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Recent IP Law Revisions in Japan Effective in 2024

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Overview

1. Implementation of consent system TM
2. Relaxed requirements for registration of TMs containing individual names TM
3. Relaxed procedural requirements for exception to lack of novelty Design

1. Implementation of Consent System in Japan

Background

Registration possibility under Trademark Law 4(1)(xi)

		Goods/Services	
		Identical	Similar
Trademark	Identical	No	No
	Similar	No	No

- A TM identical/similar in mark and goods/services to a prior registered TM cannot be registered (Trademark Law 4(1)(xi)).
- Many countries/regions allow concurrent registration of similar TMs with the consent of the prior TM owner.



Implementation of a consent system

“Non-Binding” Consent System

TM

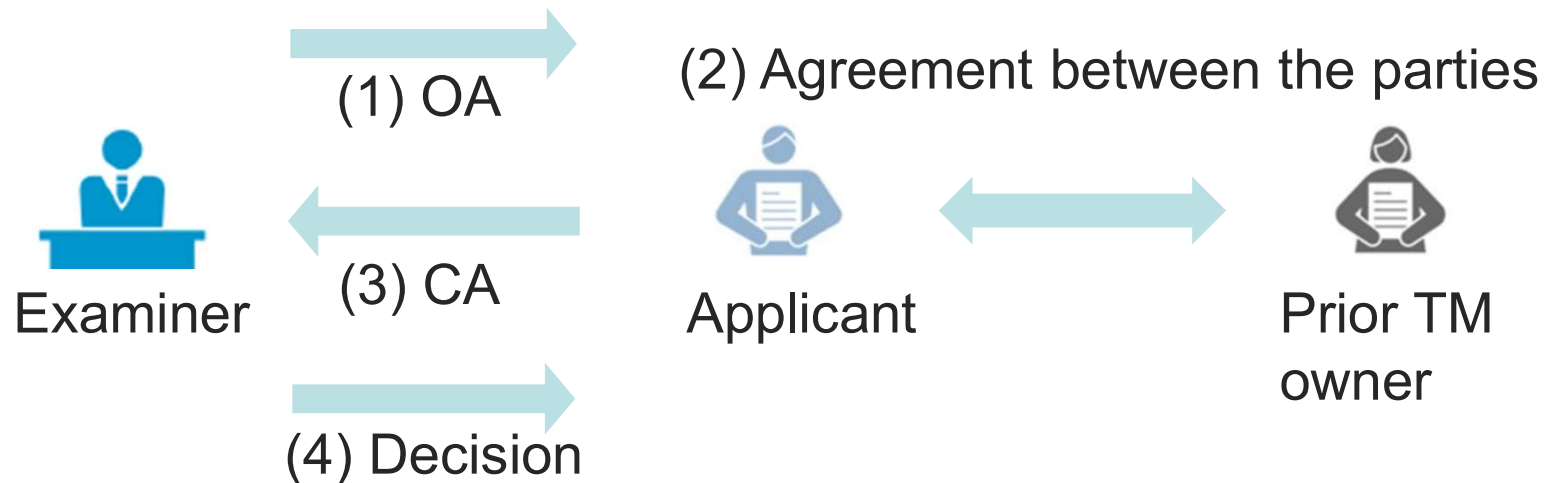
- Consent Agreement (CA) is not binding upon the Examiner.
- Rejection under Article 4(1)(xi) is overcome only when no likelihood of confusion.
- Examiner analyzes likelihood of confusion not only based on the CA, but also on other factors.

