

Non-Traditional Trademark in Japan

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Agenda

- *What is Traditional or Non-Traditional Trademark?*
- *Examples*
- *Difference between US & Japan*
- *Future Changes in Japan*

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What is Traditional Trademark?

- *Trademark*
- *Service mark*
- *Collective mark*
- *Certification mark*
- *Defensive mark*

	US	JAPAN
• Trademark	○	○
• Service mark	○	○
• Collective mark	○	○
• Certification mark	○	○
• Defensive mark	×	○

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What is Non-Traditional Trademark?

- *Trade dress*
 - *Product Design (shape of the goods)*
 - *Product Package Design (shape of a container for the goods)*
 - *Buildings and interior*
 - *3 Dimensional items*
- *Sound*
- *Color*
- *Slogan*
- *Franchise, scent*
- *Touch*
- *Taste*
- *Motion*
- *Characters as mark, etc.*

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Japanese Non-Traditional Marks

- *Not many...*
- *In 1996 – Japan adopted “3D trademark.”*
- *3D Trademark could include...*
 - *Product Design - configuration (shape) of the goods*
 - *Product Packaging Design - configuration (shape) of a containers, packaging, wrapping or boxes in connection with the goods*

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Example – early registrations



Class 16: Paper and cardboard,
Class 41: Educational and instruction services relating to arts, crafts, sports or general knowledge

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Example – early registrations



Class 29: Meat for human consumption [fresh, chilled or frozen], Fresh, chilled or frozen edible aquatic animals (not live), eggs, etc...
 Class 30: bread, and confectionary; ice-cream mixes; spices; gyoza etc...
 Class 32: beers, Vegetable juices, Whey beverages etc...
 Class 42: Restaurant

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Japanese 3D Trademarks

- **Formalities**
 - Must state the mark is “3D”
 - Could include more than one drawing
 - Could be picture/line drawings
- **Substantive concerns**
 - **Functionality** – Article 4(1)(xviii)
 - **Distinctiveness** – Article 3(1)(iii) – overcome by secondary meaning

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Japanese Trademark law

- Article 4(1)(xviii)
 - **Functionality:**
 Trademarks consisting solely of a three-dimensional shape of goods or their packaging with the shape being indispensable to secure the functions of the goods or their packaging
- Article 3(1)(iii)
 - **Distinctiveness:**
 [T]rademarks which consist solely of a mark indicating in a common way, the origin, ... shape (including packaging shape)....

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Japanese 3D Trademarks

- **3D statement** → considered to be 3D trademark even with literal elements
- A lot of 3D marks have literal elements → Not clear whether enforceable against identical/similar 3D marks without literal elements.
 - The shape of the statue?
 - The literal element?
- No disclaimer system



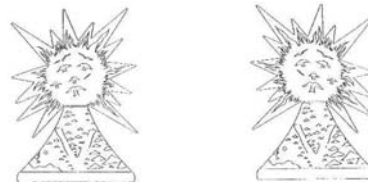
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Let's see pure 3D trademark cases!

QUIZ!!!

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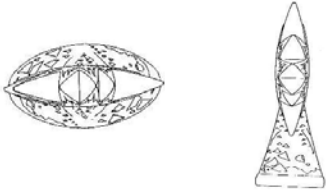
Example



Class 3: Soaps and detergents; cosmetics, dentifrices

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Example



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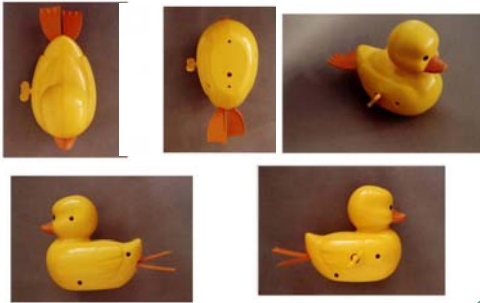
Example



Class 28: Toys

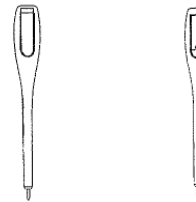
14

Example



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Example – court decision



Class 16: pencils; ball point pen etc.

Secondary meaning: "OKAYA" "pegcil"

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Example



Class 3: Perfumes, and Cosmetics etc.

