



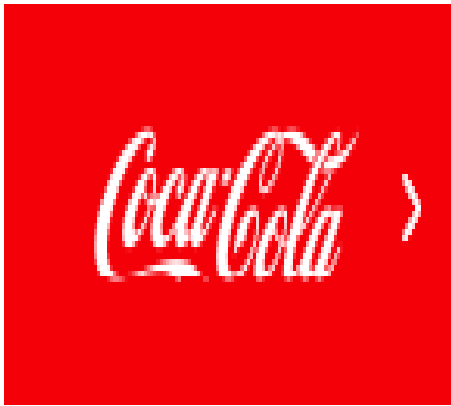
Trade Mark Act in Japan

How to use trademarks to protect the brand

Takeda & Hasegawa
Attorney at Law
Kentaro Hattori

1. Introduction

The growing importance of brands



SONY



fans, repeaters



1. Introduction

Functions of trademarks (functions of brands)

Indication of origin or ownership

Guaranteed performance

Advertisement

1. Introduction

The market is worldwide.

Needs to be acceptable in worldwide.



1. Introduction

Everyone learns from successful case.

however,

- copy, imitation
 - free ride or dilution of high reputed brand will happen
 - barrier to enter is necessary
- ⇒ Intellectual property rights
especially trademarks

1. Introduction

(Effects of trademark right)

Article 25

The **holder of trademark** right shall have an **exclusive right** to use the registered trademark in connection with the **designated goods or designated services**

1. Introduction

(Right to demand injunction)

Article 36 (1) The holder of trademark right or of exclusive right to use may demand a person who is infringing or is likely to infringe the trademark right or the exclusive right to use **to stop or prevent such infringement.**

(2) In making such a demand under the preceding paragraph, the holder of trademark right or of exclusive right to use may demand the person to take measures necessary for the prevention of such infringement, including **the destruction of articles which constitute the act of infringement** and the **removal of equipment** used for or contributing to the act of infringement.

1. Introduction

(Acts deemed to constitute infringement)

Article 37 The following acts shall be deemed to constitute **infringement of a trademark right** or an exclusive right to use:

(i) the use of a trademark **similar to the registered trademark** in connection with the **designated goods or designated services**, or the use of the registered trademark or a trademark similar thereto in connection with goods or services **similar to the designated goods or designated services**;

2. Trademark Act of Japan

No universal trademarks

The systems may be different country by country

Principle of territoriality

Needs to acquire country by country

cf copyrights

ex cases concerning “i Phone” trademarks

2. Trade Mark Act in Japan

How can we acquire a trademark right?

REGISTRATION-BASED DOCTRINE
(ex Japan)

AND

USE-BASED DOCTRINE
(ex United States)

2. Trade Mark Act in Japan

REGISTRATION-BASED DOCTRINE

First to File principle

No need of use to register

Can exercise the without using trademarks

adopted in CTM(EU), Japan, China or other many countries.

2. Trade Mark Act in Japan

USE-BASED DOCTRINE

United States

No need of registration

need of using the trademarks to exercise the rights

registration of trademarks

- 1) Based on Use,
- 2) Based on "Intent-to-Use,"
- 3) Based on a Foreign Application,
- 4) Based on a Foreign Registration,
- 5) Based on extension of protection of an international registration to the US (Madrid Protocol)

2. Trade Mark Act in Japan

United States

Merits of registration

constructive use and nationwide in effect (Lanham Act § 7(c))

incontestability (Lanham Act § 15)

constructive notice (Lanham Act § 22)

prima facie evidence (Lanham Act § 33)

2. Trade Mark Act in Japan

What is the trademark ?

United States

The term “trademark” **includes** any word, name, symbol, or device, or any combination thereof

The term “service mark” means any word, name, symbol, or device, or any combination thereof

wider protection (from the perspectives of definition and distinctiveness) than Japan
function as a **source designator**

2. Trade Mark Act in Japan

Example of trademarks

3-D marks, Color per se marks, Sound marks

Motion marks, Hologram marks, Position marks

Scent marks, Taste marks, Touch marks and

Trade dress

Registration Number 1639128

Description of Mark THE MARK IS A HIGH IMPACT, FRESH, FLORAL FRAGRANCE REMINISCENT OF PLUMERIA BLOSSOMS.

