

42.114.01**Handling of Denominations of Registered Varieties of Propagating Materials**

Denominations of registered varieties of propagating materials will be handled as follows according the designated goods or designated services.

1. When the designated goods are goods assigned with the "subject similar group code" (33C01 or 33D01) or where the designated services are retail services handling goods related to the "subject similar group code."

[Subject similar group code]

- (i) 33C01 "Seeds and bulbs"
- (ii) 33D01 "Trees, grasses, turf [natural], dried flowers, seedlings, saplings, flowers [natural], pasture grass, potted dwarf trees [Bonsai]"

(1) When the filed trademark is identical with or similar to the denomination of a variety for which registration for variety has been obtained pursuant to the Plant Variety Protection and Seed Act¹ (hereinafter referred to as the "registered variety") and the duration of the variety registration has not expired, Article 4(1)(xiv) of the Trademark Act will be applied.

(2) When the filed trademark is recognized as the denomination of the variety for which registration for variety has been obtained pursuant to the Plant Variety Protection and Seed Act but the breeder's right has extinguished due to reasons such as the expiration of the duration of the variety registration (hereinafter referred to as the "denomination of a deleted registered variety"; also refer to item (i) of the [Notes]), the provisions of Article 3(1)(i), (iii) or (vi) of the Trademark Act will be applied.

(3) When the filed trademark is a composite trademark comprised of characters recognized as the denomination of a registered variety (the same applies to denominations of deleted registered varieties) and a distinctive figure, etc. and is found to mislead as to the quality of goods or services, Article 4(1)(xvi) of the Trademark Act will be applied.

[Notes]

- (i) When a variety registration has been extinguished due to being rescinded prior to expiration of duration for any reason, the same handling will be applied as in the case where the registered term has passed (expired) regardless of the relevant duration in light of Article 22 of the Plant Variety Protection and Seed Act.
- (ii) With respect to the variety registration, the latest information on expiration or rescission will be confirmed using the "data retrieval for variety registration" available on the website on variety

¹ Stipulated in Article 18(1) of the Plant Variety Protection and Seed Act.

registration of the Ministry of Agriculture, Forestry and Fisheries (<http://www.hinsyu.maff.go.jp/>) to determine the applicable provision.

[Reference trial or appeal decision]

Since the Plant Variety Protection and Seed Act and the Trademark Act are stipulated for different purposes, there are different scopes of similar goods corresponding to the respective purpose of the Act (Article 17 of the Regulation for Enforcement of the Plant Variety Protection and Seed Act in the case of the Plant Variety Protection and Seed Act). Therefore, the determination of similarity of goods based on the Plant Variety Protection and Seed Act cannot serve as the basis to determine the similarity of goods based on the Trademark Act (Appeal against Examiner's Decision of Refusal No. 2002-004926).

2. When the designated goods are "harvested material" of fruits or vegetables, etc. (excluding those that are subject to the "similar group code" mentioned above)

(1) When the filed trademark is recognized as the denomination of a registered variety and the designated goods are "harvested material related to the registered variety" or "harvested material in general (fruits, vegetables, etc.), Article 3(1)(iii) of the Trademark Act will be applied. In addition, when the filed trademark is found likely to mislead as to the quality of goods, Article 4(1)(xvi) of the Trademark Act will be applied. (see Example 1)

(2) Denominations of deleted registered varieties will be handled in the same manner as that mentioned in (1) above.

(3) When the filed trademark is a composite trademark comprised of characters recognized as the denomination of a registered variety (the same applies to denominations of deleted registered varieties) and the designated goods are "harvested materials related to the registered variety," if the filed trademark is found likely to mislead as to the quality of goods, Article 4(1)(xvi) of the Trademark Act will be applied (see Example 2).

(Example 1) When the registered variety includes "とちひめ (tochihime)" ("Crop classification: Vegetables; Type of agricultural, forestry and aquatic plants: Fragaria L.; Japanese name: Strawberry) and an application for trademark registration has been filed for the trademark "とちひめ(tochihime)" designating the goods "fruits."

