

1 Study on International Harmonization for Objects of Protection or the like of Trademarks

International harmonization of trademark systems has become more important due to the increased globalization of business. However, a few of differences still remain in the substantive aspect of the systems between major countries. In this study, investigations were carried out on systems and practices in 28 overseas countries as well as user needs in Japan with respect to the following three subjects that have been adopted overseas, but not in Japan, and necessity of introducing such the systems to Japan was examined.

The first subject is protection of new types of trademarks such as sound and scent. The legal problems and practical aspect such as examination procedures in making those protectable were considered.

The second subject is the consent system. Having reviewed the reasons for shelving the introduction of the system upon the 1996 amendment of the Trademark Law, desirable system if it is introduced in Japan was discussed.

The third subject is the disclaimer system. Japan also used to adopt a disclaimer system under the Trademark Law of 1921, which was abolished later. Thus, considering such circumstances, necessity of a suitable disclaimer system in Japan was examined.

I Legal Examination Concerning New Objects of Protection

1 Situations in Foreign Countries

We have carried out investigations concerning protection of new types of trademarks (hereinafter referred to as new trademarks) such as trademarks consisting of sound, scent (smell, olfactory) or color itself in twenty-eight foreign countries. Among Western countries and Oceanian countries, many countries protect marks consisting of color itself or sound. On the other hand, concerning scent marks, some countries await a decision of the European Court of Justice or do not admit registration of such marks. Among Asian countries, most countries do not protect the new trademarks.

Situations in the United States, the European Union (EU), France, Germany and the United Kingdom will be hereinafter described in detail.

(1) United States

- (i) A color mark, whether it is a combination of colors or a single color, is registrable as a trademark. For registration, the party concerned needs to claim that the color mark has acquired an essential distinctiveness or a secondary meaning. In addition, the color mark is required to have non-functionality.
- (ii) A sound mark is registrable, although it is required to acquire a secondary meaning.

- (iii) A scent mark is registrable. For a scent mark, attribute, functionality and descriptiveness are issues, and it is considered that the scent mark should involve imaginativeness for the goods on which it is used.

(2) EU

- (i) The Office for Harmonization in the Internal Market (OHIM) admits that a sign consisting of color itself (a single color or a combination of colors) may be protected as a Community trademark. However, OHIM tends to generally consider a single color to be devoid of distinctive character and deny its protection^{(*)1}.

Currently, the Dutch Supreme Court (Hoge Raad) refers to the European Court of Justice for preliminary ruling on distinctive character or the like of a single color^{(*)2}. Its consequence attracts attention.

- (ii) A sound trademark is admitted in Examination Guidelines of OHIM (Guidelines Part B 8.2). Musical notation is shown as an example of a method of graphically representing a sound trademark.

- (iii) There are previous registrations of olfactory trademarks^{(*)3}. However, currently, OHIM always refuse registration of olfactory trademarks because of lack of graphical representation.

Currently, the German Federal Patent Court (Bundespatentgericht) refers to the European Court of Justice for a preliminary ruling on graphical representation for olfactory signs^{(*)4}, the

(*)1 In re Orange Personal Communications Services Ltd., OHIM Third BoA, Feb.12, 1998, Case R7/1997-3, 30 IIC 197 [Orange]; In re WM. Wrigley Jr. Co., OHIM Third BoA, Dec.18, 1998, Case R122/1998-3, 31 IIC 329 [Light Green]; In re Ty Nant Spring Water Ltd., OHIM Third BoA, July 20, 1999, Case R5/1999-3, 31 IIC 1010 [Colour Cobalt Blue].

(*)2 Libertel Group v. Benelux Trademark Office C-104/01 - Estelle Derclaye, *ECJ to Decide 'War of Colours' Between Belgian, Dutch Supreme Courts*, WIPR 15, 5, p.11 (May, 2001).

(*)3 In re Vennootshcap onder Firma Senta Aromatic Marketing, OHIM Second BoA, Feb.11, 1999, Case R156/1998-2.

(*)4 Ralf Sieckmann v. Deutsches Patent- und Markenamt, C-273/00, *Schlussantraege des Generalanwalts Colomer*, 6.11.2001 (Judgment of the Court on 12 December 2002).

result of which will attract attention.

(3) France

(i) Protection of color signs is admitted for arrangements, combinations or shades of color (Article L711-1 (c) of the 1992 Law).

