



International Trademark Association

655 Third Avenue, 10th Floor, New York, NY 10017-5617 USA

+1-212-768-9887 • f: +1-212-768-7796 • www.inta.org • info@inta.org

24 March 2009

Attn: Comments for the Trademark - WG
Legislative Affairs Office
Japan Patent Office
3-4-3 Kasumigaseki, Chiyoda-ku, Tokyo
Japan

Dear Sirs:

The International Trademark Association (INTA) is grateful for the opportunity to submit its comments with respect to the issues raised in the Japan Patent Office's (JPO) New Types of Marks Working Group's (WG) draft recommendations on Non-Traditional Marks (NTMs).

INTA is a not-for-profit membership association of more than 5,800 corporations, law firms and other trademark-related businesses from more than 190 countries throughout the world. INTA is headquartered in New York with offices in Brussels and Shanghai. Its membership crosses all industry lines, including manufacturers and retailers, and is united in the goal of supporting the essential role trademarks play in promoting effective national and international commerce, protecting the interest of consumers, and encouraging free and fair competition.

INTA congratulates the JPO's WG on its initiative to review its current trademark law and practice with a view to modernize and harmonize Japan's trademark system with other advanced systems around the globe with regards to non-traditional marks. We are particularly pleased that the WG recommends adding motion and holograms, color(s) only, position and sound NTMs to the scope of registrable trademarks in Japan. This will be a tremendous benefit to trademark owners competing in the Japanese and world marketplaces. However, we respectfully question the WG's recommendation not to include the registration of smell, touch, taste marks and trade dress. INTA's Non-traditional Marks and Legislation & Regulation Committees analysed the WG's proposals based on INTA's Model Law Guidelines and Model Examination Guidelines, the specific relevant sections of which are enclosed. We therefore request that the JPO take into consideration the following comments.

In this highly competitive global market, trademark owners are constantly looking for new and innovative ways to distinguish their brands from others through creation of new types of marks. This constant evolution of marks has resulted in many countries revising their trademark statutes so that they provide as broad a scope of protection as possible so that the law does not become quickly obsolete and require constant updating. The definition of what may be registrable is thus left to rules promulgated by the Trademark Office, which can be more readily updated as needed. To assist governments in drafting their laws in this manner, INTA's Model Law Guidelines recommends that:

a mark should be registrable...if it is (a) visually perceptible or (b) capable of being depicted or described by written notation, diagram or other visual means. This includes alphanumeric marks, color marks, marks for packaging and for the form or configuration of a product, and marks which are three-

dimensional. It also includes sound, smell, taste, or touch marks where these satisfy the above criteria.

We note that the WG report cites relatively low interest (20%) from Japanese businesses in filing applications for smell, taste, touch marks and trade dress as a reason not to include these marks in an expanded definition of a trademark. However, INTA believes that any interest in filing these types of marks presents the JPO with a valuable opportunity to expand the Japanese Trademark Act to broadly protect all types of trademarks that are becoming increasingly filed and protected in various regions around the world.

The WG also expressed concern about the ability to: 1) properly represent a mark within a registry; and 2) properly examine applications for these non-traditional marks. As stated above, INTA's Model Examination Guidelines were developed to assist offices like the JPO in addressing these exact concerns. Specifically, these examination guidelines provide detailed advice for representing several types of non-traditional marks in applications for registration, including:

Taste (Flavor) marks: Representation should consist of a written description that conveys the identity of the flavor clearly and unambiguously and permits its differentiation from other flavors. Additional representations might include submitting a sample of the flavor or a chemical formula of the compound that creates the flavor. However, these should not substitute for the written description, as the flavor sample may dissipate and the chemical formula may not be readily understood by the general public.

Touch (Texture) marks: Representation should consist of a written description that conveys the identity of the touch characteristic clearly and unambiguously and permits its differentiation from other touch characteristics. Additionally, the representation should be "clear, precise, self-contained, easily accessible, intelligible, durable and objective." European Court of Justice C-273/00; Sieckmann, 2002.

Smell (Olfactory) Marks: Representation should consist of a written description that conveys the identity of the scent clearly and unambiguously and permits its differentiation from other scents. Additional representations might include submitting a sample of the scent (scratch and sniff) or a chemical formula of the compound that creates the scent. However, these should not substitute for the written description, as the scent sample may dissipate and the chemical formula may not be readily understood by the general public.

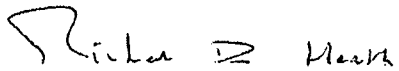
Although INTA's guidelines do not mention trade dress as a particular non-traditional mark, several advanced trademark jurisdictions, including the United States of America, Singapore, and Hong Kong, allow for trade dress registration, and some have detailed instructions for examination in their trademark examination practice manuals. INTA, through amicus briefs on trade dress cases, has strongly supported the idea that trade dress, which is broader than just protection for 3-D marks, should be registrable if adequately described in an application and therefore protected.

Finally, while INTA understands that the JPO has expressed concern in the past about the technological limitations and challenges that registering new types of trademarks can present to an IP office, please note that the United States Patent and Trademark Office (USPTO) and the European Union's Office for Harmonization in the Internal Market (OHIM) have

managed to create dynamic and technologically advanced systems to register and store information for trademarks. Through the trilateral discussions the JPO has with the USPTO and OHIM, we believe that the JPO would have an excellent opportunity to exchange information on the latest techniques for updating registration and storage systems.

INTA would be happy to answer any resulting questions you may have on these comments. Should you require further information, please contact Mr. Mark Neighbors, INTA's External Relations Manager for the Asia-Pacific Region, at mneighbors@inta.org.

Sincerely,

A handwritten signature in cursive script that reads "Richard Heath".

Richard Heath
INTA President 2009

Enclosures: INTA Model Law Guidelines, Examination Guidelines