



SHIN-EI PATENT FIRM, P.C.

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YOUR PARTNER IN INTELLECTUAL PROPERTY LAW IN ASIA AND BEYOND

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Agenda

- **The number of trademark applications in Japan**
- **Average time of FOA**
- **Average ime of trial period**
- **Fast track examination**
- **AI Examiner?**
- **Refusal for non-distinctiveness**
- **Similarity of Trademarks**
- **Similarity of Goods and Services**
- **Amendment of Japanese Design Law (Trade Dress)**

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The number of trademark applications in Japan

- **Nowadays, the number of trademark applications including international trademark applications (Madrid route) is increasing in Japan.**

Year	2013	2014	2015	2016	2017
Applications	117,675	124,442	147,283	161,859	190,939

- **Even if the number of applications in the name of Ikuhiro Ueda and Best License company are deducted from the above number, the number of trademark applications are increasing in Japan.**

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Average time of FOA

- **In Japan, the average time for trademark examination is getting longer.**

Year	2013	2014	2015	2016	2017
Months	4.3	4.1	4.3	4.9	6.3

- **As of April 2019, we expect that the average time for trademark examination in 2019 will be longer than the average time in 2017.**
- **We estimate that it will take 8-9 months for examiners to terminate the examination.**

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Average time of trial period

- In Japan, the average time of trial period for trademark applications is getting shorter.

Year	2013	2014	2015
Months	7.1	7.2	6.0

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Fast track examination

- The “fast track examination” program of the Japan Patent Office has been available since October 1, 2018.
- If applicants designate Japanese standard description goods/services only, “fast track examination” will automatically be applied to such applications. However, “fast track examination” is not automatically applied for applications via Madrid route and applications for non-traditional trademarks.
- The examination term is expected to shorten approximately 2 months if “fast track examination” is applied.
- There are no additional official fees for “fast track examination.”

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AI Examiner ?

- **Japan Patent Office is now developing AI robots to support the examination for trademark applications.**
- **If development of AI robots is completed, the Japan Patent Office will try to make the AI search device marks and examine for clarity of goods/services.**

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Refusal for non-distinctiveness

- Japan Patent Office (JPO) has relaxed the criteria of refusals based on non-distinctiveness since April 2016. Especially, trademarks for catchphrases are less likely to be refused **at examination stage**.
- On the other hand, it has been argued that the scope of protection becomes narrow due to the relaxation. Therefore, the JPO amended the criteria of refusals based on non-distinctiveness (i.e. the criteria of judgement about whether applied marks are descriptive or suggestive) on January 2019. Before the amendment, only if JPO found the fact that the marks were broadly used in actual, JPO would refuse the applications. However, after the amendment, even if JPO couldn't find the fact that the marks were broadly used in actual, JPO can refuse the applications.

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Refusal for distinctiveness (Case study for catchphrase marks)

- The following trademarks have been registered without any refusals.

Trademark	Class	Applicant	Result
For the ocean, For life	3,5,29,30,31,32,35,36,39	Maruha Nichiro Corporation	Registered
Just for your best	7,9	JTEKT Corporation	Registered
Innovation for Culture	1,5	Nissan Chemical Corporation	Registered
EDUCATION FOR LIFE	36	Internationale des Coiffeurs de Dames I.C.D. Intercoiffure-Interbeauté-Mondial	Registered
エコロジーフォーライフ ECOLOGY FOR LIFE	16	Corelex Shinei Kabushiki Kaisha	Registered

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Similarity of Trademarks

- Since a few years before, the number of citation refusals has tended to be decreasing in Japan. The most of cited trademarks were identical or almost identical trademark.
- The criteria of the citation refusal may become slightly stricter in the near future because some companies claim that it should be slightly stricter.
- However, at present, it seems that the possibility of citation refusals is relative lower in Japan than in other countries.

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Similarity of Trademarks

- For example, JPO allowed the following trademarks to coexist (goods and services are similar).

