



# Proving Trademark Use in a Cancellation Action Based on Non-Use

**Chihiro IJIMA**  
**Japan Patent Attorneys Association**  
**International Activities Center**



# Agenda

1. Overview of Japanese Practice
2. Issues on Use Requirements and Justification for Non-Use
  - (1) Use Requirements – In Japan
  - (2) Use Requirements – Identity of Marks
  - (3) Justification for Non-Use
3. Recent Amendments to Trademark Law

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# 1. Overview of Japanese Practice

- Cancellation is available against a trademark registration when the mark has not been used for over three years after the date of registration.
- Proof of use is not required prior to a registration, at renewal or at certain points after registration.

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# 2 (1). Use requirements – In Japan

## Use of the trademark must occur in Japan

### 【COVERDERM】

\**Heisei 29 (Gyoke)* No. 10071 (IP High Court., Nov 29, 2017).

Registered trademark: COVERDERM

Trademark owner: Farmeco S.A. Dermocosmetics

### 【PAPA JOHN'S】

\**Heisei 17 (Gyoke)* No. 10095 (IP High Court., Dec 20, 2005).

- Registered trademark: PAPA JOHN'S
- Trademark owner: Papa John's International, Inc.

### Issue:

Whether the use of a mark on a website is considered as use in Japan

# 2 (1). Use requirements - In Japan

COVERDERM \*Heisei 29 (Gyoke) No. 10071 (IP High Court., Nov 29, 2017).

## Facts:

- COVERDERM was affixed on a website, Coverderm Product Order Form
- Descriptions about the brand, [written in Japanese](#)
- Order form with the following description [written in Japanese](#)  
"Please fill in the required information in the blank below and place your order."
  - Set up an order form on the website that allows consumers in Japan to order the products
- and
  - [A Japanese domain name](#) was used for the website: coverderm.jp

## Petitioner:

There was no proof that the products were actually delivered to Japan.

The use should not be admitted as use in Japan.

# 2 (1). Use requirements - In Japan

COVERDERM \**Heisei 29 (Gyoke) No. 10071 (IP High Court., Nov 29, 2017).*

## Decision:

Registered mark is maintained, as use of the mark is confirmed.

## Reasons:

- It is clear that the website is a product order form targeting consumers in Japan.
- There are descriptions about the brand [written in Japanese](#).
- The owner set up an order form on the website with the intention of allowing customers in Japan to order their products.
- The owner obtained and used [a Japanese domain name](#) for the website.
- The website is sufficient to establish that the use of the mark occurs in Japan even though the owner does not provide proof of the actual delivery of the product to Japan.



# 2 (1). Use requirements - In Japan

## PAPA JOHN'S

*\*Heisei 17 (Gyoke) No. 10095 (IP High Court., Dec 20, 2005).*

- Registered trademark: PAPA JOHN'S
- Trademark owner: Papa John's International, Inc.

# 2 (1). Use requirements - In Japan

## PAPA JOHN'S

*\*Heisei 17 (Gyoke) No. 10095 (IP High Court., Dec 20, 2005).*

### Facts:

- Pizza shops only in other countries.
- Advertised pizzas through the website bearing the registered mark.
- Recruited franchisees in Japan through the website to expand their business into Japan.
- Written in English.
- Accessible to consumers in Japan.

# 2 (1). Use requirements - In Japan

## PAPA JOHN'S

*\*Heisei 17 (Gyoke) No. 10095 (IP High Court., Dec 20, 2005).*

### **Decision:**

Registered mark is cancelled, as use of the mark is not confirmed.

### **Reasons:**

- The website is all written in English. It is hard to admit that the website targets consumers in Japan.
- It is natural for a website to be accessible from Japan. It cannot be a reason to affirm that the use occurs in Japan.

# 2 (1). Use requirements- In Japan

## Practical Tips

- Materials should be written in Japanese.
- Actual delivery to Japan would not be required.
- Obtaining and using a Japanese domain name would be helpful.

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## 2 (2). Use requirements - Identity of Marks

- Mark to demonstrate the use should be identical with the registered mark.
- Mark differing from the registered mark would be admitted as long as the mark in use does not alter the distinctive character of the registered mark.