(ii) Audible signs include simple sounds, a musical phrases, series of rhythms (Article L711-1 (b) of the 1992 Law), and distinctive nature is required for protection.

(iii) An olfactory sign cannot be graphically represented as required by the French Trademark Law and has no capability to identify an object. Therefore, it is considered that registration of an olfactory mark would be impossible.

(4) Germany

(i) Registrability of a sign consisting of color itself has been affirmed^{(*)5}.

(ii) As to sound trademarks, approximately 200 applications have been filed since the enforcement of the 1995 Trademark Law, 90% of which seems to have been registered.

(iii) It is not clear whether an olfactory sign can be registered as a trademark particularly due to a problem of the capability of graphical representation.

(5) United Kingdom

(i) It is acknowledged that a sign consisting of color itself can be a trademark^{(*)6}.

(ii) It is acknowledged that a sign consisting of sound can be a trademark^{(*)7}.

(iii) As to smell trademarks, the U.K. Patent Office shows a negative attitude to its registration because of the problem of graphical representation^{(*)8}.

2 Examination of the Trademark Law in Japan

(1) Present Situation

Article 2, section 1 of the Japanese Trademark Law limits trademarks to those visually recognizable. Therefore, this means that sound trademarks, scent trademarks, taste trademarks and touch trademarks, which are recognized by senses other than sight, are not protected under the trademark system.

Moreover, signs that are visually recognized but consists of color itself are not protected either.

(2) Needs for Protecting New Trademarks in Japan

As a result of questionnaires survey for domestic companies, it was found that 2% of the companies use new trademarks in foreign countries

and 18% of the companies consider new trademarks necessary. From these results, it is difficult to say that the need for protection of new trademarks is large.

(3) Legislative Examination

We have considered what kind of revision should be made to the Trademark Law, if color, scent or the like were to be protected as a trademark under the Trademark Law.

(i) As to signs that are visually recognized such as color, it seems to be sufficient to add them in Article 2, section 1 of the Trademark Law. As to signs that are not visually recognized, it is also possible to add them individually in Article 2, section 1 of the Trademark Law. However, if there is no sign of a particular form which should not be protected, it would be appropriate to give comprehensive definitions of trademarks as in the Community Trademark Regulations^{(*)9} or the Trademark Directive^{(*)10}.

In that case, as the requirements for a trademark, first, it is necessary that there is distinctiveness of an applicant's own goods (services) compared to others' goods (services). In addition, under a registration system, it is necessary that a trademark to be registered itself can be specified.

(ii) Article 2, section 3 of the Trademark Law specifically provides for "uses" of a trademark individually. If scent, sound or the like is to be protected, the definition of "use" must be revised. The direction of revision of the current law is either to add individual and specific acts or to introduce a comprehensive concept of use.

II Issues in a Practical Aspect for New Objects of Protection

1 Method of Describing New Trademarks in Applications

(1) Situations in Foreign Countries

We have examined situations how new trademarks are specified in applications for trademark registrations in foreign countries. Examples of color, sound and scent trademarks in applications for trademark registrations are shown as follows:

(i) Color trademark

As to specification of color itself, there are many applications representing colors in words. For example, there are ① a registration indicating that an article or a package of an article has a

(*)5 BPatG 15.7.1998, GRUR 1999, 61, 30 IIC 812 [Aral/Blau].

(*)6 Trade Marks Registry Work Manual, Chapter 6, 2.3.5 Colour marks.

(*)7 Trade Marks Registry Work Manual, Chapter 6, 2.3.6 Sound marks.

(*)8 Trade Marks Registry Work Manual, Chapter 6, 2.3.8 Smell marks.

(*)9 Council Regulation (EC) No.40/94 of 20 December 1993 on the Community trade mark, O.J. L11, 14.1.1994 p.1.

(*)10 First Council Directive of 21 December 1988 to approximate the laws of the Member States to trade marks (89/104/EEC), O.J. L40, 11.2.1989, p.1

specific color (e.g., US:RN2143835), ② a registration indicating that a specific part of an article has a specific color (e.g., US:RN2248445), ③ a registration for a combination of a character, a figure or the like with a color as in Japan (e.g., US:RN2097284).

