

January 15, 2013

Kazufumi Dohi
Chair, Trademark System Subcommittee of the Industrial Structure Council
Legislative Affairs Office
Japan Patent Office
3-4-3 Kasumigaseki, Chiyoda-ku Tokyo
100-8915, JAPAN

Dear Chairman Dohi:

The American Intellectual Property Law Association (AIPLA) welcomes this opportunity to submit comments on the Draft White Paper of Trademark Act prepared by the Trademark Advisory Committee at the Japan Patent Office (“The Committee”).

AIPLA is a national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA commends the Committee for its efforts to improve the trademark protections in the Trademark Act, and has incorporated specific comments into the attached White Paper. If the Committee has any questions, requires further information, or wants to discuss AIPLA’s comments or other trademark issues, please let us know.

Sincerely,

Jeffrey I.D. Lewis
President

American Intellectual Property Law Association

Comments for Draft White Paper of Trademark Act:

Prepared by the Trademark Advisory Committee at the Japan Patent Office (“The Committee”).

Subject: Protection for Non-Traditional Marks

1. The Committee considers the Trademark Act should revise to make the following types of trademarks below register-able on the Registry.

- Moving mark
- Hologram mark
- Color mark without contour
- Position mark
- Sound mark

AIPLA COMMENTS:

AIPLA agrees with the Committee and supports a revision of the Trademark Act that would allow the above-listed marks to be registered on the registry. Technological advancement has made both filing and examining such marks much easier today than in the past. Moving marks, hologram marks, color marks, position marks and sound marks are all capable of effectively distinguishing goods or services from one undertaking from those of other undertakings, and consumers can recognize such marks as identifying particular goods or services. Such marks, while not fully conventional, can be produced and reproduced as meaningful graphic representations and/or can consistently render distinctive indication as to the source of goods or services.

2. The Committee considers the Trademark Act should not revise to make the following types of trademarks below register-able on the Registry.

- Scent mark
- Touch feeling mark
- Taste

AIPLA COMMENTS:

AIPLA believes that, under certain circumstances, scents, textures, and tastes can function as source-identifiers for goods/services, and in such circumstances they should be protectable and registrable as marks.

3. The Committee considers the Trademark Act should require the following information on filing document to secure a filing date and to specify a scope of protection.

Type of Mark	Requirement to secure filing date	Identifier of scope of trademark
Moving	Specify a representation of mark in a filing document.	Written description in filing document
Hologram		
Color		
Position		
Sound		<u>Digital source of sound and written description in filing document</u>

AIPLA COMMENTS:

AIPLA agrees with the filing requirements considered by the Committee. Digital video files could be helpful submissions, along with written descriptions, for moving, hologram, color and position marks. With particular regard to the filing requirements for Sound marks, AIPLA suggests that Applicants should submit both a digital source of the sound (such as an MP3 file), as well as a written description of the Sound mark. Sound marks, like all trademarks, should be distinctive, and a unique and memorable sound mark can be distinctly described in writing. Such a written description can assist in defining the bounds of the sound mark prior to examination. With the continued increase in the presence and use of mobile electronic devices, registrants are increasingly utilizing sonic experiences to convey and mark brand distinctiveness pertaining to goods and services.

4. The Committee considers the Trademark Act should treat an inherent distinctiveness on the non-traditional marks as below.

Type of Mark	Distinctiveness on marks
Moving	Inherently non-distinctive.
Hologram	Need acquired distinctiveness on mark

Color	
Position	
Sound	

AIPLA COMMENTS:

AIPLA recognizes the Committee’s careful consideration regarding distinctiveness and the need to balance registration standards pertaining to less traditional marks, so that marks having unique distinguishing features are registerable and marks with no distinctive characteristics are not registerable. However, AIPLA is hesitant to label less traditional marks, such as those listed above, as always *inherently* non-distinctive. Distinctiveness depends, to a great extent, on the individuality of the marks and the associated goods and/or services. Nevertheless, AIPLA recognizes the need to efficiently and consistently evaluate whether consumers can recognize a less traditional mark as a distinctive source indicator. Hence, AIPLA agrees that the Trademark Act should require applicants to show acquired distinctiveness when filing for registration of moving marks, hologram marks, color marks and position marks.

Subject: II. Expansion of Regional Brand Protection in the Trademark System

1. The Committee considers the Outline of the current system

The Regional Collective Trademark System was enacted on April 1, 2004⁷¹ in an attempt to maintain trust in businesses in regards to regional products, etc. and ease requirements for registration for character trademarks created from “names of regions” and “names of goods (services),” etc., that are often used as so-called “regional brands” with the purpose of strengthening industrial competitiveness in Japan and revitalizing regional economies through the protection of regional brands.

2. The Committee considers Problem areas

1. Status of protection of regional brands through regional collective trademarks

Over 500 regional brands have been registered as regional collective trademarks, and along with the efforts of those who obtained the rights, these trademarks have been praised as contributing a substantial amount to the revitalization of regions and the development of regional industries. On the other hand, problems and issues have been indicated in the

⁷¹ After being enacted in April 2004, there have been a total of 1,024 applications filed for the Regional Collective Trademark System as of September 30 2012, and 523 of these have been registered.

registration requirements (requirements regarding entities, objects of protection and well-known nature of the trademark) for the Regional Collective Trademark System.

i Matters concerning entities

Today, items that have not traditionally been recognized as regional brands such as “local delicacies” have gained attention as “new regional brands,” and a wide range of regional businesses, etc. in regions throughout the country have cooperated in activities for their popularization. While there are cases where the entity taking action is a commercial and industrial association, chamber of commerce and industry, non-profit, etc.⁸², currently registration entities for regional collective trademarks are limited to business cooperatives, etc.

