

# Practical Use of the Defensive Mark System in Japan

By Mr. Mitsuharu TAKEUCHI, SOEI Patent & Law Firm, Japan

---

## 1. Introduction

One option for protecting a well-known trademark in the Japanese Trademark System is to obtain a “Defensive Mark Registration.” In 1960, the Japanese Trademark practice introduced “Defensive Marks” based on the British Trademark System in order to enhance the protection of well-known trademarks.

A Trademark Registration only provides protection when a third party uses the mark with respect to goods/services similar to or the same as the goods/services designated for a Registered Trademark. However, use of the mark by a third party with respect to goods/services different from the goods/services designated for the trademark may cause confusion, dilution or pollution if the trademark is well-known and damage the goodwill that has accrued to the Registered Trademark. The “Defensive Mark System” is able to remedy this weakness in the protection provided by trademark registration.

## 2. Registration Requirement

Art.64 of Trademark Law sets out the requirements for registration of a Defensive Mark. These requirements may be outlined as follows:

- (1) Registered Trademark [A] is well-known with respect to the designated goods/services provided by the trademark owner and designated in the registration.
- (2) If a third party were to use Trademark [A] with respect to goods/services, [B], which are different from and not similar to the goods/services designated in the Trademark [A] registration, there is a risk that consumers would be confused about the origin of the goods/services, [B].
- (3) The application for a Defensive Mark is filed by the owner of Trademark [A], is directed to Trademark [A] and designates the goods/services, [B].

### 3. Defensive Mark Protection

The table below compares the range of protection provided by Trademark Registrations and Defensive Mark Registrations

	Range of Protection (A third party's trademark application that meets the following conditions will be rejected, and the registrant can excise its rights against a third party if the third party uses a mark with respect to goods/services that meet the following conditions.)	
	Mark	Goods/Services
Trademark Registration	similar or same	similar or same
<b>Defensive Mark Registration</b>	<b><u>same</u></b>	<b><u>same</u></b>

As shown in the table, the range of protection of a Defensive Mark Registration is narrower than that of a Trademark Registration. As a result, it seems to be impractical to protect a well-known mark with only the Defensive Mark System because the number of goods/services on this earth that could cause confusion with respect to a well-known mark could, in many cases, be too many. That is to say, in order to obtain secure protection for a well-known mark using only the Defensive Mark System, the trademark owner has to designate all the goods/services for which there is at least some risk of infringement.

### 4. Value of the Defensive Mark System in Practice

In practice the value of the Defensive Mark Registration is not only the protection provided by a Defensive Mark Registration. The value of a registration often lies in providing a means for easily proving the fame of the registered mark in a Trademark Invalidation Trial or a lawsuit alleging infringement, etc. The mere fact that the mark has been registered as a Defensive Mark means that the JPO has officially determined that the mark is well-known, and, regardless of the goods/services with which a third party uses the mark, it is easy to prove that the mark is being used to compete unfairly or is infringing under the Unfair Competition Prevention Law.

For this reason, some companies actively take advantage of the Defensive Mark System.

## 5. Samples of Registered Defensive Marks

Following trademarks, for example, are registered as Defensive Marks.

The Adidas logo, consisting of the word "adidas" in a bold, lowercase, sans-serif font.

Reg. No. 1499855



Reg. No. 1517133



Reg. No. 4258117

The Industrial Property Digital Library (IPDL) provides information on registered Defensive Marks in its "Japanese Well-Known Trademark" database ([http://www.ipdl.inpit.go.jp/homepg\\_e.ipdl](http://www.ipdl.inpit.go.jp/homepg_e.ipdl)). Anyone can see the list of registered Defensive Marks in the database.

### ***For more information, please contact:***

Mr. Mitsuharu TAKEUCHI

Patent Attorney

SOEI Patent & Law Firm

Marunouchi MY PLAZA 9th fl.

1-1, Marunouchi 2-chome, Chiyoda-ku, Tokyo 100-0005 JAPAN

Tel: +81-3-6738-8022 (for English)

Fax: +81-3-6738-8015

E-mail: [trademark@soei-patent.co.jp](mailto:trademark@soei-patent.co.jp)

Website: <http://www.soei.com/>

Mr. Takeuchi received his B.S. (2001) and M.Litt. (2003) in Modern History from Kyoto University, Japan. After graduation, he worked for the Welfare Department in Kyoto City Hall. In 2011, after working for another patent law firm in Tokyo as a translator for two years, he qualified as a Patent Attorney and joined SOEI Patent & Law Firm, where he specializes in Trademarks.