US Registration Number: 3155702

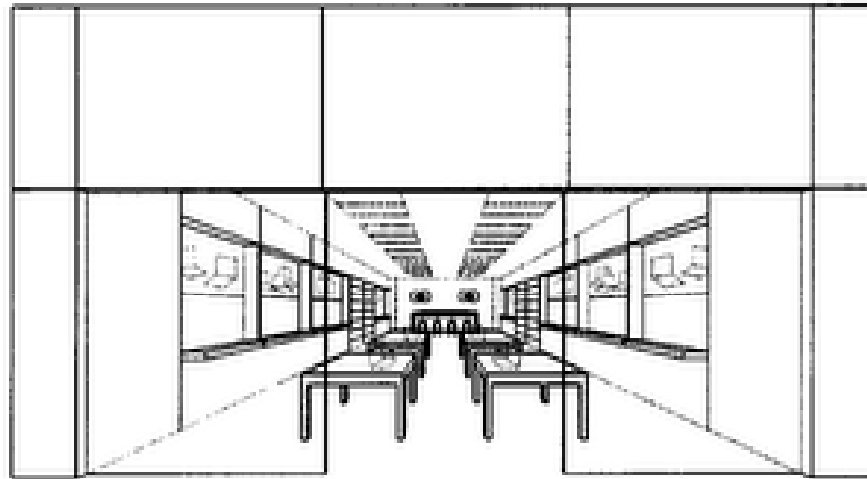
The mark consists of a velvet textured covering on the surface of a bottle of wine. The dotted line in the drawing is not a feature of the mark but is intended to show the location of the mark on a typical container for the goods; the dark/lower part of the container drawing shows the mark. The stippling in the drawing is not a feature of the mark, but a representation of how one type of velvet covering may appear in visual form. The mark is a sensory, touch mark



2. Trade Mark Act in Japan

Example of trademarks

Trade dress: the visual appearance of a product or others



2. Trade Mark Act in Japan

Japan

Definition of the trademarks- revised in 2014

(Definitions, etc.)

Article 2 (1)

“trademark” in this Act means any character(s), figure(s)s, sign(s), three-dimensional shape(s), or color(s) or any combinations thereof; or sounds or any others as provided by Cabinet Order, as recognized by a person’s perception.

