

# Looking Beyond Trademarks

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**Ad Words, Metatags and  
Trademarks, Oh my: How to  
enforce your trademark rights on  
an uneven playing field  
- JAPAN**

# Looking Beyond Trademarks



**1. Can it be an “infringement of a trademark right”?**

# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

Typical use of a trademark

Law requirements:

- Visibility (Article 2(1))
- Affixation to an advertisement material relating to goods/services (Article 3(viii))



# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

### Meta tags/ Title tags

AIGI Intellectual Property Law Firm - JAPAN

words in the title tag

[en.aigipat.com/](http://en.aigipat.com/) ▼

words in the meta tag (description tag)

Patent and trademark law firm in Japan -prosecutions and litigations on Japanese intellectual property issues.

A trademark is displayed,  
but **Not** in an **advertisement material**



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### 1. Can it be an “infringement of a trademark right”?

#### Meta tags/ Title tags

***KURUMA NO 110 BAN case*** (H16-2004(wa)No.12032) <sup>3</sup>

Infringement of the trademark right was **affirmed**

-“A meta-tag description **displayed** on a search site would be taken as an **advertisement** to designate source of the website”

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## 1. Can it be an “infringement of a trademark right”?

### Meta tags/ Title tags

#### *Cases:*

**KURUMA NO 110 BAN case** (H16-2004(wa)No.12032) <sup>3</sup>

**IKEA case** (H24-2012(wa)No.21067) <sup>4</sup>

**BIKE LIFTER case** (H29-2017(wa)No.547) <sup>5</sup>

**TAKAGI case** (H29-2017(wa)No.14637) <sup>6</sup>

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### 1. Can it be an “infringement of a trademark right”?

#### Keyword tags

A keyword in keyword tags is **NOT displayed** even on a search site.



# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

### Keyword tags

***BIKE LIFTER case*** (H29-2017(wa)No.547) <sup>5</sup>

Infringement of the trademark right was **denied**

-“Use” (Article 2(3)(viii)) should be an act which can be recognized by perception by consumers, and the affixed mark to the content of an advertisement should be recognized by perception”

# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

### Adwords

advertisement  
as a search result  
on Google

人気結婚式場【BEST 10】 | 最新2018結婚式場ランキング

[www.hana-yume.net/](http://www.hana-yume.net/) ハナユメ公式/結婚式場探し ▼

おすすめ会場、口コミ、挙式実例、割引特典、多数掲載！人気結婚式場の費用が50%オフ。特典付きのお得な見学予約。人気結婚式場の特典検索。予算や後払いも相談OK。全国に無料相談デスクも。今だけフェア予約で商品券。無料セミナーも開催中。

費用はいくらかかる？

実際の負担額の相場、内訳は？

予算内で理想の結婚式をあげる方法

貯金がなくても大丈夫？

結婚式費用はハナユメデスクに相談！

予算や後払いの無料相談・当日来店OK

A trademark chosen as an adword **is/is not**  
**displayed** in an **advertisement**  
as a search result

a trademark displayed

## Looking Beyond Trademarks



### 1. Can it be an “infringement of a trademark right”?

#### Adwords

***CARICA CELAPI case*** (H18-2006(wa)No.7458) <sup>7</sup>

*The disputed trademark was not displayed on the search site*

Infringement of the trademark right was **denied**

- “The defendant's act cannot be “use” in Article 3 of Trademark Act”

## Looking Beyond Trademarks



### 1. Can it be an “infringement of a trademark right”?

#### Adwords

***SEKKEN HYAKKA appeal case*** (H28-2016(ne)No.1737) <sup>8</sup>

*The disputed trademarks were displayed on the search site;*

*The site (shopping mall) hyper-linked to the advertisement space included a display of goods;*

