

University of Miami International and Comparative Law Review

Volume 1
Issue 1 *THE UNIVERSITY OF MIAMI YEARBOOK
OF INTERNATIONAL LAW VOLUME 1*

Article 13

1-1-1991

Foreign Language Trademarks in Japan: The Linguistic Challenge

Rosalynn Frank

Follow this and additional works at: <https://repository.law.miami.edu/umiclrl>



Part of the [Comparative and Foreign Law Commons](#), and the [International Law Commons](#)

Recommended Citation

Rosalynn Frank, *Foreign Language Trademarks in Japan: The Linguistic Challenge*, 1 U. Miami Int'l & Comp. L. Rev. 206 (1991)

Available at: <https://repository.law.miami.edu/umiclrl/vol1/iss1/13>

This Article is brought to you for free and open access by the Journals at University of Miami School of Law Institutional Repository. It has been accepted for inclusion in University of Miami International and Comparative Law Review by an authorized editor of University of Miami School of Law Institutional Repository. For more information, please contact library@law.miami.edu.

FOREIGN LANGUAGE TRADEMARKS IN JAPAN: THE LINGUISTIC CHALLENGE

ROSALYNN FRANK*

SUMMARY

- I. INTRODUCTION
- II. THE JAPANESE LANGUAGE
- III. JAPANESE TRADEMARK LAW
 - A. THE BASICS
 - B. LINGUISTIC SIMILARITY
- IV. USE OF A TRADEMARK
- V. EXAMPLE ANALYSIS
- VI. CAUTIONS
- VII. CONCLUSION

I. INTRODUCTION

As international commerce increases, foreign businesses need to become familiar with the different laws under which they will deal and be held accountable.¹ The protection of intellectual property rights is one of the most important issues arising in the context of international transactions, particularly in the Japanese market, which is prone to copying and imitation.²

In essence, trademarks are significant because they identify the origin of goods. Appearing as symbols or any form of words, they represent the distributor's guarantee of the quality of his goods and thus protect consumer confidence. Moreover, owning a trademark gives the owner the right to prevent others from using names which sound confusingly similar to his trademark, or marks which might deceive the consumer. Registering foreign words under Japanese trademark law, however, presents novel problems to lawyers in international practice, for the Japanese pronunciation of foreign words differs significantly from the words' native pronunciation. The transformation, or transliteration, of foreign words into Japanese alters the pronunciation of the foreign words to such an extent that the resulting Japanese pronunciation may be completely unrecognizable to a native's ear.³ While, as a general principle, a trademark may give the owner the right to prevent others from using marks

* B.S.F.S., School of Foreign Service, Georgetown University; J.D. University of Miami School of Law.

¹ Many American businesses have successfully conducted business in Japan. They include IBM, Coca-Cola and McDonalds. However, even these successes also encounter problems in introducing new trademarks into Japan.

² Guttman, *International Trademarks and the Japanese Language: A Guide for the Perplexed*, 71 TRADEMARK REP. 570 (1981).

³ *Id.* at 571.

or names which sound confusingly similar, or marks which are common names, as the trademark is altered to fit the Japanese language, the word protected changes also. This article will discuss basic elements of the Japanese language, Japanese trademark law, and the legal problems that foreign language trademark applicants are likely to encounter as a result of the radical transformation that their trademarks suffer when they are transliterated into Japanese.

II. THE JAPANESE LANGUAGE

The Japanese language uses a very limited number of sounds. In contrast, an "Indo-European language such as English has many more sounds difficult or impossible for native speakers of Japanese to pronounce than vice versa."⁴ As a result, there are drastic changes in non-Japanese trademarks and trade names when they are translated into Japanese, and the Japanese pronunciation of the foreign trademarks differs greatly from the trademarks' native pronunciation.

