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10 **ARTICLE**

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12 **Japanese Trade Mark Law and *Benrishi*: Preparing for Tokyo 2020**

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16 By Martin Szarkiszjan<sup>1</sup> and Janice Denoncourt<sup>2</sup>  
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20 **Abstract**

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23 Many firms are interested in establishing their brand in Japan, a sophisticated,  
24 competitive and stable market. Over the past third years, the country has  
25 undergone much deregulation and is relatively open in most sectors. Indeed,  
26 Japan is the UK's largest export market outside Europe and the USA. Trade  
27 marks are the signifiers and legal anchors of brands.<sup>3</sup> This article examines the  
28 Japanese trade mark law framework and offers streamlined legal guidance on  
29 Japanese trade mark registration, with on focus bringing a brand to the Japanese  
30 market in time for the Tokyo 2020 Olympics and beyond. Trade mark  
31 registration in Japan is not unduly complicated, however, pitfalls may arise due  
32 to the language barrier and relatively isolated legal system. This article  
33 uniquely discusses the Japanese IP profession, the *Benrishi*, the Tokyo 2020  
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53 School, conducting comparative UK-Japan trade mark research. Thanks to my co-author and Director of  
54 Studies, Dr Janice Denoncourt and my Supervisor, Associate Professor Graham Ferris for their encouragement  
55 and advice.

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59 <sup>3</sup> A Griffiths, Brands, 'weightless' firms and global value chains: the organizational impact of trade mark law  
60 (2019) Vol 39 Legal Studies 284-301, at p286.

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3 Olympic Brand Protection Guidelines, GIs and certain unique cultural and  
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5 linguistic aspects of the Japanese trade mark law system. (175 words)  
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10 **Keywords:** association right, *Benrishi*, brand, Brand Protection Guidelines, Japan,  
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12 Olympics; Tokyo 2020, trade mark; trade mark attorney.  
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17 Integral to the success of any brand launched in Japan is an understanding of the Japanese  
18 language, Japanese trade mark law and legal tradition. High profile foreign businesses have  
19 struggled to register marks in Japan due to the differences between the Japanese trade mark  
20 regime and their local national system and institutions. The McDonald's litigation,<sup>4</sup> for  
21 example, has been a lengthy and costly legal ordeal for the global brand. This article examines  
22 the Japanese trade mark law framework and offers a deeper insight into the Japanese trade mark  
23 registration system from a Western perspective, with a focus bringing a brand to the Japanese  
24 market in preparation for the Tokyo 2020 Olympics, adding to the limited academic literature  
25 specifically on the Japanese trade mark law and the *Benrishi*, the Japanese IP profession. Japan  
26 is ranked 13<sup>th</sup> on the Global Innovation Index, and its nominal GDP is the 3<sup>rd</sup> highest in the  
27 world. As the Japanese market is highly sophisticated and competitive, simply being a  
28 respected foreign brand does not guarantee success. Japanese consumers are extremely  
29 discerning and a foreign brand needs to be attuned to the Japanese market. The Tokyo 2020  
30 Olympics will provide a spectacular opportunity for foreign corporations to gain exposure for  
31 their brands with the Japanese, Asian tourists and opportunity for global exposure. The  
32 Japanese jurisdiction and trade mark regime are reliable and effective at supplying relative  
33 certainty, but that relative certainty requires a brand planning and prior investment. The  
34 commercial rewards for successfully establishing a brand in such an enormous market can be  
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<sup>4</sup> 10 Mutai Zaisan Hanreishuu, Shouwa 54 (O) 145, Shouwa 56-10-13

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3 substantial, if managed properly. The Tokyo 2020 Olympics offer a great opportunity for  
4 branding and marketing. Due to the scale, renown and visibility of the event, each Olympiad  
5 is an unparalleled opportunity for brand exposure and Japan is a hospitable jurisdiction,  
6 offering ready access to its market. Marketing in Japan provides exposure in other Southeast  
7 Asian markets, through the large volume of tourists that visit from neighbouring Southeast  
8 Asian countries, with arrivals from the People's Republic of China and Korea representing the  
9 majority. This article focusses on trade mark registration in the context of the Tokyo 2020  
10 Olympic Brand Protection Guidelines and critically discuss the unique cultural and linguistic  
11 aspects of the Japanese trade mark law system. There is a paucity of guidance, in English, with  
12 relation to Japanese legal processes. Although legislation is translated into English, there is a  
13 scarcity of English academic and practitioner commentary and literature with respect to the  
14 registration and use of trade marks. The Japanese legal tradition, the *Benrishi* IP Profession,  
15 linguistic and procedural differences are discussed next.

### 33 1. The Japanese legal tradition

34  
35 Historically, Japanese law was influenced by Chinese law and then developed independently  
36 during the *Edo* period.<sup>5</sup> However, since the late 19<sup>th</sup> century, the Japanese legal system has  
37 been largely based on the civil law of German. Japan's legislature, the National Diet of Japan,  
38 enacts laws with the approved of the Emperor as a formality. The main body of Japanese law  
39 originates with the Six Codes: the Constitution of Japan, Civil Code, Criminal Code,  
40 Commercial Code, Code of Civil Procedure and the Code of Criminal Procedure. As Japan  
41 has a civil law system, judicial decisions are not binding on lower courts. However, the  
42 precedents of the Japanese Supreme Court and the High Courts are regularly cited and are  
43 persuasive. Key English language literature examining the Japanese legal system includes John  
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59 <sup>5</sup> The *Edo* period is between 1603 and 1868 in the history of Japan, when Japanese society was under the feudal-  
60 style rule of the Tokugawa shogunate and the country's 300 regional daimyō.

Owen Haley's *The Spirit of Japanese Law*<sup>6</sup> and Kenneth L. Port *et al*, *Comparative Law: Law and the Process of Law in Japan*.<sup>7</sup> The *Trademark Act 1959* codifies the Japan registered trademark law framework. The Japanese Patent Office (JPO)<sup>8</sup> is the body responsible for dealing with trade mark applications. The *Unfair Competition Prevention Act 1993* is relied upon to enforce unregistered mark rights. While the JPO provides detailed information as to the various steps of registration, enlisting the help of a Japanese intellectual property (IP) expert or *benrishi* to engage in the trade mark application process is invaluable.<sup>9</sup>

Even for a lawyer from another jurisdiction, Japanese judicial sources are difficult to access. English translations of the 1959 and 1993 Acts are published with some delay from enactment, so it is possible to form a good idea of substantive statutory provisions, but Japanese case law is often not reported in English. The Supreme Court oversees the reporting of its own cases, as well as the cases of lower and specialist courts and cases falling into under specialist divisions.<sup>10</sup> The Japanese case search feature on the Supreme Court's website is relatively sophisticated, allowing for specific intellectual property searches to be undertaken, including for trade mark cases falling under the 1959 and the 1993 Acts respectively (the former tend to be filed under the trade mark and the latter under administrative cases).<sup>11</sup>

The primary difficulty arises from the brevity of Japanese law reports. The website allows the body of the case reports to be searched, but because Japanese law reports are very concise, it is difficult to find a case without knowing the exact date of the decision, which is the most

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<sup>6</sup> John Owen Haley, *The Spirit of Japanese Law* (Revised edn, University of Georgia Press 2006)

<sup>7</sup> Kenneth L. Port, Gerald Paul McAlinn and Salil Mehra, *Comparative Law: Law and the Process of Law in Japan* (3rd edn, Carolina Academic Press 2015)

<sup>8</sup> The Japanese Patent Office [www.jpo.go.jp](http://www.jpo.go.jp)

<sup>9</sup> Japan Office, 'Examination Guidelines For Trademarks | Japan Patent Office' ([jpo.go.jp](http://jpo.go.jp), 2019) <<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/index.html>> accessed 2 April 2019.

<sup>10</sup> Meryll Dean, *Japanese Legal System : Text, Cases and Materials* (2nd edn, Routledge-Cavendish 2002), 160

<sup>11</sup> Japanese Supreme Court, '裁判例情報' (2019) <[http://www.courts.go.jp/app/hanrei\\_jp/search1](http://www.courts.go.jp/app/hanrei_jp/search1)> accessed 24 June 2019

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3 effective way of retrieving a case (the date must be supplied in the format of the Japanese  
4 Imperial Calendar).<sup>12</sup> The English counterpart on the Supreme Court's website is far less  
5 detailed and contains far fewer cases. The search system also features fewer filters, but once  
6 again, the most effective method is to search by exact date. Japanese judicial citations do not  
7 include party names, which further exacerbates the difficulty of finding cases, especially in  
8 English.<sup>13</sup>

### 16 ***The Benrishi: Japanese Intellectual Property Attorneys***

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19 Given the lack of English language information on the workings of the Japanese trade mark  
20 system, the first step in establishing a brand in Japan is locating a local Japanese trade mark  
21 law expert, a *benrishi*.<sup>14</sup> The Japanese legal system is a somewhat closed one<sup>15</sup> with a strong  
22 local tradition.<sup>16</sup> The closest parallel to a qualified British trade mark attorney in Japan is a  
23 *benrishi* (弁理士 - べんりし).<sup>17</sup> Within the Japanese legal profession, the *benrishi* profession  
24 is comparatively small, highly specialised area of practice.<sup>18</sup> The proportion of lawyers to trade  
25 mark and patent attorneys in the UK and Japan is quite similar.<sup>19</sup> *Benrishi* are less numerous  
26 than *bengoshi* (advocates). Nonetheless, a sophisticated legal industry now exists in Japan to  
27 support foreign business activities in Japan. Trade mark and patent attorneys are increasingly  
28 common as trade mark law becomes more developed and refined with incremental growth as  
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44 <sup>12</sup> *Ibid.*

