

**Comparative Analysis of Refusal of
Trade Mark Registration on Moral and
Public Policy Grounds in Japan and
the United Kingdom**

by

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Abstract

This thesis is a comparative, jurisprudential work, dedicated to the exposition and comparative analysis of the trade mark regimes of the United Kingdom and Japan, in the context of the Absolute and Public Policy grounds for refusal to register a trade mark.

Based on the comparative and legal-theoretical analysis, the author has found that there are numerous points of legal convergence and divergence between the two jurisdictions. However, there are considerable differences in the pattern of divergence and convergence in terms of the cause and reason behind instances of convergence or divergence.

Much of the divergence is in the area of the protection of unregistered marks, whereas there is considerable convergence in the protection of registered trade marks. The divergence in the area of unregistered marks, however, is proportionately less significant. The protection for unregistered marks account for the exception to the rule, and because of the inexpensive nature of trade mark registration and the availability of trade marks, the divergence is less prominent overall.

There is a common and pervasive notion in the historic scholarship about the Japanese disposition, especially towards litigation and conciliation. Japanese

people are incorrectly portrayed as litigation-averse. The true cause of the suppressed litigation rates in Japan is availability, including due to the pre-war suppression of the legal profession and judicial activity.

Finally, the World Intellectual Property Organization and the Agreement on Trade-Related Aspects of Intellectual Property Rights are responsible for a harmonising effect in the area of trade mark law. The trade mark regimes of the UK and Japan are thus harmonised, to some extent. However, these factors cannot account for the entirety of the harmonisation, as the contemporary reified, registration-based model had existed in Japan and the UK prior to the inception of WIPO or the TRIPS agreement.

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1 Introduction

Japan and the United Kingdom both attract considerable interest in a very broad range of areas. Both countries boast large and powerful economies and both export a vast volume of culture. There is scarcely a person on Earth unfamiliar with the UK or Japan, who has no conception of what they are like.

In legal academia these opinions are far more cautious, but it is probable that prior to a detailed investigation, most scholars comparatively approaching the two jurisdictions would have some idea of what to expect in legal and legal-cultural terms, even if they have no significant prior experience of working with or within either of the two jurisdictions.

It seems intuitive that both legal systems would have distinctive traits, as they belong to distant branches of different legal traditions. It also seems intuitive and compelling that their differences in specific fields would be exacerbated by their idiosyncrasies and eccentricities. This is probably a reliable assumption in a wide range of areas, and it likely rings more true the further one travels back in time.

In truth, however, it is not so evident and obvious that Japan and the UK are vastly different in terms of the standard, underlying features of their respective legal systems and, particularly, intellectual property regimes.

The focus of this thesis is trade mark law, and it is through the lenses of trade mark law that this thesis approaches the matter. This is an important distinction because trade mark law is

different from many other fields of law. Whereas many areas of law, including property law, evolve gradually and incrementally through the shared experiences of all the people who participate in them, intellectual property typically has a different course of evolution.

The most evident and compelling characteristic of most models, conceptions or understandings of intellectual property law, including trade mark law, is that they are instrumental systems. That is not to suggest that those areas are lacking in instrumental value and utility – it is merely that you are not designed in the same top-down fashion as, for example, trade mark regimes.

In the second and third chapters, following the present introductory chapter, this thesis will investigate the prevailing state of affairs in the field of trade mark law in the respective jurisdictions. These are the substantive chapters and, in order to be in a position of being able to reason about the nature and essence of the two jurisdictions or about how similar they are to each other, it is vital to investigate what their trade mark regimes are like in the first place.

Chapter 4 will launch into comparative and jurisprudential analysis, and this is going to be the most extensive and largest chapter with commensurate discussion of the relevant comparative and jurisprudential approaches which are necessary in order to be able to reason about not only the underlying technical systems, but the normative principles which inspire and demand them.

Understandably, reasoning about something so abstract, elusive and complex is difficult, and

ordinary, customary and familiar vocabulary and phenomenology is often not suited to completely and accurately describe phenomena which do not conform to the experiences and phenomenology of a legal practitioner or legal scholar operating in a particular system of laws and, by extension, a particular, shared cognitive system for operating effectively and without friction in a particular legal system.

That familiar idiomatic legal understanding becomes a hindrance to comprehending what are, fundamentally, abstractions and abstract values which exist within legal systems. However, they can be understood and they can be described and reasoned about accurately through neutral, descriptive language, paradigms and phenomenology. By eliminating the idioms and abbreviations familiar from most legal systems, it is possible to transcend the misleading connotations of terms and concepts which are far from universal across legal systems. This is the objective of Chapter 4.

The objective of Chapter 5, in turn, is to wield the knowledge obtained in Chapter 4 through comparative and jurisprudential techniques, and provide an analysis of the normative principles which permeate society and the societal features which, in turn, influence the practical outcomes which investigation might reveal in a legal system.

The purpose of Chapter 6 is to provide historical and cultural analysis by leveraging the totality of all the conclusions arising from the various different fields previously discussed, in order to try to ascertain the reason as to why the two legal systems have evolved as they have and to draw general conclusions as to why cultures and legal systems evolve in particular ways.

Chapter 7 is, in turn, the concluding chapter and it will provide a summary of and conclusion of the matters which have been raised and discussed in the context of the thesis. The overarching purpose of the comparative element of this thesis is, as the definition of the discipline implies, to compare legal systems. However, a legal system for the purposes of the present comparison is not simply the substantive law of a jurisdiction, but a much broader ecosystem where complex and interconnected processes take place.

Fundamentally humans influence the course of a system's evolution, and humans are the intended users of any legal system. Accordingly, the ultimate comparative analysis of the two legal systems is also a comparative analysis of more than just what the law governing trade mark registration is, but also the manner in which the people in the respective jurisdictions engage with the system.

1.1.1 Absence of Substantive Moral/Normative Conclusions

It is vitally important to account for the subject-matter and contributions of the thesis at the outset, however, it is also important, in the present case, to mention what this thesis does not purport to do. The notion of moral analysis can easily imply that the point or one of the points of the thesis is to discuss the rightness or wrongness of some or all parts of a particular legal edifice. This is not the case here.

It is not an objective of this thesis to argue as to the rightness or wrongness of the features of either jurisdiction or discuss the ethical merits of any particular position, such as one might

in a discussion about topics such as the justifications for the various forms of intellectual property or the rectitude of imposing criminal penalties for some forms of IP violations. These are ethical discussions involving value-judgments about normative entities. This thesis does not involve such value-judgments about normative entities. It is a discussion of norms, with an indifference to their rectitude.

The reason for this is simply that the objective and the very broad methodology of this thesis is to critically assess the status quo and explain the how and why of its establishment.

1.2 *Central Argument of Thesis*

The central and overarching argument of this thesis pertains to the levels of divergence or convergence between the legal systems of Japan and the United Kingdom, with relation to trade mark registration, including the principles which operate in this area, as well as the protection of unregistered marks through the respective systems which the trade mark regimes furnish to this end.

The beginning point of this analysis is in the substantive laws of the respective legal systems. Chapters 2 and 3 are the substantive chapters dedicated to the substantive analysis of the Japanese and UK trade mark regimes. Their purpose is to describe the laws with relation to the registration of trade marks and the acquisition of trade mark rights, as well as the protection of unregistered marks.

1.2.1 **The Substantive Chapters**

The substantive chapters will demonstrate that, in a black letter sense, the laws of the UK

and Japan with relation to trade mark registration are highly convergent.¹ In a functional sense, they serve much the same purpose in much the same fashion. In contrast, it will be demonstrated in the substantive chapters that there are differences in the way that the Japanese and UK legal systems protect unregistered marks.² As will be discussed, this protection differs in a practical and theoretical sense, where the UK protects goodwill through the tort of passing-off, whereas the Japanese trade mark regime provides protection for reputation/fame through its system of protection for well-known and famous marks.³ The underlying question for the purposes of Chapters 2 and 3 is, therefore, whether the trade mark regimes are similar on a substantive analysis, before undertaking the comparative and jurisprudential assessments of Chapter 4?

1.2.2 The Comparative and Jurisprudential Chapter

Chapter 4 will use the expository information which has been described in Chapters 2 and 3 to undertake comparative and jurisprudential analysis.

This is a functional comparative analysis, and the chapter will look at the subject-matter from the perspective of functionalism and functional equivalency. Furthermore, the jurisprudential analysis will use a Dworkinian framework⁴ to define the scope of the applicable subject-matter, especially as unlike the UK, Japan does not have a formalized system of binding precedent. Accordingly, it is useful to discuss the issue in the Dworkinian sense, talking about rules and principles which interact in a shared legal ecosystem.⁵

With regard to the central argument, it will be argued that there is a significant degree of

¹ *Infra* 2.7 & 3.8

² *Infra* 2.4 & 3.5

³ *Ibid*

⁴ *Infra* 4.3

⁵ *Ibid*

convergence between Japan and the UK in terms of their registration-based, reified trade mark regimes, not the least because their legal systems are internationally harmonised to be alike.⁶

Furthermore, it will be argued that while there is a significant measure of convergence with relation to the treatment of registered trade mark, there is a measure of divergence regarding unregistered marks. The UK and Japan protect their unregistered marks differently, with such marks being protected by the tort of passing-off in the UK, and in Japan by the protections afforded to well-known and famous marks, requiring regional and nationwide reputation and fame respectively.⁷ Accordingly, it will be argued that the UK and Japan protect goodwill and reputation respectively, and despite some overlap, in circumstances where a mark has both, at least, regional reputation and goodwill, these protections are not completely convergent.

The central question in this chapter, which it is intended to answer, is whether there is broad convergence or divergence between the Japanese and UK trade mark regimes across the identified areas, and what is the extent and nature of such convergence and divergence?⁸

1.2.3 **The Moral Principles & Societal Analysis Chapter**

Chapter 5, the chapter on moral principles and societal analysis, continues the analysis where Chapter 4 had concluded it. This chapter is dedicated to the discussion of moral principles, especially in the context of society.

One of the postulations of older scholarship on Japan, as well as proponents of the

⁶ *Infra* 4.10

⁷ *Infra* 4.13

⁸ *Infra* 4.15

Nibonjinron movement,⁹ proposing a unique and uniquely Japanese disposition, is that Japanese people are intrinsically conciliatory and not disposed towards litigation and the disharmony it produces.

It will be argued in this chapter that while there is a tendency of rule-following within Japanese society, and politically a related tendency towards centralisation and strong, centralised governments, as exemplified by the Liberal Democratic Party (LDP)¹⁰ of Japan, Japanese people are not considerably different from their peers elsewhere in terms of the ways they interact with the trade mark regime – that they are not uniquely conciliatory and averse to litigation and the zero-sum situations which it can create.¹¹ This analysis will also consider the legal history of Japan, with a focus on the anti-legalism of the pre-war years.¹²

This chapter will also highlight international truthfulness, as an important moral principle which transcends the boundaries of the trade mark regime. It does operate in a trade mark context, but as will be discussed in greater detail in this chapter, it is much broader and uniquely Japanese.¹³

International truthfulness, in the trade mark context, generally manifests itself as a type of extraterritorial, trade mark comity. It will be demonstrated that the principle is broader, and it highlights that it is a unique feature of the Japanese legal system. It is likely not ancient and indigenous, in the sense of hearkening back to before the Ritsuryou system, but it is likely a

⁹ *Infra* 5.3

¹⁰ *Infra* 5.4.1, 5.4.3, 5.6

¹¹ *Infra* 5.4.4

¹² *Infra* 5.3

¹³ *Infra* 5.6

more recent indigenous development which exemplifies and encapsulates uniquely Japanese mores and norms.

Accordingly, the central question in this chapter is whether the Japanese have a uniquely conciliatory, anti-legalist disposition and, importantly, whether international truthfulness is a uniquely Japanese principle or entity, which encapsulates uniquely Japanese moral principles and norms? Furthermore, if it is unique, does this mean that there is a degree of divergence compared to the UK, in this matter?¹⁴

1.2.4 **The Historical and Cultural Analysis Chapter**

Chapter 6 employs a related, albeit different, perspective. This chapter is dedicated to historical and cultural analysis, including legal and general history, as well as linguistics, especially with relation to the Japanese language. This chapter will serve the central thesis through an analysis of the legal history of the respective legal systems.

Despite significant differences in the legal history and evolution of the respective legal systems,¹⁵ there is considerable historic convergence of legal paradigms in the context of trade marks. Despite the postulations of the earlier scholarship about the uniqueness of the Japanese disposition and tendency towards conciliation, there is broad convergence in the domain of trade marks, irrespective of the different historical experiences of the respective legal systems.¹⁶ While, admittedly, there is a tendency of rule-following amongst the Japanese public, as discussed in the previous chapter, and despite the differences of geography and language and the fact that Japan belongs to the Civil Law, rather than Common Law,

¹⁴ *Infra* 5.8

¹⁵ *Infra* 6.2

¹⁶ *Infra* 5.3, 6.2

tradition, the modern Japanese trade mark regime appears convergent also from a historic perspective.¹⁷ Indeed, an important element of the legal history of Japan, whether with relation to the Ritsuryou code, the Civil Law system or the post-war American influence, is that Japan is very receptive to legal transplants, not on a moral, deontological basis, but solely on pragmatic grounds.¹⁸ It is receptive to adopting a legal system which meets its needs, such as with the registration-based, reified trade mark systems in the present, economically interconnected era.

The central question of this chapter is whether, the TRIPS agreement is mostly or wholly responsible for the harmonisation and similarity of the UK and Japan, or perhaps some of the similarity can be ascribed to, simply, to natural legal-evolutionary processes and the Japanese receptiveness to legal transplants? Not the least because both the Trademark Act 1959 and the Trade Marks Act 1938,¹⁹ precursor to the current Trade Marks Act 1994, establish registration-based, reified systems akin to their modern versions/successors.

¹⁷ *Infra* 6.2

¹⁸ *Ibid*

¹⁹ *Infra* 2.5

1.3 *The Challenges Encountered in the Course of Research and Writing*

1.3.1 **Availability of Resources**

Comparative law research with relation to Japan is intrinsically difficult due to the relative scarcity of comparative writings on the topic. The preponderance of comparative writings which deal with Japan are either not in English or they do not compare Japan directly with the United Kingdom. Resources which compare Japan with jurisdictions other than the United Kingdom exist, but they are not exceedingly numerous, and they tend to be somewhat older.²⁰

The Japanese academic publishing system and the Japanese-speaking segment of academia are, from a Western viewpoint, quite self-contained and arguably insular. This is due to a combination of the linguistic ability demanded by academic publications in the west, the cumbersome process of publication and the availability and the relative speed of Japanese publishing. The Japanese academic publishing industry is large. Taking into account the population size of Japan, the academic output of the country is enormous. However, the secondary effect of the size of the Japanese academic publishing industry is that for most academics in Japan, most of whom are Japanese native speakers, publishing in western and international publications is neither a career necessity, nor an important career aim, as there is ample opportunity in Japan. Not only is there ample opportunity but the process of

²⁰. Kenneth L Port, *Trademark and Unfair Competition Law and Policy in Japan* (Carolina Academic Press 2007); John Owen Haley, *The Spirit of Japanese Law* (University of Georgia Press 2006).

publication is typically much shorter as well.²¹

As a result of this, a considerable amount of Japanese scholarship, not just in the legal field, but in all of Japanese academia, is never published in English, so there is a complete disconnection between the Japanese and global academic communities, and the availability of Japanese scholarship in English depends largely on the scholars who constitute the exceptions to the trend.²²

Comparative law, comparing Japanese law with other legal systems, has long existed. Virtually all jurisdictions across the world are in a constant state of legal evolution. While there has been interest in the Japanese legal system and in Japan as a political-legal entity in the past hundreds of years, due to the aforesaid evolution, the comparisons of the 20th century are not exceedingly useful in the context of trade mark regimes and trade mark registrations. The United Kingdom maintains continuous, unbroken link with its past institutions due to the nature and circumstances of the Common Law. The history of the Japanese legal system, however, has been too tumultuous and teeming with large structural changes for the historic comparative writings to retain much relevancy to the contemporary legal system and trade mark regime.

Because of the reduced relevancy of past scholarship and due to political and legal evolution in the intervening decades, there is no established way of comparing the legal systems of Japan and the United Kingdom. There is no body of scholarship which exists as a point of

²¹ Jeremy Seymour Eades and others, 'Why Don't They Write in English?': Academic Modes of Production and Academic Discourses in Japan and the West' (2000) 6 *Ritsumeikan Journal of Asia Pacific Studies* 58.

²² *ibid.*

reference, which could be used as a basis for discussing Japan-UK trade mark law comparisons. There is no powerful economic, historic or social connection between the United Kingdom and Japan, and Japan-UK trade amounts to only approximately £27,500 million. In contrast, the aggregate trade with the EU is approximately £615,000 million. Although it is possible that despite the relatively smaller volume of trade, the two countries might maintain strong ties which warrant an interest and investment in comparative law research, there is no indication that this is the case, nor any other supervening reason for an extraordinary volume of scholarship to exist, despite little incentive to carry out such scholarly work.

There is a general paucity of Japanese law resources in English. However, this paucity does not extend to Japanese intellectual property legislation. The World Intellectual Property Organization hosts WIPO Lex²³ a repository of IP law texts - primarily legislation - of the world's IP regimes. This work uses the translations of the Trademark Act 1959 and the Unfair Competition Prevention Act 1993 available through WIPO Lex.

Furthermore, www.japaneselawtranslation.go.jp is also relied on in a corroborative role. The JPO itself links to this resource on its website,²⁴ and the two sources are used, in conjunction, to corroborate their contents.

1.3.2 Linguistic Differences

It might seem convenient and easy to dismiss the linguistic differences as simply the

²³ 'WIPO Lex' <<https://www.wipo.int/web/wipolex>> accessed 14 June 2024.

²⁴ 'Information for Holders of International Registrations Seeking Extension of Protection to Japan under the Madrid Protocol | Japan Patent Office' <https://www.jpo.go.jp/e/system/trademark/madrid/japan_under_the_madrid_protocol.html#anchor7> accessed 28 June 2024.

differences in the way identical information is expressed using two analogous albeit different syntactical rulesets i.e. languages. Ostensibly, they are merely different languages, however, languages as cognitive constructs reflect far more than mere collections of vocabulary and syntactical rules.

A large portion of the challenge of learning a language is not in learning the vocabulary or the syntactical rules, but the phenomenology of a society. Idioms like “hit the hay”, “see eye to eye” or “cut corners” are used to express ideas which are vastly different from their literal meaning. Such idiomatic language is an expression of the phenomenology of a society, people or some other social ordering. Such phenomenology also exists in the legal realm where legal practitioners and scholars speak a superset of their natural language – a type of legal sociolect complete with its own phenomenology.²⁵

For example, in the Japanese language, the conceptual differences between blue and green are blurred. For the better part of Japanese history, the only term which existed to describe these two colours was *ao* or *aoi*, which means blue. The term *midori* has only proliferated in the last hundred years as the discrete adjective for green things.²⁶ Accordingly, green traffic lights are readily described by Japanese people as blue, and in the idiomatic Japanese language, green traffic lights are rightly blue. Similarly, the idiomatic way to say that one is a trade mark attorney is: “I do trade mark attorney”. In contrast with English which relies on a noun, Japanese uses an auxiliary verb *suru* to express the same idea through a verb – through action.

²⁵ Matthew S McGlone, Sam Glucksberg and Cristina Cacciari, ‘Semantic Productivity and Idiom Comprehension’ (1994) 17 *Discourse Processes* 167.

²⁶ Anna Wierzbicka, ‘The Meaning of Color Terms: Semantics, Culture, and Cognition’ (1990) 1 99.

Linguistic differences are discussed in passing here, but they will be the subject of more thorough examination in subsequent chapters, principally Chapter 6.²⁷

²⁷ *Infra* 6.7, 6.8, 6.9

1.4 *Literature Review*

1.4.1 **Primary Authors**

Kenneth L. Port

The late Professor Kenneth L. Port (1960-2019) has been primary contributor to the comparative study of Japanese trade mark law from a western perspective. Port was principally a comparatist with an interest in Japan, which is reflected in his bibliography of works. His initial, more extensive contribution to a broader understanding of Japanese trade mark law has been his book *Japanese Trademark Jurisprudence*.²⁸ Despite the title, this book is not a book of legal theory, but an exposition of Japanese statutory law and judicial practice in the field of trade mark law. The writing has been published in 1998, and due to important changes in the Japanese trade mark regime, serves more as a guide to the broad, overarching legal structures which define the foundation of the Japanese trade mark regime. Although the substantive law may since its publication have changed, the fundamental nature of the Japanese trade mark regime, is unchanged.

Japanese Trademark Jurisprudence has since been superseded by a more recent book written by Port: *Trademark and Unfair Competition Law and Policy in Japan*.²⁹ This latter book is an iteration of Japanese Trademark Jurisprudence, but considerably more current, due to its initial publication date of 2007, and improved also in terms of the breadth and depth of comparative analysis. The book can be viewed as an enhanced version of its antecedent.

It is notable that Port's approach to the exposition of Japanese law has been driven by his

²⁸ Kenneth L Port, *Japanese Trademark Jurisprudence* (Wolters Kluwer 1998).

²⁹ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20).

approach as an American theorist. His two primary books are written from the American perspective, and much of his exploration of Japanese law is presented in a language which is eminently sensible to an American readership. This creates a cognitive overhead when using the texts, but as intellectual property is a highly harmonised discipline, in terms of the language and terminology used in the context of discussing intellectual property, his works are just as helpful and informative for the purposes of the present thesis as if they had been written from a UK perspective.

Port also commented more broadly on Japanese comparative law in *Comparative Law: Law and the Legal Process in Japan*.³⁰ This is a more general writing, commenting on the various aspects of Japanese law with the approach of a comparatist.

Port has written quite broadly on a host of trade mark or trade mark related issues as well as Japanese topics, but he focussed, to a great degree, on Japanese trade mark law in the context of his two books on the topic. Despite the importance of Port's works to the thesis, they are written primarily in a substantive, exploratory fashion. The objective of his writings was to provide an exposition of the Japanese trade mark regime from an American perspective, and there is no broader exploration of the cultural dimension, including factors driving the evolution of the Japanese legal system. Accordingly, it was necessary incorporate a body of legal research focussed more on the historic and social elements of Japanese law and legal history.

³⁰ Kenneth L Port, *Comparative Law: Law and the Legal Process in Japan* (Carolina Academic Press 2003).

John Owen Haley

John Owen Haley, is likewise a comparatist, but his focus is considerably more jurisprudential than that of Kenneth L Port. Although Haley does not have a specific trade mark focus, his principal contribution is in the context of the theoretical structure of the Japanese law. His most important work for the purposes of the present thesis is *Authority without Power: Law and the Japanese Paradox*.³¹ *Authority without Power* is an in-depth discussion of the characteristics of Japanese law. Haley takes a comprehensive approach in discussing contemporary legal structures, and there is considerable discussion of the historical background which had led to the development of the contemporary legal system. The book is not solely expository, and Haley makes a persistent effort to identify not only what the Japanese legal system is like, but why it has come to be that way. He also goes to great lengths to portray the Japanese legal system as it truly is, not necessarily as a cursory, superficial analysis might depict it. Haley also provides an analysis of the development of the Japanese legal profession from the time of the Meiji Restoration, including a historical analysis of the development of the Japanese legal profession and historic attitudes to traditional values, litigation and historic, socially conservative anti-legalism, which is now the principle school of analysis used to explain contemporary Japanese attitudes to litigation and litigiousness.

Haley has written extensively on a host of other, narrower topics in the context of East Asia and Comparative law. His other notable books on the topic are: *The Spirit of Japanese Law*,³² *Legal Innovations in Asia: Judicial Law-making and the Influence of Comparative Law* and *Comparative Law: The Contemporary Civil Law Tradition in Europe, Latin America, and*

³¹ John Owen Haley, *Authority without Power: Law and the Japanese Paradox* (Oxford University Press 1994).

³² Haley, *The Spirit of Japanese Law* (n 20).

East Asia, vol. 2³³.

Where Kenneth L. Port provides the comparative analysis of Japanese trade mark law, John Owen Haley is the legal theorist supplying the jurisprudential explanations which explain the nature of the Japanese law in the context of legal theory and a historic understanding of the development of laws.

Hiroko Onishi

The recently sadly deceased Dr Hiroko Onishi was also a Japanese-born comparatist. Her principal work in the present context is *Well-Known Trade Marks: A Comparative Study of Japan and the EU*.³⁴ This book provides a very thorough, detailed legal analysis of the treatment of well-known trade marks. This is an important text for the purposes of the present thesis, albeit the primary focus of the thesis is at the intersection of trade mark registration and the principles which are liable to prevent registration.

Irene Calboli & Jane C. Ginsburg

Irene Calboli and Jane Ginsburg are joint editors of *The Cambridge Handbook of International and Comparative Trademark Law* – a comparative trade mark law work addressing some of the most important issues within the field. To date, this is the only work discussing comparative trade mark law in the context of a wide range of Asian jurisdiction, albeit it does not cover the Japanese legal system. This edited collection is a major contribution to the literature

³³ John O Haley and Toshiko Takenaka, *Legal Innovations in Asia: Judicial Lawmaking and the Influence of Comparative Law* (Edward Elgar Publishing 2014).

³⁴ Hiroko Onishi, *Well-Known Trade Marks: A Comparative Study of Japan and the EU* (Routledge 2015).

related to comparative trade mark law.

The book is structurally modular, as it had been authored by a large number of contributors, with their work confined mostly to a particular chapter and country. As a singular entity, the book has remarkable breadth, acting as an exposition of trade mark law comparative methods and problems. The objective of the book is evidently to cover the entire range of comparative trade mark law topics in some detail, including issues such as trade mark transactions, the intersection of trade mark with designs and copyright or the right of publicity. The book is structurally divided into such sections, with thematically grouped chapters. Accordingly, a number of these chapters are not strictly applicable to the topic of the thesis, but the chapters which are applicable provide vital insight into comparative law within the specific, outlined fields. The work does not contain a chapter on Japan, however, despite this, it contains numerous chapters, the contents of which are vital to the discussion and analysis in the Comparative and Jurisprudential Chapter.

Martin Szarkiszjan and Janice Denoncourt

Szarkiszjan and Denoncourt have contributed to the UK and Japanese comparative law trade mark literature in their article entitled *Japanese trade mark law and Benrishi: preparing for Tokyo 2020*.

As part of the research required for this thesis, an extensive literature search was carried out with relation to comparative, Japanese materials in a sports business context focussing on the Tokyo Olympics 2020:

“Several firms are interested in establishing their own brands in Japan, a sophisticated, competitive and stable market. Over the past thirty years, the country has undergone much deregulation and is relatively open in most sectors. Indeed, Japan is the UKs largest export market outside Europe and the USA.

Trade marks are the signifiers and legal anchors of brands.² This article examines the Japanese trade mark law framework and offers streamlined legal guidance on Japanese trade mark registration, focusing on the considerations required to bring a brand to the Japanese market in time for the Tokyo 2020 Olympics and beyond.

Trade mark registration in Japan is not unduly complicated. However, pitfalls may arise due to the language barrier and relatively isolated legal system. This article uniquely discusses the Japanese Intellectual Property profession, the Benrishi, the Tokyo 2020 Olympic Brand Protection Guidelines, Geographical Indications and certain unique cultural and linguistic aspects of the Japanese trade mark law system.”³⁵

The peer-reviewed law *Journal of Intellectual Property Law and Policy* piece, is arguably the most current comparative UK- Japanese trade mark law system analysis, shining a light on the workings of the Japanese legal, the IP professions and brand protection in Japan as compared with those functional elements in the UK. The article was deemed to be of significant international importance and was also published in the JIPLP sister publication GRUR to make it available to a European readership.

Cambridge Handbook of International and Comparative Trademark

³⁵ Martin Szarkiszjan and Janice Denoncourt, ‘Japanese Trade Mark Law and Benrishi: Preparing for ‘Tokyo 2020’ (2019) 14 *Journal of Intellectual Property Law & Practice* 850.

Law

International Aspects of Trademark Protection

The Internalisation of Trademark Protection

Chapter 3 – The Internationalisation of Trademark Protection by Susanna H. S. Leong³⁶

Chapter 3 discusses the *status quo* of trade mark protection at a high level – at the level of treaties and other agreement, which are, accordingly, politicised and affected, to a large degree, by the relations and competition between states. The writing focuses, at first, on a discussion of the roots of the Madrid System, established by the Madrid Agreement in 1892. The exposition then follows a chronological course, discussing the subsequent amendments and important international changes with the inception of the Madrid Protocol in 1989, the Trademark Law Treaty 1994 and the Singapore Treaty on the Law of Trademarks 2006, which have made important procedural changes to the way that singular trade marks are registered in multiple jurisdictions. Leong goes on, then, to discuss Well-Known marks, beginning with the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, then goes on to discuss signs in the context of the WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs on the Internet.

Leong concludes with a discussion of the evolution of trade mark law in the recent decades.

Much of the conclusion focusses on the mercurial nature of the *status quo*, due to

³⁶ Susanna HS Leong, 'The Internationalisation of Trademark Protection: Mapping and Documenting Twenty-Five Years of (Post-Paris Convention and) Post-TRIPS Trademark Agreements' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020).

technological and political forces. Leong laments the current state of protectionism, which harkens back to a time in the development of the international community and the international order which was dominated by such state-driven, politically-inspired protectionism.

The chapter by Susanna Leong is a vital element of the broader thesis. The focus of her exposition is primarily the present state of affairs, in an effort to bridge the past and the present. One of the principal conclusions of the thesis is rooted in the discussion by Leong and other discussions in the same vein. The thesis is driven by comparative law, and so the politicisation of legal systems, whether in part or fully, is very relevant to the broader discussion of the nature and evolution of the trade mark registration regimes of the United Kingdom and Japan. Indeed, the contemporary legal system of Japan is to a large extent predicated on the politicisation of the broader, global economy and the politicisation of economic phenomena and instruments.

This chapter is very helpful in providing the core facts and sentiments of a discussion which the thesis uses in providing a more specific discussion of the trade mark regimes of the UK and Japan, especially in the context of the degree to which the respective trade mark regimes have been allowed to be shaped by and develop according to the demands of market forces. In spite of the historic politicisation of the UK and Japanese legal systems, the author of this thesis had found little evidence of heavy-handed politicisation of the respective trade mark regimes. While it is difficult, in many ways, for a foreign undertaking to enter the Japanese market and compete therein with the use of trade marks, this is due to legal-cultural and linguistic factors, rather than due to politically-motivated, anti-competition barriers to entry. In the context of the UK, the situation is the same, with the cardinal difference that there is no such legal-cultural or linguistic hurdle, as the language of commerce in the UK is the

global *lingua franca*, and the business culture of the UK is well-understood by the broader economic community the world over.

The Trademark Provisions In Post-TRIPS Mega-Regional Trade Agreements

Chapter 4 - The Trademark Provisions in Post-TRIPS Mega-Regional Trade Agreements by Professor of Law Susy Frankel, Victoria University of Wellington

The author in this chapter investigates the relationship between the TRIPS Agreement (and the earlier Paris Convention) and the provisions of free trade agreements (FTAs). The chapter is an exposition of the political landscape of FTAs with provisions which implement trade mark standards higher than the requisite, minimal standard outlined in the TRIPS Agreement. The author states throughout the chapter that under many circumstances, with respect to modern FTA or FTA style agreements, such as TTIP, TTP, CPTPP or RCEP often involve a measure of political influence by trade organisations, bodies or industries.

The TRIPS Agreement makes express provision for states to enact higher trade mark protection standards than required by the agreement, without necessarily the obligation to do so. In practice, the minimal, baseline protection set out in the TRIPS Agreement has long since been departed from in favour of stronger trade mark protections. Very often, as the author states, such protection is utilised by industrial lobbies within states to secure an advantage for the pertinent sector. Generally, strong trade mark protections favour the importer rather than the exported of goods, and the respective industrial lobbies have often been successful in creating trade mark conditions which favour their import/export

orientation.

Professor Frankel's³⁷ chapter is important for the purposes of the discussion of Chapter 3 by Susanna Leong, as FTAs as an instrument are intended to distort the global market to obtain a local advantage. The very objective of FTAs, with relation to trade marks, is to manipulate and alter the local conditions to produce a global effect. Accordingly, such agreements act to distort markets and create disparity in trade mark provisions and trade mark standards.³⁸ In the last two decades, there has been a relative scarcity of scholarly works published on the topic of UK-Japan comparative law with the exception of the article the present author had co-authored with Associate Professor Dr Janice Denoncourt (Director of Studies).³⁹

The UK and Japan have both benefitted from the relative ease of market entry, and they have trade mark protections which are functionally very similar. Although the wording and structure of their respective statutes may differ, and there are procedural, linguistic and conceptual differences, the similarity of trade mark regimes makes inter-operation intrinsically easy, coupled with other features of their markets, such as with relation to establishing businesses such as through incorporation, visa requirements, etc.

The areas where inter-operability suffers are the areas of divergence, such as where there are discrepancies in the strength of the applicable trade mark protection. An example of such a

³⁷ Susy Frankel, 'The Trademark Provisions in Post-TRIPS Mega-Regional Trade Agreements' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020) <<https://www.cambridge.org/core/books/cambridge-handbook-of-international-and-comparative-trademark-law/trademark-provisions-in-posttrips-megaregional-trade-agreements/B4475DABBDECD8F823748D9572189104>> accessed 28 June 2024.

³⁸ Leong (n 36).

³⁹ Szarkiszjan and Denoncourt (n 35).

divergence is the protection of unregistered trade marks.⁴⁰ Japan affords limited protection to unregistered marks, and feasible protection they might be able to obtain is afforded only to well-known and famous marks, whereas the UK has a powerful system of protections for unregistered marks in the form of the law of passing-off, which is an ancient common law remedy under the law of tort. Viewed from a comparative perspective, neither arrangement is intrinsically superior, however there is an inter-operability and reduced overheads benefit in harmonising the systems to provide the same degree of protection. Piecemeal harmonisation is possible in certain areas, and this has been the experience to date, broader harmonisation, integration and convergence requires depoliticization which is, for example, what happened at the end of the Japanese economic bubble period, when convergence and global commerce became more lucrative than protectionism.

⁴⁰ *Infra* 3.5

Konrad Zweigert & Hein Kötz

An Introduction to Comparative Law by Konrad Zweigert and Hein Kötz is the seminal work on comparative law and the process of performing comparative law. The primary significance of the text in the context of the thesis is to provide procedural guidance on the construction of an ideal trade mark regime, complete with its own terminology and paradigmatic definitions, in order to serve as a jurisdiction neutral basis for the theoretical discussion and comparison of the principles present in the respective trade mark regimes. The book is, furthermore, used to provide a broader comparative approach for the determination of the objectives of comparison, including the underlying purpose for the production of this thesis.

Ronald Dworkin

Ronald Dworkin's jurisprudential model of law as integrity, described in *Law's Empire*,⁴¹ has been chosen because it is a system which readily facilitates discussion of both statutory and judicial law without necessarily becoming entangled in a lengthy discussion of the formal validity of laws. The present thesis compares legal practice in the United Kingdom and Japan. The objective of the comparative model of analysis constructed for the purposes of the thesis is to remain jurisdiction neutral and to avoid adopting a Japanese or UK perspective. Accordingly, it is vital to have a legal theoretical system, such as law as integrity, which can describe jurisdictions and jurisprudential systems irrespective of the specific role of judicial law within the system. Law as integrity excels as being able to do this, as the jurisprudential model of Ronald Dworkin primarily focuses on the continuity of law and its integrity along

⁴¹ Ronald Dworkin, *Law's Empire* (Harvard University Press 1986).

this continuum.

1.4.2 **Gaps in the Scholarship**

The contributions of this thesis to human knowledge are of two varieties. The preponderance of the aforesaid contribution arises as conclusions arrived at in the course of traversing the procedural pipeline outlined above. These conclusions pertain to substantive, comparative, societal, historic and normative concerns, and the findings emerging in these fields are the primary product of this thesis.

These conclusions correspond to and arise where there are gaps in the knowledge, and conclusions are produced so as to fill those gaps. These gaps are found in the various areas which the thesis covers, and they are substantive findings revealed by an investigation of the subject-matter in the context of this thesis. For example, statements and conclusions on the tendency of divergence or convergence of the pertinent trade mark regimes would yield such a substantive conclusion and, in turn, fill one of the gaps in the scholarship which had previously existed due to prevailing lack of information about the similarities of the two trade mark registration regimes.

The other type of gap exists in the procedural realm of UK-Japan comparative law scholarship. As stated above, there is no current custom, convention or other authoritative body of scholarship which governs the comparative law methodology and furnishes scholars with tools to carry out UK-Japan comparative law research. No definitive manual or guide exists to guide the work of the UK-Japan comparatist, which constitutes a large gap in the scholarship in terms of the requisite scholarly tools, techniques and preceding fundamental

work required to carry out substantive and substantial comparative analysis.

Port & Haley

This thesis uses extensively the structures and research of Kenneth L. Port and John Owen Haley. Much of the initial exposition regarding Japanese trade mark law is predicated on the work of Port. Port is a highly practical scholar and, although there is considerable theoretical discussion and he supplies a nuanced and sophisticated view, Port does not dedicate an extraordinary volume of writing to legal theory or discussion of comparative methods.

In contrast with Port, Haley's work is largely theoretical. Haley provides an analysis of the socio-legal realities of the Japanese legal system over the course of hundreds of years of social and legal evolution. Haley's analysis contains a broad range of concerns and it is much more inter-disciplinary, blending legal history, legal theory, culture and anthropology.

However, Haley is not a trade mark scholar. He does not provide a methodical exposition of the contemporary Japanese legal system, let alone specifically the trade mark regime. There is an exposition of the normative principles of the legal system, but the substantive law plays a merely demonstrative role, and extensive substantive exposition is not the objective.

Port and Haley cover broadly the entirety of Japanese trade mark regime in a substantive, comparative sense as well as in a theoretical light, albeit there is no jurisprudential model of the trade mark regime directly arising from Haley's work, as he does not directly address the Japanese trade mark regime. The present thesis fills these gaps through other, more minor resources and critical analysis.

A yet larger gap is the absence UK law from most comparative or solely Japanese resources

which are used throughout the thesis. Although Haley's conclusions are highly abstract and they have immediate comparative appeal, as they are easy to compare with findings from another legal system, and Port's writings are explicitly comparative, the comparison with the UK counterpart is mostly bespoke and one of the primary original contributions of this thesis.

Hiroko Onishi

For reasons of legal convergence, such comparative analysis is the closest the available scholarship has to offer in terms of direct comparison of the UK and Japanese legal systems. However, the focus of Dr Onishi's book on well-known trade marks overlaps with the topic of this thesis only to a limited extent, albeit Dr Onishi's work is important in the context of its analysis of well-known trade marks.

Dworkin, Zweigert & Kotz

Ronald Dworkin and Zweigert & Kotz provide the jurisprudential and comparative frameworks respectively. They are vital to the structure of the thesis, but they offer procedural guidance which is applicable and useful in producing the comparative and jurisprudential models for the purposes of this thesis. They are, in essence, the methodology with which to transform the raw intellectual materials into a cognitive system of thinking about and engaging with the concepts presented within this thesis. Accordingly, their objective is not so much to fill the gap in the scholarship, but to equip scholars with the cognitive toolkits required to fill such gaps as they choose to focus on.

Because of the aforesaid reasons, there is not broader text on comparative law concerning comparisons of the UK and Japanese jurisdictions. Although there are scholars such as Dr

Onishi, who are academics in the UK and have a keen understanding of the UK and Japanese legal systems, such scholars are not numerous. Although Hiroko Onishi makes an important contribution to the body of scholarship concerning the subject, and she is a Japanese academic operating in the UK, the jurisdictions which she compares are Japan and the EU.

As jurisdictions, the UK trade mark law and community trade mark law were inter-operable, albeit this inter-operability is likely only going to reduce in light of waning legal alignment in the aftermath of Brexit.

Hiroshi Oda

There are other important works on the Japanese jurisdiction, such as *Japanese Law*⁴² by Hiroshi Oda, which is a high level, general overview of the Japanese legal system. Oda's book has been important for the purposes of this thesis in helping provide a general basis or background for the research, however, it is not an extensively theoretical book and it does not set forth a system for performing comparative law.

Original Contributions

To fill this gap, the thesis supplies such fundamental comparative analysis as is necessary to be able to provide meaningful comparison between the two jurisdictions. The thesis contributes a discussion of the historic development of the two legal systems, from the earliest traces of legal systems to modernity.

While Port supplies an analysis of trade mark registration in his two important books on Japanese trade mark law, he addresses a primarily American readership or a readership with

⁴² Hiroshi Oda, *Japanese Law* (4th edn, Oxford University Press 2021).

a keen understanding of American law and legal practice. In its capacity as an expository work, it helps expound the underlying nature of the Japanese legal system, but an analysis of trade mark registration in the context of Japan and the UK is an original contribution of this thesis.

2 Substantive Trade Mark Law of the United Kingdom

2.1 *Introduction*

The objective of this chapter is to provide necessary exposition of the substantive law of the United Kingdom with relation to trade mark registration. As a process, this chapter, in conjunction with the subsequent chapter on Japanese Substantive Law, is the entry point for the purposes of the overarching analysis.

A concrete comparison of substantive laws is perhaps the most intuitive way of performing comparative law analysis, albeit it is also very error prone, unless there is already considerable expository and theoretical work available and if the jurisdictions are fundamentally similar in the way two Common Law jurisdictions or two Romano-Germanic jurisdictions might be similar. There is no such degree of similarity between the jurisdictions of Japan and the UK, so the role of the respective substantive chapters will be primarily expository and auxiliary.

Auxiliary in the present case means that although these chapters give rise to conclusions, substantial analysis is deferred until legal-theoretical and comparative processes have concluded in subsequent chapters.

As part of the substantive exposition, this chapter will look, firstly, at a brief legal history of the UK. This is intended to introduce the legal history of the UK, but the main, detailed legal-historical analysis is deferred until Chapter 6.

The focus of this chapter is on the acquisition of trade marks, the protection of unregistered marks as well as the court system and, to a very small extent, a brief look at the UK Trade Mark Attorney profession.

To this end, the chapter will investigate the registration process of trade marks, which is the designated form of original acquisition for trade marks.⁴³ Furthermore, the chapter will look at objections to registration and the grounds of refusal to register a trade mark, including the absolute and relative grounds.

Unregistered marks are also part of the same appellation ecosystem within which trade marks operate and, accordingly, the protection for unregistered marks, the tort of passing-off, will also be investigated⁴⁴

As articulated in 1.2.1 the central question of this chapter is as follows:

The underlying question for the purposes of Chapters 2 and 3 is, therefore, whether the trade mark regimes are similar on a substantive analysis, before undertaking the comparative and jurisprudential assessments of Chapter 4?

⁴³ *Infra* 2.3

⁴⁴ *Infra* 2.4

2.2 *Legal History of the United Kingdom*

It is safe to say that customary law generally precedes positive law, which seems only logical considering that literacy and numeracy are not pre-requisites of sapience, but often its accompanying features and that literacy is, effectively, a pre-requisite of positive law. This holds true of Japan as much as it does of the British Isles. Before even the reception of the Chinese Confucian model and the Ritsuryou system based thereupon, there was a rudimentary, embryonic form of governance predicated on customs. There is evidence of customary law in ancient Japan, predicated on superstition and social mores,⁴⁵ but there is reason to assume, given the seeming universality of the phenomenon, that even as far back as the Jomon era, there were recurrent social phenomena which were carried out fervently and without much spontaneity, even if only practices so simple as funerary⁴⁶ or marital rites (Although it is not precisely the topic of this writing, there is some evidence, and an associated hypothesis, that, faced with exogamy, ancient Jomon people have practiced customary, post-marital tooth extraction, perhaps to distinguish those bound to the community by consanguinity, from those bound by marriage by following different extraction patterns.⁴⁷ It is not difficult to see how such a severe and robust custom might, over time, become a legal principle of some variety with adequate sponsorship by a sacral authority and a sufficiently impressionable martial one.). Without Infrastructure, roads, communication, etc. of note, however, it is clear that different customs would develop based around different local variables. This is precisely what happened on the British Isles where not only were there ever-shifting political differences arising out of the presence of the minor

⁴⁵ Petra Schmidt, *Capital Punishment in Japan*, vol 17 (Brill 2002) 9–11.

⁴⁶ Takamune Kawashima, 'Burial Practices and Social Complexity: Jomon Examples' (2011) 38 *Documenta Praehistorica* 109.

⁴⁷ Junko Habu, *Ancient Jomon of Japan*, vol 4 (Cambridge University Press 2004).

and the major kingdoms of the isles⁴⁸ such as Mercia, Wessex or Kent, there were other regional cultural, customary and religious differences which are to be expected in an age characterised by relative isolation and low population density.^{49 50}

This proved to be the foundation of the embryonic form of what is now understood to be the common law, but it was not until the Norman conquest that the most basic understanding of common law began to take shape. The Norman administrative improvements had the effect that central governance was sufficiently secure and stable to create a unitary set of principles to govern subjects. During his reign, Henry II sent out itinerant justices – travelling judges – to resolve regional matters on an ad hoc basis by ascertaining what the local customs were and applying them to the facts.⁵¹ These judges would then go on to discuss their judgments with each other and, eventually, from their findings the principle of *stare decisis*, the binding precedent arose.⁵² The investiture controversy of the middle ages was a significant conflict between the Church and secular powers. This conflict between the Papacy and the secular powers affected legal enforcement during Henry's II's reign too, as Thomas Becket, the Archbishop of Canterbury, was murdered in relation to a conflict regarding the issue of whether clerical persons, interpreted very broadly, should be tried before clerical or secular courts.⁵³

Whether a case was heard before an ecclesiastical or a secular court was not only of social and political significance, but it was also significant from a legal, scholarly perspective. Where

⁴⁸ Barbara Yorke, *Kings and Kingdoms of Early Anglo-Saxon England* (Routledge 2002) 9.

⁴⁹ Theodore Frank Thomas Plucknett, *A Concise History of the Common Law* (The Lawbook Exchange, Ltd 2001) 6.

⁵⁰ Szarkiszjan, 'A Comparative Analysis Of The Requirements Of The Registration Of Trade Marks In Japan And The UK/EU

⁵¹ Martin Szarkiszjan, 'A Comparative Analysis Of The Requirements Of The Registration Of Trade Marks In Japan And The UK/EU' (Nottingham Trent University 2015) 101–104.

⁵² David LA Barker, *Law Made Simple* (Routledge 2020) s 2.2.1.

⁵³ Plucknett (n 49) 17–19.

the Canon Law was silent, there was a tendency in the ecclesiastical courts (the Chancery, at the time, for instance) to fall back to Roman Law in handing down decisions.⁵⁴ Indeed, the revival of Roman Law was an ecclesiastical affair mainly, so it is unsurprising that the courts of the Papacy – an institution headquartered on the continent, the heart of Roman Law – had a Roman Law slant. For example, the practice of distributing the intestator's estate per stirpes, in English law, is a Roman Law derivative practice, introduced by the ecclesiastical courts which used to hear succession cases. (though qualified by the rights of a surviving spouse, it is still the most basic principle of intestate succession in England⁵⁵) Another useful example is donatio mortis causa – a gift made in contemplation of death.⁵⁶

Roman Law influenced common law through the secular courts as well, but in much more subtle ways. There is now a large body of judicial precedent where, principally in the absence of guidance from recognised sources of law, the English judges turned to Roman Law for "inspiration". It is important to note, however, that they were not looked upon as sources of English law. They did not have a binding character in English law, but they were, nevertheless, persuasive. There are examples of substantial borrowing, but "borrowing" is the key word here. Roman Law remained an outsider – a sagacious, wizened outsider, but an outsider all the same.⁵⁷

The legal systems of Northern Ireland and Scotland are somewhat different, with Northern

⁵⁴ Damien Freeman, 'The Influence of Roman Law in English Courts' (2014)

<<https://damienfreeman.com/assets/content/PDF/PDF38%20-%20Influence%20of%20Roman%20Law%20in%20English%20Courts.pdf>> accessed 28 June 2024.

⁵⁵ 'IHTM12125 - Succession: Intestacy: Distributions (England & Wales): Other Persons - HMRC Internal Manual - GOV.UK' <<https://www.gov.uk/hmrc-internal-manuals/inheritance-tax-manual/ihtm12125>> accessed 28 June 2024.

⁵⁶ William Searle Holdsworth and Charles William Vickers, *The Law of Succession: Testamentary and Intestate* (The Lawbook Exchange, Ltd 2004) 83–85; Martin Szarkiszjan (n 51).

⁵⁷ Freeman (n 54) 2; Martin Szarkiszjan (n 51).

Ireland being governed by a slightly different common law system, whereas Scots Law is a hybrid legal system with influences from both the common law and Roman law traditions. In the latter regard, before Scottish universities began offering complete programmes of legal education, many aspiring lawyers went on to attend continental universities (very often in the Netherlands) where the study of Roman law was par for the course.⁵⁸ Scots law also recognises the writings of certain academics (institutional writers) as sources of law. While Roman law instruments are not recognised as sources of law, much Roman law has found its way into Scots law through incorporation by the institutional writers.⁵⁹

The eventual conversion of England into a constitutional monarchy began in the aftermath of the 1688 revolution when Parliament – the successor of the Great Council (Magnum Concilium) of yore – was firmly established as the paramount legislative entity. This system was largely inherited with the 1707 union of England and Scotland. This was a significant step towards creating a powerful variety of legislation, the kind of legislation whereby much of the modern world is now governed.⁶⁰

While some legal-historical analysis is provided here, the primary legal-historical comparison will be deferred until and undertaken in Chapter 6.⁶¹

⁵⁸ William M Gordon, 'Roman Law in Scotland' (1995) 19 The civil law tradition in Scotland.

⁵⁹ Szarkiszjan, 'A Comparative Analysis Of The Requirements Of The Registration Of Trade Marks In Japan And The UK/EU

⁶⁰ Albert Venn Dicey, *AV Dicey: General Characteristics of English Constitutionalism: Six Unpublished Lectures* (Peter Lang 2009) 60–62; Martin Szarkiszjan (n 51).

⁶¹ *Infra* 6.2

2.3 *UK Trade Mark Registration Process*

2.3.1 **Trade Mark Application**

Trade Mark Classification

In the typical course of events, most trade mark applications in the UK begin by consulting the trade marks register maintained by the UK Intellectual Property Office. Trade⁶² marks must be registered against an exhaustive list of classes for goods and services,⁶³ and a trade marks may be registered as belonging to one or more such classes. For example, a mark might be registered as intended for “Hand tools and implements (hand-operated); cutlery; side arms; razors” in Class 8⁶⁴.

Opposition Procedure

If there is no prior registration, or no registration within the same class, the mark can be registered subject to s.5 of the Trade Mark Act 1994. The trade mark is then examined as per s.37 and if the registrar considers that the requirements have been met, the application is published for up to 3 months, and any person may oppose the registration, as per s.38. In the absence of successful opposition, the trade mark is granted and the certificate is issued.⁶⁵

2.3.2 **Trade Mark Examination**

The examination guidelines⁶⁶ are drafted in such a fashion as to closely follow the Trade

⁶² ‘Search for a Trade Mark - Intellectual Property Office’ <<https://trademarks.ipo.gov.uk/ipo-tmtext>> accessed 26 December 2022.

⁶³ Trade Marks Act 1994 s 34.

⁶⁴ World Intellectual Property Organisation, ‘Index of Trade Mark Classes, Nice Classification’ <<http://www.wipo.int/classifications/nice/nclpub/en/fr/>> accessed 8 April 2018.

⁶⁵ *Infra* 4.9 on *Original Acquisition* provides a discussion of the underlying theory of acquisition.

⁶⁶ UK Intellectual Property Office, ‘Trade Marks Manual’ (2021) <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/361114/Manual_of_trade_marks_practice.pdf> accessed 5 May 2024.

Mark Act 1994 and judicial developments. They represent an interpretation and a guide produced to assist trade mark examiners in applying legislation and case law to the specific facts of applications. However, although trade mark examiners are UK IPO personnel who are tasked with applying trade mark law directly in examining applications, the trade mark examination manual is not a binding legal document, but a summary and aide to interpreting and working within the boundaries of the existing trade mark regime as it pertains to registration.

The 1994 Act divides the absolute and relative grounds of refusal into two distinct concepts. Sections 3 and 6 of the Act set out the three distinct thematic sub-divisions of the absolute grounds of refusal. The relevant sections are set out as follows:

s.3(1)(b) trade marks which are devoid of any distinctive character.

s.3(1)(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

s.3(3)(a) contrary to public policy or to accepted principles of morality, or

s.3(3)(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

s.3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Section 3(3)(a) is, for the purposes of this work, the central provision which governs registrability in a public policy and morality context.

Presence or Absence of Morality in Public Interest

The counterpart of s.3(3)(a) in Japanese law altogether omits morality from the wording, although, as discussed in the following chapter, the trade mark examiners at the Japan Patent Office do interpret the notion of *contrary to public interest* as including marks which are contrary to societal moral principles.

Generic Marks

Section 3(1)(b) precludes the registration of marks which are so generic as to be devoid of distinctive character,⁶⁷ such as a mark which would be perceived by consumers as something other than a sign indicating the undertaking the goods originate from, such as an unrelated word mark with so many connotations and competing uses as to be unsuited to designating origin.⁶⁸

For example, laudatory words such as 'Treat'⁶⁹ in product names are not distinctive.⁷⁰ However, it is possible to make a claim that the mark in question had subsequently acquired a distinctive character, through use, in the eyes of the consumers.⁷¹ This is a concept called acquired distinctiveness.

In the case of *Apple v Arcadia*,⁷² Apple argued that its mark IWATCH (iWatch) had distinctive character by virtue of the fact that it followed the same naming convention as previous Apple products, i.e. it was a conventional and non-distinctive word preceded by a lowercase 'i'. The

⁶⁷ Heidi Hurdle, 'Jacob J 'Treats Us All!' [1996] European Intellectual Property Review 299.

⁶⁸ Mark Webster, Janet Strath, Angela Fox, 'Family of Marks Cannot Save Apple as iWatch Application Fails' [2017] Computer and Telecommunications Law Review 120.

⁶⁹ Hurdle (n 67).

⁷⁰ Andrew Inglis, 'Registrability and Enforcement of Inherently Non-Distinctive Trade Marks in the United Kingdom' (1997) 19 European Intellectual Property Review 138.

⁷¹ Alice Blythe, 'Misrepresentation, Confusion and the Average Consumer: To What Extent Are the Tests for Passing off and Likelihood of Confusion within Trade Mark Law Identical?' (2015) 37 European Intellectual Property Review 484.

⁷² *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch).

court decided that such an argument was insufficient to support a finding of acquired distinctiveness, as the mere fact that the product had followed an established Apple naming convention was not sufficient to educate consumers as to the origins of the iWatch, and the average consumer⁷³ would not associate iWatch with Apple, despite the existence of earlier, similarly named products.⁷⁴

The ground of refusal under s.3(1)(c) is similar in the sense that it considers distinctiveness, but its primary concern and function is more utilitarian:

trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

This test goes back to the case of *Windsurfing*,⁷⁵ where it was held that although marks which indicate, for example, geographical origin may still be registered, despite the provisions of s.3(1)(c) if the public has come to associate the mark with the origin of the goods or services, rather than the non-distinctive indications.

The *Windsurfing* test has subsequently been incorporated in the case of *Lloyd Schuhfabrik*⁷⁶ where the court held that the test is not one of statistical data, and that the perceptions of

⁷³ Jennifer Davis, 'Revisiting the Average Consumer: An Uncertain Presence in European Trade Mark Law' (2015) 1 Intellectual Property Quarterly 15.

⁷⁴ Mark Webster, Janet Strath, Angela Fox (n 68).

⁷⁵ *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ETMR 585.

⁷⁶ *Case C-342/97 Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690.

the average consumer are⁷⁷ the paramount consideration in determining whether a mark applied for is caught by s.3(1)(c). *Windsurfing* is a case regarding the purpose of the registration of geographic marks. The case concerned the registration of the mark 'Chiemsee', a lake in Germany and therefore a geographic indicator. Against the defendant's pleadings, the court ruled that where a mark is not precluded from registration, and if it had acquired distinctiveness, i.e. if the consumers associate the mark with the applicant, then registration may proceed.

⁷⁷ Dev Gangjee, Verena Von Bomhard, and Graham Williams, 'Who Is the Average Consumer in Trade Mark Law?' [2015] *Managing Intellectual Property* 74.

2.3.3 **Objections to Trade Mark Registration & Grounds for Refusal to Register**

2.3.4 **Grounds for Refusal**

In the context of the United Kingdom, and in some other jurisdictions as well, the grounds of refusal are separated into two categories on the basis of whether they are unregistrable because of a particular intrinsic quality, such as that of being generic and non-distinctive, or due to the existence of a prior registration which precludes a similar or identical trade mark from being registered. These are the absolute and relative grounds for refusal to register a trade mark.

While the terms *absolute* and *relative* grounds are used in many jurisdictions, including the UK, these are purely descriptive terms. In the context of comparative law, it is important to account for false friends, such as terms which have a particular idiomatic meaning in one jurisdiction, but not in another. The *absolute* and *relative grounds* are not such, as these terms are not idiomatic, and their objective is to describe certain intrinsic and extrinsic reasons not to allow registration of a trade mark.

Accordingly, this thesis will continue to use the terms *absolute* and *relative grounds*, as such terms are innately system agnostic. For a more detailed discussion about the comparative significance of this grouping into absolute and relative grounds, see 4.11.5.

Contrary to Public Policy / Morality

The Intrinsic Flexibility of Public Policy / Morality

Section 3(3)(a) represents the most relevant aspect of the absolute grounds of refusal in that

it is intertwined with moral principles, and serves to highlight the underlying nature of trade mark law in expressing intrinsic moral principles as well as permitting extrinsic ones to operate in the context of trade marks.

Public policy and morality are intrinsically nebulous concepts, and arguably there is an intrinsic benefit to their nebulosity, which is a desirable quality. This nebulosity ensures that, although society may undergo profound changes and there might be significant changes in the prevailing moral atmosphere, the provisions of 3(3)(a) remain current, as the act does not attempt to establish an exhaustive list of circumstances, but instead leaves the matter to the discretionary judicial power of the court presiding over the issue. This variability serves as a vehicle for the application of public policy and morality⁷⁸ where these are instantiated to decide a case.

