

41.100.04

Application for Trademark Registration that may not be "Used in Connection with Goods or Services Pertaining to the Business of an Applicant" in a High Probability

Examination Guidelines for Trademarks: Part I, Chapter 2, Item 2

(2) The designated services falling under, for example, the following example will receive a notification of reasons for refusal stating that the trademark does not fall within the category of trademarks registrable in accordance with the main paragraph of Article 3(1), because it is likely that it is impossible to use the trademark, and whether the applicant may carry out the designated services or not shall be confirmed.

(Example)

If it is required to have any national qualification prescribed in laws and regulations to execute a business in connection with the designated services, and it is not possible to confirm whether the applicant is a juridical person that may execute the business connected with the designated services from the applicant's name or other matters described in an application or the applicant has the national qualification as an individual

For example, for services as follows, in order to engage in their businesses, relevant persons are obliged to have national qualifications, etc. prescribed by laws and regulations.

Accordingly, when applications designating these services are filed, the examiner confirms whether the applicant falls under anyone of following conditions (1) and (2) from registers of national qualifications or names of applicants, etc. (the matter stated in (a) is confirmed when the applicant is an individual, and the matter stated in (b) is confirmed when the applicant is a corporation).

If an examiner cannot confirm that the applicant falls under anyone of the following (1) and (2) by considering the description in the documents submitted by the applicant and the results of examination upon the court's own authority, the examiner shall notify the applicant the reasons for refusal that he/she has judged that the filed trademark does not fall under the trademarks registrable under the main paragraph of Article 3(1) of the Trademark Act since it is highly likely that the applicant may not use the trademark with respect to that service, and shall confirm whether the applicant is capable of offering the designated service.

After that, if the examiner can confirm that the applicant falls under any of the following (1) and (2), the reasons for refusal shall be resolved.

(1) The applicant has the relevant national qualification, etc. as an individual.

(2) The applicant is a corporation capable of engaging in the business pertaining to the designated service.

In the case of the following services, attention should be paid to the fact that amending the description to, for example, "provision of information on the service" or "advice on the service" is a change of gist.

(Example)

(i) An attorney or a legal professional corporation for services "lawsuits and other legal services" (Article 72 of the Attorney Act)

(a) Confirming that the applicant is an attorney

Website of Japan Federation of Bar Associations: search attorneys (<http://www.bengoshikai.jp/>)

(b) Confirming that the applicant is a legal professional corporation

To be recognized that letters of "legal professional corporation" are used in the corporation name

Article 72 of the Attorney Act

Article 72 of the Attorney Act

No person other than an attorney or a legal professional corporation may, for the purpose of obtaining compensation, engage in the business of providing legal advice or representation, handling arbitration matters, aiding in conciliation, or providing other legal services in connection with any lawsuits, non-contentious cases, or objections, requesting for re-examination, appeals and other petitions against administrative agencies, etc., or other general legal services, or act as an intermediary in such matters; provided, however, that the foregoing shall not apply if otherwise specified in this Act or other laws.

(ii) A judicial scrivener or a judicial scrivener corporation for services "Representation regarding the procedures involved in a registration or a statutory deposit" (Article 73 of the Judicial Scrivener Act)

(a) Confirming that the applicant is a judicial scrivener

Website of Japan Federation of Shiho-shoshi's Associations: search judicial scriveners (<http://www.shiho-shoshi.or.jp/doui.html>)

(b) Confirming that the applicant is a judicial scrivener corporation

To be recognized that letters of "judicial scrivener corporation" are used in the corporation name

Article 73 of the Judicial Scrivener Act

No person other than a judicial scrivener or a judicial scrivener corporation (except an Association) may engage in the business prescribed in items (i) to (iv) of Article 3(1); provided, however, that the foregoing shall not apply if otherwise specified in other laws.

(iii) A patent attorney or a patent attorneys office for services "Representation regarding the procedures related to industrial property" (Article 75 of the Patent Attorneys Act)

(a) Confirming that the applicant is a patent attorney

Website of Japan Patent Attorneys Association: Japan patent attorneys search (<http://www.jpaa.or.jp/?cat=775>)

(b) Confirming that the applicant is a patent attorneys office

To be recognized that letters of "patent attorneys office" are used in the corporation

name

Article 75 of the Patent Attorneys Act

A person that is not a patent attorney or a patent attorneys office may not, at the request of others and by receiving compensation, engage in the business of representing others regarding procedures with the Japan Patent Office relating to patents, utility models, designs or trademarks, or international applications or applications for international registration of designs or applications for international registration of trademarks, or procedures with the Minister of Economy, Trade and Industry for filing a request for review under the provisions of the Administrative Complaint Review Act or an award relating to patents, utility models, designs or trademarks (except for representing others regarding procedures of paying patent fees and applying for registration in the patent registry and other acts specified by Cabinet Order) or the business of giving expert opinions on matters relating to these procedures or making documents or electronic or magnetic records (meaning a record used in computerized information processing which is created in electronic form, magnetic form, or any other form that cannot be perceived by the human senses) specified by Cabinet Order.

