

TOKYO - JAPAN

NAKAMURA & PARTNERS

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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, the Trademark Law Treaty, TRIPs and the Madrid Protocol.
- (2) The “first-to-file” principle has been long adopted and an exclusive right to a trademark comes into force upon the trademark being registered at the Japan Patent Office (JPO).
- (3) The 12th Edition of the NICE International Classification of Goods and Services was adopted as of January 1, 2024.

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, 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 a mark consists of only plain block letters in English or Japanese characters, we do not need any prints/image files thereof. The mark can be applied for registration in standard characters. However, if the mark consists of a logo, stylized letters, design, three dimensional shape, or has color(s), we need a clear copy showing the same. If a mark is a color mark, position mark, hologram mark, or motion mark, we need a specimen of the mark as well as a detailed explanation of the mark. If a mark is a sound mark, we need (i) information necessary to define the composition of the sound, such as staff notation or a full score, and (ii) a CD-R or DVD-R in which the sound mark has been recorded in 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 business or intends to conduct business with respect to the goods and services in Japan.

(iv) Priority

It is possible to claim partial priority and multiple priorities.

In order to enjoy priority under the Paris Convention, requirements (i) through (iii) below need to be met. If these requirements are not met, the effect of the priority claim shall not be recognized.

- (i) The applicant of an application for trademark registration claiming priority is the same person as the applicant shown in the priority certificate or the successor thereof; and
- (ii) The trademark described in the request of an application for trademark registration claiming priority is identical with the trademark described in the priority certificate; and
- (iii) All or part of the designated goods or designated services pertaining to an application for trademark registration claiming priority are included in the designated goods or designated services shown in the priority certificate.

(2) Documents

- (i) In principle, no Power of Attorney or any other formal documents from the applicant are required. However, the JPO may request the applicant to file documents to confirm nationality, corporate entity, etc.
- (ii) Neither prior use nor evidence of use is required. Any party who intends to use the mark may file an application.
- (iii) If priority based on the Paris Convention is claimed, the date, country and the filing number of the basic application must be indicated on the application form, and a certified copy of the basic application must be submitted within three months from the filing date of the Japanese application. An electronic copy (as a PDF) of the certified priority document issued by the Office of the country in which the basic application was filed is acceptable to the JPO. An original of the certified priority document is unnecessary.

3. Trademark Search

We may conduct a trademark search based upon the JPO's records only – 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 (including International Registrations designating Japan), however, those filed during the previous 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 characteristics 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 mainly in terms of distinctiveness, their similarity to prior registrations or trademarks applied for by third parties, and from the viewpoint of public interest or the protection of private interests. A “Letter of Consent” system was introduced in April 2024.

If there is any reason for rejection of the application, the Examiner will issue a preliminary official notice of rejection and the applicant may file an argument and/or an amendment to overcome the official notice. If the application is finally rejected, the applicant may 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 may 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 on average about 4 to 10 months after filing of the trademark application.

(3) Certificates of Registration

The JPO issues Certificates of Registration for trademarks which have been registered as from January 1, 1999. This practice is applicable to those trademarks which were registered only on or after January 1, 1999.

For those trademarks registered on or before December 31, 1998, a registrant who wishes to obtain a certificate concerning registration of a trademark must 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 with the JPO.

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

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

6. Opposition

After the application is registered, it is published in the Official Gazette for opposition. Japan adopts a post-grant opposition system, and anyone may file an opposition against a trademark registration within two months from the publication date (the opposition term). No extension of this opposition term is granted, and therefore it is necessary to file a notice of opposition (a pro-forma opposition) within these two months to secure title as an opponent, after which the opponent must file substantial reasons for the opposition and supporting evidence 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 opposition term has expired. 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 the opposed registration and request the registrant to file a response to the notice. After examination of the registrant's response, an official decision maintaining or canceling the registration is finally issued.

A registrant who receives a decision canceling a registration may 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 may 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 in about 6 to 8 months after the opposition is filed.

7. Trials for Invalidation or Cancellation

A “cancellation trial” may be filed against a trademark registration based on non-use. An “invalidation trial” is filed to invalidate a trademark registration based on a third party's prior right to a similar mark or the lack of distinctiveness of the trademark at issue.

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

(1) Cancellation Trial

Under the Japanese Trademark Act, anyone may file for 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 the registrant or a licensee with respect to the goods for which cancellation of registration is sought, or that there is a good reason which justifies non-use of the mark. Otherwise, an approval decision is made and the registration will be cancelled with respect to the goods for which cancellation of registration is sought.

