

Yearbook

2020/2021

A global guide for practitioners

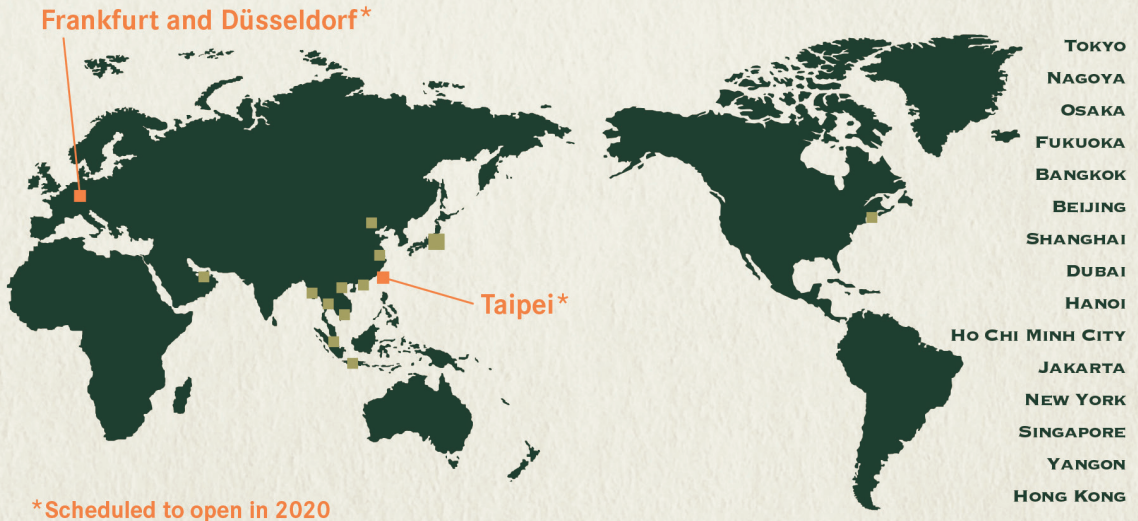
Japan

Nishimura & Asahi

Hitomi Iwase, Chisako Yagi and Ryohei Saito

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Authors

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Legal framework

National

The Trademark Act and its related regulations govern the registration and protection of trademarks in Japan. The Examination Guidelines for Trademarks also play an important role in the examination of trademark applications at the Japan Patent Office (JPO).

In addition, the Unfair Competition Prevention Act protects well-known trademarks, both registered and unregistered, as well as certain configurations of goods, from unauthorised use.

International

The following international treaties apply in Japan:

- the Paris Convention for the Protection of Industrial Property;
- the Trademark Law Treaty;
- the Singapore Treaty on the Law of Trademarks;
- the Nice Agreement on the International Classification of Goods and Services;
- the Madrid Protocol; and

- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

Unregistered marks

Trademark Act

Under the Trademark Act, unregistered marks are protected only in certain circumstances.

Prior user's rights: Even if an unregistered mark is identical or similar to another's registered mark, a prior user may continue to use the mark provided that:

- at the time of the subsequent trademark application the unregistered mark is well known to consumers or dealers in Japan for goods or services relating to the prior user's business; and
- the prior user has no intention of engaging in unfair competition in its use of the unregistered mark.

The prior user:

- may not seek an injunction or compensatory damages against the infringer;
- may use its unregistered mark only within the specific region in which the mark

was used at the time of the subsequent trademark application, and only in relation to the goods or services for which it was used at the time; and

- may assign the mark only along with its business.

Unfair Competition Prevention Act

Unregistered marks that are well known or famous, as well as certain configurations of goods, are protected under the Unfair Competition Prevention Act.

The act provides that where unfair competition causes damage to a person's business, that person may seek an injunction and, if the damages were caused negligently or intentionally, compensatory damages.

'Unfair competition' includes:

- use of another's mark that is well known to consumers or dealers as identifying its goods or business, thus causing confusion (or the likelihood of confusion) with that party's goods or business;
- use as one's own of another's mark that is famous to consumers or dealers as identifying its goods or business; or
- imitation of the configuration of another's goods (except when such configuration is indispensable for ensuring the function of the goods themselves).