For this reason, in cases where the parties taking a central role in spreading a regional brand do not correspond to a current registration entity for regional collective trademarks, either a new cooperative that fulfills this requirement must be established, or an applicant that is a cooperative that fulfills this requirement must be arranged within the region.

AIPLA COMMENTS:

AIPLA agrees that it is generally appropriate to allow any type of collective organization (cooperative, association or other collective group) to qualify for protection under a Regional Collective Trademark Registration, provided that membership to such collective organization, and, therefore, use of the protected regional mark is open to, all entities that meet the standards for membership (e.g., deal in the type(s) of goods/services protected and such goods/services do in fact originate from the geographic region that is the subject of the Regional Collective Trademark Registration).

ii Matters concerning objects of protection

Trademarks for which applications for regional collective trademarks can be made are limited to character trademarks created from “names of regions” and “names of goods (services),” etc. (Article 7-2, Paragraph 1, Items 1-3 of the Trademark Act), and registrations for regional collective trademarks consisting of elements that do not correspond to such are not accepted. Therefore, registrations for regional collective trademarks that do not include “names of goods (services)” (“trademarks that are only

⁸ For example, there are cases of these types of groups have taken a central role in measures for the popularization of regional brands, such as Namiecho Commercial and Industrial Association and “Namie yakisoba,” Iseaki Chamber of Commerce and Industry and “Iseaki monja” and the non-profit Shodoshima Olive Association and “Shodoshima olive oil.”

the names of regions⁹³,” “trademarks recognizing regions as the origin, etc. of the goods¹⁰⁴”) are not accepted.

AIPLA COMMENTS:

AIPLA agrees that this requires careful consideration. We further agree that the main concern is unduly restricting use of a regional/geographic term, especially where the particular geographic region may be distinctive in relation to a variety of goods/services that originate in that region.

iii Matters concerning well-known nature of trademark

Trademarks: When registering a regional collective trademark, the required result of the use of that trademark is “wide recognition among consumers as indicating the goods or services associated with your own work or that of members” (well-known nature), but in the current review standards and administration, there are cases where well-known nature is only required to reach neighboring prefectures¹¹⁵, and for most proposals, incomplete evidence for this well-known nature is the reason for notification of grounds for rejection¹²⁶.

AIPLA COMMENTS:

AIPLA recognizes that perhaps this is simply a definitional issue, but we view the standard of a mark being “well-known” as being a heightened standard. We are of the view that the standard should be whether the mark in question has become “distinctive” (e.g., has achieved a reputation for certain desirable attributes associated with goods/services originating from that region) in the minds of a significant portion of the relevant consuming public. Exactly how far and wide the applicant is required to prove that distinctiveness/reputation extends (e.g., nationally or only to neighboring prefectures) in order to qualify for registration as a Regional Collective Mark is purely a policy issue. To further the stated objectives of Regional Collective Marks, we would suggest that the applicant be required to prove that the mark has achieved distinctiveness/reputation anywhere outside the geographic region for which registration is sought.

2. Conditions surrounding the protection of “geographical indications”

9 For example, names of French wine such as “Champagne” and “Bordeaux.”

10 Trademarks in which a regional name indicating the origin, etc. of the goods is not included in the composition of the mark but that recognize a specific area as being the origin, etc. of that product. For example, the name of the Greek cheese “feta” (Greek for “slice”).

11 Trademark Review Standards No. 7, Article 7, Paragraph 2, Item 1; Article 7, Paragraph 2, Item 1, Note 6. (1)

12 Patent Agency, “2008 Investigative Report on Trademark Application Trends: Investigation on Application Strategies Related to Regional Collective Trademarks,” March 2009

“Geographical indications¹³⁷” are a type of indication protected by regional collective trademarks and similar indications. These geographical indications are protected in various other countries through special systems¹⁴⁸ or trademark rights¹⁵⁹, but the protection systems and contents of protection vary depending on the country or region.

In Japan, in the past, the protection of geographical indications was secured through the Trademark Act, Unfair Competition Prevention Act, and laws, etc. regarding the maintenance of liquor taxes and liquor business associations. In addition to these protections, the introduction of a protection system for the geographical indications of Japanese agricultural, forest and fishery products as well as foodstuffs has been proposed¹⁶¹⁰. In response to this, the Ministry of Agriculture, Forestry and Fisheries held a “Geographical Indication Protection System Study Group” in March 2012, and the examination of the state of geographical indications in Japan is progressing.

3. The Committee considers Courses of action

1. Registration entities for regional collective trademarks

Currently, registration entities for regional collective trademarks are limited to business cooperatives that have corporate status and cooperatives established under other special laws, as well as foreign corporations that correspond to either of these, and those for which the governing law for incorporation prescribes to the effect that membership of individuals who qualify as a member cannot be unfairly restricted (freedom of membership).