No Statutory Definition of Public Order, Policy and Morality

While public policy is a well-understood principle and a utilitarian appraisal of the situation can yield an understanding of whether a mark is contrary to public policy, morality is much more elusive. Structurally, the 1994 Act offers no guidance as to the intended meaning of the wording, so matters of morality are much more extensively discussed in the associated case law. Similarly, much of the content which pertains to morality in the examination guidelines is written based on judicial sources of law. This mirrors the treatment of the examination manual in Japan, which likewise represents the organisational understanding of the Japan Patent Office, but it is not a text which has any innate legal authority.

⁷⁸ *Infra* 4.12

Morality is ever-changing.⁷⁹ In *Hallelujah*, the court was concerned with an application for the word mark HALLELUJAH, and it ruled that for a mark to be offensive, it must offend the prevailing mores of the time. The same principle came to the fore in Hong Kong⁸⁰, and was further developed in the *FCUK* application (distinct from but related to the *French Connection v Sutton*⁸¹ case. The applicant was the same as in the UK *FCUK* litigation, which took a different turn to its Hong Kong counterpart.), which was refused.⁸² The application concerned the acronym of French Connection United Kingdom or 'FCUK', in the context of Hong Kong customers.

The decision in the application to refuse registration focused on the perception of the consumers in Hong Kong, and it was determined that at the time of the application, the consumer base in Hong Kong would consider the mark offensive, which resulted in a refusal to register it. However,⁸³ as a general principle, the courts have held that not all which is distasteful is inherently and automatically precluded from registration.⁸⁴

The UK understanding of what constitutes an immoral mark hinges on the 'harm principle'. In looking for harm, the courts are inclined to look at two different streams or fields within which to find harm: religious, family and social values, and the prevention of disorder and

⁷⁹ Derek Besner and Marilyn Chapnik Smith, 'Chapter 3 Basic Processes in Reading: Is the Orthographic Depth Hypothesis Sinking?' in Ram Frost and Leonard Katz (eds), *Advances in Psychology*, vol 94 (North-Holland 1992).

⁸⁰ *FCUK Trade Mark Application No 7114 of 2001 (Hong Kong)*.

⁸¹ Douglas Litowitz, 'Reification in Law and Legal Theory' (1999) 9 *Southern California Interdisciplinary Law Journal* 401.

⁸² Ingrid Piller, 'Advertising as a Site of Language Contact' (2003) 23 *Annual Review of Applied Linguistics* 170.

⁸³ Colin Davies, 'A Scandalous Affair: The Disparity in the Application of Morality to Trade Marks, Patents and Copyright' [2011] *European Intellectual Property Review* 4.

⁸⁴ Susie Middlemiss and Jeremy Phillips, 'Bad Faith in European Trade Mark Law and Practice' [2003] *European Intellectual Property Review* 397.

crime.⁸⁵ The courts have generally drawn the line at insulting representations where some manner of meaning is conveyed.⁸⁶ Mild sexual innuendo and thinly veiled profanity are not inherently contrary to morality as they do not convey a message which might undermine religious, family or social values.⁸⁷ However, something so flagrant as ‘fuck’ is liable to provoke ‘justifiable outrage’ amongst the populace.⁸⁸

The standard for determining what is reasonable or obscene corresponds to the standards a “reasonable person with normal levels of sensitivity should apply.”⁸⁹ The precise meaning of this standard is mercurial and ever-changing,⁹⁰ and there is empirical evidence to support that there is a trend towards liberalisation in the course of time⁹¹ and with inevitable social changes, which has resulted in a level of divergence in different age groups in terms of their perceptions of what is contrary to morality.⁹²

2.3.5 Distinction Between Public Policy and Morality in the Case Law

Section 3(3)(a) of the Trade Marks Act 1994 states that a trade mark is not registrable if it is “*contrary to public policy or to accepted principles of morality.*”

⁸⁵ Anil Samtani, ‘Trade Marks That Are Contrary to Public Policy or Morality: The Search for the Right-Thinking Man’ [2012] Intellectual Property Quarterly 39.

⁸⁶ Colin Davies and Rhiannon Davies, ‘Fighting Controversy in the UK: Morality and a Trade Mark Application’ (2003) 24 Business Law Review.

⁸⁷ Jan Engberg, ‘Comparative Law for Legal Translation: Through Multiple Perspectives to Multidimensional Knowledge’ (2020) 33 International Journal for the Semiotics of Law - Revue internationale de Sémiotique juridique 263.

⁸⁸ James Grant, ‘Trade Marks: Bad Faith - Requirement of Dishonesty?’ [2004] European Intellectual Property Review N14.

⁸⁹ *ibid.*

⁹⁰ Anil Samtani (n 85).

⁹¹ Francis Conlan, ‘Searching for the Semantic Boundaries of the Japanese Colour Term “Ao”’ (2003) 26 Australian Review of Applied Linguistics 71.

⁹² Anil Samtani (n 85).

This establishes two distinct but related grounds which can co-occur in the same instance: public policy and morality. The case of *Constantin Film Produktion v EUIPO* discusses the difference between the two in some detail. AG Michael Bobek describes public policy and accepted principles of morality as follows:

*“Public policy is a normative vision of values and goals, defined by the relevant public authority, to be pursued now and in the future, that is, prospectively. Public policy thus expresses the public regulator’s wishes as to the norms to be respected in society. Its content should be ascertainable from official sources of law and/or policy documents. However it is expressed, much like charting a course, public policy must first be set out by a public authority, and only then can it be pursued.”*⁹³

Accepted principles of morality refer, in my understanding, to values and convictions currently adhered to by a given society, set and enforced by the prevailing social consensus within that society at a given time. In contrast to the top-down nature of public policy, they grow from the bottom up. They also evolve over time: but when ascertaining them, the focus is primarily fixed on the past and present. Naturally, in terms of what it wishes to achieve, morality is also normative and prospective, in the sense that that set of rules also has the ambition of inducing and maintaining certain behaviour.⁹⁴

⁹³ *Case C-240/18 Constantin Film Produktion v EUIPO* [2020] Bus LR 1422 [76].

⁹⁴ *ibid* 77.

AG Bobek's distinction is, primarily, in the origins of these two entities. Morality is described as arising *bottom-up* from the social consensus, whereas public policy is *top-down*, defined by some variety of public regulator. Accordingly, public policy is objective and it can be reasoned about with reference to the stated policy objectives within a polity.⁹⁵ Morality, in contrast, is context-specific and reasoning about the prevailing mores involves an empirical assessment concerning the social context.⁹⁶

Reasoning About Public Policy & Morality

It is difficult to clearly delineate public policy and morality grounds in operation in a trade mark context. They are often discussed in the same context and frequently with little explicit acknowledgement of their distinct natures. However, the distinction described in *Constantin* is helpful to determine whether the reasoning is based on the *top-down* or *bottom-up* approaches of public policy and morality, respectively.

However, it is noted in *Constantin* that it is not obligatory to make such distinction between the two when assessing the impropriety of a mark.⁹⁷ The relevant provisions of Art.7(1)(f) EUTMR and s.3(3)(a) of the 1994 Act are bifurcated in the sense that they pertain to both public policy and morality. However, the outcomes are binary and not bifurcated. There is no possible divergence in outcome based on the

⁹⁵ *ibid* 79.

⁹⁶ *ibid* 80; Carina Gommers, Eva De Pauw and Ine Letten, “‘Thou Shalt Not Pass’—Trade Mark and Design Offices and Courts as Guardians of Public Policy and Morality” (2021) 16 *Journal of Intellectual Property Law & Practice* 21, 22.

⁹⁷ Gommers, De Pauw and Letten (n 96) 22.

proportion of public policy and morality - a mark is either permitted registration or not. Accordingly, it makes practical sense that the boundaries are not always clearly stressed in trade mark proceedings. Whether for reasons of public policy or morality, a mark is either registrable or not.

Top-Down & Bottom-Up

Constantin is a relatively recent case, decided in 2020. However, the observations of AG Bobek are descriptive with regard to the distinction between the top-down and bottom-up nature of public policy and morality. Accordingly, they are able to accurately describe and explain the distinction even in cases preceded by *Constantin*.

In the case of *Pooja Sweets & Savouries v Pooja Sweets*,⁹⁸ for example, the central question was whether registration of the term POOJA, as part of a trade mark, would be objectionable to observant Hindus. The term *pooja* has a religious significance in the Hindu religion.

To establish whether the registration is contrary to morality, the court carried out a *bottom-up* or empirical analysis⁹⁹ and came to the conclusion that it was not offensive

⁹⁸ *Pooja Sweets & Savouries Ltd v Pooja Sweets Ltd* [2015] 2 WLUK 243.

⁹⁹ Jennifer Davis and Łukasz Żelechowski, 'Bad Faith, Public Policy and Morality: How Open Concepts Shape Trade Mark Protection' (2023) 54 IIC - International Review of Intellectual Property and Competition Law 859, 880.

to practicing Hindus or to broader society.¹⁰⁰ The mere use of a religious term is not, by itself, sufficient to evidence immorality.¹⁰¹

From a *top-down* perspective it did not appear that the registration would be injurious to public policy either. There was, for example, no threat of harm to the public order. In the case of *Screw You* it was stated regarding the issue of religious sensitivities that: Signs which severely offend the religious sensitivities of a substantial group of the population are also best kept off the register, if not for moral reasons, at least for reasons of public policy, namely the risk of causing public disorder.¹⁰²

Accordingly, the public policy dimension can warrant a refusal on discrete, public policy grounds where there is a threat to public order.

The assessment of the possible impropriety of the mark, whether with relation to public policy or morality, should be undertaken from the perspective of "the standards of a reasonable person with normal levels of sensitivity and tolerance."¹⁰³

The central question in many applications for religious terms is whether the registration is morally repugnant or contrary to public policy in a narrow sense, e.g.

¹⁰⁰ Jennifer Davis, "‘FACK JU GÖHTE’: OR WHEN IS A TRADE MARK OFFENSIVE?" (2020) 79 *The Cambridge Law Journal* 234, 237.

¹⁰¹ Elena Izyumenko, 'A Freedom of Expression Right to Register "Immoral" Trademarks and Trademarks Contrary to Public Order' (2021) 52 *IIC - International Review of Intellectual Property and Competition Law* 893, 903.

¹⁰² R 495/2005-G *Application of Kenneth (trading as Screw You)* [2007] *ETMR* 7 [20].

¹⁰³ *ibid* 21.

the registration is liable to undermine the public order. However, there is a further, general and overarching consideration with relation to religious terms and other elements of religion - simply that such terms should be freely used and free from monopolistic control by trade mark proprietors.¹⁰⁴

In *Toke UJ Ltd's Trade Mark Application*¹⁰⁵ the emphasis was on a *top-down*, public policy objection to the registration of the mark TOKE. It is stated in the explanation of the decision that the term *toke* has the meaning of "To take a draw on a cannabis cigarette" in the Collins English dictionary. Part of the reasoning of this decision was that "It is against public policy for the Registry to accept terms which are descriptive of or associated with an illegal activity."¹⁰⁶ Permitting the registration would be "seen as promoting the use of drugs."¹⁰⁷

The decision does not discuss the sources of an anti-drug policy at length, albeit it does note that the term *toke* makes reference to an illegal activity. The state's stance regarding drugs is well understood, in part due to the prohibitions and criminal penalties imposed with respect to illegal drugs. In general, an application which is at odds with the existing body of laws will be seen as contrary to public policy, but the courts look beyond just the laws, at other sources of public policy in their

¹⁰⁴ Izyumenko (n 101) 913.

¹⁰⁵ *Toke UJ Ltd's Trade Mark Application O-119-06*.

¹⁰⁶ *ibid* 2.

¹⁰⁷ *ibid* 8.

assessment.¹⁰⁸

The issue of registering trade marks that include the term *cannabis* raises a complex linguistic issue. because the term has multiple meanings only one of which refers to illegality.¹⁰⁹ Unlike the recreational use of cannabis products, the use of the plant for textile production and therapeutic uses are not contrary to public policy.¹¹⁰ In *Conte v EUIPO* the court stated that "a sign must be refused registration if at least one of its possible meanings characterises the existence of an absolute ground for refusal."¹¹¹

Sproting Kicks Ltd's Trade Mark Application is similar to *Toke UJ's Application*. The issue in *Sproting* was that INTER CITY FIRM, the mark applied for, referred to football hooliganism and the football hooligan group by the same name. The decision states that, contrary to public policy, registration of the mark would promote football hooliganism.¹¹²

This case raises an interesting point regarding a chronistic element in the context of public policy. Cases like *Oomphies*¹¹³ highlight that there is such an element in the context of morality and the ground for refusal based thereon. In *Sproting* the question was raised whether INTER CITY FIRM is a retro sign of football club allegiance. An

¹⁰⁸ Berdien van der Donk, 'Cannabis, Corona and the Latest Morality Developments in European Trade Mark Law' (2022) 17 Journal of Intellectual Property Law & Practice 303, 304.

¹⁰⁹ T-234/06 DEP - *Torresan v OHMI - Klosterbrauerei Weissenobe (CANNABIS)*.

¹¹⁰ van der Donk (n 108) 304.

¹¹¹ T-683/18 - *Conte v EUIPO (CANNABIS STORE AMSTERDAM)* [25]; van der Donk (n 108) 305.

¹¹² *Sproting Kicks Ltd's Trade Mark Application O-302-05* [3].

¹¹³ *La Marquise Footwear Inc's Application* (1946) 64 RPC 27.

important part of this issue was whether the hooligan group was still active - whether there was contemporary delinquency or illegality on part of Inner City Firm.¹¹⁴

The European Convention on Human Rights, Freedom of Speech & Trade Mark Registration

In the aftermath of *Constantin*, it is confirmed that applications are subject to the operation of the right to freedom of expression.¹¹⁵ While a precise test was not established in *Constantin*, the court had specified that freedom of expression is considered in the overall assessment.¹¹⁶

Freedom of expression is applicable with relation to both morality and public policy in the context of registration. It can be difficult to determine whether a mark is contrary to morality, except in the extreme cases. There are marks which are clearly repugnant or innocuous, but with borderline cases it is difficult to determine whether a mark crosses the boundary into impropriety. In the case of *Screw You* the OHIM stated that:

“It can be extremely difficult to ascertain when a sign crosses the boundary from being merely irreverent or distasteful to being seriously abusive and likely to cause deep offence. Signs which contain slightly rude words or mild sexual innuendo might not be refused, but signs which contain manifestly profane

¹¹⁴ *Sproting Kicks Ltd's Trade Mark Application O-302-05* (n 112) para 15.

¹¹⁵ *Case C-240/18 Constantin Film Produktion v EUIPO [2020] Bus. L.R. 1422* (n 93) para 56.

¹¹⁶ Gommers, De Pauw and Letten (n 96) 28.

*language or depict gross obscenity have no place on the register.*¹¹⁷

Commercial Expression

While commercial expression is subject to protection by the right to freedom of expression,¹¹⁸ artistic expression is afforded a greater measure of freedom. The fact that something is permissible artistic expression does not automatically indicate that it will necessarily be considered appropriate to register as a trade mark.¹¹⁹

Public policy and morality are in constant evolution. While they have different sources, both the prevailing moral views and policy objectives are subject to constant change. Accordingly, There have been judicial signs in the context of the EU as well as with relation to human rights case law that the position has changed in recent years, and courts are more permissive of the registration of marks which engender only a mild degree of offence.¹²⁰

Pablo Escobar & CP14

CP14

The CP14 regarding Trade Marks Contrary to Public Policy or the Accepted Principles of Morality is the focus and product of a project involving multiple stakeholders in the context

¹¹⁷ R 495/2005-G *Application of Kenneth (trading as Screw You)* [2007] E.T.M.R. 7 (n 102) para 19.

¹¹⁸ Gommers, De Pauw and Letten (n 96) 27.

¹¹⁹ R 495/2005-G *Application of Kenneth (trading as Screw You)* [2007] E.T.M.R. 7 (n 102) para 24.

¹²⁰ Izyumenko (n 101) 907.

of the EU Intellectual Property Network. CP14 is intended to ameliorate the issues arising from the indeterminacy, uncertainty and subjectivity intrinsic to the process of ascertaining the moral propriety of a mark.

Ascertaining whether something is contrary to morality is a complex and difficult process. This intrinsic difficulty is exacerbated, in the context of the EU, by the added complexity of reasoning about variable mores at the time of assessment, while also considering the geo-cultural diversity of the EU and the prevailing mores in the constituent member states. This highlights that this area of trade mark registration, due to its subjective nature, is intrinsically difficult to reason about.¹²¹

CP14 is intended to accomplish its objective through guidelines to be used in carrying out the assessment of moral and public policy propriety, with a view to fostering transparency and consistency in the application of public policy and morality in the context of trade mark registration.¹²²

Pablo Escobar

The recent Pablo Escobar¹²³ case highlights many of the issues arising from the aforesaid moral, temporal and geo-cultural complexity. The case concerned an application to the EU IPO for the word mark PABLO ESCOBAR by Escobar Inc. The case concerned, amongst other things, the perceptions of the drug lord Pablo Escobar, the relevant public for assessing such perceptions and the cultural characteristics of that public.

¹²¹ Rachel Claire Brady, 'Trade Marks Contrary to Public Policy or to Accepted Principles of Morality - a Critical Analysis of CP14' (2023) 45 European Intellectual Property Review 472, 472-473

¹²² *Ibid*, 473-475

¹²³ Case T-255/23 Escobar v EUIPO [2024] E.T.M.R. 30

The General Court states that the assessment of propriety under Art.7(1)(f) is to be carried out in an objective manner, “based on the standard of a reasonable person with average sensitivity and tolerance thresholds.”¹²⁴

The Court further stated that the relevant public, for this purpose, was the public in Spain, on account of the linguistic and historical connection between Colombia and Spain.¹²⁵ Accordingly, the propriety assessment would have to be carried out with reference to the aforesaid reasonable person within the Spanish public,¹²⁶ rather than with reference to a majority of the Spanish public.¹²⁷ The Court stated that it is sufficient if “at least a non-negligible part of the relevant Spanish public would associate the mark applied for with Pablo Escobar, perceived as a symbol of a drug lord and a narco-terrorist.”¹²⁸

The wording “non-negligible” indicates that there is a quantitative element to the assessment, but it does not require a majority.

Bad Faith

It is conceivable for a trade mark application made in bad faith to be successful. However, such an application is nevertheless subject to being revoked, if successfully challenged on grounds of bad faith.¹²⁹ A finding of bad faith is a procedural consideration.¹³⁰ The substance of the application is not under review in determining whether the applicant acted in bad faith. An otherwise suitable application might be revoked in response to a successful challenge based on the circumstances, rather than the substance, of the application.¹³¹

There is no exhaustive list as to the manifestations of bad faith, and the test to determine

¹²⁴ Ibid, [24]

¹²⁵ Ibid [19], [20]

¹²⁶ Ibid, [25]

¹²⁷ Ibid, [24]

¹²⁸ Ibid, [21]

¹²⁹ Susie Middlemiss and Jeremy Phillips (n 84).

¹³⁰ Ieuan Jolly, ‘Earlier Rights and Passing Off’ (2003) 15 Entertainment Law Review 25.

¹³¹ Conrad Arander, ‘Passing off - Ownership of Goodwill’ (2001) 12 Entertainment Law Review N25,28.

whether bad faith is present looks at the totality of circumstances¹³² Bad faith needs to be established at the date of application, and subsequent behaviour can be indicative of the presence of bad faith.¹³³ It is also possible for an application to be made in good faith, yet the applicant's circumstances and behaviour can lead to a subsequent finding of bad faith where bad faith emerges between the filing of the trade mark and a grant thereof.¹³⁴ In the *MICKEY DEES*¹³⁵ case, the court was concerned with the application of an employee, without the permission of the proprietor, for a trade mark which he had no interest in. The mark pertained to the undertaking, a night club, and only a portion of the functions in the specification were carried out by the applicant, who provided only "singing and musician services," so the registrar determined the application to have been made in bad faith 'only in part'.¹³⁶ However, the onus remains with the party making the allegation of bad faith to evidence it.¹³⁷ Furthermore, s.32(3) requires,¹³⁸ as part of the application process, effectively a declaration of good faith,¹³⁹ and an intention to use the mark applied for.¹⁴⁰

The focus of the preceding discussion on Public Policy and Morality has been mostly practical. However, a more theoretical discussion is included in Chapter 4, which discusses the issue in more theoretical detail and with the inclusion of Japanese materials as well.¹⁴¹

¹³² Desiree Fields, 'Supreme Court Confirms That Mere Reputation in the UK Is Insufficient to Establish Passing Off' (2015) 26 Entertainment Law Review 217.

¹³³ Haruo Kubozono, 'The Mora and Syllable Structure in Japanese: Evidence from Speech Errors' (1989) 32 Language and Speech 249.

¹³⁴ Mark Lim and Gene Kwek, 'Conflict between Common Law and Statutory Trade Mark Rights: Does Registration Confer Immunity against a Claim for Passing Off?' (2003) 26 European Intellectual Property Review 36.

¹³⁵ 'MICKEY DEES (Nightclub) Trade Mark' (1998) 115 Reports of Patent, Design and Trade Mark Cases 359.

¹³⁶ Michael Edenborough, 'Trade Marks - Declaration of Invalidity - Bad Faith - Earlier Right - Amendment to the Specification' (1998) 20 European Intellectual Property Review N47.

¹³⁷ Catherine W. Ng, 'A Common Law of Passing-off? English and Scottish Perspectives' (2009) 13 Edinburgh Law Review 134.

¹³⁸ Kimberlee Weatherall, 'The Consumer as the Empirical Measure of Trade Mark Law' (2017) 80 Modern Law Review 57.

¹³⁹ 'MICKEY DEES (Nightclub) Trade Mark' (n 135).

¹⁴⁰ Rachel Aaron, 'Trade Marks - Applications in Bad Faith' (2004) 26 European Intellectual Property Review N22.

¹⁴¹ *Infra* 4.12

2.4 *The Protection of Unregistered Marks*

The United Kingdom is the origin jurisdiction of the action for passing-off. Passing-off exists in the same Infrastructure as trade marks and often it is encountered alongside them. The United Kingdom has a registration-based trade mark regime, so there is a significant and intentional discrepancy in the power and value of an unregistered and a registered mark. The registration of trade marks is the foundation of the trade mark system,¹⁴² and passing-off is a related legal feature which can provide a degree of protection for marks which are legitimately used in the absence of a registration.

An action in passing-off is a judicial action where the pursuer must establish the existence of goodwill, as opposed to that of any type of registered or unregistered right.¹⁴³ A legal person, for example, which enjoys a long history of using a specific mark will face a lesser evidential burden in establishing goodwill, but technically there is no reason why a lesser known commercial entity could not establish goodwill accruing to a mark, the use of which has only recently commenced, provided that the requirements of passing-off are met.¹⁴⁴

Furthermore, goodwill is geographically-based.¹⁴⁵ An undertaking which does not have customers in the UK cannot have the requisite goodwill, and an action in passing-off will not succeed where the customers of the aggrieved undertaking are customers only abroad¹⁴⁶ irrespective of whether they are present in the UK as non-customers.¹⁴⁷

¹⁴² *Infra* 4.10 regarding reification.

¹⁴³ Conrad Arnander (n 131).

¹⁴⁴ *Reckitt & Colman Products Ltd v Borden Inc (No3)* [1990] RPC 341.

¹⁴⁵ Jennifer Davis, 'The Continuing Importance of Local Goodwill in Passing Off' (2015) 74 Cambridge Law Journal 419.

¹⁴⁶ *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31.

¹⁴⁷ Desiree Fields (n 132).

The pursuer must establish that the defendant's actions were such as to mislead the public into believing that the goods originate from the pursuer or are otherwise affiliated with the pursuer.¹⁴⁸ It is not necessary to establish that such misrepresentation¹⁴⁹ was the result of fraudulent action. Passing-off operates even in the absence of bad faith, and even innocent misrepresentation can be grounds for an action in passing-off. Passing-off is not concerned with protecting the interests of the consumers. It operates to the advantage of the party who suffered the misrepresentation. Only the undertaking which has suffered resultant damage has the ability to bring an action in passing-off.¹⁵⁰

The pursuer must also show that the misrepresentation and the subsequent confusion on part of the consumers has resulted in some form of damage. Damage is understood in the broad sense. It is simple to establish a loss of revenues arising from a loss of sales where the goods or services concerned are evidently in commercial competition with each other, however other forms of damage can be considered satisfactory as well.¹⁵¹

All three of the aforesaid elements must be present: goodwill, misrepresentation and damage. As passing-off is very laborious in terms of the evidential burden,¹⁵² it is important to note that often passing-off is not economically viable as a long-term brand protection strategy.

There is no register for successful passing-off challenges which would afford any protection

¹⁴⁸ Catherine W. Ng, 'The Law of Passing off - Goodwill beyond Goods' (2016) 47 *International Review of Intellectual Property and Competition Law* 817.

¹⁴⁹ Laurence J. Cohen and Kate Schmit, 'Is the English Law of Passing off Discriminatory to Continental European Trade Mark Owners?' (1999) 21 *European Intellectual Property Review* 88.

¹⁵⁰ Catherine W. Ng (n 148).

¹⁵¹ *Reckitt & Colman Products Ltd v Borden Inc (No.3)* [1990] R.P.C. 341 (n 144).

¹⁵² 'Passing-off Claim - Costs-Capping Order' (2006) 7 *Civil Procedure News* 3.

to an undertaking which had successfully resorted to the remedy of passing-off.¹⁵³ This means that every instance of passing-off imposes the same procedural requirements in terms of fact-finding, and every passing-off litigation is complete, even if a subsequent one must completely replicate all of the procedural, fact-finding steps of the previous one.

This is compounded by the fact that all three elements of the tripartite test must always face the evidential burden and be established. Misrepresentation and damage are, understandably, unique to each case brought, yet even the existence of goodwill must be established in every instance of litigation, even though the same undertaking might have successfully overcome the evidential burden of establishing goodwill for the same goods or services marketed under the same appellation as those concerned in earlier litigation.

This creates a curious relationship between trade marks and passing-off. The Trade Mark Act 1994 expressly states that its provisions do not prejudice the law of passing-off,¹⁵⁴ which means that a registered trade mark is not a defence¹⁵⁵ against passing-off,¹⁵⁶ and an undertaking might find itself liable for passing-off despite using a registered trade mark.¹⁵⁷ At the same time, there is nothing in the operation of the 1994 Act which prevents an unregistered and even, at times, unregistrable mark from being protected under the law of passing-off.¹⁵⁸ In this way, a mark which might fall foul of the absolute requirements of registration might still be protected, such as with a mark which is too generic to be

¹⁵³ Kimberlee Weatherall (n 138).

¹⁵⁴ Trade Marks Act 1994 s 2(2).

¹⁵⁵ Ieuan Jolly (n 130).

¹⁵⁶ Konrad Zweigert and others, *An Introduction to Comparative Law* (3rd edn, Oxford University Press 1998).

¹⁵⁷ Mark Lim and Gene Kwek (n 134).

¹⁵⁸ Maire Ni Shuilleabhain, 'Common-Law Protection of Trade Marks - the Continuing Relevance of Passing Off' (2003)

34 *International Review of Intellectual Property and Competition Law* 722.

registered,¹⁵⁹ albeit this is possible only through the procedurally laborious system of potentially recurrent challenges under passing-off.¹⁶⁰ It is a possibility, but it is far easier and less costly to simply register a trade mark.

2.4.1 **The Brand Protection Ecosystem**

Trade marks and passing-off exist in the same brand protection ecosystem. These systems are different - they have different procedural steps, protect different rights or interests and they have different strategic value in a commercial context. However, passing-off is facultatively available in many trade mark infringement circumstances, such as where the circumstances meet the requirements of both trade mark infringement and passing-off.

Trade marks and passing-off can be complementary in the sense that, although they can co-occur in trade mark cases, passing-off can provide a measure of protection in the absence of registered trade marks. However, despite this complementarity, trade marks and passing-off have completely different objectives.

Trade marks are property rights and they protect the exclusionary right of the proprietor to use the mark. In contrast, the purpose of passing-off is to protect the goodwill accrued to a business.

¹⁵⁹ See Trade Marks Act 1994 s 3(1) regarding acquired distinctiveness.

¹⁶⁰ Alice Blythe (n 71).

2.4.2 Court System

As the United Kingdom has multiple constituent parts for the purpose of court nomenclature, trade mark litigation can begin in a number of ways. The traditional destination for trade mark disputes is the Chancery Division of the High Court, or the Intellectual Property Enterprise Court for claims under £500,000.

The Intellectual Property Enterprise Court, which was constituted originally as the Patents County Court, is essentially a ‘small claims court’ for intellectual property claims. While it is a direct successor of the Patents County Court, the IP Enterprise Court has undergone major reforms of procedures and remit.

The initial purpose of the court was to offer a more streamlined, cost-effective and efficient process for smaller cases. Judges presiding over cases at IPEC enjoy a more extensive role in having greater involvement in the investigation by exerting greater control in the pre-trial phase, and the application process is much more streamlined and rigorous, which allows the court to handle a large number of less complicated cases.

Rule 63 on Intellectual Property Claims sets out the procedures of the court. While IPEC was created with a specific, streamlined and highly efficient procedure in mind, the same streamlined procedures have since been made available to all courts. Furthermore, IPEC is a special list of the High Court, and depending on the subject matter of the litigation, transfer of cases is possible between the High Court and IPEC. Additionally, appeals from the Enterprise Court are heard by the Court of Appeal.

The court, which was initially formulated as the Patents County Court, has accordingly undergone some structural changes which are also discussed below. For the purposes of the present discussion, the important feature of the IPEC is that it is intended to satisfy the demand for simpler litigation, with a “Small Claims Track”¹⁶¹ for dealing with litigation involving relatively small awards, in the range of £10,000 and below,¹⁶² with a cap on recoverable counsel fees. While the compensation sought must be no more than £10,000, the court can make awards in excess of that sum.

As outlined below, the IPEC is a court which is intended to process a large volume of simple cases, to provide legal accessibility.¹⁶³ The SCT proceedings serve to create a measure of economic parity between prospective litigants of disparate economic power.¹⁶⁴ However, the Small Claims Track is also subject to significant limitations. The Small Claims Track excludes cases concerning patents, registered designs and plant varieties, but it does permit cases concerning UK registered trade mark rights, as well as some other IP rights.

While, in principle, cases regarding trade mark rights can be brought through the Small Claims Track, there are further limitations arising from the characteristics of the particular claim. The IPEC Guide states that:

"In deciding on allocation, the court will take into account the value of the claim, the type of intellectual property rights it relates to, the likely complexity and the number of parties and

¹⁶¹ HM Courts & Tribunals Service, ‘Guide to the Intellectual Property Enterprise Court Small Claims Track’ <<https://assets.publishing.service.gov.uk/media/64a82d47404eac00c763b52/ipec-sdt-guidance.pdf>> accessed 14 June 2024.

¹⁶² *ibid* 4.

¹⁶³ Angela Fox, *The Intellectual Property Enterprise Court: Practice and Procedure* (Sweet & Maxwell 2014).

¹⁶⁴ *ibid*.

the number of witnesses that may be needed to give oral evidence. A claim where both liability and quantum cannot be resolved within one day (to include judicial reading time) are usually not suitable for the IPEC SCT. By way of example, cases concerned with the validity of trade marks (rather than the infringement of a trade mark), for example, are unlikely to be suitable."¹⁶⁵

Accordingly, while the Small Claims Track is open to trade mark litigation, there are significant complexity limitations which preclude complex cases including trade mark validity cases which are "unlikely to be suitable."¹⁶⁶

The formulation of the PCC occurred in 1990, whereas the internet was born in 1983. By the early 90s, the technological foundations of information society were already laid. The PCC was restructured and reformulated over 20 years later in 2013 to become the IPEC.¹⁶⁷ The internet is a mercurial entity which has become an engine of trade mark dissemination unlike any previous medium before it.

Due to the nature of the internet, the dissemination of information is trivial, and virtually all of the information is able to cross state boundaries unhindered, with the exception of various instances of state censorship of the internet.

Barriers to entry are greatly diminished within the digital economy, and foregoing costs traditionally associated with establishing a business has resulted in an increase of business

¹⁶⁵ HM Courts & Tribunals Service (n 161) 5.

¹⁶⁶ *ibid* 4.

¹⁶⁷ Fox (n 163) ss 1–002.

activity, including largely by market actors with a relatively smaller pool of resources at their disposal.

The number of trade mark applications in the UK in 1995 was in the range of 60,000¹⁶⁸ and, in spite of a noticeable decrease in applications around the time of the financial crisis of 2007-2008 and onward, the aggregate number of applications had reached approximately 165,000, likely achieving a more than threefold increase since then.¹⁶⁹ The threefold increase also broadly coincided with evolution of the PCC/IPEC and the evolution of the digital economy and the internet.

This process has been catalysed by transformative technological changes, chiefly in the context of the internet and internet content delivery, which have resulted in the proliferation of such iconic content delivery services as Netflix, Steam, etc., furnishing catalogues of products,¹⁷⁰ almost all of them complete with their affixed trade marks and other forms of intellectual property.

The growth of the online trade mark ecosystem, however, has not been restricted to monolithic giant corporations. The number of corporations with 250+ employees has suffered a large drop in numbers between 2000 and 2016, and the number has only recently rebounded, with large companies having increased by 8% in number over the course of the

¹⁶⁸Facts and Figures: Patent, Trade Mark, Design and Hearing Data: 2019' (GOV.UK) <<https://www.gov.uk/government/statistics/facts-and-figures-patent-trade-mark-design-and-hearing-data-2019/facts-and-figures-patent-trade-mark-design-and-hearing-data-2019>> accessed 2 April 2021..

¹⁶⁹ *ibid.*

¹⁷⁰ Roland Frank, Gregor Schumacher and Andreas Tamm, 'Everything Becomes Digital' in Roland Frank, Gregor Schumacher and Andreas Tamm (eds), *Cloud Transformation: The Public Cloud Is Changing Businesses* (Springer Fachmedien 2023).

last two decades. There has been moderate growth in the numbers of smaller companies, in the range of 30-40% since 2000. However, number of businesses without employees has nearly doubled, showing an increase of 94% over the course of the last two decades. In terms of the population of all businesses, small enterprises account for over 99% of the aggregate businesses operating in the UK, albeit this does not automatically translate into a 99% share of the markets or capital.¹⁷¹

While these businesses do not, necessarily, need to use trade marks, and it is reasonable to expect that many of them will rely on generic marks of, at most, local significance, trade mark acquisition in the UK is remarkably inexpensive. The baseline trade mark application costs only £170, or £200 using a physical medium, with additional classes charged at a rate of £50 per additional class.¹⁷² With such expenses, it is not impossible for even smaller businesses to secure trade marks, to say nothing of the fact that trade mark litigation need not result from a new registration – it can just as easily result from a purportedly infringing use.

IPEC divides litigation into two forms or tracks. The “multi-track” litigation is for larger claims, but it is still restricted to claims of up to £500,000,¹⁷³ which, in the context of the Japanese *McDonald’s* litigation,¹⁷⁴ for example, is a very modest sum. The previously discussed small claims track is, in comparison, microscopic with its limit of £10,000 for claims. IPEC also heavily emphasises adherence to timelines and process.¹⁷⁵ The target timeline is 8 months for an application to result in a hearing, and once the process is in motion, deviation

¹⁷¹UK Small Business Statistics’ <<https://www.merchantsavvy.co.uk/uk-sme-data-stats-charts/>> accessed 2 April 2021..

¹⁷²Facts and Figures: Patent, Trade Mark, Design and Hearing Data: 2019’ (n 168)..

¹⁷³ HM Courts & Tribunals Service (n 161).

¹⁷⁴ See *McDonald’s v Mac Sangyo KK 13 Shouma 56* (Supreme Court) and 3.1.4.

¹⁷⁵ HM Courts & Tribunals Service (n 161).

from established dates and time allotments is very difficult. The process is stricter for the SCT than the MT. Stricter time controls and brevity of proceedings results in a considerably cheaper system for handling small to medium claims, and smaller,¹⁷⁶ more financially vulnerable businesses are not required to submit themselves to the much more generous timelines imposed by the High Court, for example.

The IPEC Court Guide also promotes the work of IP Pro Bono, offering prospective litigants who cannot afford counsel representation on a pro bono basis. The court and hearing fees for the SCT are set out in the EX50 Civil and Family Court Fees supplement.¹⁷⁷ The fees are based on the value of the claim, but the court fees do not exceed £528 + £455, which is the highest fees tier, applicable to claims with a value between 5,001 and 10,000. Likewise, hearing fees are £335 for claims over £3,000.¹⁷⁸

2.4.3 The Trade Mark Attorney Profession in the UK

The trade mark attorney profession is a relatively recent addition to the wider legal profession, and it has undergone major developments in recent years. Trade mark attorneys must belong to a professional regulatory body which enforces a standard of professionalism, as with any other professional body.

All¹⁷⁹ trade mark attorneys must hold membership with the Chartered Institute of Trade

¹⁷⁶ Fox (n 163).

¹⁷⁷ HM Courts & Tribunals Service, “Civil And Family Court Fees” <https://assets.publishing.service.gov.uk/media/6627a846838212a903a7e60f/EX50A-civil-and-family-court-fees_May_2024.pdf> accessed 12 May 2024.

¹⁷⁸ *ibid.*

¹⁷⁹ Legal Services Act 2007 s 10.

Mark Attorneys (CITMA). In practice, CITMA is a body promoting the interests of the trade mark attorney profession, and it is not the regulatory branch of the body. For regulatory purposes, CITMA and the Chartered Institute of Patent Attorneys (CIPA), which serves an identical role to CITMA in the context of patent attorneys, have jointly established a regulatory body, the Intellectual Property Regulatory Board (IPReg) in order to regulate the two respective professions.¹⁸⁰

As a regulatory body, IPReg is responsible for determining the training requirements of the two respective professions, including the requirements for the ongoing professional development of the members of the two professions, maintaining a Code of Conduct applicable to trade mark and patent attorneys and handling complaints and taking appropriate disciplinary action where warranted. The Code of Conduct is extensive and deals with matters which mirror the Codes of Conduct of other, professional regulatory bodies constituted in a similar vein, dealing with issues such as procedure, matters of integrity, professional indemnity, professional conduct, fees and liens, the promotion of justice, anti-discrimination and confidentiality.¹⁸¹

¹⁸⁰ 'Front Page | The Intellectual Property Regulation Board' <<https://ipreg.org.uk/>> accessed 6 April 2018.

¹⁸¹ IPREG, 'IPREG Disciplinary Process' <https://ipreg.org.uk/wp-content/files/2012/07/Summary-of-disciplinary-procedure_04-11-11_.pdf> accessed 6 April 2018.

2.5 *The Trade Marks Act 1938*

The Trade Marks Act 1938 is the precursor of the modern Trade Marks Act 1994. The reason for the inclusion of this historic piece of legislation is to demonstrate the historic roots and continuity of the registration-based paradigm in UK trade mark law. A central question, which will be addressed in later chapters, is whether WIPO and TRIPS are responsible the level of convergence between Japan and the UK, and to this end, it is important to assess and reason about whether the same paradigm was enshrined in the 1938 Act as in its modern successor the 1994 Act.

Unlike the 1994 Act, the 1938 Act does not categories the grounds of refusal into absolute and relative grounds. The layout and provisions of the 1938 Act are somewhat simpler and more limited than the modern equivalents in the 1994 Act, but some parallels can be found. For example, s.9 is, in essence, a simpler form of the absolute grounds under s.3 of the 1994 Act, restricted mostly to distinctiveness, compared to the breadth of s.3 of the 1994 Act. S.11 of the 1938 Act also provides some of what would in the 1994 Act become absolute grounds, such as marks which are deceptive or contrary to law or morality. S.12 deals with senior marks, but this provision is of less interest for the purposes of this thesis.

The 1938 Act also implicitly treats trade marks in a reified fashion – as property. S.4 defines the scope of the proprietary right, whereas s.22 defines the nature of the exclusionary legal monopoly provided by the right. Sections 22-25 regulate the assignment and transmission of the trade mark right, which is generally permitted under the 1938 Act. While the 1938 Act is not as sophisticated as its successor the 1994 Act, it still contains all the requisite provisions of a registration-based, reified trade mark system.

2.6 *International Instruments of Trade Mark Law*

It is important to introduce, in some detail, the international instruments of trade marks law, which are discussed in the succeeding paragraphs. This is not specific or exclusive to the UK legal system, but there is merit in discussing it early for the sake of clarity and to inform subsequent discussions. This will not be reproduced in Chapter 3, the Japanese substantive law chapter, in detail, but the only reason for this and the inclusion of this information in this chapter is that it simply occurs earlier in the text.

Intellectual property law is principally constituted by national trade mark regimes. Despite the multifarious iterations of trade mark regimes, collectively these regimes form a broader nexus of global trade mark law. It is useful to understand domestic trade mark regimes to be able to navigate the global trade mark system, as increasingly trade marks are exploited in a manner which transcends geographic boundaries. With the proliferation of sophisticated, global logistical networks and digital goods, trade marks are very easily able to pass through state boundaries.

While trade marks are constituted domestically, they are subject to international agreements which seek to shape the manner in which signatory states constitute and administer their trade mark regimes. There is value in unifying and centralising a system, such as trade marks, because it fosters certainty and consistency. However, trade mark regimes need not necessarily be consolidated in this fashion. Presently, much of the harmonisation focuses on the approximation of laws, rather than the consolidation of trade mark law institutions. Because of this, as it will be discussed, international agreements typically promote the

approximation of laws through the establishment of minimum levels of protection. For example, even the Madrid System is merely one which is intended to facilitate the registration of a trade mark in multiple jurisdictions, without the ability to produce a trade mark which is qualitatively different from a domestic trade mark. While the Madrid system is interesting in its own right, detailed discussion of the system is outside of the scope of this thesis.

2.6.1 Agreement on Trade-Related Aspects of Intellectual Property Rights 1994

The TRIPS agreement is an agreement between the members of the World Trade Organization. The purpose of the agreement is, amongst other things, to promote a minimal level of protection or a template for intellectual property rights. This system championed by the WTO and the World Intellectual Property Organization attracts criticism from some scholars and support from others. The primary point of contention is the reification and commodification of the subject-matter of intellectual property rights.

One of the effects of the TRIPS agreement is described as the 'Paris-plus approach'. All signatories of the agreement are bound by the substantive provisions of the Paris Convention, whether they are signatories of the latter or not. This means that the nationals and corporations of a signatory state are entitled to the right to registration under the same conditions as the nationals of the country where registration is sought. The trade mark rights are also independent of each other, which is reflected in the treatment of identical marks granted across different jurisdictions. The treatment of trade marks falls within the purview of the state where they are granted, and they function independently of each other.

The TRIPS agreement builds on the foundation of the Paris Convention and prescribes identically favourable treatment to foreign applicants for trade marks.¹⁸² Furthermore, it introduces the ‘Most Favoured Nation’ principle, whereby the most favourable regime of treatment offered to nationals of any country will be extended to all other members (from the date of the commencement of TRIPS).¹⁸³

2.6.2 The Paris Convention

The Paris Convention for the Protection of Industrial Property (1883)¹⁸⁴ is a historical instrument of industrial property law dealing with priority dates pertaining to industrial designs, trade marks and patents. It facilitates the filing of trade marks, by creating administrative leeway in terms of calculating the priority date of an application. Where a trade mark application is filed in a signatory state, the same priority date is used in relation to applications made in other signatory states if applied for within a period of 6 months from the initial application.¹⁸⁵

While not as extensive as other instruments or features of domestic law, the Paris Convention is an important instrument both in terms of its effect on commerce, competition and comparative law. It is an international instrument of harmonisation, and it underlines the necessity to create an integrated system of trade mark law to support industry and Infrastructure. It also underlines the universality and uniformity of the needs of commercial

¹⁸² The Agreement on Trade-Related Aspects of Intellectual Property Rights art 3.

¹⁸³ *ibid* 4.

¹⁸⁴ Gabriel Galvez-Behar, ‘The 1883 Paris Convention and the Impossible Unification of Industrial Property’ (Cambridge University Press 2020) <<https://shs.hal.science/halshs-01009953>> accessed 6 May 2024.

¹⁸⁵ *ibid*.

actors worldwide, and the inherent predilection of intellectual property to transcend national boundaries.

2.7 *Conclusion*

This chapter has explored the substantive provisions on the registration of trade marks, including with relation to the absolute and relative grounds for refusal. The chapter introduced the Trade Marks Act 1994,¹⁸⁶ as well as, briefly, its precursor the Trade Marks Act 1938 which predates the UK's WIPO membership TRIPS.¹⁸⁷ This is interesting in terms of the legal history of the UK, but it also supports one of the central positions of the thesis that the registration-based, reified system of trade marks had existed before the harmonising efforts of the WIPO, in conjunction with TRIPS.

Furthermore, this chapter had discussed public policy, bad faith and morality as well, including in the context of the recent case law, highlighting recent trends, such as with relation to the increasingly explicit discussion of the ECHR Art.10 right to freedom of expression.¹⁸⁸

The chapter also explained the court system with relation to intellectual property proceedings and provided a discussion of passing-off, the UK system for the protection of unregistered marks, as well as a brief discussion of the Trade Mark Attorney profession.¹⁸⁹

As this chapter pertains to UK substantive law, and the Japanese substantive law is analysed in the subsequent chapter, the central question outlined in the introduction to this chapter will be answer in the subsequent chapter, after the substantive law analysis with relation to Japan is also completed.¹⁹⁰

¹⁸⁶ *Supra* 2.3

¹⁸⁷ *Supra* 2.5

¹⁸⁸ *Supra* 2.3.5

¹⁸⁹ *Supra* 2.3.8

¹⁹⁰ *Infra* 3.8

3 Substantive Trade Mark Law of Japan

3.1 *Introduction*

This chapter is similar to Chapter 2, the substantive law chapter providing substantive exposition of the UK trade mark regime. Accordingly, this chapter is structurally similar. It is not identical, as the two legal regimes are not identical, but it does discuss the same concerns, albeit with relation to the respective laws of the two legal regimes.

Accordingly, this chapter will look briefly at Japanese legal history, deferring detailed comparative analysis of legal history until Chapter 6. The central discussion in this chapter is regarding the system for the registration and protection of trade marks in Japan. The chapter will look at the Trademark Act 1959, counterpart of the UK Trade Marks Act 1994, and discuss it in the context of trade mark registration.¹⁹¹

In the context of unregistered mark protection, the chapter will look at the Unfair Competition Prevention Act 1993 and the protections afforded by that statute. The chapter will investigate Arts.2(1)(i) and (ii), which are comparable to, albeit also different from, passing-off which has been covered in the previous chapter.¹⁹²

The chapter will also look at the abuse of rights system, as well as the principle of international truthfulness. This is unique to Japan, and it will be discussed in conjunction with the tendency to expropriate and transfer title in circumstances of inequitable

¹⁹¹ *Infra* 3.3, 3.4

¹⁹² *Infra* 3.5

registrations, such as in the context of unfair competition.¹⁹³

Finally, as with the previous chapter, Chapter 3 will look briefly at the Trade Mark Attorney profession and the court system.¹⁹⁴

As articulated in 1.2.1 the central question for this chapter is as follows:

The underlying question for the purposes of Chapters 2 and 3 is, therefore, whether the trade mark regimes are similar on a substantive analysis, before undertaking the comparative and jurisprudential assessments of Chapter 4?¹⁹⁵

¹⁹³ *Infra* 3.5.1

¹⁹⁴ *Infra* 3.7

¹⁹⁵ *Infra* 3.8

3.2 *Legal History of Japan*

Although the most basic cultural foundation of Japan is Shintoism, a form of animistic ancestor worship, there have been numerous other influences which have shaped the Japanese people and their legal structures. The first major set of legal transplants received by Japan manifested in the establishment of the ritsuryou (律令) system.¹⁹⁶ The system was a set of criminal and administrative regulations imported from China.¹⁹⁷ It was used to establish a rigid social hierarchy founded upon Confucian values and it was, in effect, a slightly more lenient iteration of its Chinese counterpart, with the administrative (ryou) element quite resembling the Chinese T'ang Code.¹⁹⁸

While the system, ultimately, began its gradual descent into desuetude in the 8th century, and had, by the 10th effectively fallen into complete disuse, its structural, procedural legacy remained. The idea of law as a regulatory tool predicated upon coherent and cogent procedures of discovery, amongst other things, took root.¹⁹⁹ The aforesaid, progressively increasing rates of poor adherence to the ritsuryou system led, in turn, to declining political cohesion, lawlessness and widespread voracious appropriation of land and, consequently, power.²⁰⁰ The turmoil caused by the diffusion of political power led to great reliance on the martial class.²⁰¹

As the significance of the martial class grew, so too did their power and, unsurprisingly, they started to consolidate their factual power and secure for it formal recognition. By the 12th

¹⁹⁶ Lloyd Duhaime, 'Japan: A Legal History 1210, Part 3 of 5' <<http://www.duhaime.org/LawMuseum/LawArticle-1204/PageID/1210.aspx>> accessed 22 September 2015.

¹⁹⁷ Meryll Dean, *Japanese Legal System* (1st edn, Routledge-Cavendish 2002) 55–57.

¹⁹⁸ Haley, *Authority without Power* (n 31) 17.

¹⁹⁹ *ibid.*

²⁰⁰ *ibid.* 33.

²⁰¹ Lynn Berat, 'The Role of Conciliation in the Japanese Legal System' (1992) 8 *American University Journal of International Law & Policy* 125, 126.

century, the emergence of a powerful martial class and ethos resulted in the birth of the Kamakura Shogunate, as the Minamoto clan wrested power from the rival Taira clan.²⁰² The Kamakura shogunate was, eventually, supplanted by the Ashikaga Shogunate in the 14th century, marking the beginning of the Muromachi era.²⁰³ Ultimately, however, power remained diffused as Japan tread down the path of incessant military conflict with the beginning of the Sengoku era in the 15th century, which lasted all the way until the beginning of the 17th century, when Tokugawa Ieyasu seized control of the country and established the Tokugawa Shogunate.²⁰⁴

Fundamentally, the Tokugawa shoguns brought about virtually no jurisprudential change in the sense of deviating, in a significant manner, from the model of the administrative state.²⁰⁵ Though certainly, the Tokugawa bakufu (幕府) established a strict and impenetrable caste system, it changed little, in most ways, as it remained, still, an administrative system firmly in line with its positive law-based precursors.²⁰⁶ Throughout the Kamakura, Muromachi and Tokugawa periods, law remained an instrument of administrative control and, quite distinct from the Western legal tradition, the law was not used to imbue its subjects, strictly speaking, with rights and powers. Indeed, during the Tokugawa shogunate, law was used as a veritable instrument of repression, which served to maintain the primacy of the ruling martial elite and the immensely wide berth they afforded themselves.²⁰⁷

The Sakoku or closed country period was an isolationist era in Japanese policy, brought about

²⁰² Conrad Totman, *A History of Japan, 2nd Edition* | Wiley (2nd edn, Wiley-Blackwell 2014) 110.

²⁰³ *ibid* 161.

²⁰⁴ *ibid* 218.

²⁰⁵ Haley, *Authority without Power* (n 31) 55.

²⁰⁶ *ibid* 225.

²⁰⁷ Berat (n 201) 129.

by the foreign policy espoused by the Tokugawa shogunate. It lasted from approximately 1633 to 1853, imposing an almost complete embargo on foreign trade, with the exception of a very narrow range of specific ports and domains.²⁰⁸ Meanwhile, the progenitor states of the modern UK went through centuries of trade and industrialisation, establishing a system of mercantilism towards the latter half of the nearly 200 year period.²⁰⁹

The Tokugawa Shogunate, fearing the effects of unchecked Christianity and Western influence, adopted an arguably xenophobic and most certainly isolationist policy. This was decidedly not the path of modernisation and, as historical experience clearly demonstrates, colonial powers were nothing if not determined to subject to their authority those that they could. The opponents of the shogunate recognised this and powers from within and outwith brought to bear on the system. The Tokugawa Shogunate, eventually, went under in the mid 19th century during the Bakumatsu (幕末) period after prolonged strife and struggle, marking the beginning of the Meiji Restoration.²¹⁰

With the Meiji Restoration the modernisation of not only Japanese law but also the entire country began. Previous treaties had the effect that import tariffs on goods were heavily in favour of westerners, and Japanese goods were subject to rather high tariffs in turn.²¹¹ Furthermore, as westerners did not see Japanese criminal justice system as adequate for meting out justice as they understood it, by treaty, westerners accused of crime would need to be tried abroad in their country of nationality. The only feasible solution for dispelling the effects of these onerous treaties was for Japan to modernise its legal system and adopt one

²⁰⁸ Zhao Deyu, 'The Sakoku During the Edo Period of Japan' 2001 Nankai Journal.

²⁰⁹ Editors 'Tijdschrift voor Rechtsgeschiedenis/Revue d'Histoire du Droit/The Legal History Review', 'Tijdschrift Voor Rechtsgeschiedenis/Revue d'Histoire Du Droit/The Legal History Review' 78 Tijdschrift voor Rechtsgeschiedenis/Revue d'Histoire du Droit/The Legal History Review 511.

²¹⁰ Conrad Totman (n 202) 279.

²¹¹ Haley, *Authority without Power* (n 31) 67.

which western powers would deem adequate. To this end Japan expended significant legal comparative effort to understand foreign legal systems in pursuit of establishing its own new or renewed system.²¹² Ultimately, the German model was found most compelling. Although French law was, for a time, a strong contender, it was decided that the more authoritarian German system was better suited to serve as a model for Japan due to a greater degree of similarity between the two countries and their circumstances. Thus, over a short period of time, the Japanese legal system was remoulded into a Germanic or Germanistic legal regime.²¹³

In the early 20th century and leading up to the Second World War, the country grew increasingly more authoritarian and turned to extreme nationalism and fascism. The military - despite setbacks caused by bureaucrats and capitalists who would not seem themselves divested of power - gradually took power,²¹⁴ brought an end to the development of the democratic state and established, in a manner, an ideology proclaiming the divinity of the Emperor and the precedence of the state over the individual. The tumultuous events of the Second World War brought to an end the process of borrowing legal institutions and structures from continental, *Ius Commune* legal systems.²¹⁵ On the other hand, however, the aftermath of the war brought a period of political and legal reordering under the auspices of the occupying forces – predominantly Americans. As one might expect, the third set of transplants was of a modern, Americanised common law nature. The American advisers reshaped much of Japanese law in accordance with their own sensibilities,²¹⁶ but understandably not all of it. While the *ius commune* was the baptist of the Japanese legal

²¹² Oda (n 42) 14.

²¹³ *ibid* 15.

²¹⁴ Conrad Totman (n 202) 445.

²¹⁵ Oda (n 42) 18.

²¹⁶ Haley, *The Spirit of Japanese Law* (n 20) 105.

system, which put it on a path towards becoming, in essence, a western legal regime, it was, at the end of the day, the American iteration of common law which ushered Japanese law into most recent modernity, as some of the most important legislation was enacted during this period, even though quite a number of Meiji instruments survived in whole or for the most part, or at least in spirit.²¹⁷

In the context of Japan, only the structural, mechanical element of the original legal system was transplanted, as there is no parallel historical transplant. Japan did not also transplant a fondness for and a deep interest in the history of the Civil Law, for example, and despite the use of the Romano-Germanic template, there is no strong affinity for the Roman legal roots and history. Japan is as distant to the Twelve Tablets and the Roman laws of antiquity culturally as the United Kingdom, if not more distant, and all of the historic scholarly work which brought about the recovery of the *Corpus Iuris Civilis*.

While this chapter provides some discussion about the legal history of Japan, the primary comparative discussion on this topic is included in Chapter 6, the chapter dedicated to legal history & culture, including linguistics.²¹⁸

²¹⁷ Martin Szarkiszjan (n 51).

²¹⁸ *Infra* 6.2

3.3 *Eligibility of Subject-Matter*

To be registrable as a trade mark, the subject-matter of a mark must be registrable. Art.2(1) describes the registrable range of subject-matter exhaustively:

(1) "Trademark" in this Act means any character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors (hereinafter referred to as a "mark") which is: (i) used in connection with the goods of a person who produces, certifies or assigns the goods as a business; or (ii) used in connection with the services of a person who provides or certifies the services as a business (except those provided for in the preceding item)."

This means that subject to the other provisions of the Act, such as with regard to exclusions to registration and expunction from the register for a host of other reasons, a trade mark is eligible to be registered in the trade mark register of the Japan Patent Office (JPO).

Art.3(1) of the Trademarks Act 1959 sets out that: "(1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered", subject to a range of exceptions or grounds for refusal, as follows:

- (i) "consists solely of a mark indicating, in a common manner, the common name of the goods or services;*
- (ii) is customarily used in connection with the goods or services;*
- (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;*
- (iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person;*

(v) consists solely of a very simple and common mark; or

(vi) is in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.”

3.4 *Objections to Trade Mark Registration & Grounds for Refusal to Register*

The Examination Guidelines²¹⁹ used by the Japanese Patent Office follows the layout of the Trademarks Act 1959. Articles 3 and 4 of the 1959 Act set out Registrable subject-matter and unregistrable marks, respectively, and the relevant Chapters of the examination guidelines follow the format of the two Articles. The UK examination guidelines (Trade Marks Manual) sets out the “mark types” as being: word only, figurative, 3D, hologram, sound, colour and other.²²⁰

The Japanese guidelines similarly define the subject-matter of trade marks under Articles 3 and 4 which broadly correspond to the absolute and relative grounds under ss. 3 and 4 of the 1994 Act. Art.2(1) of the Trademarks Act 1959 states that:

"Trademark" in this Act means, among those which can be perceived by people, any character, figure, sign or three-dimensional shape or color, or any combination thereof; sounds, or anything else specified by Cabinet Order (hereinafter referred to as a "mark").

The equivalent provision, s 1(a) in the Trade Marks Act 1994 describes *trade mark* as "any sign which is capable":

"of being represented in the register in a manner which enables the registrar and other competent authorities

²¹⁹ 'Examination Guidelines for Trademarks | Japan Patent Office'
<<https://www.jpo.go.jp/e/system/laws/rule/guideline/trademark/kijun/document/index/all.pdf>> accessed 5 May 2024.

²²⁰ UK Intellectual Property Office (n 66) s 2.2.2

and the public to determine the clear and precise subject matter of the protection afforded to the proprietor,"

The Japanese provisions are more specifically worded, and the UK provisions only define a standard, rather than specify a list of eligible types of sign. However, due to the *clear and precise* requirement and the judicial treatment of the subject-matter, such as in *Sieckmann*,²²¹ the UK provisions are similar in scope to the Japanese provisions, albeit relying on different drafting styles to narrow the scope.

