

JAPAN

Colour marks and sound marks introduced

ABE & Partners

Osaka



Takanori Abe and Tomohiro Kazama

At last, the Trade Mark Act 2014 amendment, which will come into effect on April 1 2015, has introduced new kinds of trade marks such as colour marks and sound marks. In the United States, Christian Louboutin had filed a lawsuit against Yves Saint Laurent for an infringement of Louboutin's trade mark, consisting of a red, lacquered outsole on a high fashion woman's shoe. We may expect similar lawsuits in Japan in the near future.

Outline of the new trade mark

Under the new trade mark system, colour marks, sound marks, moving marks, hologram marks and position marks (new trade marks) can be registered. However, trade dress, olfactory marks, touch marks and taste marks remain unregistrable.

In the registration of the new trade marks, it is important to specify the scope of the trade marks so that a third party can recognise the contents of the trade mark rights clearly. Trade marks whose scope is not specified will not be registered. The scope of colour marks, moving marks, hologram marks and position marks will be specified based on a detailed description in the application whereas the scope of the sound marks will be specified based on sound data and a detailed description in the application.

Some of the new trade marks do not seem to make the consumers recognise the goods or services as those pertaining to a business of a particular person. Therefore, whether the new trade marks have distinctiveness will be reviewed strictly. The following do not seem to have distinctiveness in principle: a single colour, a colour used only for improving the function or appearance of the goods, a sound used ordinarily in the trade of the

Int. Cl.: 25
Prior U.S. Cls.: 22 and 39

Reg No 3,361,597
Registered Jan 1 2008

United States Patent and Trademark Office

Trade mark

Trademark principal register



Application No: 002289049

goods or services, a single tone, a sound effect or a natural sound.

In infringement lawsuits, the courts are expected to judge the similarity to the registered trade marks by considering the general criterion of trade marks' appearance, idea, and pronunciation as well as the characteristics of the new trade marks.

The Trade Mark Act 2014 amendment clarified that if the trade marks are used in the way consumers cannot recognise the goods or services as those pertaining to a business of the trade mark's owner, such use does not constitute trade mark infringement. In infringement lawsuits over the new trade marks, we expect many accused infringers will make such a defence.

A person who had been using the new trade marks before the Trade Mark Act 2014 amendment may continue to use the trade marks after the amendment. Accused infringers may make such defence as well.

Practical tips

Before the Trade Mark Act 2014 amendment, the rightful claimant had to rely on the Unfair Competition Prevention Act for the infringement of colours, etc. In the judgment of December 23 1983, the Osaka District Court held that the third party's conduct selling wetsuits having a line of three colours which are almost the same as those of the rightful claimant violated the Unfair Competition Prevention Act because the combination of the claimant's goods and the three colours enabled the consumers to recognise the goods as those pertaining to a business of the claimant. In the judgment of May 27 1987, the Osaka District Court held

that Kani Shogun's conduct having a crab-shaped signboard moving uniquely which was very similar to that of Kani Doraku violated the Unfair Competition Prevention Act because Kani Douraku's signboard had novelty, originality and distinctiveness. Under the Trade Mark Act 2014 amendment, the protection could be secured by the registration of colour marks and moving marks respectively.



Source: Kani Douraku's Facebook

Despite these successful cases, protection under the Unfair Competition Prevention Act had several downsides. It lacked a notice function and thus the protection was unstable, unpredictable and slow. The burden of proving the goods were well known was heavy. The new trade mark system, having a notice function, will enable trade mark owners to prevent infringement and/or provide a licence offer to third parties and will ease the burden of proof.

In *Christian Louboutin v Yves Saint Laurent*, the United States Court of Appeals for the Second Circuit instructed the USPTO to limit the registration of the red sole mark to those situations in which the red lacquered outsole contrasts in colour with the adjoining upper of the shoe. However, in Japan no such order could be made by the court and thus according to Mr Hiromichi Aoki the drafting of the new trade marks will be quite important to prevent an invalidity finding.

The new trade mark system opens the door to plan new brand strategies. Foreign companies who have a lot of experience in their own countries regarding the application and infringement lawsuits of the new trade marks can now enjoy their advantage in Japan.