

(1) Madrid Protocol
(2) Recent Changes
in JP Trademark Law

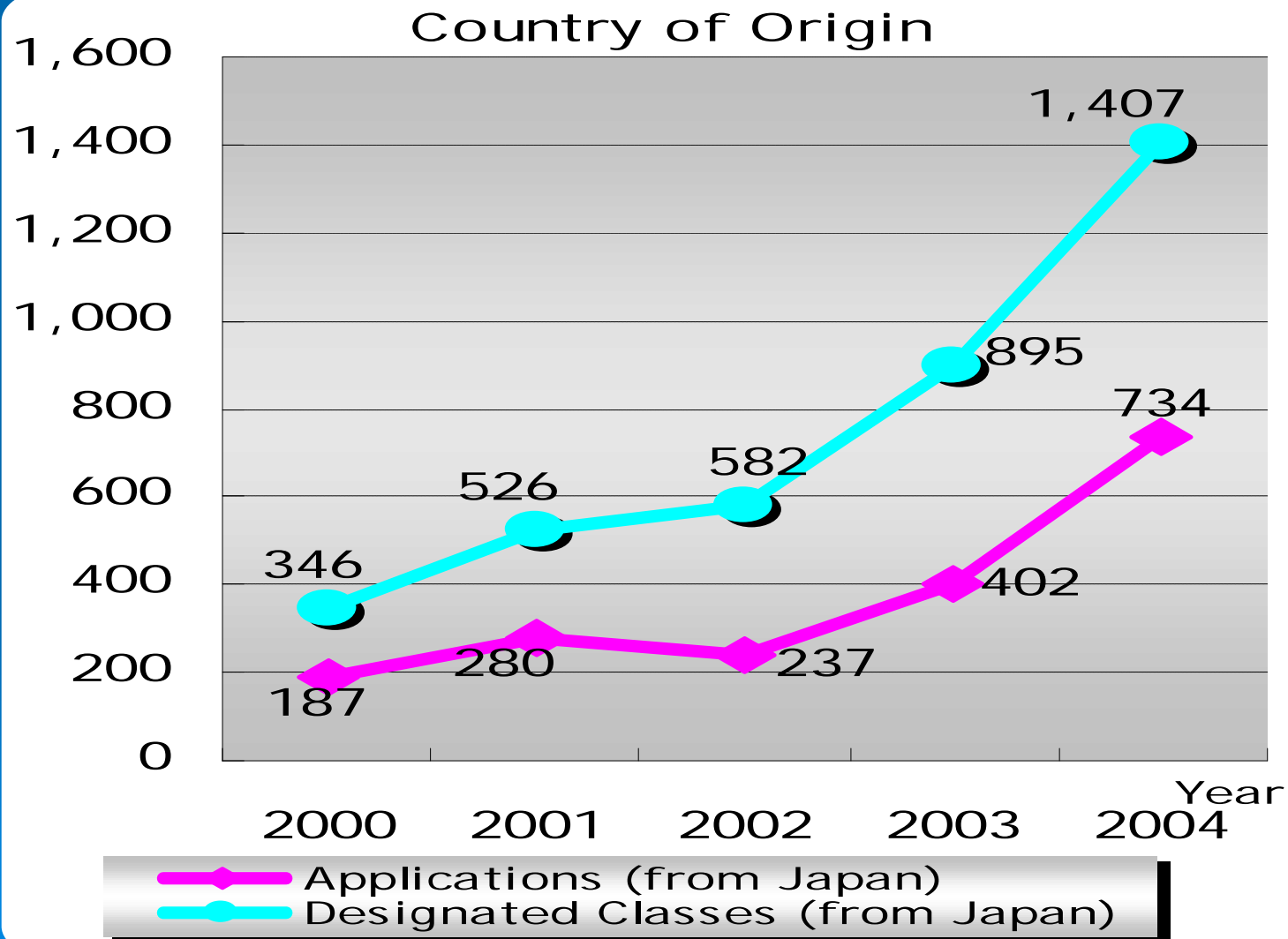
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October 25, 2005, Washington D.C.