Since trademarks consisting of names of regions and names of goods (services), etc. that are registered as regional collective trademarks were originally desired to be widely used by the producers of goods and providers of services in the region, and since registrations that corresponded to the items of Article 3, Paragraph 1 (especially Items 3 and 6) due to being unsuited to exclusivity by a single business were not recognized, careful examination of the

13 While there is no clear definition of “geographical indications” in Japan, according to Article 22, Paragraph 1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), geographical indications are “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

14 For example, in Europe, there is a special system through “Council regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs” for protecting the “geographic indications” of agricultural products and foodstuffs.

15⁹ For example, in the US, geographic indications are protected as certified trademarks. Examples of registrations in the US include trademark: “Maui,” designated goods: onions” (1790888) and trademark: “Columbian,” designated goods: “coffee” (1160492).

16 “The Basic Policy and Action Plan for the Revitalization of Japan’s Food, Agriculture, Forestry and Fisheries” (Headquarters for the Revitalization of Japan’s Food, Agriculture, Forestry and Fisheries, October 25, 2011) (Promotional Plan for Intellectual Property 2012” (Intellectual Property Strategy Headquarters, May 29, 2012))

easing of requirements for entities is necessary from the perspective of the ease of identification of trademarks and exclusive adaptability.

However, as with registration entities for current regional collective trademarks, if the group guarantees freedom of membership in its governing law, it is thought that problems seen in exclusive adaptability will decrease.

Therefore, in order to expand the protection of “new regional brands” and lead to the revitalization, etc. of regional economies, it would be appropriate to recognize commercial and industrial associations, chambers of commerce and industry, and non-profits, which are groups taking their own initiative to popularize and develop regional brands throughout the country and guarantee freedom of membership in their governing laws¹⁷¹¹, as registration entities for new regional collective trademarks.

AIPLA COMMENTS:

AIPLA agrees and reiterates the recommendation that regional trademark protection be available to such collective organizations, provided that membership to the organization, and, therefore, use of the protected regional mark is open to all entities that meet the standards for membership.

2. Composition of trademarks to be protected as regional collective trademarks

It has been indicated that making trademarks that do not include the “name of goods (services),” which are currently not eligible for regional collective trademarks, eligible for protection is problematic due to the fact that (a) “trademarks that are only the names of regions” will excessively restrict legitimate use of the regional name and could possibly shrink business activity, and (b) making “trademarks that recognize a region as the origin, etc. of goods” that do not include the region’s name eligible for protection could possibly cause Article 3, Paragraph 2 of the Trademark Act to lose its substance. Because of this, it will be necessary to give these points sufficient consideration.

Further, regarding the composition of trademarks that should be protected as regional collective trademarks, since there is a discussion on the state of protection for “geographical indications” for Japan’s agricultural, forestry and fishery products as well as

¹⁷ Commercial and industrial associations, chambers of commerce and industry, and non-profits guarantee freedom of membership in their governing laws.

Σ Commerce and Industry Association Act: Article 14, Paragraph 1
“Commerce and industry associations must not refuse membership without just cause or place unfair conditions on membership when a party eligible for membership wishes to join the commerce and industry association.”

Σ “Chambers of Commerce and Industry Act: Article 16, Paragraph 1
Σ “Act on Promotion of Specified Non-profit Activities: Article 2, Paragraph 2, Item 1, a. “Unfair conditions shall not be placed on the acquisition or loss of employee eligibility.

foodstuffs, in anticipation of progress in these discussions, it would be appropriate to continue discussions with related ministries and agencies while continuing to investigate the matter.

3. Well-known nature of regional collective trademarks

Since the Regional Collective Trademark System recognizes exclusivity through trademark registration with looser requirements than Article 3, Paragraph 2 of the Trademark Act, it requires that the trademark consisting of a regional name and goods (services), etc. has built enough of a level of trust that such trademark should be protected by restricting third parties from free use of such, and due to this, there is a enough of a level of trust built up that there is the possibility of third parties taking advantage of such, and this is also an important criteria when determining suitability as a registration entity for a regional collective trademark.

Therefore, the easing of requirements for well-known nature must be examined carefully as it could instead cause confusion in the region.

On the other hand, based on the indication that the determination of well-known nature is too strict, it is appropriate to determine the well-known nature by taking composition of the regional collective trademark, the types of goods or services, trade practices for those goods or services, and the classes of dealers and consumers, regional conditions, etc. into consideration according to the spirit of the Regional Collective Trademark System.

Subject: III. Other

1. The Committee considers the state of support for Article 6, Paragraph 3 of the Paris Treaty

1. Outline of the current system

i Obligations under Article 6, Paragraph 3 of the Paris Treaty

Article 6, Paragraph 3 of the Paris Treaty¹⁸¹² obligates countries of the union D to refuse or to invalidate the registration, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view (hereinafter, referred to as “Armorial Bearings of Countries”) (Article 6, Paragraph 3(1)(a)), as well as refuse or to invalidate the registration of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more

18 Paris Convention for the Protection of Industrial Property, March 20, 1883. Japan joined the union in the year 1899.

countries of the Union are members (hereinafter referred to as “Armorial Bearings of International Organizations”) (Article 6, Paragraph 3(1)(b)).

ii Securing obligations under Article 6, Paragraph 3 of the Paris Treaty in the Trademark Act

The current Trademark Act secures obligations under the Paris Treaty by stating that Armorial Bearings of Countries (excluding flags¹⁹¹³) and Armorial Bearings of International Organizations, etc., notified by the international secretariat and designated by the Minister of Economy, Trade and Industry (hereinafter, referred to as “Minister Designation”), as well as identical or similar trademarks, shall not be registered (Article 4, Paragraph 1, Items 2, 3 and 5 of the Trademark Act), and invalidated even after being registered (Article 46, Paragraph 1, Items 1 and 5 of the Trademark Act).

