

## **Color and Sound Marks Soon Protectable in Japan**

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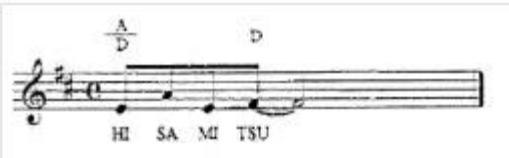
After much debate over several years, the Trademark Act of Japan (Act No. 127 of April 13, 1959) has been amended to finally allow registration of nontraditional marks such as color and sound. Although nontraditional marks such as color, sound, motion, hologram, and position marks are not registrable under the current Trademark Act, such marks have been registrable in other nations, including the United States, the EU (through the Office for Harmonization in the Internal Market), and Australia, as well as in some Asian nations, such as South Korea, China, Taiwan, and Singapore. As further explained below, not all nontraditional marks will be protected at this time. This amendment will enable brand owners to convey their brand messages in more diverse ways and seek the same protection in Japan as they have been afforded in other jurisdictions regarding these nontraditional marks. Moreover, brand owners will be able to use the Madrid Protocol system to protect their nontraditional trademarks in multiple jurisdictions, including Japan.

The Act for Partial Amendment to Patent Act, Etc. (Act No. 36 of May 14, 2014) ("Amending Act"),<sup>[1]</sup> which was enacted on April 25, 2014 and promulgated on May 14, 2014, will come into effect from the date specified by a Cabinet Order, within a period not exceeding one year from the date of promulgation of the Amending Act. The Cabinet Order has not yet been published, but it is expected that the amending Act will come into effect on April 1, 2015.

### **Expansion of Registrable Trademarks**

Under the current Trademark Act of Japan, the subject of trademark protection is any character(s), figure(s), sign(s), or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors (Article 2, Paragraph 1 of the current Trademark Act). As this definition shows, among so-called nontraditional marks, only a three-dimensional mark is protected, but color(s) can be protected only in combination with figure(s), etc. Motion, hologram, and position marks are not expressly excluded from the definition of trademark under the current Trademark Act, but these marks are not currently registrable because methods and forms of applications for these marks (e.g., how to represent the mark in an application form) have not been established. However, the need for protection of nontraditional trademarks such as color per se marks, sound marks, and motion marks has been increasing. Many nontraditional marks of famous brand owners such as Apple, Intel, etc. have already been registered and protected in other jurisdictions. More and more Japanese companies in fact have sought protection of such marks in other jurisdictions. For instance, the tricolor mark of Tombow erasers as well as the sound mark of Hisamitsu Pharmaceutical (a musical tune that corresponds to the words Hi Sa Mi Tsu), are both registered in the United States and EU.

## Actual Examples of Japanese Companies' Marks

<p>Tombow Pencil Co., Ltd.</p>  <p>Description of Mark: The color(s) blue, white and black is/are claimed as a feature of the mark. The mark consists of three horizontal blue, white and black stripes, with blue on top, white in the center and black on the bottom and the entire mark is outlined with a thin black line.</p> <p>US Registration Number: 3252941</p>	<p>Hisamitsu Pharmaceutical Co., Inc.</p> <p>HI SA MI TSU</p>  <p>The mark is a sound mark and corresponds to the words HI SA MI TSU, sung to the musical notes shown in the representation.</p> <p>CTM Registration Number: 2529618</p>
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Under the post-amendment Trademark Act ("Amended Trademark Act"), "any character(s), figure(s), sign(s), three-dimensional shape(s) *or color*, or any combination thereof, *sound(s), or other(s) specified by a Cabinet Order, as is recognizable with human perception*" will be the subject of trademark protection (Article 2, Paragraph 1) (emphasis added). As this new definition shows, color per se marks and sound marks are now expressly registrable marks. In light of the report by the Intellectual Property Committee of Industrial Structure Council of September 2013,[2] motion marks, hologram marks, and position marks will also be protected as new trademarks. As explained above, these marks are already covered by the definition of "trademark," and they will become registrable by establishing the methods for application through Ordinance of the Ministry, Economy, Trade and Industry ("METI") and the examination guidelines.