There are approximately 160 sounds in Japanese, while in English there are over a thousand sound patterns. The primary reason for this difference is the small number of Japanese vowels. In English there are 23 vowel sounds.⁵ In contrast, in Japanese there are only five basic vowels:

- (i) "a" as in farther
- (ii) "i" as in tea
- (iii) "u" as in foot
- (iv) "e" as in egg
- (v) "o" as in box.⁶

These five short vowels can be doubled in duration to produce a long vowel, resulting in just ten vowel sounds.⁷ All Japanese syllables end with vowels, except for the syllabic nasal sound "n."⁸ When "n" directly precedes "m," "p," or "b" it is pronounced as "m" for alliteration purposes. The regular syllables are formed by adding a vowel after each consonant, a process which differs significantly from that employed in other languages, where syllables frequently end with a consonant. Moreover, in many non-Japanese languages, there are consonant "clusters." These clusters are broken into individual consonant syllables, adding a vowel to each one of them, in order to make them pronounceable for the Japanese. For example, the word "Smithsonian" is pronounced by the Japanese as "su-mi-su-so-ni-a-n."

⁴ Guttman, *supra* note 2, at 570-71.

⁵ See HIDEICHI ONO, *JAPANESE GRAMMAR* 4 (1986).

⁶ T. DOI, *THE INTELLECTUAL PROPERTY LAW OF JAPAN* 133 (1980).

⁷ Guttman, *supra* note 2, at 571.

⁸ Hideichi Ono, *supra* note 5, at 1.

The Japanese language also uses the assimilated sound, or guttural stop. This pronunciation pattern occurs when two like consonants are next to each other. This guttural stop requires the speaker to stop the flow of air momentarily in front of the consonant by closing the back of the mouth and touching the tongue to the roof of the mouth. This results in two consonants. So, when a guttural stop is inserted into a word like "i-ta" ('said' in Japanese), the word becomes "it-ta" (went). The guttural stop sounds similar to the English exclamation "ouch!"⁹ In written Japanese, it appears as a miniature "tsu" in either *Hiragana* or *Katakana*. For purposes of this paper, the "tsu" is placed inside parenthesis and is not pronounced. The "tsu" is a useful tool to help the Japanese pronounce foreign words, especially consonant clusters and other unfamiliar sounds, more accurately.¹⁰

Another important linguistic quality which must be considered when transliterating foreign words into Japanese is that of subsurface phonetics. Even if a foreign word uses Japanese syllables, "a foreign wordmark has a 'subsurface phonetic part' in Japan that, like the bottom eighty nine percent of an iceberg, can cause trouble."¹¹ To ameliorate this problem, the Japanese assimilate unpronounceable sounds into familiar ones. Since doing so results in condensing two or more unpronounceable sounds into one familiar sound, however, the result is that many foreign sounds are pronounced the same way in Japanese.¹² "Subsurface" refers in particular to the sound patterns which are impossible for the Japanese to pronounce. For illustration purposes, the following is a list of Japanese syllables:

*Table of Japanese Syllabary*¹³

a	i	u	e	o	
ka	ki	ku	ke	ko	
sa	shi	su	se	so	
ta	chi	tsu	te	to	
na	ni	nu	ne	no	-n
ha	hi	hu	he	ho	
ma	mi	mu	me	mo	
ya	(i)	yu	(e)	yo	

⁹ See T.J. VANCE, AN INTRODUCTION TO JAPANESE PHONOLOGY 33 (1987).

¹⁰ Hideichi Ono, *supra* note 5, at 1.

¹¹ Guttman, *supra* note 2, at 572.

¹² Bigger & Kagedan, *Notes From Other Nations*, 75 TRADEMARK REP. 552, 572 (1985).

¹³ This table appears in E. HOROWITZ, WORLD TRADEMARK LAW AND PRACTICE § 7.02 (1990).

ra	ri	ru	re	ro
wa	(i)	(u)	(e)	(o)
ga	gi	gu	ge	go
za	ji	zu	ze	zo
da	(ji)	(zu)	de	do
ba	bi	bu	be	bo
pa	pi	pu	pe	po
kya		kyu		kyo
sha		shu		sho
cha		chu		cho
nya		nyu		nyo
hya		hyu		hyo
mya		myu		myo
rya				
gya		gyu		gyo
ja		ju		jo
bya		byu		byo
pya		pyu		pyo

The Japanese language does not differentiate between "l" and "r," "v" and "b," or "f" and "h."¹⁴ When these sounds occur in foreign words, the Japanese speaker automatically substitutes the "r" for either "l" or "r," a "b" for either "v" or "b," and an "h" for either an "f" or "h."

