

Intersection of Trademark & Design Patent Law in United States & Japan

American Intellectual Property Law Association
IP Practice in Japan Committee
Spring Delegation to Japan
April 20-23, 2009

Panel Participants

- Fumihiko Hirose
- George Lewis
- Yoshikazu Iwase
- Don Studebaker
- Hiroko Kanomata
- Ken Nakayama (co-moderator)
- Mark Guetlich (co-moderator)

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Intersection of TM and Design Limits and Boundaries – U.S. SIDE

Trademark	Design Patent
<ul style="list-style-type: none"> • A trademark is a word, symbol, or phrase, used to identify a particular manufacturer or seller's products and distinguish them from the products of another • the use of a trademark in connection with the sale of a good constitutes infringement if it is likely to cause consumer confusion as to the source of those goods or as to the sponsorship or approval of such goods 	<ul style="list-style-type: none"> • A design patent may be granted for any new, original and ornamental design for an article of manufacture. The claimed design is embedded in or applied to the article or portion thereof, and not the article itself • An accused article will not be found to infringe unless "a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, 'inducing [the purchaser] to purchase one supposing it to be the other.'"

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Intersection of TM and Design Limits and Boundaries – Japan Side

Trademark	Design
<ul style="list-style-type: none"> • A trademark is characters, figures, signs, three-dimensional shapes or any combination thereof, any combination thereof and colors • The owner of the trademark right shall have an exclusive right to use the registered trademark with respect to the designated goods or services 	<ul style="list-style-type: none"> • A design is shape, pattern or color or any combination thereof of an article which produces an aesthetic impression on the sense of sight • Inseparability of configuration from article required • The owner of the design right shall have an exclusive right to commercially work the registered design and designs similar thereto

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Intersection of TM & Design Differences between JP & US law (see attached papers)

- **Japan (Civil Law)**
 - ✓ Trademark Law (Law No. 127 of 1959, as amended)
 - ✓ Design law (Law No. 125 of 1969, as amended)(separate from Patent Law)
 - ✓ Copyright Law (Law No. 48 of 1970, as amended)
 - ✓ Unfair Competition Prevention Law (Law No. 47 of 1993, as amended)
 - ✓ Civil Code, providing for torts (Law No. 89 of 1896, as amended)
 - ✓ See also: "Panel discussion of Trademark, Design and Copyrights Discussion Paper" authored by Fumihiko HIROSE, Patent Attorney and Koza YABE, Attorney-at-law/Patent Atty.

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Intersection of TM & Design Difference between JP & US law

- **United States**
 - ✓ TM under Federal Law Lanham Act
(Rights to a trademark can be acquired in one of two ways: (1) by being the first to use the mark in commerce; or (2) by being the first to file/register the mark with the U.S. Patent and Trademark Office)
 - ✓ Design patents are obtained under US Patent Statutes (35 USC) and Rules (37 CFR)
- **US & JP Common Features**
 - ✓ Registration systems with substantive examination for Trademarks

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Intersection of TM & Design

Less traditional special case comparison

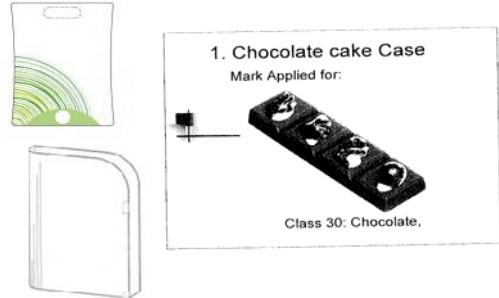
	Japan		United States	
	trademark	design	trademark	design
Color per se	No New Law	No	Limited	No
Computer Display	Limited	Limited	Limited	Yes
Sound	No New Law	No	Limited	No
Fonts	No	No	No	Yes
Moving Animation	No New Law	Limited	Limited	Yes
3-D Views	Yes	Yes	Limited	Yes
Screen Icons	No	Limited	Limited	Yes
Fragrance	No	No	Limited	No

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Examples

Packaging & Color



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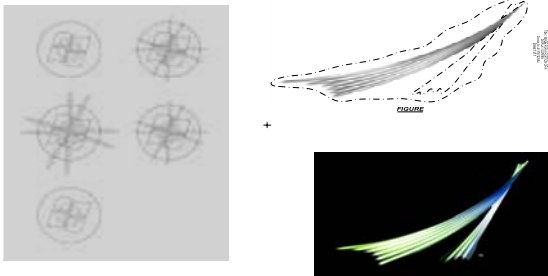
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Examples

Animation

- ✓ Is color protectable?
- ✓ Are line drawings sufficient?