The layout of the Japanese Arts. 3 and 4 broadly mirror the subject-matter of the Absolute and Relative grounds of refusal under ss.3 and 4 of the 1994 Act.

In Japan, the Japan Patent Office is responsible for examining trade mark registrations and the marks applied for. To this end, they employ a set of guidelines which corresponds to more verbose definitions of the relevant provisions of the Trademark Act 1959 and the guidelines are available online on the JPO website, including in English. While understandably the JPO is not a branch of the legislature, the concepts which they discuss do find their way into judicial discourse. The guidelines²²² on Art.4(1)(vii) are responsible for expanding on the terse wording of the 1959 Act on marks which are contrary to public policy. In particular, the examination guidelines include trade marks which are *“liable to dishonor a specific country or its people”*²²³ as unregistrable, which is very specific and useful in reasoning about the normative basis for exclusion from registration. Naturally, whether something dishonours a specific country or its people will be judged in accordance with the prevailing

²²¹ *Case C-273/00 Ralf Sieckmann v Deutsches Patent und Markenamt* [2003] ETMR 37.

²²² Chapter III ‘Examination Guidelines for Trademarks | Japan Patent Office’ (n 219) art 6.

²²³ *ibid.*

moral atmosphere, e.g. *Seirogan*,²²⁴ *Fintan*,²²⁵ *Tarzan*.²²⁶

²²⁴ Hoi-eun Kim, 'Cure for Empire: The "Conquer-Russia-Pill", Pharmaceutical Manufacturers, and the Making of Patriotic Japanese, 1904–45' (2013) 57 *Medical History* 249.

²²⁵ T2018-87581 FINTAN (フィンタン) Appeal 1370146.

²²⁶ *Tarzan Heisei 23 (gyo-ke) 10399 2012*.

3.5 *The Protection of Unregistered Marks*

3.5.1 **The Concept of "International Truthfulness" or "International Faith" & the Limits of Idiomatic Terminology**

Translating or transliterating something from one language to another is a heuristic process, which takes account of the intended audience, which determines the sufficiency of a particular translation. *Kokusai Shingi*, for instance, means something along the lines of “International Truthfulness”. Kenneth L. Port translates it as “international truthfulness” and defines it as a concept in broadly the same category as comity.²²⁷ According to Port’s definition, therefore, this concept is “trade mark comity”. This assertion is not necessarily untrue, but it is a heuristic one. Considering the broader application of *Kokusai Shingi*, it makes practical sense for Port to employ a heuristic definition which facilitates his discussion of trade mark law, where private international law makes a brief, elucidatory appearance, rather than the other way around.²²⁸

In truth, *Kokusai Shingi* is a more nuanced concept along the lines of: extra-jurisdictional deference to existing quasi-property rights in other jurisdictions on a normative basis rooted in a communitarian account or understanding of the international community. Port, in the interests of brevity, likely used a term well-understood in his primary jurisdiction, as well as the broader juristic community, because the breadth of his work demanded brevity, so the definition is heuristically sufficient.

In practice, however, there is no strict equivalent in the English legal vocabulary, and such

²²⁷ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20).

²²⁸ *ibid* 110.

concepts, and even more trite ones, require neutral, system-agnostic definitions to define phenomena.

Furthermore, as Zweigert and Kotz explain, there is an innate risk in looking for things across different jurisdictions which are structurally similar, similarly placed or similarly worded. It is possible for two statutes to have provisions which bring about a functionally equivalent result despite being structurally different. It is likewise possible for two similarly titled or worded provisions to have different functional effect, such as where there is a divergence in the connotations of words within terms, as with unfair competition and competition law.²²⁹

The American body of anti-trust law is another example where legal evolution, driven by circumstances, resulted in the labelling of competition law, a descriptive term, as anti-trust law, which is a traditionally American mode of referring to competition law. Anti-trust law had descriptively defined early American competition law, but the body of law continues to be referred to as anti-trust for historic and traditional reasons, rather than because the notion of being critical towards trusts intrinsically encompasses things such as resale price maintenance or hard core cartels. Anti-trust is an idiom of the American branch of legal English, and it is understood idiomatically, rather than descriptively, by individuals who are at least somewhat versed in idiomatic American legal English.

*DUCERA*²³⁰ is a case decided based on the elusive idea of international truthfulness. The *DUCERA* case involved a domestic undertaking seeking to register the marks of the

²²⁹ Zweigert and others (n 156).

²³⁰ *Taishin Trading KK v Ducera Dental* [1999] 1710 Hanrei Jihou 147 (Tokyo High Court).

proprietor of parallel overseas marks. The Japanese party was in negotiations with the overseas proprietor regarding the introduction of the IP to the Japanese market, and whilst the negotiations were ongoing, the Japanese party sought to register the mark DUCERUM. This case is almost a decade more recent than the final chapter of the McDonald's litigation above, so it is arguably more closely in line with modern Japanese judicial sensibilities and practice, but there are nevertheless conceptual difficulties surrounding the case.²³¹

In the Troy litigation, for example, the court refused to intervene in the operation of the Japanese regime of trade mark registration, and a remedy was offered to the overseas proprietor in the form of transfer of title. This is conceptually sound and it is in line with the rights and registration based Japanese system. In contrast, in DUCERA, the Tokyo High Court decided the matter on the basis international truthfulness. This is a nebulous and oddly-placed principle in Japanese law, and Port argues that this is an antithesis of territoriality in the context of trade marks and a form of international comity.²³²

This decision is potentially a significant departure from the previous conception of trade mark exploitation across borders. This is because in contrast with Troy, title was not transferred and instead, the court prevented registration of the mark, arguing that to permit it would amount to a violation of international truthfulness. This is at odds with the outcome of the McDonald's litigation, for example, and incongruous with the reasoning in both that succession of cases and Tarzan.²³³

²³¹ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 111.

²³² *ibid.*

²³³ *ibid* 71, 78, 111.

In any case, the precise boundaries of international truthfulness are not defined. It is a hypothetical possibility, and not contrary to logic, that international truthfulness is universally applicable to all extraterritorial rights or, at the very least, to all extraterritorial trade mark rights. However, there has been no judicial output supporting this position. Overseas trade mark registrations are not asserted as though they are Japanese registrations, at least not effectively and in great number. Indeed, it is more probable that the limits of international truthfulness, much like the boundaries of public interest or *ordre public*, are deliberately inchoate and ambiguous. In *McDonald's* and *Tarzan* the overseas proprietors of marks have persuaded the Japanese judiciary to grant them a remedy by suspending the strict application of the registration-based system. These were strictly remedies, and likely no systematic reliance on extra-territorial trade mark rights was envisaged by the courts in granting such remedy.²³⁴

International truthfulness does not appear in the body of trade mark, or any other judicial, decisions frequently. Furthermore, based on its indeterminacy and the frequency of its invocation, international truthfulness is not a remedy or legal function which is intended to be relied on as an effective and regular trade mark and brand protection strategy. In the judicial practice, it features as a last resort or remedy where the literal and harsh application of the law is seen by the pertinent court as demanding an inequitable outcome, which can only be accomplished through a clever workaround.

²³⁴ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20).

The Japanese Trademark Act 1959²³⁵ is quiet with relation to normatively problematic trade marks and merely provides that trade marks which are liable to cause damage to public policy are not to be registered. There is no statement to the extent that trade marks which contravene principles of *International Truthfulness*. In practice, the term kokusai shingi corresponds closest to “international authenticity” or “international truthfulness”, however as seen in the *Tarzan* and *Ducera*²³⁶ (a case where trade negotiations have broken down between domestic registrants and foreign partners – a similar case to *McDonald’s* below, where the Japanese courts decided in favour of the foreign undertaking on equitable grounds) cases, the courts can employ a moral principle when opposing the registration of a trade mark which they find it would be inequitable to register.²³⁷

It appears that at the level of trade mark examination, the international truthfulness tool is employed to guard against morally objectionable registrations of marks, which might not be domestically well-known or famous in a legal sense, yet for some moral reason it is thought that they should attract protection. TARZAN was not, by any measure, of overwhelming fame or acclaim in Japan at the time²³⁸ and so it was not possible to invalidate the mark on grounds of its prevalence throughout Japan,²³⁹ instead the justification provided for invalidating the registration was that such registration might have a detrimental effect on the pride and the feelings of the American people, for whom Tarzan is an iconic cultural element.²⁴⁰

²³⁵ Trademarks Act 1959 art 4(1)(vii).

²³⁶ *Taishin Trading KK v Ducera Dental* (n 230).

²³⁷ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 71, 78, 111.

²³⁸ Hogan Lovells-Eiichiro Kubota, “‘Tarzan’ Trademark Registration against Public Order and Morality” (*Lexology*, 25 October 2012) <<https://www.lexology.com/library/detail.aspx?g=9490456c-d744-41b9-a983-1d4f43ca9d45>> accessed 5 May 2024.

²³⁹ John A. Tessensohn, ‘IP High Court of Japan Rescues TARZAN Trademark in Distress’ (2013) 35 *European Intellectual Property Review* 228.

²⁴⁰ *ibid.*

In summary, *kokusai shingi* appears in two inter-related sets of cases. Cases which involve deception as to origin at the international level, such as trying to register a mark where the proprietary interest vests in a different, foreign undertaking such as in DUCERA, and cases where the registration of the mark would be simply normatively demeaning and insulting internationally, or otherwise frustrate public policy at the international level, even if domestically the registration would not be contentious, such as in *Tarzan* or the WWII, original rendering of *Seirogan*.

This raises the question whether the principle is a form of international comity. *Tarzan*²⁴¹ was a registrable mark which did not exhibit any intrinsic or extrinsic issues in the context of its registration in Japan. There was no obvious legal provision mandating that the Japanese courts must protect the mark from such appropriation in Japan. However, the court decided, nevertheless, to protect the dignity of such an important American cultural icon from the depredations of what might be described as an early trade mark troll, despite the extraterritoriality of such protection.²⁴²

The other strand, seen in DUCERA, focuses more on the pragmatic matters, as the DUCERA case concerned trade negotiations which have fallen through. The Japanese partner of the foreign undertaking with proprietary interest decided to register the mark despite the failed negotiations. The JPO and the Japanese court both decided that to permit the registration of the mark would contravene international morality and undermine the

²⁴¹ *Tarzan Heisei 23 (gyo-ke) 10399 2012* (n 226).

²⁴² Kubota (n 238).

public order which exists in the realm of international commerce. In the loose sense, it is easy to identify comity here, since there is regard for not only the international commercial system, but there is also recognition of the fact that the proprietary interest vested in DUCERUM vests not in the applicant, but in the undertaking with whom negotiations have fallen through. In contrast, it is likely that this matter would be resolved in the UK through passing-off, rather than through a nebulous moral principle.

3.5.2 Equitable Principle & Transfer of Title

Much of the scholarly writing on the topic discusses the first-to-file nature of the Japanese trade mark system from the perspective of its American counterpart, e.g. Port.²⁴³ In a comparison between the US and the Japanese trade mark registration systems, the difference appears stark, however, the UK²⁴⁴ and the rest of the EU operate an unambiguously filing based system of trade mark registration.

In this respect, the matter of unregistered marks in the UK is handled primarily through the law of passing-off,²⁴⁵ which has normative foundations, as a judicial remedy which ought to protect against states of affairs which are considered unfair or unjust. Furthermore, there are some fundamental differences between the two paradigms. Passing-off pertains often to deceptive and underhanded diversion of custom, but at the very least honest yet unjust misrepresentation.²⁴⁶ In contrast, under the Japanese trade mark regime, the Japanese courts are willing to interfere with trade mark title even in the absence of such confusion.

²⁴³ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 27.

²⁴⁴ Trade Marks Act 1994 s 2.1.

²⁴⁵ *ibid* 2.2.

²⁴⁶ *Supra* 2.4

The Tarzan²⁴⁷ case, for example, would likely have failed under passing-off, as it would have been impossible to point to a redirection of revenues and deception in relation to two distinct undertakings operating within the same market. Similarly, if a passing-off case were brought before a Japanese court, the court would be forced to ascertain how famous and well-known the mark of the aggrieved party is and the case would focus on the issue of whether the mark is entitled to protection in the first place, given the familiarity and knowledge of domestic consumers.²⁴⁸

Regulating competition in Japan is not exclusively the domain of the Trademark Act 1959, whereas this is the case with its UK counterpart, the Trade Marks Act 1994. The Unfair Competition Prevention Act 1993 is partially responsible for regulating forms of competition under the Japanese trade mark regime.²⁴⁹ In the context of the Japanese scholarship regarding the UCPA 1993 and the Trademarks Act 1959, competition has a specific connotation: it is legitimate competition in the field of intellectual property, including trade marks. UCPA, therefore, regulates the area of trade mark law which is concerned with behavioural impropriety, which is what Unfair Competition Prevention broadly defines.²⁵⁰

Under UCPA²⁵¹ it is possible to bring a case where the unjust conduct of the domestic partner to a foreign undertaking is concerned. Ostensibly this is a contractual matter, but it has been possible in the Japanese trade mark regime to obtain a judicial remedy where the strict operation of the trade mark regime had resulted in an injustice to the overseas

²⁴⁷ *Tarzan Heisei 23 (gyo-ke) 10399 2012* (n 226).

²⁴⁸ *Infra* 3.5.3

²⁴⁹ Kenneth L Port, 'Trademark Harmonization: Norms, Names & (and) Nonsense' (1998) 2 *Marq. Intell. Prop. L. Rev.* 33.

²⁵⁰ *Infra* 4.13.1 regarding unfair competition law in the UK.

²⁵¹ Unfair Competition Prevention Act 1993 art 3 See *Infra* 4.19.3 regarding history of unfair competition law in Japan.

proprietor of the mark.

Although This is what happened in the *McDonald's* litigation²⁵² where a domestic undertaking sought to register some of McDonald's marks on the domestic market without the approval of McDonald's after negotiations have broken down. The *McDonald's* litigation took place in response to McDonald's attempt in the mid 70s to enter the Japanese market.

The cadre of lawyers on the American side was not aware of the nature of Japanese Trade Mark registration, and so they did not exercise adequate caution in dealing with a local partner Marushin Foods. In contrast with the trade mark regime in America, Japanese trade marks are registration-based, and while there is robust protection for well-known unregistered marks, the standard to which such marks must be well-known or famous is very high, and the marks must have regionwide or national recognition respectively.

In the case, Marushin Foods registered the marks Mac and Burger (MAKKU and BAAGAA) in Japan as a domestic partner, on behalf of McDonald's. Eventually negotiations fell through McDonald's sought a different means of exploiting its IP in Japan. Marushin Foods sought to continue to use the registered marks and, furthermore, a combination of the two: MACBURGER or MAKKUBAAGAA, in addition to a similar, albeit not identical iteration of the golden arches associated with McDonald's.²⁵³

Marushin Foods had valid registrations for MAKKU and BAAGAA, registered in line with

²⁵² 10 *Mutaizaisan Hanreishu* 478 (Tokyo High Court); *McDonald's v Mac Sangyo Han-Ji Issue 1020*; 35 *Minsbu* 1169 (Tokyo District Court).

²⁵³ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 77.

the requirements of the Japanese trade mark registration provisions. However its use of the two marks in conjunction was considered to infringe a well-known mark.²⁵⁴ This case demonstrates that there is protection for unregistered marks. The litigation spanned in excess of 10 years, however, which demonstrates that while there is a remedy and protection for well-known trade marks, direct registration, without intermediaries, is the intended and optimal route in the Japanese trade mark Infrastructure.²⁵⁵

In contrast with what might happen in the UK/EU, however, the mark was never revoked. Because of the operation of Japanese law, the registration by the domestic undertaking was valid and the matter was resolved through UCPA, rather than the Trademark Act 1959. The mark remained valid under the 1959 Act and proprietorship was transferred to McDonald's instead, as the trade mark was legitimately registered.²⁵⁶

3.5.3 Well-known and Famous Marks

In the Tarzan case, the subject of the litigation was the mark TARZAN²⁵⁷ The mark is not morally reprehensible, and a trade mark for it was legitimately obtained. Nevertheless, the IP High Court decided that due to the extensive use of TARZAN abroad, evidencing a special extent or quality of being well-known abroad, the registration of the mark would be normatively inappropriate, on procedural grounds.²⁵⁸

²⁵⁴ *ibid.*

²⁵⁵ *ibid.*

²⁵⁶ *ibid.*

²⁵⁷ Michio Morishima, *Why Has Japan 'Succeeded'?: Western Technology and the Japanese Ethos* (Cambridge University Press 1982).

²⁵⁸ John A. Tessensohn (n 239).

Port highlights this as a possible instance of judicial activism, and this seems quite plausible from an economic perspective, as both the *McDonald's* litigation and *Tarzan* had the effect of providing added protections to overseas investors, during a time when overseas investment came to be highly sought-after ²⁵⁹

In the *Tarzan* case, there was no domestic provision of law which would have precluded the registration of the *Tarzan* mark. The mark was well-known abroad, but not in Japan. The case itself was not decided based on whether the mark was well-known, as the Japanese court would have had to dismiss the case, given the circumstances surrounding the formal validity of the mark. The decision was instead decided based on the moral principle of international truthfulness.²⁶⁰

As a predominantly Romano-Germanic legal system,²⁶¹ this form of normative control can be seen as judicial excess, however it is also arguably a necessary safeguard against abuses of the rigidly registration-based trade mark regime, not the least because unlike with the UK, in Japan there is nothing else but the protection for well-known and famous marks, which excludes the preponderance of trade marks from protection. It is judicially and politically uncontroversial for the Japanese courts to refuse registration of marks which would be 'inequitable' to register.²⁶² This is in line with the principle of 'international truthfulness'.²⁶³

Trade mark law has a history intertwined with and derived from the law of passing-off in the

²⁵⁹Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20)..

²⁶⁰ *Infra* 4.12.7

²⁶¹ Hiroshi Oda, 'The History of Modern Japanese Law' in Hiroshi Oda (ed), *Japanese Law* (Oxford University Press 2009) <<https://doi.org/10.1093/acprof:oso/9780199232185.003.0002>> accessed 5 May 2024.

²⁶² John A. Tessensohn (n 239).

²⁶³ *Infra* 4.12.7

Anglophone legal world, and the linguistic differences of the Japanese language would have made the operation of such a body of law very different and much less feasible. Japanese trade mark protection for unregistered marks recognises two types of marks: *common* or *common knowledge* (broadly analogous with the term well-known) (shuuchi - (周知) and *famous* (chomei - 著名).²⁶⁴

Famous marks are afforded protection under Art.2(1)(i) and well-known marks under Art.2(1)(ii) of UCPA.²⁶⁵ These are procedural protections, such as passing-off, albeit also very different. For a mark to be famous, per Art.2(1)(ii), it needs what is, essentially, national fame – it must be famous nationwide. In contrast, Art.(2)(1)(i) only requires regional fame.²⁶⁶ Art.(2)(1)(i), unlike Art.2(1)(ii) also requires confusion. While there are similarities between Art.2(1)(i) and passing-off, this protection is only applicable in the geographic locality where the appellation is well-known and offers no nationwide protection.²⁶⁷ Port likens this protection under the UCPA to the provisions of s.3 of the 1994 Act.²⁶⁸ These protections, despite the conceptual overlap, are distinct from the similar protections afforded under Arts.4(x) and 4(ix) of the Trademark Act 1959 in the context of refusal to register.²⁶⁹

The threshold for affording protection to such marks is recognition-based (Japanese law does not permit of a jury or survey evidence in trade mark proceedings under most

²⁶⁴ Kenneth L Port, 'Trademark Dilution in Japan' (2005) 4 Northwestern Journal of Technology and Intellectual Property 228, 233.

²⁶⁵ *ibid.*

²⁶⁶ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 164.

²⁶⁷ Onishi (n 34) 188.

²⁶⁸ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 180.

²⁶⁹ *Infra* 4.13 for a more detailed discussion of Arts.4(x) and 4(ix) of the Trademark Act 1959.

circumstances. When survey evidence is admitted, it is subject to considerable scrutiny.²⁷⁰⁾

The level of recognition required for a mark to be recognised as famous is very high, and it arguably has to be for the reason that the language is so rich with linguistic and semantic uncertainty due to inescapable similarities that a lower threshold might or might be seen as being liable to create a practical impediment to the functioning of the market because semantically a very large number of Japanese marks have the potential to be confused with other marks in the expression stage described above and before linguistic corroboration occurs in the interpretation stage.²⁷¹

The highlighted linguistic difference could be seen as purely that – a mere linguistic difference, but it produces qualitative and quantitative difference when comparing Japanese and UK law. Japan's WIPO memberships and signatory status to TRIPS makes it, very similar in terms of intellectual property and trade mark law as any other compliant signatory state, due to the imposition of the minimum standard of protection by TRIPS.²⁷²

However it is notable that law is a type of applied semantics in all of its various forms, be it criminal law, the law of antiquities or sports law, but trade mark law is semantics itself in numerous ways,²⁷³ even if there is more to trade marks than semantics, especially in the realm of non-lexicological trade marks. In numerous trade mark cases the very meaning, connotations, disambiguation and similarity of words is extensively discussed by some of the

²⁷⁰ *Infra* 4.10 regarding the use of survey evidence.

²⁷¹ Michel Paradis, Hiroko Hagiwara and Nancy Hildebrandt, *Neurolinguistic Aspects of the Japanese Writing System* (Elsevier Science 1985).

²⁷² Irene Calboli and Christine Haight Farley, 'The Trademark Provisions in the TRIPS Agreement' [2016] *Intellectual Property and International Trade: TRIPS Agreement*.

²⁷³ Piller (n 82).

foremost judicial experts, the judges, in the field, e.g. the relative grounds and the relevant case law.²⁷⁴

Contemporary trade mark law is highly reified.²⁷⁵ Although it is possible to argue that intellectual property rights are rights ‘*in personam, contra omnes*’, and this argument is made by some theorists, modern trade marks are seen as property analogous with conventional forms of property.²⁷⁶

The law of passing-off is a field of rights *in personam*, however its successor, the trade mark is increasingly cast as a thing, reified and seen as *rem*.²⁷⁷ This is seen even more starkly in Japanese law, where registration, due to the high threshold required for well-known and famous marks to merit protection, is even more important than in the UK, due to the absence of a system such as passing-off, which is available to protect marks from free-rider deprecations irrespective of how well-known they are.

Japan is a Romano-Germanic legal system (it is a Germanic legal system, for a host of reasons. Calling it a Romano-Germanic legal system is like calling the US an ‘Anglo-Norman’ legal system. It is not untrue, but the Norman element is relatively smaller and more subdued than the English element) and rights *in rem* play a crucial part in this system because of the character of the legal system and its tendency to reify obligations, including negative obligations such as trade marks, where all parties which are not the proprietor, or designated

²⁷⁴ *Infra* 4.10.3

²⁷⁵ Trademarks Act 1959.

²⁷⁶ Henry E Smith, ‘Intellectual Property as Property: Delineating Entitlements in Information’ (2007) 116 *The Yale Law Journal* 1742.

²⁷⁷ Giorgio Bernini, ‘Protection of Designs: United States and French Law Notes and Comments’ (1952) 1 *American Journal of Comparative Law* 133.

by the proprietor, or subject to some other limited legal exception must refrain from using the proprietor's trade mark.

Within the Japanese domestic trade mark Infrastructure, an unregistered mark is afforded very limited protection. The logic of the process does not proceed on the basis that there should be protection for commercial entities which do not register trade marks. It proceeds on the basis that trade marks are easy to register, and the outcome of neglecting registration is the lack of a trade mark right.

The UK retains the law of passing-off as an alternative system to provide protection where trade mark registration was not possible but also where it was not an avenue which was pursued at all. In this way, passing-off is an avenue of protection where a business – generally a small business – is not contemplating trade mark registration. The Japanese protection for well-known marks under Art.2(1)(i) of the 1993 Act is not so reliable, on account of its regional reputation requirement.

3.5.4 Protection under Art.4(x) of the Trademark Act 1959

The Trademark Act 1959 provides under Art.4(x) that a trade mark is not to be registered if it:

“is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;”

This is a complementary form of protection to the protection for well-known and famous

marks under UCPA Art.2(1)(i) and (ii), albeit it is a distinct and separate provision as well.

The case law offers no of instances where small or medium local undertakings successfully protect their unregistered marks because the marks have to be exceedingly well-known, the test for which was demonstrated in the *DCC Coffee* case.²⁷⁸ Onishi states that “In this case, ‘syuchi-syohyo’ is required to be well known by nearly 50 per cent of the relevant public in three different prefectures...”²⁷⁹ This only acts to strengthen the position and value of registered trade marks, because a registration is indispensable to fend off deprecations by predatory commercial entities.²⁸⁰

The DCC Coffee case involved the unregistered use of a subsequently registered mark. The DCC Coffee mark was used by the defendant for 23 years prior to the litigation. After over two decades of unregistered use, the pursuer, an unrelated entity, had registered the mark and the legal challenge was brought to prevent the original user of the mark from using it.²⁸¹

The court did not recognise that the mark was well-known or widely recognised in the sense of the statutory system, despite a perceived 30% recognition rate on part of customers. However, the defendant was allowed to continue to use the mark. The basis of the court’s decision was that while the registration was valid, and it was not expunged, it would amount to an abuse of the trade mark right to prevent the original, unregistered user from applying the mark to its goods after 23 years of uncontested use. The practical outcome is that the

²⁷⁸ *DCC Coffee* [1982] 499 Hanrei Times 211 (Hiroshima District Court).

²⁷⁹ Onishi (n 34) 161.

²⁸⁰ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 71, 111.

²⁸¹ *ibid.*

original user enjoyed only the right to use the mark, with none of the protections typical of trade mark proprietorship, such as the ability to bring legal action for infringement – a right which the trade mark troll in the case had now enjoyed.²⁸²

This decision demonstrates that although the Japanese courts are willing to protect the users of unregistered marks, they are reluctant to do so in a way which interferes with the operation of the registration based system. In the DCC Coffee case, while the original user was recognised as having a right to use the mark, this recognition does not grant any type of property right. The right to the trade mark is held almost completely by the registrant, and the unregistered user would have no means of preventing freeriding and the exploitative use of the mark, absent a registered trade mark. It is firmly the case that despite the 23 years of continuous use by the original undertaking, the registrant has an almost unfettered trade mark right.²⁸³

As observed in the DCC Coffee case, the permitted use of the trade mark by the defendant is not a trade mark right. In spite of 23 years of use and associated goodwill, the court determined that the trade mark right would be vested in the pursuer. The *Ginrei Scandal*²⁸⁴ case demonstrates the implication of discontinuing to use a trade mark under similar conditions, without access to the conventional forms of proprietorship which gives access to title to a trade mark right.²⁸⁵

²⁸² *ibid.*

²⁸³ *ibid.*

²⁸⁴ *Ginrei Sandal* [1971] 3 Mutai Zaisan Hanreishuu 140 (Shizuoka District Court).

²⁸⁵ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 71, 111.

In the *Ginrei Sandal* case, an undertaking was making unregistered use of the pertinent mark, and the court recognised that the mark was regionally so well-known as to be afforded legal protection for well-known marks. Despite being well-known, the beneficiary of the unregistered mark had stopped using the mark, and the court held that to do so would inevitably result in losing the rights afforded by the well-known mark exception.²⁸⁶

The position of the beneficiary of an unregistered trade mark right is quite weak, because the continuity of the exception to the rights associated with registration is contingent on the continuity of trade mark use. Because the beneficiary of the unregistered mark had stopped using the mark, the right to do so was irreversibly lost, despite the mark being able to satisfy the stringent requirements of the well-known exception. This case leaves no doubt that there is scarcely a salient reason not to register a trade mark where registration is possible.²⁸⁷

The *Computeworld* case is neither an exception nor in strict conformity with the circumstances of the cases decided based on the principle articulated in *DCC Coffee*. The *Computeworld* case involved a publication – Computerworld – which was decidedly not well-known within the wider context of the Japanese market, as it was never available on the Japanese market. However, within the context of the Japanese computing industry, the publication was universally recognised. The Tokyo High Court considered that because the target market of the magazine was precisely the computer professionals who were all well-acquainted with the product and therefore the mark, such level of recognition was sufficient to establish the mark as well-known.²⁸⁸

²⁸⁶ *ibid* 112, 143.

²⁸⁷ *ibid*.

²⁸⁸ *ibid* 112, 138.

3.5.5 Abuse of Rights

The *Virusbuster*²⁸⁹ case involved the registration of a mark which was already extensively used by a different undertaking. Instead of interfering with the operation of the Japanese trade mark registration system, the Tokyo District Court decided to rely on the principle of abuse of rights. The judgment precluded the registrant from asserting the trade mark right against the prior user. The court considered that it would be an abuse of a right derived from legitimate trade mark title to prevent the earlier undertaking from continuing to use the mark. Such a remedy is rare and small in scale, as the trade mark right had normal exclusionary application to all other undertakings.²⁹⁰

The *Budweiser*²⁹¹ case is similar, in principle, to *Virusbuster*. Anheuser-Busch asserted its trade mark right against Budweiser-Budvar, a Czech company with a somewhat different trade mark. In contrast with Anheuser's registration, the Czech product was marketed as Budweiser-Budvar, and the court held that because there is no likelihood of confusion between these two products, and Budweiser-Budvar is a prior user, and so to assert the right against Budweiser-Budvar would have constituted an abuse of rights.²⁹²

3.5.6 Court System

²⁸⁹ *Virusbuster* 1691 Hanrei Jibo 136.

²⁹⁰ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 71.

²⁹¹ *Anheuser-Busch v Budweiser Budvar* 1821 Hanrei Jibo 136.

²⁹² Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 71.

The hierarchy of the courts which hear IP cases begins with the numerous district courts, and from the district courts appeal lies to the Tokyo High court. A special feature of the Tokyo High Court is that since 1948, as per the Patent Act 1948, it includes a specialist 'Intellectual Property Division,' which has in 2004 become the Intellectual Property High Court (知的財産高等裁判所 - Chiteki Zaisan Koutou Saibanshou).²⁹³ The IPHC has been established in 2005 with a similar purpose as the UK equivalent, the Intellectual Property Enterprise Court, to reduce costs and streamline the litigation process. The IPHC hears appeals from the district courts, as well as appeals of the decisions of the Japanese Patent Office.

In contrast, Japan does not have a court comparable to the IPEC, but it has a specialist IP court in the form of the Intellectual Property High Court. Although Japan does not have a specialist small claims IP court, the Tokyo and the Osaka District Courts have specialist IP divisions which deal with IP litigation at the first instance, including smaller cases.²⁹⁴

The first hearing will usually take place within two months of filing, which will usually be followed by brief monthly hearings as the case progresses. Cases will take, on average, 1.5 years to conclude, which is a much quicker resolution than with most UK High Court IP cases, which often take up to 3 years to reach a resolution.²⁹⁵

²⁹³ 'History | Intellectual Property High Court' <<https://www.ip.courts.go.jp/eng/aboutus/history/index.html>> accessed 5 May 2024.

²⁹⁴ Hitomi Iwase, Yoko Kasai, and Keitaro Kubo, 'Intellectual Property Rights in Japan: Overview' (*Practical Law*) <[http://uk.practicallaw.thomsonreuters.com/5-501-5659?comp=pluk&transitionType=Default&contextData=\(sc.Default\)&firstPage=true&OWSessionId=cf45206142da4e daa2d0ed246c62b7ed&skipAnonymous=true](http://uk.practicallaw.thomsonreuters.com/5-501-5659?comp=pluk&transitionType=Default&contextData=(sc.Default)&firstPage=true&OWSessionId=cf45206142da4e daa2d0ed246c62b7ed&skipAnonymous=true)> accessed 2 April 2021.

²⁹⁵ Anderson Mōri, Tomotsune-Masayuki Yamanouchi and Satoko Yokogawa, 'Trademark Enforcement in Japan' (*Lexology*, 16 October 2019) <<https://www.lexology.com/library/detail.aspx?g=a84e9f9c-7b86-4d54-b8cf-6242b6a31572>> accessed 2 April 2021.

Japanese trade mark litigation is, likewise, not exceedingly costly. Despite the fact that there is no specialist court which offers fast track/small claims procedures for cases of a lesser economic magnitude, the court fees remain quite reasonable at a rate of 0.3% on trial at the District Courts and 0.5% on appeal to the IP High Court. There is no formalised system for determining the maximum chargeable or recoverable counsel fees, however, so the fees are liable to be determined by the market value of the services at the time of trial.²⁹⁶

The cost of trade mark registration is much lower in Japan than in the UK. Registration costs ¥3,400, with an extra ¥8,600 for each additional class. This amounts to approximately £22 and £56 respectively, so the Japanese registration system is cheaper to approximately 25 additional classes, at which point the UK registration system becomes less costly.²⁹⁷ This is excellent for smaller businesses, which operate in narrower markets, and it is not costly at all to build and maintain a portfolio of narrowly classified trade marks, such as, for instance, for a small scale web store or other online service.

Comparatively, the Japanese IP High Court is very prompt in dealing with cases. At first instance, the average time period to reach a resolution has been in the range of 7.2 to 9.3 months at first instance, and 7.0 to 8.5 on appeal.²⁹⁸

²⁹⁶ibid..

²⁹⁷ ibid.

²⁹⁸ 統計 (Statistics - Intellectual Property High Court) | 知的財産高等裁判所 <https://www.ip.courts.go.jp/eng/vc-files/eng/2021/10_toukei.pdf> accessed 2 April 2021.

3.6 *The Trade Mark Profession in Japan*

The Japanese equivalent of a Trade Mark Attorney is a Benrishi (弁理士), which is an umbrella term for intellectual property law practitioners. The 日本弁理士会 or Nihon Benrishi Kai is translated as the Japanese Patent Attorney Association, but the organisation represents practitioners practicing in the fields of copyright, patents, trade marks, trade secret and unfair competition law.²⁹⁹

²⁹⁹ Szarkiszjan and Denoncourt (n 35).

3.7 *Conclusion*

As with the preceding Chapter 2, the purpose of this chapter is to provide an exposition of substantive law. This chapter had discussed the same subject-matter as Chapter 2, albeit in the context of Japan and with reference to Japanese law. There is a discussion of the trade mark registration regime of Japan, complete with discussion of the relevant grounds of refusal, chiefly on public policy and morality grounds.

There is, furthermore, a discussion of the systems for the protection of unregistered marks. Unregistered marks are protected either as well-known or famous marks, requiring regional and nationwide fame/reputation respectively.³⁰⁰ As discussed, this form of protection has some similarities with the UK tort of passing-off, but while passing-off protects goodwill,³⁰¹ these causes of action, provided for under the UCPA, rather than the 1959 Act, protect fame/reputation.³⁰² They operate differently, target different concepts or entities to protect and, functionally, they are not identical. However, there is an overlap between them, and it is conceivable for a particular mark to have both regional/nationwide fame and goodwill, thus making it eligible for protection by passing-off or the protection for well-known or famous marks.³⁰³ However, this is not necessarily the case.

This chapter has also highlighted that the Trademark Act 1959, as with the UK Trade

³⁰⁰ *Supra* 3.5.3

³⁰¹ *Supra* 2.4

³⁰² *Supra* 3.5.3

³⁰³ *Ibid*

Marks Act 1938,³⁰⁴ precedes Japan's WIPO membership – in fact both the 1938 and the 1959 Acts precede the founding of WIPO in 1967. Accordingly, this further supports one of the main contentions in the central thesis that the level of convergence between the UK and Japan trade mark regimes cannot be solely ascribed to the harmonising effects of WIPO and TRIPS. Indeed, both Japan and the UK have had reified, registration-based trade mark systems before WIPO and TRIPS.³⁰⁵

Furthermore, this chapter discusses the uniquely Japanese principle of international truthfulness.³⁰⁶ This principle is not exhaustively discussed here, and there is further discussion in the succeeding chapters, as it is of particular importance due to being unique to the legal system of Japan.

As with the preceding chapter, there is some discussion of the court system, but also of interesting practices such as the transfer of title in cases of impropriety, such as with relation to the causes of action under UCPA 1993 and its precursor the UCPA 1934. While the concept of unfair competition law is interesting and it is discussed in the Japanese context, a comparison with English unfair competition law is deferred until Chapter 4,³⁰⁷ because of the complexity of the English counterpart, which is constituted by a miscellany of different laws, rather than by a unitary cause of action. In answer to the question of 1.2.1, reiterated in the conclusions of Chapters 2 and 3, there is a significant level of convergence between the UK and Japanese trade mark regimes. The convergence is not complete, but it is significant, even taking into

³⁰⁴ *Supra* 2.5

³⁰⁵ *Infra* 4.13.3, *Supra* 2.5

³⁰⁶ *Supra* 3.5.1

³⁰⁷ *Infra* 4.13.1

account the uniquely Japanese international truthfulness, the tendency of expropriation and transfer of title in impropriety cases or the protections afforded to unregistered marks.³⁰⁸

While there is significant divergence in terms of the court system and the nature of the legal system, such as with relation to legal precedent, these are to be expected, and they do not impinge the general level of convergence in terms of substantive laws.

³⁰⁸ *Supra* 3.5.1, 3.5.2

4 Comparative & Jurisprudential Analysis

4.1 *Introduction*

The previous chapters have established the substantive background of the thesis. They have outlined the various features of the trade mark registration systems, and there are some conclusions which can be readily drawn from just the substantive law. However, in terms of the informational pipeline discussed at the outset of this thesis, the exposition of the substantive law also serves to enable subsequent discussions and subsequent conclusions based thereon.

Because of the stark differences which exist between the two legal systems, in terms of geography, culture and language, it is necessary to provide comparative analysis which looks beyond the obvious ostensible trappings of the two legal systems. The objective in this chapter is to provide that comparative analysis. This work adopts the functional approach to comparative analysis, with an emphasis on the functions of legal phenomena, structures and institutions.

This chapter is, by a significant margin, the largest chapter of the thesis. It provides jurisprudential as well as comparative analysis. As the designated comparative chapter, it begins with a discussion of comparative law methodology: functionalism. Thereafter, the chapter introduces the Dworkinian framework to help in defining the scope the analysis. The Dworkinian model is chosen because of Dworkin's conception of law as integrity, as well as

his model or ecosystem of rules and principles for describing, primarily, adjudication.³⁰⁹

As this work is focussed on both legislation and judicial sources, the choice of theoretical model is accordingly the Dworkinian framework. There is some explanation as to why this choice was made, as well as some discussion of the other jurisprudential school which could have been used: legal realism.³¹⁰

Subsequently, the chapter discusses functionalism and functional equivalency in to explain how two features, paradigms or parts of different legal systems can be analysed with a view to ascertaining whether, in functional terms, they serve the same or a similar functional purpose.³¹¹

There is, furthermore, a discussion of prevalent issues and problems in the context of comparative analysis, especially with relation to the present work, such as the general paucity of theoretical works on the subject, as well as linguistic and phenomenological differences arising from the linguistic differences between the respective legal systems.³¹²

There is also discussion of the proprietary nature of trade marks, their original acquisition and the role of reification in endowing those trade marks, despite being structurally intellectual monopolies, with the characteristics of conventional property, e.g. alienation, security in lending, etc.³¹³

³⁰⁹ *Infra* 4.3

³¹⁰ *Infra* 4.

³¹¹ *Infra* 4.5, 4.6

³¹² *Infra* 4.7

³¹³ *Infra* 4.9, 4.10

The chapter then proceeds to a discussion of public interest, policy and morality. This is an important part of both trade mark regimes, and while not all cases allude to or expressly describe the precise public policy and morality dimension, it is nevertheless important to understand the functional of the morality and public policy-based absolute grounds.³¹⁴ This is made all the more important by the fact that often there is no clear delineation, in a particular case, as to whether it is decided based on public policy or morality, and if it is due to a combination of both, the precise proportions.

Subsequently, the chapter will conclude with a discussion of the protection of unregistered marks and issues of trade mark registration, in a comparative context, which will build on the respective discussions of the preceding substantive chapters³¹⁵

As articulated in 1.2.2, the underlying question of this chapter is as follows:

The central question in this chapter, which it is intended to answer, is whether there is broad convergence or divergence between the Japanese and UK trade mark regimes across the identified areas, and what is the extent and nature of such convergence and divergence?

³¹⁴ *Infra* 4.12

³¹⁵ *Infra* 4.13

4.2 *Comparative Law Methodology*

The methodology is a bespoke arrangement of borrowed concepts, hearkening back to the seminal work of Konrad Zweigert and Hein Kötz.³¹⁶ The analysis of several legal paradigms forms the backbone of this work. A paradigm, in this context, means an abstract legal idea or system which can be extracted or extrapolated from the workings and practice of a non-ideal (that is, concrete rather than hypothetical or imaginary), existing legal feature or sub-system within a jurisdiction.³¹⁷

Legal precedent, as understood in Common Law jurisdictions is, accordingly, a legal paradigm, which may be implemented differently from system to system. For example, there are differences in the way the UK and US implement common law, despite sharing an overarching paradigm.³¹⁸ Despite the differences in implementation, there is a minimal, rudimentary and necessary description with a set of indispensable properties in the absence of which the paradigm is no longer able to describe the supervening commonality shared by every instance which implements it. E.g. passing-off would be an instance of a *goodwill protection system*, as it mandatorily protects goodwill. However, the contemporary registered trade mark only facultatively protects goodwill. It can protect goodwill, if such accrues to the mark, but it is not a requirement of trade mark infringement, which operates irrespective of whether there is goodwill.

In summary, a paradigm which cannot accurately describe every one of its instances is not

³¹⁶ *Supra* 1.4.1

³¹⁷ *Ibid*

³¹⁸ Richard A Posner, *Law and Legal Theory in England and America* (Oxford University Press 1997).

reliably a paradigm. The refusal to register generic trade marks in order to protect common industrial vocabulary or undue monopolistic deprecations is a paradigm in as much as there is a systematic effort within a trade mark regime to implement a related, broader normative policy in protection of this paradigm – in protection of the free use of common vocabulary, including in branding. One might term this paradigm an *expressive diversity protection system*.

For example, a judicial system where previous cases have no influence over future judicial outcomes cannot be considered the paradigm of Common Law legal precedent, because it does not implement *stare decisis*, the shared system of binding judicial decisions implemented in every instance of the paradigm of *binding judicial precedent*.³¹⁹

The binding nature of judicial decisions is, therefore, a necessary property of the paradigm of *binding legal precedent*. However, it is not necessary that the system should be administered and furnished in the English language. The administrative language could be Japanese or yet another language, which means that language is an accidental property, and not a requisite parameter of the paradigm.³²⁰

³¹⁹ Teresa Robertson and Philip Atkins, 'Essential Vs. Accidental Properties' in Edward N Zalta (ed), *Stanford Encyclopedia of Philosophy* (2013).

³²⁰ Michael Gorman, 'The Essential and the Accidental' (2005) 18 Ratio 276, 276–289.

4.3 *A Framework to Reason About Laws and Legal Systems*

It is necessary to have a structured framework to allow one to reason about legal systems. Using such a framework, it is possible to establish a taxonomy of a legal system. In this taxonomy, one might define taxa from the most atomic elements, such as individual legal rules and legal principles, to the most complex such as an entire legal system. Because of the intrinsic flexibility of such a taxonomic schema, the following is an explanation as to why, for the purposes of this comparison, the taxonomic structure naturally arising from a Dworkinian framework is chosen to provide structure for the functional analysis, to the exclusion of legal realism.

4.3.1 **Normative Considerations in Devising a Taxonomy**

The taxonomic classification of a legal system is intrinsically flexible.³²¹ Perhaps there are strong prevailing reasons to consider a positivist or even a formalistic approach where there are normative reasons to do so. For example, a trial for a serious crime is, for normative reasons, not the appropriate place to try to redefine the taxa law consists of, lest it undermine the values engendered in that process of criminal law. In contrast, in the context of this thesis there are no such normative reasons to consider that a particular taxonomic configuration is morally desirable. A court is tasked with ascertaining what the law is with reference to a strict set of rules and means of testing whether something is law, so as to allow the legal system to function - an academic writing is not subject to the same restrictions.

³²¹ Esin Orucu, 'Methodological Aspects of Comparative Law Keynote Addresses IACL Congress' (2006) 8 *European Journal of Law Reform* 29, 30.

Accordingly, this thesis does not adhere to a particular normative taxonomic system. To demonstrate this idea, one might envision a hypothetical jurisdiction (NewSSR or New Soviet Socialist Republics) where bribery is formally unlawful, albeit widely accepted approach to litigation. The litigants bid their bribes through discreet, unofficial channels, and the higher bidder prevails in the litigation. This, in principle, is admissible in this thesis as a taxon, as the practice is so prevalent that the jurisdiction's system of adjudication cannot satisfactorily be described without its inclusion, and the thesis is not concerned with the moral rightness of such classification, albeit it is still concerned with the internal structure and logic of analysis.

While this framework or model is more in the domain of legal pluralism and informal legal systems,³²² it highlights the difficulty of defining and delimiting the sources of law. The rules, norms and customs of a criminal organisation cannot be understood to be a part of the law in a positivist or formalist framework, but under some circumstances, their omission from the discussion of law will result in a partial and flawed account of the underlying legal processes. This phenomenon is not solely in the criminal domain, and there are examples such as the Albanian code of honour, the *Kanun*,³²³ which provides general guidance across various aspects of life, including with relation to dispute resolution.

While legal pluralism and informal legal systems are interesting in their own right, it serves only to demonstrate that in some circumstances the positive, formal law is insufficient to

³²² Tilmann J Röder, 'Informal Justice Systems: Challenges and Perspectives' (2012) 58 *Innovations in Rule of Law* 58, 58.

³²³ Jan Bazyl Klakla, 'The Rebirth of Customary Law in a Time of Transition. The Case of Albania' [2017] *Central and Eastern European socio-political and legal transition revisited*. Peter Lang, Frankfurt am Main 75, 79.

account for the transpirations and transactions within society. The scope of this thesis is not so broad as to include informal legal systems, and focus will, instead, be on the Dworkinian understanding of what the law is.

4.3.2 Dworkinian and legal realist frameworks

Dworkin's interpretivism stands in contrast with the positivist understanding of what law is.³²⁴ Positivism operated as collection of frameworks with prescriptive, proscriptive and permissive features, focused generally on the delegation of legitimate authority, such as Hart's Rule of Recognition.³²⁵

In contrast with this, Dworkin incorporates principles to explain and provide an account of what positivists, he asserts, are unable to satisfactorily describe in their positivist frameworks.³²⁶

4.3.3 Realities of the legal systems of Japan and the United Kingdom

There is a considerable ostensible difference between Japan and the UK in the way these jurisdictions implement precedent,³²⁷ albeit the functional reality shows that under the surface there is considerable convergence, rather than divergence.

³²⁴ Jordan L Perkins, 'Hartian Positivism and Dworkinian Interpretivism: Two Approaches to the Relationship between Judicial Review and Democracy' (2022) 100 University of Detroit Mercy Law Review 353, 354.

³²⁵ Douglas E Edlin, 'The Sovereignty of Positivism' (2021) 12 Jurisprudence 347, 355.

³²⁶ Ronald Dworkin, *Taking Rights Seriously* (Bloomsbury Academic 2013) 32.

³²⁷ Hiroshi Itoh, 'The Role of Precedent at Japan's Supreme Court Decision Making on the Japanese Supreme Court: The Supreme Court's Decision-Making Practices' (2010) 88 Washington University Law Review 1631.

As will be discussed, Japan implements a system of precedent which is functionally the same as the precedent implemented in the UK. There are differences between the two, but functionally both jurisdictions implement a system of binding judicial decisions in conjunction with a hierarchy of courts, whether formal or informal, to establish the primacy of certain courts over others.³²⁸

Both jurisdictions have standardised, binding rules which describe the ambit of the respective judiciaries. By describing positively what falls within the ambit, automatically the rules also describe what falls outwith them. A formalist or positivist framework cannot satisfactorily describe the judicial and legislative behaviour which falls outwith the ambit of what is formally permitted and prescribed. This criticism is pervasive in the context of not only the Dworkinian model, but also amongst legal realists.³²⁹

Positivism and formalism are not equipped to satisfactorily discuss such phenomena. The Dworkinian model, in contrast, makes explicit provision for legitimate legal principles which exist in the same ecosystem of adjudication as legal rules.³³⁰ For example, the principle of *International Truthfulness* can be readily explained in a Dworkinian model through Dworkin's account of rules and principles and the mechanics of their interactions.³³¹

³²⁸ *ibid.*

³²⁹ William E Forbath, 'Taking Lefts Seriously' (1983) 92 *The Yale Law Journal* 1041, 1043.

³³⁰ Dworkin (n 326) 38.

³³¹ *ibid.* 39.

4.3.4 Legal realism in the context of the Japanese trade mark regime

The Dworkinian model and legal realism are both suitable for dealing with factors of adjudication which are extrinsic to the positive law, such as legal principles. There is no room in this thesis to discuss the entire array of legal realist thought and it is necessary to generalise legal realist positions to an extent.

Legal realism focuses on adjudication, looking to judicial activity as a way to ascertain or comprehend what the law is. For example, Karl Llewellyn's seminal book, *The Bramble Bush*,³³² is mostly in the context of adjudication, Oliver Wendell Holmes advocates for an empirical, predictive rather than deductive approach,³³³ and legal realism's primary criticism of formalism is that it does not account for the full range of factors which influence the decisions of judges.³³⁴ While this empirical understanding is different from the Dworkinian position, a principle like *International Truthfulness* can be accounted for in legal realism. The Dworkinian system is principally concerned with furnishing a model of adjudication which both describes adjudication and provides a prescriptive system for adjudication.³³⁵

In contrast, the legal realist position is focused on the empirical analysis of what the judges decide and what motivates them to so decide. Curiously, Port, in his seminal work *Trademark and Unfair Competition Law and Policy in Japan*,³³⁶ adopts an implicitly realist position, stating that "This work is based almost exclusively on the Japanese judge's expression of the

³³² KN Llewellyn, *The Bramble Bush: The Classic Lectures to Law and Law Schools* (Oxford University Press 2008).

³³³ Catharine Pierce Wells, 'Holmes on Legal Method: The Predictive Theory of Law as an Instance of Scientific Method' (1993) 18 329, 329.

³³⁴ Forbath (n 329) 1043.

³³⁵ Dworkin (n 326) 214.

³³⁶ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20).

trademark and unfair competition rights as viewed from the judiciary."³³⁷

This approach defines the work in the sense that Port is not concerned with the normative or moral aspect of International Truthfulness or whether it strictly adheres to a strict system of adjudication.³³⁸ Throughout the work Port remains consistent in this approach, often explaining judicial decisions and other phenomena with reference to a causative factor.

While Port's work has a comparative element, for example where he provides a brief comparison of the use-based nature of the US trade mark regime with its registration-based Japanese counterpart. However, it is not an explicit or implicit comparison of the legal systems of Japan and the United States or even a comparison of the entire trade mark regimes. However, he writes in the language of realism, which, as a jurisprudential school, emerged in the context of and to describe adjudication in the US. Accordingly, the work looks at the Japanese legal system often through the lenses of a different legal system, where adjudication is at the forefront of legal practice and discourse.³³⁹

4.3.5 Reasons for the choosing the Dworkinian model rather than legal realism.

4.3.6 Issues arising from the the scope of analysis

³³⁷ *ibid* 4.

³³⁸ *ibid* 111.

³³⁹ *ibid* 4.

As evidenced in Port's seminal work, *Trademark and Unfair Competition Law and Policy in Japan*, an implicitly legal realist approach is very suited to explain not only judicial behaviour in the US but conceivably anywhere else. Legal realism operates by reducing abstractions to their constituent parts, and one can undertake to explain the abstractions of law, such as principles and the decisions based thereon, by reducing them to their constituent parts - this is, after all, how prediction of judicial decisions is undertaken.³⁴⁰

The early trade mark expropriation cases provide a good example. Cases like *McDonald's*³⁴¹ were decided at the time of market liberalisation, when Japan was looking to attract foreign investment.³⁴² The freeriding of domestic undertakings would have had a deterrent effect on foreign investment,³⁴³ and this factor can be relied on, in a realist framework, to provide a plausible explanation - the court's decision was congruous with public policy and the national interest.

However, while it can be useful to carry out reduction to explain the underlying causal factors influencing judicial behaviour, it also removes a useful abstraction layer: legal principles. The empirical approach of legal realism excels at describing law from a sociological perspective,³⁴⁴ but this description is of a microscopic scope. While this work incorporates considerations which are microscopic, such as observations about Japanese society, the Japanese language and their underlying characteristics, the entirety of this thesis is not dedicated to such.

³⁴⁰ Neil Duxbury, 'Law and Prediction in Realist Jurisprudence' (2001) 87 ARSP: Archiv für Rechts- und Sozialphilosophie / Archives for Philosophy of Law and Social Philosophy 402, 408.

³⁴¹ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252).

³⁴² Masahiro Takeda and Philip Turner, 'The Liberalisation of Japan's Financial Markets: Some Major Themes'.

³⁴³ *ibid* 67.

³⁴⁴ Mark C Suchman and Elizabeth Mertz, 'Toward a New Legal Empiricism: Empirical Legal Studies and New Legal Realism' (2010) 6 Annual Review of Law and Social Science 555.

As noted, legal principles are an abstraction layer which describe social phenomena, and they are a useful tool for mesoscopic and macroscopic discussion when a microscopic, reductionist approach is not suitable or where reduction has already taken place, and the granular mechanics underneath the abstraction layer have been duly explained. It is useful to know about market liberalisation, because it can help explain the trade mark expropriation cases since the 1980s, but it would be counter-productive to constantly seek microscopic causes to explain every decision, not the least because not every judicial decision can readily be ascribed to external factors.

Even where it is reasonable to postulate that external factors might be at play, it is not practicable to continuously and persistently pursue external factors. External factors can be helpful in establishing causal relationships, but the complexity of adjudication does not always lend itself to simple explanation through such factors. External factors often co-occur with intrinsic elements of law or other external factors and, in many instances, it is neither practicable, helpful, nor the aim of this work to analyse these in detail - such analysis is best reserved for works which operate on a microscopic scale and do so as a matter of their stated objective.

To demonstrate this in practice, one can look at the expropriation or transfer of trade mark title in line with *International Truthfulness* and in accordance with the Unfair Competition Prevention Act 1993.

There have been cases which were decided at the time of market liberalisation, there are also

cases which were decided after the period of market liberalisation but before the enactment of the 1993 Act,³⁴⁵ and there are cases which were decided in line with the 1993 Act. It is plausible to argue that public interest and market liberalisation played a role in the early cases, such as *McDonald's*,³⁴⁶ but this does not help explain the incorporation of this or an analogous principle in the 1993 Act, nor the cases which were decided on the basis of the 1993 Act. It is not practicable and, in general, difficult to ascertain to what extent these cases were decided on the basis of cited external factors.

It is also difficult to reconcile this with decisions such as *Fintan*³⁴⁷ which was decided explicitly with a view to protect the national dignity of Finnish people and Finland, and in the absence of significant monetary incentives.

4.3.7 Issues arising from the difficulty of comparison

The comparison of the two jurisdictions can become unduly granular if opting for a legal realist approach. Market liberalisation and the national objective to attract foreign investment may have been the judicial objectives in cases like *McDonald's*. However, this piece of information is difficult to compare with other jurisdictions. One can make very general inferences based thereon, e.g. 'Japanese judges sometimes prioritise public policy over law.' However, the level of generality of such inferences is difficult, in a system of functional analysis, to compare with another jurisdiction.

³⁴⁵ *Infra* 4.13.3 regarding a discussion of the Unfair Competition Prevention Act 1934, precursor of the 1993 Act.

³⁴⁶ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252).

³⁴⁷ *T2018-87581 FINTAN (フィンタン)* (n 225).

The effects of economic policy on trade mark law have no clear analogue in the UK. Certainly, economic policy may well have an effect on UK trade mark law, but that is the domain of comparative economics rather than comparative law. Accordingly, legal principles remain as useful abstractions to escape the necessity of that granular discussion about a myriad factors which may influence judicial outcomes.

However, the drawback of the principles is that they abstract away the underlying causative factors. The objectives of this work are more readily served by that abstraction layer, rather than an unnecessary volume of granular information. There is significant convenience in being able to simply say that "This is a principle, one of the building blocks of a legal system." This is the reason for adopting a Dworkinian rather than a legal realist framework for the purposes of this thesis.

4.3.8 Comparison through Dworkinian Law as Integrity

Dworkin's interpretivism is inherently normative. Furthermore, the Dworkinian system arose in the context of a common law jurisdiction, and it is tailored to prescribe a code of judicial conduct which is most easily accommodated in the context of the common law. It is not to say that civil law countries are devoid of legal theory and legal principles, quite the contrary.

The issue is, however, that while German lawyers might be intimately familiar with the Roman law list of *condictionem* or how, for instance, the Roman law *action de in rem verso* contributed to the development of the modern law of unjust enrichment, Law as Integrity

best fits a common law legal system.³⁴⁸ However, a simple cognitive solution to this problem is simply to treat any system of legal precedent, whether formalised, such as with *stare decisis*, or more informal systems of precedent as pragmatically the same. They achieve the same outcomes of legal continuity, despite doctrinal differences.

While it might be the case that the underlying doctrinal justifications are different in both the UK and Japan, if the conduct of the judges converges around an identifiable system of precedent, even if informal in Japan, that is sufficient for the Dworkinian model.

It is arguable that Japan is a formalist jurisdiction, and certainly, compared to common law judges, the discretion enjoyed by the Japanese judiciary is more limited. The value of litigation is inversely proportional to the predictability of legal outcomes, and while the Japanese are no less litigious under the same circumstances as their western counterparts, Japanese circumstances are different. Because Japanese law is characterised by judicial restraint and a great deal of emphasis on predictability, the rate at which Japanese people settle instead of proceeding to court is relatively high, and the Japanese legal profession is small in a measure of lawyers *per capita*.³⁴⁹

Everything about the Japanese legal system, its history and Japanese society points towards the fact that the Japanese view the law and recourse to the hard application to the law as a distinct possibility. Japanese legal and natural persons are willing to resort to litigation if necessary, but they are very mindful of the harsh application of the law, judicial and other

³⁴⁸. Barry Nicholas, 'Unjustified Enrichment in the Civil Law and Louisiana Law' (1961) 36 Tul. L. Rev. 605.