2. Trade Mark Act in Japan

Examples of new types of trademark in Japan



color marks



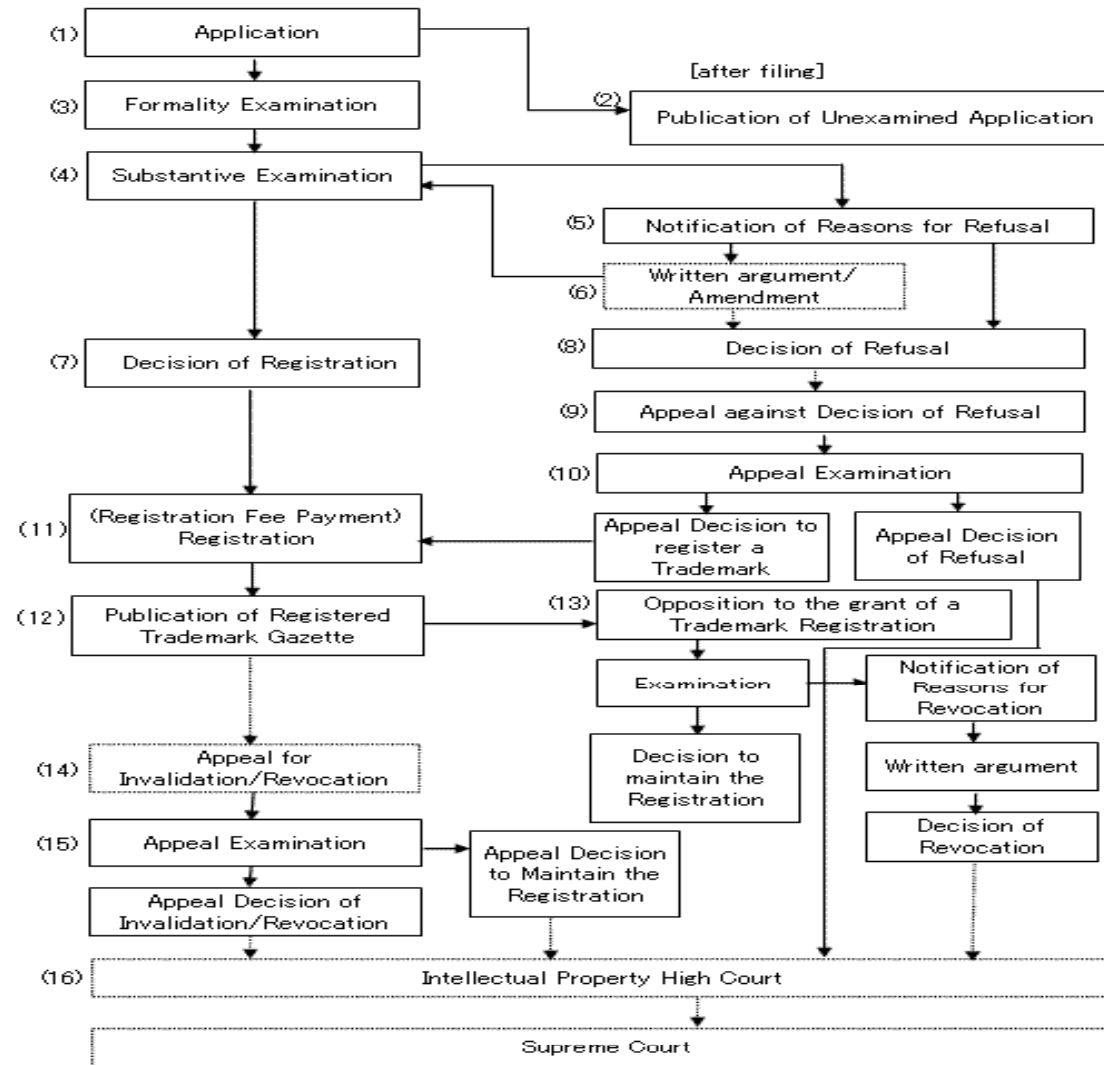
position marks

distinctive from others?

- No registered trademarks consists from color only in Japan
 - any battling with other IPs such as copyrights or designs ?

2. Trade Mark Act in Japan

Procedures for Obtaining a Trademark Right



2. Trade Mark Act in Japan

Application of trademarks

(Application for trademark registration)

Article 5 (1) Any person who desires to register a trademark **shall submit an application** to the Commissioner of the **Patent Office** accompanied by the required documents. The application shall state the following matters:

- (ii) **the trademark for which registration is sought**; and
- (iii) **the designated goods** or **designated services** and the class of goods or services provided by Cabinet Order as provided for in Article 6(2).

cf patents, designs: no need to be novel

cf copy rights: need of application

2. Trade Mark Act in Japan

Designated goods or designated services

Even if one holds a trademark in certain designated goods, others can register the same trademark in other designated goods or services in principle.

Nice Classification

goods; class 1 to 34

services; class 35 to 45

example class 25; Clothing, footwear, headgear

2. Trade Mark Act in Japan

Once the application filed, the examiner of the JPO will examine.

(Requirements for trademark registration)

Article 3 Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

- (i) consists solely of a mark indicating, in a common manner, the common name of the goods or services;
- (ii) is customarily used in connection with the goods or services;
- (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;
- (iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person;
- (v) consists solely of a very simple and common mark; or
- (vi) is in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.

(Unregistrable trademarks)

Article 4 (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(1) consists of a mark indicating, in a common manner, the common name of the goods or services;

2. Trade Mark Act in Japan

Once the application filed, the examiner of the JPO will examine.

(Unregistrable trademarks)

Article 4 (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

- (i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;
- (vii) **is likely to cause damage to public policy**;
- (viii) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);
- (xi) **is identical with, or similar to, another person's registered trademark** which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (referring to goods or services designated in accordance with Article 6(1) (including cases where it is applied mutatis mutandis pursuant to Article 68(1)); the same shall apply hereinafter), or goods or services similar thereto;

2. Trade Mark Act in Japan

Once the application filed, the examiner of the JPO will examine.

(Unregistrable trademarks)

Article 4 (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(i) to (vii), (ix) and (x vi): **absolute registration bars**

(viii) , (x) to (x v) , (x vii) to (x ix): **relative registration bars**

(xi) is **identical with**, or **similar** to, another person's registered trademark (omitted), if such a trademark is used in connection with the **designated goods or designated services** (omitted) or goods or services **similar thereto**;

cf In the cases of CTM, the examiner checks only the formality and absolute registration bars **but does not check relative registration bars**.