2. Problem areas

Since there is a difference in the scope of protection between Article 6, Paragraph 3 of the Paris Treaty and the Trademark Act, the following problems have been indicated.

i. Article 4, Paragraph 1, Item 3 of the Trademark Act

In the Paris Treaty, there is no obligation to refuse or invalidate Armorial Bearings of International Organizations notified by the international secretariat if they are not of such a nature as to suggest or mislead the public that a connection exists with said organizations. (Article 6, Paragraph 3(1)(c)).

On the other hand, Article 4, Paragraph 1, Item 3 of the Trademark Act prescribes that registration of Armorial Bearings of International Organizations as well as identical or similar trademarks shall be refused or invalidated without clearly prescribing²⁰¹⁴ if consideration is given to whether or not they are of such a nature as to suggest or mislead a connection with international organizations.

Also, in recent years, the number of notifications from the international secretariat regarding Armorial Bearings of Countries (other than flags) and Armorial Bearings of International Organizations have increased²¹¹⁵, and since it is thought that many are

19 Among Armorial Bearings of countries, the Paris Treaty obligates the protection of “flags” by union countries without the requirement of notification (Article 6, Paragraph 3(3)(a) and (6)). The Japanese Trademark Act also refuses or invalidates the registration, either as trademarks or as elements of trademarks, flags (national flags of foreign countries) without the requirement of Minister Designation (Trademark Act, Article 4, Paragraph 1, Item 1; Article 15; Article 46, Paragraph 1, Items 1 and 5).

20 As with the Trademark Act, Article 17 of the Unfair Competition Prevention Act, which secures the provisions of Article 6, Paragraph 3 of the Paris Treaty, states that misleading about a connection to said international intergovernmental organization is a requirement for application, the same as the Paris Treaty.

21 The number of marks notified by the international secretariat pursuant to Article 6, Paragraph 3 of the Paris Treaty and, as of October 31, 2012, having a valid Minister Designation, is 2,981, while the number that had been designated when the current Trademark Act was enacted in 1959 was 11.

used as abbreviations in trade names or the names of goods (especially the abbreviations of names of international organizations in Europe that have three or four letters), in order not to excessively narrow the range of selection of trademarks for businesses, it is thought that perhaps registration should be recognized for those trademarks for which there is no possibility of misleading a connection to international organizations.

ii. Article 46, Paragraph 1, Item 5 of the Trademark Act

In regards to the protection of Armorial Bearings of Countries (other than flags) and Armorial Bearings of International Organizations, the Paris Treaty prescribes that the provisions of Article 6, Paragraphs 3(1) through (5) shall only apply to trademarks registered more than two months after receiving notification from the international secretariat. (Article 6, Paragraph 3(6)).

On the other hand, Article 46, Paragraph 1, Item 5 of the Trademark Act prescribes that even if a trademark is registered before two months have passed after receiving notification from the international secretariat regarding the protection of Armorial Bearings of Countries (other than flags) and Armorial Bearings of International Organizations, it can be invalidated in cases where Article 4, Paragraph 1, Item 3 of the Trademark Act applies to that trademark registration after it has been registered.

This means that, when Armorial Bearings of Countries (other than flags) and Armorial Bearings of International Organizations receive Minister Designation, there is reason to retroactively invalidate the trademark registered before the period above has passed, and this is thought to not be appropriate from the perspective of stability of trademark rights.

3. Courses of action

i The possibility of misleading about a connection to an international organization

If consideration is given to both obligations under the Paris Treaty and not excessively narrowing the range of selection of trademarks for businesses in Japan, it is appropriate to take measures so that trademarks for which there is no possibility of misleading about a connection to an international organization are not subject to Article 4, Paragraph 1, Item 3 of the Trademark Act.

AIPLA COMMENTS:

AIPLA agrees and this appears to be a reasonable approach, whereby various interests are balanced, both in regards to the Paris Treaty and the National Law, as well as regarding rights holders (both International Organizations and businesses).

ii Scope of trademarks subject to invalidation

There have been no cases found of a trademark being invalidated pursuant to Article 46, Paragraph 1, Item 5 due to corresponding to Article 4, Paragraph 1, Items 2, 3 or 5 through Minister Designation of Armorial Bearings of Countries (other than flags) and Armorial Bearings of International Organizations, etc. after these items were established. Also, if trademarks for which there is no possibility of misleading about a connection to an international organization were not subject to Article 4, Paragraph 1, Item 3 of the Trademark Act as stated in above, it is thought that it would be even more difficult for there to be any cases where a registered trademark would be retroactively invalidated.

Further, if the registered trademark goes into disuse, it can be said that making it possible to invalidate the registered trademark if it misleads about a connection to an international organization due to changes in circumstances after being registered, such as the armorial bearings of the international organization becoming well know, would conform to the current ways of thinking for the provisions, which stress the public interest of maintaining the dignity of countries and international organizations.

Based on the points above, it is appropriate to maintain the current situation regarding the scope of trademarks that are subject to invalidation under Article 46, Paragraph 1, Item 5 of the Trademark Act.

AIPLA COMMENTS:

AIPLA agrees and this also appears to be a reasonable approach. There have been no instances in which a retroactive cancelation has taken place, thus confirming the extremely low risk that this event may occur.