Finally, another important linguistic concern is that the Japanese language uses up to four different scripts. The *Katakana* syllabary is used primarily to render foreign words into Japanese. *Hiragana*, another syllabary, is also "widely used, particularly as *okurigana* [which] indicate the inflexions of verbs and certain words, the stems of which are written in *Kanji*."¹⁵ *Kanji* consist of Chinese characters, each with different Japanese and adopted Chinese pronunciation. Roman-style letters are also used¹⁶ and are referred to as *Romaji*. Foreign language trademark registrants should bear in mind that sentences and trademarks may consist of a combination of any of these systems.¹⁷

¹⁴ *Id.*

¹⁵ THE MODERN READER'S JAPANESE-ENGLISH CHARACTER DICTIONARY 1013 (2nd ed. rev. 1984).

¹⁶ J. Cunard, *Protecting Foreign Technology Transferred to Japan: Patents, Trademarks, Trade Secrets, Copyrights, Semiconductor Chips and Licensing Requirements* (Paper presented at the American Bar Association National Institute on Japan-United States Trade and Investment: Strategies for the 1990's)(Nov. 30, 1989) at 13; See also T. DOI, *supra* note 6.

¹⁷ T. DOI, *supra* note 6, at 133.

III. JAPANESE TRADEMARK LAW

A. The Basics

Even though Japan is a civil law country, the Japanese approach to trademark law is essentially like the American approach. Both countries see the need to protect intellectual property. Article 1 of the Japan Trademark Law states that its "objective [is] the protection of trademarks, with a view to maintain [sic] the business goodwill of those who use trademarks and thereby to contribute to the development of industry as well as to protect the interest of consumers."¹⁸ Similarly, the purpose of the Lanham Act, the federal legislation on trademarks in the U.S., is to protect the owner's rights and the right of the public to know the origin of the goods it consumes.¹⁹

The Japanese Trademark Act²⁰ states that a trademark is "a character, figure or symbol, a combination thereof, or a combination of any of these with colors which is used in business by a person on such goods as he produces, processes, certifies or assigns."²¹ Under the Lanham Act, a trademark is defined as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others."²²

¹⁸ *Id.* at 118.

¹⁹ 15 U.S.C. § 1127 (1988).

²⁰ Shoohyoo Hoo (Trademark Act), Law No. 127 of 1959. For a list of English translations of the Trademark Law of Japan see T. DOI, *supra* note 6, at 176 n.3.

²¹ Shoohyoo Hoo (Trademark Act), Law No. 127 of 1959, Article 2(1). For another translation from the Japanese see T. DOI, *supra* note 6, at 118. Furthermore, the effect of a trade mark registration does not extend to:

a. Those marks indicating in a common way one's own portrait, name, title, well-known pseudonym, professional name, pen name or well-known abbreviation thereof; b. Those indicating in a common way the common name, place or origin, place of sale, quality, material, efficacy, use, quantity, shape, price or method or time of manufacturing, processing or using of the goods concerned; and c. Those customarily used with regard to the specified goods.

MANUAL FOR THE HANDLING OF APPLICATIONS FOR PATENTS, DESIGNS AND TRADE MARKS THROUGHOUT THE WORLD 19 (supp. 58 1988). Service marks, those used to sell or advertise the services of a person and to differentiate them from others, are not registrable under the Trademark Act in Japan. A service mark is "a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." See 15 U.S.C. § 1127 (1988).

²² 15 U.S.C. § 1127 (1988).

Trademarks must be registered in Japan,²³ unlike in the United States, where use of a trademark alone will provide protection.²⁴ As the first applicant is entitled to registration and the sole right to use the mark for a specific good, proper registration is very important to ensure ownership of a specific trademark.

