

Trademarks Law in Japan and its Comparison with India

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ABSTRACT: *It was a time in 19th century when there is a risk of Japan being colonized by the Western Power, however, they have fought back and moved towards modern industrialization and scientific development. This Japanese Era is known as the Meiji Era. This era becomes more important from the intellectual property perspective because during this regime the first legal system to protect the trademarks has been established. The first and foremost legal framework related to the trademark law is Trademark Ordinance 1884. It was revised from time to time to match with the different international treaties and industrial developments. In this review paper researcher will try to explain trademark law of Japan which shall include international treaties, convention, and agreements followed by the Japan. Their domestic legal framework, trademark registration criteria, trademark not registerable, registration process, landmark judgment and a comparative analysis of the whole registration process exists in Japan and India.*

KEYWORDS: *Criteria, India, Japan, Registration, Trademark.*

INTRODUCTION

The IP system is now one of the prominent subject matter in today's world which is mostly based on the trade and commerce. For a particular territory the IP system also appeared as catalyst for the development of the economy of the nation. Since this paper will not cover the economic development due to IP, but will discuss the legal framework of one of the subset of the intellectual properties i.e. Trademark Law. Basically intellectual properties are divided in two categories industrial properties and copyright. The first category i.e. Industrial Properties includes trademark within its preview[1].

The trademark is generally associated with any sign which is competent of distinguishing the product and services provided by one manufacturer from those of another manufacturer. It may also include words, letters, etc. The trademark protection in the Japan is governed primarily by the Trademark Law and Unfair Competition Prevention Law. Like India, Japan has also signed several international IP treaties like Paris Convention, TRIPS Agreement, Madrid System for the registration of the trademark, etc.

The trademark put liability on the proprietor to maintain the quality and characteristic of the goods and services provided. Since the mark is not only associated with the goods and services to identify the manufacturer, but, it also gains goodwill and reputation. It becomes liability of the proprietor to maintain the good will and reputation. In return of the registration of the trademark the proprietor of the trademark gets the exclusive right to make and use the trademark[2].

In this new world of e-commerce and e-trading system the trade and commerce have been frequently growing all over the world. This also opens the floor for the intellectual properties to show their importance in global trading system. The international convention has been regularly promoting the importance of the intellectual property protection. However, it will be only effective when properly implemented in the domestic laws. The strong IP protection and effective enforcement will surely help in economic development of the country.

1. Brief History of the Trademark law in Japan

The first and foremost legal frame work related to the trademark law is Trademark Ordinance" 1884. It was revised from time to time to match with the different international treaties and industrial developments. The major changes in the trademark law was made in the year 1888, 1899, 1909, 1921, 1959, 1975, 1991, 1994, 1996, 1998, 1999[3].

2. *International Treaties followed by the Japan*

It was time in 19th century when there is risk of Japan being colonized by the Western Power, however, they have fought back and moved towards modern industrialization and scientific development. This Japanese Era is known as Meiji Era. This era becomes more important from the intellectual property perspective because during this regime the first legal system to protect the trademarks has been established. Since it was enacted very early there was need to revise the legal framework from time to time to match with international treaties and industrial developments.

Like India, Japan is also signatory of the significant intellectual properties treaties and conventions like Paris Convention, Nice Agreement, Trademark Law Treaty, Madrid Agreement & Protocol and TRIPS Agreement[4].

3. *Legal Protection available for Trademark in Japan*

3.1. *Unfair Competition Prevention Law*

The Unfair Competition Prevention Law along with the Trademark Law provides the provisions related to the protection of the trademarks. On one hand, trademark law aims to provide monopoly to the proprietor for using their mark for particular time period whereas on the other hand Unfair Competition Prevention Law helps the proprietor of business in maintain economic order through reputation in using the trademark and also help in establishing the interest of the consumers[5].