2. Trade Mark Act in Japan

What is “similar” trademarks?

“a likeness between trademarks which, when the two marks displayed on their respective products, may lead to **confusion over their source.**”

(Vol. 15, No. 6, Supreme Court, Minshu, p. 1730, Jun. 27, 1961. Vol. 22, No. 2, Supreme Court, Minshu, p. 399, Feb. 27, 1968.)

2. Trade Mark Act in Japan

What is “similar” goods or services?

whether an identical trademark being attached to more than one good or service would cause **confusion**

Standards on Similarity of Goods or Services

2. Trade Mark Act in Japan

If the examiner refuse to register the trademark,
you can appeal (§ 44)

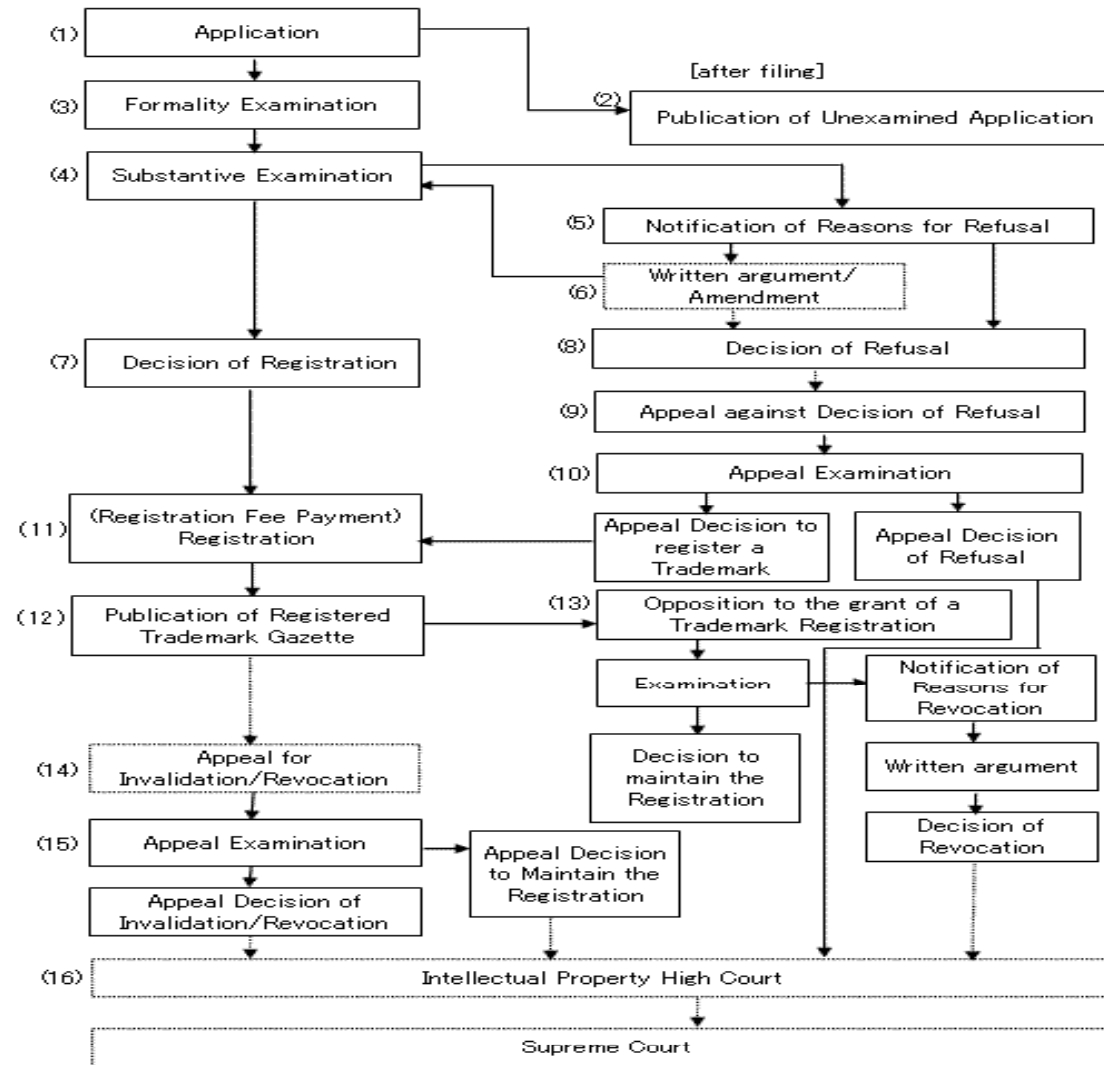
If the examiner decides the trademark shall be
registered,