B. Linguistic Similarity

Only those marks which are distinctive from other registered trademarks can be registered in Japan.²⁵ One way to determine distinctiveness is to see if the mark seeking registration is likely to cause confusion when compared to an existing mark.²⁶ The major factor considered in determining a mark's likelihood to cause confusion is its similarity to other marks.

The trademark law of Japan deals with the problem of confusion and the associated linguistic comparison problems.²⁷ Rules 4 to 7, under Article 4 (1) (xi) of the Trademark Law of Japan, deal with problems associated with the Japanese language. The first three rules of Article 4(1)(xi) of the Trademark Law are the Examination Standards to help judge similarity. First, similarity in appearance (*gaikan*), pronunciation (*shooko*) and meaning (*kannen*) are examined. Second, similarity is determined from the viewpoint of the consumer "having a normal degree of caution."²⁸ Third, consideration is given to "the usage in the trade concerning the goods to which [the] trademarks pertain."²⁹

²³ See Trademark Law, *supra* note 21, Art. 18(1).

²⁴ See Cunard, *supra* note 16, at 13. See also The Lanham Act § 45, 15 U.S.C. § 1127 (1988). The Trademark Law Revision Act of 1988 adopted an "intent-to-use" system. This allows a distributor to register a trademark before it is actually used in a sale so long as the distributor has a good faith intent to use the trademark. The Revision Act amended the Lanham Act in order to coordinate the trademark registration system in the U.S. with other countries' programs.

Japan maintains membership in certain conventions, including the International Union, the Arrangement of Madrid (concerning false indications of origin), the Hague Convention Abolishing the Legalization Requirements for Foreign Public Documents and the World Intellectual Property Organization. TRADEMARKS THROUGHOUT THE WORLD § 7.01 (4th ed. 1989).

²⁵ 15 U.S.C. § 1052 (1988); Japan Trademark Act, Art. 3(1).

²⁶ 15 U.S.C. § 1052(d) (1988); Japan Trademark Act, Art. 4(1)(xv).

²⁷ See 15 U.S.C. § 1126(b) (1988) for the statutory provisions for foreign applicants. No specific provisions exist for foreign language applicants. It is generally suggested, however, that applicants check for potential translation and interpretation problems. See generally JOHN OATHOUT, TRADEMARKS: A GUIDE TO THE SELECTION, ADMINISTRATION, AND PROTECTION OF TRADEMARKS IN MODERN BUSINESS PRACTICE (1981).

²⁸ S. Kimura and T. Katsube, *Concerning Judgement of Similarities: Trademarks in APAA Countries*, Asian Patent Attorneys Association, WIPO 1984 at 125. (reprinted in E. HOROWITZ, *supra* note 13, § 7.02, n.46a). For considerations used by the Patent Office in judging the similarity of goods, see E. HOROWITZ, *supra* note 13, § 7.02 (1990).

²⁹ T. DOI, *supra* note 6, at 133.

Rule 6 compels a comparison, based on pronunciation, appearance or meaning, of prevalent parts in determining similarity between two trade names.³⁰

In addition, the Japanese Patent Office has developed certain criteria to determine if the Japanese pronunciations of foreign language marks and Japanese language marks are judged phonetically similar. They are:

