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Newsletter E-204

The Recent Main Changes to the Trademark Law, Design Law, and Unfair Competition Law in Japan

I. Revisions to the Japanese Trademark Law, applied to the applications filed on/after April 1, 2024

(1) Introduction of consent system

Under the Japanese Trademark Law, a trademark similar to or identical with another person's prior registered trademark cannot be registered for similar or identical goods/services. At this time, the consent system will be introduced. Under this new consent system, the younger application will be registered provided that the owner of the registered trademark consents to the registration of said younger application, and that there is no likelihood of confusion. Please keep in mind that the submission of the letter of consent does not automatically result in the registration of the younger application. Rather, the Examiner examines whether there is any likelihood of confusion. Therefore, the applicant must provide written submissions to explain why there is no likelihood of confusion, in addition to the letter of consent. The examination in this regard is likely to be strict.

(2) Review of the requirements for the registration of a trademark containing another person's full name

Under the current Trademark Law, a trademark containing another person's full name is not allowed for registration unless there is consent from said person. This means that if a trademark application faces this reason for refusal, the applicant must obtain consent from all the other individuals whose full name is the same with the one contained in the trademark. Under the revised Trademark Law, such consent will only be necessary if the other person's full name is famous (requirement 1). On the other hand, it will also be examined (requirement 2), as to (a) whether on the applicant's side there is a relevant relationship between the applicant and the full name contained in the trademark, and (b) whether there is no wrongful purpose for applying for a trademark registration.

II. Relaxation of the Requirements for "Exception of Lack of Novelty of Design" applicable to design applications filed on/after 1 January 2024

If a design is publicly known, disclosed in a distributed publication, or made publicly available through a telecommunications line in Japan or a foreign country before the application is filed, even if it was disclosed by the person with the right to register the design, said design will lack novelty and will be considered a ground for refusal.

To apply the "Exception of lack of novelty of design", in the case that the concerned lack of novelty of design is caused by the actions of the person with the right to register the design himself, the following was required before the Design Law revision (*):
i) To submit a document, simultaneously with the filing of the application, stating that the person is seeking the exception of lack of novelty of design;
AND
ii)-1 To submit a certificate proving the fact that the person himself disclosed the design,
ii)-2 regarding all designs disclosed by the person exhaustively, i.e., the identical design as filed and the similar ones thereof,
ii)-3 within thirty days from the date of filing of the application;

* Disclosure(s) of the design more than one year before the filing date is (are) not eligible for such relief.

＜Revised point＞
The requirement item ii)-2 was revised as follows:
NEW ii)-2 regarding ONE (1) design of the earliest disclosed date, either a design identical to the design filed or one of the similar designs thereof,

[Our Comment]
In order to reduce the amount of work for the applicant, the requirement of "all disclosures of all disclosed identical and similar designs to the filed one exhaustively" was revised to "a disclosure of a design (either a design identical to the design filed or one of the similar designs thereof) of the earliest disclosed date". Any disclosure is acceptable if it was disclosed multiple times on the earliest disclosed date (i.e., it is not a problem whether said disclosure was made at the earliest time of that day or not) and no certificate(s) is (are) required for the design(s) disclosed after the earliest disclosed date. The other requirements remain unchanged. Please note that it is still necessary to submit a certificate for articles embodying dissimilar designs respectively.

III. Prevention of acts of imitation in the digital space

The definition of acts of unfair competition relating to the imitation of configuration of goods has been revised and the scope for exercising the right to seek an injunction, etc. has been expanded. (Date of enforcement: April 1, 2024)

<Existing Law>
Article 2 Par. 1 No. 3 of the Japanese Unfair Competition Prevention Act, among others, defines acts of unfair competition as follows:
acts of assigning, leasing, displaying for the purpose of assignment or leasing, exporting or importing goods which imitate the configuration (excluding configuration that is indispensable for ensuring the function of said goods) of another person's goods;

The above definition is to be amended as follows in view of the expected increase in transactions not only in the real world but also in digital spaces such as the metaverse.

<Revised version>
acts of assigning, leasing, displaying for the purpose of assignment or leasing, exporting, importing or providing through a telecommunications line goods which imitate the configuration (excluding configuration that is indispensable for ensuring the function of said goods) of another person's goods;

At present, no specific examples of acts of imitation in the digital space have been given, but these will be provided in due course.