

TOKYO - JAPAN

# NAKAMURA & PARTNERS

中村合同特許法律事務所

PATENT TRADEMARK & LEGAL AFFAIRS

## OUTLINE OF TRADEMARK SYSTEM IN JAPAN

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## 1. General

- (1) Japan is a member of the Paris Convention, Trademark Law Treaty, TRIPs and Madrid Protocol.
- (2) The “first-to-file” principle has been long adopted and an exclusive right to a trademark shall come into force upon the trademark being registered at the Japan Patent Office (JPO).
- (3) The 11<sup>th</sup> Edition of the NICE International Classification of Goods and Services has been adopted as from January 1, 2017.

## 2. Filing Requirements

- (1) (i) The applicant’s full name, address and nationality
- (ii) Details of the mark

Any words or designs with or without colors, three-dimensional marks, collective marks, color marks (a single color or a combination of colors), sound marks, position marks, hologram marks and motion marks may be registered as trademarks.

If the mark consists of only plain block letters in English or Japanese characters, we do not need any prints thereof. The mark is applied for registration in a standard character. However, if it consists of a logo, stylized letters, design, 3-D or has color(s), we need a clear copy showing the same. If the mark is a color mark, position mark, hologram mark and motion mark, we need a specimen of the mark and detailed explanation of the mark. If the mark is a sound mark, we need (i) staff notation or full score or (ii) explanation of the mark and (iii) CD-R or DVD-R in which a sound mark has been recorded under mp3 format.

- (iii) Goods and/or services to be covered must be itemized

A multi-class application is acceptable.

There is no limitation of the number of goods or services to be designated in one class. An additional fee is required for each additional class in the same application (a multi-class application). However, if the application covers 23 or more similar group codes (categories) of goods and services in one class, the JPO will issue a preliminary notice of rejection in order to confirm whether an applicant is actually conducting or intends to conduct the business with respect to the goods and services in Japan.

(iv) Priority

If Convention priority is claimed, the date and country of the basic application must be indicated in the application, and a certified copy of the basic application must be submitted within a three-month period from the filing date of the Japanese application.

## **(2) Documents**

- (i) No Power of Attorney or any other formal documents from the applicant are in principle required. However, the JPO may request the applicant to file documents to confirm nationality, corporation entity, etc.
- (ii) Neither prior use nor any evidence of use is required. Any person who intends to use the mark may file an application.

## **3. Search**

We can conduct a trademark search based only upon the JPO's records, namely, the prior registrations and pending applications for trademarks the same as or similar to the proposed trademark with respect to goods or services on which the mark is to be used. Regarding the pending applications, however, those filed during the last three months or so are not completely listed in the data available for the search.

## **4. Examination**

### **(1) First-to-file System**

One of the main characteristic parts of the Japanese trademark system is the first-to-file system, namely, a trademark in an application filed prior to other applications for identical or similar trademarks shall be registered. Therefore, it is always advisable to file an application as soon as possible to secure an earlier filing date.

### **(2) Examination**

All trademarks applied for are examined as to their distinctiveness and their similarity to third persons' prior registrations or trademarks applied for.

If there is any reason for rejection of the application, the Examiner will issue a preliminary notice of rejection and the applicant can file an argument and/or an amendment to overcome the official notice. If the application is finally rejected, the applicant can file an appeal against the decision with the Trial Board of the JPO. Furthermore, if an unfavorable decision in the appeal is issued, the applicant can file a court action seeking the revocation thereof with the Tokyo High Court.

On the other hand, if there is no reason for rejection or the applicant can overcome the official notice, an official decision for registration of the application will be issued and the application will be registered upon the payment of a registration fee.

An official action for a trademark application is, in general, received by us about 10 - 14 months on average from filing of the trademark application.

In this regard, the JPO has introduced the examination operation called “fast-track examination” since October 2018.

Under the current operation, if an application is subject to fast-track examination, a first official action (either of refusal or grant) will be issued approximately six-months from the filing date of the application.

