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Intersection of Trademark & Design in USA & Japan
Discussion paper

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1. Difference between Japan and U.S.

A distinctive design or sign used simply in the market can be protected in the U.S.A. because Common Law system may provide certain intellectual property right or interest to be protected against a “false designation of origin” or a “misappropriation.” The Lanham Act, a federal law regarding trademark protection, may also extend protection even if the trademark is not registered or specifically defined by taking into account somewhat unfair competitive nature. This is different from Civil Law countries’ tradition, especially in Japan. Without a registration under the Trademark Law and the Design Law, or a certain sufficient fulfillment of the restrictive requirements of the protection even without registration under the Unfair Competition Prevention Law and the Copyright Law, it is unlikely you can find good protection of intellectual property interests on the sign and design. In addition, the Civil Code may also appear as a guardian of intellectual property interest in Tort if the infringer’s attitude is quite outrageous. But you cannot expect an injunction in general under the Civil Code. We still need to stay and watch how the Japanese intellectual property laws will be more flexible to expand the definition of protectable subject matters of sign and design.

2. Trademark Law

The scope of protection covered by the Trademark Law was revised in 1997 and expanded to three-dimensional marks. It means that a configuration of product can be protected as a kind of sign based on its configuration per se while a product design is traditionally protected under a design registration. Although quite a few of three-dimensional trademark applications were denied via product configuration per se mainly due to lack of distinctiveness, a few of successful applications has been recently made in the cases of Mini-Maglight, Coca-Cola’s bottle shape and GuyLiAN’s chocolate. In addition, a further expansion of statutory registrable marks is under consideration. For example,

1) color per se, 2) sound, 3) moving mark, and 4) hologram would be introduced as registrable marks. The preliminary discussions were nearly concluded at the committee of the Institute of Intellectual Property. The governmental council for legislation should start working on the subject matter soon. A draft revision of the law by the Patent Office is underway.

3. Design Law

The Law aimed to protect a product design under the design registration. Therefore, the scope of protection is limited to a design in an article (goods/products) which has an ornamental appearance. While there is a need to give a legal protection for a design that is not associated with tangible article, such as typeface, icon, screen design, display design, sign figure, such matters are not yet fallen into the current scope of design protection under the Law. In addition, a moving design can be protected if an article is transformed to a configuration of the subject product. An icon may be same to be protected under the Law if it appears on the article as industrial design under the Design Law. Package is also protected if it satisfies the requirements of the Law. There may be a need for a revision of Law to encompass even these unconventional designs apart from articles or products to promote more effective development of industrial design. Please also note that a partial design of article registration is also available to protect a part of product under the Law.

4. Copyright Law

The Law is providing protection to a creative expression of idea or feeling in relation to literature, science, art or music. However, a protection is restricted to the original expression itself, even in any type of style, and not extends to an idea or a concept described therein. Even an applied art which can be produced via industrial method is also excluded from this copyright protection. Only a few cases for example doll figure, cabinet could provide copyright protection of certain significantly artistic figures and designs even though they are still reproduced as applied arts of product. On the other hand, a series of moving characters like animation may be fallen into a movie work to be protected under the Copyright Law. However, the character in general has still limitation in their protection under the Copyright Law. It is limited into a certain copy of specific scene copyrighted as a part of animation/cartoon.

5. Unfair Competition Prevention Law

An unregistered design or sign, including the package of goods, actually used in

the market can be protected by the Unfair Competition Prevention Law. In a case, where a design or a sign is actually used acquired well-known status as an indication of goods/service source and likelihood of confusion took place, it is protected under Art. 2, Para. 1, Item 1 of the Unfair Competition Prevention Law. If such an indication of goods/service source becomes famous, Art. 2, Para. 1, Item 2 will have provided a protection with injunction and damage claim by an infringer's use even though no likelihood of confusion occurred. In addition to, according to 1993 amendment of the Law, a sale, etc. of imitation of the other person's goods configuration is directly prohibited by Art. 2, Para. 1, Item 3. This article leads also an injunction and damage claim as well as ones for Para. 1, Items 1 and 2 of the Article 2. Provided however, this Item 3 can be valid only for three years since the first release of the product's configuration in the Japanese market. It does not also apply to any functional configuration of same/similar product in the market.

6. Civil Code; General Tort

The Civil Code, especially the section of Tort, applied to one case that an infringer made an identical copy via photograph of the other's original design on Japanese wallpaper product. The court affirmed that the defendant as an infringer show outrageous attitude of intentional infringement on the legitimate interest to be protected for the other wallpaper manufacturer's product.

7. Evaluation on the subjects in discussion

1) Font of Japanese Hiragana letters as registered in US design patent should not be registered in Japan due to lack of novelty of design under the Design Law. It is also unlikely to find any creative nature to be protected under the Copyright Law. It may be protected as a "goods" configuration or a well-known/famous indication of goods under the Unfair Competition Law. However, the court precedents are hesitated to give protection to font under the Unfair Competition Prevention Law.

2) A screen icon can be registered by trademark registration in Japan if it is used for certain goods/service source. However a simple use of such screen icon in the computer without close connection with goods or services doesn't create an infringement of the trademark right. The Design Law cannot perhaps apply to that because the screen icon cannot identify its own an article (goods/products) which has an ornamental appearance. The Design Law only provides protection about an icon which holds ornamental appearance of the article, for example one of a controller for an air conditioner. The protection of

Copyright Law is skeptical about the level of “creative” nature therein. The court precedents denied copyright protection about the screen design of intra-office communication software. The Unfair Competition Prevention Law may be the last resort because a court precedent has expressed protection about the screen design of scheduling software as configuration of product.

3) Color per se is not and will not be protected until the Trademark Law revised, although color combinations or color mixed with a design is readily protectable even under the Law to this time. No court precedents have admitted yet color per se as indication or configuration of goods to be protected under the Unfair Competition Law.

4) Package can be protected under the Design Law if it satisfies a certain new product design on an ornamental appearance of article. It is also protected under the Unfair Competition Prevention Law if the infringer imitates the configuration of the other’s goods and sells such a slavish copy of the product, even though it is not yet registered under the Design Law. The other protection for well-known or famous indication of goods source is also available under the Unfair Competition Prevention Law.

5) An auto part can be protected by the Design Law as a partial design registration with using dotted line to show non-protectable elements. If it is also identified independently as a goods configuration or a well-known/famous indication of goods, a protection may be available under the Unfair Competition Prevention Law.

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