

The above stipulations shall be applied even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like "

11 *Article 23 2 of the TRIPS Agreement provides that the registration of a trademark for wines or spirits containing or consisting of a geographical indication shall be refused or invalidated with respect to wines and spirits not having such origin Article 4(1)(xvii) of the Trademark Law of Japan implements this provision as regards geographical indications from WTO Members The Patent Office of Japan has adopted a list of those geographical indications registered with the International Bureau of WIPO which cannot be registered as trademarks in Japan What provisions has Japan taken to update this list?*

As a part of voluntary measures, which Japan has been taking to implement Article 23 2 of the TRIPS Agreement, the Japanese Patent Office has published, for an advance notice, a list of geographical indications whose registration could be refused under Article 4(1)(xvii) of the Japanese Trademark Law More specifically, Japan has disclosed "the List of Geographical Indications for Wines and Spirits Registered with the WIPO International Bureau" in the Trademark Gazette of 23 June 1995 When the Japanese Patent Office obtains a revised edition of the said list, the revised list of geographical indications and the translations thereof will also be published

[Follow-up question from the EC]

The reply given to question 11 does not seem to fully answer the point raised in the question The answer given appears to indicate that the protection of geographical indications for wines and spirits is limited to these geographical indications registered with the International Bureau of WIPO and contained in the list circulated by the International Bureau Any extension of that list appears to be dependent on the issuing of a new list by WIPO We therefore seek further clarification

- *Are geographical indications for wines and spirits which do not figure in the WIPO list protected in Japan? If not, how can a rightholder obtain protection for such a geographical indication?*
- *What action has been taken in Japan to ensure the protection of geographical indications for wines and spirits originating in WTO Members which do not figure on the WIPO list?*

The protection of geographical indications for wines and spirits is not limited to those in the WIPO list The Japanese Government has made efforts to collect lists of geographical indications by asking the competent authorities of foreign countries to provide lists of geographical indications protected within their territories. Those lists obtained are of use in the course of examination as a material to show the existence of the geographical indications

12. *Does Japanese trademark legislation allow for the right to continue the use of a trademark acquired through use in good faith where such a trademark is identical with, or similar to, a geographical indication and, if so, what, if any, are the relevant dates in accordance with Article 24 5 of the TRIPS Agreement? Please explain*

The use of a trademark indicating or suggesting a geographical unit other than a true place of origin in such a manner as to mislead the public regarding the origin of goods has been prohibited as a misleading representation since 1974 by the Japanese "Act against Unjustifiable Premiums and Misleading Representations". Therefore, it is not envisaged in Japan that a person continues to use

this kind of trademark, and "the relevant dates" in accordance with Article 24.5 of the TRIPS Agreement are not provided for

When a trademark does not mislead the public regarding the true place of origin, Article 22 of the TRIPS Agreement is not applicable and the trademark which contains or consists of the geographical indication of goods is allowed to continue to be used. Therefore, "the relevant dates" in accordance with Article 24.5 of the Agreement are not provided for

[Follow-up question from the EC]

Does the answer of Japan to question 12 mean that it is not possible under Japanese Law to acquire or maintain rights to a trademark applied for or registered in good faith, where the trademark is identical with, or similar to, a geographical indication in such a manner as to be misleading to the public? Please explain

The following practice under Article 4(1), sub-paragraph (xvi) of the Trademark Law was established before entry into force of the TRIPS Agreement

"An application for the registration of a trademark shall be rejected under the Japanese Trademark Law where the trademark in the application is identical with, or similar to, a geographical indication in such a manner as to be misleading to the public "

Therefore, it is not possible under Japanese Law to acquire or maintain rights to a trademark applied for or registered in good faith where it is liable to mislead the public

13. *Does Japanese law provide for the protection of textile designs, including fashion? If yes, on what legal basis and under which conditions (Article 25.2 of the TRIPS Agreement)?*

Under the Japanese Design Law, any industrial design which meets the requirements prescribed by the Law is eligible for registration, subject to examination. In this context, textile designs, or any fashion made of them, are eligible subject matters protected by the Law

There are no legal conditions under which textile designs are protected. The conditions concerning textile designs, in particular those concerning cost, examination and publication, are, as described below, identical to, or slightly more advantageous than, those concerning other goods (see Articles 2(1) and 3)

Cost The official fee structure for obtaining rights for textile designs is identical to the one for designs in other fields.