45 <sup>13</sup> Japanese Supreme Court, 'Judgments of the Supreme Court' (2019)  
46 <[http://www.courts.go.jp/app/hanrei\\_en/search?](http://www.courts.go.jp/app/hanrei_en/search?)> accessed 24 June 2019

47 <sup>14</sup> John O. Haley, 'The New Regulatory Regime for Foreign Lawyers in Japan: An Escape from Freedom'  
48 [1986] 5 UCLA Pacific Basin Law Journal 1

49 <sup>15</sup> Susan Sayuri Kigawa, 'Gaikoku Bengoshi Ho, Foreign Lawyers in Japan: The Dynamics behind Law No. 66  
50 Note' [1988] 62 Southern California Law Review 1489

51 <sup>16</sup> Bruce E. Aronson, 'The Brave New World of Lawyers in Japan: Proceedings of a Panel Discussion on the  
52 Growth of Corporate Law Firms and the Role of Lawyers in Japan' [2007] 21 Columbia Journal of Asian Law  
53 45, 67-80

54 <sup>17</sup> Patent Attorney Act 2000, Art.4(1)

55 <sup>18</sup> Japan Patent Attorneys Association, 'Membership Breakdown of the Japan Patent Attorneys Association'  
56 (2017) <<https://www.jpaa.or.jp/old/wp-content/uploads/DistributionMap2017.pdf>> accessed 2 April 2019;  
57 Kay-Wah Chan, 'Setting the limits: who controls the size of the legal profession in Japan?' [2012] 19  
58 International Journal of the Legal Profession 321

59 <sup>19</sup> 'A Career As A Trade Mark Attorney – An Overview | Graduate Jobs, Internships & Careers Advice - Inside  
60 Careers' (Insidecareers.co.uk, 2019) available at <https://www.insidecareers.co.uk/career-advice/a-careers-as-a-trade-mark-attorney> accessed 4 April 2019.

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3 the profession matures. According to academic Ruth Taplin, while there are numerous  
4 similarities, Japanese *benrishi* are not perfectly analogous with UK trade mark attorneys. The  
5 Japanese legal profession was established in the *Meiji* era<sup>20</sup>, predating UK trade mark attorney,  
6 but it did not assume its present form until much later. Before the significant legal changes in  
7 the past 20 years, *benrishi* were a type of auxiliary support personnel assisting in intellectual  
8 property (IP) matters alongside lawyers, who at the time had a much greater share of powers  
9 over legal procedures, including in matters of intellectual property law.<sup>21</sup> The changes of the  
10 past two decades have changed the *benrishi*, through incremental steps. They now enjoy much  
11 greater autonomy<sup>22</sup> from lawyers,<sup>23</sup> and they have the power to represent clients in adversarial  
12 proceedings and secondary matters arising in relation to trade marks, such as in the context of  
13 alternative methods of dispute resolution.<sup>24</sup>

14  
15 Although a *benrishi* is not, technically an equivalent for a UK trade mark attorney, a firm of  
16 *benrishi* will be competent to act in matters of trade mark registration and legal matters.  
17 Frequently, the trade mark specialist within a law or IP firm will be designated as a Patent  
18 Attorney specialising in trade mark law, and confusingly this is also the designation of a patent  
19 attorney or an expert in designs. This is not a universal convention. Oftentimes, firms will use  
20 Trade Mark Attorney as the solitary designation or Trade Mark and Patent Attorney. In other  
21 words, all trade mark attorneys are *benrishi*, but not all *benrishi* are trade mark attorneys.

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<sup>20</sup> The Meiji era (明治 Meiji) of Japanese history took place between 1868 to 1912 when radically new Western European ideas were adopted resulting in profound change to Japanese society, politics, the military its economy and foreign relations.

<sup>21</sup> 'History of the Japan Patent Attorneys Association | 日本弁理士会' (Jpaa.or.jp, 2019) at <https://www.jpaa.or.jp/old/?cat=673> accessed 2 April 2019.

<sup>22</sup> Lee Rousso, 'Japan's New Patent Attorney Law Breaches Barrier between the Legal and Quasi-Legal Professions: Integrity of Japanese Patent Practice at Risk Comments' [2000] 10 Pacific Rim Law & Policy Journal 781

<sup>23</sup> Ruth Taplin, 'Transforming intellectual property in Japan' [2007] KnowledgeLink newsletter from Thomson Scientific

<sup>24</sup> Patent Attorney Act 2000, Arts.4-6

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3 Due of the traditional nature of the Japanese legal profession,<sup>25</sup> <sup>26</sup> it can be difficult to contact  
4 a law firm outside of Japan to register a mark(s) in a seamless fashion, just as one might contact  
5 a French law firm to register a Community Trade Mark. Although Japan is a signatory to the  
6 Madrid Protocol<sup>27</sup> and it is possible to use the Madrid system, that system has its own share of  
7 problems, not the least of which is the vulnerability to central attack and the relatively narrow  
8 response windows to objections to registration and other administrative events which would,<sup>28</sup>  
9 in any case, prompt a prudent prospective trade mark proprietor or prudent undertaking to find  
10 a *benrishi* to be responsible for Japanese marks. The principal problem is the fact that the  
11 Madrid system did not establish a new type of trademark, and it is much less a trade mark  
12 regime than an international system to facilitate national trade mark registrations, which is what  
13 makes it vulnerable to central attack.<sup>29</sup> In the case of central attack, if the trade mark is  
14 expunged from the register and extinguished in the country of registration, it would necessarily  
15 be rendered invalid in Japan as well (there is an exception to this, as marks become immune to  
16 such challenge after 5 calendar years from registration)<sup>30</sup>. Superficially, this might not seem  
17 like a problem, but registration of certain marks in Japan, rather than in the foreign business  
18 home country may be easier. Interestingly, while there are 364 Italian entries in the WIPO<sup>31</sup>

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25 Terry LS, 'Putting the legal profession's monopoly on the practice of law in a global context' (2013) 82  
*Fordham L.Rev.* 2903.

26 John O. Haley, 'The Role of Courts in Making Law in Japan: The Communitarian Conservatism of Japanese  
Judges Symposium: Law in Japan and Its Role in Asia: Between East and West: Remarks' [2013] 22 *Pacific  
Rim Law & Policy Journal* 491

27 Protocol Relating to the Madrid Agreement Concerning  
the International Registration of Marks

28 Daniel C Schulte, 'The Madrid Trademark Agreement's Basis in Registration-Based Systems: Does the  
Protocol Overcome Past Biases (Part I)' [1995] 77 *J Pat & Trademark Off Soc'y* 595

29 John M. Murphy, 'Demystifying the Madrid Protocol' [2003] 2 *Northwestern Journal of Technology and  
Intellectual Property* 240

30 *Ibid*

31 TMview is a trade mark aggregator, aggregating trade marks from the IP offices of the EU member states, the  
EUIPO and WIPO, making it the largest collaborative trade mark database.



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3 Global Brand Database<sup>32</sup> for Prosciutto,<sup>33</sup> there are only 14 in the Japanese register,<sup>34</sup> the  
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5 foremost tool of trade mark examiners in Japan in evaluating identity and similarity. This is  
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7 closely connected with the system and register of well-known marks (see section 4.7). While  
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9 there is some protection for famous marks – generally marks which more than 50% of the  
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11 consumers recognise – there are few cases where the operation of well-known trade marks  
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13 produces the same outcome as successful central attack.<sup>35</sup> As Japan is a registration-based  
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15 system with a highly reified conception of trade marks, coupled with steep requirements for  
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17 the protection of unregistered marks, a Japanese registration is recommended where resources  
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19 and other circumstances permit.  
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26 If registration is sought in Japan, in addition to several other signatory states, a Madrid  
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28 application might be a good cost-saving measure,<sup>36</sup> but the Tokyo 2020 Olympic Games will  
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30 likely put pressure on the JPO trade mark examiners so speed is of the essence. Further,  
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32 objection proceedings will create legal-administrative impediments for those without the  
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34 assistance of a local expert.<sup>37</sup> The Japanese legal market makes a strong effort to cater to the  
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39 <sup>32</sup> World Intellectual Property Organisation (WIPO), 'Global Brand Database' (*World Intellectual Property*  
40 *Organisation*, 2019) is an aggregator of trade marks and emblems, aggregating the marks registered under the  
41 Madrid system, emblems registered under the Lisbon system and those protected as per 6ter of the Paris  
42 Convention, see <https://www.wipo.int/branddb/en/> accessed 9 June 2019. The GBD is an effective tool to  
43 perform a wide-ranging search to gauge the registrability of a mark across several jurisdictions. There is some  
44 variation in the level of sophistication of national trade mark databases, and the robust and refined search  
45 capabilities of the WIPO database, and its reverse image search capabilities make it a very useful tool.

