

25.71

Handling of a Case in which a "Transliteration of the Mark," "Translation of the Mark" or "Description of the Mark" was Indicated in an International Application for Trademark Registration

1. When a "transliteration of the mark" or "translation of the mark" is described, the examiner can use it as a reference for identifying the sound or concept.

In this case, the examiner will decide whether or not to use it as a reference by taking into consideration the degree of recognition by Japanese consumers.

2. When a "description of the mark" is made, the examiner confirms the description and follows the procedures below.

(1) When a description mentions that the claimed trademark is a "motion trademark," "hologram trademark" or "position mark," the handling described in Part IV, Article 5 (Applications for trademark registration), Chapter 6, Item 2 of the Examination Guidelines for Trademarks shall apply.

(2) When there is a clear description that multiple trademarks are being filed in a single application, the application is in violation of the requirement of single trademarks for each application as provided in Article 6(1) of the Trademark Act. For example, the British Trademark Law adopts a series mark system where multiple trademarks can be filed in a single application, and thus an international application for trademark registration using such series mark as the basic registration or basic application falls under the category of applications mentioned above.

(3) When there is a description on the constituents or appearance of the trademark such as an explanation of the three-dimensional trademark¹ or an explanation of the combination of colors in the trademark, the information is referenced in examination as required.

(4) When there is a description that is not provided in the current trademark system of

¹ Of this handling, the part concerning "an explanation of the three-dimensional trademark" in 2(3) is applied to applications filed on or before March 31, 2020 (see the Ministerial Order Partially Amending the Regulation for Enforcement of the Trademark Act [Order of the Ministry of Economy, Trade and Industry No. 8, February 14, 2020]). Meanwhile, from April 1, 2020, onward, an entry to the column "Description of the mark" in the designation notification will be the detailed description of the trademark, also for a "three-dimensional trademark" (see Part IV, Item 7(2) [Article 5 (Applications for trademark registration)] of the Examination Guidelines for Trademarks).

Japan such as non-claim of right to a part of the trademark or claiming an associated trademark, the description is not considered.

(Note) Points to consider in cases where there is a description that does not claim the right to a part of the trademark

When the applicant does not claim the right to a part of the trademark, that part is generally less capable of distinguishing the applicant's goods (or services) from the goods (or services) of others. Therefore, when examining such an application, it is necessary to consider that said part of the trademark is often incapable of distinguishing the designated goods (or services) or that it may lead the general public to misunderstand the quality of such goods (or services).

Also, there are cases where a description of a non-claim of right is made when the trademark includes a national flag and the applicant does not wish to acquire the right to the flag part. In this case, the examiner refuses the trademark pursuant to Article 4(1)(i) of the Trademark Act if he/she recognizes that the trademark noticeably comprises a national flag or the graphic of a foreign national flag.

3. When the "description of the mark" contains a statement that is found likely to negatively affect public policy

Even if the "description of the mark" contains a statement that is found likely to negatively affect policy, the examiner shall determine whether the trademark itself or its use is likely to negatively affect publicly policy in the examination but shall not determine that the trademark is likely to negatively affect public policy merely based on such statement.

<Reference> Example of statement in the "Description of the mark"

(i) Explanation of the trademark

- Explanation of the constituents and appearance of the trademark
- Explanation of the color of the trademark
- (Including a description stating that it is equivalent to the proviso to Article 5(6) of the Japanese Trademark Act)
- Explanation of the characters used in the trademark (grammatical explanation of the word: for example, "noun" or others)
- Explanation of the trademark (i.e. reasons for using the trademark)

(ii) Explanation of the three-dimensional trademark

(iii) Statement of non-claim of right to a part of the trademark

(iv) Statement to the effect that the trademark is in standard characters

(v) Explanation of motion marks, hologram marks or position marks, etc.

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

Main Paragraph of Article 3(1)

Article 4(1)(i) (National flag and imperial chrysanthemum crest)

Article 5 (Applications for trademark registration)

Article 6 (Single trademark on each application)