It is the responsibility of the registrant to submit proof-of-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 to refute it and thus the case would be lost. On the other hand, if the defendant does not file any response and evidence of use, it would be unnecessary to take any further action and the case would be won. In any case, an official decision will be issued for the parties concerned.

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

(2) Invalidation Trial

An invalidation trial may only be filed by a person or entity who has a legal interest in the trademark registration at issue. Further, in principle, said trial may be filed only within a limit of five years from the registration date. 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 trial is, in general, received about 10 months after the trial is filed. On the other hand, an official decision in a cancellation trial based on non-use is, in general, received about 7 months after the trial is filed.

8. License

The Japanese Trademark Act recognizes two kinds of use rights under Licensing Agreements: a “Senyo-Shiyo-Ken” (which may be translated as “an exclusive-use right”) under Article 30 of the Trademark Act; and a “Tsujiyo-Shiyo-Ken” (which may 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 use right is recognized as having an exclusive-use right to a registered trademark to the extent of the Licensing Agreement. Further, the licensee can initiate a court action solely in the licensee’s own name against an infringer to stop use of the registered trademark and to recover damages. In addition, no party other than the licensee (even the licensor) may use the trademark within the scope of the License granted to the licensee of this use right, unless otherwise stipulated by the Licensing 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. In principle, the licensee may not take a court action against an infringer in the licensee’s own name. It is possible to record this use right, but such a registration is effective only against latecomers – for example, future assignee(s) 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 does not have the right to 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 Act, a trademark right shall come into force upon registration of the trademark at the JPO. A trademark-right holder shall exclusively possess the right to use the registered trademark on the designated goods or services. This means that the trademark-right holder may 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 may be renewed for the same period by filing a petition for renewal as well as paying a renewal fee. The renewal fee may be paid in two installments, each of which

covers a five-year period. There is a six-month grace period for the payment of the renewal fee, but in this case a renewal fee double the usual amount must be paid.

11. Trademark Marking

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

Enforcement Regulations of the Trademark Act prescribe that a registration notice shall be indicated by the words “registered trademark” in Japanese “kanji” characters (which read “登録商標”) and the registration number (or the International Registration number) thereof. However, the “®” symbol is widely used in actual trade instead to indicate that a mark is 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, use of the “®” symbol or any other indication meaning “registered trademark” on products sold in Japan would be use of a false indication, which is subject to penalties.

The “™” symbol is also used in Japan, although it is less popular, when the mark concerned has not been registered. However, there is no clear definition of the symbol in Japan and thus it is unlikely that the average Japanese consumer recognizes the meaning of the symbol. Of course, there is no legal effect resulting from the use of said symbol. Furthermore, in Japan, there is no particular indication to show that the mark belongs to the user when the mark has not been registered.

12. Well-known Trademarks

The JPO provides a list of established “famous and well-known marks” on its homepage. The list includes two kinds of trademarks: trademarks which have been registered as defensive marks; and trademarks which have been recognized as famous or well-known trademarks in trial decisions or court decisions.

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

Famous and well-known marks are also protected by the Unfair Competition Prevention Act. That is, use of indications (including trademarks, business names, etc.) identical to or similar to another party’s well-known indications for the purpose of assignment, transfer, import, export, etc. of products bearing such identifications, which will cause confusion with another party’s products or business, can be an act of unfair competition (Article 2, Section 1, Item 1 of the Unfair Competition Prevention

Act). Further, use of indications (including trademarks, business names, etc.) identical to or similar to another party's famous indications for the purpose of assignment, transfer, import, export, etc. of products bearing such indications can be an act of unfair competition (Article 2, Section 1, Item 2 of the Unfair Competition Prevention Act). A court may issue an injunction against the above unfair competition acts. Further, the owner of the well-known/famous indication may file a claim for damages caused by activities in breach of said unfair competition acts.

13. Assignment

Under the Japanese Trademark Act, the assignment of a trademark application or registration is effective only when it is recorded in the Official Register. In order to record this assignment, a petition for recording the assignment must be filed with the JPO together with: (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) Powers of Attorney executed by the assignor and assignee.

14. Recording Change of Name and/or Address

In order to record the change of a name and/or address, a Power of Attorney executed by a trademark owner is required. 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.

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