46 <sup>33</sup> WIPO search: Prosciutto (wipo.int, 2019)

47 <https://www.wipo.int/branddb/en/index.jsp?q=%7B%22searches%22%3A%5B%7B%22te%22%3A%22BRAND%3Aprosciutto%22%7D%5D%7D> accessed 11 May 2019

48 <sup>34</sup> The present iteration of the Japanese Online Trade Mark Register does not produce a static link for searches,  
49 but the register can be searched at: J-Plat Pat (j-platpat.inpit.go.jp, 2019), see [https://www.j-](https://www.j-platpat.inpit.go.jp/t0100)  
50 [platpat.inpit.go.jp/t0100](https://www.j-platpat.inpit.go.jp/t0100) accessed 01 June 2019

51 <sup>35</sup> Jeffrey M. Samuels and Linda B. Samuels, 'International Trademark Prosecution Streamlined: The Madrid  
52 Protocol Comes into Force in the United States' [2004] 12 *Journal of Intellectual Property Law* 151

53 <sup>36</sup> Gerd F. Kunze, 'The Madrid system for the international registration of marks as applied under the Protocol'  
54 [1994] *European Intellectual Property Review* 223

55 <sup>37</sup> Almost all statistical indicators published by the Japanese Patent Office show a significant increase in the  
56 number of trade mark applications across the period of the last 3-5 years. Some of this increase can be attributed  
57 to an increase in the size of the economy and greater interest in the registration of trade marks, however the  
58 trend remains strong even when accounting for this possibility. Japan Office, 'Preliminary Statistical Data On  
59 Applications, Requests And Registrations | Japan Patent Office' (Jpo.go.jp, 2019) at  
60 [https://www.jpo.go.jp/e/resources/statistics/syutugan\\_toukei\\_sokuho/index.html](https://www.jpo.go.jp/e/resources/statistics/syutugan_toukei_sokuho/index.html) accessed 4 April 2019.

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3 needs of foreign undertakings.<sup>38</sup> Although there has been a diminution and a downward trend  
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5 in the operations of international, primarily Anglo-American, law firms in Japan they maintain  
6  
7 a strong presence in Tokyo, with a cadre of IP practitioners, including Japanese Patent  
8  
9 Attorneys – *benrishi* –often also admitted to the bar of the State of New York or California.  
10  
11 Such firms<sup>39</sup> and their *benrishi* are uniquely well-placed to act on behalf of foreign clients,  
12  
13 notwithstanding the use/registration difference between the trade mark regimes of the US and  
14  
15 most other jurisdictions worldwide.  
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22 Secondly, incorporating a company in Japan and working in conjunction with a local Japanese  
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24 partner e.g. to launch a brand or product, offers the benefits of local knowledge, a pooling of  
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26 resources and better apportioned risk, but it also has its perils. Such partnerships have not  
27  
28 always been successful, due to a lack of understanding of the Japanese trade mark registration  
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30 system and the fundamentals of who owns the registered trade mark rights can lead to  
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32 complications, which further necessitates the involvement of local IP experts.  
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38 It is also important to consider the constraints created by the International Olympic Committee  
39  
40 (IOC), the governing body overseeing the Tokyo 2020 Olympic Games. As per the agreement  
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42 with the IOC, the Olympic venues and their locality will be heavily policed to ensure that  
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44 unauthorised, non-Olympic Partner brands do not infiltrate them.<sup>40</sup> Official guidance has now  
45  
46 been published by the Tokyo Organising Committee (TOC). While the *Brand Protection*  
47  
48 *Guidelines* issued by the TOC does not have the power of legislation, it is sensible for firms  
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50 abide by the rules to avoid unnecessary disputes and ensuing negative publicity for the brand.  
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56 <sup>38</sup>See The Legal 500 Asia Pacific 2019: Japan: Intellectual Property: Recommended Law Firms, Lawyers'  
57 (Legal500.com, 2019) available at <http://www.legal500.com/c/japan/intellectual-property> accessed 1 April  
58 2019.

59 <sup>39</sup> Prominent firms include Baker McKenzie, Hogan Lovells and Morrison & Foerster.

60 <sup>40</sup> Katelynn Hill, 'Ambush Marketing: Is It Deceitful or a Probable Strategic Tactic in the Olympic Games  
Comments' [2016] 27 *Marquette Sports Law Review* 197

## 2. Branding and the Tokyo Olympics 2020 Brand Protection Guidelines

The IOC negotiates a contract with the host country, in this Japan, as a matter of course. The particulars of the Japanese host city contract are fairly standard, affording Japan with broadly the same rights and responsibilities as previous hosts, with incremental development of the contract through iterations of the Olympic games. As part of the host city contract, Japan has to satisfy the IOC that adequate safeguards are in place to protect the marketing interests of the official sponsors, who are required to pay the IOC large sums of money for the right to display Olympic indicia and to be associated with the event, and to have their trade marks displayed at the Olympic venue.<sup>41</sup> Consequently, the JOC's *Brand Protection Guidelines* should reassure stakeholders and clarify the legal position with relation to the use of marks, branding and advertisement in the context of the Tokyo 2020 Olympic Games.<sup>42</sup>

By way of background, past Olympiad host countries (such as the UK, host of the London 2012 Olympiad<sup>43</sup>) have enacted legislation that includes protection of Olympic brand, but enacting legislation is not a fundamental IOC requirement as long as there is adequate protection for the official sponsors' IP rights. The purpose of the Tokyo 2020 Olympic *Brand Protection Guidelines*<sup>44</sup> (the *Guidance*) is to protect Olympic sponsors and, by extension, the IOC's financial interests, by deterring ambush marketing<sup>45</sup> and IP infringement. The *Guidance* sets out are three prominent ways in which contravention may occur: (1) infringement of sponsor trade marks; (2) infringement of the trade marks; or (3) indicia of the IOC and introduction of

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<sup>41</sup> Benoit Séguin and Norman J O'Reilly, 'The Olympic brand, ambush marketing and clutter' [2008] 4 International Journal of Sport Management and Marketing 62

<sup>42</sup> Brand Protection Guidelines (1st edn, Version 4.3, JOC 2019) at <https://tokyo2020.org/en/copyright/data/brand-protection-EN.pdf> accessed 2 April 2019.

<sup>43</sup> London Olympic Games and Paralympic Games Act 2006, s.33

<sup>44</sup> *ibid*

<sup>45</sup> Ambush marketing occurs when a rival firm attempts to associate its products with an event, such as the Olympic Games, that already has official sponsors.

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3 non-sponsor marks to the Olympic venue.<sup>46</sup> Ambush marketing may occur in other ways as  
4 well, but unlike the infringement of the Olympic brand or the marks of the official sponsors, a  
5 marketing ambush is often a purely contractual matter, with no element of trade mark  
6 infringement.<sup>47</sup> Unlike the UK in anticipation of the 2012 London Games, Japan chose not to  
7 enact special legislation specifically to prepare the trade mark regime for the Olympics as it  
8 was determined that the existing IP legal framework sufficiently protects sponsor IP rights.<sup>48</sup>  
9  
10 As regards the marks of the IOC, they enjoy the baseline trade mark protection afforded to  
11 trade marks in Japan, on grounds of identity or similarity. The IOC, however, also enjoys a  
12 further layer of protection as it is an international organisation, so the trade mark examiners of  
13 the JPO are almost certain to refuse to register marks identical to or closely resembling the  
14 marks of the IOC.<sup>49</sup> All official sponsors are corporate entities, so they enjoy only the baseline  
15 protection. Trade mark law is, not strictly relevant to the two most prominent forms of ambush  
16 marketing. Most notably, any trade mark displayed inside of the Olympic venue is very likely  
17 to be construed by consumers as belonging to an official sponsor.<sup>50</sup> There are contractual  
18 arrangements in place to prevent an infiltration by non-sponsor marks, but this is a contractual  
19 matter.<sup>51</sup> Japanese contract law is codified and defines the rights and obligations of the parties  
20 generally. In practice, however, Japanese contracts are succinct, some say 'terse', and tend to  
21 contain very little detail in contrast with the level a detail in a traditional English law contract.  
22  
23 In Japan, the parties negotiate resolutions to complications as they arise.<sup>52</sup> However, in  
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50 <sup>46</sup> Tom Robinson and Lois Bauman, 'Winning the Olympic marketing game: recall of logos on clothing,  
51 equipment and venues at the 2006 Winter Olympics' [2008] 9 International Journal of Sports Marketing and  
52 Sponsorship 48

53 <sup>47</sup> Stephen Townley, Dan Harrington and Nicholas Couchman, 'The legal and practical prevention of ambush  
54 marketing in sports' [1998] 15 Psychology & Marketing 333

55 <sup>48</sup> Trademarks Act 1959, Arts 3(1) and 4(1).