2. System for revoking a trademark that has lost distinctiveness

1. Outline of the current system

Usually, the registration of trademarks that lack distinctiveness, such as those indicating, in a common manner, the common name of goods, is not recognized since it corresponds to the items in Article 3, Paragraph 1. Therefore, when assessed, registered trademarks that lack distinctiveness can be revoked or invalidated under certain conditions

On the other hand, if a registered trademark loses distinctiveness after registration, that does not comprise a reason for refusal or invalidity, and there is no system established that can revoke a registered trademark that has lost its distinctiveness.

2. Problem areas

While restrictions on the validity of trademark rights for registered trademarks that have lost their distinctiveness after registration are solely governed by Article 26, Paragraph 1, Items 2 through 4 of the Trademark Act, it has been indicated that there is the possibility of unnecessary disputes arising in the first place from continued trademark rights for trademarks for which consumers are aware as common names or quality indications, etc.

Further, since, from the point of view of the trademark rights holder, the loss of distinctiveness of a registered trademark after its registration is the loss of proprietary rights, it has been indicated that it is necessary to take effective measures in advance to prevent the fall of a name into common use.

3. Courses of action

i. System for revoking a registered trademark that loses distinctiveness after registration

When a survey²²¹⁶ was held on a system for revoking registered trademarks that have fallen into common use, a substantial number of respondents answered that it was unnecessary because even though there might be a need for such among companies to a certain extent, there are provisions in the current law for restricting validity (Article 26, Paragraph 1 of the Trademark Act), and thus it is fine to fight such problems individually with infringement lawsuits. There was also a substantial number that answered “neither.” Because of this, it cannot be said that there is urgent need.

AIPLA COMMENTS:

AIPLA agrees that it would be appropriate to have a system whereby interested parties could seek cancelation of a trademark based on loss of distinctiveness. For example, in the situation where a third party uses a mark on goods/services such that the mark is distinctive and the non-distinctive registered mark serves to bar registration of the subsequent distinctive mark, the subsequent user would need a mechanism whereby to cost effectively remove the non-distinctive mark from the

²² Survey of 906 member companies of the Japan Intellectual Property Association held July – August, 2012. Responses were received from 330 companies. The results of the survey were as follows.

① A total of 34.5% of the companies said that a revocation system is necessary, while 26.1% said such a system is unnecessary since it is fine to fight this individually with infringement lawsuits, and 39.4% said “neither.”

② When asked, in the case of introducing a new trademark system, what they think about a system that would revoke trademarks that had lost distinctiveness after registration, 22.8% of the companies said that a revocation system is necessary, 55.0% said they should determine if it was good or bad to examine the new trademark system after seeing how the system was administered after it was introduced, 8.5% said that the system was unnecessary since it is fine to fight this individually with infringement lawsuits, and 13.7% said “none of the above.”

register. Also, if a registered mark has become generic for the goods or services covered by the registration, competitors who wish to use that generic term should be permitted to seek cancellation of the registration.

Also, if a revocation system is introduced, it was expressed that there is a concern over several revocation claims against a single trademark and that other companies in the same industry would collude to make the trademark fall into common use, and thus caution is necessary to ensure that when introducing a system, it is not too harsh on trademark rights holders. For this reason, it will be necessary to examine whether the party qualified to make a claim should be limited to interested parties or if anyone will be able to do it, whether some kind of restriction will be necessary on the number of revocation claims on a single trademark right, and whether some kind of measures will be necessary for actions that intentionally cause a trademark to fall into common use.

Further, regarding the scope of trademarks that would be subject of revocation, it is necessary to examine whether only those trademarks that have fallen into common use will be subject or if trademarks in general that have lost their distinctiveness will be subject, but the most common opinion was that the companies should only examine if the new trademark system was good or bad after seeing how the new system was administered after being introduced.²³¹⁷

Also, since a detailed investigation of systems and how they are administered in other countries will be indispensable when examining these points, it is too early to examine the introduction at the present time, and it would be appropriate to decide on a course of action after making another careful examination.

AIPLA COMMENTS:

AIPLA agrees that the introduction of a new system such as the one contemplated herein will require careful examination, and the systems of other countries should be examined.

i. Measures to prevent trademarks from falling into common use

When to begin with, there are few countries that legally prescribe measures for preventing trademarks from falling into common use, and there is the possibility of restricting free speech since depending on how the provision is made, careful examination will necessary when introducing such a system.

On the other hand, since it has also been indicated that some kind of provision that would protect trademarks from falling into common use would be beneficial to trademark

²³ See Question © in Note 22 above.

rights holders, when examining a revocation system for registered trademarks that lose distinctiveness after registration, it would be appropriate to examine this point as well.

3. Status of protection for famous trademarks in Japan

1. Problem Areas

In some other countries, there are systems in trademark laws in which the validity of trademark rights extends over actions, etc. that dilute or dirty famous trademarks, even when there is no possibility of confusion, and it is thought that perhaps it may be necessary to expand the protection of famous trademarks in Japan's Trademark Act as well in this fashion.