The filed trademark is subject to Article 3(1)(iii) of the Trademark Act in relation to the goods "strawberry" as a trademark indicating the denomination of the variety of the goods "strawberry." In addition, the filed trademark is also subject to Article 4(1)(xvi) of the Trademark Act since the filed trademark is likely to mislead as to the quality of the goods when it is used for the goods "strawberry" other than "tochihime strawberries."

(Example 2) When the registered variety includes "とちひめ(tochihime)" and an application for trademark registration is filed for the trademark "♪♪とちひめの恵み(♪♪Tochihime no Megumi (gift of tochihime strawberries)" designating the goods "strawberry"

Article 4(1)(xvi) of the Trademark Act will be applied as the filed trademark is likely to mislead as to the quality of goods when it is used for "strawberries" other than "tochihime strawberries."

3. When the designated goods are "processed products" using the harvested materials of fruits or vegetables, etc. as raw material

(1) When the filed trademark is recognized as the denomination of a registered variety and the designated goods are "processed products using the harvested materials related to the registered variety as the raw materials," the applicability of Article 3(1)(iii) of the Trademark Act will be determined and when the filed trademark is found likely to mislead as to the quality of goods, Article 4(1)(xvi) of the Trademark Act will be applied.

(2) Denominations of deleted registered varieties will be handled in the same manner as that mentioned in (1) above.

(3) When the filed trademark is a composite trademark comprised of characters recognized as the denomination of a registered variety (the same applies to denominations of deleted registered varieties) and a distinctive figure, etc. and the designated goods are "processed products using the harvested materials related to the registered variety as the raw material," if the filed trademark is found likely to mislead as to the quality of goods, Article 4(1)(xvi) of the Trademark Act will be applied (see Example 2).

(Example 1) When the registered variety includes "とちひめ (tochihime)" and an application for trademark registration is filed for the trademark "とちひめ(tochihime)" designating the goods "bread and buns."

The filed trademark is subject to Article 3(1)(iii) of the Trademark Act in relation to the goods "bread and buns using strawberries" as a trademark indicating the raw material of the goods ("tochihime strawberries"). In addition, the filed trademark is also subject to Article 4(1)(xvi) of the Trademark Act since the filed trademark is likely to mislead as to the quality of the goods when "strawberries" other than "tochihime strawberries" are used as the raw material.

(Example 2) Case where the registered variety includes "とちひめ(tochihime)" and an application for trademark registration is filed for the trademark "♪♪とちひめの恵み(♪♪Tochihime no Megumi (gift/blessing of tochihime strawberries)" designating "ice cream"

Article 4(1)(xvi) of the Trademark Act will be applied as the filed trademark is likely to mislead as to the quality of goods when "strawberries" other than "tochihime strawberries" are used as the raw material in relation to the goods "ice cream using strawberries" included in the designated goods.

4. When the designated services are the retail service handling "harvested materials" of fruits and vegetables, etc. (excluding those that are subject to the "subject similar group code" as mentioned above)

(1) When the filed trademark is recognized as the denomination of a registered variety and the designated service is retail services handling "harvested materials related to the registered variety" or "harvested materials in general (fruits and vegetables, etc.)," Article 3(1)(vi) of the Trademark Act will be applied. In addition, when the filed trademark is found likely to mislead as to the quality of services, Article 4(1)(xvi) of the Trademark Act will be applied. (see Example 1)

(2) Denominations of deleted registered varieties will be handled in the same manner as that mentioned in (1) above.

(3) When the filed trademark is a composite trademark comprised of characters recognized as the denomination of a registered variety (the same applies to denominations of deleted registered varieties) and a distinctive figure, etc. and the designated services are retail services handling "harvested materials related to the registered variety," if the filed trademark is found likely to mislead as to the quality of goods, Article 4(1)(xvi) of the Trademark Act will be applied.

5. When the designated services are retail services handling "processed products" using the harvested materials of fruits or vegetables, etc. as the raw material

(1) When the filed trademark is recognized as the denomination of a registered variety and the designated services are retail services handling "processed products using the harvested materials related to the registered variety as the raw materials," the applicability of Article 3(1)(iii) of the Trademark Act will be determined and when the filed trademark is found likely to mislead as to the quality of service, Article 4(1)(xvi) of the Trademark Act will be applied.

(2) Denominations of deleted registered varieties will be handled in the same manner as that mentioned in (1) above.

