

41.103.01

Trademarks Related to Foreign Geographical Names

1. Country names

A name of a country, an abbreviation of a country's name, and the former name of an existing country will be refused, in principle, since it indicates the place of origin, the place of sales (place of transaction) of the goods, or the place of provision of services (place of transaction).

Names that are indicated in characters used in the home country, in the Japanese language, and other foreign languages, will also be subject to this restriction in principle.

2. Geographical names

In the cases of (a) the name of a capital, (b) the name of a state, (c) the name of a prefecture, (d) the name of a state capital, (e) the name of a province, (f) the name of the capital of a province, (g) the name of a county, (h) the name of the capital of a prefecture, (i) a former country name, (j) an old regional name, (k) the name of a district, (l) the name of a city, or special district, (m) the name of a busy downtown street, and (n) the name of a sightseeing area, even though these names may not be directly described in a dictionary or other documents/material as the place of origin, the place of sales (location of transaction) of the goods, or the location of provision of services (location of transaction), if a factor exists that establishes a connection between the goods and the name as the place of sales (location of transaction), or the location of the provision of services (location of transaction), in principle, the trademark will be refused on the grounds that it indicates the location where the goods are sold (location of transaction) or the location of provision of services (location of transaction).

3. Common names

A trademark indicating the common name of goods or services in a foreign language (irrespective of whether the name is indicated in foreign language characters or Japanese characters), in principle, must be translated into Japanese and comply with the provisions of Article 3(1)(i) of the Trademark Act, irrespective of whether or not that foreign word is used in Japan.

4. Indicating the quality

A trademark indicating the quality of goods or services in a foreign language (irrespective of whether the name is indicated in foreign language characters or Japanese characters) must be translated into Japanese in principle, and will be examined to determine whether or not Article 3(1)(iii) of the Trademark Act is applicable to the

trademark, without requiring the condition of use of that foreign word in Japan.

5. Personal names, etc. (in relation to Article 4(1)(viii) of the Trademark Act)

Notwithstanding the fact that all personal names and names of legal entities in foreign countries will be subject to the restrictions stated below, in the process of reaching a decision, as it is difficult to be acquainted with all foreign names, efforts must be expended to research material and evidence and to contact people in the pertinent business sectors to gather relevant information. The information provided will also be considered to be evidence upon which an examination will be conducted.

Though the abbreviated name of a legal entity without the titles of Corporation, or Co., Ltd. may not be well known, if those names can be clearly understood to be the name of a specific person, Article 4(1)(viii) of the Trademark Act will be applied to that trademark.

(Note) According to the "Act on General Incorporated Associations and General Incorporated Foundations" (Act No. 48 of 2006), it is stated that "a general incorporated association or a general incorporated foundation shall use the words 'ippan shadan houjin' or 'ippan zaidan houjin' in its name according to the kind of entity." However, if the procedure of transition has not been completed, the expression "shadan houjin OO" and "zaidan houjin OO" may be allowed as a transitional measure for a five-year transitional period from the enforcement of the Act (December 1, 2010).

6. Well-known marks (in relation to Article 4(1)(x) of the Trademark Act)

When Article 4(1)(x) of the Trademark Act is applied to an application for trademark registration by citing a foreign trademark, that foreign trademark must be well known by consumers in Japan before that application for trademark registration has been filed (Article 4(3) of the Trademark Act).

Therefore, when a determination as to whether or not a trademark is well known must be made, evidence that can prove the above fact with respect to the goods in question must be produced. For example, when documents that prove that the trademark is well known in a foreign country, that the goods are being exported to several countries, or that services are being provided in many countries, that evidence must be taken into consideration to build conviction when determining whether or not the trademark is well-known. Even though the evidence obtainable in Japan may be limited, the evidence must be studied with the broadest intention of accepting the trademark as being well known (the trademark need not be known to end consumers).