(ii) Sound trademark

There are, for example, ① a sound trademark represented by a scale code (e.g., US:RN2315261), ② a sound trademark represented by a score (e.g., DE:AP2276238), ③ a sound trademark represented by replacing a classification of sound with a language (e.g., US:RN1746090), and ④ a sound trademark represented by a phrase expressing a sound (e.g., US:AP78013907). Further, other media such as a cassette tape are submitted in some cases.

(iii) Scent trademark

Examples of scent trademark registrations (applications) are few. This investigation revealed a registration for scent trademark indicating a language expressing a specific scent (e.g., US:RN1639128).

(2) Method of Description in an Application

As specific methods of describing color, sound and scent trademarks in applications, means as described below are also conceivable. Future examination is required.

(i) Color trademark

It would be appropriate to electronically file an image data in such a state that a mark is colored and to specify an identical trademark according to that data in the Patent Office. In addition, it should also be considered to request an applicant to describe symbols specifying a color (color name in words, Munsell value, Pantone value or the like) as reference information.

(ii) Sound trademark

It would be appropriate to record a sound in a "sound file" of a computer software, electronically file it and specify an identical trademark according to the sound file data in the Patent Office.

(iii) Scent trademark

Scent trademarks are most difficult to specify among the new trademarks. As in the examples of foreign countries, it would have to be replied on description in words. However, at the present stage, there is no means for objectively specifying scent trademarks to the same degree as the other new trademarks.

(3) Relationship with a Scope of Right

Considering the above-mentioned situations in foreign countries and the state of introduction of electronic filing system in Japan, from technical point of view, the new trademarks other than scent trademark can be almost unambiguously specified.

Then, it would be possible to unambiguously specify a scope of identity of trademarks, that is, an exclusive right to use the registered trademark (first paragraph of Article 25 of the Trademark

Law), according to a scope specified by an electronic filing at the time of the application. This is consistent with the current practice under the Trademark Law, and no particular doubts would arise in this regard.

2 How to Determine Presence or Absence of Distinctiveness

Distinctiveness of color, sound and scent trademarks is considered as described below.

(1) Color Trademark

According to the Japanese Trademark Law, a trademark consisting of color itself is not admitted. This is because, essentially, any person is allowed to freely select and use a color and the number of identifiable single colors is limited (depletion theory of colors). In addition, usually, a color itself is not used as an identifying means and does not have a function as an indication of an origin.

Considering these points, it would be better to judge whether or not color is to be protected, by examining arguments and proofs prepared by the parties concerned at the time when a problem actually arises, rather than uniformly judging it at the examination stage of applications.

(2) Sound and Scent Trademarks

Unlike traditional marks that are visually represented (marks such as character and figure), sound and scent trademarks themselves cannot be visually represented.

(i) As a method of visually representing and specifying a sound, there are notations, sonograms and the like. In examination of an application, it is possible to objectively judge similarity of sounds by comparison of performances or scores.

(ii) On the other hand, as a method of visually representing and specifying a scent, there are diagrams or the like produced by gas chromatography or high performance liquid chromatography. However, any of these has a problem in terms of accuracy.

(iii) Considering the above-mentioned points, a sound may be an object of the Trademark Law from the viewpoint of distinctiveness, but a scent would not be fit for examination and therefore should not be an object of the Trademark Law.

(3) Distinctiveness

(i) Judgement on distinctiveness of ordinary sound and scent

An ordinary sound such as a sound consisting of one or two musical notes only is not registered because it does not have distinctiveness in the first place (Article 1, section 1 (5) of the Trademark Law).

Since a sound may lack a capability of designating the origin in relationship to goods or services, it is necessary to judge distinctiveness from this viewpoint as well. In addition, a sound that is inherent in goods or services as a

characteristic and a feature (attribute) thereof, should not be allowed for trademark registration in association with the goods or services.

(ii) Should a sound mark be registered only when it has acquired distinctiveness through use?

Since there is no particular reason only for sound trademark to justify that it is registrable only when it has acquired distinctiveness through use, it would be treated in the same manner as the traditional marks.

(iii) A composite trademark of an object without distinctiveness and sound or the like with distinctiveness

A composite trademark of an object without distinctiveness and sound with distinctiveness is theoretically conceivable. If such a composite trademark is applied for registration, it is sufficient to treat the part of the sound having distinctiveness as a main part to judge distinctiveness of the composite trademark.

