

Administration of Examinations of Unclearly Designated Goods or Services

Concept for Examination of Unclearly Designated Goods or Services

In cases where either the content or scope of the designated goods or services described in the request were unclear, the JPO would order the applicant to present a written submission of evidence or to make an amendment to clarify the designated goods or services. If the applicant did not then present a written submission of evidence or written amendment, an order for submission of a written amendment would be sent to the applicant in the name of the Commissioner of the JPO. If this also met with no response, the trademark application would be dismissed.

However, this method of ordering a written submission of evidence wasted a considerable amount of time before the goods or services could either be properly amended or before the application could be dismissed due to the lack of amendment, given that the procedure required not only an order in the name of the examiner, but also another order to the same effect in the name of the Commissioner of the JPO. Thus, it hindered the speeding up of the examination process.

Moreover, the examination of whether or not the content or scope of designated goods or services described in the request were clear requires technical knowledge, so this should essentially be included in substantive examination by the examiner, rather than in formal examination by the Commissioner of the JPO. (There is an appeal precedent where the application in question was handled by applying Section 6(1) of the JTL before the amendment, based on the same purport (1984 Appeal Decision No. 8314).)

Meanwhile, the means of remedy against the dismissal by the Commissioner of the JPO was to file an objection under the Administrative Appeal Law. However, as mentioned above, technical knowledge is required to handle a dispute on the content or scope of designated goods or services, so such cases should be dealt with by the JPO's appeal procedures rather than by procedures under the Administrative Appeal Law which is a law that applies to general administrative measures.

Therefore, cases in which the content or scope of designated goods or

services described in the request are unclear shall be handled, in principle, by sending a notification of reasons for refusal instead of ordering the presentation of a written submission of evidence or a written amendment. The specific examination processes shall be based on the following policy.

(Reference) Flowchart of the processes for examination of unclearly designated goods or services

1. In cases where the designated goods or services described in the request are unclear and the classification of the goods or services described in the request is judged as not conforming to the classification prescribed by cabinet order, the said trademark registration shall not comply with the requirements in Section 6(1) and (2) of the JTL, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

Grounds for not satisfying the requirements in Section 6(1) and (2) of the JTL

Section 6(1) of the JTL provides “..... shall designate....goods or services.....to be used,” and the paragraph requires the applicant to designate goods or services for which the trademark will be used when filing a trademark application.

Also, the content and scope of this “designation” must be clear, since the goods or services described in the request not only decides the scope of the trademark, but also the scope of the trademark application or the trademark right.

Therefore, when the content or scope of the designated goods or services are unclear, the trademark application does not comply with the requirement in this subsection due to an insufficient “designation” of goods or services.

There are cases where, because the designated goods or services described in the request are unclear, it is not possible to judge whether the designated goods or services fall under the classification described in the request. The trademark application does not comply with the requirements in Section 6(2) of the JTL in such cases, because it is difficult to determine whether the designation of goods or services complies with the classification stipulated by cabinet ordinance (Note).

The main paragraph of Section 3(1) of the JTL provides that trademarks used for “goods or services in connection with one’s own business” can be registered. Therefore, when the designated goods or services described in the request are unclear, it will be deemed that the “goods or services in connection with one’s own business” in this subsection are unclear, thus, it will not be illegal to refuse the trademark application for not complying the requirement in the main paragraph of Section 3(1) of the JTL. However, since the provision of this paragraph is not stipulated as directly as that of Section 6(1) of the JTL, it would

be more appropriate to refuse the application for not complying with the requirement in Section 6(1) of the JTL.

Since Section 6(2) obligates the applicant to abide by the classification prescribed by cabinet order when designating goods or services based on the provision of Section 6(1), the provision of Section 6(2) should be applied in cases where the classification of goods or services described in the request is unclear or different from the actual classification of the goods or services, and not to cases where the designated goods or services themselves are unclear.