## Looking Beyond Trademarks



### 1. Can it be an “infringement of a trademark right”?

#### Adwords

#### **SEKKEN HYAKKA appeal case** (H28-2016(ne)No.1737) <sup>8</sup>

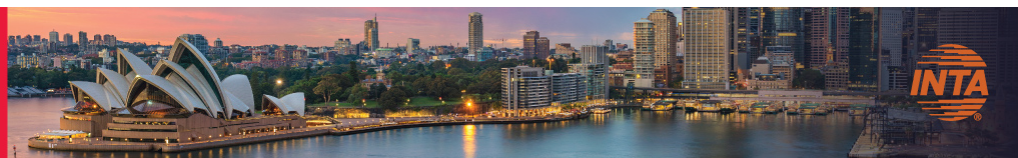
*The Defendant was a shopping mall operator but the adwords were automatically determined by hidden keywords which a tenant chose;*

*The Defendant prohibited tenants’ unauthorized use of a trademark*

Infringement of the trademark right was **denied**



# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

	A trademark displayed?	Can be an infringer of a trademark right?		
		advertiser	Shopping mall operator	Search site provider
Typical “use of a trademark”	<b>Displayed</b> on an advertiser’s site (i.e., advertisement material)	Yes (Article 2(1), (3)(viii))	Yes/ No <b>Case 9</b>	
Meta tag/ Title tag	<b>Displayed</b> on a search site	Yes <b>Case 3, 4, 5, 6</b>		
Keyword tag	No (hidden)	No <b>Case 5</b>		

**Case 3: KURUMA NO 110 BAN case (H16-2004(wa)No.12032)**

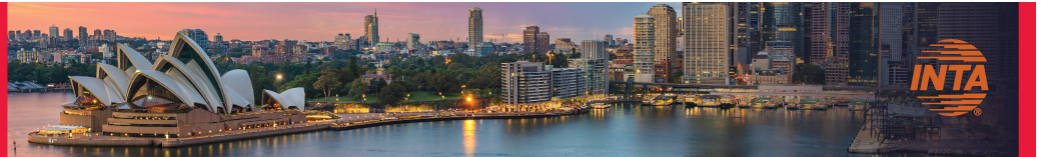
**Case 4: IKEA case (H24-2012(wa)No.21067)**

**Case 5: BIKE LIFTER case (H29-2017(wa)No.547)**

**Case 6: TAKAGI case (H29-2017(wa)No.14637)**

**Case 9: RAKUTEN case (H21-2009(wa)No.33872)**

# Looking Beyond Trademarks



## 1. Can it be an “infringement of a trademark right”?

	A trademark displayed?	Can be an infringer of a trademark right?		
		advertiser	Shopping mall operator	Search site provider
Adwords	No	No <i>Case 7</i>		
	<b>Displayed</b> on a search site		Yes/No <i>Case 8</i>	

