



## Question Q214

**National Group:** JAPANESE NATIONAL GROUP

**Title:** Protection against the dilution of a trade mark

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### Questions

#### I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

1. Do the laws of your country provide for protection against dilution of a trademark? If so, which laws?

(Response)

Protection is provided.

Unlike in the EU and USA, provisions which exclude the use of anyone else's marks are provided for in Article 2.1.2 of the Unfair Competition Prevention Act rather than in the Trademark Act.

Excluding the application and registration of trademarks which provoke the dilution of trademarks is provided for in Article 4.1.19 of the Trademark Act.

Provisions which protect against the dilutions of a trademark, requiring confusion, are provided for in Article 2.1.1 of the Unfair Competition Prevention Act and Article 4.1.15 of the Trademark Act and Article 64 of the Trademark Act (Defensive Mark) but are not covered in this report.

2. Is there a legal definition of dilution in your legislation or case law?

(Response)

There is no legal definition of dilution.

The following theories have been put forward.

*“As a result of others using famous trademarks in a wide variety of goods which are neither identical nor similar to such goods or which are not in danger of causing misunderstandings, in addition to diluting the index power of famous trademarks, there is general dilution of phenomenon which results in weakening.”*

*“Dilution of specific discrimination power refers to dampening down such specific discrimination power by unauthorized use of famous indications, in other words, famous indications are just another indication.”*

**3.1. Which trademarks are afforded protection against dilution? What are the eligibility criteria? (Please only briefly list the eligibility criteria here; more detailed explanations will be required below).**

(Response)

The protection eligibility criteria against dilution in the event of receiving civil relief under the Unfair Competition Prevention Act are as set forth below. (Article 2.1.2, Article 3, Article 4 Unfair Competition Prevention Act.)

- (1) Using the famous marks of others (goods or other indications) and marks which are the same or similar (goods or other indications)
- (2) As one’s own marks (goods or other indications)
- (3) Or assigning goods which use such marks (goods or other indications), delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through an electric telecommunications line
- (4) Leads to the infringement or likelihood of infringement of business interests

With regard to the notion of (1) above, there are theories which require nationwide recognition (multiple theories) and theories in which recognition locally (specific region) alone is sufficient.

The protection eligibility criteria for excluding the application and registration of trademarks which provoke the dilution of trademarks (Article 4.1.19 of the Trademark Act) are explained in 9. (1).

**3.2. To be eligible for protection against dilution, does a mark need to be distinctive? If so, does the protection depend upon the mark being inherently distinctive or are marks that have acquired distinctiveness through use also protected?**

(Response)

To be eligible for protection against dilution, a mark needs to be distinctive. This is because unauthorized use of famous trademarks would be considered as an unfair competitive activity when specific distinctiveness, a result of competition, is damaged.

With regard to whether a mark should be inherently distinctive, marks which have acquired distinctiveness through use are also protected. The protection requirements provided for in Article 2.1.2 of the Unfair Competition Prevention Act are thought to be satisfied if distinctiveness is acquired through use and indications are exceptionally prominent.

**3.3.1 To be eligible for protection against dilution, does a mark need to have a reputation or be well-known or famous? If so, when does a mark have a reputation, when is it well-known or when is it famous? Are the factors mentioned in paragraph 15 and 22 above relevant for determining whether a mark has a reputation, is well known or famous? For what point in time does this have to be assessed?**

(Response)

To be eligible for protection against dilution, marks need to be famous (Article 2.1.2 of the Unfair Competition Prevention Act). In order to impose criminal penalties on a person violating the Unfair Competition Prevention Act, marks need to be famous as well as such person must have the aim of gaining unjust enrichment using the reputation of such famous marks or the aim of damaging the reputation of such famous mark (Article 21.2.2 of the Unfair Competition Prevention Act).

It is generally considered that the fact that marks are famous means that marks are widely known as its owner's own indications, exceeding one's own original consumers from one's own sales and original sales region as a result of marketing efforts, and that such marks had established a certain level of goodwill, reputation and popularity.

