

Differences of Trademark Practices in Japan

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Filing Trademark Applications

Registerable Trademarks

Marks with color, **movement** and/or **its position**

Three-dimensional marks

Colors per se

Sounds

Holograms

Not Registerable

Smells

“Katakana” Expressions

- Alphabetical TMs can be transliterated to Katakana. The alphabetical and Katakana trademarks have similar scopes of protections with small differences, because of different outlooks.
- When a competing TM is similar with an alphabetical TM in sound, but not in outlook or meaning:
 - ⇒ Katakana version of the alphabetical TM is likely similar with the competing mark.

Katakana TM or Alphabetical TM

File in alphabet or Katakana, whichever will be used more in Japan.

For Japanese with average or lower level of intelligence
⇒ Katakana-expressions are often used.

For sophisticated people
⇒ Alphabetical TMs are often used as well.

Emphasizing the image of a foreign country
⇒ Alphabetical TMs are more often used.

Very important TMs ⇒ Filing in both

cf. US

Any slight intent to use is sufficient for filing and registering TMs

Generally suggested to **designate more goods** than in the U.S., even if added goods are not entitled to priority.

Note, however:

- Each Class is divided into subclasses in Japan.
If Subclasses > 22 (in a Class), declaration of intent to use and simple business plan are required.
⇒ We will send you those forms, as necessary.
- **Qualifications** required for performing the designated services must also be proven.

cf. US

Prior use of unregistered TM
does not provide exclusive right

Allowed to continue using TM, if the TM was:

- used for fair purpose,
- **well known** when the other filed the application,
and
- being used without termination.

If classes are improper, a new class cannot be added to Madrid application

Some goods fall into different classes in Japan
⇒ Include those classes for Japan
when filing a Madrid application

A new class **can be** added to a **domestic** application for reclassifying the goods/services

JPO is very strict regarding descriptions of goods/services

International standard goods/services are sometimes rejected.



Try to choose goods/services from the JPO's list of “**Acceptable Descriptions**” of goods/services, which can be viewed in English via https://www.ryuka.com/en/trademark/trademark_classes.shtml.

Please note that recent updates to the JPO list might not always be reflected to the English version.

If goods/services are not found
in the “Acceptable Descriptions,”

We explain goods in detail by submitting
pamphlets, print-outs from websites, etc.



Examiner will suggest a description.*

* If Examiner’s suggestion is not acceptable, please provide us with information about the goods/services and we will propose an appropriate description.

Goods/Services can only be limited after the application is filed

Broadening goods/services → ×



Include broader descriptions of
goods/services in the original application to
support further limitation, as necessary.

No POA nor other signed document is required for filing an application

We only need:

- Trademark, classes and goods/services*
- Name and address of applicant
- Priority information (six months)

Certified copy of priority application:

Due within three months of JP filing date.

Examination

Substantive examination is carried out typically within a half year

Can be **expedited** if:

- the applicant proves that it has substantially prepared to use TM, and
- a counterpart application was filed in abroad.

Similarity is analyzed differently at the JPO

- Trademarks

Largely based on the phonetics of the Japanese language, which is often different from true pronunciation.

For example, “r” and “l” are pronounced the same in Japan, as are “ce” and “se.”

- Goods/Services

The JPO mechanically considers the similarity of goods and services by whether they fall into the same subclass.

Dealing with refusal based on similar prior TM

- If cited mark was registered more than 3 years ago, consider filing **non-use cancellation** (next slide)
- **Temporary assignment** (following slide)
- If cited trademark application is still pending, **wait** for final decision on cited trademark
- Delete conflicting goods and/or argue dissimilarity

Even minor changes to TM are not permitted.

Non-use cancellation can easily be filed in Japan

- Requester has **no initial burden** of proof. ⇒
Cancellation is routinely filed in Japan.
- TM owner must prove the use for any challenged goods in the last three years or a justifiable reason for non-use.
- Challenged goods/services are cancelled, if not proved.
- If cited trademark is maintained, the applicant can still change designated goods/services at the JPO.
(If Madrid, at WIPO)

Consent does not help for overcoming prior TM

With “Temporary Assignment” → ○

Applicant

↓ Assignment

Owner of Cited TM ---> Your TM is registered

↓ Assignment

Original Applicant

RYUKA negotiates with the owner of the cited TM
to agree with “Temporary Assignment.”

For overcoming lack of distinctiveness, prove, for example:

Secondary meaning through long and extensive use

A unique concept being implied by the trademark

Not indicating the quality of goods/services considering general consumer's perceptions

Otherwise, **appeal and confirm rejection** to ensure that TM would not be registered by a third party.

(Appeal decisions are referred by other examinations)

Dealing with refusal based on implied contents of trademark

- Limit designated goods/services to those that are implied; or
- Explain that the trademark does not imply the contents of goods/services in light of the real market situation

After Registration

Post-grant opposition can be filed within 2 months of publication

- Any party may file, against even a portion of designated goods.
- Three or five trial examiners handle
- If reason for cancelation is found, TM owner may respond.
- If cancelled, an appeal may be filed with the IP High Court.

TM can be assigned for **a portion** of goods/services, but the assignment is not effective until recorded

- Licensee may not assign or grant any license without permission, except that a license may be transferred concurrently with a related business.

If a non-use cancellation is requested, what shall TM owner prove?

- Use by licensee is Okay.
- The following differences of TM are **Okay**.
 - the same characters in a different style, or
 - different characters with same pronunciation & concept

Ex) TM Registered: **Roman** Letters

TM in Actual use: Japanese **Katakana** Syllables

Thank you.

*We welcome any inquiries at:
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