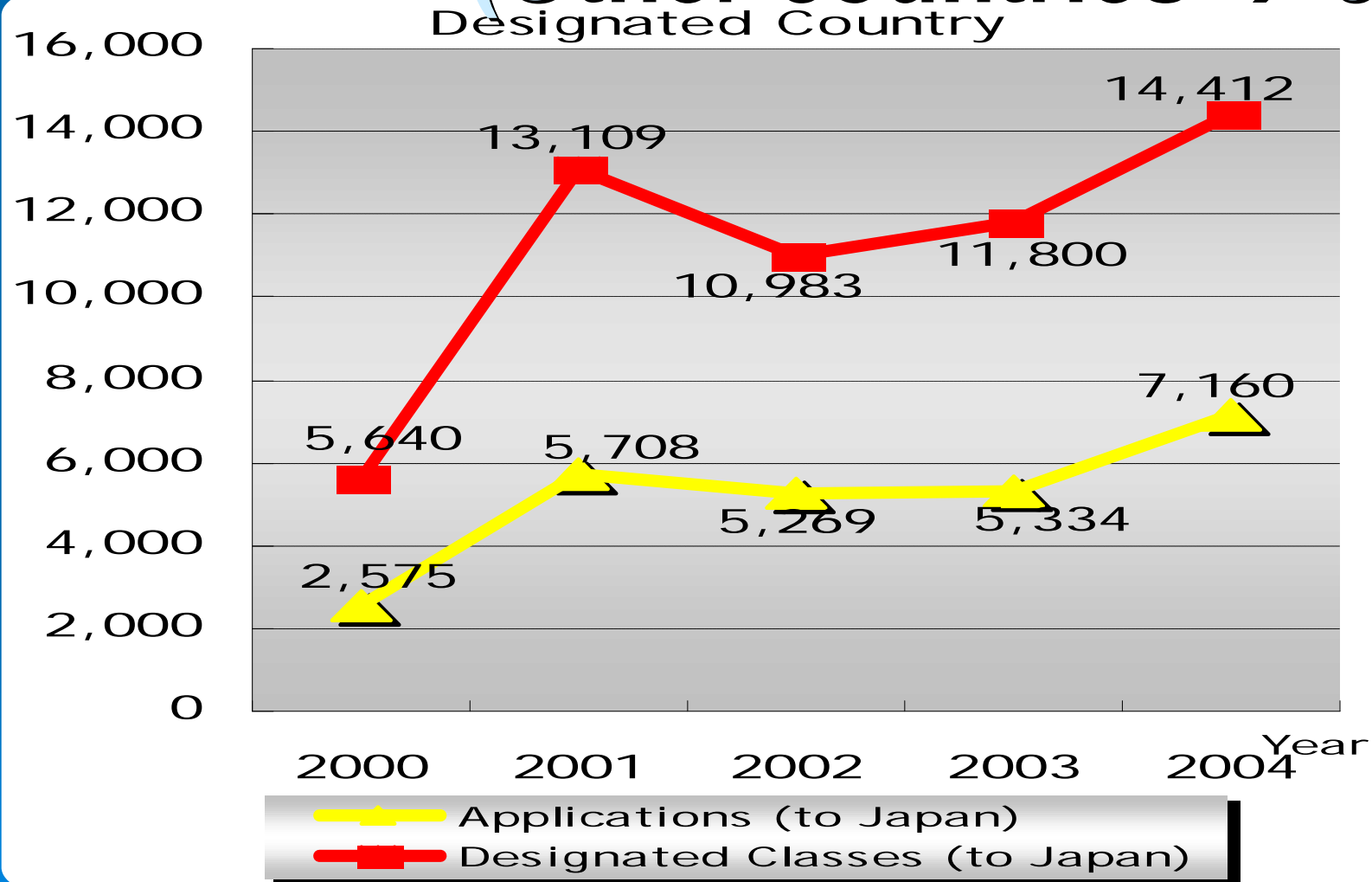
Agenda

- *Madrid Protocol from the Viewpoint of JP Trademark Attorney*
- *Recent Changes in JP Trademark Law*
 - *Geographic Indication Protection*

CHANGE in Numbers of Appl'n (JP → other countries)



CHANGE in Numbers of Appl'n (Other countries → JP)



The Top 7 Designated Countries (2004) (JP → Other countries)

	Country	Designations
1	China	514
2	U.S	459
3	South Korea	417
4	U.K	328
5	France	327
6	Germany	323
7	Italy	287
	Others	3,862
	Total	6,517

The Top 7 Nationalities (2004) (Other countries → JP)

	Nationality	Applications
1	Germany	1,531
2	France	916
3	Italy	854
4	Switzerland	715
5	U.S	650
6	China	360
7	U.K	352
	Others	1,782
	Total	7,160

(cont'd)

Year	2000	2001	2002	2003	2004
Applications (from Japan)	187	280	237	402	734
Designated Classes (from Japan)	346	526	582	895	1,407
Designated Countries	1,834	3,259	2,377	3,849	6,517
Applications (to Japan)	2,575	5,708	5,269	5,334	7,160
Designated Classes (to Japan)	5,640	13,109	10,983	11,800	14,412

Is Madrid Protocol Useful?