It is generally considered that famous mark has a certain level of goodwill, reputation and popularity. For this reason, in addition to whether a mark is famous, whether a mark has established a reputation will rarely become a separate issue.

Factors stated in paragraphs 15 and 22 are relevant for determining whether a mark is famous or well-known.

This assessment is made at the conclusion of the oral proceedings for fact-finding proceedings with regard to claims requesting injunction and when damages are incurred with regard to damage compensation claims.

**3.3.2 For a mark to have a reputation or to be considered well known or famous, must it meet a certain knowledge or recognition threshold? If so, what is that threshold? What percentage of population awareness is required? How widespread must the awareness be across the country? If a mark is well known or famous in one country, what effect, if any, does this have with regard to other countries?**

(Response)

Legislators believe that, in order for a mark to be considered as famous and become eligible for protection against dilutions, such fame of the mark must be widespread across the country. Under such theories there is also the notion that it is sufficient to be significantly widely known if not strictly known throughout the country. In actual cases in which a mark was found famous, such fame of mark is often recognized nationwide.

There is no clear threshold for the percentage of recognition. With regard to this point, there is a case in which the recognition percentage according to questionnaires targeting general consumers was 16.6%, and the mark was found well known but not famous.

Whether a mark is well known or famous in one country has no effect with regard to other countries. Fame within Japan is required as long as protection in Japan is sought .

**3.3.3 What is the relevant population in determining the knowledge, recognition or fame of the mark, the general public at large or the relevant sector of public? Is recognition or fame in a limited product market (“niche market”) sufficient?**

(Response)

Fame of the mark needs to be recognized by the general public at large and not just by the relevant sector of the public.

Consequently, recognition or fame in a limited product market (niche market) is not sufficient.

**3.4. To be eligible for protection against dilution, is it required that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country where protection is being sought?**

(Response)

Such mark must be famous in Japan but use within Japan is not an essential requirement. Further, that the mark has been registered as a trademark or that an application has been made for registration as a trademark are not conditions.

**3.5. Are there any other criteria a mark must comply with to be eligible for protection against dilution?**

(Response)

In addition to a mark (goods or other indications) being famous the following requirements are necessary (Article 2.1.2, Article 3, Article 4) of the Unfair Competition Prevention Act).

- (1) Using famous marks of others (goods or other indications) and marks which are the same or similar (goods or other indications)
- (2) As one’s own marks (goods or other indications)
- (3) Or assigning goods which use such marks (goods or other indications), delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through an electric telecommunications line
- (4) Leads to the infringement or likelihood of infringement of business interests

**3.6. Is eligibility for protection against dilution a matter of law or an issue of fact? Who bears the burden of proof regarding the eligibility criteria? How does one prove that a mark meets the eligibility criteria? Are sales and advertising figures sufficient or is survey evidence required? Which evidential standard must this proof satisfy?**

(Response)

The matter of protection eligibility against dilution is a matter which has been legally determined based on finding of facts by a judge and is a mixture of a matter of law and an issue of fact.

The burden of proof is born by the plaintiff (the person who asserts an act of unfair competition, in other words the person who owns the famous mark).

Proof is essentially demonstrated by the submission of a variety of documentary evidence. Specifically, documents showing sales, units sold, sales period, sales region, advertising method, frequency, period, advertising expenses, etc. are often produced as evidence.

Survey evidence is not required but submission of survey evidence is allowed.

Survey evidence will be used as ordinary evidence, regardless of its content, but the judges will decide on the credibility thereof at their discretion.

**3.7. Is there any registry of eligible marks in your country? If so, what is the evidentiary value of registration? Can it be challenged in litigation?**

(Response)

There is no special registry which records marks with protection eligibility. With regard to marks which are well known amongst consumers, the Industrial Property Digital Library's "Japanese well known trademarks search" and the list of Japanese well known trademarks published by the Japanese Association Internationale pour la Protection de la Propriété Intellectuelle (AIPPI JAPAN), and defensive mark registrations are used as evidence to demonstrate fame. The Industrial Property Digital Library's "Japanese well known trademarks search" is a free searchable database which enables the users to search Japanese well-known marks, and the database is based on information from trademark registrations registered as defensive marks, decisions on opposition, appeal/trial decisions and court decisions. However, even if defensive marks have been registered, such fact is no more than a decision on an individual case by the Patent Office, and it does not bind a court.