³⁴⁹. Haley, *Authority without Power* (n 31), 81

transactional overheads and the difficulties which might arise from litigation. When coupled with the size of the Japanese legal profession and the relative clarity and predictability of legal outcomes, it comes as no surprise that there is a strong willingness to seek extra-judicial solutions where litigation can be avoided, such as settling out of court.³⁵⁰ However, these are pragmatic concerns, and it does not logically follow that Japanese people are rule-averse and anti-legalist in disposition. Actual willingness to litigate is contextual, and if a legal system does not afford opportunities to litigate boldly and frequently, it is logical to expect that litigation rates will decrease. The size of the Japanese legal profession is small and there are hurdles in the way of litigation. This is useful information, and it might inform one about the political culture of Japan, which is responsible for maintain the small size of the legal profession, but it does not tell one a vast amount about the willingness of Japanese people to litigate under circumstances where litigation is encouraged or, at very least, not discouraged by the prevailing, practical circumstances.³⁵¹

The Japanese judges are not encouraged to perform justificatory ascent until they find the one and only right way to decide the case because that, for them, is to exercise restraint and produce clarity, hence why Japanese courts, at times, deliberately limit their ability to create precedent, so as to avoid distorting the way in which laws are interpreted by other courts.³⁵²

The practice of a court to restrict the ability of its own decisions to serve as precedent can be seen as a mechanism against the same problem presented by Dworkin in the context of

³⁵⁰ Koichi Hamada, 'Explaining the Low Litigation Rate in Japan' (2000) 179 *Finance, governance, and competitiveness in Japan*.

³⁵¹ *Infra* 5.3, 5.4.4

³⁵² Itoh (n 327).

legal uncertainty in a formalistic jurisdiction which has no way to address them in an integrated fashion – by ‘judicial sacrifice’.

The isolated case, which will have no power to influence subsequent courts might be decided on a policy basis, whether with reference to global or local principles of morality or by other means, albeit whilst paying lip service to expectations of restraint and predictability. This account, however, is inherently one of rule scepticism, only it is not mentioned overtly that the Japanese judiciary has the power to exercise a level of judicial power and judicial discretion, limited in application to individual cases, which is not overtly acknowledged.³⁵³

³⁵³ Hiroshi Itoh, ‘Judicial Review and Judicial Activism in Japan’ (1990) 53 *Law & Contemp. Probs.* 169.

4.4 *Neutrality as a Necessary Prerequisite of Comparative Analysis*

Neutrality is an important element of comparative legal analysis. The perspective of this thesis is intended to be neutral, which means that it is a perspective different from that from within one of the two legal systems. This neutrality means that neither jurisdiction is viewed solely from the perspective of the other. The perspective of comparison, if it is to be objective, requires a theoretical trade mark model, complete with the relevant paradigms and terminology.³⁵⁴

The nature of this thesis requires this measure of neutrality and detachment. The present state of Japanese scholarship is such that, for historic, legal-theoretical and geographic reasons, there is little by way of comprehensive writings on the topic, such as books, principally, establishing a comprehensive system of legal comparison and comparative law methodology which could serve as the basis of Japan-UK comparative, legal studies.

³⁵⁴ Zweigert and others (n 156).

4.5 *The Use of Functionalism in This Thesis*

The objective of the broader thesis is to provide a comparative analysis of the moral principles in the trade mark registration regime. As with any work of legal comparison, it is vital to first establish a framework of theoretical considerations, terminology, conventions and practices to allow the seamless integration of the materials, such as judicial cases, from both jurisdictions, into a unitary discussion.

As part of the comparative analysis, the objective of the thesis is to ascertain the degree of convergence and divergence across the registration systems of the respective jurisdictions. Convergence and divergence are impossible to identify and meaningfully discuss without defining a legal structure to serve as a template for what is relevant to the discussion.

Differences in the jurisprudential approach can change the outcome of the comparison and the report degree and specific instances of divergence. Due to the high degree of linguistic divergence and because the two jurisdictions belong to different legal traditions, it is to be expected that there is a large degree of ostensible divergence, with entire legal paradigms being absent from the respective legal systems, such as international truthfulness and passing-off. However, a mere formalist acceptance of the ostensible would constrain discussion of influences, including moral ones, which are not derived from recognised sources of authority in a rigid formalistic system.

The present objective is, therefore, to supply a theoretical framework and understanding of law which is not formalistic and which can reason about more abstract conceptions of law

which transcend the strictly positive, enacted instances of law. Although there are, no doubt, other legal positions which would likewise have allowed such discussion, for the present thesis the concept of Law as Integrity as formulated by Dworkin and his treatment of principles and rules have become the primary influence.

With relation to the practical comparison of legal features, following their interpretation and passage through the Dworkinian framework,³⁵⁵ the functionalist analyses about the convergence of more microscopic elements of the trade mark registration system can be used to reason about mesoscopic or even macroscopic elements of the trade mark regime – to reason about a general tendency or measure of convergence within the broader trade mark systems.

³⁵⁵ Jonathan Crowe, 'Dworkin on the Value of Integrity.' (2007) 12 Deakin Law Review 167.

4.6 *Functional Equivalency*

The cascading model of equivalency is a logical extension of the system of equivalency used throughout this work in order to facilitate discussion of the various, constituent elements of the trade marks regimes in Japan and the United Kingdom. The comparative model of equivalency is based on the idea of an ideal trade mark regime of functional elements. For example, a system for dealing with unregistered marks is a functional category which can have many practical implementations.

4.6.1 **Functions**

A function is an element or module of a legal system which has a transformative effect on the outcome of a legal issue or situation. In terms of its formal representation, most functions are logical disjunctions in terms of how they behave when applied to a legal case, be it a judicial case or in the context of trade mark examination by trade mark examiners, for example in the Japan Patent Office or the UK Intellectual Property Office.

Art.3(1)(ii) of the Trademark Act 1959 states that a mark may not be registered if it “is customarily used in connection with the goods or services;”

Section.3(1)(d) of the Trade Marks Act 1994 states that a “*trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*” shall not be registered.

These provisions are both self-contained functions for the purposes of functional equivalency. These functions are typically disjunctive in the sense that a trade mark is not

registrable if one **or** any other are applicable. In this sense, the Art.3 and s.3 are a sequence of functions which must have a false outcome, i.e. they must not be applicable. The trade mark applied for must not be a mark which “is customarily used in connection with the goods or services” and it must likewise not fall under any of the other functions (sections) which check the trade mark applied for against their own definitions.

In terms of equivalency, despite the differences in wording, the underlying meaning of the respective wordings of Art.3(1)(ii) and s.3(1)(d) are broadly the same. In practice, this means that if applied to the mark SINGLE MALT (for a distilled drink like whiskey) in the same jurisdiction, the result of the test should be the same. Irrespective of which wording is chosen, if either function is used in the context of SINGLE MALT in the UK, the result will be that the mark SINGLE MALT satisfies the conditions in Art.3(1)(ii) and s.3(1)(d). Likewise, the mark LEST MALIGN (an anagram of single malt) would likely not be considered to have satisfied the requirements of the aforesaid sections and it would, therefore, be registrable, subject, of course, to how strict or relaxed the relative grounds are in a jurisdiction.

Functional equivalency is not the same, however, as being identical. Art.3(1)(ii) and s.3(1)(d) can produce identical results if applied to identical circumstances, however functional equivalency does not require identity or complete equivalency. The two sections might have a divergence of outcome, but they remain functionally equivalent to the extent that they produce the same kind of result.

In this instance, Art.3 and s.3 will always produce a result which answers to the question of

whether a mark is registrable. The type of question one must ask of Art.3 and s.3 are the same and the type of the answers which these sections are able to provide are also the same, irrespective of the fact that one of the jurisdictions could, hypothetically, decide to make registration contingent on astrological factors, such as the horoscopic model of the western zodiac – if the inputs are of an identical type e.g. trade mark applications and the outcomes are of an identical type e.g. trade mark examination outcomes, then the two legal functions are identical in essence, i.e. they are functionally equivalent.

While this appears almost mathematical and complex, the intuitive and heuristic assessment, effectively, compares what the subjects of comparison do. E.g. Is the protection of goodwill the same as the protection of reputation? Is it the same as the protection of a property right?

Of course, the answers depend on the nature of these things, e.g. what is goodwill, reputation or property?

4.6.2 **Granularity**

The elements of a trade mark regime which are functionally equivalent can be very different in implementation and outcome. Identical outcomes are not the hallmark of functional equivalency, although they are a possibility. A particular system, such as the Japanese system which exists for dealing with unregistered marks, has varying levels of similarity with its UK functional equivalent, depending on the level of abstraction at which it is viewed. The higher the level of abstraction, the higher the level of similarity, and the more granular the analysis, the more the divergent features come to the fore.

If viewed at a very low level, in terms of the most concrete, granular elements of the system, UK and Japanese law can appear quite different, due to the differences in the way that passing-off and the system of well-known marks implement protection for unregistered marks. The protection for well-known marks is a reputation-based protection, whereas for passing-off a normative judicial remedy, so at a high degree of granularity, there is evident divergence. However, in terms of the high level view, they accomplish the same thing – they provide protections, however effective, to unregistered marks.

International truthfulness is, perhaps, closer to passing-off at a high level of granularity, as it involves the fashioning of a judicial remedy, but even in the presence of this factor, the sheer difference in availability means that at a low, highly granular level, they are different entities.

4.6.3 Functional Equivalency of Trade Mark Regimes

The degree of equivalency between the trade mark regimes at the highest degree of abstraction and generality is almost complete – in a completely macroscopic sense the trade mark regimes are almost identical, in the sense of furnishing people with avenues for the obtention and use of proprietary trade mark rights. Two trade mark regimes can be functionally different in some of their functions at a very granular level and still be harmonised. However, it is logically not conceivable for highly harmonised systems to be divergent on the macroscopic level. Structurally, the Trade Marks Act 1994 and the Trademark Act 1959 are not typographically identical, but in terms of their most crucial provisions they are virtually identical, especially as they pertain to the topic of trade mark registration and the issues arising from this field.

Trade mark regimes are also highly modular. The current trade mark regime template has been carefully fostered by the World Intellectual Property Organization through several decades, and it is devised to integrate, relatively seamlessly, into any existing legal system. For example, Chapter V (Appeal and Trial) of the 1959 Act sets out the appeals process in a self-contained format and likewise does Part III (Administrative and other supplementary provisions) of the 1994 Act, and this holds true with relation to other elements of the two trade mark statutes. The preponderance of the rules needed for the resolution of trade mark processes are included in the statutes.

There are, of course, other rules which would influence trade mark proceedings in the UK or Japan, but the provisions of the statutes are not likely to be contrary to the fundamental rules of a jurisdiction, such as the procedural rules governing evidence in private proceedings.

Because of the high degree of functional equivalency at a high level of abstraction, one might be able to take the provisions of the 1994 Act, and transpose them into Japanese law, supplanting the 1959 Act. Such a hypothetical act would likely prompt a thorough re-examination of the way the trade mark industry works, but it would not do away with any of the hallmarks of an ideal trade mark regime. Practitioners and other personnel would be alarmed in such a hypothetical scenario, but this would likely prompt a practical worry about the cognitive cost of compliance, rather than normative, ethical worry.

4.6.4 The Constituent Parts of Comparative Analysis

This thesis is, fundamentally, a comparative work, the objective of which is to compare the

Japanese and the UK trade mark registration regimes. The term *comparative* will be used throughout this writing to also refer to a range of concerns related to comparative analysis, and to encompass them as umbrella terms.

Comparative law is, by itself, the comparison of two or more jurisdictions. The self-evident connotation is the comparison of the judicial or statutory legal *corpus* of two jurisdictions, with a view to reasoning about the instances and levels of convergence and divergence. While this is important, it is not the totality of what can be incorporated into comparative analysis.

Legal systems are a product of the social ordering within which they exist. Every legal system reflects the history of the polity which gave rise to it, and it is, therefore, possible to reason about legal systems with a view to understanding the events and processes which have shaped them. This is valuable in its own right, but it is also informative in allowing a comparison of the contextual environments which have influenced the Japanese and UK legal systems to evolve as they have.

Legal culture is not a free-standing entity. It is a result of the characteristics of a legal system and the polity within which that system exists. For example, the anti-legalism of the interwar Japan had resulted in a significant diminution of the size of the Japanese legal profession,³⁵⁶ a change which persists to this day. By comparing such factors of legal-historical significance, it is possible to reason about the why and the how of the evolution of legal systems.

Legal transplants are ubiquitous, albeit hidden from sight - in plain sight. Harmonisation is

³⁵⁶ Haley, *Authority without Power* (n 31) 96.

prominent and common in the modern, global ecosystem of jurisdictions, e.g. the Paris³⁵⁷ and Berne Conventions³⁵⁸ or the TRIPS agreement.³⁵⁹ There are numerous benefits which derive from legal similarity, but that process of harmonisation also results in legal transplantation of parts of other legal systems, whether derived from national, *Supra*-national or ideal legal systems.

Some legal transplants have resulted from national processes other than harmonisation. For example, the objective of the establishment of the Ritsuryou system has not been harmonisation, but the adoption of much of an existing legal code, with a view to introducing a legal system to the benefit of the state, as understood by the ruling elite of the time.³⁶⁰

This work discusses legal transplantation as an element of the aggregate analysis. Legal transplants were important in shaping Japan and the sequence of various Japanese legal systems, including the latest iteration, the contemporary Japanese legal system. Similarly, transplants are vital in shaping the trade mark regimes of the UK and Japan and moulding them in line with contemporary needs and demands.

The primary instrument, in the contemporary trade mark context, for this transplantation is the TRIPS agreement, which has an important role in providing a template to ensure a minimum level of protection for trade marks, as well, by so ensuring, to harmonise the laws of the signatories and achieve a level of uniformity across the respective trade mark

³⁵⁷ Paris Convention for the Protection of Industrial Property; Leong (n 36).

³⁵⁸ Berne Convention for the Protection of Literary and Artistic Works.

³⁵⁹ The Agreement on Trade-Related Aspects of Intellectual Property Rights.

³⁶⁰ Haley, *Authority without Power* (n 31) 29.

regimes.³⁶¹

Accordingly, the TRIPS agreement is a legal transplant. While it does not originate from a state, such as Tang China³⁶² or Imperial Germany,³⁶³ it is nevertheless a discrete legal model which can be transplanted in the same way and, as a result of transplantation, it supplants national laws in the area which it governs.

³⁶¹ Leong (n 36).

³⁶² Haley, *Authority without Power* (n 31) 29.

³⁶³ *ibid* 77.

4.7 *Problems in Comparative Analysis*

4.7.1 **Objectivity of Analysis**

It is not a necessity that the author should have a clear picture of what scholars within the jurisdiction think about the jurisdiction, but it is helpful.³⁶⁴ In the context of comparative law it is interesting to analyse what scholars and practitioners within the system think and write about the system which they inhabit and constitute. However, ascertaining and compiling such opinion is a different concern from describing the system objectively. The internal experience and perspective endows the commentator with valuable experience of the system, but in order for an objective position to be constituted, such opinions must travel through a system of objective, independent and factual scrutiny. In the present instance, this is achieved through an adherence to the functional approach to comparative law analysis.³⁶⁵

4.7.2 **Phenomenology**

The traditional limitations of phenomenology also apply to comparative law. Even when using a system agnostic model of equivalency, such as that called for by Zweigert & Kotz,³⁶⁶ the descriptions and definitions are innately relational and subjective.³⁶⁷ Trade mark comity, as a paradigm, is a bespoke configuration of familiar

³⁶⁴ Engberg (n 87).

³⁶⁵ *Supra* 4.4, 4.5, 4.6

³⁶⁶ Zweigert and others (n 156).

³⁶⁷ David Woodruff Smith, 'Phenomenology', *Encyclopedia of Cognitive Science* (John Wiley & Sons, Ltd 2006).

concepts. It is possible to further disambiguate the concept by defining it through combining two concepts: trade marks and comity. However, the concepts employed in such use are still highly subjective and rooted in language and culture. In the case of Kokusai Shingi, Port had decided to refer to it as a type of trade mark comity.³⁶⁸ In principle, this would place Kokusai Shingi in the category of phenomena broadly falling under the Huberian comity doctrine.³⁶⁹

In the recent application of FINTAN (フィンタン)³⁷⁰, which is for a popular anthropomorphised representation of Finland frequently portrayed in Japan, one of the underlying concerns was not only the impropriety of a private individual monopolising such a popular intellectual entity, but also the possibility that the commodification and commercial exploitation of the symbol might harm the authority and dignity of the Finnish state. This is distinctly the same type of reasoning as seen in the case of Tarzan where the fear was that the depredations of a trade mark troll could demean and degrade an American cultural icon: Tarzan. This confirms that Tarzan is still good law and international truthfulness still applies to such cases, as it did before. It also establishes a distinct and discrete category of trade marks – marks of national, cultural, ethnic or racial significance, which are likely all exempt from the depredations of trade mark trolls and other similar entities, as with TARZAN and FINTAN.

³⁶⁸ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 111.

³⁶⁹ Kurt H Nadelmann, 'Introduction - The Comity Doctrine' (1966) 65 *Michigan Law Review* 1.

³⁷⁰ T2018-87581 FINTAN (フィンタン) (n 225).

The Huberian conception of comity between sovereign states pertains to a similar principle. The judiciary of a sovereign state wilfully refrains from exercising the totality of its sovereign, territorial legal powers in the interests of civility between states. The protection of the authority and dignity of the Finnish state is in conformity with the normative element of the Huberian account.

4.7.3 Language

Language is the primary phenomenological barrier in the seamless conveyance of an idea between the English and Japanese languages. In Japan, the same word *ao* (noun) or *aoi* (adjective) is used to describe blue and green and things which are blue or green. The kanji for both blue and green is, therefore: 青³⁷¹. The PHILIPS trade mark is therefore blue, HEINEKEN is mostly blue and SPRITE is, by extension, blue and blue in Japanese. The issue of blue-green is relatively simple to resolve with numeric representations of colours, but the mismatch of chromatic definition between the languages illuminates a large level of plasticity of thought. This can be seen in the context of the divergent perceptions of linguistic groups, and language is generally a tool used to describe a phenomenon in a relational fashion.

There are, furthermore, statistically significant differences between the ability of male

³⁷¹. Conlan (n 91).

and female observers to lexicalise various specific spectral ranges.³⁷² This difference is particularly significant in the context of precisely the colours blue and green. Although not natively in the English vocabulary, the spectral range encompassing both what in English is referred to as green and blue is referred to as *grue* in the scholarship dedicated to colour perception and lexicalisation.³⁷³

Due to these reasons, there is an intrinsic discrepancy between how approximately the two halves of the population can perceive and lexicalise colours, and there is a further discrepancy in the lexicalisation of colours based on whether a society and its associated languages distinguish between blue and green, or whether they are treated as *grue*.³⁷⁴ Accordingly, it can be inferred that a large portion of the Japanese population has the ability to perceive and lexicalise a large range of different variants of *grue*. However, they would be unlikely to interpret and lexicalise turquoise as belonging to the distinct category of green because green, as discussed above, is a more recent addition and culturally most forms of blue and green were considered to be *aoi* or blue.

4.7.4 **Legal Theory and Transliteration between UK and Japanese Trade Mark Law**

A comparative law discussion requires neutral vocabulary and definitions. The respective

³⁷² James L Donahue and others, 'Shade Color Discrimination by Men and Women' (1991) 65 *The Journal of Prosthetic Dentistry* 699.

³⁷³ Mary Hesse, 'Ramifications of "Grue"' (1969) 20 *The British Journal for the Philosophy of Science* 13.

³⁷⁴ Nicole A Fider and Natalia L Komarova, 'Differences in Color Categorization Manifested by Males and Females: A Quantitative World Color Survey Study' (2019) 5 *Palgrave Communications* 1.

vocabularies and definitions of the specific systems are not always suited to reasoning about one another. There are examples which are suitable, however, such as terms like the *relative* and *absolute grounds for refusal*. These terms are purely descriptive, and they are not used idiomatically in English legal parlance – they are used descriptively. Accordingly, such terms are safe due to their descriptiveness.

The Unfair Competition Prevention Act³⁷⁵ has a broad application, but its primary purpose is to regulate procedural impropriety, such as bad faith, in the context of intellectual property. For most western lawyers, it seems intuitive to think immediately of behaviour which is in violation of competition law – the legal field regulating competition between commercial undertakings. One might instinctively assume that unfair competition, in this context, is something in the same category as predatory pricing, mergers, resale price maintenance or a range of other competition law issues. Naturally, one might also think about unfair competition law in the contextually correct sense of a body of law which regulates unfair competition in a descriptive sense.³⁷⁶

This assumption would be wrong.³⁷⁷ Furthermore, an American lawyer might assume that unfair competition is how his Japanese counterparts describe antitrust law, and this assumption would likewise be wrong. Unfair competition in this context refers, instead, to the state of mind of the person whose behaviour, in the context of intellectual property, is

³⁷⁵ Port, 'Trademark Harmonization: Norms, Names & (and) Nonsense' (n 249).'

³⁷⁶ 4.13.1

³⁷⁷ This is an example of the phenomenon of false friends – often cognate words which, in the context of specialist vocabulary, have come to be used as part of specific terms. These terms can be misleading by having ostensible, superficial similarity, as they are cognate, whilst having different meanings in the specialist vocabulary. For a discussion of false friends see: Ádám Fuglinszky and Réka Somssich, 'Language-Bound Terms—Term-Bound Languages: The Difficulties of Translating a National Civil Code into a Lingua Franca' (2020) 33 International Journal for the Semiotics of Law - Revue internationale de Sémiotique juridique 749.

being scrutinised.

Translation or transliteration from one language to another is a heuristic process, which means that the translation or transliteration is often merely an approximation of the original meaning, rather than a perfect and complete reproduction in another language. While it is not possible to explore this in greater detail in this thesis, it appears that different languages impart different cognitive toolkits in describing things through language,³⁷⁸ and this would logically extend to the legal register or subset within a language.

Often it is convenient to discuss the elements of another jurisdiction in English or any other language which one is inclined to use, but the practical usefulness of this exercise depends on the linguistic and legal proximity between the points of view and the jurisdictions. By way of analogy, one might consider the *postal rule* of contract law. *Dunlop v Higgins*³⁷⁹ offers a good exposition of the basic principles of the postal rule in UK law.

Likewise, *Cantu v Central Education Agency*³⁸⁰, with relation to the position in the USA. Similarly, Art.526 of the Japanese Civil Code describes very clearly the prevailing postal rule. However, this matter belongs to a part of law which addresses logistics which have been much the same across the entirety of the world at one point or another, in the sense that these rules arose in response to a need for managing risk in delayed or lost acceptances of contractual offers.

³⁷⁸ Lera Boroditsky, 'How Language Shapes Thought' (2011) 304 Scientific American 62.

³⁷⁹ *Dunlop v Higgins* (1848) 1 HL Cas 381.

³⁸⁰ *Cantu v Central Education Agency* 884 SW2d 565.

There is cultural adjacency, and the three jurisdictions resolve the matter similarly for similar reasons. This is quite comparable to many elements of the trade mark regimes of the UK and Japan, where the global IP regime had created a large degree of harmonisation and artificial cultural and legal-cultural adjacency, through participation in the global economy.

In contrast, there is remarkably little legal or cultural adjacency with regard to Japanese concept of international truthfulness, which is culturally alien to the UK legal system, and linguistically difficult to describe in or transpose into English. One can describe it through discussing the legal consequences of the principle of international truthfulness and the decisions of Japanese judges based thereon, but it is very difficult to formulate a succinct sentence to accurately and comprehensibly describe it, let alone a term composed of just two words, such as *international truthfulness*. Of course, this is only in part because *kokusai shingi* is an idiomatic term – it is also, partly, following the Dworkinian model, it is a principle and not a rule, so it is not described with the clarity and precision of a rule.

The term *kokusai shingi*, corresponding to a type of extra-territorial comity discussed in the context of Tarzan,³⁸¹ means international truthfulness in the translation of Kenneth Port. However, it could also be transliterated as *faith between states*. At its core, it refers to an ambiguous normative principle of solidarity between states in matters of extra-territorial rights – or so it appears in the treatment and practice of Japanese courts. As a principle, it is one of the very few indigenous pieces of Japanese law, albeit it does not hearken back to the very origins of Japanese law, rather, it is societally of clearly Japanese origin. It is also possible to infer from the practice of the courts with relation to this principle, that it plays an

³⁸¹ *Supra* 3.5.1

important role in the moral system of Japanese society. It represents a preoccupation, interest or disposition within Japanese society, and one can infer that Japanese legal culture has a disposition to honouring the mores or norms encapsulated by international truthfulness, whatever they might be – in a way which is not typical of states and, by extension, their societies.

The terms international truthfulness and faith between states are terms which, in translation or transliteration, are inadequate for the purpose of conveying the underlying mechanics of their application at a highly abstract level. International truthfulness, even in its Japanese form, is highly idiomatic, and it incorporates a normative element of “keeping faith” as a token of moral solidarity with another entity, such as a state, organisation or individual.

Most layers of complexity are abstracted away in the basic wording, and there is little to demonstrate or define the precise mechanics of its application. The terms are not misnomer, but neither do they describe adequately the underlying effect of their invocation in judicial proceedings. There is an element of indeterminacy and uncertainty due to not being conclusively and comprehensively defined. This necessarily means that it is possible to reason about international truthfulness, but its limits have not been entirely or completely explored and it is very likely that such a complete and comprehensive exploration is not sought or desired, so as not to undermine the flexibility of its application, such as when morally needed to fashion a remedy, as it happened in the cases where it had been invoked in a trade mark context. This is a trait which it shares with other nebulous concepts such as public policy or public interest.³⁸² It is a principle in the Dworkinian sense, after all.

³⁸² *Infra* 4.12

In the context of trade mark law, international truthfulness has a meaning which the aforesaid layers of abstraction conceal. Although international truthfulness is not a trade mark law concept, and it can be applied to other extra-territorial rights, as well as a range of other activities and behaviours, it has a very specific effect on trade mark law. In trade mark law it creates domestic protection for extra-territorial trade mark rights, and the objective of functional analysis is to describe this precise ability or tendency, rather than to follow the transliterated meanings and connotations of abstract, broad terminology such as *international truthfulness*³⁸³ – an idiom which is more likely to mislead non-Japanese commentators than assist them.

Structurally, this work hinges primarily on statutory and judicial sources, and, by extension, international treaties which have been responsible for the development of much of the domestic trade mark laws of the two jurisdictions. This chapter employs a jurisprudential and comparative trade mark law framework for the purpose of engaging with and reasoning about the characteristics and nature of the respective trade mark regimes.³⁸⁴

The jurisprudential basis for this framework also on Dworkin's idea of law as integrity – a form of legal continuity predicated on adherence to the rights and obligations which are perceived to have been created by the broader community. This thesis is not a wholesale adoption and account of Dworkin's views,³⁸⁵ but the flexibility afforded by the constructive interpretation of multiple factors permits a degree of flexibility in engaging with legal

³⁸³ *Supra* 3.5.1

³⁸⁴ *Supra* 4.3

³⁸⁵ Paul Gaffney, *Ronald Dworkin on Law as Integrity: Rights as Principles of Adjudication* (Edwin Mellen Press 1996).

materials and it permits a descriptive account of legal practice more broadly, without necessarily focussing on the strict, procedural validity of each piece of law in a more formalist fashion.³⁸⁶

4.7.5 Structural Similarities in Legislation

As argued throughout this thesis, the Japanese and the UK trade mark regimes are structurally similar. A UK jurist, when looking at the structure and contents of the Japanese Trademark Act 1959, would be able to relate the preponderance of provisions to their direct equivalents in the Trade Marks Act 1994. It is very likely that a British lawyer or legal scholar with no previous working experience with intellectual property law would not be able to discern which state most of the general provisions of the Trademark Act 1959 correspond to.

Article 4(1)(viii) states that a mark shall not be registered if it:

“contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);”

Despite this similarity, however, and despite the large level of functional equivalency,

³⁸⁶ *Supra* 4.3

there are certain paradigms which require the observer to think **in** a phenomenologically different fashion about something which may very well be very familiar and ingrained.

This is demonstrated by “unfair competition” and the inherently confusing nature of this term, when used in the broader context of western legal systems and western lawyers. Unfair competition is definitionally unlike anti-trust law. In the global legal context, anti-trust as a term to describe competition law is a misnomer. Even in the modern American legal setting this term is antiquated and no longer corresponds to the primary and most pervasive forms of anti-competitive conduct. In contrast, unfair competition perfectly describes a trade mark application made in bad faith in order to despoil a competitor and deprive him of the use and enjoyment of intellectual property. Incidentally, the dictionary meaning of the combination of the words within this phrase also perfectly describes resale price maintenance and hard core cartels in the context of perverting competition to gain an unintended financial and economic advantage.

Because neither term is incongruous, anachronistic or otherwise factually incorrect, it can be difficult to rely on these definitions because they are such insidious false friends. In Japan, competition law is known as both *Monopoly Prohibition Law* (独占禁止法 – dokusen-kinshihou) and *Competition Law* (競争法 – kyousou-hou), although the former is the more common and popular designation.

The Unfair Competition Prevention Act 1993 is an instrument which features prominently in regulating impropriety in the context of trade mark registration in Japan. This Act is referred to as 不正競争防止法 in Japan and it uses the same literal term for competition 競争 (kyousou) as appears in the term competition law 競争法.

The Japanese counterpart of the UK Intellectual Property Office is called the Japan Patent Office, and Japanese trade mark applications are submitted, therefore, to a nominal patent office. Japanese trade mark attorneys, likewise, are referred to as Patent Attorneys, and there are countless Japanese trade mark attorneys with no scientific or technical background who, nevertheless, bear a title which is, in the UK and the EU, associated with a small cadre of professionals who engage almost exclusively with patent concerns.³⁸⁷

This further underlines the fact that internal descriptors can be treacherous.

³⁸⁷ *Infra* 3.7

Structure of Comparative Analysis

The Trade Marks Act 1994 offers a particular ordering of issues, based on the structure of the act – i.e. the typographical order in which the sections and sub-sections are presented, in line with UK sensibilities of how an act ought to be ordered. This does not mean that this writing employs, wholesale, the phraseology and definitions of the UK trade mark regime.

The objective is not to write a thesis wholly in the UK trade mark parlance, but simply to rely on the existing structure of the 1994 Act for the purposes of setting out the ordering and flow of the discussion of abstract paradigms which may or may not exist in the two trade mark regimes, and to do so objectively.

The core issue of trade marks is whether particular marks can be registered, and the scope of this writing primarily focusses on registration. All subsequent trade mark protections follow registration, other than to the extent of protection afforded to unregistered trade marks, in jurisdictions where this is available (this is in contrast with non-trade mark protections, such as passing-off).

4.7.6 Absolute & Relative Grounds for Refusal

In order to register a mark as a trade mark, the mark must, on examination, overcome a number of hurdles, such as those outlined above, in line with socio-legal norms and economic needs – the normative and moral basis for having a trade mark regime. The policy

tool used to regulate and broaden or narrow the category of eligible trade marks is the concept of registrability discussed above, such as with relation to the ethics and economics of non-traditional trade marks.

The definitions for the absolute and relative grounds for refusal to register trade marks are intuitive. Relative grounds pertain to situations where the mark is registrable on the face of it, and there is nothing intrinsic about it which would preclude its registration. However, it is nevertheless not registrable such as, for example, because there is a similar or identical mark already registered within similar classes. In contrast, the absolute grounds for refusal to register pertain to marks which are intrinsically precluded from registration, such as SEIROGAN written so as to mean “Conquest of Russia with Bullets”.³⁸⁸

Once it has been established that a mark can be represented, the examiners are tasked with ascertaining whether there are any provisions under the absolute grounds which would altogether prevent the registration of the mark applied for, irrespective of its circumstances. Once the mark clears this hurdle, the examiners assess whether registration should be denied on the basis of circumstance, such as on account of existing prior registrations. A trade mark is not eligible for registration if it is eliminated at any of the three stages.

Absolute Grounds for Refusal

The absolute grounds are, in an abridged form, as follows:

Section	Description
1(a)	Contrary to 1(1)

³⁸⁸ Kim (n 224).

1(b)	Not distinctive
1(c)	Qualitative and quantitative descriptions
1(d)	Industrial terminology
2(a)	Descriptive characteristic of goods (innate)
2(b)	Descriptive characteristic of goods (technical necessity)
2(c)	Descriptive characteristic of goods (added value)
3(a)	Contrary to public policy or morality
3(b)	Deceptive
4A(a)	(Origin or Geographical Indications) Contrary to existing enactment or rule of law
4A(b)	(Origin or Geographical Indications) Contrary to provision of EU law
4A(c)	(Origin or Geographical Indications) Contrary to applicable international agreement
4B(a)	(Wine or traditional specialities) Contrary to provision of EU law
4B(b)	(Wine or traditional specialities) Contrary to international agreement applicable to EU
4C(a)	Essential reproduction of registered plant variety denomination
4C(b)	Plant varieties of same or closely related species
4D(a)	(Plant variety rights) Contrary to existing enactment or rule of law
4D(b)	(Plant variety rights) Contrary to provision of EU law

4D(c)	(Plant variety rights) Contrary to applicable international agreement
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Grouping the grounds for refusal into two categories provides an abstraction which helps and facilitates the discussion of two of the three various hurdles which a mark must overcome to be registered. This category-based grouping intuitively steers discussion of the various grounds of refusal to the process of overcoming consecutive hurdles. This is helpful in providing an abstract and efficient way of reasoning about the process, but it is not an absolute necessity to think of the examination process as a set of two consecutive groups of hurdles.

Applying the various grounds for refusal and checking for a positive match can be a linear process, following the aforesaid three steps, but it is likewise possible to treat each ground of refusal as a discrete entity which a mark can be checked against out of a particular order, rather than necessarily as part of a category-based, phased approach. The Trademarks Act 1959 does precisely this. Categorising and grouping grounds of refusal is, after all, not an absolute necessity, and the categories are more useful divisions and cognitive aids than necessary divisions. Fundamentally, if there are 10 grounds of refusal which are grouped into two clusters of 5, or treated as 10 discrete grounds of refusal, if a mark must not fall afoul of any of them to be registered, then it is inconsequential whether it clears 10 discrete tests or two clusters of 5 each.

There is no clear, singular rationale or justification for the entirety of this category. Descriptive marks describing the quantitative or qualitative features of goods, for example, are liable to obstruct legitimate, *bona fide* competition.³⁸⁹ In contrast, the provisions pertaining to public order and morality or deception fall under a different category of normative grounds. Descriptive marks describing the colour or texture of goods are liable to create barriers to entry and impediments to competition and a great deal of consternation for market participants,³⁹⁰ but the result is markedly different in the case of marks causing political outrage and disrupt society because of an emotional disruption of the social order.³⁹¹ With both of these categories, there is a perceived harm if marks were to be registered indiscriminately, albeit the source of the harm is very different

Although “absolute grounds” is a useful categorisation where categories are extensively used throughout legislation and in legal parlance, but some trade mark legislation is not structured in such a way as to rely on such distinctions. The primary trade mark statute of South Korea,³⁹² for example, makes no category distinction based around absolute and relative grounds, much like its Japanese counterpart. The Armenian³⁹³ primary trade mark statute, however, breaks the grounds down into

³⁸⁹ Phillip Johnson, “So Precisely What Will You Use Your Trade Mark for?” *Bad Faith and Clarity in Trade Mark Specifications* (2018) 49 *IIC - International Review of Intellectual Property and Competition Law* 940.

³⁹⁰ Ilanah Fhima, “The Public Interest in European Trade Mark Law” [2017] *Intellectual Property Quarterly* 311.

³⁹¹ Marc J Randazza, “Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights” (2015) 16 *Nevada Law Journal* 107.

³⁹² Trademark Act 1949 (Republic of Korea).

³⁹³ Trademark Act 2010 (Republic of Armenia).

absolute and relative grounds, much like the 1994 Act, whereas its predecessor used the terms absolute and “other”.³⁹⁴ Accordingly, the division into absolute and relative grounds is a drafting preference or convention, rather than something which signals divergence. Whether grouped into relative or absolute grounds, the substantive provisions are convergent across the UK and Japan.

4A, 4B, 4C and 4D are jurisdiction specific provisions. It is not unusual for a trade mark system to have elements overlapping with other legal features and protections, especially other forms of intellectual property. These provisions need not be strictly equivalent to legal provisions in other jurisdictions, but such **internal consistency**³⁹⁵ provisions are often necessary to expressly provide for the rules of interaction between different bodies of legal provisions. This is to ensure that different forms of intellectual property and other intangible things such as rights are not inter-operated in such a way as to create unintended, degenerate effects not intended by the legislature and not in line with the spirit of the law, such as for example undermining and paralysing the plant varieties system through tactical registrations of trade marks intended to block the exploitation of specific plant varieties. This is a normative principle likely intrinsic to any modular system, such as the trade mark regime, in that the trade mark regime has some hazily defined albeit powerful boundaries surrounding the remit of its operation, and it would be normatively fraught if trade marks were used in a way, for example, copyright has been intended to be used –

³⁹⁴ Trademarks, Service Marks and Appellations of Origin Act 2000 (Republic of Armenia).

³⁹⁵ John E Coons, ‘Consistency’ (1987) 75 California Law Review 59.

usurping the very role of copyright.

Although such internal consistency provisions can be extraordinarily important under certain circumstances, they are not devised to feature as part of trade mark competition. Art.4(1)(i) of the Japanese Trademarks Act 1959, for example, provides that:

“(1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark: (i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;”

The provisions of the Article indicate that the, for example, the imperial chrysanthemum crest is not intended to be used in the same fashion as trade marks typically are.³⁹⁶ It is a crest with an elevated importance, and it serves certain purposes which are of significance to the state – sufficiently so to warrant its protection.

Accordingly, these provisions delimit the boundaries of trade mark law and prevent its operation in areas which are the domain of other types of rights.

The Trade Marks Act 1994 is extensively referenced by other legislation and it does, in turn, reference other statutes. This is not unusual, and it underlines a feature of

³⁹⁶ Trademarks Act 1959 art 4(1)(i).

statutory structure in demonstrating the importation of segments of other legislation or rules of law.

This referential relation can be seen, for example, with relation to the Act of Sederunt (Rules of the Court of Session 1994). 1994/1443 Sch. 2(4)(55) para. 55.1, for example, expressly states that causes pursued under the 1994 Act are subject to Chapter 55 of the Act of Sederunt – the secondary legislation governing the procedures of the Court of Session. The Act of Sederunt is a merely an example, but it underlines the fact that legislation does not exist in a contextual vacuum. This means that the implementation of a trade mark regime occurs against the background of an existing legal system.

Accordingly, it is not always possible to describe, in its entirety, a trade mark regime solely based on the self-contained provisions of the primary statute or source of law, such as the 1994 or 1959 Acts, without reference to other factors, including the statutory nexus which controls the broader legal system, or even case law.

This is further demonstrated by the Unfair Competition Prevention Act 1993, which includes numerous procedural safeguards which in other implementations of the archetypal trade mark regime might have been incorporated into the primary statute or law, rather than compiled as auxiliary legislation to accompany primary statutes on trade marks, designs, patents, etc.

Relative Grounds for Refusal

The relative grounds for refusal are set out in s.5 of the 1994 Act.

Sub-Section	Description
1	Refusal – identical mark, identical goods or services
2(a)	Refusal – identical mark, similar goods or services
2(b)	Refusal – similar mark, identical goods or services
3(a) & 3(b)	Refusal – identical or similar mark, unfair advantage damaging to reputation or distinctive character
3A	Modification of scope of s.3
4(a)	Importation of passing-off
4(aa), 4(b), 4B	Importation of protection for origin and GI applications according to priority date, per 4B
4A	Priority provisions for 4(a)

Confusion is the likelihood that consumers are going to be confused or misled as to the origin of the goods, and trade marks also serve to protect consumers from

confusion in terms of preventing them from mistakenly purchasing goods or services which they do not intend, in the mistaken belief that they originate from a different source.

The relative grounds for refusal are so-called due to their relational nature. In contrast with the absolute grounds, relative grounds³⁹⁷ are evaluated with reference to their relationship with other registered trade marks. S.5(4) clarifies the relationship between the trade mark regime and passing-off.

Passing-off is an innately relational legal protection, intended to protect unregistered marks, and their accrued goodwill, from free-riding. Because it is imported in much the same fashion as plant varieties protection under the absolute grounds for refusal, it need not necessarily be incorporated under s.5, as the reference under s.5(4) to that body of judicial law is sufficient.

As with plant varieties, origin and GI protection, different implementations of an archetypal trade mark regime are liable to have a miscellany of provisions under a section or article corresponding, broadly, to s.5, but such provisions may be scattered throughout the act, as with the Trademarks Act 1959, which has a large degree of overlap with the parallel UK provisions, but without the thematic/theoretical grouping provided in the Trade Marks Act 1994.

³⁹⁷ Catherine Seville, 'Trade Marks and Related Rights', *EU Intellectual Property Law and Policy* (Edward Elgar Publishing 2016).

The primary provisions of relative grounds are contained in ss.4(1)-(3). The provisions, which serve primarily to support internal consistency need not mandatorily be included under the category of relative grounds of refusal. Because trade mark law intrinsically pertains to meaning and representation, all trade marks convey a piece of information or knowledge which the observer can use to match the trade mark against various known undertakings in order to ascertain the source of origin.

Association can be made between the Golden Arches and McDonald's,³⁹⁸ for example. A thing which is not able to convey this message cannot be used in association with a source of origin, and is not, therefore, useful as a trade mark – it cannot fulfil the intended semiotic purpose of trade marks.³⁹⁹ Trade mark law, intrinsically is a field of law predicated on definitions, and this is enshrined especially in the various representation provisions in trade mark statutes which provide the basic definitional restrictions.⁴⁰⁰

Section.4 of the 1994 Act covers protection for “Specially Protected Emblems”, and this category includes sub-categories such as Royal heraldry, the various national flags of the United Kingdom, family coats of arms and, by way of importation, some of

³⁹⁸ *Infra* 4.10.3

³⁹⁹ *Ibid*

⁴⁰⁰ Jake Linford, ‘A Linguistic Justification for Protecting Generic Trademarks’ (2015) 17 *Yale Journal of Law and Technology* 110.

the provisions of the Olympic Symbol etc. (Protection) Act 1995, protecting Olympic symbols.⁴⁰¹ Similarly, Art.4(1)(i) of the Japanese Trademark Act 1959 provides:

Article 4

(1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(i) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;

⁴⁰¹ Szarkiszjan and Denoncourt (n 35).

4.8 *Nature of Law and Trade Marks*

Law is a normative entity. It is a human construct, and arguably law is altogether fictional.⁴⁰²

The most commonly invoked arguments attempting to refute the existence of moral norms and morality fall into the group known as arguments from queerness.⁴⁰³ These arguments, in their various formulations, state that in the meta-ethical and meta-physical sense, objective values are queer i.e. incongruent with and absent from material reality and, unlike other entities within the natural world, they are, therefore, implausible.⁴⁰⁴

Similarly, as there have been no observations of objective moral values (humanity has no technology to observe such entities), there have been no observations of laws either. All laws are inherently fictionalist in that they require individuals to act in a specific manner because such action is advantageous to specific individuals or groups of people. In a sense, law is a descriptive affair, describing commonalities in the socio-legal understanding and adherence of persons within society.⁴⁰⁵

This is illuminated by the sempiternal jurisprudential battle to establish the primacy of a jurisprudential model of laws.⁴⁰⁶ Austin's command theory, Kelsen's *grundnorm*,⁴⁰⁷ Hart's rule of recognition⁴⁰⁸ all try to pinpoint the origin of laws or arbitrarily appoint one, such as in the case of Kelsen's Pure Theory of Law. If, however, law is an inherently fictitious, queer

⁴⁰² Mark D White, *Theoretical Foundations of Law and Economics* (Cambridge University Press 2009).

⁴⁰³ Hallvard Lillehammer, 'Queerness, Argument From', *The International Encyclopedia of Ethics* (John Wiley & Sons, Ltd 2013).

⁴⁰⁴ Leong (n 36).

⁴⁰⁵ David O Brink, 'Moral Realism and the Sceptical Arguments from Disagreement and Queerness' [1984] *Australasian Journal of Philosophy*.

⁴⁰⁶ Geoffrey Samuel, 'Is Law a Fiction?' in Maksymilian Del Mar and William Twining (eds), *Legal Fictions in Theory and Practice* (Springer International Publishing 2015).

⁴⁰⁷ Uta Bindreiter, *Why Grundnorm?: A Treatise on the Implications of Kelsen's Doctrine* (Springer Science & Business Media 2002).

⁴⁰⁸ Julie Dickson, 'Is the Rule of Recognition Really a Conventional Rule?' (2007) 27 *Oxford Journal of Legal Studies* 373.

and implausible entity, then it is impossible for such a source of laws to be found or appointed.

Dworkin seeks to bypass the positivist's problem of infinite regression in pursuit of law.⁴⁰⁹ According to the Dworkinian understanding of law as integrity, laws must fit into a social or community framework, as he explains through his example of a chain novel, written, chapter by chapter, by a group of novelists, each writing only a chapter, bound by the limitations of previous chapters.⁴¹⁰ This position does circumvent the positivist's problem of infinite regression, but it remains ineffectual when faced with the meta-physical and meta-ethical problem that laws cannot be observed – in a naturalist sense, they are altogether untestable. The innate problem remains, and as long as law is considered to be an intrinsic entity or quality within the natural world, it will always face the problem of being untestable.⁴¹¹

One can try to discern what the law is, however, it becomes inherently futile to attempt to ascertain what the law ought to be, if law is a queer entity, the existence of which is not plausible within the natural world.⁴¹² Consequently, it is better to accept that all of the law is fictionalist.

In order for a legal system to be functional, it requires a level of adherence to its laws and, in turn, such adherence is fundamental to modern society. It is likely true that some level of social ordering through law is necessary for a civilised society to exist, but it is also true that

⁴⁰⁹ 閔允令, '드워킨의 [법의 제국] 에 대한 니체 철학적 의문' (2012) 14 중앙법학 69.

⁴¹⁰ Stefanie A Lindquist and Frank B Cross, 'Empirically Testing Dworkin's Chain Novel Theory: Studying the Path of Precedent' (2005) 80 New York University Law Review 1156.

⁴¹¹ Brian Leiter, 'The Radicalism of Legal Positivism' (2009) 66 National Lawyers Guild Review 165.

⁴¹² Frederick Schauer, 'The Social Construction of the Concept of Law: A Reply to Julie Dickson' (2005) 25 Oxford Journal of Legal Studies 493.

the desire for a civilised society does not render laws any more queer, fictional and implausible, solely on account of the collective human desire for a society governed by rules.⁴¹³ Laws are a social creation which humans have collectively created because humans and the Infrastructures which they have built cannot effectively function without them.

Law, at the most fundamental level, can be taken to mean a descriptive account of the way in which humans conduct their affairs in accordance with a set of perceived normative rules. In this sense, the conduct of people within society can be described through the positivist language of commands, sanctions, rules of recognition and adjudication, but these principles all struggle to produce a method whereby valid law is distinguished from invalid law or non-law.

Natural⁴¹⁴ law, likewise, faces the same problem, as well as all other legal theories which purport to establish the existence of some type of meta-legal entity for the ascertainment of 'true' laws, the basis of which is arbitrariness and aggregated individual biases. By contrast, fictionalism does not make a more ambitious promise than can reasonably be delivered upon.⁴¹⁵

In the context of trade marks, the principle of *stare decisis* in UK law is hardly contentious, yet in the context of Japan judicial precedent becomes only 'guiding', rather than binding.⁴¹⁶ Japanese judges pay every bit as much attention to cases from the Supreme Court, without

⁴¹³ Samuel (n 406).

⁴¹⁴ Veronica Rodriguez Blanco, 'The Methodological Problem in Legal Theory: Normative and Descriptive Jurisprudence Revisited' (2006) 19 *Ratio Juris* 26.

⁴¹⁵ David Gawthorne, 'Fictionalising Jurisprudence: An Introduction to Strong Legal Fictionalism' (2013) 38 *Australian Journal of Legal Philosophy* 52.

⁴¹⁶ Itoh (n 327).

any need for a formal principle of *Stare Decisis*. Similarly, the Ritsuryou system, the T'ang Chinese laws transplanted effectively wholesale saw progressively greater levels of desuetude with time until, eventually, they ceased to be enforced.⁴¹⁷ Similarly, one can look at a more distant example of the USSR underground economy,⁴¹⁸ where people have established an entire economy revolving around the use of cigarettes and alcohol as currency, in spite of and in violation of laws prohibiting the smuggling of and sale of western goods, as well as private commercial ventures.

Ultimately, both the Ritsuryou code and the Soviet laws prohibiting commerce were law in the sense that they were positively enacted rules, widely accepted and hardly, if at all, protested, yet the reality in both examples was of widespread disregard for the law.

It can be argued that such laws were not in line with the previous body of principles, in the sense of the law as integrity or chain novel, as expounded by Dworkin,⁴¹⁹ however there was no guiding principle in either example, other than expediency. The martial classes in the late Ritsuryou era were powerful enough to disregard the Ritsuryou code, and the people of the USSR were destitute and desperate enough to disregard Soviet laws.

The body of trade mark law is similarly made up of instances where the perceived laws are followed and enforced, as well as when departures from the perceived laws occur for a variety of reasons. For instance, in the *Mac Sangyo*⁴²⁰ case, it was advantageous for the Japanese

⁴¹⁷ *Infra* 6.2

⁴¹⁸ Steven L Sampson, 'ANNALS, AAPSS, 493, September The Second Economy of the Soviet Union and Eastern Europe', *Occupational Crime* (Routledge 2001).

⁴¹⁹ Lindquist and Cross (n 410).

⁴²⁰ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252) 15.

courts to relax the application of the registration-based trade mark laws of the country in order to accommodate US undertakings in the aftermath of the Japanese economic bubble period, during an era of market liberalisation.⁴²¹ It made economic sense to permit the seamless entry of McDonald's' investment into the country, and the court was both willing and able to make such a decision, and so it did. It was not acting on a principle so much as an overarching desire for economic growth.

⁴²¹ Takeda and Turner (n 342).

4.9 *Original Acquisition*

Original acquisition⁴²² in the present instance refers to acquisition of a trade mark which has not been through the transfer of an existing right. Original acquisition of a trade mark takes place where a trade mark comes into existence through the demarcation of its subject-matter in the form of the depth and breadth of the claim in the trade mark application, and exclusive, monopolistic proprietorship of that demarcated and reified subject-matter is then assigned to the applicant as the trade mark is recorded in the register.

The theory underlying original acquisition is extensive and fraught with numerous theoretical disagreements. Most developed jurisdictions have, to date, postulated a method or a means of acquiring property. Most of these systems now have sophisticated sub-systems for the acquisition of different forms of property, movable Tangible property, immovable property, fisheries or intellectual property title or many other forms of property. Although the underlying theory is not apparent or necessarily intuitive when dealing with some of these forms of property.

Different legal traditions relied on different forms of acquisition of property with different conditions. In general terms, these different acquisition systems follow two routines, where such acquisition can be conditional or unconditional. Roman law, for example, has *usucapio*,⁴²³ that is the *bona fide* possession of property without title for a period of time, such as with its modern descendant *acquisitive prescription*, which forms part of most civil law jurisdictions in

⁴²² Sukhinder Panesar, 'Theories of Private Property in Modern Property Law' (2000) 15 Denning Law Journal 113.

⁴²³ Sebastian Lohsse, 'Usucapio' [2013] The Encyclopedia of Ancient History.

some form. Likewise, there is *occupation*, or the seizing of unowned or ownerless property.⁴²⁴ *Usucapio* is conditional, as it requires that the possessor ought to possess the property in good faith, for a period of time. *Occupatio*,⁴²⁵ in contrast, is unconditional, as the first occupant can seize title of the thitherto unowned property.

There has been much development in this field since the times of ancient Roman law or the *Ius Commune*,⁴²⁶ and much of the discussion centred around the propriety and persuasiveness of various methods or standards of original acquisition. Much of the discussion concerning the original acquisition of property and the various theories centred around this concept are focussed on corporeal property. In contrast with corporeal immoveable and moveable property, intellectual property rights, amongst them trade marks, are conceptually and theoretically nebulous, including in their treatment by the state. The body of theoretical writings explaining the various, sometimes competing justifications for the existence of intellectual property often compare and contrast the application of these theories in providing justifications for intellectual property rights, refuting them or otherwise discussing them.⁴²⁷

There are multiple prominent theories of original acquisition of property.

⁴²⁴ Cornelius G Van der Merwe, 'The Roman Law of Occupatio' (University of the Free State 1966) <<https://scholar.ufs.ac.za/server/api/core/bitstreams/5542f375-9854-4159-80b2-3a1e4b25360e/content>> accessed 28 June 2024.

⁴²⁵ *ibid.*

⁴²⁶ Charles Jr Donahue, 'Ius Commune, Canon Law, and Common Law in England Symposium: Relationships Among Roman Law, Common Law, and Civil Law' (1991) 66 *Tulane Law Review* 1745.

⁴²⁷ E.g. one might look at the following sources Peter Drahos, *A Philosophy of Intellectual Property* (Routledge 2016); Justin Hughes, 'The Philosophy of Intellectual Property' (1988) 77 *Georgetown Law Journal* 287; Richard A Posner, 'Intellectual Property: The Law and Economics Approach' (2005) 19 *Journal of Economic Perspectives* 57; William M Landes and Richard A Posner, *The Economic Structure of Intellectual Property Law* (Harvard University Press 2003) albeit this is a very small sample of the considerable volume of writings on the subject. It is merely to demonstrate the plurality of opinions in the area.

4.9.1 Labour Theory

Labour theory is the Lockean position that original ownership of property can come about through the admixture of labour and nature, constituting property. This theory is grounded in a natural law ordering of some nature, whether one advocated by Locke or an alternative arrangement. Locke describes a kind of commons which is cultivated with the design of furthering societal objectives, property remains a relationship between *things* and individuals who have, through their labour, acquired the aforesaid *things*.⁴²⁸

4.9.2 Occupation Theory

Occupation theory is not altogether unlike the labour theory, although it is simpler in terms of its requirements and due to the lack of a sophisticated system of commons and communal objectives. The Roman law principle of *occupation* falls under this category, as the solitary requirement of ownership is that the *thing* should not already be in the ownership of someone or something.⁴²⁹

In the context of trade mark law, the discussion about the original acquisition of trade marks does not take place at the forefront of trade mark affairs. In practical discussion of the underlying theory takes place during the legislative phase, if at all, and more often than not, the result is legislation which is implicitly predicated on one justification or another, without explicitly expounding its intricacies or even acknowledging it.

⁴²⁸ Christopher May, 'Thinking, Buying, Selling: Intellectual Property Rights in Political Economy' (1998) 3 *New Political Economy* 59.

⁴²⁹ John MacDonell, 'Occupation and Res Nullius' (1899) 1 *Journal of the Society of Comparative Legislation* 276.

While there is no explicit mention of any particular theory in most trade mark statutes, and it is absent from both the Unfair Competition Prevention Act 1993, Trademark Act 1959 and the Trade Marks Act 1994, it is possible to extrapolate from the system of acquisition the underlying theoretical principles of acquisition.

The basic definition of a trade mark under the 1994 Act is:

“In this Act “trade mark” means any sign which is capable—

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”

The definition of trade mark, therefore, requires that the subject matter should be susceptible to a clear and precise representation and definition, that it must be able to distinguish goods or services and that per TMA 1994 1(1) *“in particular [a trade mark] may consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”* A mark which satisfies this criteria will then proceed to be evaluated in the context of the Grounds for Refusal of Registration. The grounds are set out in ss.3 - 8, but the with the absolute and the relative grounds defined in ss.3 and 5 respectively. For the present thesis the grounds in s.3 are the most important, as s.3(3)(a) contains the statutory provisions regarding refusal to register on grounds of public policy and morality.

The Act states, under s.2(1) that *“A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.”* As intellectual property is incorporeal, the usual volumetric and gravimetric system of measurements are not useful in defining the boundaries of a “piece” of intellectual property. The act establishes that, in the absence of all the other qualitative requirements, at its most basic, a trade mark is a mark which has been registered in accordance with the provisions of the 1994 Act. This positive description is followed by ss.3-8.

Sections 1 and 2 have set out the broad range of registrable trade marks. The positive definition, however, takes no account of the underlying, variable state of registrations with relation to the kinds of marks which are already registered, as well as the special provisions regarding marks which are altogether exempt from the application of ss.1 and 2. The exemptions follow mainly two strains:

1, Marks which are already the property of someone, in some form, and the auxiliary right of enjoyment of such property.

2, Marks which it is considered should not be available to be owned.

Section 5 of the 1994 Act sets out the relative grounds for refusal of registration. This section puts forward the legally appropriate method for the delineation of trade mark title. It allows the reader to look at the trade mark register and ascertain whether a mark which satisfies the

criteria of s.1 is already “owned”, and to what degree it is owned and in which contexts.⁴³⁰ This is the intellectual property equivalent of a gravimetric and/or volumetric survey being carried out to determine how many m³ or barrels of salted fish or how many hL of brandy is in one’s ownership, and how much of the cargo belongs to someone else.

In contrast, s.4 sets out Specially Protected Emblems. Structurally, these emblems are trade marks, whether registered or not, otherwise it would have made no sense to exclude them expressly from registration. Examples include things such as elements of British Royal heraldry. Although these marks need not be evaluated in the same way as ordinary marks under s.5, they are still earmarked for, that is owned by, someone or something, whether that should be society, a trust, the state, or anyone else.

The last category is exemplified by the Absolute grounds for refusal of registration. Although tautological, s.3(1)(a) expressly states that:

“(1)The following shall not be registered—

(a)signs which do not satisfy the requirements of section 1(1)”

It further goes on to include categories such as marks which are devoid of distinctive character, and under ss.(3)(4), (4A), (4B), (4C) and (4D), it covers marks which are not subject to being registered due to the operation of another body of laws or legal edifice. Sections 3(4A) and (4B), for example, exclude registrability where it is prevented by the application of other laws, including treaties which the UK (3(4A)) or the EU (3(4B)) have enacted or are

⁴³⁰ *Infra* 4.10.3 on delimitation of trade marks.

party to. Plant varieties and plant breeders rights constitute a narrow and specialist system of intellectual property rights, and these rights are protected in the UK by the Plant Varieties Act 1997 and at the community level by the Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights. Sections 3(4C) and 3(4D) explicitly acknowledge that the subject-matter of the 1994 Act does not include or overlap with the subject-matter of the UK and EU body of plant varieties.