3 Logic and Treatment of Judgment on Similarity

(1) Present Common View

Judgment on similarity between two trademarks is made by comparing them with regard to their appearances, names, and concepts as factors of judgment.

It would be sufficient to make judgment on similarity for color, sound and scent trademarks using criteria and a method of observation adopted by the present court decisions and generally adopted views, by taking into account characteristics of the respective trademarks.

(2) Judgment on Similarity of Color, Sound and Scent trademarks

(i) Color trademarks

For color trademarks, examination of name is omitted among the above-mentioned three factors for judgment.

In color trademarks, “similarity in appearance” means that both trademarks may be confused with each other when their colors are observed through sight, and “similarity in concept” means both trademarks may be confused with each other in their meanings (implications or impressions) when a certain meaning (including implication or impression) is to be grasped from the colors.

Then, usually, if both trademarks may be confused with each other in either appearance or concept, then both trademarks are found to be similar.

(ii) Sound trademarks

① For sound trademarks, examination of appearance is omitted among the above-mentioned three factors for judgment because it is not a visual trademark.

In addition, it is not appropriate to use the so-called “name” as a factor for judgment on

similarity, so that “sound” per se instead of “name” should be regarded as a factor for judgment on similarity.

② In sound trademarks, “similarity of sounds” means that both trademarks may be confused with each other in their sounds per se, and “similarity of concepts” means that both trademarks may be confused with each other in their meanings (implications or impressions) when a certain meaning (including implication or impression) is to be grasped from the sounds.

Then, usually, if both trademarks may be confused with each other in either “sound per se” or “concept”, then both trademarks are found to be similar.

③ Problems of sound trademarks

(a) Visual representation and judgment on similarity

It should be considered that even if an applicant describes (in writing) that a “sound” consists of “roaring of a lion” in an application for a sound trademark, “roaring of a lion” is not always conceived (implied or impressed) by the “sound”. Since “visual representation” is only a requirement for registration, similarity shall be judged for a “sound” per se (sound trademark).

(b) Similarity of a sound trademark and a word trademark

If “name” of a word trademark and “sound” of a sound trademark may be confused with each other as sound (similarity of sounds), then both trademarks are considered to be similar.

In addition, if a “concept” (including implication and impression) to be grasped from “sound” of a sound trademark and “concept” to be grasped from a word trademark may be confused with each other (similarity of concepts), then both trademarks are also considered to be similar.

(iii) Scent trademarks

① For scent trademarks, “appearance” among the above-mentioned three factors for judgment is omitted for judgment because it is not a visual trademark.

In addition, it is not appropriate to use a so-called “name” as a factor for judgment on similarity because a “scent” per se is a trademark.

② In scent trademarks, “similarity of scents” means that both trademarks may be confused with each other in their scents per se, and “similarity of concepts” means that both trademarks may be confused with each other in their concepts (implications or impressions) when a certain meaning (including implication or impression) is to be grasped from the scents.

Then, usually, if both trademarks may be confused with each other in either “scent per se” or “concept”, then both trademarks are found to be similar.

III Consent System

1 Situations in Foreign Countries

(1) Outline of the Consent System

The consent system can be classified into (i) consent relating to conflict with an earlier trademark application or earlier registered trademark, (ii) consent relating to conflict with an unregistered well-known trademark and (iii) consent relating to conflict with a name of another person, according to an object of the consent.

Among them, concerning (i) consent relating to conflict with an earlier trademark application or earlier registered trademark, jurisdictions are classified into ① a jurisdiction where consent is not admitted at all, ② a jurisdiction where examination of relative grounds for rejection is conducted and it is admitted to overcome grounds for rejection by consent, and ③ jurisdiction where it can be concluded that, so to speak, a “hidden” consent system is adopted because only examination of absolute grounds for rejection is conducted.

Moreover, consent systems in the jurisdiction ② can be classified into a “reservation type consent system” in which registration is granted only when there is no likelihood of confusion of trademarks and a “complete type consent system” in which relative grounds for rejection can be overcome as long as consent exists.

