

Newsletter / IP Japan**Outline of Non-traditional Trademark Application in Japan**

The revised Japanese Trademark Act to take effect in April

Japan Industrial Property Law was revised in 2014. It is scheduled to come into force from April 1, 2015. This is one of the largest revisions for the Japanese Trademark Act for the first time in years.

The current Japanese Trademark Act stipulates that a protectable trademark should be “any character, figure, sign or three-dimensional shape, or any combination thereof, or any combination thereof with colors” (Article 2). That is, only flat and three-dimensional marks (Traditional trademarks), which are visible, have been protected.

The new act will revise the definition of “Trademark”: It will accept “Color”, “Position”, “Sounds”, “Holograms” and “Movement” (Non-traditional trademarks) as registrable trademarks.

According to the transitional measure of the revised act, even after someone obtains the non-traditional marks which conflict with a person’s marks having been used since before April 1, 2015, the person has right to use his/her marks under the following conditions;

- The person has continuously used the mark before the date of enforcement.
- The trademarks are not used for unfair purposes.
- Using the mark within the geographical range that the person uses the mark at the time of enforcement.
- When the mark is well known among consumers at the time of enforcement, person is able to use the mark outside of the said geographical range.

In the face of the revised act taking effect, we would like to survey the requirements for filing the application for these non-traditional trademarks. Since the Japan Patent Office released the examination guideline for the revised act, we introduce the outline for you.

1. Color marks

(1) What is color mark?

“Color mark” in this context is the mark which consists of color(s) only. The revised trademark act aims to protect color without outlines as a trademark.

(2) Detailed description of the mark

The applicant has to claim that the mark is color and refer to detailed description of the mark. “Detailed description of the mark” is a unique particular in the applications for non-traditional trademarks. Since samples of trademarks may not be enough to determine the trademarks, the revised act requires applicants to explain details of the non-traditional marks.

ex. 1)

【Trademark applied for registration】



【Trademark which consists of color only】

【Detailed description of the mark】

The trademark applied for registration consists of color only. It consists of the red color (RGB color code :R255, G0, B0)

A combination of colors is registrable as a trademark.

ex. 2)

【Trademark applied for registration】



【Trademark which consists of color only】

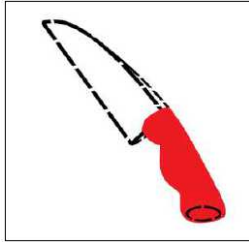
【Detailed description of the mark】

The Trademark applied for registration (Herein after “The trademark”) consists of combination of colors. The color combination is red (RGB color code:R255, G0, B0), Blue (RGB color code :R0, G0, B255), Yellow (RGB color code :R0, G255, B0) and Green (RGB color code :R255, G128, B0). The balance of colors is as follows: 50 percent of Red, 25 percent of Blue, 15 percent of Yellow and 10 percent of Green from the top.

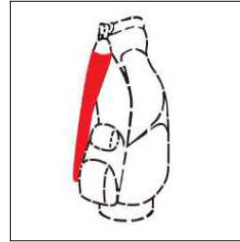
The guideline shows the example that the colors are defined by RGB Color Chart. The way to define the color does not seem to be limited by RGB Color Chart. However, the applicant should identify the color with numbers of color charts or systems which are commonly used in the market.

If the color mark is characterized in the position of the item, the applicant specifies the color mark by identifying that the color is settled in a certain position of the item.

ex. 3) Class 8 “Knives”



ex. 4) Class 28 “Bags for golf clubs”



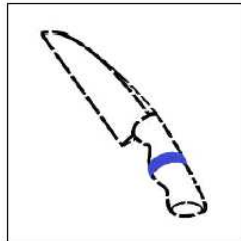
The applicant needs to explain “The part which is depicted with dash lines only shows an example of the figure of the commodity. The part does not consist of trademark”.

2. Position marks

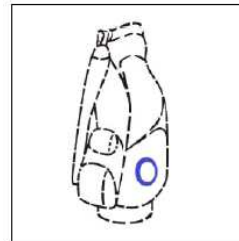
(1) What is position mark?