3.2. *Different legal framework for protection of Trademark*

Generally, in Japan the trademarks, if registered are secured primary by Trademark Law. Though, there are certain different legal frameworks which are related to the registration procedures, fees or classification of goods and services, etc. Some of the important legal frameworks are briefly mentioned here as follows:

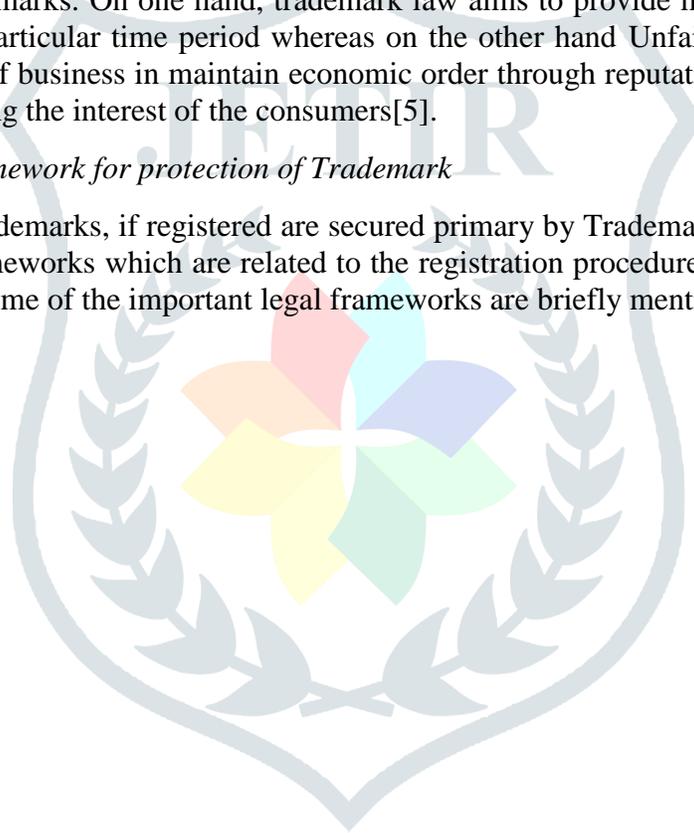


Table 1: Legal Framework for Registration of trademark in Japan

S.NO.	Legal Framework	Purposes
1.	Trademark Law Enforcement	(i) Classification of Goods and Services (ii) Qualification of Examiners and Trial Examiners
2.	Trademark Registration Order	(i) Matters to be Registered Concerning Trademarks (ii) Procedures for Registration
3.	Enforcement Orders related to the Exempted Procedures for IP	(i) Application for Trademark Registration etc. as Specific Procedures which may be applied through electronic information processing Systems
4.	Regulations under the Trademark Law	(i) Form of Application for Registration of Trademark (ii) Form of Request for Renewal Registration of the Term of the Trademark
5.	Trademark Registration Order Enforcement Regulations	(i) Method for Registration of Establishment of Trademark Right (ii) Form of Request
6.	Enforcement Regulations related to the Exempted Procedures for IP	(i) Exemptions of procedures related to intellectual properties including trademark
7.	Ministerial Ordinance related to the Procedures for cash payments of IP fees	Issuance of payment slips, and payments in order to accept bank transfer payments of fees for industrial properties including trademarks

4. *Meaning of trademark*

In Japan, Trademark Act 1959 defines “Trademark” under Article 2 as any characters, figures, signs or 3-D shapes, color or any combination thereof which is used for goods and services and certifies the goods and services as a business.

5. *Requirement for trademark registration*

Article 3 of the Act laid down that any trademark may be registered. However, at the same time it laid down the list of the cases when the trademark cannot be registered. They can be listed as follows:

- Mark depicting the common name
- Customarily associated with goods or services;
- It indicates place of origin or sale, quality, usefulness, proposed reason, amount, shape, method or time of production or use, in case of goods
- It indicates the location, quality, efficacy, proposed reason, amount, modes, price or method or time of provision in case of services
- Mark consists of a last name or name of a popular non-human legal **entity**
- Generic, common and descriptive mark
- Trademark by which consumers are not able to distinguish business

Further, Article 4 laid down list of the unregistrable trademarks. It provides that trademark is unregistrable if the mark is identical with or similar to the

- National or foreign national flag, medals The Imperial Seal of Japan;

