

42.400.02**Handling of Materials Relating to Claims under Article 4(4) of the Trademark Act****1. Materials confirming that the consent of another person has been obtained (the written consent)**

The written consent submitted with respect to the claim under Article 4(4) shall include (1) a statement which identifies a person as the holder of the cited trademark right, and (2) a statement which has an effect to consent that an applicant obtains a trademark registration with respect to a relevant application for the trademark registration.

The document does not necessarily have to be the one called "written consent," but must be able to confirm (1) and (2) above.

(1) Regarding the statement which identifies a person as the holder of the cited trademark right

For the purpose of identifying a person as the holder of the cited trademark right, entries of the name or title, the domicile or residence of the holder of the cited trademark right, and the registration number of the cited trademark are necessary in a written consent.

The identification of the holder of the cited trademark right shall be carried out by checking the name or title, and the domicile or residence of the holder of the cited trademark right stated in the written consent against the registry of the cited trademark. If a person cannot be identified as the holder of the cited trademark right from the statements in the written opinion, etc., confirmation will be made by sending a written notice to the applicant.

(2) Regarding a statement which has an effect to consent that an applicant obtains a trademark registration with respect to a relevant application for the trademark registration

In addition to entries of the number of an application for a trademark registration, the designated goods or the designated services, and the classes of the goods and the services, a statement is made with an effect to consent that an applicant obtains a trademark registration with respect to a relevant application for the trademark registration.

The designated goods or designated services and the classes of goods and services in the application for trademark registration shall be stated at least

for all the designated goods or designated services which have been found to be identical with or similar to the designated goods or designated services of the cited trademark in the determination under Article 4(1)(xi).

2. Materials that demonstrate that "there is no likelihood of confusion"

In order to demonstrate that there is "no likelihood of confusion," the applicant may submit, for example, the following materials.

In order for this paragraph to apply where an exclusive right to use or non-exclusive right to use is established for the cited trademark, there must be no likelihood of confusion not only with the holders of the cited trademark right but also with the holders of the exclusive right to use or non-exclusive right to use, so "the holders of the cited trademark right" and "the holders of the exclusive right to use or non-exclusive right to use" are hereinafter collectively referred to as "the holder of the cited trademark right or the like."

(1) Materials regarding "no likelihood of confusion" at the present time of the examiner's decision

With regard to the matters to be considered in the Trademark Examination Guidelines, Part III, Chapter 19, Article 4(4) (hereinafter referred to as "the Guidelines") 4. (3)(viii) Mode of use of the trademark and other actual circumstances of the transactions," the applicant is required to clarify the current mode of use of the cited trademark and the trademark as applied (hereinafter referred to as "both trademarks") and other actual circumstances of transactions. If, at the present time of the examiner's decision, there is an agreement on the modes of use, etc., the details of the agreement may be submitted as evidence. The documents related to the agreement shall be the same as in (2)(a) below.

(2) Materials regarding "no likelihood of confusion" in the future

(a) The documents related to the agreement between the parties

(i) Description

The specific circumstances regarding both trademarks exchanged by the parties must be described, and the existence of an agreement between the applicant and the holders of the cited trademark right or the like must be confirmed. Although it is possible to submit a summary of the agreement without stating all of the specific details, it should be noted that there may be cases where the summary statement does not support a finding of "no likelihood of confusion."

(ii) Document format

Document forms such as an agreement or contract (including a summary thereof) describing the details agreed upon by the applicant and the holder of the cited trademark right or the like are assumed, but need not necessarily have to be in a form signed and sealed by both parties, and materials confirming the existence of a valid and appropriate agreement are required (for example, a letter from the holder of the cited trademark right confirming the details of the agreement, and a written opinion from the applicant stating that there is no difference in the content of the letter, or a written opinion from the applicant stating that an agreement has been reached between the parties and a link to the press release clarifying the outline of the agreement).

(b) Materials that prove that it will not fluctuate in the future

If there is no confusion at the moment and the likelihood of the specific circumstances fluctuating is considered low on the basis of objective facts, it can be inferred that the state of no confusion will continue in the future. The fact that the likelihood of the specific circumstances fluctuating is low may be proved by materials concerning the business activities of the applicant, the holder of the cited trademark right or the like (publicized company brochures, etc.), materials concerning the mode of use of both trademarks, such as the period of use, the area of use (advertisements, newspaper articles, magazines, etc.), materials concerning the future program (publicized corporate press releases, etc.), materials concerning the absence of current confusion (surveys targeting traders and consumers, etc.).

(3) Written opinion

The submission of a written opinion is not mandatory. However, if the written opinion describes the specific circumstances regarding both trademarks (the degree of similarity of both trademarks, the mode of use of the trademark and other actual circumstances of the transactions, etc.) and explains the evidentiary materials submitted in such a way that the specific explanation of the absence of likelihood of confusion is provided (e.g., an explanation of the importance of not changing the modes of use, etc. of both trademarks in light of the characteristics of both trademarks and the markets for the goods or services, and of the agreement reached taking this into account), it will be considered.