**4. Does your law require the existence of a 'mental association' or 'link' between the earlier trademark and the later trademark? If so, in which circumstances does a 'mental association' or 'link' between the earlier trademark and the later trademark exist? Are the factors mentioned in paragraph 27 and 28 above relevant for assessing the existence of such a 'mental association' or 'link'? Are there other factors to take into account? Is the assessment of a link a question of fact (so something that can be established by market surveys), or is it a question of law to be established by the courts or authorities on the basis of such factors?**

(Response)

It is appropriate to understand that the judgment criteria of "similarities" in Article 2.1.2 of the Unfair Competition Prevention Act, considering to the purpose of the Article, shall be to study whether the indication is so similar that elicits a certain degree of dilution, destroying the one on one correspondent relationship between famous indications and the famous business entity which owns such indications, ; in other words, whether such indications is so similar that it easily evokes a famous

indication. (Suntory Kuro Oolong Tea Case, Tokyo District Court, December 26, 2008/ 2007 (wa) 11899).

Factors mentioned in paragraph 27 and 28 above seem to be adequate to determine the existence of such “mental association” or “link”. In court decisions, factors listed here (whether there is a risk of erroneous belief that some connection exists (general confusion), extent of fame and distinctiveness, field in which used, etc.) are deemed to be decision factors.

Any recollection (**the existence of a ‘mental association’**) is judged based on the indication as a whole which uses the mark: Kuro Oolong Tea Case “in light of acknowledging major differences in appearance and sound, even if consumer and traders recognize the defendant’s product indication B, (hypothetically) it cannot be said that the famous plaintiff product indication itself will be easily evoked.”

Degree of fame: the Kuro Oolong Tea Case judgment noted that “with the exception of when there are special circumstances, it should be understood that a certain amount of time must pass in order to reach the degree of fame”, and the fame of the plaintiff’s product indication after approximately 2.5 months from going on sale was denied. However, it is thought that fame may be acknowledged even in a short space of time due to other factors such as intensive large volume advertising (J-PHONE case, Tokyo Supreme Court October 25, 2001 1/ 2001 (ne) 2931).

Judgment on links is a matter which has been legally judged based on fact-finding by a judge and is a mixture of a matter of law and an issue of fact.

**5. Does such ‘mental association’ or ‘link’ between the earlier trademark and the later trademark automatically result in detriment to the earlier trademark’s repute or distinctive character? Or does detriment have to be proved over and above the existence of a ‘mental association’ or ‘link’?**

(Response)

“Risk of confusion”, and “fall in trademark reputation and distinctiveness” are not requirements in order to be protected as provided for in Article 2.1.2 of Japan’s Unfair Competition Prevention Act. Protection will be granted if “similarity” and “fame” requirements are satisfied.

Generally, if “famous”, trademarks are thought to have established a certain reputation.

“Mental association” and “link” take judgment factors on “similarity” to famous indications into consideration.

In “similarity” judgments, with regard to weak marks, in addition to the perspective of whether a mark is so similar that it easily evokes a famous indication, “monopoly adaptability” shall be taken into consideration; in other words, a protection shall be limited from the perspective of whether the common parts remain in indistinctive areas as provided for in Article 26.1.2 and 26.1.3 of the Trademark Act. Further, it is sufficient for consumers to be able to easily evoke famous indications and it is not necessary to go as far as similarities in the goods which can be mistaken.

**6. Are the same factors taken into consideration to assess the existence of detriment as those already discussed for the link? Are there additional ones?**

(Response)

Not applicable.

As responded in 5, “the existence of detriment in trademark reputation and distinctiveness” is not a requirement.

