

Where a trademark, subject to cancellation under Article 53*bis* of the Law, is well known, an application for registration of such a trademark should have been refused based on Article 4(1)(x) of the Law.

Accordingly, if the well-known trademark has been registered in bad faith, the five-year time-limit provided for in Article 53*bis* is not applied and its registration may be invalidated at any time through appeal under Article 46 of the Law on the grounds that it is in violation of Article 4(1)(x) and obtained in bad faith, which is consistent with Article 6*bis*(3) of the Convention.

11 *Please explain how the standards of Section 50(2) of the Japanese Trademark Law regarding the acceptance of "legitimate reasons" for non-use complies with the provisions of TRIPS Article 19.1 which requires that WTO Members recognize certain circumstances that arise independently of the will of the trademark owner as being valid reasons for non-use to prevent cancellation of a registration for non-use.*

"Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services" provided for in Article 19.1 of the TRIPS Agreement are recognized as legitimate reasons for the non-use of a trademark prescribed in Article 50(2) of the Japanese Trademark Law. Article 50(2) of the Law thus complies with Article 19.1 of the TRIPS Agreement. "Legitimate reasons for non-use" are also referred to in Article 19(3) of the Law, and the Trademark Examination Guidelines illustrating this Article provide for "complete prohibition of use by law, delay in the approval procedures and other exercise of legal action" as examples of circumstances beyond the control of the owner of a trademark. The Guidelines also apply to proceedings relating to finding a legitimate reason in the appeal procedure under Article 50(2) of the Law.

12. *Please describe the methods by which industrial designs are protected in Japan, in particular*

- (a) *the form or forms of intellectual property used to protect the design (e.g., patent, copyright, sui generis);*
- (b) *the conditions that must be satisfied to obtain the grant of such protection (e.g., whether designs must be new or original and the parameters of these concepts), and a brief description of the registration or granting procedure,*
- (c) *the nature of the rights granted and the term of protection provided,*
- (d) *the nature of remedies available to the owner of each type of protection, including a description of the conditions that may be imposed (e.g., whether commercial use is required); and*
- (e) *whether any exceptions to protection or rights exist for each type of intellectual property involved*

- (a) In Japan, industrial designs are protected by the *sui generis* system, i.e. the Japanese Design Law.
- (b) The criteria for a grant of protection under the Japanese Design Law is whether a design is new or original. Designs that do not significantly differ from designs or combinations of designs in the public domain are not considered new or original.

"Designs in the public domain" represent designs known to the public, and those shown in publications distributed, inside and outside Japan.

The registration procedure consists of filing an application, formal and substantive examination, and registration. A detailed flowchart is appended.⁵

- (c) Under the Japanese Design Law, a design right is defined as an exclusive right to work a registered design, and a design similar to it, for business. In this context, the term "working" includes "manufacturing" which corresponds to "making" referred to in the TRIPS Agreement, "assigning" which contains "selling" referred to in the Agreement and "importing" (see Articles 23 and 2(3))

The term of protection amounts to 15 years from the date of registration (Article 21)

- (d) Under the Japanese Design Law, the owner of a registered design shall be entitled to claim an injunction and compensation for damages (see Articles 37, 39 and 40). The commercial use of the design is not required to obtain such remedies.

Infringement of design rights may incur a sanction of a criminal penalty (Article 69)

Article 21(1) of the Japanese Customs Tariff Law⁶ prohibits the importation of goods which infringe design rights

A design rightholder may provide the Japanese Customs Authorities to control infringing goods at the border with information on prohibition of importing such goods based on the Guidelines Concerning the Control of Goods which Infringe Intellectual Property Rights (Ministry of Finance, Customs and Tariff Bureau, Document No. 1192, 28 December 1994).

- (e) Designs which are contrary to public order and morality are not registrable (see Article 5(i)). A prior user of the design in good faith may be allowed to use the design (see Article 29)

13 *Please explain how textile designs are protected under your 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

⁵See the Annex to the present document

⁶The law in question has been notified as a main dedicated intellectual property law in the area of enforcement (see document IP/N/1/JPN/E/1)

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).

VI. REPLIES TO QUESTIONS POSED BY AUSTRALIA

1. *Do you protect textile designs as required under Article 25 of the TRIPS Agreement by industrial design law, copyright law, sui generis legislation or a combination of these?*

In Japan, industrial designs, including textile designs, are protected by the Japanese Design Law.

2. *If it is a requirement of your trademark law that a sign be "visually perceptible", how is this requirement applied?*

Article 2(1) of the Japanese Trademark Law defines trademarks as "characters, figures or signs or any combination thereof, or any combination thereof with colours". It is understood that this provision requires that a sign be "visually perceptible", to be treated as a trademark.

3. *If your trademark legislation permits the registration of sounds and smells, how are such signs received in the Trade Marks Office and entered in the Trade Marks Register?*

The Japanese Trademark Law does not permit the registration of sounds or smells.

4. *How does your legislation meet the requirements of Article 6bis of the Paris Convention, as expressed in Article 16 of the TRIPS Agreement, concerning well-known trademarks? What criteria are applied in determining what constitutes a well-known trademark?*

(a) An application for registration of a trademark which is "well known among consumers as indicating the goods or services connected with another person's business, and of a trademark similar thereto, used with respect to such goods or services, or similar goods or services" shall be refused in accordance with sub-paragraph (x) of Article 4(1) of the Japanese Trademark Law. In case such a trademark is registered, the registration may be invalidated through appeal process, provided that such an appeal is requested within five years from the registration of that trademark. If such a trademark is registered in bad faith, however, such registration may be invalidated at any time.