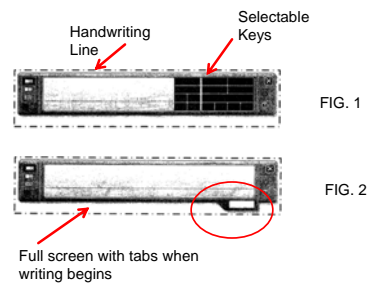
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Examples

2-state Animated Transition



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Examples

Sound



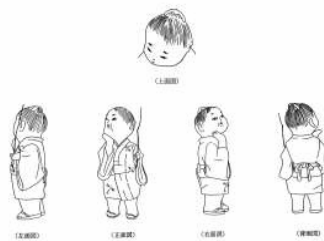
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Examples

Doll line drawing



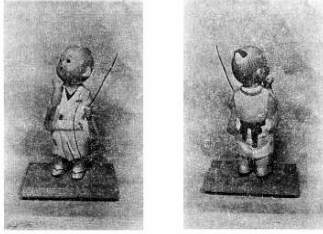
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Examples

Doll in 3-D



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Examples

Type font – D1869, November 24, 1863, USPTO



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Examples

Type font – D583858, May 7, 2008, USPTO



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Examples

FRAGRANCE

MARK CONSISTING OF SCENTED
SEWING THREAD AND EMBROIDERY
YARN.

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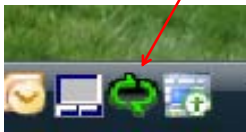
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Examples

Icons

- Computer desktop tray icon.
- Same as on startup screen of mobile telephone.



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Examples

Icons



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Examples

Consumer electronics screen displays



Digital camera
(Image on the time-setting)

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Examples

Common screen on multiple devices



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Inseparability of Configuration from an Article

- Display design or icon must be design of part of an article
- Must be indispensable for an article to function
- Must be displayed by inherent display function of an article

Initial menu screen design
-subject matter
Reg. 1207282



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2006 revised Law expanded subject matter for:

- Images used for an operation required for an article, and the operation being capable of initiating inherent function of the article (See Example 1)
- The above-described images displayed on another device, if the device and the article are used in an integrated manner (See Example 2)

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JPO Design Examination Guidelines

Images not used for operation of an article
- Not subject matter

Wall paper Contents Images saved in recording media



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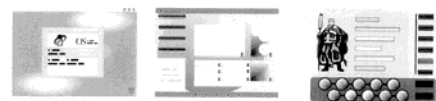
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JPO Design Examination Guidelines

Images not used for initiating function of an article – Not subject matter

Images shown by Operating System Images shown via internet Images appearing while gaming function is being performed



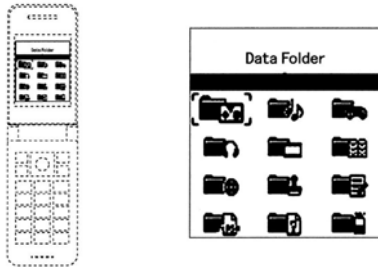
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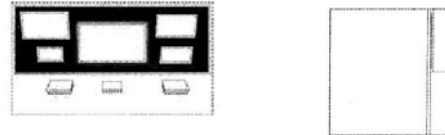
JTA Example 1

Wireless telephone
Reg.1354104



JTA Example 2

Sales demonstration machine for informational merchandise
Reg. 1348374

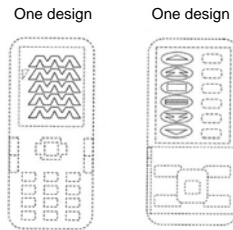
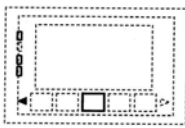


Screen view Front view

JTA Practice Tips for U.S. practitioners

One design in one application

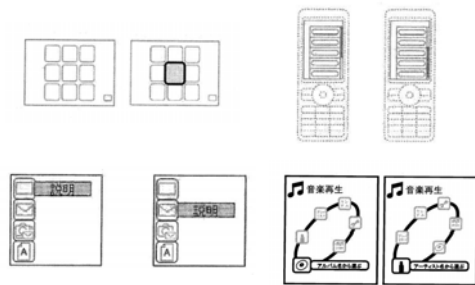
- Two or more designs - unacceptable
- No amendment allowed
- Divisional application can be filed



Examples shown in the JPO Examination Guidelines

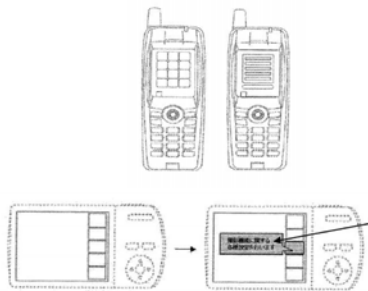
JTA JPO Design Examination Guidelines

2-state animated transition granted as one design



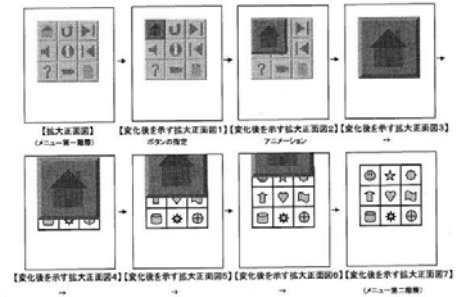
JTA JPO Design Examination Guidelines

2-state animated transition not granted as one design



JTA JPO Design Examination Guidelines

Animation not granted as one design



JTA citation

- Registered designs cited from the data base available at:

http://www4.ipdl.inpit.go.jp/lscopy/dgde_top.ipdl?N0000=3100

- Examples in the Examination Guidelines available at:

http://www.jpo.go.jp/cgi/link.cgi?url=/shiryoku/kijun/kijun2/h18_ishyoku_kijun.htm

Thank you

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