*Case 7: CARICA CELAPI case (H18-2006(wa)No.7458)*

*Case 8: SEKKEN HYAKKA appeal case (H28-2016(ne)No.1737)*

# Looking Beyond Trademarks

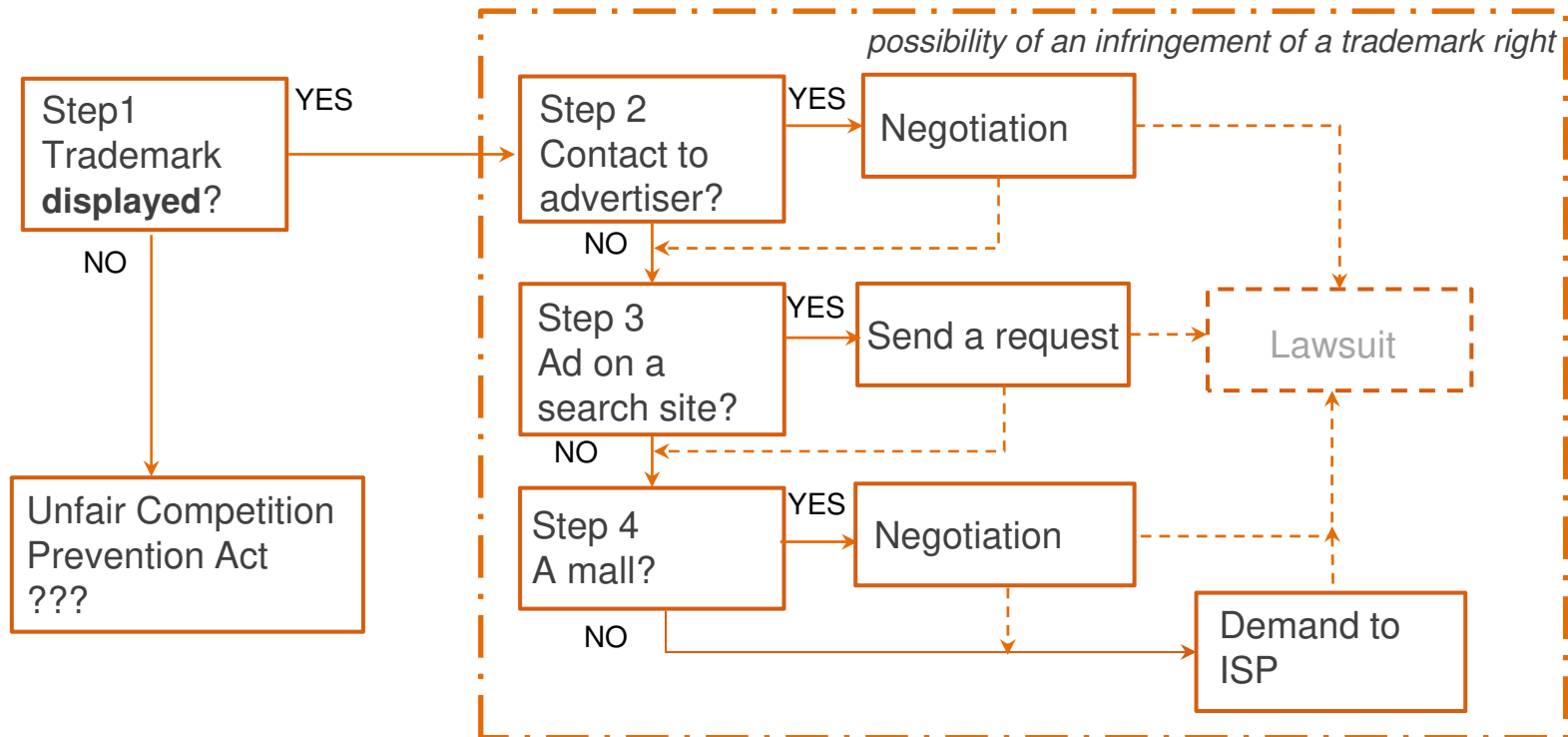


## 2. What can a brand owner do?

# Looking Beyond Trademarks



## 2. What can a brand owner do?



## Looking Beyond Trademarks



### 2. What can a brand owner do?

Step1: Is the TM displayed on a search site?

- If “Yes”,  
It can be an **infringement** of your trademark right.



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### 2. What can a brand owner do?

Step2: Can you contact the advertiser?

- If “Yes”,  
Try a negotiation with them.

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### 2. What can a brand owner do?

Step3: Is the TM displayed in an ad on a search site?

- If “Yes”,  
Send a request to Yahoo!/Google to delete the TM  
*Yahoo!* and *Google* do not accept an advertiser’s infringing a third party’s trademark right, and they accept a request from a brand owner for deleting adwords if with clear evidence.

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### 2. What can a brand owner do?

Step4: Is the ad related to a mall?

- If “Yes”,  
Try to contact and negotiate with the shopping mall operator or the auction site provider.

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## 2. What can a brand owner do?

Step4: Is the ad related to a mall?

- If “No”,  
Try to send a demand to the Internet Service Provider (ISP)
  - for disclosure of identification information of the trademark user, or,
  - for prevention of transmission

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## 2. What can a brand owner do?

Step1: Is the TM displayed on a search site?

- If “No”,  
...???

*As for Adwords...*

*Yahoo!* and *Google* clearly state that choosing third party's (registered) trademark as an Adword itself is not an infringement of a trademark right.



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## 2. What can a brand owner do?

Step1: Is the TM displayed on a search site?

- Even if “No”,

If your brand is well-known/ famous...

“Unfair Competition Prevention Act”???

*“perception” is not explicitly required for an  
“indication of goods (trade name, trademark ...)”  
to be protected in the Act.*

## Looking Beyond Trademarks



Please refer to my course material and summaries of the cases for further details.

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