56 <sup>49</sup> Art 4(1)(iii)

57 <sup>50</sup> Vikas Behal and Sania Sareen, 'Guerilla marketing: A low cost marketing strategy' [2014] 3 International  
58 journal of management research and business strategy 1

59 <sup>51</sup> Marc Mazodier, 'Ambush Marketing: Innovative or Immoral?' in Nicole Ferdinand and Paul Kitchin (eds),  
60 *Events Management: An International Approach* (11, 1st edn, Sage Publications Ltd 2012)

<sup>52</sup> J Denoncourt, *Q&A Business Law* (2009-2010) Routledge, Chapter 6, pp 57-58.

relation to the issue of ambush marketing, there does not appear to be any applicable trade mark or other IP laws which stipulate that displaying a non-sponsor mark inside of the Olympic venue is an infringing act. Nonetheless, it is to be expected that attendees, employees working at the venue and any other persons with the right to enter the premises would enjoy this right conditionally, and only to the extent that they do not introduce non-sponsor marks into the Olympic venue. The *Brand Protection Guidelines* also include a catalogue of words and terms associated with the Japanese Olympic and Paralympic Committee that are legally protected, as set out in Figure 1 below:

**Figure 1 Summary of the Tokyo 2020 Protected Olympic Terms**

<b>Names for the Tokyo 2020 Games of the XXXII Olympiad</b>	Tokyo 2020 Paralympic Games
<b>Abbreviated names for the Tokyo 2020 Games Tokyo 2020 Olympic Games</b>	Tokyo 2020 Olympic and Paralympic Games Tokyo 2020 Games Tokyo 2020
<b>Other terms (Examples) Olympics</b>	Olympism; Olympian; Olympiad; Paralympics; Paralympian Citius, Altius, Fortius Faster, Higher, Stronger Faster, Higher, Stronger (in Japanese) Spirit in Motion Olympic flame / Olympic flame relay Torch / torch relay Athletes of the Japanese Olympic delegation Athletes of the Japanese Paralympic delegation "Gambare! Nippon!" slogan

Source: *TOC Tokyo 2020 Brand Protection Guidelines*<sup>53</sup>

## 2.1. Olympic marks and Tokyo 2020

The IOC has registered numerous trade marks under its French name *Comité International Olympique* (as listed in the Japanese Trade Mark Register), but there is no specific registration for the preponderance of the listed words and phrases set out in Figure 1 above. There are general registrations, such as the mark 'Olympiad',<sup>54</sup> but it is likely that the IOC chose to forego registration of a host of marks as they would likely to be protected by Art.4 (1) of the *Japanese Trademark Act 1959* (TMA 1959). Marks such as the Olympic Motto '*Citius, Altius,*

<sup>53</sup> TOC Tokyo 2020 Brand Protection Guidelines

<sup>54</sup> Japanese Patent Office Trade Mark Registration 1128499

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2  
3 *Fortius*’, Latin for ‘Faster, Higher, Stronger’ fall under the protection afforded to a recognised  
4 international organisation under the TMA 1959. Furthermore, the IOC has 136 entries in the  
5 Japanese Trade Mark Database, 128 of which are registered and valid, whereas 8 await  
6 examination.<sup>55</sup> [Figure 1, a depiction of Romulus, Remus, the Capitoline Wolf, the Olympic  
7 Rings and the Roman numerals MCMLX as a trade mark] The marks are extremely varied,  
8 ranging from Lausanne 2020,<sup>56</sup> through Generation Rise,<sup>57</sup> to the Capitoline Wolf on top of the  
9 Latin numerals MCMLX and the Olympic Rings.<sup>58</sup> The number and variety of registrations  
10 would be difficult to navigate for any undertaking with the intent to register a mark which is  
11 even vaguely related to the Olympics, as any application is very likely to fall foul of the  
12 similarity, if not the identity exception to registration. [Figure 2, the word mark “Lausanne  
13 2020” in conjunction with the Olympic Rings as a trade mark] For the reasons outlined above,  
14 attempting to register a trade mark which bears even a superficial resemblance to any of the  
15 Olympic symbols or IOC marks is a risky endeavour. With the long window between filing a  
16 registration and the conclusion of the examination process, any delays are likely to push the  
17 registration date past the Tokyo 2020 Olympic games. A contentious mark which evokes the  
18 Olympic games in some way is almost certain to be contested by the IOC, the JOC and the  
19 official partners. Financial constraints permitting, it is a better alternative to attempt to register  
20 multiple high and low risk marks, to ensure that by the commencement of the Tokyo 2020  
21 Olympic Games, there is a registered mark to be affixed to goods. Whilst the marketing  
22 potential is strategic in terms of Tokyo 2020, trade marks are mostly registered for their  
23 potential to protect a brand in the long term, even long after the games have ended.  
24 Incorporating a limited company or Japanese GK as a special purpose vehicle (SPV) capable  
25 of acquiring, holding and disposing of IP assets such as trade marks will be discussed next.

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55 M Szarkiszjan undertook a search of the JPO Trade Mark Register on 13 June 2019.

56 Japanese Patent Office Trade Mark Registration 1205023

57 Japanese Patent Office Trade Mark Registration 1145441

58 Japanese Patent Office Trade Mark Registration 1145441

### 3. Incorporating to facilitate registering trade marks in Japan

During the Beijing 2008 Olympics, many prospective proprietors were faced with the problems of high barriers to market entry. A key factors were the operation of corporate law and incorporation<sup>59</sup> and technology transfer arrangements arising from the uneven bargaining positions of Chinese and foreign undertakings.<sup>60</sup> Although only as recently as in 2018, the PRC increased the percentage ownership cap of joint ventures between foreign and Chinese partners from 49% to 51%,<sup>61</sup> allowing a controlling share of the venture. As such, many foreign businesses contemplating a branding strategy for the Japanese market, might be reluctant to pursue incorporation in Japan or co-operation with a local partner, due to the less than optimal experiences of dealing with its northern neighbour, the PRC. However, these concerns need not apply to Japan in the same way and to the same extent. Incorporation in Japan is a straightforward process. Japanese company law is based on the Corporations Code 2006 and directors duties and shareholder liability rules are similar to the UK company law system in many respects. Therefore, with very limited exceptions, foreign legal and natural persons can own 100% of a Japanese *Kabushiki Kaisha* (K.K) (株式会社) or *Godo Kaisha* (G.K) (合同会社).<sup>62</sup> These are similar to UK public and private limited companies respectively. The former can be listed on the stock exchange, in contrast with the latter, which also has a pared down administrative structure and is less administratively onerous to maintain. Companies can be incorporated with as little as ¥1 paid up. A K.K. with capital of over ¥5,000,000 is also able to request investor visas.<sup>63</sup> The advantage of establishing a Japanese company is to facilitate

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<sup>59</sup> Paul W Beamish, 'The characteristics of joint ventures in the People's Republic of China' [1993] 1 Journal of International marketing 29

<sup>60</sup> Daniel C. K. Chow, 'A Comparison of EU and China Competition Laws that Apply to Technology Transfer Agreements' [2013] 9 I/S: A Journal of Law and Policy for the Information Society 497

<sup>61</sup> Xiaoyang Zhang, 'The legal framework governing business organisations in China: gaining an understanding of its general evolution' [2019] 2016 *Amicus Curiae* 6

<sup>62</sup> Companies (Japan) Act 2005, s.s(2)(i); Tom Nicholas, 'The Organization of Enterprise in Japan' [2015] 75 *The Journal of Economic History* 333

<sup>63</sup> Milos Debnar, *Individual migration, non-ethnic integration and challenges for the integration policies I in Japan* (2011)

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3 ownership, licensing and eventual disposal of the trade marks in that jurisdiction. Next we turn  
4 to the topic of selecting marks for the Japanese market and a critical analysis of the key  
5 linguistic and cultural considerations.  
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### 10 **3.1 Linguistic aspects of choice of Japanese word marks**

11  
12 In contrast with Indo-European languages, the Japanese language is structured differently, with  
13 a different writing system to all Indo-European languages, whether they be Cyrillic, Latin or  
14 other alphabets and writing systems. The Japanese language is predicated on syllables, in  
15 contrast with, for instance, English. While English makes use of syllables, the Latin alphabet  
16 used to construct English comprises characters which each correspond to a single sound. Japan  
17 does not have an alphabet. Rather, it has two broadly overlapping syllabaries, *hiragana* and  
18 *katakana* (*kana* collectively) and an ideographic set of symbols of Chinese origin – the *kanji*.  
19 These important linguistic features should be taken into account when choosing a trade mark,  
20 as semantics and aesthetics of the mark will be affected.<sup>64</sup>  
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#### 33 ***Japanese perceptions of aural similarity***

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35 A key consideration is how the Japanese perceive aural similarity. As much of the *kana*  
36 corresponds to syllables, there are very few freestanding sounds, such as a, i, u, e, o and n. As  
37 syllables are a more restrictive unit than sounds, as they permit for fewer permutations of the  
38 same length, the Japanese language is replete with homophones. Sammy and Sunny, for  
39 example, were considered by the Japanese judiciary to be aurally similar, despite differences  
40 in their visual appearance and the fact that in English they appear quite distinct.<sup>65</sup> Due to  
41 these characteristics of the Japanese language, the choice of trade mark can sometimes be  
42 difficult. The Japanese trade mark register includes the Romanised pronunciation of most  
43 registered trade marks. For example, the word mark Excelsior<sup>66</sup> will be aurally perceived by  
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58 <sup>64</sup> Roger Shuy, 'Using Foreign Language Words in Trademarks' in *Linguistic Battles in Trademark Disputes*  
59 (Palgrave Macmillan UK 2002) at [https://doi.org/10.1057/9780230554757\\_12](https://doi.org/10.1057/9780230554757_12) accessed on 14 June 2019.