(3) When the filed trademark is a composite trademark comprised of characters recognized as the denomination of a registered variety (the same applies to denominations of deleted registered varieties) and a distinctive figure, etc. and the designated services are retail services handling "processed products using the harvested materials related to the registered variety as the raw material," if the filed trademark is found likely to mislead as to the quality of service, Article

4(1)(xvi) of the Trademark Act will be applied (see Example 2).

6. Points to consider

The scope of application of Article 4(1)(xvi) of the Trademark Act is not necessarily limited to the scope specified above and will be determined by sufficiently taking into consideration the degree of being well-known of the denomination of the registered variety.

[Reference]

Plant Variety Protection and Seed Act

Article 18 (1) The Minister of Agriculture, Forestry and Fisheries shall register the variety unless the application for variety registration shall be rejected pursuant to the provision of paragraph (1) of Article 17.

(2) A variety registration shall be completed upon the entry of the following matters in the Register of Plant Varieties:

- (i) the registration number and the date of variety registration;
- (ii) the genus or species of the agricultural, forestry or aquatic plant to which the variety belongs;
- (iii) the denomination of the variety;
- (iv) the expression of the characteristics of the variety;
- (v) the duration of the breeder's right;
- (vi) the name and domicile or residence of the person obtaining the variety registration; and
- (vii) in addition to what is listed in the preceding items, the matters specified by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries.

(3) When he/she has registered a variety pursuant to the provisions of paragraph (1) of this Article, the Minister of Agriculture, Forestry and Fisheries shall notify the person who obtains the variety registration accordingly, and publicly notify the matters prescribed by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries.

Article 22 (1) When any person offers for transfer or transfers propagating material of a registered variety (including varieties whose registration have already expired: the same shall apply hereinafter in this Article) in the course of business, he/she shall be obliged to use the denomination of the said registered variety (where the denomination has been changed pursuant to the provisions of Article 48 paragraph (2), the denomination as changed.)

(2) When any person offers for transfer or transfers propagating material of a non-registered variety in the course of business, he/she shall be prohibited from using denomination of any registered varieties which belong to the genus or species of agricultural, forestry or aquatic plants to which the said non-registered variety belongs, or to the genus or species of agricultural, forestry or aquatic plants specified by the Ordinance of the Ministry of Agriculture, Forestry and Fisheries as similar to the

genus or species of agricultural, forestry or aquatic plants to which the said variety belongs.

2006 (Gyo-Ke) 10229 Case of Request of Rescission of Trial Decision [Judgment rendered on September 27, 2006] "Benihayato" case

The reason why the trademark listed in Article 3(1)(iii) of the Trademark Act is provided as lacking the requirements for registration as a trademark is that such kind of trademark is one which anyone would want to use as a necessary and appropriate indication for transaction and thus it is not appropriate to allow a specific person to exclusively use such trademark from the viewpoint of public interest. Moreover, such trademark is a mark that is generally used and, in many cases, lacks the capacity to distinguish one's own goods from those of others (see Judgment of the Third Petty Bench of the Supreme Court of April 10, 1979, Saibanshu, Minji, No. 126 at 507, Hanrei Jihou No. 927 at 233). In light of this purport, it is appropriate to construe that the trademark falls under Article 3(1)(iii) of the Trademark Act when the trademark may be recognized as indicating the raw material or quality of the goods by traders or consumers now and in the future and it is found inappropriate to allow a specific person to exclusively use such trademark, not to mention the case where the trademark is widely recognized by traders and consumers as indicating the raw material or quality of the designated goods at the time when the trial decision is to be rendered for this case.

(omitted)

As long as it was widely known by traders and consumers that the characters "紅隼人 (Benihayato)" could be used or is actually used as the raw material of Japanese-style confectionery and ice cream, it should be said that, when the trademark in question is used for ice cream using "Benihayato sweet potato," the traders and consumers would understand that the trademark is indicating the raw material or quality of the goods but would not recognize it as a sign distinguishing one's own goods from those of others.

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

Examination Guidelines for Trademarks:

Article 4(1)(xiv) (Name of a variety registered under the plant variety protection and seed act)

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 3(1)(vi) (Trademarks lacking distinctiveness in addition to those factors mentioned in each of the preceding items)

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