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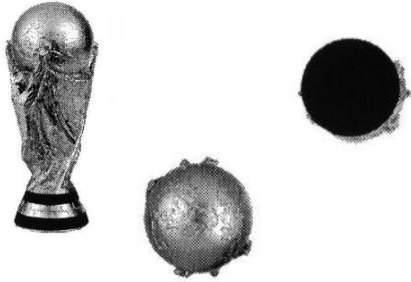
Example



Class 14: Precious metals, Trophies [prize cups], commemorative shields, key holders, clocks and watches, etc...

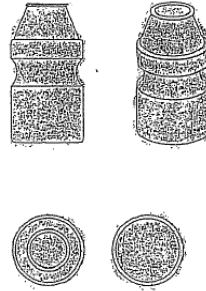
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Example



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Example – court decision



Class 29: lactic acid bacteria beverage

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US Example

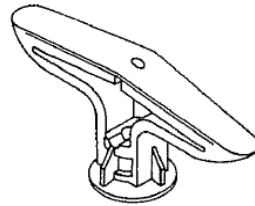


Class 29: SKIMMED MILK POWDER BASED FOODS, BEVERAGE AND CULTURED MILK DRINK

Supplemental Registration - Registered on November 8, 1988

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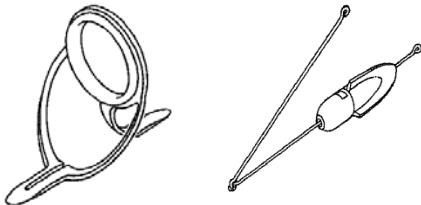
Example – court decision



Class 20: synthetic resin stoppers

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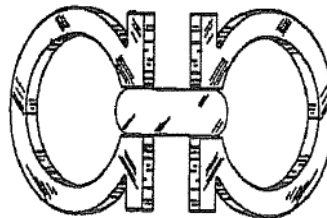
Example – court decision



Class 28: Fishing devices

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Example – court decision

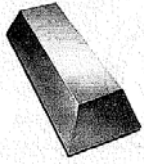


Class 14: Jewelry, key holders; clocks etc...

Owner: Ferragamo

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Example – court decision



- Class 30: Chocolates, bread and confectionary; coffee, cocoa, tea, spices; processed food; sandwiches etc.

www.favoronline.net/

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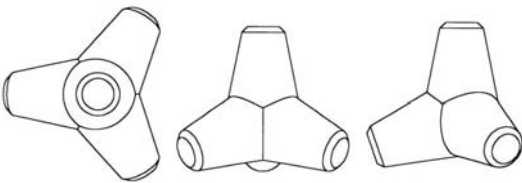
US Example

Description of Mark: The mark consists of a wrapped conical configuration with a plume emanating from the top. The stippling is for shading purposes only.



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Example



Class 19: Concrete blocks

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Example



Class 9: Cases for computers, Electronic machines, Laboratory apparatus and instruments, Optical instruments etc...

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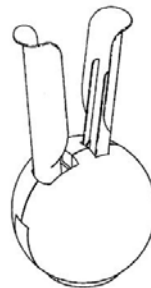
US Example



The mark consists of a profile configuration of the body of a motor vehicle. The dotted lines establish a silhouette of the vehicle providing a context for the trade dress, and are not a part of the mark.

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Example – board decision



Class 21: Spice mills (excluding electric device)

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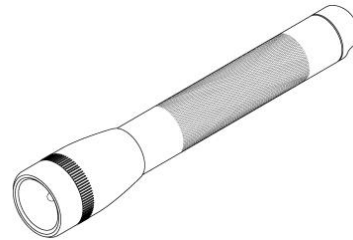
Example – court decision



Class 30: Manjyu
(Japanese bean
paste filled bun)
Secondary meaning:
HIYOKO (chick)

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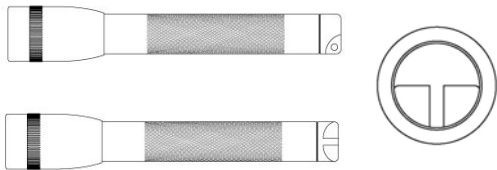
Example – Court decision



Class 11: Flashlights

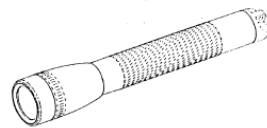
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Example



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US Example



Class 11:
Flash-
lights

Description of Mark: The mark consists of a configuration of a flashlight, namely, an elongated cylindrical body having a plurality of circumferential ridges about its mid-section and a thumb-sized circular and depressable switch adjacent to the front of the body and the shape of the head of the flashlight attached to the front of the body with a plurality of circumferential ridges about the head. The lining shown in the drawing is a feature of the mark and not intended to indicate color.