(Note) Note on Administration

In cases where the designated goods or services were unclear and the described classification of the goods or services was judged as not conforming to the classification prescribed by cabinet order, and where a notification of reasons for refusal was sent for not complying with the requirement in only Section 6(1) of the JTL, it will be necessary for the JPO to send another notification of reasons for refusal for not complying with the requirement in Section 6(2) in case the classification was found to be different at a later stage.

Nevertheless, if a notification of reasons for refusal was sent for not complying with the requirements in both Section 6(1) and (2) in the first place, it would be assumed that the applicant would amend both designated goods or services and their classification at the same time. Administering the case in this way is therefore considered desirable for realizing expeditious examination processes.

2. In cases where the designated goods or services described in the request are unclear but the classification of the goods or services described in the request is judged to conform to the classification prescribed by cabinet order, the trademark application shall be deemed not to comply with the requirement in Section 6(1) of the JTL, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

For example, when the designated goods were described as “Class 12 bicycles and other goods belonging to this class,” the description cannot be approved as the indication of the designated goods because the content and scope of goods are unclear. Nevertheless, the description mentions that not only “bicycles” but also “other goods pertaining to this class” are designated as

goods within the scope of Class 12, thus, the “designation” of the goods complies with the classification prescribed by cabinet order.

Therefore, in such cases, a notification of reasons for refusal shall be sent to the applicant for not satisfying the requirement in only Section 6(1) of the JTL.

3. In cases where the applicant submits a written argument or written submission of evidence solely consisting of the explanation of goods etc. against the notification of reasons for refusal mentioned above in 1. or 2., the examiner considers the said written argument or written submission of evidence, and invites the applicant to amend the designated goods or services by, for example, indicating a draft amendment (invitation for submission of a written amendment under the name of the examiner).

When the applicant does not respond to such invitation for amendment or does not make any appropriate amendment etc., that trademark application shall be refused based on the earlier reasons for refusal.

[Explanation]

For example, when the designated goods described in the request are new goods etc. that have never been distributed on the market, there could be many cases where it is difficult for the applicant to indicate the goods in his/her application.

In such cases, the applicant may be able to explain the use, function, materials, etc. of the goods, but it is often difficult for the applicant to make an immediate accurate amendment of the goods in response to the reasons for refusal. Thus, it may be too harsh to refuse the application for the reason that the applicant has not made the amendment immediately.

Therefore, when the applicant submits a written argument or written submission of evidence solely consisting of the explanation of the goods, and even if it does not resolve the reasons for refusal, the JPO shall not refuse the said application immediately.

In such cases, the examiner shall sufficiently consider the explanation of the goods described in the written argument or written submission of evidence, and invite the applicant to amend the designated goods or services by, for example, indicating a draft amendment.

However, if the applicant does not correspond in any way or does not amend the designated goods, the examiner shall refuse the application based on the original reasons for refusal.

The examiner shall explain details related to the reasons for refusal or the invitation for amendment, or give invitations and advice on how to respond, by interviewing or phoning the applicant or the representative as required, and encourage the submission of appropriate written amendment etc.

4. In cases where the designated goods or services described in the request are clear, but the classification of goods or services designated in the request does not conform to the classification prescribed by cabinet order, the trademark application shall be deemed not to satisfy the requirement in Section 6(2) of the JTL, and a notification of reasons for refusal shall be sent to the applicant.

[Explanation]

When the designated goods or services described in the request are clear, but there is an error in the classification of the goods or services, for example, when the classification of the goods or services does not conform to the classification prescribed by cabinet order, as in the case where the description is “Class 20 sweets” instead of “Class 30 sweets,” the trademark application shall be deemed not to satisfy the requirement in Section 6(2) of the JTL, as in the past, and a notification of reasons for refusal shall be sent to the applicant.

5. Applications filed before the amended law of 1996 entered into force shall be handled in the same manner as from 1. to 4. mentioned above, based on Section 6(1) of the JTL before the amendment.