(iv) A certified public accountant or an audit corporation for services to "audit or conduct attestation of financial documents" (Articles 47-2 of the Certified Public Accountants Act)

(a) Confirming that the applicant is a certified public accountant

Website of the Japanese Institute of Certified Public Accountants: search certified public accountants, etc. (https://www.jicpa.or.jp/cpa_search/)

(b) Confirming that the applicant is an audit corporation

To be recognized that letters of "audit corporation" are used in the corporation name

Article 47-2 of the Certified Public Accountants Act

No person other than a certified public accountant or an audit corporation shall operate the services set forth in Article 2(1) for fees at the request of others, except in the cases prescribed by Acts.

(v) A certified public tax accountant or a tax accountant corporation for services of "tax consultation" and "tax proxy" (Article 52 of the Certified Public Tax Accountant Act)

(a) Confirming that the applicant is a certified public tax accountant

Website of the Japan Federation of Certified Public Tax Accountants' Associations: search site of licensed tax accountant's information (<https://www.zeirishikensaku.jp/>)

(b) Confirming that the applicant is a tax accountant corporation

To recognize that letters of "tax accountant corporation" are used in the corporation name

Article 52 of the Licensed Tax Accountant Act

No person other than a certified public tax accountant or a tax accountant corporation shall engage in the practice of business as a tax accountant; provided, however, that the foregoing shall not apply if otherwise specified in this Act.

(vi) A medical practitioner or a medical corporation for services of "medical practice"

(Article 17, etc. of the Medical Practitioners Act)

- (a) Confirming that the applicant is a medical practitioner
 Website of the Ministry of Health, Labour and Welfare: search for confirming the qualification of a medical practitioner, etc.
 (<https://licenseif.mhlw.go.jp/search/jsp/top.jsp>)
- (b) Confirming that the applicant is a medical corporation
 Confirmation is done by recognizing that letters of "medical corporation" are used in the corporation name (take note that in some cases a "medical corporation" does not include the name of "medical corporation" in its name), etc.

Article 17 of the Medical Practitioners Act

No person except a medical practitioner shall engage in medical practice.

(vii) A dentist or a medical corporation for services of "dental practice" (Article 17, etc. of the Dentists Act)

- (a) Confirming that the applicant is a dentist
 Website of the Ministry of Health, Labour and Welfare: search for confirming the qualification of a medical practitioner, etc.
 (<https://licenseif.mhlw.go.jp/search/jsp/top.jsp>)
- (b) Confirming that the applicant is a medical corporation
 Confirmation is done by recognizing that letters of "medical corporation" are used in the corporation name (take note that in some cases a "medical corporation" does not include the name of "medical corporation" in its name), etc.

Article 17 of the Dentists Act

No person except a dentist shall engage in dental practice.

(viii) A pharmacist, a medical practitioner, a dentist or a corporation which has obtained permission for setting up a pharmacy for services of "dispensing of medicine" (Article 19, etc. of the Pharmacists Act)

- (a) Confirming that the applicant is a pharmacist
 Website of the Ministry of Health, Labour and Welfare: search for confirming the qualification of a pharmacist (<http://yakuzaisi.mhlw.go.jp/search/>)
 Confirming (vi)(a) or (vii)(a) with respect to confirming that the applicant is a medical practitioner or a pharmacist
- (b) Confirming that the corporation has obtained permission for setting up a pharmacy (Article 4(1) of the Law on Securing Quality, Efficacy and Safety of Products Including Pharmaceuticals and Medical devices)

Article 19 of the Pharmacists Act

No person other than a pharmacist may dispense medicine for the purpose of sale or provisions thereof; provided, however, that this does not apply where a medical practitioner or dental practitioner dispenses medicine according to the practitioner's own prescription in either of the following cases, or where a veterinarian dispenses medicine according to the veterinarian's own prescription:

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

Examination Guidelines for Trademarks
Main Paragraph of Article 3(1)