Effectiveness of Consent Agreement in Different Countries/Regions

Non-binding	Binding
US, CN, TW, SG	NZ

Examination Procedures Using CA

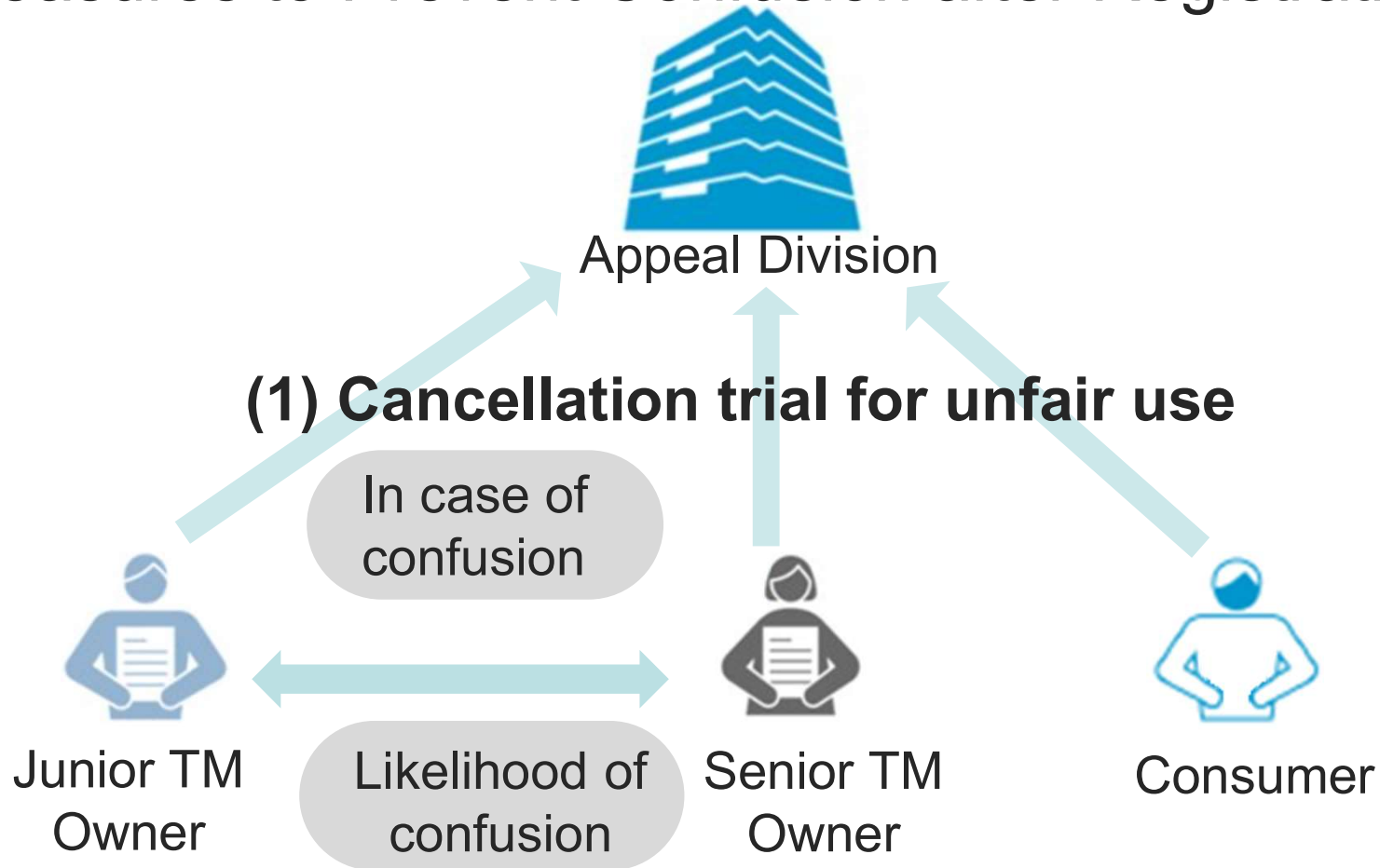
TM



- Required Documents
 - **Consent agreement**
 - Document(s) proving no **current and future likelihood of confusion**
- Ex officio search admissible

Measures to Prevent Confusion after Registration

TM



(1) Cancellation trial for unfair use

(2) Request for indication to avoid confusion

Key Points of Consent System

TM

- Already in effect on April 1, 2024.
- Not applied to applications filed before the effective date.
- Applicable even when the cited TM is not in use.
- CA and submitted documents are subject to public disclosure.
- Registration using CA in another jurisdiction does not guarantee registration using CA in Japan.
- Not effective for identical TMs designating identical goods/services.
⇒ Consider "Assignment back."

