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## **The Global Fight against Trademark Trolls: Using Japan's Trademark Protection System to Prevent Bad Faith Applications for Famous Abbreviations Arising from Famous Trademarks**

Shinji SUMIDA\*

Japanese trademark practice has increasingly protected famous trademarks beyond the mandates of the Paris Convention. This article explains the scope of Articles 4(1)(vii), (x), (xv), and (xix) of the Trademark Act in Japan and provides recommendations as to how owners of famous trademarks might prevent bad faith applications for famous abbreviations arising from famous trademarks. This article is intended to provide information to potential collaborators interested in working with us to prevent bad faith trademark applications throughout the world, especially in Asia.

### **I. Introduction**

Most trademark practitioners have experienced difficulties with trademark trolls. Owners of famous marks are concerned with means of preventing the registration of trademarks that are

identical or similar to their own famous trademark. As trademark examination procedures continue to develop in various countries, the possibility of rejecting trademark applications that are similar to famous marks might gradually increase. Trademark trolls' techniques, however, will also likely improve. Accordingly, holders of famous trademarks will need to prepare for more sophisticated techniques. This article has been written for the purpose of providing suggestions for handling trademark trolls' techniques, based upon experiences with the Japan Patent Office's Examination Guidelines for Trademarks (hereinafter Examination Guidelines).

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\* Attorney-at-Law in Japan, Akasaka International Law, Patent & Accounting Office  
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## II. Protection in Japan of Foreign Well-Known Marks

### A. Relevant Provisions of Japan's Trademark Act

Perhaps more so than in many other jurisdictions, Japan's Trademark Act offers a great deal of opportunity and flexibility for holders of foreign, well-known marks to protect their marks. The most relevant Articles in the Trademark Act for famous mark protection are as follows:

- Article 4(1)(vii) applications for marks that are contrary to the public order
- Article 4(1)(x) applications for marks that are similar to well-known marks
- Article 4(1)(xv) applications for marks causing a likelihood of confusion
- Article 4(1)(xix) applications for well-known marks in Japan or foreign countries made with an unfair intention, such as an intent to gain an unfair profit, an intent to harm other persons, etc.

As the grounds for rejection of third-party applications for marks that are well known in Japan or in foreign countries via the provisions of Article 4(1)(vii) and 4(1)(xv)<sup>1</sup> are unclear, Article 4(1)(xix) was introduced in 1996.

Though there are *conventional* applications<sup>2</sup> of Article 4 (1)(vii), (x), (xv), and (xix), because the JPO and the courts are expanding the scope of these provisions, this article discusses the *new* scope of the application of these provisions in order to illustrate how to prevent bad faith trademark applications.

### B. Unregistrable Trademarks

#### 1. Article 4(1)(x): Well-Known Marks

According to Article 4(1)(x), a trademark cannot be registered if it is "identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto..."<sup>3</sup>

The argument that if the mark is not used by the trademark owner, the mark cannot be well known was denied in the "Computer World Case" in the Tokyo High Court decision dated February 26, 1992.<sup>4</sup> According to this judgment, the law does not require the use of a mark in Japan to be well known. Rather, the law only requires that, if the consumers are limited to a particular consumer market, considering the nature of the goods, the mark shall be well known only by such consumers, relying upon citations and broadcasts of the mark as indications of the value and prestige of the goods in Japan.<sup>5</sup>

Further, as international exchange of people and products is increasing, it is possible that famous brand products that are not imported formally will also become increasingly well known by consumers who return from foreign countries and/or are introduced to the products through mass media. In such cases, those foreign well-known marks shall also be well respected.<sup>6</sup>

In order to prove that a mark is well known among consumers as indicating goods or services in connection with a person's business before the filing of a trademark application, evidence from both Japan and other countries may be

used as long as the evidence shows that the mark is famous.<sup>7</sup>

Accordingly, it is unnecessary to prove that it is well known only by evidence obtained from within Japan. Rather, if evidence indicating that the mark is famous in the country of origin is submitted, the JPO, in its consideration of that evidence, might assume that the mark is also well known in Japan.

However, if the mark is not similar to the mark listed and/or the goods and services are not similar, then this argument will not work well.

