

News

May 2016

Development of Japanese IP Law

1. Update of Non-Traditional Trademarks

According to the information published by JPO as of May 25, 2016, the number of applications and registrations is as follows. No color marks have matured into registrations. It is interesting to note that there are still many pending non-traditional trademark applications filed on April 1, 2015 (the first day when JPO began accepting non-traditional trademark applications) where the status is "Awaiting Examination". According to the JPO Status Report 2016, the average period from filing an application to issuing the first action (FA pendency) was 4.0 months in 2015. We normally expect to receive the first action within 6 months from the filing date and more than one year seems to be unusual.

| | Total | Breakdown | | | | |
|-------------------------|-------|-----------|--------|----------|----------|-------|
| | | Sound | Motion | Position | Hologram | Color |
| Number of Applications | 1275 | 410 | 89 | 287 | 16 | 473 |
| Number of Registrations | 66 | 32 | 28 | 5 | 1 | 0 |

2. IP High Court reversed the Trial Decision which invalidated the parody mark (Appeal from the JPO's trial decision regarding the invalidation of trademark registration)

On April 12, 2016, Japanese IP High Court reversed the Trial Decision of JPO and decided Trademark Registration No. 5517482 was not similar to cited trademarks and valid.

Trademark Registration No. 5517482(Class 14: watches and clocks etc.)

フランク三浦

*The pronunciation of FURANKUMIURA is generated.

Cited References

a. Trademark Registration No. 4978655 (including watches and clocks in Class 14)

フランク ミュラー (Katakana of FURANKU MULLER)

* The pronunciation of FURANKUMYURA is generated.

b. Trademark Registration No. 2701710 (including watches and clocks in Class 14)

FRANCK MULLER

c. IR No. 777029 (including timepieces, and chronometric instruments in Class 14)

FRANCK MULLER REVOLUTION

SHIMIZU & DAIGO

Although the court acknowledged the similarity of sound, it held that the appearance and the meaning is different. The subject trademark suggested Japan and / or Japanese, but the cited references clearly meant the famous foreign brand “FRANCK MULLER” and there would be no likelihood of confusion. The products bearing the subject trademark is a parody of “FRANCK MULLER”.

If you have any questions or comments, please feel free to contact us.