The duration of the trademark: 10 years
may be renewed (§ 19)

cf other intellectual property rights such as
patent

2. Trade Mark Act in Japan

Procedures for Obtaining a Trademark Right



2. Trade Mark Act in Japan

If the examiner decides the registration of a trademark, but you think the trademarks shall not be registered, you can:

- (a) file an **opposition within two months** or,
- (b) request for **a trial for invalidation** of the trademark registration

2. Trade Mark Act in Japan

(Opposition to registration)

Article 43-2

Any person may file with the Commissioner of the Patent Office an **opposition** to registration **within two months from the date of publication of the bulletin containing the trademark**, on the grounds that the trademark registration falls under any of the following items;

2. Trade Mark Act in Japan

(Trial for invalidation of trademark registration)

Article 46 (1)

Where a trademark registration falls under any of the following items, a request for a trial for invalidation of the trademark registration may be filed;

2. Trade Mark Act in Japan

A trademark **becomes socially valuable only when it is used.**

Where a trademark is not used in connection with any of the designated goods and designated **services for three consecutive years**, any person may file **a request for a trial for rescission of such trademark registration.** § 50

cf other types of intellectual property

2. Trade Mark Act in Japan

Remedies for the infringement of a trademark

see the slides page No.6 to 8

Presumption of amount of damage is ruled. § 38

Use as a trademark



3. Practical issue concerning Trademarks

The character of intellectual property; **incorporeal**

Therefore, people can use simultaneously.

You can license a trademark.

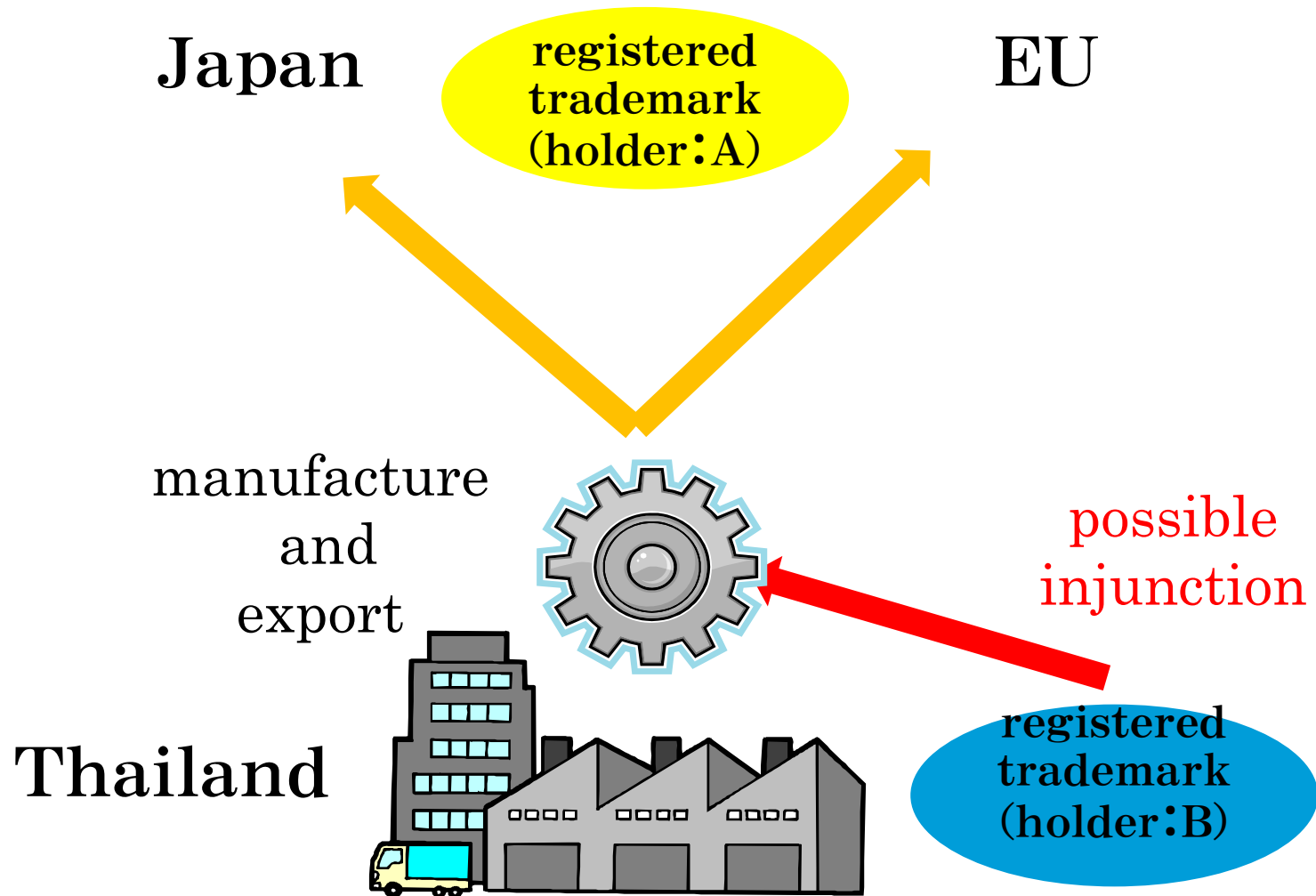
⇒ conditions concerning quality control is important.