7. **Must actual dilution be proved or is a showing of likelihood of dilution sufficient? Whose burden of proof is it? How does one prove dilution or likelihood of dilution? Does detriment require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely? If so, what is a change in the economic behaviour of the average consumer? Is reduced willingness to buy goods sold under the earlier mark a change in the economic behaviour? How do you prove a change in the economic behaviour of the average consumer or likelihood of such change in behaviour?**

(Response)

Since “actual dilution” and “likelihood of dilution” are not requirements for unfair competition prescribed in Article 2.1.2 of the Unfair Competition Prevention Act, it is not necessary to prove these in order to have protection eligibility against dilution. Consequently, proof of a “change in the economic behaviour of the average consumer, or likelihood of such change in behaviour” is not necessary.

8. **What is the extent of protection afforded to marks which are eligible for dilution protection? May the owner of the earlier trademark object**
- **to the registration of a later trademark?**
  - **to the actual use of a later trademark?**
  - **in respect of dissimilar goods only or also in respect of similar goods?**

(Response)

Protection afforded to marks which are eligible for dilution protection is exclusion of the use and/or registration of marks by others. (Article 2.1.2 of the Unfair Competition Prevention Act, Article 4.1.19 of the Trademark Act)

In the event that later trademarks are registered which may dilute earlier trademarks, the owner of such earlier trademarks may oppose such registration by filing an opposition to registration or an invalidation trial. (Article 43.2 and Article 46 of the Trademark Act)

The owner of a mark eligible for dilution protection may exclude actual use of later trademarks. (Article 2.1.2 of the Unfair Competition Prevention Act)

The owner of earlier trademark may exclude registration of later trademarks in respect of both dissimilar goods and similar goods.. (Article 4.1.19 of the Trademark Act)

Further, use of later trademarks can be excluded whether they are used for similar goods or for dissimilar goods. (Article 2.1.2 of the Unfair Competition Prevention Act)

**9. What are the legal remedies? May the owner of the earlier trademark file an opposition and/or a cancellation action? May he ask for injunctive relief or preliminary injunctive relief? Does your trademark office refuse the registration of a later trademark on grounds of likelihood of dilution?**

(Response)

(1) Japan's Trademark Act does not include clauses which directly stipulate that the dilution of a trademark is a reason to file an opposition, etc. However, the following clause is included of which the legislative intent is to prevent dilution of the source indicating function of well known and famous trademarks. When a trademark registration infringes the provisions of such clause, it shall be possible to file an opposition with regard to such a trademark registration (Article 43-2.1 of the Trademark Act) and to request a trial for invalidation of the trademark registration (Article 46.1.1 of the Trademark Act).

“no trademark shall be registered if the trademark is identical or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such a trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes)” (Article 4.1.19 of the Trademark Act).

This clause was added in 1996 in order to clarify that trademark applications made for illicit purposes which violate the doctrine of good faith regarding well known trademarks in Japan or overseas should not be accepted. The background to the addition of this clause is as follows. Famous trademarks, which acquired a good reputation, trust and reputation for goods and services following persistent extensive advertising campaigns and business efforts, and became known throughout the country not just amongst original traders and consumers and sales regions, had goodwill even if such trademarks are used for goods and services no longer related to the goods and services which the trademarks were originally used for. Said goodwill itself is an important intangible property. In recent years, third parties have taken free rides on such famous trademarks. Thus requests for protection from dilution have increased.

According to Japan's Trademark Act, it is not possible to submit litigation for cancelling a trademark registration to the courts since a trademark registration cancellation and invalidation can only be undertaken through Patent Office procedures.

(2) It is possible to request remedies through injunctive relief and provisional disposition.

A person whose business interests are infringed or likely to be infringed through conduct which falls under Article 2.1.2 of the Unfair Competition Prevention Act (unfair competition) may seek an injunction suspending or preventing such infringement against the party which infringed or is likely to infringe such business



interests (Article 3.1 of the Unfair Competition Prevention Act). Furthermore, when making requests in accordance with the provisions of paragraph 1 of the above article, it shall be possible to seek an injunction for the destruction of articles that constituted the act of infringement (including articles created by the act of infringement), removal of equipment used for the act of infringement, or other acts required for suspension or prevention of the infringement (Article 3.2). However, it shall not be possible to seek an injunction with regard to the act of a person who has used an indication of goods or other indications that is identical or similar to another person's indication of goods or other indications before said person's indication became famous or the act of a person who has succeeded to a business pertaining to such indication of goods or other indications, such use of the indication of goods or other indications being done without a wrongful purpose, etc. (so called prior use before acquiring fame) (Article 19.1.4 of the Unfair Competition Prevention Act).