60 <sup>65</sup> [THC] 23/07/1991 273 Tokyo to Kigyo 42

<sup>66</sup> Japanese Patent Office Trade Mark Registration 1759770



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2  
3 the Japanese public as “ekuserushiooru” or “ikuserushio”. Some words can be rendered in  
4  
5 Japanese without such a conversion, but words with multiple consonants without much  
6  
7 interspersion by vowels cannot.  
8  
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### 10 ***Visual similarity and Japanese writing***

11  
12 The Japanese language has a different relationship with its principal writing system, the *kanji*,  
13  
14 compared to the relationship between the Latin alphabet and the English language. 物 and 生  
15  
16 can be read as ‘mono’ and ‘shou’ respectively, and they mean ‘thing’ and ‘life’. In conjunction,  
17  
18 生物 becomes ‘seibutsu’ and means life form. In other words, *kanji* changes its reading and its  
19  
20 meaning in conjunction with other *kanji* and *kana*. The Chinese symbols, in use in Japanese,  
21  
22 are not bound to a single sound, instead they are building blocks used to construct words in an  
23  
24 intuitive and variable way. To successfully communicate with and attract Japanese consumers,  
25  
26 it is important to be cognisant of the operation of these two phenomena. *Kanji* is intuitive, not  
27  
28 static, so it is best to avoid combining *kanji* in a way which treats individual ideographs as  
29  
30 constants, as they are not constants but variables. As noted, Japanese is rich in homophones,  
31  
32 and the aforesaid operation of the writing system is necessary to aid in ascertaining the intended  
33  
34 meaning of words. In speech and longer writings, the meaning of a word can be intuitively  
35  
36 ascertained using the available context. Unfortunately, with trade marks, there is often no  
37  
38 context. Without knowing that the marke NIKE is derived from the name of the Greek goddess  
39  
40 of victory, it might be difficult to ascertain the intended pronunciation of the mark. This  
41  
42 problem is exacerbated in Japanese by the dynamic fluidity of the *kanji*. 御柱祭 can be  
43  
44 pronounced as “mihashira-matsuri”, “onbashira-matsuri”, “mihashirai-sai” or “onbashira-sai”.  
45  
46 All of these readings mean *Mihashira* Festival, *matsuri* and *sai* being two of the possible  
47  
48 readings for 祭 or festival. However, *matsuri* and *sai* are aurally very different and they would  
49  
50 be perceived as aurally akin to different sets of prior registrations. It is also very likely that 御  
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3 柱祭 would not be visually similar to a mark it shares aural similarity with.<sup>67</sup> This is in contrast  
4  
5  
6 with something like the visual and aural similarity of the words Wagamama and Rajamama.<sup>68</sup>  
7  
8 Trade mark examiners and Japanese courts are keenly aware of and take into account these  
9  
10 factors. This is understandable given the significant proportion of advertising which employs  
11  
12 non-Japanese script.<sup>69</sup>  
13  
14  
15 Therefore, the most important consideration in choosing a trade mark is how Japanese  
16  
17 consumers would perceive the mark both aurally and visually. This deeper understanding of  
18  
19 the layers of difficulty in selecting an appropriate mark for the Japanese market will support  
20  
21 preliminary trade mark searches. Further, foreigners will be better placed to communicate their  
22  
23 instructions and understand advice received from Japanese *benrishi* when determining brand  
24  
25 strategy for the Japanese market.  
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27

### 28 ***Transliteration issues and registering foreign marks in Japan***

29  
30 Further, it is not self-evident that a registration for a mark in *kana*, *kanji* or Romanised form  
31  
32 covers the others. It is very likely that the courts will afford protection, but it is not automatic,  
33  
34 as the systems of transliteration<sup>70</sup> are imperfect and numerous.<sup>71</sup> The most prominent  
35  
36 romanisation styles are Hepburn, Hepburn Revised, Nihon-Shiki/Kunrei-shiki and JSL, but  
37  
38 none are universally accepted or the true, correct style of Romanisation, as they all only  
39  
40 approximate native Japanese pronunciation. Similarly, Japanese speakers try to approximate  
41  
42 the native language pronunciation of words, most commonly English. The author's name  
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44 Martin, for example, can be pronounced in a rhotacised fashion, a non-rhotacised fashion, with  
45  
46 a silent 'r', with a glottal stop or some combination of these. It can, therefore be rendered as  
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53 <sup>67</sup> *Toyoshimaya v Suwa Taisha* [THC] 04/08/1998 Han-Ji Issue 1660, 120

54 <sup>68</sup> *Wagamama Ltd v. City Centre Restaurants PLC* [1995] FSR 713; P Jaffey, 'Likelihood of association'  
55 (2002) 24(1) *European Intellectual Property Review* pp3-8

56 <sup>69</sup> [THC] 26/05/1992 5904 Sokuho 205

57 <sup>70</sup> Transliteration is a type of conversion of a text from one script to another, whereby letters are swapped in  
58 predictable ways.

59 <sup>71</sup> Shusaku Yamamoto & John A. Tessensohn, 'A *bigen* or not a *bigen*, that is the question' (1996) 18 *European*  
60 *Intellectual Property Review* 640-644

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3 “Maa-chin“, “Maru-chin“, “Maa-tin“, “Maru-tin“, “Ma-tin“, “Mar-in“ and so on. Although the  
4  
5 first two are the most likely contenders, as ‘ti’ is a less common rendering than ‘chi’, the  
6  
7 possible transliterations are still numerous.<sup>72</sup> Accordingly, the prudent choice is to provide  
8  
9 multiple transliterations when filing a trade mark application in Japan. Although there is  
10  
11 evidence that this is not necessary, and Japanese courts take an analytic perspective, a better  
12  
13 deterrent is a precise registration which precludes, rather than wins, litigation.<sup>73</sup> The objective  
14  
15 of the Japanese trade mark register search, under such time constraints is not to find a mark  
16  
17 which is theoretically registrable, but one which is likely to avoid harsh scrutiny at the  
18  
19 examination stage and opposition upon publication, to be discussed further in section 4 below.<sup>74</sup>  
20  
21 Once a mark has been selected, the next stage is to engage in the Japanese trade mark  
22  
23 registration process.  
24  
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#### 28 **4. Registering a Trade Mark in Japan**

29  
30 A trade mark application must be filed with the Japanese Patent Office or JPO. The application  
31  
32 must specify the particulars of the mark applied for, such as the name and address of the  
33  
34 applicant and the class or classes applied for within the context of the Japanese trade mark  
35  
36 classification system for goods and services.<sup>75</sup> While Japan does not discriminate against  
37  
38 foreign undertakings with respect to incorporation and trade mark registration, the latter is a  
39  
40 laborious and protracted process for Japanese and foreign persons alike. There is little over a  
41  
42 year remaining until the commencement of the 2020 Olympiad, and this necessitates that all  
43  
44 due haste be taken in relation to the registration process. Trade mark registration in Japan, as  
45  
46 elsewhere, is a lengthy affair for the examiners, involving an extensive search to be conducted  
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48 in increasingly greater numbers as Tokyo 2020 approaches. The examination stage is a lengthy  
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56 <sup>72</sup> Hideo Okada, ‘Japanese’ [1991] 21 *Journal of the International Phonetic Association* 94

57 <sup>73</sup> *Ibid*

58 <sup>74</sup> Masaya Suzuki, ‘The trademark registration system in Japan: a firsthand review and exposition’ [2001] 5  
59 *Marq Intell Prop L Rev* 133, 175

60 <sup>75</sup> *Ibid*, 144

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2  
3 process, not the least because the Examiners must take particular care to ensure the smooth  
4 operation of the market and competition. Presently, the Japanese examination process can take  
5 just under a year to over 3 years conclude,<sup>76</sup> which does not necessarily result in a trade mark  
6 registration. An initial refusal, or heavy objections can supervene to extend the registration  
7 period beyond the commencement date of the 2020 Olympiad.  
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11  
12 American global brand, General Electric, is one of the Worldwide Olympic Partners of the  
13 IOC. GE recently succeeded in registering their “GE90” trade mark registration in Japan, which  
14 is an international Madrid registration, based on a 2002 US<sup>77</sup> registration. The filing date for  
15 their Japanese application was 12/11/2015 and the trade mark was registered four years later  
16 on 08/02/2019. The long delay has been caused by a refusal to register by the examiner,  
17 followed by a request to appeal request lodged on 30/06/2017. Although the mark was  
18 eventually registered, the timeline makes it clear that a refusal to register at the examination  
19 stage will almost assuredly delay grants beyond the date of the 2020 Olympics. However, Intel,  
20 another WOP sponsor, used their existing US<sup>78</sup> registration through the Madrid system, with a  
21 Japanese filing date of 28/12/2016 which was granted under two years later 28/09/2018.  
22 Panasonic, also a WOP sponsor, bypassed the Madrid system altogether by filing an application  
23 directly in Japan with a filing date of 12/07/2018 and grant date of 26/04/2019, reducing the  
24 time from filing to grant even further.<sup>79</sup> GE’s Madrid application with appeal took 1184 days,  
25 whereas without opposition proceedings, Intel’s Madrid application took 639 days. In contrast,  
26 Panasonic’s application was filed directly in Kadoma-shi, Osaka and proceeding without any  
27 opposition proceedings. Panasonic Japanese trade mark registration only took 288 days from  
28 application to grant. Considering the applicable time constraints, a direct application in Japan  
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57 <sup>76</sup> Japanese Patent Office Trade Mark Registration 2561930; International Registration 1291316

58 <sup>77</sup> Japanese Patent Office Trade Mark Registration 2561930; International Registration 1291316

59 <sup>78</sup> Japanese Patent Office Trade Mark Registrations 87979748 & 87275464; International Registration 1361992

60 <sup>79</sup> Japanese Patent Office Trade Mark Registration 6140990

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3 is the recommended, if not the preferred course of action. The author has confirmed that  
4 applications by the other major sponsors such as Alibaba,<sup>80</sup> Bridgestone,<sup>81</sup> Samsung,<sup>82</sup> etc., all  
5 follow similar trends.  
6  
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#### 10 **4.2 The Japanese Trade Mark Law Regime**

