

*Trademark Distinctiveness  
(especially) In the Information  
Technology Area*

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# My Question...

- Especially as to Information Technology area in Japan, there are rapid changes in distinctiveness of trademarks.
  - For example, a trademark registered three years ago is losing distinctiveness and becoming generic this year.
  - In such a case, it is sometimes difficult to determine whether a third party's use is fair or not, that is, whether the trademark is completely generic or not, at present.
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- In enforcing a trademark right, is there any similar problem in the United States?

# Situation in Japan

The following slide Nos. 4 – 8 explain  
the situation in Japan  
under the current law as of April 2005.

# Trademark Law § 46

- Trial for Invalidation of trademark registration

It is possible to invalidate a trademark registration where the mark had already lost distinctiveness at the time of registration, within five years from registration.

# However...

- It is not possible to invalidate a trademark registration after the five years passed, in principle under TL§47, even if the mark without distinctiveness was erroneously registered.
- And further, it is not possible to invalidate or cancel a trademark registration if the mark lost distinctiveness **after registration**.
- That is, there exist many trademarks without distinctiveness on the Registry.

# Trademark Law § 26

- Limits of Trademark Rights
  - (1) The effects of the trademark right shall not extend to the following trademarks (including those which constitute part of other trademarks)
    - (ii) trademarks indicating, in a common way, the common name, origin, place of sale, quality, raw materials, efficacy, use, quantity, shape (including packaging shape) or price or the method or time of manufacturing or using the designated goods...

# The problem is...

- §26 consideration (in a common way or not, trademark use or not) is sometimes difficult.
- When a trademark owner takes an action, it is not possible to invalidate or cancel the trademark registration, but only possible to insist that it is fair use.

# Another problem is...

- In Japan, there is no system of disclaimer, that is, it is sometimes difficult to decide which part is distinctive in a registered mark, and there is a possibility that a trademark owner takes an action based on a non-distinctive word mark where the registered mark as a whole is regarded as distinctive. (See Slide 11 sample)

# Sample Registrations in Japan

The following slide Nos. 10 – 14 are  
for your information.

# Sample Registrations

Cl.9: Computers etc.

**SOLUTION** (registered 1987)

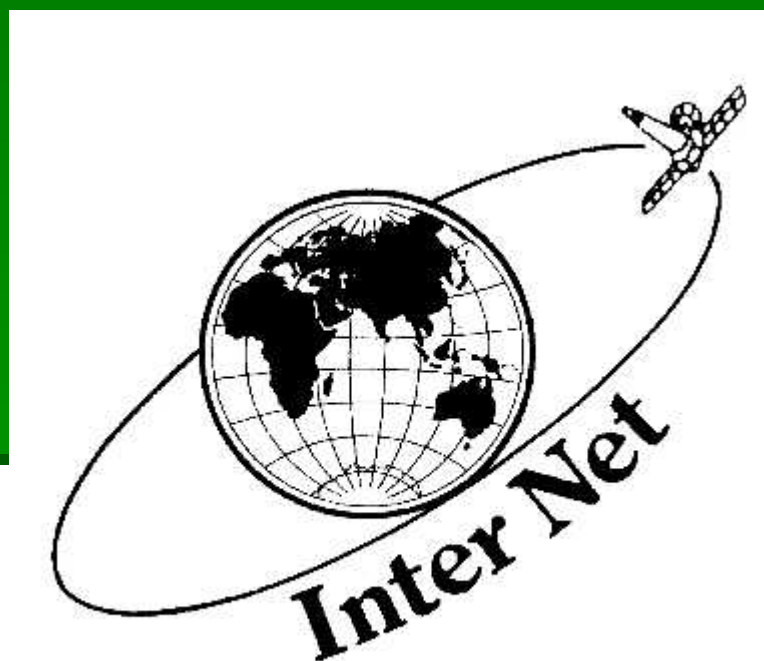
**WWW** (registered 1989)

**Linux** (registered 2003)

Registrant appears a person relating to  
Japan Linux Association.

# Sample Registrations

CI.9: Computers etc.

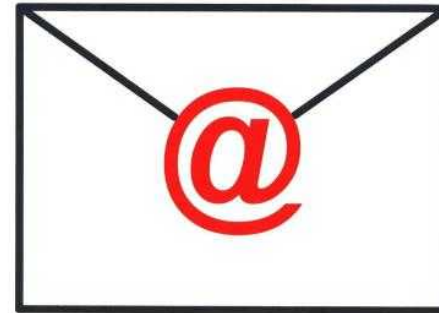


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# Sample Registrations @

Cl. 9: Computers etc.

Cl.42: Computer  
related services



# Sample Registrations @

Medicine

@  
アットマーク

Music related  
goods

アットミュージック  
@  
MUSIC

× (rejected)

@  
.COM

# Sample Registrations @

Advertisement( × Recruiting woman)

アットマークウーマン  
**@WOMAN**

Computer related services  
**@MESSAGE**