- (1) both marks have the same number of syllables, when in Japanese, and one syllable, with the same vowel, differing (eg., PASTA/pa-su-ta & ASTHA/a-su-ta);
- (2) both marks have the same number of syllables with one differing syllable in the same row in the 50 basic syllable Japanese Alphabet system (eg., DINHILL/di-n-hi-ru & DUNHILL/du-n-hi-ru);
- (3) both marks have the same number of syllables and the one syllable that differs is the consonant syllable (eg., PHOENIX/fe-nik-(tsu)-ku-su & FELIX/fe-rik-(tsu)-ku-su);
- (4) both marks differ in only a weak [i.e., short] syllable; both can have a weak syllable or one can have a weak syllable and the other have no corresponding syllable (eg., GUM/goo-mu & GOMU/go-mu);
- (5) both marks differ in only a long syllable or of a double consonant or between a long syllable or double consonant or between a long syllable and a weak one (eg., HUNMERU/hun-me-ru & HUMMELL/hum-(tsu)-me-ru);
- (6) both have a large number of syllables and a single different syllable (eg., PHOENIX/fe-ni-(tsu)-ku-su & FELIX/fe-ri-(tsu)-ku-su);
- (7) both have a large number of syllables and one has an additional syllable (eg., BRITEX/bu-ri-te-ku-tsu & BLISTEX/bu-ri-su-te-ku-tsu);
- (8) both sound alike but:
 - (a) differ in two syllables, but each difference is within (1) - (5) above;
 - (b) the difference is in one syllable which is a contraction of the other;
 - (c) the different syllables are pronounced the same or similarly in the original language;
 - (d) the vowel or consonant in the differing syllable is similar;
 - (e) the phonetically or acoustically impressive [i.e., predominant] part is similar.³¹

³⁰ *Id.* The trademark classification system in Japan is divided into 34 classes and numerous subclasses. For review purposes, goods in a subclass are considered similar. See E. HOROWITZ, *supra* note 13, Appendix A.

³¹ E. HOROWITZ, *supra* note 13, § 7.02.

IV. USE OF A TRADEMARK

When the foreign language trademark, registered in a foreign language, uses Japanese characters to represent it, "those characters must represent the foreign-language word as it is pronounced by an ordinary Japanese speaker." This is a critical point for foreign language words seeking Japanese trademark protection. If a foreign trademark does not naturally fit within the limited number of syllables in Japanese, then "the Japanese will mentally revise the foreign spelling and pronounce the mark to fit"³² within their native and familiar sound patterns. At times, the "[d]etermination of confusing similarity may be based on 'the level of foreign language ability in Japan.'"³³ Furthermore, it is recommended to register, as an associated mark, a Japanese transliteration of a foreign-language mark.³⁴ Conversely, if a mark is registered only in *Katakana*, which is typically used to transliterate foreign words into Japanese, it "does not give the registrant rights in the original, foreign-language name from which the registered mark derives."³⁵

An interesting aspect of Japan's Trademark Law is that to partially determine use of a trademark, the Japanese Patent Office will examine the use of language and the different alphabets and characters in the trademark. When more than one language or writing system is used to register a trademark, different requirements are used to determine use. These requirements include a language analysis.³⁶ Any type of script may be used for Latin/*Romaji* lettered trademarks registered in *Romaji*.³⁷ However, Chinese characters registered in cursive script cannot appear in the standard or semi-cursive styles.³⁸ Also, a trademark registered in both Latin and *Katakana* characters may be used in either way, as long as the pronunciation corresponds, and remains protected.³⁹ However, if the mark was registered only in Latin letters, then

³² Guttman, *supra* note 2, at 571.

³³ E. HOROWITZ, *supra* note 13, § 7.02, (quoting *Daimatsu Boueki K.K. v. Hitto Yunion K.K.*, decision of the Osaka District Court, Dec. 9, 1987).

³⁴ TRADEMARKS THROUGHOUT THE WORLD, *supra* note 24, at J-11.

³⁵ Cunard, *supra* note 16, at 14. "It was recently reported that a Japanese company claimed the rights to the name 'Roto-Rooter' written in *Katakana* because the American company of that name had registered its mark in Japan only in Roman characters; a similar, famous case involved Playboy Enterprises, Inc., which lost use of its name in *Katakana*." BUSINESS TOKYO, March 1990, at 4.

³⁶ Standard on Examination of Trademark Renewal Applications, March 1978, cited in E. HOROWITZ, *supra* note 13, § 6.05. See also Yagyo, *Recent Trends on Renewal of Trademark Registration and on Cancellation Trial Based on Non-Use*, 6 YUASA AND HARA PATENT NEWS 12, 13 (1979).

³⁷ See E. HOROWITZ, *supra* note 13, § 6.05.

