

# **The Role of Trademarks in Protecting a World-Wide Brand Originating in Japan**

**Presented by: Jill Browning, William Boshnick, Jeff Handelsman**

**January 2022 Video Lecture for  
JIPA Regional Division's Monthly Meeting**



# Greenblum & Bernstein

Formed in 1978

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35+ Patent attorneys – all technologies

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10 Japanese speakers

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17 former USPTO examiners

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Experienced in Prosecution/Litigation/  
M&A/IPR/Licensing Strategies

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Located in DC area, near Dulles Airport

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Often travel to Japan

# Overview



- CREATION/SELECTION OF TRADEMARK
- TRADEMARK SEARCHES
- FILING STRATEGY
- PROSECUTION
- MAINTAINING TRADEMARK RIGHTS/  
USE REQUIREMENTS
- ENFORCEMENT



# CREATION/SELECTION OF TRADEMARK



- Distinctiveness
  - Levels of distinctiveness
    - Fanciful
    - Arbitrary
    - Suggestive
    - Descriptive
    - Generic
- Inappropriate meaning/Cultural issues



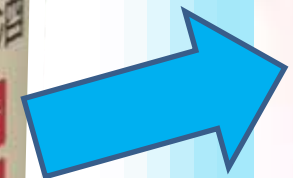
# Trademark Searches

- Various public databases to search for identical marks as a starting point (prior to conducting “comprehensive” trademark searches)
- Timing – prior to or at same time as filing applications
- Foreign equivalents

- Which mark(s)
  - Word Mark, Logo
  - English/Japanese (Kanji/Katakana)
  - (1) “chiru” (2) “chill”  
(3) チル



- Label





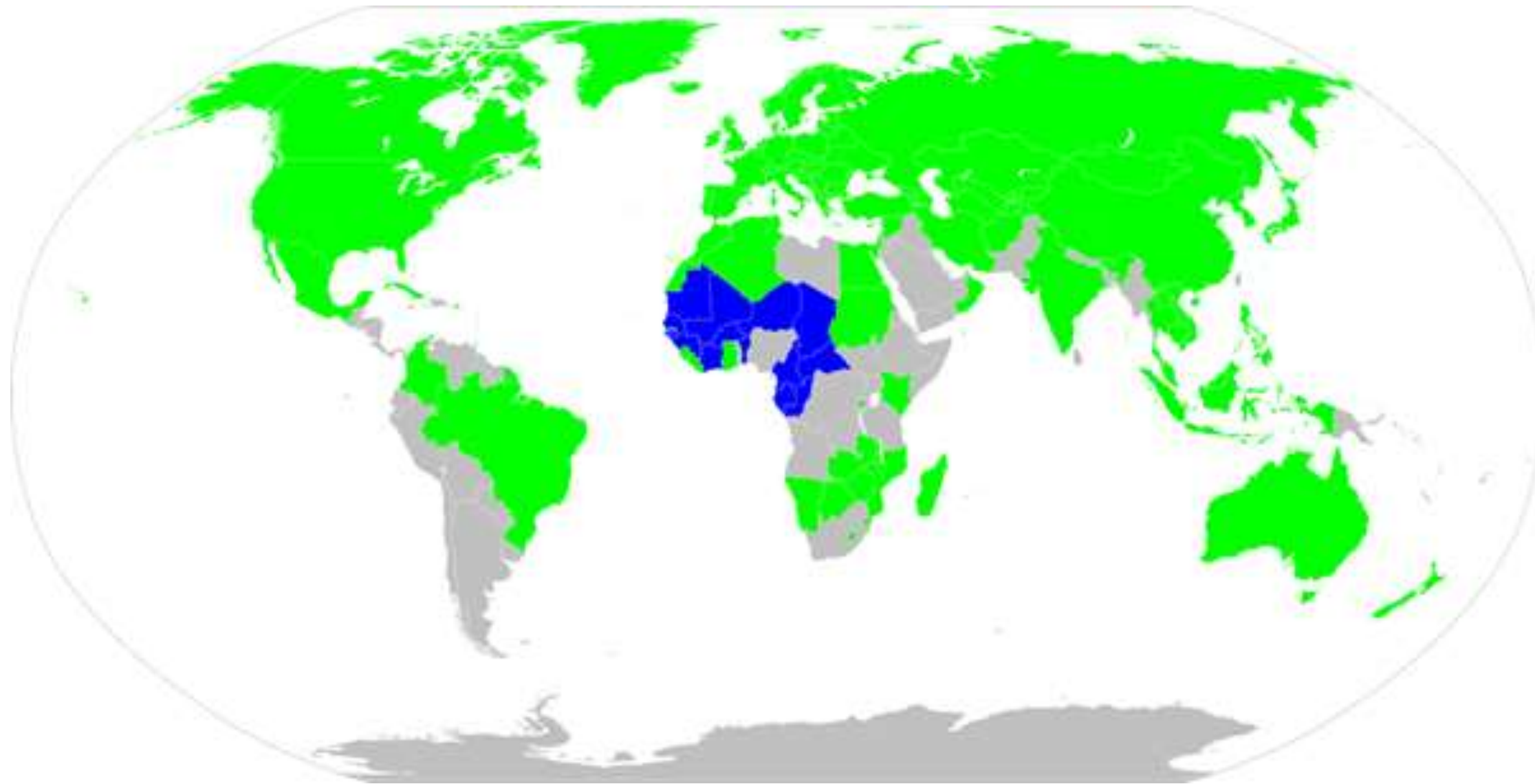
- Which mark(s)
  - Shape/Color(s)/Design (“trade dress”)
  - Design Patent
  - Copyright