Further, it shall be possible to file an order for civil provisional remedies (provisional disposition) in the event that irremediable damages will be suffered by waiting for a final ruling on the seeking of an injunction (Article 1 of the Civil Provisional Remedies Act).

(3) There are other remedies such as the following.

(A) Ability to claim compensation for damages (Article 4 of the Unfair Competition Prevention Act).

A claim for compensation for damages resulting therefrom may be made against a person who intentionally or negligently infringes on the business interests of another person by unfair competition. However, claims may not be made against prior use before acquiring fame (Article 19.1.4 of the Unfair Competition Prevention Act).

(B) The court may order a person who has intentionally or negligently committed an act of unfair competition and thereby injured the business reputation of another person to take, upon the request of the person whose business reputation has been so injured, necessary measures for restoring the business reputation of that person in lieu of or in addition to compensation for damages. (Article 14 of the Unfair Competition Prevention Act). However, said order may not be made against prior use before acquiring fame (Article 19.1.4 of the Unfair Competition Prevention Act).

(C) Ability to claim return of unjust enrichment (Articles 703 and 704 of the Civil Code).

A claim to return such benefit as unjust enrichment may be made against a person who has benefited from unfair competition and has thereby caused loss to others. Claims for return of unjust enrichment may be accepted even when there was no intent or negligence on the part of the other party or when it is not possible to prove such intent or negligence.

(D) Claims for registration procedures to erase or alter a corporate name in accordance with the Unfair Competition Prevention Act in litigation may be accepted in the event that a mark is used as a corporate name.

(E) Subject to criminal penalties (Article 21.2.2 of the Unfair Competition Prevention Act).

A person who, for the purpose of acquiring an illicit gain through the use of trust or reputation pertaining to another person's famous indication of goods or other indications or for the purpose of injuring said trust or reputation, commits any act of unfair competition provided for in Article 2.1.2 of the Unfair Competition Prevention Act shall be punished by imprisonment with work for not more than five years or a fine of not more than five million yen, or both. Such punishment may be subject to the commencement of criminal proceedings even if charges are not made (Article 21.3 of the Unfair Competition Prevention Act). Further, not only the offender but also a juridical person that said offender belongs to shall be punished by a fine (of not more than three hundred million yen), a so called dual liability (Article 22 of the Unfair Competition Prevention Act). However, this shall not apply to prior use before acquiring fame (Article 19.1.4 of the Unfair Competition Prevention Act).

(F) Regulations of customs (Customs Act).

Acts falling under Article 2.1.2 of the Unfair Competition Prevention Act (excluding prior use before acquiring fame) shall be designated "goods not to be exported" or "goods not to be imported". "Goods not to be exported" may be impounded and destroyed by the customs chief (Articles 69-2.1.4 and 69-2.2 of the Customs Act) and "goods not to be imported" may be impounded and destroyed by the customs chief or ordered to be reshipped (Article 69-11.1.10 and Article 69-11.2 of the Customs Act).

(4) Japan's Trademark Act does not include clauses which directly stipulate the refusal of the registration of later trademarks on grounds of likelihood of dilution. However, given that Article 4.1.19 of the Trademark Act mentioned above is provided as a reason to refuse registration (Article 15.1 of the Trademark Act), the Patent Office refuses to register trademarks fall under such provision. However, trademarks not falling under such clause at the time of filing a trademark application shall not be refused registration on the grounds of such clause. (Article 4.3 of the Trademark Act).

## **II. Proposals for adoption of uniform rules**

**The Groups are invited to put forward proposals for adoption of uniform rules with a view to protecting trademarks against dilution. More specifically, the Groups are invited to answer the following questions:**

- 1. Which trademarks should be eligible for protection against dilution? What should the eligibility criteria be? Should recognition or fame in a limited product market ("niche market") be sufficient?**

(Response)

The following should be protection requirements.