When determining whether or not a trademark is well known, its relation to the goods or services and the actual state of the transaction will sufficiently be taken into consideration. For example, if the goods or services are in a specialized field, the application for trademark registration will be handled with the broadest intent of

accepting the trademark as being well known, even though the volume of evidence submitted may not be large. (Note)

7. Famous trademarks (in relation to Article 4(1)(xv) of the Trademark Act)

Trademarks to be refused on the basis of Article 4(1)(xv) of the Trademark Act using a citation from a famous trademark include trademarks which are recognized as a famous trademark in foreign countries by consumers of Japan prior to the date when the relevant application for trademark registration was filed (Article 4(3) of the Trademark Act) and which, when used by the applicant who has filed the application, are liable to cause confusion with the goods or services connected with another person's business. When determining whether there is a possibility that confusion may be caused with the goods or services connected with another person's business, full consideration must be given to the relation between the trademark and the goods or services, and the actual circumstances of the transaction. (Note)

(Note) With respect to the application of Article 4(1)(xix) of the Trademark Act in relation to well-known and famous trademarks, see 42.119.03.

8. Trademarks comprising the name of a country or region

Trademarks comprising the name of a country or region will be handled as follows:

(1) When a trademark comprises the name of a foreign country or region that is deemed to indicate the place of origin or sales (place of transaction) of goods, and when that trademark will be used for goods that are manufactured in a country or region other than that pertinent country or region, the trademark will be refused, and a notification of reasons for refusal (Article 4(1)(xvi)) will be sent for the reason that the trademark may mislead consumers about the quality of the goods.

(2) When a trademark comprising the name of a country or region is recognized as indicating a unique attribute of the service content or the place of provision of service (place of transaction) with respect to the designated service, but the trademark is used for the provision of services other than the services with a unique attribute indicated by the name of the country or region or the services provided in the country or region, that trademark will be refused, and a notification of reasons for refusal will be sent based on the likelihood that the trademark would mislead consumers as to the quality of the service (Article 4(1)(xvi) of the Trademark Act).

(3) In cases of (1) and (2) above, when the examiner requests the applicant to amend the goods or services, for example when the trademark includes the letters "Champs Élysées" or "France," the examiner requests the applicant to amend the letters to "OO

produced in France" for goods and to "the provision of French food" for services that involve the provision of food and drinks.

In this case, when the applicant is an individual, or for other reasons, when the applicant is expected to experience difficulty in complying with the request for amendment, the examiner shall add, in the notification of reasons for refusal, additional comments, such as "however, the refusal does not apply if the designated goods of the application are amended to state 'OO manufactured in OO'."

(4) When the name of a country or region is used simply as an appendant, the portion with the letters can be deleted from the trademark as an amendment. The examiner will add, in the notification of reasons for refusal, an additional comment stating that "however, the refusal does not apply if the letters 'OO' are deleted" (only limited to the case when the letters are deemed from appearance to be clearly independent and indicate the place of origin or sale of the good (place of transaction) or the place of provision of services (place of transaction), and even though it is deleted, future applications for trademark registration will not be affected).

9. National flags and other emblems

The determination of similarity with a national flag or other emblems will be based on as broad a scope of similarity as possible in view of the need to honor international faith.

10. Famous emblems of royal families, symbol marks of countries, etc.

The use of famous emblems of royal families and symbol marks of countries will be refused pursuant to Article 4(1)(vii) of the Trademark Act since this is contrary to the need to honor international faith.

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

Examination Guidelines for Trademarks:

Article 3(1)(i) (Common name of goods or services)

Article 3(1)(iii) (Indication of origin, place of sale, quality and other characteristics of the goods, or indication of location, quality and other characteristics of provision of the services)

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

Article 4(1)(ii), (iii) and (v) (State coat of arms and other emblems)

Article 4(1)(vii) (Contravention of public order or morality)

Article 4(1)(viii) (Name of another person)

Article 4(1)(x) (Well-known trademark of another person)

Article 4(1)(xv) (Confusion over the source of goods and services)

Article 4(1)(xvi) (Misleading as to the quality of the goods or services)