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The so-called trademark is a mark used in production and business operations to identify the source of goods or services. Trademark represents the quality of goods or services and the credibility of their producers and proprietors. Consumers purchase goods by identifying the trademark. Based on the function of trademark, the author introduces the relevant legal provisions, judgment standards and methods when judging similar trademarks from the perspective of comparison between China and Japan.

Comparison of Trademark Similarity Criteria between China and Japan

Preface

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I. Legal provisions regulating trademarks which are similar to others' prior ones could not be registered

Article 30 of P.R.C. Trademark Law stipulates that "any trademark that does not meet the relevant provisions of this law or is identical or similar to other's registed or preliminarily approved trademark on same or similar goods shall be rejected by the Trademark Office". Article 31 rules that "if two or more applicants applying for same or similar trademarks on same or similar goods, the one with earlier application date should be preliminary approved; If the applications are submitted on the same day, the earlier one put in use should be preliminary approved". Corresponding to this, Article 8 of the Japanese Trademark Law rules that (1) For applications filed on different dates, if there are two or more same or similar trademarks on same or similar goods or services applying for registration, only the first applicantion can obtain registration; (2) if the applications filed on same day, the applicants should negotiate and decide which one could be registered. In addition, Article 4 of the Japanese Trademark Law enumerates 19 conditions where registration cannot be obtained, among which 5 conditions involving same or similar trademarks. They are Articles 4.10[i], 4.12[ii], 4.15[iii], and 4.19[iv].

In summary, both China and Japan's trademark laws indicate that " same or similar trademarks with others' previous trademarks should not be registered on same or similar goods." But what are the differences between the two countries in the specific judgment?

II. Judgment criteria of assessment similar trademarks

In December 2016, the former State Administration for Industry and Commerce updated the "Standard of Trademark Examination and Trial", the third part of this "Standard" stipulates that "trademark similarity refers to the similarity in shape, pronunciation and meaning of trademark, [for marks containing device] the composition, coloring and appearance, or the overall arrangement and combination of text and graphics, the whole visual effects... use on same or similar goods or services can easily confuse the relevant public with the source of the goods or services. According to the "Standard", the assessment elements can be summarized into three aspects. The first is the similarity of the constituent elements of the trademark and its entirety. The second is degree of relevance of the goods or services, and the third is whether it is easy to cause confusion. Among them, the degree of similarity of the trademark is basis, the degree of relevance of the product is element, and the ultimate criterion is whether the coexistence of the trademarks is likely to cause confusion. However, in practice, the above standards are more commonly used in judicial cases, while in the administrative examination stage, the examiner has no way to confirm whether or not it is likely to cause confusion.

Japan's trademark law does not provide with clear criteria on judging similar trademarks. In practice, the criteria confirmed by Janpanese Supreme Court in [Iceberg Seal] case in 1968 is still used till now as the standard. "To determine whether the trademarks are similar, it should

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consider whether using these marks on same or similar goods will cause confusion and misidentification of the origin of the goods. In addition, when a trademark is used on a designated product, the appearance, meaning, and pronunciation of the trademark should be comprehensively taken into account to the relevant consumers' impressions, memories, and associations. If they can clearly understand the market habits of their products, they should also be based on actual market conditions." According to the above-mentioned jurisprudence, Japanese judgment standards can also be summarized into three points. The first is that the basic criterion of similar trademarks lies in whether it is easy to cause confusion. The second, the judgment of similar trademarks should be a comprehensive inspection of the appearance, meaning and pronunciation of the trademark. The last, where possible, judgments should be made based on specific market conditions and trading habits. This standard is not only used in the examination of trademark application procedure, but also involved in trademark infringement cases. For example, in the case of [小僧寿し], the defendant was a take-out sushi chain store, its trademarks were [小僧寿し], [KOZO] [KOZO SUSHI], and

"  ". The plaintiff's registered trademark [小僧] designated in the class 45 on food and seasoning products. In the plaintiff's lawsuit against the defendant, the Supreme Court held that "the appearance of the trademark, meaning, and pronunciation is just one aspect for judging whether it is easy to cause confusion and misunderstanding. Therefore, even if the above three points are similar, if other aspects are obviously different, or the possibility to cause confusion is quite low, the marks should not be judged as similar marks."

Comparing the practice between China and Japan, we can see that there are differences in understanding of "similarity". In China, trademark similarity is not only a factual concept, but also a legal judgment. In short, trademark similarity = similar of signs + confusion. If the two marks are similar, even if other factors are considered, it is often difficult to conclude that they will not cause confusion and do not constitute similar trademarks. In practice, most cases are judged based on the similarity of the trademark per se. In Japan, there is only one criterion for similarity judgment, which is the possibility of causing confusion. The degree of similarity of the trademark mark itself, market habits are only the basis for judging whether it has caused confusion. Moreover, in the judgment, the general attention of the general public concerned should be emphasized as the standard.

III. Judgment methods for similar trademarks

Regarding the similarity judgments of different types trademarks in China, especially the comparison methods between word trademarks, device trademarks, and combination trademarks are summarized in the " Standards of Trademark Examination and Trial" and explained with examples. Among them, 1. For word marks, the glyph is usually the most important. If the glyphs are the same or similar, they can be considered to constitute similarity. If different, they need to have same pronunciation and meaning to be considered as similarity. For example, "法宝" and "发宝", they have the same pronunciation, but different in glyphs and meanings, therefore, they do not constitute similar trademarks[v]. 2. Graphical trademarks can be further divided into figurative and abstract graphic trademarks. Figurative graphic generally mean that the trademark can be identified as a specific thing. Abstract graphics refer to graphics that are difficult to correspond to specific things. The similarity judgment of graphic trademarks is mainly compared in terms of design elements and overall composition. For example, the overall composition of the following two trademarks is similar, and it is easy to cause confusion visually, so they constitute similar trademarks.

