

Differences of Trademark Practices in Japan

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This article provides an overview of the Japanese trademark process and strategies for trademark applicants to secure their trademarks in Japan.

1. CONSIDERATIONS BEFORE FILING

Intent to Use the Trademark

Actual use or intent to use the trademark is required for the applicant to register a trademark. In Japan, each international class is further divided to subclasses. If goods or services are selected from more than seven subclasses within a single International class, the patent office will require a declaration accompanied by a business plan in order to prove applicant's intent to use the trademark. Generally, an applicant is not required to provide evidence of the intent to use the trademark.

What is Registrable

A trademark may include colors and may be two-dimensional or three-dimensional, but mere color without any accompanying figure is not permitted in Japan. Similarly, sounds and smells are not eligible for trademark protection.

Prior Use

Prior use of an unregistered trademark will not automatically confer an exclusive right to use the mark. However, any person that has been using a trademark in Japan that is identical or similar to a registered trademark prior to the application date of that registered trademark will be permitted to continue to use the mark, assuming that the mark being used had become well known.

Term of registration and renewal

The term of trademark protection is 10 years from registration and is renewable indefinitely. A request for renewal may be filed within six months before the expiration without a surcharge and within six months after the expiration for a 100 % surcharge.

Description of Goods and Services

The JPO published "Acceptable Descriptions of Goods and Services," which can be viewed through www.ryuka.com/goods. The JPO is very strict in the description of goods and services. The International standard classifications for goods and services are sometimes rejected as well. If the actual goods or services correspond to the Acceptable Description, the Acceptable Description should be used.

If the actual goods or services do not correspond to any Acceptable Description, the goods or services should be listed with specificity and the application should contain a detailed

explanation of the goods or services, such as pamphlets or print-outs from web sites, so that the examiner is able to clearly understand the nature and scope of the goods or services. The examiner will then suggest a description in the first office action.

During prosecution, the applicant is permitted to further limit goods or services, but may not broaden them. At the time of filing, it is advisable to add a broad identification of goods and services to support future limitation, especially in cases where the actual goods or services sought to be registered do not correspond to the Acceptable Description.

2. EXAMINATION

Examination

All trademark applications are subject to a substantive examination by the Japanese Patent Office. Requests for expedited examination are permissible in special circumstances, such as possible infringement of the trademark or a pending application in a foreign country. Trademarks are examined for distinctiveness and registrability including:

1. Whether an identical/similar trademark is registered for identical/similar goods/services;
2. Whether a famous trademark exists in Japan or abroad;
3. Whether the trademark contains the stage name of another person or a famous abbreviation thereof; and
4. Whether a trademark is identical or similar to any national flags or state coat-of-arms;

If any of the above requirements are met, the examiner will issue a notice of reasons for rejection, to which a foreign applicant must respond within three months.

Amendment and Argument

If the application is rejected based on a prior mark, conflicting goods or services may be deleted from the application to avoid the citation. The Applicant may also argue dissimilarity of the mark. However, changes to the trademark, even minor alterations, are not permitted. When responding to rejections, an applicant is encouraged to use arguments supported by past JPO, court rulings, or any other relevant supporting documents.

Cancelling a Cited Trademark

If overcoming the rejection appears difficult, one option that is routinely chosen in Japan is to file a non-use cancellation request against the cited trademark. If the registered trademark has not been used in connection with any conflicting goods or services within the last 3 years, the cited mark will be successfully cancelled for the conflicting goods or services.

Consent

Mere consent from the owner to use the cited trademark will not cure a rejection in Japan. However, by temporarily assigning the trademark application to the owner of the cited trademark, the rejection can be overcome. After the trademark is successfully registered, the registered trademark is assigned back to the original applicant in under a contract made prior to the registration. Another option is to negotiate with the owner of the cited trademark for either a direct assignment or a license of the cited trademark. For matters of negotiating with the owner of the cited trademark, making the contract, and pursuing the above assignments, please contact us at cases_to_jp@ryuka.com.

Secondary Meaning

If the trademark application is rejected based on lack of distinctiveness, proof that the mark has acquired distinctiveness through long and extensive use may be sufficient to register the mark. If this option is not available, it may be necessary to ensure that the mark is not registrable in Japan so that no other party would be able to obtain registration of the mark. For that purpose, filing an argument or even an appeal to confirm rejection should be undertaken.

3. AFTER THE REGISTRATION

Post-grant opposition

Any parties that oppose a registration of a particular mark may file an opposition within two months of the publication of the registered trademark. If the board examiners find a reason to cancel the registration, the owner will be notified and given an opportunity to respond. If the grounds for the opposition are not overcome, the examiners will render a decision to cancel the registration, which may be appealed to the Tokyo High Court. If the opposition is limited to portion of the designated goods or services, classes representing that portion are cancelled.

Assignment and licensing

A registered trademark or trademark application may be assigned for one or more of the specified goods or services. Except in cases of inheritance or other general succession, the transfer of a registered trademark is not effective until recorded.

An exclusive licensee may not transfer the exclusive license nor grant a non-exclusive license to another without the express permission of the trademark owner. However, if a related business is transferred concurrently with the mark (*e.g.*, as in the sale of a business), the exclusive license may be transferred without separate permission from the trademark owner.

While exclusive licenses of marks are affected via recordation with the patent office, non-exclusive licenses need not be recorded. However, in order to avoid potential problems, we suggest recording non-exclusive licenses with the Japan patent office as soon as possible.

Non-use cancellation

If a registered trademark has not been used for given designated goods or services for three years in Japan, a third party may file a non-use cancellation request against the trademark registration with respect to those goods or services. The trademark registration will be cancelled unless the registrant provides sufficient evidence of use or a justifiable reason for non-use of the mark.

In Japan, use by a licensee considered as use of a registered trademark for purposes of non-use cancellation. A registered trademark is also regarded as being in use even if the trademark owner uses a slightly different trademark consisting of the same characters in a different style, or different characters having the same pronunciation and concept. For example, a registered trademark consisting of Romanized characters is considered to be in use if a trademark consisting of Japanese Katakana syllables that has the same pronunciation and concept is used.

Trial system

Trials include those for invalidating trademark registration, cancelling trademark registration due to abuse, and cancelling trademark registration to avoid confusion over source. A body consisting of three or five trial examiners handles all of the trials and either party may appeal the decision of the trial examiners to the Tokyo High Court.

4. PLANNING FOR SUCCESS

In order to decrease the possibility of rejection and trademark infringement, it is recommended that a preliminary trademark search be carried out, with a view toward registration encompassing a broad specification of goods and/or services. Initial effort and strategic planning will provide an applicant with a greater chance of registration and the final result of a registered trademark with strong enforcement rights in Japan.

In order to file a trademark application in Japan, we require the following:

1. Name and address of the applicant;
2. Filing date and the country of the priority application, if any;
3. Trademark; and
4. Classes and Designated goods or services

More than one class may be selected in a single application. A certified copy of the priority application must be submitted within three months of the Japanese filing date, and a power of attorney is not required unless an appeal is filed.

Should you have any questions, please feel free to contact us.

Truly yours,

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