(1) Fame

- Fame in a certain area,
- Recognition by the general public at large and not just by the relevant sector of the public in order to afford protection for non-similar goods and services . (It shall be known outside of intrinsic consumers and sales area, and has established trust, fame

and reputation above a certain level. Recognition or fame in a limited product market (niche market) is not sufficient.)

- Being well known or famous in another country is irrelevant, but it should be famous in the country concerned.

(2) Distinctiveness

- Trademarks shall have distinctiveness (including both inherent distinctiveness and distinctiveness through use).

(3) Identical or similar trademarks

- Trademarks shall be identical or similar. (As a requirement for being similar, confusion is not a requirement, and trademarks should be judged as being similar if the later trademark easily evokes the earlier famous trademark.)

Continuous use for a certain period should not be an unequivocal requirement. Given that nowadays information communication networks such as the internet, nationwide fame can be achieved in a short period of time through extensive investment, and in such cases, it is not appropriate to judge that there is no protection eligibility based only on the issue of limited period of use.

Article 2.1.2 of Japan's Unfair Competition Prevention Act, differs from the US, "the likelihood of dilution including blurring and tarnishment" is not stipulated as a protection requirement. Further, unlike in the EU, "takes unfair advantage of the distinctive character or repute" and "is detrimental to the distinctive character or repute" are not protection requirements.

Instead, "use of other's marks as one's own marks" is a protection requirement.

In the event that someone else is using marks as their own, such use can easily be excluded in accordance with Article 2.1.2 of Japan's Unfair Competition Prevention Act. However, if the other party is not using marks as their own marks (e.g.: comparative advertisements), there is the disadvantage that excluding use shall not be possible even if there is a risk of dilution.

When studying dilution protection requirement, the advantages and disadvantages arising from the basic structure provided for in Article 2.1.2 of Japan's Unfair Competition Prevention Act will serve as a useful reference.

**2. Should it be a criteria for being eligible for dilution protection that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country?**

(Response)

Filing, use and registration in the country concerned should not be a requirement for protection eligibility.

**3. Should there be a registry of eligible marks? If so, what should the evidentiary value of registration be? Should it be possible to challenge it in litigation?**

(Response)

Publishing lists of trademarks which have been approved as well known or famous through opposition or other legal proceedings in each country or region is effective from the perspective of strengthening protection of famous trademarks from dilution. However, a unified register across the world involves many issues from the perspective of protection eligibility requirement, list maintenance, etc. and is not practical.

Fame does not last forever and since it fluctuates according to the situation of use of the mark, the evidentiary value of registration in a register should be judged on a case by case basis and whilst it serves as a reference, it cannot form the basis of unequivocal fame judgments.

The protection eligibility of trademarks recorded in a register should be contestable at the every stage, including litigation.

**4. Should the existence of a ‘mental association’ or ‘link’ between the earlier trademark and the later trademark be an independent requirement for a trademark dilution claim?**

(Response)

It should be sufficient to interpret within trademark similarity requirements without having “mental association” or “link” as independent requirements. When determining similarity, if the later trademark easily evokes the earlier famous trademark, it should be judged as similar even if there is no likelihood of confusion as to the source.

**5. Should detriment to the distinctive character or reputation of the earlier mark require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely?**

(Response)

Evidence should not be required. Requiring such evidence makes it unnecessarily difficult to obtain protection from dilution.

**6. What should the remedies be for dilution of a mark?**

(Response)

Exclusion of later trademark registrations - Any trademark applications which incite the dilution of famous trademarks should be rejected, and such registrations should be prevented through oppositions or cancellation actions.

Exclusion of later trademark use – injunction, demands for compensation for damages, demands for the restitution of unjust enrichment, measures to restore business reputation (such as a published apology), cancellations of trade name registration and demands for change of trade name , customs seizures and confiscations, and malicious cases should be subject to criminal penalties.

Also, registrations and/or use of later trademark which incite the dilution of famous trademarks shall be excluded not only for non-similar goods/services but also for similar goods/services.