11  
12 [In general, the trade mark regime of Japan resembles the regimes of the wider WIPO  
13 membership. To this end, Japan, since the end of the economic bubble period, has been striving  
14 to attract foreign businesses to participate in its market. The principal legal instruments  
15 governing the trade mark regime are the Trademark Act 1959 and the Unfair Competition  
16 Prevention Act 1993. The 1959 Act is the flagship statute governing the procedural elements  
17 of trade mark registration, use, infringement and ancillary matters. The 1993 Act governs  
18 matters pertaining to unregistered trade indicia, and it is superficial analogue of the law of  
19 passing off, although the standard for protection is much less charitable than under passing off  
20 in common law regimes.  
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##### 33 ***Registration of traditional and non-traditional marks***

34  
35 Art.2(1) of the 1959 Act defines registrable subject-matter as “among those recognizable by  
36 human perception, any character(s), figure(s), sign(s) or three-dimensional shape(s) or colours,  
37 or any combination thereof, sounds, etc. provided by Cabinet Order”. Since 1 April 2015, the  
38 TMA 1959 has been revised to permit the registration of non-traditional trademarks. In  
39 particular, olfactory, gustatory and tactile marks cannot be registered in Japan at present, but a  
40 host of traditional and non-traditional marks, such as text, 3-D, auditory, motion and  
41 holographic marks can. As the crux of the test is human perception, the onus will be on the  
42 applicant to demonstrate that the mark can be represented in a human-perceptible fashion.<sup>83</sup> As  
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55 <sup>80</sup> Japanese Patent Office Trade Mark Registration 5980200, non-Madrid, no opposition: 340 days

56 <sup>81</sup> Japanese Patent Office Trade Mark Registration 6138644, non-Madrid, no opposition: 267 days

57 <sup>82</sup> International Registration 1359116, Madrid, no opposition: 556 days, cf. Reg.No.6087904, non-Madrid, no  
58 opposition: 354 days

59 <sup>83</sup> Michiru Takahashi, ‘Japan: Amendment To Trademark Act Of Japan - New Marks, Including Color Marks  
60 And Sound Marks, Can Be Protected’ *mondaq* (www.mondaq.com)

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2  
3 noted earlier, there is little time remaining to register a trade mark comfortably to be used  
4 during the Olympiad. Non-traditional trade mark applications are liable to invite resistance on  
5 part of the examiners, if for no other reason than due to their lower prevalence and definitional  
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noted earlier, there is little time remaining to register a trade mark comfortably to be used during the Olympiad. Non-traditional trade mark applications are liable to invite resistance on part of the examiners, if for no other reason than due to their lower prevalence and definitional nebulosity.

### ***Absolute Grounds of Refusal***

Art.3(1)(i) sets forth the exceptions to registrability, namely that an application which "consists solely of a mark indicating, in a common manner, the common name of the goods or services" is not registrable. Under Art.3(1)(i) marks which are descriptive or customarily used to describe goods, marks which denote place of origin, sale, quality or other terms and words which are not used to directly describe the goods, but which describe the particulars of its production or use are not registrable. Likewise marks which consist only of a common name or surname, marks which are not suitable to allow consumers to discern the pertinent undertaking, other than if the mark, through use, had acquired such distinctiveness as to allow consumers to discern the associated undertaking, in spite of the ostensibly generic nature of the indicia.

This provision is subject to "genericide" (extinction and subsequent expungement of a mark which has become a generic word through its own success) and acquired distinctiveness. Kaminari Okoshi (雷おこし) is a type of Japanese confectionery. Although there was once a registration for *Kaminari Okoshi*, through extensive use in the Asakusa area of Tokyo, the mark lost its distinctiveness and became a byword for crispy rice sweets known today as Kaminari Okoshi.<sup>84</sup> With acquired distinctiveness this occurs in reverse, and a previously generic terms comes to be associated with an undertaking. This is what happened in the *khaki*

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<<http://www.mondaq.com/x/338350/Trademark/Amendment+to+Trademark+Act+of+Japan+New+Marks+Including+Color+Marks+and+Sound+Marks+Can+Be+Protected>> accessed 2 April 2019

<sup>84</sup> *Tokiwado v Abe* [SC] 08/04/1975 Han-Ji Issue 779, 56

1  
2  
3 *cha or persimmon tea* case.<sup>85</sup> At first instance the Khaki Cha mark was considered common, as  
4  
5 it indicated the common name of the goods. However, on appeal, the Tokyo High Court decided  
6  
7 that the mark, through prolonged use and association with a commercial undertaking, acquired  
8  
9 distinctiveness.<sup>86</sup> *Juicy (juushii)*, likewise, is a generic descriptor for fluids, however, the mark  
10  
11 was permitted registration as consumers have come to associate the English word  
12  
13 overwhelmingly with the applicant.  
14  
15

16  
17 Under Art.3(1)(iii) there is provision for a further set of exclusions for words which are  
18  
19 customary within the pertinent industry. *Junsei* (genuine) is the customary word for first party  
20  
21 car parts in the Japanese automobile industry and consequently the court held a registration for  
22  
23 *Junsei* invalid in the *Takagi v Daihatsu*<sup>87</sup> case. Geographic location marks are likewise covered  
24  
25 under Art.3(1)(iii), and acquired distinctiveness is applicable. In *Georgia Coffee*,<sup>88</sup> the  
26  
27 principal consideration was whether the consumers could distinguish between the semantic  
28  
29 meaning of the words and the trade mark representing an undertaking. In the *Georgia Coffee*  
30  
31 case such acquired distinctiveness was held to be absent, In contrast with the *Waikiki* case.<sup>89</sup>  
32  
33 The circumstances of the latter case concerned the sale of hygiene products and toiletries under  
34  
35 the Waikiki Beach name. Through prolonged and systematic use, the Japanese public came to  
36  
37 associate Waikiki Beach foremost with such products. Registration was ultimately denied, but  
38  
39 it was not for lack of acquired distinctiveness, but due to the operation of Art. 4(1)(xvi), as the  
40  
41 mark was considered liable to mislead consumers, as the goods had no connection to Waikiki  
42  
43 Beach in Hawaii.  
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55 <sup>85</sup> [TDC] 30/11/1994 Han-Ji Issue 1521, 139; *Biochemical Research Institute v Genoa* [THC] 18/01/1996 Han-Ji  
56 Issue 1562, 116

57 <sup>86</sup> Shusaku Yamamoto & John A. Tessensohn, Written in the tea leaves, [1996] 18 *European Intellectual*  
58 *Property Review* 107 18 (2), 107-109

59 <sup>87</sup> *Takagi v Daihatsu Motors* [TDC] 19/07/1976 Han-Ji Issue 841, 49

60 <sup>88</sup> *Coca-Cola Co. v JPO* [SC] 23/01/1986 Han-Ji Issue 1186, 131

<sup>89</sup> *K.K. Otsuka Medical v K.K. Sanseido* [SC] 10/04/1979 Han-Ji Issue 927, 233

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2  
3 Art. 4(1) covers what, in the UK, falls under absolute and relative grounds of refusal to register  
4 a trade mark – marks which for normative or relative reasons are not to be registered, in contrast  
5 with the marks discussed above which are to be refused registration only to the extent that they  
6 are unable to indicate the trade mark proprietor associated with them (semantically this is a  
7 type of relative ground as well) – to the extent that they can not transcend the genericity of the  
8 mark. Restrictions concern, amongst others, marks such as the imperial chrysanthemum crest,<sup>90</sup>  
9 or the crest or heraldry of a foreign nation, state emblems<sup>91</sup> or the crest or symbol of an  
10 international organisation or supra-national organisation such as the EU<sup>92</sup> or a well-known  
11 mark or a symbol indicating control by a state or organisation. Furthermore, it also covers  
12 marks which are liable to cause damage to public policy.<sup>93</sup> Although not specifically in the  
13 wording of the statute, marks which are morally repugnant are also considered by the trade  
14 mark examiners as well as the courts to fall under this provision.

#### 30 **4.6 Relative Grounds of Refusal**

31  
32  
33 The relative grounds for refusal provide also that a mark is not registrable to the extent that it  
34 is identical with or similar to another mark filed *prior in tempore*, or if it is identical with or  
35 similar to a defensive mark (a well-known mark, for which the Japanese Trade Mark Database  
36 has a sub-section).<sup>94</sup> A defensive mark affords a type of status, title or protection which adheres  
37 to a mark which is well-known.<sup>95</sup> This latter protection is an enhancement of the baseline trade  
38 mark right, and a defensive mark covers additional registration classes, so using a mark on  
39 cutlery, similar to a well-known or famous mark for petrochemical products would fall foul of  
40 the provisions, despite the vast difference between the class of goods and services.  
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55 <sup>90</sup> Art.4(1)(i)

56 <sup>91</sup> Art.4(1)(ii)

57 <sup>92</sup> Art.4(1)(iii)

58 <sup>93</sup> Art.4(1)(vii)

59 <sup>94</sup> Art.4(1)(xii)

60 <sup>95</sup> Kenneth L Port, 'Protection of Famous Trademarks in Japan and the United States' [1996] 15 Wis Int'l LJ 259



1  
2  
3 Although Japan uses a system of registration, well-known trade marks are structurally closer,  
4 in their operation, to trade marks granted in use-based systems. In contrast with traditional,  
5 registered trade marks, a well-known mark is created through opposing proceedings and  
6 judicial action. The subset of trade marks which have been found to be well-known are entered  
7 into the database of well-known and defensive trade marks, as the two are aggregated. Whether  
8 a mark is well-known is judged in relation to the knowledge of the Japanese public.  
9