## 2. Article 4(1)(xv): Likelihood of Confusion

Article 4(1)(xv) contains the following two types of registration of well-known/famous marks as unregistrable trademarks:

A combination of another person's registered trademark "well known among consumers" and other characters or diagrams that are, in principle, handled so that they may cause confusion as to the source of the goods or services, including those trademarks to which the description of the composition of appearance is well united or conceptually related.<sup>9</sup>

A trademark application with respect to a trademark which is liable to, if used by the applicant, cause confusion over the source of its goods or services with those of a trademark well known as a famous trademark overseas among consumers in Japan (not necessarily to final consumers) at the time of its filing is liable to be refused under the provision of this paragraph with that famous trademark cited as a reason for refusal.<sup>10</sup>

The Supreme Court decision dated July 11, 2000 held that the "likelihood of confusion" shall be determined by gen-

eral consideration of the elements, such as the extent of similarity between the applicable trademark and another's indication, the extent to which the mark is well-known or famous, the creativity of the other's mark, the extent of the relationship with respect to the character, purpose or objects of the goods between the applicable trademarks and others' marks, the grounds in common between dealers and consumers of each of the marks, and any other factors related to the actual transaction to be considered, based on a standard of usual attention given by consumers of the goods/services of the applicable trademark ("l'air du temps case")<sup>11</sup>.

Arguably, the most important element of Article 4(1)(xv) is the likelihood of confusion.<sup>12</sup> Even if a mark is dissimilar to the applicable mark, as long as a likelihood of confusion can be proven, the applicable mark might be unregistrable under Article 4(1)(xv).

If a mark includes a series of words, as long as its abbreviation is well known, the main argument for challenging the registration of the abbreviation (solely or in combination with other words or graphics) by third parties shall be under Article 4(1)(xv).

## 3. Article 4(1)(xix): Unfair Purpose Toward Well-Known Marks

According to Article 4(1)(xix), a trademark will not be registered if it "is identical with, or similar to, a trademark which is well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such a trademark is used for unfair purposes..."<sup>13</sup>

Part 16 of the Examination Guidelines provides a detailed explanation of

<b>First type</b>	No similarity to goods/services but can cause likelihood of confusion.
<b>Second type</b>	Well-known part functions as indication of goods/services at the moment of the transaction, which can cause a likelihood of confusion, or the well-known part functions as a series of trademarks due to the association of the trademarks, causing a likelihood of confusion that the origin of goods is from an affiliate trademark owner. <sup>8</sup>

the components of Article 4(1)(xix). Specifically, in relation to the phrase “well known among consumers...abroad” in Article 4(1)(xix), “trademarks...need to be well known in the countries they originate from but do not necessarily need to be well known in multiple countries outside those countries. Nor do they in Japan.”<sup>14</sup>

If third parties are arguably attempting to cause confusion, but are registering a dissimilar mark, this Article perhaps may not be easily applied. Additionally, evidence of such an unfair purpose<sup>15</sup> needs to be obtained.

#### 4. Other - Article 4(1)(vii): Public Order<sup>16</sup>

The spirit of Article 4(1)(xix) is to clarify that an application for a famous trademark by a third party is invalid. Considering such spirit, it is easier for us to first check Article 4(1)(xix) before considering Article 4(1)(vii), which involves many elements.

The Intellectual Property High Court decision dated July 15, 2010 held that a trademark that “is likely to cause damage to public order or morality” includes:

- (1) Letters or diagrams in a composition which is per se outrageous, obscene, discriminatory or unpleasant to people,
- (2) Trademarks that are liable to conflict with the public interests of the society or contravene the generally

accepted sense of morality if used for designated goods or designated services,

- (3) Trademarks for which their use is prohibited by other laws,
- (4) Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to international good faith, or
- (5) Trademarks for which the background of the application contravenes generally accepted reasonableness and it is unacceptable to allow registration due to contravention of the public order expected by the Trademark Act.