(2) States of Implementation in Foreign Countries

States of implementation of the consent system in foreign countries can be classified as follows:

- (i) Countries where consent is not admitted at all
Japan, Argentina, China, Indonesia, Thailand
- (ii) Countries and region where relative grounds of rejection are examined
 - ① Reservation type consent
Austria, Canada, Spain, Sweden, (Norway), United States, Mexico, Australia, New Zealand, Hong Kong, India, Malaysia, Singapore
 - ② Complete type consent
United Kingdom
 - (iii) “Hidden” consent
OHIM, Germany, France, Switzerland, Benelux, Denmark

2 Situation in Japan

(1) Needs of Users

As a result of domestic questionnaires survey in this study, it was found that 18% of companies

have utilized consent in foreign countries, and 39% of the companies consider that the consent system is necessary, which is greater in number than those considering that the consent system is unnecessary.

3 Pros and Cons of Introduction of the Consent System and an Desirable System in Japan

(1) Reasons for Shelving Introduction of the System at the Time of the Trademark Law Amendment of 1996

Introduction of the consent system was examined in the Trademark Issue Examination Subcommittee of the Industrial Property Council, however, shelved due to the following reasons:

- (i) Assuming that examination concerning general confusion of origins (Article 4, section 1 (11) of the Trademark Law) is not conducted, if the Patent Office strictly examines presence or absence of specific confusion of origins (Article 4, section 1 (15) of the Trademark Law), burdens of examination would increase and significant procedural delay would be caused. On the other hand, if only simple examination is performed, registration of a trademark that is likely to cause specific confusion would be granted.
- (ii) If the consent system is introduced, an applicant commences negotiations for consent with the right holder of a cited trademark at the point when the applicant receives a notice of grounds for rejection. Then, if the negotiation becomes lengthy, examination procedure would be delayed.
- (iii) Since the scope of similarity is narrower in Japan than in foreign countries, there is less room for the consent system to function.
- (iv) If a similar trademark is once registered in the name of the right holder of an earlier registered trademark, and later assigned to an applicant for such a similar trademark, it is possible for the applicant to obtain a trademark right of the similar trademark. If coexistence of trademarks is admitted by separating and transferring similar trademarks, “*Keriai*”^(*11) is likely to occur for a new trademark application by one right holder. There is a view that the consent system is necessary in order to prevent this from occurring. However, since transfer of a similar trademark that is likely to cause “*Keriai*” is not expected to occur, it is unnecessary to consider remedies for such a risk.

(*11) Even if one right holder of a similar trademark that is transferred to a different right holder applies for registration of a trademark similar to its own trademark for development of a trademark which reflects changing of the times, the application will be rejected due to similarity of that trademark to the trademark of the other right holder. Such a case is called “*keriai*”.

(2) Examination of the Reasons for Shelving Introduction of the Consent System at the Time of Trademark Law Amendment of 1996

- (i) Delay in examination of an application due to increase in burdens for examination of specific confusion of origins

In the countries where the “reservation type consent system” is adopted, examination on “likelihood of confusion” is still conducted even if a consent exists. Although introduction of the consent system seems to have shelved on the premise that this requirement of confusion corresponds to Article 4, section 1 (15) of the Japanese Trademark Law, this premise seems to have not been examined sufficiently.

The increase in burdens for examination under Article 4, section 1 (15) of the Trademark Law if the consent system is introduced should be discussed based on examination on how a relationship between the consent system and the requirements for registration of Article 4, section 1 (11) to 15 of the law should be understood and how the requirement for registration of Article 4, section 1 (15) of the law should be understood.

- (ii) Problem of delay in examination caused by waiting for submission of consent

There should be the same problem in other countries where examination of relative grounds of rejection is conducted and the consent system exists. Therefore, this problem can be overcome, if practices of patent offices in foreign countries are investigated and an appropriate way of implementing the system is examined including a period for submitting consent or the like from the viewpoint of preventing delay in examination procedure.

- (iii) Lack of needs for introduction of the consent system

Concerning the reason that there is less room for the consent system to function in Japan, if the scope of similarity is narrower than that in foreign countries, the number of users of the consent system would not be large and it would be unnecessary to be concerned about delay in examination procedure. In addition, it would be appropriate to introduce the consent system for users who need it from the viewpoint of user-friendliness.

- (iv) Existence of other adoptable means

It is not appropriate to force users to take complicated procedures such as separate transfers of similar trademarks without any positive reason.

Moreover, it is proposed in a report of the Council that the consent system should be introduced in order to prevent “*Keriai*” phenomenon due to separate transfers of a similar trademark. This proposal should be reevaluated so that construction of trademarks can be changed in accordance with changing of the times.