- Coats of arms or any other State emblems of a countries parties to different treaties and as declared by government officials.
- Mark representing the UN or any other international organization declared by government officials
- Emblems or titles prohibited in concerning statute;
- Official hallmark or sign indicating control or warranty by the national or a local government of Japan;
- Marks representing the State, a local administration, an agency thereof, a non-profit organization/enterprise established for the interest of public.
- Prize awarded at an presentation held by the government officials;
- Well known trademark;
- Already filed trademark application
- Registered defensive mark of another person;
- The name of a variety registered in accordance with PVP and Seeds Act;

The other unregistrable trademark as discussed as below:

- Mark is expected to cause harm to public guiding principle;
- Mark contain name, description of another person;
- Mark contains famous pseudonym, professional or pen name, or famous abbreviation thereof;
- Is likely to cause confusion with the goods and services of other person;
- Is expected to deceive public with regard to the quality of the goods or services.

6. *Application for Registration of trademark*

Article 5 of the act provides that any person who desire to register trademark can apply before the Commissioner of the Patent Office with required documents. It provides that name, domiciled and residence of the applicant must be stated in the trademark application. The application must also state the trademark for which the registration is sought and mentioned the designated goods and services.

The Commissioner after conducting formal examination related to the name, intent, registration sought and the designated goods/services accord the filling date of the application as the submission date of the application for the registration.

A trademark application can be filed for the single trademark. However, the application for registration of trademark can be multi-class and can claim the registration over different classes with single application. The whole trademark procedure from application to the registration is explained in the given Figure 1.