For example, in the “Anne of Green Gables” judgment dated September 20, 2006, the Intellectual Property High Court applied Article 4(1)(vii) as grounds for invalidation of the mark, and made the following findings while stating that the trademark in question “is likely to cause damage to public policy”:

- (1) The work has substantial cultural value,
- (2) An amicable relationship exists between Japan and Canada,
- (3) Granting the registration of a trademark would be contrary to international faith between Japan and Canada and would be likely to harm public interest between both countries,

Article 4(1)	(x)	(xi)	(xv) type 1	(xv) type 2	(xix)	(vii)
Well-Known/ Famous	Yes	No <sup>19</sup>	Yes	Yes	Yes	-
TM Registration	No (but not mandatory)	Yes	-	-	No	-
Similarity of TM	Yes	Yes	No	Yes	Yes	-
Similarity of Goods and Services	Yes	Yes	Yes	No	No	-
Likelihood of Confusion	-	-	Yes	Yes	No	-
Unfair Purpose	-	-	-	-	Yes	Yes
Others	-	-	-	-	-	Yes

- (4) The word sign Anne of Green Gables is protected as a public sign and prohibited from being used by private persons,
- (5) As the work in question has strong power to attract consumers, it is not adequate to grant trademark registration to one private entity having nothing to do with the work in question, and
- (6) Development of Plaintiff's application deviates from reasonableness.<sup>17</sup>

In practice, the application of this Article tends to be vague.<sup>18</sup> If there is a background of bad faith, however, it is worth considering this Article as possible grounds for challenging registration by third parties.

### C. Summary Chart of the Above Articles

The above chart summarizes the Examination Guidelines for foreign trademarks that are well known in foreign countries but not used in Japan.

## III. Strategies for Fighting Bad Faith Trademark Applications for Famous Abbreviations<sup>20</sup>

### A. Passing off Famous Abbreviations Originating from Foreign Well-Known Marks

In Japan, applications depicting a distinctive mark added to a generic or descriptive noun that is already registered can potentially be registered at the JPO.

For example, if an entity has registered "White," which is descriptive, another entity may add "Sumida" in combination with the word "White." As "White" is not distinctive, but "Sumida" is distinctive, the JPO may allow registration of the "Sumida White" mark.

Such possibility lends itself to bad faith use quite easily. For example, if a foreign mark holder registers its full name but does not register any related abbreviations, which can be generic or descriptive nouns, there exists the possibility that a trademark troll or bad faith entity or individual may successfully apply for registration of such an abbreviation with the addition of a distinctive name or word.

## B. Using Japan's Trademark Act to Combat Passing off

If a mark itself is well known worldwide, the JPO might take the fame of the mark into consideration under Article 4(1)(xix). However, if an abbreviation is not well known in Japan, it will be difficult to protect the abbreviation. For example, if the well known abbreviation of the well known mark for candy "bonbon White,"<sup>21</sup> is "White" and someone wants to free-ride on the fame of "White" by adding "SUMIDA," such an addition might be accepted by the JPO.

"SUMIDA White" is different from "white" because the appearance and sound are different and the meaning of "white SUMIDA",<sup>22</sup> which means that SUMIDA is white (adjective), is different from "white," which is a noun.

If a mark is the full name of a natural or juridical person, then such an abbreviation might be protected under Article 4(1)(viii)<sup>22</sup> by proving that the abbreviation is famous.

Article 4(1)(xix) requires that said mark should be similar or identical. If a distinctive mark like "Sumida" has been added to the descriptive noun "White" in the previous example for goods, then it is normally difficult to prove that the mark is similar or identical unless "White" is well known to consumers of the good, because "White" only has weak distinctiveness.

In such instances, use of the Article 4(1)(xv) (the likelihood of confusion) should be considered. It is not possible to register a trademark if it "is likely to cause confusion in connection with the goods or services pertaining to a business of another person...."<sup>23</sup>

As long as it can be proven that the abbreviation is well known, there is the

possibility of invalidating the registration of the mark under Article 4(1)(xv).<sup>24</sup>

In addition, if the mark can be proven as both very famous and monopolized by a third party unrelated to the aggrieved party, then the Japanese courts and the JPO might consider rejecting the trademark application for registration under Article 4(1)(vii) (contrary to public order).

It is necessary to note that proving that a mark is famous requires substantial evidence and translation. Therefore, if a mark is not famous, the above actions are not recommended.