According to the above description, any of the grounds shown as the reasons for shelving introduction of the consent system at the time of Trademark Law amendment of 1996 is not decisive. There would be sufficient room for reconsideration toward introduction of the consent system, from the viewpoints of securing international harmonization and user-friendliness.

(3) Desirable Consent System in Japan

If the consent system is to be introduced in Japan, the “complete type consent system” of the United Kingdom or the “reservation type consent system” represented by that of the United States would be a model.

A trademark system has both an aspect of private interest in that confidence of traders and a process of accumulating the same are protected and an aspect of public interest in that confusion of consumers are prevented. A system that can be adopted depends on which of these aspects is emphasized.

The complete type consent system may be regarded as a system in which the aspect of private interest is emphasized in that registration is admitted without any examination of relative grounds for rejection at all if consent of the party concerned is submitted. On the other hand, the reservation type consent system is a system that does not admit registration if there is likelihood of confusion although consent is respected. If importance is to be attached to the aspect of public interest, the reservation type consent system would be adopted.

Moreover, it is also necessary to examine consent relating to conflict with a well-known trademark.

A system in Japan will be designed through examination of these points.

IV Disclaimer System

1 What is the Disclaimer System?

The disclaimer system is a system under which an applicant of a trademark declares disclaimer of a right to the effect that, if the trademark includes a generic or non-distinctive element, the applicant does not claim an exclusive right for use of such an element, and if the trademark is registered, the applicant cannot claim a right for the element for which the right is disclaimed.

2 Situations of Implementation in Foreign Countries

- (i) Countries where the disclaimer system is adopted
 - ① Countries and a region where the disclaimer

system is adopted in law

OHIM, United Kingdom, Denmark, Norway, Spain, Sweden, United States, Canada, Australia, Hong Kong, India, Malaysia, Singapore, Thailand, etc.

Note that the disclaimer system is seldom used in practice in OHIM and the United Kingdom.

② Countries where the disclaimer system is adopted in practice

Argentina, China, India, etc.

(ii) Countries where the disclaimer system is not adopted

① Germany, France, Austria, Switzerland, Italy, Russia, New Zealand, Indonesia, Korea, etc.

② Countries where there are alternative measures substituting for the disclaimer system

In New Zealand, a trademark can be amended so as to delete a non-distinctive part. China adopts the disclaimer system while adopting a similar practice to that in New Zealand.

3 Right disclaiming system (*Kenri Fuseikyu Seido*) in Japan

(1) History of the Right Disclaiming System and Reasons for Abolishing the Same

In Japan, the right disclaiming system (*Kenri Fuseikyu Seido*) was provided in the Trademark Law of 1921 and had lasted until abolished by the 1959 Law now in force. Reasons for abolishing the right disclaiming system by the 1959 Law include the following:

① Interpretation of the word “a part that is likely to be found as a main part of a trademark” was difficult, and there was actually a problem in finding a “main part” in examination of an application.

② There was an abuse in that a trademark without specific distinctiveness is actually registered utilizing the right disclaiming system.

③ Moreover, a doubt was raised that the scope of claim for damages under the civil proceeding and the scope of criminal liability were different for a part for which a right was disclaimed.

4 Arguments on Reintroduction of the Disclaimer System in Japan

(1) Needs of Users

It was found from domestic questionnaires survey carried out in this study, it was found that 16% of companies actually utilize the disclaimer system mainly in Asian countries.

In addition, many companies utilizing the disclaimer system are large companies with the capital of 10 billion-yen or more.

In response to a question of whether or not the disclaimer system should be introduced to our country, 32% of the companies answered it is necessary, which exceeds 24% that answered it is

unnecessary. Thus, the necessity of introducing the disclaimer system seems to be high.

(2) Summary of Arguments For and Against Introduction of the Disclaimer System in Japan

Currently existing arguments for and against introduction of the disclaimer system are summarized based on the reasons for abolishing the right disclaiming system in 1959.

(i) Clarification of right

① Argument for introduction: The disclaimer system is helpful in clarifying relationship of trademark rights and is also useful in terms of convenience of examination of applications.

② Argument against introduction: Since a practice has been established for finding a scope of an exclusive right in the scenes of examination of senior or junior applications and an infringement of right and an idea generally accepted by society has been formed on this issue, there are not so significant evils or confusions even if the disclaimer system is not adopted.