It is apparent from the above categories that subject-matter can be exempt from original acquisition on the grounds of being already owned, or the risk of interference with the conventional trade mark ownership of another. On the grounds of some alternative form of possession or ownership, such as by the UK state or the British Royal Family in a quasi-trade mark capacity, *sans* numerous administrative elements of trade marks, such as registration, renewal, alienation, etc. Furthermore, on the basis that the subject-matter is already covered by a more appropriate system with its own rules of original acquisition, which acknowledges that different forms and types of property warrant different rules of original acquisition.

In this context, the concept of ‘original acquisition’ means acquisition other than by way of alienation of trade mark title or other transference of a right. The distinction is important in the Japanese cases where the courts are at liberty to choose the transfer of title or expunction from the trade mark register, such as litigation akin to McDonald’s,⁴³¹ where trade marks are legitimately registered, albeit under unfair circumstances.

Distinction based on such unfair circumstances is a feature of the moral principles

⁴³¹ John Whitney Hall, ‘Feudalism in Japan — a Reassessment’ (1962) 5 *Comparative Studies in Society and History* 15.

influencing the procedural elements of trade mark acquisition. The relevant area of Japanese law is unfair competition law, governed by the Unfair Competition Prevent Act 1993.

It expressly governs trade marks, but the 1993 Act does not delve into matters of substantive trade mark law. In the *McDonald's litigation*,⁴³² McDonald's was contesting the validity and propriety of a local partner's technically legitimate trade mark registration in Japan of some elements of McDonald's trade mark portfolio. As the trade marks were formally valid, McDonald's had no substantive remedy.

Following lengthy litigation, a remedy was eventually fashioned under the provisions of the UCPA 1993. The Japanese court had elected to transfer title to McDonald's, rather than substantively interfere in the operation of the trade mark registration system under the Trademark Act 1959.

The original acquisition - generally registration - of trade marks cannot be completely divorced from their use in the context of the market. Structurally, in most trade mark regimes, the relative grounds for refusal are semantically also the grounds on which a trade mark is infringed.⁴³³ There is horizontal competition between competing registrations, in the context of relative grounds, as the discussion turns on whether there is a degree of impermissible similarity⁴³⁴ and likelihood of confusion.⁴³⁵ The theoretical difference between the two categories of issue is that under the relative grounds of refusal, the reason for

⁴³² *McDonald's v Mac Sangyo KK* 13 *Shonwa* 56 (n 174).

⁴³³ Trade Marks Act 1994 ss 5 & 17.

⁴³⁴ *ibid* 5(2)(b) & 17(2).

⁴³⁵ *ibid* 5(2)(b) Confusion is not directly referenced in s.17(2).

disallowing a registration is that by registering the pertinent mark, the proprietary right encapsulated by the new registration would interfere with the proprietary right within the senior mark. In contrast, an offensive trade mark is liable to harm society in the context of public policy and morality. In practice, however, it is a pragmatic and powerful litigation strategy to target the validity of an opposing litigant's mark, such as to defeat a claim of infringement.

The linguistic, cultural and paradigmatic considerations of comparative law exacerbate the epistemological and semantic constraints already heavily imposed by the aforesaid definitions.⁴³⁶ Art.4(1)(vii) of the Trademark Act 1959 states that a trade mark should not be registered if it is "likely to cause damage to public policy". There is no definitive and static definition of what is meant by public policy, nor was there likely intended to be one, to provide a measure of legal flexibility, as is often the case with such provisions in intellectual property legislation. The principle is best exemplified by the American case of *Jacobellis v Ohio*,⁴³⁷ where Justice Potter Stewart famously stated that "*I shall not today attempt further to define the kinds of [obscene] material I understand to be embraced within that shorthand description; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it...*"

The trade mark provisions on public policy and morality engender uncertainty which can only be ameliorated and dispelled with reference to the prevailing mores within society and the prevailing public policy at the time. Accordingly, to truly understand the applicable law at any given time, the observer has to possess contextual awareness of the prevailing mores

⁴³⁶ Dan M Kahan and Donald Braman, 'Cultural Cognition and Public Policy Essay' (2006) 24 Yale Law & Policy Review 149.

⁴³⁷ *Jacobellis v Ohio* 378 US 184 (1964).

and policy objectives in the respective society, be it Japan or the UK. In a conceptual sense, an understanding of the relevant law on trade mark registration is incomplete without such contextual knowledge. This is intrinsically related, also, to the mercurial, ever-changing nature of social mores and policy objectives.⁴³⁸ One has to reason about mores and policy objectives with reference to a certain time within a chronology, after all.

⁴³⁸ *Infra* 4.12

4.10 *The Role of Reification and Use in Survey Evidence*

4.10.1 **Reification**

The reification of intellectual property is a natural consequence of the operation of economies and commerce. Consumer loyalty and confidence makes goodwill a valuable entity, and inevitably a tool of both lawful and illegal competition. While trade marks are property rights, which afford the proprietor an exclusionary right to use the subject-matter, that right can be used to accumulate goodwill, to the proprietor's benefit. In a modern economy, a trade mark can be used to boost revenues and, if violated, to diminish them.⁴³⁹ It is necessary to be able to ascertain the value of a trade mark in order to ascertain the value it adds to the undertaking or patrimony of the proprietor, as well as the monetary extent of damages in the event of wrongdoing.

Historically, the law of passing-off fulfilled a similar role to modern trade marks, in that it was developed to prevent free-riding by competitors. However, passing-off is not a property right, unlike trade marks. It is not capable of conferring a property right, and it merely prevents the passing-off of goods as those belonging to the aggrieved party. Because passing-off is not a property right, it cannot be disposed of in the way property rights can. For example, trade marks can be used as security to obtain a commercial loan. In contrast, passing-off is not capable of such.

The problem with the reification of intellectual property is not specific to trade marks, but it is something shared with all intellectual property rights. An intellectual property right is a

⁴³⁹ Philipp Sandner, 'The Market Value of R&D, Patents, and Trademarks' in Philipp Sandner (ed), *The Valuation of Intangible Assets: An Exploration of Patent and Trademark Portfolios* (Gabler 2010).

'bundle of sticks' in contrast with conventional corporeal property, although similarities do exist.⁴⁴⁰ They are also negative and prohibitive in nature. An intellectual property right does not empower the owner of the title to do anything other than to transfer title. Possession of the title merely prohibits the use of the protected subject matter other than by the or with the permission of the proprietor.

Intellectual property can best be seen as a set of legal prohibitions not to treat the protected subject-matter in particular ways. The specific prohibitions can be disapplied by the proprietor to the extent desired, causing the fragmentation of rights.⁴⁴¹ Fundamentally, IP is not like corporeal property, however it may still be treated as property, as evidenced by modern intellectual property regimes. It is perhaps better to think of the treatment of intellectual property as commodification, rather than reification. Whether intellectual property is formally recognised as property properly so-called is of far less importance than whether it is commodified and used as a commercially relevant entity, capable of being bought, sold, used as security, licenced and so on.⁴⁴²

This commodification is only a significant problem when viewing intellectual property through the utilitarian justification, because there is arguably little utilitarian justification for the heightened reification of intellectual property rights to fulfil commercial and corporate demands, beyond serving as mere incentive to engage in societally beneficial behaviour. This is a less prominent problem with trade marks than in the case of copyright, where there has

⁴⁴⁰ Jane B Baron, 'Rescuing the Bundle-of-Rights Metaphor in Property Law' (2013) 82 University of Cincinnati Law Review 57.

⁴⁴¹ Tom W Bell, 'Copyright as Intellectual Property Privilege Symposium: Creators v. Consumers: The Rhetoric, Reality and Reformation of Intellectual Property Law and Policy' (2007) 58 Syracuse Law Review 523.

⁴⁴² Benjamin Coriat and Olivier Weinstein, 'Intellectual Property Right Regimes, Firms and the Commodification of Knowledge' (29 July 2009).

been a marked increase of the copyright term over the past decades, well beyond what is a mere incentive.

Trade marks have the intrinsic ability to survive in perpetuity. However, the transfer of trade marks can be difficult to justify on utilitarian grounds, because of the potential for confusion and deception in the event of the transfer of a trade mark from one business to another. For example, it is easy to see how transferring the P.E.T.A. trade mark to Tyson Foods, one of the largest meat producers worldwide, might lead to undesired confusion on part of the consumers of P.E.T.A. merchandise. There are situations where consumers are not likely to be so aggrieved, such as with relation to slight qualitative issues, but such confusion is liable to create normative issues as well, such as the hypothetical example above, which can result in severe normative and moral crises for consumers.

In contrast with the UK, Japan does not have a history of passing-off. The Japanese trade mark regime evolved with a decidedly Germanic influence, and so the system never afforded much protection to unregistered marks, albeit they are afforded some protection under the UCPA.⁴⁴³ While there are certain countermeasures to protect the goodwill of an undertaking which uses a mark without registration, such protection is primarily aimed at large overseas undertakings, such as McDonald's,⁴⁴⁴ to ensure that trade marks are protected from the depredations of trade mark trolls within Japan, in the intervening period when their marks are not yet registered within the Japanese trade mark regime.

⁴⁴³ *Supra* 3.5.3

⁴⁴⁴ *McDonald's v Mac Sangyo KK 13 Shouwa 56* (n 174).

4.10.2 Delimitation of Intellectual Property

The United States operates a use-based system of trade mark registration, and Port, as he is writing, primarily, to an American readership, from the perspective of an American lawyer, is clear in explaining the fundamental differences between US and Japanese trade mark law. One of these differences is that the Japanese trade mark system is rights (権利主義 - *Kenrisbugi*) and registration based (登録主義 - *Tourokushugi*).⁴⁴⁵

Port likens the registration component of the Japanese trade mark regime to American patent registration, more so than to American trade mark registration, albeit only to the extent that original acquisition of *rem* is carried out through only a registration process.⁴⁴⁶

The registration system is intended to ascertain the boundaries of a trade mark right. One of the implicit tasks of the absolute and relative grounds for refusal is to determine whether the subject of a trade mark application is the right kind of subject-matter and to identify the intellectual and conceptual boundaries of the right.

In a trade mark regime, it is necessary to have a method or system of reasoning about trade marks and trade mark rights. In the case of T^{angible} property, one can reason about it based on volumetric, gravimetric or geographic properties. One might purchase a litre of vinegar, 100g of fenugreek or 30 km² of land.⁴⁴⁷

⁴⁴⁵ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 27.

⁴⁴⁶ *ibid.*

⁴⁴⁷ Wendy J Gordon, 'Intellectual Property' in Mark Tushnet and Peter Cane (eds), *The Oxford Handbook of Legal Studies* (Oxford University Press 2005) <<https://doi.org/10.1093/oxfordhb/9780199248179.013.0028>> accessed 24 June 2024.

The means of delimitation are different, but intellectual property must be delimited, in much the same way as other property, to allow people to make reasoned decisions about how to interact with it.⁴⁴⁸

4.10.3 Delimitation of Trade Marks

Instead of the aforesaid measurements, trade marks are delimited through semantics and semiotics.⁴⁴⁹ For a trade mark to serve its purpose as a semiotic implement, it is necessary for the mark to be perceived and comprehended in conjunction with the contextual information which certain consumers possess about a particular trade mark. If both of these co-occur, the consumer is able to ascertain, for example, that the stylised Golden Arches belong to McDonald's, and that they represent a particular thing, such as a particular culinary experience in the case of McDonald's.

Accordingly, to delimit trade marks, it is necessary to consider not only the intrinsic characteristics of a trade mark, as with absolute grounds, but also the manner in which a trade mark is perceived and understood by consumers. Because trade marks are semiotic implements,⁴⁵⁰ at times the proprietary boundaries of trade marks can only be understood with reference to both the trade mark register and the perceptions of consumers.

Port discusses this in a comparison of the *likelihood of confusion* in the US and Japan.⁴⁵¹ In the US, the matter of the likelihood of confusion is an entirely empirical matter. The likelihood

⁴⁴⁸ Paul Manning, 'The Semiotics of Brand' (2010) 39 Annual Review of Anthropology 33, 37.

⁴⁴⁹ Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2003) 51 UCLA L. rev. 621.

⁴⁵⁰ *ibid.*

⁴⁵¹ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 114.

of confusion is inseparable from subjective perceptions of consumers. In the absence of survey or jury evidence, a judge or examiner must use deduction to reason about consumer knowledge and perceptions.⁴⁵² This is very similar to the relative grounds and confusion under s.5(2) and s.10(2) of the 1994 Act⁴⁵³ and the related case law on assessing identity/similarity.⁴⁵⁴

Using empirical methods, such as survey evidence, can allow one to reason about the proprietary boundaries with the help of empirical information about consumer perceptions. However, it would not be practicable to consult every consumer within a geographic locality, on every occasion, which warrants trade mark delimitation. Additionally, survey evidence is prone to issues generally seen in statistical evidence, such as sampling issues or non-representative samples.⁴⁵⁵

To carry out delimitation, such as with relation to infringement or the relative grounds, trade mark regimes use heuristic methods, which are either inductive or deductive in nature. Deductive methods are heuristic.

For example, the relative grounds are *good enough* to ascertain whether the marks are sufficiently similar or identical, and whether there is a likelihood of confusion. However, conceptually, there can be no certitude regarding that assessment, other than through consulting every consumer.

⁴⁵² *ibid.*

⁴⁵³ Trade Marks Act 1994.

⁴⁵⁴ E.g. *Case C-39/97 - Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* [1999] ETMR 1; *Case C-251/95 - SABEL v Puma, Rudolf Dassler Sport* [1998] ETMR 1; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159.

⁴⁵⁵ E Deborah Jay, 'He Who Steals My Good Name: Likelihood-of-Confusion Surveys in TTAB Proceedings' (2014) 104 *The Trademark Reporter* 1141.

Understandably, at the registration stage the examiners look at the relative grounds and a predictive assessment of the likelihood of confusion, but even in the event of infringement, looking at s.10, it is not practicable to consult every consumer. In this way, survey evidence, too, is merely a heuristic - an assessment which is true only by approximation through a process of inferential statistics.⁴⁵⁶ One has to extrapolate from a limited dataset and derive an overarching, heuristic conclusion, such as, for example, that consumers are or are not confused.

Both the UK and Japanese trade mark regimes generally resort to the deductive methods of delimitation of trade marks, e.g. the aforesaid relative grounds and infringement.

The primary deductive means of delimitation is with reference to a register of trade marks, as with the registers in the UK⁴⁵⁷ or Japan.⁴⁵⁸ A reference to an entry in such a register can inform the reader, for example, that the Golden Arches are registered by McDonald's. The reader can carry out the delimitation of the property on this basis, with reference to the trade mark laws - principally the absolute and relative grounds.

As stated above, at times it is necessary to reason about, for example, the likelihood of confusion. However, this is often carried out deductively based on the relative grounds and provisions for infringement. The possibility of using survey evidence exists, but it is not the

⁴⁵⁶ Katarzyna Stapor, 'Descriptive and Inferential Statistics' in Katarzyna Stapor (ed), *Introduction to Probabilistic and Statistical Methods with Examples in R* (Springer International Publishing 2020) 65 <https://doi.org/10.1007/978-3-030-45799-0_2> accessed 25 June 2024.

⁴⁵⁷ 'Search for a Trade Mark - Intellectual Property Office' (n 62).

⁴⁵⁸ 'Trademark Search | J-PlatPat [JPP]' <<https://www.j-platpat.inpit.go.jp/t0100>> accessed 25 June 2024.

default mechanism, in the UK⁴⁵⁹ or Japan,⁴⁶⁰ to determine whether the mark is unregistrable or the use infringing. It was stated in the case of *Interflora* that:

*“In cases involving an assessment of ordinary consumer goods and services, the trial judge could reach a conclusion which was based on his own experience and without the need for evidence from consumers. Internet keywords relating to such ordinary consumer goods and services were the same as those goods and services for the purposes of such assessment.”*⁴⁶¹

In a registration based system, examination and litigation need not focus so much on empirical evidence of trade mark use. Much of the requisite information is available in the registry, which, as a system of recording the life cycles of trade marks, provides information about the date of original acquisition to the date of, for example, removal from the register due to invalidity, per s.47 1994, or foregoing renewal, where such has occurred.

The trade mark register engenders a high level of determinacy, and it is rarely necessary to rely on inductive methods, such as survey evidence to be able to accurately reason about the validity of a trade mark. There are circumstances where such inductive methods are appropriate, such as, for example, when the validity of a mark is contested, and the register is not infallible - there is merely a rebuttable presumption of its rectitude, which can be challenged, for example, under s.47 1994 or Art.46 1959.

⁴⁵⁹ ‘The Value and Treatment of Survey Evidence in Different Jurisdictions’ (2010) 100 *The Trademark Reporter* 1373, 1380.

⁴⁶⁰ John A Tessensohn, ‘Orange Is the New Black—IP High Court of Japan and Single Colour Trade Marks’ (2021) 16 *Journal of Intellectual Property Law & Practice* 974, 983.

⁴⁶¹ *Case C-323/09 Interflora Inc v Marks & Spencer Plc* [2013] *ETMR* 11 (2012) [H7].

Similarity, identity and confusion, or the likelihood thereof, are central to the relative grounds. Confusion or the likelihood of confusion can be reasoned about with reference to survey evidence, to ascertain how likely confusion is or whether it has occurred, such as at the infringement stage. However, trade mark examiners and judges have methods of determining whether confusion is likely to or it has, in fact, resulted. For example, the global appreciation test described in *Sabel BV v Puma AG*⁴⁶² is the premiere deductive tool to this end.

Such rules enable examiners and judges to, heuristically, reason about similarity, identity and confusion in a deductive way, by comparatively assessing the characteristics of prior and subsequent marks. In registration based systems this is, by approximation, a sufficiently accurate way of determining whether there is a likelihood of or actual confusion.

4.10.4 Treatment of Survey Evidence

There are differences in the treatment of survey evidence, depending on the ends to which it is gathered. A case challenging the validity of a trade mark on the basis of genericide⁴⁶³ is different from a case about infringement proceedings concerned with similarity.

In the latter example, the judge can reason about and delimit the boundaries of the marks with the use of the aforesaid deductive process in conjunction with the trade mark registration in the register. However, in the example of genericide, the mark is formally valid and any challenge to its validity is based on an argument which is testable only with reference

⁴⁶² *Case C-251/95 - SABEL v Puma, Rudolf Dassler Sport [1998] E.T.M.R. 1* (n 454).

⁴⁶³ John Dwight Ingram, 'The Genericide of Trademarks' (2003) 2 Buffalo Intellectual Property Law Journal 154.

to an empirical measurement regarding the perceptions of consumers. However, such empirical measurements can be reasoned about deductively with reference to, for example, dictionaries, newspapers and magazines.⁴⁶⁴

Both the UK and Japanese trade mark regimes permit survey evidence. However, the judiciary, in both Japan⁴⁶⁵ and the UK,⁴⁶⁶ is cautious and exacting in the use of such evidence. This means that the survey has to be carried out in a specific fashion and in conformity with certain requirements. Some of these requirements, for example, were articulated, in the UK, in the passing-off case *Imperial Group v Philip Morris*⁴⁶⁷, which sets them out as follows:

*"If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (g) the exact answers and not some abbreviated form must be recorded, (h) the instructions to the interviewers as to how to carry out the survey must be disclosed and (i) where the answers are coded for computer input, the coding instructions must be disclosed."*⁴⁶⁸

⁴⁶⁴ Neal A Hoopes, 'Reclaiming the Primary Significance Test: Dictionaries, Corpus Linguistics, and Trademark Genericide' (2018) 54 *Tulsa Law Review* 407, 409.

⁴⁶⁵ Tessensohn (n 460) 983.

⁴⁶⁶ 'The Value and Treatment of Survey Evidence in Different Jurisdictions' (n 459) 1380.

⁴⁶⁷ *Imperial Group plc & Another v Philip Morris Limited & Another* [1984] RPC 293.

⁴⁶⁸ *ibid* 5.

In *O2 Holdings Ltd v Hutchison 3G*,⁴⁶⁹ the High Court held that prior permission is required to undertake a survey, if it is to be admissible. Subsequent case law has⁴⁷⁰ confirmed this approach. Furthermore, s.35.4(1) of The Civil Procedure Rules 1998 states that "*No party may call an expert or put in evidence an expert's report without the court's permission.*"⁴⁷¹

Japanese courts have historically been strict with survey evidence, rejecting almost all survey evidence which parties sought to adduce. The reason for the high complete rejection of survey evidence has been the perception of the courts that surveys are intrinsically undertaken with a view to serving one's own strategic purposes in litigation, by producing a favourable response. The approach of blanket rejection has changed and surveys are now considered to be acceptable, in principle, albeit still subject to considerable scrutiny.⁴⁷²

The Examination Manual of the JPO recommends survey evidence as particularly suitable for certain tasks, such as assessing whether a trade mark is well-known. However, the Manual reiterates that "due consideration must be paid to the objectivity of who conducted the surveys, how the surveys were conducted and among whom the surveys were conducted."⁴⁷³

Tessensohn states the following regarding secondary meaning:

"...the respondent population has to be correctly chosen and right-sized in proportion to the market conditions;

⁴⁶⁹ *Case C-533/06 O2 Holdings Ltd v Hutchison 3G UK Ltd* [2008] ETMR 55.

⁴⁷⁰ *UK Channel Management Ltd v E! Entertainment Television Inc* [2008] FSR 5.

⁴⁷¹ The Civil Procedure Rules 1998, no. 3132.

⁴⁷² INTA, 'Report on Best Practices in Conducting Surveys in Trademark Matters' (International Trademark Association) 89

<<https://web.archive.org/web/20140406215212/http://www.inta.org/PDF%20Library/INTA%20Report%20on%20Best%20Practices%20in%20Conducting%20Surveys%20in%20Trademark%20Matters.pdf>> accessed 3 June 2024 This report is difficult to access as it is no longer available through the INTA website. However, it is available through the Wayback Machine, an archive of websites supplied by the Internet Archive. For this reason, the url refers to the document as it appears in the archived version of the INTA website.

⁴⁷³ 'Examination Guidelines for Trademarks | Japan Patent Office' (n 219) arts 7-2(1).

the chosen sample should be representative of that respondent population; the data gathered should be accurately recorded and reported; the data was analysed in accordance with accepted statistical principles; the survey questions should be simple to understand, clear, unambiguous and not leading; the survey should be professionally conducted following proper interview and surveying procedures, controls and protocols; and the entire surveying process should be conducted so as to ensure objectivity, eg eliminate bias, reduce prejudice, maintain neutrality, retain impartiality and the like."⁴⁷⁴

⁴⁷⁴ John A. Tessensohn (n 239) 985.

4.11 *The Degree of Convergence, Divergence & Functional Equivalency as between UK and Japanese Trade Mark Law*

Criteria for convergence

It is vital to establish criteria which must be checked for instances of convergence or divergence. One of the principal hurdles of comparative law is the difficulty of ascertaining whether, based on the evidence available, whether the features of legal systems, or legal systems themselves are convergent or divergent. In this assessment, the comparatist has to look beyond the superficial trappings of the elements of legal systems, and conduct in-depth analysis to ascertain what those elements truly are. It does not matter, for example, whether an element is called antitrust law, competition law or 独占禁止法 (*dokusen-kinshibou*) as these things are functionally the same.

To ascertain whether two or more things are the same, the thesis is going to employ the functional method of comparative law to test whether, functionally, subjects of comparison are convergent in terms of the functions they serve in their respective legal systems.

Criteria for divergence

The assessment for divergence is merely the opposite of the assessment for convergence. E.g. a case for passing-off and a case for trade mark infringement can have identical outcomes, in the sense that a court may order the infringement or misrepresentation to stop, but passing-off and trade mark infringement have structural differences which yield different outcomes, such as in terms of what the actions protect, whether they involve property rights or whether there is a need to re-litigate in every instance.

In summary, passing-off and trade mark infringement have similarities, but they are not completely convergent in all of their outcomes, albeit they can both, under some circumstances, be used to stop the depredations of a freerider.

4.12 *Public Interest, Public Policy and Morality*

Public policy and morality are easy to identify but much harder to define. One can readily identify the operation of these phenomena in a legal judgement, often because they are expressly or implicitly referred to. However, defining the precise ambit of public policy and morality is difficult. Public policy might be described as the opposite and antithesis of private interest, whereas morality can be defined as a prescriptive, normative system for the normative appraisal and regulation of human behaviour. Public policy, in turn, reflects the prevailing policy objectives of the governing policy which are, at least nominally, derived from that which is in the public interest. Although these definitions do not comprehensively and complete describe these concepts, they offer a starting point for discussion.

4.12.1 **A Definition of Public Interest**

Public interest is simply that which is in the interest of the public. Although this definition is simple, determining what is in the public interest is difficult, not least because actors within society often have incompatible and conflicting opinions about whether something is in or contrary to the public interest.

Structurally, public interest can be distinguished from private interest, but this distinction does not give rise to a clear dichotomy - something which is in the public interest is not necessarily contrary to private interests and *vice versa*. The public interest is, therefore, the interest of broader society and, as there is no clear dichotomy, public and private interest

often coincide.⁴⁷⁵

Public policy at the state or political level is not the focus of this work. Public policy is interesting in the context of its interaction with the absolute grounds. However, while a broader discussion of policy is outside of the scope of this work, it is valuable to include a brief discussion of policy.

4.12.2 A Definition of Public Policy

Public Policy is a set of aims, objectives, and plans which are devised in furtherance and protection of a perceived interest or body of interests. Public policy is generally established with reference to what is in the public interest, other than in the unlikely case that a society wishes not to act in its own interests. However, while public policy is hoped to exhibit positive characteristics, it need not do so.⁴⁷⁶

Public policy is a more refined and narrower range of objectives. It is in the interests of a society to generate wealth or improve the life expectancy of any number of other things considered beneficial. However, these are not policies - a policy is a concrete plan to bring about such benefits. There are more philosophical discussions of public interest and public policy, with the aim of defining what public interest is and what is in the public interest.⁴⁷⁷ However, such philosophical discussions are beyond the scope of this writing. For the present purposes, it is sufficient that something is identified as public policy, whether

⁴⁷⁵ James Plunkett, 'Principle and Policy in Private Law Reasoning' (2016) 75 *The Cambridge Law Journal* 366, 372.

⁴⁷⁶ Michael Howlett and Ben Cashore, 'Conceptualizing Public Policy' in Isabelle Engeli and Christine Rothmayr Allison (eds), *Comparative Policy Studies: Conceptual and Methodological Challenges* (Palgrave Macmillan UK 2014) 17.

⁴⁷⁷ Theodore M Benditt, 'The Public Interest' (1973) 2 *Philosophy & Public Affairs* 291.

explicitly or implicitly, by the courts.

4.12.3 A Definition of Morality

Morality, in turn, is a normative body of prescriptions, proscriptions, and permissions.

While a moral system need not necessarily have the means to compel people to behave in particular ways, it is, nevertheless, a system which allows people to reason about the normative and moral rightness or wrongness of actions, omissions, states of affairs and other things.

Morality is intertwined with public policy and public interest. The pursuit of public interest is generally described as a moral pursuit, and societies tend to identify the promotion of their interests as morally right. There are multiple proposed sources of morality, and society or social norms feature amongst them⁴⁷⁸ The philosophical discussion of the sources of morality is fascinating, but it is beyond the scope of this work.

Morality is not the same as public interest. There is no opportunity for a more involved discussion of the circumstances where morality and public interest diverge, such as where the public interest is served, through public policy, in immoral ways, but such instances can theoretically exist.⁴⁷⁹

⁴⁷⁸ Paul Bloom, 'Moral Nativism and Moral Psychology.', *The social psychology of morality: Exploring the causes of good and evil*. (American Psychological Association 2012).

⁴⁷⁹ Howard Elcock, 'Ethics and the Public Interest: A Question of Morality' (2012) 30 *Teaching Public Administration* 115.

4.12.4 Japanese Cases of Practical Morality

An application which is contrary to morality is something which, it is expected, invokes a sense of “wrongness” in a non-trivial sized segment of society. In contrast, in Japan, it is possible for the term to mean such a normative “wrongness”, but⁴⁸⁰ also a less emotionally evocative response to an attempt to gain an unfair advantage by precluding competitors from using common, descriptive words such as *lawyer*, *grocery* or other such terms. It makes no implicit or explicit reference to an emotionally evocative concept or historic experience, but there is a level of moral impropriety intrinsic to it which indicates that an award of a trade mark right would not be appropriate, as demonstrated in the *Doctor of Patent Architecture* case.⁴⁸¹

The Patent Architecture case involved registrations for marks such as DOCTOR OF PATENT ARCHITECTURE or DOCTOR OF PATENT ECONOMICS. These marks are not inherently immoral, however, cases can be brought for being contrary to morals for two reasons.

The present case involved procedural impropriety. The registration of the marks applied for would obstruct other businesses in a way and to an extent not intended by the statutory trade mark regime, and the Japanese courts are able and willing to invalidate the registrations where necessary to protect trade marks more widely as a paradigm as well as protecting consumers from deception and confusion and competitors from undue obstruction. Preventing

⁴⁸⁰ Kim (n 224).

⁴⁸¹*Doctor of Patent Architecture* 13 Mutai Zaisan Hanreishuu 608 (Tokyo High Court); Port, ‘Trademark Dilution in Japan’ (n 264); ,

competitors from using common descriptive words to describe their goods and services is not an accepted form of competition.

The UK understanding of “contrary to morality” does not encompass the totality of what the equivalent term means in the context of the Japanese legal system. There might not have been any bad faith on part of the applications in the *Doctor of Patent Architecture* case, and the registrations are not substantively immoral or inflammatory, yet it would be morally inappropriate to grant a monopolistic right, in this scenario. Very likely, in the UK this matter might have been dealt with under generic marks which are lacking in distinctiveness.⁴⁸² E.g. s.3(1)(c) still encapsulates a moral principle which featured in the enactment of this provision, but unlike the decisions under s.3(3)(a), this moral dimension is implicit rather than explicit.

Likewise, “precedent” in the context of the Japanese legal system does describe a kind of deference on the basis of the hierarchy of the courts,⁴⁸³ but it does not encompass the paradigm of *stare decisis*, which in the United Kingdom represents a formal, prescriptive system, rather than a descriptive account of an informal, tacit practice.⁴⁸⁴

The *Nutrition Controlist*⁴⁸⁵ case is one decided in the same vein as the *Patent Architecture*⁴⁸⁶ case. The registration of KANRI EIYOSHI, meaning NUTRITION CONTROLIST, was sought in this case. This mark is very similar to KANRI SHOKUYOUSHI, which is the official Japanese designation and title of a nutritionist. It was recognised that the purpose of the

⁴⁸² *Infra* 4.6

⁴⁸³ Itoh (n 327).

⁴⁸⁴ Frank Emmert, ‘Stare Decisis: A Universally Misunderstood Idea’ (2012) 6 *Legisprudence* 207.

⁴⁸⁵ *Nutrition Controlist’ Kyoukai v Imai* [2004] Han-Ji Issue 1846 (Tokyo High Court).

⁴⁸⁶ *Doctor of Patent Architecture* (n 481).

registration was to derive an advantage through obstructing the use of customary and legitimate designations and titles within an industry, and while nothing about NUTRITION CONTROLIST is offensive, the registration itself is contrary to public morality.

This category is filed under morality and public policy, but the examples point to a pragmatic underlying principle which is set forth using mildly moral language. Indeed, much of Japanese law on the topic is focused on bad faith more so than normativity.

4.12.5 Public Interest, Policy and Morality in a Trade Mark Context

The three titular entities sometimes coincide and occur in the context of trade mark registration due to the operation of the absolute grounds. Trade mark systems generally provide for some means of refusing registration to applications for marks which are considered repugnant or inflammatory. Japan⁴⁸⁷ and the United Kingdom⁴⁸⁸ are not exceptions to this arrangement, and there is a considerable volume of case law originating from these countries which is decided on the basis of, or at least makes reference to, these concepts.

Although they occur in the same conceptual space, these entities play distinct roles. As already discussed, Art.4(1)(vii) of the Japanese Trademark Act 1959 provides for refusal on the grounds that a mark is contrary to public policy, whereas its UK counterpart, s.3(3)(a) of the Trade Marks Act 1994 provides grounds to refuse marks on grounds of public policy as well as "accepted principles of morality." In practice, Japanese trade mark

⁴⁸⁷ Trademarks Act 1959 art 4(1)(vii).

⁴⁸⁸ Trade Marks Act 1994 s 3(3)(a).

examiners and courts implicitly incorporate morality into this definition. The JPO

Examination Manual states that the following marks are not registrable:

*“Trademarks which are, in composition per se, characters or figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds that are unethical, obscene, discriminative, outrageous, or unpleasant to people.”*⁴⁸⁹

*Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith.”*⁴⁹⁰

Public policy and morality can be identified in some cases, but it is difficult to clearly delineate and quantify the extent to which some decisions are made on the basis of the one or the other, and it is unlikely that courts would have reasoned about the matter with such mathematical precision prior to rendering judgment.

There are some conceptual and practical differences between the cases. Public policy and morality emerge clearly in the context of cases like *Seirogan*⁴⁹¹ or *Nutrition Controlist*⁴⁹² which are intrinsically concerned with the propriety of registration. However, public policy and morality also emerge in other cases relating to the proprietorship of trade marks.

⁴⁸⁹ ‘Examination Guidelines for Trademarks | Japan Patent Office’ (n 219) Part III Chapter 6: Article 4(1)(vii).

⁴⁹⁰ *ibid* Part III Chapter 6: Article 4(1)(vii).

⁴⁹¹ Kim (n 224).

⁴⁹² *Nutrition Controlist’ Kyoukai v Imai* (n 485).

In cases concerning proprietorship, the principles of public interest, policy, and morality manifest as a result of the broader operation of the legal system. Whether a trade mark right vests in one potential proprietor or another is not necessarily a trade mark issue. If a trade mark right is transferred to another proprietor, as seen in cases like *McDonald's*,⁴⁹³ because of the impropriety of registration, that is a broader issue of policy and proprietorship.

This is congruous with the Dworkinian conception of law, which is an ecosystem where rules and principles coexist.⁴⁹⁴

4.12.6 Proprietorship Cases Decided Based on Public Policy

Cases like *McDonald's*⁴⁹⁵ or *Tarzan*⁴⁹⁶ are decided principally on the basis of public policy. While it may be argued that there is a moral dimension in protecting the interests of the overseas undertaking, this is not a compelling argument. Such expropriation and forcible transfer of title is only carried out with relation to marks which are very prominent.⁴⁹⁷ Unless there is some prevailing moral good in protecting large undertakings, it seems more logical to think of these decisions as implementing public policy.

4.12.7 Proprietorship Cases Decided Based on International Truthfulness

This is in contrast with cases like *Ducerum*⁴⁹⁸ which was decided with reference to and on

⁴⁹³ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252).

⁴⁹⁴ Dworkin (n 326) 38.

⁴⁹⁵ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252).

⁴⁹⁶ *Tarzan Heisei 23 (gyo-ke) 10399 2012* (n 226).

⁴⁹⁷ *McDonald's v. Mac Sangyo Han-Ji Issue 1020* (n 252).

⁴⁹⁸ *Taishin Trading KK v Ducera Dental* (n 230).

the basis of International Truthfulness. There might be a policy objective in instating a system of comity which overrides, at times, the territoriality of trade marks.⁴⁹⁹ However, International Truthfulness is ostensibly a normative principle.

4.12.8 Absolute Grounds Cases Decided Based on Trade Mark Provisions

The third category consists of decisions that relate to the intrinsic characteristics of the trade marks. This is a satisfactory definition, albeit cases like *Oomphies*⁵⁰⁰ or *Seirogan*, also make reference to the prevailing mores within society, which are mercurial. These cases are decided explicitly based on the public policy/morality provisions of absolute grounds, which serve as codified variants of the principles which they hearken back to - they are rules with binary applicability.

4.12.9 Trade Mark Purpose, Objective & Effect

Trade marks, as a category of property or quasi-property right have both objective and effect. The objective of trade marks is to afford an exclusionary legal monopoly to the proprietor. Cases such as *Arsenal v Reed*⁵⁰¹ and *L'Oreal v Bellure*⁵⁰² discuss the various trade mark functions, including the primary origin function. It is possible to extrapolate from this the intended objectives, e.g. to provide utility and benefit to the proprietor in terms in terms of

⁴⁹⁹ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 109.

⁵⁰⁰ *La Marquise Footwear Inc.'s Application* (n 113).

⁵⁰¹ *Case C-206/01 Arsenal Football Club plc v Matthew Reed* [2003] ETMR 19.

⁵⁰² *Case C-487/07 L'Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v Bellure NV, Malaiika Investments Ltd and Starion International Ltd* [2009] ETMR 55.

e.g. origins, quality, investment and so on. The effect of a trade mark is to prevent free-riding, which is the main source of the value of this exclusionary right.⁵⁰³

Frequently, the objective of a trade mark regime or policy will be cast in the context of bolstering the domestic economy or securing some form of economic benefit within and for the purposes of a state. The Japan Revitalization Strategy,⁵⁰⁴ for example, is a policy document which is geared towards reversing the trend of stagnation in the context of economic growth. These perceived benefits are often somewhat nebulous.⁵⁰⁵

A legal restriction, such as the exclusionary power of trade marks, is detrimental without a purpose. If a restriction serves no purpose, then it hinders without a resulting benefit.

This means that trade marks are instrumental in the sense that the solitary reason for their existence is to achieve, attain or obtain a particular, practical benefit. In a sense, intellectual property is a form of legal fictionalism.⁵⁰⁶ It can be a useful abstraction, to the extent that it produces a practical benefit.⁵⁰⁷

A set of powerful protections for trade marks is beneficial to importers, because it affords their brands and branded products a strong legal monopoly power, but it could very well be to the detriment of domestic undertakings whose branding and merchandising operations

⁵⁰³. Annette Kur, 'Trademark Functions in European Union Law' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020).

⁵⁰⁴. Government of Japan, 'Japan Revitalization Strategy' (Government of Japan 2014) <<https://www.kantei.go.jp/jp/singi/keizaisaisei/pdf/honbunEN.pdf>> accessed 28 June 2024.

⁵⁰⁵. Mark P McKenna, 'The Normative Foundations of Trademark Law' (2006) 82 *Notre Dame Law Review* 1839.

⁵⁰⁶ Drahos (n 427).

⁵⁰⁷ Kenneth Einar Himma, 'The Justification of Intellectual Property: Contemporary Philosophical Disputes' (2008) 59 *Journal of the American Society for Information Science and Technology* 1143.

are stifled as a result of the degree of trade mark protection.⁵⁰⁸ To whom the benefit accrues and when is not always completely clear, but the trade mark regime is intended to ensure that the winners within the system tend to be more often the undertakings which invest into their brands, rather than those who attempt to exploit and misappropriate the brands of other undertakings. This is intended to protect and encourage lawful commercial activity and competition, in line with policy objectives.⁵⁰⁹

⁵⁰⁸ Kur (n 503).

⁵⁰⁹ *Supra* 4.12

4.13 *Unregistered Marks*

The primary objective of trade mark law is to prevent free-riding being used at the expense of the proprietor of the trade mark. – to protect against the use of free-riding as a market and competition strategy, much the same as the criminal law protects undertakings from theft of their physical goods by their competitors.⁵¹⁰

Because of this exclusionary nature and due to other exclusions which do not pertain to competition between market participants, such as family coats of arms or vulgarity, inevitably there will be issues with unregistered marks. This is further exacerbated by the registration-focused nature of the trade mark regimes of both the UK and Japan, where the inability, for a variety of reasons, to register a mark can lead to an inability to use that mark in the course of trade, such as if another legal or natural person elects to register it, albeit there are often remedies for such occasions.

It is not required that a trade mark regime should have a parallel regime for the protection of marks which are not registered. However, most societies with sophisticated trade mark regimes recognise that there is a measure of inequity sometimes to the operation of any trade mark system.⁵¹¹ The registration system promotes a degree of clarity and ease of comprehension and use, but its operation often creates zero-sum outcomes for entities which find themselves in a dispute.

Unregistered trade mark protection is, therefore, usually seen as a complementary system to provide equitable outcomes where the strict operation of the registration-based trade mark

⁵¹⁰ Mark A Lemley, 'Property, Intellectual Property, and Free Riding' (2004) 83 Texas Law Review 1031.

⁵¹¹ David W Barnes, 'Trademark Externalities' (2007) 10 Yale Journal of Law and Technology 1.

regime is liable to produce inequity.

Unregistered trade mark protection can take a variety of shapes, and it can structurally form part of the legislative instruments which constitute their associated trade mark regimes.

In the context of Japan, Art.4 (Unregistrable Trademarks) of the Trademarks Act 1959 contains the various exclusions from registrability which correspond to the absolute and relative grounds for refusal in its UK counterpart, the Trade Marks Act 1994.

This is a purely statutory system, and it provides a measure of protection from the depredations of free-riders, but it does not constitute protection from a competing registration. The Unfair Competition Prevention Act 1993 regulates normatively undesired behaviour (it is not a competition law instrument, despite the name) in the context of business and commercial activity, which it defines as competition. Art.2(1)(i)-(ii) elaborate on and extend the protection constituted by Art.4(1)(x) of the 1959 Act:

“Article 2 (1) The term "unfair competition" as used in this Act means any of the following:

(i) the act of creating confusion with another person's goods or business by using an indication of goods or business (meaning a name, trade name, trademark, markings, containers or packaging for goods belonging to a business, or any other indication of a person's goods or business; the same applies hereinafter) that is identical or similar to the another person's indication of goods or business that is well-known among consumers as belonging to that person, or by transferring, delivering, displaying for the purpose of transfer or delivery, exporting, importing or providing through a telecommunications line

goods that use the same indication;

(ii) the act of using an indication of goods or business that is identical or similar to another person's famous indication of goods or business as one's own, or of transferring, delivering, displaying for the purpose of transfer or delivery, exporting, importing, or providing through a telecommunications line goods that use the same indication;"

Structurally, this is similar to passing-off. The UK iteration of passing-off requires goodwill, misrepresentation and confusion, and⁵¹² while Art.2(1)(i) does not make explicit reference to goodwill and misrepresentation, functionally this provision serves the same purpose in providing for a judicial remedy as a weak alternative to registered trade mark protection.

The major distinction is in the requirement that the mark should be well-known or famous respectively. Functionally, this is still unregistered mark protection. In contrast with passing-off in the United Kingdom, this protection is derived from legislation. However, as discussed at 3.5.3 above, there is a significant difference in the sense that the protection for well-known and famous marks is predicated on their level of reputation or fame, whether regional or national. This is not identical in its social effects, but there are similarities, and they exist in a similar niche within the respective legal systems.

4.13.1 Unfair Competition Law in the UK

Historically, there has been no unfair competition law in England. The historical position of the courts has been that it is not within the power of the judiciary to determine what is fair

⁵¹² Catherine W. Ng (n 148); Catherine W. Ng (n 137).

and what is unfair in competition, as stated, for example, in the case of *Mogul Steamship Co Ltd v McGregor Gow & Co*.⁵¹³

However, Richard Arnold asserts that despite no unitary cause of action or other subsystem of law, there is a miscellany of laws which collectively constitute law of unfair competition: trade mark infringement,⁵¹⁴ passing-off,⁵¹⁵ malicious⁵¹⁶ falsehood and breach of confidence.⁵¹⁷

Whether the law of unfair competition is constituted by a single overarching cause of action or body of law or whether by a miscellany of laws is a structural, taxonomic matter. Despite this taxonomic reality, in a functional sense it functions, collectively, as the law of unfair competition. Article 10^{bis}(1) of the Paris Convention⁵¹⁸ states that: "*The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.*" And the requirements of this provision are met by this miscellany of laws.⁵¹⁹

Accordingly, there are many examples of functional convergence in the context of the miscellany of laws constituting unfair competition and the Japanese system of unfair competition, but there are also limits to this convergence. There is a significant difference in terms of underlying principles because of the asymmetry between passing-off and the protection for well-known marks. Certainly, they can have an overlap, and there are no doubt

⁵¹³ *Mogul Steamship Co Ltd v McGregor Gow & Co* [1892] AC 25; Richard Arnold, 'English Unfair Competition Law' (2013) 44 IIC - International Review of Intellectual Property and Competition Law 63, 64.

⁵¹⁴ Arnold (n 513) 71.

⁵¹⁵ *ibid* 73.

⁵¹⁶ *ibid* 75.

⁵¹⁷ *ibid* 76.

⁵¹⁸ Paris Convention for the Protection of Industrial Property.

⁵¹⁹ Arnold (n 513) 77.

cases which would satisfy the requirements of both passing-off and the protection for well-known marks, but the requirement of a particular level of reputation or fame makes the functions and practical and social outcomes somewhat different. E.g. the protection for well-known marks cannot be relied on by small undertakings of relatively little regional repute, even if they would satisfy the requirements of passing-off.

4.13.2 **What is a Trade Mark? What is a Mark?**

A mark is a symbol and an abstraction which is responsible for inducing the subject into making an association with an entity, such as a corporation. Alfred Korzybski, scholar of philosophy, semantics and logic, discussed this in his remarks about what he referred to as map-territory relation. He observed that a geographic map and a geographic territory, for example, are distinct objects. The geographic map is an abstract representation of a geographic territory, without being the geographic territory itself – it is an effigy or an imperfect and incomplete emulation. In a similar manner a mark “represents” the undertaking which owns it in the relevant market to a consumer.⁵²⁰ This is, in essence, a semiotic discussion.⁵²¹

The trade mark system, while it incorporates a plethora of normative principles and concerns, is not a system which operates on the basis of and to the extent of damage. Financial damage is a significant concern of restitution and penalties, in the context of trade mark law, but it is not an absolute requirement of trade mark infringement, in the way that passing-off requires some form of damage to have been suffered by the aggrieved party.⁵²²

⁵²⁰Gregory Bateson, Katie Salen and Eric Zimmerman, “The Game Design Reader: A Rules of Play Anthology”.

⁵²¹ *Supra* 4.10.3

⁵²² Gary I Lilienthal, “The Development of the Tort of Passing-Off” (phd, Curtin University 2012).

Trade mark infringement is not concerned with goodwill – it occurs to the extent that an action contravened the express provisions of the 1994 Act, or any enacted or judicial measure within the trade mark system. Passing-off is different, in this respect, because passing-off is a mostly consequentialist system, the purpose of which is to provide remedies to aggrieved parties rather than, as with trade marks, uphold an abstract set of mid level principles.⁵²³ Passing-off is also not reified, whereas trade mark rights are proprietary in nature.⁵²⁴

Mid level principles in this instance are, as with ethics more broadly, principles which are derived from other norms, generally fundamental, but not necessarily so. It is a fundamental principle of UK society that stealing is morally objectionable.

It is not necessarily the case that all ways of obtaining goods for free are wrong, but stealing in particular is considered to be so, because of reasons such as that it financially damages the person the goods are being taken from. There is a lower level principle which dictates that stealing is wrong because it causes damage to an innocent party, but opinions within society are likely far less unequivocal about the act of stealing to stave off death by starvation, for example.⁵²⁵

It is theoretically possible to create an archetypal or even a real trade mark regime predicated on fundamental norms and principles, but by necessity and due to its intense focus on case-

⁵²³ Michael D Bayles, 'Mid-Level Principles and Justification Part I: Justification in Ethics: Section 4' (1986) 28 NOMOS: American Society for Political and Legal Philosophy 49.

⁵²⁴ *Supra* 4.10

⁵²⁵ Kenneth Henley, 'Abstract Principles, Mid-Level Principles, and the Rule of Law' (1993) 12 Law and Philosophy 121.

by-case determination of outcomes, such a system is not likely to arise, which can be extrapolated from the primacy of trade mark law over passing-off on grounds of utility and cost-saving, in terms of the degree of use and popularity. The case-by-case adjudication passing-off embodies is simply not as effective and popular as the simple heuristic which is a trade mark. By abstracting away the moral layer which is discussed in every case of passing-off, society has created its replacement, the trade mark regime, which achieves similar moral outcomes for proprietors of marks who diligently register them, without the judicial overhead of constant passing-off litigation.⁵²⁶ Additionally, there is also a further benefit to reification – a trade mark right enjoys many of the benefits of property, including in the context of lending and security.⁵²⁷

The abstract rules of a trade mark statute represent mid level principles, but the system itself is predicated on and devised to protect more fundamental principles and norms. These norms include societal values which, through the political and legislative processes have led to the enactment of the provisions constituting a trade mark regime.⁵²⁸

Because the norms embodied by trade mark provisions are abstractions, they are much simpler to reason about than fundamental norms. In contrast, passing-off and similar systems are much lower level in terms of their proximity to fundamental norms. It is, of course, always possible to make a policy argument, with varying levels of success, about a matter of policy and its implications for practical outcomes.

⁵²⁶ Verena von Bomhard and Artur Geier, 'Unregistered Trademarks in EU Trademark Law' (2017) 107 *The Trademark Reporter* 677.

⁵²⁷ *Supra* 4.10

⁵²⁸ Henley (n 525).

Intellectual property and trade marks, more narrowly, form part of a heavily harmonised system predicated on a particular trade mark template overseen and cultivated by the World Intellectual Property Organization. Various different societies, such as with Japan and the United Kingdom have differences in the mores which influence their use of mid level norms furnished by the positive provisions of trade mark legislation.⁵²⁹

Because of the distinction between the mid level norms enshrined in positive laws and the fundamental norms which they are predicated on, it is not possible to ascertain the fundamental norms of society based solely on positive laws. A better, more accurate appraisal is possible through the combination of the analysis of the positive provisions of a trade mark regime and the manner and frequency of reliance on such positive provisions.

4.13.3 Protection of Unregistered Marks in Japan

The protection afforded to unregistered trade marks is limited and structurally complicated. Unregistered marks, as such, enjoy no protection under the trade mark regime, other than to the extent that they have regional or nationwide reputation or fame.⁵³⁰ There is no feature built into the Japanese trade mark regime which would protect unregistered marks in the way passing-off does.⁵³¹

Unregistered marks can, however, benefit from protection afforded to marks under s4(1)(x)

⁵²⁹ *Supra* 2.6

⁵³⁰ *Supra* 3.5

⁵³¹ Catherine W. Ng (n 137).

1959 or under the provisions of the Unfair Competition Prevention Act 1993.⁵³² Although these forms of protection can be valuable, they cannot be relied on in a strategic fashion. In order for a mark to qualify for protection for well-known and famous marks, it must be judicially recognised as such, and the standard of consumer familiarity is high and reputation-based, and not something which an undertaking might reliably be able to foster, despite persistent, robust advertising campaigns.

The precursor of the Unfair Competition Prevention Act 1993 was the Unfair Competition Prevention Act 1934. This Act received numerous amendments intended to keep it up to date, current and relevant in the light of the significant social and economic changes of the decades leading up to the early 90s. In the early 90s, the Unfair Competition Prevention Act 1993 was enacted, inheriting the structure of the 1934 Act, but also expanding the purview of the law to address the diversification of unfair competition.⁵³³ A detailed comparison of the 1934 and 1993 Acts is outside the scope of this thesis.

The UCPA protection is, likewise, potentially unreliable. For a mark to qualify for protection, another party must have obtained an advantage which would judicially be considered unfair. This is typically something like misleading the public as to the origin of goods or services, through otherwise legitimate means.⁵³⁴

The nature of the protection afforded under both systems is such as to be able to address obvious cases where there had been some manifest inequity or outcomes which the system

⁵³² Port, 'Trademark Harmonization: Norms, Names & (and) Nonsense' (n 249).

⁵³³ Japan Patent Office, 'Outline of the Japanese Unfair Competition Prevention Law' <https://www.jpo.go.jp/e/news/kokusai/developing/training/textbook/document/index/Unfair_Competition.pdf> accessed 26 June 2024.

⁵³⁴ Unfair Competition Prevention Act 1993 art 2(1)(xiv).

clearly did not intend. Despite this, there is no protection for marks which were simply not registered. There is no indication, however, that this is an omission in the Japanese trade mark regime – that it is not the reflection of legislative intent, and this is in line with Zweigert & Kotz in terms of rising above the legislature in providing analysis and taking an external view of things:

“However, there is one important difference between the comparatist’s criticism of law and the criticism made by the observer of a rule of municipal law: the comparatist’s conclusions are not rendered superfluous by the word of the legislator, since his comparative and critical analysis takes him above the national systems, which merely provide him with his data.”⁵³⁵

The Japanese trade mark regime is, therefore, generally as intended legislatively, including in having no intention to protect marks through a system such as passing-off, and instead focussing on the level of regional or national reputation or fame.⁵³⁶

⁵³⁵ Zweigert and others (n 156).

⁵³⁶ *Supra* 3.5

4.14 *Judicial Comparison*

Both the United Kingdom and Japan have highly developed, powerful economies, where commercial competition through branding and merchandising is the norm. Accordingly, there is considerable demand, in both countries, for effective dispute resolution systems. Furthermore, intellectual property – which trade mark law is a subset of – is a specialist area which requires counsel and judges who have had special training or specialist intellectual property experience as intellectual property exhibits certain characteristics which differ from the behaviour and traits of conventional forms of property.

Intellectual property share certain traits which make it useful to discuss them collectively in certain contexts, such as with respect to their use as security for the purposes of lending⁵³⁷ or with respect to licencing and other areas or intellectual property reification.

Because of the complexity of the various subdivisions of intellectual property, both Japan⁵³⁸ and the United Kingdom⁵³⁹ have a cadre of specialist legal professionals who represent clients with respect to specific IP issues and plead before the designated IP courts. In the United Kingdom this body of experts is known as Trade Mark Attorneys, whereas in Japan they are titled *Benrishi*, which encompasses Trade Mark and Patent Attorneys. The counterpart of a UK Trade Mark Attorney is a Japanese *Benrishi* with a trade mark specialism.⁵⁴⁰

⁵³⁷ Xuan-Thao Nguyen and Erik D Hille, 'The Puzzle in Financing with Trademark Collateral' *Trademark Law: Institute for Intellectual Property & Information Law Symposium* (2018) 56 *Houston Law Review* 365.

⁵³⁸ Szarkiszjan and Denoncourt (n 35); Kur (n 503).

⁵³⁹ Trade Marks Act 1994 as amended by Legal Services Act 2007 184.

⁵⁴⁰ *Supra* 3.7

4.14.1 Marks Which are Not Registrable on Normative Grounds

UK/EU trade mark law features numerous attempted registrations of trade marks which were found objectionable on moral grounds, such as the hypothetical BABYKILLER,⁵⁴¹ OOMPHIES⁵⁴² or STANDUPIFYOUHATEMANU.⁵⁴³ There are similar examples in Japan, such as the ‘BUDDHA’S BOOGER’⁵⁴⁴ mark, JESUS,⁵⁴⁵ which was denied registration in the UK, but not in Japan,⁵⁴⁶ and SEIROGAN.

This aspect of trade mark law is perhaps the least contentious in terms of what it aims to accomplish. As in the UK/EU,⁵⁴⁷ so too in Japan,⁵⁴⁸ trade marks which are contrary to public policy, public morality and existing laws are not available to be registered or, at very least, are vulnerable to invalidation. Where this field is contentious is in relation to its subject-matter.

The Jesus mark, for example, has not seen any opposition during the opposition stage of the registration when registration was sought in Japan, and so it is arguable that it causes no noteworthy moral inflammation in Japan, and it was also registered in a number of European

⁵⁴¹ *Philips Electronics NV v Remington Consumer Products Ltd* [1998] RPC 283.

⁵⁴² *La Marquise Footwear Inc.’s Application* (n 113).

⁵⁴³ *CDW Graphic Design Limited’s Trade Mark Application 2227520 “standupifyouhatemanu.com”*.

⁵⁴⁴ Wolf Sauter, ‘Proportionality in EU Law: A Balancing Act?’ (2013) 15 *Cambridge Yearbook of European Legal Studies* 439.

⁵⁴⁵ ‘J E S U S Reg.4233485’.

⁵⁴⁶ John Tessensohn, ‘Japan: Trade Marks - Opposition - Invalidity - Contrary to Public Morality’ [2004] *European Intellectual Property Review* N188.

⁵⁴⁷ *Trade Marks Act 1994* s 3(3)(a).

⁵⁴⁸ *Trademarks Act 1959* art 4(1)(vii).

countries, in spite of the denial it was met with in the UK.⁵⁴⁹ Technically, however, Japanese law prohibits the debasement of religious symbols, as in the example of the Buddha case, where Buddha would likely be directly analogous with Jesus in respect of their relative sacral importance to respective adherents.⁵⁵⁰ This is tied to the concept of international truthfulness⁵⁵¹ and the examination guidelines of the Japanese Patent Office, which examines trade marks in Japan, as discussed above.

Another shared feature of the two Jurisdictions – likely most jurisdictions within this field – is that they take into account the prevailing moral atmosphere at the time. *Seirogan* rendered as ‘Conquering Russia with Bullets’ was a perfectly accepted, if not widely supported mark at the time of the Russo-Japanese war. Indeed,⁵⁵² it was a herbal medicine issued to officers at its inception and the mark was only reined in later, after public mores have shifted, so as not to demean a state and geographic region the Japanese state previously thought acceptable to demean and offend as a psychological part of an ongoing military campaign.⁵⁵³ Similarly, in the UK, the converse has likely taken place, in that the mark OOMPHIES was deemed to be of a subtly sexual nature. Considering that the case is a relatively old one, it is doubtful that it would contravene contemporary mores.

There is, furthermore, a body of trade marks in Japan which are rather difficult to categorise.

⁵⁴⁹ John Tessensohn (n 546).

⁵⁵⁰ *ibid.*

⁵⁵¹ *Supra* 3.5.1

⁵⁵² Shoen Ono, ‘Ch.5 Establishment of Trademark Rights’, *Overview of Japanese Trademark Law* (2nd edn, Yuhikaku 1999) 32.

⁵⁵³ Kim (n 224).

4.14.2 Marks Which Are Procedurally Invalid

In the Tarzan case, the subject of the litigation was the mark ‘TARZAN’.⁵⁵⁴ As a mark, Tarzan does not fit the category of inherently reprehensible marks as it is intrinsically a rather innocent mark. Furthermore, in the Tarzan litigation, the mark was not considered to be invalid on technical grounds and, furthermore, there was no prior registration in Japan. The mark itself was unassailable on both intrinsic moral and technical-moral grounds. Nevertheless, the high court decided that in light of the use made of ‘Tarzan’ abroad, the registration of the mark would be normatively inappropriate.⁵⁵⁵

This highlights the existence of a further category of marks which are refused registration on moral grounds, however, in contrast with technically and purely normatively inviable marks, these marks are both perfectly legitimate as marks – the real and only factor which renders them not registrable is outside the boundaries of trade marks and is a result of the broad application of the law pertaining to the registration of immoral marks and marks contrary to public policy.