➤ *Advantages*

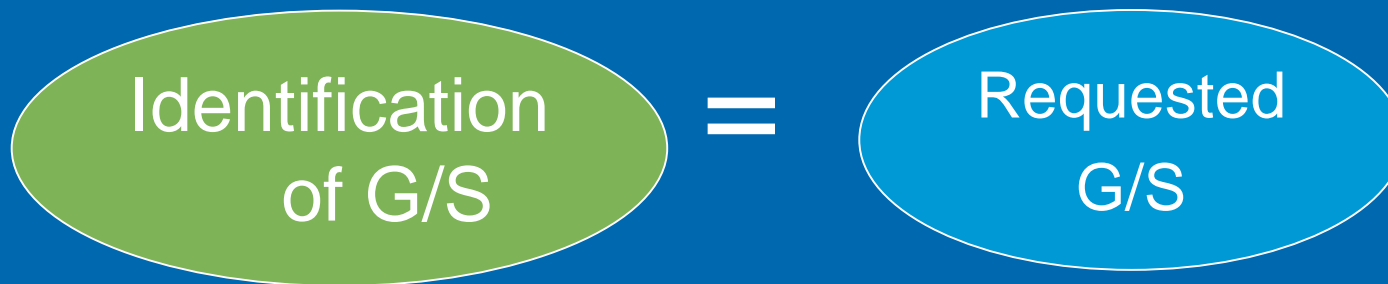
- *One Effective Date - Easy to administrate*
- *Less Expensive* *etc...*

➤ *Disadvantages*

- *Central Attack* *etc...*

Advantage or Disadvantage?

- Madrid Protocol Route



- Paris Convention Route



Disadvantage to USA - Identical/ Narrower

Skirts (Class 25)

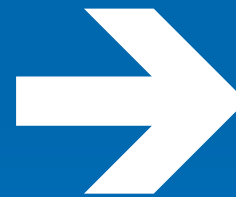
Clothing (Class 25)



Advantage to JP – Fixable

Clothing (Class 25)

Skirts (Class 25)



Advantages to Madrid Protocol

- Warnings for Paris Convention

Route ➤ *Language Issue - Check the Accuracy*

US: Computer software, namely, an application allowing sales and field service employees to update and receive data stored in an enterprise's computer databases in real time, using a mobile device, with full telephony integration with the telephone and/or software features of the mobile device.

JP: 電子応用機械器具およびその部品 : Electronic machines and instruments and their parts and fittings

(Cont'd)

- Multiple meanings
Eg. Sign → Road sign? Nameplate?
Eg. Confections → Sweets? ? ?
- Services/Goods that do not exist in Japan
Eg. Pension System
Eg. educational testing, namely providing standardized tests and skills assessment and testing to determine employment skills, and employer needs analysis; testing, analysis and evaluation of the goods and services of others for the purpose of certification (class 42)

Advantages to Madrid Protocol

➤ Double Standard in JPO
between

- Paris Convention Route
- Madrid Protocol Route

Advantages? – When Home registration is broad

- *Broad scope of protection*
- *To other countries, such as USA → USPTO definitely issues OA*
 - *Too broad, indefinite etc...*
- *Greater chance of being cited for likelihood of confusion*
- *Greater chance of being abandoned for non use portion*

Review

- Advantages (other than general advantages)
 - Language Issues
 - The scope of designated goods
 - Yes, to Japanese,
 - No, to American
 - Double Standard by the JPO

Recent Change in JP TM

- Geographic Indication at local level
- Sort of Collective /Certification mark
- Purpose: To protect local industry

Examples



- WHAT IS THIS?
- HOW MUCH IS THIS???

Source: Yubari city government's web site

Examples



Examples



Source: JA Matsuzaka's web site

- WHAT IS THIS?
- HOW MUCH IS THIS???

Requirement

- Well known – No Secondary Meaning throughout the country required - good enough to be known at least in a local area
- Has to be “GI” + “Goods/Services”
- Word Mark Only, No Design Mark
- Can be filed by only industrial business corporative association and other associations established under the special law

Registrable in the US?

- Effective April 1, 2006
- Registrable in the US?
- Any Problems?

Questions?

Thank you!

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