In addition, more appropriate judgment corresponding to respective scenes in which a specific problem occurs can be expected, if an interested party and both parties concerned make specific decisions in each scene, rather than fixing judgment at the time of registration.

(ii) Influence on examination of applications

① Argument for introduction: As described in above (i), the disclaimer system is also useful in terms of convenience of examination of applications.

② Argument against introduction: In Japan, facilitation of examination of applications is realized by abolishment of the associated trademark system and shift to the post grant opposition system and speedy procedure is realized in practice. Adoption of the disclaimer system is against such a trend toward facilitation of examination procedure.

(iii) Viewpoint of international harmonization

① Argument for introduction: In an international application for trademark registration designating Japan under the Madrid Protocol, if an applicant of the international application disclaims a right, exercise of a right should also be restricted for a problem of infringement of the right in Japan, along the intention of the applicant not to claim the right voluntarily.

② Argument against introduction: According to revision of the common rule of the Madrid Protocol, an applicant of an international application will be able to optionally enter disclaimer in a description of a trademark on an application even if a basic registration or the like does not involve disclaimer. Thus, advantage of adopting the disclaimer system in Japan is reduced.

Moreover, internationally, countries are rather reluctant to adopt the disclaimer system. For example, in the United Kingdom, request for

compulsory disclaimer was revised to optional disclaimer to be voluntarily chosen by an applicant. In the United States, abolishment of the disclaimer system is under consideration.

(iv) System that should be introduced

① Argument for introduction: If the optional disclaimer system of the United Kingdom is adopted, the problem of delay in examination of applications is eliminated so as to be able to comply with the trend toward international harmonization of trademarks in recent years.

② Argument against introduction: There are problems in both the compulsory and optional disclaimer systems. In the former system, for an application that is registrable in nature, an applicant is obliged to make a counter argument or the like by submitting a written opinion concerning only propriety of finding of the disclaimer. In addition, in the latter system, if a disclaimer is not declared, a trademark is likely to be misunderstood as if it is admitted as an exclusive right.

(v) Others

Argument for introduction: Existence of the disclaimer system can serve as a means for establishing conditions that the parties concerned should approve for each other in opposition or invalidation appeal procedures. The disclaimer system, together with the consent system, can be a means for providing a mechanism for solving a dispute between the parties concerned. That is, the disclaimer system contributes to private autonomy. In the future, it would be necessary to thoroughly discuss these issues and examine whether or not the disclaimer system should be adopted in Japan from new viewpoints.

5 Tentative Plan of a New Disclaimer System in Japan

We have examined a system design to be used in the case that the disclaimer system is introduced in Japan and discussed points to be revised in the law, based on basic subjects associated with the system.

(1) Effect of a Trademark Right by Disclaimer, in Particular, a Problem of Similarity with a Registered Trademark

Concerning an effect of a disclaimed trademark right, there are differences in interpretation thereof in foreign countries adopting the system and there is not always an internationally established uniform method of handling the issue.

In examining similarity of trademarks, we consider that similarity of trademarks as a whole should be decided including a part for which a right is disclaimed.

Disclaimer is not for abandoning an effect

under the law for registering a trademark right, that is, an effect of excluding registration of another trademark conflicting with the registered trademark^(*12). Therefore, as long as a trademark is registered, even a trademark for which a right is disclaimed should be compared and examined as a whole in judging similarity as in normal cases.

In addition, a court decision also rules that similarity should be decided for trademarks as a whole including a disclaimed part in examining similarity of trademarks^(*13).

(2) Should Failure to Disclaim be a Requirement for Unregistrability?

The disclaimer system should be made optional, and even if a part of a trademark not having distinctiveness or including doubtful points is not disclaimed, this failure to disclaim should not be a requirement for unregistrability.

(3) Is Disclaimer Admitted for Each Goods and Service?

A problem of whether or not disclaimer is to be admitted for each goods and service should also be left to an own volition of an applicant or a trademark right holder. Since a system for designating goods and services of multiple classes in one application is employed in Japan, it would be too harsh for an applicant or the like to disclaim a right for all goods and services including designated goods and services for which the matter of presence or absence of distinctiveness does not become a problem.

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(*12) Makoto Amino "Trademark" p.435 (Fifth edition, Yuhikaku, 1999).

(*13) The decision of Tokyo High Court, March 28, 1968, Showa 41 (Gyo-Ke) 101.