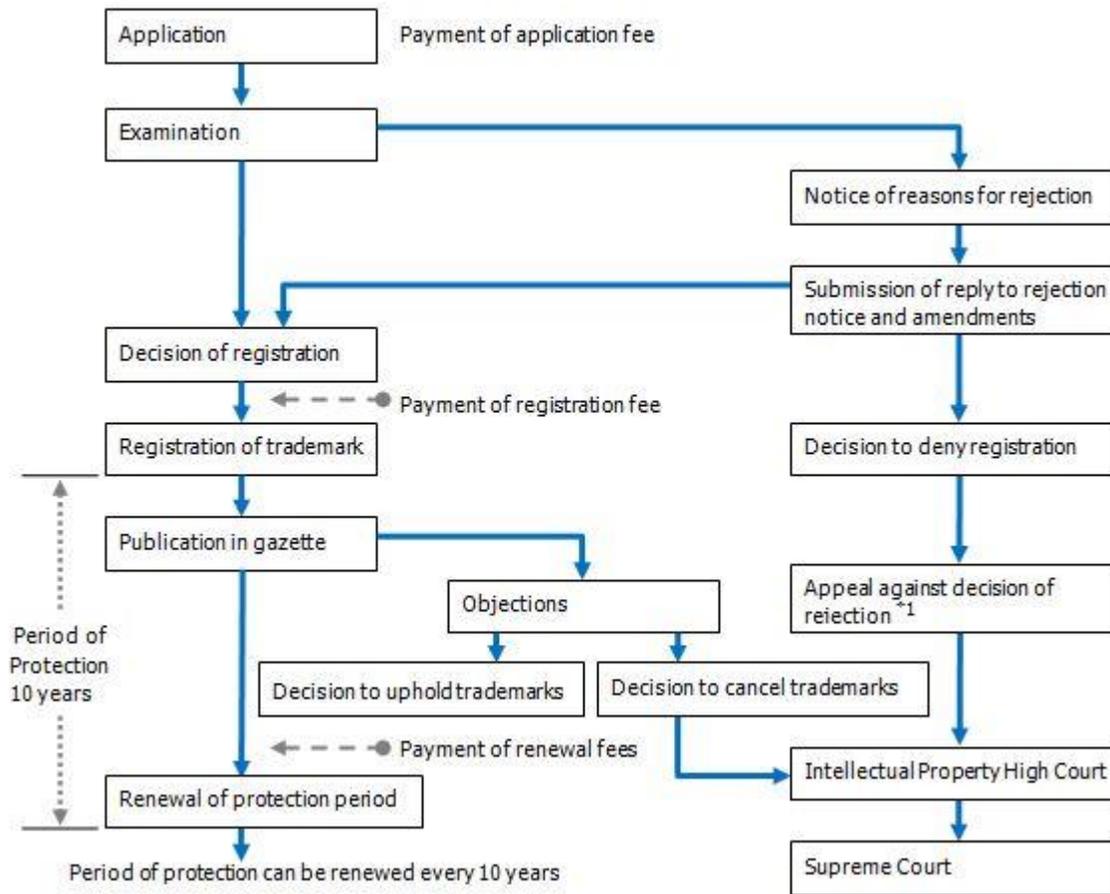


Figure 1: Registration Procedure in Japan (Source: JETRO Websites[6])

7. *Comparing the Position of India and South Africa*

On the basis of the discussion made above we can have made a comparison table which will depict the whole registration process in Japan and similarity/differences in its procedure with India. In the given Table 1 grace period means the period provided after the expiry of the duration to renew the trademark.

Table 2: Trademark Registration Comparison between India and Japan[7], [8]

S. NO.		JAPAN	INDIA
1.	Filing System	Multi-Class System	Multi-Class System
2.	Time Taken for Registration	12 Months	18 Months
3.	Duration of Protection	10 years from registration date	10 years from the filing date
4.	Type of Examination	Formal and Substantive Examination	Formal Examination
5.	Examination Time	07-08 Months	03 Months
6.	Opposition Period	02 Months	04 Months
7.	Renewal Application	Within 06 months before expiry	Within 06 months before expiry
8.	Grace Period	06 months	06 months
9.	Method of Conducting Search	Official Only	Official and Non-Official
10.	Usual Time Taken in Completing Search	04 Days	08 Days

8. *Defensive Trademark Registration*

For protecting well-known trademark, in Japan the Trademark Act provides the provision related to the Defensive Trademark Registration. The concept was based on the British Trademark System and was added in Japan in the year 1960 to strengthen the protection of the well-known trademarks. Before that trademark system provides remedies to the registered trademark. However, now under the Defensive Trademark Registration head the well-known unregistered trademark can be protected and awarded remedies in case of infringement.

9. *Enforcement of Rights*

The judicial enforcement of trademark right can be entertained before district court of Japan. There have also Special Division for Intellectual Properties in Tokyo and Osaka. These special divisions in district court are primarily for IP infringement cases including trademarks infringement cases. The appeal from JPO, Tokyo and Osaka district court can be exclusively entertained by High Courts. In Tokyo High Courts also there are four special Intellectual Properties Division. Further, the Supreme Court also entertained the appeal but for limited cause of action[9].

For the enforcement of the trademark rights the proprietor can either opt for civil action or criminal action against the infringer. The most prominent civil action are Injunction and Damage. The proprietor can also send the notice of cease and desist letter to the infringer. The criminal proceeding involves mandatory investigation. In quasi-judicial proceedings monitoring, accusation, confiscation and destroy of the object is the most prominent methods.

If we talk about the remedies, we can divide into two main categories:

9.1. *Preliminary Injunction:*

It is quick progress and is only subject to deposit of the cash or Bank Bond. It does not require any involvement of witnesses.

9.2. *Permanent Injunction:*

It is more complex than the preliminary injunction. It is given after hearing both the sides and is deemed to be final order of the court.

10. Cause of Action

For the cause of action against any infringer under the trademark law the following requisite are necessary. They are as follows:

- The mark should be registered under trademark law
- Defendant is using similar or identical mark
- Defendant is using such mark for the similar or identical goods or services as those of the plaintiff registered mark
- Such use of the identical and similar mark is without approval of the owner of the mark.

11. Defense Available in infringement cases

The most relevant and prominent defense available in infringement cases is that the mark is not identical or similar to the registered trademark. The other defense available is that the mark is used in such a way that it appeared as generic name and does not qualified as a trademark. The argument of the invalidity of the trademark was added after the amendment in the year 2005. In such a case, the proprietor of the trademark is not allowed to enforce his right against the infringer. It is to be noted that the nullity action or invalidation action can be filed by any interested party. However, generally after the time of 5 year has passed from the date of the registration no one can file the invalidation action[8].