³⁸ *Id.* § 2.03.

³⁹ *Id.* § 6.05.

use of the *Katakana* equivalent will not be considered use of the registered trademark.⁴⁰ Conversely, if the trademark was registered in *Hiragana* characters, then the *Katakana*, *Romaji*, or *Kanji* equivalents will not be considered use of the trademark.⁴¹

It is important to note that if a trademark owner or licensee does not use a mark registered in Japan for at least three years (on goods that it has been registered with), then the mark runs the risk of cancellation⁴² but it must appear like the mark registered.⁴³

V. EXAMPLE ANALYSIS

Since the basic issue here is similar sound patterns, it is not strange that words from two different languages and spelled in two different ways are still considered similar if the pronunciation is the same. The Tokyo High Court, for example, held that "GRAND EMPEREUR," a trademark for alcoholic beverages, was similar to "EMPEROR," for similar goods. The court said that since "the sound of a trademark should be determined based on how it is naturally pronounced in the actual trade, . . . how a trademark is pronounced is determined for each specific trademark."⁴⁴

In another case, the Swiss firm, Ciba, Ltd., attempted to register CIBA in *Katakana* letters. The Tokyo High Court denied trademark protection because when CIBA was pronounced by the Japanese, it became 'chi-ba,' both a common Japanese surname and a prefecture in Japan.⁴⁵ The sound "ci" (pronounced "sea" in this case) does not exist in Japanese. It is replaced by the sound "chi."

Another interesting example dealt with the non-differentiating standard of 'l' and 'r' in Japanese. In *Nihon Bristol Laboratories K.K. v. Director General of Patent Office*,⁴⁶ a Patent Office decision denying registration of a trademark was upheld by the Tokyo High Court. Nihon Bristol sought to register "BRITEX" ('bu-ri-te-ku-tsu') for chemical products, pharmaceutical products

⁴⁰ *Id.*

⁴¹ *Id.* § 2.03.

⁴² *Id.* § 6.05.

⁴³ Trademark Law, Art. 70(1).

⁴⁴ Y. Yamasaki, Japanese Case Law Report, AIPPI Journal, of the Tokyo High Court, dated March 1986, at 32 (citing decision of June 25, 1985) (reprinted in E. HOROWITZ, *supra* note 13, § 7.02).

⁴⁵ Ciba, Ltd. v. Director General of Patent Office, TOKKYO TO KIGYOO July 1970, 41 (Tokyo High Ct., April 16, 1970); DIGEST 38 (reprinted in T.DOI, *supra* note 6, at 122).

⁴⁶ Hanrei Taimuzu (No. 259) 297 (Tokyo High Ct., Sept. 30, 1970) (reprinted in T. DOI, *supra* note 6, at 134).

and drugs. The court found that it conflicted with "BLISTEX" ('bu-ri-su-te-ku-tsu'), a previously registered trademark for goods of the same class. The 'l' and 'r' are not distinguished to the Japanese consumer and the court found that "BRITEX" and "BLISTEX" were too similar and thus too confusing.

The same question arose in *M. & T. Chemicals, Inc. v. Director General of Patent Office*.⁴⁷ The issue concerned the registrability of "LEVELUME" ('re-ve-ru-me') for agents and additives for nickeling and its conflict with "LIBRIUM," ('ri-vu-ri-u-mu') a previously registered trademark for chemical products. The court again upheld the Patent Office's finding that the two trademarks were too similar in pronunciation and thus difficult for the Japanese ear to differentiate based on the lack of distinction of 'l' and 'r,' in addition to 'v' and 'b.'

Although some marks appear different when compared by sight and sound, their Japanese pronunciation can be similar.⁴⁸ The Japanese listener may become confused, especially when consumers or "traders" request goods recognized by the marks.⁴⁹ For example, in a recent case, the Tokyo High Court held that the mark PHOENIX (pronounced 'fe-nik-(tsu)-ku-su'), for sporting goods, was similar to FELIX ('fe-rik-(tsu)-ku-su'), for photographic equipment and thus declined the former's trademark application.⁵⁰ The "(tsu)" signifies a guttural stop. Here it is used to reproduce the sound of "x" following a vowel.