2. Course of action

i. Defensive Mark Registration System

Since protection of famous trademarks is devised in Article 2, Paragraph 1, Items 1 and 2 of the Unfair Competition Prevention Act, there is the opinion that the Defensive Mark Registration System be abolished, but on the other hand, since actions that cause confusion associated with similar marks cannot be prohibited within the scope of rights in the Defensive Mark Registration System, there are also opinions that it should be expanded and that asserting and demonstrating the fact that a defensive mark registration has been made in Japan as a measure against overseas trademark infringement and filing of infringing applications, etc. will be useful countermeasures against counterfeit goods.

Therefore, it is appropriate to continue the Defensive Mark Registration System for the time being while focusing on discussions on the status of protection of famous trademarks in the trademark system.

AIPLA COMMENTS:

AIPLA agrees that, when a mark has become exceptionally well-known, care must be taken to determine whether another party should be able to register the same mark for certain other goods or services, especially when use of the mark by someone other than the famous mark owner on other goods or services would possibly detract from its distinctive character in relation to the goods or services for which it has been so used. Keeping the Defensive Mark Registration System in place will retain a procedural level of caution with respect to famous marks.

ii. Scope of rights for famous registered trademarks

There was an opinion that perhaps it would be good to allow the scope of rights for famous registered trademarks to extend to non-similar goods, etc. where the source could possibly be confused as well as those that would dilute or dirty the famous registered trademark. On the other hand, there was the opinion that expanding the

prohibitive force of trademark rights for famous trademarks would make it necessary to demonstrate that prominence has been obtained, a fluid circumstance after registration, the possibility of confusion of the source, and the dilution or dirtying of the trademark when executing prohibition rights in the trademark rights, that the scope of rights would have to be drawn in advance in the registration, and that this would be difficult within the framework of the current Trademark Act, which employs a public notice system. There was also the opinion that if you take the provisions of Article 2, Paragraph 1, Items 1 and 2 of the Unfair Competition Prevention Act into consideration, the level of protection compares favorably with provisions designed to prevent confusion in the trademark laws of major countries, and it is not necessary to expand the scope of protection in the Trademark Act.

Therefore, the expansion of force for famous registered trademarks should continue to be examined.

AIPLA COMMENTS:

AIPLA agrees that, when a mark is considered famous, then it is more likely that consumers may associate the mark with goods and services beyond those for which the mark is used. Trademark dilution occurs when a use of a trademark by someone other than its owner impairs the mark's distinctiveness. We recommend the scope of protection for famous marks be set forth to be sufficient to prohibit dilution, regardless of whether or not a similar mark is used on a competing product or in a way that is likely to cause customer confusion.

4. Revision of the Registration Opposition System

1. Problem Areas

In Since the Registration Opposition System of the Patent Act was consolidated with the Invalidation Trial System in 2003, the status of both systems in the Trademark Act is currently being examined as well, and it was decided that the examination of consolidation of both systems will proceed carefully while assessing needs, etc. since it cannot be said that the problems²⁴¹⁸ in both systems are manifested or that the positions and needs of the opposition systems in the Patent Act and Trademark Act differ.

2. Course of action

²⁴ At the time, it was indicated that problems include trends towards (a) a strong demand for a higher level of active participation of the opposing parties in the opposition procedures and (b) parties seeking to invalidate patents requesting an invalidation trial after filing an opposition, resulting in repeated procedures for the Patent Agency to review patents due to the same party, and this was a factor in the lengthening of the period needed for a final solution to the dispute overall.

A survey was held in 2010 to grasp the use of the Opposition System and Invalidation Trial System²⁵¹⁹. The results showed that the Opposition System is mostly used to simply revoke flawed patent registrations at a lower cost for those system users utilizing a patent registration watch service, and that the Invalidation Trial System was mostly used to ensure the invalidation of rights using sufficient preparation time when involved in an infringement lawsuit or receiving a warning.

As shown above, the needs of both systems differ, and it is thought that users utilize them for different purposes.

Therefore, there is currently no special need to consolidate the Registration Opposition System and Invalidation Trial System, and if no conspicuous problems can be seen in their coexistence, it is appropriate to maintain the current systems as long as there are no major changes to the conditions that surround both systems.

5. Additions to reasons for non-registration of well-known place names in Japan and overseas

1. Problem Areas

Some countries have a legal system in which a trademark registration is refused or invalidated (revoked) for being a “well-known place name” even if it isn’t recognized as the origin of the goods. There is a necessity for arranging registration requirements, etc. and the status of administration of “well-known place names” in Japan while doing comparative research into systems and administration in major overseas countries, including those with a system described above.

2. Course of action

While it is thought that amending provisions on registration requirements and reasons for non-registration so that registrations can be refused or invalidated beyond the perspective of distinctiveness is unnecessary, trademarks that lack distinctiveness cannot be registered under the current Trademark Act, and in order to devise the unification of review criteria and improve foreseeability, it would be meaningful to examine the necessity of further maintenance of review standards.

AIPLA COMMENTS:

AIPLA suggests that, in addition to considering the distinctiveness issue, the committee consider the issue of a goods-place association between the location identified by the mark and the

²⁵ See Reference Material 3 “Revision of the Registration Opposition System” from the 23rd Meeting of the Industrial Structure Council, Industrial Property Policy Section, Trademark System Subcommittee.

associated goods/services. This issue goes to matters of not only distinctiveness, but descriptiveness and deceptiveness as well.

Accordingly, the Trademark Review Standards Working Group examined this point, and partially amended the handling of trademarks consisting of geographical names both in Japan and overseas in the trademark review standards of Article 3, Paragraph 1, Items 3 and 6 in the Trademark Act (enacted November 1, 2012).

