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YKI Trademarks Japan

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JPO Activities

In this issue, we will provide tips concerning design applications.

According to certain news reports, the Japan Patent Office (JPO) recently announced that it would adopt a new system which allows drastic reduction of the examination period for design applications as of 2005. While at present it takes about 8 months on average for the prosecution of a design application from the start of examination until registration, when a company who has filed a design application reports to the JPO that a counterfeit of the applied design has been discovered, the JPO will examine the case preferentially and issue a notice within one month. Under the current situation, where companies usually start selling their promising products before obtaining design rights for them, which results in the appearance of counterfeit products on the market only a few months later, such an infringement of intellectual property rights is left uncontrolled for as long as several months after the sales of these products.

Although the Japan Patent Office has been trying to shorten the examination period for design applications as a whole, with the number of design applications filed per year reaching 40,000 it has recognized the limits of the current system. With the new system which prioritizes the applications to be examined, the Japan Patent Office hopes to minimize damages incurred by applicants due to counterfeit products.

The Hanshin Yusho Mark: After the Uproar

Do you remember the uproar caused by the mark "Hanshin Yusho"? The Hanshin Tigers are a Japanese professional baseball team based in the Osaka and Kobe (Hanshin) region of Japan, and they beat the New York Yankees in the opening game of the MBL held in Japan this year. (Note that although the Hanshin Tigers won the pennant last year, the team is not doing anywhere near so well this year.)

In 2001, an individual filed a trademark application including the characters "Hanshin Yusho" and the application was registered. When, in the hope of capturing its first League pennant in eighteen years last year, the team filed their own application for a character mark "Hanshin

Yusho", the team's application was rejected based on the existence of the registered mark. This course of events aroused the attention of the media and annoyed the team. The team seems to have been very upset with this experience and has become extremely sensitive to trademark matters. Please also note that the Hanshin Tigers is commonly abbreviated to both "Hanshin" and "Tigers".

At this time, the Tigers complained about a registered trademark "TIGER" owned by the Tiger Corporation, a manufacturer of electric cooking ware. More specifically, the team argued that the mark "TIGER" is similar to the famous abbreviation "Tigers" of the Hanshin Tigers and therefore causes confusion.

However, Tiger Corporation is a time-honored firm established in 1923, and their trademark "TIGER" is very famous in Japan. Therefore, not only legal professionals but also ordinary people mostly regarded this act by the Hanshin Tigers to be a little drastic.

Actually, the Japan Patent Office did not accept the above argument of the Tigers, stating that the mark "TIGER" composed of uppercase characters owned by the Tiger Corporation should be distinguished from "Tigers" composed of a combination of uppercase and lowercase characters of the Hanshin Tigers.

Thereafter, Tiger Corporation filed a mark "TIGERS", which was rejected because the mark would recall the Hanshin Tigers. Currently, the mark "TIGER" in a singular form which belongs to Tiger Corporation is differentiated from "Tigers" in plural form which belongs to the Hanshin Tigers.

We believe that this incident must have been a nuisance to Tiger Corporation who continued to use the mark "TIGER" for more than 80 years. However, it seems that this incident impressed upon the Japanese people the fact that the Hanshin Tigers are very sensitive to trademark matters. In this sense, the tactics of the Hanshin Tigers may have been successful.

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Please send any questions or comments to:

newsletter@yki.jp

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YKI Patent Attorneys
http://www.yki.jp/

1-34-12 Kichijoji Honcho
Musashino-shi, Tokyo
180-0004 Japan

Tel: 81-422-21-2501
Fax: 81-422-21-2391

e-mail: trademarks@yki.jp

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