

Questionnaire for JTA • AIPLA meeting

April 12, 2005

I. Consent agreement

As you may be aware, Japan is considering to introduce consent system in the near future. We would be grateful if you could let us have your written answer to the attached questionnaire on consent system. (Foreign Trademarks Committee)

II. Three Dimensional Trademarks

We would be grateful if you could let us have your written answer to the attached questionnaire on three dimensional trademarks. (Design Committee)

III. Design patent

1. Please explain the standard for determining infringement of a design patent, as applicable in the United States.
2. Please provide us with your comments on the following cases with particular reference to how the cases interrelate and how a judge may take into account the precedents set by these cases in determining infringement of a design patent;
 - (1) Markman v. Westview Instruments Inc.
 - (2) Gorham Co. v. White – ordinary observer test
 - (3) Litton Systems, Inc. v. Whirlpool Corp. – point of novelty test
 - (4) Elmer v ICC Fabricating Inc. – All element rule
3. Please explain what constitutes a designation of “ordinary observer” in the United States. In this regard we note that under EU Regulations an “informed user” is designated; and such a user is a retailer in a concerned sector, but is not a design expert (Paul Maier and Dr. Martin Schlotelburg “Manual on the European Community Design”).
4. Please let us know whether Doctrine of Equivalents is applicable to a design infringement case in the United States.
5. In Japan, the article (title) “motor vehicles” is not deemed similar to the article (title) “motor vehicle toys”. Consequently, a design right for a motor vehicle” does not extend to a third party’s use of motor vehicle toys”, even in a case that the designs are identical. In this regard, please let us know what the current situation is in the United States.

IV. Geographical indication

- 1 In the United States, is it possible to register geographical indications (GI) for agricultural products, e.g. California prune or Washington soft-shell crab as trademarks ? We presume such GI may be protected by certification mark and collective mark in your country. We would be grateful if you could let us have your comment therefor, in particular, in what circumstances, user can choose each system, merit and demerit of certification mark and collective mark respectively together with some registration examples.
- 2 Are there any other means of protections for GI ? For instance, does patent law protect business model which features a local nature of reputation as geographical origin for meat, fish or plant ? Is a protection of name of State or town as a local brand for new variety of plants available, which should be distinguished from plant patent for new variety of plants ? Or are there protections under any other laws including common law?

V. Distinctiveness of trademarks in Information Technology area

Especially as to Information Technology area in Japan, there are rapid changes in distinctiveness of trademarks, that is, 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. In enforcing a trademark right, is there any similar problem in the United States?

Japan Trademark Association