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Current

- *Not many non-traditional trademark categories in Japan*
- *Therefore, not many cases involving JP companies in foreign countries*
- *Let's compare!*

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Comparison - Sound

- *US* → ○
- *JAPAN* → ×

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US Example by Japanese Owner

Listen 

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Comparison – Buildings & interior

- US → ○
- JAPAN → △?

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Japan Example - Buildings



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US Example – Buildings



Description of mark: The mark consists of a three-dimensional configuration of a building and the trade dress of a building described as neoclassical with art deco influence, and consists of primary and secondary cornices creating a two-tiered effect, an exaggerated arch, scored exterior building materials creating a stucco-like appearance a neutral color scheme, and diamond accents.

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Example – interior



Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE sandwiches, pickup, euro-Asian sandwiches, and coffee APART FROM THE MARK AS SHOWN

Description of Mark The color(s) Neon Pink, Neon Blue, Neon Orange, Neon Green, Neon Purple, Red, Blue, White and Pink is/are claimed as a feature(s) of the mark. The mark consists of a trade dress consisting of an interior of a restaurant. When entering the interior of the establishment, there are three separate upper trim wall panels, consisting of a left, a middle, and a right panel. In particular, the left panel is of the color light blue and contains the curvilinear letterings of "Pick-Up" in the color of neon pink, "Euro" in the color of neon blue, "Asian" in the color of neon orange, and "Sandwiches" in the color of neon green. The right side panel is also of the color light blue and contains the curvilinear lettering "Coffee" in the color of neon purple and "Smoothies" in the color of neon green. The remaining middle panel is of the color pink, is curved outward and contains the lettering "LEE'S SANDWICHES" in the color of red. The apostrophe in the word "LEE'S" is replaced by a five-point star and is also in the color red. The surrounding interior walls behind the service counters contain three distinct lines that in descending order are in the color blue, white and red, respectively. Collectively, these elements define the interior of a restaurant. Pertaining to this trade dress, color is a claimed feature of the mark.

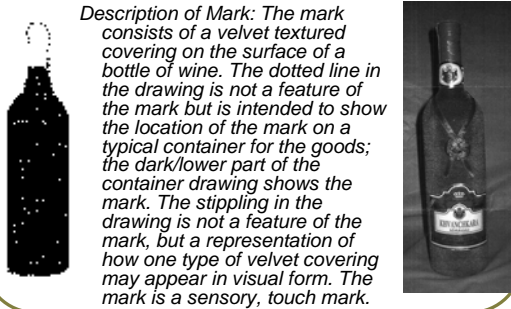
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Comparison – Texture

- US → ○
- JAPAN → ×

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US Example – Texture



Description of Mark: The mark consists of a velvet textured covering on the surface of a bottle of wine. The dotted line in the drawing is not a feature of the mark but is intended to show the location of the mark on a typical container for the goods; the dark/lower part of the container drawing shows the mark. The stippling in the drawing is not a feature of the mark, but a representation of how one type of velvet covering may appear in visual form. The mark is a sensory, touch mark.

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Comparison – Motion Mark

- US → ○
- JAPAN → ×

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Comparison – Scent / Fragrance

- US → ○
- JAPAN → ×

-- US FIRST REGISTRATION for Scent! --

- Class 23: Sewing thread and embroidery yarn
 - High impact, fresh, floral fragrance reminiscent of plumeria blossoms
- Synthetic lubricants for high performance racing and recreational vehicles - Cherry

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Comparison - Color

- US → ○
- JAPAN → ×

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US Example – Color Mark

● Brown



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Comparison - Taste

- US → ×
- JAPAN → ×
- Orange flavor for quick-dissolving antidepressant medication
- In re N.V. Organon (TTAB 2006)
- Functional feature of its product

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Are most non-traditional marks other than 3D trademark not protected in Japan?

- No, under trademark law,
- But yes, to certain categories under other laws

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Protection under other laws

- *Unfair Competition* – famous design product shape
- *Copyright* – buildings, slogan, music (sound)

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Future Changes regarding non-traditional mark in Japan

- *Need for protection in Trademark law!*
 - Increase certainties of protection without resort to litigation!
- *JPO is considering protecting non-traditional trademark under TM law.*
- *To what extent and How???*

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Possible solutions

- *Distinctiveness* – secondary meaning
 - Evidence of Use?
- *Functionality*
 - Disclaimer?
- *Mark Description?*

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QUESTIONS?

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Thank you!

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