Concretely, if an application fulfills the requirements both of (a) and (b) shown below, the application will be automatically subject to fast-track examination.

(a) Only designates the goods and/or services which are specifically shown in either one of “Examination Guidelines for Similar Goods and Services” or “International Classification of Goods and Services (Nice Classification)” at the time of filing an application.

(b) An amendment has not been made until the examination of an application is commenced.

\*New types of trademarks (Color marks, Sound marks, Position marks, Hologram marks, and Motion marks) and applications filed under the Madrid Protocol are not subject to fast-track examination.

### **(3) Certificates of Registration**

The JPO has issued Certificates of Registration of Trademarks which have been registered as from January 1, 1999. This practice is applicable to the trademarks which were registered only on January 1, 1999 or after.

As for the trademarks registered on December 31, 1998 or before, if a registrant wishes to obtain a certificate concerning registration of a trademark, it is necessary to request the JPO to issue a special Certificate.

## **5. Appeal against Decision for Rejection**

It is possible to file an appeal against a decision for rejection of a trademark application. The appeal must be filed with the Appeal Board of the JPO. We can initially file a notice of appeal without showing any ground therefor. The JPO will notify us of the appeal number assigned to the subject appeal within about one month of the filing the appeal, and thereafter send us a formal official notice requesting us to file substantial reasons for the appeal along with any evidence to support our argument. When such an official notice is issued, we must file the substantial reasons within 30 days (no extension is allowable of said issuing).

For filing and proceeding with the appeal, we must file a Power of Attorney executed by the applicant.

The appeal is examined by three Trial Examiners based upon the reasons for the appeal and evidence filed by the applicant, and no hearing is held in principle. When the examination has been finished, the official decision will be issued.

## **6. Opposition**

After the application is registered, it is published in the Official Gazette for opposition, and anyone can file an opposition against it within two months from the publication date, which is a post grant opposition system. No extension of this opposition term is obtainable, and it is therefore necessary to file a notice of opposition (a pro-forma opposition) within these two months to secure a title as an opponent, after which the opponent must file substantial reasons for the opposition and evidence supporting it within 90 days after the opposition term has expired. (Even if an opposition is not filed within the above terms, it is possible to file an invalidation action based on the same reasons as those for the opposition after the date which the opposition can be filed by. The examination of an invalidation trial takes longer and is more detailed than that of an opposition.)

A copy of the opposition is sent to the registrant by the JPO, but the registrant is not required to take any action at that time. The Examiners of the Trial Board will examine the opposition and, if they consider it unreasonable, they will issue an official decision dismissing the opposition and maintaining the opposed registration. On the other hand, if they consider the opposition reasonable, they will issue a preliminary notice of cancellation of this registration and request the registrant to file a response to the notice and, after examining the response, they will finally issue an official decision maintaining or canceling the registration.

A registrant who receives a decision canceling a registration can file a court action seeking the revocation of the decision before the Intellectual Property (IP) High Court. On the other hand, an opponent who receives a decision dismissing an opposition cannot file an appeal against the opposition decision itself, but a trial for invalidation of the registration can be filed with the JPO based on the same reasons as those for the opposition.

An official decision in an opposition is, in general, received by us about 6 months after the opposition is filed.

## **7. Trials for Invalidation or Cancellation**

“Cancellation trial” is filed against a trademark registration based on non-use. “Invalidation trial” is filed to invalidate a trademark registration based on a third person’s prior right to a similar mark or the lack of distinctiveness of the trademark at issue.

In order to seek the cancellation or invalidation of a trademark registration, it is necessary to file with the Trial Board of the JPO a trial.

## **(1) Cancellation Trial**

Under the Japanese Trademark Law, anyone can file a cancellation trial against a trademark registration based on non-use for three consecutive years in Japan with respect to all or some of the designated goods of the registration and, if such a cancellation trial is filed, the registrant must prove the fact that the mark has been used by him/her or a licensee with respect to the goods sought to be cancelled, or that there is a good reason which justifies non-use of the mark. Otherwise, the cancellation trial will be accepted and the registration will be cancelled with respect to the goods sought to be cancelled.