2. Relaxed Requirements for Registration of TMs Containing Individual Names

TMs Containing Individual Names

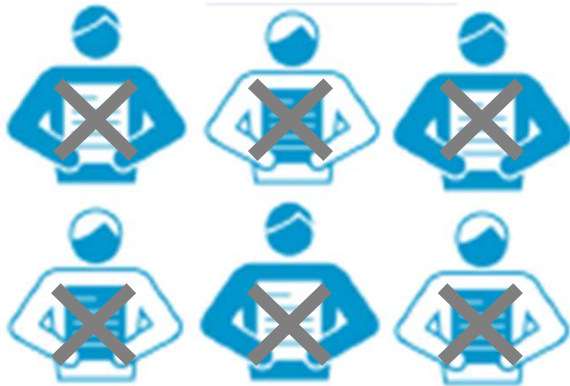
TM



TM: Ken Smith
Goods: Rings and necklaces
Applicant: Ken Smith

Before revision

Rejection



Many **un-well-known**
Mr. Ken Smiths

W/o all the Mr.
Ken Smiths'
consents

After revision

Can be
registered

Examination of TMs Containing Individual Names

TM

(a) Any person with the same name and a **certain level of recognizability?**

– Consent unnecessary if no one with the name is well-known.

(b) Cabinet order requirements:

(i) **“Reasonable relationship”** between the name and the applicant;

(ii) **No unfair competition purposes.**

If requirements (a), (b) (i) and (b)(ii) are met, the TM can be registered w/o the consent of others.