Although scent/smell, touch, and taste marks will not be protected as trademarks at this time, the Amended Trademark Act provides the flexibility to add a new type of trademark through a Cabinet Order, to accommodate any increased need for protection of such other marks and changing business circumstances in the future.

### Review of the Definition of Use

The Amended Trademark Act revises the definition of "use" of a trademark with respect to a sound mark. Under the Amended Trademark Act, use of a sound mark occurs when a sound mark is recorded to a recording medium that is affixed to goods, articles to be used for providing services, or advertisement relating to goods or services, including when such an item is a recording medium itself (Article 2, Paragraph 4, Item 2 and Article 2, Paragraph 3, Item 1). Additionally, an act to emit a sound mark for the purpose of assignment or delivery of goods or providing services is use of a sound mark (Article 2, Paragraph 3, Item 9). Furthermore, to accommodate the future possible addition of other types of marks, acts specified by a Cabinet Order may be added to the use of a mark under Article 2, Paragraph 3, Item 10 of the Amended Trademark Act.

### Filing for New Types of Trademarks

**Statement of Type of Mark.** In the current Trademark Act, when a person desires to register a three-dimensional trademark or a standard character trademark, the application shall contain a statement so indicating. Similarly, under the Amended Trademark Act, for purposes of adequately determining

the nature and scope of the protection sought, the application for registration of the following trademarks must contain a statement indicating: (i) a trademark whose character(s), figure(s), sign(s), three-dimensional shape(s), or color(s) changes and consisting of the character(s), figure(s), sign(s), three-dimensional shape(s), or color(s), or any combination thereof, before and after such changes (Article 5, Paragraph 2, Item 1) (i.e., a motion mark and a hologram mark); (ii) a color per se trademark (Article 5, Paragraph 2, Item 3); (iii) a sound trademark (Article 5, Paragraph 2, Item 4); and (iv) other trademarks specified by the METI Ordinance (Article 5, Paragraph 2, Item 5). A position mark is planned to be specified by the METI Ordinance pursuant to Article 5, Paragraph 2, Item 5.

**Representation of Trademarks (Trademark Sample).** How new marks should be represented in an application will be provided in the examination guidelines, to be amended in line with the Amended Trademark Act. The Japan Patent Office is currently working on amending the guidelines.

**Detailed Description and Object.** For new types of trademarks, as is required in other jurisdictions, a detailed description of the mark for which registration is sought is required to determine the scope of the mark's protection (Article 5, Paragraph 4). More details about the requirements for such descriptions will be provided in the METI Ordinance and the examination guidelines. In addition, with regard to a sound mark, submission of an object (e.g., an audio file on which the sound was recorded) will be required, which will also be provided for in the METI Ordinance. To determine the scope of a registered trademark, such detailed description and an object will be taken into consideration to interpret the meaning of the trademark represented in the application (Article 27, Paragraphs 3 and 1).

## Others

**Absolute Requirements (Distinctiveness).** As with conventional trademarks, registration of new types of trademarks shall be rejected unless the mark is inherently distinctive or has acquired distinctiveness. It is expected that a color mark will be likely found distinctive only based upon acquired distinctiveness, but even proof of such acquired distinctiveness will be a very difficult task, especially for a single color mark. In addition, new types of marks that are merely functional cannot be registrable regardless of acquired distinctiveness. On this point, the Amended Trademark Act provides that "a trademark consisting only of characteristics naturally possessed by goods, etc., as specified by a Cabinet Order," cannot be registered (Article 4, Paragraph 1, Item 18). For instance, the sound of bowling pins being knocked down (the designated service is providing bowling alleys for the customer's use) is considered functional (natural characteristics, in the language of the Amended Trademark Act) and will not be registrable regardless of proof of acquired distinctiveness under the above provision.