Registered marks

Ownership

An individual or corporation that intends to use a trademark for goods or services related to its business may apply for trademark registration and own a trademark. Actual use is not a requirement for trademark registration. A power of attorney is unnecessary when applying for trademark registration.

Scope of protection

Protected: The Trademark Act provides that a trademark should be recognisable by human perception and shall consist of characters, figures, signs, three-dimensional (3D) shapes, colours or any combination thereof, or sounds, and be used for goods or services relating to the applicant's business. In April 2015, motion marks, hologram marks, colour marks *per se*, sound marks and position marks also became registrable as trademarks.

A trademark right is granted when an examiner of the JPO determines that the mark meets all registration requirements. It is an exclusive right to use the mark with respect to designated goods or services, which becomes effective throughout Japan upon registration of the trademark with the JPO. The Trademark Act follows the first-to-file principle.

Not protected: Under the Trademark Act, a trademark application will be rejected unless the following substantive requirements are satisfied:

- The mark is sufficiently distinctive for consumers to distinguish the applicant's goods or services from those of others;
- The mark qualifies as registrable under the Trademark Act; and
- The application does not violate any treaties.

Some trademarks that lack distinctiveness – excluding generic terms – may still be registered if the applicant can prove that they have acquired distinctiveness for specific uses. Further, a well-known trademark consisting of a geographical name and a generic term for a product or service that is owned by an industrial business cooperative association, a commerce and industry association, a chamber of commerce and industry or a specified non-profit corporation (including an equivalent



Some trademarks that lack distinctiveness may still be registered if the applicant can prove that they have acquired distinctiveness for specific uses

foreign legal entity) may be registered, provided that it fulfils the other requirements.

Even if a mark is sufficiently distinctive, it will be rejected if it falls under one of the various bars set out in Section 4 of the Trademark Act concerning the public interest or an individual interest.

Examples of public interest prohibitions include:

- trademarks that consist of a national flag, coat of arms or other insignia of Japan or any foreign nation, the Red Cross or similar marks;
- trademarks offending public order or morality;
- trademarks that are misleading as to the quality of the goods or services;
- 3D trademarks comprising solely functional features that are essential to the use or purpose of the goods or their packaging; and
- trademarks that comprise foreign well-known trademarks and are used in bad faith.

Examples of individual interest prohibitions include:

- trademarks comprising the name or portrait of another person;
- trademarks that are identical or similar to another's well-known mark and used for identical or similar goods or services;
- trademarks that conflict with a prior registration;
- trademarks that cause confusion with respect to the source of the goods or services;
- trademarks for wines or spirits that indicate regional origin in a manner prohibited by the TRIPS Agreement or the JPO; and
- trademarks that are identical or similar to another's well-known trademark in Japan or abroad as identifying the relevant goods or services if the applicant uses such mark in bad faith.

Measures against non-use of trademark:

Where there is justifiable doubt as to whether the applicant is conducting, or is planning to conduct, business in connection with the designated goods or services, the examiner will preliminarily reject the mark and notify the applicant accordingly. This refusal may then be overturned if the applicant certifies the use or intended use of the trademark under the application where it has designated:

- a wide range of goods or services;
- two or more dissimilar retail services; or
- general retail services.

Procedures

Examination

An applicant may file a trademark application with the JPO in person, by mail or online.

Once formal registration requirements are satisfied, the examiner will examine whether the application meets the substantive requirements for registration.

If the examiner finds reasons to reject the application, he or she will notify the applicant accordingly within 18 months. The applicant may submit written arguments or amendments in response. After the implementation of the Singapore Treaty on the Law of Trademarks, the applicant has more opportunities to request an extension of the specific time limit for filing the response – a one-month extension may be filed before the expiration of the time limit, and an additional two-month extension may be filed even after the time limit has expired. There is no need to show reasonable grounds to obtain these extensions.

If the applicant does not reply to the JPO's notice, or if its written arguments or amendments fail to overturn the reasons for rejection, the JPO will issue a refusal decision.