The registrant must establish use of the challenged trademark. Therefore, in the initial document submitted in the trial for cancellation based on non-use, it is not necessary for the plaintiff to make substantial arguments or file any evidence proving non-use of the trademark at issue. Instead, it is sufficient for the plaintiff to file a petition seeking cancellation of the mark based on non-use. If the defendant (the owner of the trademark at issue) files a response to the trial with evidence sufficient to prove the use thereof, it would be impossible for us to refute it and we would thus lose the case. On the other hand, if the defendant does not file any response and evidence of use, it would be unnecessary for us to take any further action and we would win the case. In both cases, an official decision to that effect will be served on the parties concerned.

Further, if the response and evidence filed by the defendant are disputable or there are some questions thereon, we can file a refutation and make a substantial argument emphasizing the trademark at issue should be cancelled based on non-use. Furthermore, the parties concerned can thereafter file documents supporting their respective argument, although this rarely happens. Finally, an official decision will be issued, and the party who receives an unfavorable decision can file an appeal before the IP High Court.

## **(2) Invalidation Trial**

Invalidation trial can be filed only by a person who has a legal interest in the trademark registration at issue. Further, said trial may be filed within only a limit of five years from the registration date in principle. In a case where a trademark registration has been registered with the intention of conducting unfair competition or carrying out a dishonest scheme, said limitation term is not applicable.

### **(3) Time Required**

An official decision in an invalidation or cancellation trial is, in general, received by us about 12 months or more after said trials are filed. On the other hand, an official decision in a cancellation trial based on non-use is, in general, received around 6 months after said trial is filed, in a case that the registrant does not file a response against the cancellation trial.

## **8. License**

Japanese Trademark Law recognizes two kinds of use rights under Licensing Agreements; one is a “Senyo-Shiyo-Ken” (which can be translated as “an exclusive use right”) under Article 30 of the Trademark Law, and the other is a “Tsujiyo-Shiyo-Ken” (which can be translated as “an ordinary use right”) under Article 31 thereof.

A “Senyo-Shiyo-Ken” is effective only when it is recorded on the Official Register, and the holder of this right is recognized as having an exclusive right to a registered trademark to the extent of the Licensing Agreement. Further, the licensee can initiate a court action solely in his/her own name against an infringer to stop use of the registered trademark and recover damages. Also, no person other than the licensee, even the licensor, can use the trademark within the scope of the License granted to the licensee of this right, unless otherwise stipulated by the Agreement.

On the other hand, it is not necessary to record a “Tsujiyo-Shiyo-Ken”. This use right is effective based only upon the Licensing Agreement between the trademark owner and the licensee, who may use it to the extent of the Licensing Agreement. The licensee may not take a court action against an infringer in his/her own name in principle. It is possible to record this use right, but such a registration is effective only against late comers, for example, a future assignee of the trademark concerned. On the other hand, if this use right is not recorded and the trademark concerned is assigned to a third party, the use right is not effective against such a third party. Even if this use right is not recorded, use of the trademark by the licensee will meet the use requirement for the trademark concerned in a possible cancellation trial based on non-use.

Both use rights mentioned above may be recorded only after the trademark concerned is actually registered.

If there is an exclusive trademark license agreement and the use right is not recorded on the Official register, such a use right is not a “Senyo-Shiyo-Ken”; it is still an exclusive right in the sense that the licensor may not grant a license to a third party unless otherwise stipulated by the Licensing Agreement. In such a case, the licensee may not stop use of the registered trademark by a third party, but may claim damages against the third party depending on the circumstances.

## 9. Infringement

Under the Japanese Trademark Law, a trademark right shall come into force upon a trademark being registered at the JPO. A trademark right holder shall exclusively possess the right to use the registered trademark on the designated goods or services. This naturally means that the trademark right holder can prevent others from using a trademark identical with or similar to the registered trademark with respect to goods or services the same as or similar to those covered by the registration.

