

Trademark Prosecution in Japan

1. Trademark System
2. Trademark Filing Procedure
3. Madrid Protocol

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1. Trademark System in Japan

(1) How to protect marks

- Trademark law
- Unfair Competition Prevention law
- Customs Tariff law
- Domain Name Dispute Resolution Policy

(2) History of the Japanese Trademark law

1884: Trademark law in effect

(24 Articles and rules)

Registration principle

First-to-file principle

Civil and criminal prosecution



1885: Patent law in effect

1888: Similarity of marks

Appeal system

1899: Member of the Paris Convention
Patent Attorney law in effect

Harmonization with the Paris Convention
Distinctiveness

1921: Publication and opposition
Notice of reasons for refusal and
opportunity to argue
Scope of protection (to similar goods)
Right of continuous use

1959: Article 1*
Acquisition of distinctiveness
10 year expiration
Assignment without goodwill
License
Right of pledge
Defensive marks
Interpretation

*The purpose of this Law shall be to ensure the maintenance of the business reputation of persons using trademarks by protecting trademarks, and thereby to contribute to the development of industry and to protect the interests of consumers.

1957: Member of WIPO

1990: Nice Agreement

1992: Service marks come into effect

1995: TRIPS

1996: Three dimensional marks
Multi-class applications
Collective marks
Standard characters
Strengthening of well-known marks
Post-granted opposition
Power of Attorney not required for
application
Simple renewal procedure

1996: 150,000,000 JPY fine to a legal entity

1997: Accession to the Trademark Law Treaty

2000: Accession to the Madrid Protocol

Publication of Application

Pre-registration protection

On-line application

2. Trademark Filing Procedure

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(1) Frequent questions before filing

A) What is registrable?

Word marks, devices, signs, three-dimensional shapes, combinations thereof

Trademarks,

Service marks,

Collective marks (Certification marks),

Defensive marks

B) Is a trademark search necessary?

Strongly recommended

JPO Database:

http://www.ipdl.ncipi.go.jp/homepg_e.ipdl

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National Center for Industrial Property Information and Training
NCIPI

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[\[SUMMARY\]](#)

Reg. No.4563553

[\[Class, Class of goods and Services\]](#)

ORIGINAL

(111) 4563553
(540)

[1/1]

(111) [Registration number]	4563553
(151) [Registration date]	2002/04/26
(450) [Date of publication of official gazette]	2002/06/04
(210) [Application number]	2001-014868
(220) [Application date]	2001/02/05
[Date of entry into force of prior right]	2001/02/05
[Date of publication of application]	2001/03/22
(156) [Renewal registration date]	
(180) [Expiration date of the term of the right]	2012/04/26
[Expiration date of paying in installments]	
[Transmission date of refusal]	
[Date of final disposition]	
[Type of final disposition]	
[Type of application]	

[Trademark(for retrieval)] SOEI

(531) [Figure Term(Vienna Classification)]

[Additional information]

(641) [Repetition number]

[Appeal/Trial number]

[Type of appeal/trial]

[Date of request for appeal/trial]

[Petition and joukoku-appeal division]

[Petition and joukoku-appeal division number]

創英
SOEI

C) Is using a mark mandatory before filing?

No.

- Registration principle
- First-to-file principle

D) Is an unregistered mark protected?

It could be protected.

E) What documents are necessary?

None.

F) How much does it cost?

(One mark, One class)

Total: 182,000 JPY (approx. 69,000 THB)

(One mark, Two classes)

Total: 306,000 JPY (approx. 116,000 THB)

(estimated by Soei Patent & Law Firm)

G) Are retail services recognized?

No.

H) Is parallel importation illegal?

Yes, it is illegal under the following conditions:

1. The trademark on the parallel import goods was duly affixed thereto by the trademark owner in the exporting country or a licensee thereof;
2. The trademark owners in the exporting country and in Japan are the same party, or may legally or financially be deemed to be the same party, such that the trademark on the parallel import goods is deemed to indicate the same origin of goods as the origin indicated by the registered trademark in Japan (i.e., no damage on the origin indication function of the trademark); and
3. The parallel import goods and products bearing the registered trademark affixed by the trademark owner in Japan are not deemed to substantially differ in the quality guaranteed by the trademark (i.e., no damage on the product quality guarantee function of the trademark).

(Case No. H14 (Ju) 1100, Supreme Court ruling on Feb. 27, 2003)

I) Does a license have to be recorded?

Exclusive license: Yes.

Non-exclusive license: Optional

Note: The main difference between exclusive and non-exclusive licenses is whether a licensee has the right to accuse a third party of trademark infringement. A non-exclusive licensee can use a contract to prevent a trademark registrant from issuing another license to any other party.