## C. Global Strategies for Fighting Passing off

As the JPO respects marks that are considered famous worldwide, the Japanese system can be leveraged to the advantage of holders of internationally famous marks to take countermeasures against bad faith applications in other countries because favorable Japanese judgments might be used in other jurisdictions as evidence.

In order to apply pressure against a wrongdoing entity or individual, it is advantageous to file against that entity or individual in every jurisdiction in which the bad faith mark has been applied for or registered.

In such instances, close collaboration with attorneys representing the famous mark holder in other jurisdictions is likely necessary. If contradictory arguments are made by the various attorneys of the famous mark holder, then the wrongdoer can perhaps take advantage of such contradictions. It is advisable for attorneys working toward a common goal in various jurisdictions to use the following protocol:



- The attorneys working to protect the mark need to create an integrated argument to which must be attached a great deal of evidence.
- This argument should be distributed to each attorney in charge of the proceedings in the various jurisdictions so that such attorneys may consider how pressure may be applied in a more appropriate manner in their jurisdiction.
- To share information, it may be very helpful to use a secured cloud system like Amazon Cloud Service or Microsoft Cloud Services, which shall be custom-made to help facilitate the exchange of information between the various attorneys arguing for protection of the famous mark.
- Communication should be in English to facilitate the sharing of information between attorneys.

The timeframe is also important because a favorable judgment might be useful evidence in the other countries in which proceedings have been initiated. It is important to consider in which jurisdiction a favorable judgment will most likely be awarded (forum shopping).

In Japan, if a party resides in a foreign country, an extension period might be granted to the said party so that they might have time to prepare its argument. In an invalidation procedure, it might take one to two years<sup>25</sup> for JPO Board decisions.

It is recommended that a client retain a skilled patent agent or attorney because seeking a judgment in Japan based on the provisions of the Trademark Act discussed above requires far more evidence than in normal cases (more than 5,000 pages in our experience) and organization is very difficult. Furthermore, because we

also need to consider how to litigate before the Intellectual Property High Court in the event of an unfavorable judgment being granted, or an appeal by the opponent party in the event of a favorable judgment, it may be useful to retain an attorney with litigation experience.

Additionally, an attorney may consider litigation in the District Court based on the Unfair Competition Prevention Act. Thus, in considering the possible necessity for developing a strategy for appeal and in using other avenues, such as litigation before the District Court, it may be of particular benefit to initially retain an attorney in the early stages of litigation, such as during an invalidation proceeding.<sup>26</sup>

#### **D. Attorney-Client Collaboration**

Foreign clients might experience difficulty finding evidence in Japan. In such cases, attorneys shall assist in the acquisition of evidence within Japan. At a minimum, however, it is important to communicate why the mark is famous within the country and to provide relevant evidence on this point so that appropriate evidence may be found within Japan.

The client likely knows the practice of selling or distributing relevant goods and services in detail, as well as the relevant consumers of such goods and services. In principle, the client should provide evidence concerning such practices and consumers so that attorneys can find additional evidence to supplement the evidence provided by the client.

Litigation requires teamwork between clients and attorneys, so the client needs to be aware that they are an integral part of the team in order to win. As such, the client needs to work together with their attorney so that the judge can

understand the argument. Without such collaboration, even if a highly skilled and experienced attorney is found, it might be difficult to achieve success.

#### IV. Conclusion

Trademark trolls will continue to try to register trademarks that are similar or identical to famous marks. As the development of examination procedures by various jurisdictions' trademark offices increasingly prevent simple passing off, trademark trolls will likely begin to use more complex methods. In the event that trademark trolls use sophisticated methods to free ride on others' reputation and fame, this article might perhaps be used to prevent such occurrences from being successful. Additionally, if foreign legislatures are aware of such issues and provide measures to prevent such bad faith applications, the number of meaningless trademark litigation cases may be reduced.

#### Appendix<sup>27</sup>

Part 5: Article 4(1)(vii) (Contravention of Public Order or Morality) is likely to cause damage to public order or morality;

1. Trademarks that are "...likely to cause damage to public order or morality" are trademarks which are letters or diagrams, in composition per se, outrageous, obscene, discriminative or unpleasant to people, or trademarks which are, irrespective their unobjectionable composition, liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for designated goods or

designated services.