(b) Furthermore, an application for registration of a trademark which is "well known among consumers as indicating the goods or services connected with another person's business, and of a trademark similar thereto, used with respect to non-similar goods or services" shall be refused in accordance with sub-paragraph (xv) of Article 4(1) of the Law, if it is likely to cause confusion with goods or services connected with another person's business. In case such a trademark is registered, the registration may be invalidated through appeal process, provided that such an appeal is requested within five years from the registration of that trademark. If such a trademark is registered in bad faith, however, such registration may be invalidated at any time.

(c) The Trademark Examination Guidelines provide that the following elements should be taken into account by authorities concerned in determining "whether or not a trademark is well known among consumers" as provided for in sub-paragraph (x) of Article 4(1) of the Law:

(i) whether or not the trademark in question is actually used; the nature of goods or services for which the trademark is used;

- (ii) the starting date of the use,
- (iii) the period of the use,
- (iv) the area where the trademark, or the trademark goods or services have been used,
- (v) the volume of production or transaction of the goods or services, the number of certificates issued,
- (vi) the methods, frequency and contents of advertisement

(d) In addition to the protection by the Trademark Law, the Japanese Unfair Competition Prevention Law provides that the use of an indication of goods or business (including a trademark), which is identical with, or similar to, another person's indication as to be well known among consumers, is one of the types of unfair competition, provided that the use causes confusion with another person's goods or business. Any person whose business interests are infringed by the unfair competition is entitled to request an injunction under the Law (see Article 3 of the Japanese Trademark Law)

ANNEX

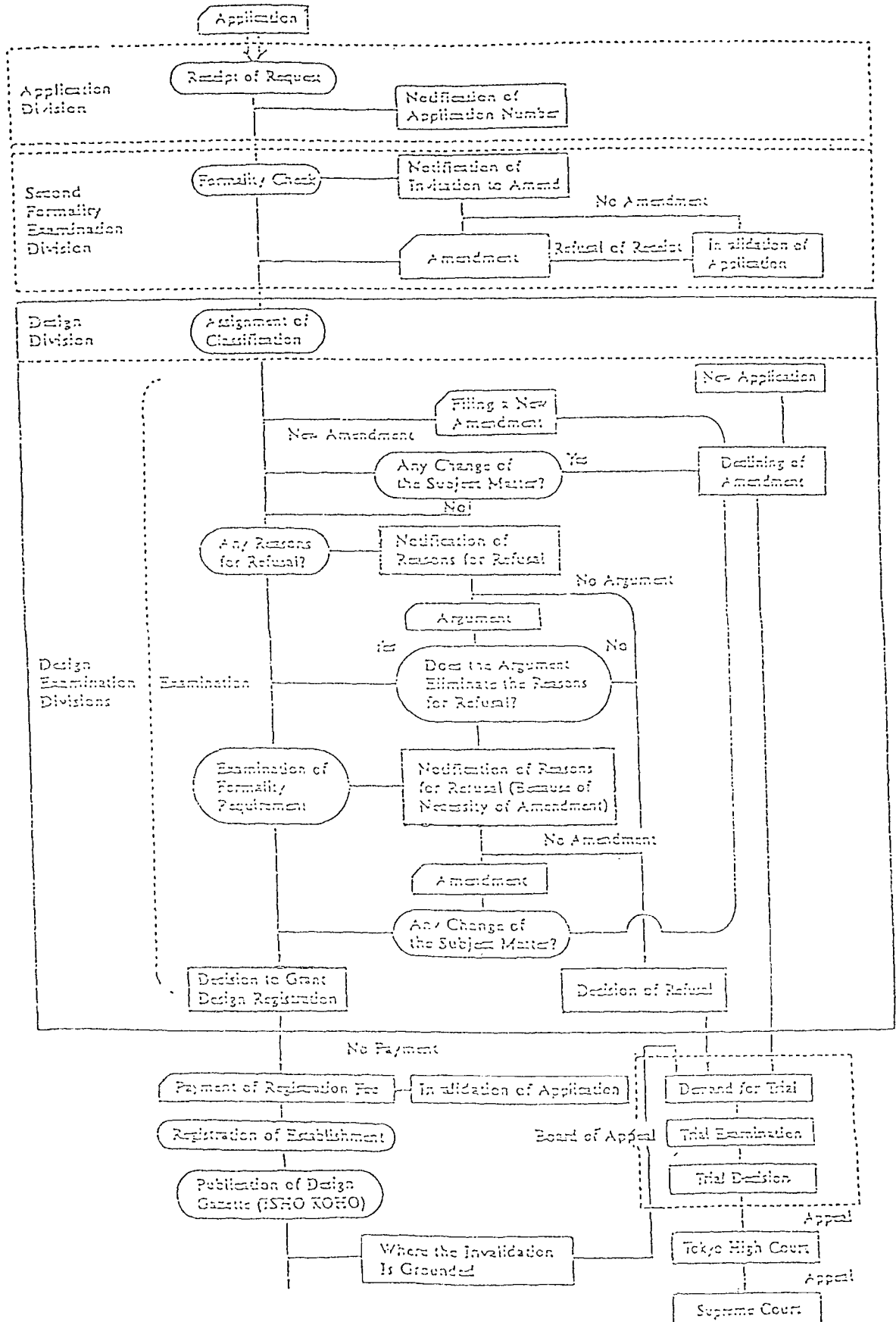


Fig. 1 Procedures of Application for Design Registration