[Explanation]

Section 3 of the Supplementary Provisions of the Law Partially Amending the Trademark Law etc. (Law No. 68 of 1996) provides that examination concerning designated goods or services in applications filed before the amended law of 1996 entered into force should be handled according to the conventional administration. However, since there are no particular reasons to handle these separately from the applications filed after the law entered into force, such applications shall be handled in the same manner as from 1. to 4. mentioned above. In cases where a written submission of evidence has

already been made or amendment has been ordered under the name of the examiner for an application filed before the law entered into force, but where the application still did not satisfy the requirement in Section 6(1) of the previous JTL, a notification of reasons for refusal shall be sent to the applicant, in principle.

6. Unclear designated goods and/or services or unclear classification of goods and/or services shall be handled as follows.

1) When the designated goods and/or services are recognized to be unclear, the examiner shall send a notification of reasons for refusal grounding that the requirement in Section 6(1) has not been satisfied and shall request that the applicant amend the respective designated goods and/or services so that they are clearly described.

However, when the content and scope of the goods and/or services are clear from the indication of each item of designated goods and/or services, the indication is accepted as the indication of the designated goods and/or services of the respective application in principle. This will be so even if the designated goods and/or services are overlapped.

2) The classification of the goods and/or services shall follow the classification described in a notification of designation. When classification is found to be apparently erroneous, the examiner confirms with the International Bureau.

3) Handling Item 3. above applies mutatis mutandis to international trademark applications.

[Explanation]

(1) In respect to the description of the designated goods and/or services, when the content and scope of the designated goods and/or services are unclear from the indication of designated goods and/or services in an international trademark application (including the name of the goods and/or services on the alphabetical list), the JPO shall send a notification of reasons for refusal grounding that the requirement in Section 6(1) has not been satisfied, and shall request that the applicant amend the designated goods and/or services to clarify the content and scope. (In this case, goods and/or services that are found to be unclear, even though published in the alphabetical list of International Classification, shall be indicated with * in the remark column of the "Japanese translation of the alphabetical list of the Nice Classification [7th edition] (with group codes for similar items)" for the time being.)

However, since the goods and/or services designated by an international registration have already been classified and examined by the International Bureau, the international registration notified to our country and

recognized as an international trademark application shall be basically dealt with in deference to the indicated classification and examination. When the indication of each item of the designated goods and/or services clarifies the content and scope of the goods and/or services, it is recognized as the indication of the designated goods and/or services of the respective application in principle, even though the designated goods and/or services are overlapped.

- (2) Since the International Bureau has already examined whether or not the designated goods and/or services are indicated according to the classification of the goods and/or services, there is no need to examine it in the designated state. Even if the examiner in charge finds doubt in the designated classification, the examiner shall follow the classification specified by the International Bureau and confirm with the International Bureau only when an obvious error is recognized.
- (3) In relation to a national application, when an applicant submits a written argument or a written explanation of the designated goods and/or services etc. in response to a notification of reasons for refusal grounding that unclear indication of the designated goods and/or services (Section 6 (1)), but the applicant does not make amendment to clarify the designated goods and/or services, the examiner shall consider the written argument, etc. and invite the applicant to amend the designated goods or services properly; for example, by referring to a draft amendment. An international trademark application shall be handled in the same manner.

In such a case, the examiner is able to send invitations for amendment to the representative in Japan, including instructions to amend the designated goods and/or services properly, in the same manner as a national application.

The Examiner shall clearly describe that the time limit designated in the previous notification of reasons for refusal shall be extended, and that the application shall be refused according to the previous notification of reasons for refusal when the applicant does not respond to the respective invitations for amendment or when the applicant does not make any proper amendment.

(Reference)

General Flowchart of the Process of Examination of Unclearly Designated Goods or Services

(Note) The cases where the classification of designated goods or services does not conform to the actual classification of the goods or services (Section 6(2) of the JTL) shall be handled according to the conventional administration without any changes.