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16  
17 Evangelion,<sup>96</sup> for instance, is a famous Japanese animated television and film series. The brand  
18 is well-known in Japan, as the registration attests, but the same level of renown might not be  
19 present across other countries. Similarly, Kakicha is well-known in Japan, but it enjoys  
20 relatively little renown outside of Japan.<sup>97</sup> The requirement that a mark should be well-known  
21 can be set aside under specific circumstances, where the mark concerned pertains to a speciality  
22 product not likely to garner a large base of consumers outside of specific industries. It is also  
23 not always necessary that the goods associated with the mark should have been marketed in  
24 Japan. The popular IT magazine *Computerworld* was considered to be well-known despite not  
25 being made available to Japanese consumers as, the court reasoned, the publication was well-  
26 known within the industry.<sup>98</sup>  
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#### 39 40 **4.7 Database of Well-Known Trade Marks**

41  
42 The Japanese Database of Well-Known Trade Marks serves the convenience of businesses,  
43 providing a resource which can be consulted to ascertain which marks are well-known.  
44 However, it cannot be used, through elimination, to ascertain which marks are not. As a  
45 requirement of inclusion is judicial recognition, there are likely to be numerous marks which  
46 have yet to be included in the database due to a lack of involvement in litigation to date. Hiroko  
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58 <sup>96</sup> Reg.No.3324699, khara, Inc., Suginami-ku, Tokyo

59 <sup>97</sup> Reg.No.1318401, SEIKAGAKUKENKYUSYO CORPORATION Sakaide-shi, Kagawa.

60 <sup>98</sup> *CW Comm v Dempa Newspaper Han-Ji* ([THC]) 1992.

1  
2  
3 Onishi's Well-Known Trade Marks: A Comparative Study of Japan and the EU,<sup>99</sup> Hiroshi  
4  
5 Oda's work entitled, *Japanese Law*<sup>100</sup> for more detailed information.  
6  
7

#### 8 **4.8 Defensive trade mark registration strategies**

9  
10 A defensive trademark strategy involves the owner of a well known mark applying for a trade  
11  
12 mark in a class of goods or services not intended to be used by the owner. The purpose of filing  
13  
14 a defensive trade mark application is to reduce the possibility of other traders using the trade  
15  
16 mark for unrelated goods or services. In other words, defensive marks provide a further layer  
17  
18 of protection for a brand. However, before a mark can be designated as a defensive mark, it  
19  
20 needs to be well-known. There is no requirement that the goods or services should be similar  
21  
22 to a registered class, or that the mark should be used in conjunction with other goods or services.  
23  
24 The legal requirement for a mark to be recognised as well-known is for over 50% of consumers  
25  
26 to recognise it. A defensive mark also offers protection against subsequent applications which  
27  
28 seek, indirectly, to leverage the reputation and goodwill associated with a well-known mark.  
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#### 33 **4.9 McDonald's experience partnering with a local Japanese business**

34  
35 As discussed in section 2 above, it is relatively easy to set up a limited company in Japan and  
36  
37 the relationship with the Japanese partner may smooth the way for the brand to enter the  
38  
39 Japanese market. Most common law, continental and mixed legal regimes have trade mark  
40  
41 systems which permit original acquisition of trade marks through a system of registration. This  
42  
43 is in contrast with the US, one of the very few jurisdictions which operates on the basis of use  
44  
45 of a mark. In the *Makku Sangyo*<sup>101</sup> case for example, the legal team of McDonald's  
46  
47 unfortunately disregarded this crucial legal difference leading to prolonged litigation in Japan.  
48  
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51 [In essence, McDonald's local Japanese business partner was unwilling to relinquish the trade  
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57 <sup>99</sup> Hiroko Onishi, *Well-Known Trade Marks: A Comparative Study of Japan and the EU* (1st edn, Routledge  
58 2015)

59 <sup>100</sup> Hiroshi Oda, *Japanese Law* (3rd edn, Oxford University Press 2011)

60 <sup>101</sup> *Supra* note [4]

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2  
3 marks which it had registered<sup>102</sup> for the purposes of the partnership, in its own name to  
4  
5 McDonald's. Fortunately, McDonald's was able to rely on the *Japanese Unfair Competition*  
6  
7 *Prevention Act 1993* to recover its trade mark rights through an order for transfer of title.  
8  
9  
10 However, it took over 10 years for McDonald's, now an official sponsor the Tokeyo 2020  
11  
12 Olympics, to be granted this remedy by the Japanese court. When dealing with a local Japanese  
13  
14 partner, appropriate contractual safeguards should be in place to avoid a similar situation.  
15  
16 [McDonald's had a very good business case for the the global brand to devote substantial  
17  
18 resources and expenditure over a decade to enforce its legal rights in Japan. This luxury may  
19  
20 be less accessible to other firms wishes to establish their brands in Japan.  
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22  
23

## 24 **5. Unregistered marks**

25  
26 There is a further class of marks in Japan which are important for the purposes of conducting  
27  
28 a thorough search and to ensure that a mark applied for is registrable. Unregistered marks,  
29  
30 despite the name, are a category of their own, altogether distinct from passing-off or well-  
31  
32 known marks. These marks are not only unregistered, but they are not susceptible to  
33  
34 registration. The marks are added through ministerial designation, and the Japanese database  
35  
36 also indexes the marks within the same category designated by the World Trade Organisation.  
37  
38 The preponderance of these marks belong to international organisations, agencies and other  
39  
40 bodies, such as the International Energy Agency<sup>103</sup> or Association of Southeast Asian  
41  
42 Nations.<sup>104</sup>  
43  
44  
45

### 46 ***No law of 'passing off' exists in Japan***

47  
48 As a civil law country, Japan does not have a law of passing off to protect unregistered marks.  
49  
50 Under a case of passing-off (were it to exist in Japan, which it does not), for example, an  
51  
52 undertaking would have to establish, every time, the existence of goodwill at first instance.  
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58 <sup>102</sup> Japanese Patent Office Trade Mark Registrations 2066698; 2319342; 2188712

59 <sup>103</sup> Japanese Trade Mark Register Public Notice Number 206-1.

60 <sup>104</sup> Japanese Trade Mark Register Public Notice Number 246-6.

## 6. Is there a Tokyo 2020 Olympic Association Right?

The association right is the legal right to be associated with the Olympic Games conferred upon a corporation by virtue of being an Olympic sponsor. It was originally created by the *London Olympic Games and Paralympic Games Act 2006*, s.33. Structurally, the association right is similar to an IP right. Without an association right, it is not lawful to claim, explicitly or implicitly, to be associated with the Olympic Games. The association right lifts this restriction, and the IOC leverages the restriction in order to encourage sponsors and prospective sponsors to make sponsorship payments in return for the competitive advantage of being associated. In the run up to the London 2012 Olympiad, the bespoke Olympic legislation was criticised for been overly restrictive, especially for smaller businesses. Although the UK employed such a right in complying with its contract with the IOC, the association right is only one of many ways to comply with the pertinent Host City Contract (the contract between the IOC and the host state setting out the terms of the Olympiad). The association right is not a traditional form of IP protection and is better described as the right to identify oneself as an official Olympic sponsor. For the RIO 2016 Olympics, Brazil introduced similar legislative provisions. At the apex of the sponsorship pyramid is the Olympic Partners programme which in Rio 2016 included global brands such as Coca-Cola, McDonalds, Samsung and Visa. These top tier sponsors generated US\$957m for the IOC in the 2009-2012 period.<sup>105</sup> The sponsors are granted worldwide Olympic marketing rights and category exclusivity (e.g. beverage, food, technology, finance). The IOC distributes more than 90% of Olympic marketing revenue across the movement, including to national committees, their Olympic teams and athletes. Commercial partners help to fund the games.<sup>106</sup>

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<sup>105</sup> G S Gangjee, Is the IOC's protection of the Olympic brand over the top? (2016) *The Conversation at* <http://theconversation.com/is-the-iocs-protection-of-the-olympic-brand-over-the-top-62914> accessed on 14 June 2019

<sup>106</sup> Ibid

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5  
6 In contrast to the British and Brazilian approach, the JOC opted to rely on the existing Japanese  
7  
8 consumer and IP rights legal framework and host city contract instead of opting to introduce  
9  
10 legislation to formalise a Tokyo 2020 association right. However, the JOC has produced the  
11  
12 Olympic Brand Protection Guidelines discussed in section 2 above to educate against and  
13  
14 minimise the likelihood of ambush marketing.  
15

### 16 17 **7. Geographic Indications & Regional Collective Marks** 18

19  
20 Geographic indications in Japan are protected by the *Protection of the Names of Specific*  
21  
22 *Agricultural, Forestry and Fishery Products and Foodstuffs Act 2014* (entered into force in  
23  
24 2015) or the *Geographic Indications Act 2015*. Note that regional collective marks are distinct  
25  
26 from GIs, despite the overlap of function and substance-matter. Regional collective marks are  
27  
28 governed by Art.7.2(1) of the TMA 1959, and structurally this is a type of trade mark right.  
29