Position mark is letters, graphics and/or their combination, which position attached on the item is specified.

ex. 1) Class 8 “Knives”



ex. 2) Class 28 “Bags for golf clubs”

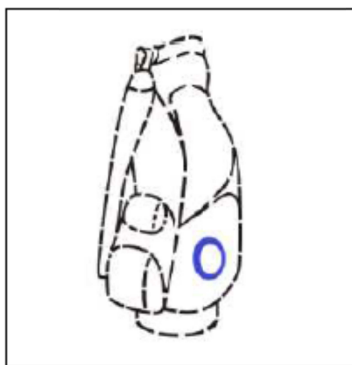


(2) Detailed description of the mark

The applicant needs to explain what the specimen shows. Since the designs and figures of the commodities are usually not the same, the applicant shows the outline of the goods with dashed lines in order not to fix the outline. Meanwhile, the part which is depicted with lines shows the rough position of the mark on the goods.

ex. 3)

【Trademark applied for registration】



【Trademark which consists of color only】

【Detailed description of the mark】

This trademark is a position mark which consists of a figure attached on the lower side of the “Bags for golf clubs”. The part which is depicted with dash lines is only an example of the item. This part does not compose the trademark”.

【Class, goods and services】

【Class 28】

【Goods (Services)】 Bags for golf clubs

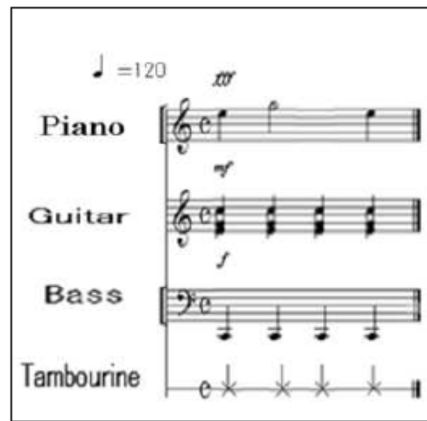
3. Sound marks

The present trademark act defines the trademark must be visible. Thus, it has been impossible to protect sounds by the Japan Trademark Act. The revised act aims to protect not only linguistic elements of the sound but also sounds without linguistic elements.

(1) How to specify sound marks?

The applicant must specify the sound with (1) staff notations including musical notes, treble clef, bass clef or alto clef, tempo, signature and linguistic element (if any), (2) echoic words and mimetic words and their combination.

ex. 1) Staff notations



The applicant can use a single notation only if they are shown in full scores.

The applicant can specify the sound marks with echoic words

ex. 2) The sound of clapping hands: “Pam-pam”

The sound of cat meowing: “Meow”

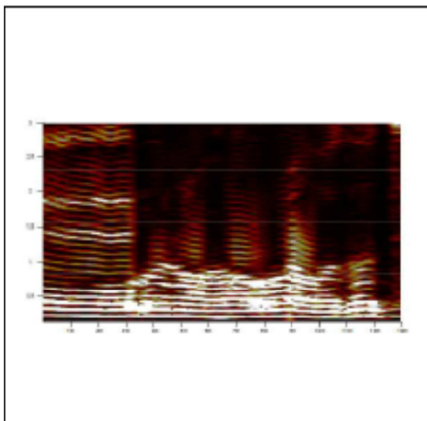
The moaning sound of winds: “Gou-gou”

“This trademark is three seconds long: after the sound “pam-pam” from clapping hands arises, “meow” sound of cat comes.

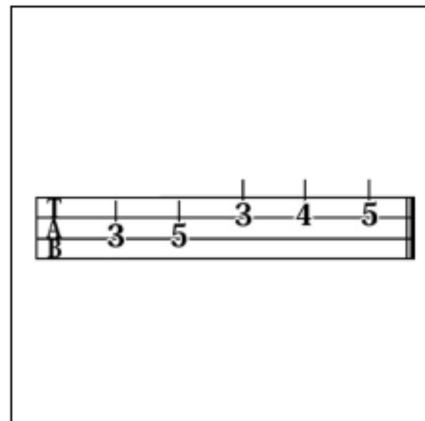
Therefore, the sound which is specified with sonograms, tablature, title of the songs, and so on, would not be accepted as trademark.

