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How to determine the likelihood of confusion at the examination stage



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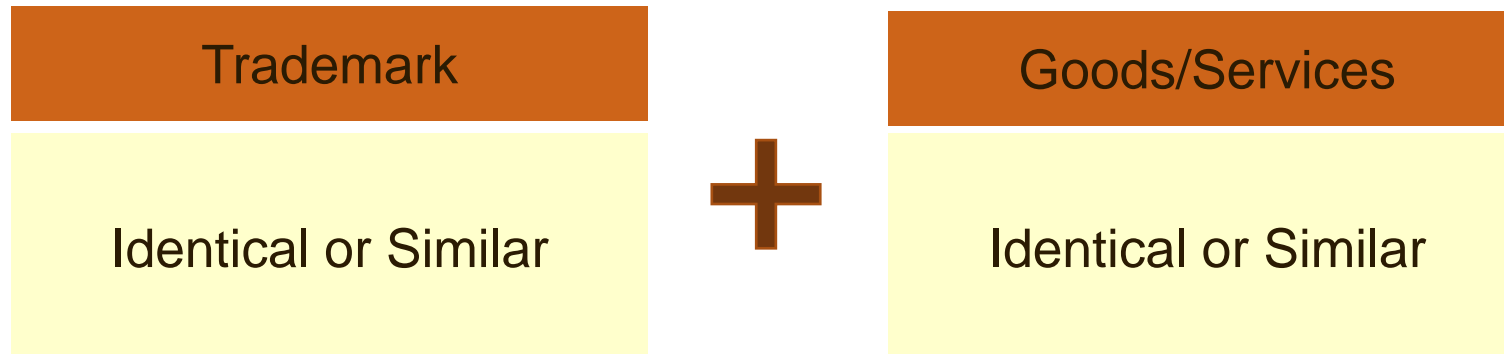
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1. Basic Information

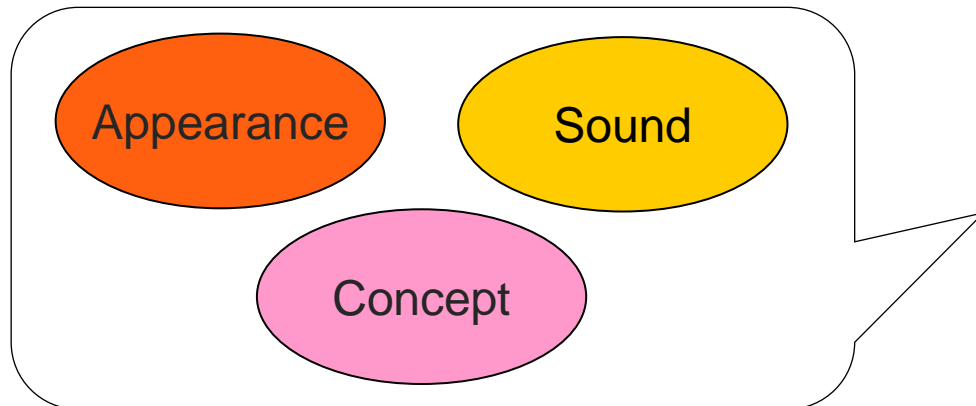
1. Basic Information

No trademark may be registered if it is 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.
(Art. 4(1)(xi) of the Trademark Act)



1. Basic Information

Similarity of Marks



Three elements of the marks are taken into consideration in a comprehensive manner.

[Detail for Similar Group Codes System >>>](#)



(Examination Guidelines)

Similarity of Goods/Services

Consideration in terms of:

production stage, stage of sales, materials and quality, intended purpose, a range of targeted consumers and relationship between finished-products and parts.

JPO examiners use **Similar Group Codes**.

1. Basics

Similar Group Codes System

Similar goods are grouped based on...

- manufacturing / sales division
- raw materials
- quality
- intended use
- scope of consumers
- relevance between the finished product and spare parts, etc.

Similar services are grouped based on....



- means of provision
- purpose of provision
- place of provision, etc.

Detail for Similar Group Codes System >>>





(JPO Website)

32D01

<u>Spinach</u>		Similar
<u>Tomato</u>		

42V02

<u>Medical services</u>		Similar
<u>Preparation of medications</u>		

2. Introduction of Consent System

2. Consent System

- JPO introduces the consent system from April 1st, 2024.
- Concurrent registration of trademarks is allowed under the following conditions.

- The prior registered trademark holder consents to the registration.

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- The concurrent registration will not cause confusion among consumers.