Furthermore, as seen in the Tarzan case, the Japanese judiciary seems to engage in some degree of arguable judicial activism.⁵⁵⁶ As a predominantly Romano-Germanic legal system,⁵⁵⁷ this form of normative control can be seen as judicial excess, however it is also

⁵⁵⁴ *Tarzan Heisei 23 (gyo-ke) 10399 2012* (n 226).

⁵⁵⁵ John A. Tessensohn (n 239).

⁵⁵⁶ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20).

⁵⁵⁷ Oda (n 261).

arguably a necessary safeguard against abuses of the heavily registration-based trade mark regime. Indeed, it appears judicially and politically uncontroversial for the Japanese courts to refuse registration of marks which it would be 'inequitable' to register, although equitable in this instance means something more along the lines of respectful or culturally cordial and sensitive.⁵⁵⁸ This is in line with the principle of 'international truthfulness' which if it is not a variant of comity as applied to fact, it derives or stems from the same principle of 'international solidarity', if it can be thus construed.⁵⁵⁹

Much of the scholarly writing on the topic discusses the first-to-file nature of the Japanese trade mark system through the lenses of its American counterpart. In a comparison between the US and the Japanese trade mark registration systems, the difference appears stark, however, the UK⁵⁶⁰ and the EU operate an unambiguously filing based system of trade mark registration.

In this respect, the matter of unregistered marks in the UK is handled chiefly through the law of passing-off,⁵⁶¹ which clearly has normative foundations. Consequently, there is an ostensible difference and an underlying similarity between the treatment of unregistered marks in that recourse to passing-off is an overwhelmingly judicial affair, whereas it is technically possible for trade marks the registration of which might be considered 'inequitable' to be refused registration altogether by the JPO.

⁵⁵⁸. John A. Tessensohn (n 239).

⁵⁵⁹ *Supra* 3.5

⁵⁶⁰. Trade Marks Act 1994 s 2(1).

⁵⁶¹. *ibid* 2(2).

Because this is a broad application of the underlying morality and public policy principle provided legislatively, and because of what the aggrieved party is trying to establish before the Japanese courts is that the mark is well known abroad, there is a visible parallel between the two systems of protecting unregistered marks, although the two systems are still different, despite the aforesaid elements of similarity.

4.15 *Conclusion*

Chapter 4 is a monolithic, gargantuan chapter, and it might be easier to list what is excluded from it, rather than what it includes. However, for the purposes of this interim conclusion, one can reason about the contents of the chapter with sufficient detail to answer the question formulated in 1.2.2 and reiterated in the introduction to this chapter.

For the reasons already discussed in the conclusion to the previous chapter, there is broad convergence in the law. This chapter looks at the issue through a functionalist perspective, and in this regard, much of the trade mark registration system of the two jurisdictions is functionally equivalent.⁵⁶²

An important part of this analysis is reification. Reification refers to the tendency or trend for things to become reified – to become property. This reification is seen in both legal systems. As Port notes, the Japanese trade mark system is rights and registration based. This means that original acquisition of a trade mark is through registration, in contrast with, for example, the US trade mark system.⁵⁶³ Also, this means that the trade mark conferred on the proprietor is a proprietary rights – it is property. This is much the same in the UK,⁵⁶⁴ and the Trade Marks Act 1994 explicitly describes the trade mark right as a type of property.

Although the subject of survey evidence seems like an unlikely field to demonstrate convergence between Japan and the UK in the area of reification, but it does a good job of showing the tendencies of both legal systems. Port writes from an American perspective, at times commenting on the contrast between Japanese and American trade mark laws.

In the context of survey evidence, he paints the picture a US trade mark regime where survey

⁵⁶² *Supra* 3.8

⁵⁶³ *Supra* 4.10.2

⁵⁶⁴ *Supra* 4.10

evidence is simply how one reasons, empirically, about the boundaries of goodwill and thus of trade marks.⁵⁶⁵

In contrast, the Japanese trade mark regime, much the same as the UK trade mark regime, has a conservative disposition towards survey evidence, only seldom relying on it and showing a degree of mistrust towards its inclusion in many circumstances. The UK and Japanese systems are, after all, reified systems with their respective trade mark register which ought to be a presumptively and generally correct record of the trade marks in the legal system, with room for rebuttal under some circumstances. To reason about trade mark rights in Japan and the UK, one has to, primarily, consult the register and deductively, rather than empirically, delimit the boundaries of the property right.⁵⁶⁶

In this regard, Japan and the UK, in a functional sense, are both not only highly reified, but also convergent.

There are other functional considerations, such as with relation to the protections afforded under passing-off and UCPA, but it is important to consider the cost of trade mark protection which, to register a simple word mark or simple device mark, is not costly for even a smaller undertaking. Similarly, trade mark registration requires no prior use. These factors in conjunction with each other mean that unregistered marks are the exception. One can infer that both in the UK and Japan, the intended form of protection for marks is through formally registering a trade mark, and passing-off and protection under UCPA are the exception.⁵⁶⁷ Accordingly, it is correct to say that there is functional divergence in terms of international truthfulness, the expropriation and transfer of rights and with relation to the protection of unregistered marks, but all this is in the exceptional cases. Proportionally, the

⁵⁶⁵ *Supra* 4.10

⁵⁶⁶ *Ibid*

⁵⁶⁷ *Supra* 4.13

divergence is very limited, because the functional effect of this divergence on society is very muted – divergence, after all, is not in the default, baseline system of registered trade marks, but in the auxiliary systems.

5 Moral Principles & Societal Analysis

5.1 *Introduction*

The UK and Japan have very different ethnic, racial and cultural compositions, despite being island nations. In 2019, ethnic minorities accounted for less than 2% of the aggregate population of Japan, meaning that the indigenous Japanese population within Japan is over 98%,⁵⁶⁸ in contrast with England and Wales the indigenous population is 80.5%.⁵⁶⁹

Furthermore, the UK has for centuries participated in international trade, diplomacy and other activities which invariably result in the migration of populations and cultural exchange, the clash of laws and the inter-operation of jurisdictions. Unsurprisingly, entry to the legal profession of the UK is considerably more liberalised.⁵⁷⁰ The UK and EU legal edifices, respectively, have been tailored to be inter-operable,⁵⁷¹ and so the ethnic makeup of the legal profession in the UK comprises a much broader range of persons than in Japan, where the legal profession is almost exclusively, if not exclusively Japanese.⁵⁷²

Accordingly, the objective of this chapter is to analyse the moral and societal dimension in the context of the subject-matter and comparative analysis. The chapter starts with an analysis of the economic significance and strength of Japan and the UK. This is important

⁵⁶⁸. 'Japan Ethnic Groups - Demographics' <https://www.indexmundi.com/japan/ethnic_groups.html> accessed 12 May 2024.

⁵⁶⁹. 'UK Population by Ethnicity' <<https://www.ethnicity-facts-figures.service.gov.uk/uk-population-by-ethnicity/>> accessed 10 December 2019.

⁵⁷⁰. 'Registered Foreign Lawyers - Guidance' (24 March 2021) <<https://www.sra.org.uk/solicitors/guidance/registered-foreign-lawyers/>> accessed 12 May 2024.

⁵⁷¹. Directive 77/249/EEC 1977.

⁵⁷². Bruce E Aronson, 'The Brave New World of Lawyers in Japan: Proceedings of a Panel Discussion on the Growth of Corporate Law Firms and the Role of Lawyers in Japan' (2007) 21 *Columbia Journal of Asian Law* 45.

for establishing their role and level integration in the global economy and economic-political structures, such as the WIPO and TRIPS,⁵⁷³ albeit there is further discussion of this subject in Chapter 6.⁵⁷⁴

Subsequently, the chapter discusses the important political and cultural factors which influence trade mark law. This is, to an extent, a political-cultural discussion including some historic elements in postulating moral, societal and political reasons as to the development of the respective trade mark regimes. This includes a discussion of the objectives of the respective trade mark regimes, and the objectives here also point to causality – the regimes exist in furtherance of their objectives, after all.⁵⁷⁵

Thereafter, the chapter looks at the socio-legal principles which influence this area as well as the rule-following disposition of Japanese people. The chapter, then, looks at the moral principles which feature in the absolute grounds for refusal, discussing it also from the perspective of the distinction between the consequentialist outrage and deontological impropriety.⁵⁷⁶

The chapter will also discuss the uniqueness of the Japanese jurisdiction, also discussing the broader Nihonjinron movement dedicated to postulating an overarching uniqueness, or “Japaneseness”.⁵⁷⁷

⁵⁷³ *Infra* 5.3

⁵⁷⁴ *Infra* 6.3 & 6.6

⁵⁷⁵ *Infra* 5.4

⁵⁷⁶ *Infra* 5.5

⁵⁷⁷ *Infra* 5.3

Finally, the chapter will conclude with a brief discussion and comparison of legal services, and a more detailed discussion of the comparison of international truthfulness in a broader, societal context, beyond strictly trade mark law. This is to help understand this principle beyond its operation in the context of trade mark law, and especially to demonstrate its breadth ⁵⁷⁸

As articulated in 1.2.3, the central question for this chapter is as follows:

Accordingly, the central question in this chapter is whether the Japanese have a uniquely conciliatory, anti-legalist disposition and, importantly, whether international truthfulness is a uniquely Japanese principle or entity, which encapsulates uniquely Japanese moral principles and norms? Furthermore, if it is unique, does this mean that there is a degree of divergence compared to the UK, in this matter?

⁵⁷⁸ *Infra* 5.7

5.2 *The Economic Significance of the Respective Jurisdictions*

Trade marks are all but ubiquitous. Within modern society, most goods and services bear a trade mark. Because of the multitude of often competing products, it is vital for consumers to be able to discern the origins of goods and services.

Japan and the United Kingdom are the 3rd and 6th largest economies in the world in terms of nominal GDP. Japan boasts 53 Fortune Global 500 companies and the United Kingdom 22, as of 2020. The companies on the list, as well as countless other corporations large and small, acquire and exploit trade mark rights as a matter of business necessity.⁵⁷⁹

Trade marks are an indispensable tool for continued success of a corporation, and virtually essential in the context of branding. It is unthinkable, for example, for Adidas to compete without asserting any trade mark rights over its traditional forms of branding or to pursue a course of brand protection through trade marks.⁵⁸⁰

Despite the sufficiency of domestic regimes to protect trade marks within a specific jurisdiction, trade marks engender an innately and increasingly cross-border character. As trade marks so easily cross jurisdictional boundaries, their systems are intrinsically well-suited for comparative analysis.⁵⁸¹ Some trade mark proprietors register a trade mark only in a single

⁵⁷⁹Mira Wilkins, 'The Neglected Intangible Asset: The Influence of the Trade Mark on the Rise of the Modern Corporation' (1992) 34 *Business History* 66.; Teresa da Silva Lopes and Mark Casson, 'Brand Protection and the Globalization of British Business' (2012) 86 *Business History Review* 287.

⁵⁸⁰Katie M Brown and Natasha T Brison, 'Think like Adidas: A Quantitative Analysis of Adidas' Trademark Protection Strategies' (2021) 32 *Marquette Sports Law Review* 445.; Sungho Cho and others, 'A Theoretical Explanation of Sport Trademark Litigation: *Already v. Nike and Forever 21 v. Adidas*' [2023] *Journal of Global Sport Management*.; Rahul Sukesh, 'Battle of the Stripes: An Aristotelian Analysis of Adidas' "Three Stripes" Trademark Infringement Cases' (2019) 1 *Fordham Undergraduate Law Review*.

⁵⁸¹ Dan L Burk, 'Trademark Doctrines for Global Electronic Commerce' (1997) 49 *South Carolina Law Review* 695.

jurisdiction, but the most widespread brands are exported so widely that it would be impossible to understand the trade mark strategy of Adidas in the context of only the jurisdiction of the goods' origin.

Because of the fragmented nature of trade mark regimes, trade mark registration and trade mark proprietorship, it is necessary to obtain trade marks for a host of products, based on the portfolio of a corporation, but this acquisition must be carried out in each successive jurisdiction, subject to some conveniences such as the Madrid system. Detailed discussion of the Madrid system is beyond the scope of this thesis.⁵⁸²

A UK corporation would need to obtain a Japanese trade mark to protect its goods and services, despite already possessing a corresponding UK trade mark. There are exceptions to this, such as famous and well-known marks.⁵⁸³ However, such protection is so difficult to obtain that for most businesses, registration is the only way to obtain a sufficient level of protection. Under such circumstances, it is advisable to approach the matter from a comparative perspective and to try to see the respective trade mark regimes from a comparative perspective.

Likewise, Japan has no automatic protection for unregistered marks in quite the same way as passing-off is available in the UK where no trade mark registration exists. Although there is

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⁵⁸³ *Supra* 3.5.3

protection for unregistered well-known and famous marks, that protection requires the fulfilment of the quantitative standard of reputation or fame, which can be difficult for many undertakings, especially in the context of nationwide fame.⁵⁸⁴

Both systems are registration based trade mark regimes with a high degree of *reification* of trade mark rights.

There is a significant difference in the legal profession on a nationality and cultural basis, and this does influence entry into the legal profession. Likewise, there is significant difference in terms of the protection afforded to unregistered trade marks, but this does not affect the preponderance of major brands any more than the lack of effective global trade mark registration already inconveniences them.

It would be convenient to have a universal system of trade mark registration, but the inconvenience of free-riding in the context of Japan is equally applicable, logically, between any other two jurisdictions where there are linguistic barriers and trade marks have to be separately registered.

With the protection afforded by the registration system, the famous and well-known trade mark protection system, and international truthfulness,⁵⁸⁵ most⁵⁸⁶ large undertakings have comparable protection in both the UK and Japan.

⁵⁸⁴. Trademarks Act 1959 s 64.

⁵⁸⁵ *Supra* 3.5.1

⁵⁸⁶. *Supra* 3.5.3

Smaller and emergent undertakings are more vulnerable to the depredations of predatory registrants, not the least because of the threshold of famous and well-known trade mark protection, but this is more a feature of a relatively free trade mark system, where precarious task of securing adequate IP protection is part of the early stages of corporate growth.⁵⁸⁷ It is true in both jurisdictions that businesses with fewer financial resources are less able to secure their brands with sophisticated trade mark and other IP strategies.

Structurally, the focus of this chapter is the theoretical background of social influences and behaviours in the context of trade mark law. At a glance, modern trade mark law is somewhat quiet in acknowledging its underlying theoretical justifications, and while these justifications sometimes appear in the *obiter dicta* or even occasionally in the integral parts of modern judgments, it is useful to supply theoretical exposition beyond that supplied in legislation and case law.

The Trade Marks Act 1994, for example, is terse when it comes to providing theoretical clarity. Section 22. “Nature of registered trade mark” provides merely a single line as to the nature and status of a trade mark right: “*A registered trade mark is personal property (in Scotland, incorporeal moveable property).*”, albeit this does provide a purely practical clarity in designating, explicitly, the nature and type of the right.

Although s.9(1) is more verbose, there is still a lack of explanation as to the detailed theoretical nature of a trade mark registration, a trade mark right and its effect:

⁵⁸⁷Joern H Block and others, ‘Trademarks and Venture Capital Valuation’ (2014) 29 Journal of Business Venturing 525.

The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent. The acts amounting to infringement, if done without the consent of the proprietor, are specified in subsections (1) to (3) of section 10.”

Consequently, it is important to discuss the implications of such registration beyond the skeletal definitions outlined in legislation. This is also important due to differences between intellectual property, other forms of incorporeal property and corporeal property.

The chapter furthermore will consider the political and economic dimension of trade mark acquisition. Trade mark law affords protection for trade marks, which enables undertakings to invest into their brands in the knowledge that they are protected, by trade marks, from freeriding. How and whether undertakings are able to protect their commercial interests has a significant impact on the economy of a jurisdiction, and trade mark regimes are generally treated as a branch of law responsible for bringing some economic benefit to the jurisdiction.

Competition theory, trade policy and political intentions are divergent across states, and understandably there is no universal and correct trade mark approach to promote domestic growth. Social, cultural and political factors go on to influence the laws which are enacted to steer economic policy. To try to approximate a complete comparative analysis it is also important to provide a discussion of these social, cultural and political factors.⁵⁸⁸

⁵⁸⁸ McKenna (n 505).

5.3 *The Uniqueness of the Japanese Jurisdiction*

In early comparative writings there is a tendency to discuss a uniquely Japanese system or a type of “Japaneseness”. In the wake of WW II, there was a proliferation of writings, both casual and scholarly, with relation to the unique characteristics and the uniqueness of the Japanese people. The collective term for these various disciplines of inter-disciplinary study is “Nihonjinron” (日本人論) meaning broadly “theory of the Japanese people”. Nihonjinron has mostly been a body of research or opinion dedicated to establishing the uniqueness of the Japanese people, in contrast with others peoples, primarily western nations.⁵⁸⁹ Through various disciplines, including climatology, biology, linguistics and many others, the proponents of this broad discipline argued that the Japanese people are fundamentally distinct from other ethnicities.⁵⁹⁰

The contemporary legal scholarship agrees that much like any jurisdiction, the Japanese legal system has various unique elements stemming from the character of the Japanese people, as well as numerous derivative traits which it shares with other cultures.⁵⁹¹ Nihonjinron does not cross over into trade mark law specifically, but the decades of promoting the uniqueness of a social and legal model of dispute resolution in Japan likely led to the general sentiment of looking for distinctions rather than commonalities when conducting comparative legal studies with respect to Japan.⁵⁹²

⁵⁸⁹. Yoshio Sugimoto, ‘Making Sense of Nihonjinron’ (1999) 57 Thesis eleven 81.

⁵⁹⁰. Harumi Befu, ‘Symbols of Nationalism and Nihonjinron’, *Ideology and practice in modern Japan* (Routledge 2002).

⁵⁹¹. Haley, *Authority without Power* (n 31), 4

⁵⁹². Giorgio Fabio Colombo, ‘Japan as a Victim of Comparative Law’ (2013) 22 Michigan State International Law Review 731.

There have been times throughout history when the Japanese legal system did rather incongruous and unique things, such as the introduction of large scale or the imposition of mandatory mediation and dismantling the legal profession in the early 20th century, but the contemporary Japanese intellectual property regime is not unique in its foundations or fundamental leanings.⁵⁹³

Japan is a prominent country in terms of intellectual property, and a signatory of numerous treaties administered by the World Intellectual Property Organization.⁵⁹⁴ WIPO itself is an international body dedicated to the harmonisation of intellectual property laws, including trade mark law. There are some implicit and express expectations with relation to the Japanese trade mark regime, and while the attitude of the Japanese people to litigation, the judiciary and the law might influence the manner in which they engage with the content, often incorporated into Japanese law, the fundamental nature of the legal templates, which signatories of a host of these treaties employ, does not change.⁵⁹⁵

The other proposition frequently encountered in older scholarship is that the Japanese people are inherently conciliatory in their outlook on disagreement and legal dispute. Although there is historic evidence to support that the Japanese had a prominent system of conciliation, it is a stretch to argue that they are innately conciliatory in the sense of acceptance of a benevolent authoritarian hierarchy, akin to Plato's anti-legalist position in the Republic.⁵⁹⁶ As discussed above, the Japanese are conciliatory in the presence of a

⁵⁹³. Haley, *Authority without Power* (n 31), 83.

⁵⁹⁴. 'WIPO Lex' (n 23).

⁵⁹⁵. James Boyle, 'A Manifesto on WIPO and the Future of Intellectual Property' (2004) 3 Duke L. & Tech. Rev. 1.

⁵⁹⁶. Chin Kim and Craig M Lawson, 'The Law of the Subtle Mind: The Traditional Japanese Conception of Law' (1979) 28 International & Comparative Law Quarterly 491.

numerically small legal profession and predictable judicial outcomes. Arguably, any groups of people would likely be conciliatory if legal services are difficult or lengthy to obtain and legal outcomes can readily and accurately be predicted by legal experts.

Admittedly, however, it is through the dynamics of Japanese society through history that the prevailing state of affairs of legal predictability and a small legal profession came to exist. Japanese society sought to resolve the issue of mounting litigating by limiting the size of the legal profession and enhancing the clarity of the law, whereas some other societies, such as the United Kingdom, sought to improve the supply of lawyers, in line with market demand, and improve the legal process to meet demand. Haley argues that the reason for the aforementioned perception on part of western commentators is broadly because of the previously noted, early 20th century propagandistic dismantling of the judicial system in line with what was, effectively, authoritarian, warlike ideology.⁵⁹⁷

With respect to the history of Japan and the Japanese law, it is important to distinguish pre-WW II Japan from contemporary Japan. At a glance, Japan is an island nation, an idea which Japanese people often acknowledge and refer to as an important factor in the nation's development, but economically Japan has a great a stake in the global economy, and its institutions are well integrated with the global economy.⁵⁹⁸

The purported Japanese unwillingness to engage in litigation has historical roots. State propaganda of the early 20th century saw the dismantlement of the legal profession in Japan

⁵⁹⁷. Haley, *Authority without Power* (n 31), 83.

⁵⁹⁸. Kazuyoshi Matsuura and others, 'Institutional Restructuring in the Japanese Economy since 1985' (2003) 37 *Journal of Economic Issues* 999.

in the service of a warlike, statist propaganda a cornerstone of which was the Japanese family.

Historically, the radical unit of the Japanese legal system was the village or *mura*. Justice was administered at a community level, and in the aftermath of the Meiji restoration, as radicalisation took hold leading up to WW II, the emphasis evolved to uphold family values. The *mura* was too large as the smallest, atomic entity the structure of legal affairs, and it was supplanted by the family which still carried the intended conservative, collectivist normative ethical connotations and it was still useful for the purposes of propaganda, but it afforded considerably more accuracy and detail compared to a collective as large as the aggregate population of a village, with a more predictable numeric range of membership, e.g. number of individual persons within a family.⁵⁹⁹

The number of lawyers and access to the legal profession and litigation was on a steady rise following the Meiji restoration, and the Japanese population was making extensive use of their new, reified system with the assistance of the *benrishi* or advocates. However, the authoritarian and militaristic elements of the Japanese state engine saw this change as a detrimental one, fundamentally contrary and caustic to the fundamental values, such as the importance of family or benevolent rule by the elite – all values which state propaganda hinged on.⁶⁰⁰

During this time, over the course of decades and through incremental legal amendments, the legislature introduced mediation. Mediation was first available under specific circumstances

⁵⁹⁹ Haley, *Authority without Power* (n 31), 83.

⁶⁰⁰ *ibid.*

in a limited range of cases, such as with land disputes between landlords and rice-farming tenants.⁶⁰¹

Then mediation gradually became available, as an option at the choosing of the parties, in all legal cases. Eventually, the legislature gave the courts the ability to impose mandatory mediation upon the parties, even if they should seek a judicial settlement. In the years shortly before the war, the legal profession had effectively become defunct, and the number of practicing *benrishi* declined to nearly insignificant numbers.⁶⁰²

While Japanese law has a decades long chapter of enforced mediation, it is not true that mediation and by extension informal conciliation is a fundamental and automatic norm or behaviour arising from the uniquely conciliatory nature of Japanese people. The case law clearly indicates that contemporary Japanese people, just like their forebears before systems of mandatory mediation were introduced, are entirely willing and unashamed in asserting their property and other rights, to the extent that they have such rights.⁶⁰³

In the context of trade marks, the Unfair Competition Prevention Act 1993 is a trade mark statute which operates at a higher, procedural level than the Trademark Act 1959. The Trademark Act is Japan's principal trade mark statute, serving much the same purpose as the Trade Marks Act 1994 does in the UK.

The Unfair Competition Prevention Act (UCPA), is responsible for the regulating trade

⁶⁰¹. Seiyei Wakukawa, 'Japanese Tenant Movements' (1946) 15 Far Eastern Survey 40.

⁶⁰². Haley, *Authority without Power* (n 31), 83.

⁶⁰³. John Owen Haley, 'The Myth of the Reluctant Litigant', *Law and Society in East Asia* (Routledge 2017).

marks at a transactional or procedural level. The McDonald's⁶⁰⁴ case exemplifies the emphasis on the registration of trade marks in Japan. In the case, various McDonald's trade marks were registered by a local partner at the behest of McDonald's. When negotiations fell through, McDonald's expected to become the proprietor of the trade marks, as might have happened in the United States.

However, Japanese law clearly designates the registrant as the proprietor of a trade mark in cases of original acquisition through registration, to the point of transfer. In this case, it is apparent that the Japanese partner, whilst consistent with the 1959 Act, was acting in an opportunistic fashion with normative impropriety, from the perspective of Japanese society, albeit there is also the previously discussed issue of market liberalisation in the context of McDonald's and similar cases.⁶⁰⁵

While there is no way to challenge a substantively valid registration, the UCPA can be used to perform a forced transfer of title, which was the outcome of the case. The McDonald's litigation spanned over a decade, and the erstwhile Japanese partner fought bitterly for extremely valuable economic rights, which further emphasises the fact that even in the face of social norms and mores, litigants will dedicate themselves to pursuing self-serving economic ends, much like one might expect to see in any western jurisdiction.

Likewise the Tarzan⁶⁰⁶ case concerned an extra-territorial registration for the mark TARZAN. Although the mark was, at the time, well-known in the west, it was much less

⁶⁰⁴ Hall (n 431).

⁶⁰⁵ *McDonald's v Mac Sangyo KK* 13 *Shouwa* 56 (n 174).

⁶⁰⁶ *Tarzan Heisei 23 (gyo-ke)* 10399 2012 (n 226).

prominent in Japan. A local entity registered the mark in Japan, for which no prior registration existed, only to be subsequently challenged on the grounds of the overseas registration.

This is highly opportunistic behaviour, and the case was fought for monetarily high value intellectual property rights, despite the clear moral wrongness of appropriating the goodwill of an overseas mark through a mere contrivance of the operation and inter-operation of domestic trade mark regimes and the global trade mark Infrastructure.

The case was settled on normative grounds when the court invoked the principle of international truthfulness⁶⁰⁷ so as to grant a remedy where one is not otherwise available, and the law provides no other protection (as the mark was not well-known or famous in the legal, trade mark sense) against the depredations of free-riders.

The same trend repeats itself in the *Showa Monasteries "Trappist"*⁶⁰⁸ case. In this case, a local entity tried to exploit the reputation of the Trappist monks and their output in the locality. This trade mark, as with the *McDonald's* and *KK Troy*⁶⁰⁹ case, was formally valid. The court decided, on normative grounds, that the mark was registered with the intention to deceive, and it was subsequently expunged from the register, although it was not retroactively rendered invalid. In this case, too, the registrant showed a high level of opportunism and tenacity in trying to achieve a legalistic resolution and arguing against a somewhat conciliatory or equitable one.

⁶⁰⁷ *Supra* 3.5.1

⁶⁰⁸. *Showa Monasteries KK v Trappistines Monastery* [1996] 1580 Hanrei Jihou 131.

⁶⁰⁹. *Troy of California v KK Troy* 1184 Hanrei Jibou 114 1985.

These cases all have in common various features which can only point away from a tendency of anti-legalism and conciliation. In these cases, the entities trying to engage in free-riding behaviour are Japanese. The cases concern opportunistic registrations intended to facilitate free-riding and courts grant remedy on normative grounds. However, such remedy is only granted after prolonged and hard-fought litigation, which the free-riders contest despite and in the face of social norms and, in the more recent cases, against a background of clear judicial antipathy to such behaviour.

The Trappist case was heard by the Tokyo High Court, *KK Troy* by the Osaka High Court, Tarzan by the IP High Court and the *McDonald's* litigation went all the way to the Supreme Court. It is evident, especially with Tarzan and McDonald's that these litigations were prolonged, costly and the zero-sum game of the outcome did not deter the local registrants from free-riding attempts.

When the scholarly investigation of Japan and the Japanese legal system first truly started, most scholars made various assumptions with respect to the fundamental nature of the Japanese people and their legal system. The broad opinion of the legal scholarship was that the Japanese people are innately non-litigious⁶¹⁰ and dislike law, because of the frequency and degree of confrontation and zero-sum situations.⁶¹¹

Similarly, the statistics and tendencies in the judicial realm do not point towards an innate

⁶¹⁰ Haley, *Authority without Power* (n 31), 83.

⁶¹¹ Kim and Lawson (n 596).

aversion to litigation and an intrinsic preference for mediation. Statistically, judicial activity and the size of the legal profession in Japan are not extreme. Japan is frequently compared with the United States, but this comparison can be misleading in a contextual vacuum.

The US is a statistically litigious country, albeit not the most litigious when considering litigation rates per capita. However, litigation statistics are very susceptible to variations introduced by statistical methods and decisions. It emerges from the scholarship of the late Christian Wollschläger that Germany is statistically the world's most litigious country, with litigation rates at around 123.0/1000.⁶¹² However, compiling statistical data about litigation rates in different jurisdictions is difficult due to the differences in statistical methods and reporting between states.

The reason that Germany is reported to be the most litigious state is because the statistical data includes summary debt collections. If this is excluded, the statistic indicates that the US is the most litigious state. The statistical data can only approximate the truth, so whether the US is the most litigious country is difficult to decisively state, but the statistics leave the possibility open.⁶¹³

The Japanese legal profession is reported to be much smaller statistically than that of the US in terms of both judges and lawyers in general. The number of lawyers in Japan is approximately 2.83 whereas the number of lawyers is 23 per 100,000. In the US this is 10.81

⁶¹² Christian Wollschläger, 'Exploring Global Landscapes of Litigation Rates' in Jürgen Brand and Dieter Stempel (eds), *Soziologie des Rechts: Festschrift für Erhard Blankenburg* (1998) 582.

⁶¹³ Gillian Hadfield, 'Higher Demand, Lower Supply? A Comparative Assessment of the Legal Resource Landscape for Ordinary Americans' (2010) 37 *Fordham Urban Law Journal* 129 147, (fn 77).

and 391 respectively.⁶¹⁴

Haley explains that the perception that Japan is non-litigious culturally is a result of the frequent comparisons with the US in the postwar era. In relative terms, Japanese society is not as litigious as American society. However, on a broader comparison, there are states such as Norway and Sweden, which may be less litigious still.⁶¹⁵ Conciliation is afforded an important role in Japanese society, and it is difficult to rule out the possibility that this may have a statistically significant effect on litigiousness and litigation rates. However, this can not solitarily account for attitudes towards litigation.

Judicial cases also amply evidence the willingness of Japanese litigants to act in obstructive ways and ways which are contrary to public interest. Structurally, much of the litigation falling under public order and morality pertains to industrial obstruction. The NUTRITION CONTROLIST⁶¹⁶ and DOCTOR OF PATENT ARCHITECTURE⁶¹⁷ cases respectively featured attempts at restricting the access of competitors to the terminology employed within their respective industries. These terms are not normatively reprehensible, but their use is liable to be contrary to public interest. As with the cases above, the category of such obstructive cases features extensive and expensive litigation. As per the evidence, Japanese people do not appear to shy away from pursuing litigation contrary to the public interest. In contrast, Japanese courts can play a conciliatory role, or at least act in an equitable fashion.

⁶¹⁴ J Mark Ramseyer and Eric B Rasmusen, 'Comparative Litigation Rates' [2010] The Harvard John M. Olin Discussion Paper Series.

⁶¹⁵ Haley, *Authority without Power* (n 31) 110.

⁶¹⁶ Port, 'Trademark Dilution in Japan' (n 264).

⁶¹⁷ *Doctor of Patent Architecture* (n 481).

5.4 *The Influence of Political & Cultural Factors on Trade Mark Law*

5.4.1 **The Objectives of the Japanese Trade Mark Regime**

Although the EU is an assortment of different cultures of varying inter-connectedness and similarity, there are elements in the learned/acquired understanding and behaviour of these cultures which connect them⁶¹⁸ and, in turn, set them apart from the learned/acquired understanding and behaviour of the native Japanese populace, in terms of rules and rule-following.⁶¹⁹

Japan is legally rather different from China, and the Chinese-derivative Ritsuryou legal system had limited substantive impact on modern and contemporary Japanese law, but the cultural transplants of Confucian philosophy, while rarely discussed in the religious context, have become integral in the socio-political sense.⁶²⁰

The historic Japanese emperors, shoguns, the Meiji era and modern politicians and even, to some extent, the Liberal Democratic Party have all governed in a hierarchical, paternalistic way. The latter has been the governing party of Japan almost uninterrupted since 1958, and the LDP⁶²¹ has a consistent history of repeated prime ministerial terms. The late Abe Shinzou was serving his third term, and he became the longest serving Prime Minister on the 19th of November 2019.

Despite the differences between Japan and China, and between Japan and the conventional

⁶¹⁸. Ettore Recchi, 'Pathways to European Identity Formation: A Tale of Two Models' (2014) 27 *Innovation: The European Journal of Social Science Research* 119.

⁶¹⁹. Morishima (n 257).

⁶²⁰. Hiroshi Kubota and others, *Religion and National Identity in the Japanese Context*, vol 5 (LIT Verlag Münster 2002).

⁶²¹. Francis Fukuyama, 'Confucianism and Democracy' (1995) 6 *Journal of Democracy* 20.

array of western states, the Japanese trade mark regime is similar in its behaviour to its western counterparts.⁶²² Like any trade mark regime, Japan retains some idiosyncrasies arising from its history. The examples are numerous, such as the somewhat globally incongruous trade mark comity in the form of international truthfulness⁶²³ or specific features such as the absence of survey evidence in trade mark cases, or even the terse style of judgments, which it shares with other Roman derivative legal systems.⁶²⁴ Despite these idiosyncrasies, the objectives of the Japanese trade mark law are both locally and globally much the same as the aspirations and aims of other developed trade mark regimes:

“The purpose of this Act is, through the protection of trademarks, to ensure the maintenance of business confidence of persons who use trademarks and thereby to contribute to the development of the industry and to protect the interests of consumers.”⁶²⁵

Some of the domestic objectives of trade mark law in Japan, much as they are in the UK/EU, are, on a normative basis, to protect certain types of desired behaviour, such as investment, and to deter other types of behaviour such as free-riding which is seen as both unethical and harmful to the domestic economy, both in terms of direct harm and acting as a deterrent to investment.⁶²⁶

Japan is an economically and developmentally mature state, and the era of Japanese market

⁶²² Port, ‘Trademark Harmonization: Norms, Names & (and) Nonsense’ (n 249).

⁶²³ *Taishin Trading KK v Ducera Dental* (n 230).

⁶²⁴ Itoh (n 327).

⁶²⁵ Trademarks Act 1959 art 1.

⁶²⁶ John F Coverdale, ‘Trademarks and Generic Words: An Effect-on-Competition Test’ (1984) 51 *The University of Chicago Law Review* 868.

protectionism ended when Japan transitioned from a heavily manufacturing, labour-based economy, to an economy predicated on labour-saving, technology and intellectual property. It is no coincidence that this transformation took place during and towards the end of the Japanese “Economic Bubble Period”, bringing to an end the “Economic Miracle” of the previous three decades.⁶²⁷ Although trade marks were not principally responsible for the end of the bubble period, a country’s trade mark regime can be a reflection of the policy aims it pursues with relation to brand competition, between economic actors of varying size, success and significance.

5.4.2 The Objectives of the United Kingdom’s Trade Mark Regime

The United Kingdom had a somewhat different course, as it transitioned from the British Empire – a trading nation – to the United Kingdom in the wake of two World Wars. Although there was no comparable bubble or economic miracle, the neo-liberal transformation brought on by the three successive governments helmed by Margaret Thatcher have fundamentally altered the crux of the political and social discourse, to focus on markets, supply and demand.⁶²⁸ This neo-liberal ethos, in turn, was a catalyst of global economic, commercial and market inter-connectedness, which in the case of the United Kingdom and the EU culminated, in the context of intellectual property and trade marks, in the eventual harmonisation of the intellectual property regimes⁶²⁹ of the members of the European Economic Community and eventually the European Union.⁶³⁰

⁶²⁷. Leon Hollerman, *Japanese Dependence on World Economy: An Approach Toward Economic Liberalization*, vol 2248 (Princeton University Press 2015).

⁶²⁸. Patrick Minford, ‘What Did Margaret Thatcher Do for the UK Economy?’ (2015) 10 *British Politics* 31.

⁶²⁹. Paul Maier, ‘OHIM’s Role in European Trademark Harmonization: Past, Present and Future’ (2012) 23 *Fordham Intell. Prop. Media & Ent. LJ* 687.

⁶³⁰. Ansgar Ohly and Justine Pila, *The Europeanization of Intellectual Property Law: Towards a European Legal Methodology* (Oxford University Press 2013).

In the case of Japan and the UK, the economic models, whether for better or worse, have transitioned to a greater level of market inter-connectedness, increasing the investment and local stakes in the global economy. Similarly, trade mark law follows a trend of harmonisation. The World Intellectual Property Organization plays a large role in harmonising intellectual property law, administering 26 IP and IP-related treaties,⁶³¹ and it is in turn an agency of the United Nations, a body one of the purposes of which is to create and maintain a political ordering conducive of co-operation and co-existence, including through a shared, common interest.

The purpose of a trade mark is to encourage certain commercial activities which are considered to be desirable for the purposes of society. In this way, trade marks encourage investment, offering a certain quality of service.⁶³² Trade marks also encourage and foster a hospitable environment for the application and instantiation of certain types of mores. An environment where predatory and unscrupulous behaviour is prohibited or curtailed, it is possible to economically succeed and thrive through stability and investment. As discussed in the context of unregistered trade marks, there have been and there will continue to be some circumstances where the rigorous application of the registration-based paradigm can lead to inequitable outcomes, but as an ecosystem, the trade mark regime, whether it be in Japan or the UK, serves to protect society from the harms of unlimited and unsupervised market competition, in the realm of IP.⁶³³

⁶³¹. 'WIPO-Administered Treaties' <<https://www.wipo.int/treaties/en/index.html>> accessed 28 June 2024.

⁶³². Sidney A Diamond, 'The Public Interest and the Trademark System' (1980) 62 J. Pat. Off. Soc'y 528.

⁶³³ *Supra* 2.4, 3.5

Depending on whether a trade mark is considered a trade asset, an article of property, or a formal and legal recognition of a fact, its treatment and objective might change. In the UK a trade mark is transmissible with or without goodwill.⁶³⁴ There is some room to educate consumers as to the sale, and there might be remedies for starkly predatory behaviour, where it leads to a deception of the consumers, but unless the undertakings which have conducted the transaction are willing to litigate, be it on grounds of passing-off in the UK or on the basis of one of the Japanese judicial remedies, the consumers have little protection.⁶³⁵

The small difference between the two systems within this field is also reflected in the different attitudes to and legal rules governing the collection of survey evidence. In contrast with the USA, for instance, UK courts are more judicious with survey evidence, taking into account the overheads and matters of reliability to a greater extent,⁶³⁶ whereas survey evidence as a practice and a paradigm is virtually absent from the Japanese trade mark regime, reflecting that Japan is even further along the spectrum towards the continental paradigm of the trade mark right which is mere property.⁶³⁷ In the Japanese example, survey evidence is far less important because the principal determining factor of the propriety of legal protection is the existence of a trade mark registration and a reified or commodified right which accompanies it.

⁶³⁴ Trade Marks Act 1994 s 24(1).

⁶³⁵ Dan Shanahan, 'The Trademark Right: Consumer Protection or Monopoly' (1982) 72 *Trademark Rep.* 233.

⁶³⁶ Gary Lea, 'Masters of All They Survey? Some Thoughts upon Official Attitudes to Market Survey Evidence in UK Trade Mark Practice' [1999] *INTELLECTUAL PROPERTY QUARTERLY* 191.

⁶³⁷ 井上由里子, '普通名称性の立証とアンケート調査: アメリカでの議論を素材に' (2008) 20 *知的財産法政策学研究* 235.

5.4.3 The Impact of Socio-Legal Principles on Japanese Trade Mark Law

The unifying ethical strand of the various forms of governance throughout Japanese history is benevolence.⁶³⁸ Although whether the governing powers have always governed with benevolence is highly subjective and debatable, these powers have generally professed to be governing with benevolence and in the interests of subjects.⁶³⁹ Understandably in modern democracies this is a trite point, as seldom would a democratic government claim to be governing without benevolence.

In practice, this creates a contrast with much of the culturally Western perspective of those in power and the laws enacted by them. The Western populace is often highly critical of those with political power or in association with such persons. The manner in which Western people often respond to politics is acerbic and cynical, and this is reflected in the media commentary discussing the often partisan politics of the West, and political parties such as the Democratic and Republican parties of the US⁶⁴⁰ or Labour and the Conservative Party in the UK⁶⁴¹ maintain a longstanding adversarial conflict.⁶⁴²

In contrast, the Japanese LDP⁶⁴³ is a type of “one stop shop” due to much of the political conflict existing internally within the LDP⁶⁴⁴ because of the sway the various political

⁶³⁸. Weiming Tu, *Confucian Traditions in East Asian Modernity: Moral Education and Economic Culture in Japan and the Four Mini- Dragons* (Harvard University Press 1996).

⁶³⁹. Haley, *Authority without Power* (n 31), 22.

⁶⁴⁰. John Sides and Daniel J Hopkins, *Political Polarization in American Politics* (Bloomsbury Publishing USA 2015).

⁶⁴¹. R Alan Walks, ‘City–Suburban Electoral Polarization in Great Britain, 1950–2001’ (2005) 30 *Transactions of the Institute of British Geographers* 500.

⁶⁴². Geoffrey Evans, Anthony Heath and Mansur Lalljee, ‘Measuring Left-Right and Libertarian–Authoritarian Values in the British Electorate’ [1996] *British Journal of Sociology* 93.

⁶⁴³. Cheol Hee Park, ‘Factional Dynamics in Japan’s LDP since Political Reform: Continuity and Change’, *Critical Readings on the Liberal Democratic Party in Japan* (Brill 2018).

⁶⁴⁴. J Mark Ramseyer and Frances McCall Rosenbluth, *Japan’s Political Marketplace* (Harvard University Press 2009).

factions within it hold.⁶⁴⁵ Practically all of the LDP factions are right-leaning and espouse some type of economic orthodoxy, and so the political and economic alignment of the governance is not mercurial and does not often create a zero sum game between parties representing irreconcilably antagonistic electoral bases.⁶⁴⁶

5.4.4 **The Influence of "Rule-Following" Behaviour on Japanese Trade Mark Law**

When the scholarly investigation of Japan and the Japanese legal system first truly started, most scholars made various assumptions with respect to the fundamental nature of the Japanese people and their legal system. The broad opinion of the legal scholarship was that the Japanese people are innately non-litigious⁶⁴⁷ and dislike law, because of the frequency and degree of confrontation and zero-sum situations.⁶⁴⁸

The practical effect of this is that native Japanese people generally see rule-following as a type of behaviour which is innately desirable.⁶⁴⁹ This does not mean that Japanese people slavishly follow all rules – they will question manifestly undesired rules, but they often view it as desirable to follow rules which are neither to one's detriment nor benefit, for the sake of clarity and cohesion.⁶⁵⁰ This is reflected in their attitude to law as well, and their attitude to trade mark law and registrations more narrowly.

⁶⁴⁵ Gary W Cox and Frances M Rosenbluth, 'Factional Competition for the Party Endorsement: The Case of Japan's Liberal Democratic Party', *Critical Readings on the Liberal Democratic Party in Japan* (Brill 2018).

⁶⁴⁶ Ethan Scheiner, *Democracy without Competition in Japan: Opposition Failure in a One-Party Dominant State* (Cambridge University Press 2006).

⁶⁴⁷ Haley, *Authority without Power* (n 31), 83.

⁶⁴⁸ Kim and Lawson (n 596).

⁶⁴⁹ Toshio Sugiman, 'Group Dynamics in Japan' (1998) 1 *Asian Journal of Social Psychology* 51.

⁶⁵⁰ Haley, *Authority without Power* (n 31), 83.

In practice, there are provisions which Japanese people will oppose or support. Art.9 of the Japanese constitution forbids the maintenance of any form of military force. The Japanese Self Defence Force, well-equipped though it might be, is theoretically a type of police force.

Art.9 furthermore prohibits the use of force to settle international disputes. The initiatives of the Shinzou Abe government to amend or “re-interpret” the present provisions of Art.9 have been met with much ambivalence, and this point of the Japanese constitution has elicited a moral response. Whether the underlying justification for such a moral position is deontological or consequentialist, there has been a measure of active, not reactive support for the amending the constitution or maintaining it as it currently is.

In contrast, this is much less or not at all the case in terms of trade mark law. The case law demonstrates this point. As discussed in Chapter 3, a large portion of Japanese cases dealing with public policy and morality turn on the market competition through various trade marks. The opposition by a litigious party or at the examination stage is reactive, and it stems not from a moral outrage or opposition, but from a practical, generally financial one. It is normal for competitors in the same market to oppose one-another’s registrations given the opportunity, but the rightness or wrongness of registrations is not a genuine concern for commercial actors, but its economic consequences.

The principal difference in terms of the registration of morally inappropriate marks is in the way Japanese people view the “rightness” or “wrongness” of such registrations against the

background of the positive law.⁶⁵¹ For example, Japanese business undertakings and applicants will rarely have moral or ethical misgivings about conduct such as has been demonstrated in the McDonald's⁶⁵² litigation, Tarzan⁶⁵³ or Nutrition Controlist⁶⁵⁴ and Doctor of Patent Architecture⁶⁵⁵ cases.

In these cases, the applicants and proprietors have been or thought to have been acting in line with the Trademark Act 1959. For example, as discussed in Chapter 4, the trade mark registration in McDonald's has been considered valid and no steps were made to expunge the mark from the register. The Unfair Competition Prevention Act 1993 is, at times, relied on to grant a remedy by the operation of procedure, such as through the transfer of trade mark title,⁶⁵⁶ but generally Japanese undertakings and persons are likely to have no misgivings about using the law in ways where its operation might confer a benefit which seems undeserved from a Western perspective.

At the time of the McDonald's litigation,⁶⁵⁷ McDonald's had already established itself as the most monolithic fast food enterprise the world over, and to Western sensibilities it would appear self-evident that a local partner is not legally or ethically entitled to the goodwill corresponding to billions of investment and decades of fastidious commercial activity.

The Troy⁶⁵⁸ litigation was akin to the McDonald's litigation. It involved a very similar

⁶⁵¹ *ibid.*

⁶⁵² *McDonald's v Mac Sangyo KK 13 Shonwa 56* (n 174).

⁶⁵³ *Tarzan Heisei 23 (gyo-ke) 10399 2012* (n 226).

⁶⁵⁴ Port, 'Trademark Dilution in Japan' (n 264).

⁶⁵⁵ *Doctor of Patent Architecture* (n 481).

⁶⁵⁶ *McDonald's v Mac Sangyo KK 13 Shonwa 56* (n 174).

⁶⁵⁷ *ibid.*

⁶⁵⁸ *Troy of California v KK Troy 1184 Hanrei Jibou 114 1985* (n 609).

arrangement between a non-Japanese undertaking – the overseas proprietor – and the Japanese partner who would help in the introduction of the IP to the domestic market through licencing.

The parties had an agreement which stipulated that KK Troy was to secure the trade marks of the overseas partner in Japan and that upon the expiration of the licence period, KK Troy would cease using the aforesaid marks. This had partially come to pass, as KK Troy did make the trade mark registrations, however, in contrast, once again, with America, the Japanese trade mark acquisition system is unequivocally registration-based. This case demonstrated very well the technical operation of the Japanese system of trade mark registration and the treatment of such registered trade marks.

There was a licence agreement between Troy of California and KK Troy, which expressly defined the term during which KK Troy was to use the trade marks it registered, at the behest of Troy of California, in its own name. Although a remedy was granted to Troy of California, it is notable that the registration by KK Troy was valid and the Osaka High Court did not dispute its validity or expunge or otherwise invalidate the registration.

The case was resolved by ordering KK Troy to surrender its trade mark title to the pertinent marks. This is an elegant solution to a very clear-cut legal state of affairs which leaves hardly any remedy for smaller undertakings faced with such circumstances. In contrast with a number of other similar scenarios involving an American overseas proprietor and a domestic partner, not all American undertakings fared so well, and it is also the case that the time-limited nature of the licence agreement was also favourable in allowing the Osaka High Court

to order the transfer of the right.

The case of *Hummel*⁶⁵⁹ was the opposite, in terms of circumstances, of *Troy*.⁶⁶⁰ In *Troy*, the licence agreement stipulated that the domestic partner should cease all use of the trade mark upon the expiration of the licence period. In contrast in *Hummel*, the overseas partner surrendered all rights in the context of Japan, and the domestic partner, therefore, faced none of the hurdles associated with the prevailing circumstances in *Troy*.

In conjunction with *Troy*, this demonstrates that despite the fact that the Japanese courts are very reluctant to interfere with the operation of trade mark acquisition, they are not so reluctant to grant remedies where the consensus and the contractual agreement of the parties clearly indicates that the trade mark right ought to vest in one party or another. Direct registration of a trade mark is much preferable to contractual arrangements, but it is clear that Japanese courts are ready to look at the intended outcomes of the agreements between parties and critically analyse the likely intended outcomes on the basis of what the parties have agreed, in conformity with the rules on unfair competition.⁶⁶¹

⁶⁵⁹ *Omatsu Trading KK v Hit Union KK* 1269 Hanrei Jibou 130.

⁶⁶⁰ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 83.

⁶⁶¹ *Supra* 3.5

5.5 *Moral Principles as Grounds for Refusal in the Context of Japanese Trade Mark Law*

The reification of trade marks is the norm in both the UK, the EU and the wider Civil Law tradition on the continent and elsewhere, so the notion that a trade mark right is a type of intangible property is not as unusual as it might be in the American context, where trade marks are conceptually much more in response to a recognition of goodwill.⁶⁶²

As with the UK trade mark, the Japanese trade mark was intended and designed to be treated as the property of the first legitimate registrant and it is structurally created to be a fragmentable into the constituent rights which make up a trade mark right. It is a type of property to the benefit of the proprietor, albeit the interests of consumers are normatively not irrelevant to the operation of the system.

The UK and generally most western common and civil law derived legal systems have a longstanding jurisprudential tradition. The rightness or wrongness of laws and principles has, since time immemorial, been an integral element of western legal discourse. The discussions surrounding public order, public policy and morality are often innately nebulous due to the relevant subject-matter.⁶⁶³

Although the American case of *Jacobellis* is concerned with obscenity, in, the same principle is applicable to articles in contravention of morality in the context of trade mark law: “I know

⁶⁶² *Supra* 4.10

⁶⁶³ JM Kelly, *A Short History of Western Legal Theory* (Oxford University Press UK 1992).

it when I see it.”. in the words of Justice Potter Stewart.⁶⁶⁴ Generally, the legislature and judiciary go to no great pains to define conclusively and exhaustively the categories of mark which are contrary to public order and morality, not the least because open-ended and vague definitions are useful in promoting flexibility, which is the underlying principle behind Justice Stewart’s statement regarding obscenity.

Both British and Japanese judges are faced with the problem that they have to make a heuristic decision using little guidance from the legislature, despite the complexity and abstraction of determining whether registration should be permitted for, for example, a novel rendering or iteration of a word, a phrase or symbol in a system, different in usage from the context of its everyday use.

A judge, therefore, has to determine whether “Oomphies”⁶⁶⁵ has ever been contrary to morality, whether it remains so, and whether it remains so to such an extent that its registration should be disallowed, or whether it is only mildly distasteful but not so repugnant as to be denied registration,⁶⁶⁶ and all of the above without a clear directive as to which overarching value or aim the judgment is ought to promote. In the cases, described by Justice Stewart in *Jacobellis*,⁶⁶⁷ where there is something starkly and evidently contrary to morality, like anti-Russian propaganda, it is easy for a court to make a decision about the matter. However, in the borderline cases, the normative concerns which influence judgment can be

⁶⁶⁴ *Jacobellis v. Ohio* (n 437).

⁶⁶⁵ *La Marquise Footwear Inc.’s Application* (n 113).

⁶⁶⁶ *Supra* 2.3.5

⁶⁶⁷ *Jacobellis v. Ohio* (n 437).

very nuanced and a clear and compelling judgment difficult to produce.

In contrast, as most Japanese cases fall on whether there is likely to be outrage, the cases can often be simplified. Japanese judges are not normally required to make abstract value judgments as to an intrinsic rightness or wrongness of a trade mark. The role of the Japanese judge is more expository and descriptive in nature, and they are tasked with the heuristic computation of a much more determinate factor: probability. The judges must rely on their cultural knowledge, knowledge of ethics, societal mores and their general understanding of social dynamics, but based on the body of Japanese cases, descriptive and expositive extrapolations as to likely outrage are the determining and guiding factor in deciding whether certain marks are normatively unregistrable.⁶⁶⁸

A considerable proportion of Japanese litigation with respect to trade mark registrations and propriety pertains to consequentialist matters. *Nutrition Controlist*⁶⁶⁹ and *Doctor of Patent Architecture*⁶⁷⁰ were two cases where the registrations were considered to contravene Art.4(1)(vii), and superficially the language used appears moral, but in the practical sense the issue before the court was whether trade mark registrations such as “nutrition controlist” or “doctor of patent architecture” might have an unfairly restrictive effect on their legitimate competition. In the absence of the trade marks applied for, i.e. “nutrition controlist” and “doctor of patent architecture”, anyone is free to use such terms to describe goods or services, and the subject-matter is not contrary to public policy or morality, as there is nothing inflammatory about the use of the terms “nutrition controlist” or “doctor of patent

⁶⁶⁸ Itoh (n 353); Itoh (n 327).

⁶⁶⁹ Port, ‘Trademark Dilution in Japan’ (n 264).

⁶⁷⁰ *Doctor of Patent Architecture* (n 481).

architecture”.

This category of case is difficult to categorise as pertaining to morality, but in terms of legal nomenclature, that is the legal heading they fall under, and it is possible to oppose a trade mark registration on such grounds.⁶⁷¹ In both cases it was clear that the law is invoked with respect to the conduct and intentions of the parties, as the marks, if registered, would be liable to undermine legitimate competition within the industry.

The comparison becomes strained, however, when looking at normative, deontological reasons to deny a trade mark registration.

In contrast, the UK case law comprises precedent and opposition decisions such as the “FCUK” litigation, “www.standupifyouhatemanu.com”,⁶⁷² and other, similar cases which have implicitly been decided on both a deontological and consequentialist basis. The situation is similar at the community level where registrations for “SCREW YOU”,⁶⁷³ “FUCKING FREEZING”⁶⁷⁴ and “HIJOPUTA”⁶⁷⁵ have been considered to be unregistrable, as well as marks such as “PAKI”⁶⁷⁶ and the hammer and sickle of the USSR.⁶⁷⁷

The UK IPO opposition decision (as part of the trade mark examination process while the application is pending) of “TINY PENIS” makes express mention of “religious, family or

⁶⁷¹. Trademarks Act 1959 art 4(1)(vii).

⁶⁷². *CDW Graphic Design Limited's Trade Mark Application 2227520 "standupifyouhatemanu.com"* (n 543).

⁶⁷³. *Case R-495/2005-G Kenneth v JA Kemp & Co*, [2006].

⁶⁷⁴. Enrico Bonadio, ‘Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks’ (2015) 19 *Marq. Intell. Prop. L. Rev.* 39.

⁶⁷⁵. *Case T-417/10 López v OHIM* [2012].

⁶⁷⁶. *Case T-526/09 PAKI Logistics v OHIM* [2011].

⁶⁷⁷. *Case T-232/10 Couture Tech Ltd v OHIM*, [2011].

social values. ”⁶⁷⁸ This is in contrast with many of the Japanese cases pertaining to Art.4(1)(vii), and in line with the decision to refuse the registration of the hammer and sickle at the community level.

5.5.1 The EU "SCREW YOU" Case [2005]

The case of “SCREW YOU” is interesting in that it highlights the compartmentalised nature of the trade mark regime, and likewise the compartmentalised functioning of moral principles in connection with the subject-matter. Trade marks are classified on the basis of the goods which they are to be used in connection with.

There is a perennial conflict at the heart of all trade mark opposition based on moral grounds, as Art.10 of the European Convention on Human Right 1950 protects the freedom of expression. The article sets out the right to freedom of expression under Art.10(1) and there is a qualification of this right under 10(2), namely that the right can be restricted “for the protection of health or morals”. The UK, and other signatories of the ECHR, must work with the twin principles of proportionality⁶⁷⁹ and with proportionality in the context of European Union law⁶⁸⁰ and the margin of appreciation.

Under the margin of appreciation, states have a limited right of derogation from the

⁶⁷⁸. *Ghazilian's Application [2002] ETMR 631*.

⁶⁷⁹. Jonas Christoffersen, ‘Human Rights and Balancing: The Principle of Proportionality’, *Research handbook on human rights and intellectual property* (Edward Elgar Publishing 2015).

⁶⁸⁰. Sauter (n 544).

substantive provisions of the ECHR. The principle of proportionality, in contrast, demands that any derogation ought to follow a test set out in *Quila & Anor*,⁶⁸¹ which requires that the measure and derogation should be proportional, which means that a refusal to register a mark on normative grounds, contrary to freedom of speech, is a balancing exercise.

It is because of the competing freedom of expression that in “SCREW YOU” the registration of the titular trade mark was not permitted fully. The appeal was allowed in part, but registration of the trade mark was restricted to Class 10 of goods, which includes implements restricted to be sold in adult shops, where it is expected that the clientele are less sensitive to such trade marks.⁶⁸²

5.5.2 **The EU "FUCKING FREEZING" Case.**

Unlike “SCREW YOU”, “FUCKING FREEZING” was decided on the basis that the refusal to register a trade mark is not a derogation from Art.10 of the ECHR. This case concerned, once again, the titular expression. In the case of “SCREW YOU”, there is, arguably, a measure of antagonism to the exclamation.

The appellant in “FUCKING FREEZING” had argued before the OHIM (NOW EUIPO) first board of appeal that unlike “SCREW YOU”, “FUCKING FREEZING” is an exclamation where the word “FUCKING” has taken on the

⁶⁸¹. *Quila & Anor, R (on the application of) v Secretary of State for the Home Department* [2011] UKSC 45.

⁶⁸². *Case R-495/2005-G Kenneth v. J.A. Kemp & Co.,* [2006] (n 673).

meaning of “very” or “extremely” and in the pertinent combination it no longer makes a reference to sexual intercourse.

