

28.01

Handling of the Indications of Services not Complying with the Attached Table of the Regulation for Enforcement of the Trademark Act

(Introduction)

The retail services listed in the Attached Table of the Regulation for Enforcement of the Trademark Act and described in the Examination Guidelines for Similar Goods and Services are limited examples, and other retail services—for instance, applications for trademark registration designating the following services—are processed as described below.

In this case, similar group codes for retail services through which similar goods are dealt in (35K02 - 35K21) and those for goods which are presumed to be similar to goods dealt in through the retail services stated in the application will be assigned to such applications. When there are no equivalent retail services, "35K99" and similar group codes for goods which are presumed to be similar to goods dealt in through the retail services will be assigned.

1. When indicating a part of services (benefits) covered by retail services as designated services, such as "selection and display of goods, and provision of a concierge service to customers in retail services and/or wholesale services for XXX (hereinafter XXX refers to the type of goods)," applicants are required to amend the applications to be covered by a wording like "retail services and/or wholesale services for XXX."

(Explanation)

Retail services are regarded as one of the services providing general services conducted in the course of retail and wholesale business, and they are not services which provide an individual benefit as a service.

Accordingly, it is not appropriate to indicate each element of these general services as "benefits" of retail services. For this reason, applicants are required to amend the applications by replacing each element of the retail services with "benefits" to be covered by a wording like "retail services and/or wholesale services for XXX."

2. Under the amended Trademark Act, the wording "the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods." does not specify whether business-support services or retail services are covered. Therefore, the examiner confirms the applicants' intentions by issuing a notification of reasons for refusal based on Article 6 of the Trademark Act.

As a result of the confirmation, when they indicate business-support services, the

examiner requires the applicants to amend the applications to be covered by wording like "other than retail services and/or wholesale services." When they indicate retail services, the examiner requires the applicants to amend the applications to be covered by a wording like "retail services and/or wholesale services for XXX."

(Explanation)

On or before March 31, 2007, indications for services covered by "the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods."—the wording for international applications—were regarded as indications of services. Under the Trademark Act on or before March 31, 2007, when retail services were not included in the category of services under the Trademark Act, the term "others" in the abovementioned indication of services represented retailers of goods and was deemed to refer to business-support services. Accordingly, a similar group code, "35B01," was assigned to such applications.

However, since April 1, 2007, when retail services are included in the category of services under the Trademark Act, the term "others" represents not only retailers but also purchasers of goods. Therefore, for applications for such services designated by the abovementioned term and filed on or after April 1, 2007, it is not clear whether these applications are filed for retail services or for business-support services. Thus, the examiner shall first confirm for which service the applicant filed the application (application of Article 6(1) of the Trademark Act).

As a result of the confirmation, if the applicants intended to indicate retail services, the examiner requires them to amend the applications in line with the examples in the Attached Table of the Regulation for Enforcement of the Trademark Act, such as "retail services and/or wholesale services for XXX."

On the other hand, when indicating business-support services, the examiner requires the applicants to amend the applications by adding the wording, for example, "other than retail services and/or wholesale services."

3. Others

(1) Indicating "retailing XXX" and "wholesaling XXX"

Indications of "retailing XXX" and "wholesaling XXX," are not specific enough to designate goods or retail services, and they do not satisfy the requirements stipulated in Article 6 of the Trademark Act. Thus, the examiner shall confirm the applicants' intentions.

As a result of the confirmation, if the applicants intended to indicate retail services, the examiner requires them to amend the applications to be covered by a wording like "retail services and/or wholesale services for XXX." For designating goods, the examiner requires the applicants to amend the applications to simply indicate the type XXX of designated goods.

(2) Indicating "retail services for XXX" and "retail store services for XXX" The wordings "retail services for XXX" and "retail store services for XXX" clearly represent retail services, but they are not considered as appropriate descriptions for indications. Thus, the examiner sends a notification of reasons for refusal based on Article 6 of the Trademark Act and requires the applicants to amend the applications to be covered by a wording like "retail services and/or wholesale services for XXX." It should be noted that applicants cannot amend the applications to change these indications into their goods since such amendment is deemed as a change of gist.

(3) Indicating "retail store services" as an international application under the Madrid Protocol

For indications for retail store services covered by the wording "retail store services," the examiner sends a notification of reasons for refusal based on Article 6 of the Trademark Act since the filed goods are unknown and the retail store services are not specific, and requires the applicants to amend the applications by changing the wording into "retail services and/or wholesale services for XXX" to specify the goods. It should be noted that applicants cannot amend the applications to change the indications into the goods since such amendment is deemed as a change of gist.

(4) Indicating "providing information about retail services or wholesale services"

As for filed identifications covered by this wording, the examiner sends a notification of reasons for refusal to have the applicant specify the services in the applications based on Article 6 of the Trademark Act and requires the applicants to amend the applications according to either of the following rules (a) through (c).

(a) Business recognized as that aiming to provide collective information about retail services of others for a business purpose is considered as that "providing information about the sales of goods (35B01)." Therefore, the applicants are required to amend the applications to change the applications as such.

(b) Business aiming to promote sales of goods through retail services of the applicants is considered as an advertisement for services provided by the applicants. Such identifications are not accepted and thus, the applicants are required to amend the applications to be covered by the wording "retail services and/or wholesale services for XXX" to specify the goods dealt by the applicants.

(c) If the business is recognized as that aiming to provide information and advice for consumers in the choice of products and retailers that handle them, the applicants are required to amend the applications to be covered by the wording "providing commercial information and advice for consumers in the choice of products and services (35L01)."

(5) Indicating general retail services from which "clothing," "food and beverage" or "livingware" is deleted

Applications from which these terms are deleted are no longer applications for general

retail services but rather specific retail services, based on the wording "retail services and/or wholesale services for a variety of goods in each field of clothing and livingware, carrying all goods together." Therefore, the examiner sends a notification of reasons for refusal based on Article 6 of the Trademark Act and requires the applicants to amend the applications to specify the retail services covered by a wording like "retail services and/or wholesale services for clothing and furniture."

It should be noted that applicants cannot amend the applications by adding their goods to provide general retail services since such amendment is deemed as a change of gist.

(6) Indicating retail services for certain business conditions instead of goods dealt in by retail services

For applications for this indication, such as those covered by "retail services and/or wholesale services in the field of convenience store business" or "retail services and/or wholesale services in the field of do-it-yourself store business," the examiner sends a notification of reasons for refusal based on Article 6 of the Trademark Act, and requires the applicants to amend the applications to be covered by the wording "retail services and/or wholesale services for XXX" to specify the goods that the applicants deal in.