It is judged whether "letters or diagrams are discriminative or unpleasant to people," with consideration given to their historic backgrounds, social impacts, etc. from a comprehensive viewpoint.

2. Trademarks with their use prohibited by other laws, trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith are judged to fall under the provision of this paragraph.

#### (Notes)

<sup>1</sup> Article 4(1)(x) is applicable only if the applied-for trademark is identical or similar to another person's trademark (whether registered or not) that is well known *in Japan* among consumers as that indicating goods or services in connection with the person's business. See Kanji, Kudoshouhouhou nokaisetu to saibanrei (explanation of trademark and jurisprudence) 132 (Masterlink 2011).

<sup>2</sup> Conventional applications typically take a few different forms. If the application is for a trademark that is identical with, or similar to, another person's trademark that is well known *in Japan* among consumers as that indicating goods or services in connection with the person's business such applications should be rejected under Article 4(1)(x). If a mark is famous *in Japan*, applications for marks causing confusion with said famous marks shall be rejected under Article 4 (1)(xv). If marks are well known or famous in Japan but are not protected under the above two provisions, applications made with intention to use for unfair purposes shall be rejected under Article 4(1)(vii) before referring to Article 4(1)(xix). The remaining well-known marks are protected under Article 4(1)(xix). See Kozo Takeuchi, Chukai Shohyohou (Commentary of Trademark Act) 448 (Shouen Ono 2nd Seirinshoin 2005)(1993).

<sup>3</sup> Translation by the Ministry of Justice.

<sup>4</sup> 1430 HANREI JIHO 116 (Tokyo High Court, Feb. 26, 1992).

<sup>5</sup> This idea is similar to Paragraph 6 of Part 8 of the Examination Guidelines.

<sup>6</sup> Paragraph 6 of Part 8 of the Examination Guidelines concerning Article 4(1)(x) states

that “[i]n judging whether a foreign trademark is well known in Japan, full consideration needs to be given to, if submitted, materials showing that the trademark concerned is well known in a foreign country and goods on which the trademark is used are exported to several countries or services bearing the trademark are rendered in several countries” (JPO translation).

<sup>7</sup> JPO Board decision dated June 21, 2000 of the “POP-TARTS” case.

<sup>8</sup> See Kanji Kudo, *jitureidemiru shouhyoushin sakijunno kaisetsu* (Explanation of Examination Guidelines for Trademarks using Examples) 377 (7th edition hatumeisuishin kyokai, 2012)(1991). Example is “arenoma / アレノマ” for clothing with “renoma” (bags etc.). See Paragraph 5 of Part 8 of the Examination Guidelines.

<sup>9</sup> Paragraph 5 of Part 12 of the Guidelines.

<sup>10</sup> Paragraph 6 of Part 12 of the Guidelines.

<sup>11</sup> 54 MINSHU 6, 1848 (Sup. Ct., July 11, 2000).

<sup>12</sup> Paragraph 2 of Part 12 of the Guidelines requires consideration of the following elements to prove “likelihood of confusion”:

- (a) How much the other person’s trademark is known (the degree or dissemination of advertisement, publicity, etc.).
- (b) Whether the other person’s trademark is a creative mark.
- (c) Whether the other person’s trademark is a house mark.
- (d) Whether there is the possibility of multiple businesses.
- (e) Whether there is any relationship between goods, services or goods and services. (JPO translation)

<sup>13</sup> Emphasis added (Ministry of Justice translation).

<sup>14</sup> Paragraph 3 of Part 16 (JPO translation).

<sup>15</sup> Paragraph 4 of Part 16 describes “unfair purpose” in detail:

- (a) Materials proving that another person’s trademark is well known among consumers (the period, scope, frequency of its use)
- (b) Materials showing that a well known trademark is composed of a coined word or particular in composition
- (c) Materials proving that the owner of a well known trademark has a concrete plan to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.)
- (d) Materials proving that the owner of a well known trademark has a plan to expand its business in the near future (such as, for

example, the start of a new business, development of its business in new areas, etc.)

(e) Materials proving that the owner of a well known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc.

(f) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well known trademark (JPO translation).