potential infringement of a trademark

⇒ needs of continuous check and warranty of non- infringement by your business partner

3. Practical issue concerning Trademarks

The Principle of territoriality



3. Practical issue concerning Trademarks

What would you do if you find a trademark is already registered by a third party?

consent to register by the third party (no consent rules in Japan)

get licensed

buy the trademarks

3. Practical issue concerning Trademarks

First to File principle

Passing off problems in China

iPad

蜡笔小新



The best way to protect is to register trademarks in China.

3. Practical issue concerning Trademarks

Counterfeit problems

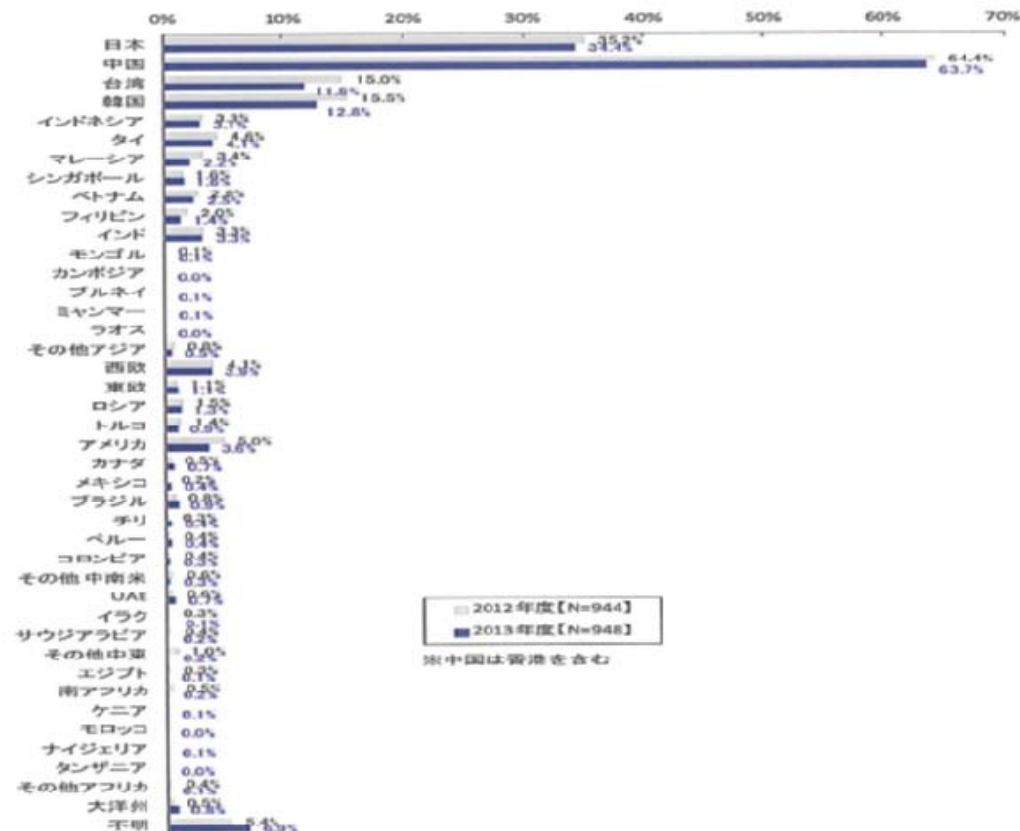
The damages to the sales, reputation of the brand

