in an extremely separated manner
 - ✓ the trademark has a long sound
 - ✓ the trademark has no conceptual relationship
1. the particular component **independently creates a strong and dominant impression** as identifying the commercial source of the goods or services;
2. the remaining elements **lack independent phonetic or conceptual significance** as indicators of origin.

1. Criteria for Assessing Trade Mark Similarity

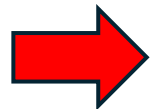


Example 1:

Trademarks in which figures and words/letters appear separately

Applied-for Mark	Prior Mark
 KANGOL	KANGOL (standard character)

Designated Services:
Class 35 Retail services or wholesale services for clothing etc.



Similar
“KANGOL” constitutes a dominant and independently source-identifying element.



1. Criteria for Assessing Trade Mark Similarity

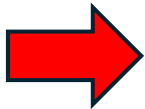


Example 2:

Trademarks that incorporate words/letters within a figure

Applied-for Mark	Prior Mark
 The applied-for trademark for Marie Gold biscuits. It features a yellow background with a red speech bubble containing the words 'MARIE GOLD' in white. To the right is a round biscuit with a cow illustration, a small white pitcher, and a cow in a field.	 The prior trademark, which consists of the word 'MARIE' in white, serif capital letters centered on a solid red square background.

Designated Goods and Services:
Class 30 Biscuits, cookies etc.



Dissimilar

“MARIE” does **NOT** constitutes a dominant and independently source-identifying element.




1. Criteria for Assessing Trade Mark Similarity

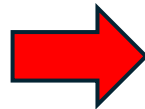


Example 3:

Trademarks that incorporate words/letters within a figure

Applied-for Mark	Prior Mark
Explore Your Life (standard character)	 The logo for Tamsaú, featuring a circular emblem with the text 'EXPLORE YOUR LIFE' at the top and 'Tamsaú' at the bottom. Inside the circle is a stylized figure holding a globe, with a checkmark below it.

Designated Goods:
Class 18 Bags etc. , Class 25 Clothing etc.



Similar

“Explore Your Life” constitutes a dominant and independently source-identifying element.



1. Criteria for Assessing Trade Mark Similarity



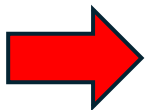
Example 4:

Trademarks consisting of a combination of multiple words/letters

Applied-for Mark	Prior Mark
UNITED GOLD (standard character)	UNITED

Designated Goods:

Class 25 suits etc. , Class 35 Retail services or wholesale services for clothing etc.



Dissimilar

“UNITED” does **NOT** constitutes a dominant and independently source-identifying element.



1. Criteria for Assessing Trade Mark Similarity



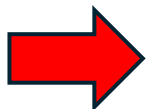
Example 5:

Trademarks consisting of a combination of multiple words/letters

Applied-for Mark	Prior Mark
Ovation Stem (standard character)	OVATION

Designated Goods:

Class 10 Femoral stem for total hip replacement (total hip replacement components)



Similar

“Ovation” constitutes a dominant and independently source-identifying element.





2. Key Case Law on Composite Marks

2. Key Case Law on Composite Marks

Case 1: Empire Steak House case

(Date of Judgement: January 17th, 2023)



vs. E M P I R E
(standard characters)

Designated Services: Class 43 Providing steaks etc

Appeal case against the JPO Decision

Examination	Similar
Appeal	Similar
IP High Court	Similar

2. Key Case Law on Composite Marks



Case 1: Empire Steak House case Court's Reasoning



vs. E M P I R E

- ✓ The figurative element depicting a bull and the wording “Empire Steak House” are **clearly distinguishable** from each other on visual inspection.
- ✓ “STEAK HOUSE,” being descriptive of the designated services (the provision of steaks), **has little or no ability to distinguish** those services from those of other undertakings.
- ✓ By contrast, “EMPIRE” conveys a **strong and dominant impression** to the relevant public as an indicator of the commercial origin of the services in question.
- ✓ Accordingly, it is appropriate to focus on “EMPIRE” as the **dominant element** and to compare it with the cited trade mark when assessing similarity.

2. Key Case Law on Composite Marks

Case 2: Reebok Royal Flag case

(Date of Judgement: January 20th, 2016)

Reebok



ROYAL FLAG

vs.

ROYAL FLAG

Designated Services: Class 25 Footwear, special footwear for sports, etc

Appeal case against the JPO Decision

Examination

Similar

Appeal

Similar

IP High Court

Dissimilar

16

2. Key Case Law on Composite Marks



Case 2: Reebok Royal Flag case

Reebok



ROYAL FLAG

vs. ROYAL FLAG

Court's Reasoning

- ✓ As “Reebok” was widely recognised among the relevant public in Japan, it conveys a **strong and dominant impression** as a mark indicating the commercial origin of the goods.
- ✓ The applied-for mark is presented as a coherent whole, and the wording “ROYAL FLAG” appears in a standard typeface and in a significantly smaller size than “Reebok.”
- ✓ When contrasted with “Reebok,” the “ROYAL FLAG” element does not **convey a strong or dominant impression** as an indicator of the origin of the goods to the relevant public.
- ✓ Accordingly, it is **not appropriate to focus solely on “ROYAL FLAG”** and compare it with the cited trade mark when assessing similarity.

2. Key Case Law on Composite Marks

Case 3: KEYAKI case

(Date of Judgement: October 30th, 2025)



VS.



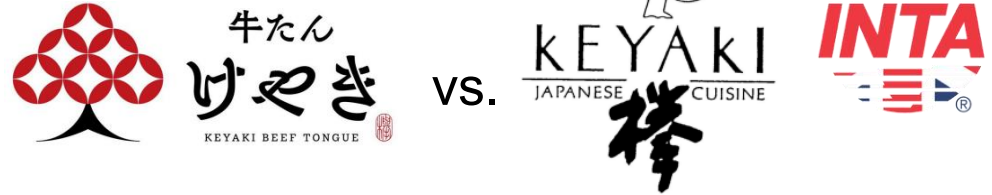
Designated Services: Class 43 providing foods and beverages

Appeal case against the JPO Decision

Examination	Similar
Appeal	Similar
IP High Court	Dissimilar

2. Key Case Law on Composite Marks

Case 3: KEYAKI case Court's Reasoning



- ✓ The applied-for trade mark and the cited trade mark **lack strong overall unity**, and the relevant public is likely to perceive and understand “KEYAKI” (represented in Hiragana characters in the centre of the applied-for mark and in alphabet characters in the centre of the cited mark) as a separate element.
- ✓ “KEYAKI,” meaning the name of a tree, has **a certain degree of source-indicating significance** in relation to the service at issue, namely the provision of food and drink.
- ✓ However, because “KEYAKI” is relatively commonly used as a restaurant name in Japan, it has **low inherent distinctiveness** for distinguishing the services from those of other undertakings.
- ✓ • The applied-for trade mark and the cited trade mark are **clearly distinct in their visual appearance**.

3. Practical Takeaways



- As a general rule, trade mark similarity is assessed based on the overall impression of the mark as a whole.
- In limited circumstances, focus may be placed on a particular component of a composite mark.
- The degree of distinctiveness of each component may influence the assessment of similarity between the marks.

Thank you!



Speaker
Saho
Munakata

Specialist for Trademark Planning,
Trademark Division, Japan Patent
Office (JPO)



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