<sup>16</sup> Please see the Appendix for the JPO’s explanation of the text “is likely to cause damage to public order or morality” in Article 4(1)(vii).

<sup>17</sup> Additionally, the Intellectual Property High Court decision dated June 27, 2012 in the so-called “Tarzan Case,” held that “though the word ‘tarzan’ does not have goodwill to attract consumers with respect to applicable goods/services, maintaining the trademark in question in Japan is contrary to international good faith. Granting monopoly to the Defendant, who is an unconnected third party to Plaintiff, is not acceptable but contrary to public order because such registration could cause chaos to the order of fair transactions. Thus, Article 4(1)(vii) shall be applied in this case.”

<sup>18</sup> Kanji Kudo, *id.* 108-110.

<sup>19</sup> The Guidelines for Article 4(1)(11) in paragraph 6 (6) state that “a trademark combining another person’s registered trademark that is widely recognized in respect of the designated goods or designated services with other letters or figures, including one whose appearance in totality is well formed or one having a connection in concept, is judged as similar to that another person’s trademark, in principle, excluding however cases where the part of another person’s trademark has become an established word” (JPO translation).

<sup>20</sup> In order to counteract free-rider applications, trademark registration of famous abbreviations can serve as a useful strategy. Additionally, provision of information (情報提供) to the JPO during the trademark registration process or pursuit of opposition proceedings under Article 43(2) of the Trademark Act might be helpful tactics.

<sup>21</sup> “Bonbon” is a French word meaning candy.

<sup>22</sup> A trademark application will be rejected under Article 4(1)(viii) if it “contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has

been approved by the person concerned); to necessary extent, it might be better to take into consideration.” (Ministry of Justice translation).

<sup>23</sup> Article 4(1)(xv). (Ministry of Justice translation).

<sup>24</sup> In the Tokyo High Court decision dated December 16, 1999, the Court held that Ralph Lauren or Polo became famous (in Japan) at the latest by 1991 in fashion industries and we can recognize among the submitted evidence that it is not rare to see “POLO,” “Polo,” etc. as an abbreviation. When “POLO,” “Polo,” etc. is used for fashion-related products, consumers seeing such products will likely recognize products related to Ralph Lauren or Polo Ltd. If the applicable mark (ROYAL PRINCE POLO CLUB) is used for this good, consumers will associate it with the mark POLO, which is a component of the well-known mark Ralph Lauren, and it will cause a likelihood of confusion that the product in question originates from Ralph Lauren or an organization affiliated economically or systematically (summarized by author). Additionally, in the Supreme Court decision dated July 6, 2001 it was held that, using the standard provided in the “L’Air du Temps” case (please see page 5 of this article), the applied-for trademark “PALM

SPRINGS POLO CLUB” used on clothes, coats, shirts, etc. caused a likelihood of confusion with the famous mark “polo,” which is used on clothes etc. because the mark “polo” is famous, consumers for both products are similar and thus the “polo” part will draw consumer attention, even though “polo” itself is not creative. See 1762 HANREI JIHO 130 (Sup. Ct., July 6, 2001).

<sup>25</sup> Invalidation procedures for foreign clients residing outside of Japan takes more than average time (which is usually less than one year) due to the translation of foreign languages etc. This data is based on Tomoyasu Sato, *Shinpanseido no gaiyou to saikin no doukou* (the outline of trials in JPO and current tendencies), 63-3 Patent 96, (2010).

<sup>26</sup> To save money, some clients may wish to initiate unfair competition litigation to claim for damages arising from infringement. However, considering that trademark registrations are granted by the JPO, the District Court might be deferential toward JPO registration decisions. As such, it may become more difficult to win such a case. Thus, to remove such barriers, it is recommended that trademark invalidation be sought first.

<sup>27</sup> Examination Guidelines (JPO translation).

# GORODISSKY & PARTNERS

RUSSIA

Patent Attorneys & IP Lawyers



Head Office:

B. Spasskaya Str., 25, bldg. 3, Moscow 129090, Russia  
Tel.: +7 (495) 937 6116. Fax: +7 (495) 937 6104/6123  
E-mail: pat@gorodissky.ru  
www.gorodissky.com

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