“The sign applied for consists of the English words ‘FUCKING’ and ‘FREEZING’ and an additional character (an exclamation mark). The first word ‘FUCKING’ means ‘verdammt’ [damned] in German. It comes from the verb ‘fuck’ and is a crude and offensive expression used in English to refer to sexual intercourse, as a result of which it is designated in dictionaries as ‘taboo spoken’. The second word, ‘FREEZING’, in German means, amongst other things ‘eiskalt’ [extremely cold] or ‘Frost’ [frost] (Longman Dictionary of Contemporary English and Leo Online Wörterbuch, EnglischDeutsch, <http://dict.leo.org>). The sign ‘FUCKING FREEZING!’ as a whole is a vulgar expression meaning ‘Es ist Schweinekalt!’ [It’s bloody cold!] or ‘Es ist verdammt eiskalt!’ [It’s damned freezing!].”⁶⁸³

The court refused the appeal on the grounds that although the moral sentiment towards crass language has become more liberal in recent years, in numerical terms, there is a large class of persons who, whether for reasons of age or personal circumstance, would find such profanity offensive.⁶⁸⁴

The mark was taken, on the grounds of one of its component words, to be contrary to public policy and morality, even if the aggregate of the words means something

⁶⁸³. *ibid.*

⁶⁸⁴. *ibid* 25.

benign such as “It is very cold!”. Although the court makes mention of morality, it is obvious from the wording of the judgment that such morality refers primarily to the collective and shared sentiment within a portion of the public. The judgment turns primarily on the social impact of allowing the registration – namely the widespread exposure of the populace, including children to profanity.

“SCREW YOU” was partially registrable with respect to goods in Class 10. However the applicant sought to register the Fucking Freezing mark in respect of Classes 18⁶⁸⁵ and 25.⁶⁸⁶ These categories are considerably different from Class 10, and the aggregate composition of the clientele visiting stores selling conventional articles of clothing (Classes 18 & 25) is likely to differ greatly from the clientele of a specialised adult store.⁶⁸⁷

5.5.3 Consequentialist and Deontological Grounds

Although superficially these cases appear to protect, in a deontological or normative sense, some type of moral good, they are not structured in such a way as to support this notion. Furthermore, the language and nomenclature of a UK/EU trade mark cases dealing with moral issues generally leans towards discussing some kind of

⁶⁸⁵. “Goods of leather and imitations of leather, included in class 18, namely bags and other containers not adapted for the object being carried, and small goods of leather, in particular purses, pocket wallets, key wallets; trunks and travelling bags; umbrellas, sun umbrellas, parasols.”

⁶⁸⁶. “Clothing, furs (clothing), leather clothing, fur stoles, gloves (clothing), belts (clothing), footwear and headgear.”

⁶⁸⁷. *Case R 168/2011-1 fucking freezing! by TÜRPIZ (BILDMARKE) [2011]*.

societal harm.

As discussed above, the registration of the Soviet coat of arms – the hammer and sickle – was considered contrary to moral principles and registration was refused in the earlier Hungarian case. Although it has now expired, “MARKS & STALIN”⁶⁸⁸ was a UK trade mark which has, for a time, existed in the UK trade mark register, incorporating, as a separator between the two words, the very same Soviet coat of arms which was refused registration in Hungary.

This points to the fact that much of the moral component of a trade mark case is circumstantial. The moral grounds for these cases are contradictory in a model of deontological or virtue ethics, unless those systems too are applied on a geographic basis.

However, the treatment of the two registrations seems much more sensible in the context of history and the likelihood of some practical harm to society. This principle is aptly demonstrated by the case of “*Hallelujah*”.⁶⁸⁹ The 1976 case of *Hallelujah* precedes the modern Trade Marks Act 1994. S.11 provides that a trade mark should not be registered if it “would be contrary to law or morality, or any scandalous design.” “Scandalous design” is a vestige from an era before Directive

⁶⁸⁸. UK IPO *Trade Mark Registration UK00002267534 MARKS STALIN*.

⁶⁸⁹. ‘HALLELUJAH TRADE MARK’ (1976) 93 Reports of Patent, Design and Trade Mark Cases 605.

89/104/EEC⁶⁹⁰ harmonised the laws of the member states, creating the present definition of a mark contrary to public policy or morality.⁶⁹¹ The case is very helpful due to its candid treatment of the underlying moral, religious and semantic issues. It expressly acknowledges that:

“At present we live in what is commonly called the "permissive age", where previously accepted moral standards are undergoing change. There have been similar periods in the past and no doubt there will follow in due course a return to stricter standards as the historical wheel turns full circle. However, it is well established that the registrability of a trade mark must be judged as at the date of its application. I conclude that the phrase "contrary to morality" falls to be considered by the generally accepted standards of today and not by those of 1938. The difficulty is to be sure what those are, and more particularly, where the line is to be drawn between marks whose registration is prohibited by the section and those where it is not.”⁶⁹²

This is an acknowledgment that for the purposes of trade mark law, moral principles are neither universal, nor timeless. The case concerned the registration of the titular mark in respect of “Articles of clothing for women”. The application to overrule the registrar’s decision had failed, and this ruling was made on the basis that registration of the mark carries a likelihood of “giving offence to many people” and that the

⁶⁹⁰. First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

⁶⁹¹. Trade Marks Act 1994 s (3)(3)(a).

⁶⁹². ‘HALLELUJAH TRADE MARK’ (n 689).

“registration would be reasonably likely to offend the religious susceptibilities of a not insubstantial number of persons.⁶⁹³” Since late 2006, there have been three successful registrations of marks containing HALLELUJAH, across classes 3, 9 and 30.⁶⁹⁴

The case of “TINY PENIS” also discusses the issues of temporality, as well as human rights. As discussed above, there is a lack of clarity as to whether Art.10 of the ECHR is interfered with, whether legitimately or not, in the case of a refusal to register a mark on moral grounds. On appeal, Simon Thorley Q.C. alluded to the discussion of whether human rights are applicable to the issue of refusal to register, but he refused to discuss the issue⁶⁹⁵ on the grounds that it seems pointless to redefine the public policy and morality ground as only applicable when there is a pressing social need, as that is already implicitly a part of the meaning of the provision under the Trade Marks Act 1994, s.(3)(a).⁶⁹⁶ However, this area of law has seen some development since this case has been decided, and there is increasing acknowledgement of the human rights dimension.⁶⁹⁷

“THE SLANTS”⁶⁹⁸ case, from the US, is, of course, an extra-territorial judgment, so it has no authority in matters of UK/EU trade mark law, however, it is an important case demonstrating a potential divergence of theoretical approach to trade marks. The

⁶⁹³. *ibid.*

⁶⁹⁴. UK IPO Registration UK00002442391; UK IPO Registration UK00003281890; UK IPO Registration UK00003222833

⁶⁹⁵. *Ghazilian's Application* [2002] ETMR 631 (n 678).

⁶⁹⁶. contrary to public policy or to accepted principles of morality

⁶⁹⁷ *Supra* 2.3.5

⁶⁹⁸. *Matal v Tam*, 137 S Ct 1744.

Lanham Act states that:

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”⁶⁹⁹

In that case, the US Supreme Court decided that the Lanham Act was unconstitutional in imposing a ban on trade marks considered immoral. The case also stated that the Lanham Act⁷⁰⁰ was, therefore, also discriminatory in that it discriminates on the basis of viewpoint, undermining freedom of speech, as trade marks are a form of commercial expression.

In the case of HIJOPUTA,⁷⁰¹ the court sided with the notion that the issue of human rights is not relevant, as the refusal to register the trade mark does not restrict the ability of the applicant to market the product under the name of “Hijoputa”. The US has a sophisticated and extensively developed principle of commercial speech and it

⁶⁹⁹. Lanham (Trademark) Act / Trademark Act 1946 para 1052(a).

⁷⁰⁰. *ibid* 1052(a).

⁷⁰¹. T-417/10 *Federico Cortes del Valle Lopez v OHIM*.

is relatively well-understood and formulated.

Commercial speech has been recognised as protected by Art.10 of the European Convention on Human Rights. The case of *Markt Intern*⁷⁰² concerned an independent publication and consumer lobby group, Markt Intern, making repeated castigatory claims and calls for boycott against certain business practices and, by extension, the businesses engaging in such practices.

These businesses eventually brought action against Markt Intern under the German Unfair Competition Act 1909. Per articles 936 and 944 of the German Civil Code, an interim injunction was issued with respect to the infringing pieces written regarding the company “Cosmetic Club International”.⁷⁰³ The litigation mostly dealt with the applicability of the 1909 act, as the undertakings were not in direct competition, as well as the veracity of Markt Intern’s claims.

It progressed through the Hamburg Regional Court, the Hanseatic Court of Appeal, the Federal Court of Justice, and the Federal Constitutional Court. The Federal Constitutional Court did not entertain the appeal, on the grounds of its low chance of success, and the case ended up before the European Court of Human Rights thereafter.⁷⁰⁴ One of the questions before the court was whether Art.10, on the Freedom of Expression, was applicable to the subject matter, namely the restriction

⁷⁰². *Markt Intern Verlag GmbH v Germany (A/164) (1990) 12 EHRR 161.*

⁷⁰³. *ibid* 10.

⁷⁰⁴. *ibid* 10–22.

of Markt Intern's ability to publish castigatory commercial opinions.

The court, upon entertaining the possibility of a violation, found that considering the Art.10(2) proviso, the legitimacy and justification of the state's aim and the margin of appreciation therefore afforded, that there was no violation of Art.10. The case was decided by a panel of 18 judges, and President Rolv Ryssdal had the casting vote to break the tie of nine to nine as per Rule 20(3) of the Rules of the Court (this is historic, and under the present rules the President must opt for adjournment, however, Rule 23 provides an alternative vote, followed by a casting vote by the President, should that fail). The case was very narrowly decided against the favour of the applicant, and it fell on issues of proportionality, margin of appreciation and justification, meaning that Art.10 was engaged, albeit not violated.⁷⁰⁵

The circumstances of Markt Intern are somewhat different from trade marks as commercial speech. The freedom of the press, including in matters of commercial speech, is a more conventional area and application of Art.10 and the Freedom of Speech more generally. The deciding factor in this matter is whether trade marks are commercial speech (e.g. the US model)⁷⁰⁶ and whether they count as such commercial speech as was protected in Markt Intern. The SLANTS case is important in that it opens up and will hopefully stimulate the discussion surrounding the issue of whether trade marks ought to be afforded protection under freedom of speech principles and

⁷⁰⁵. *ibid* 34.

⁷⁰⁶. Rebecca Tushnet, 'Trademark Law as Commercial Speech Regulation' (2006) 58 SCL Rev. 737.

provisions. It is difficult to decide whether freedom of speech is an appropriate form of protection for one's ability to register trade marks, including morally reprehensible ones. The primary purpose of a trade mark is to create a causal connection between trade mark and origin in a semiotic sense,⁷⁰⁷ and it is a moot point whether there is an underlying principle, value or relationship for human rights to protect, or whether the only use of a trade mark should be to indicate origin, prevent confusion and to reduce overheads on information acquisition on part of the consumers.⁷⁰⁸ In recent judicial practice, the role of human rights is increasingly being recognised in the context of commercial speech, including trade marks.⁷⁰⁹

5.5.4 **The moral issue of obscenity and trade marks**

As discussed at the outset of this chapter, the standard for obscenity, as described in *Jacobellis v Ohio*,⁷¹⁰ is innately nebulous. This convenient ambiguity is a feature of many laws, not the least of which is morality and public interest in a trade mark law context. There is a generalised uncertainty as to whether human rights law is applicable to trade mark registrations and if so to what degree. There is further uncertainty at the judicial level as to whether deontological thought is applicable to trade marks at all, and truly deontological or virtue-based language seems mostly absent from judgments, be they UK, EU or Japanese judgments.

⁷⁰⁷ *Supra* 4.10.3

⁷⁰⁸ Stephen L. Carter, 'The Trouble with Trademark' (1989) 99 Yale LJ 759.

⁷⁰⁹ *Supra* 2.3.5

⁷¹⁰ *Jacobellis v. Ohio* (n 437).

Even SEIROGAN,⁷¹¹ BUDDHA’S BOOGER⁷¹² and the JESUS⁷¹³ cases discuss the perceived societal outrage and harm, and so the Japanese case law seems to omit moral language which cannot be interpreted or cast in a consequentialist way.

The consequentialist sense of harm means either some form of unruly action by the aggrieved, the emotional anguish of hurt feelings or a combination of the two. In STANDUPIFYOUHATEMANU, the decision taken by Allen James (now head of the Trade Mark Tribunal) does not even refer to the element of morality, and the word is only mentioned to the extent that the full provisions of the TMA 1994, s.3(3)(a) are quoted, mentioning morality.

The decisive factor in the case was that it was considered contrary to “public policy” on practical grounds. Allen James also references the case law of the ECJ regarding the morality and public policy counterpart in the context of patents. He quotes Advocate General Jacobs’ Opinion⁷¹⁴ with respect to the patent case of *Netherlands v Commission and Council*,⁷¹⁵ where Jacobs states, with relation to harm envisioned by the public order & policy, that:

“...the Court’s approach is essentially similar to that of the European Patent

⁷¹¹. Kim (n 224); Shoen Ono (n 552) 14, 32.

⁷¹². Sauter (n 544).

⁷¹³. John Tessensohn (n 546).

⁷¹⁴. *Case T-232/10 Couture Tech. Ltd. v. OHIM*, [2011] (n 677).

⁷¹⁵. *Case T-526/09 PAKI Logistics v OHIM* [2011] (n 676).

Office, whose guidelines for substantive examination state that the purpose of the ordre public and morality provision is 'to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour...'

However, in most extensive discussions of the topic, there is some reference to “religious, social and family” values and the preservation thereof. In contrast with the primary justification for a refusal to register a mark on moral grounds, it can be argued that this is a genuinely deontological principle. There is no obvious physical harm in the erosion of these values in the same way as harm may result from the violent behaviour of football fans in the context of STANDUPIFYOUHATEMANU, but the wording envisages some kind of undesirable and undesired transpiration or change.

Absent any other moral principles, the only applicable one seems to be stasis, namely the valuing of the present state of moral affairs and the present, prevailing moral atmosphere over one which is substantially different or an uncertain future one.

If there is such a principle at the heart of some decisions, then those might rightly be classified as cases with a non-consequentialist element. Whether the preservation of our present “religious, social and family” values is a moral imperative or obligation, or whether it is virtuous to preserve them, this language invokes an abstract principle rather different from the consequentialist elimination of perceived harm, such as in

“STANDUPIFYOUSHATEMANU”.

The antagonistic relationship between some of the fans of Manchester United and other football fans, in conjunction with the inflammatory domain registration, are liable to lead to verbal and physical violence and create a real detriment to society.

Society employs adversarial and antagonistic language in numerous contexts, however, which are seldom considered morally contentious.⁷¹⁶ In contrast, “TINY PENIS” is not likely to spark a similar or even a lesser reaction. The reason for refusing to register the mark is not so much stemming from the foreseeable consequences of allowing the registration of the mark as it is from the contravention of certain, existing values which, it is thought, ought not to be contravened on grounds of elevated moral status. Although Japanese judicial activity seems mainly to be concerned with the practical consequences of contravening marks, Dr Shoen Ono, (author of the now somewhat out of date trade mark textbook published formerly by the Japan Patent Office and now the Institute of Intellectual Property) states that:

The question of whether public morality has been contravened depends on the norms of society. In other words, the answer to whether the public order has been damaged or not will be different based on the era and unique social phenomena.”⁷¹⁷

⁷¹⁶. CDW Graphic Design Limited's Trade Mark Application 2227520 “standupifyouhatemanu.com” (n 543).

⁷¹⁷. Shoen Ono, *Overview of Japanese Trademark Law* (2nd edn ed, Yuhikaku 1999).

Dr Ono's account of the criterion does accommodate the idea of normative, deontological grounds to object to trade mark registrations, and he supports the statement with "*Director of Patent Architecture*" and "*Seirogan*" (conquering Russia with bullets) cases. Considering the staunchly pacifist stance of the country since WWII, the example of "*Seirogan*" is unsurprising, as it is a mark which was used (prior to the amendment of the kanji comprising the mark, which established the current, non-adversarial version), during the Russo-Japanese war, to exhort Japanese soldiers to enact violence against Russian combatants. This is a similar example to the sickle and hammer case, which was decided on the grounds that the hammer and sickle may cause offence to nationals of a host of post-communist countries, such as Hungary, where the symbol is prohibited, heavily disparaged or both.

5.6 *International Truthfulness in the Context of Trade Mark Law*

International truthfulness⁷¹⁸ is either a uniquely Japanese phenomenon, a type of comity or political loyalty and responsibility. The term (国際信義 – kokusai shingi) is translated by Kenneth L. Port to mean “international truthfulness”.⁷¹⁹ 国際 or “kokusai” means “international” or “diplomatic” in an impliedly geopolitical sense. 信義 or “shingi”, however, can mean a range of different things based on the context. It is generally translated as fidelity or loyalty, in non-legal parlance, but the legal definition can be principle of good faith, or that of fairness and equity.

The political invocation of the idea of “kokusai shingi” mainly refers to its connotation as loyalty and fidelity. The term has been invoked, in the political context, with respect to relationship of political and diplomatic support between Japan and the pre-democratisation Republic of China (Taiwan) under the rule of the KuominT’ang.⁷²⁰

There was a large volume of internal discussion within the Japanese political governance with respect to whether they should break faith with Taiwan, support its expunction from the UN and support the accession of the People’s Republic of China instead. The incumbent Prime Minister at the time, Satou Eisaku, belonged to the pro-Taiwan division of the Liberal Democratic Party, and the discussion of whether to break faith with Taiwan pitted debt and moral obligation against realpolitik and political convenience.⁷²¹

⁷¹⁸ *Supra* 3.5.1

⁷¹⁹ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 110.

⁷²⁰ Yutaka Kanda, *Japan’s Cold War Policy and China: Two Perceptions of Order, 1960-1972* (Routledge 2019).

⁷²¹ *ibid.*

Satou's faction defended the course of keeping faith with Taiwan on grounds of international faith, or "kokusai shingi".⁷²² Although the political connotation of the term can be very different from its legal connotation, especially considering that there are two conventional legal connotations. The term also appears in Japanese law, but it refers to a concept which can exclusively exist between states, so it has a diplomatic and international element to it. Accordingly, in the present context, "kokusai shingi" is likely both a legal and a political principle, or a legal principle the implementation of which is necessitated by political or moral considerations.

In this sense, the term refers to an obligation which ought, morally, be discharged even where to do so is inconvenient or detrimental.

During the premiership of Satou, it might have been politically expedient to support the People's Republic of China, but Satou treated the matter as a deontological issue. Satou's faction considered breaking faith with Taiwan to be a dereliction of moral duty.⁷²³ The scant mention of the principle in the case law, legislation and other legal literature does little to elaborate on the exact definition of this principle, but the typical case involving international truthfulness tends to pit the positive, registration-based Japanese trade mark law against the principle of international truthfulness, that is, keeping faith with other jurisdictions in recognising their trade marks, even though they are extra-territorial registrations and the positive law, other than to the extent of the application of international truthfulness, demands that the overseas application be treated as having no effect on the trade mark

⁷²², *ibid* 183.

⁷²³, *ibid*.

regime and, therefore, the litigation. On this basis, international truthfulness satisfies all three criteria, as it is an indigenous legal/political principle, behaving like comity.⁷²⁴

International truthfulness is unique and the UK has no similar feature for the universal recognition of extra-territorial trade marks. The EU trade mark (formerly Community trade mark) system encompasses all member states for the purposes of trade mark protection. Even in spite of this, the EU trade mark is more an instrument of positive law, than a feature purely of judicial discretion. It also appears that one of the primary criteria for being granted protection under international truthfulness is an existing trade mark registration in another jurisdiction. This sets international truthfulness apart from paradigms such as passing-off. According to s.5(4)(a):

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—
(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met.”

⁷²⁴ Joel R Paul, ‘Comity in International Law’ (1991) 32 Harv. Int’l. LJ 1.

5.7 *Comparison of the Legal Services Sectors of Japan and the UK*

Both the UK and Japan have remarkably mature legal systems and professions, and the trade mark regime and the trade mark profession, as discussed above in the context of the *benrishi*, understandably stand to gain customers who require their knowledge of Japanese trade mark law. This is functionally the same in every jurisdiction with a trade mark regime and a trade mark profession, e.g. trade mark attorneys to provide trade mark legal services. However, in the context of Japan, there is a considerable linguistic, cultural and geographic barrier.

English is the current *lingua franca*, and there is a certain level of mutual familiarity and interoperability between the various Anglophone legal systems, not the least because in the Common Law, they share the same paradigmatic foundations. Likewise, with the EU and the states within geographic or political proximity to the EU, there is a great deal of knowledge about the trade mark regime and workings of the trade mark systems. Rather remarkably, it is possible for lawyers from a whole host of jurisdictions to undergo the Solicitors Qualifying Examination (SQE)⁷²⁵ as part of the Qualified Lawyers Transfer Scheme (QLTS)⁷²⁶. The list of jurisdictions includes Japan, as well as a range of other politically and geographically distant legal systems. This is not applicable to *benrishi* – Japanese trade mark or patent experts, but it is applicable to *bengoshi*, the equivalent of solicitors, generally translated as advocates.

The UK, as a legal system, is remarkably open, and legal services are rendered by an international cadre of legal professionals, especially in industries, such as the IP industries,

⁷²⁵. ‘Developing the SQE’ (12 December 2017) <<https://www.sra.org.uk/sra/policy/solicitors-qualifying-examination/>> accessed 6 May 2021.

⁷²⁶. ‘Qualified Lawyers’ (26 October 2023) <<https://www.sra.org.uk/become-solicitor/qualified-lawyers/>> accessed 6 May 2021.

which are intrinsically predisposed to require work across national boundaries. The same level of openness does not exist in Japan. The loose equivalent to the QLTS in Japan is the **外国法事務弁護士** (gaikokuhou jimusho bengoshi - GJB),⁷²⁷ or Foreign Lawyer system. However, the objective of the GJB system is to allow foreign lawyers to practice the law of the jurisdiction of their initial qualification, and to be able to work alongside Japanese *bengoshi*, but not independently of them in matters of Japanese law. They, likewise, have no ability to plead before courts and they are, functionally, not Japanese lawyers. They might be foreign experts who are required who supply legal services, but structurally, the system is created in such a way as to prevent GJB lawyers from competing with *bengoshi* to attract customers.

By ethnicity, approximately 97.8% of the Japanese population is Japanese.⁷²⁸ Statistically, it is more likely for Japanese natives, irrespective of their ethnicity, to qualify as providers of legal services, than non-natives. The GJB is not a venue to become a Japanese advocate. Accordingly, it is no surprise to see that the membership of the Japanese legal profession is overwhelmingly ethnically Japanese or, in any case, native to Japan. This protectionism is likely, to a large extent, a result of circumstance, rather than deliberate implementation of protectionism, but the GJB could most certainly have been implemented in the fashion of the QLTS, had there been the will for it.

While the outcome of the aforesaid protectionism is that overseas undertakings will overwhelmingly contract Japanese lawyers, it is not as though the same Japanese experts demonstrably discriminate against overseas undertakings in terms of the quality of their

⁷²⁷ 'Developing the SQE' (n 725).

⁷²⁸ 'Statistics Bureau Home Page/News Bulletin December 28, 2021'
<<https://www.stat.go.jp/english/info/news/20211228.html>> accessed 28 June 2024.

services or its availability. There is a large market for providing legal counsel to overseas businesses, and there is no commercial sense, on part of Japanese legal experts, in shirking from providing such legal services.

5.8 *Conclusion*

The objective of this chapter is, amongst other things, to answer the question formulated in 1.2.3 and reiterated in the introduction to this chapter. This answer also reinforces the arguments in the overarching thesis, that Japanese people are not uniquely dissimilar to people in the UK in terms of their relationship with the law and litigation. Indeed, there has been view, in part based on the pre-war, policy-driven diminution of the size and importance of the Japanese legal profession, that Japanese people are intrinsically not disposed towards litigation, on account of their conciliatory, anti-legalist attitude.⁷²⁹

As discussed in this chapter, Japanese people truly have a law-abiding, rule-following disposition. However, it would be logically incorrect to equate this rule-following with rule-aversion. Arguing that Japanese people are uniquely disposed against litigation is arguing that they are rule-averse – they do not wish to nor engage with the rules of the legal system which furnish them with the ability to avail themselves of the boons of trade mark regime and the legal system more broadly. This is untrue.⁷³⁰

There is no indication that Japanese people are extremely litigious, or that the Japanese legal profession is very large – it did not recover its pre-war size, after all.

⁷³¹However, Japanese people are also not extremely averse to litigation. They are also not averse, as one can observe in the case law, to legal opportunism, such as in the

⁷²⁹ *Supra* 5.3

⁷³⁰ *Supra* 5.4.4

⁷³¹ *Supra* 5.3

unfair competition, expropriation cases.⁷³² This points to a legal-cultural convergence with the UK.

While there are obvious differences due to the different legal traditions which the respective systems belong to, but one can infer that Japanese society does not diverge considerably from the litigiousness from its UK counterpart – certainly not in the sense of being uniquely averse to litigation.

The chapter also provides discussion of the moral principles in operation in the trade mark system, such as with relation to the absolute grounds of refusal based on public policy and morality. This discussion involves an analysis of consequentialist and deontological approaches to the matter, observing both deontological and consequentialist argumentation in Japanese and UK cases.⁷³³

Admittedly, there are some cases discussed also in 4.12.4, such as *Nutrition Controlist* or *Doctor of Patent Architecture*, which Port collectively refers to as *marks which harm public morals*. While these cases use the language of morality, what they are more likely referring to is a type of unfair competition, in a broader sense than UCPA, in trying to monopolise common terminology and diminish expressive diversity in the sector. In any case, there are decisions such as *Seirogan* or *Fintan* which engender morality. Accordingly, Japan and the UK are similar and convergent in their treatment of cases on grounds of morality and public policy.⁷³⁴

However, international truthfulness is an altogether divergent paradigm or principle,

⁷³² *Supra* 5.5, 3.5

⁷³³ *Supra* 5.5

⁷³⁴ *Supra* 5.5.3

and it has no parallel or functional equivalent in the UK legal system. As with the conclusion to Chapter 4, one can conclude that there is a measure of divergence, particularly in the context of international truthfulness, which is altogether unique and has no parallel in the UK legal system. However, this is likewise a case of divergence in the exception to the rule. Most cases are not decided based on international truthfulness, so the overall divergence of the trade mark regimes is limited, because of the rarity of the invocation of international truthfulness – most cases are decided on functionally convergent rules and principles.

6 Historical and Cultural Analysis

6.1 *Introduction*

The objective of this chapter is to provide historic and cultural analysis. The chapter will first begin with a detailed comparison of the history of the respective jurisdictions. Subsequently, the chapter will provide a historical analysis of specifically trade mark rights.

Thereafter, it will briefly discuss the issues of legal continuity in Japan, which simply refers to the fact and consequences of the erasure or prevention of an establishment of a purely indigenous legal system, in the vein of the Common Law in the UK.⁷³⁵

Thereafter the chapter will also provide a discussion of the origins of regional and national systems, discussing legal transplants and the aforesaid indigenous legal system.⁷³⁶

Furthermore, the chapter will discuss the historic convergence of legal paradigms to reason about the current state of convergence between the respective legal systems.⁷³⁷

After this, the chapter will turn to the broader subject of the Japanese language. The chapter will discuss, first, the characteristics of the Japanese language in the context of the subject-matter and subsequently the Japanese language in conjunction with the ideographic writing system and, finally, its implications for the trade mark system⁷³⁸

⁷³⁵ *Infra* 6.4

⁷³⁶ *Infra* 6.2

⁷³⁷ *Infra* 6.6

⁷³⁸ *Infra* 6.7, 6.8, 6.9

As articulated in 1.2.4, the central question for this chapter is as follows:

The central question of this chapter is whether, the TRIPS agreement is mostly or wholly responsible for the harmonisation and similarity of the UK and Japan, or perhaps some of the similarity can be ascribed to, simply, to natural legal-evolutionary processes and the Japanese receptiveness to legal transplants? Not the least because both the Trademark Act 1959 and the Trade Marks Act 1938,⁷³⁹ precursor to the current Trade Marks Act 1994, establish registration-based, reified systems akin to their modern versions/successors..⁷⁴⁰

⁷³⁹ *Supra* 2.5

⁷⁴⁰ *Infra* 6.10

6.2 *Historic Comparison*

“We offer no essence, no core, no gist -- because there is none. Law is not a coherent system that follows central organizing principles -- not here, not in Japan, not even in those classic code countries like Germany and France. Anyone who claims otherwise is either wrong or lying. Law is an unruly, disjointed corpus. It reflects nothing more than the accumulated exigencies of lawmaking by legislatures, courts, and administrative agencies over time.”⁷⁴¹

Almost all legal systems have similar beginnings, being rooted in the custom and practices of a culture thereby governed.⁷⁴² Historically, Japan and the United Kingdom are no different in this respect. Although the historic, past English kingdoms have occupied broadly what was formerly Roman Britain, the *Corpus Iuris Civilis* was not fully recovered until the time of the glossators around the 12th century. While⁷⁴³ English princes, prior to the Norman era, have issued laws and other legal instruments, there is no evidence of any concerted effort to compile or to maintain an existing, compiled body of law, to codify or to consolidate it. There was no effort to uproot custom and replace it with enacted laws.⁷⁴⁴

By comparison Japan produced no endogenous system of writing, and writing was introduced to Japan around the 645 Taika reforms, which marked the beginning of the adoption process of the Chinese writing system and the first legal transplant, as Japan adopted the Chinese Confucian T'ang code, leading to the Ritsuryou system.⁷⁴⁵

⁷⁴¹ J Mark Ramseyer and Minoru Nakazato, *Japanese Law: An Economic Approach* (University of Chicago Press 1999).

⁷⁴² William A Edmundson, 'Law's Evolution and Law as Custom 2014 Editors' Symposium' (2014) 51 San Diego Law Review 875.

⁷⁴³ Hurdle (n 67).

⁷⁴⁴ Frederick Pollock, 'English Law Before the Norman Conquest' (1898) 14 LQ Rev. 291.

⁷⁴⁵ Kozo Yamamura, 'The Decline of the Ritsuryō System: Hypotheses on Economic and Institutional Change' [1974] Journal of Japanese Studies 3.

This demonstrates that both geographic regions trace their legal history to local and non-centralised custom. For comparative purposes, the distinction in circumstances occurs when the two systems diverge in their treatment of custom or any potentially existent customary laws, however recorded and enforced in the localities. The Ritsuryou system in Japan was an example of an external, legal and social transplant. Prior to the implementation of the substantive and procedural elements of the T'ang code, there was no indication, based on the social character of the peoples of Japan, that Japan would have endogenously produced a Confucian ordering of itself or a social ordering which, in any case, materially like the Confucian ordering.⁷⁴⁶

The Ritsuryou system was a penal code to serve the needs of the administrative state in maximising productivity by minimising practices perceived as detrimental to it. It was also an early attempt at large-scale social engineering by trying to fit Japanese society into the Confucian mould of the T'ang dynasty.⁷⁴⁷

Although the Ritsuryou system was fated to fail because of the long-term incompatibility of Japanese society with a strictly Confucian ordering within and outside the Palace, it introduced the idea and the paradigm of overarching legal governance to Japan.⁷⁴⁸

The Code⁷⁴⁹ has arguably muted the Japanese social character in terms of producing its own

⁷⁴⁶ Charles Holcombe, 'Ritsuryō Confucianism' (1997) 57 *Harvard Journal of Asiatic Studies* 543.

⁷⁴⁷ Haley, *Authority without Power* (n 31) 17.

⁷⁴⁸ *ibid.*

⁷⁴⁹ Yamamura (n 745).

positive law, and it is also arguable that the Ritsuryou system might have been the reason an endogenous Japanese 'common law' based on local custom was never able to evolve.⁷⁵⁰

The birth of the Ritsuryou system is broadly comparable to the beginning of the Norman era in Britain, despite the superficial similarity, however, there is stark difference between the effects of the two events. What happened in Japan was the imposition of a foreign legal code, by a native dynastic governing edifice, upon the native populace.

By contrast, the Norman era saw the imposition of a foreign dynastic governance upon the native population, subject to native customs. Japanese society was like western societies at the time, and its ordering around clans resembled early feudalism even before the breakdown of the Ritsuryou system and the commencement of the Shogunate era and conventional feudalism.⁷⁵¹ The transplantation of the T'ang Code was insufficient to establish a lasting Confucian society ordered by a Confucian legal system, but it was sufficient to erase custom as the basis of an endogenous legal system.

Although the Ritsuryou T'ang laws have fallen into desuetude with the commencement of the Shogunate era, the Shoguns had no interest in conflict and conflict resolution between commoners. The commoners were the parallel of western serfs, and the governance of the successive shogunates simply wanted them to remain productive. While there were mercantile laws during the era of the Shogunates, there was no effort at preserving local custom or codifying it, and there is no historic indication that custom, as a legal implement,

⁷⁵⁰ Haley, *Authority without Power* (n 31) 17.

⁷⁵¹ Hall (n 431).

was perceived as valuable.⁷⁵²

Despite the administrative style of legislation and adjudication of the various Shogunates, the legal apparatus of the time recognised the value in protecting what were the precursors to modern branding. These took the forms of crests, insignias and other symbols which distinguished the works of craftsmen and merchants. As far back as 1478 there is evidence of, effectively, trade mark litigation with⁷⁵³ respect to what is analogous with passing-off in the context of sake production.⁷⁵⁴

The Rokuseimon case involved regional distinctiveness in the case of an unregistered mark. In 1478 in Japan, no robust, positive trade mark regime existed, but the mark ‘Rokuseimon’ (Six Gates) became distinctive in the Kyoto region, used in the context of sake. The original manufacturers petitioned the Shogunate court to grant them an injunction on the basis that their mark had gained distinctiveness in the region, and the injunction was granted.⁷⁵⁵

Despite the seemingly modern circumstances and treatment of the case, the Rokuseimon case is still an example of the operation of the administrative state. The injunction was granted in a completely retroactive fashion, creating a remedy in the absence of any positive laws prescribing such a decision.

⁷⁵² Haley, *Authority without Power* (n 31) 17.

⁷⁵³ This is structurally trade mark litigation, but the trade marks of the time were no formally recognised as intellectual property rights and neither did they belong to a sophisticated, global nexus of intellectual property regimes. Indeed, the craftsman or producer had not identifiable property right – no *ius in re*, as these trade marks were not *rem* as understood in the Common and Civil Law traditions.

⁷⁵⁴ *Rokuseimon (Six Gates) Oyamoto Nikki (Shogunate journal of current affairs) (Shogunate Court, Muromachi Bakufu)*.

⁷⁵⁵ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 17.

There is also, strikingly, no system of registration involved, as there was no such system in existence in the Muromachi Period. Structurally, this case is much more analogous with passing off, as the decision was based not on property or quasi-property rights, but deception and subsequent use.

Despite the absence of robust property rights and trade mark proprietorship, it can be ascertained from the facts of the decision that the sensibilities surrounding goodwill and free-riding were then as they are now in much of the United Kingdom and Japan, and the act of parasitising the goodwill of a market competitor provokes, as it had provoked in this case, a sense of injustice in members of society and, by extension, adjudicators.

It was not until considerably later in 1880 that Japan began laying the foundations for a *reified* trade mark system predicated on the embryonic idea of a trade mark as a *ius in re* or a *ius* at all. The *Trade Mark Forgery* case involved an undertaking exporting charcoal and silk in the Guma prefecture. The Guma authorities did not recognise the mark of the undertaking in the absence of a statute or any other law, and so the exportation of goods under an identical mark, by a free-riding competitor was not prevented. This was the case which created the political will originating at the Tokyo Chamber of Commerce to create a statutory trade mark regime. This eventually resulted in the enactment of the Trademark Regulations of 1884, creating the first iteration of the registration-based trade mark regime in Japan, and the precursor to the contemporary system.⁷⁵⁶

The Trade Mark Forgery case is different from Rokuseimon in the respect that it had

⁷⁵⁶ *ibid* 21.

occurred 20 years following the Meiji Restoration, and the cases are hundreds of years apart. The successive Shogunate governments, while they recognised the value of preventing freeriding, did not feel compelled to establish a trade mark registry and registration system, which had changed in the aftermath of the Meiji Restoration which prompted Japan to open up to the international community and integrate its economy with the global economy of the time.⁷⁵⁷

This is in contrast with what happened in Britain, where the Norman governance employed itinerant justices in order to compile, consolidate and codify the customary laws of the native populace.⁷⁵⁸ This is the primary point of divergence in the development of laws in Japan and the United Kingdom. The implementation of the Ritsuryou system saw the application of an early Confucian jurisprudence to a society which did not order itself, primarily, in the Confucian fashion, but in the fashion of an early feudalist state.⁷⁵⁹

The strict courtly hierarchy of China was successfully replicated, for a time,⁷⁶⁰ but it is difficult to derive a satisfactory jurisprudential account of how the state functions, theoretically, against a background of socio-legal contradiction, further exacerbated by the lack of familiarity with and existence of a large volume of later jurisprudential writings which established the field of study.

Even Roman Law is not a pure body of laws, produced from nothing, but an evolution of

⁷⁵⁷ *ibid* 17.

⁷⁵⁸ Ernest Freund, 'Effect of the Norman Conquest on English Law' (1887) 1 *Colum. LT* 232.

⁷⁵⁹ Haley, *Authority without Power* (n 31) 17.

⁷⁶⁰ John Gadsby, 'Some Notes on the History of the Japanese Code of Criminal Procedure' (1914) 30 *LQ Rev.* 448.

customary law or Etruscan religious dogma⁷⁶¹ prior to the creation of the Twelve Tablets, and the connection to the origin of the legal system is intact, albeit obscure – Etruscan religious dogma lives on in the modern Civil Law jurisdictions, albeit in a latent, unseen fashion.

When the Common Law in Britain, in the high middle ages, was already well-formed, the Japanese Shogunates were still treating law as an almost purely administrative instrument, in a completely top-down fashion.⁷⁶² In contrast, the evolution of the Common Law was mostly unhindered. Even during the era of the Commonwealth of England, between 1649 and 1660, the nature of the Common Law was not changed and most legal changes were substantive in nature.⁷⁶³ In comparison, shortly after the fall of the Tokugawa Shogunate and the Meiji Restoration, the new imperial governance of Japan was again looking outward to find a satisfactory system of laws in order solve the issue of a lack of laws and legal uncertainty. The choice fell on the Romano-Germanic system not because of jurisprudential reasons, but simply because of similarities of Imperial Japan and Imperial Germany in terms of the power of their respective monarchs and their vertical hierarchies.⁷⁶⁴

Following the end of WWII, Japan was, once again, in a similar position, although much less due to its own volition and much more due to the prevailing circumstances at the time. After the end of the war, Japan was still a very conservative society and the immediate post war era was one of legal reform, under the auspices of the allied forces, primarily General Douglas

⁷⁶¹ Jenő Szmodis, 'A Jog Realitása: Az Etruszk Vallástól a Posztmodern Jogelméletekig'.

⁷⁶² Haley, *Authority without Power* (n 31) 17.

⁷⁶³ Charles Dautch, 'Oliver Cromwell, Lord Protector of the Commonwealth' (1934) 39 Com. LJ 629.

⁷⁶⁴ Tsung-Fu Chen, 'Transplant of Civil Code in Japan, Taiwan, and China: With the Focus of Legal Evolution' (2011) 6 National Taiwan University Law Review 389.

MacArthur, who exerted an American influence over the legal reform process.⁷⁶⁵ It was during this time that Japan was modernised in a number of respects and brought in line with the wider community of developed states, such as in matters of family law, departing from the legal paradigm of a family and towards the individual.⁷⁶⁶

The historical evolution of the two legal systems distinguishes them in key respects, yet in others they remain very similar. Japan is a legal system of the Romano-Germanic tradition, whereas the UK is a common law jurisdiction.⁷⁶⁷ What sets Japan apart from many of its civil law peers is that Japan and the Japanese have never participated in the birth and development of Roman law, which is the case with many Slavic, Germanic and other populations who have since adopted a distant successor of Roman law as their own, but most of continental legal systems have had ancestral legal systems which have in some way participated in the use of the restored Byzantine Roman law and the development of derivative systems.⁷⁶⁸

In the case of Japan, they, effectively, borrowed a modified German legal system, with little connection to the wider, jurisprudential nuance and theory of the system. Consequently, there seems to be little interest in the endogenous jurisprudential elements of the Japanese legal system in Japan – certainly compared to the continental scholarship focussed on legal history.⁷⁶⁹

The character of the Japanese legal system does signal, however, that it is very pragmatic,

⁷⁶⁵. William H Overholt, 'Japan's Economy, at War with Itself' [2002] *Foreign Affairs* 134.

⁷⁶⁶. Fujiko Isono, 'The Evolution of Modern Family Law in Japan' (1988) 2 *International journal of law, policy and the family* 183.

⁷⁶⁷. Colombo (n 592).

⁷⁶⁸. Charles Sumner Lobingier, 'Revival of Roman Law' (1919) 5 *Cornell Law Quarterly* 430.

⁷⁶⁹. Tammo Wallinga, 'The Common History of European Legal Scholarship' (2011) 4 *Erasmus Law Review* 3.

with an emphasis on the utility and the instrumental value of the system and the process to peoples' affairs.⁷⁷⁰ Japan also has no principle of *stare decisis*, and so any legal precedent is not intrinsically binding, but the judiciary treats legal precedent as useful for elucidation, all the same, and legal cases decided by the Supreme Court enjoy a hierarchically higher position.⁷⁷¹

Superficially, it appears that the Japanese courts operate *per curiam*, in deciding cases, as judicial decisions are issued anonymously, but there is ample room for Japanese judges to deviate from the majority opinion and reflect on fact and law. The decision of the case is the majority opinion, and optional minority, opposition and supplementary opinions may be issued. Although on the face of it, the opposition and minority opinions are also anonymous, yet they are produced by dissenting judges, whether the phenomenon is referred to as dissent or not. The transcripts are terse, as Civil Law transcripts tend to be – certainly compared to the verbose common law transcripts.⁷⁷²

The Japanese civil courts operate in an adversarial way, which has been one of the changes to arise out of the MacArthur era, as the traditional Romano-Germanic paradigm was the inquisitorial form of litigation,⁷⁷³ which was in place in Japan until the commencement of Allied control.

Criminal justice is somewhat different, as there is arguably no presumption of innocence in the western sense and with pre-trial confessions being the norm, the conviction rate is

⁷⁷⁰ Haley, *Authority without Power* (n 31) 17.

⁷⁷¹ Shigenori Matsui, 'Constitutional Precedents in Japan: A Comment on the Role of Precedent' (2010) 88 Wash. UL Rev. 1669.

⁷⁷² Itoh (n 327).

⁷⁷³ Jinkyoo Lee, 'Myth of Inquisitorial Civil Proceedings in Civil Law Tradition' (2013) 12 Asian Business Lawyer 57.

remarkably high and convictions are all but assured and seemingly dependent on prosecution taking an interest in the case.⁷⁷⁴ As stated, Japanese civil judgments are very brief, and a Supreme Court judgment is generally not much longer than perhaps 3-8 pages in length.⁷⁷⁵

This is perhaps contrary to what one might expect in light of the adversarial nature of the civil procedure, but it is critical not to overstate the importance of judicial precedent and the eloquence and elucidatory value of judgments. As there is no principle of *stare decisis*, judges are technically completely free to depart from any previous legal decision if they see fit to do so, and they are bound only by positive, enacted laws. At the same time, the Supreme Court tends to follow its own precedent, and it has the power to reverse the decisions of a lower court. This is not, technically, precedent, yet the judicial process is controlled by the Supreme Court in the fashion of quasi-legal precedent.⁷⁷⁶

In a conceptual sense, the Supreme Court, or any Japanese court, is not taken to have departed from the law, and the position of the law is very clear. A court is, instead, taken to have ‘distinguished’ the case to answer based on its differences of fact, which is not a dissimilar process to the way the matter is handled under common law.

It is often extremely hard to succeed in a common law court with a policy argument, and this would seem to be very similar if not further exacerbated in Japan because Japanese judges are characterised by restraint, rather than activism, and Japanese litigants do not make policy arguments for the most part, because the Japanese judiciary has no right to embark on activist

⁷⁷⁴. Etsuko Sugiyama, ‘Simplified Civil Procedure in Japan’ (2015) 8 *Erasmus L. Rev.* 201.

⁷⁷⁵. Coverdale (n 626).

⁷⁷⁶. Itoh (n 327).¹

adventures, modest or bold.⁷⁷⁷

It is questionable whether any judiciary can practice perfect and complete restraint, and likewise it is also impossible to argue that Japanese judges only ever ascertain the law, because the fallibility, imperfection and incomplete nature of the law presupposes some level of legal uncertainty where someone must fill the *lacuna* or gap in the law. There is also an unusual contrivance of the Japanese judicial hierarchy whereby courts expressly limit the authority of their own decisions.

Obiter Dicta are intimately familiar to all in the common law jurisdictions, and what the Japanese judges do is somewhat similar. In the case of *obiter*, a subsequent court looks at the case and determines whether an element of the holding pertains to the *ratio decidendi*, yet a Japanese court can highlight a decision as having no power of precedent by citing the same litigation in the Hanreishuu, a type of law report meant for public and extra-judicial use, as citing the internal Saibanshuu, meant for judicial use, might otherwise create precedent.⁷⁷⁸

Much of the Japanese law arises out of pragmatism and practical excellence. Japanese legal education is concerned with the eminence of practical knowledge, and Japanese texts make only passing mention of underlying theory, and the entirety of Japanese cultural and legal history seems to support the idea that the Japanese have not, historically, been beholden to strong absolute, normative philosophical principles. Individuals within society have likely had strong personal values and value systems, but no rigid adherence to an externally

⁷⁷⁷. *ibid.*

⁷⁷⁸. *ibid.*

imposed doctrinal regime.⁷⁷⁹

While feudal Japan had produced the Bushidou or Way of the Warrior – a rigid martial code⁷⁸⁰ – but even this is a weak argument as the Bushidou functionally the same as *Noblesse Oblige* in the context of western nobility: a romanticised summation of the rights and responsibilities of the feudal elite. The warrior code was a useful tool to ensure that the interests of the elite are protected and to prevent undesired vertical mobility.⁷⁸¹

Similarly, the native Japanese religion is Shinto – a type of animism, which has no centralised or even localised dogma or moral teachings, apart from fragmentary parables and tales involving the gods and goddesses of the land. Furthermore, the counterpart of Shinto is Buddhism, and Japanese society, over the centuries, successfully accommodated both religions alongside one another, melding them harmoniously, in a way which, in the long term, had avoided major sectarian and religious tensions between Shinto and Buddhism.⁷⁸² A growing modern influence is Christianity, and Japanese people will often combine elements of the three religions in their ordinary lives in a non-hierarchical fashion.⁷⁸³

Based on the evidence presented above, the Japanese are pragmatic about their religious and legal-political affairs in a way the west has not often been. The earliest beginnings of endogenous Japanese philosophy and, consequently, Jurisprudence have likely been overshadowed if not erased by the cultural influence of T'ang China, yet the Ritsuryou system

⁷⁷⁹. Haley, *Authority without Power* (n 31) 17.

⁷⁸⁰ David L Davis, 'The Evolution of Bushido to the Year 1500' (1978) 13 *Journal of the Oriental Society of Australia* 38.

⁷⁸¹. George W Bouldin, 'Japanese Ethics' (1921) 18 *Review & Expositor* 63.

⁷⁸². Robert S Ellwood, 'Shinto and the Social Order' (1972) 14 *Journal of Church and State* 43.

⁷⁸³. Eiichiro Takahata, 'Religious Accommodations in Japan' [2007] *BYU L. Rev.* 729.

was unable to create a lasting Confucian influence in a society with a pre-feudal and later feudal ordering.⁷⁸⁴

With the arrival of modernity, it was likely too late to begin developing a native philosophy to inform jurisprudence and a body of laws – this was not the era of major ethnogenesis, and much of the cultures of the world, including the Japanese culture, were already mature and fully-formed.

The west has often been a battlefield of philosophies and moral codes, intertwined with religion and much of Hellenic and Christian philosophy was concerned with normative ethics and metaphysics. This can also be seen when looking at modern Japanese society. The Japanese electorate is largely apolitical, the Japanese school curriculum is almost completely centralised and the Liberal Democratic Party has been at Japan's helm for over four decades.⁷⁸⁵

To a western observer this might seem like a political issue or problem, and likely an impediment to democracy, but the pragmatism of Japan also seems to create political efficiency, as Japan has never been mired in internecine philosophical conflict in the way the west has often been. This is not a criticism of either paradigm, merely a reflection on the different priorities of the two.

Considering the differences, one might expect that Japanese trade mark law ought to be quite

⁷⁸⁴ Haley, *Authority without Power* (n 31) 17.

⁷⁸⁵ Gary W Cox, Frances M Rosenbluth and Michael F Thies, 'Mobilization, Social Networks, and Turnout: Evidence from Japan' (1998) 50 *World Politics* 447.

unlike its UK counterpart, but this is not the case. Japanese trade mark law and intellectual property more widely is much in line with that in the UK.⁷⁸⁶

Japan is a major economic power and it has been participating in the global economy in a very active and successful fashion, and there does not seem to be a good reason to bring its trade mark system out of alignment with the remainder of the international business community.

This matter, in turn, leads to the jurisprudential elements of the historical and comparative discussion. The jurisprudential model of Ronald Dworkin has been used to describe systems of law, with a special focus on judicial law, and to understand them in terms of a dynamic continuum of legal principles.⁷⁸⁷

In the context of the UK/EU, despite a rich jurisprudential history, it is difficult to say that any particular legal theory or theorist would enjoy clear primacy from a strictly practical standpoint -- not, in any case, in the same vein as the American legal realist movement or phenomenon.⁷⁸⁸ However, it is also the case that in the academic context, legal theory is readily available in the UK and both the UK and the EU have a history of legal theoretical analysis and jurisprudential discussion.

The United Kingdom has a prominent legal-cultural tradition. Judicial and other legal

⁷⁸⁶ *Supra* 4.15

⁷⁸⁷ Russell L. Caplan, 'Professor Dworkin's Jurisprudence' (1977) 22 *Am. J. Juris.* 118.

⁷⁸⁸ Richard A Posner, 'Legal Formalism, Legal Realism, and the Interpretation of Statutes and the Constitution', *Precedents, Statutes, and Analysis of Legal Concepts* (Routledge 1998).

institutions and features are innately linked to tradition. In contrast with the United Kingdom, while Japan has robust cultural and historical roots with respect to the legislative element of the state (it is a monarchy, after all), the Japanese legal system is now largely a construct of historical legal transplants with no surviving, vestigial elements of the legal system, such as Udal law⁷⁸⁹ in the case of Scotland, or many traditional (and Udal-based) elements of Manx law.

In terms of legal theory and all of the theoretical underpinnings of the Japanese legal system, it is 'all business', in that the Ritsuryou code had fallen into desuetude leading up to the era of the Shogunates, but the administrative regimes of the Shogunates era failed to yield anything like a complete code of laws for the governance of a state and subjects, written or unwritten.⁷⁹⁰

The legal transplants which have shaped Japan to become a Romano-Germanic legal system and subsequently the reforms/legal transplant implemented under the auspices of the United States have brought the legal system of Japan in line with Western legal systems in terms of its fundamental character and functioning.⁷⁹¹

However, in contrast with most Western legal systems which trace their roots at least partly to the common law or civil law or both. Japan, on the other hand, has a legal system which has been assembled out of foreign components for purely pragmatic reasons.⁷⁹²

⁷⁸⁹ Eileen Linklater, 'Udal Law—Past, Present and Future' [2002] Glasgow: University of Strathclyde.

⁷⁹⁰ Haley, *Authority without Power* (n 31) 17.

⁷⁹¹ R Daniel Kelemen and Eric C Sibbitt, 'The Americanization of Japanese Law' (2002) 23 University of Pennsylvania Journal of International Economic Law 269.

⁷⁹² Hideo Tanaka, 'The Role of Law in Japanese Society: Comparisons with the West Note' (1985) 19 University of British Columbia Law Review 375.

Trade mark law and trade marks cross national boundaries very easily. Trade marks and other such symbols are used virtually universally across the world, and it is altogether very common and not unusual for such marks to cross national boundaries in the course of trade. The World Intellectual Property Organization is in charge of overseeing and administering multiple intellectual property treaties, many of which pertain, at least in part, to trade marks.

WIPO is the foremost global organisation tasked with the development and harmonisation of intellectual property laws, but harmonisations exist elsewhere too, such as, for instance, the community trade mark in the EU.

To understand the respective trade mark registration regimes, it is important to trace their historical development, especially in the context of the circumstances which have given birth to the trade mark regimes and brought about their gradual evolution over the course of several centuries.

Trade marks are an instrumental system, which means that they were created, developed and they are presently used to fulfil specific purposes in protecting valid trade mark registrations. Accordingly, the current configurations of the present trade mark regimes in Japan and the United Kingdom have developed in response to the needs, disposition and demands of the respective societies.

These trade mark regimes developed not in a random and unpredictable, but in a causal fashion and, by identifying the causal origins of the trade mark regimes, it is possible to infer

why contemporary trade mark regimes are such as they are. Ostensibly, it appears that there is a great degree of convergence in terms of the objectives and broad principles and concepts within trade mark regimes, including trade mark regimes which are not geographically, linguistically and culturally very proximate, such as the United Kingdom and Japan.

One of the main objectives of this thesis is to investigate this ostensible convergence with relation to moral principles in the context of trade mark registration, which warrants an analysis of how the trade mark regimes evolved from various localised, rudimentary systems of protections into a broad and inter-connected global trade mark Infrastructure.

Although this paradigm is not unusual in the evolution of states and laws, contemporary trade marks are dependent on a more robust system of property law. A modern trade mark is a type of property right or, at the very least, it is akin to a property right in many ways. Although there is some theoretical discussion as to whether intellectual property rights are truly property rights, they are valuable tools in the hands of legal and natural persons. These tools are used at the initiative and in furtherance of the purposes of the proprietor and they endow the proprietor with certain monopolistic powers which it may wield to its own benefit with relative discretionary power.

In contrast with this, the historical system of itinerant justices – the progenitor of the common law, or the administrative justice system of the shogunates were not systems which were predicated on the idea of granting the populace a system for the regulation of ownership of corporeal and incorporeal rights. The purpose of the historic systems was merely to resolve disputes in the understanding that internecine conflict would undermine the

productivity and the efficacy of subjects. It was not intended that the subjects should enjoy rights which would converge to form an Infrastructure of rights which would autonomously regulate the broader economic Infrastructure. It was simply that the administrative regimes had a strong preference that squabbling subjects should return to their productive activities.

To produce a comparative analysis of the two respective UK and Japanese trade mark regimes, it is important to consider the historical background of the two systems. Historically the precursor states to the modern United Kingdom and Japan were very similar in their jurisdictional character. In the aftermath of the Norman conquest, Henry II despatched itinerant justices to adjudicate in matters of law throughout the realm. Conceptually, this was an element or a behaviour of the regulatory state. The itinerant justices were not tasked with enforcing a code in the vein of, for example, the Visigothic Code, which was a case of top-down legislation. The purpose of the justices was to simply to provide a framework capable of creating and maintaining a level of order which was adequate to support the Infrastructure of the state.

Competition between providers of goods and services was inevitable and centuries after the despatch of the itinerant justices, the common law evolved passing-off as an instrument to deal with matters of trade marks in the wider sense. In this way, passing-off was the precursor and progenitor of trade marks. It served as the original judicial system for the protection of goodwill. Modern trade marks are, in contrast with passing-off, exclusionary property rights. However, passing-off also has an exclusionary effect to the extent that it proscribes behaviour which meets its requirements of goodwill, misrepresentation and damage.

However, despite its impressive rise and evolution passing-off was still not a system or form of property right or ownership. Much like the procedures of the mediaeval regulatory state, passing-off was and remains procedural and reactive, failing to confer title. Passing-off focuses solely on the nature of the use of a mark, rather than putting any emphasis on the relationship between proprietor and thing. Passing-off is a vestige from a goodwill protection system that has never been reified, one which is altogether agnostic of rem.

The industrial revolutions, however, brought about such a saturation of providers of goods and services, that passing-off as the sole regulator of trade indications became insufficient and unable to support a robust system of competition based on reputation and goodwill. Accordingly, trade mark regimes have evolved in the wake of and in response to modern economic and *Infrastructural* realities in the United Kingdom (and elsewhere, for that matter).

The principal ostensible difference between the United Kingdom and Japan is in the number and extent of legal transplants which Japan had incorporated into its legal system over the centuries. Although the United Kingdom has been influenced by legal trends and developments in proximate countries, it has not experienced an imposition of major legal-cultural changes since the Norman conquest. The evolution of the common law since its inception in the aftermath of the conquest has been an organic process. Japan, in contrast, has much less historic jurisdictional continuity on account of the various legal transplants which have supplanted inchoate domestic legal concepts and paradigms which, as a result, never developed into mature, domestic jurisdictional foundations.

The history of England is very much the history of the common law. The system originated in and hails from the British Isles, but it incorporates not only the legacy of regional customs as restated by itinerant justices as the common law and developed over the centuries, but also, to a small extent, a trace of Canon law and Roman law, as explained above. Japan, on the other hand, has its legal roots, ostensibly, in the Confucian legalcultural transplant received from China. One might expect, therefore, that Japan is not a "Western" jurisdiction, whatever the word even truly connotes, and there is certainly historical support for the claim. It is a fact that the nation, for the most part of its existence, has had little to do with Western legal traditions. As we have seen, since the very beginning of Japanese jurisprudence and all the way up to the second set of continental legal transplants, Japan has been a public law legal system. For the greatest part of the civilisation's existence, people did not enjoy actionable legal rights in a manner reminiscent of Roman legalism, and people knew the law only as something onerous. Curiously, when the itinerant justices of England set out to administer justice in the far corners of the realm, the focus was on fulfilling a demand – that judges help people settle their disputes. It is not that Henry II saw the value of abstract legal rules in the lives of his subjects, and it is most certainly not that he recognised the value of intestate succession per stirpes. Instead, he saw, as did the vast majority of monarchs, that little tribute flows from a peasantry mired in internecine, local squabbles. In this sense, his attitude was not all that different from the ritsuryou governance, or the shoguns that succeeded it. The crux of the matter was not that normative values had to be enforced through positive law, but that disputes had to be settled because they are a destabilising social ill. Henry II proved wise in opting to elevate customs, because they already had firm roots in the minds of his subjects, which might go to explain why the Sinicised ritsuryou system only lasted a few centuries before people reverted to doing what they would, in any case,

have done 16 according to custom and habit.

