

42.117.01**Interpretation of Article 4(1)(xvii) of the Trademark Act based on the TRIPS Agreement**

1. Article 23(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the "TRIPS Agreement") provides that a "trademark containing a geographical indication" should be refused. The interpretation of this provision involves the problem of determining the criteria for judging whether a trademark falls under this "trademark containing a geographical indication." Due to the reasons given below, it is considered that the criteria must be based on formal judgment of whether the indication included in the trademark coincides with an indication specifying a specific geographical origin, and that the way in which the indication is used (e.g. "Bordeaux-style Yamanashi wine", etc.) or the question of whether the geographical indication is famous in Japan would not affect such judgment.

(Reasons)

1) Article 23(1) of the TRIPS Agreement obligates the authority to prevent the use of a trademark containing a geographical indication regardless of whether it misleads consumers, even when the trademark is "accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like." Therefore, this Article is interpreted as not being affected by the manner in which the trademark containing the said indication is recognized by the general public.

2) Article 24(6) of the TRIPS Agreement provides for an exception for cases where the indication has become a common name. If this is interpreted from an opposite point of view, it can be considered that a trademark formally recognized as containing a geographical indication will be under the application of Article 23 of the Agreement in principle, even when the indication has become a common name and its use is no longer restricted to a geographical indication.

2. Since Article 23 of the TRIPS Agreement is interpreted as above, Article 4(1)(xvii) of the Trademark Act, which ensures the provisions under this article of the TRIPS Agreement, shall provide for "trademarks containing a mark indicating an origin of wines or spirits in Japan (omitted) or a mark indicating an origin of wines or spirits in a Member of the World Trade Organization (omitted)" as the subjects of the provisions, and shall not be affected by whether or not consumers would recognize the mark as a geographical indication.

Therefore, in cases where the trademark contains a geographical indication protected in the country of origin, the trademark should be refused regardless of

whether or not it is recognized as a geographical indication in Japan. On the other hand, even if an indication may be mistaken by consumers as a geographical indication, it would only fall under Article 4(1)(xvi) of the Trademark Act and not under Article 4(1)(xvii) when the indication is not a geographical indication protected in the country of origin.

3. However, the examination of whether a trademark "contains a geographical indication" should not be based on the current criterion for "similarity," which is determined by comprehensively observing the appearance, sound, or concept of the trademark based on the state of transactions but instead, it should be judged based on whether the mark is exactly identical to the indication of the place of origin.

Therefore, a trademark "containing a geographical indication" would only refer to a mark containing an indication of the place of origin described in the local language or in translation.

For example, in the case of a geographical indication of "MOULIS" in France, if the place name is described with a Chinese character "森 (mori: Japanese for forest)," it is usually not considered as a translation of a place name in France, thus, it would not be regarded as identical to the indication of the place of origin. Also, when the place name is described with katakana letters "モリ," it would not be considered as a translation of a place name in France if it is used with other words to take on a different meaning ("元気モリモリ (full of vitality)"), and it would not be regarded as identical to the indication of the place of origin.

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

Examination Guidelines for Trademarks:

Article 4(1)(xvii) (Indication of origin of wines or spirits)