The specimens below would not be accepted.

Sonograms



Tablature



(2) Detailed description of the mark

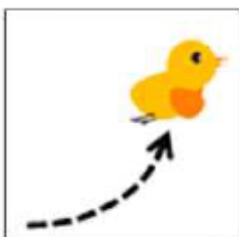
The applicant can file the sound mark in the form of sound data MP3. It should be recorded in CD-ROM or DVD-ROM and submitted to the Japan Patent Office.

4. Movement marks

The applicant has to describe the movement of the mark with the passage of time. For example, as you see at the example 1, the applicant shows the movement with a dashed arrowed line. (This specimen shows that the bird figure would move without changing.)

ex.1)

【Trademark applied for registration】



【Movement trademark】

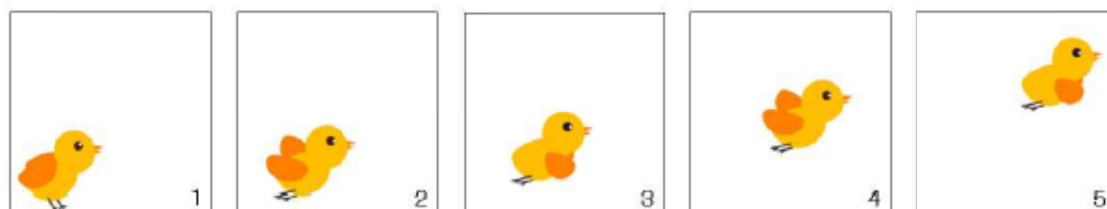
【Detailed description of the mark】

The trademark is movement trademark. It shows a bird moves following the dotted line from bottom left to right top. This movement is 3 second long. The dotted line does not compose the trademark. It just shows trajectory of the moving bird.

The applicants can submit several pictures showing frames of the movement.

ex.2)

【Trademark applied for registration】



【Movement trademark】

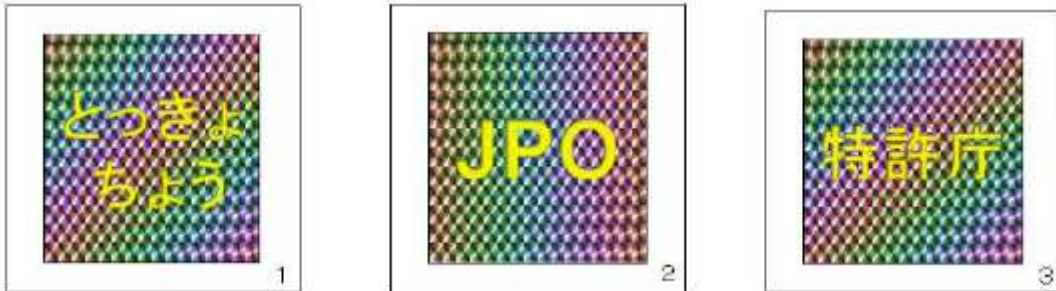
【Detailed description of the mark】

The trademark is movement trademark. The five frames from No.1 to No.5 show a moving bird flapping its wings from bottom left to right top. This movement is 3 second long. The numbers shown at the bottom of the right corner just show the order of frames. They do not compose the elements of the trademark.

5. Hologram marks

The applicant is required to submit one or more pictures which specify to-and-fro variation of the mark which changes through holographic effects or other visible effects.

【Trademark applied for registration】



【Hologram trademark】

【Detailed description of the mark】

The trademark is a hologram trademark views which show different visual surfaces according to the angles. The picture No.1 shows the visual surface which is seen from the left. The picture No.2 shows the visual surface which is seen from the front. The picture No.3 shows the visual surface which is seen from the right. The numbers shown at the bottom right corner just show the order of views. They do not compose the elements of the trademark.

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