

Chapter XV: Article 68 -9, 10, 11, -12, 13, 15, 16, 17, -18, 20, and 28

(Special Provisions Relating to Application for International Registration)

Article 68-9

(1) Any request for territorial extension to designate Japan shall be deemed to be an application for trademark registration filed on the date of international registration provided in Article 3 (4) of the Protocol (hereinafter referred to as the "date of international registration"); provided, however, that in the case of subsequent designation, such request shall be deemed to be an application for trademark registration filed on the date on which the subsequent designation pertaining to the international registration pursuant to Article 3ter (2) of the Protocol (hereinafter referred to as the "date of subsequent designation") is recorded in the International Register of the International Bureau provided in Article 2 (1) (hereinafter referred to as the "International Register"). (2) Matters stated in the left column of the following table contained in the International Register pertaining to the international registration designating Japan shall be deemed to be the matters stated in the right column of the said table contained in the application submitted pursuant to Article 5 (1).

The name and the domicile or residence of the registered holder of international registration.	The name and the domicile or residence of the applicant for trademark registration.
The trademark subject to international registration.	The trademark for which registration is sought.
The goods or services listed in the international registration and the class of the goods or services	The designated goods or designated services and the class of the goods or services provided by Cabinet Order as provided for an Article 6(2);

Article 68-10

(1) Where a registered trademark (hereinafter in this article referred to as a "registered trademark based on international registration") pertaining to the request for territorial extension which is deemed to have been an application for trademark registration pursuant to Article 68-9 (1) (hereinafter in this chapter

referred to as an "international application for trademark registration") is identical with the registered trademark prior to the trademark registration (except registered trademarks based on international registration, hereinafter referred to in this article as a "registered trademark based on national registration") and the designated goods or designated services pertaining to the registered trademark based on international registration overlap with the designated goods or designated services based on national registration, and further the holder of trademark right of the registered trademark based on international registration is identical with the holder of trademark right of the registered trademark based on national registration, the international application for trademark registration shall be deemed to have been filed on the date of filing of the application for trademark registration pertaining to the registered trademark based on national registration to the extent of the scope which is overlapping.

(2) The provisions of paragraphs (3) and (4) of Article 68-32 shall apply mutatis mutandis to the international application for trademark registration under the preceding paragraph.

Article 68-11

For the purpose of application of Article 9 (2) to an international application for trademark registration, the term "at the time of filing of the application for trademark registration" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

Article 68-12

Article 10 shall not apply to an international application for trademark registration.

Article 68terdecies

Articles 11 and 65 shall not apply to an international application for trademark registration.

Article 68quindecies

(1) The provisions of paragraphs (1) to (4) of Article 43 of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13 (1) of this Act shall not apply to an international application for trademark registration.

(2) For the purpose of application of Article 43(1) of the Patent Act as applied mutatis mutandis pursuant to Article 43-2 (3) of the Patent Act as applied mutatis mutandis upon reading the specified terms in accordance with Article 13 (1) of this Act to the international application for trademark registration, the portion "at the time of filing of the patent application" in the said paragraph shall be replaced with "within thirty days from the date of the international application for trademark registration."

Article 68-16

(1) For the purpose of application of Article 34 (4) of the Patent Act as applied mutatis mutandis pursuant to Article 13 (2) of this Act to the international application for trademark registration, the portion ", except in the case of general successions including inheritance, without the Commissioner of the Patent Office." in the said paragraph shall be replaced with "without notification to the International Bureau."

(2) The provisions of paragraphs (5) to (7) of Article 34 of the Patent Act as applied mutatis mutandis pursuant to Article 13 (2) of this Act shall not apply to an international application for trademark registration.

Article 68-17

Where all or some of the goods or services listed in the international registration are divided and transferred as a result of a change in the ownership of international registration, the international application for trademark registration shall be deemed to have become applications for trademark registration with respect to each of the registered holders after the change.

Article 68-18

(1) Article 17-3 of the Design Act as applied mutatis mutandis pursuant to Article 17-2 (1) or 55-2 (3) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2)) of this Act shall not apply to an international application for trademark registration.

(2) Article 17-4 of the Design Act as applied mutatis mutandis pursuant to Article 17-2 (2) of this Act shall not apply to an international application for trademark registration.

Article 68-20

(1) Where all or a portion of the international registration on which the international application for trademark registration is based has lapsed, the international application for trademark registration shall be deemed to have been withdrawn in respect of all or the portion of the designated goods or designated services that have lapsed.

(2) Where all or a portion of the international registration on which the international registration is based has lapsed, the trademark right based on such international registration the establishment of which has been registered under Article 18 (2) as applied upon reading the specified terms in accordance with Article 68-19 (1) (hereinafter referred to as the "trademark right based on international registration") shall be deemed to have lapsed in respect of all or the portion of the designated goods or designated services that have lapsed.

(3) The preceding two paragraphs shall take effect as of the date the international registration lapses in the International Register.

Article 68-28

(1) Any amendment to the designated goods or designated services stated in the international application for trademark registration may be made only within the time limit designated in Article 15-2 (including cases where it is applied mutatis mutandis pursuant to Article 55-2 (1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2))) or Article 15-3 (including cases where it is applied mutatis mutandis pursuant to Article 55-2 (1) (including cases where it is applied mutatis mutandis pursuant to Article 60-2 (2))).

(2) Article 68-40 shall not apply to an international application for trademark registration.

1. Article 68(10) (Special Provisions for Time of Filing of Application for International Trademark Registration) will be handled as follows:

(1) Article 68(10) will be applied to registered trademarks based on effectively existing national registrations (hereinafter referred to as "nationally registered trademarks") at the time of the examination for the said application for international trademark registration, fulfilling the requirements of the regulations in this Article. This will not be applied to, for example, trademarks under application or trademarks related to registration based on applications for international trademark registration.

(2) The guidelines for the decisions concerning the overlapped designated goods or

designated services in relation to the applications for international and national trademark registrations are as follows:

(i) When it is apparent that the designated good or service of the application for international trademark registration did not exist at the time of the application for national registered trademark, this will not be considered to be overlapped.

(ii) Though the designated good for the application of international trademark registration may not have existed at the time of the said application of national trademark registration, regardless of guideline 1, accounting for the quality, form, intended purpose, functions etc. of the good and the concept and idea of trade in general to which the designated good should belong, when the good is substantially considered to belong to the same kind as a designated good of a nationally registered trademark, the said designated good will be considered as duplicating. Furthermore, designated services in relation to the application for international trademark registration will be handled in a similar manner to designated goods.

However, for example, when the said designated good is specified as a “wooden desk”, a “metal desk” will not be considered as duplicating.

(3) Based on a strict interpretation, the identity of trademarks between the application for international trademark registration and nationally registered trademarks will be limited to trademarks in which the composition and states are identical (or those are to scale).

(4) When the application for international trademark registration designates more than one good or service, and when there are one or more domestic registered trademarks relevant to overlapping, whether the application date will retroact in accordance with the regulations of Article 68(10) or not will depend on the examination of the fulfillment of the requirements given in Article 65(10) for each domestic registered trademark case. When the requirements are proven to be fulfilled, the application date will retroact for each designated good or service of each domestic registered trademark.

2. From the nature of international registration, trademark amendments cannot be made in relation to the application for international trademark registration.