## 2 (2). Use requirements - Identity of Marks

Examples:

- Typeface

○ Bluebird ↔ Bluebird

- Upper case /Lower case letter

○ HI-KE ↔ hi-ke

- Convey the substantially same impression in appearance



## 2 (2). Use requirements - Identity of Marks

Different in characters, but generating the same sound and meaning

Examples:

○ LOVE ↔ ラブ (Japanese transliteration: LOVE in katakana)

○ APPLE ↔ アップル (Japanese transliteration: APPLE in katakana)

× PEACE ↔ ピース (Japanese transliteration: PEACE in katakana/  
PIECE in katakana)

× PIECE ↔

× LIGHT ↔ ライト (Japanese transliteration: LIGHT in katakana /

× RIGHT ↔ RIGHT in katakana)



## 2 (2). Use requirements - Identity of Marks

○ Adding/Using with descriptive terms

Examples:

Registered Mark: EUROPEAN

Mark in use: EUROPEAN COFFEE (Goods: Coffee)

× Adding/Using with distinctive terms

Examples:

Registered Mark: rhythm

Mark in use: NEO RHYTHM (Goods: Footwear)

## 2 (2). Use requirements - Identity of Marks

Marks consisting of a device and letters

Examples:

Registered Mark:  
(Class 25)



× Mark in use: CAMEL COLLECTION

\*JPO Trial Board: 2000-30379

Registered Mark:




(Class 21)

○ Mark in use: SUNNAP

\*JPO Trial Board: H11-031305

## 2 (2). Use requirements - Identity of Marks

### Practical Tips

- Whether the mark in use alters the distinctive character of the registered mark
- Consumers' view
- Famous / well-known/ mark
- Indication of registered trademark symbol 

Mark in use: EUROPEAN® COFFEE (Goods: Coffee)

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## 2 (3). Justification for Non-Use

In cases where it would be too harsh to attribute the non-use to the trademark owner

Such as :

- Force majeure  
ex) earthquake, flood, etc.,
- Exercise of public authority  
ex) prohibition of use by law or regulations

## 2 (3). Justification for Non-Use

Circumstances beyond the control of the trademark owner

× Tried to expand the business into the Japanese market, but it was not successful.

× Due to the Pharmaceutical Affairs Law, there was a delay in using the trademark to obtain the necessary permission for the manufacturing of cosmetics

# Summary

☞ To trademark owners:

- Review the material involving the use if it would serve as evidence of use in Japan.
- Review the mark in-use and consider refiling the mark.

# Summary

- ☞ To the applicants who wish to obtain a trademark right in Japan
  - Explore the chances of success in a cancellation action based on non-use



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### 3. Recent Updates - Law Amendments in 2023

- Relaxation of Requirements for Trademark Registration Containing a Person's Name

(Art. 4(1)(viii) of Trademark Act)

- Introduction of Consent System for Trademark Registration

(New Art. 4(4) of Trademark Act and Art. 19 of UCP Act)

- Will be enforced on **April 1, 2024**

# 3. Recent Updates - Law Amendments in 2023

## Relaxation of Requirements for Trademark Registration Containing a Person's Name

(Art. 4(1)(viii) of Trademark Act)

[Before]

× JUNKO SHIMADA



Rejected (Trial No. 2017-008311)

× KEN KIKUCHI



Rejected (Heisei 31 (Gyoke) No. 10037,  
IP High Court., August 7, 2019 )

# 3. Recent Updates - Law Amendments in 2023

## Relaxation of Requirements for Trademark Registration Containing a person's name

(Art. 4(1)(viii) of Trademark Act)

[After]

A trademark containing a person's name **that is widely known among consumers in the fields of goods and services that the trademark is used for** cannot be registered, except those the registration of which has been approved by the person concerned.

# Recent Updates - Law Amendments in 2023

## Introduction of Consent System

(New Art. 4(4) of Trademark Act and Art. 19 of UCP Act)

- Letter of Consent from the owner  
and
- No likelihood of confusion between the marks

# Recent Updates - Law Amendments in 2023

## Introduction of Consent System

(New Art. 4(4) of Trademark Act and Art. 19 of UCP Act)

### Under discussion

- How examiners determine the likelihood of confusion
- Necessary documents

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**Thank you for your attention.**



**Chihiro IJIMA**

[ijima@onm-tm.jp](mailto:ijima@onm-tm.jp)

Trademark Attorney

Oshima, Nishimura & Miyanaga PPC

**ONM**  
TRADEMARK X DESIGN



# Any Questions?