3. In the comparison of combined trademarks, the word part usually plays a more important role. The examination standard on combined trademarks is based on the principle of combining overall comparison with comparison

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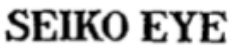
with major parts. The overall comparison is the foundation, and the main or significant part of the trademark must be considered. The difficulty with such an application is which one will prevail? How to decide which part is the major part? In practice, any part of a combination mark, either the word part or graphics part, if similar to the previous trademark, the combination mark and the previous mark are deemed as similar trademarks. For example, the following two trademarks are not similar in overall comparison, but the word is similar, they also constitute similar trademarks.

In Japan, similar trademark comparisons are also carried out from three aspects: visual effects, pronunciations, and meanings. Different from China, the most important element of the three is "pronunciation", followed by meaning and appearance. The author believes that this is mainly because there are many forms of Japanese characters such as pseudonyms, Chinese characters, and foreign words in daily life in Japan. The pronunciation and meaning of different words are the same, but the writing is different, so pronunciation becomes an important means to distinguish different signs. 1. For word marks, if the pronunciations are same or identical, the marks can be regarded as similarity. For example: "「アトミン／Atomin」と「アタミン／ATAMIN」. 2. The comparison of graphic trademarks, Japan emphasizes the overall comparison and the general attention of the relevant public instead of paying too much attention on details. For the following two graphic trademarks, due to the overall composition of the graphic and the impression left by consumers, they are still considered as similar trademarks despite differences in details.

3. Different from China, the comparison of Japanese combined trademarks attaches more importance to "comparison of major parts". Extract the main part of the trademark as the first step, and then consider whether they are similar. Of course, when extracting the main parts, the degree of combination of the parts in the combined trademark must also be considered. In the case of [eye miyuki], the court held that [SEIKO] and [EYE] in the cited trademark were used in combination with the eyewear product, and [SEIKO] played a role in distinguishing the source of the product, while the [EYE] part is closely related to the designated products and threof the distinctiveness of this part is low. Therefore, although [eYe] is highlighted in the application trademark, the main part of the cited trademark [SEIKO EYE] is [SEIKO], so the two trademarks are not considered to constitute similarity.

(application mark)



(cited mark)

IV. Summary

As mentioned in the preface of this article, the main role of trademarks is to distinguish the origin of goods or services. The use of the same or similar trademarks on same or similar products will inevitably lead to confusion and misidentification to relevant consumers. Therefore, in order to prevent confusion, both the Paris Convention and the TRIPS Agreement stipulate that “the member states' trademark registration authorities shall prevent all third parties from dealing with registered trademarks in the trade process without the consent of the owner of registered trademark on same or similar goods or services.”

Both China and Japan are members of Paris Convention and TRIPS Agreement, the above provisions are reflected in the trademark laws of both countries. Although there is no clear standard in the statute, ruling "causing confusion" is a standard, we can see that in practice, judicial authorities in both countries have taken "probability of confusion" as an aspect when judging similar trademarks. Especially after the Trademark Law was amended in 2013, Chinese courts have more actively applied the "possibility of causing confusion" to trademark infringement cases,

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such as the case [非诚勿扰][vi]. However, we also noticed that both China and Japan's trademark rights must be obtained through administrative procedures, and the similarity judgment standards of administrative authorities and judicial authorities still differ to certain extent. Especially in China, the number of trademark applications in 2018 has exceeded 7 million. The huge number of applications determines that during the trademark registration stage, examiners can only focus on examining and comparing the trademark mark itself and the goods or products in accordance with the Standards for Trademark Examination and Trial. The basic attributes of the service cannot be determined to cause confusion. In order to rectify trademark registrations obtained through improper means in administrative procedures, Japan has formulated a system of [abuse of power]. In this regard, the author believes that China's invalidation system against registered trademarks needs to be improved.

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i Goods or services related to the business of others that are widely known or similar to consumers and are used on or similar to those goods or services;

ii The same trademark with other's registered protective trademark (refers to the mark obtained by the registration of a protective trademark, the same below), and is used on the goods or services specified by the registration of the protective trademark;

iii Trademarks that may be confused with goods or services related to another person's business;

iv Trademarks that are the same or similar to those that represent goods or services related to another person's business and are widely known among domestic and foreign consumers, for improper purposes (referring to the purpose of obtaining improper benefits, Improper purposes for the purpose of increasing damage by others, the same below) held and used (except those listed in the preceding paragraphs);

v (2012) No.1 Intermediate Court Admin 1st Instance 2162;

vi (2016) Guandong Civil Retrial No. 447.

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Ms. WU is very experienced in trademark opposition, invalidation, administrative litigation, trademark application, layout and analysis on strategic brand program of enterprises, and particularly in dealing procedures after trademark right affirmation and sophisticated administrative or litigation cases. She has had a significant impact for her strong expertise in multiple cases handled. Ms. WU has represented many Fortune 500 companies in over thousands of trademark prosecution and litigation cases. The cases dealt with by Ms. WU have been awarded as the excellent cases by China Trademark Association. The "Kyocera" trademark opposition review administrative lawsuit handled by her has made the trademark of the right holder recognized as a well-known trademark through judicial channels.

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