**National Groups are invited to comment on any additional issue concerning the protection of a mark against dilution.**

**Note:** It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.

December 2009

## Question Q214 Summary

Unlike in the EU and USA, provision is made in Japan for exclusion of the use of a mark, where such use would dilute distinctiveness of a prior registered and famous mark, under the Unfair Competition Prevention Act (UCPA) rather than under the Trademark Act.

On the other hand, provision is made in Japan for exclusion of application for and registration of a mark, where such application and registration would dilute distinctiveness of a prior registered and famous mark under the Trademark Act.

Amendment of the UCPA regarding dilution came into effect in Japan in 1993; that is, before introduction of corresponding regulation in the EU and the USA. Amendment of the Trademark Act regarding dilution came into effect in Japan in 1997. However, in the UCPA and Trademark Act in Japan the term “dilution” is not employed. Criteria for eligibility for civil relief for protection against dilution under the UCPA in Japan are simply as follows:

- (1) Using the famous marks of others (goods or other indications) and marks which are the same or similar (goods or other indications)
- (2) As one's own marks (goods or other indications)
- (3) Or assigning goods which use such marks (goods or other indications), delivering, displaying for the purpose of assignment or delivery, exporting, importing, or providing through an electric telecommunications line
- (4) Leads to the infringement or likelihood of infringement of business interests

The above condition differs from the US, “the likelihood of dilution including blurring and tarnishment” is not stipulated as a protection requirement. Further, unlike in the EU, “takes unfair advantage of the distinctive character or repute” and “is detrimental to the distinctive character or repute” are not protection requirements.

Instead, “use of other's marks as one's own marks” is a protection requirement. In the event that someone else is using marks as their own marks, such use can easily be excluded in accordance with UCPA. However, if the other party is not using marks as their own marks (e.g.: comparative advertisements), there is the disadvantage that excluding use shall not be possible even if there is a risk of dilution.

When studying dilution protection requirement, the advantages and disadvantages arising from the basic structure provided for Japan's UCPA would serve as a useful reference.

End of summary

## Résumé du point Q214

Contrairement à l'UE et aux Etats-Unis, les dispositions prévues par le Japon pour exclure l'utilisation d'une marque dans le cas où celle-ci aurait pour effet de diluer une autre marque célèbre déjà enregistrée, sont inscrites dans la loi sur la prévention de la concurrence déloyale (UCPA ou *Unfair Competition Prevention Act*) et non pas dans la loi des marques de commerce.

D'autre part, dans le cadre de la loi des marques de commerce, le Japon a prévu des dispositions qui excluent la demande de dépôt et l'enregistrement d'une marque susceptible de « diluer » l'identité d'une autre marque célèbre déjà enregistrée.

Une révision de l'UCPA concernant la dilution des marques est intervenue en 1993, c'est-à-dire avant l'entrée en vigueur d'une réglementation similaire dans l'UE et aux Etats-Unis. C'est en 1997 que la loi des marques de commerce japonaise fut révisée sur le point de la dilution des marques. Cependant, l'UCPA comme la loi des marques de commerce n'utilisent pas le terme de « dilution ». Pour protéger contre une dilution dans le cadre de l'UCPA, les critères qui rendent le recours civil admissible sont simplement les suivants :

- (1) Utilisation d'une marque (produit ou autre mention) célèbre ou d'une marque (ou produit ou autres mention) identique ou similaire.
- (2) Utilisation de la marque (produit ou autre mention) comme sa propre marque de commerce (ou produit ou autre mention).
- (3) Mise à disposition, livraison, ou étalage de produits dans le but de fournir, livrer, exporter, importer ou soumettre le produit par le biais de ligne de télécommunication électrique utilisant la marque (ou produit ou autre mention) en question,
- (4) Utilisation aboutissant à un préjudice ou probabilité de préjudice aux intérêts de l'activité d'autrui.

Cette condition diffère du texte américain qui stipule dans les conditions conservatoires « l'éventualité d'une dilution, y compris les effets d'ambiguïté et de souillage de réputation » (*the likelihood of dilution including blurring and tarnishment*). De plus, contrairement à l'UE, dans les critères de protection, on ne trouve pas de mention du type « retire un avantage inéquitable du caractère distinctif ou de la réputation.... » ni celle du type « nuit au caractère distinctif ou à la réputation.... ».