In contrast to the general procedure the Japanese Supreme Court in the year 2017 in Eemax Case elucidate that defense of the in validity is not barred by the 5-year limitation and can be claimed even after the lapsed of the 5 year.

12. Recent Amendments

The recent amendments made in the year 2014 and 2006 includes- inclusion of the retailer and wholesaler under the preview of the service provider. Now the use of the mark also includes its export. Spaces for the unconventional trademark are also given under the trademark law system. Further, the criminality liability was also increased from 5 years of imprisonment to 10 years and from 5 Million Yen to 10 Million yen.

13. Similarity Test and Landmark Judgment

The similarity test of mark includes following criteria wiz:

- Appearance of the Mark
- Pronunciation and Concept of Mark
- Situation of trade in which trademark is being used.

13.1. Hyouzan Case:

In this case the two conflicting mark are “氷山” and “しょうざん” pronounced as Hiyouzan and Shiyouzan respectively. The first mark is of the applicant having Iceberg concept and is related to the Glass fiber thread goods whereas the second mark is cited mark having no concept is related to the goods concerning threads. The JPO in first instances rejected the trademark application on the grounds that the both the mark is phonetically similar to each other. However, THC giving more importance to the actual situation of trade reversed the JPO decision and said that both the mark is similar despite they are phonetically similar.

13.2. Choop Case:

In this case the similarity criteria of “actual situation of trade” is discussed. Here the both the mark is phonetically similar and JPO nullified the mark Shoop (Figure 2). However, IPHC revoked the decision of the JPO and held that both the mark is phonetically identical but both the mark are different in their actual situation of trade and thus there is no possibility of confusion at all.



Figure 2: Difference between Choop and Shoop

CONCLUSION

From the discussion made above it is clear that registration process in the Japan and India is somehow similar. This may be because we both follow the same international convention like Paris Convention, TRIPS Agreement and Madrid System for the Registration of the Trademark. Since the trademark law is territorial in nature there is minor difference in timeline has to be followed in both countries as evident from the Table 2. The Japan Patent Office is Japan's official portal for IP services. It includes the portal for online search of the trademark, patent, design etc.

REFERENCES

- [1] L. Hallenborg, M. Ceccagnoli, and M. Clendenin, "Chapter 3 Intellectual property protection in the global economy," *Advances in the Study of Entrepreneurship, Innovation, and Economic Growth*. 2008, doi: 10.1016/S1048-4736(07)00003-3.
- [2] M. Husovec, "Trademark Use Doctrine in the European Union and Japan," *SSRN Electron. J.*, 2016, doi: 10.2139/ssrn.2742035.
- [3] A. M. Rector, B. Sandefur, M. Ceccagnoli, M. Clendenin, and L. Hallenborg, "Introduction to legal means for protecting intellectual property," in *Advances in the Study of Entrepreneurship, Innovation, and Economic Growth*, 2016.
- [4] J. R. Boyarski, R. M. Fishman, J. D. Lawrence, J. Linn, and et al, "Japan allows trademarks in famous names," *Intellect. Prop. Technol. Law J.*, 2001.
- [5] J. Kakinuki, "Japan: Protection of Trademarks and Anticounterfeiting Law - Part II: Methods for Dealing with Counterfeiters," *East Asian Exec. Reports*, 1989.
- [6] Japan External Trade Organization(JETRO), "The Registration Process," [Online]. Available: <https://www.jetro.go.jp/usa/the-registration-process.html>.
- [7] S. R. Bhat, "Innovation and intellectual property rights law—an overview of the Indian law," *IIMB Manag. Rev.*, 2018, doi: 10.1016/j.iimb.2017.12.003.
- [8] S. Jelisavac, "International regulation of intellectual property rights," *Medjunarodni Probl. Probl.*, 2004, doi: 10.2298/medjp0403279j.
- [9] O. Suzuki, "Enforcement of Trademark Rights in Japan," *Yuasa & Hara.*