**Conflict with Neighboring Rights.** In Japan, under the Copyright Act (Act No. 48 of May 6, 1970), the rights of performers, producers of phonograms, broadcasting organizations, and wire-broadcasting organizations ("Neighboring Right(s)") are uniquely protected. Therefore, for example, if a person registers a sound recorded on a CD as a trademark and uploads it to his/her homepage, it may conflict with the phonogram producer's right to make his/her phonogram transmittable.[3] When the use of a registered trademark in a particular manner with respect to its designated goods or designated services conflicts with another person's Neighboring Right arising before the filing date of the trademark registration application, the holder of the trademark right, etc. may not use the trademark in the same manner with respect to the conflicting part (Article 29). The Neighboring Rights will be added to the current provision for adjusting the conflicts with another person's patent and copyright, etc.

## **Transitional Measures**

**Right of Continuing Use.** A person who has been using a new trademark, excluding a motion trademark, prior to this amendment without an unfair competition purpose may continuously use the mark, even if the mark conflicts with a mark to be registered by another person, but only within the scope that the person actually uses the mark for goods or services concerned and the scope of business for which the mark is used at the time when the Amending Act takes effect (Article 5, Paragraph 3 of the Amending Supplementary Provisions of the Amending Act). If the mark already in use has become a well-recognized source identifier of such person at the time when the Amending Act takes effect, the person has the right to use the mark for the goods or services concerned (Article 5, Paragraph 5 of the Amending Supplementary Provisions of the Amending Act).

**No Special Provisions of Filing Date.** As Japan uses a first-to-file system for trademark registrations, when service marks were newly introduced in 1992, a transitional measure was taken under which two or more trademark applications within a certain period following the effective date were deemed to be applications filed on the same date. With this transitional measure, service mark applicants did not need to rush to file applications to secure their interests. However, such a transitional measure is not provided for in this amendment because not so many new types of trademarks are expected to be filed when the Amending Act takes effect.

## **Conclusion**

As explained above, we still need to wait for publication of the Cabinet Order, METI Ordinance, and examination guidelines for further details on the requirements for describing such new marks in an application document and any other object that may be required with such application, as well as how applications for such new marks will be examined (e.g., how to judge similarity and distinctiveness). While it is not yet clear when these detailed rules will be published, brand owners who are interested in protecting their new marks such as sound or color marks need to continue monitoring developments and commence preparation. Further, as there is no transitional measure to modify the first-to-file system as explained above, if a company has already used such new types of marks and wishes to seek registration, an application should be filed as soon as possible. In particular, given the difficulties in establishing the acquired distinctiveness of color per se marks, a brand owner who is interested in registering a color per se mark should collect sufficient evidence for proof of acquired distinctiveness.

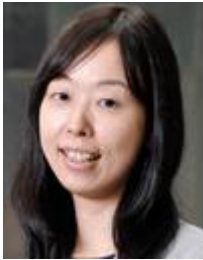
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[1] The Amending Act includes revisions to the other industrial property laws, such as the Patent Act and the Design Act, and also includes revisions to the Trademark Act in other respects. Among these revisited points, this *Commentary* focuses on the introduction of new nontraditional trademarks in Japan.

[2] Intellectual Property Committee of Industrial Structure Council, *Regarding Ideal Trademark System for Protection, Etc. of New Types of Trademarks* (September 2013) at [http://www.jpo.go.jp/shiryoutoushin/toushintou/pdf/shohyo\\_bukai\\_houkoku1/houkoku.pdf](http://www.jpo.go.jp/shiryoutoushin/toushintou/pdf/shohyo_bukai_houkoku1/houkoku.pdf) (available only in Japanese).

[3] Trademark System Subcommittee of Industrial Property Policy Section of Industrial Structure Council, *Reference Material 1, Regarding Restriction on Effects of New Types of Trademarks and Other Issues* (September 2012) at [https://www.jpo.go.jp/shiryoutoushin/shingikai/pdf/t\\_mark29/shiryoutoushin1.pdf](https://www.jpo.go.jp/shiryoutoushin/shingikai/pdf/t_mark29/shiryoutoushin1.pdf) (available only in Japanese).