Examination. The Japanese Patent Office has been making efforts to expedite the examination process in every design field and has set a goal to the effect that by the year 2000 the first action is to be communicated within 12 months. As to textile designs, in particular, this action plan is better facilitated by staffing experts to assist in accelerated examination. In addition, when the design in an application is likely to be imitated, that application can be put to accelerated examination at the request of the applicant and, in such a case, that application will be processed in approximately four months from the request to final decision

Publication: Under the Design Law, any designs shown in applications are published in the official gazette only after they are registered. In addition, the publication can be deferred for a prescribed time period at the request of an applicant. These matters also apply to textile designs (see Article 14)

IV. REPLIES TO QUESTIONS POSED BY NEW ZEALAND

1 *In Section 3(2) of the Design Law it specifies that designs which "could have been easily created . by someone skilled in the art to which the design pertains, on the basis of a shape, pattern or colour [sic] or any combination thereof widely known in Japan" shall not be registered. Please explain how this conforms to Article 25 1 of the TRIPS Agreement which states that "Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features"*

"Designs that could easily have been created on the basis of a shape, pattern or colour or any combination thereof widely known in Japan" provided for in Article 3(2) of the Japanese Design Law correspond to designs that "do not significantly differ from known designs or combinations of known design features" referred to in Article 25 1 of the TRIPS Agreement

Furthermore, " a shape, pattern or colour or any combination thereof widely known in Japan" provided for in Article 3(2) of the Law corresponds to "known designs or combinations of known design features" referred to in Article 25 1 of the TRIPS Agreement Since the condition "widely known in Japan" for the exception to registrability of designs is more restrictive than the condition "known" referred to in the Agreement, a wider range of designs could be deemed eligible for registration under the Law than under the Agreement

2 *In Section 5(i) of the Design Law it specifies that designs liable to contravene morality are excluded from design protection Please explain what types of designs could fall within this provision*

The "designs liable to contravene morality" (Article 5(i) of the Japanese Design Law) are those that damage human morals, and cause feelings of shame or hatred. For example, designs that damage human morals are those that portray drugs or acts of violence; those that cause feelings of shame or hatred are those that portray obscenities, human wastes or vomit

V. REPLIES TO QUESTIONS POSED BY THE UNITED STATES

1 *Please explain whether Section 2(1) of the Japanese Trademark Law permits registration of personal names as a "sign" and how this practice complies with TRIPS Article 15 1*

Article 2(1) of the Japanese Trademark Law provides that "trademark" means characters, figures or signs, any combinations thereof, or any combinations thereof with colours "Characters", in comparison with "figures" or "signs", mean words including personal names, letters and numerals Consequently, personal names referred to in Article 15.1 of the TRIPS Agreement are eligible for trademark registration in Japan

2. *Please explain whether, under Japanese law, colours can be registered without accompanying figurative elements, as required by TRIPS Article 15.1.*

See reply to question 4 from the EC above.

3. *Please explain whether Section 5 of the Japanese Trademark Law provides for the acceptance of applications to register a trademark based on an intent to use the mark pursuant to TRIPS Article 15 3*

Please explain the requirements and conditions that are placed on parties wishing to register and maintain registration of a mark based on an intent to use the mark.

Article 3(1) of the Japanese Trademark Law provides that any person may obtain a registration for a trademark to be used with respect to goods or services in connection with his/her business. Accordingly, a trademark may be registered not only in the case of actual use but also in the case of intent to use and no particular requirements or conditions are imposed on the registration of a trademark applied based on intent to use.

A registered trademark which has not been used for an uninterrupted period of three years may be subject to an appeal for cancellation. If such an appeal is requested, the registration may be cancelled unless there are due grounds for non-use (Article 50).

4 *Please explain whether the nature of goods or services to which a trademark is to be applied can serve as an obstacle to the registration of the mark under Japanese law. If so, please identify and explain the subject matter excluded under this authority; the relative provisions of the Japanese law that serve as a basis for these exclusions, and how this practice complies with TRIPS Article 15.4*

Under the Japanese Trademark Law, the nature of goods or services for which a trademark is applied by no means serves as an obstacle to the registration of the trademark.