# Filing Strategy (continued)



- **Where to file**
- **National v. International filing (Madrid Protocol)**



[https://en.wikipedia.org/wiki/Madrid\\_system](https://en.wikipedia.org/wiki/Madrid_system)



# Filing Strategy (continued)



- PROS/CONS OF MADRID PROTOCOL (INTERNATIONAL REGISTRATION)

## PROS

### COSTS

- Filing Fees
- Renewal Fees
- Changes of Ownership

Reduces Maintenance Burden

## CONS

"Central Attack"

Portfolio management

- Different Renewal Deadlines, e.g., U.S., Mexico, Philippines

Issues Unique to United States:

- Cannot amend to Supplemental Register
- Register
- No reclassification of goods/services
  - Cannot amend mark

# Filing Strategy (continued)



- Advantages to relying on foreign application or registration when filing national U.S. application
  - No need to submit Statement of Use, but...
    - There is a 3-year non-use cancellation period
    - New USPTO *Ex Parte* cancellation procedures

# Prosecution of U.S. Trademark Applications

- Filing basis
  - what constitutes “use” in United States
- Office Actions
  - “Likelihood of confusion” refusal
  - “Merely descriptive” refusal
- Oppositions
  - 30-day publication period

# Maintenance of U.S. Trademark Registrations

- Declaration of Use due between 5th and 6th year following U.S. registration date and Renewal/Declaration of Use due every 10 years from U.S. registration date
- Must submit at least one “specimen” (proof of use) per Class
  - SPECIMEN
    - Use of mark on product, labels, packaging, website (product must be available for purchase), trade show display
    - Post-Registration audits



🔍 zoom

## Chiru Junmai Ginjo Sake

750ml

WINERY DIRECT®

Oregon - This Junmai Ginjo Sake delivers flavors of red berries, cherry, guava, and mochi. It is mildly sweet with aromas of melon, grapes, and hints of tropical fruit on the nose.

BRAND	<a href="#">Chiru</a>
COUNTRY / STATE	<a href="#">Oregon</a>
WINE TYPE	<a href="#">Sake &amp; Plum Wine</a>
VARIETAL	<a href="#">Sake</a>
STYLE	Semi-sweet
ABV	14.8%
TASTE	Red Berry, Guava, Cherry
BODY	Medium-bodied
SKU	213348750-1

★★★★☆ 4.0 (10)

\$19.99

<input checked="" type="radio"/>	<b>Pick Up</b> <a href="#">In Stock</a> Chantilly Aisle 07, Left	<a href="#">Nearby Stores</a>
<input type="radio"/>	<b>Delivery</b> <a href="#">Available</a> Confirm your address to check eligibility.	<a href="#">Confirm Address</a>
<input type="radio"/>	<b>Ship to Virginia</b> <a href="#">In Stock</a>	<a href="#">Change Location</a>

Quantity	Size(s)
- 1 +	750ml (Single)

Add To Cart

\*Price, vintage and availability may vary by store.

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🔍 zoom



## Joto Junmai One Cup Sake "The Graffiti Cup"

200ml

Japan-Packaging of Joto One Cup was designed by Japanese graffiti artist, Shiro. Made by Marumoto Brewery, which grows yamada nishiki, the most famous sake rice. Some of this sake is blended into this affordable, single serving to give it a fruitier style.

BRAND [Joto](#)  
COUNTRY / STATE [Japan](#)  
WINE TYPE [Sake & Plum Wine](#)  
VARIETAL [Sake](#)  
SKU 213500200-1

★★★★★ 5.0 (6)

\$3.99

☒ Pick Up

[In Stock](#)

Chantilly

Aisle 07, Left

[Nearby Stores](#)

☐ Delivery

[Available](#)

Confirm your address to check eligibility.

[Confirm Address](#)

☐ Ship to Virginia

[In Stock](#)

[Change Location](#)

Quantity

— 1 +

Size(s)

200ml (Single)

[Add To Cart](#)

\*Price, vintage and availability may vary by store.

Share



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# Brand Management/Enforcement

- Trademark Watches
- Competitor Watches
- Social media watches
- UDRP proceedings (domain names – register important domain names)
- Importance of U.S. Registration (can record with U.S. Customs and Border Protection (CBP), social media/e-commerce take-down notices, Amazon Brand Registry, etc.)

# TAKEAWAYS



- Select a distinctive mark
- Conduct trademark search before use of mark in U.S.
- What marks and where to file  
(including whether to utilize *Madrid* system)
- Importance of “use” of the mark in the U.S.
- Active “Policing” of Brand

# THANK YOU FOR YOUR TIME!

## Greenblum & Bernstein, P.L.C.

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