

* Same Word Origin Marks

[Similarity]

The Examiners often decide that trademarks which have the same word origin, such as “navigator” and “navigate”, are confusingly similar each other since differences between these words are only subtle, such as the difference of ending of a word or suffix, and so trademarks which have the same word origin are conceptually and aurally similar as a whole even if such trademarks include another word.

On appeal against decision of rejection, however, it was sometimes held that such trademarks were conceptually dissimilar each other if these trademarks are combined with another word and creates new phrases. In addition, it was often held that these trademarks were aurally dissimilar as well since the difference of ending of a word became vitally important for making the decision of its similarity.

Having reviewed the cases below in detail, it would commonly appear that the proprietor of the prior mark filed an invalidation trial against the later mark which is a derived word of the prior mark after the registration of the later mark. The proprietor of the prior mark worries that customers would be confused if the later mark came to the same marketplace as the prior mark and so the proprietor thinks that the later mark should not be registered. It would be better not to select such similar mark as a trademark in order to avoid unnecessary conflict.

Trademarks derived from

(1) Derived word trademarks

● Similar (=)

Mark	Similarity	Cited mark	Class	Case No.	Memo
NAVITIME	=	NAVITIMER	14	2004-90509	
ITCAST	=	Itcaster	35	2004-2448	
Gluco balancer	=	Gluco balance	29	2002-25145	
PENJECT	=	PENJECTOR	10	2001-13827	
Xylidenter	=	Xylidental	30	H11-17710	

● Dissimilar (X)

Mark	Similarity	Cited mark	Class	Case No.	Memo
Active walk	X	ACTIVE WAKER	25	2007-900486	
Skin block	X	Skin blocker	5	2007-3404	
Smileydent	X	Smiledent	3	2007-900543	Both marks are coined terms.
Whitey rose	X	White rose	3,5	2005-3008	
Prestigious	X	PRESTIGE	3	2004-90586	
VOLUMY	X	VOLUME	3	2004-9590	VOLUMY is a coined word.
Crystal shiner	X	CRYSTAL SHINE	21	2003-22730	
DVD Toaster	X	TOAST	9,42	2007-900124	“Toaster” and “TOAST” are conceptually different.
i-Reporter	X	I Report	42	2006-10896	
DIMINISHER	X	DIMINISH	3	2006-22427	
FlowService	X	FLOWSERVE	9	2006-90567	
Architecture	X	Architect	3	2004-90024	