Subject: IV. Reference (past system amendments, etc.)

1. Action through amendments to systems

A. Amendment of provision excluding trademark registration by others for one year after lapse of trademark rights (law amended in 2011²⁶)

From the perspective of meeting the needs of users wishing to quickly obtain rights, Article 4, Paragraph 1, Item 13 of the Trademark Law was abolished to make it possible for others to register a trademark without having to wait one year after the lapse of trademark rights.

B. Effect of items in the 2011 Partial Amendment of the Patent Act, etc. on the Trademark Act (law amended in 2011)

① Handling of retrials through invalidity trials after final judgments in infringement lawsuits

In addition to revisions to the Patent Act that restricted retrials through final trial decisions in invalidity trials, etc. made after final decisions in infringement lawsuits, revisions were made to the Trademark Act that restricted retrials through final trial decisions made after upholding judgments in trademark infringement lawsuits.

② Status of third party effect in final trial decisions of invalidation or revocation trials

In addition to abolishing third party effect in final trial decisions for invalidation trials in the Patent Act, third party effect in final trial decisions for invalidation or revocation trials in the Trademark Act were also abolished.

③ Status of partial final trial decisions, etc.

In addition to providing a provision in the Patent Act based on the principle of the thought that finalization of invalidation trial and correction trial decisions, etc. for patent rights consisting of several claim items should be decided for each individual claim item, a provision was provided in the Trademark Act as well based on the principle of the thought that the finalization of trial decisions, etc. for invalidation trials of registered trademarks and objections to registration should be decided for individual designated goods or services.

④ Revision of provisions to restore trademark rights after the registration application period for the renewal of the continuation period has past

In addition to approving relief (recovery of rights) in the Patent Act for a specific period and easing requirements for relief (recovery of rights) after the period for late payment of patent fees,

etc. had passed in cases where the subjective requirement corresponding to due care in the clauses of the Patent Act are met, even when the submission period for translations of

26 “Legislative Bill for the Partial Amendment of the Patent Act, Etc.,” approved by the Cabinet on March 11, 2011, was passed and established on May 31, 2011, officially announced as Law No. 63 on June 8, 2011, and enacted on April 1, 2012.

documents and applications, etc. in foreign languages has passed, there was an easing in the Trademark Act as well of requirements for relief (recovery of rights) after the registration application period for renewal has passed to improve convenience for users. However, the maximum period (currently 6 months) to apply for the recovery of rights was maintained based on the possibility that relaxing this would delay the review process, etc.

⑤ Revision of exhibition designations by Director of the Patent Agency in the Trademark Act

In addition to abolishing the system for designations at exhibitions, etc. related to exceptions to lack of novelty in the Patent Act, in the Trademark Act as well, the system of designations at exhibitions by the Director of the Patent Agency prescribed in Article 4, Paragraph 1, Item 9 and Article 9, Paragraph 1 was abolished from the perspective of improving convenience for applicants and reducing the burden on those holding exhibitions. Also, a system was set up to make trademarks that are identical or similar to marks awarded at exhibitions that conform to fixed standards subject to reasons for non-registration, and to make it possible for special assertions at the time of application.

2. Actions through amended standards and changes to administration, etc.

(1) Methods for establishing review standards for trademarks

In order to increase the transparency of methods for establishing review standards for trademarks, in addition to seeking public comments when establishing review standards, it was decided to refer matters to the Trademark System Subcommittee made up of members from various professions including legal scholars, relevant parties from legal circles, those from industry, and attorneys who act as agents, when necessary.

Also, from the perspective of making review standards even easier to understand for users, in addition to setting up mutual links between items related to “Review Standards for Trademarks” and the “Review Manuals for Trademarks” published on the Patent Agency website, links between related trial judgments and the provision in question were set up, and review standards, etc. were visualized and structured (converted to hypertext) (enacted in August 2009).

(2) Establishment of Trademark Review Standards Working Group

Since timely responses that conform to the conditions that surround trademarks and the realities of transactions as well as detailed examinations of such by experts in law and businessmen well-versed in the actual conditions of business transactions are necessary, it was decided to establish the “Trademark Review Standards Working Group” under the Trademark System Subcommittee as a place for discussing trademark review standards, and that this workgroup would examine the establishment and revision of trademark review standards. The first meeting of the workgroup was held May 25, 2012.

(3) Revision of administration of expedited reviews and trials

It was decided to add “Applications that only designate goods or services where the applicant, etc. is already using the trademark related to the application or has made a substantial degree of progress towards use” to those eligible for expedited review and trial, and to aim for implementing a waiting period for review that meets user needs (enacted in February 1, 2009).

(4) Revision of “review standards for similar goods and services”

“Review standards for similar goods and services,” for which revision was originally requested as necessary to make the standards match the actual state of the economy and actual transaction conditions, were amended along with the putting into effect of the 10th Edition of International Categories based on “Agreement on Needs Related to International Categories for Registering Marks on Goods and Services” with (a) reductions to several types of similarities though detailed revisions of current similarities; (b) the smallest scope necessary based on industry intentions and trends in trial judgments so there is no hindrance to company brand strategies; and (c) determinations made from the perspective of ensuring foreseeability among applicants and with sufficient consideration given actual transaction considerations (enforced from January 1, 2012).