3. Practical issue concerning Trademarks

Counterfeit problems

More than 60% of counterfeit of Japan are made in China

図 2.3-1 模倣品・サービスの製造国・地域の被害社率（複数回答）

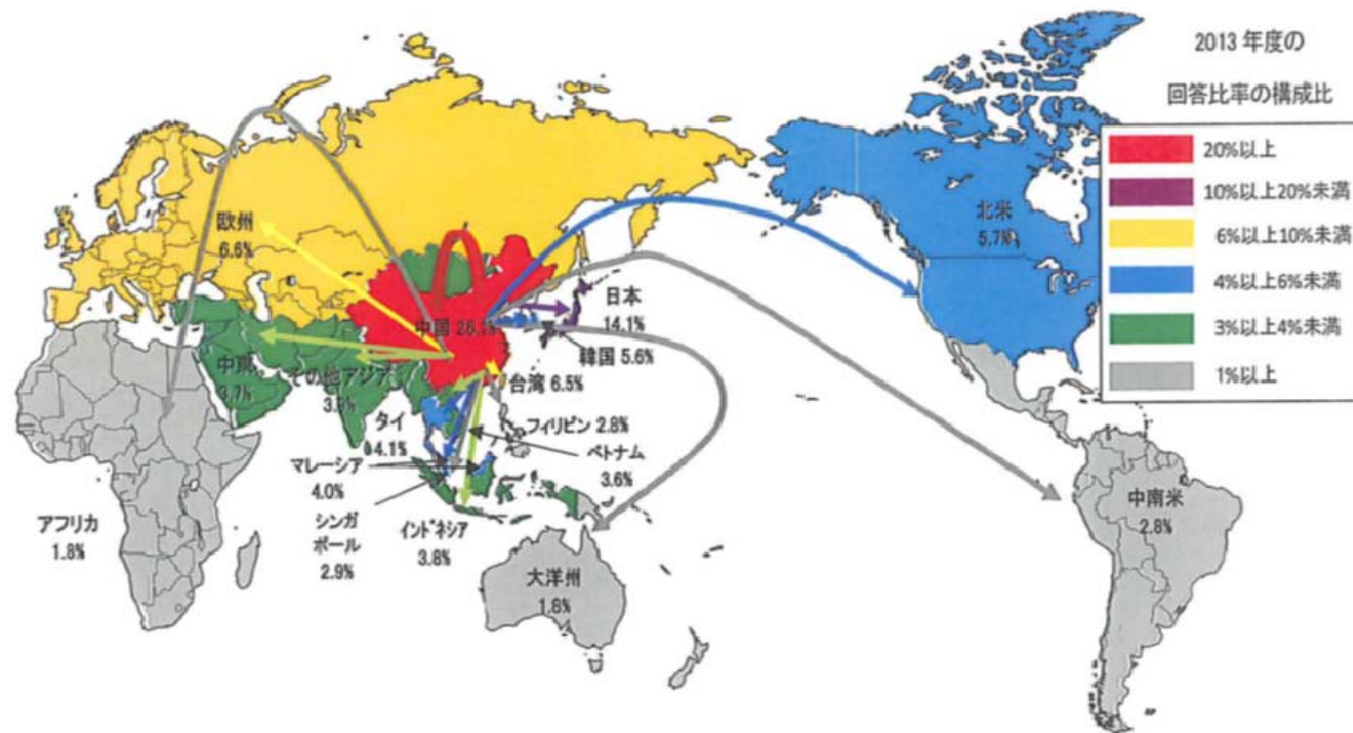


3. Practical issue concerning Trademarks

Counterfeit problems

Counterfeits made in China are exported to the world

図 2.3-18 中国で製造された模倣品・サービスの販売提供国・地域（流出先）の構成



3. Practical issue concerning Trademarks

Counterfeit problems

Examples of raid by Chinese Administration for Industry and Commerce(AIC)

The materials will be shown but not attached here due to my confidentiality duty.



Thank you!

If you have any questions, please feel free to contact me.

hattori@takedalaw.jp