2. Consent System

Factors taken into consideration to consider likelihood of confusion

- i. The degree of similarity between the trademarks
- ii. The degree to which the trademarks are well known
- iii. Whether the trademarks consist of coined words or have distinctive features in their composition
- iv. Whether the trademarks are house marks
- v. Whether there are the possibilities of multiple management in the companies
- vi. Whether there is any relationship between goods, services or goods and services
- vii. Whether there is any commonality between the consumers of goods, etc.
- viii. The form of the trademarks in use, and the other actual state of transactions



3. Protection of Well-known Marks

3. Protection of Well-known Marks

Other persons' trademarks that are <i>well known in Japan</i>	Other persons' trademarks that are <i>well known only in foreign countries</i>	Other persons' trademarks that are <i>not well known</i> either in Japan or foreign countries
When designated goods/ services are similar to each other → Article 4 (1) (x)		
Even if designated goods/ services are not similar to each other, but when there is likelihood of confusion as to the sources → Article 4 (1) (xv)		
Even if there is no likelihood of confusion, when trademarks are used for unfair purposes → Article 4 (1) (xix)		
When claimed trademark are against public interest, public morality or international fidelity due to fraud in the filing process and the like → Article 4 (1) (vii)		
Lack of intention to use the trademark → Main Paragraph of Article 3(1)		
Any persons or legal entities can provide information to the JPO, indicating why registration of claimed trademarks should be refused.		

3. Protection of Well-known Marks

Applied trademark : A

Well-known others mark: B

Factors taken into consideration to decide likelihood of confusion

- Whether the mark “B” is well-known among relevant consumers.
- Whether the other person’s trademark “B” is a **creative mark** (ie. has strong distinctive character).
- Whether the other person’s trademark “B” is a **trade name**.
- Whether the holder of the mark “B” is expanding/is likely to expand business into **diversified fields**.
- Relationship between goods/services of “A” and “B”.

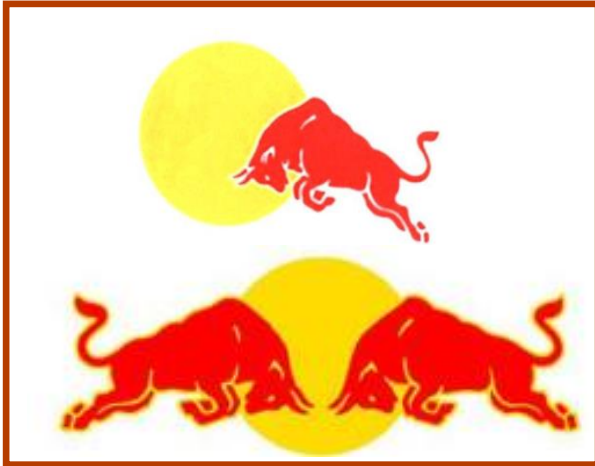
3. Protection of Well-known Marks

Criteria for determining whether the mark is well-known

- **Length** of use of the mark
- **Area** where the mark has been used
- The **volume of production, a scale of business**
(number of stores, areas of business, sales volume, etc.)
- Frequency and contents of **advertising**
- Frequency and contents of its appearance in newspapers, trade journals, magazines and the Internet
- The outcome of the questionnaire on consumers awareness of the trademark

3. Protection of Well-known Marks

Likelihood of confusion
even if the designated G/Ss are not similar



Plaintiff

- Uses on the surface of energy drink
- Large sales amount
- F1 race sponsor, uses racing related products from 1995



Defendant

- Registered the trademark in connection with automobile supplies in 2013

3. Protection of Well-known Marks

Likelihood of confusion
even if the designated G/Ss are not similar

Court ruling

- At the time of filing the defendant's application, the plaintiff's trademark was **widely recognized** among the suppliers and consumers in Japan.
- The designated goods "automobile supplies" of the defendant's trademark are related to the products which are well known for the plaintiff's trademark.
- Main consumers **may not notice small differences** between the trademarks.
- The defendant's trademark is **likely to cause confusion** in connection with the G/Ss pertaining to a business of another person.

3. Protection of Well-known Marks

When trademarks are used for unfair purposes



Company D (US right holder)

- Shoulder bags, sports bags
- Started using in 1983 (US)
- Being Well-known in US



Applicant X

- Bags, pouches and sacks
- Negotiation with D failed in 1988
- Filed the mark in Japan without permission of D

3. Protection of Well-known Marks

When trademarks are used for unfair purposes

Court ruling

- X understood that the trademark used by D had already been **widely known in the US** and that X was **not granted a license** to use this trademark.
- Nevertheless, X filed the disputed trademarks in Japan.
- Such filings by X **were intended for unfair purposes**.

Thank you!

Speaker

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