(4) Cases where "no likelihood of confusion" cannot be determined based on the materials submitted

If, despite the submission of the above materials, "no likelihood of

confusion" cannot be determined because of ambiguities in the details of the agreement, etc., the applicant shall be notified of the matters to be clarified or supplemented and requested to submit additional materials. If it is difficult to determine because the summary of the agreement does not contain specific statements, the applicant may be required to submit the unabridged agreement or contract.

3. Submission form

Materials related to 1. and 2. (1) and (2) above may be submitted in a combined form in a single document. However, this does not preclude the separate submission of these materials.

The documents to be submitted need not be the originals of the agreement or other documents, and copies are acceptable; however, if there is any doubt as to the existence or authenticity of the originals, submission of the originals may be required.

4. Materials confirming that the consent of another person has been obtained and a model of documents related to the agreement

See below

Materials confirming that the consent of another person has been obtained
(Example of Written Consent)

Written Consent	
	Date
Domicile or Residence	
Name or Title, etc.	
(In the case of a legal entity, the title and name of the representative, etc.)	
<p>I, "○○," the rights holder of registered trademark No. XXX, consent that "△△ (Applicant's name or title) receives a trademark registration with respect to the following application for the trademark registration.</p>	
Note	
1 .	Number of the application for the trademark registration
2.	Designated goods or designated services and classes of goods and services
Class ●	...
Class ▲	...
Concluded	

Examples of documents related to the agreement (if the details of the agreement are not summarized)

(Examples of descriptions)

Party A (the holder of the cited trademark right) and Party B (the applicant), when Party B files an application for registration of the trademark listed in Appendix 1 (hereinafter referred to as the "trademark as applied") with the consent of Party A, agree as follows in order to prevent "likelihood of confusion" under Article 4(4) of the Trademark Act between the goods or services in which the trademark as applied is used and the goods or services pertaining to the business of Party A (including the holder of exclusive right to use or the holder of non-exclusive right to use; hereinafter the same shall apply) of the trademark of Trademark Registration No. ○○○○ (hereinafter referred to as the "cited trademark").

(1) Party A consents to Party B obtaining a trademark registration for the trademark as applied.

(2) Party A shall not use the cited trademark without the company name listed in Appendix 2, and Party B shall not use the trademark as applied without the house mark listed in Appendix 3.

(3) Party A shall use the cited trademark only for medical computer software in the designated goods in Class 9 "Computer Software," and Party B shall use the trademark as applied only for the designated goods.

(4)...

Date

A (Holder of the cited trademark)	B (Applicant)
○○ Corporation	XX Corporation
Representative Director ○○○*	Representative Director ○○

*The above is an example of a description and is not limited to representative director(s).

	Appendix 1
1. Trademark as applied	
2. Designated goods or designated services, and classes of the goods and the services	
Class ● ...	
Class ▲ ...	

Examples of documents related to the agreement (if the details of the agreement are summarized)

(Examples of descriptions)

Party A (the holder of the cited trademark right) and Party B (the applicant), when Party B files an application for registration of the trademark listed in Appendix 1 (hereinafter referred to as the "trademark as applied") with the consent of Party A, agree as follows in order to prevent "likelihood of confusion" under Article 4(4) of the Trademark Act between the goods or services in which the trademark as applied is used and the goods or services pertaining to the business of Party A (including the holder of exclusive right to use or the holder of non-exclusive right to use; hereinafter the same shall apply) of the trademark of Trademark Registration No. ○○○○ (hereinafter referred to as the "cited trademark").

(1) Party A consents to Party B obtaining a trademark registration for the trademark as applied.

(2) Party A shall not use the cited trademark without Party A's company name, and Party B shall not use the trademark as applied without a specific house mark.

(3) Party A shall use the cited trademark only for the specific goods among the designated goods, and Party B shall use the trademark as applied only for the designated goods, so that Party A and Party B shall never use the trademark as applied and the cited trademark for the same goods.

(4)...

Date

A (Holder of the cited trademark) ○○ Corporation Representative Director ○○	B (Applicant) XX Corporation Representative Director ○○
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Appendix 1

1. Trademark as applied

2. Designated goods or designated services, and classes of the goods and the services

Class ● ...

Class ▲ ...

*The details of the agreement necessary to make a "no likelihood of confusion" determination vary depending on the specific circumstances, such as the degree of similarity of both trademarks. Therefore, when submitting a document summarizing the details of the agreement between the parties, it is not always sufficient to include the information shown in the above examples, and submission of a document describing more specific details of the agreement may be required.

References

[Examination Guidelines for Trademarks:](#)

Article 4(4)(Exceptions to another person's registered trademark applied for prior to the filing date of the trademark application concerned)