In one case, the Osaka District Court held that since the Japanese public would pronounce the two marks under examination (HIMMEL 'him-(tsu)-me-ru' and HUNMERU 'hum-(tsu)-me-ru' in *Katakana* letters) similarly to HUMMELL ('hum-me-ru') a West German company's mark,⁵¹ they could not be registered. This example incorporates both the issue of the lack of distinction between the "l" and "r," and the guttural stop.

VI. CAUTIONS

When looking solely at the linguistic aspect of Japan's Trademark Law, there are several steps that a registrant of a foreign language trademark can take

⁴⁷ Tokkyo To Kigyo, Aug. 1976, 37 (Tokyo High Ct., June 30, 1976) (reprinted in T. DOI, *supra* note 6, at 136).

⁴⁸ See also Guttman, *Japanese Trademarks and the Japanese Language*, PATENTS AND LICENSING 15 (Oct. 1981).

⁴⁹ E. HOROWITZ, *supra* note 13, § 7.02.

⁵⁰ Tokyo High Court No. 166 (Gyo-Ke)/85, dated April 24, 1986, Suzuye Report No. 50, November 1986, at 12-13 (reprinted in E. HOROWITZ, *supra* note 13, § 7.02).

⁵¹ Daimatsu Boueki K.K. v. Hitto Yuion K.K., Dec. 9, 1987, Patents & Licensing, Vol. 18, No. 3, Issue No. 97, June 1988, at 21 (reprinted in E. HOROWITZ, *supra* note 13, § 7.02).

to facilitate, and help insure, proper trademark registration. First, the registrant should consult someone familiar with the Japanese writing and pronunciation system,⁵² and a trademark specialist.⁵³ If both were the same person it would be safer. This specialist should be familiar with current trends in the Japanese language. It should also be noted that, Japanese speakers condense a foreign word down to fewer syllables, for easier pronunciation.⁵⁴ For example, "mass communnication" becomes "ma-su-ko-mi," "panty stocking" becomes "pa-n-su-to," and "personal computer" becomes "pa-su-con."

Second, the registrant should choose a version of the trademark in *Katakana* so the Japanese can easily read and recognize the mark.⁵⁵ This has the added benefit of facilitating transliteration of the mark into *Romaji*, or Roman script.⁵⁶ Third, the Japanese translation should be monitored to insure it remains close to the original foreign language pronunciation.⁵⁷

Fourth, a composite mark should be registered which would consist "of the original foreign-language name with its equivalent in Japanese syllabary."⁵⁸ This method of registration, however, is limited in its flexibility. It requires the trademark holder to use both parts of the mark to constitute use of the mark.⁵⁹ The solution is to file separate applications for a trademark in *Romaji* and in Japanese script.⁶⁰

Finally, the registrant should ensure that the word does not have a meaning in Japanese which is arrant or misrepresentative. "A word that is quite innocent and acceptable in English might become derogatory or obscene in another language."⁶¹ To prevent this, foreign trademark holders should review the dictionary, check with a specialist, or even conduct a language investigation, a common practice of large advertising firms.⁶²

⁵² See Guttman, *supra* note 2, at 572.

⁵³ See Cunard, *supra* note 16, at 4.

⁵⁴ See Guttman, *supra* note 2, at 570.

⁵⁵ *Id.* at 572.

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ Cunard, *supra* note 16, at 14.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ Oathout, *supra* note 19, at 62.

⁶² *Id.*

VII. CONCLUSION

The main concern for an applicant seeking to register a foreign language trademark in Japan is to make certain that, when transliterated into the limited Japanese sound patterns, the mark does not overlap into a sound pattern or word that is already registered in Japan as a mark. Members of the foreign business and legal communities are not denied equal access to Japan's intellectual property protection system. Proper care should be taken, however, not to overlook this uncommon, yet potentially harmful blunder when seeking intellectual property right protection in Japan.