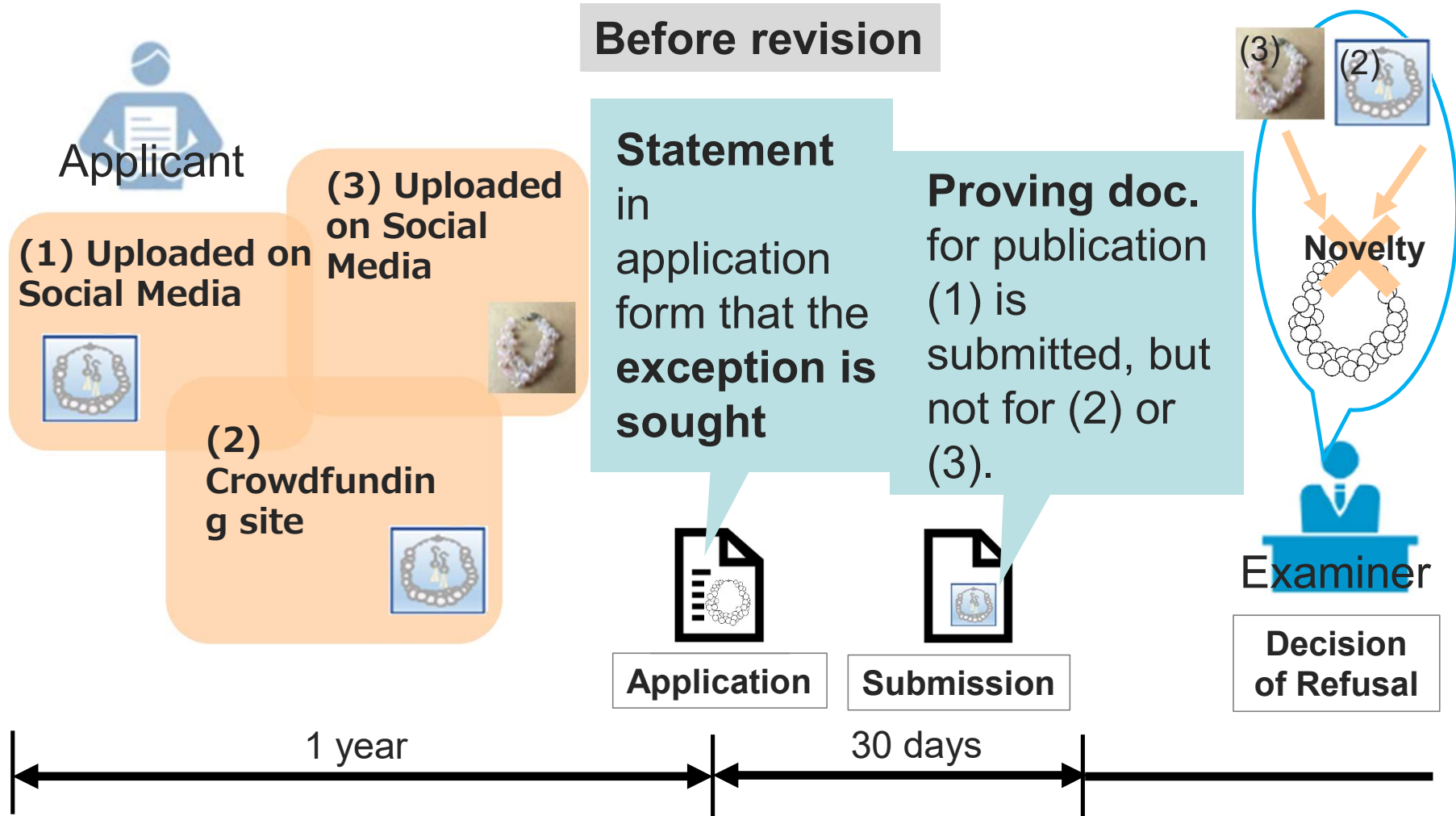
Key Points of TMs Containing Individual Names

TM

- Already in effect on April 1, 2024.
- For applications filed prior to the effective date, no registration w/o consent of all others with the same name.
- Applied to non-Japanese names.
- Applications containing an individual name filed after the effective date not eligible for accelerated examination.