Senior Application	Class	Junior Application	Class
EPOCH エポック	16	EPOCH—ONE	16,35
iCareRing	9,42	CareRings	9,35,38,42
i Renaissance	9,42	RENAISSANCE ルネサンス	9
COSMO	7	CosmoAce	7
モア MORE	3	Bi—more	3



Case study for Similarity of Trademarks

- **With respect to the similarity judgement, JPO tends to weigh pronunciations more than appearances and concepts. Therefore, if you wish to register trademarks whose pronunciation is the same as the pronunciation of prior trademarks, it is difficult to register such trademarks.**
- **However, some trademarks have been registered even when they have a pronunciation that is the same as those of prior marks.**

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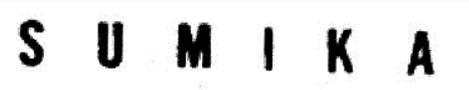


Case study for Similarity of Trademarks -Dissimilar cases- (Same pronunciations)

Applications	Cited trademarks
<p>LUCA</p> <p>Class 35</p>	<p>RUCA</p> <p>Class 25</p>
<p>Qross</p> <p>Class 12</p>	<p>CROSS</p> <p>Class 12</p>
<p>快音くん</p> <p>*The pronunciation is KA-I-ON-KUN. *快 means “comfort”, 音 means “sound” and くん is a post-nominal title.</p> <p>* Class 10</p>	<p>快温くん</p> <p>*The pronunciation is KA-I-ON-KUN. *快 means “comfort”, 温 means “temperature” and くん is a post-nominal title.</p> <p>Class 10</p>



Case study for Similarity of Trademarks -Similar cases- (Same pronunciations)

Applications	Cited trademarks
<p>コータック</p> <p>(“コータック” is pronounced as “KO-TA-KU” in Japanese.)</p> <p>Class 1</p>	 <p>Class 1</p>
 <p>(“炭家” is pronounced as “SU-MI-KA” in Japanese.)</p> <p>Class 36</p>	 <p>Class 36</p>

****Goods and services are similar***

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Similarity of Trademarks (Summary)

- **JPO tends to raise citation refusals if the JPO finds prior marks that have a pronunciation that is same as the pronunciation of the applied trademarks.**
- **In generally, it is relative hard to get registrations for trademarks whose pronunciation is same as the pronunciation of prior marks.**
- **However, especially, if the applied trademarks are dissimilar conceptually to the concept of the prior marks, there may be chance to overcome citation refusals.**

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Similarity of Goods and Services

- **With respect to the similarity judgement for Goods and Services, the JPO has adopted the goods/services similarity code system (subclass system).**
- **In other words, if the goods/services are in the same subclass, Examiners judge that the goods/services are similar.**
- **At the examination stage, in general, many arguments about the dissimilarity of goods which fall under the same similarity code are unlikely to be persuasive. However, while unlikely, some arguments can be persuasive at the appeal stage.**

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Case study for Similarity of Goods and Services

Goods and Services (subclass)	Goods and Services (subclass)	Result
Class 32 vegetable juices [beverages] (32F04)	Class 30 almond paste (32F04)	Dissimilar
Class 28 pinball machine (24B02)	Class 24 billiard cloth (24B02)	Dissimilar
Class 9 home video games (24A01)	Class 20 cradles (24A01)	Dissimilar
Class 10 gloves for medical purposes (17A04)	Class 25 gloves as clothing (17A04)	Dissimilar
Class 10 electrodes for physiotherapy (10D01)	Class 5 bracelets for medical purposes (10D01)	Dissimilar
Class 10 catheters (10D01)	Class 5 bracelets for medical purposes (10D01)	Similar
Class 21 Wearable containers with tube and suction port (19A04)	Class 21 water bottles (19A04)	Dissimilar

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Similarity of Goods and Services (Summary)

- **JPO tends to judge goods and services as being similar if the goods/services are in the same subclass.**
- **At examination stage, it is hard to overcome the refusal if the goods/services are in the same subclass.**
- **However, if selling areas, class of consumers, and so on are different, or the goods are pretty unique, there may be chance of overcoming the refusal (especially at the appeal stage).**

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Amendment of Japanese Design Law (Trade Dress)

- The Japanese Design Law will be amended. The amended Design Law will allow registration of an external appearance and an interior design.
- For example, the following interior design will be registered under the Amended Japanese Design Law.



- On the other hand, “trade dress” still can’t be registered under the Japanese Trademark Law.

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