The applicant may appeal the JPO's decision, which will become final and conclusive if no appeal is sought.

If an appeal is requested, the application will be scrutinised by a panel of trial examiners. If the panel issues an unfavourable ruling, the applicant may appeal to the IP High Court; if it fails to do so, the rejection decision becomes final.

Registration

If the examiner determines that there are no reasons to reject the application, or if such reasons are defeated, he or she will issue a decision of grant. In practice, it takes an average of 10 to 14 months from filing an application to a registration decision, if the JPO finds no reason to reject the application.

A trademark right is established upon registration of such right with payment of the registration fee.

The trademark registration will then be published in the *Trademark Gazette*.

The term of protection lasts for 10 years from the date of registration. The trademark right may be renewed every 10 years by filing a request for renewal within six months prior to the expiration date.

Opposition

Anyone may file an opposition to registration within two months of the trademark being published in the *Trademark Gazette*. Once an opposition is filed with the JPO, the panel of trial examiners will consider whether it has merit.

The grounds for opposition are similar to the reasons for rejection in the examination stage (ie, lack of distinctiveness and unregistrability).

If the JPO intends to accept the opposition and revoke the registration, it must provide notice of the reasons for this and give the rights holder an opportunity to contest such notice.

If the rights holder succeeds in its arguments against opposition, the trademark registration will be maintained; otherwise, it will be revoked. The opponent may take no action against a decision to maintain the registration. Thus, in order to contest a registration once maintained, the opponent must demand an invalidation trial with the JPO.

In case of a decision to revoke registration, the rights holder may appeal to the IP High Court. If it does not appeal, the decision becomes final and conclusive.

Removal from register

Aside from successful opposition, a registered trademark may be removed from the Trademark Register for the reasons outlined below.

Cancellation/surrender: A rights holder may voluntarily cancel its trademark right. The cancellation may apply to all or only some of the designated goods or services.

Invalidation: An interested party may request a trial with the JPO to invalidate a trademark registration on the basis of similar grounds to those available in an opposition to trademark registration; additionally, invalidation may be sought based on some facts that occurred after registration.

An invalidation trial may be commenced even after a registered trademark right has expired or has been relinquished. However, an invalidation trial based on grounds such as lack of distinctiveness or individual interest prohibitions may not be brought more than five years after the date of registration.

Once a decision to invalidate a registration has become final, in principle, the trademark right is retroactively deemed never to have existed.

Revocation: Anyone may request a trial with the JPO to revoke a registered trademark based on the following grounds:

- Non-use – if a registered trademark has not been used in Japan by a rights holder or its licensee for at least three consecutive years.
- Improper use – if a rights holder or its licensee uses a registered trademark in an improper manner.
- Similar trademarks owned by different persons – if similar registered trademarks come to belong to different persons as a result of the transfer of a registered trademark right, and one person uses such mark with the intention of committing an act of unfair competition and in a manner that may cause confusion with the other's goods or services.

Where a trademark owner's rights are registered in a country that either is a signatory to the Paris Convention or the Trademark Law Treaty, or is a member of the TRIPs Agreement, the rights holder may seek revocation of a Japanese trademark registration if its agent or representative files the trademark application without the owner's authorisation, within five years of such unauthorised registration.

Searches

The JPO provides a public database called the Japan Platform for Patent Information, in which trademarks can be searched in a variety of ways.

Enforcement

Trademark Act

The unauthorised use of a mark that is identical or similar to a registered trademark in relation

to identical or similar goods or services constitutes infringement. The Trademark Act provides that certain preparatory activities shall be deemed to constitute infringement.

These include: the possession of the designated goods, or goods similar to the designated goods or services, affixed with the registered trademark or a trademark similar thereto on the goods or their packaging for the purpose of assignment, delivery or export; and the manufacture, assignment, delivery or importation, as a business, of products to be used exclusively for the manufacturing of products indicating the registered trademark or a trademark similar thereto.