(2) Preparation of filing

Necessary information

- a) Applicant's name and address
- b) Specimen of the mark
- c) Goods/services

Unnecessary documents

- a) Power of Attorney
- b) Corporation Nationality Certificate
- c) Declaration of Use

(3) Statistics

A) Current Trends

Class	Class Headings	2001		2002		2003	
		No.	Rank	No.	Rank	No.	Rank
3	Substances for laundry use; soaps; perfumery, cosmetics, etc.	8,530	6	8,710	5	9,125	4
5	Pharmaceutical and veterinary preparations, etc.	6,884	10	6,215	9	6,230	10
9	Electronic apparatus and machines, computers and computer program, etc.	20,193	1	17,987	1	17,551	1
16	Paper, printed matter, etc.	9,715	5	8,289	6	8,847	5
25	Clothing, footwear, etc.	9,843	4	9,869	3	10,292	3
28	Sports equipment, toys, etc.	5,958		5,933		6,305	9
29	Foods	7,548	9	7,946	8	8,558	7
30	Confectionery, coffee, spices, etc.	11,031	3	11,655	2	12,521	2
35	Advertisement, business management, etc.	7,734	8	5,945	10	5,989	
41	Entertainment, seminar	8,311	7	8,057	7	8,664	6
42(old)	Computer programming, restaurant services, accommodation, etc.	16,871	2				
42(new)	Computer programming, etc.			9,041	4	8,042	8

("The Number of Applications and Registrations in 2004" published by the JPO)

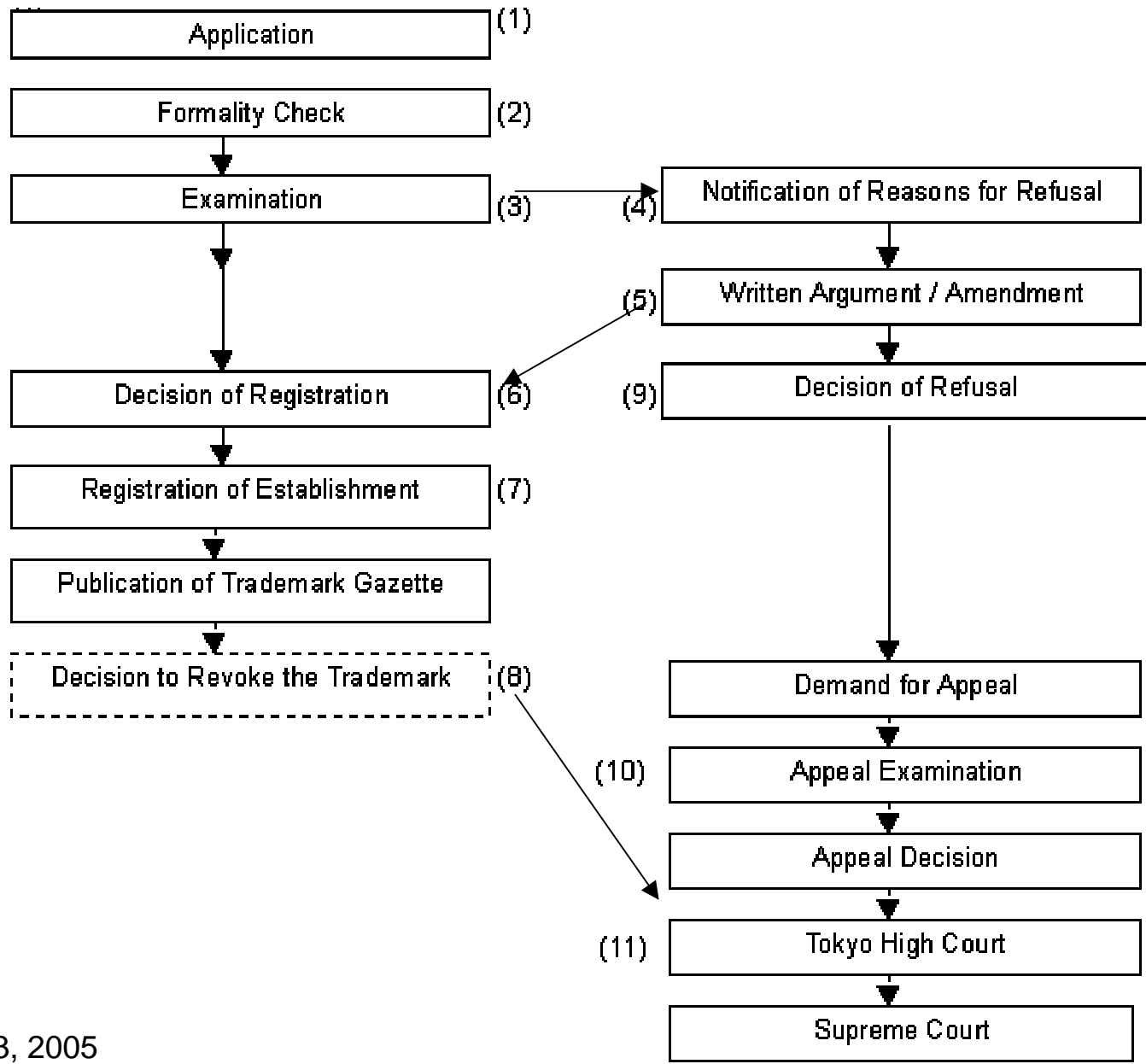
B) Number of Applications

	1995	1996	1997	1998	1999	2000	2001	2002	2003	2004
Trademarks	179,689	188,160	133,116	112,469	121,861	145,668	123,754	117,406	123,325	128,843