## 10. Duration of Registration and Renewal

The duration of a trademark registration is 10 years from the registration date and can be renewed for the same period by filing a petition for renewal along with paying a renewal fee. The renewal fee can be paid in two installments, each of which covers a five-year period. There is a six-month grace period for paying the renewal fee, but in this case a renewal fee double the usual must be paid.

## 11. Trademark Marking

Under the Japanese Trademark Law and Regulations, it is provided that a trademark right holder shall “make efforts” to indicate that the trademark is registered on the goods or packaging thereof. Accordingly, indication of a trademark registration notice is not compulsory, only optional. There is no statutory penalty or disadvantage resulting from the failure to indicate a registration notice.

The Trademark Law Enforcement Order prescribes that a registration notice shall be indicated by the words “registered trademark” in Chinese characters (登録商標) and the registration number thereof. However, only the ® symbol is widely used in actual trade to indicate that a mark has been registered in Japan.

The trademarks registered in other countries have no legal effect in Japan. Therefore, if a mark has not been registered in Japan, the use of any indication meaning “registered trademark” or the ® symbol on products sold in Japan would be use of a false indication, which is punishable.

The ™ symbol is also used in Japan, though it is not so popular, when the mark concerned has not been registered. However, there is no clear definition of the symbol in Japan and thus the average Japanese consumers would not probably know the meaning of the symbol. Of course, there is no legal effect resulting from the use of the symbol. Furthermore, in Japan, there is no particular indication to show that the mark belongs to the user, when it has not been registered.

## 12. Well-known Trademarks

The JPO has informally published “a list of established famous and well-known marks” on the Internet. The list includes two kinds of trademarks, one being the



trademarks which have been registered as defensive marks, the other being trademarks which have been recognized as famous or well-known trademarks in decisions rendered by the Trial Board of the JPO or courts.

If the owner of a trademark wishes to have his/her trademark published in this list, it would be necessary to obtain a defensive mark registration with respect to his/her trademark. In other words, if his/her mark were registered as a defensive mark, then the mark would be automatically published in the above list.

Famous and well-known marks are also protected by the Unfair Competition Prevention Law. That is, use of identifications (including trademarks, business names, etc.) identical to or similar to another person's well-known identifications, assignment, transfer, import, export, etc. of products bearing such identifications, which cause confusion with another person's products or business, is deemed an act of unfair competition (Article 2, Section 1, Item 1 of the Unfair Competition Prevention Law). Further, use of identifications (including trademarks, business names, etc.) identical to or similar to another person's famous identifications, assignment, transfer, import, export, etc. of products bearing such identifications is deemed an act of unfair competition (Article 2, Section 1, Item 2 of the Unfair Competition Law). A court can issue an injunction against the above unfair competition acts. Further, the owner of the well-known/famous identification can file a claim for damages caused by said unfair competition acts.

### **13. Assignment**

Under the Japanese Trademark Law, the assignment of a trademark application or registration will be effective only when it is recorded in the Official Register. In order to record this assignment, we need (1) a deed of assignment executed by the assignor or an agreement between the assignor and assignee concerning the assignment (the application and/or registration numbers of the trademarks concerned must be indicated in these documents) and (2) a Power of Attorney executed by the assignee.

A petition for recording the assignment must be filed together with the above documents with the JPO, after which said assignment would be registered.

### **14. Recording Change of Name and Address**

In order to record the change of a name and address, we need only a Power of Attorney executed by the trademark owner. It is sufficient to file a petition for recording the same with the JPO, but the application and/or registration numbers of the trademarks concerned must be indicated in the petition.

### **15. Appeal before IP High Court**

In a case when an official decision dismissing the appeal is issued, the applicant can file a court action seeking the revocation of the decision before the IP High Court.

Further, it is possible to appeal against the decision rendered by the IP High Court before the Supreme Court, a decision by which is final.

An official decision for an appeal is, in general, received by us about 18 months or more after the appeal is filed.

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