



**International
Trademark
Association**

Alan C. Drewsen
Executive Director

655 Third Avenue, 10th Floor, New York, NY 10017-5646, USA

t: +1-212-642-1700 | f: +1-212-768-7796

inta.org | info@inta.org

January 11, 2013

Kazufumi Dohi
Chair, Trademark System Subcommittee of the Industrial Structure Council
Legislative Affairs Office
Japan Patent Office
3-4-3 Kasumigaseki, Chiyoda-ku Tokyo 100-8915, Japan

Dear Chairman Dohi:

The International Trademark Association (INTA) is pleased to submit the following comments on the Industrial Structure Council Trademark System Subcommittee Report on the Current State of the Trademark System in Japan.

INTA is a not-for-profit membership association of more than 6,000 trademark owners and professional firms from more than 190 countries. The association was founded in 1878 and is dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. INTA members share common interests in the protection of trademarks and the development of trademark law, and they rely on INTA to represent and advocate for those interests with national governments and international organizations. INTA's diverse membership includes multinational corporations and other business enterprises of all sizes, intellectual property and general practice law firms, trademark agent firms, service firms, trademark consultants, and academic institutions. INTA currently has 102 member firms in Japan. Further information about our association can be found at www.inta.org.

Section 1 – Non-Traditional Marks

INTA supports the recommendations that provide for the registrability of motion, hologram, color, position and sound marks. This will bring trademark practice in Japan in line with that of other advanced economies.

However, INTA strongly encourages expanding the list of registrable marks to also include scent, touch and taste marks as well as trade dress. It is our suggestion that the trademark law accommodates these and future types of non-traditional marks by indicating that the list of registrable marks is non-exhaustive.

Regarding the requirements for filing non-traditional marks, the law should allow for an electronically filed representation for all types of registrable non-traditional marks. For the filing of sound marks, digital recordings and/or written descriptions should be accepted.

New York | Shanghai | Brussels | Washington, D.C.

PowerfulNetworkPowerfulBrands™

Furthermore, INTA does not support the suggestion that all non-traditional marks should be presumed to be inherently non-distinctive. This determination should be taken on a case-by-case basis.

Section 3.2 – Loss of Distinctiveness

The report notes that the Japanese Trademark Law does not provide a system for revocation of a mark that becomes generic after registration through losing its distinctiveness. The report does not give any specific recommendations, but suggests that research of other countries' systems be undertaken.

INTA urges Japan to include loss of distinctiveness after registration as a valid ground for revocation. It encourages Japan to recognize the general obligation to protect the integrity of its trademark register by eliminating from it any trademark registrations that do not meet the appropriate standards. Since marks that have become generic terms no longer possess the distinctiveness required for registration, it should be provided that these registrations are subject to removal from the registry by revocation.

Section 3.3 – Well-Known Marks

INTA does not take a position on whether maintenance of the Defensive Mark Registration System as a tool for protecting well-known trademarks is justified. However, failure to register a well-known mark should not preclude an owner of an unregistered well-known mark from seeking and receiving protection. Any registry for well-known marks should follow certain established procedures as explained in INTA's Board resolution on the issue (see <http://www.inta.org/Advocacy/Pages/Well-KnownMarkRegistries.aspx>).

INTA supports the expansion of the scope of protection for famous registered trademarks, i.e. marks that are widely known by the general public, to include dilution. Such protection should extend to non-similar goods, where the source could possibly be confused as well as those that would dilute the famous mark.

Furthermore, INTA endorses likelihood of dilution as the appropriate standard for establishing a dilution claim rather than showing that measurable dilutive harm has occurred, *i.e.*, that the mark has been measurably impaired. The fundamental objective of dilution protection for famous marks is to prevent dilution at its incipiency, before measurable damage to the mark has occurred. Otherwise, by the time measurable, provable damage to the mark has occurred, much time has passed, the damage has been done, and the remedy, which is injunctive relief, is far less effective.

Section 3.4 – Opposition System

INTA supports the report's suggestion to keep the Opposition System and Invalidation Trial System separate. As the report notes, "There is currently no special need to consolidate the Registration Opposition System and Invalidation Trial System, and if no conspicuous problems can be seen in their coexistence, it is appropriate to maintain the current systems."

Chairman Dohi
January 11, 2013
Page | 3

These comments were prepared with the assistance of INTA's Legislation and Regulation Committee, Famous and Well-Known Marks Committee, Non-traditional Marks Committee, Enforcement Committee and Related Rights Committee, as well as members of INTA's policy staff.

If you have any questions about the above comments or INTA, please contact Mr. Seth Hays, External Relations Manager for Asia-Pacific at shays@inta.org.

Sincerely,

A handwritten signature in cursive script, appearing to read "Alan C. Dreier".