

* Identity of Trademarks between Registered and in Use

Trademark owner is obliged to use registered mark itself, however it is held that the mark can be altered or modified to some extent as long as it can be regarded as identical mark to the registered trademark, especially if it is consist of featureless fonts such as standard characters.

Although we cannot arbitrary define how much alteration is acceptable, Article 50 of Japanese Trademark Law states that the use of 'the trademarks regarded to be generally accepted as identical with the registered trademark' will be regarded as the use of registered trademark, which means the alteration of the used mark is within the range of identity of registered mark due to the same sound or conception in the ordinary people's perception.

As a matter of fact, trademark owners do not always use the exact representation of the registered mark in the actual trade and they sometimes omit/separate the part of trademarks, change the fonts/characters/devices or combine it with other characters/devices, which often give rise to the issue of identity.

This question is frequently discussed in the examination process of the cancellation trial and so we collected up the cancellation trial decisions in which the identity of trademarks are discussed and sorted them into types of alterations.

For your information, Article 50 of Japanese Trademark Law illustrates the acceptable alteration of the registered mark as follows.

1. trademarks consisting of identical characters only with their fonts modified
2. trademarks with their indication mutually replaced in character of hiragana and katakana (Japanese phonetic characters) and Latin alphabet may imply an identical pronunciation and concept
3. trademarks consisting of figures common in appearance

(1) Registered Trademarks in two lines

If the trademark is consist of Roman letters in top line and Katakana scripts in bottom line and the sounds of two characters are spontaneously regarded as same, the use of one character will basically be accepted as the use of the registered mark.




●Identity(= : Identical, X : Different)

Registered mark	Identity	Mark in use	Class	Case No.	Memo
ココロ(kokoro in katakana) KOKORO	=	kokoro	10	2005-30386	
PASS パス(pass in katakana)	=	PAS	25	2002-30526	The decision was made on the ground that the consumers of the apparel industry cannot always distinguish PASS from PAS according to their English abilities.
2CV ドゥーシボ(Deux C V)	X	2CV	Old 17	S60-17169	The deletion of the coined word “ドゥーシボ(Deux C V)” influences the distinctiveness of the trademark and thus this modification was not accepted.

(2) The Deletion of Characters

It used to be that the use of mark, from which indistinctive parts were omitted, was occasionally regarded as the use of registered mark. However, in recent years it tend to be thought that the deletion of characters do influences the identity of registered mark even if it is indistinctive part and thus it is not regarded as the use of registered mark due to differences in sound and concept.


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Registered mark	Identity	Mark in use	Class	Case No.	Memo
THE MONTGOMERY DUFFLE LTD.	X	MONTGOMERY	Old 17	2003-30769	Defendant argued that 'THE' and 'LTD' are indistinctive parts. Also, 'DUFFLE', the generic name of coat' is generally omitted from the trademark in the apparel industry and so the deletion of these parts does not influence the identity of trademark. However, this argument was not accepted.
	X	SURIYA	3	2006-30202	The use of 'SURIYA' is not regarded as the use of the registered mark due to lack of distinctive design and distinctive word "μ".
スコッチ テリヤ  SCOTCH TERRIER	X	 (Terrier Sports)	9	2004-31292	The mark in use was not accepted due to the difference of the meaning/sound of 'scotch terrier' and all kinds of 'terrier dogs'.
THUNDERBIRDS	X	THUNDEERBIRD	Old 24	S55-15118	The difference of the ending sound 's'

(3) Partial Separation

Separately use of combined trademark is regarded as identical to the registered mark as long as total design is shown in a unified manner so that the pronunciation and the conception will be the same.

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Registered mark	Identity	Mark in use	Class	Case No.	Memo
PRESSO PRESSO	=	Presso Presso	30	2005-3011 4	
NETMARKS	=		42	2002-3007 7	Tokyo High Court (Case H15(行ケ) 123) maintained this decision.
プルーフテック PROOFTEC	=		9	2007-3010 82	
MISS WAIKIKI	=	MISS WAIKIKI	Old 17	S60-16713	
クイーンフローラ QUEENFLOWRA	=	QUEEN FLOWRA クイーンフローラ	Old 17	S58-17839	

(4) Different fonts

Modification of fonts is generally accepted unless it is dramatically designed according to Article 50 of Japanese Trademark Law.

The mark used for magazine which seems to be significantly different from the registered one was accepted by explaining the practice of publishing industry while the slight modification was not accepted for ICM case.


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Registered mark	Identity	Mark in use	Class	Case No.	Memo
FOOT WORK	=		3	2007-3006 30	Point of issue was the space between "FOOT" and "WORK" in registered mark.
電撃Hobymagazine	=		16	2002-3141 5	There seems to be significant difference between the registered mark and the mark in use. However, the registration was maintained since marks used for magazine titles are generally highly stylized in publishing industry.
	=		Old 4	H11-30688	"TBS" was regarded as the distinctive part of the marks in use since Katakana script "ショッピング" means "shopping" in English and so it is indistinctive. Consequently, the marks in use are accepted as showing the use of the registered mark.
	X	ICM	11	2005-3048 0	It is thought that double lined design was contributed to the distinctiveness of the trademark, so without the design, the mark was not regarded as identical to registered mark.

(5) Addition of Letters

It would appear that the distinctiveness of added letter dominates the judgement of identity.

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Registered mark	Identity	Mark in use	Class	Case No.	Memo
SKAGA	X	BLAZER SKAGA	Old 23	2008-300093	
HOT TOPIC	X	SOFTBANK HOT TOPIC	9	2007-301414	'SOFTBANK' is the well-known company name
CREATION	X	CREATION SET	30	2007-301386	
CAROL	X	CAROL SPORTS	Old 17	2005-30310	
DYMA	X	SUPER DYMA	6	2005-30405	
PATIS	X	Patisfrance	32	2006-30847	"France" was regarded as an indistinctive part which merely indicates production area and thus "Patisfrance" was accepted as the use of "PATIS".
'IMPULSE	=	IMPULSE M	16	2006-30078	
Express	=		Old 11	2007-300733	

(6) Deletion/Addition of Symbols

It would appear that the distinctiveness of symbol dominates the judgement of identity.

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Registered mark	Identity	Mark in use	Class	Case No.	Memo
OK Reattack	=	OK—Reattack	16	2003-31450	The addition of hyphen.
OUI	=	Oui !	17	2004-31592	Difference of exclamation mark '!'. !
BLD	=	B . L . D	Old 10	S56-23880	The addition of period.
FSG—LINE	=	FSGLINE	Old 10	S60-2434	The deletion of hyphen.