Where infringement occurs, the owner of the registered trademark (or its registered exclusive licensee) may enforce its rights by filing a trademark infringement suit in district court. Alternative dispute resolution before certain private entities, such as the Japan Intellectual Property Arbitration Centre, may also be considered.

Remedies for trademark infringement available under the Trademark Act are outlined below.

Civil remedies: The plaintiff may seek an injunction against an infringing party (or a party that is highly likely to infringe) which acts with or without negligence or wilfulness. Together with an injunction, the plaintiff may seek an order for destruction of the infringing goods and removal of the facilities used to commit the infringement, as well as other measures necessary to prevent the infringement.

The plaintiff may also seek a preliminary injunction. To obtain this, the plaintiff must show irreparable harm due to the infringement; courts sometimes require that a bond be posted.

In the case of negligent or intentional infringement, compensatory damages are also available. Under the Trademark Act, an infringer's negligence is presumed. To ease the burden of assessing damages, the Trademark Act provides the following optional measures for calculating damages:

- the owner's expected profit per item multiplied by the number of infringing items sold, to the extent of the owner's production or sale capability (for the

portion beyond the owner's production or sale capability, it is also possible to claim damages for an amount equivalent to the deserved royalties);

- the actual profit made by the infringer; or
- an amount equivalent to the deserved royalties (when determining the amount of the deserved royalties, the court can take into consideration the amount which would likely be decided between the plaintiff and the defendant on the premise that an infringement of a valid trademark right has occurred).

Where the rights holder proves the amount using one of these measures, this will be presumed to be the damages incurred. However, the rights holder may seek actual damages exceeding this by proving the amount of such damages.

A plaintiff may additionally claim other damages, such as consequential damages (eg, intangible damage to brand reputation) and attorneys' fees, although the courts tend to affirm claims for attorneys' fees only to a limited extent. There are no punitive damages under the applicable Japanese laws.

The rights holder may seek an order for rehabilitation of brand reputation, including corrective advertising.

Criminal penalties: Intentional trademark infringements are subject to criminal penalties of up to 10 years' imprisonment and/or a fine of ¥10 million in certain cases.

Unfair Competition Prevention Act

Civil remedies: The owner of either a registered trademark or unregistered but well-known or famous trademark whose business has suffered (or is likely to suffer) damage from unfair competition may file suit in a district court seeking an injunction against an infringing party (or a party that is highly likely to infringe), regardless of whether that party is acting negligently or wilfully. The plaintiff may also seek an order for the destruction of the infringing goods and removal of the facilities used to commit the infringement, as well as other measures necessary to prevent the infringement.

In case of negligent or intentional infringement, the rights holder may claim

compensatory damages. As with the Trademark Act, the Unfair Competition Prevention Act also provides optional measures for calculating the rights holder's damages. However, unlike under the Trademark Act, negligence is not presumed.

Pursuant to the Civil Code, the plaintiff may also seek:

- restitution for unjust enrichment for infringement, with or without negligence or wilfulness; and
- an order for rehabilitation of brand reputation, including corrective advertising in the case of negligent or intentional infringement.

Criminal penalties: The misappropriation of a well-known mark with the intent to commit an act of unfair competition is punishable by imprisonment and/or a fine.

Appeals

A party which is not satisfied with the district court's decision may appeal to the competent appellate court, whose decision may subsequently be appealed to the Supreme Court on limited grounds.

Ownership changes and rights transfers

Assignment

A rights holder or applicant may assign its rights relating to the trademark or trademark application. The assignment documents need not be notarised or legalised.

Assignment of status as applicant: The assignor or assignee must file a notice of change of ownership with the JPO. The assignment will take effect once such notice is filed.



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Hitomi Iwase is a partner at Nishimura & Asahi, specialising in copyright, patents, trademarks and trade secrets in multiple business sectors, including information technology, life sciences and healthcare, energy, entertainment, financial services, e-commerce and retail goods. Ms Iwase's expertise encompasses all forms of transactional work, including licensing, strategic alliances, joint development, asset transfers, financing and advising on development of IP portfolios and prosecution strategies, as well as various IP disputes. She obtained an LLM from Stanford Law School and an LLB from Waseda University, and she is admitted to practise in Japan and New York. She speaks Japanese and English.



