

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

1. Examination of applications for trademark registration where there is a high probability that the applicant will not be able to "use the trademark for goods or services related to his/her own business".

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.

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 ex officio examination, 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.

If the examiner can confirm that the applicant falls under any of the following (1) and (2) from the description in the documents submitted by the applicant, etc., the reasons for refusal shall not be notified.

(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) Services of "agencies for legal procedures relating to lawsuits or other legal issues" (Article 72 of the Attorney Act)

- (a) Confirming that the applicant is an attorney
Website of Japan Federation of Bar Associations: search attorneys
(<https://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.
- (c) Confirming that the applicant is authorized to perform business in accordance with the provisions of individual laws
 - Confirming that the applicant is a patent attorney or a patent attorney corporation (Article 6 of the Patent Attorney Act).
Regarding the confirmation of the patent attorney, check (iii) (a).
 - In addition, confirm the fact that the applicant is able to perform business related to the designated services through the description of the submitted documents¹.

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) Services of "agencies for judicial registration or deposits" (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
(<https://www.shiho-shoshi.or.jp/other/doui/>)
- (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.
- (c) Confirming that the applicant is a lawyer or legal professional corporation
Regarding the confirmation of the lawyer, check (i) (a).

¹ If it can be confirmed from the description of the submitted documents, for example, that the applicant is a judicial scrivener who is authorized by the Minister of Justice and is able to carry out related business such as summary litigation representation, or a judicial scrivener corporation that has such a judicial scrivener as a member, the main paragraph of Article 3(1) of the Trademark Act shall not apply.

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) Services of "

agencies for procedures relating to industrial property rights, preparation of expert opinions " (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 (<https://www.benrishi-navi.com/>)

(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.

(c) Confirming that the applicant is a lawyer or legal professional corporation

Regarding the confirmation of the lawyer, check (i) (a).

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) Services of "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) Services of "advisory services relating to tax planning" and "tax payment processing Services

" (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 be recognized that letters of "tax accountant corporation" are used in the corporation name.
- (c) Confirming that the applicant is a lawyer, legal professional corporation or certified public tax accountant
Regarding the confirmation of the lawyer, check (i) (a).
Regarding the confirmation of the certified public tax accountant, check (iv) (a).

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) 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_isei/)
- (b) Confirming that the applicant is a medical corporation
To be recognized that letters of "medical corporation" are used in the corporation name².
- (c) Confirming that the applicant is a local public entity
- (d) Confirming that the applicant has obtained permission³ for setting up a hospital, etc.
To be recognized that the applicant has set up or has obtained permission for setting up a "hospital" or "clinic" through the description of the submitted documents⁴.

Article 17 of the Medical Practitioners Act

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

² The term "medical corporation" refers to ones that include the letters of "medical corporation" in the name of legal status, such as "medical corporation association" or "medical corporation foundation". The same applies to (vii) and (viii) below.

³ Article 7(1) of the Medical Care Act

⁴ If, for example, the fact that a "public interest corporation," "school corporation," or "joint-stock corporation" has set up a hospital, etc., is confirmed through the description in the submitted documents, the main paragraph of Article 3(1) of the Trademark Act shall not apply to either "medical practice," "dentistry services," or "preparation and dispensing of medications" The same applies to (vii) and (viii) below.

(vii) Services of "dentistry services" (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_isei/)
- (b) Confirming that the applicant is a medical corporation
 To be recognized that letters of "medical corporation" are used in the corporation name.
- (c) Confirming that the applicant is a local public entity
- (d) Confirming that the applicant has obtained permission for setting up a hospital, etc.
 To be recognized that the applicant has set up or has obtained permission for setting up a "hospital", "clinic", etc., through the description of the submitted documents.

Article 17 of the Dentists Act

No person except a dentist shall engage in dental practice.

(viii) Services of "preparation and dispensing of medications" (Article 19, etc. of the Pharmacists Act)

- (a) Confirming that the applicant is a pharmacist, medical practitioner or dentist
 Website of the Ministry of Health, Labour and Welfare: search for confirming the qualification of a pharmacist
 (https://licenseif.mhlw.go.jp/search_iyaku/top.jsp)
 Regarding the confirmation of a medical practitioner or dentist, check (vi)(a) or (vii)(a).
- (b) Confirming that the applicant is a medical corporation
 To be recognized that letters of "medical corporation" are used in the corporation name.
- (c) Confirming that the applicant is a local public entity
- (d) Confirming that the applicant has obtained permission for setting up a hospital, etc.
 To be recognized that the applicant has set up or has obtained permission for setting up a "hospital", "clinic", etc., through the description of the submitted documents.
- (e) Confirming that the applicant has obtained permission⁵ for setting up a pharmacy
 To be recognized that the applicant has set up or has obtained permission for setting up a pharmacy through the description of the submitted documents.

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: (omitted)

2. Omission of submission of a "document certifying that the applicant has a national

⁵ Article 4 (1) of the Act on Securing Quality, Efficacy and Safety of Products Including Pharmaceuticals and Medical Devices

qualification, etc., provided by laws and regulations to perform the business, for services for which the applicant is required to have the national qualification, etc." by the same applicant

If the same applicant has already submitted a "document certifying that the applicant has a national qualification, etc., provided by laws and regulations to perform the business, for services for which the applicant is required to have the national qualification, etc." in another earlier application, the applicant may omit the submission of the document to prove that the applicant is performing the services for the designated services by indicating the application number and the name of the document, etc., in the written opinion.

In this case, the examiner shall use the documents submitted in the earlier application to confirm that the applicant has the relevant national qualification, etc., provided by laws and regulations to perform the business, for the services for which the applicant is required to have the national qualification, etc.

The same shall also apply when the applicant has indicated to that effect from the beginning of the application in a subsequent application for trademark registration. For example, the statement to that effect in the application shall be as follows:

(Example) (Example of statement in an application for trademark registration)

The following is an example of an application for trademark registration: in the "[Other]" column of the application form, the words "Documents certifying that the applicant has the national qualifications, etc. provided by laws and regulations to perform the business" and the "application number" and "name of the document and its submission date" should be indicated.

[Other] Documents certifying that the applicant has the national qualifications, etc., provided by laws and regulations to perform the business Trademark Application 2020-XXXXXX Written Opinion (submitted on DD MM, 2020)
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