5. *Please explain whether marks that are not eligible for registration because they are "similar to" registered marks are evaluated using a "likelihood of confusion" standard or using an analysis based solely on whether the marks are similar without regard to the goods or services involved. Please provide information regarding any relevant decisions of administrative or judicial bodies that address this issue.*

Under the Japanese Trademark Law, similarity between trademarks in question and prior registered trademarks is evaluated using the "likelihood of confusion" standard.

Under this standard, due account is to be taken as regards designated goods or services with respect to which both trademarks are used as well as any identity or similarity between the trademarks and prior registered trademarks themselves. "Hyozan case" is a leading case on this issue decided by the Supreme Court (*Minshu* 22, No. 2, 399).

6 *Please explain whether and upon what authority under Japanese law a trademark examiner can refuse an application to register a trademark because the proposed mark is identical or similar to an unregistered well-known mark.*

An application to register a trademark shall be refused based on Article 4(1)(x) of the Japanese Trademark Law where the trademark is identical, or similar, to an unregistered well-known trademark and the goods or services with respect to which the trademark applied is used are identical, or similar, to those with respect to which the well-known trademark is used.

Even if goods or services for a trademark applied are not identical, or similar, to those for a well-known trademark, the application shall be refused based on Article 4(1)(xv) of the Law on condition that it is likely to cause confusion.

7 *Please explain whether Japanese trademark law establishes a presumption of likelihood of confusion in the determination of confusing similarity in cases where identical marks are used on identical*

goods, as required by TRIPS Article 16.1. If so, please identify and explain the legal basis for this presumption.

Under the Japanese Trademark Law, the owner of the trademark has the exclusive right to prevent third parties from using "an identical sign for identical goods or services" provided for in Article 16.1 of the TRIPS Agreement irrespective of a likelihood of confusion

This conclusion stems from Article 25 of the Law which provides that the owner of a trademark right shall have the exclusive right to use the trademark with respect to the designated goods or designated services, and from Article 36 of the Law which provides that the owner of a trademark right may require a person who is infringing or is likely to infringe upon the trademark right to discontinue, or refrain from, such infringement

8. *Please explain how Section 24(6) of the Japanese Trademark Law, which requires trademarks owned by non-profit entities to be transferred only with the transfer of the enterprise, is compatible with TRIPS Article 21.*

Article 24(6) of the Japanese Trademark Law relates to trademarks which are already famous in Japan as marks identifying non-profit enterprises working in the public interest (such as water utilities and public road transport corporations). The registration of an identical or similar trademark by a person who has no association with such a public entity will very probably confuse consumers, and detract from the due rights of third parties. The registration of such a trademark by such a person is, therefore, prohibited under the Law (see Article 4(1)(vi)) With this in mind, the Law prohibits the transfer of such a trademark, unless the enterprise itself is transferred This limited exception applies only to famous trademarks concerning non-profit enterprises and is permitted under Article 17 of the TRIPS Agreement.

9. *Please explain whether Section 47 of the Japanese Trademark Law precludes a person from obtaining cancellation of a fraudulently obtained registration in relation to the criteria specified in Section 47 more than five years after registration. If it does, please explain how this provision complies with the requirements of Article 2.1 of the TRIPS Agreement, to the extent that it incorporates Article 6bis(3) of the Paris Convention, which precludes WTO Members from placing time limits on requests for cancellation of marks that were registered or used in bad faith.*

The five-year time-limit stipulated in Article 47 of the Japanese Trademark Law does not apply to the request for cancellation of the registration of a well-known trademark registered in bad faith. Article 47 provides that in the case where a trademark is registered in contradiction to Article 4(1)(x) (Protection of well-known trademarks), the five-year time-limit shall not be applicable to such a registration obtained with the intention of unfair competition. The intention of unfair competition is construed as the same as bad faith

10. *Please explain whether the authority specified in Section 53bis of the Japanese Trademark Law to demand a trial for cancellation of a mark obtained in bad faith is subject to the five-year limitation specified in Section 53ter. If so, please explain how Sections 53bis and 53ter comply with Article 2.1 of the TRIPS Agreement to the extent that it incorporates Article 6bis(3) of the Paris Convention, which precludes WTO Members from placing time limits on requests for cancellation of marks that were registered or used in bad faith.*

Article 53bis of the Japanese Trademark Law corresponds to Article 6septies(1) and (2) of the Paris Convention, and Article 53ter of the Law corresponds to Article 6septies(3) of the Convention.