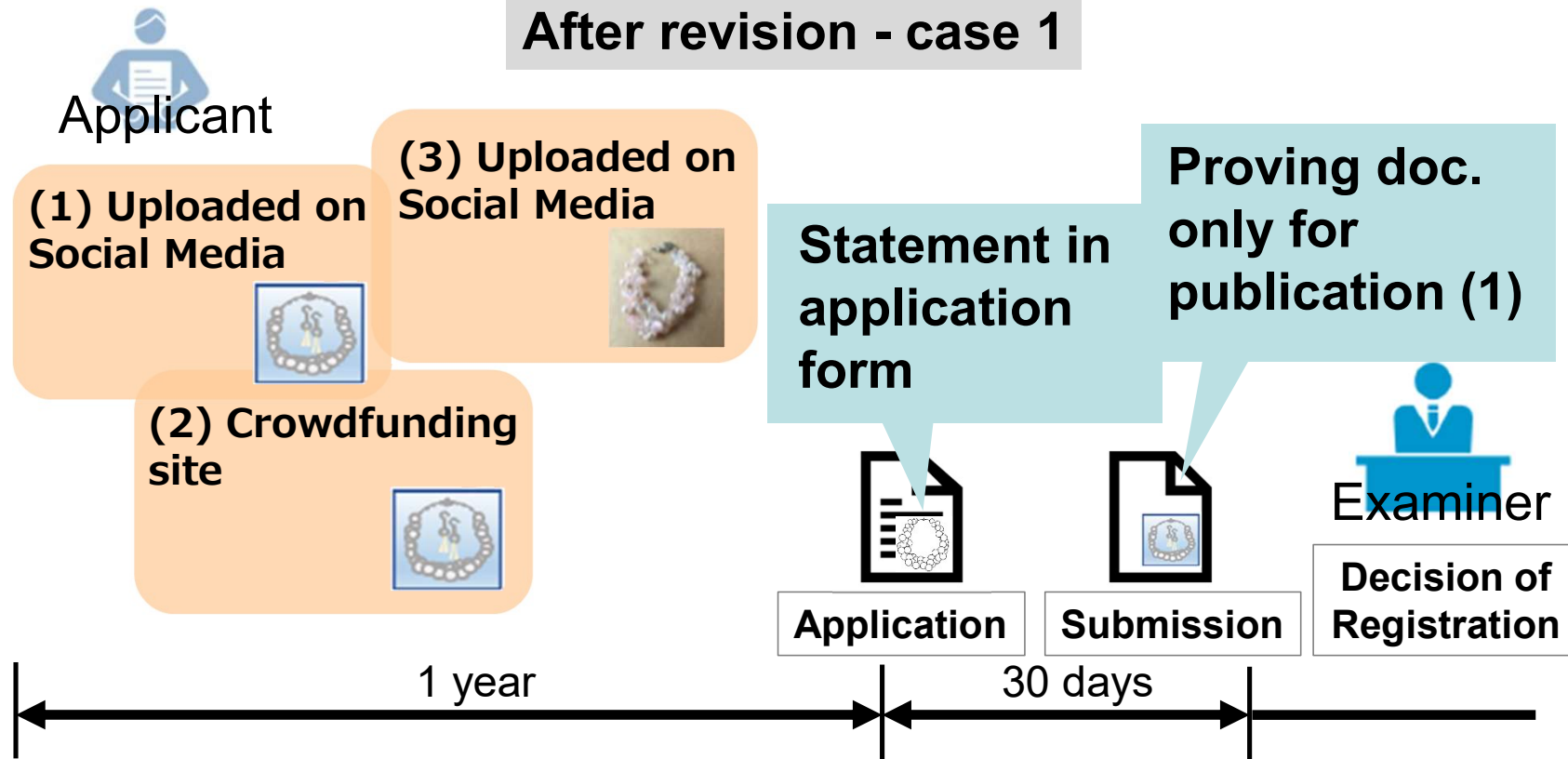
3. Relaxation of procedural requirements for “exception to lack of novelty”