To answer the question of whether Japan has a "Western" legal system is roughly to answer the question: how Confucian is Japanese law? There is now a popular view amongst laity as well as lawyers, in part cultivated by superficially contrasting the Japanese legal system with that of the United States, that the Japanese are less litigious than their non-Japanese counterparts. That, perhaps, Japan is, after all, the land of social harmony (Wa - 和) and conciliation. The problem with this kind of thinking is that it oversimplifies things. Firstly, rates of litigation are not indicative of how reliant a nation is on positive law. As a corollary, neglecting to bring matters before a court is not evidence of having, in some romantic, Confucian sense, transcended the need for laws. Although Japan is most frequently compared with the US, a comparison with the UK provides a similar result. The UK is governed, to a significant extent, by common law, as far as laws go. The judiciary has a greater level of freedom and generally exercises less judicial restraint than their civil law counterparts. Indeed, a large portion of UK law is a result of judicially evolved law. English courts are empowered to grant equitable remedies and, indeed, the very system is historically a system of effective, pragmatic remedies. Furthermore, the UK has a population which is very diverse. Conversely, Japan has, since the Meiji reordering, a Germanistic legal system characterised, as it normally is, by a relative degree of judicial restraint and reluctance to risk inconsistent judgments and apparent retroactivity of law, and there is a clear emphasis on statutory law. Finally, Japan is a largely homogeneous country ethnically and racially. Considering the above, it is reasonable to make the claim that it is not that the Japanese are unconcerned with the provisions of the law, it is simply that the clarity and predictability of judicial outcomes is such that often litigation can be avoided altogether. In other words,

Japan is a legal system firmly governed by positive law, but it is very simplistic to say that positive law prospers only where judicial use is made of it. It is absurd to think, for example, that a personal injury case where a reckless driver knocked over a pedestrian, then reversed on him five times, only to, promptly, drive away whilst holding four mobile phones – two in each hand, somehow – would be settled by the two parties exchanging curt bows, then proverbs in a ritualistic fashion, only to then agree on a public apology. Simply put, as far as legal claims go, the driver has the legal equivalent of a slingshot, whereas the victim is loaded for bear. There is nothing intrinsically joyous about litigation, and its whole purpose, from the perspective of the individual, is to assist in extracting some manner of advantage. In this case there is no reason to litigate because that advantage can be extracted without lengthy court proceedings for the simple reason that the driver will cave in and give and woe betide him if he is foolish enough to try to litigate. He will want to settle out of court because there is clarity and predictability of judicial outcome – it is not as if he can weasel his way out of his predicament. It is the presence of such factors that warrants, indeed demands, a realist view, as a strictly legalistic and formulistic approach cannot, adequately, engage with such issues.

Naturally, the above claims are general statements and the personal injury example is very clear cut – perhaps even unfairly so. In practice, it is quite difficult to paint an entire culture and the associated legal system with the same brush. Family law, while it has undergone considerable changes, remained of the same magnitude as before in that it regulates matters such as marriage, divorce, paternity and so on. But where the embryonic form of trade mark law might have dealt with talented tradesmen with some domestic repute, it now regulates indicia used by corporations, some of which are possessed of such economic and political

influence as to rival smaller states. Insofar as the history of indicia of origin is concerned, Port notes that there is a tendency on the part of Japanese scholars to begin their expositions of Japanese trade mark history with the Meiji reception of Germanistic law. The tendency is to downplay the importance of historical laws regulating the field, and it is a compelling argument that this is, in part, because those systems are not extant, and current legislation has departed from the historical laws. In truth, Japan had a sophisticated system of trade indicia, that, in terms of the underlying theory could well be expected to be seen in a modern setting. As far back as the *ritsuryou*, the Japanese formally recognised the value of using indicia to identify the source of goods, and one of the oldest trade mark cases – the *Rokuseimon* case involving counterfeit sake - originates from 15th century Japan. In contrast with modern Japanese trade mark law, however, the historical law was dependent not on registration but on use and there was no trade mark registry, although sake manufacturers did create their own in the 1600s, but that is neither a legislative affair nor, indeed, a judicial one.

The UK's background is rather similar in that prior to the 19th century changes, trade mark law was largely non-statutory and use-based. In the UK the Trade Marks Registration Act 1875 was responsible for establishing a system of registration, whereas in Japan this was accomplished through the Trademark Regulations of 1884, which in the same vein created a registration based system. Although the law is, of course, a process rather than a terminal state of being, but the aforementioned instruments had a formative effect on trade mark law in the two countries, and defined the nature of their systems. There were numerous changes on both ends, but space constraints do not permit a lengthy discussion of all particulars.

6.3 *History of Trade Mark Rights*

Trade mark law and trade marks cross national boundaries very easily. Trade marks and other such symbols are used virtually universally across the world, and it is altogether very common and not unusual for such marks to cross national boundaries in the course of trade. The World Intellectual Property Organization is in charge of overseeing and administering multiple intellectual property treaties, many of which pertain, at least in part, to trade marks.

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To understand the respective trade mark registration regimes, it is important to trace their historical development, especially in the context of the circumstances which have given birth to the trade mark regimes and brought about their gradual evolution over the course of several centuries.

Trade marks are an instrumental system, which means that they were created, developed and they are presently used to fulfil specific purposes in protecting valid trade mark registrations. Accordingly, the current configurations of the present trade mark regimes in Japan and the United Kingdom have developed in response to the needs, disposition and demands of the respective societies.

These trade mark regimes developed not in a random and unpredictable, but in a causal

fashion and, by identifying the causal origins of the trade mark regimes, it is possible to infer why contemporary trade mark regimes are such as they are. Ostensibly, it appears that there is a great degree of convergence in terms of the objectives and broad principles and concepts within trade mark regimes, including trade mark regimes which are not geographically, linguistically and culturally very proximate, such as the United Kingdom and Japan.

One of the main objectives of this thesis is to investigate this ostensible convergence with relation to moral principles in the context of trade mark registration, which warrants an analysis of how the trade mark regimes evolved from various localised, rudimentary systems of protections into a broad and inter-connected global trade mark Infrastructure.

Although this paradigm is not unusual in the evolution of states and laws, contemporary trade marks are dependent on a more robust system of property law. A modern trade mark is a type of property right or, at the very least, it is akin to a property right in many ways. Although there is some theoretical discussion as to whether intellectual property rights are truly property rights, they are valuable tools in the hands of legal and natural persons. These tools are used at the initiative and in furtherance of the purposes of the proprietor and they endow the proprietor with certain monopolistic powers which it may wield to its own benefit with relative discretionary power.

In contrast with this, the historical system of itinerant justices – the progenitor of the common law, or the administrative justice system of the shogunates were not systems which were predicated on the idea of granting the populace a system for the regulation of ownership of corporeal and incorporeal rights. The purpose of the historic systems was merely to

resolve disputes in the understanding that internecine conflict would undermine the productivity and the efficacy of subjects.⁷⁹³ It was not intended that the subjects should enjoy rights which would converge to form an Infrastructure of rights which would autonomously regulate the broader economic Infrastructure. It was simply that the administrative regimes had a strong preference that squabbling subjects should return to their productive activities.

To produce a comparative analysis of the two respective UK and Japanese trade mark regimes, it is important to consider the historical background of the two systems. Historically the precursor states to the modern United Kingdom and Japan were very similar in their jurisdictional character. In the aftermath of the Norman conquest, Henry II despatched itinerant justices to adjudicate in matters of law throughout the realm.⁷⁹⁴ Conceptually, this was an element or a behaviour of the regulatory state. The itinerant justices were not tasked with enforcing a code in the vein of, for example, the Visigothic Code, which was a case of top-down legislation. The purpose of the justices was to simply to provide a framework capable of creating and maintaining a level of order which was adequate to support the Infrastructure of the state.⁷⁹⁵

Competition between providers of goods and services was inevitable and centuries after the despatch of the itinerant justices, the common law evolved passing-off as an instrument to deal with matters of trade marks in the wider sense. In this way, passing-off was the precursor and progenitor of trade marks. It served as the original judicial system for the protection of goodwill. Modern trade marks are, in contrast with passing-off, exclusionary property rights.

⁷⁹³. Barker (n 52).

⁷⁹⁴. Yorke (n 48).

⁷⁹⁵. Plucknett (n 49).

However, passing-off also has an exclusionary effect to the extent that it proscribes behaviour which meets its requirements of goodwill, misrepresentation and damage.⁷⁹⁶

However, despite its impressive rise and evolution passing-off was still not a system or form of property right or ownership. Much like the procedures of the mediaeval regulatory state, passing-off was and remains procedural and reactive, failing to confer title.⁷⁹⁷ Passing-off focuses solely on the nature of the use of a mark, rather than putting any emphasis on the relationship between proprietor and thing. Passing-off is a vestige from a goodwill protection system that has never been *reified*, one which is altogether agnostic of *rem*.

The industrial revolutions, however, brought about such a saturation of providers of goods and services, that passing-off as the sole regulator of trade indications became insufficient and unable to support a robust system of competition based on reputation and goodwill. Accordingly, trade mark regimes have evolved in the wake of and in response to modern economic and *Infrastructural* realities in the United Kingdom (and elsewhere, for that matter).

The principal ostensible difference between the United Kingdom and Japan is in the number and extent of legal transplants which Japan had incorporated into its legal system over the centuries. Although the United Kingdom has been influenced by legal trends and developments in proximate countries, it has not experienced an imposition of major legal-cultural changes since the Norman conquest. The evolution of the common law since its inception in the aftermath of the conquest has been an organic process. Japan, in contrast,

⁷⁹⁶ *Reckitt & Colman Products Ltd v Borden Inc (No.3)* [1990] R.P.C. 341 (n 144).

⁷⁹⁷ Haley, *Authority without Power* (n 31), 17.

has much less historic jurisdictional continuity on account of the various legal transplants which have supplanted inchoate domestic legal concepts and paradigms which, as a result, never developed into mature, domestic jurisdictional foundations.

6.4 *The Continuity Issues in Japanese Legal History*

The problem with this position is that Japanese statutory law is not overflowing with theoretical explanations, much like statutory law in the UK is also mostly silent or rather terse in providing exposition of underlying normative principles and reasoning. Judicial cases in the UK tend to be verbose and elucidatory with regard not only to the *rationes decidendi*, in terms of the underlying reasons for the particular judgment, but also by providing frequent helpful remarks by way of *obiter dicta*.

Japanese judges are not activist to a significant degree, and Japanese law is not a product of theoretical ponderings and an uninterrupted legal tradition of metaphysical and epistemological contemplation of matters of normative ethics, religion and philosophy.

Certainly,⁷⁹⁸ Japanese judges have a degree of freedom in distinguishing the facts of cases so as to influence the outcome of a case, but they would struggle to produce a clear normative principles, position or bases if required to ascertain the nature of a continuum of historic legal principles which will have been severed as far back as 645 during the reign of Emperor Koutoku,⁷⁹⁹ when the Ritsuryou system had disconnected the Japanese Court from the beginnings of the endogenous legal system and therefore legal principles.

The Japanese legal edifice did not appear to have inherited the interest in the legal history and jurisprudence associated with Romano-Germanic law. Japanese judges appear more

⁷⁹⁸ Itoh (n 353).

⁷⁹⁹ Bruce L Batten, 'Foreign Threat and Domestic Reform: The Emergence of the Ritsuryō State' [1986] *Monumenta Nipponica* 199.

likely to fall back to the principle of judicial restraint and decide cases in a positivist fashion.

6.5 *The Origins of Regional and National Legal Systems*

Part of the historical analysis revolves around the origins of the respective legal systems. The first chapters describe the beginnings of the two legal systems, with reference to the later legal developments which have led, in the case of the UK, to the unbroken continuity of the common law and, by contrast, in Japan, to a series of legal transplants which have all but erased the traditional Japanese system of law before it could even emerge on the historic, regional arena.⁸⁰⁰

The erasure of the indigenous Japanese legal system and conversely the preservation and consolidation of the UK precursor legal systems makes the comparison particularly valuable. This is because of its ability to demonstrate that global economic and political forces are able to bring about legal convergence, despite the factual tendency for divergence. As discussed above, no indigenous trade mark system arose in the context of Japan in modernity, and the indigenous UK trade mark regime is only vestigial alongside the modern trade mark regime, taking the form of the common law tort of passing-off.⁸⁰¹

With the growth of the trade mark attorney profession and the growing sophistication of intellectual property and trade mark systems, it is unlikely that passing-off will ever assert its primacy and afford protection comparable to that of trade mark rights.

The law of passing-off is of interest to the thesis because it is both a historic precursor to trade marks, and it is, in the UK, an alternative or parallel system which is often present

⁸⁰⁰. *Supra* 6.2

⁸⁰¹ Lilienthal (n 522).

alongside trade mark actions in legal proceedings. Passing-off somewhat overlaps the domain of trade marks, and there are situations where trade marks are unable to supply a remedy and litigants choose to rely on passing-off instead, albeit typically as an alternative or less preferred option.

The Japanese regime does not possess the level of protection afforded to UK unregistered marks on account of the law of passing-off.⁸⁰² Indeed, the Japanese system is perhaps more straightforward in the sense that it is truly a system predicated on registered marks only, with little significance afforded to unregistered marks, and only to the extent they possess a level of nationwide or regional reputation or fame.⁸⁰³ This is demonstrated by the fact that much of the Japanese litigation revolving around the protection of unregistered marks comprises cases which are not borderline cases. The courts were faced with difficult decisions in fashioning the remedies which they have created to serve the immediate needs of the litigation, but there was never significant moral uncertainty or dilemma as to the impropriety the case was focussed on.

Much of the moral difficulty in the cases resulted from the innate impulse of the judges to refrain from overstepping their judicial boundaries, and the cases where unregistered marks were successfully protected are stark, unusual and form very much the exception to the typical outcome in the case of an unregistered mark where there is no moral issue, and no significant regional or nationwide reputation.⁸⁰⁴

⁸⁰² *Supra* 3.5

⁸⁰³ *Ibid*

⁸⁰⁴ *Ibid*

This is broadly in line with the pragmatism of incorporating legal transplants on an instrumental basis, because such a system is perceived to be functionally adequate. From the perspective of the Japanese system, passing-off might seem like an all but vestigial, archaic system which offers a measure of protection which might seem all but unnecessary in light of the availability of trade marks. Trade mark registration in Japan, as in the UK, is inexpensive, after all.⁸⁰⁵ The Japanese trade mark regime is truly registration based and heavily invested in trade mark registration, to an even greater extent than the UK, which is also a quintessentially registration-based system.

This in many ways parallels the developments in Japanese legal history, where there is also a noticeable progression from the rudimentary procedural legal framework to a much more sophisticated top-down, legislative successor in response to profound societal and economic changes, as discussed above.⁸⁰⁶

Historically, trade mark regimes have developed and continued to evolve within specific jurisdictions, to a point. While there were goods and services which crossed national boundaries, and the *lex mercatoria*,⁸⁰⁷ the principles and laws of medieval commerce influenced economic relations between commercial entities trading across national boundaries, there was no harmonisation on a scale such as exists today.

It is important to understand the historic beginnings of the two jurisdictions and their

⁸⁰⁵ *Supra* 3.5.6

⁸⁰⁶ Haley, *Authority without Power* (n 31) 17.

⁸⁰⁷ Alfred H Marsh, 'Japanese Law and Jurisprudence' (1903) 1 *Commonwealth Law Review* 217.

respective trade mark regimes, but as the contemporary trade mark economy is the end destination for analysis in terms of chronology, it is vital to understand the international trade mark ecosystem in the context of global commerce and harmonisation as well.

The presence of the most significant genetic precursor of the contemporary Japanese people, the Yayoi have arrived in Japan in the 3rd century BC, whereas the Joumon people, who account for a smaller cultural and genetic contribution, have lived in Japan a long time before this. The Etruscan civilisation was established around the time of the 9th century BC and went on to develop the primeval layer in the customary and legal system of the later Roman civilisation of Latium, contributing the Etruscan religious dogma which would later give birth to many features within the early Roman legal regime.

One of the most significant questions of this thesis, in the legal realm is, how did thousands of years of legal evolution produce culture agnostic trade mark regimes, irrespective of the trajectory and the legal conservatism (in the literal sense) of one of the two cultures? In simple terms, the needs of global commerce prevailed over cultural impulses and the conservation of endogenous systems of law.

6.6 *Historic Convergence of Legal Paradigms*

Historically, the Japanese and UK legal systems have evolved from culturally very different societies. Despite the numerous cultural differences, the historic and the contemporary human experience of the people who have constituted and continue to constitute legal systems is not altogether very dissimilar. Virtually all historic legal systems are traceable to a body of typically unwritten customary norms and rules,⁸⁰⁸ and in this respect, the UK and Japan are no different. The cardinal historic difference is in the fact, that the traditional, customary roots of Japanese law have been largely discontinued in the course of a series of judicial transplants which have supplanted the nascent, indigenous Japanese legal system before it could develop into a fully-fledged legal regime.

The roots of the contemporary Japanese legal system lie in the legal systems which have influenced it throughout the various historic stages of legal evolution, ranging from Confucian Legalism⁸⁰⁹ in the form of the Ritsuryou code, through the Romano-Germanic (and to some extent French) legal transplants,⁸¹⁰ to the American Common Law influences in the aftermath of WWII.⁸¹¹

The UK legal system, in contrast, evolved in a continuous fashion since its inception. It is a composite legal tradition, consisting of the various influences of local bodies of custom and law, and it has been influenced, in terms of its vocabulary and internal theory, by Roman and Canon law, albeit the UK legal system had travelled an altogether different of path.⁸¹²

⁸⁰⁸. Edmundson (n 742).

⁸⁰⁹. Holcombe (n 746).

⁸¹⁰. Chen (n 764).

⁸¹¹. Kelemen and Sibbitt (n 791).

⁸¹². Plucknett (n 49).

Despite the numerous differences, both legal systems have sophisticated, mature trade mark regimes, and both trade mark regimes are remarkably similar in terms of their functional elements. Despite the differences of the historic evolution of the two regimes, both Japan and the UK are largely compliant with and implement the WWT (WTO-WIPO-TRIPS) intellectual property template.⁸¹³ Due to market forces, there is an increasingly more powerful harmonising force in the field of IP, the implementation of the WWT template is one of its hallmarks.

Structurally, the WWT template is a module in the sense that it works in a modular fashion and it interfaces with the elements of the legal system which it is implemented by. Because of this interface and modularity, it is possible to implement the WWT template in numerous different jurisdictions, with different types of legal systems. In spite of the differences in legal history between the two legal systems, the outcome of the implementation of their respective trade mark regimes and the WWT template is remarkably similar.

An assessment of the structure of the Trade Marks Act 1994 and the Trademark Act 1959 highlights this fact, as the two statutes are structurally very similar in terms of their provisions on trade mark registration, from a functional equivalency standpoint.

Japan and the UK have various sub-systems of law, such as the law of evidence or the court procedures of the respective Supreme Courts of the two legal systems. All but inevitably, there will be differences in the way the sub-systems are implemented. The procedures of the

⁸¹³ Irene Calboli, 'Trademarks: Trademarks: International Harmonization of National Laws' (2023) <<https://www.elgaronline.com/display/book/9781839105609/b-9781839105609.trademarks.xml>> accessed 28 June 2024.

Japanese Supreme Court⁸¹⁴ and the UK Supreme Court⁸¹⁵ are certain to differ, and there might very well be differences in the precise way the law of evidence on IP matters is implemented, but due to the modular nature of the WWT template, it is able to interface with these sub-systems so as to implement an IP template and a minimum level of protection by being, essentially, legal-system agnostic.

Whether survey evidence is admissible before at trial and the requirements of admissibility are important considerations, however, even where survey evidence in trade mark matters is not admissible, the horizontal effect, across the broader body of persons who use the system, is the same – the admissibility of survey evidence is known by the legal personnel who are responsible for the provision of trade mark law services, and the admissibility or inadmissibility of survey evidence applies with parity across the profession.

Art.(3)(xv) and s.5(1) both state that a mark is not to be registered to the extent that it is liable to cause confusion on part of the public as to the origin of the goods or services. If survey evidence is admissible, the matter of whether the mark applied for is liable to cause confusion can be settled with reference to survey evidence. If survey evidence is not admissible, the matter can be resolved by other evidentiary functions of the underlying legal system. The template, when implement, therefore seamlessly interfaces with the underlying procedural elements of the legal system, and this is true in the context of trade mark regimes in general.

⁸¹⁴. Court Act 1947 (Japan).

⁸¹⁵. The Supreme Court Rules 2009, No. 1603 (L. 17).

6.7 *Japanese Language*

Linguistics can be an important part of comparative law, albeit not all comparative scholarship must focus on linguistics. Some comparative law analyses lend themselves more to discussions of linguistics, and trade mark law is an example of such comparative field – trade marks are intertwined with semantics and meaning, after all.

Trade marks consist of more than just word marks, and many trade marks are not alphanumeric or ideographic – they are simply not written and do not convey lexicographic information. However, writing in trade marks is ubiquitous. Word marks are some of the most numerous trade marks, and in a comparative analysis of trade mark law, it is impossible to forego a discussion of the linguistic differences between the languages of the respective jurisdictions. The English language is an Indo-European language, whereas Japanese is a Japonic language. Japanese is a language isolate, and a clear relationship with other languages is difficult to establish. English falls under the Anglo-Frisian branch of the Indo-European languages.⁸¹⁶

The syntax, vocabulary and the writing systems of the respective languages are so different, that it is necessary to discuss the linguistic differences, as they are so stark that structurally, a word mark can be rendered in altogether different ways and it can carry multiple different definition or connotations across the two languages.⁸¹⁷

⁸¹⁶Patrick V Stiles, 'Remarks on the "Anglo-Frisian" Thesis' [1995] *Friesische Studien* II 177.

⁸¹⁷ *ibid.*

6.8 *The Japanese Language & Writing System*

The Japanese writing system is predicated on the pictographic Chinese lexical symbols received in the 7th and 8th centuries. This fact might seem of limited importance by itself, but this is another example which demonstrates the tendency of careful borrowing on part of Japanese society.

A sovereign entity since its inception as a monarchy, Japan has been exposed to politically powerful states throughout its entire existence, and even during periods of wilful isolation and isolationism. Linguistically, these periods can be broken down into five important phases or periods of cultural influence:

- The pre-literacy era
- The Chinese influence era
- The German influence era
- The Anglophone influence era
- Modernity

The pre-literacy era marks the formative years of the Japanese language, which is when its distinguishing features evolved, which also make it remarkably different from Indo-European languages, and which create a very different background for the purposes of trademark law in the linguistic sense.

The Chinese influence and the era leading up to the pre-WWI Meiji Restoration⁸¹⁸ and German influence and greater international engagement is interesting because of the evolution of the Japanese written language, as the Japanese have centrally adopted the Han Chinese writing system wholesale, allowing the language to undergo gradual changes organically, apart from more recent, modern reforms of the writing system which were imposed in a top-down fashion.

The most ancient Japanese text, the Kojiki, is written in a heavily Sinicised Japanese, the Manyougana (Manyougana 1).⁸¹⁹

In contrast with later iterations of Japanese, Manyougana is a way of representing the Japanese language through essentially unmodified Chinese characters. By the time of the German era, however, Japan has long since evolved its own writing system from its Chinese, Han origins and gradually adjusted it to better suit the morphological needs of the Japanese language.

During the era of the Shogunates and as Japan had been exposed to Western states, it has increasingly become exposed to the linguistic influences of Indo-European languages. The Japanese language is now very rich in loanwords (gairaigo - 外来語) from a host of Western states, virtually all of them predominantly characterised by Indo-European languages.⁸²⁰

⁸¹⁸. Charles R Stevens, 'Japanese Law and the Japanese Legal System: Perspectives for the American Business Lawyer' (1971) 27 Bus. Law 1259.

⁸¹⁹. Robert Borgen and Marian Ury, 'Readable Japanese Mythology: Selections from Nihon Shoki and Kojiki' (1990) 24 The Journal of the Association of Teachers of Japanese 61.

⁸²⁰. James B Brown, 'Is Gairaigo English' (1995) 1 The Internet TESL Journal.

Many of the early loan-words are of German, Dutch or French origin, but modernity and the post-WWII⁸²¹ American political and cultural influence has brought about an explosion of English-derivative vocabulary (Wasei Eigo - 和製英語 cf Sino-Japanese words or 漢語) in the Japanese language.

An important characteristic of Japanese is that it is structurally very different from Indo-European languages. Beyond the differences in subject-object-verb order, and the different writing systems (a pictographic character pool supported by two ‘syllabaries’ cf purely phonetic alphabets in Indo-European languages), Japanese is a morae-timed language.⁸²²

Although outwardly Japanese seems to be constructed using syllables, as the presence of two syllabaries (kana: katakana and hiragana) would suggest, the Japanese language is predicated upon and relies on a system of mora-timing or morae. (Kubozono 2017)⁸²³ Each mora is like a tick of a metronome and serves as a rhythmic⁸²⁴ aid, where syllables are constructed against a temporal template of morae, where the absence of a sound is also a valid use of a mora.⁸²⁵

The moraic system of the language has the effect of causing the aggregate number of available morphological building blocks to become limited. Syllables occupy ‘moracic space’ along the rigidly timed ‘moracic metronome’ and the language subtly takes on the character of musical notation. Because of such rigid construction, the syllable is the smallest functional

⁸²¹ Thomas L. Blakemore, ‘Post-War Developments in Japanese Law’ [1947] *Wis. L. Rev.* 632.

⁸²² Takashi Otake and others, ‘Mora or Syllable? Speech Segmentation in Japanese’ (1993) 32 *Journal of memory and language* 258.

⁸²³ Haruo Kubozono, ‘Mora and Syllable’ [2017] *The handbook of Japanese linguistics* 31.

⁸²⁴ Mary Beckman, ‘Segment Duration and the ‘Mora’ in Japanese’ (1982) 39 *Phonetica* 113.

⁸²⁵ Fusa Katada, ‘On the Representation of Moras: Evidence from a Language Game’ [1990] *Linguistic inquiry* 641.

building block of the Japanese language.⁸²⁶

Although Japanese has free-standing vowels, free-standing consonants are restricted only to the sound 'n'.⁸²⁷ Because words can only be constructed using the mora-based syllabaries, the Japanese language is reliant on the two strategies of additive lengthening word length to create more permutations of the available syllables, vowels and the consonant 'n', and the use of homophonic words. Homophones in Japanese, as in other languages, rely on context and intonation to become distinctive⁸²⁸ and they require the user to make a contextual judgment, whereas the lengthening of words or the creation of combinatorically lengthy words is stylistically taxing and difficult in the context of a living entity such as a language, where coining and popularising words solely for the sake of efficacy has often proven unsuccessful.

Reliance on homophones is liable to create greater complexity and add elements of uncertainty to the language. In the context of spoken Japanese, the user must be able to make the distinction as to which meaning or even connotation of the homophone is used on the basis of all available information.⁸²⁹

In the context of a language such as English, such a distinction is generally easy to make, due to the relative lack of homophones, however the sheer number of homophones in the Japanese language makes the same process very difficult. The Japanese language, in general,

⁸²⁶ Mieko S Han, 'Acoustic Manifestations of Mora Timing in Japanese' (1994) 96 *The Journal of the Acoustical Society of America* 73.

⁸²⁷ John Hinds, 'English and Japanese: A Contrastive Study (1978–1982)' (1982) 3 *Annual review of applied linguistics* 78.

⁸²⁸ Otake and others (n 822).

⁸²⁹ *ibid.*

places great emphasis on a cultural understanding of the language and the language is prone to omission in service to brevity.⁸³⁰

A further contrast with Indo-European languages, including English, is that for example the English writing system is merely an accessory to the language itself (with the exception of the realm of aesthetics, such as calligraphy), and its primary purpose is to assist in rendering the language in written form. The alphabet of most other languages represented with alphabetic script could functionally replace the Anglo-Latin script. English script could be replaced with minimal adjustment by the Glagolitic alphabet used to write Old Church Slavonic, because the morphology of a language can easily be accommodated by any set of alphabetic glyphs sufficient in number.

Japanese, in contrast, comprises overlapping yet distinct written and spoken languages. Full Japanese script (in contrast with partial and assisted script, such as that used by children or non-native learners⁸³¹ in the process of acquiring the language⁸³²) employs a combination of ideographic symbols and syllables from the two syllabaries, one used primarily, but not exclusively, for conjugation and native words (hiragana) and the other for exclamations,⁸³³ foreign words, advertising⁸³⁴ (katakana).⁸³⁵

⁸³⁰. Takahiro Sekiguchi and Yoshiaki Nakajima, 'The Use of Lexical Prosody for Lexical Access of the Japanese Language' (1999) 28 *Journal of Psycholinguistic Research* 439.

⁸³¹. Maya Shiho Kobayashi and others, 'Effects of Mora Deletion, Nonword Repetition, Rapid Naming, and Visual Search Performance on Beginning Reading in Japanese' (2005) 55 *Annals of Dyslexia* 105.

⁸³². Meryl Siegal, 'The Role of Learner Subjectivity in Second Language Sociolinguistic Competency: Western Women Learning Japanese' (1996) 17 *Applied linguistics* 356.

⁸³³. Jeffrey S Bowers, 'Different Perceptual Codes Support Priming for Words and Pseudowords: Was Morton Right All Along?' (1996) 22 *Journal of Experimental Psychology: Learning, Memory, and Cognition* 1336.

⁸³⁴. Laura MacGregor, 'The Language of Shop Signs in Tokyo' (2003) 19 *English Today* 18.

⁸³⁵. Takeshi Hatta and Tsugui Ogawa, 'Hiragana and Katakana in Japanese Orthography and Lexical Representation' (1983) 5 *Language Sciences* 185.

Familiarity with Han-derivative, Chinese characters is an essential requirement of Japanese literacy, and the Han characters, the Kanji (漢字) function in a highly complex fashion as well. Each symbol can have (and often does) up to two different types of reading i.e., the morae-timed syllables it expresses if transliterated into hiragana or katakana or expressed in speech. The two types of readings are the onyomi (the Sino-Japanese reading - 音読み) and the kunyomi (the native reading - 訓読み).⁸³⁶ Multiple readings of a character may exist depending on the kanji, and different readings enjoy varying levels of popularity, which reflects the literary evolution of the language through history.

This often creates situations where the meaning of a word and a consequently a sentence becomes difficult to discern in the absence of a robust context, such as a paragraph of text, or against a background of familiarity between speaker and listener. By parallel, the converse can also happen where a compound word permits of multiple different readings of one or more of its constituent kanji without running the risk of producing a meaningless word. The Japanese spoken and written languages are distinct and they are incomplete without each other and one of their primary or co-equal purposes of the one is to aid the other in disambiguation.

In the Anglophone and Indo-European context, the use of and disambiguation of homophones is not, in itself, an unusual or alien practice, however Japanese script and the spoken language is characterised by an innate and impossible to dispel ambiguity which is intrinsic to the language and disambiguation and clarity can only be achieved through a

⁸³⁶RA Brown, 'Chinese Character Education in Japan and South Korea' (1990) 10 Language and Communication 299.

robust contextual and linguistic understanding.⁸³⁷

Although seemingly irrelevant to the trade mark discussion, an explanation of the linguistic characteristics of the Japanese language is indispensably to the comparison of Japanese and UK/EU law in the context of trade mark registration, especially in relation to confusion and identity.

A Japanese trade mark or rather a trade mark in Japan can acquire multiple connotational and morphological identities, which is only possible because of the nature of the interaction between the writing system and the spoken language. In the context of aural and lexical similarity and confusion, a Japanese trade mark within the Japanese market and the Japanese consumers can often only acquire semantic accuracy or distinctiveness when the written and the spoken languages corroborate one-another. A compound word formed of multiple kanji can be pronounced in multiple ways, all of which are valid, and a spoken word can often likewise be written in a multitude of ways, each of which might carry a different connotation or even meaning. This is quite different from alphabetic systems, as the differences in the way these homophones are written can vary much more than with alphabetic homophones, which are often written in an identical or very similar way.

This area is seemingly not-researched at all in a context other than a purely linguistic or cultural one, so I will proceed by coining the term 'linguistic corroboration' to mean the process used to discern the intended meaning of a written or spoken word in the context of

⁸³⁷ Ping Li and Michael C Yip, 'Context Effects and the Processing of Spoken Homophones' (1998) 10 *Reading and Writing* 223.

trade marks.

It is also important to distinguish the use of a language, but much more importantly Japanese, in the present context, with relation to its stages of expression and interpretation. Compared to English,⁸³⁸ a Japanese expression can be semantically deficient in the expression phase. When a word is uttered or written, absent linguistic corroboration, the lack of contextual data can present a supervening impossibility to the accurate semantic representation of the very same word. In contrast with English, where this is less of an issue due to its linguistic characteristics, in Japanese, the disambiguation (the linguistic corroboration is an important aspect of the disambiguation of the Japanese language) takes place in the mind of the recipient party. Such contextual disambiguation occurs through comprehending, heuristically, the likely connotation or meaning of a particular spoken word on the basis of the preceding conversation or some other piece of contextual information. Shito (しと - /ʃito/ in International Phonetic Alphabet) can be written and disambiguated as 使徒 (apostle, disciple), 使途 (purpose of an expenditure), 司徒 (a ministerial position in multiple Chinese dynasties) or 死都 (ghost town). Some of these compounds have related meanings and feature identical kanji as part of their composition, but even with these, the difference between an apostle and a minister is significant enough that the intended meaning of the word must be determined contextually.

Cognitively, too, language has a significant impact. For example, Lera Boroditsky points out that there is a difference between the agency with which the English, Spanish and Japanese languages describe that someone broke a vase. English clearly highlights the agent, i.e. “I

⁸³⁸. Derek Besner and Marilyn Chapnik Smith, ‘Basic Processes in Reading: Is the Orthographic Depth Hypothesis Sinking?’, *Advances in psychology*, vol 94 (Elsevier 1992).’

broke the vase.”, whereas in Spanish and Japanese there is a tendency to use syntax which omits the direct object, using an intransitive form: “The vase broke”. This even has cognitive implications for the cognitive toolkit which people possess and use to reason about the world. For example, Lera Boroditsky points out that there is a difference between the agency with which the English, Spanish and Japanese languages describe that someone broke a vase. English clearly highlights the agent, i.e. “I broke the vase.”, whereas in Spanish and Japanese there is a tendency to use syntax which omits the direct object, using an intransitive form: “The vase broke”. This even has cognitive implications for the cognitive toolkit which people possess and use to reason about the world.⁸³⁹

Superficially, linguistic corroboration is a purely technical feature of the Japanese language, but this feature of the language means that disambiguation is a more important part of the Japanese language, compared to Indo-European and other alphabetic languages. This means that, in general, the meaning of a compound word comprising multiple kanji and kana for conjugation is relatively easy to ascertain, but choosing the intended and correct and non-infringing reading can be much more difficult, which is why Japanese trade marks, rendered in Japanese, foster a much greater connotational, morphological and definition uncertainty than exists in alphabetic systems, or even in an abjad system such as the Arabic script and derivatives or Imperial Aramaic in the past.

⁸³⁹ Boroditsky (n 378).

6.9 *Japanese Language, Writing System and Implications for Trade Mark Law*

The technical aspects to registrability are perhaps the most remarkable in light of the fact that English is a language predicated on the use of vowels and consonants relatively freely, represented by the Latin alphabet, whereas Japanese is a language predicated on a set of ideographic symbols which are further reducible phonetically to two similar sets of syllabaries which permit of a much less liberal arrangement of sounds, resulting in, at times, a multiplicity of potential readings for a given ideograph and especially for a given compound of ideographic symbols.⁸⁴⁰

This is somewhat comparable to the FCUK⁸⁴¹ case, which concerned the brand French Connection United Kingdom, which when rendered as an acronym is perilously close to a well-known expletive.⁸⁴² The analogy is crude, however, and there is no truly analogous example as, due to the nature of the English language and the manner in which it is rendered in writing, it is not difficult to ascertain how a set of words would be rendered phonetically, therefore there is no disconnection between the phonetic and the lexical⁸⁴³ and consumers need not guess as to the reading of, for instance, FISHERMAN'S FRIEND.

This is not the case with terms such as Mihashira Matsuri (御柱祭), which has at least 4 readings due to the number of permutations the constituent parts of the term give rise to. (In the International Phonetic Alphabet, they are as follows: /mihæɪra sai/, /oŋbaɪra sai/,

⁸⁴⁰ Peter T Daniels and William Bright, *The World's Writing Systems* (Oxford University Press 1996).

⁸⁴¹ *Woodman v French Connection Ltd* [2007] ETMR 8.

⁸⁴² *ibid.*

⁸⁴³ James Stanlaw, *Japanese English: Language and Culture Contact* (Hong Kong University Press 2004).

/mihacira matsuri/, /onbacira matsuri/)⁸⁴⁴ Naturally, as the readings represent different, albeit partly overlapping, phonetic entities in the Mihashira case, with a single, shared lexical identity, aural similarity is rather divorced from thematic and lexical similarity, which is unlike most languages and writing systems.⁸⁴⁵

The reverse can also be true, and it is possible for a single phonetic unit to have multiple lexical expressions. Furthermore, in the case of a mark such as FCUK or as seen in the FOOK case, the average consumer must, as a matter of rule, acknowledge the erroneous spelling of the perceived word, which immediately removes the uncertainty and distinguishes the lexical content of the mark from the correct spelling of the sounds.

This issue is only exacerbated by the nature of trade marks and consumer knowledge as well as the international nature of intellectual property as a whole. The preponderance of all Japanese consumers treat brands, lexical trade indicia as sets of syllables. For ease of pronunciation, Japanese people often convert non-Japanese words into a more familiar syllable format, and this conversion has its own conventions.

Accordingly, not only is a mark such as 御柱祭 liable to cause phonetic confusion in the UK, where, unless and until one of the numerous pronunciations is applied, the readings have different aural characteristics and varying degrees of aural similarity to various other phonetic forms of marks and the problem is compounded by the fact that in Japan, the phonetic form of most marks is likely to change somewhat in the minds of the consumers.⁸⁴⁶

⁸⁴⁴ *Toyoshimaya v Sawa Taisha* (1998) 1660 Han-Ji (Tokyo High Court).

⁸⁴⁵ Port, *Trademark and Unfair Competition Law and Policy in Japan* (n 20) 120.

⁸⁴⁶ *ibid.*

The degree of phonetic change is also dependent on the syllables of the word. Words which contain an abundance of consecutive consonants are liable to change greatly as the Japanese consumer will most commonly interpose vowels between the consonants so as to form familiar syllables, as is customary in Japanese when rendering words which do not otherwise follow this method. This, in turn, means that it is possible for seemingly unrelated and harmless English words to take on phonetic forms which bear an aural similarity to registered marks or other entities which preclude registration or use in the Japanese language.⁸⁴⁷

A further consideration in this regard is raised by the Seirogan case discussed above. Seirogan is a herbal remedy produced in Japan which is exported to a number of countries worldwide. The mark in and of itself is not morally fraught, other than in relation to trade mark dilution and genericide (the extinction of a trade mark due to becoming generic),⁸⁴⁸ which it has suffered in Japan.⁸⁴⁹ However, as a feature of a language predicated on syllabaries, Japanese is phonetically very constrained structurally, and there are far fewer combinatorial options, far fewer phonetic permutations than in the case of languages not restricted to the use of syllables as the smallest building blocks of the language.

Accordingly, it is very simple to transform a compound word into a perfect homophone, which is what happened to the ostensibly innocent herbal remedy. The inoffensive spelling 正露丸 can be converted into 征露丸 which means the ‘Conquest of Russia through Bullets, 丸 being the character corresponding to small balls, bullets, pellets, shells and other

⁸⁴⁷ MacGregor (n 834).

⁸⁴⁸ *Taiko Pharmaceutical v Izumi Yakubin Kogyo*, H18 (ne) 2387.

⁸⁴⁹ Port, ‘Trademark Dilution in Japan’ (n 264).

projectiles both martial and harmless.⁸⁵⁰ To exacerbate this problem, the same word can be written using the syllabaries (kana) used in Japanese, where both 正露丸 and 征露丸 turn into せいろうがん (hiragana) and セイロガン (katakana) respectively. The two words are completely homophonous and therefore completely indistinguishable written in kana, other than through ascertaining the intended meaning from their respective contexts, which can be rather difficult in the case of a trade mark used in a relative contextual vacuum.

Additionally, the repertoire of Japanese trade mark expression is not restricted to Japanese text, be in the form of Japanese words, or foreign terms rendered in Japanese through kana. As commerce and IP are heavily international, it is unsurprising that Japanese undertakings as well as foreign undertakings in Japan make use of indicia which are either not exclusively lexical or use Latin script (as well as, theoretically, other writing systems, although they are far less prevalent).⁸⁵¹

Because of the wide availability of a large number of permutations of text and images, the argument that due to the constrained nature of the Japanese language undertakings must contend on the market through homophonous marks with different lexical representations loses a lot of traction and, indeed, it is extremely prevalent for monumental foreign as well as Japanese undertakings to employ English language marks rendered in English in the Latin alphabet or, in any case, Latin characters, whether thematically English or not.⁸⁵²

⁸⁵⁰ Shoen Ono (n 552) 32.

⁸⁵¹ MacGregor (n 834).

⁸⁵² *ibid.*

6.10 *Conclusion*

The central question in this chapter, as formulated in 1.2.4 and reiterated in the introduction to this chapter, pertains to the overarching question of whether WIPO and the TRIPS agreement are solely responsible for the level of convergence, in terms of registered trade mark provisions, between the UK and Japan.

It is difficult to contest that they are not responsible for much of the convergence. There is considerable convergence which is a result of WIPO membership and TRIPS signatory status. However, as stated, the Trade Marks Act 1938 and the Trademark Act 1959 both predate WIPO and the TRIPS agreement. In fact, the precursor to the Unfair Competition Prevention Act 1993, the Unfair Competition Prevention Act 1934 also predates it. One can see that historically, the reified, registration based trade mark model had existed in Japan and the UK prior to WIPO and TRIPS. Accordingly, logically this model cannot have been established by WIPO and TRIPS. What is more likely is that it had organically evolved.⁸⁵³

WIPO and TRIPS are not freestanding entities, and neither did they pioneer or bring about the proliferation of an unpopular, incongruous and unwarranted trade mark regime. It seems more plausible, as these legal systems have organically developed paradigmatically and functionally similar trade mark regimes to that engendered by TRIPS, that these trade mark regimes, alongside TRIPS, are the result of broader changes in the global economy. This implicitly also raises the question of what influenced the trade mark standards in TRIPS? Is it not uncanny that this model emerged around the time of the proliferation of trade marks

⁸⁵³ *Supra* 6.2, 6.6

in the global economy and domestically as well? It would be better to ask, whether what had influenced TRIPS might have also influenced the Japanese and UK trade mark regimes, before there was even a WIPO and a TRIPS.⁸⁵⁴

In contrast with the significance of the aforesaid concerns, the discussion on the Japanese language might seem somewhat subdued. It is somewhat less prominent in directly helping to support the overarching thesis of this work, but it does play a role in it. It is intrinsically difficult to functionally analyse the divergence in Japanese language in a functional sense, same as with ideographic writing systems.

There is considerable linguistic divergence, because of the considerable difference of the languages, but it is hard to argue that the languages, despite their dissimilarities, are not functionally equivalent. However, despite these difference, one would hard pressed to argue that, functionally, there is a linguistic difference between the languages.⁸⁵⁵

However, notwithstanding this, there is a functional difference in the way that the languages describe things for the purposes of trade marks. There are, for example, differences in the way that blue, green and “grue” are described in English and Japanese. As highlighted, the difference is significant for the purposes of colour perception in trade marks, and there are also differences in spelling. The kanji which the Japanese language uses often has multiple readings and a disconnection between the phonetics and semantic values of an ideograph, which is demonstrated with relation to words such as *shito* or *Mibashira/Onbashira*, which

⁸⁵⁴ Ibid

⁸⁵⁵ 6.7, 6.8, 6.9, Boroditsky (n 378).

highlights the multipotentiality of the combination of phonemes in /eito/ (rendered in the International Phonetic Alphabet) and its ability to refer to different homophonous words, and the converse, the multipotentiality of the compound 御柱 to refer to /mihaeira sai/, /onbaeira sai/, /mihaeira matsuri/, or /onbaeira matsuri/.

This clearly acknowledges a large degree of divergence of language, but this can hardly be ascribed to the Japanese trade mark regime or legal system. This is intrinsic to the language, and native Japanese speakers do not navigate the same phonetic and semantic multipotentiality when they operate in and process the English language, and this is apparent in the way different languages describe natural phenomena and perceive causal relations differently, as in the example Boroditsky provides with the breaking of a vase.⁸⁵⁶ However, rather than argue that this does not point to divergence, it is perhaps more logical to conclude that this divergence is not within the trade mark regime, but that it affects it through providing the social context within which the Japanese trade mark regime exists.

⁸⁵⁶ *Supra* 6.8

7 Conclusions

The interim conclusions of the preceding chapters already advance the overarching argument of the thesis with some clarity and, accordingly, the overarching conclusion will follow the same structure as in the respective chapter and at 1.2 regarding the central arguments of the thesis.

7.1.1 The Substantive Chapters

Chapters 2 and 3 provide the substantive exposition of the trade mark and adjacent laws of the respective legal systems. These chapters have described and explained the legal provisions in regarding trade marks and the registration of trade marks in the UK and Japan. The primary objective was to provide this exposition so that it can be further analysed in subsequent chapters.

The exposition covered trade mark registration, which is the central element of this substantive exposition. As both the UK and Japan have registration-based, reified trade mark regimes, the central element of the exposition was the trade mark registration system. However, while this is important and central, both trade mark regimes also have systems for the protection of unregistered marks.

The forms of protection are different across the UK and Japan. Protection for unregistered marks in by way of the tort of passing-off in the UK, whereas in Japan protection is furnished by the Unfair Competition Prevention Act 1993. The protection applies to well-known and famous marks which possess regional or nationwide fame or reputation respectively.

The substantive chapters have highlighted the apparent and ostensible convergences, which would have to be appraised subsequently in Chapter 4 in the context of functional

equivalency.

This chapter answered the question raised in 1.2.1 with relation to the role of WIPO and TRIPS in being the solitary cause or driving factor behind the ostensible convergence of trade mark registration systems across the UK and Japan. This chapter confirmed that this is not and cannot be the case. The Trade Marks Act 1938, Trademark Act 1959 and the Unfair Competition Prevention Act 1934 predate both WIPO and TRIPS, and the provisions in these acts are sufficiently similar to their successors and, in the case of the 1959 Act, to its modern iterations, that it is not possible for this convergence to have originated with and from WIPO and TRIPS.

7.1.2 The Comparative and Jurisprudential Chapter

The focus of the comparative Chapter 4 is on processing and reasoning about the information explained and introduced in the substantive chapters. This is the largest, most extensive chapters with the broadest range of concerns and topics. The central question or task of this chapter is to ascertain whether there is convergence between the UK and Japanese trade mark regimes and to determine the degree or measure of convergence or divergence.

This chapter had also discussed a range of topics in its exploration of the subject-matter and functional assessment and comparison of the respective trade mark regimes. The chapter established a comparative methodology, composed of the functional method of comparative law, in conjunction with the Dworkinian conception of law as integrity and his model of rules and principles described in *Taking Rights Seriously*.

This model has been used throughout much of the thesis, and it is a necessary combination of tools to determine the scope of analysis and to enable reasoning about the Japanese case

law, despite no formal principle or doctrine comparable to *stare decisis* in the UK Common Law.

Additionally, functionalism has been used to appraise the subject-matter through an analysis of whether paradigms or systems of comparison are truly functionally equivalent or similar across the respective legal systems. Here, the idea of functional equivalency was predicated on the notion something is functionally equivalent or similar if it fulfils the same function and accomplish the same task in the social context.

In terms of this functional analysis, the substantive laws with relation to trade mark registration are highly convergent functionally across Japan and the UK. Despite small differences, such as, for example, the omission of categorisation into absolute and relative grounds of refusal in Japan, the functional comparative analysis has shown that the provisions themselves, irrespective of their ordering or typography within the statutes, are convergent across the Trade Marks Act 1994 and Trademark Act 1959.

The chapter also discussed, in detail, issues of public interest, public policy and morality. In addition to discussing, in general terms, public policy, interest and morality, the chapter also discusses the application of public policy in the context of the absolute grounds, to prevent registrations contrary to public policy and morality, but also in the context of UCPA and unfair competition. This analysis reveals that there is a measure of divergence in terms of the systems used to afford protection to unregistered marks. Conclusion is congruous with the same conclusions, on the basis of a more black letter, substantive analysis, in the preceding chapters.

Indeed, this chapter had confirmed that the preliminary conclusions in Chapters 2 and 3 were correct with relation to the degree of convergence/divergence in terms of the convergent registered trade mark provisions and the divergence in the way passing-off works

and the way well-known and famous trade marks are protect per Arts.2(1)(i) and (ii), respectively, of UCPA 1993.

The chapter also uses the concept of reification to contrast the UK and Japanese trade mark regimes with the US trade mark system. While the US system is not fleshed out in full comparative detail, it is interesting because the most prolific recent author writing about Japanese trade mark law in English, the late Kenneth L Port, wrote from the American trade mark perspective. Where Port highlights points of divergence, such as in terms of reification and the use of survey evidence, between Japan and the US, an analysis between Japan and the UK reveals convergence – this is entirely expected and it is salient considering that paradigmatically the Japanese and the UK trade mark regimes are both registration and property right based.

The chapter further supported this position through the examples of reification and survey evidence, where the courts in Japan and the UK have a comparable level of conservatism and caution in the context of survey evidence, whereas in the use based, non-reified system of the US the empirical way of reasoning about trade marks, through survey evidence, is the norm.

However, in this chapter, it was established that in Japan and the UK the opposite is the case, reasoning about trade mark proprietary boundaries is a deductive process, generally with reference to the trade mark register. Of course, it is implicit in this statement that unlike in the US, trade marks in the UK and Japan are property rights, and they are testable with reference to the contents of the register, with some exceptional circumstances acknowledged

regarding genericide, albeit even in these circumstances it is possible for courts and litigants to reason about the possible empirical realities through deductive means, such as dictionaries, magazines, etc.

In summary, this chapter answers the question in 1.2.2 in the affirmative. There is broad convergence, albeit there is also divergence in the area of unregistered marks and with relation to concepts such as international truthfulness. However, as noted in 4.1.5, these are the exception and such divergence, therefore, accounts for only a small proportion of cases and concerns. Most trade mark affairs are conducted through the use of registered trade marks, which are both easy and inexpensive to obtain. Accordingly, because unregistered trade mark cases account for only a minority of aggregate cases, the extent or level of divergence is commensurately small.

7.1.3 The Moral Principles & Societal Analysis Chapter

Chapter 5 was tasked with discussing, in general, the moral principles and the uniqueness of the Japanese anti-legalist disposition.

This chapter established, in short, that the Japanese disposition towards law is not anti-legalist. There is a law abiding, rule-following tendency on part of Japanese people, but this rule-following is not the as rule-aversion. Rule-following merely means that Japanese people are comfortable to operate within the prescribed rules, such as the rules within the Japanese trade mark regime.

The chapter demonstrated this rule-following tendency with reference to the rates of litigation and the history of the Japanese legal profession and the undulation of its size from

the pre-war era to the contemporary Japanese legal profession. As stated in the chapter, the anti-legalism of the Japanese political apparatus might conjure the impression that Japanese people are culturally anti-legalist and averse to litigation, but this is an anomaly generated by what can be termed as social engineering by the ideologically-inspired political elite.

The chapter further establishes that Japanese people are not rule-averse with reference to, for example, the manner in which they interact with the moral principles which are outlined in the chapter, such as the opportunistic trade mark registrations which were litigated on the basis of the UCPA, which show that there is an appetite to work within the formal boundaries of the system to one's own benefit. It is difficult to speculate about the state of mind of the registrants in cases such as *McDonald's*, but one might entertain the possibility that the registrant may very well have understood the impropriety of misappropriating the reputation of a mark in which another undertaking, in this instance McDonald's, has a clear proprietary interest. Indeed, the author would postulate that in both Japan and the UK, most people would consider such behaviour inappropriate.

The question which this chapter had answered was whether international truthfulness points to a measure of divergence between the UK and Japan. The chapter explained that international truthfulness is, indeed, unique and uniquely Japanese. Accordingly, as there is no equivalent or parallel in the UK, this is a point of divergence. However, the conclusion and answer of the previous chapter also applies here. While international truthfulness highlights an instance of divergence, it is proportionately small in significance. Only a minority of cases are decided based on this principle, or based on the provisions of UCPA, and the standard, intended form of protection through registered trade marks is convergent.

Accordingly, while there is divergence on account of international truthfulness and the provisions of UCPA, this is proportionately much smaller than the convergence in the registered trade mark provisions.

7.1.4 **The Historical and Cultural Analysis Chapter**

Chapter 6 has explained and concluded the broader significance of WIPO and TRIPS in bringing about the level of convergence between the trade mark regimes of the UK and Japan. This chapter had explained that historically WIPO and TRIPS are not the source or precursor of the reified, registration-based model of trade marks.

Indeed, it seems plausible, since the Trade Marks Act 1938, the Trademark Act 1959 and the Unfair Competition Prevention Act 1934 all precede WIPO and TRIPS, that the harmonisation sponsored by WIPO and TRIPS are part of a broader change in the global economy. The proliferation of global logistics, trade and the proliferation of trade marks as a driving economic implement have coincided with the emergence of the reified model in both countries, and it might be more logical to think of WIPO and TRIPS not as the origin of the reified system, but as a chronologically congruous force which was devised to catalyse the existing process of adoption of that reified model, rather than to produce it.

The other part of this chapter had discussed the Japanese language along with its writing system. The conclusions with relation to linguistics are more subdued, but the conclusion in the chapter is that the Japanese language and English are clearly very divergent linguistically. They belong to different language families and they have dramatically different writing systems. However, while this is true, it also does not inform one about the level of divergence between the UK and Japan. This linguistic divergence is not of a trade mark nature, albeit it has a significant effect on the way

trade marks are processed. However, it does not establish a level of divergence or convergence between the UK and Japanese trade mark regimes. Indeed, it would be a category error to conflate the Japanese language with paradigms or elements within the trade mark regime. However, it should be acknowledged that the multipotentiality of combinations of phonemes and kanji compounds does have a trade mark significance in the way these are interpreted aurally, lexically, semantically and thematically.

7.1.5 **Central Argument of Thesis**

The preceding chapters have established and supported the central argument of this thesis. The central argument is that the Japanese trade mark regime is generally similar to and convergent with the UK trade mark regime in the context of registered trade mark rights. They are both registration-based systems with significant reification of the trade mark rights which they confer. This can be seen in the level of ostensible and functional convergence in the registered trade mark provisions of the Trade Marks Act 1994 and the Trademark Act 1959.

On a functional analysis, it is apparent that despite minor differences, such as the absence of the categorisation into relative and absolute grounds in the 1959 Act, the provisions of the 1959 and 1994 Acts on registration are very similar and highly convergent.

Likewise, on an assessment of the moral principles, such as Chapter 5, it emerges that moral principles in the context of registered trade marks are also similar, with both UK and Japanese case law exhibiting both public policy and consequentialist and deontological morality decisions, representing, in the context of morality, outrage and disruption and moral, normative impropriety respectively.

In terms of public policy, it is arguable that there are substantive public policy differences between the systems, but this is not intrinsic to the trade mark regimes. The prevailing policy changes, but the immanent policy considerations reflected in the provisions of the registered trade mark systems are convergent – they are both registration based, reified systems, after all.

There is a measure of divergence, on account of the systems for protecting unregistered marks, but this is proportionately subdued and limited, because unregistered marks represent the exception in the handling of marks in Japan and the UK.

In terms of the role of WIPO and TRIPS, it is confirmed in the preceding chapters that WIPO and TRIPS are not the solitary cause of convergence between Japan and the UK. They have assuredly contributed to the harmonisation of the UK and Japanese regimes, and many others besides, but registration-based, reified systems have existed in Japan and the UK, established by statutes, such as the Trade Marks Act 1938 and the Trademark Act 1959 which predate WIPO and TRIPS. Accordingly, the thesis establishes that it is better to think of changes in the world and the global economy, the proliferation of trade marks and the growth of the economic significance of trade marks, which is likely causative of WIPO and TRIPS as well.

8 List of Abbreviations

Abbreviation	Meaning
WIPO	World Intellectual Property Organization
TRIPS	The Agreement on Trade-Related Aspects of Intellectual Property Rights
FTA	Free trade agreement
TTIP	Transatlantic Trade and Investment Partnership
TPP	Trans-Pacific Partnership
CPTPP	Comprehensive and Progressive Agreement for Trans-Pacific Partnership
RCEP	Regional Comprehensive Economic Partnership
UCPA 1993	Unfair Competition Prevention Act 1993
UCPA 1934	Unfair Competition Prevention Act 1934
TA 1959	Trademark Act 1959
TMA 1994	Trade Marks Act 1994
TMA 1938	Trade Marks Act 1938
GI	Geographical Indications
PCC	Patents County Court
IPEC	Intellectual Property Enterprise Court
SCT	Small Claims Track
MT	Multi-track
UK IPO	United Kingdom Intellectual Property Office
WTO	World Trade Organization
JPO	Japan Patent Office
IPHC	Intellectual Property High Court
MFN	Most favoured nation

CEPA	UK-Japan Comprehensive Economic Partnership Agreement
QLTS	Qualified Lawyers Transfer Scheme
SQE	Solicitors Qualifying Examination
GJB	gaikokuhou jimusho bengoshi (Foreign Lawyer System)
CITMA	Chartered Institute of Trade Mark Attorneys
IPReg	Intellectual Property Regulatory Board
JPAA	Japanese Patent Attorneys Association Homepage
JRS	Japan Revitalization Strategy
RCM	Regional Collective Mark
LDP	Liberal Democratic Party
OHIM	Office for Harmonization in the Internal Market
EUIPO	European Union Intellectual Property Office

9 Tables:

9.1 *Table of Cases*

UK Cases

<i>Al-Fagih v HH Saudi Research & Marketing Ltd</i> [2001] EWCA Civ 1634
<i>Apple Inc v Arcadia Trading Ltd</i> [2017] EWHC 440 (Ch)
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