

Questionnaire for J T A • A I P L A Luncheon Meeting

April 19, 2004

11.30 a.m.-1.30 p.m.

1. Madrid Protocol

Please provide us with the following information if possible.

- 1) The number of the applications filed with USPTO through Madrid Protocol System.
- 2) The number of countries on average designated in a single application.

2. Three dimensional marks / Trade dress

- 1) Solid line and dotted line in a representation of the mark
 - a. When a trademark is represented in solid lines and dotted lines, what legal effect is afforded the part represented in dotted lines? Does it not form a part of the trademark just to illustrate a position of the mark, or is it treated as a disclaimer where a dotted line is used? Is a description of mark such as 'The matter shown by the dotted lines is not part of the mark and it serves only to show the position of the mark' not compulsory when using dotted lines? If such description of mark is not indicated in the application form, how is the part represented in dotted lines treated before USPTO?
 - b. Please let us know if there are any court decisions concerning a infringement of three-dimensional marks using solid lines and dotted lines.
- 2) Has there been any further development as to the trade dress protection after Wal-Mart case (Wal-Mart Stores, Inc. v. Samara Brother, Inc., 165 F.3d 120 (2000))?

In order to enjoy protection of trade dress of product configuration, does a plaintiff need to prove the secondary meaning? For protection of trade dress of the others such as product packaging, is the establishment of secondary meaning necessarily required?

3. U.S. prosecution practice

- 1) Color mark

When a color trademark is applied for without color claim, how is it treated by the USPTO? Is it detrimental to the trademark proprietor if a color trademark is filed and color claim is not asserted?

Is the scope of color trademark right without color claim restricted compared

to that of color trademark right with color claim or that of black and white trademark right? In order to be afforded the widest protection, how can we apply for a color trademark?

- 2) Standard Character Claim
 - a. Please explain briefly concerning Standard Character Claim which has been adapted recently in your country.
 - b. What is a difference between Plain Block Letters and Standard Character Claim?
 - c. How do we mention Standard Character Claim in an application form?
 - d. Can we still file an application in Plain Block Letter?
- 3) Please explain in details how the Acceptable Identification of Goods and Services Manual is edited.

4. Others

- 1) Please let us have some typical cases in which initial interest confusion or post purchase confusion is established to sustain opposition or cancel trademark registration by TTAB together with brief introduction of such cases.
- 2) In case of enforcement of non-traditional trademarks such as a single color mark, a sound mark and an olfactory mark under Lanham Act Sec. 32, how will a court decide the scope of protection or decide whether there is likelihood of confusion? Are there any peculiar criteria different from those for traditional trademarks such as a word mark?
- 3) Is there any movement to amend Lanham Act Sec. 43 (c) after the Supreme Court decision of Victoria's Secret case (2003 WL 716807 (U.S.)) to strengthen the protection of a famous mark?
- 4) Use of a trademark on the Internet
Please update any court decisions in the U.S. concerning a use of a mark on the Internet, infringement of a trademark right and jurisdiction therefor.

Japan Trademark Association