À la place, on trouve « Utilisation de la marque comme sa propre marque de commerce » dans la liste des critères de protection. Au cas où un tiers utiliserait une marque comme

étant la sienne, cet usage peut être éliminé aisément conformément à l'UCPA. Cependant, si l'autre partie n'utilise pas la marque comme la sienne (par exemple dans le cas de publicités comparatives), l'exclusion ne peut pas intervenir même s'il y a risque de dilution.

Les avantages et les inconvénients inhérents à la structure de base de l'UCPA japonais peuvent constituer une base de réflexion utile dans le cadre des travaux sur les critères de protection contre la dilution des marques.

Fin du résumé



## Frage Q214 Überblick

Anders als in der EU und in den USA finden sich in Japan Regelungen, die die Verwendung einer Marke ausschließen, falls ihre Verwendung die Unterscheidungskraft einer bereits eingetragenen und bekannten Marke verwässern würde, im Gesetz gegen den unlauteren Wettbewerb (Unfair Competition Prevention Act, UCPA) und nicht im Markengesetz.

Auf der anderen Seite schreibt das Markengesetz den Ausschluss einer Marke von der Anmeldung und Eintragung vor, wenn eine solche Anmeldung bzw. Eintragung die Unterscheidungskraft einer bereits eingetragenen und bekannten Marke verwässern würden.

Eine Änderung des UCPA hinsichtlich der Verwässerung trat in Japan im Jahr 1993 in Kraft, also vor der Einführung der entsprechenden Regelung in der EU und in den USA. Eine Änderung des Markengesetzes zur Verwässerung trat in Japan im Jahr 1997 in Kraft. Allerdings verwenden weder UCPA noch das Markengesetz in Japan den Begriff „Verwässerung“. Stattdessen liegen gemäß dem japanischen UCPA die folgenden einfachen Qualifikationskriterien für Rechtsmittel bei Schutz vor Verwässerung vor:

- (1) Die Verwendung bekannter Marken (Waren oder andere Bezeichnungen) anderer und Marken (Waren oder andere Bezeichnungen), die gleich oder ähnlich sind,
- (2) als eigene Marke (Ware oder andere Bezeichnung)
- (3) oder die Abtretung, Übergabe, Ausstellung zum Zweck der Abtretung oder Übergabe, Ausfuhr, Einfuhr oder Bereitstellung über eine elektrische Telekommunikationsleitung von Waren, die diese Marken (Waren oder andere Bezeichnungen) verwenden
- (4) Die Verletzung von Geschäftsinteressen ist gegeben oder wahrscheinlich

Die oben aufgeführten Bedingungen unterscheiden sich dadurch von denen der USA, dass die „Wahrscheinlichkeit der Verwässerung einschließlich des Verwischens oder Verunglimpfens“ nicht als Schutzvoraussetzung festgesetzt ist. Anders als in der EU sind zudem das „Ausnutzen der Unterscheidungskraft oder des guten Rufs“ und die „Schädigung der Unterscheidungskraft oder des guten Rufs“ der Marke keine Schutzvoraussetzungen.

Stattdessen bildet die „Verwendung der Marken anderer als eigene Marke“ die Schutzvoraussetzung. Für den Fall, dass jemand andere Marken als eigene Marken verwendet, kann diese Verwendung nach dem UCPA leicht unterbunden werden. Nutzt

die andere Partei die Marken allerdings nicht als eigene Marken (sondern beispielsweise in vergleichender Werbung), besteht hier der Nachteil, dass es auch dann nicht möglich ist, die Verwendung auszuschließen, wenn eine Verwässerungsgefahr besteht.

Die diversen Vorteile und Nachteile, die sich aus der Grundstruktur der Regelungen des japanischen UCPA ergeben, können eine Reihe wertvoller Denkanstöße bei der Untersuchung der Voraussetzungen für einen Schutz gegen Verwässerung bilden.

Ende des Überblicks