

Part 14: Article 4 (1)(xvi) (Misleading as to the Quality of the Goods or Services)

is likely to mislead as to the quality of the goods or services;

1. "... likely to mislead as to the quality of the goods or services" applies in a case where the quality of goods or services, whether it actually exists or not, is mistakenly recognized by consumers as quality inherent to goods or services).

2. Where a reason for refusal is served against an application for the registration of a trademark which is judged as likely to cause confusion as to the quality of goods or services in connection with its designated goods or designated services, an amendment to change the designated goods or designated services to those not liable to cause confusion as to their quality is permitted unless it does not change the gist of the application concerned but rejected if it changes the gist of the application.

3. A trademark including a state name, a geographical name, etc. which is recognized to indicate the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services and used for goods produced and sold or services provided in a country or a place other than those where it is inherently produced and sold or provided falls under the provision of this paragraph on the ground that the trademark is liable to be misleading as to the quality of goods or services.

Especially, those trademarks in which the description of the composition of appearance is well united or conceptually related to the state name contained, (excluding cases where the term is a segment of an established word etc. not being recognized as a name of a state.), in principle, fall under the provision of the paragraph as indicating the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services.

However, this does not apply where the designated goods or services are indicated in an adequate manner not to cause a misleading recognition as to its quality as in the following cases.

(a) A trademark for clothing includes letters "イギリス" (Britain) and designates goods "イギリス製の服" (British-made Clothing).

(b) A trademark for services serving food and beverages includes letters "フランス" (France) and designates services "フランス料理の提供" (Provision of French

Dishes).

Appendant letters added to a trademark to indicate the place of production and sale of goods or the location of the provision of services, such as a state name, geographical name, etc., can be deleted by an amendment.

However, appendant letters added to trademarks in relation to an application of international trademark registration may not be deleted.

(Examples)

Corresponding

“SWISSTEX”                      Designated goods Class 14 Clocks

<Remarks> The state name “SWISS” is recognized by the letters “SWISS”

Not corresponding

“どどいつ” [Dodoitsu]      Designated goods Class 11 Bathtub

<Remarks> “どどいつ” is recognized by the letters “都々逸”

4. Where a trademark carries letters or a diagram guaranteeing the quality of goods or services such as “(... Exhibition Gold Medal Winning)” and “(... Minister’s Award Winning), a proof needs to be produced to that effect. When such a proof is not produced, the provision of this paragraph applies except in case where a trademark is refused for the reason set forth in Article 4(1)(ix).

5. Any letters used in a trademark merely in an appendant portion, such as “JIS”, “JAS”, “特許”(patent), “実用新案”(utility model registration), “意匠” (design registration), etc. comes under the provision of this paragraph unless it is deleted by an amendment.

However, appendant letters added to trademarks in relation to an application of international trademark registration may not be deleted.

6. This paragraph will apply to regional collective trademarks where the trademark is used with respect to goods or services other than those having a close relationship to the regional name in the trademark, because such use is liable to be misleading as to the quality of goods or services.

However, this paragraph shall not apply where the designated goods or designated services are indicated properly in such a way as not to be misleading as to the quality of goods or services, as shown hereunder.

(i) Indication of “(name of goods) made in ○○ (regional name)” where the regional name is the origin of the relevant goods

(ii) Indication of “(name of services) provided in ○○ (regional name)” where the regional name is the location of provision of the services

(iii) Indication of “(name of goods) made mainly of □□ (raw materials) produced in ○○ (regional name)” where the regional name is the origin of the main raw materials used for the relevant goods.

(iv) Indication of “ (name of goods) produced by the method originated in ○○(regional name)” where the regional name is the origin of the method used for the relevant goods, excluding methods such as “Indian curry” and “江戸前すし” [EDOMAE SUSHI] which have become recognized as a general method in the course of losing their close relationship to the relevant region.

The above example 4 shall not hinder the application of this paragraph, where the designated goods for a regional collective trademark stating “ (name of goods) produced by the method originated in ○○ (regional name)” is liable to mislead the consumers into perceiving the goods as those made in ○○ or those made mainly of □□ (raw materials) produced in ○○.