

“The Industrial Property Rights System in Japan”

Chapter 3. The Trademark System in Japan

Reason for Refusal / Rejection

The grounds for refusal to register a trademark following the substantive examination can be roughly divided into two types: absolute and relative. “Absolute grounds” include the lack of distinguishability mentioned earlier, and being identical or similar to public trademarks. “Relative grounds” include possible confusion with someone else’s prior trademark.

In most countries, absolute grounds for registration refusal are determined during the examination ex-officio. In some countries, however, an examination for relative grounds for refusal is not carried out. Registration of a later application of a similar trademark may be accepted as long as no opposition to the registration is filed by the holder of a prior registered trademark before the trademark right is granted.

It takes longer to acquire the right when an examination for relative grounds for refusal is included than when there is only an examination for absolute grounds.

However, the right granted in such cases is superior in terms of stability because there is less confusion with other rights holders regarding its source after registration.

Taking the stability of the right into account, examiners in Japan carry out examinations for both absolute and relative grounds for refusal ex officio.

Here are two examples of cases that will not be registered because they are similar to prior registered trademarks:

“HCNDA”, because it looks similar to the prior application “HONDA”;

and “Bahhalo”, because it sounds similar to the prior application “Buffalo”.

Any trademark that is likely to mislead those who see or hear it will not be registered.

For example, “tora” is the Japanese word for “tiger”. If an application is made for “TIGER”, but there is already a prior “TORA” trademark, “TIGER” may be determined to be a similar trademark, even though the two words differ in appearance and pronunciation. Since they both have the same meaning, it will therefore not be eligible for registration.

When an application is refused, a notification is made of the grounds for refusal. The applicant may then submit a written opinion or amendment that includes any amendment or amendments made to the designated goods or designated services or trademark for which the registration is sought.

A decision of refusal is made when there is no response from the applicant for a notification for grounds of refusal, or when the written opinion or amendment may not eliminate the grounds for refusal.

An applicant who is dissatisfied with the examiner's decision may file a request for a trial against the examiner's decision of refusal.

Where no reasons for refusal are found in connection with an application for trademark registration, the examiner will render a decision to the effect that the trademark can be registered. The application is registered in the Trademark Registry by carrying out the subsequent procedures, and a trademark right will go into effect upon registration of the establishment of that right.

A trademark right expires ten years after the date of its registration of establishment. However, because the aim of trademark protection is to ensure the maintenance of business confidence among those who use trademarks, it may be renewed any number of times.