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Asia IP Focus, Japan: A strategic approach for TM protection

To obtain secure trade mark rights in Japan you must prepare properly, writes Paul Smith of Ryuka IP Law Firm

The Trade Mark Law in Japan is designed to identify a particular manufacturer or seller's products or services and distinguish them from products or services made, sold, or provided by another. Trade marks in Japan, like patents, operate under a first-to-file system. The duration of a trade mark is 10 years, and is renewable. Since 1992 service marks can also be registered. All communications with the Japanese Patent Office (JPO) must be in Japanese.

This article provides an overview of the Japanese trade mark process and strategies for trade mark applicants to successfully secure their trade marks in Japan. We also propose guidelines for avoiding common pitfalls in Japanese trade mark practice.

Requirements for filing

An applicant in Japan may claim priority based upon a trade mark application filed in any other country that is a signatory of the Paris Convention.

Necessary information

Any person desiring trade mark registration is required to submit a request to the Commissioner of the Japanese Patent Office stating the following:

1. the name and address of the applicant and, in the case of a legal entity, the name of an officer entitled to represent the applicant;
2. the trade mark for which registration is sought; and
3. the designated goods or designated services and the class of goods or services as prescribed by Cabinet Order.

If foreign priority is being claimed, then a declaration indicating at least the filing date and the country of the first application is necessary at the time of filing. A certified copy of the priority document must be submitted within three months from the Japanese filing date.

A power of attorney is not required at the time of filing but is required for some procedures, such as filing an appeal against the final rejection, abandoning an application, or withdrawing an application. The power of attorney must be signed by the applicant (not notarized or legalized).

Who may register a trade mark

Any person or legal entity that intends to use a trade mark in Japan may file for registration. The threshold for showing intention appears to be met merely by filing.

Current use in Japan is not required for the applicant to file an application or to register a trade mark. Furthermore, it is not necessary for the applicant to prove intent-to-use.

An applicant who has no domicile or place of business in Japan is also entitled to registration if the person is a national of the country that constitutes a Union of Paris Convention, International Protection of Industrial Property Trade mark Law Treaty, or the World Trade Organization (WTO).

Representation

An applicant who has domicile or residence in Japan may represent himself or herself before the Patent Office, or may be represented by a patent attorney (*benrishi*) or a general attorney (*bengoshi*). However, an applicant who does not have a domicile or residence in Japan must be represented by a *benrishi* or *bengoshi* who has their domicile or residence in Japan.

The domicile or residence of a *benrishi* or *bengoshi* representing an applicant who does not have a domicile or

residence in Japan will be considered when determining the proper venue for litigation.

Ownership rights

The registration of a trade mark gives the registrant an exclusive right to use the mark in connection with the designated goods or services. Only when a trade mark is registered does its respective right become effective. Therefore, prior use of an unregistered trade mark does not automatically confer an exclusive right to use the mark with respect to the specified goods or services. However, any person or business that has been using a trade mark in Japan that is identical or similar to a registered trade mark prior to the application date of the registered trade mark is allowed to continue to use the mark, assuming the mark has become well-known.

Applying for a trade mark

Trade mark applications to the JPO can be filed online, at which time an application number is immediately issued.

The chart below shows the steps in prosecution of a trade mark application in Japan.

Japanese law allows for multi-class applications. This means that the designation of more than one of the 42 classes of goods and services is permitted in a single application.

Japan trade mark filing process