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Chisako Yagi is a patent attorney at Nishimura & Asahi, specialising in trademark prosecution, including oppositions, invalidations and cancellations at the Japan Patent Office. Ms Yagi also has expertise in online counterfeit and trademark infringement issues. She earned her LLB from Aoyama Gakuin University and was admitted by the Japan Patent Attorneys Association in 2012. In 2017 she was certified as a qualified IP litigator. She speaks Japanese and English.

Assignment of registered trademark: An application to register the transfer of a trademark right must be filed either by both the assignor and the assignee, or by the assignee alone if it has obtained such consent from the assignor.

The change in ownership will take effect once it is entered in the Trademark Register.

General succession

If an applied-for or registered trademark transfers by merger, inheritance or other general succession, this will have immediate effect. However, the successor must notify the JPO by filing a notice of change of ownership of the application (before registration) or an application to register the transfer of the trademark right (after registration).



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Ryohei Saito is a patent attorney at Nishimura & Asahi, specialising in trademark, design and foreign filings relating to infringement issues, portfolio management, due diligence and transactions. He received his LLB from Chuo University and was admitted to the Japan Patent Attorneys Association in 2013. In 2016 he was certified as a qualified IP litigator. He speaks Japanese and English.

Licensing

Exclusive licences (*senyo shiyoken*) must be registered to be effective. While registration is not compulsory for non-exclusive or exclusive licences other than *senyo shiyoken*, registration will allow the licensee to maintain its rights to the trademark in the event of any third party's subsequent acquisition and/or exclusive licence for such trademark right.

Related rights

Where a trademark – especially a 3D trademark – is a new technological invention or device, it may also be protected as a patent under the Patent Act or as a utility model under the Utility Model Act. If the trademark is a new, functional and ornamentally featured design, it may also be protected as a design under the Design Act. However, these rights are protected only if they are registered with the JPO.

Where the trademark is an original and creative expression as a result of intellectual or cultural activities, it will also be protected under the Copyright Act, without any registration.

The Companies Act prohibits the bad-faith use of a trade name or company name that causes confusion with a different company's name.

Online issues

The Trademark Act provides that the 'use' of marks includes use on the Internet in the following manner:

- providing trademarked goods or services via the Internet (eg, online distribution of trademarked products);
- providing services through a website displaying a trademark (eg, mobile banking services displaying trademarks on the monitor or screen); and
- providing information consisting of advertisements, price lists or other business documents relating to trademarked goods or services on or through the Internet.

Protection under the Unfair Competition Prevention Act extends to an act of unfair competition on the Internet.

With respect to cybersquatting, the Unfair Competition Prevention Act protects owners

of registered and unregistered marks by providing that no one may obtain, keep or use in bad faith a domain name that is identical or similar to a trademark owned by a third party.

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Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?

No



Examination for relative grounds for refusal based on earlier rights?

Yes



Non-traditional marks registrable?

3D; colours; sounds; motion; holograms; position.



Unregistered rights

Protection for unregistered rights?

Yes: but only for well-known marks and configurations.



Specific/increased protection for well-known marks?

Yes



Opposition

Opposition procedure available? Term from publication?

Yes: two months.



Removal from register

Can a registration be removed for non-use? Term and start date?

Yes: three years' non-use before filing of application for revocation.



Are proceedings available to remove a mark that has become generic?

No



Are proceedings available to remove a mark that was incorrectly registered?

Yes



Enforcement

Specialist IP/trademark court?

Yes: optional jurisdiction.



Punitive damages available?

No



Interim injunctions available? Time limit?

Yes: in some cases.



Ownership changes

Is registration mandatory for assignment/licensing documents?

Yes: assignment. Yes: exclusive licences only (senyo shiyoken).



Online issues

National anti-cybersquatting provisions?

Yes



National alternative dispute resolution policy (DRP) for local ccTLD available?

Yes: JP Domain Name Dispute Resolution Policy.