C) Number of Applications by non-Japanese

Nationality			Continental	
1	The United States	5,874	Asia	1,939
2	Germany	1,869	North and South America	6,272
3	France	1,318	Africa	37
4	Switzerland	1,057	Oceania	323
5	Italy	846	Europe	7,633
6	The United Kingdom	825		
7	South Korea	501		
8	Taiwan	477		
9	The Netherlands	404		
10	China	356	Total Number	16,368

("The Number of Applications and Registrations in 2004" published by the JPO)

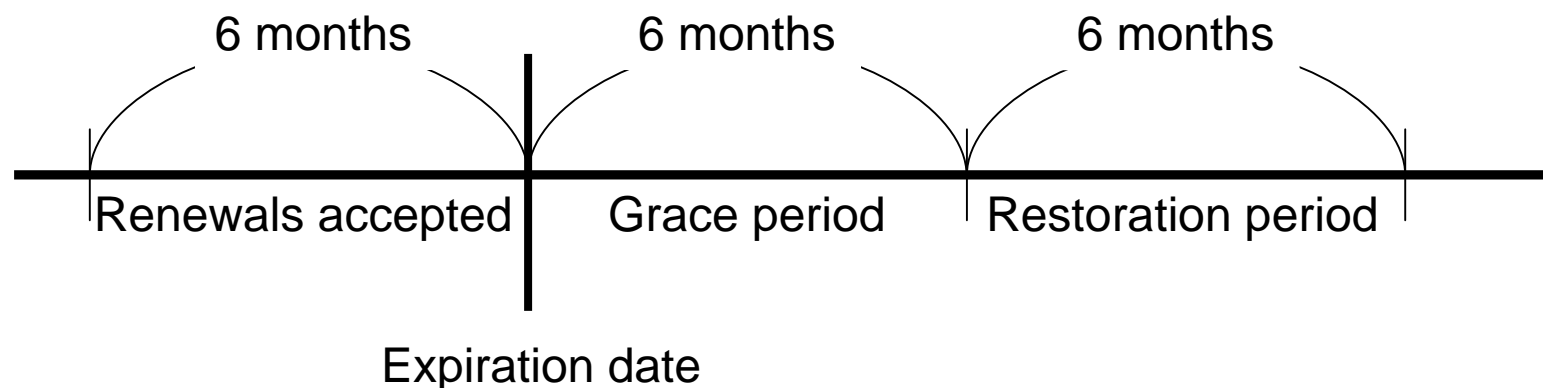


(4) Renewal Procedure

Necessary procedure

a) Filing of a request

b) Paying of the renewal fee



3. Impact of the Madrid Protocol

(1) Impact on Japanese Companies

- Cost reduced
 - Time saved
 - Easy management
 - Global point of view
-
- Basic registration/application required
 - Same scope of goods/services

(2) Impact on Foreign Companies

- Cost reduced
- Protection in English
- Easy management

(3) Impact on Japanese Attorneys

- Time saved
- Total management
- Certain goods/services protected

- Fewer cases
- Knowledge of foreign TM laws required

(4) Impact on Japan Patent Office

A) Number of International Registration Applications

Year	Applications	Designations	Average No. of designations
2000	187	1,834	9.8
2001	280	3,259	11.6
2002	237	2,377	10
2003	402	3,849	9.6

B) Number of Applications Designating Japan

Year	
2000	2,575
2001	5,708
2002	5,269
2003	5,334

C) Number of Applications Designating Japan

Office of Origin	2000	2001	2002	2003
Austria	52	102	109	83
Australia	-	9	95	99
Belgium	64	139	143	93
Switzerland	353	899	798	714
China	55	149	78	162
Germany	763	1,509	1,333	1,317
Spain	47	144	126	145
France	491	933	869	846
The U.K.	114	289	266	250
Italy	166	645	623	685
South Korea	-	-	-	16
The Netherlands	206	286	277	268
Sweden	86	146	106	113
The U.S.	-	-	-	11
Total	2,575	5,708	5,269	5,334

Thank you!!!

If you have any questions on this presentation or on Japanese trademarks, please feel free to email me at miyanaga@soei-patent.co.jp.