

### 15.03

#### **Regarding the Decision of "Identicalness of Trademarks" Concerning Standard Characters Where an Application for Trademark Registration Accompanies a Priority Claim**

Irrespective of whether or not the first foreign application was filed claiming standard characters, when either the first foreign application, which serves as the basis for priority, or an application with a priority claim filed in Japan, has been filed claiming standard characters, the "identicalness of trademarks" will be decided based on a comparison between the trademark shown in the priority certificate and the trademark shown in the application submitted in Japan (if the application filed in Japan is claiming standard characters, the trademark shown after being written in standard characters).

(Explanation)

Some trademarks, for which an application for trademark registration with a priority claim has been filed in Japan, may be filed claiming standard characters in their first foreign applications which serve as the basis for priority. However, because the scope and appearance of characters allowed to be used as standard characters differ between the country of first application and Japan, the fact that the first foreign application was filed claiming standard characters cannot serve as a condition for deciding the "identicalness of a trademark" even if the application for trademark registration filed in Japan has been filed claiming standard characters.

On the other hand, when an application for trademark registration filed in Japan is filed claiming standard characters, the trademark which is the subject of the application will not be the trademark that is stated in the application but the one written in standard characters (Part IV (Article 5), Chapter 3 of the Examination Guidelines for Trademarks). (See Article 12-2(2)(iii), Article 18(3)(iii) and Article 27(1) of the Trademark Act).

Therefore, the decision of "identicalness of trademarks" in cases where there is a priority claim will be based on the trademark shown in the priority certificate, irrespective of whether or not the first foreign application serving as the basis for priority is filed claiming standard characters. When the application for trademark registration has been filed in Japan without claiming standard characters, the trademark will be compared with the trademark stated in the application submitted in Japan to make the decision regarding the identicalness of the trademark. If the application for trademark registration has been filed in Japan claiming standard characters, the trademark stated in the application will be converted to standard characters and then compared to make the determination of identicalness.

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks: Article 5 (Applications for trademark registration)