Exception to Lack of Novelty



Relaxation of Procedural Requirements

After revision - case 1

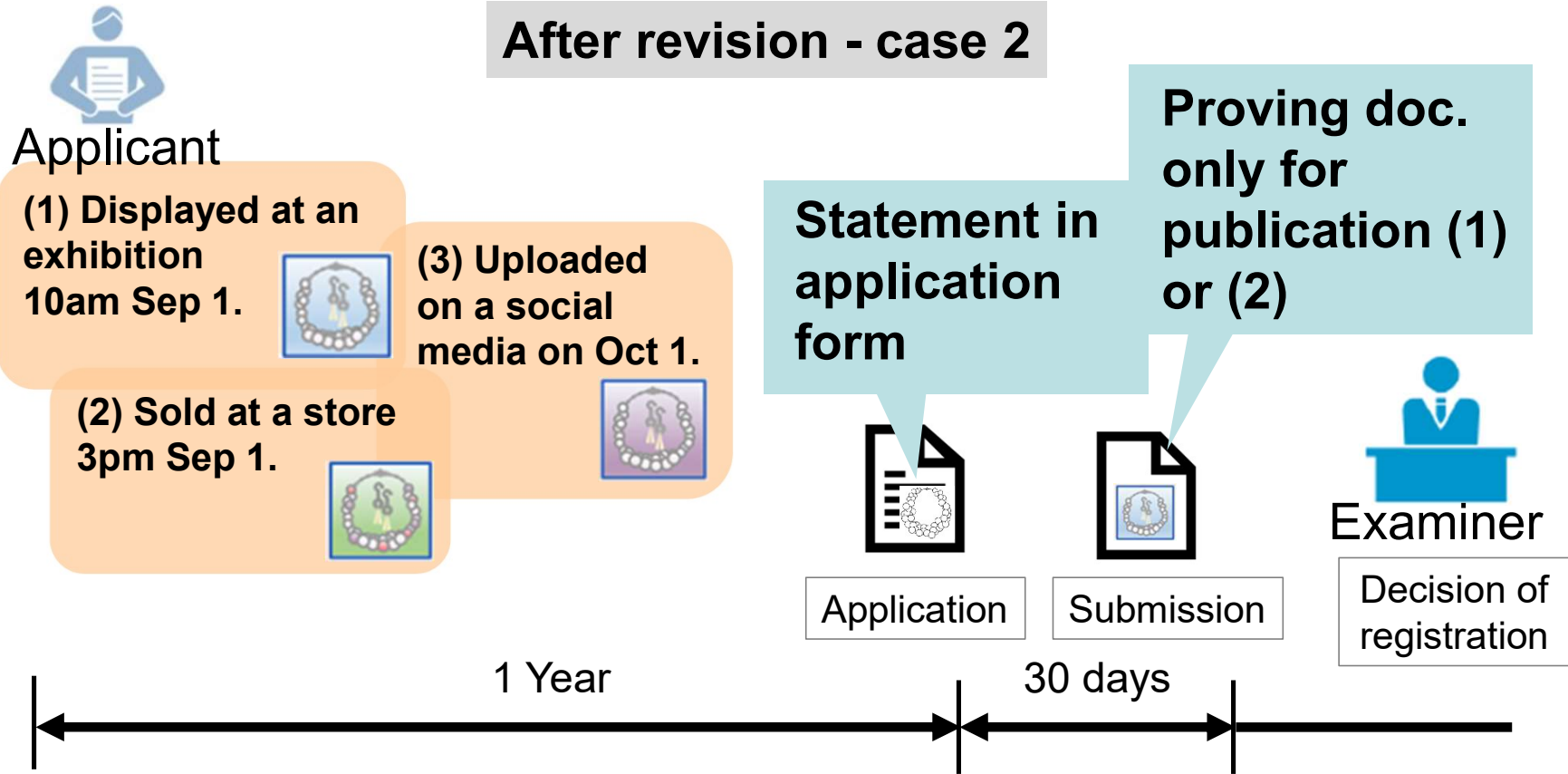


If a proving doc. for the earliest published design (1) is submitted, designs (2) and (3) will not be considered as cited designs even if they have been published prior to the application.

A proving doc. is valid for identical or similar designs.

Relaxation of Procedural Requirements

After revision - case 2



Sufficient to file a proving doc. for **one of the earliest day's publications** if they are similar.

Relaxation of Procedural Requirements

After revision - case 3

Prior publications

(1) First publication:
Partial release
through teaser ads



Later publication is broader

(2) Second publication:
Product launch



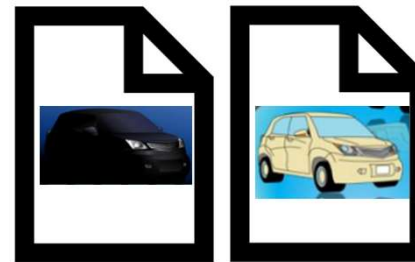
Design application



Statement in
application form



Proving doc.
for each
publication (1)
and (2)



Key Points for Exception of Lack of Novelty

- Already in effect on January 1, 2024.
- Only one proving doc. necessary for pre-publication of identical/similar designs.
- If dissimilar designs are published, a proving doc. should be submitted for each.
- No relief will be granted in case of publication 1 year+ prior to the filing date.
- Novelty is judged on the filing date, not on the publication date.



Thank you for your attention!

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