30  
31 The Ministry of Agriculture, Forestry and Fisheries is responsible for regulating GIs in Japan.  
32  
33 Although GIs are not formally recognised as trade marks, they function in a similar way.  
34  
35 Whereas with trade marks, goodwill is thought to accrue to an undertaking, with a GI, the  
36  
37 goodwill accrues to the geographic locality. The purpose of GIs is to protect the goodwill  
38  
39 accruing to the *terroir* (the environmental factors responsible for the product's unique  
40  
41 character) and to prevent its dilution and diminution in value and regard, and to protect  
42  
43 consumers from confusion. The process for registering a foreign GI is somewhat more involved  
44  
45 than a trade mark application. Art.7 sets out the requisite information which must be supplied  
46  
47 by the group of producers applying for the GI, which pertains principally to the geographic  
48  
49 definition of the producing region and the production methods which, upon successful  
50  
51 application, will be the defining characteristics of the protected goods. The MAFF issues a  
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3 public notice<sup>107</sup> and there is a three month window for opposition.<sup>108</sup> Following the notice  
4  
5 period, the MAFF consults experts with relevant knowledge of the subject-matter<sup>109</sup> and taking  
6  
7 into account the opinions of the experts, the Minister of Agriculture, Forestry and Fisheries  
8  
9 will either implement the registration<sup>110</sup> or refuse to register the GI.<sup>111</sup>

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11  
12 Regional Collective Marks are different as they protect standard trade mark subject-matter,  
13  
14 with some variation as to the particulars of the ownership of the mark. They can be applied for  
15  
16 by bodies or consortia representing a regional industry, such as the Consorzio del Prosciutto di  
17  
18 Parma, which is a consortium of Prosciutto di Parma producers in Italy.

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20  
21 The TMA 1959 is drafted in such a way that Art. 3(1)(i) states that marks which consist “solely  
22  
23 of a mark indicating, in a common manner, the common name of the goods or services” are not  
24  
25 to be registered. Art.7.2(1) provides that an authorised body is able to register “*trade mark*  
26  
27 *consisting solely of characters indicating, in a common manner, the name of the region and*  
28  
29 *the common name of the goods or services pertaining to the business of the applicant or its*  
30  
31 *members.*” However, Art.7.2(1) goes on to qualify by adding “*except a case falling under item*  
32  
33 *(i) or (ii) of Article 3(1).*” Due to the circular logic of the provisions, the Japanese courts have  
34  
35 in some cases considered generic subject-matter unregistrable due to the exception to the  
36  
37 exception.<sup>112</sup>

## 41 42 **8. The EU-Japan Economic Partnership Agreement**

43  
44 The EU-Japan Economic Partnership Agreement entered into force on 1 February 2019. UK  
45  
46 undertakings currently trade with Japan under the terms of the agreement, but prior to the  
47  
48 agreement the UK and Japan were trading on World Trade Organization rules. Under most  
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53 <sup>107</sup> Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs Act 2014,  
54 Art.8.

55 <sup>108</sup> *Ibid.*, Art.9.

56 <sup>109</sup> *Ibid.*, Art.11.

57 <sup>110</sup> *Ibid.*, Art.12.

58 <sup>111</sup> *Ibid.*, Art.13.

59 <sup>112</sup> Kenneth L Port, ‘Regionally Based Collective Trademark System in Japan: Geographical Indicators by a  
60 Different Name or a Political Misdirection’ [2015] 6 *Cybaris Intell Prop L Rev* 2

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3 Brexit scenarios the UK would leave the EU with a transition period. Before the extension until  
4  
5 October 2019, the UK was scheduled to depart the EU in March 2019, and the transition period  
6  
7 was to last until the end of 2020, with room for extension by bilateral agreement.<sup>113</sup> This would  
8  
9 allow UK businesses to take advantage of the EU-Japan agreement for the duration of the 2020  
10  
11 Olympics, but the long term trade relationship between the UK and Japan would depend on the  
12  
13 substantive deal, or lack thereof, between the UK and the EU. There is the prospect of a Japan-  
14  
15 UK trade agreement, but Japan primarily requires an entry point to the single market, and the  
16  
17 UK's ability to successfully negotiate a trade agreement will depend on the terms and degree  
18  
19 of access it can offer to the EU markets.  
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## 24 **9. Conclusions, Reflections & Recommendations**

25  
26 Japan has a very well developed IP law regime with multiple databases of trade mark  
27  
28 registrations and restricted indicia spanning decades of registrations. However, knowledge of  
29  
30 the law and registers is a pre-requisite for minimising the risk of a refusal to register at the  
31  
32 examination stage and heavy opposition upon publication. There is also a register of well-  
33  
34 known trade marks and defensive marks. In addition, coats of arms and other heraldry and  
35  
36 crests and symbols of international organisations, are designated by WIPO or through  
37  
38 ministerial designation by the Japanese executive. There is also a database of figurative  
39  
40 elements, in line with the Vienna classification system and GIs. Although the Japanese  
41  
42 jurisdiction and markets do not discriminate against foreign undertakings, impediments to  
43  
44 market entry exist, especially in the realm of trade mark registration largely due to linguistic  
45  
46 reasons. (The barriers are high, but not insurmountable with careful planning.) The UK's  
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58 <sup>113</sup> *Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the*  
59 *European Union and the European Atomic Energy Community, as endorsed by leaders at a special meeting of*  
60 *the European Council* (2018), 195, Art.126.

1  
2  
3 China IPR SME Helpdesk,<sup>114</sup> and the EU-Japan EPA Helpdesk<sup>115</sup> both offer resources and  
4 services for UK and EU businesses contemplating working in Japan. The Japanese Law in  
5  
6 Asia-Pacific Socio-Economic Context, a University of Sydney Blog is also useful.<sup>116</sup>  
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11  
12 Whilst the Tokyo 2020 Olympics will focus intense global attention on Japan, the country has  
13 always been a popular tourist destination, and most tourists travel to Japan from China, as well  
14 as other Southeast Asian countries. Visitor arrivals from Mainland China and South Korea  
15 were in the range of 8.3 and 7.5 million respectively in 2018.<sup>117</sup> The 2020 Olympics will attract  
16 an even greater number of affluent Chinese and South Korean consumers. For business, a  
17 robust marketing campaign, underpinned by branding and legally protected trade marks, can  
18 lay the foundation for further expansion into other Southeast Asian markets. The Tokyo 2020  
19 Olympic Games are imminent, and the window for registering a trade mark is fast becoming  
20 prohibitively narrow. It is possible that an undertaking might aim only to exploit the  
21 opportunity presented by the Olympics, but the infrastructure necessary for such a purpose can  
22 also provide a foothold and a bridge to the Japanese market in the long term. A corporate  
23 presence in Japan creates a more convenient and proximate means of controlling and exploiting  
24 IP rights and has the additional benefits of enabled staff to transfer to Japan, whether in the  
25 short or the long term, as well as facilitate visa requirements. Japanese law is mostly a  
26 combination of legal transplants from western legal systems. The paucity of translated sources  
27 and the language barrier can make the Japanese legal system seem very distant, certainly  
28 against the background of the inter-operability of the legal and IP professions in the EU, and  
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54 <sup>114</sup> European IP Helpdesk, 'China IPR SME Helpdesk' (*European IP Helpdesk*, 2019)  
55 <<https://iprhelphdesk.eu/china-helpdesk>> accessed 14 June 2019

56 <sup>115</sup> EU-Japan Centre, 'EU-Japan EPA Helpdesk' (2019) <<https://www.eu-japan.eu/epa-helpdesk>> accessed 14  
57 June 2019

58 <sup>116</sup> 'Japanese Law in Asia-Pacific Socio-Economic Context' (*University of Sydney*, 2019)  
59 <<http://blogs.usyd.edu.au/japaneselaw/>> accessed 14 June 2019

60 <sup>117</sup> Japan Tourism Statistics, 'Breakdown by Country/Area' (2019)  
<<https://statistics.jnto.go.jp/en/graph/#graph--breakdown--by--country>> accessed 14 June 2019



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2  
3 particularly trade mark attorney profession. Foreigners must navigate the linguistic and  
4  
5 cultural differences, yet expert counsel can be costly. Most foreign businesses will not have a  
6  
7 nuanced understanding of the local Japanese legal services. This can be alleviated by enlisting  
8  
9 the services of international law firms operating in Japan, at a cost. Meanwhile, the Japanese  
10  
11 legal profession has a strong local tradition, and it is prudent for commercial undertakings to  
12  
13 have expert counsel such as the *benrishi*. The time from filing a trade mark to grant can span  
14  
15 over 3 years and if there are opposition proceedings much longer. By briefing a *benrishi*, it is  
16  
17 possible to reduce the administrative delay intrinsic to the Madrid system.  
18  
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23  
24 While the Japanese jurisdiction and trade mark regime are reliable, effective and provide  
25  
26 relative certainty for brand owners, that relative certainty requires a prior investment. The  
27  
28 Tokyo 2020 Olympics will provide a spectacular opportunity for official sponsors, global  
29  
30 brands owned by large corporations. As for smaller companies, the commercial benefits are  
31  
32 less clear. On a positive note, however, the lack of Japanese Olympics legislation to enforce a  
33  
34 restrictive Tokyo 2020 Olympics association right is a far less strict approach, than the last two  
35  
36 Olympiads. The JOC has simply issued fairly brief Olympic Brand Guidelines and a list of  
37  
38 Olympic words, terms and logos not to be used by non-sponsors - a more flexible, less strict  
39  
40 approach than a legislative regime of fines and crimes. The Japanese approach is pragmatic  
41  
42 and avoids the heavy handedness of the London 2012 games to non-official sponsors.  
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51 **(11,072 words)**  
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