(5) Handling of trademark registration applications consisting of names of historical figures

It is appropriate to refuse registration of trademarks of names of historical figures as a violation of public policy since applications that seek to obtain a registered trademark and monopolize the person’s name in the scope of designated goods and services with the intent of taking advantage of the person’s reputation for use in one’s own business or damage the person’s reputation could possibly have a detrimental effect on regional development and industry in the home area of that person and disturb order in fair trade, and could possibly also injure the reputation and honor of the person as well as harm the feelings of surviving family members.

The Trademark System Subcommittee examined the matter, and established a new Review Manual for Trademarks “Handling of trademark registration applications consisting of names of historical figures (Names of well-known or famous deceased figures)” stating that such figures, etc. would be handled as a violation of public policy (Article 4, Paragraph 1, Item 7 of the Trademark Act) from the perspective of ensuring the unification, clarity and foreseeability of reviews (enforced from October 2009).

(6) Amendments to trademark review standards, etc. in conjunction with the 2011 Partial Amendment to the Patent Act

Regarding the abolition of the provision excluding registration for a period of one year after the lapse of trademark rights, the standards of Article 4, Paragraph 1, Item 13 were deleted, and even in cases where the continuation period of the trademark rights of the quoted trademark in a review established in Article 4, Paragraph 1, Item 11 has expired, when renewed, it was clearly noted that the Item would not apply to cases where the trademark rights holder declares his intention not to apply for renewal and it is clear that the trademark rights will not be renewed.

Regarding the abolition of exhibition designations in the Trademark Act, it was clearly noted in the application of Article 4, Paragraph 1, Item 9 and Article 9, Paragraph 1 that the determination of “those at an exhibition held by a party other than the government, etc. and that conform to standards established by the Director of the Patent Agency” will be determined depending on whether or not they conform to “standards established by the Director of the Patent Agency,” and clearly noted in the same standards (enforced from April 1, 2012).

2013年1月15日

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日本国特許庁 産業構造審議会 知的財産政策部会

商標制度小委員会

委員長 土肥 一史 殿

アメリカ知的財産権法協会 (AIPLA) は、「産業構造審議会 知的財産政策部会 商標制度小委員会 (以下、「委員会」) 報告書『商標制度の在り方について』 (案)」について、以下のとおり意見を提出致します。

1. 新しいタイプの商標の保護

AIPLA は、「動き」「ホログラム」「色彩」「位置」「音」について商標登録を認めるとの委員会の意見に賛成し、商標法改正を支持します。また、AIPLA は、一定の状況の下では、「香り」「触感」「味覚」については、商品/役務の出所標識として機能し得ることから、そのような状況の下では、保護されるべきであり、商標として登録されるべきであると考えます。

AIPLA は、出願日認定要件及び保護範囲の明確化のための願書の記載事項について、委員会で考慮された出願の要件に賛成しますが、「動き」「ホログラム」「色彩」「位置」の商標については、デジタルビデオファイルもまた有益なものとして、商標の説明とともに提出されるべきであります。「音」の商標については、商標の説明とともに、例えば MP3 ファイルのような音のデジタル音源についても、出願人が提出できるようにすることを提案します。

AIPLA は、識別力に係る登録要件について、委員会による識別力及び登録の基準とのバランスの必要性についての熟慮を評価します。「動き」「ホログラム」「色彩」「位置」について、常に本来的に識別力を有しないとする点には躊躇を覚えるものの、結論としては、AIPLA は、「動き」「ホログラム」「色彩」「位置」の商標の出願に際し、商標法が出願人に使用による識別力の獲得を要件とすることに賛成します。

2. 商標制度における地域ブランド保護の拡充

AIPLA は、地域団体商標の登録主体について、どのような団体であれ、団体への加入要件とその保護される地域的商標の使用が加入の基準を満たすすべての団体に開かれているのであれば、地域団体商標の下での保護を認めることが一般的には適当であるという点について賛成します。また、客体については、熟慮が必要である点についても賛成します。AIPLA は、さらに、地域的・産地表示の使用が過度に制限されないことに主たる懸念がある点にも賛成します。

地域団体商標の周知性については、AIPLA としては、周知性の基準は高いものと考えており、地域団体商標としての登録を認められるためにどの程度の周知性が必要とされるかについては、純粋に政策的な問題であると考えます。AIPLA としては、出願人は、その標章が登録を求めているその地域的範囲外のどこであっても、識別力を獲得したことを証明することが必要となることを提案します。

3. その他

AIPLA は、パリ条約第 6 条の 3 への対応の在り方についての対応の方向性について、賛成します。

また、AIPLA は、登録後に自他商品役務の識別力を喪失した商標の取消制度の対応の方向性について、そのような制度を有することが適切であることについて、賛成します。但し、このような制度の導入にあたっては、諸外国の制度の調査を踏まえて慎重に検討する必要がある点についても、賛成します。

さらに、AIPLA は、我が国における著名商標の保護は、類似の商標が競合製品に使用されているか否か、消費者に混同が生じそうな方法で使用されているか否かを問わず、希釈化を防ぐために十分なものとすべきことを提案します。

国内外の周知な地名の不登録事由への追加については、AIPLA は、識別性の論点に加え、その商標によって特定された地域と、その地域に関連する商品・役務間の、商品-場所間の関連性の問題についても、委員会が考慮することを提案します。この問題は、識別性だけでなく、記述性や虚偽性についても問題となります。

ジェフリー I.D. ルイス

会長